≪１級課題 -知財法務実務-≫

【解答にあたっての注意】

１．問題の指示により和訳してください。

２．解答語数に特に制限はありません。適切な箇所で改行してください。

３．課題文に段落番号がある場合、これを訳文に記載してください。

４．課題は２題あります。それぞれの課題の指示に従い、２題すべて解答してください。

問１.以下は、ある米国特許出願について米国特許庁の PTAB（The Patent Trial and Appeal Board、特許審判部）がくだした Decision of Appeal（審決）からの抜粋です。翻訳対象箇所を日本語に翻訳してください。

翻訳に際しての注記

（１）翻訳対象箇所は３箇所あり、それぞれ*** START ***, *** END ***で始終点を示してあります。

（２）翻訳に際して、引用元を示す記載、例えば、Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001)、Ans. 7–8 等の記載は翻訳せず原語のまま日本語翻訳文に記載してください。引用符で囲まれている語句、例えば”configured to”などの語句は、翻訳上の必要に応じて原語で記載するか日本語に翻訳して記載するかを選択してください。

（３）翻訳文だけを読んでも内容を正確に且つ容易に理解できるよう、文書として自然な翻訳を心がけてください。必要であれば、内容の正確性が担保される限りにおいて、一文を区切って二文で表現するなど、工夫を凝らしていただいて構いません。

*** START *** A central issue before us is the meaning of the phrase "configured to" as used throughout claim 1, and in particular, the meaning of the limitation "a camera configured to acquire three-dimensional image data of a molding surface of a mold to be cleaned." As we note above, the Examiner interprets this limitation to mean a camera capable of acquiring three-dimensional image data of a molding surface of a mold to be cleaned. Ans. 7–8. On the other hand, Appellant's position is that this limitation

requires a camera that is specifically designed and positioned to capture three-dimensional image data of a molding surface of a mold to be cleaned. Appeal Br. 13. *** END ***

*** START *** We begin, appropriately, with the claim's words. See Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001)("Only when a claim is properly understood can a determination be made . . .whether the prior art anticipates and/or renders obvious the claimed invention."). The PTO's traditional pre-issuance approach has been to give claims "their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" Phillips v. AWH Corp., 415 F.3d 1303, 1316 (Fed. Cir. 2005) (emphasis added). Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the Specification. *** END ***

Having considered the respective interpretations of the Examiner and Appellant, we find the broadest reasonable interpretation is that the camera is positioned and includes hardware and software necessary to acquire 3Dimage data of the molding surface of a mold to be cleaned sufficient to enable the control device to control motion of the arm on the basis of the image data when the mold is cleaned, thereby moving the laser head along the molding surface while irradiating with the laser beam to clean the molding surface. *** START *** Although the Examiner applies a broad meaning to the phrase "configured to" to mean "capable of" (Ans. 8), we find the ordinary and customary meaning of this phrase, especially in light of Appellant's Specification, supports a narrower meaning for this phrase to require that the camera is designed such that it is able to perform the particular use, purpose or situation recited in claim 1. See Aspec Eyewear, Inc. v. Marchon Eyewear, Inc., 672 F.3d 1335, 1349 (Fed. Cir. 2012) (The phrase "adapted to" construed narrowly to mean "configured to", as opposed to "capable of" or "having the capacity of".); Boston Scientific Corp. v. Cordis Corp., 2006WL 3782840 (N.D. CA. 2006) ("A widely accepted dictionary

definition of the word 'configure' means '[t]o design, arrange, set up, or shape with a view to specific applications or uses.' American Heritage Dictionary 386 (4th ed. 2000).") *** END ***

問２．以下は ABC Inc.及び XYZ 株式会社間で締結を予定している架空の共同開発研究契約の抜粋です。翻訳対象箇所を日本語に翻訳してください。

翻訳に際しての注記
（１）翻訳対象箇所は１箇所で、***** START ***, *** END *****で始終点を示してあります。
（２）翻訳に際して、特別に定義されている用語（先頭大文字の用語です。以下「定義語」といいます。）については、翻訳文でも定義語であることが一目瞭然となるように（定義語でない語と紛らわしくないように）訳語を工夫してください。
（３）翻訳文だけを読んでも内容を正確に且つ容易に理解できるよう、文書として自然な翻訳を心がけてください。必要であれば、内容の正確性が担保される限りにおいて、一文を区切って二文で表現するなど、工夫を凝らしていただいて構いません。

<div align="center">Joint Research and Development Agreement</div>

（中略）

5. Intellectual Property

*** START ***

a. For the purpose of this Agreement, "Intellectual Property" means an invention patented pursuant to, or eligible for patent protection under the Patent Act of Japan, a device registered as such pursuant to, or eligible for utility model registration under the Utility Model Act of Japan, an industrial design registered as such pursuant to, or eligible for

design patent protection under the Design Act of Japan, knowhow or trade secret eligible for protection under the Unfair Competition Prevention Act of Japan, a work of authorship eligible for copyright protection under the Copyright Act of Japan, and those equivalent in any territory outside of Japan.

b. Any and all activities of the Joint Research shall be recorded in writing in the joint laboratory book prepared by the secretary office of the Joint Research (the "Joint Lab Book"), for which every entry must be properly dated and signed with the representative researchers of ABC and XYZ present in such activities and the secretary office manager. For any and all activities singly pursued by ABC and XYZ each for the Joint Research, ABC and XYZ shall record such activities in writing in its own laboratory book (the "Individual Lab Book"), each record of which must be properly dated and signed with the authorized representative of the party and explicitly contain any information and the source thereof accessed in the course of such activities.

c. If any researcher of ABC or XYZ conceives any Intellectual Property as the result of the Joint Research but without access to any information disclosed by the other party or any researcher thereof, and ABC or XYZ as applicable is vested with, or succeeds to, all titles, rights and interests in and to such Intellectual Property in relation to such researcher, such Intellectual Property shall be the sole property of such party unless such conception is contested as evidenced by any contradictory record contained in the Joint Lab Book or the Individual Lab Book of the other party.

*** END ***