

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

1. Court precedents relating to Outline of Examination

Classification	Content	No.	Date of Decision (Case No.)	Relevant Portion of Examination Guideline
11	How to proceed with examinations, and trials and appeals	1	Intellectual Property High Court Decision, October 26, 2005 (2005 (Gyo KE) No. 10199)	Part I, Chapter 2, Section 5, 3.(2) and (3)
		2	Intellectual Property High Court Decision, May 31, 2006 (2005 (Gyo KE) No. 10710)	
		3	Intellectual Property High Court Decision, December 20, 2006 (2006 (Gyo KE) No. 10102)	
		4	Intellectual Property High Court Decision, December 27, 2006 (2006 (Gyo KE) No. 10262)	
		5	Intellectual Property High Court Decision, June 16, 2008 (2007 (Gyo KE) No. 10244)	
		6	Intellectual Property High Court Decision, September 16, 2009 (2008 (Gyo KE) No. 10433)	
		7	Intellectual Property High Court Decision, November 30, 2010 (2010 (Gyo KE) No. 10124)	
		8	Intellectual Property High Court Decision, October 17, 2012 (2012 (Gyo KE) No. 10056)	
		9	Intellectual Property High Court Decision, December 18, 2014 (2014 (Gyo KE) No. 10102)	

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3. (2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, well-known art

1. Bibliographic Items

Case	"Ink vessel" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 26, 2005 (2005 (Gyo KE) No. 10199)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-337446 (JP 2002-192753A)
Classification	B41J 2/175
Conclusion	Dismissal
Related Provision	Article 29(2), Article 150(1), same article (5), Article 153(2), Article 159(2)
Judges	IP High Court Third Division, Presiding Judge: Hisao SATOH, Judge: Ryoichi MIMURA, Judge: Yuji KOGA

2. Overview of the Case

(1) Procedural History

- September 9, 2002 : Amendment (See the "The Claims" described below.)
- December 26, 2002 : Request for an Appeal against an Examiner's Decision of refusal (Fufuku No. 2002-24965)
- March 29, 2004 : Appeal decision of "The request for a trial and appeal of this case is dismissed."

Note that the appeal decision cites as well-known art the documents (Exhibit A6 to Exhibit A8) found by the examination of evidence by ex officio (Article 150(1)) and denies the inventive step of the claimed invention.

(2) The Claims (Amended) (Claimed invention)

[Claim 1] An ink vessel to be loaded to a printer, comprising:

a storage device configured to store multiple pieces of predetermined information related to the ink vessel and be sequentially accessed one-bit by one-bit, wherein

the storage device includes a first storage area in which multiple pieces of data that are not updated accompanying use of the ink vehicle are stored and in which the data is stored in a data size of minimum

number of bits necessary for storage of the respective data, and a second storage area in which data that is updated accompanying use of the ink vessel is stored and in which respective data is stored in a data size that is the integral multiple of 8 bits.

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>The claimed invention can be easily invented by a person skilled in the art based on JP 2-279344A (Exhibit A4. Hereinafter referred to as "cited invention") and well-known art. Therefore, the claimed invention cannot be patented according to the provisions in the Patent Act Article 29(2)...</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>(1) Citing the documents (Exhibit A6 to Exhibit A8) found in the examination of evidence by ex officio, the appeal decision denied the inventive step of the claimed invention and dismissed the request for a trial. However, the demandant was not provided an appropriate opportunity to attack and defend, and thus there is a procedural deficiency in the trial and appeal.</p> <p>More specifically, the Patent Act prescribes that if an examination of evidence by ex officio (Article 150(1)) is conducted in the appeal and trial procedure, a result thereof shall be notified to a party concerned and the party must be provided an opportunity to present their opinions after a specified reasonable period (same article-5). Thus, an opportunity to attack and defend must be provided to the demandant. In the appeal and trial of this case, although information which is prejudicial for the demandant was collected while the Plaintiff, the demandant, was uninformed, the demandant has not been provided an appropriate opportunity to attack and defend.</p> <p>(2) In the appeal and trial, the proceeding has not been fully conducted, and there is a procedural deficiency in the appeal and trial.</p> <p>In the appeal and trial procedure of this case,</p>	<p>Allegations by Defendant</p> <p>(1) The Plaintiff alleges that there is illegality that no opportunity to attack and defend was provided to the Plaintiff, although the examination of evidence by ex officio was conducted on Exhibit A6 to Exhibit A8 which were cited as well-known art in the appeal decision.</p> <p>However, well-known art is what a person skilled in the art should naturally know, and it is not an irregularity to newly exemplify an example thereof at the time of appeal decision without notifying the example in advance (See the decision by Tokyo High Court on November 12, 2002 (2001 (Gyo KE) No. 322), and the decision by Tokyo High Court on August 24, 2004 (2001 (Gyo KE) No. 549)).</p> <p>Note that showing a well-known example in an appeal decision differs from an examination of evidence. If the reason for refusal based on a new cited document is found in the appeal and trial, the reason for refusal shall be notified (Article 50 applied mutatis mutandis by the Patent Act, Article 159(2)). However, this differs from an examination of evidence. If the allegation by Plaintiff was followed, the both a notice of reasons for refusal and a notice of examination of evidence by ex officio must be notified, which is unreasonable.</p> <p>(2) The Plaintiff alleges that in the appeal and</p>

<p>since the appeal decision was made without providing the demandant with an opportunity to be involved in the proceeding after the written supplement of appeal and trial reasons was submitted, an empty proceeding that overlooking the characteristic part of the claimed invention is under way.</p>	<p>trial, the proceeding has not been fully conducted, and the applicant's critical right, which is the "right to be subjected to deliberate examination and receive a determination by a specialized administrative agency while a party concerned is involved" was violated.</p> <p>However, as previously stated, in the cited invention, adoption of the constitution of the claimed invention regarding respective differences is the matter that a person skilled in the art could easily conceive based on well-known art. Therefore, the Allegations by Plaintiff are unreasonable.</p>
<p>Judgement by the Court</p> <p>(1) The Plaintiff alleges that the appeal decision has the procedural deficiency that it did not provide the demandant with an appropriate opportunity to attack and defend concerning the documents (Exhibit A6 to Exhibit A8) found in the examination of evidence by ex officio.</p> <p>However, <u>any of the documents Exhibit A6 to Exhibit A8 cited by the appeal decision is merely exemplified as a document that shows well-known art. It is not possible to note the citation of the documents as a document that shows well-known art and state that it falls under the examination of evidence conducted by ex officio. Therefore, even if the demandant was not provided with an opportunity to state his/her opinion on the same documents, it cannot be stated that there is a procedural deficiency of the Patent Act Article 150(5). The Allegations by Plaintiff cannot be accepted.</u></p> <p>(2) ...The Plaintiff alleges that in the appeal procedure of this case, since the appeal decision was made without providing the demandant with an opportunity to be involved in the proceeding after the written supplement of appeal and trial reasons was submitted, an empty proceeding is under way with the characteristic part of the claimed invention still misidentified.</p> <p>...The Patent Act prescribes that in appeals against an examiner's decision of refusal, when a reason for refusal which differs from a reason for final decision is found (Article 159(2), the same act) when an examination of evidence or preservation of evidence is conducted by ex officio (Article 150(5), the same act), and when a reason that has not been pleaded by a party concerned or a intervenor is being examined (Article 153(2), the same act), a demandant should be provided with an opportunity to state his/her opinions about a result of the examination. However, in any case other than the above, there exists no prescription that the demandant must be provided with an opportunity to state his/her opinions without fail after submission of a written supplement of appeal reasons. Since it cannot be found that in the appeal procedure of this case, the examination which falls under the case in which the opportunity to state one's opinions must be provided was made, it cannot be stated that there was a deficiency in the procedure of the appeal of this case. Therefore, the Allegations by Plaintiff that the appeal decision overlooks the characteristic part of the claimed invention on the assumption that there is a deficiency in the appeal and trial procedure cannot be accepted at all.</p>	

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3. (2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, primary cited invention

1. Bibliographic Items

Case	"Advertisement through cellular phone" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 31, 2006 (2007 (Gyo KE) No. 10710)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-290290 (JP 2002-118656A)
Classification	H04M 3/42
Conclusion	Acceptance
Related Provision	Article 50 as applied mutatis mutandis pursuant to Article 159(2), Article 29 (2)
Judges	IP High Court Fourth Division, Presiding judge: Tomokazu TSUKAHARA, Judge: Naoki ISHIHARA, Judge: Chieko SHIMIZU

2. Overview of the Case

(1) Summary of Procedures

A decision of refusal has been issued for the claimed invention of this patent application under the provision of Article 29 (2) of the Patent Act by cited JP H11-069024A (Exhibit A6 in 3. below), JP H11-88521A (Exhibit A7 in 3. below) and JP2000-206916A.

The applicant has filed a request for appeal against an Examiner's decision of refusal and then he/she has received an appeal decision without being notified another notification of reason for refusal.

In the appeal decision, the claimed invention of this patent application is decided not to grant a patent under the provision of Article 29 (2) by cited JP H11-069024A (Exhibit A6 as described) and also newly cited JP H05-260185A and JP H09-261169A.

(2) Procedural History

- May 20, 2003 : Examiner's decision of refusal
- June 23, 2003 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-11597)
- August 18, 2005 : Appeal decision of "The request for a trial and appeal of this case is dismissed."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p> <p>It is stated that the claimed invention cannot be patented according to the provision in the Patent Act Article 29(2), because a person skilled in the art can easily invent based on the invention (hereinafter referred to as the "cited invention") stated in <u>the paper publication (JP H11-88521A, Exhibit A7)</u> and the well-known art.</p>	
<p>Decision</p>	
<p>Allegations by Plaintiff</p> <p>The appeal decision cited as paper publication the document which is different from the cited document 1 that was adopted as the reason for the examiner's decision of refusal, and affirmed that the claimed invention could be easily conceived. This falls under the "case in which a reason of refusal which is different from a reason of refusal in an examination is found in appeals against an examiner's decision of refusal" referred to in the Patent Act Article 159(2). According to the text of the Article 50 of the same act that the same section applies mutatis mutandis, a new reason of refusal must be notified.</p> <p>In addition, <u>although the paper publication cited in the appeal decision is cited in the notice of reasons for refusal, it was merely cited as the document indicating "It is a well-known matter that multiple advertisements are displayed as advertisement information and rendered user-selectable" for claims 2 and 3 of the application concerned, and not for the claimed invention (claim 1), and not cited as the document indicating "an advertisement through a cellular phone wherein a display screen of a cellular phone on a receiving side is an advertisement medium and an advertisement requested in advance is displayed together with a telephone number of a transmitting side on the display screen" referred to in the appeal decision.</u></p>	<p>Allegations by Defendant</p> <p>The paper publication cited in the appeal decision is the cited document 2 that was cited as the cited document 2 in the written notice of reasons for refusal. The reason of refusal in the examiner's decision of refusal is that "the invention according to claims 1 to 6 can be easily invented by a person skilled in the art based on the inventions stated in the cited documents 1 to 3". Therefore, the appeal decision was not made based on a reason different from the reason in the examiner's decision of refusal.</p> <p>The Plaintiff alleges that the publications cited by the appeal decision are cited to the inventions described in claims 2 and 3, not to cited to the claimed invention (claim 1). However, ... By the amendment after the notice of reasons for refusal, the point "it is determined whether or not reception of the advertisement information is allowed" was added to claim 1. However, this is the addition to claim 1 made by changing the expression of the point "an advertisement item selected and allowed by the receiving side is displayed" stated in claim 2 before amendment. As such, the claimed invention incorporates the matter stated in claim 2 before amendment. Since, for claim 2 before amendment, the same document as the paper publication cited in the appeal decision was cited in the notice of reasons for refusal, it should be stated that the same document was also cited for the claimed invention.</p>
<p>Judgement by the Court</p>	

(2) ...The examiner's decision of refusal cited the reason in the notice of reasons for refusal. The notice of reasons for refusal only cites JP H11-069024A (Exhibit A6) as the "cited document 1" in connection with claim 1 (the claimed invention), but JP H11-088521A (Exhibit A7) cited as a publication in the appeal decision is merely cited as the "cited document 2" in connection with claims 2 and 3.

Therefore, in connection with the claimed invention, the publication cited in the appeal decision was not cited in the notice of reasons for refusal and the examiner's decision of refusal, and cited for the first time in the appeal decision. Thus, the appeal decision determined that the claimed invention could be easily conceived based on the reason different from the reason in the examiner's decision of refusal, and it should be stated that this falls under the "case in which a reason of refusal different from a reason of the examiner's decision is found in the appeal against an examiner's decision of refusal" referred to in the Patent Act Article 159(2).

In addition, from the substantive standpoint, in the notice of reasons for refusal, what is pointed out as the matter disclosed in the cited document 2 is "it is a well-known matter that multiple advertisements are displayed as advertisement information and rendered user-selectable". Since there is no room for the patent applicant (Plaintiff) who received the same notice to conceive that the claimed invention discloses the cited invention which was found by the appeal decision (An advertisement through a cellular phone wherein a display screen of a cellular phone on a receiving side is an advertisement medium and an advertisement requested in advance during a call is displayed to the receiving side on the display screen), the patent applicant could not substantially obtain an opportunity to take any measure such as submission of a written opinion or the like, on this point. Therefore, unless the new reason of refusal on the point mentioned above is notified in the appeal procedure, the patent applicant is obliged to receive the appeal decision without being provided any opportunity to make an argument on the point mentioned above, and apparently, which unfairly deprives the patent applicant of an opportunity to defend.

In the appeal procedure of this case, since the appeal decision that the request for appeal of this case is dismissed was made without notifying the patent applicant of the new reason of refusal, it should be stated that the appeal decision violates the provision in the text of Article 50 of the Patent Act that Article 159(2) of the same act applies mutatis mutandis.

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, well-known art

1. Bibliographic Items

Case	"Sheet tension adjustment method, sheet tension adjustment device, and sheet role wick" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, December 20, 2006 (2006 (Gyo KE) No. 10102)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 1996-330836 (JP H10-167533A)
Classification	B65H 23/182
Conclusion	Acceptance
Related Provision	Article 50 applied mutatis mutandis in Article 159(2), [P: Old law] Article 17(2)(v), Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Tomokazu TSUKAHARA, Judge: Naoki ISHIHARA, Judge: Tatsufumi SATO

2. Overview of the Case

(1) Overview of Procedure

In the decision of refusal, Japanese Utility Model Publication No. H1-36832 publication (Publication 1. Publication in which the cited invention 1 in 3. below is described) and registered Utility Model No. 3031148 publication (Publication 2. Publication in which the cited invention 2 in 3. below is described) were cited, and it was decided that the claimed invention could not be patented, according to the provisions in Article 29(2).

In response, the applicant made a request for appeals against an examiner's decision of refusal and made amendments to the claims, or the like. Then, the appeal decision was made without notifying the applicant of a new reason for refusal.

In the appeal decision of the refusal, the microfilm (Exhibit A3 in 3. below) of Japanese Utility Model Application No. H3-50354 (JP H4-135546 U) was newly cited, in addition to Japanese Utility Model Publication No. H1-36832 publication (Publication 1. Publication in which the cited invention 1 in 3. below is described) and registered Utility Model No. 3031148 publication (Publication 2), which were cited in the

decision of refusal, and it was decided that the claimed invention could not be independently patented at the time of application for patent, according to the provisions in Article 29(2).

(2) Procedural History

- April 20, 2005 : Decision of refusal
- May 26, 2005 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2005-10030)
- June 27, 2005 : Procedural amendment of claims and descriptions and request for appeal decision
- January 25, 2006 : Appeal decision that "The request for appeals and trials of this case is not valid."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>After determining that the amendment to the application is intended to restrict by limitation, the appeal decision ...dismissed the amended claimed invention as having no inventive step as so-called independent requirements for patentability. Then, the appeal decision refused the inventive step of the claimed invention.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>The appeal decision refused the inventive step of the amended claimed invention based on the cited inventions 1, 2, and the Exhibit A3 that was cited for the first time in the appeal decision. However, the positioning of the cited invention 2 as well-known art differs from the notice of reasons for refusal (Exhibit A4), and the Exhibit A3 is applied as a well-known example. The Plaintiff was provided neither any opportunity to state opinions on the Exhibit A3 invention nor any opportunity to amend. Therefore, it is obvious that this is a violation of the provisions of Article 50 which is applied mutatis mutandis in the Patent Act Article 159(2), and that this affects the conclusion of the appeal decision. Hence, it is inevitable to rescind the appeal decision.</p>	<p>Allegations by Defendant</p> <p>To decide on the inventive step, it is natural to compare the claimed invention with inventions described in publications considering well-known arts or commonly used arts as premises, and then make a decision. ... The appeal decision compared the amended claimed invention with the cited invention 1 and acknowledged that a difference was present. Then, this difference determined that the invention could be made easily by applying the cited invention 2 and well-known arts, and the appeal decision was not made for the reason which is different from the reason of the decision of refusal. The microfilm (Exhibit A3) of Japanese Utility Model Application No. H3-50354 (JP H4-135546 U) presented in the appeal decision was not cited as a new publication but is simply one illustrative document exemplified to describe the well-known art.</p>

Judgment by the Court

As the Defendant pointed out, well-known arts refer to arts which are generally known in the technical field thereof, and which should be naturally known by those skilled in the art. Consequently, even if the appeal decision that there was no inventive step was made by adding well-known matters, which were not stated in the notice of reasons for refusal, it should be interpreted, in principle, that it does not represent a10102 new reason for refusal (See Tokyo High Court Decision on May 26, 1992/1990 (Gyo KE) No. 228, for example).

However, in this case, the constitution related to the difference between the amended claimed invention and the cited invention 1 is a critical part of the amended claimed invention. The examiner erroneously identified that the constitution related to said difference was described in the Publication 2, issued the notice and made a decision to the effect that the application for patent was refused. Yet, although the Plaintiff contended for the identification based on the Publication 2 in the examination procedure and appeal procedure, the appeal decision identified the constitution related to the difference, based on the well-known art that was not even substantially shown in the examination procedure, instead of the Publication 2. Furthermore, it cannot be acknowledged that well-known art is highly well known like the universal principle or extremely common-sense/basic matter to those skilled in the art. In such a case, it can be stated that the case corresponds to a case in which a reason different from the decision of refusal is found in the appeals against an examiner's decision of refusal. In addition, from the standpoint that the procedural appropriateness demanded by the reason for refusal notification system should be secured, it should also be stated that the examiner should have issued a new notice of reasons for refusal and provide the Plaintiff, who was an applicant, with an opportunity to state opinions. Then, since the appeal decision uses the above-mentioned well-known art as the basis of the decision on the difference, it is obvious that this defect in the procedure affects the conclusion of the appeal decision.

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, primary cited inventions

1. Bibliographic Items

Case	"Long-term feeding stuff for aquatic animals" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, December 27, 2006 (2006 (Gyo KE) No. 10262)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H6-520662 (National Publication of International Patent Application No. H8-507922)
Classification	A23K 1/18
Conclusion	Acceptance
Related Provision	Article 50 and Article 29(2) that are applied mutatis mutandis in Article 159(2)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge; Yoshiyuki MORI, Judge: Koichi TANAKA

2. Overview of the Case

(1) Overview of Procedure

In the decision of refusal, JP No. H4-117243 publication (Publication 2 in 3. below, Exhibit A1), JP No. S59-173052 publication, and JP No. S60-153764 were cited, and it was decided that the claimed invention could not be patented according to the provisions in Article 29(2).

In response, the applicant made a request for appeals against an examiner's decision of refusal and made amendments to the claims. Then, the appeal decision was made without notifying the applicant of a new reason for refusal.

In the appeal decision of refusal, it was newly stated that the claimed invention was publicly known in the description of the application concerned, and West Germany Patent Application Publication No. DE3707032 (Publication 1 in 3. below, Exhibit A2. For the matters described therein, the descriptions in JP No. S63-230039, which is the laid-open application publication of the application to the Japan which is the application for claim of priority under the Paris convention based on this application, were adopted. Exhibit A3 in 3. below), which the demandant knew, as well as JP No. H4-117243 publication, JP No. S59-173052 publication, and JP No. S60-153764, which were cited in the decision of refusal, were cited, and it was decided that the claimed invention could not be patented according to the provisions of Article 29(2).

(2) Procedural History

- January 7, 2002 : Decision of refusal
- April 15, 2002 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-6395)
- May 9, 2002 : Procedural amendment of claims
- July 17, 2002 : Procedural amendment of the request for appeals
- January 30, 2003 : Appeal decision that "The request for appeals and trials of this case is not valid."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p> <p>It was decided that the claimed invention could not be patented according to the Patent Act, Article 29(2), because it could be easily invented by those skilled in the art on the basis of the well-known art described in "Publication 1" and "Publication 2" described below.</p> <p style="text-align: center;">Remarks</p> <p>Publication 1 West Germany Patent Application Publication No. DE3707032 (The invention described therein is hereinafter referred to as the "prior-art invention" and for the matters described therein, the descriptions in JP No. S63-230039, which is the laid-open application publication of Japan, [Exhibit A3] were adopted.)</p> <p>Publication 2 JP No. H4-117243 publication (The invention described therein is referred to as "Publication 2 invention". Exhibit A1)</p>	
<p>Decision</p>	
<p>Allegations by Plaintiff</p> <p>...According to the decision of refusal (Exhibit A8), the reason therefor is ...that the claimed invention should be refused for the reasons described in the notice of reasons for refusal (Exhibit A7). Then, in the above-mentioned notice of reasons for refusal, it is stated that the inventions claimed in claims 1 to 6 cannot be patented according to the provisions of the Patent Act Article 29(2) because they can be easily invented by those skilled in the art based on the Publication 2 invention. Then, no reasons for refusal other than those described in the above-mentioned notice of reasons for refusal (Exhibit A7) are notified to this application.</p>	<p>Allegations by Defendant</p> <p>Taking into consideration the prosecution history till the request, it can be said that the reason of the appeal decision that the claimed invention can be easily conceived is the reason within the reasons for refusal that were notified in the examination phase. Then, the Plaintiff had the opportunity to state opinions on this and did actually state opinions in the argument (Exhibit B1).</p> <p>Therefore, since it can be said that there was no need to provide the Plaintiff, who was familiar with the content of the conventional invention and who had already stated opinions in the above-mentioned argument, with any opportunity to state opinions again, there is no illegality that should rescind the appeal</p>

<p>Reason for the Appeal Decision</p> <p>In response, the appeal decision states that the claimed invention can be easily invented by those skilled in the art based on the conventional invention and the well-known art described in Publication 2. More specifically, in the appeal decision, the Publication 2, which is made the reason for the decision of refusal, remains in the position as a supplementary material for showing the well-known art, and the Publication 1, which is different from the Publication 2, was cited for the first time at this stage. Then, the conventional invention was identified from this Publication 1 and the decision that the claimed invention lacked the inventive step was made.</p> <p>Purpose of Text of Patent Act, Article 50</p> <p>...In addition to this, in the argument (Exhibit B1) that the Plaintiff submitted to the examiner on November 26, 2001 after receipt of the notice of reasons for refusal, the Plaintiff did not state opinions on the reason for the appeal decision that the claimed invention can be easily conceived. More specifically, in the argument (Exhibit B1), the Plaintiff provided counterarguments, understanding from the notice of reasons for refusal (Exhibit B7) that the main citation was Publication 2, that the cited invention (Publication 2 invention) was identified therefrom, and that the difference between the claimed invention and the cited invention (Publication 2 invention) was that the former was long-term feeding stuff for aquatic animals, while the latter was a dry pellet for fish farming, and did not state opinions, recognizing the conventional invention based on the Publication 1 as the cited invention.</p>	<p>decision.</p> <p>...</p> <p>C Consideration of the prosecution history</p> <p>...It is obvious that the notice of reasons for refusal regarding the Publication 2 was presented because the claimed invention is characterized by modified parts when compared with the Publication 1 (No. DE3707032 description).</p> <p>...It is also obvious that keeping the Publication 1 in mind and on the premise of the feeding stuff described in the Publication 1 as the conventional long-term feeding stuff, the Plaintiff determines that the claimed invention is characterized in the modified parts compared therewith and provides counterarguments. Thus, even if a notice of reasons for refusal including the Publication 1 is presented again, it is simply formality and the purpose of the notice of reasons for refusal will be same as the notice of reasons for refusal (Exhibit A7) dated June 12, 2001, and will make no sense.</p> <p>Therefore, it is obvious that since the notice of reasons for refusal (Exhibit A7) dated June 12, 2001 naturally included the reason on the premise that the Publication 1 is the main cited example, there is no need to present again a notice of reasons for refusal including the Publication 1 as a cited example.</p>
<p>Judgment by the Court</p> <p>A As identified above, the appeal decision on this case made on January 30, 2006 decided on the inventive step of the claimed invention, with the Publication 1 as the main citation and the Publication 2 as the</p>	

supplementary citation. However, not only the Publication 1, which is the main citation (West Germany Patent Application Publication No. DE3707032 (Publication 1 in 3. below, Exhibit A2. For the matters described therein, the descriptions in JP No. S63-230039, which is the laid-open application publication of the application to the Japan which is the application for claim of priority under the Paris convention based on this application, were adopted. Exhibit A3 in 3. below) was not a reason for the decision of refusal, but also it is acknowledged that so far, the Publication 1 had not been shown to the Plaintiff in the examination/trial and appeal.

Then, it can be said that when making the above decision in the appeal decision according to the Patent Act Article 50 that Article 159(2) of the same applies mutatis mutandis, the examiner had to notify the Plaintiff, who is the applicant, of the reason for refusal to the effect mentioned above, specify a considerable period of time, and provide the Plaintiff with an opportunity to submit the argument. Therefore, the above-mentioned decision of the appeal decision that was made without providing the Plaintiff with any opportunity to state opinions violates the Patent Act Article 50 that Article 159(2) of the same applies mutatis mutandis, and it should be stated that the extent thereof is critical enough to affect the conclusion of the appeal decision.

B Decision on the Defendant's objection

First, the Defendant argues that there is no procedural illegality that should rescind the appeal decision, since the Plaintiff was familiar with the technical contents described in the "No. DE3707032 description" (Publication 1, Exhibit A2) at the time of filing an application of the claimed invention, if the Plaintiff considers the content of the statements in the description of the application concerned and the configuration or the like of the Publication 1.

However, even if it can be said, as the Defendant argues, that the Plaintiff was familiar with the technical contents described in the Publication 1 by considering the content of the statements in the description of the application concerned and the configuration or the like of the Publication 1, the facts remain unchanged that the Publication 1, which is the main citation, was not the reason for the decision of refusal, and that the Publication 1 was not shown to the Plaintiff in the examination/trial and appeal. In addition, it is reasonable that the Plaintiff should have been given by the examiner an opportunity to submit an argument by comparing the claimed invention with the conventional invention.

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities

1. Bibliographic Items

Case	"Screen board in apparatus for producing cellulose pulp" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, June 16, 2008 (2007 (Gyo KE) No. 10244)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-32224 (JP 2000-234288A)
Classification	D21C 7/00
Conclusion	Acceptance
Related Provision	Article 50 applied mutatis mutandis under Article 159(2), Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Nobuyoshi TANAKA, Judge: Michinari ENOKIDO, Judge: Ken ASAI

2. Overview of the Case

(1) Overview of Procedure

In the decision of refusal, International Publication No. WO 96/26315 (the "Citation" in the following section 3.) has been cited and it has been determined that this application is not patentable under Article 29(1)(iii) and Article 29(2).

The applicant filed a request for an appeal against the examiner's decision of refusal and the Appeal Decision dismissing the appeal has been rendered without any new reason for refusal being notified.

In the Appeal Decision dismissing the appeal, International Publication No. WO 96/26315, which had been cited in the above decision of refusal, was again cited and it was determined that the claimed invention is not patentable under Article 29(2).

(2) Procedural History

May 28, 2003 : Decision of refusal

August 25, 2003 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.

2003-16308)

November 26, 2003 : Procedural amendment to the written request for appeal

February 27, 2007 : Appeal decision to the effect that "the request for appeal of this case is dismissed."

3. Portions of Appeal/Trial Decisions relevant to the Holding

<p>Appeal Decision (cited from the Court Decision)</p>	
<p>The Appeal Decision held that since the claimed invention would have been readily made by a person skilled in the art on the basis of the following citation, the claimed invention is not patentable under Article 29(2) of the Patent Act, and thus concluded that "the request for the appeal of this case is dismissed."</p> <p>(1) The invention (hereinafter referred to as the "cited invention") described in the Brochure of International Publication No. 96/26315 which was distributed on August 29, 1996 (Exhibit A3, which is hereinafter referred to as "Citation").</p>	
<p>Decision</p>	
<p>Allegations by Plaintiff</p> <p>(1) ...</p> <p>C. ... With regard to this application, the Examiner made the <u>Decision of Refusal</u> (Exhibit A6, which is hereinafter referred to as "this Decision of Refusal") on May 28 of the same year. In light of the statement found in its Remarks which reads that "<u>In view of the above, since in the cited invention, the screen bar which corresponds to the "land area" of the claimed invention also exists in the cited invention, they do not differ in this respect,</u>" it can be said that the reason of this Decision of Refusal, also consists in that the cited invention is substantially identical with the claimed invention.</p> <p>D. In response to the above contention, Plaintiff argued that ... the screen bar of the cited invention does not correspond to the land area of the claimed invention and that the claimed invention has advantages in terms of strength, operability, etc. over the cited invention, and presented other relevant arguments.</p> <p>E. However, the JPO's Panel ... without further notifying new reasons for refusal,... rendered the Appeal Decision to the effect that the claimed</p>	<p>Allegations by Defendant</p> <p>(2) The Examiner drafted and dispatched this notice notified the reasons for refusal to Plaintiff on the basis of ... claim 19 prior to amendments to the scope of claims.... This notice of reasons for refusal stated, as its Reason 4, the reason to the effect that "(the claimed invention would have been) readily arrived at on the basis of the citation" and Plaintiff was conversant with this citation. Accordingly, Plaintiff, who received this notice of reasons for refusal, should have reasonably understood the presence of the different matters between the original invention of this application and the cited invention as well as the content thereof and should have understood that the Examiner determined that "although the original invention of this application has matters different from those of the cited invention, the difference is readily arrived at," etc.</p> <p>...</p> <p>(3) The Appeal Decision precisely identified the structural difference between the original invention of this application and the claimed invention, recognized the difference as alleged by Plaintiff in this written opinion and this written amendment (in the Appeal),</p>

<p>invention would have been readily made by a person skilled in the art on the basis of the cited invention as well as the well-known art.</p> <p>(2) When the findings in the Appeal Decision for the request for appeal against the examiner's decision of refusal are significantly changed departing from the original findings in the stage of the examination, the Panel should notify the new reason(s) for refusal and thus give Demandant the opportunity to present his opinion in response thereto. As mentioned in the above section (1), the Panel made the Appeal Decision to the effect that the request for appeal should be dismissed for the reasons that are substantially different from those in the stage of the examination without notifying new reasons for refusal and giving Plaintiff the opportunity to present his opinion in response thereto. Hence, the Appeal Decision has been rendered in violation of the provision of the main paragraph of the Article 50 applied mutatis mutandis under Article 159(2) (hereinafter indication of the Article that provides the basis for the mutatis-mutandis application of another Article is omitted).</p>	<p>and made determination thereof.</p> <p>In other words, the difference recognized in the Appeal Decision was caused by this amendment, which is in no way different from the difference which Plaintiff had recognized and for which Plaintiff had presented his opinion.</p> <p>Further, the Appeal Decision decided to adopt the Reason 4 that was already notified to Plaintiff in the examination procedures and determined that the claimed invention would have readily been arrived at on the basis of the citation as well as the well-known art. As such, it cannot be concluded that the Appeal Decision made the determination based on "a reason that is different from that of the decision of refusal."</p>
<p>Judgment by the Court</p> <p>(2) <u>The Appeal Decision found that ... the claimed invention and the cited invention differ from each other in that "the screen plate in the claimed invention comprises a plurality of slot regions and a plurality of land areas provided between said slot regions, while the screen plate of the cited invention only includes one slot region and does not includes the land areas of the claimed invention,"</u> further found that, with regard to the features related to the difference of the claimed invention, the feature of "said screen plate comprising a metal screen plate having individual slot regions wherein each region comprises a plurality of slots formed therein" is "widely known prior to filing of this application" and "can be selected and adopted as appropriate by a person skilled in the art," and thus determined that "the claimed invention would have been readily made by a person skilled in the art on the basis of the cited invention as well as the well-known art." Thus the Appeal Decision drew on the cited invention and the well-known art and found its basis for dismissing this request for appeal against the examiner's decision of refusal in that the claimed invention falls under the provision of Article 29(2).</p> <p>(3) A. Article 159(2) provides that Article 50 is to be applied mutatis mutandis when any reason for refusal that</p>	

is different from that of the decision of refusal is found in the appeal against the examiner's decision of refusals.

When the above provision is taken into consideration in the context of this case, as mentioned above, since the Appeal Decision found that the claimed invention would have been readily made based on the cited invention as well as the well-known art and thus falls under the provision of Article 29(2), it is necessary that the above reason has already been notified in the stage of the examination, in the absence of which the reasons for refusal must be further notified. When this respect is considered, according to the above (1) B., it is stated in this notice of reasons for refusal that the claimed invention would have been readily made by a person skilled in the art on the basis of the citation and thus falls under Article 29(2), and according to the above (1) D., this decision of refusal determined that the claimed invention falls under Article 29(2) for the above reason stated in this notice of reasons for refusal. Hence, as a conclusion, the only specific reason for refusal notified prior to the Appeal Decision is the identification of the citation while the remaining portions are only directed to pointing out the provision of Article 29(2).

In the meantime, when the fact that Article 50 guarantees the opportunity for the applicant to present the written opinion after the notification is taken into account, it is reasonable to interpret that the purpose of Article 50 providing that the reasons for refusal are to be notified is to clarify the reasons for refusal, take the opinion of the applicant into account, reexamine the validity of the reasons for refusal, and thus ensure carefulness and objectivity in rendering the determination. In light of this purpose, the extent of the reason that should be notified needs to be in principle such that it enables the applicant to specifically recognize the reasons for refusal in the context of the claimed invention. When this point is taken into account in relation to application of Article 29(2), it is in principle required to specifically describe the content of the cited invention to be compared to the claimed invention, the correspondence and the difference which are the result of the determination of the comparison, and the grounds for recognizing that the feature corresponding to the difference of the claimed invention would be readily arrived at, unless there is a special circumstance where it is reasonably deemed that the reasons for refusal have been substantially notified.

When this point is considered in the context of this case, as discussed in the foregoing, in this case, identification of the citation was in fact included, but neither the correspondence nor the difference was pointed out, and further nothing specific was mentioned regarding the obviousness of the feature of the claimed invention corresponding to the difference. As a result, unless there is a specific circumstance where it is reasonably deemed that the reasons for refusal have been substantially notified, the statement is far from reaching the level that the statement is expected to reach as a notice of the reasons for refusal.

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, well-known art

1. Bibliographic Items

Case	"Exhaust gas purifying method and purifying device of internal combustion engine" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, September 16, 2009 (2008 (Gyo KE) No. 10433)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H09-339028 (JP H11-173181A)
Classification	F02D 41/04
Conclusion	Acceptance
Related Provision	Article 50 applied mutatis mutandis under Article 159(2), Article 29(2)
Judges	IP High Court First Division, Presiding judge: Tomokatsu TSUKAHARA, Judge: Tamotsu SHOJI, Judge: Shunya YAGUCHI

2. Overview of the Case

(1) Overview of Procedure

In the decision of refusal, International Publication No. WO 94/25143(Exhibit A1 in the following section 3.), JP S62-97630A, and JP H9-4492A have been cited and it has been determined that this application is not patentable under Article 29(2).

The applicants filed a request for an appeal against the examiner's decision of refusal and the decision dismissing the appeal has been rendered without any new reason for refusal being notified.

In the Appeal Decision dismissing the appeal, JP H7-139340A (Exhibit A2 in the following section 3.) and JP H7-332071A (Exhibit A3 in the same section) have been newly cited along with International Publication No. WO 94/25143 (the above Exhibit A1), which had been cited in the decision of refusal, and it was determined that the claimed invention is not patentable under Article 29(2).

(2) Procedural History

July 19, 2005 : Decision of refusal

- August 25, 2005 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2005-16201)
- January November 17, 2005 : Procedural amendment to the written request for appeal
- October 7, 2008 : Appeal decision to the effect that "the request for appeal of this case is dismissed."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>The Appeal Decision determined that the claimed invention is not patentable under Article 29(2), for the claimed invention would have been readily made by a person skilled in the art on the basis of International Publication No. WO 94/25143 (Exhibit A1, which is hereinafter referred to as "Citation." The invention described in this Citation is referred to as "the cited invention"), JP H7-139340A (Exhibit A2, which is hereinafter referred to as "Well-Known Example 1"), JP H7-332071A (Exhibit A3, which is hereinafter referred to as "Well-Known Example 2"), and JP H6-66129A (Exhibit A4, which is hereinafter referred to as "Well-Known Example 3")...</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>As Plaintiffs extensively discussed in the written opinion and the written supplement for the grounds of demand, ...use of the "NOx purifying catalyst" is very important aspect of the claimed invention, but the Appeal Decision identified the feature associated with this difference relying on the Well-Known Art 1 including Well-Known Examples 1 and 2, which did not appear in the examination procedures, and the Well-Known Art 2 including Well-Known Examples 1 and 3. However, as stated in the above sections 4 and 6, it is noted that this well-known art is not a significantly widely known technique such as universal principles or extremely common and fundamental matters. Such a case corresponds to the case where a reason for refusal that is different from the reason(s) of the examiner's decision of refusal is found in the appeal against the examiner's decision of refusal. Also, in view of guarantee of procedural appropriateness which is required under the system of notice of reasons for refusal, the Japan</p>	<p>Allegations by Defendant</p> <p>Well-Known Art 1 ... corresponds to the explanation in the "Remark" in the decision of refusal (Exhibit A13) that "as the NOx purifying catalyst, the one that adsorbs NOx onto the surface of the catalyst is so well known prior to filing of this application that exemplification thereof will not be necessary."</p> <p>Also, Well-Known Art 2 ... corresponds to the explanation in the "Remark" in the notice of reasons for refusal (Exhibit A12) that "the reduction time ... is merely a matter that can be determined as appropriate by a person skilled in the art" and corresponds to the explanation in the "Remark" in the decision of refusal (Exhibit A13) that "optimum values may be obtained for the frequency of so-called rich spike and the depth of the rich state with the fuel consumption, purification capability, etc. taken into account and through repeated experimentations by a person skilled in the art."</p> <p>Further, these Well-Known Arts 1 and 2 are, as explained in the above sections 5 and 6, so well-known that they constitute common and fundamental matters</p>

<p>Patent Office should have drafted and dispatched a new notice of reasons for refusal and give Plaintiffs who are the applicants the opportunity to present his opinion. Further, the Appeal Decision drew on the aforementioned well-known art as the basis for determining the difference. As such, it is clear that this procedural defect affects the conclusion of the Appeal Decision. Therefore, the Appeal Decision has been rendered in violation of Article 50 applied mutatis mutandis under Article 159(2).</p>	<p>for a person skilled in the art.</p> <p>In view of the foregoing, presentation of the Well-Known Arts 1 and 2 by the Appeal Decision does not fall under the case where a reason for refusal that is different from the reason(s) of the examiner's decision of refusal is found in the appeal against the examiner's decision of refusal.</p> <p>Therefore, the Appeal Decision has not been rendered in violation of Article 50 applied mutatis mutandis under Article 159(2).</p>
<p>Judgment by the Court</p> <p>As alleged by Defendant, it is clear from the interpretation of Article 29(1), Article 29(2), and Article 50 that, even when the Well-Known Arts 1 and 2 are well known as prominent inventions, the mere fact that they are well-known arts is not sufficient for relying on them as the cited inventions under Article 29(1) and Article 29(2) without explicit indication thereof in the reasons for refusal. Admittedly, <u>even well-known art that is not indicated in the reasons for refusal may be in exceptional cases allowed to be used in finding and determining obviousness under Article 29(2). However, such exceptional cases are limited to such cases where they are used for fine adjustment of the identification of the cited invention constituting the reasons for refusal, used in an auxiliary manner in the process of the determination of the obviousness, or they are very significantly well known in the relevant technical fields and they are used as the knowledge constituting evident or implicit premise in understanding the technical matters. It does not follow that they can be unconditionally cited as long as they are well-known art, without being indicated in the reasons for refusal.</u> The well-known art that Defendant alleges is very widely known and is expected to be very familiar among people concerned. However, in view of the fact that they play an important role in the procedure of finding and determining the obviousness in this case, this case does not fall under the cases where they are merely used for fine adjustment of the findings, used in an auxiliary manner in the process of determining the obviousness, or they serve as the knowledge constituting evident or implicit premise in understanding the technical matters. Hence, in this case, they cannot be factors for determination affirming the obviousness.</p>	

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, well-known art

1. Bibliographic Items

Case	"Intrinsically safe signal conditioner for a coriolis flowmeter" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, November 30, 2010 (2010 (Gyo KE) No. 10124)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-532063 (JP2003-512612A)
Classification	G01F 1/84
Conclusion	Acceptance
Related Provision	Article 50 applied mutatis mutandis under Article 159(2), Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Toshiaki IIMURA, Judge: Norio SAIKI, Judge: Eiko TAKEMIYA

2. Overview of the Case

(1) Overview of Procedure

In the decision of refusal, JP H6-281485A, JP H6-288806A, JP H8-35872A, and JP H8-166272A (Exhibit A1 in the following section 3.) have been cited and it has been determined, with regard to the inventions of claims 45 to 50 out of the inventions of claims 1 to 50, that the claimed inventions are not patentable under Article 29(2).

The applicant filed a request for an appeal against the examiner's decision of refusal and the decision dismissing the appeal has been rendered without any new reason for refusal being notified.

In the Appeal Decision dismissing the appeal, with regard to the invention of claim 45, National Publication of International Patent Application No. H4-505506 (Exhibit A2 in the following section 3.), National Publication of International Patent Application No. H6-508930 (Exhibit A 3 of the same section), and National Publication of International Patent Application No. H2-500537 (Exhibit A 4 of the same section) as the well-known art with respect to the Difference 1 have been newly cited along with JP H8-166272A (the above Exhibit A1), which had been cited in the decision of refusal; and JP H6-281485A, and JP H6-288806A as

well-known arts with respect to the Difference 2, which had also been cited in the decision of refusal, and it was determined that the claimed invention is not patentable under Article 29(2).

(2) Procedural History

- March 5, 2007 : Decision of refusal
- June 6, 2007 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2007-15678)
- August 16, 2007 : Procedural amendment to the written request for appeal
- December 15, 2009 : Appeal decision to the effect that "the request for appeal of this case is dismissed."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>(1) The Decision, as stated in the following, identified the content of the JP H8-166272A (Exhibit A1) (which is hereinafter referred to as the "cited invention"), recognized the correspondence and difference between the claimed invention and the cited invention, and determined that the claimed invention is not patentable under Article 29(2) of the Patent Law, for it would have been readily made by a person skilled in the art on the basis of the cited invention as well as the well-known art.</p> <p>(2) With regard to the inventive step or non-obviousness regarding the difference, the Appeal Decision determined as follows:</p> <p style="padding-left: 40px;">"(1) First, examination of the above Difference 1 indicates that the feature of "the coupling of the signal conditioner and the host system being made to be remote" is a technique that is well known in the technical field of flowmeters as follows.</p> <p style="padding-left: 40px;">For example, National Publication of International Patent Application No. H 4-505506... Also, National Publication of International Patent Application No. H 6-508930... Further, National Publication of International Patent Application No. H 2-500537...</p> <p style="padding-left: 40px;">(2) Next, examination of the above Difference 2 indicates that the feature of "the section provided in the signal conditioner and coupled to the flowmeter assembly being defined to be the flowmeter assembly protection circuit" is a technique that is well known in the technical field of flowmeters as described, for example, in JP H6-281485A..., JP H6-288806A..., and JP H8-35872A, which were cited in the Remarks of the Decision of Refusal."</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>A. Insufficiency of statement of the notice of reasons for refusal</p> <p>...The notice of reasons for refusal dated August 2, 2006 (Heisei 18) (Exhibit A12) only contains abstract</p>	<p>Allegations by Defendant</p> <p>A. In response to insufficiency of statement of the notice of reasons for refusal</p> <p style="padding-left: 40px;">Article 50 of the Patent Act does not specify the level or extent of the statement of the notice of reasons</p>

<p>statement such as "(the invention) only utilizes explosion proof circuitry technology for Coriolis flowmeters as appropriate." None of the following aspects are specifically stated therein: (1) the content of the cited invention to be compared with the claimed invention; (2) the correspondence and the difference identified as the result of the comparative determination; and (3) the grounds for concluding that the feature of the claimed invention corresponding to the identified difference would have been readily arrived at. The notice thus fails to reach the level that a notice of reasons for refusal is expected and required to reach. Therefore, the Appeal Decision should be rescinded pursuant to Article 50 applied mutatis mutandis under Article 159(2).</p> <p>B. Lack of notification of new reasons for refusal in relation to reasoning that is different from that of the decision of refusal</p> <p>When an Appeal Decision in an appeal against an examiner's decision of refusal is to be rendered based on a reason or reasons for refusal that are different from those of the decision of refusal, the new reason(s) for refusal must be notified and the opportunity to submit a written opinion must be given to the applicant with designation of an adequate time limit for the submission (Article 50 applied mutatis mutandis under Article 159(2)).</p> <p>However, as long as this case is concerned, the decision of refusal rejected the application on the ground that the claimed invention is mere aggregation of known techniques without identifying the primary citation. In contrast, the Appeal Decision identified JP H8-166272A (Exhibit A1), which is one of the known techniques, as the primary citation, and the document describing the well-known art as the</p>	<p>for refusal and it should be decided as appropriate within the discretion of the Examiner, depending upon specific cases, to which extent the cited invention identified from the description of documents cited in the notice of reasons for refusal should be elucidated, and whether or not the correspondence and the difference between the claimed invention and the cited invention should be stated, and, when it should be stated, to what extent they should be elucidated.</p> <p>As long as this case is concerned, Plaintiff made specific allegations ... with regard to the content of each of the inventions described in the citations, the correspondence and the difference between the claimed invention and each of the above cited inventions, and the obviousness of the claimed invention in relation to this difference. Accordingly, the meaning of the reasons for refusal notified by the Examiner was sufficiently communicated to Plaintiff, and, for example, the prior notice of reasons for refusal did not contain any defect that may prevent Plaintiff from effectively responding to the notice. As such, it cannot be said that this notice of reasons for refusal, which was made within the discretion of the Examiner, contains irregularities constituting violation of the law.</p> <p>B. With regard to the lack of notification of a new reason for refusal associated with the reasoning that is different from that of the decision of refusal</p> <p>... The primary citation that serves as the basis of the reason for denying the inventive step of the claimed invention is one of the four publications listed in the prior notice of reasons for refusal (Exhibit A12), i.e., (1) JP H8-166272A (Exhibit A1), (2)..., (3)..., and (4) ... so that this decision of refusal includes the reason for finding that the claimed invention would have been readily made relying on JP H8-166272A (the above (1),Exhibit A1) as the primary citation.</p>
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<p>secondary citation, which falls under the case where the Appeal Decision is made on the ground of a reason for refusal different from the reason(s) of the decision of refusal...</p> <p>C. Lack of the opportunity to submit the written opinion regarding the well-known art and the document describing the well-known art</p> <p>Neither the notice of reasons for refusal nor the decision of refusal of this case stated that the features of "the coupling of the signal conditioner and the host system being made to be remote" and "the section provided in the signal conditioner and coupled to the flowmeter assembly being defined to be the flowmeter assembly protection circuit" both pertain to the well-known art. Also, the Appeal Decision fails to identify the document or documents based on which the Appeal Decision recognized that these features pertain to the well-known art. Further, no opportunity to present an opinion was given to Plaintiff. The above well-known techniques are relied upon by the Appeal Decision to recognize that "a feature that is not included in the cited invention" is disclosed therein. This means that these well-known techniques were not simply used as techniques that are taken into account in the course of reasoning of the obviousness from the matters described in the distributed publications as provided in Article 29(1) and Article 29(2). Hence, new reasons for refusal should be notified and an opportunity to present an opinion (the opportunity of rebuttal, amendments, or filing a divisional application) should be given to Plaintiff, in the absence of which the procedures of the appeal proceeded in violation of the law, necessitating rescission of the Appeal Decision.</p>	<p>Also, the reason in the Appeal Decision for finding that the claimed invention would have been readily arrived at is based on JP H8-166272A (Exhibit A1), so that there is no discrepancy between the reason of the decision of refusal of the first instance and the reason of the Appeal Decision, and not notifying new reasons for refusal does not constitute procedural irregularity.</p> <p>C. With regard to lack of the opportunity to submit the written opinion regarding the well-known art and the document describing the well-known art</p> <p>"The technique of configuring the coupling of the signal conditioner and the host system to be a remote coupling" is a commonplace technique that is taken into account in the course of reasoning of affirming the obviousness from the matters described in the publications, etc. in the meaning of Article 29(1) and (2). Accordingly, even if neither the notice of reasons for refusal nor the decision of refusal describe that they pertain to the well-known art and the Appeal Decision presented Exhibits A2 to A4 for the first time, it does not blindsided Plaintiff or constitute any irregularity.</p>
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Judgment by the Court

In this case, the Appeal Decision stated for the first time the finding and determination to the effect that the technical feature of "the coupling of the signal conditioner and the host system being made to be remote" regarding the Difference 1 between the claimed invention and the cited invention pertains to the well-known art (Exhibits A2 and A4), and that the claimed invention would have been readily arrived at by adopting the well-known art.

In the meantime, when an Appeal Decision presents its determination causing addition to or modification of the reasoning presented in the notice of reasons for refusal or the decision of refusal, and if cases are set aside where there is such a special circumstance that giving the party (Demandant) no opportunity to present his/her opinion does not harm the procedural fairness or the interest of the party (Demandant), the opportunity to submit the written opinion must be given (Article 159(2), Article 50) unless there is such a circumstance. Further, whether or not there is such a special circumstance that giving the party (Demandant) no opportunity to present his/her opinion does not harm the procedural fairness or the interest of the party (Demandant) should be determined taking into account all the circumstances including, in the case of the determination of the presence or absence of obviousness, the significance and importance of the technique that provides the basis for readily arriving at the claimed invention, and whether or not the party (Demandant) had been granted the substantial opportunity of defense.

Examination is to be made as follows in light of the above aspect.

In this case, ... (2) according to the statement of the Description, etc. of this application, the feature associated with Difference 1 is a characterizing feature associated with the solution to the problem that the claimed invention seeks to solve, (3) the Appeal Decision identified this feature as Difference 1 with respect to the cited invention, and determined for the first time in this Decision that the feature associated with the difference of the claimed invention would have been readily arrived at by adopting the well-known art, (4) with regard to the evidence (Exhibits A2 to A4) on the basis of which the feature associated with Difference 1 is identified as the well-known art, it was presented to Plaintiff for the first time in this Decision, (5) even when all the evidences are considered, it cannot be said that the feature associated with Difference 1 is clearly well known regardless of the specialized and technical fields and the time of filing of the application, and (6) in the written opinion submitted by Plaintiff on February 7, 2007 (Heisei 19), Plaintiff's argumentation completely concentrated on the presence of the defect that Difference 1 between the claimed invention and the cited invention is not noted, and the fact is that Plaintiff never presented his opinion to the effect that the feature associated with this difference is not the one that would have readily been arrived at.

When the above facts are all taken into consideration, with regard to appropriateness of the findings and determination of the Appeal Decision to the effect that the above feature associated with Difference 1 would have been readily arrived at from the well-known art, it is essential that Plaintiff who is the Demandant be given the opportunity to submit the written opinion, deprivation of which constitutes the procedural defect that harms procedural fairness and the interest of Plaintiff.

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Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, primary cited invention

1. Bibliographic Items

Case	"Construction machinery with electric actuator for working machine and swing drive device" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, October 17, 2012 (2012 (Gyo KE) No. 10056)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-33453 (JP 2001-226077A)
Classification	E02F 9/20
Conclusion	Acceptance
Related Provision	Article 50 applied mutatis mutandis under Article 159(2), Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Akio DOI, Judge: Makiko TAKABE, Judge: Iwao SAITO

2. Overview of the Case

(1) Overview of Procedure

In the decision of refusal, JP H9-247994A (Citation 2 in the following section 3.), JP S62-211295A (Well-Known Example 3 of the same section), JP H10-96250A (Well-Known Example 2 of the same section), and JP H7-213094A (Citation 1 of the same section) as an example describing the well-known art were cited, and it was determined that the claimed invention is not patentable under Article 29(2).

The applicant filed a request for an appeal against the examiner's decision of refusal and made amendments to the scope of claims, etc., and the decision dismissing the appeal has been rendered without any new reason for refusal being notified.

In the Appeal Decision dismissing the appeal, JP S57-44030A (Citation 3 in the following section 3.), JP S60-82096A (Citation 4 of the same section), and JP H7-222456A (Well-Known Example 1 of the same section) were newly cited along with JP H7-213094A (the above Citation 1) and JP H9-247994A (the above Citation 2), which had been cited in the decision of refusal, and it has been determined that the invention is not

the one which could have been patented independently at the time of filing of the patent application under Article 29(2).

(2) Procedural History

- March 25, 2010 : Decision of refusal
- July 16, 2010 : Request for Appeals against an Examiner's Decision of Refusal(Fufuku No. 2010-15996)
Procedural amendments made to the scope of claims, the detailed description of the invention, and the drawings
- November 29, 2011 : Appeal decision to the effect that "the request for appeal of this case is dismissed."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>The reason of the Appeal Decision is summarized as follows: (2) Even though it is recognized that the matters associated with the amendments are intended for the purpose of restriction of the scope of claims, the claimed invention as amended would have been readily made by a person skilled in the art on the basis of the inventions described in the following Citation 1 and the following Citations 2 to 4 as well as the well-known technical matters, and thus the claimed invention is not the one which could have been patented independently at the time of filing of the patent application under Article 29(2), and accordingly this amendment should be dismissed under Article 53(1) applied mutatis mutandis under Article 159(1); and (3) the claimed invention is not patentable under Article 29(2) because the claimed invention would have been readily made by a person skilled in the art on the basis of the inventions described in the following Citation 1 and the following Citations 2 to 4 as well as the well-known technical matters.</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>(1) This Decision refused the claimed invention without notifying to the Plaintiff the reason constructed relying upon Citation 1 as the primary citation and Citations 2 to 4 as the secondary citations and without giving Plaintiff the opportunity to present his opinion. As such, the Appeal Decision has been rendered in violation of Article 50 applied mutatis mutandis under Article 159(2).</p> <p>(2) ...</p> <p>When the primary citation is different, the known fact is also different, so that the reasons for refusal are basically different. Also, Citation 1 is</p>	<p>Allegations by Defendant</p> <p>(2) In the written request for appeal, Plaintiff compared the claimed invention as amended with the inventions described in Citations 2 and 1 and presented detailed assessment mentioning the correspondence and the difference therebetween.</p> <p>In response to the above, the Panel determined that Plaintiff had assessed Citation 1 in detail in the written request for appeal, and constructed the reason for refusal on the basis of Citation 1, which was identified when the decision of refusal was made, as the primary citation, and denying the inventive step of the claimed invention, with regard to the difference, on</p>

<p>merely the document cited as an example of the well-known fact when the decision of refusal was made based on the reason for refusal constructed relying on Citation 2 as the primary citation.</p> <p>Accordingly, the reason for refusal constructed based on Citation 2 as the primary citation and the reason for refusal constructed based on Citation 1 as the primary citation are clearly different from each other, and Demandant should be given the opportunity to present his opinion and allowed to make the due response in accordance with the provisions of the law.</p> <p>(3) In the examination and appeal procedures of this application, there are three reasons for refusal, including this Decision, each constructed based on different primary citations. If there were no noticeable difference in explaining the obviousness relying on different documents, it would not have been necessary to change the primary citation twice.</p>	<p>the basis of the Citation 2 and the well-known art identified when the decision of refusal was made.</p> <p>Also, the substantial framework of the determination has not been changed both at the time of decision of refusal and at the time of the Appeal Decision, but it just changed the starting point for facilitating the explanation of the reason why the claimed invention is readily arrived at, so that there is no noticeable difference in the substantial determinations.</p> <p>(3) ...</p> <p>Further, the reason for refusal constructed relying on Citation 1 disclosing the above well-known technical matters as the primary citation and the well-known technical matters described in Citation 2 as well as Well-Known Examples 1 to 3 as in this Decision, and the reason for refusal constructed relying on Citation 2 as the primary citation as in the stage of decision of refusal and the well-known technical matters described in Well-Known Examples 2 and 3 as well as the above well-known art described in Citation 1, are both mere aggregation of the well-known technical matters taken from the inventions described in Citations 1 and 2 as well as the well-known technical matters. Although it is admitted that there are differences in the expressions, there is no difference in the substantial recognition of the difference, comparison, or determination.</p>
<p>Judgment by the Court</p> <p>(4) With regard to replacement of the primary citation</p> <p>A. In general, identification of the correspondence and the difference changes depending upon which citation is relied on as the primary citation to be compared to the claimed invention, which means that change also occurs in the content of the determination of the inventive step or non-obviousness to be made on the basis of the identified correspondence and difference. Accordingly, it is interpreted that <u>when determination is to be made citing another primary citation that is different from the one that had been cited in the decision of refusal, Article 50 is in principle applied mutatis mutandis as this case falls in the case where "a reason for refusal is found that is different from the reasons of the decision of refusal" as provided in Article 159(2) unless there is a</u></p>	

special circumstance where change in the primary citation does not deprive the applicant of his/her right to defense.

B. As discussed in the above (2) C and (3) C., in this case, there occurs difference in the finding of the correspondence and the difference with respect to the claimed invention depending upon whether Citation 1 or Citation 2 is to be ascertained as the primary citation.

... The Panel should have reasonably recognized that the above difference arises in the finding when the primary citation, i.e., Citation 2 is replaced by Citation 1.

C. ... Thus, substantial difference arises in the process of determination of the obviousness depending on whether the cited invention 1 or the cited invention 2 should be selected as the primary citation, regarding whether or not it becomes necessary to take the above problem to be solved by the cited invention 2 into consideration.

D. In this case, Citation 1 which was newly used as the primary citation had already been identified as an example of the well-known art in the decision of refusal, but it is clear that Plaintiff's assessment at every opportunity focused on the opinion regarding the determination of the comparison with Citation 2 (Exhibits A1, 16, and 20), and it is recognized that the opinion regarding Citation 1 was merely of an incidental nature.

Further, when the combination of the invention described in the primary citation and the well-known art is assessed, it is possible that the difference between the invention described in the document cited as the Well-Known Example and the claimed invention are assessed, but such an assessment cannot be identical with the assessment of the difference with respect to Citation 1 that serves as the primary citation.

Moreover, in this case, relying upon the Citation 1 as the primary citation is not easily predictable from the content of the reasons for refusal that was already notified in the course of the examination procedures.

(11)-9

Relevant portion of Examination Guidelines	Part I, Chapter 2, Section 5, 3.(2) and (3)
Classification of the Case	11: How to proceed with examinations, and trials and appeals
Keyword	Irregularities, Notice of reasons for refusal

1. Bibliographic Items

Case	"Studless tire having large braking force and manufacturing method thereof" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, December 18, 2014 (2014 (Gyo KE) No. 10102)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-179033 (JP 2008-296894A)
Classification	B60C 11/00
Conclusion	Dismissal
Related Provision	Article 50 applied mutatis mutandis under Article 159(2), Article 29(2)
Judges	IP High Court First Division, Presiding judge: Ryuichi SHITARA, Judge: Mayo OYORI, Judge: Akifumi HIRATA

2. Overview of the Case

(1) Overview of Procedure

Reasons for refusal were notified for multiple rounds at the stages of the examination and the appeal. Plaintiff proceeded with the examination and appeal procedures without any appointed agent.

(2) Procedural History

- May 29, 2007 : Filing of this application (Japanese Patent Application No. 2007-179033)
- March 29, 2010 : Notice of reasons for refusal (1)
- May 11, 2011 : Notice of reasons for refusal (2)
- March 13, 2012 : Decision of refusal
- June 28, 2012 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2012-12177)
- November 8, 2012 : Notice of reasons for refusal (3)
- January 24, 2013 : Amendments made to the scope of claims by a written amendment

- June 21, 2013 : Notice of reasons for refusal (4)
 August 14, 2013 : Amendments made to the scope of claims by a written amendment
 February 18, 2014 : Appeal decision to the effect that "the request for appeal of this case is dismissed."

3. Portions of Appeal/Trial Decisions relevant to the Holding

Appeal Decision (cited from the Court Decision)	
<p>The gist of the Appeal Decision is as follows: [1] This application fails to comply with the requirements of Article 36(4)(i) and Article 36(6)(ii) of the Patent Law; [2] This application fails to comply with the requirement of Article 37 because the claimed invention of claims 1 to 6 and the claimed invention of claims 7 and 8 do not constitute a group of inventions recognized as fulfilling the requirements of unity of invention; [3] The claimed invention 1 is not patentable under Article 29(2) because it would have been readily made by a person skilled in the art on the basis of the invention described in JP 2001-219716A as well as the well-known art; Therefore, this application should be rejected on the basis of any one of the above reasons [1] to [3].</p>	
Decision	
<p>Allegations by Plaintiff</p> <p>... when the Japan Patent Office notifies the reasons for refusal in response to filing of an application for a patent etc. by a ordinary person, the Patent Office has obligation to describe the reasons for refusal so that it is easily understood and so as to facilitate submission of a written amendment by the ordinary person...</p> <p>A. The sections (2) and (3) of the notice of reasons for refusal read as follows: The category of the claimed inventions according to claims 1 to 5 are all unclear. Therefore, the claimed inventions according to claims 1 to 5 are not clear." "... The category of the claimed inventions according to claims 1 to 5 was regarded as a process." However, the meaning of the "category" is indefinite.</p> <p>B. In the sections (2) and (3) of the notice of reasons for refusal read as follows: "(The claimed invention) is unclear because it is indefinite whether claim 4 of this application is an independent claim or a dependent claim that depends from claim 1, 2, or 3... (The claimed invention) is unclear because it is indefinite whether claim 5 of this application is an independent claim or a dependent claim that depends</p>	<p>Allegations by Defendant</p> <p>(1) With regard to the term "category of the invention," as described in the "Examination Guidelines for Patent and Utility Model in Japan", "Patent Examination Guidelines and Operation of Examination" (auxiliary textbook for the JPO's information session), "Commentary on Patent Law," and "Introduction to Intellectual Property Law," it is widely known among people involved in the patent procedures that the term is used to indicate that the "invention" is either an invention of a "product", an invention of a "process," or an invention of a "process for producing a product." For example, about 1,870,000 hits were obtained by Yahoo! Search on the Internet with the search words of "invention; category."</p> <p>Moreover, also in the section (1) of the notice of reasons for refusal, it is specifically pointed out that it is indefinite whether the invention is an invention directed to a "product," or an invention directed to a "process" along with suggestion for amendments. Further, in light of the general meaning of "category" ("Hanchu"), the purport of the reasons for refusal can be sufficiently understood.</p>

<p>from claim 1 or 2." However, the meanings of "independent claim" and "dependent claim" are unclear.</p> <p>C. The section (1) of the notice of reasons for refusal reads as follows: "Also, when it is regarded as an invention of a "product," care should be taken so that it does not become a so-called "product-by-process claim." However, the meaning of the "product-by-process claim" is indefinite.</p> <p>(2) Defendant alleges that the meanings of the terms can be understood by reading literatures and using the Internet, but an ordinary person may not see the literatures or use the Internet, and the Japan Patent Office has obligation to provide explanations such that such a person can understand the content of the notice of reasons for refusal from the notice alone without the need of reading literatures or using the Internet.</p> <p>Also, with regard to the meaning of the "independent claim," Defendant alleges that it is specifically pointed out in the section (1) of the notice of reasons for refusal. However, this notice does not use the term "independent claim" or "dependent claim," as a result of which Plaintiff was not able to understand that the content of this notice intended to convey the meaning of these terms.</p>	<p>(2) With regard to the term "independent claim," as described in the "Examination Guidelines for Patent and Utility Model in Japan", "Commentary on Patent Law," and "Patent Law," it is widely known among people involved in the patent procedures that the term denotes "a claim recited without making reference to the recitation of any other claim." For example, about 2,810,000 hits were obtained by Yahoo! Search on the Internet with the search word of "independent claim."</p> <p>Moreover, the content of the reasons for refusal is specifically pointed out in the sections (1) to (4) of the notice of reasons for refusal, and in light of the general meaning of "independent," the purport of the reasons for refusal can be sufficiently understood.</p> <p>(3) Therefore, since there is not any unclear point in the terms as such and the reasons for refusals are specifically stated, Plaintiff's allegation is groundless.</p>
<p>Judgment by the Court</p> <p>... The purpose of notification of the reason(s) for refusal is to guarantee the carefulness and reasonableness of the examiner's determination and thus prevent the examiner's arbitrariness, and to ensure the applicant's opportunity to present his/her opinion regarding the examiner's determination prior to the final decision of refusal or prior to the appeal, and further facilitate the applicant's consideration of whether or not any amendment should be made. Hence, it is noted that the reasons to be stated in the notice of reasons for refusal must be stated in such a manner or to such an extent that the applicant can specifically understand, from the very statement of the reasons, by application of which provisions of law and legislation, and for what factual relationship, the application should be rejected, so as to enable such statement of his/her opinion and amendments to be made. does not exclude the possibility</p> <p>Also, since the patent application procedures of the one who wants a patent to be granted proceeding with</p>	

the procedures without appointment of a patent attorney or a lawyer, the manner in which the notice of the reasons for refusal are to be stated must not be such that only professional lawyers or patent attorneys can understand them, and in general, it should be so clearly stated that the applicant can readily understand the content of the refusal. However, on the other hand, the matters that may constitute reasons for refusal may vary (items listed in Article 49), and the content thereof often involves professional and technical matters. As such, it suffices that the notice of reasons for refusal, which is notified to an applicant who took the prosecution of the application by himself/herself, is stated such that the manner in which the reasons for refusal are stated enables an ordinary applicant to understand it using knowledge that can be obtained through the efforts ordinary expected..

... With regard to the term "category of the invention," it has been a widely accepted practice to classify inventions as "invention of a product," "an invention of a process," or "an invention of a process for producing a product" (see the items listed in Article 2(3)), and thus use the term "category of the invention" as a term that denotes such a category based on the classification of inventions, not only in the JPO's "Examination Guidelines for Patent and Utility Model in Japan" (Exhibit B21) but also in other generally available instruction books on the patent law and explanations associated with inventions on the Internet (Exhibits B23, B24, and B35), and such classification is described in the textbooks distributed in the information session on the "Examination Guidelines" taken by the Japan Patent Office whose intended audience include common citizens, and in which Plaintiff himself was participated (Exhibit B22, page 52 as well as the entire import of the oral argument). As such, it is noted that the term "category of the invention" is a term that is widely known to people who are involved in the patent prosecution procedures. Hence, it should be said that the statement of the notice of reasons for refusal of the above [1] can be read, with knowledge that may be obtained by an ordinary applicant seeking granting of a patent with efforts that is ordinarily expected to make, as meaning that it is indefinite whether the claimed invention of claims 1 to 5 is defined as "an invention of a product," "an invention of a process," or "an invention of a process for producing a product."

... With regard to the terms "an independent claim" and "a dependent claim," the "Examination Guidelines for Patent and Utility Model in Japan" of the Japan Patent Office uses the terms "independent form claim" and "dependent form claim" which correspond to these terms, respectively (Exhibit B21, pages 17, 18). Although terms identical with the "independent claim" and the "dependent claim" are not used therein, it is very familiar, with regard to the forms of the language of the scope of claims, in commercially available literatures related to the Patent Law and other explanations available on the Internet related to patent claims, that the "independent claim" is used to refer to "a claim recited without making reference to the recitation of any other claim" and the "dependent claim" is used to refer to "a claim recited with making reference to the recitation of any other claim" (Exhibit B23, 36). It is thus noted that the terms "an independent claim" and "a dependent claim" are also terms widely and commonly known among people involved in the procedures of patent prosecutions. As such, the statement of the above [2] of the notice of reasons for refusal can be understood, with knowledge obtained by efforts that is ordinarily expected to be made by common applicants, to mean that it is unclear

whether or not claimed inventions 4 and 5 are a claim recited without making reference to the recitation of any other claim or a claim recited with making reference to the recitation of any other claim.

... With regard to the term "product-by-process claim," as stated in the above B., the term in question is not described in the section (1) of the notice of reasons for refusal as constituting a part of the reasons for refusal and the term in question is not included in the reasons for refusal of the Appeal Decision, which means that use of the term does in no way constitute a defect of the notice of reasons for refusal. Even when this point is set aside, it is a widely accepted practice that the term "product-by-process claim" is used to denote "a claim that defines a product by the process for making the same product" in commercially available literatures on patents (Exhibit B40) as well as in the "Examination Guidelines for Patent and Utility Model in Japan" of the Japan Patent Office (Exhibit B39). It is noted that the general meaning of this term is widely and commonly known among people involved in the patent prosecution procedures. Hence, the meaning of the statement of the above [3] can be understood with knowledge obtained by efforts that is ordinarily expected to be made by ordinary applicants seeking granting of a patent.

