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

4. Court precedents relating to Novelty and Inventive Step (Article 29(i) and (ii) of the Patent Act)

Classification	Contents	No.	Date of Decision (Case No.)	Rellevant Portion of Examination Guidelines
41	Presence of novelty	1	Intellectual Property High Court Decision, June 30,2005 (2005 (Gyo KE) No. 10280)	Part III, Chapter 2, Section 1
		2	Intellectual Property High Court Decision, July 24, 2013 (2012 (Gyo KE) No.10207)	
42	Existence of motivation to apply sub cited invention to main cited invention	1	Intellectual Property High Court Decision May 24, 2005 (2005 (Gyo KE) No. 10287)	Part III, Chapter 2, Section 2, 3.1.1
		2	Intellectual Property High Court Decision, October 11, 2006 (2005 (Gyo KE) No. 10717)	
		3	Intellectual Property High Court Decision, March 24, 2010 (2009 (Gyo KE) No. 10185)	
		4	Intellectual Property High Court Decision, July 21, 2010 (2010 (Gyo KE) No. 10086)	
		5	Intellectual Property High Court Decision, July 28, 2010 (2009 (Gyo-KE) No. 10329)	
		6	Intellectual Property High Court Decision, December 22, 2010 (2010 (Gyo KE) No. 10147)	
		7	Intellectual Property High Court Decision, September 29, 2011 (2011 (Gyo KE) No. 10045)	

		8	Intellectual Property High Court Decision, December 14, 2011 (2011 (Gyo KE) No. 10169)	
		9	Intellectual Property High Court Decision, January 31, 2012 (2011 (Gyo KE) No. 10142)	
		10	Intellectual Property High Court Decision, April 9, 2012 (2011 (Gyo KE) No. 10265)	
		11	Intellectual Property High Court Decision, November 15, 2012 (2012 (Gyo KE) No. 10006)	
		12	Intellectual Property High Court Decision, December 19, 2012 (2012 (Gyo KE) No.10174)	
		13	Intellectual Property High Court Decision, December 12, 2012 (2011 (Gyo KE) No. 10434)	
		14	Intellectual Property High Court Decision, May 9, 2013 (2012 (Gyo KE) No. 10213)	
		15	Intellectual Property High Court Decision, September 3, 2013 (2013 (Gyo KE) No. 10034)	
		16	Intellectual Property High Court Decision, September 30, 2013 (2012 (Gyo KE) No. 10361)	
		17	Intellectual Property High Court Decision, October 31, 2013 (2013 (Gyo KE) No. 10078)	
		18	Intellectual Property High Court Decision, November 21, 2013 (2013 (Gyo KE) No. 10033)	
		19	Intellectual Property High Court Decision, November 21, 2013 (2013 (Gyo KE) No.10053)	

		20	Intellectual Property High Court Decision, January 30,2014 (2012 (Gyo KE) No. 10416)	
		21	Intellectual Property High Court Decision, February 27, 2014 (2013 (Gyo KE) No. 10102)	
		22	Intellectual Property High Court Decision, August 7, 2014 (2013 (Gyo KE) No. 10240)	
		23	Intellectual Property High Court Decision, December 24, 2014 (2014 (Gyo KE) No. 10071)	
		24	Intellectual Property High Court Decision, April 28, 2015 (2013 (Gyo KE) No. 10263)	
43	Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification	1	Intellectual Property High Court Decision, February 23, 2006 (2005 (Gyo KE) No. 10448)	
		2	Intellectual Property High Court Decision, June 29, 2006 (2005 (Gyo KE) No. 10490)	
		3	Intellectual Property High Court Decision, July 30, 2007 (2006 (Gyo KE) No. 10483)	
		4	Intellectual Property High Court Decision, October 29, 2009 (2009 (Gyo KE) No. 10090)	
		5	Intellectual Property High Court Decision, September 8, 2011 (2010 (Gyo KE) No. 10296)	
		6	Intellectual Property High Court Decision, December 26, 2011 (2011 (Gyo KE) No. 10017)	
		7	Intellectual Property High Court Decision, February 22, 2012 (2011 (Gyo KE) No. 10178)	

		8	Intellectual Property High Court Decision, February 27, 2012 (2011 (Gyo KE) No. 10193	
		9	Intellectual Property High Court Decision, March 22, 2012 (2011 (Gyo KE) No. 10219)	
		10	Intellectual Property High Court Decision, May 28, 2012 (2011 (Gyo KE) No. 10260)	
		11	Intellectual Property High Court Decision, July 8, 2013 (2012 (Gyo KE) No. 10340)	
		12	Intellectual Property High Court Decision, July 11, 2013 (2012 (Gyo KE) No. 10297)	
		13	Intellectual Property High Court Decision, February 19, 2014 (2012 (Gyo KE) No. 10423)	
43-1	Whether or not workshop modifications are taken into consideration when applying the sub cited invention to the main cited invention	1	Intellectual Property High Court Decision, January 30, 2008 (2007 (Gyo KE) No. 10155)	Part III, Chapter 2, Section 2, 3.1.1 (Note 1) and 3.1.2(1)
		2	Intellectual Property High Court Decision, October 29, 2008 (2007 (Gyo KE) No. 10295)	
		3	Intellectual Property High Court Decision, March 25, 2014 (2013 (Gyo KE) No. 10278)	
		4	Intellectual Property High Court Decision, November 26, 2014 (2014 (Gyo KE) No. 10079)	
44	Whether or not Claimed Invention is mere aggregation of prior arts		-	Part III, Chapter 2, Section 2, 3.1.2(2)
45	Advantageous effect in comparison with the cited invention	1	Intellectual Property High Court Decision, April 28, 2005 (2005 (Gyo KE) No. 10059)	Part III, Chapter 2, Section 2, 3.2.1

		2	Intellectual Property High Court Decision, May 31, 2005 (2005 (Gyo KE) No. 10294)	
		3	Intellectual Property High Court Decision, January 30, 2007 (2006 (Gyo KE) No. 10222)	
		4	Intellectual Property High Court Decision, January 30, 2012 (2011 (Gyo KE) No. 10158)	
		5	Intellectual Property High Court Decision, May 28, 2012 (2010 (Gyo KE) No. 10203)	
		6	Intellectual Property High Court Decision, November 13, 2012 (2012 (Gyo KE) No. 10004)	
		7	Intellectual Property High Court Decision, February 27, 2013 (2012 (Gyo KE) No. 10177)	
		8	Intellectual Property High Court Decision, March 18, 2013 (2012 (Gyo KE) No. 10252)	
		9	Intellectual Property High Court Decision, July 24, 2013 (2012 (Gyo KE) No. 10206)	
		10	Intellectual Property High Court Decision, October 31, 2013 (2013 (Gyo KE) No. 10078)	
		11	Intellectual Property High Court Decision, August 7, 2014 (2013 (Gyo KE) No. 10170)	
46	Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)	1	Intellectual Property High Court Decision, July 19, 2007 (2006 (Gyo KE) No. 10488)	Part III, Chapter 2, Section 2, 3.2.2
		2	Intellectual Property High Court Decision, November 10, 2010 (2010 (Gyo KE) No. 10104)	

		3	Intellectual Property High Court Decision, December 6, 2011 (2011 (Gyo KE) No. 10092)	
		4	Intellectual Property High Court Decision, December 22, 2011 (2010 (Gyo KE) No. 10097)	
		5	Intellectual Property High Court Decision, July 17, 2012 (2011 (Gyo KE) No. 10098)	
		6	Intellectual Property High Court Decision, September 12, 2012 (2011 (Gyo KE) No. 10242)	
		7	Intellectual Property High Court Decision, September 27, 2012 (2011 (Gyo KE) No. 10320)	
		8	Intellectual Property High Court Decision, September 25, 2013 (2012 (Gyo KE) No. 10398)	
		9	Intellectual Property High Court Decision, April 16, 2014 (2013 (Gyo KE) No. 10191)	
		10	Intellectual Property High Court Decision, September 25, 2014 (2013 (Gyo KE) No. 10339)	
		11	Intellectual Property High Court Decision, January 28, 2015 (2014 (Gyo KE) No. 10120)	
47	Hindsight when determining on inventive step	1	Intellectual Property High Court Decision, March 25, 2009 (2008 (Gyo KE) No. 10261)	Part III, Chapter 2, Section 2, 3.3(1)
		2	Intellectual Property High Court Decision, October 12, 2011 (2010 (Gyo KE) No. 10282)	
48	After pointing out the relation of technical field and problems to be solved	1	Intellectual Property High Court Decision, March 25, 2009 (2008 (Gyo KE) No. 10305)	Part III, Chapter 2, Section 2, 3.3(2)

	between Claimed Invention and main cited invention, to try for reasoning based on the main cited invention	2	Intellectual Property High Court Decision, March 17, 2011 (2010 (Gyo KE) No.10237)	
		3	Intellectual Property High Court Decision, July 31, 2013 (2012 (Gyo KE) No. 10305)	
		4	Intellectual Property High Court Decision, August 28, 2013 (2012 (Gyo KE) No. 10448)	
		5	Intellectual Property High Court Decision, September 3, 2013 (2013 (Gyo KE) No. 10034)	
48-1	Relation of problem to be solved between the main cited invention and sub sited invention, and relation of problem to be solved between Claimed Invention an main cited invention	1	Intellectual Property High Court Decision, May 23, 2012 (2011 (Gyo KE) No. 10208)	Part III, Chapter 2, Section 2, 3.3(2) (Note 1)
49	Reasoning when applying well-known art	1	Intellectual Property High Court Decision, February 27, 2007 (2006 (Gyo KE) No. 10203)	Part III, Chapter 2, Section 2, 3.3(3)
		2	Intellectual Property High Court Decision, May 22, 2007 (2006 (Gyo KE) No. 10342)	
		3	Intellectual Property High Court Decision, December 11, 2012 (2011 (Gyo KE) No. 10443)	
49-1	Whether or not determination on inventive step is allowed after finding a well-known art covering multiple technical fields	1	Intellectual Property High Court Decision, January 31, 2007 (2005 (Gyo KE) No. 10523)	Part III, Chapter 2, Section 2, 3.3(3)
50	In determining on inventive step, to take into consideration condition such	1	Intellectual Property High Court Decision, September 27, 2007 (2007 (Gyo KE) No. 10146)	Part III, Chapter 2, Section 2, 3.3(6)

	as commercial success or desired for since long ago	2	Intellectual Property High Court Decision, March 26, 2014 (2013 (Gyo KE) No. 10176)	
51	Concerning finding of Claimed Invention (overlooking differences)	1	Intellectual Property High Court Decision, June 6, 2006 (2005 (Gyo KE) No. 10564)	Part III, Chapter 2, Section 3, 2.
		2	Intellectual Property High Court Decision, January 27, 2009 (2008 (Gyo KE) No. 10166)	
		3	Intellectual Property High Court Decision, April 26, 2012 (2011 (Gyo KE) No. 10336)	
		4	Intellectual Property High Court Decision, May 30, 2012 (2011 (Gyo KE) No. 10221)	
		5	Intellectual Property High Court Decision, December 25, 2012 (2012 (Gyo KE) No. 10082)	
		6	Intellectual Property High Court Decision, May 23, 2013 (2012 (Gyo KE) No. 10243)	
51-1	Interpretation on whether the claim is an open claim (invention that can contain other constitution than constitution of the claim), or a closed claim (invention limited to the constitution of the claim)	1	Tokyo High Court Decision, July 7, 2003 (2002 (Gyo KE) No. 232)	Part III, Chapter 2, Section 3, 2.
		2	Intellectual Property High Court Decision, August 8, 2012 (2011 (Gyo KE) No. 10358)	
52	Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)	1	Intellectual Property High Court Decision, March 28, 2007 (2006 (Gyo KE) No. 10211)	Part III, Chapter 2, Section 3, 3.
		2	Intellectual Property High Court Decision, October 24, 2011 (2010 (Gyo KE) No. 10405)	
		3	Intellectual Property High Court Decision, July 17, 2013	

			(2012 (Gyo KE) No. 10300)	
		4	Intellectual Property High Court Decision, May 26, 2014 (2013 (Gyo KE) No. 10248)	
		5	Intellectual Property High Court Decision, January 28, 2015 (2014 (Gyo KE) No. 10131)	
		6	Intellectual Property High Court Decision, December 21, 2017 (2017 (Gyo KE) No. 10072)	
		7	Intellectual Property High Court Decision, April 13, 2018 (2016 (Gyo-KE) Nos. 10182 and 10184)	
52-1	Concerning finding of the cited invention as the generic concept	1	Intellectual Property High Court Decision, September 27, 2012 (2011 (Gyo KE) No. 10385)	Part III, Chapter 2, Section 3, 3.2(2)
		2	Intellectual Property High Court Decision, December 19, 2012 (2012 (Gyo KE) No. 10099)	
		3	Intellectual Property High Court Decision, August 9, 2013 (2012 (Gyo KE) No. 10436)	
		4	Intellectual Property High Court Decision, July 4, 2017 (2017 (Gyo KE) No. 10220)	
53	Whether or not the invention can be deemed to be an invention that was described in a distributed publication or an invention that was made publicly available through electric telecommunication lines	1	Intellectual Property High Court Decision, April 28, 2010 (2009 (Gyo KE) No. 10163)	Part III, Chapter 2, Section 3, 3.1.1 and 3.1.2
		2	Intellectual Property High Court Decision, June 9, 2011 (2010 (Gyo KE) No. 10272)	
		3	Intellectual Property High Court Decision, October 24, 2011 (2010 (Gyo KE) No. 10245)	
		4	Intellectual Property High Court Decision, November 29, 2011 (2011 (Gyo KE) No. 10116)	

		5	Intellectual Property High Court Decision, October 16, 2013 (2012 (Gyo KE) No. 10419)	
54	Whether or not the invention that was described or posted in a distributed publication as a cited invention (for invention of product, whether or not it is described or posted so that it can be manufactured, and, for invention of method, whether or not it is described so that it can be used)	1	Intellectual Property High Court Decision, September 14, 2006 (2005 (Gyo KE) No. 10553)	Part III, Chapter 2, Section 3, 3.1.1(1)b
		2	Intellectual Property High Court Decision, December 26, 2007 (2006 (Gyo KE) No. 10316)	
		3	Intellectual Property High Court Decision, August 19, 2010 (2009 (Gyo KE) No. 10180)	
55	Whether or not the invention can be deemed as an invention that was publicly known	1	Intellectual Property High Court Decision, July 11, 2012 (2011 (Gyo KE) No. 10271)	Part III, Chapter 2, Section 3, 3.1.3
		2	Intellectual Property High Court Decision, March 26, 2014 (2013 (Gyo KE) No. 10178)	
56	Whether or not the invention can be deemed to be a publicly worked invention	1	Intellectual Property High Court Decision, June 30, 2005 (2005 (Gyo KE) No. 10061)	Part III, Chapter 2, Section 3, 3.1.4
		2	Intellectual Property High Court Decision, September 8, 2005 (2005 (Gyo KE) No. 10113)	
		3	Intellectual Property High Court Decision, April 10, 2006 (2005 (Gyo KE) No. 10384)	
57	Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify a product using the use of the product in the claim	1	Intellectual Property High Court Decision, August 31, 2006 (2005 (Gyo KE) No. 10665)	Part III, Chapter 2, Section 4, 3.
		2	Intellectual Property High Court Decision, November 29, 2006 (2006 (Gyo KE) No. 10227)	

58	Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify the invention of subcombination by using a matter related to other subcombination in the claim	1	Intellectual Property High Court Decision, February 8, 2011 (2010 (Gyo KE) No. 10056)	Part III, Chapter 2, Section 4, 4.
		2	Intellectual Property High Court Decision, October 11, 2011 (2011 (Gyo KE) No. 10043)	
		3	Intellectual Property High Court Decision, February 10, 2022 (2021 (Gyo KE) No. 10056)	
59	Finding of the invention and novelty and inventive step of the invention according to a claim that includes a description trying to identify the product with the manufacturing method in the claim	1	Intellectual Property High Court Decision, December 7, 2006 (2005 (Gyo KE) No. 10775)	Part III, Chapter 2, Section 4, 5.
60	Novelty and inventive step of the invention according to a claim that includes a description trying to identify the invention using numerical limitation	1	Intellectual Property High Court Decision, February 28, 2006 (2005 (Gyo KE) No. 10436)	Part III, Chapter 2, Section 4, 6.
		2	Intellectual Property High Court Decision, March 1, 2006 (2005 (Gyo KE) No. 10503)	
		3	Intellectual Property High Court Decision, January 26, 2009 (2008 (Gyo KE) No. 20210)	
61	Concerning novelty and inventive step of selection invention		-	Part III, Chapter 2, Section 4, 7.
62	Whether or not exception to lack of novelty (Article 30) can be applied	1	Intellectual Property High Court Decision, August 30, 2007 (2006 (Gyo KE) No. 10559)	Part III, Chapter 2, Section 5
		2	Intellectual Property High Court Decision, November 30, 2017 (2016 (Gyo KE) No. 10279)	

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 1
Classification of the Case	41: Presence of novelty
Keyword	

1. Bibliographic Items

Case	"Ultra-fine nickel powder for laminated ceramic capacitors" (Opposition to the Grant of a Patent) Intellectual Property High Court Decision, June 30,2005 (2005 (Gyo KE) No. 10280)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H7-50905 (JP H8-246001A)
Classification	B22F 1/00
Conclusion	Dismissal
Related Provision	Article 29(1)(iii)
Judges	IP High Court Fourth Division, Presiding Judge: Tomokatsu TSUKAHARA, Judge: Masatoshi TANAKA, Judge: Tatsufumi SATO

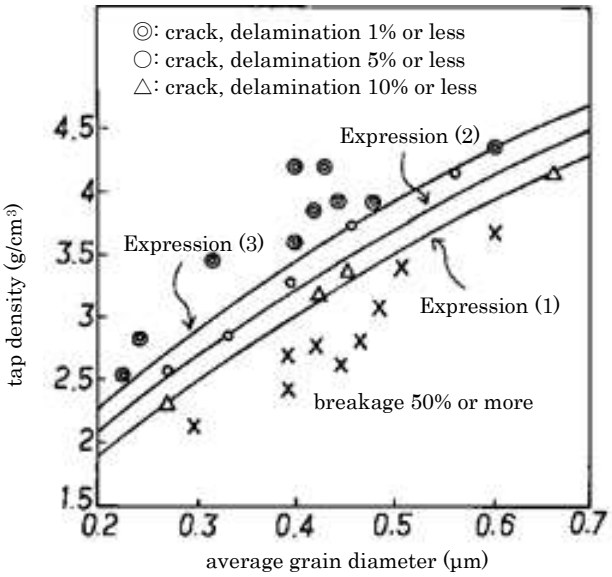
2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention has the problem to be solved for providing a nickel powder as a low-resistance electrode material which is hardly cracked or detached in the process for producing a ceramic capacitor. The claimed invention has the configuration in which the nickel powder has an average grain diameter falling within the range between 0.1 and 1.0 micro meters, a tap density satisfying the conditions expressed by equation (2), a geometrical standard deviation of a grain size distribution less than or equal to 2.0, and an average crystallite diameter more than equal to 0.2 times the average grain diameter.

Tap density >= - 2.5 * (average grain diameter) ^{2} + 7.0 * (average grain diameter) + 0.8 ... equation (2)

[FIG. 1]



(2) State of the art

(i) Publication 2: JP H4-365806A

""[0020] [Embodiment] Embodiment 1 Using a reactor as shown in FIG. 1, 10 gram amount nickel chloride is put in a quartz boat 3 of an evaporating part 2 as a material, and evaporated in an argon gas with 2 liters/minute such that the density (partial pressure) reaches $5.0 * 10^{-2}$. This gas mixed with material is transported to a reacting part 5 set in 1030 degrees (0.755 times nickel melt point in absolute temperature), and reacted by contacting and mixing with hydrogen supplied in the percentage 1 liter/minute from a reacting center nozzle 6. The temperature in the reacting part is measured with a thermocouple 8 protected by a quartz tube and increases to 1065 degrees (0.755 times nickel melt point in absolute temperature)." (column 3, line 47 to column 4, line 8)

"[0023] Embodiment 4 The nickel powder is produced under the same condition as that in the Embodiment 1 except that the evaporating temperature is set in 1000 degrees (0.74 times nickel melt point in absolute temperature), and the density (partial pressure) is set $8.5 * 10^{-2}$. It is measured with a thermocouple 8 and increases to 1053 degrees (0.755 times nickel melt point in absolute temperature). The specific surface of the produced nickel powder has 2.9 square meters/grams, and has the spherical powder having the average grain diameter with 0.23 micro meters from the observation of electronic microscope." (column 4, lines 31 to 38)" (cited from the Court Decision)

(3) The Claims (after Amendment) (Only Claim 3 is shown)

[Claim 1] A nickel powder has an average grain diameter falling within a range between 0.1 and 1.0 micro meters, a tap density satisfying the conditions expressed by equation (2), a geometrical standard deviation of a grain size distribution less than or equal to 2.0, and an average crystallite diameter more than equal to 0.2 times the average grain diameter,

Tap density >= - 2.5 * (average grain diameter) ^{2} + 7.0 * (average grain diameter) + 0.8 ... equation (2).

(4) Procedural History

April 23, 2001	:	File amendment (Refer to "The Claims" above.) and written argument
June 8, 2001	:	Registration to establish a patent right
November 12, 2001	:	Opposition to the grant of a patent (Igi No. 2001-73067)
February 19, 2003	:	Decision "... to revoke the patent."

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

Decision on opposition (cited from Court Decision)
Comparing the Embodiment 1 of the specifications and the Embodiment 4 of the Publication 2, it is recognized that they are almost the same in the nickel chloride evaporating density and reaction temperature, and have almost the same extent values in the specific surface and average grain diameter, thus, almost the same extent values of the geometrical standard deviation of the grain size distribution, average crystallite diameter and tap density are obtained. ... the Publication 1 cited in the revocation reason ... describes that, as a common characteristic of ultra-fine nickel powder produced by a CVD method (a method for reacting chemically a nickel chloride vapor and

hydrogen), "the geometrical standard deviation of grain size distribution falls within the range between 1.3 and 1.5, and the average grain diameter can be controlled within the range between 0.1 and 0.5 micro meters", and "the average crystallite diameter is more than or equal to 0.1 micro meters and has the high crystallinity grain being single crystal or containing bicrystal inside" ... The embodiments of the specifications describes the ultra-fine nickel powder is obtained in the nickel chloride evaporating density falling within the range between 5.0 * 10^{-2} and 2.0 * 10^{-1} and the reaction temperature falling within the range between 1010 degrees and 1070 degrees, and that the geometrical standard deviation of grain size distribution of the obtained ultra-fine nickel powder falls within the range between 1.4 and 1.6, and the average crystallite diameter of the obtained ultra-fine nickel powder falls within the range between 0.1 and 0.2 micro meters. Thus, they have little differences, and the ultra-fine nickel powder obtained in the Embodiment 4 of the Publication 2 is not probable to deviate from these ranges to a large extent. Accordingly it can be recognized that the geometrical standard deviation of grain size distribution is less than or equal to 2.0, and the average crystallite diameter is 0.2 times the average grain diameter.

From the above, it can be recognized that the ultra-fine nickel powder described in the Publication 2 contains one produced in the same conditions as that under which the ultra-fine nickel powder is produced in the claimed inventions recited in claims 1 and 2, and the tap densities, geometrical standard deviations of grain size distribution and average crystallite diameters have the commonalities between the inventions of the Publication 2 and the claimed inventions. Thus, it cannot be said that both are substantially different in terms of the above.

Decision

Allegations by Plaintiff	Allegations by Defendant
... the presumption made in the decision on opposition is a hindsight by deducing the result of the patented invention and is not based on a rational ground. If the presumption is appropriate, it only indicates that a part of the ultra-fine nickel powder produced in the producing method described in the Publication 2 may satisfy the characteristic of powder recited in the patented claim 1. ... the Plaintiff conducted an additional test to indicate that the ultra-fine nickel powder produced in the method described in the Publication 2 is different from the ultra-fine nickel powder recited in the patented claim 1. ... then, it can be seen that it is not necessarily to be capable of producing the ultra-fine nickel powder satisfying all of the characteristics recited in the patented claim 1 if it is produced under	The Plaintiff alleges that it is apparent for the ultra-fine nickel powder described in the Embodiment 4 of Publication 2 does not satisfy the equation (2) for tap density in the patented invention, as indicated by the data of the test report of Exhibit A7 from the conducted additional test, thus the decision on opposition is erroneous in determining that the patented invention is described in the Publication 2. ... reviewing the above test report, data is compared between from the additional test with respect to the bad point(x), acceptable point(△) and good point(○) in FIG. 1 of the Patent Gazette, and from the additional test in the Embodiments 1 and 4 of Publication 2. As a result of comparison, the additional test is conducted under the same condition except for the apparatus L/D (the apparatus L/D values are set as

the condition described in the Embodiment 4 of Publication 2 (Table 2 of Exhibit A7). The above additional test sets the test condition taking the matters as of the filing when the applications corresponding to the invention of Publication 2 and the patented invention into consideration. That is, the invention described in the Publication 2 uses the quartz tube with 50 millimeter diameters as a reaction tube, and sets the length/diameter (hereinafter referred to as "apparatus L/D") value of reaction part of reaction tube as "6" in order to use the apparatus close to the apparatus used in the invention as of filing. On the other hand, the patented invention employs the quartz tube with tube diameter (65 millimeter diameter) obtainable as of filing, and sets the apparatus L/D value as "13.7" in considering that it is necessary to produce a lump sum ultra-fine nickel powder having a certain characteristic by lengthening the length of reaction part as of filing. As seen from the above, the condition setting is rational for the apparatus L/D indicated by the data of test report of Exhibit A7, and the condition is only set as of this time, as the most understandable condition for explaining and demonstrate that the obtained one in embodiments if Publication 2 and one of the patented invention are different one and different in the availability.。；c	6, 8.9 and 13.7 for the bad point, acceptable point and good point respectively), and the good point only satisfies the equation (2) with respect to the additional test in FIG. 1. In contrast, in the embodiments of Publication 2, the additional test is conducted under the condition for which the apparatus L/D value is set as "6", and does not satisfy the equation (2) ... there is room for considering that the tester dare to set the numerical values not satisfying the equation (2) with respect to the embodiments of Publication 2. Accordingly, the test report submitted by the Plaintiff lacks the objectivity and believability per se, and is not based on the specifications and the description of Publication 2. Thus, The decision on opposition should not be made in determining the novelty based on such data of test report.

Judgment by the Court

(1) The decision on opposition determines that the patented inventions 1 and 2 is described in the Publication 2, thus these inventions fall under Act 29(1)(iii), and do not satisfy the requirement for patentability, whereas the Plaintiff alleges that this determination is erroneous. The "inventions described in the publication" specified in the same items should be constructed as matters described in the publication and matters understandable for a person skilled in the art from the publication ...

... the Plaintiff submitted the Embodiments 1 and 4 of the Publication 2, 3 points (×, ○, △) shown in FIG. 1 of the specifications, and the test report (Exhibit A7) describing the result of additional test with respect to the Embodiment 1 of the specification. In addition, the Plaintiff alleges that the nickel powder does not satisfy all of the characteristics recited in the patented claim 1, which is produced under the condition described in the

Embodiments 4 of Publication 2.

However, this additional test is conducted under the condition for which the apparatus L/D values are set as "6" as in the embodiments of Publication 2 and "13.7" in the patented invention. In contrast, the production test is conducted under the condition described in the Embodiment 4 of the specification except for the apparatus L/D with respect to the data for 3 points (×, ○, △) shown in FIG. 1 of the specification (the specification does not describe the specific production condition.), and as a result, the point × and point △ do not satisfy the equation (2), for which the apparatus L/D values are set as "6" and "8.9" respectively and the point ○ satisfies the equation (2), for which the apparatus L/D value is set as "13.7". It can be seen that the apparatus L/D value is one of the factors on which the tap density value depends from the test result.

The specification and Publication 2 do not describe the reaction tube diameter D or reaction part length L at all, as well as the apparatus L/D value. Thus, it can be said that it would only a matter of design variation for a person skilled in the art how the apparatus L/D value is set. In addition, there is no rational ground for setting the apparatus L/D value as "6" (the tap density has the lowest value in the case that the apparatus L/D value is set as "6" in the additional test in FIG. 1 of the patented invention) in the embodiments of Publication 2, and setting the apparatus L/D value as "13.7" (the tap density has the highest value in the case that the apparatus L/D value is set as "13.7" in the additional test in FIG. 1 of the patented invention) in the embodiments of the patented invention.

Therefore, it cannot be recognized that the result of additional test conducted by the Plaintiff precisely indicates the average grain diameter, tap density, geometrical standard deviation of grain size distribution, and average crystallite diameter for the nickel powder produced under the condition described in the Embodiments 1 and 4 of Publication 2.

... the Plaintiff asserts that if the ultra-fine nickel powder produced by the producing method described in the Publication 2 satisfies the characteristics recited the patented claim 1 as explained in the decision on opposition, it is only a small portion, and others do not satisfy the above characteristics. However, according to the above, the patented invention is a "novel invention of product". Thus, if a portion of the nickel powder produced based on the producing method described in the Publication 2 satisfies the characteristics recited the patented claim 1, it should be said that it does not hinder from recognizing that the patented invention is described in the Publication 2.

... from the above, the decision on opposition is not erroneous in determining that the patented invention is described in the Publication 2, ...

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Relevant portion of Examination	Part III, Chapter 2, Section 1

Guidelines	
Classification of the Case	41: Presence of novelty
Keyword	

1. Bibliographic Items

Case	"Acid-addition salts of optically active piperidine derivative" (Trial for Invalidation) Intellectual Property High Court Decision, July 24, 2013 (2012 (Gyo KE) No. 10207)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-109 (JP 2007-145852A)
Classification	C07D 401/12
Conclusion	Dismissal
Related Provision	Article 29(1)(iii)
Judges	IP High Court Third Division, Presiding judge: Ryuichi SHITARA, Judge: Rika NISHI, Judge: Masaya TANAKA

2. Overview of the Case

(1) Summary of present invention

While since it has been generally known that optical isomers show different pharmacological activity or safety and there are also differences in the metabolic rates and the protein binding ratios therebetween, a pharmacologically preferable optical isomer is required for the medicine, the claimed invention is based on the finding that the present compound having (S)-form in the absolute configuration is a superior optical isomers acting as an active component in vivo having antihistaminic activity and antiallergic activity, since the (S)-ester has superior activity than those in (R)-ester in the test of inhibitory effects on histamine-induced death and the test of inhibitory effect on homologous PCA reaction using guinea pig.

In addition, while it is desirable for the medicine to have superior properties in physico-chemical stability in order to secure high quality of the optical isomer, the claimed invention is based on the finding that although various acid-addition salts of the present compound having (S)-form in the absolute configuration are the oily products or hydroscopic crystals, salts of benzene sulfonic acid is obtained as a crystalline having less hydroscopic property and having superior stability for storage, to be a particularly suitable compound as the medicine.

(2) State of the art

(i) Publication of Exhibit A1 (Invention of Exhibit A1): Indication of the amendment pursuant to Article 17bis for JP H2-25465A and Japanese Patent Application No. S63-175142 (identification by the Trial Decision)

"salt of benzene sulfonic acid of 4-[4-[(4-chlorophenyl)(2-pyridyl)methoxy]-1-pyperidyl]butanoic acid"

(cited from the Court Decision)

(ii) Exhibit A75-1 Publication: "Separation technique (Bunri-Gijutsu)", Vol. 25, No. 5 (identification by the Court Decision)

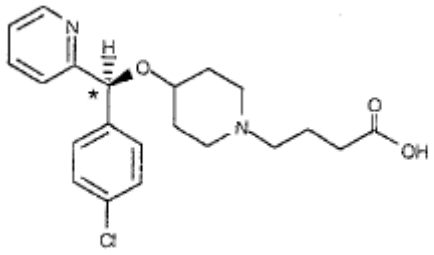
"...it has been widely known that actions between the optical isomers against the biological organism are varied as a common general knowledge at the priority date of the present patent, and it can be perceived that chemical substances having different actions between the optical isomers against the biological organism have been tended to use it as the optical isomer, not use it as a racemic body itself, resulting from the recent progression in the technique for asymmetric synthesis and optical resolution." (cited from the Court Decision)

(3) The Claims (only Claim 1 is described) (Present Patented Invention 1)

[Claim 1]

A benzene sulfonic acid salt of an optically active piperidine derivative represented by the formula (I)

[Chemical formula 1]



(I)

, which has (S)-form in the absolute configuration.

(4) Procedural History

January 4, 2007	:	Patent Application filed by the Defendant (Patentee) (Priority date: December 26, 1996)
March 18, 2011	:	Registration of establishment of the patent right (see "The Claims" as mentioned above)
June 9, 2011	:	Request for Trial for patent invalidation by Plaintiff (Muko No. 2011-800098)
April 23, 2012	:	Trial Decision that "the request for the present trial is dismissed

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

Appeal Decision (cited from the Court Decision)
The Present Patented Invention 1 is not the Invention of Exhibit A1 ...stated in ...Publication of Exhibit A1, and it cannot be decided that the patent of the Present Patented Invention 1 is granted by violating ...the provision of Article 29(1)(iii) of the Patent Act. (2) A difference between the invention ...identified by the Trial Decision and the Present Patented Invention 1 is as follows: C Difference

4-[4-[(4-chlorophenyl)(2-pyridyl)methoxy]pyperidino]butanoic acid is "which has (S)-form in the absolute configuration" in the Present Patented Invention 1, while to have (S)-form in the absolute configuration is not specified in Invention of Exhibit A1.

(hereinafter, 4-[4-[(4-chlorophenyl)(2-pyridyl)methoxy]pyperidino]butanoic acid is referred to as a "Present Compound").

...since it cannot be identified that an optical isomer included therein is disclosed upon which the racemic body is disclosed therein in case of a compound used for the medicine, the novelty of the Present Patented Invention has been affirmatively inferred ...

Decision

Allegations by Plaintiff	Allegations by Defendant
(1) Concerning the disclosure of the racemic body and the disclosure of its optical isomer ...1991 (Gyo KE) No. 8 ...(hereinafter, referred to as "1991 Tokyo High Court Decision") has held that if a racemic body is publicly known, its optical isomer does not have novelty. The Japan Patent Office has also determined that the disclosure of the racemic body leads to determine the disclosure of (R)-form and (S)-form against a pharmaceutical composition, after this Court Decision. ...Therefore, if the racemic body is disclosed, it should be determined that (R)-form and (S)-form are disclosed and it cannot be perceived that its optical isomer has novelty. This is obvious in light of "Standard for operation relating to Product Patent System and Multiple Claiming System" of a Guideline on Japan Patent Office (formulated by the Patent Office on October, 1975) (...hereinafter, referred to as "Guideline"). ...the Guideline states that "it is a principle that an invention of a chemical substance in which the presence of its optical isomer is not obvious and an invention of its optical isomer are different inventions, each other. (Provided that to be obvious herein means that the presence of its optical isomer is apparent by the presence of asymmetric carbon atom, as a simple optical isomer)." This statement is of explaining that if the presence of the optical isomer is	(1) The difference between the Present Patented Invention 1 and Invention of Exhibit A1 can be precisely said that (i) while the Present Compound in the (S)-form is used in the Present Patented Invention 1, Invention of Exhibit A1 is not specified on this point (Difference (i)) ..., and (ii) while the Present Compound in the (S)-form is used as its benzene sulfonic acid salt in the Present Patented Invention 1, Publication of Exhibit A1 does not describe this point (Difference (ii)). Concerning the Difference (i), it had not been known at the time of the priority date for the Present Patented Invention that the (S)-form is collected from the racemic body of the Present Compound described in Publication of Exhibit A1 by using the collecting method and condition stated in each experimental report ...of Exhibit A7. Concerning the Difference (ii), there is no disclosure in Publication of Exhibit A1 of "benzene sulfonic acid salt" of the Present Compound in the "(S)-form" according to the Present Patented Invention. (2) The Plaintiff has asserted that it cannot be perceived to have novelty for the Present Patented Invention since it should be determined that the disclosure of the racemic body leads to the disclosure of its (R)-form and (S)-form based on the 1991 Tokyo High Court Decision and the Guideline.

apparent, the invention of racemic body and the invention of the optical isomer are treated as the same invention. ... (2) Concerning that the method described in the experimental report of Exhibit A7 (hereinafter, referred to as a "method described in Exhibit A7) is obvious While the Trial Decision has determined that it cannot be said that the method described in Exhibit A7 is obvious for a person skilled in the art as a method for optically resolving the Present Compound, this determination is error. Since there are several succeeded examples to actually resolve by using the column for use in the method described in Exhibit A7 at the time of the priority date for the present patent..., it should be said that the method described in Exhibit A7 is obvious for a person skilled in the art as the method for optically resolving the Present Compound. Therefore, it should be said that it is equivalent that Publication of Exhibit A1 states a method for optically resolving the Present Compound by the method described in Exhibit A7.	However, while the 1991 Tokyo High Court Decision is a court decision of a "product" not having any activities itself as an intermediate of an insecticide, the Present Patented Invention is an invention relating to "compound used as an active ingredient of medicine". So, the range of the above-mentioned court decision does not cover the Present Patented Invention. In addition, while it can be considered that the assertion for the Guideline made by the Plaintiff is based on the opposite interpretation of a portion of "it is a principle that an invention of a chemical substance in which the presence of its optical isomer is not obvious and an invention of its optical isomer are different inventions, each other" by utilizing the statement of " Provided that to be obvious herein means that ...", the description within the parenthesis is merely of defining the wording of "obvious", not to be a basis of the above-mentioned opposite interpretation. Originally, the Guideline is not used no longer as a guideline by revising the standard for examination in 1995 and is not utilized in any trial decisions.

Judgment by the Court **the character(s) having italic face in the sentences is of correcting an obvious clerical error.*

...according to the description of Exhibit A75-1 Publication, it had been widely known as the common general knowledge at the priority date for the Present Patent (December 26, 1996) that the actions between the optical isomers against the biological organisms may vary, and it can be perceived that chemical substances having different actions between the optical isomers against the biological organism have been tended to use it as the optical isomer, not use it as a racemic body itself, resulting from the recent progression in the technique for asymmetric synthesis and optical resolution.

In consideration of the common general knowledge at the priority date for the Present Patent, when a patent application is filed on the basis of the finding that actions between optical isomers against the biological organisms are varied for an invention of a chemical substance, it is reasonable that novelty is perceived on a point of disclosing that the actions between the optical isomers included therein against the biological organisms are varied, even though its racemic body itself is publicly known.

The Plaintiff has asserted that it should be determined that each of (R)-form and (S)-form is disclosed if the racemic body is disclosed, based on the 1991 Tokyo High Court Decision and the Guideline and the presence

of the optical isomer especially for the Present Compound is clearly described in Publication of Exhibit A1, accordingly it is obvious to lack novelty for the Present Patented Invention in the (S)-form to be subjected.

However, the 1991 Tokyo High Court Decision is a court decision to deny novelty of an invention in a case of cancelling the Appeal Decision for cancelling the Appeal Decision denying novelty of the invention filed as a patent application having January 31, 1978 as a priority date, wherein when a racemic body comprising a pair of optical isomers is stated in a publication, it was raised as an issue whether or not the invention in which one of the pair is provided as a single substance has novelty and it should be said that the disclosure of the racemic body leads to the disclosure of the optical isomer since an optical isomer generally has no difference in the physico-chemical properties except the direction of the optical rotation. It is obvious that such a court decision did not consider the common general knowledge at the priority date for the Present Patent (December 26, 1996). It is impossible that the court decision is a court case to be applied for the present case.

That is, ...in light of the common general knowledge at the priority date of the Present Patent, when a patent application is filed based on the finding that the chemical actions between the optical isomers against the biological organisms are varied in an invention of a certain chemical substance, it should be perceived to have novelty on a point of disclosing that the actions between the optical isomers included therein against the biological organisms are varied, even though the racemic body itself is publicly known. There is an error in denying the novelty since the disclosure of the racemic body leads to the disclosure of its optical isomer as a determination at the priority date for the Present Patent.

In addition, concerning the Guideline, there is the statement asserted by the Plaintiff that (it is a principle that an invention of a chemical substance in which the presence of its optical isomer is not obvious and an invention of its optical isomer are different inventions, each other. (Provided that to be obvious herein means that the presence of its optical isomer is apparent by the presence of *asymmetric* carbon atom, as a simple optical isomer)(Page Toku-13)). It has to admit a room that this statement states that it should be understood that the disclosure of the racemic body leads to the disclosure of its optical isomer, since the presence of the optical isomer is obvious when the presence of the optical isomer is apparent by the presence of asymmetric carbon atom.

However, as mentioned above, since the common general knowledge at the priority date for the Present Patent had not been established at the time of 1978 as a common general knowledge, it is obvious that it had not been established at the time of 1975 as the common general knowledge. Concerning the presence of novelty for the Present Patented Invention, it should be determined in light of the common general knowledge at the priority date ...of the Present Patent, and there is an error to be deteremined on the basis of the provision of the Guideline.

...even though a large number of substances which can be resolved using the column used in the method described in Exhibit A7 is present, any examples in which the Present Compound or similar compound having chemical structure thereto can be optically resolved using the column have not been known. So, it cannot be said that the method described in Exhibit A7 is obvious for a person skilled in the art as a method for optically resolving the Present Compound at the time of the priority date for the Present Patent and that it is equivalent

that Publication of Exhibit A1 states a method of optically resolving the Present Compound with the method described in Exhibit A7.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Similarity of working and function

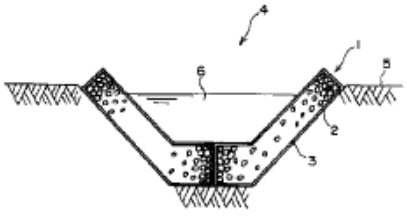
1. Bibliographic Items

Case	"Construction material for permeable waterway" (Appeals against an Examiner's Decision of Refusal) Intellectual Property High Court Decision, May 24, 2005 (2005 (Gyo KE) No. 10287)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H11-243947 (JP 2001-65040A)
Classification	E03F 1/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Residing judge Tomokatsu TSUKAHARA, Judge Masato TANAKA, Judge Tatsubumi SATO

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 2]



The claimed invention provides a construction material for permeable waterways which has a simple configuration, may be mass-produced, and has excellent installability and easy handling, so as to construct the permeable waterways or a drainage channel readily at a low cost. The construction material 1 for permeable waterways at least has an aggregate 2 and a pouch 3 that accommodates the aggregate 2 and has meshes each having a diameter smaller than that of the grain of the aggregate 2.

(2) State of the Art (Approval of appeal decision)

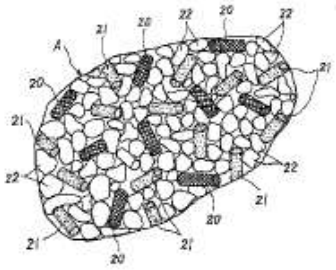
(i) Publication 1: JP H6-280296A

"A permeable fabric that is used to form a drainage having a V-shaped cross section and is constituted by a synthetic fiber material or a nonwoven fabric." (Cited from the Court Decision)

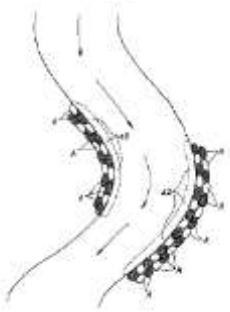
(ii) Publication 2: JP H11-147010A

A bag is disclosed in which the bag is used to arrange (to partially "form") at corner portions 42 of a river having an angularly U-shaped cross section (corresponding to "waterway having an angularly U-shaped cross section of the claimed invention). The bag at least has a filtering material 22 ("aggregate"), and a package container 10 ("pouch") that is filled with ("accommodates") the a filtering material ("aggregate") and has meshes ("meshes") each having a smaller size ("diameter") than the size ("grain diameter") of the filtering material 22 ("aggregate"). The bag is considered to be permeable and has a function to allow a part of water to be absorbed into the ground." (Cited from the Court Decision)

[FIG. 2]



[FIG. 5]



(3) The Claims (Amended) (Only claim 1 is stated)

[Claim 1] A construction material for permeable waterways to form a waterway having an angularly U-shaped cross section comprising: an aggregate; and a pouch accommodating the aggregate and having meshes each having a diameter smaller than that of a grain of the aggregate.

(4) Procedural History

June 26, 2002	:	Amendment (see the above-mentioned "The Claims ")
September 10, 2002	:	Decision of refusal
September 27, 2002	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-18877)
November 4, 2003	:	Appeal decision stating that "the request for appeal for this case is dismissed."

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

Appeal Decision (cited from the Court Decision)
(3) Comparison between the claimed invention and the invention described in Publication 1 <Differences> "In the claimed invention, the permeable member consists of an aggregate and a pouch that accommodates the aggregate and has meshes fach having a diameter smaller than that of grains of the aggregate. On the other hand, in the invention disclosed in Publication 1, the permeable member is constituted by a fabric made of a synthetic fiber or a nonwoven fabric." (4) Judgement of the difference

"Considering the above-mentioned difference, Publication 2 discloses the bag used to be arranged (partially "form") at corner locations 43 of the river having an angularly U-shaped cross section (corresponding to the "waterway having an angularly U-shaped cross section" of the claimed invention...), the bag having a filtering material 22 ("aggregate"), and a package container 10 ("pouch") that is filled with ("accommodates") the a filtering materia ("aggregate") and has meshes ("meshes") each having a smaller size ("diameer") than the size ("grain diameter") of the filtering material 22 ("aggregte"). Since the bag has a permeability, and has a function to allow part of the water to be absorbed into the ground, a person skilled in the art would readily arrive at the configuration of the claimed invention relating to the above-mentioned difference by applying the above-mentioned configuration of the invention disclosed in Publication 2 as a permeable member that constitutes a construction material for permeable waterway of the invention disclosed in Publication 1 in order to allow water to be absorbed into the groud."

Decision

Allegations by Plaintiff

Also, in Publication 2, stacking up the bags around the corner portions of river to prevent erosion is merely stated..., and there is no disclosure and suggestion as in the claimed invention that the bag itself is installed so that the bag is brought into contact with top of the river to cover the river, i.e., the entire waterway, having an angularly U-shaped cross section, instead of part of such a waterway, is formed by the bag. Therefore, a person skilled in the art cannot conceive of obtaining the configuration of the claimed invention by applying the bag of Publication 2 to the invention of Publication 1.

Even if the bag of Publication 2 is replaced by the fabric or nonwoven fabric of the invention of Publication 1, this does not make the "construction material for permeable waterways" of the claimed invention that is installed to cover the unsupported gutter and to be adjacent to the top of the unsupported gutter, reinforces the unsupported gutter, and forms the entire waterway, having an angularly U-shaped cross section, on its own.

Allegations by Defendant

...In the appeal decision Publication 2 was cited to demonstrate that "an aggregate and a pouch having meshes each having a diameter smaller than that of the grain of the aggregate" as a permeable member used corner portions of river, is publicly known before the patent application for the claimed invention was filed. Since the construction material for permeable waterway of the invention described in Publication 1 and the pouch described in Publication 2 have a commonality in that both are used for waterways and both has permeability, there is no inhibiting factor to apply the invention of Publication 2 to the invention of Publication 1. Thus, obtaining the configuration relating to the above-mentioned difference by applying the pouch described in Publication 2 instead of the construction material for permeable waterways described in the invention of Publication 1, can be readily done by a person skilled in the art. Therefore, the judgement made in the appeal decision that denied the inventive step of the claimed invention is correct.

Judgment by the Court

The water-quality purification bag disclosed in Publication 2 aims for "purification of water-quality (environment preservation), protection at waterfront, water-flow control, impact alleviation of collision

water"..., in which "when permeating or passing through the water-quality purification bag, the water is purified by the filtering material." On the other hand, the fabric or the nonwoven fabric disclosed in Publication 1 also forms a waterway to control water flow, and water permeates therethough so as to "purify rainwater having appropriate permeability and retention". Thus, the fabric and the nonwoven fabric disclosed in Publication 1 and the water-quality purification bag in Publication 2 have a commonality in that both has a function to control water flow and allow for permeability and retention of water, and therefore it is easily understood by a person skilled in the art that a water-quality purification bag that exerts its function of water flow control and permeability and retention of water in "rivers" is also applicable to a "drainage." Furthermore, since the water-quality purification bag of Publication 2 " can be changed its shape in accordance with the shape of sandbags," a person skilled in the art would readily understand that an embodiment in which arrangement of the bag along the surface of the "drainage" is viable. Therefore, the judgement in the appeal decision stating that using the water-quality purification bag of the invention disclosed in Publication 2 in place of the fabric or nonwoven fabric of the invention disclosed in Publication 1 is applicable can be approved.

(42)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, similarity of problems to be solved

1. Bibliographic Items

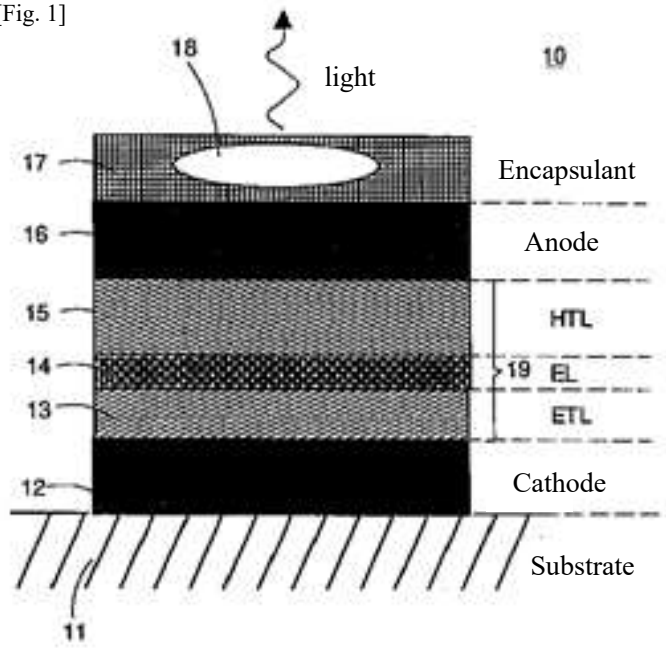
Case	"Siloxane and siloxane derivatives as encapsulants for organic light-emitting devices" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, October 11, 2006 (2005 Gyo KE) No. 10717
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-504964 (National Publication of International Patent Application No. H11-514791))
Classification	H05B 33/04
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Tomokatsu TSUKAHARA, Judge: Naoki ISHIHARA, Judge: Teruhisa TAKANO

2. Overview of the Case

(1) Summary of Claimed Invention

An organic light-emitting device (10) capsulated with a siloxane layer (17) is provided. The siloxane layer (17) is applied to the light-emitting part of a diode (10) to protect it from contamination, degradation, oxidization, etc. The siloxane layer (17) supports an optical component such as a lens (18). The optical component (18) is arranged so that the light generated in the diode (10) is output therethrough.

[Fig. 1]



(2) State of the art

(i) Publication 1 (Cited Invention 1b): JP H8-083688A (finding in the reason for the appeal decision published in the Court Decision)

"An organic EL element comprising a pair of contact electrodes, one functioning as an anode, and the other as a cathode, and

an organic light-emitting layer in which light is generated by electroluminescence when a voltage is applied between said pair of contact electrodes, characterized in that,

the light-emitting part is covered by an overcoat layer and said overcoat layer comprises a light-scattering part placed in the light path." (Cited from the Court Decision)

(ii) Citation 3 (Cited Invention 3): JP H5-036475A (finding in the reason for the appeal decision published in the Court Decision)

"Siloxane as a protective layer having a function to encapsulate an organic light-emitting device"

(3) The Claims (Claimed Invention)

[Claim 1]

An organic light-emitting element comprising a pair of contact electrodes, one functioning as an anode, and the other as a cathode, and

an organic area in which light is generated by electroluminescence when a voltage is applied between said pair of contact electrodes, characterized in that,

the light-emitting part is covered with siloxane and said siloxane comprises an optical component placed in said light path, and

said optical component consists of a lens, diffraction grating, diffuser, polarizer, or prism, or an arbitrary combination thereof embedded in said siloxane, formed in said siloxane, or arranged in the pocket-like part of said siloxane.

(4) Procedural History

July 10, 1996	:	Patent application filed
April 11, 2002	:	Decision of refusal
July 16, 2002	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-
	:	13257)
August 6,2004	:	Amendment (Refer to "The Claims" above.)
June 7, 2005	:	Appeal decision to the effect that "the present appeal does not hold good"

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

Reason for the appeal decision published in the Court Decision	
(4) Determination on Difference between Claimed Invention and Invention a disclosed in Publication 1 The overcoat layer in Invention a disclosed in Publication 1 is for covering the light-emitting part and similarly the entire light-emitting part. A person skilled in the art could have easily arrived at a matter of using siloxane as a protective layer having a function to encapsulate the organic light-emitting device described in Publication 3 instead of the overcoat layer of the invention described in Publication 1. (5) Comparison of and determination on Claimed Invention and Invention b disclosed in Publication 1 Comparison of the Claimed Invention and Invention b disclosed in Publication 1 reveals that the "organic light-emitting layer" and the "organic EL element" of Invention b described in Publication 1 correspond to the "organic area" and "organic light-emitting device" of the Claimed Invention respectively. In addition, the "light-scattering part" of Invention a described in Publication 1 has the same meaning as "diffuser," and the "light-scattering part" of Invention a described in Publication 1 corresponds to the optical component of the Claimed Invention comprising "a lens, diffraction grating, diffuser, polarizer, or prism, or an arbitrary combination thereof." Here, since the overcoat layer of invention b described in Publication 1 is provided on the light-scattering part to planarize the surface, if it is looked in its completed status, it can be said that the light-scattering part is embedded in the overcoat layer. In addition, since the overcoat layer of the invention b described in Publication 1 and siloxane of Claimed Invention have the same function of covering the light-emitting part, both of them can be reworded as a covering layer. Then, the identical features and the differences between the Claimed Invention and Invention b described in Publication 1 are identical with the identical features and the differences between the Claimed Invention and the invention a described in Publication 1. Therefore, from the same reason as described in the determination in (4) above, it is a matter at which a person skilled in the art could have easily arrived to use siloxane described in Publication 3 as the protective layer having a function to encapsulate the organic light-emitting device and covering the light-emitting part similarly with the overcoat layer described in Publication 1 that is for covering the light-emitting part, in place of the overcoat layer of the invention b described in Publication 1.	
Decision	
Allegations by Plaintiff 4. Reason for Cancellation 4 (Error in determination on the difference between Claimed Invention and Cited Invention 1b) ... the overcoat layer of Cited Invention 1b is, the same as the overcoat layer of Cited Invention 1a, planarizes the uneven surface of the light-scattering part (Publication 1, paragraph [0033]), and there is no disclosure nor suggestion in Publication 1 that the	Allegations by Defendant 2. Against Reason for Cancellation 4 (Error in determination on the difference between Claimed Invention and Cited Invention 1b), (1) Plaintiff alleges that, while the overcoat layer of Cited Invention 1b is for planarizing the uneven surface of the light-scattering part, siloxane of Cited Invention 3 is a protective membrane for the organic light-emitting device, but not for planarizing the uneven

organic light-emitting device is encapsulated by the overcoat layer. As described in 3(1) above, in organic light-emitting device equipment of Cited Invention 1b, an overcoat layer is formed between the substrate and the organic light-emitting device, and, since the overcoat layer is not disposed on the top surface, it does not need to play a role to encapsulate same as in Cited Invention 1a. On the other hand, since siloxane of Cited Invention 3 is a protective membrane of the organic light-emitting device, and not for planarizing the uneven surface of the light-scattering part as described in 2 above, the overcoat layer of Cited Invention 1b and siloxane of Cited Invention 3 have different functions and there is no motivation to replace the overcoat layer of Cited Invention 1b with siloxane of Cited Invention 3. In Publications 1, and 3, it is not disclosed nor suggested to cover the top surface of the organic light-emitting device with siloxane or siloxane derivatives in order to form an excellent barrier (shield layer) against external contaminant such as water, solvent, and dusts.	surface of the light-scattering part, and therefore, the overcoat layer of Cited Invention 1b and siloxane of Cited Invention 3 have different functions and there is no motivation to replace the overcoat layer of Cited Invention 1b with siloxane of Cited Invention 3. However, if we look at the relation between the light-emitting part (the organic EL element of Cited Invention 1b and the laminated structure of Cited Invention 3) and the covering layer (the overcoat layer of Cited Invention 1b and siloxane of Cited Invention 3), since the light-emitting part is covered by the covering layer in both of Cited Invention 1b and Cited Invention 3, and Cited Invention 1b and Cited Invention 3 belong to the same technical field of organic light-emitting device, there is no special difficulty to make the feature according to the difference by replacing the overcoat layer of Cited Invention 1b with siloxane of Cited Invention 3. In addition, since the overcoat layer of Cited Invention 1b has a function to improve adhesion by planarization and cover the light-emitting part, and siloxane of Cited Invention 3 protects the light-emitting part by covering it, they have a function to cover the light-emitting part. Therefore, it is natural for a person skilled in the art who wants to try better materials to use siloxane of Cited Invention 3 instead of the overcoat layer of Cited Invention 1b. In addition, even if attention is drawn to the function of planarization of the overcoat layer of Cited Invention 1b, using siloxane as a membrane for planarization is a conventional well-known art as seen in JP H1-307247A (Exhibit B1) and JP H2-123754A (Exhibit B2). Therefore, there is no negative teaching for replacing the overcoat layer of Cited Invention 1b with siloxane of Cited Invention 3.

Judgment by the Court

2. Concerning Reason for Cancellation 4 (Error in determination concerning the difference between the claimed invention and Cited Invention 1b)

... according to the statement in Publication 1 "in the organic EL device of the claimed invention ... the organic EL element is formed on the substrate on which the light-scattering part is provided, and, when a light-scattering part having an uneven surface is provided on the inner surface of the substrate so that the uneven surface faces the organic EL element, after forming a substantially flat surface by providing an overcoat layer on this light-scattering part, an organic EL element is formed on this overcoat layer. If the organic EL element is formed directly on the light-scattering part without providing any overcoat layer, since the transparent electrode (transparent electrode constituting the organic EL element = anode) that directly contacts the light-scattering part cannot be flat because of influence of unevenness of the light-scattering part, and, as a result the thickness of each layer composing the organic EL element is not constant, many dark spots form on the light-emitting face, or broken wire due to short pass tends to occur" (Paragraph [0033]), ... it is acknowledged that an overcoat layer is formed to substantially planarize the uneven surface of the light-scattering part in order to avoid formation of many dark spots on the light-emitting face and broken wire by short pass caused by influence of unevenness of the light-scattering part when the organic light-emitting device is formed directly on the uneven surface of the light-scattering part. ... Siloxane of Cited Invention 3 is provided as a protective membrane to protect the organic light-emitting device against influence when a shield layer is formed on the outer surface of the organic light-emitting device, and it is acknowledged that it is especially preferable to be formed by a CVD method under a vacuum environment in order to prevent as much as possible degradation of characteristics of the light-emitting layer and opposing electrode in the process of forming the protective layer.

... the overcoat layer of the Cited Invention 1b must be such that can substantially planarize the uneven surface of the light-scattering part, but, there is no evidence to prove that siloxane of the Cited Invention has 3 has characteristics suited to planarization including the method for formation and the thickness of membrane, but, by contrast, it can be deduced from statements in the above Publication 3 and JP H1-307247A; that it is not suitable for planarization. Then, even if the light-emitting part (the organic EL element of Cited Invention 1b, and the laminated structure of Cited Invention 3) is covered by a covering layer (the overcoat layer of Cited Invention 1b, and the siloxane of Cited Invention 3) in both of Cited Invention 1b and Cited Invention 3, and, both Cited Invention 1b and Cited Invention 3 belong to the same technical field of organic light-emitting device, it cannot be reasoned, by that alone, that a person skilled in the art could easily conceive to use siloxane of Cited Invention 3 in place of the overcoat layer of Cited Invention 1b.

(42)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, similarity of problems to be solved, similarity of operations or functions, and negative teaching

1. Bibliographic Items

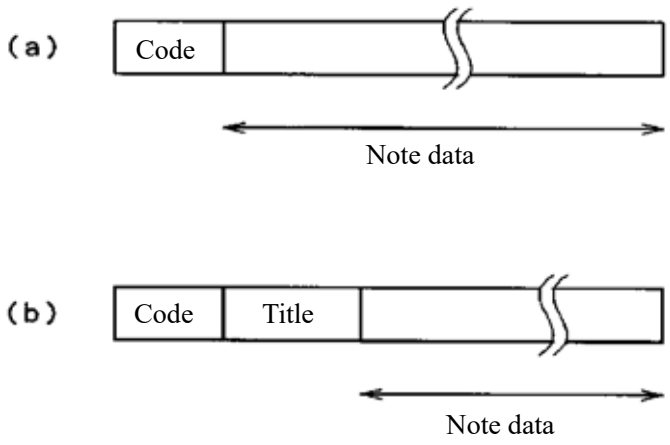
Case	"Method for providing melody data" (Trial for Invalidation) Intellectual Property High Court Decision, March 24, 2010 (2009 (Gyo KE)No.10185)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-101546 (JP2003-333207A)
Classification	H04M 11/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Yoshiyuki MORI, Judge: Katsumi SHIBUYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to provision of melody data to a radio selective calling receiver which users can enjoy by adding a fresh melody as the annunciation sound and never get tired of it. If the user of melody data selects melody data through a phone line, the provider of melody data provides the selected melody data through a phone line after adding a code for melody data and a title of melody data.

[FIG. 2]



(2) State of the art

(i) Publication 1 (Cited Invention 1): JP H7-322323A (Finding by the trial decision)

"A radio selective calling receiver receiving messages with a selective calling signal and composing ringing tone information set by the user in advance to be used as annunciation sound when a message is received, comprising

an EEPROM 54 storing ringing tone information,

a switch section 4 to which a user's instruction is input,

an LCD 7 displaying messages,

a decoder 3 receiving data, and

a CPU 53, when data received by the decoder 3 is received as a selective calling signal, storing data received as the selective calling signal in RAM 52 storing message signals as messages, and when a ringing tone is composed, storing in EEPROM 54 as a ringing tone"

(ii) Publication 2 (Cited Invention 2): JP H22-047936A (Finding by the trial decision)

"A radio receiver receiving melody data selected by a user in advance with an address and used as ringing tone when received"

(3) The Claims (claimed invention)

[Claim 1]

A radio receiver receiving messages with the first address, and receiving melody data selected by the user in advance with a second address and used as ringing tone when received, characterized in that the radio receive comprises:

a memory section for storing melody data,

an operating section in which a user's instruction is input,

a display section for displaying messages,

a receiving section for receiving data, and

a control section, when data is received by the receiving section with the first address, for storing data received with the first address as a message in the storing section storing message data, and, when received with the second address, storing data received with the second address by adding the data to the storing section as a new melody data

(4) Procedural History

August 4, 2006	:	Patent right registered
November 21, 2008	:	Demand for a trial for invalidation of a patent (Muko No. 2008-800262)
February 13, 2009		Demand for correction by Plaintiff (Refer to the above "The Claims.")
June 2, 2009	:	Trial decision to the effect "Correction is accepted. ... the patent is invalidated."

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

<table>
<tr><td colspan="2">Trial decision</td></tr>
<tr><td colspan="2">Since Cited Invention 1 and Cited Invention 2 are exactly the same with respect to technical problem to be solved and technical field in that they relate to an art to change a melody for annunciating receipt of call for radio receivers, there is no special difficulty in applying Cited Invention 2 to Cited Invention 1 and, on that occasion, taking into consideration that, with respect to radio receivers, to use addresses properly according to the use; namely, to have the second address in addition to the first address for other use, is a well-known art as disclosed in, for example, JP H7-321938A (Paragraph 39), JP H8-223625A (Paragraphs 22, and 52), and JP H3-23727A (Page 2, Upper right column, Lines 1 to 20); in Cited Invention 1, in Cited Invention 1, as a means to obtain melody data, it is a matter which a person skilled in the art could easily make to adopt Cited Invention 2 in Claimed Inventions and "receive" melody data "selected" in advance by the user with "the second address" and to be used as annunciation sound for incoming call.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff

The purpose of Cited Invention 2 is to provide a new and improved method to reprogram an alarm pattern for a remote receiver (Publication 2 [Exhibit A2], Page 2, lower left column, Line 20 to lower right column, Line 3), in Cited Invention 2, an alarm pattern is transmitted from a transmitter to a remote receiver, and the alarm pattern is reprogrammed and replaced in the remote receiver (Claims, "Claims 1 and 2"). As stated above, the purpose of Cited Invention 2 is to provide data of melody from the outside of the radio receiver, reprogram and replace, and it is contrary to the purpose of Cited Invention 1 that the user composes by themselves favorite melodies using a selective calling receiver.

Therefore, there is a negative teaching to combine Cited Invention 2 to Cited Invention 1.

...

Since Cited Invention 2 reprograms and replaces the alarm pattern, it is heterogeneous to the technical idea of the claimed invention that receives melody data with an address other than that for receiving message data and additionally stores it in the memory section, and to the technical idea of Cited Invention 1 that the user him/herself composes a favorite melody.</td><td>Allegations by Defendant

Plaintiff alleges that the purpose of Cited Invention 2 is to supply melody data from the outside of the radio receiver, and rewrite it by reprogramming, and since it is not consistent with the purpose of Cited Invention 1 that the user themselves composes a favorite melody using a selective calling receiver, there is a negative teaching to combine Cited Invention 2 to Cited Invention 1.

As already discussed, however, since Cited Invention 1 proposes "composing" as an aspect to obtain new melody data, it is not against the purpose of Cited Invention 1 to adopt a constitution to receive supply of melody data from the outside of the radio selective receiver as another aspect to obtained new melody data.

...

Since Cited Invention 2 is also common to the Claimed Invention and Cited Invention 2 in that their object is also to make it possible to use a new melody as annunciation sound for new arrival, there is sufficient motivation to apply with Cited Invention 2 to Cited Invention 1.</td></tr>
</table>

... there is no motivation to apply Cited Invention 2 to Cited Invention 1, and there is no motivation also to lead to the Cited Invention. Determination of the trial decision that applies both Cited Inventions nevertheless is incorrect.	

Judgement by the Court

A. Combination of Cited Invention 1 with Cited Invention 2

Since both of Cited Invention 1 and Cited Invention 2 [1] belong to the same technical field of radio receivers, and [2] have common problem to be solved for the invention in that they aim at obtaining melody data to be used as a notification sound for new arrival, and [3] they have a similar function and operation in that they obtain melody data to be used as a notification sound for new arrival and store the melody data in the storage section, it should be understood that Cited Invention 1 and Cited Invention 2 can be combined with each other.

Although Plaintiff alleges that the purpose of Cited Invention 2 is to supply melody data from the outside of the radio receiver, and replace it by reprogramming, and, therefore, it differs from the purpose of Cited Invention 1 that the user themselves composes a favorite melody with a selective calling receiver, even if there is a difference as alleged by Plaintiff between Cited Invention 1 and Cited Invention 2, it cannot be said, because of that, that there is a negative teaching to combine Cited Invention 2 to Cited Invention 1, and, since there are common points between Cited Invention 1 and Cited Invention 2, they must be able to be combined with each other.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of the technical field, Similarity of the problem to be solved, Obviousness of or easy to conceive the problem to be solved, Obstructive factor

1. Bibliographic Items

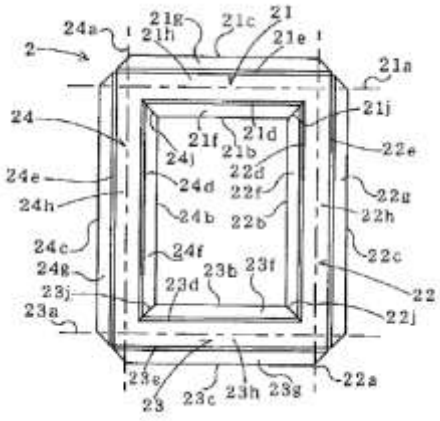
Case	"Exhibit support" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, July 21, 2010 (2010 (Gyo KE) No. 10086)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2096, page 128, HANREI TIMES No. 1343, page 188
Application No.	Japanese Patent Application No. H8-243976 (JP H10-66638A)
Classification	A47G 1/06
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Yasuhito INOUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention aims at providing an exhibit support 2 which is easily assembled and furnished with a suitable design. The exhibit support 1 has a substantially, rectangularly annular thin-plate-shaped frame 2 with a predetermined width. One surface of each of central flat portions 21h to 24h acts as an inwardly-foldable surface for joining an exterior folding piece 21g to an interior folding piece 21f. The other surface of each of the central flat portions 21h to 24h acts as a decorative surface.

[FIG. 2]



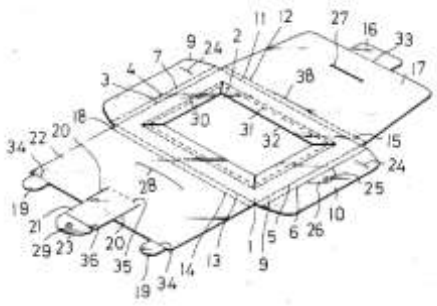
(2) State of the Art

(i) Cited Invention (Cited Invention 1): (JP S55-114271U) (Findings of the Appeal)

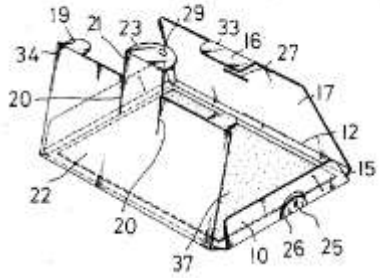
"A decorative frame body comprising: a rectangular center plate 1 having a rectangular window 2 at the

center; an inwardly-bending left-side plate 8, an inwardly-bending right-side plate 10, an inwardly-bending external plate 7, and an inwardly-bending interior plate 22 all of which are provided along respective outer edges of the center plate 1 by way of outer bend lines; and an inwardly-bending center piece 32 provided along an inner edge of the center plate 1 by way of inner bend lines; wherein a picture plate 37 is housed in the interior of the decorative frame; and a center insert piece 16 provided on the inwardly-bending exterior plate 17 is inserted into a second kerf 28 provided on the inwardly-bending interior plate 22, thereby making it possible to place the picture plate 37 so as to expose from the window 2" (cited from the court decision, and the drawings are cited from JP S55-114271U).

[FIG. 1]



[FIG. 2]



(ii) Citation 3 (Cited Invention 3): JP S58-173517A

"'The frame is decorated before molding' is disclosed." (Cited from the court decision)

(3) The Claims (Amended) (Claimed Invention)

[Claim 1] An exhibit support comprising a substantially-rectangular annular thin-plate-shaped frame with a predetermined width; in which each of frame sides has two folding portions formed substantially in parallel to a center line of the frame and between the center line and an inner edge as well as between the center line and an outer edge, and also has a central flat portion, an outwardly folding piece, and an inwardly folding piece that are divided by the two folding portions; in which one surface of the central flat portion acts as a surface for joining the outwardly folding piece and the inwardly folding piece that are both folded inwardly; in which another surface of each of the central flat portion, the outwardly folding piece, and the inwardly folding piece acts as a decorative surface to be decorated before the outwardly folding piece and the inwardly folding piece are folded; and in which an exhibit can be placed by way of arbitrary engagement means such that at least a portion of the exhibit becomes exposed out of an opening.

(4) Procedural History

January 19, 2007	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2007-5094)
August 17, 2009	:	Decision of refusal
August 17, 2009	:	Amendment (see above "The Claims")
January 25, 2010	:	The appeal decision stating that "the request for trial and appeal shall not lie."

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

<table>
<tr><td colspan="2">Appeal Decision</td></tr>
<tr><td colspan="2">A contradistinction between the claimed invention and the cited invention shows ...
(Difference 2)
In the claimed invention, "another surface of each of the central flat portion, the outwardly folding piece, and the inwardly folding piece acts as a decorative surface to be decorated before the outwardly folding piece and the inwardly folding piece are folded." Meanwhile, it is uncertain for the cited invention to have such a process in this regard.
(About Difference 2)
...the "photo-frame" is an equivalent of the "exhibit support" of the claimed invention, and hence ...the citation 3 can be said to disclose that "the frame is decorated before formation."
Also, the invention stated in the cited invention and that stated in the citation 3 fall in the same technical field of exhibit supports. Therefore, a person skilled in the art could have easily conceived to realize the matter specifying the claimed invention pertinent to the Difference 2 by applying the configuration disclosed in the citation 3 to the frame of the cited invention.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(2) Even if the citation is analogous in some aspect, the citation is on a different level when compared to the claimed invention in terms of conceptual and potential aspects. The analogous aspect points out a common figuration and function in various fields (categories) of exhibits. However, the cited invention is ...only a portion of the claimed invention and a kind of invention virtually subsumed under the claimed invention. ...the case shows an erroneous interpretation of the Patent Office resultant from a failure to gain an insight of a potential outstanding quality as a result of being shackled by its ordinary, common appearance.</td><td>Allegations by Defendant
(2) Further, in the appeal decision, the identical feature and differences are pointed out by means of the contradistinction between the claimed invention and the cited invention 1. The difference is appropriately interpreted, and hence the trial decision is free from the erroneous interpretation alleged by Plaintiff.</td></tr>
<tr><td colspan="2">Judgment by the Court
C About Difference 2
The citation 3 discloses that "the frame is decorated before formation." (Exhibit B3)
It can be said that (1) both the cited invention 1 and the cited invention 3 fall within the same technical field of display supports, and inexpensively provide display supports; (2) an attractive appearance of the display support is a problem to be ordinarily conceived and a similar problem also lies in the cited invention 1;</td></tr>
</table>

and (3) no difficulties will be encountered in accommodating the "picture plate 37" even if the frame is decorated before formation in relation to the cited invention 1 and presence of a motivation to apply the cited invention 3 to the cited invention 1 can be deduced from a comprehensive determination that there is no factors acknowledged for technical hindrance.

Consequently, a person skilled in the art could have easily conceived the configuration of the claimed invention pertinent to the difference 2 by applying the cited invention 3 to the cited invention 1.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Similarity of the problem to be solved, Well-known problem to be solved

1. Bibliographic Items

Case	"Method for stirring and defoaming solvent, etc." (Trial for Invalidation) Intellectual Property High Court Decision, July 28, 2010 (2009 (Gyo KE) No. 10329)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-406507 (JP 2005-131622A)
Classification	B01D 19/00
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Misao SHIMIZU, Judge: Kenjiro FURUYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention includes: housing a solvent in a container provided on an arm body; holding an interior of the container evacuated when rotating the arm body (revolving the container) and causing the container to spin; and detecting a temperature of the solvent, etc., in the container, thereby independently controlling the number of revolutions and spins of the container in accordance with an increase in the temperature of the solvent, etc., and stirring the solvent in an optimum state and performing deforming with a higher degree of accuracy.

(2) State of the Art

(i) Citation 1 (Exhibit A1) (Cited Invention 1): JP 2000-61207A (Findings of the Decision)

"...the cited invention 1 relates to an apparatus that revolves an evacuated kneading container with a drive motor, causing the kneading container to spin with the drive motor or another different driving machine to knead and defoam a material to be kneaded, and operating conditions for kneading are admitted to be previously set in accordance with conditions, like types of a material to be kneaded and a limit on a required temperature increase.

Further, the citation 1 explicitly shows a problem which occurs when a temperature is increased by stirring the material to be kneaded during kneading and defoaming operations in the kneading and defoaming apparatus.

The citation 1 discloses a method for providing a cooling fan as well as evacuating only the kneading container in order to suppress a temperature increase. Consequently, the cited invention 1 is admitted to disclose a technical problem of a necessity for limiting a temperature increase of the container when the evacuated kneading container is caused to spin and revolve to knead and defoam the material to be kneaded." (Cited from the Court Decision)

(ii) Citation 2 (Exhibit A2) (Cited Invention 2): JP H5-150548A (Finding of the Decision)

"...the cited invention 2 relates to a method for mixing a plurality of toner materials. It is admitted that, in order to cope with a temperature increase due to frictional heat caused by stirring the toner material during mixing, there is adopted a configuration for measuring an internal temperature of the hopper with a temperature sensor provided on an upper surface of the hopper when the toner material charged into a hopper is mixed by rotating the stirring member through rotational driving of a motor, and that ...the toner material can be stirred and mixed while held in a predetermined temperature range." (Cited from the Trial Decision)

(iii) Well-known Example (Exhibit A12): JP H5-72942A

"...the well-known document relates to an esterification reaction apparatus for esterifying a terephthalic acid and ethylene glycol and is admitted to disclose the followings. When both materials are stirred and mixed in a mixing tank by rotation of stirring impeller vanes, a temperature increase in the mixing tank stemming from stirring heat is detected by a temperature detection end, and the number of rotations of the stirring impeller vanes is reduced so as to suppress the temperature of contents within a predetermined value. Thus, the number of rotations of the stirring impeller vanes is controlled in accordance with a temperature change of the contents." (Cited from the Court Decision)

(3) The Claims (Corrected) (Only Claim 1 stated) (Corrected claimed invention 1)

[Claim 1] A solvent stirring and defoaming method for stirring and defoaming a solvent stored in a container by rotating the container storing a solvent, etc., and rotating an arm body supporting the container, the method comprising:

controlling an internal evacuated state in the container while controlling the number of revolutions of the container or the number of revolutions and spins of the container; detecting a temperature of the solvent stored in the container while, at least, the container is evacuated; and, when the temperature rises to a given temperature, repeating an increase or decrease in the number of revolutions and spins of the container while independently controlling the number of revolutions and spins of the container.

(4) Procedural History

September 9, 2008	:	Trial for Patent Invalidation by Plaintiff (Muko No. 2008-800174)
December 26, 2008	:	Request for correction by Ex-patentee
February 3, 2009	:	Transfer and Registration of Patent Right (from ex-Patentee to Defendant)
June 16, 2009	:	Amendment of Request for Correction (see above "The Claims")
September 10, 2009	:	The appeal decision stating that "the amendment shall be approved" and that "the request for trial and appeal shall not lie."

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">...the corrected claimed invention 1 cannot be said to have been easily conceived from the citations 1 and 2 and the well-known techniques.
...the difference between the corrected invention 1 and the cited invention 1 approved by the appeal decision...lies in the followings:
<Difference 1>
As to evacuating the interior of the container while revolving and spinning the container, the corrected claimed invention 1 comprises "controlling an internal evacuated state in the container while controlling the number of revolutions of the container or the number of revolutions and spins of the container; detecting a temperature of the solvent stored in the container while, at least, the container is evacuated; and, when the temperature rises to a given temperature, repeating an increase or decrease in the number of revolutions and spins of the container while independently controlling the number of revolutions and spins of the container." In contrast, the cited invention 1 lies in: "previously setting the operating conditions in accordance with a type of a material to be kneaded and a limit on temperature increase; setting evacuation timing, a time of evacuation, and a degree of evacuation to optimum conditions; and performing operation to effect evacuation at required timing while revolving and spinning the container."
The appeal decision admits that the "operating conditions are previously set in accordance with the type of a material to be kneaded and a limit on temperature increase" and that "the temperature increase in solvent, etc.," is limited by the setting of the operating conditions and is not to be taken as an issue. Further, the appeal decision admits that a motivation to further control the "temperature increase in a solvent, etc." by another technique is not found in the cited invention 1....
The appeal decision admits that, "even when having a cognizance of "a limit on the temperature increase" during operation of the apparatus," the cited invention 1 "does not originally have a technical idea of "detecting a temperature of a solvent, etc""".... Secondly, the appeal decision admits that ... "a motivation to "detect a temperature of a solvent, etc." and further control "the temperature increase in the solvent, etc." is not found in the cited invention 1" ....</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...the cited invention 1 discloses taking a temperature limit as one of requirements for setting operating conditions of the apparatus ...and a problem of a temperature increase in the material A to be kneaded by stirring.... Certainly, "the operating conditions are previously set in accordance with the type of the material A to be kneaded and the required</td><td>Allegations by Defendant
The cited invention 2 is for "stirring and mixing a plurality of types of toner materials charged into the hopper by driving the stirring member placed in the hopper." The cited invention 2 is totally different in structure and technical field from the cited invention 1 that "kneads and defoams the material to be kneaded by revolving and spinning the kneading container."</td></tr>
</table>

conditions (e.g., a limit on temperature increase)" ...is stated in the cited invention 1. Hence, at the time of setting of the operating conditions, the conditions are assumed to be set in consideration of the temperature increase in a solvent, etc. However, the temperature of the material A to be kneaded is increased by kneading. Accordingly, the cited invention 1 does not bring the problem of the temperature increase itself into extinction. Therefore, there exists a motivation to apply another means for solution to the problem of the temperature increase to the cited invention 1. There is no factor of hindrance to adoption of another means for solution to the cited invention 1. ...the cited invention 1 discloses taking a temperature ceiling as one of requirements for setting operating conditions of the apparatus and a problem of the temperature increase in the material A to be kneaded induced by stirring. From this, it is obvious that ...in order to set the operating conditions in accordance with the temperature ceiling on the material A to be kneaded, there is naturally a need or motivation to measure the temperature of the material A to be kneaded when the material A to be kneaded is kneaded or defoamed under various operating conditions (the number of spins, the number of revolutions, a time, and others) in ...a test for determining the operating conditions. Therefore, in the cited invention 1, there obviously exists a motivation to detect the temperature of the material A to be kneaded. Since the opening of the container is an upper end, placing the temperature detection means in the vicinity of the upper end of the container in order to detect the temperature of the material A to be kneaded in the container is a layout a person skilled in the art naturally selects....	...the defoaming-type stirring apparatus, such as that stated in connection with the cited invention 1, was established and recognized in at least 2000 as another technical field that is in a clear departure from the technical field of the apparatus for rotating impellers (impeller vanes), etc. in the container (an apparatus for rotating the stirring member in a container). Therefore, it is hardly imaginable that a person skilled in the art in the technical field of the defoaming-type stirring apparatus had an opportunity to dare to know a document (the citation 2) in another technical field at the time of filing of the claimed invention (October 29, 2003).

Judgment by the Court

...the cited invention 1 explicitly shows ...a technical problem of a necessity for restricting temperature increase in the container when the evacuated kneading container is spun and revolved to knead and defoam the material to be kneaded. It is admitted that in order to solve the problem, the operating conditions including the number of spins and revolutions of the container have been previously set. In addition, the cited invention 2 also has a similar technical problem of suppressing the temperature increase of a target that is stirred and mixed. In order to solve the problem, it is admitted to detect a temperature of the target with the temperature sensor disposed on the upper surface of the hopper; to decrease the temperature by decreasing the number of rotations of the stirring member when the temperature increases to a given temperature; and to repeat a decrease or increase in the number of rotations of the stirring member by controlling the number of rotations in accordance with a detected temperature in subsequent steps.

Further, the well-known example of the present applicaiton also discloses the technical problem of preventing the temperature from increasing to a given level or more due to stirring and also discloses the technical matter for controlling the number of rotations of the stirring impeller vanes in accordance with the detected temperature to solve the technical problem.

Accordingly, it is admitted that both the cited inventions 1 and 2 and the well-known example of the present application all have the similar technical problem of preventing a temperature increase caused by stirring operation at a given temperature, and provide the means for solving the problem respectively.

Consequently, in consideration of the technical problem, itself, of preventing the temperature increase in excess of a given level by stirring being a well-known technical problem shown in the well-known example of the present application, it must be said that a person skilled in the art easily could have conceived ...the configuration of detecting a temperature of the target and controlling operating conditions of the container including the number of spins and revolutions in accordance with a detected temperature, by means of adopting the technical idea disclosed in the cited invention 2 having the common technical problem, namely, an idea of controlling the number of rotations of a stirring member when the temperature of the target is detected and when the temperature increases to a given level, in place of the configuration in the cited invention 1 for previously setting the operating conditions including the number of spins or revolutions for kneading in accordance with conditions, like a limit of temperature increase.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, similarity of problems to be solved

1. Bibliographic Items

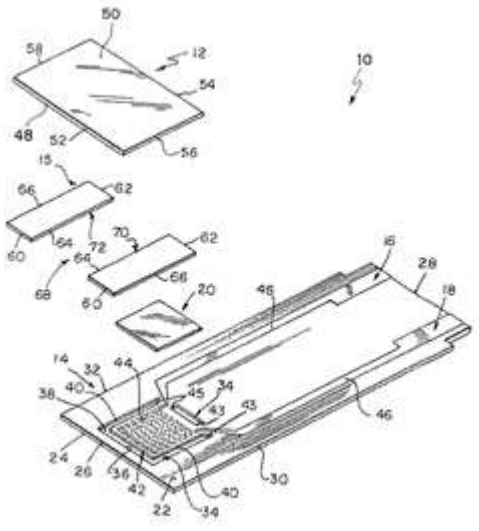
Case	"A biosensor and a set of electrodes used for the same, as well as a method to form the biosensor" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, December 22, 2010 (2010 (Gyo KE) No. 10147
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-319511 (JP 2005-37406A)
Classification	G01N 27/30
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Shuhei SHIOTSUKI, Judge: Tomoko MANABE, Judge: Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The Claimed Invention relates to a biosensor that forms a test reagent distribution having a thickness that makes a chemical reaction roughly uniform and enables accurate analysis possible. The biosensor of the claimed invention comprises a plate element having a predetermined reaction zone and a recess provided adjacent to the reaction zone. In addition, the biosensor of the present invention is provided with a test reagent placed in the reaction zone. Preferably, the recess is circumscribed to at least a part of the reaction zone.

[FIG. 1]



(2) State of the art

(i) Cited invention (Cited Invention 1): (JP H7-275251A) (Finding by the appeal decision)

"A biosensor having a structure in which two insulating substrates (1a) and (1b) are laminated to leave a space section (6) facing a reactive layer (3) having a spacer (4) therebetween, and all electrode systems and the reactive layers and the spacers are formed on the lower insulating substrate (1a), and the upper insulating substrate (1b) having a notch (11) from which a connecting terminal is disposed and a discharge vent (62) is bonded and laminated by the spacer (4) and the electrode system formed on the lower insulating substrate (1a) is composed of a lead (21), an electrode (22), a connecting terminal (23), and an insulating layer (5) and a reactive layer (3) containing biologically-relevant substances such as enzyme, etc. is provided on the electrode (22) by application of coating fluid by a dispenser, and a part that does not need to be exposed to the electrode and the lead are covered with the insulating layer (5), and the spacer (4) are formed by partial application on the lower insulating substrate as linear patterns on the both sides so that the space section (6) for causing the reactive layer to contact the sample solution and the feed port (61) and the side edge opposite the feed port open."(Cited from the Court Decision)

(ii) Citation 3 (Cited Invention 3): JP H2-001535A (Finding by the appeal decision)

"A sensing device, namely a biosensor in which a coating (32) of a test reagent such as enzyme is formed on a measuring electrode (21), and the measuring electrode (21) is surrounded by a "moat" (33) as shown in FIG. 2 is stated, ... the moat can be called a recess formed surrounding the electrode not to contact the electrode. In addition, it is stated that a sharp border for coating composition by surface tension as a function of the moat and its breadth is accurately limited to the electrode area."

(3) The Claims (Cited invention)

[Claim 1]

A biosensor comprising a first surface, a prescribed reaction zone on said first surface, a lower plate element adjoining said reaction zone on said first surface and formed to include recesses arranged at least to be circumscribed, a test reagent covered by at least a part of said reaction zone, and an upper plate element extending to cross said test reagent and acting together with said lower plate element in order to define a clearance, wherein

said clearance has an opening and has a dimension to transfer sample of fluid from said opening to the test reagent,

at least a part of said recess is located in a clearance between said opening and the test reagent, and at least one of said recesses has a width of 1000 μm,

a spacer (15) comprising a first part (70) and a second part (72) is provided between said upper plate element and lower plate element, and

opposing rims (64) extending between both ends (60, 62) of the first part (70) and the second part (72) and the second part (72) respectively form said clearance together, and each end (62) of said first part and second part are arranged spaced from an electrode array formed in said reaction zone.

(4) Procedural History

November 12, 2004 : Patent application filed (priority date of the original application: October 6, 2000, U.S.A.)

September 26, 2007	:	Amendment (Refer to "The Claims" above.)
January 10, 2008	:	Decision of refusal
April 11, 2008	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2008-9110)
December 21, 2009	:	Appeal decision to the effect that "the present appeal does not hold good"

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

<table>
<tr><td colspan="2">Appeal decision</td></tr>
<tr><td colspan="2">(Difference)
While, in Claimed Invention, the lower plate element adjoins the reaction zone on the first surface, and is formed to include recesses arranged at least to be circumscribed, and at least a part of recesses is located in a clearance between the opening and the test reagent, and at least one of the recesses has a width of 1000 μm, the invention of Publication 1 does not have such recesses.

Here, the above difference is examined.
Publication 2 states ... .
On the other hand, it is a common general technical knowledge naturally recognized by a person skilled in the art that, in a biosensor in which a reaction zone is formed by covering the electrode with coating fluid containing the test reagent, if, when the coating fluid is supplied and made spread over the electrode, the coating fluid does not spread over the entire electrode and the thickness of covering coating fluid is uneven, the test reagent exists unevenly on the electrode, and accurate analysis cannot be made.
Then, it can be said that it is a matter in which a person skilled in the art could easily achieve, in the invention of Publication 1, to form recesses as stated in Publication 2 around the electrode so that application by a dispenser to the reaction zone on the electrode is made uniformly, and to form recesses adjoining the reaction zone and at least to be circumscribed including a clearance between an opening for introducing sample of liquid and the reaction zone, and, at that time, to optimize the width of recesses to be 1000 μm in accordance with the structure of the biosensor such as the size of the reaction zone.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
B. The problem to be solved by the cited invention is to reduce cost by decreasing the space sheet, which is a constituent part, and making the structure simple, and, for that purpose, there is adopted a construction in which spacer can be omitted by printing or applying a spacer to an insulating substrate.
Since there is no statement concerning the thickness of the reactive layer in Publication 1, and</td><td>Allegations by Defendant
B. In a biosensor, it is a matter in which a person skilled in the art naturally recognizes that, if the coating fluid containing a test reagent does not spread over the whole electrode and the thickness of the coating fluid (test reagent) is not uniform, accurate analysis cannot be performed. Therefore, it is a self-explanatory technical problem to be solved to carry out accurate analysis in the technical field of analysis, and in a</td></tr>
</table>

also there is no statement to the effect that, in forming the reactive layer, processing is carried out on the lower insulating substrate or other members, it should be understood that, in the cited invention, there is no recognition on the thickness of the reactive layer, and also it is not recognized to provide other constitution to control the thickness of the reactive layer. Therefore, Publication 1 is aimed only to lower the price of the biosensor by making the structure simple, and there is no suggestion, in order to make accurate analysis possible, to provide a "recess" to make the thickness of the test reagent uniform. As stated above, since "moat" in Publication 2 and "recess" in Claimed Invention have different purposes, operations, and effects to provide such constitution, there is no motivation, in order to "form a test reagent distribution with a thickness that makes the chemical reaction roughly uniform," to make the constitution according to the "recess" in Claimed Invention by combining with the "moat" of Publication 2. C. In addition, right from the start, as of the priority date of Claimed Invention, it was not a common general technical knowledge among persons skilled in the art, in a biosensor in which a reaction zone is formed by providing the test reagent to cover the electrode, in order to carry out accurate analysis, making the thickness of the test reagent uniform. D. And, while the whole reactive layer including a pair of electrodes is covered by the test reagent in the reactive layer of the cited invention, in the reaction zone of Publication 2, only one electrode out of three is covered with the test reagent and other electrodes than one covered by coating composition are not covered by the test reagent because of the function of the moat. Therefore, since the cited invention and Publication 2 are different from each other in the	biosensor in which a reaction zone is formed by covering the electrodes with coating fluid containing the test reagent, in order to carry out accurate analysis, to providing coating fluid on the whole electrode with a uniform thickness is common general technical knowledge stated also in Exhibits B 2 and B3. Based on this common general technical knowledge, the appeal decision only discussed the possibility of application of matters stated in Publication 2 to the biosensor of the cited invention. For a person skilled in the art, it is a normal matter to repeat trial and error with respect to the structure of the sensor and to improve it, and it is nothing special for a person skilled in the art to improve the biosensor of the cited invention and make it possible to make accurate analysis. C. As stated in 1 above, both of the "recess" of the claimed invention and "moat" of Publication 2 have a technical problem to be solved to form a border for the reactive layer on the electrodes, and the number of electrodes covered by the reactive layer does not affect the essence of the technical problem to be solved. D. Therefore, as of the priority date of the claimed invention, there was a motivation to combine matters stated in Publication 2 with the cited invention to dissolve the difference.

manner of coverage of electrodes by the test reagent, there is no motivation to combine matters stated in Publication 2 with the cited invention.	

Judgment by the Court

While the biosensor of the cited invention is an apparatus to measure chemical substances such as glucose in blood (Paragraph [0001] of Publication 1) and the sensor of Publication 2 is also an apparatus to measure chemical substances such as glucose in aqueous solution (Page 1, lower right column, second line from the bottom to Page 2, upper left column, line 4), and they belong to the same technical field, it is a self-evident matter for a person skilled in the art to carry out accurate measurement and analysis with a biosensor that is an apparatus to detect the existence and concentration of chemical substances, and realization of an apparatus for carrying our accurate measurement and analysis is a natural technical problem to be solved for a person skilled in the art.

Therefore, it can be said that there is motivation to combine the constitution of the "moat" in Publication 2 with the cited invention in order to solve the above technical problem to be solved.

(2) In this regard, Plaintiff alleges that, the cited invention has no recognition of the thickness of the reactive layer, nor recognition of providing other constitution to control the thickness of the active layer, and the cited invention aims only to make the biosensor low-priced by making the structure simple, and does not suggest to provide a recess in order to make the thickness of the test reagent uniform.

Without doubt, it can be said that, according to Publication 1, Paragraphs [0004] to [0006], the problem to be solved by the cited invention is in order to provide a low-priced biosensor, to make the structure simple, and reduce the number of constituent parts, and reduce the number of manufacturing processes, and it can be said that the means for solving the problems by the cited invention is to form a spacer on one of two insulating substrates composing the biosensor by a method such as printing and omit an independent spacer sheet.

However, it is self-explanatory for a person skilled in the art to carry out accurate measurement and analysis in a biosensor that is an apparatus to detect the existence and concentration of chemical substances, and the realization of apparatus to carry out accurate measurement and analysis is a natural technical problem to be solved for a person skilled in the art.

In addition, in an extreme case in which the thickness of the test reagent on the electrode is not uniform, and it is not made spread over a part of the reaction zone or reactive layer, for example, since it is obvious that accurate measurement or analysis using such a sensor is impossible, it is hard to imagine that the inventor of the cited invention and a person skilled in the art who accessed Publication 1 do not consider the thickness of test reagent on the electrode.

...

Then, even if no statement is clearly shown with respect to the thickness of test reagent in Publication 1, it is a matter in which a person skilled in the art should consider and there is no lack of motivation to provide a hollowed part, namely a "recess" around the electrode by combining the "moat" of Publication 2 with the biosensor of the cited invention.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of the technical field, Similarity of the problem to be solved, obviousness of or easy to conceive the problem to be solved, Obstructive factor

1. Bibliographic Items

Case	"Nonvolatile memory device" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, September 29, 2011 (2011 (Gyo KE) No. 10045)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2008-98991 (JP 2008-204623A)
Classification	G11C 16/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a flash memory device having first buffer memory and second buffer memory as buffer memory for temporarily storing information to be recorded in a memory block, wherein the first buffer memory and the second buffer memory are connected in parallel between the input-output terminals and the memory block; and another write data are transferred from the input-output terminals to the second buffer memory in the middle of write data stored in the first buffer memory being transferred to a predetermined sector of the memory block, whereby consumption current which flows during erasure or writing of the entire device is dispersed timewise, and erasure and writing, or rewriting, of the nonvolatile memory device is efficiently speeded up with low power consumption.

(2) State of the Art

(i) Citation (Cited Invention): JP S63-81660A (Findings of the decision)

"...the citation discloses that there are two pieces of buffer memory in connection with operation for writing data in the "hard disk memory unit DSK" by use of the "buffer memory BUF1" and "buffer memory BUF2" connected in

parallel between the "interface circuit HINF" and the "hard disk memory unit DSK"; and that, while data equivalent of one sector transferred from one of the buffer memory are written in the sector of the memory device, the next data equivalent of one sector supplied from the host are written at high speed in the other buffer memory, thereby improving processing capability of the system." (Cited from the court decision)

(ii) State of the Art (Findings of the decision)

"...adopting "flash memory" in place of "magnetic memory," like a conventionally-used hard disk memory unit, in the technical field pertinent to the nonvolatile memory device is well known (Exhibit A15 and Exhibit B1)." (Cited from the court decision)

(3) The Claims (Amended) (only claim 7 stated) (Claimed invention)

[Claim 7] A flash memory device comprising a memory block having a plurality of sectors made up of a plurality of flash memory cells; a buffer memory for temporarily storing information to be recorded in the memory block; input-output terminals; and a read-write circuit for controlling transfer of information between the memory block and the buffer memory and between the input-output terminals and the buffer memory; wherein first buffer memory and second buffer memory are provided as the buffer memory; and the first buffer memory and the second buffer memory are connected in parallel between the input-output terminals and the memory block; and the read-write circuit instructs the first buffer memory, the second buffer memory, and the memory block to control transfer of data between the memory block and the first buffer memory, transfer of data between the memory block and the second buffer memory, and transfer of data between the input-output terminals and the first and second buffer memory, thereby transferring another write data from the input-output terminals to the second buffer memory in the course of transferring the write data stored in the first buffer memory to a predetermined sector of the memory block.

(4) Procedural History

April 7, 2008	:	Patent Application (the original filing date: March 4, 1993)
September 3, 2009	:	Decision of Refusal
January 7, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-345), Amendment (see above "The Claims")
September 27, 2010	:	The appeal decision stating that "the request for trial and appeal shall not lie."

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

Appeal Decision (cited from the Court Decision)
The claimed invention can be readily conceived by a person skilled in the art on the basis of the techniques stated in the cited invention and the well-known examples and shall be unpatentable under Article 29(2) of the Patent Act. ...The trial decision found a difference between ...the claimed invention and the cited invention...as follows: ...Difference 1: The claimed invention is a "flash memory device" in which the "nonvolatile memory

device" has "a plurality of flash memory cells." Meanwhile, the cited invention is a "hard disk memory controller and a hard disk memory unit DSK" in which the "nonvolatile memory device" is made up of "magnetic memory."

Decision

Allegations by Plaintiff

The "magnetic memory" and the "flash memory" are different from each other in terms of operation for writing data into an area where data are already written; namely, rewriting operation. Therefore, in the cited invention, it is not necessarily easy to replace the magnetic memory with flash memory. Specifically, the magnetic memory of the cited invention can implement rewriting operation simply by writing data on a sector of interest. In contrast, the flash memory of the claimed invention is different in the following points. Namely, the flash memory cannot implement rewriting operation by simply performing overwriting operation. First, contents in a memory cell of the sector of interest are erased. Second, data are written into the memory cell, whereupon rewriting operation is finally completed.

Therefore, the magnetic memory and the flash memory differ from each other in terms of rewriting operation. Rewriting operation of the flash memory is more complicated in terms of control than that of the magnetic memory. As a consequence, even a person skilled in the art encounters difficulties in employing the "flash memory" made up of the "flash memory cell" of the prior art in place of the "hard disk memory unit DSK" of the cited invention made up of the "magnetic memory." The trial decision stating that a person skilled in the art could have easily conceived this employment is accordingly unreasonable.

Allegations by Defendant

A The cited invention relates to a "hard disk memory controller and a hard disk memory unit DSK" using "magnetic memory." The cited invention shares a commonality in technical field with the known invention 1 relating to the "flash memory device," in terms of techniques pertaining to nonvolatile memory devices.

In a technical field pertaining to such a nonvolatile memory device, a technical idea of adopting "flash memory" in place of the conventionally-employed "magnetic memory" has been well known (Exhibit A15 and Exhibit B1).

Therefore, a person skilled in the art could have easily conceived a configuration pertinent to the difference 1 of the claimed invention, in consideration of the common general knowledge, by applying the technique of the cited invention, which relates to the "hard disk memory controller and the hard disk memory unit DSK" using the "magnetic memory," to the "flash memory device," such as that described in connection with the claimed invention.

B Further, the "flash memory device" is common general knowledge, and it is also common general knowledge for a person skilled in the art that the "flash memory device" requires erasure prior to rewriting operation. Therefore, a person skilled in the art could have naturally made modifications to the circuit in such a way that erasure is performed prior to rewriting, when employing the "flash memory device" in place of the "hard disk memory unit DSK" of the cited invention made up of the "magnetic memory."

Judgment by the Court

...the cited invention employs the "hard disk memory unit DSK" as a memory device. However, it is obvious that the problem that efficiently transferring data between a host and a memory device fraught with read and write operations of data in the memory device to enhance the processing capacity exists in other memory devices as well as in a hard disk memory unit.

Further, it is well known in the technical field pertinent to the nonvolatile memory device that "flash memory" is adopted in place of "magnetic memory" like a conventionally-used hard disk memory device (Exhibit A15 and Exhibit B1).

The cited invention controls transfer of data between the host and the memory device by use of two pieces of buffer memory, which is irrelevant to a difference in rewriting operation of the memory device. Hence, it is obvious for a person skilled in the art who came to know the description of the citation that the data transfer method referred to in the cited invention can also be implemented by a memory device other than the hard disk memory unit.

Accordingly, employing the "flash memory" made up of the well-known "flash memory cell" in place of use of the "hard disk memory unit DSK" in the cited invention could have easily been conceived by a person skilled in the art.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, similarity of problems to be solved, and problem to be solved is self-evident or a matter that can be easily conceived

1. Bibliographic Items

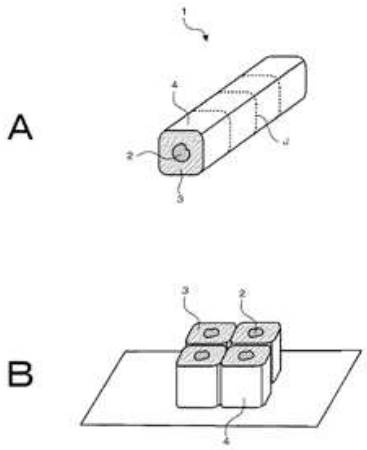
Case	"Sushi roll (*makizushi*)"(Appeal against an Examiner's Decision) Intellectual Property High Court Decision, December 14, 2011 (2011 (Gyo KE) No. 10169)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2005-38500 (JP2006-223131A)
Classification	A23L 1/10
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Tamotsu SHOJI, Judge: Toshiya YAGUCHI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is an invention relating to a sushi roll (*makizushi*) in which blue portion of pickled aubergine is used as a core of sushi roll, and its problem to be solved is to provide a sushi roll in which blue foodstuff which is highly safe, does not easily decay, and easily harvested and prepared is used as sushi filling, and, by adopting each constitution stated in Claims to solve this problem, the present invention can achieve an effect to provide sushi having clear blue color and to enrich impression of colors given by sushi.

[FIG. 1]



(2) State of the art

(i) Citation 1 (Invention of Exhibit A1): JP H8-289721A

"The problem to solve is the fact that shredded pickles are vulnerable to becoming loose, which is inconvenient for packing or preparing sushi rolls, and, in order to solve this problem, by providing sticks of pickles formed by

adding thickening agent to shredded pickles and mixing them, it is possible to prevent shredded pickles from becoming loose, and to easily pack and prepare sushi roll using such a stick as a core" (cited from the Court Decision)

(ii) Citation 2 (Invention of Exhibit A2): JP H8-173028A

"A method to obtain lightly pickled aubergine that is colored in clear blue, has no color unevenness, is crunchy, and has homogenous taste" (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] Sushi roll containing blue portion of pickled aubergine in the core

(4) Procedural History

February 16, 2005	:	Patent application files (Refer to "The Claims" above.)
April 14, 2010	:	Decision of refusal
July 16, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2006-223131)
March 29, 2011	:	Appeal decision to the effect that "the present appeal does not hold good"

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

Appeal decision
Since it can be said that a sushi roll of the cited invention containing pickles as the core has above-mentioned well-known problem to be solved of giving variety to coloration of sushi rolls, and it was a well-known matter before the filing date of the claimed invention to give variety to coloration of the core of the sushi roll to solve the problem and to use colorful pickles (such as pickled radish (*takuwan*)) as cores of sushi rolls, it is a matter in which a person skilled in the art naturally conceives to use colorful pickles for cores that give variety to coloration, trying to give variety to coloration of the sushi roll with the purpose of solving the above well-known problem of giving variety to coloration of the sushi roll, which is the above well-known problem to be solved, in the sushi roll of the cited invention having pickles in the core. On the other hand, it is stated in Publication 2 that there is pickled aubergine as one of pickles and pickled aubergine has been appreciated for its color together with its taste and clear indigo is most appreciated (Indication by excerpt (2a)), and, in addition, it was a well-known matter before the filing of the present application that the indigo color of pickled aubergine came from the skin of aubergine. Therefore, in a sushi roll containing pickles in its core of the cited invention, it is acknowledged that it was a matter at which a person skilled in the art could have easily arrived to try to give variety to coloration of the sushi roll that is a problem to be solved and, with the purpose of solving the problem, to try to give variety to coloration with cores of the sushi roll by applying the above well-known matter and to use colorful pickles as a core to give variety to coloration and to use, as a colorful pickle, the skin of aubergine having clear indigo color

(blue portion).as stated in Publication 2 and well-known before the filing of the present application.
Decision

Allegations by Plaintiff	Allegations by Defendant
(A) Error in finding concerning well-known problem to be solved The appeal decision found that it was a well-known problem to be solved before the filing of the present application to try to give variety to coloration of a sushi roll, and it is a well-known matter to give variety to coloration by cores of the sushi roll, and to use pickles as the cores, with the purpose of solving the problem to be solved. However, even if the above problem to be solved was well-known, it cannot be said that the same problem to be solved exists for the Invention of Exhibit A1. Namely, an invention concerning a stick of pickles is stated in Exhibit A1 (Paragraph [0001]), and its problem to be solved is to pack shredded pickles for aged persons with weak teeth so that shredded pickles do not get loose (Paragraphs [0002] and [0003]), but there is no statement of consideration, when manufacturing sushi rolls, for visual quality or color of completed sushi rolls. Therefore, taking the relation with the fundamental problem to be solved of Invention of Exhibit A1 and statements in Exhibit A1 as a whole, it is obvious that the finding for Invention of Exhibit A1 that the problem to be solved exists is incorrect. ... (C) Error of determination on inventive step with respect to application of Exhibit A2 to Invention of Exhibit A1 Assuming that a well-known problem to be solved exists in Invention of Exhibit A1, the appeal decision determines that a person skilled in the art could have easily arrived at to apply the well-known matter found before that and further apply the well-	... in Invention of Exhibit A1 that is an invention relating to a sushi roll for which pickles are used, it can be said that it is a matter in which a person skilled in the art could naturally make to consider coloration of cores of sushi rolls according to the scene in which the sushi rolls are provided. If any negative teaching for making such consideration is stated in Exhibit A1, this has nothing to do with the fact that Exhibit A1 does not states anything about the above well-known problem to be solved. ... Plaintiff alleges that, since there is no relation in technical fields and similarity in problems to be solved between the Invention of Exhibit A1 and Exhibit A2, there is no motivation to combine them, but, while the Invention of Exhibit A1 found by the appeal decision relates to "a sushi roll for which a stick of pickles formed by adding a thickening agent to shredded pickles and mixing them is used as a core," namely, a sushi roll in which pickles are included in the core (Finding on Invention of Exhibit A1 is correct as stated in (2) above), Exhibit A2 states that an art relating to "slightly pickled aubergine," namely "pickle," both belong to a common technical field of "pickle" or food in which "pickle" is used. And, taking into consideration that, as stated in A above, it was a well-known problem to be solved in preparing sushi rolls to arrange ingredients taking colors into consideration, and as stated in B above, taking into consideration that it is a well-known fact that bluish color of aubergine is generally accepted as coloration for food and the blue color of aubergine derives from its skin, there is no error in that the appeal decision determines that "in a sushi roll containing pickles in its core of the Invention of Exhibit A1, ... it was a matter at which a person skilled in the art could

known matter stated in Exhibit A2, but such determination is incorrect. Exhibit A1 states a sushi roll having a stick of shredded pickles formed into a stick so that shredded pickles do not become loose, and Exhibit A2 states a method of preparing slightly pickled small aubergine for improving color, texture, and taste. As stated above, however, the above well-known problem to be solved does not apply to Invention of Exhibit A1 and even if it was a well-known matter to use colorful pickle as a core for the sushi roll, it cannot be understood that there is motivation to apply the skin of pickled aubergine stated with respect to the method of preparing slightly pickled aubergine of Exhibit A2 to the Invention of Exhibit A1. In Addition, with respect to Exhibit A1 and Invention of Exhibit A2, there is no similarity of technical fields and similarity of problems to be solved, and there is no motivation to combine together matters with completely different technical ideas. ... (E) Court case ... (IP High Court, court decision in the case, 2008 (Gyo KE) No. 10096). ... if considered by applying the holding to the present case, ... there could not be any logical explanation that a person skilled in the art who accesses a sushi roll having a stick of pickles as a core and the method for preparing slightly pickled aubergine must have included blue portion of pickled aubergine in the core of the sushi roll by cutting out only the blue portion of the pickled aubergine. Exhibits A1 and A2 do not include a suggestion at all, ...	have easily arrived to try to give variety to coloration of the sushi roll as a problem to be solved and to use, as a colorful pickle, the skin of aubergine having clear indigo color (blue portion)." E. Concerning the court case (A) Even if Determination of inventive step of Claimed Invention 1 by the appeal decision is not compatible with the holding of the court decision that Plaintiff explains, this does not mean that inventive step of Claimed Invention 1 is accepted. ... it is another issue to allege lack of reasoning, but Plaintiff's allegation, based on the assumption that the appeal decision does not determine in line with the holding of a certain court decision, that inventive step of Claimed Invention 1 should be affirmed is unreasonable. There is no ground to affirm inventive step of an invention only because the cited document does not explicitly give any suggestion, etc. And, since the reasoning by the appeal decision denying existence of inventive step has no error as stated above, Plaintiff's allegation stating that no logical explanation is possible lacks grounds. (B) Court cases in which it was judged, in the cases where no problem to be solved is explicitly stated in the cited document, but the problem is self-evident or easily conceivable, that existence of inventive step of the invention is denied are as follows: Decision by Tokyo High Court, May 29, 1996 (1992 (Gyo KE) No. 142), decision by Tokyo High Court, October 16, 1997 (1995 (Gyo KE) No. 152), decision by IP High Court, September 15, 2009 (2009 (Gyo KE) No. 10003), decision by IP High Court, April 19, 2010 (2009 (Gyo KE) No. 10268), and decision by IP High Court July 27, 2011 (2010 (Gyo KE) No. 10352).
Judgment by the Court (A) Concerning "Error in finding on the well-known problem to be solved by the invention" Plaintiff alleges that, even if the problem to be solved to give variety to coloration of a sushi roll was well-	

known, the finding by the appeal decision that the problem to be solved to give variety to the coloration of the sushi roll exists in Invention of Exhibit A1 since there is no statement concerning consideration of visual quality and color of the sushi roll in Exhibit A1 is incorrect.

However, the appeal decision finds based on that it was a well-known problem to be solved to aim to give variety to the coloration of sushi roll even before the filing of the present application that the above problem to be solved exists also in Invention of Exhibit A1, which is a sushi roll having pickles in the core, but it does not find that there is a statement concerning visual quality and color of the sushi roll in Exhibit A1 itself and, because of the statement, the problem to be solved to give variety to coloration of the sushi roll exists in Exhibit A1. And, if trying to give variety to coloration of the sushi roll is a well-known problem to be solved, since it can be said that the problem to be solved to give variety to coloration of the sushi roll exists in Invention of Exhibit A1, even if Exhibit A1 does not state anything about visual quality or color of the sushi roll, the determination by the appeal decision that there is a problem to be solved to give variety to coloration of the sushi roll in Exhibit A1 has no error.

In contrast, Plaintiff alleges that, since the stick of pickles stated in Exhibit A1 is provided to solve the problem to pack shredded pickles not to become loose, and it does not involve a problem to be solved to consider coloration. However, in Paragraphs [0003] and [0004] of Exhibit A1, it is stated that the stick of pickles is for solving the problem that shredded pickles tend to become loose in making sushi rolls, and Exhibit A1 bears it in mind to manufacture sushi rolls that have a stick of pickles as their core. Then, it can be said that, even in Invention of Exhibit A1 in which sushi rolls are obtained by using sticks of pickles stated in Exhibit A1 also, a problem to give variety to coloration of sushi roll exists, and Plaintiff's allegation cannot be accepted.

(C) Concerning "error in determination on inventive step for application of Exhibit A2 to Invention of Exhibit A1"

a. As shown in (A) above, Plaintiff alleges that, since the problem to give variety to coloration of a sushi roll does not apply to Invention of Exhibit A1, even if it was a well-known matter to use pickles having clear color as the core for the sushi roll, it cannot be considered, because of that, that there is motivation to apply the skin of aubergines (egg plants) stated in relation with the method for slightly pickling of Exhibit A2 to Invention of Exhibit A1. However, as stated in (A) above, since we cannot say that "the problem to give variety to coloration of the sushi roll does not apply to Invention of Exhibit A1," Plaintiff's allegation lacks its presumption.

b. In addition, Plaintiff alleges that there is no relation in technical fields and similarity in problems to be solved between Invention of Exhibit A1 and Exhibit A2, and therefore, there is no motivation to combine the Invention of Exhibit A1 and Exhibit A2.

As stated in (3) above, however, Exhibit A2 states an art concerning a method to obtain lightly pickled aubergine that is colored in clear indigo, has no color unevenness, is crunchy, and has homogenous taste. In addition, the Invention of Exhibit A1 in which pickles are used for cores of sushi rolls and the Invention of Exhibit A2 that states an art concerning pickles belong to a common technical field of pickles or food that uses pickles. Then, there is no error in determination by the appeal decision in which Inventions of Exhibit A1 and

Exhibit A2 are considered combining them, and Plaintiff's allegation is groundless

...

(E) Concerning "court case"

Plaintiff alleges, based on the ground that the appeal decision did not determine according to the standard held in a specific court case, that the appeal decision is illegal, but, since the holding of the above court case is made in a case different from the present one, it cannot be applied to the present case as it is, and Plaintiff's allegation is groundless.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Similarity of the problem to be solved

1. Bibliographic Items

Case	"Technique for performing cooking, heating, and unfreezing by imparting heat-exchange function to ceramics using microwave of electronic oven" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 31, 2012 (2011 (Gyo KE) No. 10142)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2147, page 97
Application No.	Japanese Patent Application No. 2005-71885 (JP 2006-223782A)
Classification	A47J 27/00
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Toshiaki IIMURA, Judge: Akira IKESHITA, Judge: Eiko TAKEMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to development of a method for cooking, heating, and unfreezing that is higher in heat efficiency than conventional heating without irradiating foods directly with microwaves and by use of an electronic oven, because food components will be chemically changed with high possibility when being directly irradiated with microwaves and salty tastes will also be changed. Namely, a material having high coercive force is selected from a manganese-zinc-ferrite and a Curie temperature is also selected, and the material is powdered and applied over an entire interior surface of the ceramics in a thin film form. Being caused to absorb a microwave of 2.45 Giga-hertz, the ceramics is then heated to a high temperature within a short period of time. At this time, the manganese-zinc-ferrite causes induction heating and dielectric heating, whereupon an eddy current develops. When a material having high coercive power is selected, microwave absorption efficiency of the electronic oven is further increased, so that heating is caused with high heat efficiency.

(2) State of the Art

(i) Cited Publication 1 (Cited Invention): JP H2-271808A (Findings of the Decision)

"...when cooking is performed with a cooking container made of ceramic, potatoes, etc., are internally heated, so that a water content is vaporized to significantly destroy flavor. In light of such a conventional problem, a cooking target heating layer 14 is formed such that a ferrite material (which generates heat upon absorbing microwaves and emits infrared radiation) and a ceramic material (which permits transmission of microwaves) coexist with each other. External heating induced as a result of microwaves being absorbed by the ferrite material and dielectric heating stemming from transmission of microwaves through the ceramic material are used in combination." (Cited from the Appeal Decision)

(ii) Cited Publication 2: JP 2004-97179A (Findings of the Decision)

"...It is stated that the invention is developed as a new unfreezing technique that does not destroy flavor of an article to be cooked, or the like. It is stated that, if substances having different compositions are irradiated directly with microwaves, while being mixedly present, when being unfreezed or heated, difficulty will be encountered in unfreezing or heating the entirety of the material to be unfreezed or heated at a uniform temperature. Also, it is stated that a cause of unevenness in temperature occurred after unfreezing or heating lies in that oil and fat contents intensively absorb the microwaves, which in turn impedes unfreezing or heating of the entirety at a uniform temperature. Therefore, it is stated that, in order to heat a material by only the external heat equivalent of the Curie temperature of a sheet of magnetic substance, microwaves passed through the sheet of magnetic substance are reflected by means of a barrier, like an aluminum foil, to block the microwaves so as to avoid direct application of the microwaves on the substance. Further, paragraph [0013] states that the sheet of magnetic substance bears a heating function resulting from absorption of microwaves but does not play the function of blocking microwaves. The aluminum foil, or the like, bears the function for blocking microwaves." (Cited from the Appeal Decision)

(3) The Claims (Amended) (Claimed Invention)

[Claim 1] A method comprising: powdering a magnetic substance and magnetic ferrite; combining powders in a thin film layer such that particles are combined together; applying the thin film layer under a glaze and over an overall interior of a container and an overall interior of a cover of a ceramic; and sintering the ceramic, wherein, when the sintered ceramic is heated by microwaves of an electronic oven, the magnetic substance and the magnetic ferrite absorb microwaves; directions of rotations of electronic spins are aligned as a result of the microwaves being absorbed by the magnetic substance and the magnetic ferrite; magnetization is amplified; and a self magnetic field is induced in the thin film layer of the magnetic substance and the magnetic ferrite, by electromagnetic induction of an electric field of the microwaves; and, as a result, heating is induced by induction heating and an eddy-current loss, and a frequency of the microwaves and a frequency of magnetic substance and magnetic ferrite are substantially equal to each other and synchronized to generate ferromagnetic resonance, whereby cooking, heating and unfreezing are performed in the ceramic imparted with a heat exchange function and enhanced heating efficiency.

(4) Procedural History

March 17, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-7186)
December 20, 2010	:	Amendment (see above "The Claims")

March 15, 2011 : The appeal decision stating that "the request for trial and appeal shall not lie."

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

Appeal Decision (cited from the Court Decision)
...A person skilled in the art could easily have conceived the claimed invention on the basis of the invention stated in the "cited publication 1" (hereinafter referred to as ..."cited invention") ...distributed before filing of the claimed invention, matters stated in ..."cited publication 2"...distributed before filing of the claimed invention, and the well-known matters.... ...the difference ...between the claimed invention and the cited invention...found in the appeal decision at the time of interpretation is as follows: (a) Difference A As to the ceramic, the claimed invention is a ceramic obtained by "powdering a magnetic substance and magnetic ferrite; combining powders in a thin film layer such that particles are combined together; applying the thin film layer under a glaze and over an overall interior of a container and an overall interior of a cover of a ceramic; and sintering the ceramic." In contrast, the cited invention is "a ceramic made up of a closed-end cylindrical container body 11 and a cover 12 for opening and closing an upper opening of the container body 11. The container body 11 has two layers; an inner layer and an outer layer. The outer layer is made up of a non-radio-absorptive heat insulation layer 13 transmitting microwaves which is formed from a ceramic material, and the like, and the ceramic material is formed from ceramic powder and a binding agent by mixing, molding, and sintering. The inner layer set up to surround an inner space of a cooking container 10 is made up of a cooking target heating layer 14. The cooking target heating layer 14 is formed by mixing, molding, and sintering ceramic powder, ferrite powder which generates heat by absorbing microwaves and emits infrared radiation, and a binder for binding the ceramic powder and the ferrite powder, in such a way that the rate of absorption of microwaves is set to 50% to 70%." The appeal decision states that "a person skilled in the art could have conceived the following points of the cited publication 2 without special difficulties. Namely, in order to prevent occurrence of generation of a causal factor of cancer, which would otherwise be induced when foods are irradiated directly with microwaves, and occurrence of difficulty in unfreezing or heating foods at a uniform temperature, direct application of microwaves is hindered by blocking microwaves. Further, in connection with a portion of the microwaves passing through the cooking target heating layer 14 of the cited invention for internal heating purpose, a ceramic material of the cooking target heating layer 14 is eliminated so as to prevent transmission of the microwaves, and the microwaves are blocked by the ferrite powder, on the basis of a suggestion about heating a magnetic substance adhering to an interior and a surface of a heating container with a soft ferrite sheet by microwaves, thereby performing unfreezing or heating operation with resultant radiation heat." "The cited invention is also for reducing microwaves used for internal heating in order to solve the problem of significant deterioration of a flavor of potatoes, or the like, when the potatoes are internally heated by microwaves. In order to use only external heating for better flavor, ...a person skilled in the art could have easily conceived blocking microwaves

<table>
<tr><td colspan="2">by ferrite powder, without special difficulties...." Thus, the appeal decision interprets that "a person skilled in the art could have easily conceived the configuration of the claimed invention pertinent to the difference A."</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff

The configuration of the claimed invention pertinent to the difference A is for absorbing almost 100% of microwaves to enhance heat efficiency. It cannot be said to be easy to perform, on the basis of the suggestion stated in the cited publication 2, that the ceramic material of the cooking target heating layer 14 for internal heating in the cited invention is eliminated, and the microwaves are blocked by ferrite powder, thereby conceiving the claimed invention.

Therefore, it cannot be said that a person skilled in the art could have easily conceived the configuration of the claimed invention pertinent to the difference A from the cited invention and the invention of the cited publication 2.</td><td>Allegations by Defendant

...the cited invention is for reducing microwaves for internal heating in order to solve the problem of significant deterioration of a flavor of potatoes, and the like, by internal heating. In contrast, paragraphs [0009], [0010], [0013], [0020] of the cited publication 2 can be said to provide a suggestion about hindering direct application of microwaves by blocking microwaves and heating a magnetic substance adhering to the interior or the surface of the heating container with a soft ferrite sheet by microwaves to thereby perform unfreezing or heating with resultant radiation heat, in order to solve the problem of generation of a causal factor of cancer, which would otherwise be caused when foods are irradiated directly with microwaves, and deterioration of a flavor of an article to be cooked, which would otherwise be caused when difficulty is encountered in performing unfreezing or heating at a uniform temperature.

Consequently, the matters stated in the cited invention and the cited publication 2 are common in connection with a problem of preventing deterioration of a flavor (taste) of an article to be cooked (potatoes), which would otherwise be caused by direct irradiation of microwaves.

Therefore, in the cited invention, in order to solve the problem (challenge), the ferrite powder of the cited invention generates heat upon absorbing microwaves and blocks the microwaves in light of the suggestion of the cited publication 2, with regard to a portion of the microwaves passing through the cooking target heating layer 14 for internal heating. Therefore, it can be said that a person skilled in the art could have easily conceived eliminating the ceramic material of the</td></tr>
</table>

	cooking target layer 14 so as to prevent transmission of the microwaves and blocking the microwaves by the ferrite powder (employ only external heating); namely, eliminating clearance by bringing the ferrite powder in contact with each other.

Judgment by the Court

The cited invention solves the problem by configuring the cooking products heating layer 14 such that a ferrite material and the ceramic material coexist with each other and performing combined heating by use of external heating caused by microwaves and dielectric heating caused by infrared radiation so that the flavor of cooking products cannot be deteriorated. In contrast, the technique stated in the cited publication 2 describes microwaves are blocked with an alminum foil or the like so as to prevent the cooking products from being irradiated directly with microwaves and heating a material by means of only external heating, in order to defrost or heat the cooking products at a uniform temperature. Specifically, the techcnial feature of the cited invention lies in heating the products from inside and outside, whereas the technical feature stated in the cited publication 2 lies in blocking direct application of microwaves onto the products. Both inventions are greatly different from each other in terms of a problem to be solved and a means for solution. The cited invention does not have a necessity or motivation to heat only by means of external heating. Hence, there is no reason that it is easy to conceive, from the cited invention, the claimed invention by applying the technical matter stated in the cited publication 2.

Therefore, on the premise that a person skilled in the art could have easily conceived: eliminating the ceramic material of the cooking target heating layer 14 so as to prevent a portion of the microwaves passing through the cooking target heating layer 14 for internal heating in the cited invention; and blocking the microwave by the ferrite powder without special difficulties, the appeal decision made an interpretation, on the basis of the suggestion stated in cited publication 2, that conceiving the configuration of the claimed invention pertinent to the difference A is easy. That interpretation lacks, however, the premise and should be said to be fallacious.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42. Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, and similarity of problems to be solved

1. Bibliographic Items

Case	"Method for analyzing tendency of operation of moving object, operation control system and its constituent apparatus, and recording medium" (Trial for Invalidation) Intellectual Property High Court Decision, April 9, 2012 (2011 (Gyo KE) No. 10265)
Source	Website of Intellectual Property High Court, HANREI TIMES No. 1393, Page 303
Application No.	Japanese Patent Application No. H11-290354 (JP 2000-185676A)
Classification	G08G 1/16
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Shuhei SHIOTSUKI, Judge: Kenji FURUYA, Judge: Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to an operation control system with which dangerous behavior of a vehicle can be detected effectively, and driver's tendency of operation can be analyzed for each driver. An operation control system 1 is provided with a sensor 11 that detects behavior of the vehicle in chronological order, a recorder 13 that records the behavior detected by the sensor 11 on a memory card 20, and behavior analysis equipment 30 that sets a condition pattern for judging the behavior of the vehicle as dangerous behavior. The recorder 13 compares the condition pattern for recognizing that the behavior of the vehicle is dangerous behavior and the behavior actually detected by the sensor 11 and records information related to behaviors that fall under the condition pattern on the memory card 20 separately for each dangerous behavior, and makes it available for statistical analysis by the behavior analyzation equipment 30.

(2) State of the art

(i) Exhibit A1: JP H10-177663A (Finding by the trial decision)

"A data acquisition system equipped with a sensor detecting the behavior of the moving objects such as braking action and comprising a recording means that judges the results of comparison between the braking signal, etc. of the moving object detected by the sensor and "prescribed threshold value' as ‘an accident (signal)' and, if an accident occurs, transfers ‘driving status data' including braking signal showing the operational status and driving status of said moving object to and record in said memory card 3, and records detailed operational status data before and after the occurrence of the accident, wherein said memory card 3 is a recording medium in the form of card prepared for each classification according to "vehicle identification code" and "driver identification code" of said moving object, and since a function of a drive recorder that acquires in the fixed station various information at the time of the occurrence of the accident in which vehicle identification data and "an instruction when acquiring data' are recorded" and tachograph function in normal condition are combined in the memory card 3, the data acquisition system is very effective for control of operation status of the moving object, control of efficient delivery route, labor control, flight recorder-like use when an accident occurs, control of use of a rent-a-car (velocity, running position, etc.), analysis of results of driving in driving school, etc." (cited from the Court Decision)

(ii) Exhibit A2: JP H4-123472 U (Japanese Utility Model Application No. H3-026831)

"There is described an invention related to a data acquisition system for the purpose of grasping driving status of a vehicle in which ranks to classify the degree of acceleration and deceleration are provided, and acceleration and deceleration of the target vehicle are classified into each rank, and, by providing a means to count the number of times falling under each rank and to detect the maximum acceleration/deceleration ranks, information on history of acceleration/deceleration of the vehicle (vehicle operation data) is acquired and recorded, and, in Paragraph [0002], although it is in relation with convention art, acquired/recorded data are used to control safe driving" (cited from the Court Decision)

(3) The Claims (Claimed Invention 1)

[Claim 9]

A data recorder comprising a sensor for detecting the behavior of a moving object, and a recording means for judging whether or not any specified behavior, judged in accordance with conditions for judging certain behaviors as specified behavior, has occurred among behaviors of the moving object detected by the said sensor and recording information related to specified behavior of the moving object in a prescribed recording medium according to the occurrence of said specified behavior so that analysis of tendency of operation of said moving object becomes possible, wherein

said recording medium is a recording medium in the form of a card prepared for each classified in accordance with at least one of information for identification of said moving object, information for identification of the driver of said moving object, and a behavior environment of said moving object and records at least said conditions for judging certain behaviors therein.

(4) Procedural History

September 7, 2001	:	Patent right registered
May 20, 2002	:	Opposition to the grant of the patent
October 25, 2002	:	Demand for correction by the patentee (Refer to "The Claims" above.)
January 21, 2003	:	Decision to maintain the present patent
January 28, 2011	:	Demand for trial for invalidation by Plaintiff (Muko No. 2011-800013)
July 11, 2011	:	Trial decision to the effect that "present demand for trial does not hold good"

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

<table>
<tr><td colspan="2">Trial decision</td></tr>
<tr><td colspan="2">"Since ‘specified behavior' and ‘information related to specified behavior' of Claimed Invention 1 in Difference 1 are not stated or suggested in either of "Exhibits A2 and A3, they cannot be applied to ‘a data acquisition system' of Invention 1 of Exhibit A1, and they cannot be deemed to be a matter at which a person skilled in the art could easily arrive."
" ‘record ... so that analysis of tendency of operation of said moving object becomes possible' of the Claimed Invention in Difference 2 is not stated or suggested in either of "Exhibits A2 and A3," it cannot be deemed to be a matter at which a person skilled in the art could easily arrive." (cited from the Court Decision)</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
In Exhibit A2, tendency of operation is grasped from information on history of "dangerous behavior" such as sudden acceleration and sudden deceleration, and, in Exhibit A3 also, threshold values for speed, acceleration, etc. are set and information on tendency of operation is detected, and the technical field of Exhibits A2 and A3 is the same as that of Claimed Invention 1, and they have a common problem to be solved and purpose of invention. Therefore, it can be said that Exhibits A2 and A3 contain suggestion concerning Differences 1 and 2, and, as of the priority date of the present case, a person skilled in the art could arrive at the constitutions according to Differences 1 and 2 by applying the inventions stated in Exhibits A2 and A3.</td><td>Allegations by Defendant
"Specified behavior" used in Claimed Invention 1 means dangerous behavior such as sudden start and "tendency of operation of specified behavior" means characteristic operation different from that in normal operation such as sudden acceleration operation at the time of sudden start, and information that enables the driver to confirm that such characteristic operation has become the habit of the driver is "information related to specified behavior," and the data recorder of Claimed Invention 1 is a device that makes it possible to analyze "tendency of operation"; namely, habits of such drivers.
What is disclosed in Exhibit A2 is information on history of acceleration and deceleration in one cycle; specifically, to acquire the number of times of occurrence of acceleration and deceleration of the maximum rank, and, after occurrence of a sudden deceleration of deceleration ranks 7 and 8, no history of deceleration or acceleration is recorded in the same</td></tr>
</table>

	cycle (The next cycle begins from the next acceleration). Therefore, the information on history of acceleration and deceleration in Exhibit A2 cannot be deemed to be measured data before and after occurrence of "specified behavior" of Claimed Invention 1, and, in Exhibit A2, a technical idea to record history of operation immediately before and after the occurrence of sudden deceleration or a technical idea to record information related to "specified behavior" so that analysis of the tendency of operation becomes possible is not stated or suggested.

Judgment by the Court

2. Concerning reason of cancellation 2 (error in determination on obviousness of the constitution according to the difference between Invention of Exhibit A1 and Claimed Invention 1)

... in addition, Invention of Exhibit A1 and the invention stated in Exhibit A2 relate to a data acquisition system that acquires and records data related to behaviors of vehicles, and therefore, they belong to a common technical field.

However, the invention stated in Exhibit A2 only has a technical problem to be solved to provide a system that makes it possible to acquire driving (operational) data effective for grasping driving status of the driver without being influenced by the road conditions (Exhibit A2, Paragraph [0006]), and it does not have a technical problem to be solved to grasp operating (driving) tendency of the driver that might lead to a traffic accident. In addition, Invention 1 of Exhibit A1 has a technical problem to be solved to acquire and record data of travelling condition of the vehicle that cannot be recorded (described) by a conventional tachograph, and to acquire and record data of travelling conditions of the vehicle at high frequency (short cycle) to reproduce the status of an accident at the occurrence of a traffic accident (Exhibit A1, Paragraph [0005]), and, as stated above, it is not stated in Exhibit A1 to use data on travelling condition of the vehicle at high frequency to grasp the tendency of operation (driving) that might lead to a traffic accident by the driver and there is no statement suggesting the use in such purpose in Exhibit A1.

Then, even if the technical field is common as of the priority date of the present patent, taking the difference in technical problems to be solved, it should be judged that it is difficult for a person skilled in the art to apply the invention stated in Exhibit A2 to Invention 1 of Exhibit A1.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of the technical field, Similarity of the problem to be solved

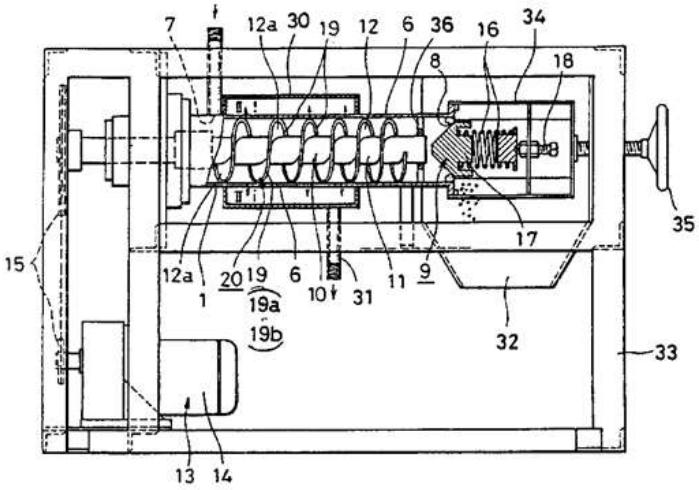
1. Bibliographic Items

Case	"Scraper filtering system" (Trial for Invalidation) Intellectual Property High Court Decision, November 15, 2012 (2012 (Gyo KE) No. 10006)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H1-107834 (JP H2-290208A)
Classification	B01D 29/25
Conclusion	Dismissal
Related Provision	Article 29(2), Article 123(1)(ii)
Judges	IP High Court Third Division, Presiding Judge: Toshifumi SHIBATA, Judge: Rika NISHI, Judge: Akira CHINO

2. Overview of the Case [FIG. 1]

(1) Summary of Claimed Invention

The claimed invention aims at providing a scraper filtering system that is free from clogging of a filter element and that exhibits a high squeezing effect and high filtering efficiency. A scraper mechanism 20 is disposed in slidable contact with the filter element 1 along an entire end face of an outer periphery of a screw-shaped impeller 12, which rotates along a periphery of the cylindrical or conical filter element 1 having desired filtering pores, and without clearance with respect to the screw-shaped impeller 12 along its front-back direction. Thus, a solid content of filtered dregs adhering to the periphery of the filter element 1 can be scraped away.



1: Cylindrical filter element
10: Screw
11: Rotation axis
12: Screw-type impeller
19: Scraper piece
20: Scraper mechanism

(2) State of the Art

(i) Exhibit A2 (Invention of Exhibit A2): JP S60-247498A (Findings of the Appeal)

"A dehydration processing apparatus dehydrates solid contents of: sludge in pollution processing facilities; solid contents of substances processed in brewing facilities, like beers, sake lees, and unrefined sake; and solid contents of foods processed in food engineering facilities, like fruits, while feeding the solid contents forwardly with the screw-shaped impeller, thereby separating a water content and the solid contents from the processed substances. In the dehydration processing apparatus, a press disc 27 capable of controlling a moisture content of the processed substances to be half solidified; namely, a dehydration rate, is disposed at an outlet of the casing 20 having a plurality of cylindrical water-draining pores 23. A cylindrical hollow shaft 30 is supported so as to be rotatable along a front-back direction within the casing 20, and a plurality of dehydration pores 32 are formed in the shaft 30. A feed impeller 31 which rotates in tight contact with an inner periphery of the casing is also provided. Cleaning water is sprayed to the outside of the casing 20 from a flush pipe disposed above the casing, thereby preventing clogging of the water-draining pores 23." (Cited from the court decision)

(ii) Exhibit A1 (Invention of Exhibit A1): US Patent No. 4,041,854 (Findings of the Appeal)

"A scraper filtering system performs filtration by applying pressure to solid aggregates, which have undergone sludge squeezing and dehydration, and pushing the aggregate toward an end, thereby separating a moisture content and a solid content from the sludge. In the filtering system, a filter-type dehydration medium 48 has a cylindrical portion and a truncated conical portion, and also has an escape passage which is formed from an annular space 58 and allows passage of liquid or filtered water but is not wide sufficiently for enabling solids to escape. A coil-spring-type wiping or cleaning blade 87 is disposed over an entire outer end of a vortex-helical shaped blade or flight 76, which rotates along an inner surface 74 of the filter-type dehydration medium 48, and without clearance with respect to the blade or flight 76 along a front-back direction thereof, so that the solid content

held by the inner surface 74 of the filter-type dehydration medium 48 can be scraped away." (Cited from the court decision)

(3) The Claims (corrected) (only Claim 1 stated) (Claimed invention 1)

[Claim 1] A scraper filtering system that performs filtration while pushing filtered dregs forwardly by application of pressure, separating a liquid content and a solid content from a filtered liquid, such as a soy bean milk solution, wherein a pressure valve capable of controlling an effect of squeezing the solid content is disposed at an outlet of a filter element having desired cylindrical or conical filtering pores; and a scraper mechanism is placed in slidable contact with the filter element along an entire outer peripheral end face of a screw-shaped impeller vane, which rotates along a periphery of the filter element, and without clearance with respect to the screw-shaped impeller vane in a front-back direction thereof, so that a solid content of filtered dregs adhering to a periphery of the filter element can be scraped away.

(4) Procedural History

January 31, 2011	:	Trial for Patent Invalidation by Defendant (Muko No. 2011-800014)
April 18, 2011	:	Trial and Appeal for Correction by Plaintiff (Patentee) (see above "The Claims")
December 1, 2011	:	The trial decision stating that the correction is admitted and that "...patent shall be invalidated"

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

Appeal Decision (cited from the Court Decision)
(B) An Identical Feature between Claimed Invention 1 and Invention of Exhibit A2 "A filtering system for performing filtration by pushing filtered dregs forwardly by application of pressure to separate a liquid content and a solid content from the filtered liquid such as a soy bean milk solution, comprising: a pressure valve capable of controlling an effect of squeezing the solid content and disposed at an outlet of a filter element having desired cylindrical filtering pores; a screw-shaped impeller vane which rotates along a periphery of the filter element; and means for preventing clogging of the filtering pores of the filter element." a Difference 3 In the claimed invention 1, the means for preventing clogging of the filtering pores of the filter element is the scraper filtering system in which "the scraper mechanism is in slidable contact with the filter element along the overall end face of an outer periphery of the screw-shaped impeller vane and without clearance with respect to the screw-shaped impeller vane along a front-back direction thereof, thereby scraping the solid content of filtered dregs adhering to the periphery of the filter element." Meanwhile, in Invention of Exhibit A2, ..."the means for preventing clogging of the filtering pores of the filter element is the filtering system which sprays cleaning water to the outside of the casing 20 from the flush pipe disposed above the casing 20, thereby preventing clogging of the water-draining pores."

In place of the means for spraying cleaning water, the scraping means using the cleaning blade stated in Exhibit A1 is applied to the means for preventing clogging of the water-draining pores in Invention of Exhibit A2, thereby realizing "the scraper mechanism which is in slidable contact with the filter element across the overall end face of the outer periphery of the screw-shaped impeller vane and without clearance with respect to the screw-shaped impeller vane in a front-back direction thereof." This is a design manner a person skilled in the art could have easily conceived.

Decision

Allegations by Plaintiff	Allegations by Defendant
...the claimed invention is a filtering system intended for extracting and squeezing a liquid content from a solid content of a food material, like a soy bean milk solution. In contrast, Invention of Exhibit A2 is ...a dehydration processing system intended solely for dehydration and totally different from the claimed invention in terms of a technical field. ...The food material is not included as a substance to be processed in Invention of Exhibit A2. Since Invention of Exhibit A2 is totally different from the claimed invention in terms of a technical field, the inventive step of the claimed invention cannot be determined by taking Invention of Exhibit A2 as a main cited invention.	...Invention of Exhibit A2, Invention of Exhibit A1, and the claimed invention 1 fall within the common technical field of "dehydration filtration." ...when a water content and a solid content are physically separated from each other, separation becomes "dehydration" when a focus is put on the solid content. Meanwhile, when a focus is put on the water content, separation becomes "filtration." Thus, choice of "dehydration" or "filtration" is relative. Therefore, Invention of Exhibit A2, Invention of Exhibit A1, and the claimed invention 1 that physically separate the water content and the solid content can be said to fall within the common technical field.

Judgment by the Court

...Invention of Exhibit A2 relates to a dehydration processing apparatus such as for sludge, and as alleged by Plaintiff, it is not intended to utilize processed substances processed as foods.

However, even when, as alleged by Plaintiff, the claimed invention is intended to extract and squeeze a liquid content from a solid content of a food material fsuch as a raw soy bean milk solution, namely, to utilize processed substances as foods, the claimed invention cannot be said to be totally different from Invention of Exhibit A2 in terms of the technical field.

..."dehydration" and "filtration" can be said to be technically common in view of separating a substance to be processed, which contains a solid content and a liquid content, into a solid and a liquid.

Further, the pressure disc of Invention of Exhibit A2 that is an invention relating to a dehydration processing apparatus such as for sludge , is equivalent of the pressure valve of the claimed invention 1. The pressure valve of the claimed invention 1 cannot be said to have the specific configuration and working effect to take a food material as a substance to be processed. There is no other evidence sufficient for judging that the claimed invention has the specific configuration and working effect to take a food material as a substance to be processed.

Then, it can be easily imagined that, regardless of whether or not the substance to be processed is a food material and whether or not the technique is intended for collecting the liquid separated from the substance to be processed and utilizing the liquid, a person skilled in the art in the technical field of the filtering system, such as that stated in connection with claimed invention 1, attempts to apply the technique in the technical field of the dehydration processing apparatus. In this sense, the technical field of the filtering system, such as that stated in connection with claimed invention 1, and the technical field of the dehydration apparatus of Invention of Exhibit A2 and the filtering-type squeezing machine of Invention of Exhibit A1 can be said to have relevance in terms of the technical field to such an extent that a person skilled in the art attempts to apply the techniques to each other.

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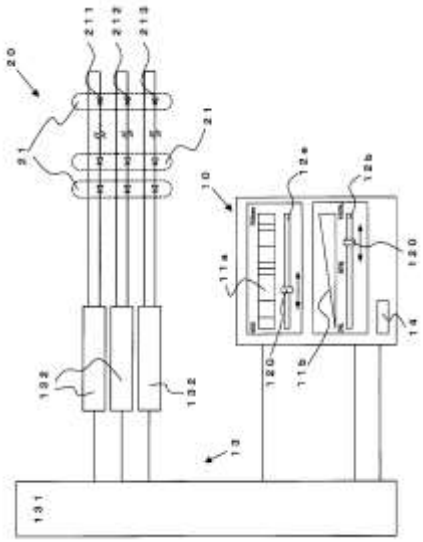
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, similarity of problems to be solved, and suggestion shown in the content of prior art

1. Bibliographic Items

Case	"Fish-luring light and method of use thereof" (Trial for Invalidation) Intellectual Property High Court Decision, December 19, 2012 (2012 (Gyo KE) No.10174)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2005-514164 (International Publication No. WO 2005/29952)
Classification	A01K 79/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Shuhei SHIOTSUKI, Judge: Tomoko MANABE, Judge: Minoru TANABE

[FIG. 4]



2. Overview of the Case

(1) Summary of Claimed Invention

A fish-luring light 1 comprises a fishing lamp 3 having a light source in which multiple light-emitting diodes with different emission colors are assembled, and a light source control device 2 that changes the light-emitted state of said light source according to operational information such as situations in the ocean areas and targeted fish type. The light source control device 2 comprises a control device 10 for setting the light-emitting state of the light source 20, and have an emission wavelength control knob 12a for changing the emission wavelength of the light source 20 and an emission intensity control knob 12b for changing the emission intensity. In addition, along with the emission wavelength control knob 12a and the emission intensity control knob 12b, an emission wavelength scale 11a and an emission intensity scale 11b are provided.

(2) State of the art

(i) Exhibit A1 (Cited Invention 1): (JP S61-039301 Publication) (Finding by the trial decision)

"An underwater light comprising a container having a light source in which a set of three LEDs; namely, LEDs for blue, red, and green respectively, is enclosed and a light color and an intensity control device for changing the color tone of the LED assembly according to fish catches by adjusting the electric current to flow to each LED according to the preset order to change the color of the light emitted from the light source as a whole" (cited from the Court Decision)

(ii) Exhibit A4 "Jasc Paint Shop Pro Version 6J) Users' Guide" (1999, Jasc Software, Inc.) pages 5, 6, 9 to 12, and 45 to 49 (Finding by the trial decision)

"A method for setting the active color comprising the following steps:

when setting the active color in the graphic software Paint Shop Pro,

start the software from the [Start] menu of Windows, Explorer or My Computer, and

when setting the color by Color Palette,

bring the mouse pointer onto the [Choose color] panel of the Color Palette displayed on the main window displayed after the start, and, with the mouse pointer changed to the form of a dropper, left-click for choosing the foreground color, or right-click to choose the background color., and

when setting the color with the [Set color] dialog box of Jasc,

carry out at least the following operations: click the foreground color or the background color on the active color panel of the Color Palette displayed on the main window displayed after the start, and, in the opened [Set color] dialog box, click the section for color in the [Basic color] box, or click the color wheel, or two-step processing of choosing the hue by dragging the ring and, then, use the [Chroma/lightness] box. "

(iii) Exhibit A5: "*Isshukande master suru Paint Shop Pro 6 for Windows* (How to master Paint Shop Pro 6 for Windows in a week)" (initial print), 2000, by Mainichi Communications Inc., pages 23, 60 to 62 (Finding by the trial decision)

"A method for setting the color, in which

color is set by carrying out at least the following operations:

when setting the color in the graphic software ‘Paint Shop Pro 6,'

if the ‘Set color' dialog box is used for setting,

click the foreground or background color panel of the active color panel in the Color Palette to display ‘Set color' dialog box and make a selection, and

if setting is carried out by clicking the ‘Choose color' panel directly,

check the color displayed on the current color panel by moving the pointer to ‘Select color panel,' and click for the foreground color, or right-click for the background color, and

said Color Palette continuously displays colors or hue starting from ‘red' through ‘yellow,' ‘green' and ‘blue' ending with ‘purple' from the top to the bottom, and, horizontally, the color changes closer to ‘white' from left to right, and it is displayed in ‘white' at the rightmost end, and,

said ‘Set color' dialog box displays a color wheel in which colors or hue are displayed starting from ‘red' through ‘yellow,' ‘green' and ‘blue' ending with ‘purple' continuously counterclockwise."

(3) The Claims (Claimed Invention)

[Claim 4]

G. A fish-luring light, comprising

A. a fishing lamp having a light source having multiple light-emitting diode assemblies formed by assembling light-emitting diodes for three colors, having emission colors of red, blue and green, and

B. an emission wavelength control knob for setting the emission wavelength of said light source, as well as

C. according to water color in the ocean area, water temperature, wind direction and wind velocity, direction and speed of tidal current, illuminance conditions, type, position and reactive action of the target of fishing, operational information such as position and behavior of fishing gears and fishing boat,

D. a light source control for continuously changing the apparent emission wavelength emitted from said light source as a whole as a composition of emitted light from diodes for three colors, red, blue and green by carrying out color matching of said light source as a whole through uniform control of the amount of luminescence of each of said light emitting diodes, when the emission wavelength of said light source is set with said emission wavelength control knob, , characterized in that

E. said light source control comprises said emission wavelength control knob for setting the emission wavelength of said light source, a wavelength scale for intuitively illustrating a light-emitting state corresponding to the set position of said control knob, and

F. a white-light switch for converting the color of light emitted from the light source into white with a single touch.

(4) Procedural History

January 11, 2008	:	Patent right registered
October 18, 2010	:	Demand for a Trial for Invalidation by Plaintiff (Muko No. 2010-880189)
January 7, 2011	:	Demand for correction by Defendant (Patentee) (Refer to the above "The Claims.")
June 15, 2011	:	The first trial decision accepting the above correction, invalidating Claims 1 to 3, and leaving Claim 4 valid.
July 25, 2011	:	The above first trial decision became final and conclusive.
October 13, 2011	:	Demand for trial for invalidation by Plaintiff (Muko No. 2011-800208)
April 11, 2012	:	Trial decision to the effect that "the demand for the present trial does not hold good"

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

Trial decision
•Difference 3 While, in the claimed invention, the light source control is equipped with a wavelength scale which intuitively illustrates a light-emission state corresponding to the set position of the emission wavelength control

knob, the Invention of Exhibit A1 does not have such constitution.

...

Due to reasons (α) to (σ) shown below, the constitutions according to Differences 3 and 4 of Claimed Invention are not matters at which a person skilled in the art could have easily arrive based on technical matters stated in Exhibits A1 to A10.

(α) None of Exhibits A1 to A10 states nor suggests the constitution according to Difference 3 of Claimed Invention. ... (σ) With the claimed invention according to Difference 3, the following effect can be obtained: 'A desired light-emitting state can be obtained quickly, by setting the control knob by checking indication on the scale. In addition, a light-emitting state can be continuously fine-tuned.' (Paragraph [0016] of the description of the present patent). None of Exhibits A1 to A10 states nor suggests such effect and it is not a matter in which a person skilled in the art could foresee."

"As discussed above, since the Claimed Invention is not a matter in which a person skilled in the art could invent based on technical matters disclosed in Exhibits A1 to A10, the patent granted for the claimed invention cannot be invalidated as not satisfying provisions of Article 29(2) of the Patent Law."

Decision

Allegations by Plaintiff	Allegations by Defendant
1. If the art is common, it should be foreseen that a person skilled in the art would consider a combination of inventions or technical matters within the scope of the technical field, and no motivation should be required. However, the fishing lights of the Invention of Exhibit A1 or the claimed invention are a mere device to illuminate the sea using a light source with high luminance with the purpose of letting fishes gather together, and the art of light-emitting diodes (LEDs) used in Invention of Exhibit A1, etc. relates closely to the art of light-emitting diodes used in a lighting system such as projector, etc. and normally parties having an art for a lighting system (included in a person skilled in the art for a lighting system) are involved in development and manufacture of fishing lights. Then, unless there is a special circumstance that the technical feature relates directly to fishing method, it should be deemed that fishing lights belong to a common technical field with a normal lighting system (lighting system other than fishing lights).	Exhibit A4 belongs to the technical field of graphic software, and it does not correspond to the technical field related to the technical problem to be solved which the "underwater light" of Exhibit A1 intends to solve. In addition, in Exhibit A1, no motivation for applying inventions or technical matters is stated in Exhibit A4. Furthermore, the color wheel of Exhibit A4 is not provided in the light source control, and the ring of Exhibit A4 is not for setting the emission wavelength of LED lights. Moreover, in Exhibit A4, a constitution in which the color is specified by taking a two-step procedure, first selecting hue using a color wheel and then selecting "Chroma/lightness" with a "Chroma/lightness" box is stated, and although it is natural that a person skilled in the art who accesses Exhibit A4 would pay attention to such procedures, it is unreasonable to judge, neglecting such procedures, that a person skilled in the art must have paid attention to a special part, a part of a color wheel. The allegation by Plaintiff is for the intent to take out a part convenient for Plaintiff among statements in Exhibit

Therefore, it is easy for a person skilled in the art to apply the invention or technical matters of the projector of Exhibit A2 that is a lighting system to the Invention of Exhibit A1. In addition, from the viewpoint that Exhibits A4, A5, and A7 also, as stated below, belong to the technical field of lighting system, and focusing attention on specific function, etc., Exhibits A4, A5, and A7 belong to the same technical field as Exhibits A1 and A2, and it is easy for a person skilled in the art to apply inventions or technical matters stated in Exhibits A4, A5, and A7 to the inventions (or, technical matters) stated in Exhibits A1 and A2. 2. Technical significance of the constituent feature E of the claimed invention, "said light source control ... said emission wavelength control knob for setting the emission wavelength of said light source, a wavelength scale for intuitively illustrating light-emitting state corresponding to the set position of said control knob" means merely that if colors of spectrum in the visible area are displayed in band form along the control knob like a scale, and if the scale is colored, the only operation necessary is to adjust the control knob according to this coloring, it is convenient to adjust the emission color (easy to carry out color matching), and is nothing special. Such technical matter belongs to a general art (elementary technology) of way of indication of the scale, and does not belong to a specific technical field such as fishing lights and color matching technology. However, the trial decision determines that none or Exhibits A1 to A5, A7, A8, A10, A17 and A21 states or suggests that the effect, "Desired light-emitting state can be obtained quickly, by setting the control knob by checking indication on the scale. In addition, light-emitting state can be continuously fine-tuned." is obtained, and it is not a matter at which a	A4 based on the constitution of the claimed invention with hindsight and is inappropriate. Therefore, it is not easy for a person skilled in the art to apply inventions or technical matters stated in Exhibit A4 to Exhibit A, or solve Difference 3 by making such application. 6. ... the mouse pointer of Exhibits A4 and A5 does not correspond to the "light-emission control knob" of the claimed invention. In addition, Color Palette, etc. of Exhibits A4 and A5 is not provided corresponding to the position of the knob, and, in the color selection panel of Exhibit A4 and A5, it is not arranged to convert to white with a single touch of a button. Color Palette and color selection panel of Exhibit A5 are different from the hue angle adjuster 12 of Exhibit A2 in which color light become white when the hue angle is 182 degrees in shape and technical structure, and there is a negative teaching to replace the above Color Palette and color selection panel with the hue angle adjuster 12. It is not easy for a person skilled in the art to apply inventions or technical matters states in Exhibit A5 to Exhibit A1, or solve Differences 3 and 4 by such application.

person skilled in the art could have easily arrived based on technical matters described in Exhibits A1 to A5, A7, A8, A10, A17, and A21 (pages 33 and 34), but, it errs in determining the technical significance of the above constituent feature E and is incorrect.	

Judgment by the Court

Since Exhibits A4 and A5 are documents related to graphic software for preparing images (files) using a computer, they belong to a different technical field from that of Invention of Exhibit A1 for collecting fishes by irradiating light from a light source in the water, and, in Exhibits A4 and A5, there is no statement or suggestion of the technical problem to be solved of Exhibit A1 that, avoiding the disadvantage of conventional fishing light that schools of fish gather together in a doughnut-like form because of avoiding the light source without getting close and, therefore, fishing efficiency is not ideal, and trying to improve fishing efficiency by letting fishes gather together more and for longer time (Exhibit A1, page 1, right lower column to page 2, right upper column), and, in addition, there is no similarity in the technical problem to be solved between them. In addition, Exhibit A1 does not state or suggest adopting the constitution of "a wavelength scale which intuitively illustrates light-emission state corresponding to the set position of the emission wavelength control knob" that continuously changes the emission wavelength of the light source in order to make the operation of change of emission color of the light source easier, and, therefore, there is no motivation for adopting such constitution for Invention of Exhibit A1. Then, it cannot be determined that it is easy for a person skilled in the art to apply inventions or technical matters stated in Exhibits A4 and A5 to the Invention of Exhibit A1.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Similarity of the problem to be solved, Suggestion based on the content of the cited invention

1. Bibliographic Items

Case	"Method for manufacturing a heat storage material" (Trial for Invalidation) Intellectual Property High Court Decision, December 12, 2012 (2011 (Gyo KE) No. 10434)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. S59-118738 (JP S60-262882A)
Classification	C09K 5/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Akihiro DOI, Judge: Makiko TAKABE, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to a heat storage material comprising sodium sulfate decahydrate as a main material, in which calcium sulfate dehydrate is used for preventing the solid liquid separation, and a supercooling inhibitor, anhydrous sodium sulfate and water, which are the other ingredients, are collectively mixed thereto and agitated to form a predetermined double salt, thereby providing an effect that the solid-liquid separation is remarkably suppressed.

(2) State of the art

(i) Cited Invention: Description of US Patent No. 4,288,338 (Identification of the Trial Decision)

"a method for manufacturing a heat storage material, comprising the steps of:
preparing a mixture of a supercooling inhibitor, anhydrous sodium sulfate, a porous solid selected from the group consisting of calcium sulfate hemihydrate and soluble calcium sulfate anhydride; and
mixing the mixture with water to agitate until the mixture solidifies" (cited from the Court Decision)

(ii) Citations 2 to 4 (Identification of the Trial Decision)

"...according to the Citations 2 to 4, ...it had been publicly-known prior to filing the present application that anhydrous calcium sulfate, calcium sulfate hemihydrate, calcium sulfate dehydrate are used as a nucleating material for preventing the supercooling ..." (cited from the Court Decision)

(iii) Well-known example

"...it can be said at the time of filing the present application to have been a common general knowledge that calcium sulfate hemihydrate and soluble anhydrous gypsum are turned into calcium sulfate dehydrate by hydration" (cited from the Court Decision)

(3) The Claims (Present Invention)

[Claim 1] A method for manufacturing a heat storage material, comprising the steps of collecting mixing and agitating a supercooling inhibitor, anhydrous sodium sulfate, water and calcium sulfate dehydrate to obtain a viscous composition.

(4) Procedural History

August 8, 1994	:	Registration of establishment of the patent right (see "The Claims" as mentioned above)
May 24, 2011	:	Request for trial for patent invalidation by the Plaintiff (Muko No. 2011-800080)
November 15, 2011	:	Trial Decision that "the request for the present trial is dismissed"

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">(1) The reason for the Present Trial Decision is that it cannot be said that the Present Invention could be easily conceivable for a person skilled in the art based on the inventions stated in the Citations 1 to 4 and the matters stated in the well-known example ...
(2) The coincidence and the difference between the Present Invention and the invention stated in the Citation 1 (hereinafter, referred to as "Cited Invention"), which had been identified in the Present Trial Decision, are as follows:
C Difference 1: as "calcium sulfate," while the Present Invention uses "calcium sulfate dehydrate", the Cited Invention uses "calcium sulfate hemihydrate and soluble calcium sulfate anhydride".
...since calcium sulfate used in the Cited Invention and calcium sulfate used in the publicly known technique stated in the Citations 2 to 4 are components which are used for separated purposes, it cannot be said that there is a motivation that the Cited Invention is combined with the publicly-known technique stated in the Citations 2 to 4 ...</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...The claims in the Present Invention does not specify any purposes for which "calcium sulfate</td><td>Allegations by Defendant
(1) if calcium sulfate dehydrate is applied instead of calcium sulfate hemihydrate in the Cited Invention,</td></tr>
</table>

dehydrate" is used in the method for manufacturing the heat storage material. Therefore, in case of determining the easiness of occurrence of the idea that calcium sulfate dehydrate is applied instead of calcium sulfate hemihydrate, when a purpose for using calcium sulfate dehydrate does not have any similarity, it is unreasonable for means for determination that there is no motivation of combining the publicly-known technique stated in the Citations 2 to 4 into the Cited Invention.	it is demanded to exert a function as a solid-liquid separating inhibitor, which is the purpose for using calcium sulfate hemihydrate, for calcium sulfate dehydrate as an alternative material. However, since calcium sulfate dehydrate in the Citations 2 to 4 is used for preventing the supercooling, there is no room that to apply calcium sulfate dehydrate is motivated instead of calcium sulfate hemihydrate in the Cited Invention, based on the description of the Citations 2 to 4.

Judgment by the Court

...the porous sold selected from the group consisting of calcium sulfate hemihydrate and soluble calcium sulfate anhydride is used for preventing the solid-liquid separation in the Cited Invention. Therefore, as stated in the Citations 2 to 4, even though it had been publicly known that calcium sulfate dehydrate is used for preventing the supercooling in various heat storage materials, in parallel to calcium sulfate hemihydrate and calcium sulfate anhydride, it should be said that there is no motivation of using calcium sulfate dehydrate, instead of the porous solid selected from the group consisting of calcium sulfate hemihydrate and soluble calcium sulfate anhydride which are used for preventing the solid-liquid separation in the Cited Invention.

...the Cited Invention ...is not of using calcium sulfate dehydrate. Rather, the Cited Invention is not to suppress the solid-liquid separation by forming the specific double salt similar to the Present Invention. ...even when calcium sulfate anhydride is used in the Cited Invention, it remains that calcium hemihydrate is formed by hydration, and there is no description and suggestion in the Citation 1 to form calcium sulfate dihydrate.

So, as mentioned above, even though it is perceived according to the description of the well-known example as the common general knowledge that calcium sulfate hemihydrate and soluble anhydrous gypsum are turned into calcium sulfate dehydrate by hydration, it should be said that there is no motivation of using calcium sulfate dehydrate instead of the porous solid selected from the group consisting of calcium sulfate hemihydrate and soluble calcium sulfate anhydride.

...while the porous solid selected from the group consisting of calcium sulfate hemihydrate and soluble calcium sulfate anhydride in the Cited Invention is used for preventing the solid-liquid separation, calcium sulfate dehydrate stated in the Citations 2 to 4 is used as the supercooling inhibitor. Accordingly, since the problems to be solved (purposes for using) do not have any similarity, it cannot be said that there is a motivation, for a person skilled in the art who reads the Citation 1, of applying calcium sulfate dehydrate instead of calcium sulfate hemihydrate. The assertion contrary to the above-mentioned matters made by the Plaintiff cannot be accepted.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of the technical field, Similarity of the problem to be solved

1. Bibliographic Items

Case	"Image shiftable zoom lens" (Trial for Invalidation) Intellectual Property High Court Decision, May 9, 2013 (2012 (Gyo KE) No. 10213)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H6-259056 (JP H8-101362A)
Classification	G02B 27/64
Conclusion	Partially accepted, partially dismissed
Related Provision	Article 29(2), Article 123 (1) (ii)
Judges	IP High Court Second Division, Residing judge Shuhei SHIOTSUKI, Judge Akira IKESHITA, Judge Takaaki SHINTANI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention aims to provide a zoom lens that includes a focusing lens group with a small lens diameter, facilitates control of an image shift, and has a good imaging performance. The claimed invention relates to such a zoom lens capable of moving some of lens groups that constitute a lens system in a direction approximately perpendicular to the optical axis to shift the image, thereby correcting the fluctuation of the image position caused by a camera shake (vibration-proofing).

(2) State of the Art

(i) Exhibit A3 (Invention of Exhibit A3) : JP H6-130330A (Approval of appeal decision)

"Invention of "a zoom lens for photograph comprising in sequence from an object side, a first positive lens group G_1 consisting of a lens combined by a negative meniscus lens that has a convex surface opposed to the object and a bi-convex positive lens, and a bi-convex positive lens; a second negative lens group G_2 consisting of a lens combined by a negative meniscus lens that has a convex surface opposed to the object and a positive meniscus lens that has a convex surface opposed to the object; a third negative lens group G_3 consisting of a lens combined by a bi-concave negative lens and a bi-convex positive lens; a fourth positive lens group G_4 consisting of a

diaphragm S, a lens combined by a bi-convex positive lens and a negative meniscus lens that has a concave surface opposed to the object, and a lens combined by a bi-convex positive lens and a negative meniscus lens that has a concave surface opposed to the object; and a fifth negative lens group G_5 consisting of a lens combined by a bi-convex positive lens and a bi-concave lens, and the zoom lens in which, at the time of magnification change, the lens groups shift such that the gap between the first lens group G_1 and the second lens group G_2 increases, the gap between the second lens group G_2 and the third lens group G_3 changes into non-linearity, the gap between the fourth lens group G_4 and the fifth lens group G_5 decreases, and the gap on the optical axis between the first lens group G_1 and the fourth lens group G_4 changes, antivibration is provided by shifting the fourth lens group G_4 in the direction approximately perpendicular to the optical axis, said fourth lens group G_4 is provided with the diaphragm, said fourth lens group G_4 and said diaphragm are shifted at the time of magnification change, and imaging magnification on an object with an infinite distance which is at an telephoto end of said first lens group G_1 is substantially zero." " (cited from the Court Decision)

(ii) Exhibit A4 (Invention of Exhibit A4) : JP S63-133119 A (Approval of appeal decision)

"Invention of "a photography lens having an antivibration function characterized in that the lens having a plurality of lens groups, among which at least one lens group F, which is behind the first lens group near the object, is shifted in the optical axial direction to perform focusing, while the lens group C arranged closer to the image surface side relative to the lens group F is off-centered, whereby blurring of the image taken is corrected."" (cited from the Court Decision)

(3) The Claims (only Claim 1 is stated) (the claimed invention 1)

[Claim 1] A zoom lens having a lens group GB as a constituent, an entirety or a part of which being shifted in a direction approximately perpendicular to an optical axis to shift an image,

the zoom lens characterized in that an aperture diaphragm S is provided in said lens group GB or adjacent to said lens group GB, a lens group GF arranged between said lens group GB and a first lens group G1 that is closest to an object is shifted along the optical axis to focus on a short-distance object, at the time of magnification change, a gap on the optical axis between said lens group GF and said lens group GB changes, and said aperture diaphragm S, at the time of magnification change, shifts integrally with said lens group GB.

(4) Procedural History

January 6, 2006	:	Registration of establishment of patent right (see the above-mentioned "The Claims")
September 13, 2011	:	Request for patent invalidation trial by plaintiff (Muko No. 2011-800167)
May 9, 2012	:	Appeal decision concluding that "....inventions directed to claims 2, 4, and 6 are invalidated.....request for patent invalidation trial on inventions directed to claims 1, 3 is not established...."

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

Appeal Decision (cited from the Court Decision)

The claimed invention 1 is not identical to Invention of Exhibit A3, and a person skilled in the art would not have arrived at the invention based on Invention of Exhibit A3, Invention of Exhibit A4, and any well-known art. Therefore, the claimed invention 1 should not be rejected on the basis of either of Article 29 (1) (iii) and Article 29(2) of the Patent Law, and Invalidation ground 2 has no reasoning.

D Difference between the claimed invention 1 and Invention of Exhibit A3

(Difference 1)

In claimed invention 1, "the lens group GF arranged between said lens group GB and the first lens group G1 that is closest to the object is shifted along the optical axis for focusing on the short-distance object" and "at the time of magnification change, the gap on the optical axis between said lens group GF and said lens group GB changes." In contrast, in Invention of Exhibit A3, which of the lens group is to be shifted for focusing on the short-distance object is not specified, and in this context, it is unclear whether, at the time of magnification change, the gap on the optical axis between the lens group GF and the lens group GB changes.

Decision

Allegations by Plaintiff

(1) The appeal decision approves that "a person skilled in the art would not usually apply the configuration of the claimed invention in Invention of Exhibit A3 to obtain such an impractical zoom lens" ..... The basis of this approval is such that "in the zoom lens having specific values as in the Example in Exhibit A3, in view of the problem that the practical image-taking distance cannot be ensured (the function is deteriorated) in the case where the second lens group G_2 or the third lens group G_3 is moved along the optical axis to focus on the short-distance object. Thus, it is understood that in the zoom lens having the data of specific values which is identical to those described in the Example in Exhibit A3, the second lens group G_2 or the third lens group G_3 is used to constitute the focusing lens groups.

However, designing a lens involves an improvement so as to obtain a desired optical performance in accordance with the description of the patent document, so in the case where focusing on a short-distance object by shifting the second lens group G_2 or the third lens group G_3 along the optical axis fails to ensure a practical image-taking distance, a

Allegations by Defendant

The appellant applies the second lens group G_2 to focusing lens group, and asserts that "starting from the data of specific values described in the Example of Exhibit A3, even when the zoom lens is used in which the wide-angle end is decreased and used in the range of f = 102 to 292 mm, the magnification change ratio of 2.86 can be ensured, so the object to increase the magnification change ratio as compared to the conventional art as in Exhibit A3 is satisfactorily accomplished.", and further asserts that "even when the value of wide-angle end in Example 1 is reduced, the object of an improved magnification change of the invention described in Exhibit A3 is secured." However, since the zoom lens of Exhibit A3 aims for an improved magnification change, even if it is considered to be possible for the Exhibit A3 to reach an higher magnification change ratio compared to that of the conventional art, it is hard to imagine that the Exhibit A3 dares to try to decrease the wide-angle end toward the opposite objective to its own teaching, aparting from the specific data shown in the Example demonstrating the numeric values of Exhibit A3.

In the zoom lens of Exhibit A3, as the appellant

person skilled in the art would try to change the design so that shifting the second lens group G_2 or the third lens group G_3 along the optical axis to allow for focusing on the short-distance object. The appeal decision does not consider whether such a design modification ensures the practical image-taking distance. The mere fact approved by the appeal decision cannot conclude that there is a factor that prevents Invention of Exhibit A3 being used to constitute the present invention 1.	asserts, in the case where the focal length of the wide-angle end is reduced to 102 mm, when the second lens group focuses to the photographing distance 2.5 m, the optical performance drastically deteriorates, which is not practically viable. When focusing is to be made using the second lens group, in particular, spherical aberration, astigmatic aberration, and coma aberration at the particularly telescopic end become greatly increased, which is impractical. Focusing with the first lens group does not deteriorate the aberration even at the telescopic end, which is practical. Therefore, even if the wide-angle end is reduced, focusing with use of the second lens group G_2 results in a change toward the deterioration that deteriorates the aberration. It cannot be considered that a person skilled in the art dares to perform such a change that is a change toward the deterioration.

Judgment by the Court

In designing lenses, it can be considered that there is a prescribed degree of freedom as to determine which lens group should be used as a lens group (a focusing lens group) that is moved along the optical axis in the case of focusing on the short-distance object....

Invention of Exhibit A3 relates to a technology of 35 mm-size photographic lens, especially of a telescopic zoom lens having an antivibration function (which performs to provide antivibration by moving in the direction perpendicular to the optical axis to obtain the antivibration function). Also, Invention of Exhibit A4 relates to a technology of photographing lens having a function correcting a blur of the image taken due to vibration by off-centering the correction lens group (i.e., by moving in the direction perpendicular to the optical axis), so called antivibration function. Thus, Invention of Exhibit A3 and Invention of Exhibit A4 have a commonality in that they belong to a technical field of a lens that correct the shift of the image position (image blurring) by shifting part of the lens group belonging to the present invention in the direction perpendicular to the optical axis.

Exhibit A3 acknowledges that the first lens group is a large-sized lens group, and is considered to have a problem that in order to drive the large-sized lens group to shift it relative to the optical axis, the drive mechanism becomes larger.

Also, Exhibit A4 also acknowledges that the first lens group is a large-sized lens group, and is considered to have a problem that in order to drive the large-sized lens group such as the first lens group to correct the blur of the image taken (i.e., to shift it relative to the optical axis), the drive mechanism becomes large-sized,

which is a problem to be overcome. Further, Exhibit A4 is considered to state that in the photographing lens, by off-centering the correction lens group, correcting a blur of the photographed image causes an eccentric aberration; in particular, changing the object distance by means of focusing causes an eccentric aberration, which results in deterioration of the optical performance.

Therefore, Invention of Exhibit A3 and Invention of Exhibit A4 are considered to have a common recognition that the first lens group is a large-sized lens group and to have a similar problem to be solved, that to drive the large-sized lens group (in order to shift I with respect to the optical axis) the drive mechanism ends up in its largeness.

In view of the above, it is considered that a person skilled in the art would have readily conceived of applying the arrangement configuration of each lens group of Invention of Exhibit A4 to Invention of Exhibit A3, and shifting the lens group arranged between the "first lens group G_1" and the "(vibration-proof) fourth lens group G_4", i.e., the "second lens group G_2" or the "third lens group G_3" along the optical axis, thereby providing a configuration that focuses on a short-distance object.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, and similarity of problems to be solved

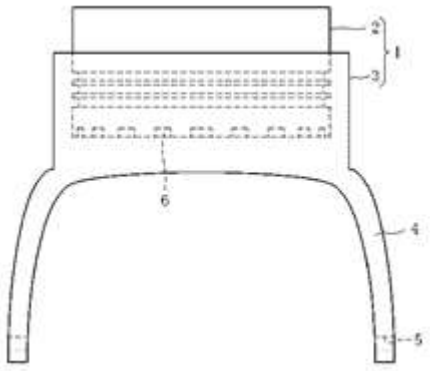
1. Bibliographic Items

Case	"Coupling device" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, September 3, 2013 (2013 (Gyo KE) No. 10034)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2009-184095 (JP 2011-38553A)
Classification	F16D 1/06
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Shuhei SHIOTSUKI, Judge:Yasushi NAKAMURA, Judge: Yuki NAKATAKE

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



The Claimed Invention relates to a coupling device in which integrity of a welded first coupling member and a second coupling member that is cast over the first coupling member can be made strong and the first coupling member's deformation and coming away from the second coupling member can be prevented. The coupling device 1 comprises a first coupling member 2 with good weldability that is connected with the object to be connected by welding and a second coupling member 3 made with cast iron formed integrally with the first coupling member 2 by casting over the first coupling member 2 in a state where a part of the first coupling member 2 is exposed, wherein the first coupling member 2 comprises an end face embedded in the second coupling member 3 and notches 6 with inner walls that extend from the outside edges of said end face toward the center and having spaces in between in the circumferential direction that become wider toward the outside edge.

(2) State of the art

(i) Publication 1 (Cited Invention): JP 2001-099367A (Finding by the appeal decision)

"A composite coupling member connected with a pipe P, wherein

said composite coupling member comprises a cylindrical part 20 with good weldability connected by welding with said pipe P, and

a body 1 made of cast iron formed integrally with said cylindrical part 20 by casting over the cylindrical part 20 with a part thereof exposed" (cited from the Court Decision)

(ii) Publication 2 (Invention of Publication 2): JP H9-168807A (Finding by the appeal decision)

"Therefore, in Publication 2, judging from the above statement, and FIGS. 1 and 6, that an end face having a superhard ring (2) embedded in cast coated metal (30) and multiple corrugated surfaces (21) with inner walls that extend from the outside edges of said end face toward the center and are formed with spaces in between in the circumferential direction that become wider toward the outside edges" is stated or suggested.

(3) The Claims (Claimed Invention)

[Claim 1]

A coupling device to be connected with an object to be connected, comprising

a first coupling member with good weldability to be connected by welding with said object to be connected, and

a second coupling member made of cast iron formed integrally with said first coupling member by casting over the first coupling member in a state in which a part of the first coupling member is exposed wherein

said first coupling member comprises an end face embedded in said second coupling member and multiple notches with inner walls that extend from the outside edges of said end face toward the center and which are formed vertically on said end face with spaces in between in the circumferential direction that become wider toward the outside edge of said end face.

(4) Procedural History

August 7, 2009	:	Patent application filed
August 24, 2011	:	Amendment (Refer to "The Claims" above.)
January 24, 2012	:	Decision of refusal
April 26, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2012-7737)
December 25, 2012	:	Appeal decision to the effect, "the demand for appeal of the present case does not hold good."

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

Appeal decision

According to the third embodiment in Publication 1 (Refer to FIGS. 4 and 5), it is stated or suggested that a circular groove 25 is provided on the outer periphery of a cylindrical part 20 and, when forming a body 1, material of the body 1 flows into this circular groove 25 and coagulates and, as a result, the coupling between the body 1 and the cylindrical part 20 in the axial direction becomes strong, and, when a pull force is applied from the connected pipe P, works as a retaining means that can lock the body 1. In addition, when the composite coupling member of the cited invention is used for a connected part of poles for traffic signage, it is a self-explanatory technical matter that, in addition to the pulling force from the pipe P to be joined applied on the joining section between the body 1 and the cylindrical part 20, a torsion (torque) is also applied by the force of gravity of the traffic signage, wind received by the traffic signage, etc., and in the composite coupling member of the cited invention, there is a technical problem that the integration between the body 1 and the cylindrical part 20 should be made stronger against torsion.

On the other hand, while technical matters stated in the cited invention and Publication 2 relate to an art to form multiple parts integrally by insert casting, judging from statements and FIGS. 1 and 6 in Publication 2, it is stated or suggested in Publication 2 that the superhard ring (2) comprises an end face embedded in the cast coated metal (30) and multiple corrugated surfaces (21) with inner walls that extend from the outside edges of said end face toward the center and are formed with spaces in between in the circumferential direction that becomes wider toward the outside edges.

In the technical field related to composite parts that form multiple parts integrally by insert casting, it is just a conventionally well-known technical means to form the shape of a part where molten material flows in when casting vertically in order to prevent slipping off or idling of the insert casting part (the circular groove 25 in FIG. 5 of Exhibit A1, and the ridge 22 in FIG. 3 of Exhibit A2).

In the composite coupling member of the cited invention, in order to make integration between the body 1 and the cylindrical part 20 against torsion (torque) stronger, it is self-explanatory to a person skilled in the art that by the Invention of Publication 2 and conventionally well-known technical means applied to the end face of the cylindrical part 20 is formed perpendicular to the end face and the spacing becomes wider as it comes closer to the outer periphery of the end face, prevention of deformation and improvement in durability can be ensured by providing such structure and receiving torsion (torque) equally on whole inner wall without concentration on the circumference side.

It cannot be recognized that effects of Claimed Invention also especially significant exceeding the sum of effects by the cited invention, Invention of Publication 2, and conventional well-known technical means.

Therefore, the claimed invention is a matter in which a person skilled in the art could easily invent based on the cited invention and Invention of Publication 2, as well as conventional well-known technical means. (cited from the Court Decision)

Decision

Allegations by Plaintiff	Allegations by Defendant
The technical field disclosed by Publication 1 has no relevancy with the technical field of coupling	In the technical field of poles for road signage, it is a matter that may be called a common general

devices to which a large torsion is applied permanently in order to transmit rotary driving torque as in a universal joint assumed by the claimed invention, and therefore, it cannot disclose or suggest any problem to be solved common with the Claimed Invention. Even if Invention of Publication 2 "relates to an art to form multiple parts integrally by insert casting," since it is merely "to prevent idling of the superhard ring (2) of the complex roll against the roll body (3), the superhard ring (2) and the roll body (3) are engaged integrally by the corrugated surface," the complex roll (mill roll) disclosed by Publication 2 has no relation of technical fields or similarity of problems to be solved with a coupling device of the Claimed Invention to be applied to objects to be connected (for example, a universal joint) on which a large driving torsion (driving torque) is applied. In addition, in the Invention of Publication 2, since both sides (both end faces) of the superhard ring (2) are sandwiched by the cast coated metal (30), it results in a technical idea of a difference in height on the corrugated surface of the end face of around 1 mm. Therefore, right from the start, the invention of Publication 2 has no problem to be solved as in the claimed invention that the first coupling member drops out from the second coupling member. Therefore, there is no motivation to apply the Invention of Publication 2 to Publication 1 (cited invention), and determination by the appeal decision 2 erred in its determination of obviousness.	technical knowledge for a person skilled in the art that a torsion applied on a structural object such as poles (Exhibits B1 to B3), and judging from such common general technical knowledge, when the composite coupling member of the cited invention is used for poles for road signage, it is self-explanatory for a person skilled in the art that torsion around the pipe shaft center is applied to the joining section with the pipe, and, taking into consideration that the composite coupling member stated in FIGS. 9 to 11 of Publication 1 in which molten metal flows into the through-hole and coagulates has a structure that can resists such torsion as a coupling member used for poles for road signage, it can be said that "a technical problem to be solved to make integration between the body 1 and the cylindrical part 20 against torsion (torque) stronger indwells in the composite coupling member of the cited invention" as determined by the appeal decision. This technical problem to be solved that indwells in this cited invention is common with the problem to be solved by the Claimed Invention that "even if a load such as torsion, etc. is applied, ... make integrity between the first coupling member and this first coupling member strong." Allegation by Plaintiff focusing only on the third embodiment of Publication 1 (FIGS. 4 and 5) and not taking into consideration the statement on the example in which the cited inventions shown in other FIGS. 9 to 11 are used for poles for road signage and common general technical knowledge, and that it cannot be said that technical problem to be solved indwells in the cited invention is not justifiable. ... The Invention of Publication 2 aims to make "the superhard ring (2) not idle against the roll body (3)" and ensure "integral rotation of the ring and the roll body (3)," and it can be said that the real purpose is that, while relative torsion is applied between the ring

	(2) and the roll body (3), the irregular of the end surface of the ring is for irregularity those two members in the direction of rotation counteracting such torsion. In addition, it can be said that as far as the claimed invention assumes that the coupling device to which torsion is applied widely, Invention of Publication 2 and the claimed invention are common in that they have a technical problem to be solved to integrate two members in the direction of rotation against torsion relatively applied between two members.

Judgment by the Court

As stated above, the invention of Publication 2 relates to a roll to be used for rolling of steel wires and rods, etc. and belongs to a different technical field from that of the claimed invention and the cited invention which belong to the technical field of a coupling device. In addition, even if the superhard ring 2 of Invention of Publication 2 can be called a cylindrical form, the configuration structure of the superhard ring 2 of the invention of Publication 2 and the roll body 1 (cast coated metal 30) is different from the configuration structure of the first coupling member (cylindrical part 20) and the second coupling member (the body 1) of the claimed invention and the cited invention, and, since the superhard ring 2 is completely embedded in the roll body, it is a structure in which the superhard ring 2 does not come out from the roll body 1, and has a different problem to be solved from that for the cited invention that requires integration of the body and the cylindrical part in order to prevent slipping off that can lock the body when pulling force or compressive force is applied.

Then, even if the cited invention and Invention of Publication 2 are common in that they relate to an art related to composite parts that form integrity of multiple parts by insert casting, it cannot be said that a person skilled in the art could easily conceive to apply the Invention of Publication 2 to the cited invention. Since the cited invention and the Invention of Publication 2 differ from each other not only in technical fields they belong, but also apart from each other in their problems to be solved, it is not easy for a person skilled in the art to recognize from statements in Publication 2 that they are common in the technical problem to be solved to integrate two members in their direction of rotation against the torsion relatively applied between multiple members and it is difficult to find any motivation to apply Publication 2 to the cited invention, and it cannot be said that it is a matter which could be easily invented.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, and similarity of operations or functions

1. Bibliographic Items

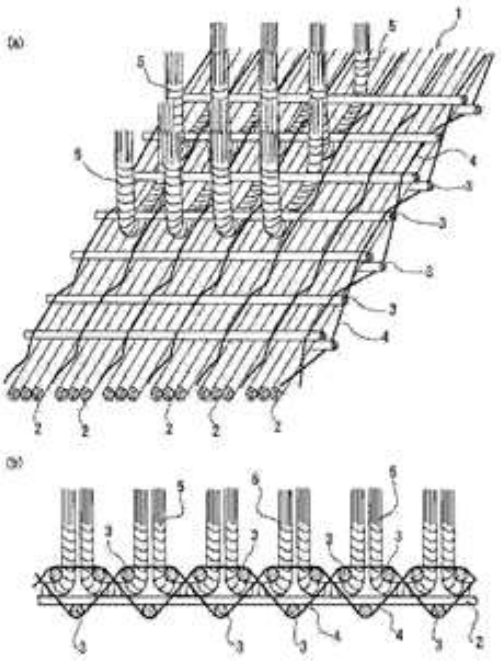
Case	"Antistatic multifunctional carpet" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, September 30, 2013 (2012 (Gyo KE) No. 10361)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2011-36862 (JP 2011-139908A)
Classification	A47G 27/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Ryuichi SHIDARA, Judge: Masaya TANAKA, Judge: Atsuki KAMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

The Claimed Invention relates to an antistatic multifunctional carpet in which an antistatic function to efficiently remove static electricity generated in the human body has been improved, and which exercises efficient deodorizing function, PH control function, and antibacterial function. In a tufted carpet, hook carpet, or Wilton carpet, an antistatic yarn made of a conductive fiber is included in a pile yarn together with a deodorizing yarn. In the case of Wilton carpet, by arranging chain yarns in a row, and sandwiching the chain yarns from the top side and the back side with weft yarns crossing the chain yarns and, at the same time, binding upper and lower weft yeans with a binding yarn, all weft yarns and chain yarns are caused to contact in a crossing state with each

[FIG. 1]



other, antistatic yarns are mixed with a prescribed rate of an antistatic yarn for a prescribed number of chain yarns, and at the same time antistatic yeans are combined with all weft yarns.

(2) State of the art

(i) Cited Publication 1 (Cited Invention 1): JP 2002-010900 (Finding by the appeal/trial decision)

"In a tufted carpet in which conductive acrylic fibers comprising conductive fibers formed by introducing copper sulfide in acrylic fibers are included in the pile yarns,
an antistatic carpet in which conductive acrylic fibers comprising conductive fibers formed by introducing copper sulfide to acrylic fibers are included in pile yarns of the tufted carpet" (cited from the Court Decision)

(ii) Cited Publication 2 (Cited Invention 2): JP 2001-271252 (Finding by the appeal/trial decision)

"A pile fabric having an antistatic effect, and antibacterial and deodorizing effects in which pile yarns are formed by doubling conductive fibers formed by coating surfaces of acrylic or Nylon fibers with copper sulfide (digenite) by very thin coating layer and acrylic fibers and polyester fibers"

(3) The Claims (Claimed Inventions)

[Claim 1]

An antistatic multifunctional carpet prepared as a tufted carpet by including antistatic yarns comprising conductive fibers formed by coating copper sulfide on the surface of acrylic fibers or Nylon fibers to pile yarns, and, at the same time, including deodorizing yarns to which a carboxyl group that deodorizes ammonia and trimethylamine through ionic bond is introduced to pile yarns, characterized in that antistatic yarns comprising conductive fibers formed by coating the surface of acrylic fibers or Nylon fibers with copper sulfide are included in pile yarns of said tufted carpet in an amount of 0.2% and, at the same time, deodorizing yarns are also included in an amount of 10%.

(4) Procedural History

February 23, 2011	:	Filing of the patent application (Filing date of original application: August 11,2009)
September 2, 2011	:	Amendment (Refer to above "The Claims/")
September 16, 2011	:	Decision of refusal
December 16, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-27256) Amendment
September 7, 2012	:	The above amendment is rejected; appeal decision determining that "the present demand for appeal does not hold good."

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

Appeal decision
(Difference 1) The point that, while conductive fibers that compose antistatic yarns are formed by coating the surface of acrylic fibers or Nylon fibers in the claimed invention, they are formed by introducing copper sulfide to acrylic

fibers in Cited Invention 2.

...

(Concerning Difference 1)

Since Cited Invention 2 relates to "a pile fabric having an antistatic effect and antibacterial and deodorizing effects in which pile yarns are formed by doubling conductive fibers formed by coating acrylic or Nylon fibers with a very thin coating layer of copper sulfide (digenite) and acrylic fibers and polyester fibers," it can be said that, in Cited Invention 2, "conductive fibers that forms antistatic yarns are formed by coating the surface of acrylic or Nylon fibers with copper sulfide" and Cited Invention 1 and Cited Invention 2 belong to the same technical field of pile yarns that contain conductive fibers, and it is a matter at which a person skilled in the art could have easily arrived to apply Cited Invention 2 to Cited Invention 1 and modify it to realize the matter specifying the invention according to the above Difference 1.

...

Decision

Allegations by Plaintiff	Allegations by Defendant
... while the claimed invention and Cited Invention 1 relate to an invention concerning a tufted carpet, Cited Invention 2 does not relate to any invention concerning a tufted carpet. Namely, while a tufted carpet in general means a carpet of a structure in which piles are inset using sewing needles into a backing in the manner of embroidery (machine embroidery), and piles are secured on the back side by coating the back side with an adhesive (latex, etc.) in order to prevent dropping off of the piles, the pile fabric of Cited Invention 2 is manufactured by doubling conductive fibers and acrylic fibers and polyester fibers to form pile yarns, and inweaving feathers of the pile yarns to the surface of cloth at predetermined spacing, and does not have a structure to secure the pile yarns by applying an adhesive to the back side of the cloth, and therefore, does not fall under a tufted carpet. Since there are various types of carpets, and they are classified by material, manufacturing method, and use, and a unique manufacturing method has been established, it is inappropriate from a technological point of view to combine Cited Invention 1, which is	The appeal decision determines that Cited Invention 2 is applied to Cited Invention 1 as a technique, "conductive fibers composing antistatic yarns are pile yarns formed by coating the surface of acrylic fibers or Nylon fibers with copper sulfide." Since there could be a motivation to apply the construction of the conductive fibers of Cited Invention 2 to the constitution of conductive fibers composing the pile yarns of Cited Invention 1, there is no error in the determination by the appeal decision on Difference 1.

a technique for tufted carpets, with Cited Invention 2, which is a technique for pile fabric that is different from tufted carpet, and there is no motivation to apply Cited Invention 2 to Cited Invention 1. Therefore, the determination by the appeal/trial that such combination is a matter which could be easily arrived at is not reasonable.	

Judgment by the Court

Plaintiff alleges that a unique manufacturing method has been established for each type of carpets, and it is inappropriate from the technological point of view to combine Cited Invention 1 that is a technique for tufted carpets with Cited Invention 2 that is a technique for pile fabric that is different from the tufted carpets, and therefore, there is no motivation for such a combination.

It is true that, while Cited Invention 1 relates to an antistatic tufted carpet in which conductive fibers are included in pile yarns, and the conductive fibers composing antistatic yarns are formed by introducing copper sulfide into acrylic fibers, Cited Invention 2 relates to pile fabrics having an antistatic effect and antibacterial and deodorizing effects in which pile yarns are formed by doubling conductive fibers formed by coating the surface of acrylic or Nylon fibers with a thin covering layer of digenite, a type of copper sulfide, and acrylic fibers and polyester fibers (Exhibit A20).

However, the tufted carpet according to Cited Invention 1 and the pile fabric according to Cited Invention 2 are common in that both of them are textile products formed by using pile yarns, and also in that, by using conductive fibers formed to include copper sulfide as pile yarns, an antistatic property is obtained.

Then, in Cited Invention 1 related to an antistatic property tufted carpet, in order to have the antistatic property, as conductive fibers to be included in pile yarns, using one formed by coating the surface of acrylic fibers or Nylon fibers of Cited Invention 2 with digenite that is a type of copper sulfides in place of one formed by introducing copper sulfide to acrylic fibers is a matter at which a person skilled in the art could have easily arrived.

Even if there is a difference in manufacturing methods for each type of carpets as pointed out by Defendant, it is not recognized that such a fact directly affects the problem as to how to produce conductive fibers by giving the antistatic property to pile yarns composing the carpet, and it cannot be concluded that applying the technique related to conductive fibers used in pile yarns for pile fabrics to the pile yarns of tufted carpets is inappropriate from the technological point of view. Since the tufted carpet of Cited Invention 1 and the pile fabric of Cited Invention 2 are common in that they are textile products formed by using pile yarns, and that conductivity is acquired by using conductive fibers formed by adding copper sulfide in pile yarns, it should be recognized that there is sufficient motivation to adopt the constitution of the conductive fiber of Cited Invention 2 in place of the conductive fiber of Cited Invention 1.

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Relevant	Part III, Chapter 2, Section 2, 3.1.1

portion of Examination Guidelines	
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, and similarity of operations and functions

1. Bibliographic Items

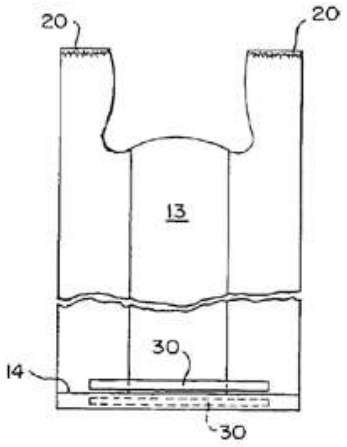
Case	"Plastic bag with gussets" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 31, 2013 (2013 (Gyo KE) No. 10078)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-559768 (National Publication of International Patent Application No. 2003-525177)
Classification	B65D 33/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Takashi SHIMIZU, Judge Akira IKESHITA, Judge: Takaaki SHINTANI

2. Overview of the Case

(1) Summary of Claimed Invention

The Claimed Invention relates to a plastic T-shirt bag including an extruded plastic tube-like form having gussets on the sides and a seal line (14) at the bottom. The junction point (24) between an inward crease and the seal line (14) is the weakest area in the bottom part of the bag. A reinforcing tape (30) is provided to extend across these two weak areas to absorb force applied when something is put into the bag.

[FIG. 14]



(2) State of the art

(1) Cited Document 1 (Cited Invention 1): U.S. Patent No. 4812055, statement (finding by appeal/trial decision)

"A bag made of heat plastic resin 10 shaped after undershirts having a tube made with a heat plastic resin film having gussets on the sides in which each gusset has an inward crease, a heat seal 18 intersecting with the inward crease at the bottom of the bag and handles 22 formed on the gusset portions of the bag 10, provided with a sealed area 26 for reducing the tendency that a junction point 24 between the inward crease and the heat seal 18 at the

bottom of the bag when something is put into the bag 10" (cited from the Court Decision).

(ii) Cited Document 2 (Cited Invention 2): Microfilm for Japanese Utility Model Application No. S56-014737 (JPS57-129050 U) (Finding by appeal/trial decision)

"In a plastic bag, to prevent breakage of the seal line that has low strength and is breakable with a reinforcing tape that is a reinforcing means separated from plastic films adhered overlapping the seal line", (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1]

A plastic T-shirt bag having a tube of a plastic film having gussets on the side parts in which each gusset has an inward crease and a seal line intersecting with the inward crease at the bottom of the bag and handles formed on the gusset portions of the bag, wherein a reinforcing means bonded to the bottom part of the bag is provided to extend across each of said inward creases, located adjacent to said seal line or overlapping the seal line, separately from said plastic film, and said reinforcing means is not bonded to the portions where handles of the bag is formed, and said reinforcing means reduces the tendency of weakening of the junction point between said inward crease and said seal line when something is put into the bag.

(4) Procedural History

February 15, 2001	:	Patent application filed (priority date: February 15, 2000, USA)
February, 22, 2011	:	Decision of refusal
June 30, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-14005), Amendment (Refer to the above "The Claims")
November 5, 2012	:	The above amendment was refused; appeal decision to the effect that "the present demand for appeal does not stand good"

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

Appeal decision
Since Cited Invention 1 and Cited Invention 2 have a common problem to be solved to prevent breakage of the part with low strength and is breakable of a plastic bag, it is a matter in which a person skilled in the art could easily make in Cited Invention 1, in place of or in addition to the sealed area 26, to bond the reinforcing means of Cited Invention 2 to the bottom portion of the bag where the seal line exists so that it overlaps the seal line and is provided to extend across the junction point with each inward crease having low strength and is breakable.
Decision

Allegations by Plaintiff	Allegations by Defendant
The purpose of Cited Invention 1 is not to directly "reinforce" the junction point 24 that has low strength and is breakable but to disperse and lessen the stress applied to the junction point 24. Namely, Cited Invention 1 is based on an idea to solve the problem of low strength and vulnerability to breaking of the junction point 24 of the inward crease and the seal line by distributing and lessening the stress applied on the junction point 24. And, its means for solving the problem is to provide a sealing area 26 in a position remote from the junction point 24. In contrast to this, in Cited Invention 2, against the problem to be solved that "as the cause of this breakage of bag, ... since the border area of the heat-sealed part 3' becomes thinner along the heat-sealed part 3', strength of this part becomes smaller and this part becomes breakable," the purpose of Cited Invention 2 is to prevent "the thickness of the border area from decreasing along the border of the heat-sealed part." In addition, for the problem to be solved and the purpose of the invention, there is provided a means to solve the problem that two reinforcing tapes are bonded totally to the bag itself beforehand and, then, inner sides of the bag 1 are heat-sealed over the reinforcing tape 2. To try to lessen the stress of the junction point when the gussets are expanded is a problem to be solved inherent to T-shirts bags having side gussets, and, since the structure of Cited Document 2 does not have any gusset, there could not be any common problem to be solved with Cited Invention 1 from a structural point of view. As stated above, Cited Invention 1 which consistently shows the means to provide a sealed area 26 in a position remote to the junction point 24 in order to lessen the tendency that the junction point that have low strength and is breakable becomes weaker,	Since both of Cited Invention 1 and Cited Invention 2 relate to a plastic bag, they belong to a common technical field and have a common problem to be solved to make a portion of the heat-sealed part where it has low strength not breakable. As stated above, Cited Invention 1 and Cited Invention 2 belong to the same technical field and have a common problem to solve, and, in addition, when multiple means exist for solving a prescribed technical problem, since it is ordinarily done to replace or overlap them, a person skilled in the art who could know of the matters stated in Cited Document 1 and Cited Document 2 simultaneously could have easily surmised, in place of "the sealed area 26 to be provided in a position remote to the junction point 24" that is the means to solve the problem of Cited Invention 1 or in addition to "this sealed area 26," to adopt "a means in which, after bonding a reinforcing tape that covers the whole of the part to become the heat-sealed part having low strength to the outer surface of the bag itself, to heat-seal over the reinforcing tape," that is the means to solve the problem of Cited Invention 2, and take measures to reinforce with the “reinforcing tape 2" including the part to become "junction point 24." In addition, while the sealed area 26 of Cited Invention 1 has working effects to lessen the stress on the junction point 24, the reinforcing tape 2 stated in Cited Document 2 also, as one of such working effects, disperses the force applied on the heat-sealed part and decreases risk of breakage of the heat-sealed part (Refer to the statement of the present application, page 5, line 18 to page 6, first line). Then, since the sealed area 26 of Cited Invention 1 and the reinforcing tape 2 stated in Cited Document 2 have a common working effect to disperse and lessen the stress applied on the weak heat-sealed part, it can be deemed that there is a

and Cited Invention 2 in which, before providing a heat-sealed part that has low strength and is breakable, such part is reinforced with a reinforcing tape 2, have completely different means to solve the problem. Therefore, it cannot be accepted that there is motivation for a person skilled in the art to combine two prior arts as such neglecting an idea consistently stated in Cited Document 1.	stronger motivation to combine the technique stated in Cited Document 2 with Cited Invention 1.

Judgment by the Court

Since both of Cited Invention 1 and Cited Invention 2 relate to a plastic bag, they belong to a common technical field, and have a common problem to be solved in that a weak portion of the heat-sealed part of the bag makes hard to break. In addition, while the sealed area 26 of Cited Invention 1 has a working effect to lessen the stress on the junction point 24, the reinforcing tape 2 of Cited Invention 2 also has a working effect to disperse the force applied to the heat-sealed part with the reinforcing tape 2 and make the heat-sealed part less breakable (Refer to the statement, page 5, line 18 to page 6, first line). Therefore, it can be said that the sealed area 26 of Cited Invention 1 and the reinforcing tape 2 of Cited Invention 2 have a common working effect in that the stress applied on the weak heat-sealed part is dispersed and lessened.

In addition, when multiple means to solve the problem are known for a predetermined technical problem, it is normally carried out to replace a certain means to solve the problem with another means to solve the problem, or to use a different means to solve the problem together with a certain means to solve the problem as an exercise of ordinary creative activity expected of a person skilled in the art. Then, a person skilled in the art who could know the matters stated in Cited Document 1 and Cited Document 2 simultaneously could have easily surmised, in place of "the sealed area 26 to be provided in a position remote from the junction point 24" that is the means to solve the problem of Cited Invention 1 or in addition to "this sealed area 26," to adopt "a means, after bonding a reinforcing tape that covers the whole of the part to become the heat-sealed part having low strength to the outer surface of the bag body, to heat-seal over the reinforcing tape," that is the means to solve the problem of Cited Invention 2, and take a means to reinforce with the reinforcing tape 2" including the part to become "junction point 24."

(42)-18

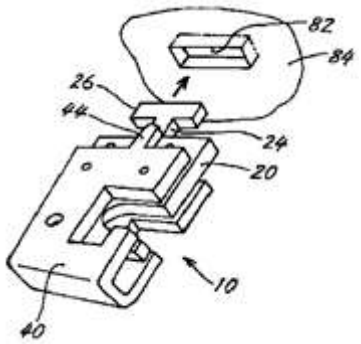
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, and similarity of problems to be solved

1. Bibliographic Items

Case	"Connector for protection against theft for devices such as a personal computer" (Trial for Invalidation) Intellectual Property High Court Decision, November 21, 2013 (2013 (Gyo KE) No. 10033)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-139328 (JP 2001-323705A)
Classification	E05B 73/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Yoshinori TOMITA, Judge: Ichiro OTAKA, Judge: Yoshiki TANAKA

2. Overview of the Case

[FIG. 6]



(1) Summary of Claimed Invention

"With the purpose ... to provide a cable connector for protection against theft for devices such as a notebook-type personal computer that can be easily mounted with a single hand, ... by adopting a configuration in which the main plate and the auxiliary plate are engaged relatively slidably by sliding forward the auxiliary plate in the direction of insertion into the slit or the direction of projection of the insertion member and the two plates are held undetachably as a means to solve the above problem, ... there can be realized the working effect that the connector can be mounted to the slit by grabbing the connection with a single hand and inserting the slip-off preventing member of the main plate into the slit and turning it 90° and pushing the turning preventing member of the auxiliary plate into the slit so that it overlaps the slip-off preventing member " (cited from the Court Decision).

(2) State of the art

(i) Citation 1 (Cited Invention 1. Exhibit A8 Invention in the trial decision): National Publication of International Patent Application No. H10-513516 (Finding by the trial decision)

"A lock interface 55 for protecting the portable computer 5 against theft that is engageable with the wall 10 through the slot 15 formed on the wall 10 of the portable computer 5, comprising

a fixed spindle 200 in the form of a plate and a lock spindle 240 in a form very closely resembling a plate, wherein

the fixed spindle 200 has a body part 205, and the body part 205 comprises a hole 210, two engaging members 215 and 220, a neck 225, and a head 230, wherein the engaging members 215 and 220 are formed on the vertical part 2 side of the fixed spindle 200, and

the lock spindle 240 has a body part 245, and the body part 245 comprises a hole 250, two engaging members 255 and 260, and a lock pin 265, wherein the curves of the lock spindle 240 constitutes the engaging members 255 and 260, and

when operating, the user matches the head 230 of the fixed spindle 200 to the slot 15 of the wall 10, and inserts the head 230 into the slot 15, and, then, by rotating the fixed spindle 200 to make the head 230 and the slot 15 mismatch each other, the head 230 and the inner surface of 20 of the wall 10 engage with each other, and, by this action, the removal of the lock interface 55 from the computer 5 is blocked, and, then, the lock pin 265 of the lock spindle 240 is inserted into the slot 15 to prevent re-matching of the head 230 of the fixed spindle 200 and the slot 15, and, on this occasion, by the engaging members 215 and 200 of the fixed spindle 200 sliding on the engaging members 260 and 255 of the lock spindle 240, the lock spindle 240 and the fixed spindle 200 engage with each other, and, furthermore, the lock mechanism 30 having a cable 35 and a lock 40 is inserted into the hole 210 of the fixed spindle 200 and the hole 250 of the lock spindle 240 to maintain engagement between the fixed spindle 200 and the lock spindle 240 and is used for locking the computer 5 to a fixture" (cited from the Court Decision).

(ii) Exhibit A12 (JP H7—20111 U)

Exhibit A12 states an art relating to a thin cosmetic case comprising a thin body 3 having a depressed portion for storage 2 to store cosmetics 1 on the upper surface and a cover 4 covering the upper surface of said thin body 3 by slidably engaging with said thin body 3 ([0005]), and, in order to prevent dropping off of the cover 4 by external force in the process of distribution, a "function to prevent dropping off" for preventing dropping off by forming a depressed portion for locking 31 in a groove 5 of the thin body 3, and a salient for locking 44 corresponding to the depressed portion for locking 31 on the fitting member 43 of the cover 4 is provided at the front and the rear parts of the thin case of cosmetics to stop at a predetermined position at both of a closure position and an opening position ([0011], [0012]) (cited from the Court Decision).

(iii) Exhibit A13 (JP H8-104321A)

Exhibit A13 states an art relating to a portable pill case in which half-open and full-open status can be easily created so that taking in and out as well as storage of objects (pills) can be carried out simply and reasonably ([0001] to [0004]) and the case comprises a body 2 and a drawer case 3 removably mounted on one side of the body 2

([0006], [0007]), wherein a pair of engaging projections 10, 10 are provided in an upward direction at the opposed positions in the inner surface of the edge of the opening side of the lower body 2B of the body 2, and, a protrusion 14 having a roughly arc-like engaging surface is provided on the outer surface at the intermediate portion of the sidewall 11 of the drawer case 3, and the protrusion 14 is arranged engageable with the engaging projection 10 and the drawer case 3 can be half-opened, and, furthermore, by pushing or pulling strongly the drawer case 3, it slips through the engaging surface of the projection 10 and make those engagement releasable, and an engaging projection 15 protrudes outwardly more than the protrusion 14 at the rear end of the sidewall 11, and the projection 15 is engageable with the engaging projection 10 during the full-opening operation of the drawer case 3 and makes it possible to maintain the full-open state of the drawer case 3 through those engagements ([0010] to [0012]). (cited from the Court Decision).

(iv) Exhibit A14 (Japanese Utility Model Publication No. S11-38362)

Exhibit A14 states an art relating to a pocketable case for cigarettes, toothpicks, etc. in which an inner box 2 is inserted into an outer case 1, a rotatable cover 5 is provided on the sidewall of the inner box 2, and a slot 9 extending in the direction of sliding of the outer case 1 is formed on the outer case 1, and a knob 10 for operating the inner case provided on the inner case 2 is engaged in the slot 9, wherein the knob 10 is operated within the slot 9 to slide the inner case 2 or the outer box 1 and operation of opening and closing the cover 5 is carried out by putting in or out legs 6 and 7 of the cover 5 to notches 11 and 12 of the outer box 1 (cited from the Court Decision).

(v) Exhibit A51 (JP H11-104002A)

Exhibit A51 states an art relating to a key holder in which, by inserting an assembling pin into a fitting hole formed on the inner side of a slide plate of a cap into a sliding slit formed on the holder ([0005]), the holder can be used without detaching the cap ([0004])(cited from the Court Decision).

(vi) Exhibit A52 (JP S61-112990U)

Exhibit A52 states an art relating to a case for leads for a mechanical pencil in which a stopper projection and stopper groove are engaged with each other, and the cover is made slidable to the case but undetachable (cited from the Court Decision).

(vii) Exhibit A53 (Registered Utility Model No. 3019866; issued on January 12, 1996)

Exhibit A53 states an art relating to a threefold metal for leather bands in which two mating plates 1c and 1d are held slidably but undetachably by engaging a pin fixed to the mating plate 1d with a slot formed in the mating plate 1c (cited from the Court Decision).

(viii) Exhibit A54 (JP H6-38813A)

Exhibit A54 states an art with respect a decoration band in which a rivet fixed to a spring band 18 engages with a slot formed in a spring band 17, and the spring bands 17 and 18 are held slidably but undetachably (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1]

A connector for protection against theft to be inserted in a slit (82) for protection against theft provided in a casing (84) of a device such as a personal computer (80), characterized in that

a main plate (20) and an auxiliary plate (40) are engaged with each other relatively slidably along the direction of insertion into the slit (82) and both plates (20) and (40) are held undetachably,

the main plate (20) comprising a base plate (22), an insertion member (24) provided to protrude at the end of said base plate (22) and a slip-off preventing member (26) provided to protrude toward the end of the insertion member (24), wherein

the auxiliary plate (40) comprises a slide plate (42) slidably engaged with the main plate (20) along the protruding direction of the insertion member (24) of said main plate (20), and a pair of turn stopper pieces (44) (44) provided to protrude at the end of the slide plate (42) to overlap with each other with the insertion member (24) sandwiched in between when the slide plate (42) is slid in the direction of protrusion of the insertion member (24) and release the overlapping with the insertion member (24) when slid reversely, and

locking sections (28) and (48) are formed in the main plate (20) and the auxiliary plate (40) at positions where they correspond to each other in a state in which the auxiliary plate (40) is slid forwardly and the insertion member (24) and the turn stopper piece (44) are overlapped with each other.

(4) Procedural History

May 28, 2004	:	Patent right registered (Refer to the above "The Claims.")
December 7, 2011	:	Demand for trial for invalidation by Plaintiff (Muko No. 2011-800253)
March 8, 2012	:	Demand for correction by Defendant (Refer to the above "The Claims.")
December 17, 2012	:	Trial decision to the effect that "Correction is accepted. Demand for the present trial does not hold good."

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

Trial decision
Since an article of daily use such as a cosmetic case and a pill case or cigarettes case in arts exemplified by Demandant belong to technical fields obviously different from the technical field of a connector for protection against theft (a connector for protection against theft comprising a main member and an auxiliary member to be inserted into a slit for protection against theft provided on the casing of the body of a device such as a personal computer and relatively slidable in the direction of insertion into the slit) of the Invention of Exhibit A8, even if the art for articles of daily use such as a cosmetic case and a pill case, a cigarette case, etc. relate to goods everybody accesses daily, it should be recognized from such fact alone that there is no motivation for a person skilled in the art to apply the art to the connection for protection against theft of the Invention of Exhibit A8.

In addition, even if the art for articles for daily use alledged by Demandant is applied to the connection for protection against theft of Invention of Exhibit A8 as it is, while the connector for protection against theft (a connector for protection against theft comprising a main member and an auxiliary member to be inserted into a slit for protection against theft provided on the casing of the body of a device such as a personal computer and relatively slidable in the direction of insertion into the slit) that is the object of the present case is, in fact, of such small size that it can be grabbed with a single hand, but operation to mount to a slot (slit) with both hands is difficult (the corrected statement of the present case, [0003]), if "an art of articles for daily use having two members composed to be slidably engageable and undetachably" deemed as a well-known art is applied to the Invention of Exhibit A8, although it is preferable that, in the work to mount, the operation to engage the main plate and the auxiliary plate can be omitted, but handling characteristic when mounting the connector for protection against theft of the Invention of Exhibit A8 to a slot (slit) (in particular, the fact that the connector for protection against theft can be grabbed by a single hand smoothly and operated in a state in which the main plate is protruded) of the Invention of Exhibit 8 cannot necessarily be ensured (even a person skilled in the art cannot judge on the actual handling characteristic unless carrying out trial manufacturing, etc.). Therefore, it should be considered that a person skilled in the art would not consider to try applying "an art of articles for daily use having two members composed to be slidably engageable and undetachably" deemed as a well-known art as it is to the connector for protecting against theft of the Invention of Exhibit A8 in a situation where there is no prospect that handling characteristic is ensured.

Therefore, in the Invention of Exhibit A8, a person skilled in the art could not easily get the constitution of Difference 2 (slidably engaging the main plate and the auxiliary plate, at any time, and making them undetachable by applying an art that includes sliding and undetachability) by applying "an art of articles for daily use having two members composed to slidably engageable and undetachably" deemed as a well-known art.

Decision

Allegations by Plaintiff	Allegations by Defendant
... Cited Invention 1 relates to a connector for protection against theft to be inserted into a slot provided on a device such as a personal computer, and it is a device to be used by slidably engaging members with each other. Therefore, a person skilled in the art who tries to improve Cited Invention 1 would, from the viewpoint of improvement in the lock mechanism, try to apply techniques in the technical field of connectors to be inserted into a slot provided on a device such as a personal computer, but, from the point of view of improvement other than lock	In Cited Invention 1, a structure in which the fixed spindle 20 and the lock spindle 240 are usually detached, and they are fitted together only when used, and the two members are used separately is adopted and mounting and dismounting are realized through this. Exhibits A12 to A14, and A51 to A54 have a structure in which the members cannot be separated and, since they are arts different from Cited Invention 1, there is no inevitability to modify Cited Invention 1 that uses a method in which members are usually separated from each other and fitted together only

mechanism; for example, improvement in handling characteristic and prevention of loss, it is possible to try application of various techniques concerning devices to be used by slidably combining members. In the working example of FIG. 7 of Citation 1, a fixed spindle 200 and a lock spindle 240 are engaged with each other in advance, and, when starting to use, locking operation can be performed by maintaining engagement of the two members by sliding the lock spindle 240 as it is. Citation 1 does not state at what time point the two members are engaged with each other, and does not have any statement to exclude advance engagement of members. Therefore, the working example in FIG. 7 of Citation 1 has a constitution in which the fixed spindle 200 and the lock spindle 240 are detachable, but, when used for its original purpose as a lock, it is indispensable that the two members are slidably engaged with each other, and, since the two members are not for the purpose of detaching, a structure in which they are undetachable can be adopted for improvement in handling characteristic, etc. Then, not limited to connectors for protection against theft, in devices composed of separate, independent components not intended for detaching, improvement in handling characteristic, prevention of disengagement, prevention of loss, etc. are self-evident problems to be solved. Arts in Exhibits A12 to A14 and A51 to A54 are common to Cited Invention 1 in that members are used by slidably engaging with each other, and since it is aimed to improve handling characteristic and prevent loss by holding members slidably but undetachably, they can be applied to Cited Invention 1. In particular, in Exhibits A51 to A 54, structures in which a pin and a slot (or a slit) are engaged with each other and two members are slidably engaged but undetachably held are	when used to a method in which members are undetachably held and engaged slidably by applying those arts, and, since there is no statement or suggestion in Citation 1 on such modification, there is a jump in technology and negative teaching in such modification. Although Plaintiff alleges that Exhibits A12 to A14 and A51 to A54 are common to Cited Invention 1 in that members are slidably engaged, members of Cited Invention 1 are slidably engaged with each other only when they are used and they are usually handled separately, and there is no common point as Plaintiff alleges. Arts disclosed in Exhibits A12 to A14 and A51 to A54 belong to technical fields different from the technical field of Cited Invention 1, and since there is no statement or suggestion of their applicability, it cannot be easily conceived to apply the above arts to Cited Invention 1 and make Claimed Invention 1.

specifically illustrated and it is easy to apply them to Cited Invention 1 as they are or with necessary modification. Then, a person skilled in the art can, in a step before trial manufacturing, find a structure easily applicable to Cited Invention 1 from well-known/commonly-used arts, and have his/her own prediction that handling characteristic is ensured even without trial manufacturing.	

Judgment by the Court

3. Concerning Cause of Cancellation 2, "Error in determination on obviousness of Claimed Invention 1 in Ground for Invalidation 2 (Lack of inventive step)(Part 1)(Application of well-known/commonly-used art)"

... in an article in which members are slidably engaged as disclosed in Exhibits A12 to A14 and A51 to A54, even if the structure in which members are slidably but undetachably engaged with each other by engaging a pin and a slot or a slit is a well-known/commonly-used art, the arts disclosed in the respective pieces of documentary evidence belong to different technical fields from that of Cited Invention 1, which belongs to the technical field of connectors for protection against theft and have a different technical problem from that of Cited Invention 1 and, in addition, the problem to be solved by the invention, purpose of the invention, means to solve the problem, basic configuration and mode of use, etc. are different from those for Cited Invention 1, and, therefore, it should be deemed that there is no motivation to adopt the constitution in which .the fixed spindle 200 and the lock spindle 240 are held undetachably by applying such arts to Cited Invention 1. Therefore, it cannot be deemed that it is easy for the person skilled in the art to apply the arts disclosed in Exhibits A12 to A14 and A51 to A54 to Cited Invention 1.

(42)-19

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of technical fields, similarity of operations or functions, and suggestions shown in the content of cited invention

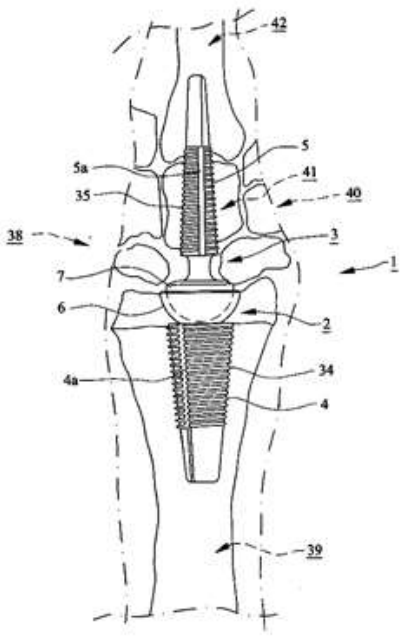
1. Bibliographic Items

Case	"Use of tools for screws for joint prosthesis and members thereof" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, November 21, 2013 (2013 (Gyo KE) No. 10053)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-555056 (National Publication of International Patent Application No. 2008-529653)
Classification	A61F 2/30
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Yoshinori TOMITA, Judge, Ichiro OTAKA, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



The claimed invention relates to a joint prosthesis, comprising two prosthesis members (2 and 3) adapted to be arranged for different bones (39; 41 and 42) of a joint (38), and the prosthesis members (2 and 3) include first and second screw-like members (4 and 5) adapted to be screwed to the bones (39; 41 and 42) respectively. One prosthesis member (2) includes a member (6) having a socket section and the other prosthesis member (3) includes a member (7) having a head section, the socket member (6) has a mounting pin (22) which can be inserted into a first hole (10) provided on the first screw-like member (4) for arranging or positioning the socket member (6), and the head member (7) has a mounting pin (27) which can be inserted into a first hole (11) provided on the second screw-like member (5) for arranging or positioning the head member (7). The first and second screw-like members (4 and 5) have at least one inner second hole (30 and 33 respectively) designed so that a rod (31) of a tool for screw (32) can be inserted in order to screw the first and second screw-like members (4 and 5) to the bones (39; 41 and 42) respectively. The second holes (30 and 33 respectively) are provided at the bottoms (17 and 19 respectively) of the first holes (10 and 11 respectively).

(2) State of the art

(i) Citation 1 (cited invention): U.S. Patent No. 5147386 (Finding by the trial decision)

"A prosthesis appliance comprising first prosthesis members (11 and 19) and second prosthesis members (13 and 17) adapted to be placed to the metacarpal bone and the phalange, wherein

each prosthesis member comprises a metacarpal body 11 and a phalange body 13 adapted to be screwed to each of the above bones, and

the second prosthesis members (13 and 17) comprise a hinge stem 17 having a socket 27, and said first prosthesis members (11 and 18) comprise a hinge body 19 having a ball end 21,

said hinge stem 17 has an elongated part 23 that can be inserted into a receiving chamber 38 of said phalange body 13 in order to arrange or position the hinge stem 17,

said hinge body 19 is a prosthesis appliance having an elongated part 33 that can be inserted into a receiving chamber 35 of said metacarpal body 11 in order to arrange or position the ball end 21, and

said metacarpal body 11 and phalange body 13 have an external conic shape and further have threaded parts (45 and 47)."

(ii) Citation 2: National Publication of International Patent Application No. 5-509006 (Finding by the trial decision)

"A prosthetic device applied for a joint to which a hexagonal section to which an Allen key for removing the prosthetic device in non-screwed state is mounted in the axis section"

(3) The Claims (Claimed Invention)

[Claim 1]

A joint prosthesis having two prosthesis members (2 and 3) adapted to be arranged to different bones (39; 41 and 42) of a joint (38),

each prosthesis member (2 and 3) comprises first and second screw-like members (4 and 5) adapted to be screwed to each of said bones (39; 41 and 42) respectively,

one prosthesis member (2) comprises a socket member (6) having a socket section and the other prosthesis member (3) comprises a head member (7) having a head section,

said socket member (6) has a mounting pin (22) which can be inserted into a first hole (10) provided on said first screw-like member (4) for arranging or positioning the socket member (6), and

said head member (7) has a mounting pin (27) which can be inserted into a first hole (11) provided on the second screw-like member (5) for arranging or positioning the head member (7), wherein

the first and second screw-like members (4 and 5) have at least one inner second hole (30 and 33 respectively) designed so that a rod (31) of the tool for screw (32) can be inserted in order to screw the first and second screw-like members (4 and 5) to each of said bones (39; 41 and 42),

said second holes (30 and 33 respectively) are provided at the bottoms (17 and 19 respectively) of the first holes (10 and 11 respectively),

said first and second screw-like members (4 and 5) are provided with through-holes (36 and 37 respectively) extending in the axial direction at the bottom of said second holes (30 and 33 respectively) so that each of said first and second screw-like members (4 and 5) is mounted on the guide line (43) mounting on each of said bones (39; 41 and 42) and have an external conic shape and are also provided with an external screw thread (34 and 35 respectively) and have no screw thread on extension parts (4a and 5a) extending in the axial direction of the first and second screw-like members (4 and 5) in order to divide the external screw threads (34 and 45 respectively) into several screw thread sections.

(4) Procedural History

February 13, 2006	:	Patent application filed (Priority date: February 16, 2005/Switzerland)
February 10, 2011	:	Decision for refusal
June 15, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2011-12814) Amendment (Refer to "The Claims" above)
October 15, 2012	:	The above amendment rejected appeal decision to the effect that "the present demand for appeal does not hold good"

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

Appeal decision

(Difference 1)

While in the corrected invention of the present case, the first and second screw-like members (4 and 5) have at least one inner second hole (30 and 33) designed so that the rod (31) of a tool for screw (32) can be inserted in order to screw the first and second screw-like members (4 and 5) to each of bones (39; 41 and 42), and

the second hole (30 and 33 respectively) are provided at the bottom (17 and 19 respectively) of the first hole (10 and 11 respectively), it is not clear whether or not the cited invention has such matter specifying the invention.

...

Cited Publication 2 describes "a prosthetic device applied for a joint to which a hexagonal section to which an Allen key (tool for screw) for removing the prosthetic device in a non-screwed state is mounted in the axis section," and the invention stated in Cited Publication 2 and the cited invention are common in that both of them relate to prosthesis, it is a matter in which a person skilled in the art could easily make to apply the invention stated in Cited Publication 2 to the cited invention. And, on that occasion, it is a matter in which a person skilled in the art could properly make to arrange the second holes (30 and 33 respectively) for the tool for screw to be provided at the bottom (17 and 19 respectively) of the first holes (10 and 11 respectively).

Decision

Allegations by Plaintiff	Allegations by Defendant
... since inventions relate to means to solve the problem in the prior art, whether or not the patented invention could be easily arrived at should be determined depending on whether or not a common problem to be solved is found in the cited publication, and even if the technical field is common, it cannot be said that they are sufficient as motivation to make the invention unless there is a common problem to be solved. But, the hexagonal section 30 in the prosthetic device stated in Citation 2 is a configuration added to the shaft section 21 (FIG. 7 in Appendix 3), and is used when insertion and drawing back in the shaft direction by the screw section 25 provided on the shaft section 21 are made possible. On the other hand, in the joint prosthesis stated in Citation 1, since there is no configuration to correspond to the screw section 25 of Citation 2, Citation 1 and Citation 2 have no common problem to be solved. In addition, in	A. Self-tapping means to create a female screw by screwing in, or to have such function (Exhibits B2 to B4). The self-tapping thread 45 of the cited invention is formed for the purpose of screwing into a bone, and the metacarpal body 11 and the phalange body 13 have a self-tapping thread 45 for screwing into a bone. On the other hand, according to the statement in Citation 2, "FIG. 6 shows an exploded view of a prosthetic device 20 for a thigh bone of the working example of the present invention. The prosthetic device 20 comprises ... a shaft section 21. ... when the shaft section is screwed into the position already explained, a helical screw for each of the screw sections 24 and 25 applies a tension to the wall of the marrow cavity of the bone," (Page 5, upper left column, lines 13 to 20), since it is obvious that the screw sections 24 and 25 of Citation 2 are for the purpose of screwing into a bone, the prosthetic device 20 of Citation 2 is to be screwed into a bone.

Citation 1, there is no suggestion of application of the configuration of "hexagonal section" stated in Citation 2 to the joint prosthesis stated in Citation 1, and, therefore, there is no motivation for such application. In fact, in the joint prosthesis stated in Citation 1, the receiving chamber 35 for the metacarpal body 11 that corresponds to the first hole of the Corrected Invention is formed deeply in the metacarpal body 11 (FIGS. 6 and 7 of Appendix 2), and, if a hexagonal section should be provided in the deeper position in this receiving chamber 35, since strength of the end of the metacarpal body 11 is drastically decreased, it is difficult to believe that such application is made actually. But, since the receiving chamber 38 of the phalange body 13 is formed in a rather shallow position, it cannot be said that it is impossible to provide any hexagonal section; however, if a hexagonal section is provided in the receiving chamber 38, a hexagonal section is provided only on one phalange body 13, and no hexagonal section is provided on the other metacarpal body 11, and this is unreasonable. Therefore, since it cannot be said that it is a matter which a person skilled in the art could have easily made to apply the configuration of "hexagonal section" stated in Citation 2 to the joint prosthesis stated in Citation 1 to make the configuration of Corrected Invention according to Difference 1, the above determination of the appeal decision is incorrect.	Therefore, the metacarpal body 11 and the phalange body 13 of the cited invention and the prosthetic device 20 of Citation 2 are common in that they are joint prostheses to be used as replacement of a joint and, at the same time, are functionally common in that they are screwed into a bone. In addition, in the metacarpal body 11 and the phalange body 13 of the cited invention, receiving chambers 35 and 38 for mounting the elongated part 33 of the hinge body 19, the hinge stem 17 and the elongated part 23 of the hinge stem 17 are provided, and, on the other hand, in the prosthetic device 20 of Citation 2 also, since the a female screw-like indentation 28 for mounting the male screw-like portion 29 of the elbow part 22 is provided on the shaft section 21, the metacarpal body 11 and the phalange body 13 of the cited invention and the prosthetic device 20 of Citation 2 are common in structural feature that a member which is screwed in a bone has a first hole to which a mounting pin of the other member is inserted. According to the above statements, since the metacarpal body 11 and the phalange body 13 of the cited invention and the prosthetic device 20 of Citation 2 are common in technical field, function, and structure, it can said that there is sufficient motivation for a person skilled in the art to apply the configuration of "hexagonal section" stated in Citation 2 to the cited invention. B. In this regard, Plaintiff alleges that, since the receiving chamber 35 of the metacarpal body 11 of the cited invention is formed deeply, if a hexagonal section should be provided in the deeper position in this receiving chamber 35, since strength of the end of the metacarpal body 11 is drastically decreased, it is difficult to conceive to apply the configuration of the "hexagonal section" stated in Citation 2 to the cited invention.

	However, since the receiving chamber 35 of the metacarpal body 11 of the cited invention is formed to mount the elongated part 33 of the hinge body 29, and it is sufficient if the receiving chamber 35 and the elongated part 33 are configured to have complementary shapes, there is no reason to require the receiving chamber 35 to be formed deeply in the metacarpal body 11 as Plaintiff alleges. In addition, the same as the receiving chamber 38 of the phalange body 13, with respect to the receiving chamber 35 also, there is no reason to obstruct to adopt a configuration to provide a hexagonal section. Therefore, Plaintiff's allegation described above is not justifiable.

Judgment by the Court

2. Concerning Reason for Cancellation 2 (Error in determination of obviousness of Difference 1)

...

(3) Concerning obviousness of Difference 1

A. According to (1) and (2) above, it is recognized that [1] the artificial joint of Citation 1 and the prosthetic device 20 of Citation 2 belong to the common technical field in that they are joint prostheses used for replacement of joint of a bone, and [2] The metacarpal body 11 and the phalange body 13, which are constituent members of the artificial joint of Citation 1 and the shaft section 21, which is a constituent member of the prosthetic device 20 of Citation 2, have a common function to be screwed in a bone from an end, and, a "hole" for mounting other constituent member (in the metacarpal body 11 and the phalange body 13, receiving chambers 35 and 38 for mounting the elongated part 33 of the hinge body 19 and the elongated part 23 of the hinge system 17, and, in the shaft section 21, female screw-like indentation 28 for mounting the male screw-like portion 29 of the elbow part 22) is provided on the other end.

And, in Citation 1, although there is no statement that directly states specific means to screw the metacarpal body 11 and the phalange body 13 into a bone, there is a statement suggesting that a tool such as screw driver (tool for screw) is used for screwing into a bone for the metacarpal body 11 and the phalange body 13.

Then, it is acknowledged that, for a person skilled in the art who accesses Citations 1 and 2, there is a motivation for applying the configuration of the hexagonal section (internal hole) to which the Allen key is provided in the prosthetic device of Citation 2 having common technical field, function and structure as a means to screw the metacarpal body 11 and the phalange body 13 of the artificial joint of Citation 1 into a bone, and it is easy to conceive, by applying this, to provide internal holes (constitution of Corrected Invention according to Difference 1) designed so that a tool for screw can be inserted at the bottom portion of the receiving chamber 35 of the metacarpal body 11 and the receiving chamber 38 of the phalange body 13 respectively.

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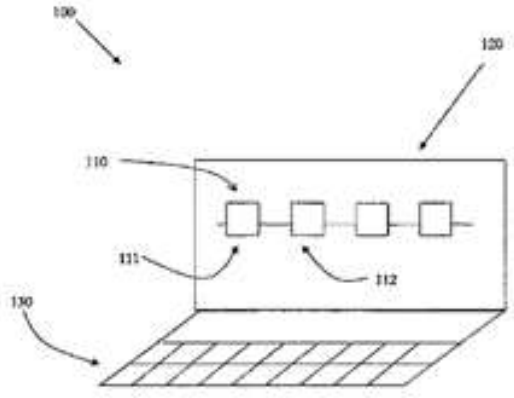
Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relevance of technical field, Similarity of problem

1. Bibliographic Items

Case	"An electronic device with incorporated antenna" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 30, 2014 (2012 (Gyo KE) No.10416)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2008-519211 (National Publication of International Patent Application No.2008-545327)
Classification	H01Q 21/08
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Toshiaki IIMURA, Judge: Kimiko YAGI, Judge: Shinji ODA

2. Overview of the Case

[FIG. 1]



(1) Summary of Claimed Invention

The claimed invention relates to an electronic device of personal utilization that has, at least, a first main surface (120, 610) and further has a first antenna (110, 620) for the purpose of communication between itself and a second party through electromagnetic waves. Said antennas are array antennas that have, at least, a first antenna element (111) and a second antenna element (112) and that are arranged on said first main surface. It is appropriate that said electronic device (100) is a portable computer with a lid (120) capable of being opened and closed. Said first main surface constitutes said lid, and the antenna (110) is arranged on the lid of said portable computer.

(2) State of the art

(i) Citation 1 (Cited Invention 1) : JP H4-503133A (Finding of Trial Decision)

"A communication device having, at least, a first patch array for communication between a communication device and a counterpart through electromagnetic waves, said patch array constituting a flat antenna array having, at least, a first patch and a second patch, and a communication device having said antenna array,

said antenna array having a first beam inlet and a second beam inlet,

each of said beam inlets being connected with each one of beams of said antenna array, each of the beams being connected with the respective beam inlets, being different from each other, antenna beams being in the number of 2n, signals from said beam inlets being made capable of being used on said communication device" (cited from the Court Decision)

(ii) Citation 2 (Cited Invention 2) : JP 2001-102848A (Finding of Trial Decision)

"A laptop computer, having a back of a display section and a planar antenna for communication between the computer and a system transceiver through radio waves, said planar antenna constituting a flat antenna array, said antenna array being arranged on the back of the display section, and being made capable of using signals whose interference is reduced by receiving radio waves of the system transceiver."

(3) The Claims (Amended) (Claimed invention)

[Claim 1]

An electronic device (100, 600) for personal utilization, comprising: at least, a first main surface (120, 610), and further, at least, a first antenna (110, 620) enabling communication between a computer and a second party by using MIMO through electromagnetic waves, and said antenna constituting a flat array antenna having, at least, a first antenna element (111) and a second antenna element (112), said array antenna being arranged on said first main surface,

said antenna (110, 620) having a first connection port (222) and a second connection port (223),

each of said ports being connected with respective beams (232, 233) of said antennas, each of beams being not related to said ports, in the form of MIMO beams in the number of N and antenna beams in the number of M, with a relation of M□N being established, the highest quality of signals from said ports being used in said electronic device.

(4) Procedural History

July 4, 2005	:	Filing of Patent Application
December 8, 2010	:	Decision of Refusal
April 12, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-7716), Amendment of Proceeding (See Above "The Claims")
July 20, 2012	:	The trial decision that "the request for appeal is dismissed"

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">Cited Invention 1 and Cited Invention 2 relate to a common technical field of antenna arrays and also have a common problem that communication is carried out by turning beam direction through a flat antenna. Thus there is no special impediment when applying said Cited Invention 2 to said Cited Invention 1. Therefore, by making said Cited Invention 1 to be a laptop computer where an array antenna is arranged on the back of a display section in such a way as described in said Cited Invention 2, a person skilled in the art could easily conceive of creating an electronic device for personal utilization that has, at least, a first main surface and has an array antenna arranged on said first main surface and of making the first antenna serve for communicating between the laptop computer and a second party.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
Cited Invention 1 relates to microstrip patch antenna that is beneficial for application in aircraft and spacecraft. If said Cited Invention 1 is used as a communication device, it is not easy to make said Cited Invention 1 to be a laptop computer where array antenna is arranged on the back of a display section, similarly as the claimed invention.</td><td>Allegations by Defendant
Plaintiff alleges that, even if Cited Invention 1 is certified as a "communication device," it is not easy to make such a communication device as equipped with aircraft or spacecraft to be a laptop computer where an array antenna is arranged on the back of a display section. However, since the array antenna in Cited Invention 1 has light weight and a flat shape, a person skilled in the art can easily conceive of making a communication device connected with an array antenna to be any of various communication devices other than that equipped with aircraft or spacecraft. Therefore, the JPO's decision is not erroneous.</td></tr>
<tr><td colspan="2">Judgment by the Court
4 Reason 3 for Dismissal (Error concerning the determination that difference is easily conceived)
... it can be said that Cited Invention 1 and Cited Invention 2 relate to a common technical field of antenna arrays and also have common problems to be solved that communication is carried out by turning beam direction through a flat antenna. Cited Invention 1 relates to a microstrip patch array that has light weight and a flat shape, and has the ability of handling multiple beams. Thus, even though Citation 1 states "especially, beneficial for application to aircraft and spacecraft," it is not admitted that a factor exists that hinders the application of Cited Invention 1 to another communication device where an antenna and a beam-forming feature are integrated into a single structure.
Accordingly, the application of Cited Invention 2 to Cited Invention 1 could be easily made by a person skilled in the art. Thus, by making Claimed Invention 1 a laptop computer in which an array antenna is arranged on the back of a display section in such a way as described in Cited Invention 2, the person skilled in the art could easily conceive of the constitution relating to the difference. Therefore, in terms of above points, the</td></tr>
</table>

determination of the appeal decision is not erroneous.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relation of the technical field, Similarity of the problem to be solved, Obviousness of or easy to conceive the problem to be solved, Obstructive factor

1. Bibliographic Items

Case	"Slime preventing agent for membrane separation" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 27, 2014 (2013 (Gyo KE) No. 10102)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2005-81945 (JP 2006-263510A)
Classification	B01D 65/06
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding judge: Toshiaki IIMURA, Judge: Kimiko YAGI, Judge: Shinji ODA

2. Overview of the Case

(1) Summary of Claimed Invention

The object of the claimed invention is to provide a slime preventing agent for membrane separation to perform efficient membrane separation using a permeable membrane, wherein the slime preventing agent prevents the decrease of the removal rate and the desalination rate due to the degradation of the permeable membrane even if the permeable membrane has a low chlorine resistance and prevents the fouling of the permeable membrane due to the growth of microbes. The claimed invention relates to a slime preventing agent for membrane separation, comprising an alkali metal hypochlorite and an alkali metal sulfamate.

(2) State of the Art

(i) Citation 1 (Exhibit B1) (Cited Invention 1): International Publication No. WO2003/96810 (found in the Appeal

Decision)

"Invention of 'a composition for prevention of slime, comprising an alkali metal hypochlorite, an alkali metal sulfamate, and an anionic polymer or a phosphonic acid compound'" (cited from the Court Decision)

(ii) Citation 2 (Exhibit A2): International Publication No. WO2004/22491 (found in the Court Decision)

"....a method for eliminating or preventing biofilm on a reverse osmosis membrane, comprising contacting the reverse osmosis membrane with an oxidizing halogen biocide in combined form which slowly releases halogen to disinfect the membrane and to kill bacteria is stated (claim 1). It is stated that, among these, "the oxidizing halogen biocide" may be a combination of (1) "an oxidizing biocide substance that contains a halogen in the +1 oxidation state" and (2) "a nitrogen containing compound which contains at least one nitrogen atom in the imide or amide form, such that the halogen in (1) loosely binds with the nitrogen in (2) thereby forming combined halogen (claim 2), and that an example of (1) is sodium hypochlorite and an example of (2) is sulfamic acid ([0013])." (cited from the Court Decision)

(3) The Claims (Amended) (Claimed Invention)

[Claim 1] A slime preventing agent for membrane separation, comprising an alkali metal hypochlorite and an alkali metal sulfamate.

(4) Procedural History

March 29, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-6592)
August 31, 2012	:	Amendment (See the aforementioned "The Claims ")
February 25, 2013	:	Appeal Decision that "the request for the appeal is to be dismissed"

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

Appeal Decision (cited from the Court Decision)
...a person skilled in the art who sees the teaching of ..."Citation 2" ...have a cause or motivation to use ..."Cited Invention" ...for slime prevention for membrane separation and ...both effects ...are within the scope which a person skilled in the art can expect. Therefore, ..."Claimed Invention" ...after the aforementioned amendment is an invention which a person skilled in the art was able to invent easily and cannot be granted a patent under Patent Act Article 29(2). Identical features and differences between the Claimed Invention and the Cited Invention found in the Appeal Decision are as follows. A Identical features Both are "a slime preventing agent comprising an alkali metal hypochlorite, an alkali metal sulfamate, an anionic polymer and a phosphonic acid compound." B Differences

Whereas the Claimed Invention is a slime preventing agent for "membrane separation," the Cited Invention is a slime preventing agent for "cooling water systems, heat-storage water systems, water systems in manufacturing processes of paper and pulp, water systems for collecting dusts and scrubber water systems," and there is no statement about use of membrane separation.

Decision

Allegations by Plaintiff

In the field of reverse osmosis membrane such as Citation 2, there is a problem that permeable membranes degrade due to free chlorine and a slime preventing agent is added to prevent this, whereas cooling water systems, heat-storage water systems, water systems in manufacturing processes of paper and pulp, water systems for collecting dusts and scrubber water systems of Citation 1 do not have such a problem. The problems and the technical fields of Citation 1 and Citation 2 are different. Therefore it is not easy for a person skilled in the art to combine Citation 1 and Citation 2 and conceive a constitution regarding the differences.

Allegations by Defendant

In Citation 1, it is stated that "the present invention aims to provide a composition for prevention of slime and a method for preventing slime, in which troubles caused by slime in cooling water systems, heat-storage water systems, water systems in manufacturing processes of paper and pulp, water systems for collecting dusts and scrubber water systems can be effectively prevented with the composition in a small amount." It is considered that the technical field thereof is related to the prevention of slime in various water systems and there is no statement which prevents use in water treatment equipment having a membrane separation process. Moreover, the biocides used in a membrane separation process shown in Citation 2 are not different from slime preventing agents.

Judgment by the Court

...Citation 2 describes a method for eliminating or preventing biofilm on a reverse osmosis membrane, comprising contacting the reverse osmosis membrane with an oxidizing halogen biocide in a combined form which slowly releases halogen to disinfect the membrane and to kill bacteria is stated (claim 1). It is stated that, among these, "the oxidizing halogen biocide" may be a combination of (1) "an oxidizing biocide substance that contains a halogen in the +1 oxidation state" and (2) "a nitrogen containing compound which contains at least one nitrogen atom in the imide or amide form, such that the halogen in (1) loosely binds with the nitrogen in (2) thereby forming combined halogen (claim 2), and that an example of (1) is sodium hypochlorite and an example of (2) is sulfamic acid ([0013])."

As above, in Citation 2, sodium hypochlorite is illustrated as an example of (1) and sulfamic acid is illustrated as an example of (2). It is common general knowledge that chlorosulfamate is formed by reacting hypochlorite and sulfamic acid ,and this chlorosulfamate is combined chlorine which is formed by the binding of chlorine with nitrogen and slowly releases chlorine. Therefore, it is obvious to a person skilled in the art that a combination of sulfamic acid and sodium hypochlorite can be used as the biocides mentioned above.

Then, it is found that combining sodium hypochlorite and sulfamic acid to form combined halogen serving as a biocide and contacting the biocide with a reverse osmosis membrane to eliminate or prevent biofilms on

the reverse osmosis membrane is stated in Citation 2. In light of such statement of Citation 2, it is a matter which a person skilled in the art conceives easily to use the Cited Invention containing an alkali metal hypochlorite and an alkali metal sulfamate "for a membrane separation."

...Plaintiff alleges that in the field of reverse osmosis membrane such as Citation 2, since there is a problem that permeable membranes degrade due to free chlorine, a slime preventing agent is added to prevent this, whereas cooling water systems, heat-storage water systems, water systems in manufacturing processes of paper and pulp, water systems for collecting dusts and scrubber water systems of Citation 1 do not have such a problem and that the technical fields of Citation 1 and Citation 2 are different.

However, ... it is a general problem to eliminate or prevent biofilms on a reverse osmosis membrane and it is stated in Citation 2 that the biocide of the combination of sodium hypochlorite and sulfamic acid can be used to eliminate or prevent biofilms. Therefore, there is nothing difficult to use a slime preventing composition comprising an alkali metal hypochlorite and an alkali metal sulfamate in a membrane separation processing using a reverse osmotic membrane.

...Plaintiff alleges that because Citation 2 is an invention to disinfect the membrane and to kill bacteria, whereas a slim preventing composition of Citation 1 exerts neither disinfection nor biocide effect, there is a factor for inhibiting combination of Citation 1 and Citation 2.

However, Citation 1 describes, "even in an additive amount of the composition having a low concentration from which a biocide effect cannot be obtained" ..."the biocide effect is not exhibited by adding 5 mg/L of ...only A component as available chlorine" .... In light of these statements, it is rational to construe that whether there is a biocide effect or not is dependent on the concentration (amount of addition). Because there is no biocide effect at low concentrations, it does not follow that a slime preventing composition according to the Cited Invention has no biocide effect, thus it does not prevent the combination of Citation 1 and Citation 2. Therefore, the Plaintiff's allegation cannot be adopted.

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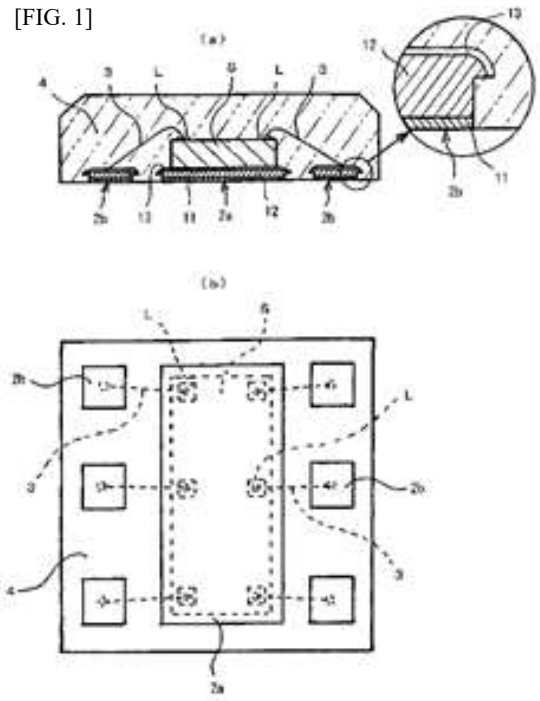
Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relevance of technical field, Similarity of problem, Suggestion in the contents of cited invention

1. Bibliographic Items

Case	"Method of producing a semiconductor device" (Trial for Invalidation) Intellectual Property High Court Decision, August 7, 2014 (2013 (Gyo KE) No. 10240)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2008-268083 (JP2009-55055A)
Classification	H01L 23/12
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Ryuichi SHITARA, Judge: Sigeru OOSUGA, Judge: Shinji ODA

2. Overview of the Case

[FIG. 1]



(1) Summary of Claimed Invention

With regard to method of producing a semiconductor device, the claimed invention relates to a semiconductor device having an island portion 2a and one or more electrode portions 2b, sealed by resin after electrically connecting a semiconductor element S mounted on the above island portion 2a with the above electrode portions 2b, each of back face sides of the island portion 2a and the electrode portions 2b is composed, being exposed on the same face of bottom side of a resin layer 4, wherein the island portion 2a and the electrode portions 2b are respectively formed by electroforming into a double-layered structure consisting of at least a metal thin film 11 for mounting on the back face side and a lead layer 12 stacked integrally thereon, so as to eliminate necessity of forming the plate to be separately mounted, on the exposed surface of the electrode portion in a following process, and thus electric conduction and reliability of the electrode at the time of mounting are improved.

(2) State of the art

(i) Citation 1 (Exhibit A2):JP2002-009196A (Finding of Trial Decision)

"A method of producing a semiconductor device, comprising steps of: forming a resist pattern layer 6 by implementing predetermined patterning on the whole surface of a stainless steel substrate 1; removing surface-oxidized film by chemical etching and implementing surface activation treatment including well-known chemical treatment with chemicals on the exposed surface of the stainless steel substrate 1; forming independently, in parallel, a metal layer 2a for mounting a semiconductor element on the stainless steel substrate 1, and one or more electrodes 2b, by electrodepositing conductive metal on the exposed surface excluding said resist pattern layer 6 of said stainless steel substrate; removing said resist pattern layer 6 from said stainless steel substrate 1; electrically connecting an electrode on semiconductor element with said electrode layer 2b, after mounting a semiconductor element S on said metal layer 2a; sealing by a resin layer 4, a portion where said semiconductor element S is mounted on said stainless steel substrate 1; obtaining a resin-sealed body where, the back side surface of said metal layer 2a and that of said electrode layer 2b are exposed on the same plane of the bottom surface of said resin layer 4, by removing said stainless steel substrate 1; and forming a gold thin film for mounting by flush plating to a thickness of 0.3-0.5 μ m or the like only on the back side surfaces of electrode layer 2b and metal layer 2a" (cited from the Court Decision)

(ii) Document of Exhibit A4: JP S63-164327A (Finding of Trial Decision)

"A method of producing a lead frame, comprising steps of: after activating a surface corresponding to a non-resist

portion 2a of a substrate 1 by pealing treatment of said substrate 1 including stainless steel, forming, by coating or plating, a contact material 3 including metal, tin, or solder on said non-resist portion 2a, thereafter forming an electroformed metal layer 4 on said contact material 3 by electroforming"

(3) The Claims (Amended) (Claimed invention)

[Claim 1]

A method of producing a semiconductor device, comprising steps of: forming a resist pattern layer (6) consisting of a predetermined pattern for forming an island portion (2a) for mounting a semiconductor element (S) and electrode portions (2b) connected with an electrode (L) of said semiconductor element on the whole side of a stainless steel substrate (1);

removing inactive film by chemical etching on the exposed surface of said stainless steel substrate (1);

forming independently said island portion (2a) formed by double-layered structure consisting of at least said metal thin film for mounting (11) and said lead layer (12) stacked integrally thereon and said electrode portions (2b), by gold plating growth to a thickness of 0.05 - 1 μm as the metal thin film for mounting (11) on the exposed surface from which the inactive film of said stainless steel substrate (1) has been removed and by integrating by stacking and forming a growth lead layer (12) by electroforming on said metal thin film for mounting (11);

removing said resist pattern layer (6) from said stainless steel substrate (1);

connecting electrically said electrode (L) with said electrode portions (2b) after mounting said semiconductor element (S) on said island portion (1);

forming a resin layer (4) by molding by resin, the mounted part of said semiconductor element (S) on said stainless steel substrate (1); and

forming each back surface of said metal thin films for mounting (11) of said island portion (2a) and said electrode portions (2b) in a state of being exposed on the same plane of the bottom surface of said resin layer (4) by peeling off and removing said stainless steel substrate (1).

(4) Procedural History

January 27, 2012	:	Registration of Patent Right
August 7, 2012	:	Request for Trial for Invalidation of Patent (Muko No.2012-800120)
May 17, 2013	:	Request for Correction by Plaintiff (Patentee) (See above "The Claims")
July 19, 2013	:	Trial Decision that "the correction is accepted. ...Invalidate the patent."

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

Trial Decision
Evidence A2 and Evidence A4 are similar, in terms of such a method of producing a semiconductor device as forming a metal layer for mounting a semiconductor element and an electrode, by peeling off a stainless steel substrate, after forming the metal layer by electroforming on a non-resist portion of the stainless steel substrate. Moreover, in terms of method of producing, the problem that it is preferable to lessen the number of steps as far as possible always exists. Therefore, it can be easily conceived by a person skilled in the art, based on the

statement of Exhibit A4 that for forming an electrode layer and a metal layer that have a gold layer in the invention of Citation 1, in the "step of forming independently island portions and electrode portions," forming independently, in parallel, a metal layer 2a for mounting on a semiconductor element on a stainless steel substrate 1 and one or more electrode layers 2b by electrodepositing conductive metal on an exposed surface excluding a resist pattern layer 6 of a stainless steel substrate, and after the "step of obtaining a resin-sealed body where each back side surface of the metal layer 2a and that of the electrode layer 2b are exposed on the same plane of bottom surface of a resin layer 4, by removing said stainless steel substrate 1," instead of flash plating of gold thin film for mounting, only on the back surfaces of the electrode layer 2b and the metal layer 2a, in the "step of forming independently island portions and electrode portions," forming contact material by metal plating on a non-resist portion, and thereafter, forming an electroformed metal layer by electroforming.

Decision

Allegations by Plaintiff	Allegations by Defendant
Document of Exhibit A4 relates to a finger with bumps in a shape of tapes as called TAB (Tape Automated Bonding) in use of TCP (Tape Carrier Package). Document of Exhibit A4 only states a method of producing a lead frame that constitutes one component for producing a semiconductor device, and thus has nothing in common with the invention as stated in Citation 1.	Document of Exhibit A4 states the well-known matter that, regardless of the method of producing a semiconductor device where a leadless surface is mounted, a metal and an electrode for mounting a semiconductor element in the method of producing a semiconductor device are formed by a metal plate, after activating the surface of a non-resist portion on a stainless steel substrate and subsequently, peeling off the stainless steel substrate after forming a metal layer by electroforming. It is apparent that a semiconductor device is obtained by the above method.

Judgment by the Court

(3) Reason 1-2 of Cancellation (error of determination on the difference certified by trial decision)

...The problem to be solved stated in Citation 1 is, as mentioned above, that in connection with the semiconductor device sealed by resin in a conventional system of mounting a leadless surface is, in the course of a production process, it is necessary to form, in a state of positioning precisely on a printed substrate, an electrode for connection on the whole surface of a printed substrate and an electrode layer on the back surface, and each of an electrode and an electrode layer formed by positioning is required to be surely conductive without position aberration by a through hole, and thus, precision in production is requested. The above precision hinders the decrease of production cost as well as an increase in the number of steps of the production process for forming a through hole and printing a conductive body on the printed substrate, and also the region for forming the through hole among a plurality of semiconductor elements arranged adjacently on the printed substrate in production is necessary and the number of semiconductor devices that can be formed by being arranged on one printed substrate is limited. Moreover, in the method employing such a way as sealing by resin, after mounting a semiconductor element on a relatively thick printed substrate, there are faults that heat generated in the

performance of forming the semiconductor element is easily accumulated and heat dissipation is worse as well as difficulty in realizing small and thin semiconductor devices because of the use of printed substrate. As mentioned above, the problem of invention to be solved stated in Citation 1 pertains to the semiconductor device sealed by resin in such a manner as leadless mounting with printed substrate.

On the other hand, the matter stated in Document of Exhibit A4 pertains to the method of producing a semiconductor device in such a manner as sealing by resin by using a lead frame, and originally does not pertain to the method of producing the semiconductor device sealed by resin in such a manner as leadless mounting with printed substrate.

In this way, suggestion and motivation cannot be obtained from the problem to be solved stated in Citation 1 pertaining to the semiconductor device sealed by resin in such a manner as leadless mounting with printed substrate and it is not recognized that there are other documents stating or suggesting that the statement of Document of Exhibit A4 should be applied to Citation 1.

In addition, the invention stated in Citation 1 pertains to the method of producing a semiconductor device in such a manner as sealing by resin. On the other hand, the statement of Document of Exhibit A4 pertains to the method of producing a lead frame used for producing such a semiconductor device as molded by resin. Accordingly, even if both of them are common in terms of the method of producing a semiconductor device, it is not recognized that, for solving the problem in Citation 1, the statement of Document of Exhibit A4 pertaining to the method of producing a semiconductor device as sealed by resin can be easily applied by a person skilled in the art encountering Citation 1 that states the method of producing a leadless-surface-mounted semiconductor device. ...Citation 1 does not include the statement or suggestion that Document of Exhibit A4 is to be applied, and even if the statement of Document of Exhibit A4 is applied to the invention stated in Citation 1, the Patented Invention 1 cannot be obtained. Therefore, the trial decision that the Patented Invention 1 can be easily conceived by applying the statement of Document of Exhibit A4 to the invention stated in Citation 1 is erroneous, to the extent as mentioned above.

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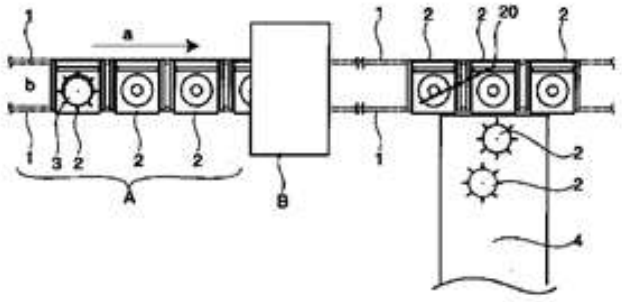
Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relevance of technical field, Similarity of problem

1. Bibliographic Items

Case	"A fruit vegetable placing body for a fruit vegetable automatic sorting device, fruit vegetable automatic sorting device, and fruit vegetable automatic sorting method" (Trial for Invalidation) Intellectual Property High Court Decision, December 24, 2014 (2014 (Gyo KE) No.10071)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2001-285930 (JP2003-53275A)
Classification	B07C 5/36
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Setu SHIMIZU, Judge: Kyou NAKAMURA, Judge: Yuki NAKATAKE

2. Overview of the Case

[FIG. 1]



(1) Summary of Claimed Invention

A fruit vegetable receiving body is a mini conveyor that can support a fruit vegetable on a conveying belt, as well as feed a fruit vegetable to a fruit vegetable receiving body beside a conveying line by moving said conveying belt in the lateral direction perpendicular to a traveling direction of the fruit vegetable receiving body. Each fruit vegetable take-in body taking in fruit vegetables released by a fruit vegetable receiving body is set up so that its upper side is even with or slight lower than the upper side of the conveying belt of the fruit vegetable receiving body, and is adjacent to an edge part of a fruit vegetable releasing side. Fruit vegetables are fed to a predetermined fruit vegetable take-in body by driving a mini conveyor based on a discrimination signal.

(2) State of the art

(i) Exhibit A2 (Invention 1 of Exhibit A2):(JP H3-256814A) (Finding of Trial Decision)

"A cradle 8 for a fruit vegetable arranging and encasing device 1, comprising: supplying parts 9 of a sorting conveyor 2 where a guide chain 7 is equipped with a plurality of cradles 8, wherein a kiwi K is placed on the cradle 8 and conveyed, and the kiwi K is measured in judging parts 3 during conveyance, and size, quality, and weight are determined, the kiwi K on the cradle 8 is sorted out based on the result of determination, and the kiwi K is fed in sorting the conveyor 2,

wherein the cradle 8 can be tilted in the conveying direction of the conveyor 2 and equipped with receiving parts by which the kiwi K can be placed on the cradle 8." (cited from the Court Decision)

(ii) Exhibit A3 (Invention 1 of Exhibit A3):JP H11-286328A (Finding of Trial Decision)

"A conveying unit 1 placing a conveyed article P as a small article for an automatic sorting device of the conveyed article P as a small article, characterized by: the Article P as a small article being placed in a feed path B of a conveying path A of the conveyed article P as a small article where a conveying rail 12 is equipped with a plurality of conveying units 1 on which the conveyed article P as a small article is placed, and the conveyed article P as a small article is sorted based on classification code number during conveyance and fed in the conveying direction of the conveying path A of the conveyed article P as a small article,

being equipped with a transporting sheet 49 that is reciprocatively movable in the conveying direction of the conveying path A of the conveyed article P as small article,

the area created, excluding both side edge areas connected with bars 48a and 48b from an upper area of the transporting sheet 49 moving in the lateral direction, stacked on the surface of a receiving board 46 where the conveyed article P as a small article can be placed on the transporting sheet 49, formed in a curve shape in the lateral direction, having a concavity 45 concaved in the center, and a cushioning sheet 47 stacked on the receiving board 46,

the side edge area connected with the bars 48a and 48b from the upper area of the transporting sheet 49 set up upward of the transporting sheet 49 and rearward with respect to the transport direction of said area created, excluding both edge areas connected with the bars 48a and 48b from the upper area of the transporting sheet 49 moving in the lateral direction, stacked on the surface of receiving board 46 where the conveyed article P as a small article can be placed on the transporting sheet 49, formed in a curve shape in the lateral direction, having the concavity 45 concaved in the center, and the cushioning sheet 47 stacked on the receiving board 46,

the side edge area of the bar 48b and the transporting sheet 49 connected with said bar 48b in a side edge protruding upward from the area created, excluding both edge areas connected with the bars 48a and 48b from the upper area of the transporting sheet 49 moving in the lateral direction, stacked on the surface of the receiving board 46 where the conveyed article P as a small article can be placed on the transporting sheet 49, formed in a curve shape in the lateral direction, having the concavity 45 concaved in the center, and the cushioning sheet 47 stacked on the receiving board 46, moving in the forward direction in connection with forward rotation of the transporting sheet 49 and returning in the rearward direction in connection with rearward rotation." (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1]

A fruit vegetable placing body for an automatic fruit vegetable sorting device, being characterized in that fruit vegetables are placed on a fruit vegetable placing body and conveyed, and fruit vegetables are measured in measurement parts during conveyance, and grades, etc. are determined and fruit vegetables on a fruit vegetable placing body are sorted based on the determination, and fed in the direction of conveying in the supplying parts of a fruit vegetable conveying body where a plurality of fruit vegetable placing bodies are equipped on the conveying body,

wherein a fruit vegetable placing body is equipped with a conveying belt capable of reciprocating rotation on a side part in the conveying direction of a conveying line, and is equipped with receiving parts where a fruit vegetable can be placed on the conveying belt, and is set up with a partition body in the upper side of the conveying belt and also behind said receiving parts, in the direction of reciprocating rotation, and a partition body protrudes upward, and moves in the direction of forward rotation in connection with forward rotation and moves in the direction of rearward rotation in connection with rearward rotation.

(4) Procedural History

February 10, 2012	:	Registration of patent right (See above "The Claims")
March 8, 2013	:	Request for Trial for Invalidation by plaintiff (Muko No.2011-800038)
February 21, 2014	:	Trial Decision that "the request for trial is dismissed."

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

Trial Decision
[Difference F'] Concerning conveying parts of fruit vegetable placing body for automatic fruit vegetable sorting device, in Claimed Invention 1, conveying part is a "reciprocatively rotatable conveying belt," and "set up partition body in an upper side of a conveying belt and also behind said receiving parts, in the direction of forward rotation, and a partition body protrudes upward from said receiving parts, and moves in the direction of forward rotation in connection with forward rotation and returns in the direction of return rotation in connection with return rotation," while, in Invention 1 of Exhibit A2, the conveying part is "a tiltable cradle 8." (B) Determination on Difference F' (Combination of Exhibit A2 and A3) a The Subject of Conveyance, the Technical field and the Problems The subject of conveyance of Invention 1 of Exhibit A2 is "kiwi K" (fruit vegetable) that are easily damaged and bruised, and are one by one different in shape and size, and the subject of conveyance of Invention 1 of Exhibit A3 is "Conveyed Article P" (a small articles as a thin or indefinite thing, for example, a bottle or a can). Thus, concerning the subject of conveyance, Invention 1 of Exhibit A2 and Invention 1 of Exhibit A3 are

common in terms of generic concept as "Article," but are different in terms of concrete characteristics.

Accordingly, Invention 1 of Exhibit A2 and Invention 1 of Exhibit A3 are similar in terms of generic concept as "article placing body for article sorting device," but are not considered to be common in terms of concrete technical field.

In addition, even if they are common in terms of generic concept as "prevention of damages and breakages of articles," there are differences in terms of power, etc. to prevent "damages and breakages due to mutual collision of conveyed articles." Therefore, there is little motivation to apply Invention 1 of Exhibit A3 to Invention 1 of Exhibit A2. (cited from the Court Decision)

Decision

Allegations by Plaintiff	Allegations by Defendant
A Motivation to apply Invention 1 of Exhibit A3 to Invention 1 of Exhibit A2 (A) Invention 1 of Exhibit A3 is to solve the problem ([0004]) that, in a conventional way as equipped with a tiltable tray, damages and breakages due to mutual collision of conveyed articles are likely to arise, and it is not suitable for conveying easily damaged articles. Since the cradle 8 in Invention 1 of Exhibit A2 has the constitution that cradle 8 is tiltable in the conveying direction of the sorting conveyor 2, there is a problem that damages and breakages as stated in Invention 1 of Exhibit A3 are likely to arise and there is concrete motivation to apply Invention 1 of Exhibit A3 to Invention 1 of Exhibit A2. In this respect, Exhibit A1 discloses the problem that damages and crashes are generated in an automatic sorting device of conventional technology (such a device as similar to Invention of Exhibit A2) that rotates and drops a fruit vegetable B, by tilting weighing bucket E. In Invention 1 of Exhibit A2 relating to "a fruit vegetable," it is well-known that the problem of Invention 1 of Exhibit A3 exists. In addition, Invention 1 of Exhibit A1 discloses the idea that a fruit vegetable placing body in a way of bucket is replaced by a fruit vegetable placing body in a way of belt. Thus, even if Invention 1 of Exhibit A2 relates to "a fruit vegetable," there is no change in the fact	A Motivation and impediment to apply Invention 1 of Exhibit A3 to Invention 1 of Exhibit A2 The subject of conveyance of Invention 1 of Exhibit A2 is fruit vegetables, while the subject of conveyance in Invention 1 of Exhibit A3 does not include fruit vegetables. Accordingly, the problem to be solved in Invention 1 of Exhibit A2 is to prevent fruit vegetables from suffering damages, while Invention 1 of Exhibit A3 that does not treat fruit vegetables does not have such problem, and thus the two inventions are not common in terms of the problem to be solved. In addition, for the reasons that sorting of Invention 1 of Exhibit A2 aims to encasement, while sorting of Invention 1 of Exhibit A3 is to feed to shoot and at least does not aim to encasement, and that in Invention 1 of Exhibit A2, sorting is conducted after measurement in a measurement part prior to encasement, while measurement is not performed in Invention 1 of Exhibit A3 and the like, Invention 1 of Exhibit A2 pertaining to the technical filed of measurement device or the technical field of encasement device, while Invention 1 of Exhibit A3 pertain to the technical filed of mere sorting without the purpose of measurement or encasement. Therefore, Invention 1 of Exhibit A2 and Invention 1 of Exhibit A3 pertain to different technical fields in this respect. As mentioned above, the two inventions are

that there is motivation to apply Invention 1 of Exhibit A3 to Invention 1 of Exhibit A2. Accordingly, with regard to the constitution as stated in Invention 1 of Exhibit A2 of sorting by the tilting cradle 8, in consideration of the technological idea as stated in Invention 1 of Exhibit A3, a person skilled in the art can easily conceive of "adopting the constitution that concave parts holding the conveyed article P are created in the lateral of transporting sheet 49 reciprocatively movable in the direction of right and left that is perpendicular to the conveying direction, and conveyed articles are smoothly and certainly conveyed by keeping conveyed articles in concave parts in a stable condition, as well as by supporting conveyed articles with a bar 48b set in a high position corresponding to H against concave parts, by running of a transporting sheet 49, and conveyed articles are set in original positions by moving transporting sheet 49 in the opposite direction before entering a feed path B of conveyed articles after sorting of conveyed article P is finished, and the same motion is repeated" In addition, Invention 1 of Exhibit A2, despite relating to the process of encasing, states that "when arranging kiwi K in the receiving box 58 by rotating, the kiwi K often contacts with the inner surface on downstream side of the receiving box 58, or the peripheral surface of kiwi K often receives bruises or scratches due to mutual collision of kiwi K to be arranged, and thus there is a problem that commodity value of kiwi K is impaired" (row 12-18, upper left field of page 2). Accordingly, Invention 1 of Exhibit A2 indicates there is a problem that the peripheral surface of the kiwi K receives bruises or scratches. Otherwise, Invention 1 of Exhibit A3 is to solve the problem ([0004]) that, in a conventional way as equipped with tiltable tray, damages or breakages due	different in all terms of the subject, the problem to be solved and the technical field. Thus, concerning the constitution that the cradle 8 of Invention 1 of Exhibit A2 is tilted, a person skilled in the art cannot easily conceive of applying the way of a transporting sheet as stated in Invention 1 of Exhibit A3. Therefore, there is no motivation to apply Invention 1 of Exhibit A3 to Invention 1 of Exhibit A2.

to mutual collision of conveyed articles are likely to arise, and it is not suitable for conveyed articles that are easily damaged. Therefore, a person skilled in the art generally attempts to change tiltable tray as stated in Invention 1 of Exhibit A2 to the constitution of Invention 1 of Exhibit A3, in consideration of said indication of Invention 1 of Exhibit A2. As mentioned above, since partition parts of Invention 1 of Exhibit A2 adopt a conventional way that Invention 1 of Exhibit A3 indicates as the problem to be solved, there is positive and concrete motivation to adopt partition parts of Invention 1 of Exhibit A3 in Invention 1 of Exhibit A2.	

Judgment by the Court

...as mentioned above, Invention 1 of Exhibit A2 relates to cradle where a fruit vegetable is placed in the device of sorting fruit vegetable such as kiwi, while Invention 1 of Exhibit A3 relates to small articles placed on a conveying unit where a small article such as a thin or deformed article are automatically sorted. Thus, Invention 1 of Exhibit A2 and Invention 1 of Exhibit A3 are common in terms of an articles placing body for articles sorting and conveying device, that is, the technology relating to "articles placing body for an articles sorting device." ... Moreover, as mentioned above, in Invention 1 of Exhibit A2, kiwi often has bruise and abrasion on its surface caused by contact with an inner wall surface at the downstream of a receiving box and also by mutual contact of kiwis when arranging kiwi in the receiving box by rotating, and thus, in order to solve the problem that commodity value is impaired, a fruit vegetable places individually on receiving part formed on a conveying surface of the conveyor and by conveying a fruit vegetable conveys in a state that each fruit vegetable is separated at a prescribed distance, and thus, contact or collision of fruit vegetables in conveyance is prevented. Accordingly, it is apparent that the problem of preventing the mutual contact of conveyed articles or the like exists not only when arranging in the box but also in all steps of sorting and conveying. Invention 1 of Exhibit A2 constitutes a cradle of sorting a conveyor that can be tilted when moving placed conveyed articles in the conveying direction, and it is well-known fact, as obvious from the constitution itself, that there are possibilities of damage or breakage due to the some degree of dropping impact or the impact of contact for moving conveyed articles in the conveying direction by tilting, as Exhibit A1 states that in conventional technology, in an automatic sorting device by tilting a weighing bucket E and by dropping fruit vegetable E with rolling, a fruit vegetable placing body in a manner of a bucket is replaced by one in a manner of a belt, in order to solve the problem that a fruit vegetable receives bruise or damage.

On the other hand, Invention 1 of A3 is ... to solve the problem that in such a conventional way as being equipped with a conventional tiltable tray, it is possible that damages or breakages are generated due to the collision of conveyed articles and thus it is not suitable for conveying conveyed articles that are easily damaged.

Therefore, Invention 1 of Exhibit A2 and Invention 1 of Exhibit A3 are common in problem.

As a result, it is considered that there is motivation to conceive of the constitution of Difference F' by applying Invention 1 of Exhibit A3, in order to solve the technical problems such as damage and breakage of conveyed articles, to the constitution of Invention of Exhibit A2 that a sorting conveyor can tilt in the conveying direction.

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1
Classification of the Case	42: Existence of motivation to apply sub cited invention to main cited invention
Keyword	Relevance of technical field, Similarity of action and function

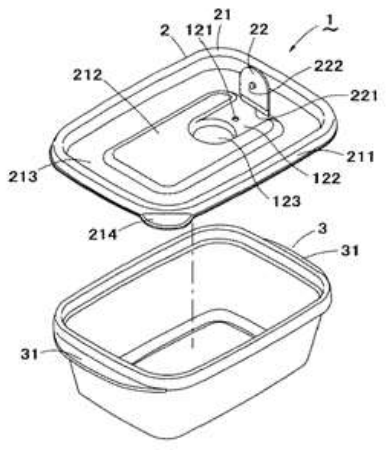
1. Bibliographic Items

Case	"A lid body and a container with this lid body" (Trial for Invalidation) Intellectual Property High Court Decision, April 28, 2015 (2013 (Gyo KE) No.10263)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2008-324756 (JP2009-143626A)
Classification	B65D 51/16
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Yoshinori TOMIDA, Judge: Ichiro OOTAKA, Judge: Yoshiki TANAKA

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



Cited invention relates to a container and a lid body used in the container suitable for heating contained foods by heating device such as a microwave oven. A lid body 1 for closing an opening part of a main body of a container 3 for containing foods and heating said foods is characterized by having one raised region in a marginal region setting a peripheral outline shape of said lid body 1 and being raised as connected with a marginal part of said container 3 forming said opening part of said container 3 and at the inside of a region surrounded by said marginal region, said one region having a hole 121 for discharging liquid in said container and a flap part 22 equipped with protruding part for closing said hole 121, said flap part having a base edge part integrally connected with said one region and rotating around said base edge part, and a tip part of said flap part 22 at least partially extending to the region between said marginal region and said one region.

(2) State of the art

(i) Citation 1: Container of Kureha (that had been sold around October, 2006 before the priority date of the Claimed Invention, Exhibit A3, Inspection of Exhibit A1) (Finding of Trial Decision)

"a. A lid for closing an opening part of a main body of a container for containing foods and heating said foods,

b. being equipped with a marginal region connected with a marginal part of said container setting peripheral outline shape of said lid and forming said opening part of said container, and

c. one raised region and concave region at the inside of the region surrounded by said marginal region,

d. said concave region having a hole part and a concave part for discharging liquid in said container and connectable with an opening and closing part equipped with a protruding part for closing the hole part,

e. said opening and closing part having a fine and thin-formed part, integrally connected with a picking part protruding outward from a marginal region of said lid, and rotating around said fine and thin-formed part,

f. a tip part of said opening and closing part being incapable of extending to the margin of said concave part,

g. said fine and thin-formed part of said opening and closing part arranged in a position far from the center of said lid toward said tip part of said opening and closing part,

h. the inside of the region surrounded by said marginal region, having a concave region at least partially containing said flap part,

i. said concave region connected with a marginal part of the upper side of said one region, through the middle region,

j. lid body." (cited from the Court Decision, the following figures show an overview of the container of Kureha (Exhibit A3•Picture 9 and 10))

(ii) Document of Exhibit A6 (Invention of Exhibit A6):US Publication of Unexamined Patent Application No. 2005/0061812 (Finding of Trial Decision)

"a. A container lid 2 for closing an opening part of a main part of a container 15 containing foods,

b. being equipped with a peripheral limb 27 connected with a marginal part of said container 15 setting a peripheral outline shape of said container lid 2 and forming said opening part of said container 15, and

c. an outside surface 33 as a raised region at the inside of the region surrounded by said peripheral limb 27,

d. said outside surface 33 having a vent hole 4 for discharging air in said container by being connected with an inlet port for a vacuum pump and a cover 7 equipped with a seal segment 3 constituting a check valve 40 capable of closing said vent hole 4,

e. said cover 7 having a film hinge 32 integrally connected with said outside surface 33, and rotating around said film hinge 32,

f. a tip part of said cover 7 being incapable of reaching the margin of said peripheral limb 27,

g. said film hinge 32 arranged in a position near from the center of said container lid 2 toward said tip part of said cover 7,

h. said outside surface 33 having a concave part 20 at least partially containing said cover 7,

i. said concave part 20 being connected with a peripheral part on the upper side of said outside surface 33,

j. container lid 2."

(iii) Exhibit A7:JP2004-123143A (Finding of Trial Decision)

"A container of powder comprising: a lid body 2 being connected with a hinge lid 3 in a state as freely opening and closing, through a hinge 3b; an edge part of the hinge lid 3 being arranged in the center of the lid body 2 and the tip part of the hinge lid 3 being arranged in the peripheral side of the lid body 2; a pour spout 4a created in a top plate 2a being formed under said hinge lid."

(iv) Exhibit A8: the description of US Patent No.4494679 (Finding of Trial Decision)

"A container containing powder materials comprising: a base part 13 raised on the upper side of a container lid 1; the base part 13 having a first raised flat surface 15; a hole a being formed in the first raised flat surface 15; a step part 25 of the first raised flat surface 15 being connected with lid flap 27 by a hinge 29; a protruding part 35 of the lid flap 27 being made capable of closing the hole a."

(3) The Claims (Claimed Invention)

[Claim 1]

A. A lid body for closing an opening part of a main body of container for containing foods and heating said foods is characterized by,

B. being equipped with a marginal region connected with a marginal part of said container setting a peripheral outline shape of said lid body and forming said opening part of said container, and

C. one raised region at the inside of the region surrounded by said marginal region,

D. said one region being equipped with a hole part for discharging liquid in said container and a flap part equipped with a protruding part for closing said hole part,

E. said flap part having a base edge part, integrally connected with said one region, and rotating around said base edge part,

F. a tip part of said flap part being incapable of reaching the margin of said marginal region,

G. said base edge part of said flap part arranged in a position near the center of said lid body toward said tip part of said flap part,

H. said one region having a concave part at least partially containing said flap part,

I. said concave region connected with a marginal part of the upper side of said one region, through the middle region,

J. lid body.

(4) Procedural History

March 12, 2010 : Registration of patent right (See above "The Claims")

March 12, 2013 : Request for Trial for Invalidation (Muko No.2013-800039)

August 20, 2013 : Trial Decision of "the request for the trial is dismissed."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">Difference 3 : A flap part comprises, in Claimed Invention 1, being equipped with "one region," and a "base edge part" of it being "integrally connected with one region" and "arranged in a position near from the center of said lid body toward said tip part of said flap part," and said "tip part" being "incapable of reaching the margin of marginal region," while the container of Kureha comprises an "base edge part" being "integrally connected with picking part protruding outward from the marginal region of the lid" and "arranged far from the center of said lid body toward said tip part of flap part," and said "tip part" being "incapable of reaching the margin of concave part."
...
Assuming that the direction of opening and closing of the flap of the container of Kureha is reversed,
the "base edge part" of the flap of the container of Kureha is connected with a "picking part protruding outward from the marginal region of the lid." In addition, in relation to this connection, the cross-sectional shape of the flap is formed not in a plate shape but in Ω shape, for climbing over the marginal region.
This is different from the well-known shape (cross-sectional plate shape) and way of attachment (connected with marginal region) as stated in Exhibit A4 and A5 and is a specific way of attachment. Moreover, since the distance between hole part and base edge part becomes larger by being connected with the "picking part protruding outward," it obviously makes the flap easier to open in view of technology.
Accordingly, in case of reversing in the direction of opening and closing of the flap of the container of Kureha, such technological advantage is lost.

The applicant asserts that there are possibilities of modification of design in view of appearance. Although, setting aside the case that modification of design results in an equal technical advantage or other technical advantages, it cannot be assumed that modification of design is made which results in mere losing of technical advantage.
Therefore, there is no motivation to reverse the direction of opening and closing of the flap, with regard to the container of Kureha.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
A person skilled in the art encountering the container of Kureha recognizes, at the same time, [1]</td><td>Allegations by Defendant
A The Invention of Exhibit A6 is a container for vacuum preserving of foods, and is used for thawing</td></tr>
</table>

the problem that there is a necessity of changing the position of the flap from the marginal part of lid body to the vicinity of the center and [2] the problem that there is a necessity of changing the direction of flap into outward-opening, maintaining such a feature of the container of Kureha that the flap is integrally formed in the lid body.

Accordingly, Exhibit A6 states the container for foods equipped with the lid body where a flap is formed not in the marginal part of lid body but integrally formed in the vicinity of the center, and also the direction of the flap is outward-opening and there is no concave part for inserting one's finger. In the lid body as stated in Invention of Exhibit A6, [1] since the flap is connected with the vicinity of the center of the lid body, if adopting the lid body, it can be avoided that the opened flap breaks by colliding with another object, needs wasteful space, and collides with the inner wall of a microwave oven, as well as avoiding the problem in design that the opened flap protrudes outward. In addition, [2] since the flap is inward-opening, if adopting this lid body, there is no necessity of setting a concave part in the center of the lid body. Thus, it can be avoided that dirt accumulates in the concave part, that the concave part oppresses foods as well as reduces the volume of the container, by protruding into the container, and the impression of simple is curtailed. Moreover, water draining after washing is not prevented. Furthermore, [3] since the flap protrudes from the raised part of the center of the lid body ("one region" as stated in the description) toward the outside of said region, although there is no concave part in the vicinity of center of lid body, the flap can be easily opened.

Accordingly, it is natural that a person skilled in the art who recognizes the problems of the container of Kureha attempts to apply the lid body of Invention foods but is not used for heating foods. In addition, the hole part of Invention of Exhibit A6 is a mere vent hole which air goes through when forming a state of vacuum or normal pressure in the container. In contrast, a container of Kureha is the container for preserving foods, and for heating foods with lid in a microwave oven or the like, and the hole part is a hole which discharges the steam generated by foods in the container when heating. Accordingly, the vacuum preserving container relating to Invention of A Exhibit 6 and the container of Kureha are entirely different inventions in terms of use, function and technical field.

Moreover, to be different from the container as stated in Exhibit A7 and A8, it cannot be said that the container of Kureha is designed to contain the object in a state of powder. Furthermore, the container of Kureha is the container capable of being heated and the hole part is to discharge steam, while the container as stated in Exhibit A7 and A8 is not capable of being heated and the hole part is to pour powder contained articles outside. In this respect, the use, function and technical field of the two inventions are entirely different. Therefore, the container of Kureha and the container as stated in Exhibit A7 and A8 relate to different technical fields.

As mentioned above, since the container of Kureha and the container as stated in Exhibit A6-A8 relate to different technical fields, it cannot be said that a person skilled in the art can easily conceive of combining the two inventions.

B Plaintiff asserts that it is important to assort a wide variety of products so as to satisfy the tastes of consumers, as a supplier manufacturing and distributing containers for foods, and there is necessity of applying Exhibit A6 stating the flap in a shape different from that of the container of Kureha to the container of Kureha in order to diversify the shapes of

of Exhibit A6 to the container of Kureha, after encountering Exhibit A6, and thus there is strong motivation to combine both items. Therefore, a person skilled in the art could easily conceive of the constitution relating to the Invention 1, based on the container of Kureha and Exhibit A6. In addition, since the container for foods in a shape that the flap of outward-opening is integrally formed in a part other than marginal one of lid body is not only disclosed in Exhibit A6 but in Exhibit A7 and A8, it can be said that a person skilled in the art similarly attempts to apply the lid body as stated in Exhibit A7 and A8 to the container of Kureha. Therefore, a person skilled in the art could easily conceive of constitution relating to Difference 3 of the Invention 1, based on the container of Kureha, and Exhibit A7 and A8.	containers, and thus there is positive motivation to combine Exhibit A6-A8 with the container of Kureha. Though, similarity of problems, similarity of action and function, and suggestion in cited invention and the like can be indicated as factors for motivation to affirm the combination of multiple inventions, in addition to the relevance of technical field. Plaintiff abstractly asserts a generality that is not related to these factors, and the generality does not constitute the reasons for affirming positive motivation.

Judgment by the Court

5 Reason 1 - (1) for cancellartion (errors concerning determination on Difference 3 between the Claimed Invention 1 and the container of Kureha)

(1) Reason 1 - (1) for cancellation pertaining to the Claimed Invention 1 is discussed below.

...

D (A) ...

(B) ... It is recognized that the container of Kureha is a container for containing foods and for heating foods with a lid by a microwave oven or the like, and the hole part is a hole for discharging steam generated in foods in the container during heating, and the protruding part for closing the hole part and the opening and closing part equipped with the protruding part are provided for the purpose of maintainng sanitary conditions of the internal environment of the container by the closing hole part when preserving the foods in the container and of discharging steam or excess air in the container out of the container by the opening hole part during heating.

(C) Otherwise, it is recognized that Invention of Exhibit A6 is ... a container for keeping foods in a vacuum state in the container, and it is naturally assumed to keep in a vacuum state in the container, and the hole part is a hole as constituting parts (the vacuum-detective inlet port 5, the vent hole 4) relating to vacuum, and the seal segment 3 is an opening and closing part for closing the vent hole and for maintaining or releasing the vacuum state.

It should be said that, as a result, the container of Kureha and the container of Invention of Exhibit A6 relate to different technical fields, and the hole part, protruding part and opening and closing part of the container of Kureha are different from the vent hole 4, seal segment 3 and cover 7 of the container relating to the Invention of Exhibit A6 in terms of use and function, and thus there is no motivation to apply the Invention of Exhibit A6

to the container of Kureha.

(D) It is recognized that the container relating to Exhibit 7 is a container for powder and granular materials such as powdery coffee and sugar, granulated seasonings and foods, or powdery medicine and tablets, and is different from the container of Kureha, not being a container which can be heated with a microwave oven or the like. In addition, the container relating to Invention 7 has a lid body made capable of selecting take-out opening according to the quantity of use, in a way that, when taking contained articles from the container, the articles are taken, removing the lid body with a tool such as a spoon in case of using large quantity and are taken in such a manner as being poured from the opening part in case of using small quantity, and the pour spout is a hole for pouring objects in a powder state as contained articles outside, and a connected cylinder wall 3a and hinge lid 3 are to close or open pour spout 4a.

It should be said that, as a result, the container of Kureha and the container pertaining to Invention of Exhibit A7 relate to different technical fields, and the hole part, protruding part and opening and closing part of the container of Kureha are different from the pour spout 4a, connected cylinder wall 3a and hinge lid 3 of the container pertaining to Exhibit A7 in terms of use and function, and thus there is no motivation to apply the invention as stated in Exhibit A7 to the container of Kureha.

(E) According to the statement of the above 4 (2), the container pertaining to Exhibit A8 is a container containing powdery materials (finely divided solid material) and is not a container which can be heated with a microwave oven or the like as is the container of Kureha. Moreover, it is recognized that the hole a for distribution is a hole for shaking the powdery materials as contained articles out of the container, and the protruding part 35 and lid flap 27 are to open or close the hole a for distribution.

It should be said that, as a result, the container of Kureha and the container pertaining to Exhibit A8 relate to different technical fields, and the hole part, protruding part and opening and closing part of the container of Kureha are different from the hole a for distribution, protruding part 35 and lid flap 27 pertaining to Exhibit A8 in terms of use and function, and thus there is no motivation to apply the invention as stated in Exhibit A8 to the container of Kureha.

(F) As mentioned above, the container of Kureha and the container pertaining to Exhibits A6-8 belong to different technical fields, and the hole part, protruding part and opening and closing part of the container of Kureha are different from the corresponding parts of the container pertaining to Exhibits A6-8 in terms of use and function. Accordingly, it cannot be found any motivation daringly applying the invention as stated in Exhibits A6-8 to the container of Kureha which is different in terms of technical field, use and function.

... In request for trial for invalidation, as the reason 1 for invalidation, the plaintiff asserts that, the Invention 1 is, when compared with the container of Kureha, different in terms of Differences 1-3, but a person skilled in the art can easily conceive of the constitution pertaining to Differences 1-3 by replacing the inward-opening type with outward-opening type of Exhibits A6-8 concerning the opening and closing part (flap) of the lid of the container of Kureha, and thus it can be easily conceived, considering respectively easily conceiving based on the combination of the container of Kureha and Exhibit A6, that based on the container of Kureha and Exhibit A7 and that based on the container of Kureha and Exhibit A8.

The trial decision has determined that there is no special technical advantage in terms of the direction of opening and closing in view of Exhibits A6 and A7, considering that, in judgement on Difference 3, "with regard to containers, it is well-known that the 'base edge part' is the center side and 'tip part' is the marginal side (for example, Exhibist of A6 and A7) and the 'base edge part' is the marginal side and the 'tip part' is center side (for example, Exhibits of A4 and A5) and that either is timely selected. Accordingly, the direction of opening and closing of flap is not special." On the other hand, the trial decision has determined that the constitution of Invention 1 pertaining to Difference 3 cannot be easily conceived, without considering easily conceiving based on the combination of the container of Kureha and Exhibits A6-8 on considering whether a person skilled in the art can easily conceive of the constitution by reversing the direction of opening and closing of the flap. Therefore, it should be said that there was premature decision in the trial decision.

Although, as mentioned above A-D, there is no motivation to apply the inventions as stated in Exhibits A6-8 to the container of Kureha, and thus it is not considered that a person skilled in the art can easily conceive of the constitution such as the matter specifying the invention pertaining to Difference 3, by applying the inventions as stated in Exhibits A6-8 to the container of Kureha.

Therefore, as mentioned above, there was a premature decision in the trial decision. However, this point is not considered to affect the conclusion of the trial decision, and thus the above assertion cannot be adopted.

(43)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

Case	"System and method for prize competition" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 23, 2006 (2005 (Gyo KE) No. 10448)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2000-233126 (JP2002-49721A)
Classification	G06F 17/60
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Katsumi SHINOHARA, Mitsuru SHISHIDO, Yoshiaki SHIBATA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide a system for prize competition where a user can acquire information concerning prize gifts at the user's request. A server computer is provided with a database storing data of information concerning prize gifts; a means for displaying information concerning prize gifts on an information communication device; a means for prompting the input of personal information of a user containing at least an e-mail address, for the user who operates the information communication device; a means for storing said inputted personal information; a means for prompting the input of application for prescribed prize gifts as requested, for the user who operates the information communication device; a means for displaying a screen asking whether a user requests provision of information concerning prize gifts on the information communication device, when the input of application for prize gifts is made; and a means for sending an e-mail including information concerning prize gifts, when the input of request for provision of information concerning prize gifts is made.

(2) State of the art

(i) Citation (Cited Invention):"Win! the law of prize completion by using internet" (Author: Katsuhito Kiida, March 23, 2000, published by Ohmsha) (Finding of Trial Decision)

"A system for prize competition by using a personal computer connected to a wired and/or wireless network, comprising: a database storing data of information concerning prize gifts; a means for displaying information concerning prize gifts on the personal computer; a means for prompting the input of personal information of a user containing at least an e-mail address, for the user who operates the personal computer; a means for storing said inputted personal information; a means for prompting the input of application for prescribed prize gifts as requested, for the user who operates the personal computer; a means for storing the matter that the application for prescribed prize gifts has been made, in association with the user's personal information, when the input of the application for said prize gifts is made; a means for displaying a screen asking whether a user requests provision of information concerning prize gifts on the personal computer, when the input of application for prize gifts is made; a means for storing the matter that the user's request has been made, in association with personal information of said user, when the input of the request for provision of information concerning prize gifts is made; and a means for sending an e-mail including information concerning prize gifts to the e-mail address of the user who requests for provision of information concerning prize gifts." (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] "A system for prize competition by using an information communication device connected to wired and/or wireless network, comprising: a database storing data of information concerning prize gifts; a means for displaying information concerning prize gifts on the information communication device; means for prompting the input of personal information of a user containing at least an e-mail address, for the user who operates the information communication device; a means for storing said inputted personal information; a means for prompting the input of application for prescribed prize gifts as requested, for the user who operates the information communication device; a means for storing the matter that the application for prescribed prize gifts has been made, in association with user's personal information, when the input of the application for said prize gifts is made; a means for displaying a screen asking whether the user requests provision of information concerning prize gifts on the information communication device; a means for storing the matter that the user's request has been made, in association with personal information of said user, when the input of the request for provision of information concerning prize gifts is made; a means for sending an e-mail including information concerning prize gifts to the e-mail address of the user who requests for provision of information concerning prize gifts; means for determining whether a receipt of responding e-mail is the application for said prize gifts for which information is provided, when said response mail is sent to said e-mail address."

(4) Procedural History

August 1, 2000	:	Filing of Patent Application
August 30, 2002	:	Amendment of Proceeding (See above "The Claims")
September 26, 2002	:	Decision of Refusal
November 7, 2002	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-21640)
March 15, 2005	:	Trial Decision that "the request of appeal is dismissed."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">"(Differences)
The point that the claimed invention sets up "means for determining whether a receipt of response mail is the application for said prize gifts for which information is provided, when said response mail is sent to said e-mail address (after sending an e-mail including information concerning prize gifts to the e-mail address of the user who requests for provision of information concerning prize gifts).
On the other hand, the invention as stated in Citation 1 sets up "means for sending an e-mail including information concerning prize gifts to the e-mail address of the user who requests for provision of information concerning prize gifts," but it is not clear whether the mail itself plays a role of an advertisement for prize competition or otherwise information including prize gifts is only sent by a mail, and the invention as stated in Citation 1 does not state "means for determining whether a receipt of response mail is the application for said prize gifts for which information is provided, when said response mail is sent to said e-mail address."
"Generally, when selling/purchasing goods, it is well-known as business practice that a customer purchases desired goods by willingly accessing goods and a customer purchases desired goods among proposed goods after a seller proposes goods to registered customers (for example, sales of goods by using DM).
Moreover, it is well-known to use a responding e-mail as the response to e-mail, and Citation 1 states the application for prize competition on the Internet by using e-mail.
Therefore, the competition prize system as stated in Citation 1 is based on an assumption that a user accesses advertisement for prize competition (that is, a user accesses the web page of an advertisement for prize competition), as well as the advertising side for competition prize advertises prize competition to registered customers, and for this reason, it is recognized that a person skilled in the art can easily conceive of providing a role for advertising prize competition with an e-mail including the information concerning prize gifts sent to the e-mail address of a user, and of using responding e-mail (in other words, 'means for determining whether a receipt of response mail is the application for said prize gifts for which information is provided, when said response mail is sent to said e-mail address') as the response to the e-mail (in other words, application for prize competition).
In addition, the effect of the invention pertaining to Claim 1 of the application is within a range as naturally foreseeable from the invention as stated in above Citation 1 and well-known technology, and is not especially outstanding."</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
"To use responding e-mail as the response to e-mail" is well-known in the technical field of regular network via e-mail but not well-known in the technical field of e-mail network in the system for</td><td>Allegations by Defendant
Plaintiff asserts that "to use responding e-mail as the response to e-mail" is well-known in the technical field of regular network via e-mail but not well-known in the technical field of e-mail network in the system</td></tr>
</table>

prize competition. In addition, Citation states "there is application made by using e-mail, in prize competition on the Internet," but does not state how to use e-mail when applying for prize completion on the internet, it is not disclosed and suggested to use responding e-mail on application for prize completion on the Internet. ...	for prize competition. In addition, Citation states "there is application made by using e-mail, in prize competition on the internet," but does not state how to use e-mail when applying for prize completion on the Internet, it is not disclosed and suggested to use responding e-mail on application for prize completion on the Internet. However, it is well-known to use responding e-mail as the response to e-mail, not only on a regular e-mail network but also a network by e-mail of a service providing system on the internet, and it is a well-known technical matter to use responding e-mail to the e-mail providing information of services as the application for said services. To be specific, the publication of B3 states the matters of sending e-mail including information concerning services to the e-mail address of the user who requests provision of the information concerning services and of determining as the input of the application for the services whose information is provided, when responding e-mail is sent to said e-mail, and the publication of B4 states the matters of sending e-mail including the information concerning services and of determining as the input of the application for the services whose information is provided, when responding e-mail is sent to said e-mail. Therefore, a person skilled in the art can easily conceive of determining the responding e-mail sent to e-mail including the information concerning prize gifts as the application for prize gifts; in other words, as the application for an advertisement, by applying well-known technology to the cited invention.

Judgment by the Court

There is no dispute among the parties concerned that it is a well-known technical matter "to use a reply e-mail in response to an e-mail," and as mentioned above in 1 (1) B, the citation realtes to a system using telecommunications with a personal computer and an e-mail. Thus, since the cited invention utilizes an e-mail,

a person skilled in the art can easily conceive of adopting the constitution as using "the receipt of a reply e-mail, when said reply e-mail is sent to said e-mail address" among "a means for determining whether a receipt of a reply e-mail is the application for said prize gifts for which information is provided, when said reply e-mail is sent to said e-mail address" as a difference between the claimed invention and the cited invention, and there is no special impediment to the use.

Next, concerning "a means for determining whether a receipt of a reply e-mail is the application for said prize gifts for which information is provided," it is the matter to be properly arranged artificially according to the aspect of the business transaction by the person implementing a prize competition on the internet that what kind of reply from a user constitutes the input of the application for the prize competition, and there is no room for discussing the technical problems.

By the way, there is no dispute among the parties concerned that it is well-known as business practices that generally, when selling or purchasing goods, customers purchase desired goods by willingly accessing the goods, and they purchase desired goods among the goods proposed by the seller to registered customers (for example, the sales of goods by using DM). Considering non-dispute business practices, with regard to the cited invention equipped with "a means for sending an e-mail including the information concerning prize gifts to the e-mail address of the user who requests for provision of information concerning prize gifts," in terms of what kind of reply from a user constitutes the input of the application for prize competition, when sending an e-mail including information concerning prize gifts to the e-mail address of a user, it is the matter to be properly arranged artificially according to the aspect of the business transaction "to determine the receipt of a reply e-mail as the input of the application for the prize gifts whose information is provided, when said reply e-mail is sent to said e-mail."

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

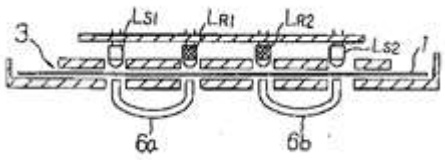
1. Bibliographic Items

Case	"An optical detecting part of a discrimination device for paper sheet" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, June 29, 2006 (2005 (Gyo KE) No.10490)
Source	Website of Intellectual Property High Court, HANREI TIMES No. 1229, Page 306
Application No.	Japanese Patent Application No. H6-322201 (JP H8-180237A)
Classification	G07D 7/12
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Katsumi SHINOHARA, Judge: Mitsuru SHISHIDO, Judge: Yoshiaki SHIBATA

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



The claimed invention relates to an optical detecting part of a discrimination device for a paper sheet, capable of being set in a limited narrow setting space and of efficiently sampling optical data from a paper sheet. In an optical detecting part, light-emitting elements LS1, LS2 and light-receiving elements LR1, LR2 are respectively arranged in a substrate of one side in the vicinity of a conveying path 3, in these elements where a paper money 1 is conveyed, between the light emitting elements LS1 and the light receiving elements LR1, and between the light-emitting element LS2 and the light-receiving element LR2 are optically connected respectively by fiber optic 6a, 6b as light guides part arranged on the other side in the vicinity of the conveying path 3, concerning irradiation light emitted by each of light emitting elements LS1, LS2, transmitted light attenuated by transmitting through two points of paper money 1 being conveyed is detected by each of light receiving elements LR1, LR2. There, absorption quantity in light energy

changes depending on shades in printing part of paper money 1. Thus the data for discriminating and determining paper money 1 are obtained by detecting this change.

(2) State of the art

(i) Citation (Cited Invention): Microfilm of Japanese Utility Model Application No. S60-141873 (JP S 62-051461U)

(Finding of Trial Decision)

"a device for detecting layered-state of a paper sheet, being equipped with an optical detecting part comprising light-emitting elements emitting an irradiated light irradiating a part of a paper sheet conveyed in a prescribed direction, a light guide part optically connected as irradiating other than a part of the paper sheet with transmitting light where said irradiated light transmits a part of said paper sheet, and light-receiving elements receiving transmitting light transmitting through said other than a part of said paper sheet, said light-emitting elements, and consisting of said light guide part and said light-receiving elements, being respectively arranged at another position in a conveying path for conveying said paper sheet"

(3) The Claims (Claimed Invention)

[Claim 1] A optical detecting part of discrimination device for a paper sheet, comprising, light-emitting elements emitting an irradiated light irradiating a part of a paper sheet conveyed in a prescribed direction, a light guide part optically connected as irradiating other than said part of paper sheet with transmitting light where said irradiated light transmits through a part of said paper sheet in the direction perpendicular to said prescribed direction, and light-receiving elements receiving a transmitting light transmitting through another part of said paper sheet, and consisting of said light-emitting elements, said light guide part, and said light-receiving elements, being respectively arranged at another position in the vicinity of a conveying path for conveying said paper sheet.

(4) Procedural History

December 26, 1994	:	Filing of Patent Application
November 15, 2002	:	Amendment of Proceeding (See above "The Claims")
August 14, 2003	:	Decision of Refusal
September 19, 2003	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-18348)
April 12, 2005	:	Trial Decision that "the request for appeal is dismissal."

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

Trial Decision
"Generally, when discriminating a paper sheet, a person skilled in the art could easily conceive of selecting a characteristic part of a paper sheet. Therefore, in the invention as stated in Citation, in case of irradiating other than a part of said paper sheet with transmitting light that transmits through a part of a paper sheet, it is mere modification of design to irradiate

other than said part of paper sheet in the direction perpendicular to said prescribed direction." (cited from the Court Decision)

Decision

Allegations by Plaintiff

As mentioned above in (2), the claimed invention generates action and effect as discriminating authenticity, etc. of a paper sheet in high precision by efficiently sampling optical data from a conveyed paper sheet. Detection lines number two and then, in case of altered notes in a way that real money paper is cut in half in a longer direction and white paper is pasted to the cut part, alteration cannot be recognized if there is one detection line, while alteration can be recognized if there are two detection lines. In this way, in the claimed invention, discrimination and determination can be precisely performed by obtaining the data of transmitting light at two points by means of a pair of sensors. Compared with cited invention, since there are two detection lines in the direction of conveyance of the paper sheet where irradiated light transmits, the action and effect is generated in which discrimination of the paper sheet can be made twice as precise. Therefore, it cannot be said that there is no special difference between one detection line and two detection lines in terms of action and effect.

From the first, "mere modification of design" means the modification of well-known technology, etc. with regard to the constitution and the means. In addition, it should be said for the case that there no special difference generated in terms of the purpose and the action and effect, and thus it is apparent that the claimed invention does not fall under the above matters.

Allegations by Defendant

Even if, as plaintiff's assertion, detection line of cited invention is one, since measurement light transmitting a part of paper sheet is irradiated to other than the above one part in the invention in which cited invention is applied to an optical detective part of a discrimination device for a paper sheet, the discrimination of a paper sheet is made in a way measurement light transmits at two points in the direction of conveyance of paper sheet. In addition, until a part of the paper sheet to which measurement light is firstly irradiated comes at the position of light-receiving elements, this part and the other part, even if detection line is one, are not at the same place. For this reason, measurement light always transmits at two different points, similarly as when detection lines number two. Moreover, even after a part of the paper sheet to which measurement light is firstly irradiated passes the position of light-receiving elements, this part is always a new place where measurement light has never transmitted, and thus the combination of this part and the other part does not conform to the place where measurement light has ever transmitted. Therefore, since there is no special difference between one detection line and two detection lines in terms of action and effect, it is mere modification of design to make two detection lines.

Judgment by the Court

The cited invention has a constitution that is common to the claimed invention, such as "an optical detecting section comprising light-emitting elements emitting an irradiated light irradiating a part of paper sheet conveyed

in a prescribed direction, a light guide member optically connected as irradiating other than a part of a paper sheet with transmitting light where said irradiated light transmits a part of said paper sheet, and light-receiving elements receiving a transmitting light transmitting said other than a part of paper sheet, and in which said light-emitting elements, said light guide section and said light-receiving elements are respectively arranged at difference positions in a conveying path for conveying said paper sheet". However, as long as it is a device for detecting layered-state of paper sheet, ... it is to merely transmit irradiated light with a paper sheet, to detect the number of sheets of paper and to detect any part of sheets of paper. there is no room for technical ideas of multiple detecting lines.

The above determination of the trial decision perhaps has the idea that a device for detecting the layered-state of paper sheets and a discrimination device for paper sheets fall under the common or closely related technology.

However, while the former detects the number of sheets of paper by using an increase of the difference of the measuring light amount received by the receiving means, the latter discriminates paper sheets by using the transmitting light containing the information such as printed pattern or colors obtained by transmission of a detection part of the paper sheet. Although the two are common in terms of the constitution such as "an optical detecting section comprising light-emitting elements emitting an irradiated light irradiating a part of a paper sheet conveyed in a prescribed direction, a light guide member optically connected as irradiating other than a part of paper sheet with transmitting light where said irradiated light transmits a part of said paper sheet, and light-receiving elements receiving a transmitting light transmitting said other than a part of paper sheet, and in which said light-emitting elements, said light guide part and said light-receiving elements are respectively arranged at different positions in a conveying path for conveying said paper sheet". However, it should be said that there are not a few differences in terms of function, action, and concrete technology. Accordingly, although a device for detecting layered-state of paper sheets and a discrimination device for paper sheets belong to relevant technical fields, the difference cannot be overlooked. Thus, for saying that, concerning the constitution, a device for detecting layered-state of paper sheets can be easily replaced by a discrimination device for paper sheets, there is necessity of some degree of motivation, and it is not considered to be mere modification of design.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

Case	"Pinball game machine" (Trial for Correction) Intellectual Property High Court Decision, July 30, 2007 (2006 (Gyo KE) No. 10483)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H11-315495 (JP 2001-96019A)
Classification	A63F 7/02
Conclusion	Dismissal
Related Provision	Article 29(2), Article 126(5)
Judges	IP High Court Third Division, Presiding Judge: Toshiaki IIMURA, Judge: Ichiro OTAKA, Judge: Kazuhide SHIMASUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a pinball game machine having a backup execution control section that performs processing for preventing loss of game information stored in game information storage means in case of detection of an irregularity of a power voltage drop due to power shutdown.

(2) State of the Art

(i) Publication A (Cited Invention): JP H6-71028A

"...from paragraph [0121] and FIG. 29, etc., it is admitted that, in the cited invention, after "power failure storage" (storage showing a state of processing at the time of detection of a power failure (at the time of execution of power failure interrupt processing) and occurrence of a power failure) is executed by means of "power failure interrupt processing" performed by the discharge controller 58, operation of the discharge controller 58 is ceased by a stop command "STOP."" (Cited from the Decision)

"...stating "as shown in FIG. 33, an access to the backup data storage area 595 is inhibited simultaneously with setting of a power shutdown flag, and the program can be left unable to return to a main job routine after completion of backup processing by insertion of the stop command (STOP) or setting of an infinite loop. This

makes it possible to yield the following effects. After completion of backup processing (1) ...(2), the voltage of auxiliary power is maintained for a given period of time, and continued processing of a program is possible. However, the auxiliary power voltage becomes unstable, normal operation of the program becomes difficult. In extreme cases, the program will run away, which may in turn result in corruption of data in the backup data storage area 595. However, if the program is ceased as mentioned above, occurrence of such a glitch can be prevented." (paragraph [0179]) ..." (Cited from the Court Detection)

(ii) Common General Knowledge

"...When a certain program has entered an "infinite loop," the computer becomes impossible to execute another processing because the program cannot complete processing indefinitely, so that the computer will substantially be shut down. This is admitted to be common general knowledge." (Cited from the Decision)

(3) The Claims (After correction)(Corrected Invention)

[Claim 1] A pinball game machine ... wherein ... a processing routine for writing the irregularity determination information into the irregularity determination information storage means is a sub-routine by means of which a CPU of the backup execution control section voluntarily makes an access at predetermined timing to another input-output circuit to which the CPU is connected and which is executed when an irregularity detection input is input to the input-output circuit at the time of the access; the CPU is guaranteed to perform the operation for a given period of time by means of an auxiliary power source even after completion of backup processing; and the sub-routine is set such that the main program does not return to the main job routine in the given period after completion of backup processing by means of setting of the infinite loop; and

when the power switch of the pinball game machine is turned off, an end signal is generated, and backup processing is hindered by means which inhibits generation of the irregularity determination information by the end signal.

(4) Procedural History

January 5, 1999	:	Patent Application (the date of priority claimed: November 9, 1998)
August 15, 2003	:	Registration and establishment of a patent right
April 14, 2006	:	Trial for Correction (Correction of the Case) (Teisei No. 2006-39055) (See "The Claims" above)
September 20, 2006	:	The appeal decision stating that the trial for correction shall not lie.

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

Appeal Decision (cited from the Court Decision)
...the amended invention can be easily conceived by a person skilled in the art on the basis of the inventions stated in JP H6-71028A (...hereinafter called "Publication A"...), JP H8-202633A (...hereinafter called "Publication B"...), and JP H10-234990A (...hereinafter called "Publication C"...) and well-known matters. Since the invention cannot be independently granted a patent under the provision of Article 29(2) of the Patent Act, the trial for correction does not conform to the provision of Article 126(5) of the Patent Act.

The trial decision admitted existence of a Difference as will be described below, when compared with the inventions stated in the amended invention and the invention (...called "cited invention") stated in Publication A.

(Difference 2)

A Difference lies in that, when an irregularity of a power voltage drop occurs, the amended invention performs ... (ii) processing in which the main program does not return to the routine of the main job after backup processing is performed through an infinite loop and that..., by contrast, ... (ii) it is uncertain whether or not the cited invention performs through, an infinite loop, processing in which the program does not return to the routine of the main job after backup processing.

...about a Difference 2(ii), ...since a routine work other than the sub-routine of the interrupt processing is not executed, it is obvious that the program does not return to the main routine even after completion of the sub-routine. Hence, ...adopting the infinite routine as means for preventing the program from returning to the main routine is only a matter that a person skilled in the art can adopt as necessary. ...therefore, any remarkable working-effect attributable to adoption of the infinite routine is not admitted.

Decision

Allegations by Plaintiff	Allegations by Defendant
...when backup processing is completed, operation of the program is usually stopped by the stop command "STOP" to prevent from the program returning to the main routine. On the contrary, in the amended invention, the program is continuously held unable to return to the main routine for a given period even after completion of backup processing by means of setting of the "infinite loop" (processing is iterated after completion of backup processing). As mentioned above, Publications A through C...and JP H5-35614A (...called "Known Publication D"...) or JP H4-303225A (...called "Known Publication E"...) do not state or suggest such a configuration (of the amended invention about a Difference 2(ii)) for performing processing which prevents the program from returning to the routine of the main job for a given period after completion of backup processing by means of an infinite loop. ...In the amended invention, when there is, other than main job, processing required after completion of backup processing, there is yielded a working-effect	(A) (1) In the state of a power failure; namely, when power is turned off, electrical equipment does not operate. This is common general knowledge. Therefore, when electric equipment operates in a state of power shutdown, the operation is backed up by a backup power source, etc. This is a natural matter of technique. (2) In light of the fact that Publication A does not state processing operation of the CPU to be performed after completion of the sub-routine of power failure interrupt processing, the CPU does not need to be operated after completion of the sub-routine of power failure interrupt processing, serving as countermeasures against a power failure, in the cited invention. Therefore, it is understood that the CPU does not operate after completion of the sub-routine. (B) Paragraph [0179] of the description of the present case states that "(2) ... continued processing of a program is possible. However, the auxiliary power voltage becomes unstable, normal operation of the program becomes difficult. In extreme cases, the program will run away, " Thus, there is a negative

of processing being able to be performed in iteration of the routine of the infinite loop. The working-effect is a special effect which can never be yielded when the operation of the program is stopped by the stop command "STOP" after completion of backup processing, as performed in connection with the cited invention. Therefore, the decision stating that "any remarkable working-effect ... is admitted" due to adoption of the configuration of the amended invention of Difference 2(ii) is faulty.	description about causing the program to perform processing after backup processing; namely, causing the program to perform processing through an infinite loop. Therefore, "...working-effect" alleged by Plaintiff is not special.

Judgment by the Court

...it is comprehensible that the cited invention adopts the stop command "STOP" as a means of "preventing the program from returning to the main routine" after a completion of a "power failure interrupt process" that is a backup process at the time of the power failure.

...at the time of the priority date of the claimed invention, ...it is admitted as the common general knowledge when a certain program enters an infinite loop, the program does not end indefinitely, resulting in making the computer unable to execute another processing and substantially halted.

In light of the common general knowledge mentioned above, it is obvious for a person skilled in the art if the "infinite loop" is adopted at the end of the sub-routine, the routine does not end indefinitely, so that execution of the main routine and other processing becomes impossible, which implements the same function as that of the stop command "STOP."

It is merely a design variation which can be properly performed by a person skilled in the art who has come to know Publication A (Exhibit A1), that in the cited invention, the "infinite loop" (the configuration of the amended invention of Difference 2(ii)) is adopted in place of the stop command "STOP," means for "preventing the program from returning to the main routine" after completion of the "power failure interrupt processing," which is backup processing at the time of a power failure. Therefore, it is admitted to be easily conceivable.

...preventing the CPU from operating after a completion of a backup process by stopping the program is achieved even by "insertion of the stop command "STOP"" as described in paragraph [0179]. This cannot be said that it is a remarkable working-effect yielded by "setting the infinite loop."

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

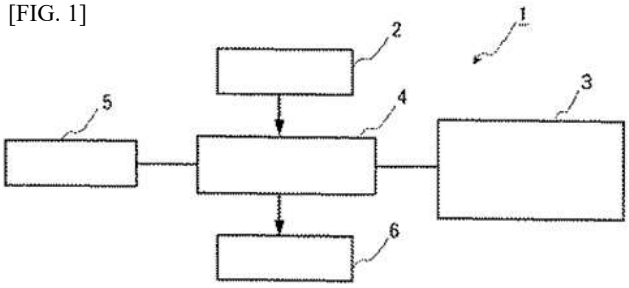
Case	"A processing system of scholarship provision for life insurance subscribers and its processing method" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 29, 2009 (2009 (Gyo KE) No. 10090)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2003-64295 (JP 2004-272720A)
Classification	G06F 17/60
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Hiroaki IMAI, Judge: Tomoko MANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide a processing system of scholarship provision for insured members that rapidly provides a scholarship for a child of an insured member insured by life insurance. The processing system of scholarship provision for insured members, comprises: a means 3 for storing the contract information that stores the information of insurance contract of insured members; an input means 2 for inputting either of application information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments, or payments completion information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments; an arithmetic processing part 4 for retrieving existence of a child that attends school at any time of insured member's death, having advanced injury, or being in need of care, based on any of said application information or any of said payments completion information that is inputted by said input means; and output parts 5, 6 for outputting at least a name and an address of said child if the child that attends school exists.

[FIG. 1]



2 INPUT PART
3 PART FOR STORING CONTRACT INFORMATION OF CUSTOMERS
4 ARITHMETIC PROCESSING PART
5 DISPLAY PART
6 PRINT PART

(2) State of the art

(i) Publication 1 (Cited Invention): JP 2003-044666A (Finding of Trial Decision)

"A system providing living information for insured members is to provide the information (living information) necessary for living environment of insured members and their families, based on the information obtained from insured members at the time of contract or maintenance and modification, and comprises: a means for storing contract information that stores the information of insurance contracts of insured members; a means for inputting the information of maintenance and modification; a processing means for retrieving the personal information necessary for provision of living information from personal information of insured members and their families based on inputted information of maintenance and modification; a means for providing information on the web or by postal mail, obtaining the information necessary for living environment of insured members and their families." (cited from the Court Decision)

(3) The Claims (Claimed Amended Invention)

[Claim 1] A processing system of scholarship provision for insured members that provides scholarship for a child of an insured member insured by life insurance, comprising: a means for storing contract information that stores the information of insurance contract of insured members; an input means for inputting either of application information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments, or

payments completion information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments; an arithmetic processing part for retrieving existence of a child from the information concerning insurance contract of said insured members at any time of insured member's death, having advanced injury, and being in need of care, based on any of said application information or any of said payments completion information that is inputted by said input means and also, in case that child exists, calculating the age of said child from the age or birth date at the time of contract to retrieve whether said child attends school; print and/or display parts for outputting at least a name and an address of said child, and the letter of a guide for said child of scholarship provision stored in insurance contract information of the assured member if it is found that the assured member has a school attending child as a result of the search by the arithmetic processing part.

(4) Procedural History

March 11, 2003	:	Filing of Patent Application
May 24, 2005	:	Decision of Refusal
June 20, 2005	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2005-11606) Amendment of Proceeding (The Amendment. See above "The Claims")
February 20, 2009	:	The above amendment of proceeding is rejected, Trial Decision that "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">"In light of the situation that it is well-known that an insurance company provides scholarship or supports the provision of scholarship at the time of the filing date of the application, a person skilled in the art can easily conceive of the system that makes scholarship provided if there is a child that attends school, in cases where material change in circumstances of an insured member occurs. In addition, as material events for maintenance and modification connected to scholarship provision, the person skilled in the art can naturally conceive of application information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments, or payments completion information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments." (cited from the Court Decision)</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The claimed invention is equipped with "a means for inputting application information concerning any of death benefits, insurance payments in case of advanced injury, and care insurance payments or a payment completion information concerning any of death benefits, insurance payments in case of</td><td>Allegations by Defendant
According to the cited invention, obtaining and storing of information concerning insurance contract, obtaining and input of information concerning maintenance and modification, retrieval of necessary personal information, obtaining of necessary living information, and presentation and print of living</td></tr>
</table>

advanced injury, and care insurance payments." On the other hand, the cited invention is equipped with "a means for inputting the information of maintenance and modification." The "information of maintenance and modification" in the cited invention is modification information as presuming the continuation of a contract, while the "application information and payments completion information" in the claimed amended invention means "contract performance information or the information concerning completion of contract performance," and is inherently different information. Therefore, "an input means" pertaining to the claimed amended invention and "an input means" pertaining to the cited invention are different.	information, when the design of the provision system for living information relating to cited invention is modified so as to provide such services as stated in the claimed amended invention, technical problems to be solved and technical difficulty are not found. Thus, it is considered that "the constitution relating to differences is within a range that a person skilled in the art can easily conceive of." In this way, the trial decision deduced the conclusion as easily conceived from the finding of fact based on evidence and the comprehensive evaluation based on rational inference, and is reasonable.

Judgment by the Court

In light of the situation that it is well-known that an insurance company supports provision of scholarship and provides scholarship by establishing an incorporated foundation, it is understood that a person skilled in the art can naturally conceive that an insurance company directly provides scholarship if there is a child that attends school, in cases where any material change in circumstances of an insured members occurs. In addition, as above material change, the person skilled in the art can naturally conceive that there are death benefits payments or the like as indicated in the claimed amended invention.

B Moreover, as indicated in above 2 (1) A (B), Publication 1 (Exhibit A1) stating the cited invention states that "… various guides of national, municipal, and private junior high schools, high schools, and universities can be displayed depending on every age of child's admission year. Furthermore, messages for celebration for every family's or child's birthday can be displayed. ...," (Paragraph [0050]) and as stated in Figure 3 as indicated in (C) of the same, considering that the constitution of family, sex, age, hobby, and the like are stated as the information registered by customers, it is understood that the cited invention is equipped with the function for obtaining and printing the information deemed to be necessary, by retrieving the personal information of insured members and their families. Therefore, with regard to the cited invention, since there is no special technical problem in making the information to be inputted to be the information of insurance payments or the like as stated in the claimed amended invention and making the information to be printed and provided to be the guides of scholarship provision, as a result, it is recognized that the differences of these constitution are within a range of the matter of design variation that a person skilled in the art can easily conceive of. Thus, there is no error in the trial decision which has determined that the constitution relating to the differences can be easily conceived.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	Suggestion based on the content of the cited invention

1. Bibliographic Items

Case	"Petrolatum-based nasal ointment" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, September 8, 2011 (2010 (Gyo KE) No. 10296)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2136, page 107, HANREI TIMES No. 1382, page 303
Application No.	Japanese Patent Application No. 2000-257825 (JP 2001-342131A)
Classification	A61K 31/01
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to a nasal ointment to provide a prophylactic for allergic reaction to inhalation, comprising at least one mixture of saturated hydrocarbons, the ointment being safe and having extensive action, comfortable usability and low treatment cost, and the mixture being characterized by having the viscosity of a certain value or greater.

(2) State of the Art

(i) The Citation (the Cited Invention): DAS No. 4117887 (Published on December 12, 1991) (Identification of the Appeal Decision)

...a "nasal ointment to prevent allergic reaction to inhalation, comprising a publicly known mixture, gelatinous at room temperature, of basically consisting of saturated hydrocarbons" (cited from the court decision)

(ii) Well-known Art (Identification of the Court Decision)

"...according to the Handbook of Pharmaceutical Excipients (Exhibit A41), a petrolatum can be said to be a mixture of saturated hydrocarbons. Moreover, a petrolatum is stated to be characterized by having a viscosity at

98.9 °C of "60-75 S.U.S.* in case of white petrolatum and 57-82 S.U.S.* in case of yellow petrolatum (*Saybolt Universal Seconds)"..., and when converted using 1 S.U.S. = 0.2158 mm^2/sec, the above viscosity is 12.9-16.2 mm^2/sec in case of white petrolatum, and 12.3-17.7 mm^2/sec in case of yellow petrolatum.

Thus, the viscosity of petrolatum used for a medicament at 98.9 °C is, for example, in the range of 13-16 mm^2/sec in case of white petrolatum, which is not thought to be greatly different from that when measured by the DIN51 562 method (100°C). Therefore, a mixture of saturated hydrocarbons having a viscosity of 8 mm^2/sec or greater when measured by the DIN51 562 method at 100°C can be said to be a material well-known before the priority date as a petrolatum to combine into a medicament." (Cited from the court decision)

(3) The Claims (Amended) (the Claimed Invention)

[Claim 1] A prophylactic nasal ointment to prevent allergic reaction to inhalation, comprising at least one mixture of saturated hydrocarbons, and at least one optionally added additive for procedure, the mixture being characterized by having a viscosity of 8 mm^2/sec (100°C) or greater by the DIN51 562 method.

(4) Procedural History

August 28, 2000	:	the patent application (the date from which priority is claimed: May 31, 2000, in Germany)
January 19, 2006	:	amendment (see "The Claims" above)
February 21, 2006	:	the decision of refusal
May 29, 2006	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2006-11063)
May 6, 2010	:	the appeal decision that "the request of the trial and appeal of this case does not materialize"

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">...the reason of the appeal decision of this case is, in essence, that the claimed invention, ..., based on the invention stated in the citation, could be easily invented by a person skilled in the art, and therefore, a patent could not be granted thereto in accordance with the regulation of Article 29(2) of the Patent Act.
...the difference between the claimed invention and the cited invention was identified as follows.
C Difference 1: at least one mixture of saturated hydrocarbons has a viscosity of 8 mm^2/sec (100°C) or greater by the DIN51 562 method in the claimed invention, whereas such mixture is a publicly known material that is gelatinous at room temperature in the cited invention.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) About the Cause of Motivation and Viscosity</td><td>Allegations by Defendant
(1) About the Cause of Motivation and Viscosity</td></tr>
</table>

A What characterizes the claimed invention The claimed invention is essentially characterized in that, by focusing attention on the "viscosity" among the parameters of a publicly known mixture comprising saturated hydrocarbons, and choosing a constitution having a "viscosity" of "8 mm^2/sec (100°C) or greater," an effect was produced by which allergic reaction can be truly prevented via "a certain physical character" arising from that viscosity ...." Namely, although it was commonly known in the relevant industry that the cited invention was ineffective in the prevention of allergic reaction and posed a danger to the body, the inventor(s) of the claimed invention had his/her unique technical idea to, by adjusting the viscosity of a publicly known mixture comprising saturated hydrocarbons, via the physical character thereof, try to truly develop a prophylactic effect on allergic reaction. Under such technical idea, for the first time, he/she truly succeeded in preventing allergic reaction in a way that the "viscosity" of the publicly known mixture comprising saturated hydrocarbons was adjusted to make it more viscous, and as a result, via the "certain physical character," without penetrating the nasal mucosa, the mixture remained at the same place as a protective film to produce a mechanical barrier against allergen carriers. B The Cause of Motivation In Examples 1 and 3 of the citation, there is no description about the "viscosity" at all. ...it is apparent that the citation has no purpose to adjust the viscosity and confirm the prophylactic effect on allergic reaction; the viscosity is "6 mm^2/sec (100°C)", and there is no disclosure or suggestion at all of 8 mm ^{2}/sec or greater (100°C) of the claimed invention.	A For a "publicly known mixture, gelatinous at room temperature, of basically consisting of saturated hydrocarbons" in the cited invention, is used a "mixture of hydrocarbons defined pharmaceutically/cosmetically as 'petrolatum'." This "petrolatum" ...is widely used as a base for medicinal ointments." The viscosity of the petrolatum used for pharmaceutical formulation is in the range of 8 mm^2/sec or greater by DIN51 562 (100°C), and therefore, it is apparent that the above "mixture of hydrocarbons defined pharmaceutically/cosmetically as 'petrolatum'" used for the "publicly known mixture, gelatinous at room temperature, of basically consisting of saturated hydrocarbons" ...in the cited invention includes those of 8 mm^2/sec or greater.... Based on the entire description of the citation, the purpose and effect of the cited invention is accomplished basically by a mixture of saturated hydrocarbons that "remains gelatinous at room temperature," and such saturated hydrocarbons include the "petrolatum" widely used in the relevant technical field, and therefore, the "publicly known mixture consisting of saturated hydrocarbons" in the cited invention, when is expressed in terms of viscosity, is a mixture of saturated hydrocarbons having a viscosity of 8 mm^2/sec or greater. Thus, even if there is no direct description about the use of petrolatum having a viscosity of 8 mm^2/sec or greater in the citation, a person skilled in the art, upon encounter of the description of the citation, as far as there is a description of the specific use of the "mixture of saturated hydrocarbons that remains gelatinous at room temperature" in the cited invention, it is apparent that the use of a petrolatum, the viscosity of which is 8 mm^2/sec or greater, is suggested .... B In citation, the use of a petrolatum, the viscosity of which is 8.0 mm^2/sec or greater, is

C The Relation to the Viscosity Range of the Widely Used Petrolatum In addition, the claimed invention is characterized in that... Without such finding, it cannot be said that the citation can be easily devised from the claimed invention, only because some of the commercially available petrolatum has by chance the viscosity corresponding to that defined in the claimed invention. The novelty characteristic of the claimed invention lies in the finding in which attention was focused on the viscosity of the saturated hydrocarbon compounds, while the citation includes no suggestion at all that any trial has been done to prevent allergic reaction by adjusting the viscosity. The judgement of the appeal decision of this case is merely an afterthought based on the current knowledge. Unless an analytical approach in an ex-post manner for decision is employed, a person skilled in the art cannot start with the citation to reach to said novelty characteristic of the claimed invention.	suggested for the "mixture of saturated hydrocarbons that remains gelatinous at room temperature" of the cited invention. The cited invention can select a "mixture of hydrocarbons defined pharmaceutically/cosmetically as 'petrolatum'" for a "publicly known mixture, gelatinous at room temperature, of basically consisting of saturated hydrocarbons." As described in Prior Art in the citation, petrolatum is an additive widely used in the field of pharmaceutical formulation such as ointment, and is not the one that "has by chance a viscosity corresponding to that defined by the claimed invention."

Judgment by the Court

A Difference 1 between the claimed invention and the cited invention lies in that at least one mixture of saturated hydrocarbons is the one having a viscosity of 8 mm^2/sec (100°C) or greater according to DIN51 562 in the claimed invention vs. the one publicly known that is gelatinous at room temperature in the cited invention.

B In the citation, there is a description that "it is known that as long as a gel-like viscosity at room temperature is provided, the purpose of this invention can be attained by any mixture consisting of substantially saturated hydrocarbons. ...similar to various types of petrolatum, the action by this invention is provided." Also in Test Example 1 to 3, there is a description that a nasal ointment using yellow petrolatum, white petrolatum and soft paraffin prevents allergic reaction to inhalation. Therefore, it is recognized that, in the citation, the suggestion is stated that a nasal ointment comprising a mixture, which is gelatinous at room temperature and has other various physical properties, basically consisting of saturated hydrocarbons is useful for prevention of allergic reaction to inhalation.

C Thus, the use of petrolatum, well-known before the priority date as mentioned above (1), having a viscosity of 8 mm^2/sec or greater measured at 100°C according to DIN51 562 for a mixture of saturated hydrocarbons, gelatinous at room temperature, as a component of the nasal ointment used for prevention of allergic reaction to inhalation is not said to be a matter that requires exceptional inventive idea for any person

skilled in the art.

(3) About the Allegation of the Plaintiff

A About Motivation and Viscosity

The plaintiff alleges that, for example, there is no suggestion in the citation that an allergic reaction will be prevented by adjusting the viscosity of a mixture of saturated hydrocarbons, and therefore, there is no motivation to arrive the present invention from the description of the citation, and the judgement of the appeal decision of this case is merely an afterthought.

In Claim 3 of the citation, ..., although there is a description, by which, the viscosity can be understood to be one of the physical properties to identify a mixture of saturated hydrocarbons, definitely no direct suggestion exists to focus attention on the viscosity of the mixture of saturated hydrocarbons in relation to the prevention of an allergic reaction to inhalation.

However, in the first place, even in the specification of the application concerned, there is no description that is recognized that the value of 8 mm^2/sec has special technical significance for the viscosity of the mixture of saturated hydrocarbons. Among various physical properties of petrolatum (density, solidifying point, viscosity, cone penetration (a type of viscosity, Exhibit A42), average carbon number, distribution of carbon numbers of hydrocarbons), the technical significance of focusing attention to the viscosity is not described, either. Therefore, in the specification of the application concerned, it cannot be said that the technical significance for the viscosity and the value of 8 mm^2/sec is disclosed.

Thus, in light of no description provided in the specification of the application concerned of the technical significance of focusing attention to the viscosity as well as of the technical significance of specifying the value of the viscosity as 8 mm^2/sec or greater, even when there is no direct suggestion in the citation to prevent an allergic reaction by adjusting the viscosity of the mixture of saturated hydrocarbons, the claimed invention cannot be said to have an inventive step based on the matter specifying the invention of the present invention.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	Suggestion based on the content of the cited invention

1. Bibliographic Items

Case	"Extermination method of imago of mosquito" (Trial for Invalidation) Intellectual Property High Court Decision, December 26, 2011 (2011 (Gyo KE) No. 10017)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H9-19854 (JP H10-194902A)
Classification	A01N 25/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division Presiding judge: Toshiaki IIMURA Judge: Kimiko YAGI Judge: Akira CHINO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention provides a repellent for imagoes of mosquito which rapidly increases the concentration of an insecticide component in air compared to conventional smoke and misting formulations, by retaining a medicament in air in an amount capable of exterminating imagoes of mosquito in several hours after treatment, has sufficient efficiency to mosquitoes in a place behind something, and has high safety with waste use suppressed, and an extermination method. The extermination method for imagoes of mosquito comprises the steps of: accommodating raw liquid comprising an insecticide and a propellant in a pressure container having an openable spraying port provided; and spraying a specific amount of the repellent for imagoes of mosquito as an active ingredient per space of 30 m^3 in which the volume ratio of the raw liquid is equal to or less than 15% of the total volume of the pressure container.

(2) State of the Art

(i) Exhibit A1 (Invention of Exhibit A1): JP S63-203649A

"An active compound stated in the present invention is suitable for controlling animal pests which are generated inside the house, are sanitary pests, or are animal pests for stored products, especially insects. The active

compound has activity to species having sensitivity and/or resistance. The animal pests comprise Anopheles species, Culex species, Musca species of Diptera order." (cited from the Court Decision)

(ii) Common General Knowledge (Exhibit A3, Exhibit A15, Exhibit A24 and Exhibit A26) (Finding of Decision)

"It has been common general knowledge that insecticides having effect for exterminating flies has effect for exterminating mosquitoes regardless of an extermination method."(cited from the Court Decision)

(3) The Claims (After the Correction) (only Claim 1 stated) (Present Invention 1)

[Claim 1] An extermination method for imagoes of mosquito comprising the steps of: accommodating raw liquid consisting of an insecticide and a propellant in a pressure container having an openable spraying port provided; and spraying 2.78 to 15 mg of the repellent for imagoes of mosquito as an active ingredient per space of 30 m^3 in which the volume ratio of the raw liquid is equal to or less than 15% of the total volume of the pressure container, wherein the insecticide in the raw liquid is used by itself without being dissolved in an organic solvent composed of aliphatic hydrocarbon or alcohol and emulsifying or suspending in water together with an active agent, the propellant is at least one material selected from the group consisting of liquefied petroleum gas, dimethyl ether and halogenated hydrocarbon, and extermination is performed by maintaining the extermination effect after spray treatment.

(4) Procedural History

June 13, 2008	:	Request for trial for invalidation by defendant (Muko No. 2008-800109)
October 14, 2008	:	Request for trial for correction by plaintiff (patentee)
March 26, 2009	:	Primary appeal decision that the correction is permitted. ...The patent is invalidated
April 29, 2009	:	Reverse of the primary appeal decision by plaintiff (2009 (Gyo KE) No. 10115)
June 5, 2009	:	Request for trial for correction by plaintiff (the trial for correction was considered as demand for correction)
July 10, 2009	:	Decision that the primary appeal decision is dismissed
April 7, 2010	:	Secondary appeal decision that the correction is permitted. ...The patent is invalidated
May 13, 2010	:	Reverse of the secondary appeal decision by plaintiff (2010 (Gyo KE) No. 10151)
August 6, 2010	:	Request for trial for correction by plaintiff (the trial for correction was considered as demand for correction) (present correction) (see the above-mentioned "The Claims")
September 8, 2010	:	Decision that the secondary appeal decision is dismissed
December 13, 2010	:	Present appeal decision that the correction is permitted. ...The patent is invalidated

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

Appeal Decision (cited from the Court Decision)
The reason of the present appeal decision, that is, the present appeal decision judged that the present invention could have easily arrived based on the inventions stated in Exhibit A1 to Exhibit A9 and well-known art.

Leading to the conclusion, the present appeal decision found difference between the present invention 1 and the invention stated in Exhibit A1 (hereinafter referred to as "Invention of Exhibit A1") as follows.

(1) Identical Features

An extermination method for pests comprising the steps of: accommodating raw liquid comprising an insecticide and a propellant in a pressure container having an openable spraying port provided; and spraying 4.96 mg of the repellent for imagoes of mosquito as an active ingredient per space of 30 m^3 in which the volume ratio of the raw liquid is equal to or less than 3.68% of the total volume of the pressure container, in which the raw liquid comprises the insecticide.

(2) Difference

A The point that "pests" are "imagoes of mosquito" in the present invention 1, on the other hand, "pests" are "houseflies" in Invention of Exhibit A1.

The present appeal decision judged that in the difference A, aerosol insecticides are usually used for houseflies and imagoes of mosquito; in the aerosol insecticides, similar efficacy tests are performed for houseflies and imagoes of mosquito; in extermination of pests, houseflies and imagoes are not discriminated; trying to exterminate imagoes of mosquito in an extermination method by which houseflies are evaluated, is a probable extent of a person skilled in the art; and a person skilled in the art would have been able to easily substitute imagoes of mosquito for houseflies in Invention of Exhibit A1.

Decision

Allegations by Plaintiff	Allegations by Defendant
(1) Errors of judgement about inventive step in a component related to the difference A ...The above-mentioned judgement of the appeal decision has errors. The present invention 1 is different from conventional extermination methods of direct spray type and is the invention related to a novel extermination method in which the extermination effect is exhibited for imagoes of mosquito coming in the room after spraying with the extermination effect maintained. In the extermination method, it is not easy to substitute imagoes of mosquito for houseflies as a target of extermination. In Invention of Exhibit A1, applying aerosol insecticides in which 100% death of imagoes of mosquito is impossible instead of an electric evaporation furnace by which 100% death of imagoes of mosquito is possible does not become motivation for the present invention 1. According to Exhibit A15, KT50 (time until 50% of individuals is	(1) Errors of judgement about inventive step in a component related to the difference A ...Aerosol insecticides having the same classification are similarly used for flies and mosquitoes. The plaintiff alleges that the insecticide effect is low in the experimental result in working example A (applying the aerosol insecticide to houseflies) in Exhibit A1, but working example B in which the tablet was subjected to heat and misting treatment indicated that a drug compound had the insecticide activity for imagoes of mosquito. Thus, it is naturally deemed that the drug compound has insecticide effect even applying to imagoes of mosquito in an aerosol state. The insecticide effect depends on insecticide activity of the used drug compound. Since the drug compound is not specified in the present invention 1, the experimental results in Exhibit A1 and examples in the present invention 1

knockdown) of the insecticide is generally longer in imagoes of Culex pipiens than that in houseflies. Consequently, it is natural to deem that in Invention of Exhibit A1, expression of the insecticide effect is not expected when applying an aerosol insecticide of working example A by which 100% death of imagoes of mosquito is impossible to imagoes of mosquito by itself with one spraying operation.	cannot be compared to each other. In the examples in the present invention 1, effect 2 hours after spraying was not exhibited, thus effect does not maintain after several hours. The plaintiff alleges that the present invention is a novel extermination method in which the extermination effect is exhibited for imagoes of mosquito coming in the room after spraying with the extermination effect maintained, on the other hand there is no problem related to the extermination method in Exhibit A1. However, the spray condition distinguishing a method of directly spraying and the other methods is not stated in the claims of the patent, the originally attached description and the corrected description. Conventional extermination methods for pests are not a method of directly spraying to flying pests at all. Effect for exhibiting extermination effect for imagoes of mosquito coming in the room after spraying is not stated in the claims of the patent, the originally attached description and the corrected description. Consequently, allegations by the plaintiff are allegations not based on the statement of the claims and the description, and are improper.

Judgment by the Court

(1) Errors of judgement about easily arriving in a constitution of Difference A

...The above-mentioned allegations of the plaintiff is improper as follows. According to Exhibit A3, it is the common general knowledge that an insecticide having extermination effects for houseflies also has extermination effects for imagoes of mosquito in regardless of extermination methods. Exhibit A1 states that an active compound stated in the present invention is suitable for controlling animal pests generated inside the house including sanitary pests or harmful organisms for stored products, especially insects. The active compound is active on species having sensitivity and/or resistance. The animal pests comprise Anopheles species, Culex species, Musca species of Diptera order, and indicates that the active compound (insecticide) has effect for controlling not only houseflies but also imagoes of mosquito. The present invention 1 specifies that extermination is performed by maintaining the extermination effect after spray treatment, and thus, an extermination method for directly spraying to flying imagoes of mosquito is not excluded therefrom. Consequently,, it would have been easily substitute imagoes of mosquito for houseflies as a target of

extermination in the invention of Exhibit A1.

On the other hand, the plaintiff alleges that in Invention of Exhibit A1, applying aerosol insecticides in which 100% death of imagoes of mosquito is impossible is not motivated instead of an electric evaporation furnace by which 100% death of imagoes of mosquito is possible However, as mentioned above, in Exhibit A1 the active compound (insecticide) in Invention of Exhibit A1 has effect for controlling not only houseflies but also imagoes of mosquito, and since Working example B (an extermination method using an electric evaporation furnace) shows controlling effect for imagoes of mosquito even if an extermination method is different, it cannot be said that an aerosol insecticide of Working example A cannot be applied to imagoes of mosquito.

Further, the plaintiff alleges that according to Exhibit A15, since KT50 of the insecticide is generally longer in imagoes of Culex pipiens, it is natural to deem that in Invention of Exhibit A1, the expression of the insecticide effect is not further expected when applying an aerosol insecticide of Working example A by which 100% death of imagoes of mosquito is impossible to imagoes of mosquito by itself with one spraying operation. However, in Exhibit A15, in a case that "pyrethrin" is used as an insecticide, KT50 of imagoes of housefly is equivalent to that of imagoes of Culex pipiens, or that of imagoes of Culex pipiens is shorter than that of imagoes of housefly. Consequently, since it would have been able to expect that effects on imagoes of mosquito are equivalent or more to that of imagoes of housefly according to kinds of insecticide, the above-mentioned allegations by the plaintiff cannot be adopted.

(43)-7

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

Case	"Cellulose acylate" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 22, 2012 (2011 (Gyo KE) No. 10178)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-311370 (JP 2005-68438A)
Classification	C08L 1/10
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

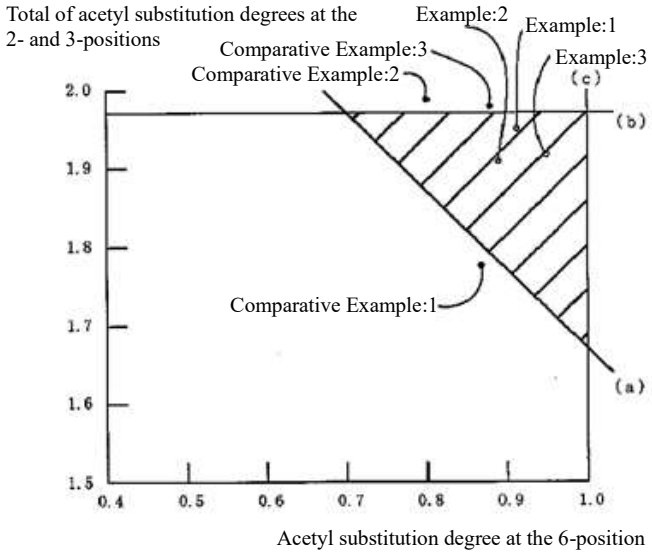
The claimed invention aims at providing cellulose acylate that exhibits superior temporal stability and that enables manufacture of a solution of cellulose acylate exhibiting a low degree of viscosity in a practical doping level region and manufacture of a film with a superior planar condition. A total of acyl substitution degrees at the 2- and 3-positions is from 1.70 to 1.90; an acyl substitution degree at the 6-position is 0.88 or more; and the acyl group is cellulose acylate that is acetyl.

(2) State of the Art

"A The Embodiment 2 of the citation states a "cellulose acetate film containing cellulose acetate in which the total of acetyl substitution degrees at the 2-, 3-, and 6-positions is 2.67 or more and in which the total of acetyl substitution degrees at the 2- and 3-positions is 1.97 or less."

B A hatched area in FIG. 1 (FIG. 1 of another sheet) of the citation shows a range of specified cellulose acetate." (Cited from the Decision)

(another sheet) FIG. 1



(3) The Claims (before amendment of the case) (the invention stated in Claim 2 is called a "claimed invention")

[Claim 1] Cellulose acylate in which a total of acyl substitution degrees at 2- and 3-positions is from 1.70 to 1.90, and an acyl substitution degree at 6-position is 0.88 or more.

[Claim 2] Cellulose acylate according to claim 1, wherein the acyl group is acetyl.

(4) Procedural History

October 26, 2004	:	Patent Application (Original filing date: January 17, 2001)
December 27, 2007	:	Amendment (see "The Claims" above)
February 22, 2008	:	Decision of Refusal
March 26, 2008	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku 2008-7402)
April 23, 2008	:	Amendment (Amendment of the Case)
April 19, 2011	:	The amendment was rejected, and the appeal decision stating that the request for trial and appeal shall not lie.

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

Appeal Decision (cited from the Court Decision) * *Italicized letters provided hereunder refer to matters added to excerpts.*
(1) The ground of the decision is that a person skilled in the art can have easily conceived the claimed invention (2) on the basis of the invention stated in the citation, and therefore the claimed invention is unpatentable under Article 29(2) of the Patent Act. Citation: JP H11-5851A (Exhibit A5) (2)...the decision presumes a point of match and a difference between the claimed invention and the cited invention as follows. B Point of match: Cellulose acylate having an acyl substitution degree at the 6-position is 0.88 or more,

and the acyl group is acylate

C Difference: a total of acyl substitution degrees at the 2- and 3-positions is "from 1.70 to 1.90" in the claimed invention, and assumes a value of "1.91" in the cited invention.

(the followings are cited from the decision)

...in the cited invention, a total of acetyl substitution degrees at the 2- and 3-positions is made smaller than 1.91, ...composing cellulose acylate in which the total value ranges from 1.70 to 1.90 is a matter that can be easily conceived by a person skilled in the art from what is stated in Cited document 1.

Decision

Allegations by Plaintiff	Allegations by Defendant
An interpretation should not be made not only on the basis of a comparison with the embodiments in finding a difference between the claimed invention and the cited invention. The interpretation should be made by comparison of the technical idea of the claimed invention with the technical idea ascertained in consideration of the entirety of the citation. ...from the citation, even when either the acetyl substitution degree at the 6-position or the total of acetyl substitution degrees at the 2- and 3-positions can be specified, the other acetyl substitution degree cannot be predicted. The citation states neither adjusting the total of acyl substitution degrees at the 2- and 3-positions to a range from 1.70 to 1.90 nor adjusting the acyl substitution degree at the 6-position to 0.88 or more. In particular, even when adjusting the total of acetyl substitution degrees at the 2-, 3-, and 6-positions and the total of acetyl substitution degrees at the 2- and 3-positions are stated in the citation, the relationship between the acyl substitution degrees at the 2- and 3-positions and the acyl substitution degree at the 6-position cannot be derived from the citation. The total of acetyl substitution degrees at the 2- and 3-positions cannot be predicted easily.	In relation to the relationship between the "total of acetyl substitution degrees at the 2- and 3-positions" and the "acetyl substitution degree at the 6-position" in the cellulose acetate stated in the citation, a range of one is defined, so long as a range of the other is specified as is evident from ...FIG. 1 of the citation. ...so long as a numerical value of the acetyl substitution degrees at the 2- and 3-positions represented by the vertical axis is determined, a range available for the acetyl substitution degree at the 6-position represented by the corresponding horizontal axis is also determined by extrapolation of the numerical value to the hatched area. Likewise, so long as a numerical value of the acetyl substitution degree at the 6-position is determined, a range available for the acetyl substitution degrees at the 2- and 3-positions is determined. Also, ...an equivalent to the cited invention (...Embodiment 2...) is present in a substantial center of the hatched area in FIG. 1. Hence, it is not especially difficult for a person skilled in the art to move the position of Embodiment 2 of the citation; namely, to increase or decrease the numerical value of the "total of the acetyl substitution degrees at the 2- and 3-positions" or the numerical value of the "acetyl substitution degree at the 6-position" within the range of the numerical value stated in the citation, respectively.

Judgment by the Court

...The claimed invention specifies the invention by the method of the "total of the acyl substitution degrees at the 2- and 3-positions" and the "acyl substitution degree at the 6-position." In the meantime, the cited invention specifies the invention by the method of "total of the acyl substitution degrees at the 2- and 3-positions" and the "total of the acyl substitution degrees at the 2-, 3-, and 6-positions." These inventions differ from each other in terms of the method for specifying cellulose acylate.

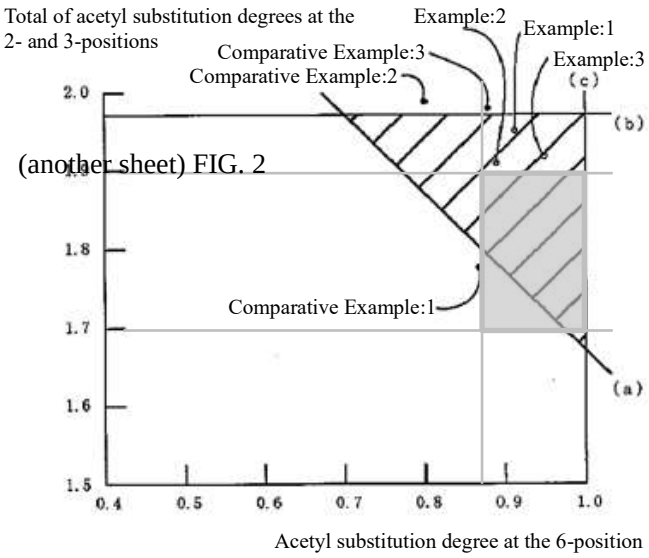
...the inventions stated in the claimed invention and the citation ... both specify cellulose acylate by use of common parameters, that is, the relationship among the acyl substitution degrees at the 2-, 3-, and 6-positions. Therefore, when the numerical range specified in the claimed invention is reflected on FIG. 1 of another sheet of the citation, the solid area in FIG. 2 of another sheet corresponds to the numerical range of the claimed invention.

According to FIG. 2 of another sheet, the claimed invention (the solid area) and the claims in the cited invention (the hatched area) have an overlapped area.

...it is easily conceivable for a person skilled in the art to specify cellulose acylate within the range satisfying the requirements specified in the citation, and to prepare a dope and form a film under the method stated in the citation by use of the thus-specified cellulose acylate .

And, it is obvious that the claimed invention includes the cellulose acylate which a person skilled in the art can easily make from such statements in the citation.

(another sheet) FIG. 2



(another sheet) FIG. 2

(43)-8

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

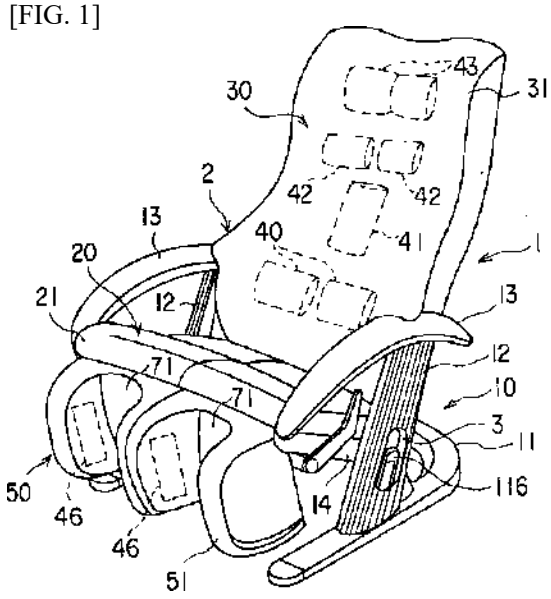
1. Bibliographic Items

Case	"Chair-type massaging machine" (Trial for Invalidation) Intellectual Property High Court Decision, February 27, 2012 (2011 (Gyo KE) No. 10193)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H9-172370 (JP H11-9634A)
Classification	A61H 7/00
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Shuhei SHIOTSUKI, Judge: Tomoko MANABE, Judge: Kenjiro FURUYA

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



The Claimed Invention relates to a chair-type massaging machine with leg rests each of which has a massaging element for massaging a leg portion (an ankle region or a calf region). In relation to the leg rest of the prior art, when a movable rest is moved in such a way that the massaging element comes to a position corresponding to a desired area to be massaged on the leg, movement of the movable rest is hindered if the massaging element remains protruding so as to push the leg. Loads on movement means become excessive, and a trouble, like feeling a pain in the leg, might arise in some cases. Accordingly, the control means 16 performs control such that the massaging elements 46 are brought into a non-protruding state when the leg rests 50 are moved in such a way that the massaging elements 46 come to positions corresponding to desired areas to be massaged in the course of massaging of the legs, whereby

operation, like smooth movement of the leg rests 50 equipped with the massaging elements 46, prevention of an overload, and suppression of a pain, is yielded.

(2) State of the Art

(i) Publication of Exhibit A1 (Invention of Exhibit A1): JP H8-322895A (Findings of the Appeal)

"A chair-type air-massaging machine comprising:

a chair body 1 having a seat 2 and a backrest 3;

leg support rests 50 each of which has leg bag bodies 60 to 63 and which are disposed so as to be movable in a front-back direction with reference to the chair body 1;

movable means for moving the leg support rests 50 in a front-back direction with respect to the chair body 1;

an air compressor 30 for inflating the leg bag bodies 60 to 63;

a remote controller unit 36; and

control means 35 for controlling the air compressor 30 and the movable means by means of an input signal from the remote controller unit 36." (Cited from the Decision)

(ii) Well-known Matters (Publication of Exhibit A2 to Publication of Exhibit A4) (Findings of the Decision)

"...in light of the technical matters disclosed in Publication of Exhibit A2 to Publication of Exhibit A4 and in the technical field of massaging machines that have massaging elements provided on a backrest and the like of a chair and the function of a control circuit moving the massaging elements in response to an input of switching operation, etc., the problem of a large amount of protrusion of the massaging elements being hazardous to a user's body or imposing heavy loads on a drive unit at the time of movement of the massaging elements are admitted to be widely-known problems for a person skilled in the art. In order to solve the problems, moving the massaging elements after the amount of protrusion of the massaging elements is minimized or after being adjusted such that the amount of protrusion becomes small is admitted to be well-known technical matters." (Cited from the Decision)

(3) The Claims (only Claim 1 stated) (Claimed Invention 1)

[Claim 1] A chair-type massaging machine comprising:

a chair body having a seat and a backrest;

leg rests each of which has massaging elements and which are disposed so as to be movable with reference to the chair body;

movable means for moving the leg rests with respect to the chair body;

drive means for moving the massaging elements in a protruding manner;

input means; and

control means for controlling the drive means and the movable means in response to an input signal from the input means, wherein

when a positioning signal for positioning the massaging elements to areas to be massaged on the leg rests

in the course of massaging operation is input from the input means to the control means, the control means performs control operation for moving the leg rests after bringing the massaging elements into a non-protruding state.

(4) Procedural History

September 17, 2004	:	Registration and establishment of a patent right (see "The Claims" above)
July 29, 2010	:	Trial for Patent Invalidation by Plaintiff (Muko No. 2010-800133)
May 11, 2011	:	The appeal decision stating that the trial for invalidation shall not lie.

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">...points of difference between the Claimed Invention 1 and Invention of Exhibit A1 are as follows:
[Difference A]
In Claimed Invention 1, when a positioning signal for positioning the massaging elements to areas to be massaged on the leg rests in the course of massaging operation is input from the input means to the control means, the control means performs control operation for moving the leg rests after bringing the massaging elements into a non-protruding state. In contrast, Invention of Exhibit A1 does not have the configuration.
H Motivation
Publication of Exhibit A1 discloses, as where the movement means is controlled in the course of massaging operation, only where areas on the legs to be massaged are subjected to stretch-massaging. Exhibit A1 does not state or suggest changing the positions of the massaging elements to the areas to be massaged put on the leg rests in the course of massaging. Therefore, Invention of Exhibit A1 cannot be said to have a motivation to apply the technical matters stated in Publication of Exhibit A2 to Publication of Exhibit A6.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...Claimed Invention 1 states the problem; namely, the problem of "movement of the movable rest being hindered," "loads on the movable means becoming excessive," and "feeling a pain in the area to be massaged" when moving massaging elements for their positioning while keeping them protruding. As can be seen from similar problems stated in Publication of Exhibit A2 to Publication of Exhibit A4, all of the problems are not the problem newly submitted in the Claimed Invention 1 but well-known problems that have widely, hitherto been admitted. In addition, a control mode that "performs control operation for moving the leg rests after bringing the</td><td>Allegations by Defendant
...Exhibit A1 Official Gazette discloses Invention of Exhibit A1 capable of situating the leg bag bodies at user's desired positions to be massaged by moving the leg rests in the front-back direction. However, the invention is equivalent solely to the prior art of Claimed Invention 1. The official gazette does not disclose at all acknowledgment of various problems of Claimed Invention 1 (paragraphs [0003], [0005]); that is, when moving the leg rests in the course of massaging, (1) a problem of movement of the movable rests being hindered when the massaging elements remain protruding so as to push the legs; (2) a problem of loads on the movable means becoming excessive</td></tr>
</table>

massaging elements into a non-protruding state," which is put forward in Publication of Exhibit A2 to Publication of Exhibit A4 in order to solve such well-known problems, is also well-known means for solution (well-known art). The technical matters stated in Claimed Invention 1, Invention of Exhibit A1 , Publication of Exhibit A2 to Publication of Exhibit A4 are all against the backdrop of the common technical field, or the chair-type massaging machine whose massaging elements are moved and positioned. Therefore, in order to solve such a well-known problem, applying the well-known art stated in Publication of Exhibit A2 to Publication of Exhibit A4 to Invention of Exhibit A1 is a design matter commonly practiced by a person skilled in the art.	and causing a failure in the movable means in some cases; and (3) a problem of areas pressed and sandwiched between the massaging elements being pulled by the massaging elements in motion in the direction of movement and a pain in the massaged areas being felt in some occasions, nor is presence of the problems suggested. Consequently, it is not easily conceivable even for a person skilled in the art to apply the technical matters disclosed in Publication of Exhibit A2 to Publication of Exhibit A4 to Invention of Exhibit A1.

Judgment by the Court

...the massaging machine of Invention of Exhibit A1 has a configuration in which the massaging elements move along the leg in each of the leg rests. However, the massaging machine is, as a whole, a chair-type massaging machine and belongs to the same technical field as that of the chair-type massaging machine stated in Publication of Exhibit A2 to Publication of Exhibit A4. Even when the massaging elements are disposed at different positions, the massaging machines have technical commonality in that the massaging elements move along the body. When coming to know Invention of Exhibit A1 equipped with the movable massaging elements for leg purpose, a person skilled in the art recognizes the above general problems pertinent to movement of the massaging elements. It is to be said that, in order to solve the problems, a person skilled in the art can apply the well-known general knowledge to Invention of Exhibit A1 to minimize the amount of protrusion, bring the massaging elements in a non-protruding state, and control the amount of protrusion appropriately when the control circuit moves the massaging elements (along with the leg rests) in response to an input of switching operation or the like, even when Invention of Exhibit A1 *per se* has no suggestion.

...the problem of smooth movement of the massaging elements being hindered while the massaging elements remain protruding is not a problem unique to the movement performed in the "middle of a massage" as stated to occur "at the time of performance of a massage or in the middle of a massage" (in paragraph [0003]) as the problem of the prior art. In addition, the specification of the present invention is not admitted to include a statement about technical meaning in performing control for moving the massaging elements in a non-protruding state in the "middle of a massage" or "when a positioning signal ...is input." Furthermore, even in the technical field of a massaging machine, no difficulty is encountered in moving the massaging elements in the middle of a massage or moving the massaging elements for positioning, and the configuration can be said

to be adopted as needed.

Therefore, it is not admitted that special technical significance exists in adopting the configuration of performing control for moving the massaging elements in a non-protruding state in the "middle of a massage" and "when the position signal is ...input." It is to be said that a person skilled in the art having come to know Invention of Exhibit A1 can appropriately adopt such a configuration as a design matter when necessary.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	Suggestion based on the content in the cited invention

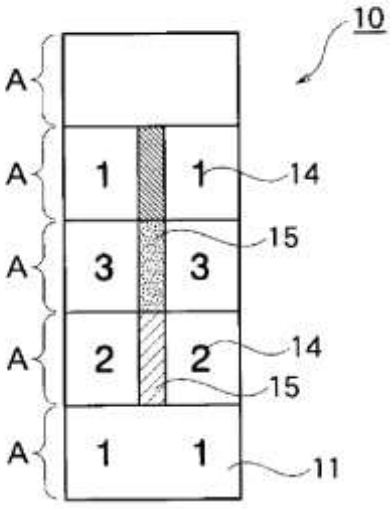
1. Bibliographic Items

Case	"Index card" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, March 22, 2012 (H23 (Gyo Ke) 10219)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2006-72721 (JP 2007-245563A)
Classification	B42F 21/06
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	Intellectual Property High Court Third Division: Presiding Judge Toshiaki IIMURA, Judge Kimiko YAGI, and Judge Akira CHINO

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



The claimed invention is related to an index card used for a folder in which patient's charts or the like are accommodated. An index card 10 has such a configuration that character indication regions A of four or more rows are provided, and that characters are printed in the respective at least four character indication regions A, and that colored parts 15 corresponding to information on the printed characters 14 are printed. In this claimed invention, a base material 11 of the index card 10 is a synthetic paper for an ink-jet printer, and the characters 14 and the colored parts 15 are formed by ink-jet printing.

A first object of this claimed invention is to provide an index card which can be used for an ordinary two-fold folder and a paper-made folder in which no pocket is formed. A second object of this claimed invention is to provide the index card which can correspond to many kinds and a production of small quantity.

(2) State of the Art

(i) Citation: JP 2004-17405A (finding of appeal decision)

"a. Difference 1

While the number of the at least two character indication regions where the characters are printed is "at least four" in the claimed invention, the number is two of the last two digits of the indication region 20 in the cited invention." (Summary from the judgment)

(3) The Claims (Amended) (the Claimed Invention)

[Claim 1] An index card attached to a folder in which patient's charts or the like are accommodated and on which characters required for searching of the patient's charts or the like are printed, having character indication regions of four or more rows in a length direction on one surface of a substantially-rectangular vertically-oriented base material, in each of the at least four character indication regions, the characters required for searching of the patient's charts or the like being printed at least one of width direction both end parts of the character indication regions, colored parts corresponding to information on characters printed in the character indication regions being printed, the base material being a synthetic paper for an ink-jet printer, the characters and the colored parts are formed by ink-jet printing.

(4) Procedural History

June 11, 2010	:	Amendment (Refer to the above "The Claims")
July 9, 2010	:	Decision of Refusal
October 13, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-23128)
June 6, 2011	:	Appeal/Trial Decision of "The request for this case trial and appeal is not established."

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

Appeal/Trial Decision
The cited invention provides an index card having an indication region 20 of four digits in a vertical direction, the last two digits of the indication region 20 being used as a print region 20A, and that can completely eliminate operational human errors at handling up to the last two digits. The citation describes "The number of digits of the indication region is not limited, and can be increased or decreased depending on a scale of a hospital that is an installation target of this system."(refer to 3-5[0025]), and "In a case where the last one digit is printed, the number of folders of one unit having the similar color tends to become too large when the number of accepted patients is increased. Therefore, when implemented, it is preferred that a color is printed while using the last two digits as the print region 20A." (refer to 3-5[0024]). Therefore, in the cited invention, for the purpose of installing in a large-scale hospital, and preventing the number of folders having the similar color from being too large when the number of accepted patients is increased, it would have been easy for a person skilled in the art

to apply, on the basis of the description in the citation, that the number of digits of the indication region 20 is increased to four or five or more, and at least last four digits are used as the print region 20A in place of the last two digits of the indication region 20 to eliminate operational human errors completely for handling up to the last four digits, and to prevent the number of folders having the similar color from being too large, that is, a configuration of the claimed invention related to the difference 1.

Decision

Allegations by Plaintiff

In the paragraph [0024] of the citation, although the print region of the last two digits can be modified to the last one digit, it is recommended that the last two digits are used as the print region from the start because, if the print region is the last one digit, the number of folders having the same color becomes large when the number of the patient's charts increases. However, there are no description and no suggestion that the print region of the last two digits is modified to at least the last four digits in a case where the number of patient's charts increases and that the last four digits are used as the colored part. ...

In addition, in the paragraph [0025] of the citation, it is merely described that the number of digits of the character region (the character indication region) can be increased or decreased depending on a scale of a hospital, and there are no description that the number of digits of the print region is increased or decreased. Further, in the citation, it is only described that hand-writing and stamps are used for means for increasing the number of characters in the indication region, and there is no description that the last four digits are used as the colored part.

Since the citation does not recognize a subject of complicatedness at the time when an index card with a small number of printed digits is used, there are no cause nor motivation that a person skilled in the art contacted with the citation employs such a configuration that the number of digits preliminarily printed on a card is increased.

Allegations by Defendant

In the cited invention, "the print region 20A" of the last two digits in the indication region 20 of the four digits, is provided for solving a problem that "since numbers are printed while being specified by colors, operational human errors can be eliminated completely at handling up to the last two digits without requiring a label adhering work" (the paragraph [0023]). In addition, it can be considered that, in the citation, with respect to "the print region 20A", there is a technical suggestion that the index card can deal with the larger number of accepted patients as the number of digits becomes larger.

Accordingly, it can be considered that there is a suggestion that, in the citation, when the number of digits of "the indication region 20" of the cited invention is further increased from four digits depending on a scale of a hospital, for the purpose of solving the above problem, the number of digits of "the print region 20A" can also be increased from two digits. For further increasing the number of digits of "the print region 20A" in the cited invention from two digits, to increase the number to four or more is merely a matter of design.

Further, at a provider side of the index card, because the number of cards to be prepared increases exponentially every time the printed digit is increased by one, it is not realistic that the numbers up to the four digits are preliminarily printed.	

Judgment by the Court

(2) Determination

According to the above respective descriptions, the cited invention relates to an index card utilized for a folder for keeping patient's medical charts in a medical institution such as a hospital. Conventionally, a label was stuck on the index card. For the purpose of solving problems generated when a sticking accuracy is poor and also problems of maintenance, etc. of label sheets, an indication region of four digits in a vertical direction is provided in the index card, and the last two digits of the indication region is used as the print region and printed with numbers. A differnet background color for each number is printed, and the remaining indication regions are blanks.

In the paragraph [0025] of the citation, it is described that the number of digits of the indication region can be increased or decreased depending on a scale of a hospital to be targeted. According to this description, it can be understood that the number of digits of the indication region can be changed depending on the number of patients, etc. that are usage targets of the index card, and the like. In addition, in the paragraph [0024] of the citation, it is described that, although the print region could be changed to the last one digit, it is preferable that the last two digits are used for the print region, because the number of folders having the similar color becomes large when the number of accepted patients increases if the print region is the last one digit. According to this description, it is indicated that the index card can deal with the larger number of accepted patients as the number of digits of the print region 20A becomes larger.

Accordingly, a person skilled in the art who contacts with the citation can easily conceive of the configuration related to the difference 1 because it is a matter of course that the index card in the cited invention can increase the number of digits of the indication region and the print region depending on a scale of a hospital using the same.

(3) Against the Plaintiff's allegations

B. The plaintiff alleges that since the citation does not recognize the troublesome problem at the time when an index card with a small number of printed digits is used, there are no cause nor motivation that a person skilled in the art contacted with the citation employs such a configuration that the number of digits preliminarily printed on a card is increased, and that, at a provider side of the index card, because the number of cards to be prepared increases exponentially every time the printed digit is increased by one, it is not realistic that the numbers up to the four digits are preliminarily printed.

The plaintiff's allegation has no reason.

That is, as described above, it can be considered that, in the citation, it is described that at least a part of the indication region is used as the print region for the purpose of solving a problem of the conventional method

of sticking labels to the index card, and it is suggested that the index card can deal with the larger number of accepted patients as the number of digits of the print region becomes larger. Accordingly, it can be considered that it is easy for a person skilled in the art contacted with the citation increases the number of digits of the print region of the index card for the purpose of dealing with usage in a medical institution with a large number of accepted patients.

(43)-10

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

Case	"Range finder based on parallel detection of spectral bandwidth" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 28, 2012 (2011 (Gyo KE) No. 10260)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-562617(National Publication of International Patent Application No. 2005-516187)
Classification	G01N 21/17
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Shuhei SHIOTSUKI, Judge: Akira IKESHITA, Judge: Kenjiro FURUYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention aims at enhancing the detection sensitivity of an optical coherence tomographic signal and a low coherence interference (LCI) signal by detection of a set of parallel spectral bandwidths.

Each bandwidth is a unique combination of optical frequencies. An LCI broadband source is split into N spectral bandwidths. The N spectral bandwidths are individually detected and processed, thereby enhancing a signal-to-noise ratio by a factor of N. Signals detected from the respective spectral bandwidths and amplified by a photodetector undergo bandpass-filtering centered at a signal bandwidth in an analog electronic circuit, thereby being digitized. As a result, influence of shot noise on the signals can be lessened by only a coefficient equal to the spectral bandwidth, whereas a signal amplitude can be maintained in the same state. A dynamic range and sensitivity can be enhanced by a decrease in shot noise.

(2) State of the Art

(i) Citation (Cited Invention):JP 2001-174404A

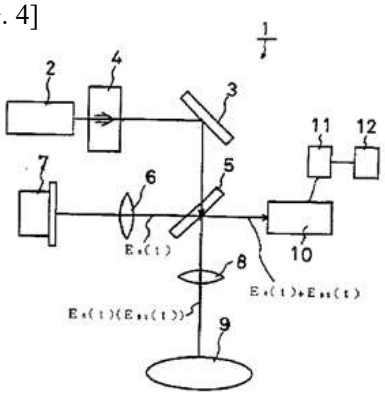
"[0005] The reference-side light condensing lens 6 for condensing the reference light $E_R(t)$ is disposed in a direction

in which the semi-transparent plate 5 reflects light. The variable delay device 7 is disposed in a direction in which light passes through the reference-side light condensing lens 6. The variable delay device 7 travels along an optical path of the reference light $E_R(t)$ at predetermined speed to reflect the reference light $E_R(t)$ toward the semi-transparent plate 5 for a predetermined desired period."

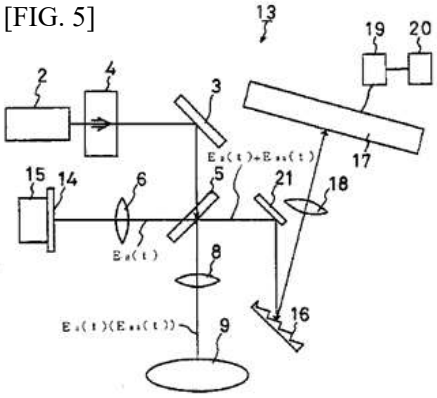
"[0015] After the reference light $E_R(t)$ reflected by the semi-transparent plate 5 is condensed by means of the reference-side light condensing lens 6, it is subjected to reflection with a desired delay time by the variable delay device 7."

"[0023] The optical tomographic measurement apparatus 13 has, in place of the variable delay device 7, the reference light reflection mirror 14 disposed on the optical path of the reference-side light condensing lens 6. The delay element 15, for instance, of a piezoelectric element (PZT) or the like, is disposed behind the reflection surface of the reference light reflection mirror 14. The delay element is for changing a propagation time and a phase of the reference light $E_R(t)$ by displacing the reference light reflection mirror 14, thereby reflecting the reference light $E_R(t)$." (Cited from JP 2001-174404A)

[FIG. 4]



[FIG. 5]



(ii) Well-known Example 1: JP 2001-264246A (Findings of the Decision)

"... it is stated that in the OCT, the prior art using the "reflection-type delay line" encountered a "low-interference output" and "deterioration of an SN ratio." However, the problems are solved by use of the "transmission-type delay line." ..." (Cited from the Decision)

(iii) Well-known Example 2: JP H1-145545A (Findings of the Decision)

"... it is stated that the reflection test apparatus for measuring properties of an object of measurement can measure a distance between the point A and the point B by adjusting a delay between the interference light and the reference light and that, in addition to the example (FIG. 3) using the mirror, the example using the prism (FIG. 2) and the example using the lens (FIG. 4) are also disclosed as the configuration of the "light delay circuit" for realizing such a delay, thereby "changing the optical path length" with those example circuits. It is therefore be comprehensible that ... a reflection-type configuration and a non-reflection-type configuration are selectable as a configuration for varying the phase of the signal light and the phase of the interference light in order to optically measure a distance." (Cited from the Decision)

(iv) Well-known Example 3: International Publication No. WO2000/16034 (Paragraph [0035] of National Publication of International Patent Application No. 2003-524758 that is a corresponding Japanese Official Gazette) (Findings of the Decision)

"... it is comprehensible that, in the OCT, the "optical circulator" is used without use of a splitter in order to improve the SN ratio. In this connection, the embodiment shown in FIG. 6 uses a "reflective reference arm delay" for the reference delay element and the standard arm (the reference arm), whereas the embodiment shown in FIG. 7 uses a "transmission delay element"." (Cited from the Decision)

(v) Exhibit B1: JP H10-267631A (Findings of the Decision)

"... it is acknowledged that, in the OCT, a person skilled in the art can select, as needed, "the reflective reference light modulation mechanism (FIG. 10)" or the "transmissive (non-reflective) reference light modulation mechanism (FIG. 12)" in consideration of a common problem such as cost." (Cited from the Decision)

(3) The Claims (Amended)

[Claim 1] An apparatus for forming an optical image comprising:

a device for receiving at least one first electromagnetic radiation from a sample and at least one second electromagnetic radiation from a non-reflective reference substance;

one spectrum separation unit for separating the first electromagnetic radiation, the second electromagnetic radiation, and at least one spectrum of a combination of the first and second electromagnetic radiations into frequency components; and

at least one detection configuration including a plurality of detectors, each detector being able to detect at least a portion of at least one of the frequency components, wherein at least

a) the first and second electromagnetic radiations interfere with each other; or

b) the frequency components of the first and second electromagnetic radiations interfere with each other.

(4) Procedural History

January 24, 2003	:	International Patent Application (the date of priority claimed: January 24, 2002, USA)
June 9, 2009	:	Amendment (see above "The Claims")
December 11, 2009	:	Decision of refusal
April 16, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-8154)
March 28, 2011	:	The appeal decision stating that "the request for trial and appeal shall not lie."

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

Appeal Decision (cited from the Court Decision)
...The appeal states that "the claimed invention can be easily made by a person skilled in the art on the basis of the cited inventions and the well-known techniques and hence shall not be granted a patent under Article 29(2) of the Patent Act. (F) Interpretation of Points of Difference From the descriptions in the citation ... "[0023] The optical tomographic measurement apparatus 13 has, in place of the variable delay device 7, the reference light reflection mirror 14 disposed on the optical path of the

reference-side light condensing lens 6. The delay element 15, for instance, of a piezoelectric element (PZT) or the like, is disposed behind the reflection surface of the reference light reflection mirror 14. The delay element is for changing a propagation time and a phase of the reference light $E_R(t)$ by displacing the reference light reflection mirror 14, thereby reflecting the reference light $E_R(t)$...," it can be said that the cited invention use the variable delay device consisting of the reference light reflection mirror 14 and the delay element 15.

In this respect, as described in; for instance, Well-known example 1 ..., Well-known example 2 ..., and Well-known Example 3 ..., the non-reflection delay device has been well known as a configuration of the variable delay device before the priority date of the claimed invention.

(A) The cited inventions and the well-known techniques have a commonality in that they are the devices for analyzing an object to be measured by interference between the light reflected from the object and the reference light. (B) The variable delay can be embodied by various techniques. Adoption of which one of the techniques can be said to be a matter which a person skilled in the art can choose as required ... (C) The reflection-type delay devices have encountered the problem of reflection occurred at the end of the fiber and on the surface of the optical element, except the movable mirror, also resulting in generation of return light and, therefore, causing noise light other than desired signal light ... In comprehensive consideration of these matters, it can be said that a person skilled in the art can readily conceive, without involvement of any difficulties, the application of the well-known techniques to the cited inventions to achieve the claimed invention in connection with the Difference.

Decision

Allegations by Plaintiff	Allegations by Defendant
...the descriptions of Well-known examples 1 through 3 clearly show the reason of a hindrance to application of the inventions described in the examples to the cited inventions. Therefore, it cannot be said that it is easy for a person skilled in the art relevant to the claimed invention to be able to easily conceive the non-reflection-type delay device from the variable delay device, which is placed in the optical path of reference light, by application of the techniques described in Well-known examples 1 through 3 to the application of the cited inventions.	There is a sufficient motivation to replace "the variable delay device consisting of the reference light reflection mirror 14 and the delay element 15" with the "non-reflective delay device; that is, the non-reflective reference element," and there is clearly no hindrance to replacement by application of the well-known techniques 1 through 3 and the well-known techniques indicated by Exhibit B1 to the cited invention. The findings and the appeal decision have no fault in connection with the Difference.

Judgment by the Court

(2) About the application of the well-known techniques to the cited invention

In the field of optical measurement including OCT, the "non-reflective delay device" is a well-known technique as a means of generating phase-variable reference lights to cause interference with signal lights. In addition, it is obvious from the descriptions in Well-known examples 1 through 3 and Exhibit B1 that adoption of either the "non-reflective delay device" or the "reflective delay device" is a matter of choice.

The citation describes two examples relevant to FIG. 4 and FIG. 5, as the prior art of the optical tomographic measurement apparatus. The former FIG. 4 shows the "variable delay device" ([0005], [0015]) that reflects reference light while moving along the optical path as a means of generating phase-variable reference light to cause interference with signal lights. The latter FIG. 5 shows the optical tomographic measurement apparatus comprising the "reflection mirror 14" ([0023]) on the back of which the "delay element 15" is disposed in place of the "variable delay device." The decision acknowledges the optical tomographic apparatus shown in the latter FIG. 5 as a cited invention.

The descriptions cannot be construed as intended, limited enumeration of the "reflection mirror 14." There are found no descriptions about a hindrance to realizing the means of generating the reference light, described in the cited invention, by use of the well-known techniques described above. Consequently, the following is a choice of a functionally-equivalent well-known technique which a person skilled in the art can easily conceive. Namely, in place of the configuration in FIG. 5 using the "reflection mirror 14" on the back of which the "delay element 15" is disposed, a configuration using second electromagnetic radiation, which is to act as reference light, from the non-reflective reference element by adoption of the non-reflective delay device of the well-known technique is adopted as a means, described in the cited invention, of generating reference light of various phases according to a distance from a position where signal light undergoes reflection to the sensor.

Therefore, the decision based on the same gist has no fault in connection with ease of conceit of the invention.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

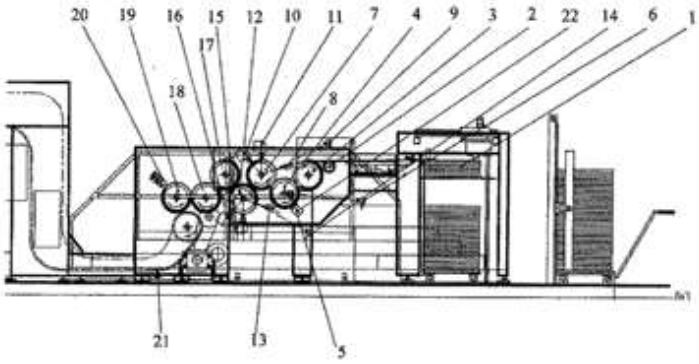
Case	"Inspection machine" (Trial for Invalidation) Intellectual Property High Court Decision, July 8, 2013 (2012 (Gyo KE) No. 10340)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-509002 (National Publication of International Patent Application No. 2007-534074)
Classification	G07D 7/12
Conclusion	Acceptance
Related Provision	Article 29(2), Article 123(1)(ii)
Judges	IP High Court Third Division, Presiding Judge: Ryuichi SHITARA, Judge: Masaya TANAKA, Judge: Koki KAMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

A problem to be solved by the claimed invention is to optimize conveyance and inspection time required to perform inspection of an imprinted sheet. Another problem is to enable building of a compact inspection machine and provide a simple and reliable inspection machine and method. The claimed invention is a machine including a sheet inspection unit with an inspection cylinder (4) for conveying an imprinted sheet at the time of inspection; illumination means (5) and a camera (6) joined to an analyzing device; an input transfer cylinder (3) for conveying the imprinted sheet to the inspection unit; and an output transfer cylinder (17) for taking the imprinted sheet out of the inspection unit, wherein the inspection unit and the input and output transfer cylinders are configured such that the output transfer cylinder (17) takes out the inspected and imprinted sheet only when

Fig.1



inspection is completed.

(2) State of the Art

(i) Citation (Document of Exhibit A1 Publication): JP 2000-85095A

"An inspection rotary press for a sheet 5 with an imprinted design, such as securities, comprising a sheet feeding section 1,

a first inspection drum 10 for conveying the sheet 5, a front inspection camera 11 for inspecting the sheet 5 conveyed by the first inspection drum 10, a second inspection drum 12 disposed in contact with the first inspection drum 10 for conveying the sheet 5 received from the first inspection drum 10, a back inspection camera 13 for inspecting the sheet 5 conveyed by the second inspection drum 12, and determination means for determining whether or not the print is a failure or non-failure on the basis of the inspection performed by the front inspection camera 11 and the back inspection camera 13; and

a transfer drum 9 for continuously conveying the sheet 5 to the first inspection drum 10 and a first impression drum 14 for conveying the sheet 5 received from the second inspection drum 12, wherein

the transfer drum 9, the first inspection drum 10, the second inspection drum 12, and the first impression drum 14 are disposed in contact with each other; and the imprinted sheet is sent from the transfer drum 9 to the first inspection drum 10, passed to the second inspection drum 12, and further passed to the first impression drum 14; and

the sheet 5 is passed to the second inspection drum 12 after undergoing surface inspection on the first inspection drum 10 with the surface inspection camera 11." (Cited from the Decision)

(ii) Well-known Techniques (Exhibit A4 Publication, Exhibit A5 Publication, Exhibit A8 to Exhibit A10 Publications)

"...a linear camera is used as an inspection camera of an inspection machine..." (Cited from the Decision)

(3) The Claims (corrected) (only Claim 1 stated) (Claimed Invention 1)

[Claim 1] A machine for inspecting a print in a form of an imprinted sheet, like securities, paper money, bank notes, passports, and other likewise documents, the machine comprising:

a sheet feeder (1);

a first sheet inspection unit including a first inspection cylinder (4) for conveying an imprinted sheet at the time of inspection, first illumination means (5) and a first linear camera (6) linked to an analyzer for photographing an image of the imprinted sheet in the course of being conveyed onto the first inspection cylinder (4);

a second sheet inspection unit including a second inspection cylinder (7) for conveying the imprinted sheet at the time of inspection, second illumination means (8) and a second linear camera (9) linked to the analyzer for photographing an image of the imprinted sheet in the course of being conveyed onto the second inspection cylinder (7);

a third sheet inspection unit including a third inspection cylinder (12) for conveying the imprinted sheet at the time of inspection, third illumination means (13) and a third linear camera (14) linked to the analyzer for

photographing an image of the imprinted sheet in the course of being conveyed onto the third inspection cylinder (12);

an input transfer cylinder (3) for continuously conveying the imprinted sheet to the first inspection unit and an output transfer cylinder (17) for taking the imprinted sheet out of the third inspection unit, wherein

the input transfer cylinder (3), the first inspection cylinder (4), the second inspection cylinder (7), the third inspection cylinder (12), and the output transfer cylinder (17) are arranged in direct contact with each other so as to directly, continuously convey the imprinted sheet from the input transfer cylinder (3) to the first inspection cylinder (4), the second inspection cylinder (7), the third inspection cylinder (12), and the output transfer cylinder (17); and

the first sheet inspection unit, the second sheet inspection unit, the third sheet inspection unit, the input transfer cylinder (3), and the output transfer cylinder (17) are arranged so as to take the inspected, imprinted sheet out of the first, second, and third inspection cylinders (4, 7, and 12) only when the imprinted sheet has finished undergoing inspection in the first sheet inspection unit, the second sheet inspection unit, and the third sheet inspection unit.

(4) Procedural History

October 27, 2011	:	Trial for Patent Invalidation by Plaintiff (Muko No. 2011-800218)
February 9, 2012	:	Request for Correction by Defendant (Patentee) (see "The Claims" above)
February 9, 2012	:	The appeal decision stating that "correction is admitted and that the trial for patent invalidation shall not lie."

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

Appeal Decision (cited from the Court Decision)
(A) Difference 1 ...in Invention of Exhibit A1, the plurality of sets of sheet inspection units assumes a number of two. It is unknown that the cameras provided in the respective sheet inspection units are linear cameras. In addition, it is unknown whether or not the respective inspection cylinders are configured so as to take the inspected, imprinted sheet out of the inspection cylinders only when inspection of the imprinted sheet has finished in each of the sheet inspection units.... The decision has the following interpretations. "The technical significance achieved when the corrected claimed invention 1 (...the claimed invention 1...) is provided with the specified matter relevant to Difference 1 can be said to lie in: that, as a result of the three sets of sheet inspection units being provided, it becomes possible of an inspection machine to subject an imprinted sheet to at least three types of inspection; that "the compact inspection machine can be embodied" by reducing the diameter of each of the inspection cylinders by use of the linear camera despite one inspection machine having as many as three inspection cylinders...; and that more concerned influence of "transfer from one cylinder to another cylinder" on inspecting operation, which would be entailed by use of a linear camera in a small-diameter inspection cylinder, is eliminated by "taking the inspected, imprinted sheet out of the first, second, or third inspection cylinder...only when inspection of the

imprinted sheet has finished in the first inspection unit, the second inspection unit, or the third inspection unit", whereby appropriate inspection of sheets and "providing a reliable inspection machine and method" are achieved." "The specified matter of the corrected claimed invention 1 relevant to Difference 1 can be fragmentarily inferred from Exhibit A2 to Exhibit A6 (...Document of Exhibit A2 through Document of Exhibit A6...). However, it is impossible to find, out of Exhibit A2 to Exhibit A6, any statements or suggestions about the technical significance of the corrected claimed invention 1 relevant to Difference 1; that is, the use of the "linear camera" for a specific purpose...and the combined use of "linear cameras" with the matter of "taking the inspected and imprinted sheet ... out of the first, second, or third inspection cylinder only when inspection of the imprinted sheet has finished in the first inspection unit, the second inspection unit, or the third inspection unit," are not found. It is consequently interpreted that there is no motivation to derive the specified matter of the corrected claimed invention 1 relevant to Difference 1, by means of the organic combination of Invention of Exhibit A1 to Invention of Exhibit A6 to solve the problems of "making it possible to make up a compact inspection machine" and "providing a reliable inspection machine and method."

Decision

Allegations by Plaintiff	Allegations by Defendant
(B) In connection with the point of Difference 1, a difference truly lies in the number of sets of inspection units that is a mere design matter. Accordingly, the claimed invention 1 can be readily conceived solely from Invention of Exhibit A1. Further, even on the premise of the Difference 1 acknowledged by the appeal decision, the number of sets of inspection units is a mere design matter. Further, using the linear camera as the inspection camera is a well-known technique. Selecting which one of types of inspection cameras is a mere design matter which a designer selects in accordance with an objective of inspection and an inspection target. Document of Exhibit A2 states the configuration in which the imprinted sheet is not transferred to the next cylinder, etc., before finishing being photographed by a camera. With the above things considered, a person skilled in the art can readily conceive the claimed invention 1 by combination of Invention of Exhibit A1 and Invention of Exhibit A2. Therefore, the claimed invention has no inventive step.	Since a suggestion, or the like, that the practice would have been done in order to reach the point of feature of the claimed invention 1, does not exist at all in Document of Exhibit A1 and Document of Exhibit A2, none of the publications include a motivation or a suggestion for deriving the specified matter of the claimed invention 1 pertinent to the Difference 1 by combination of the publications. ** The appeal decision does not include any statements about "the claim on the number of sets of inspection units." (a comment by the searcher).*

Judgment by the Court

(A) The two sets of inspection units are provided in Invention of Exhibit A1, whereas the three sets of inspection units are provided in the claimed invention 1. In this respect, the number of sets of inspection units to be disposed can be a matter of design variation which a person skilled in the art can properly select in consideration of a purpose of an inspection and an inspection target. In relation to Invention of Exhibit A1, it is understood that a person skilled in the art can set, as necessary, three sets of inspection units, each of which is made up of the inspection drum and the inspection device. Therefore, it cannot be construed that the cited documents need to include an explicit disclosure about setting the number of inspection units to three.

(C) ...using what type of camera as an inspection camera for the inspection machine is a matter of design variation which a person skilled in the art can properly select in consideration of a purpose of inspection and an inspection target....

In addition, a problem to reduce the size and weight of machines and tools is in itself a general problem. Besides that, in Invention of Exhibit A1, a necessity for reducing the size of each inspection unit is a concomitant of an increase in the number of sets of inspection unit.

(D) Defendant makes allegations that there is neither a motivation nor a suggestion deriving a specific matter of Claimed Invention 1 pertinent to the Difference 1 from the cited documents alleged by Plaintiff. However, in relation to Invention of Exhibit A1, it is a matter of design variation to increase from one set of inspection units to three sets of inspection units that a person skilled in the art can conceive as appropriate in consideration of a purpose of inspection and an inspection target even when the cited documents do not include any explicit descriptions. Moreover, as stated above, use of a linear camera, which is a well-known technique for an inspection camera, in order to reduce the size of each inspection unit associated with the above modification is a matter of design variation that a person skilled in the art can select as required. Therefore, the allegations by Defendant are unreasonable.

(43)-12

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

Case	"Oral pharmaceutical preparation" (Trial for Invalidation) Intellectual Property High Court Decision, July 11, 2013 (2012 (Gyo KE) No. 10297)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-79499 (JP 2001-261553A)
Classification	A61K 9/20
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Akio DOI, Judge: Yoshiki TANAKA, Judge: Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is directed to provide a preparation comprising bepotastine of S-configuration in high optical purity and free of racemization. The invention was completed by finding that the formulation of bepotastine or a pharmacologically acceptable salt thereof with a combination of mannitol, saccharose, lactose or a mixture thereof as an excipient and polyethyleneglycol as a binder markedly suppresses racemization of bepotastine or a pharmacologically acceptable salt thereof, resulting in markedly improved storage stability and improved production efficiency of the preparation.

(2) State of the Art

(i) Citation 1 (Cited Invention): JP H10-237070A (found in Trial Decision)

"... A pharmaceutical composition for oral administration, comprising (S)-4-[4-[(4-chlorophenyl)(2-pyridyl)methoxy]piperidino]butanoic acid benzenesulfonate combined with an additive." (cited from Court Decision)

(3) The Claims (only claim 1 is shown) (Invention 1)

[Claim 1] A solid preparation for oral administration, comprising bepotastine benzenesulfonate combined with an excipient selected from mannitol, saccharose, lactose and a mixture thereof and polyethyleneglycol.

(4) Procedural History

September 16, 2011 : Request for a trial for patent invalidation by Plaintiff (Muko No. 2011-800177)

July 9, 2012 : Appeal Decision that "the patent for the inventions claimed in claim 1 ... is to be invalidated...."

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision) * Hereinafter, the italic letters indicate matters added to the citation.</td></tr>
<tr><td colspan="2">(1) The reason of Trial Decision is, in brief, that a person skilled in the art could easily invent the Invention based on the inventions stated in Citations 1 to 3 ... (referred to as "Cited Invention 1," "Cited Invention 2," "Cited Invention 3," respectively).
(2) The differences between Invention 1 and Cited Invention 1 found in the Trial Decision are as follows:
C Difference 1: Whereas the pharmaceutical composition of Invention 1 is "a solid preparation for oral administration," the pharmaceutical composition of Cited Invention 1 is for oral administration, but is not stated to be "a solid preparation."
D Difference 2: Whereas the pharmaceutical composition of Invention 1 comprises "an excipient selected from mannitol, saccharose, lactose and mixture thereof and polyethylene glycol" as additives, Cited Invention 1 does not concretely specify the additive.
(Hereinafter, citation form Trial Decision)
... Formulating the pharmaceutical composition for oral administration of Cited Invention 1 into a solid preparation, which is a highly versatile dosage form, is a matter which can easily occur to a person skilled in the art without special originality or ingenuity.
... With the knowledge of additives which can solve the problem of adverse effects of water in a solid formulation, investigating whether the additives can be used in a solid formulation of the benzenesulfonate of Cited Invention 1 is a routine matter for a person skilled in the art.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) Regarding judgment on Difference 1
... As it is the case for eye lotions, for example, which are formulated in solution, because the crystal state is stable, it does not immediately follow that formulating it in a solid state is assumed. Moreover, in the pharmacological tests stated in Citation 1 the test</td><td>Allegations by Defendant
(1) Regarding Difference 1
The solid preparation is the general-purpose preparation that is most widely adopted as a dosage form of pharmaceutical compositions for oral administration such as Cited Invention 1. With or without a statement that a crystal is the most</td></tr>
</table>

substances were administered in solution or suspension. Therefore, it is not clear from the statement of Citation 1 whether crystal is the most preferable as a state of the active pharmaceutical ingredient contained in the oral administration preparation. (2) Regarding judgment on Difference 2 In Table 4 in Citation 1, only content of related substance, content of (R)-form, appearance and moisture absorption are listed regarding bepotastine benzenesulfonate. Moreover, it cannot be understood that water has adverse effects on bepotastine and the benzenesulfonate thereof and that there is a problem on the moisture absorbency .... It can be considered as a common general knowledge that a chemical substance which is stable in the state of bulk drug may become unstable after formulation. In order to investigate the cause of destabilization, it is necessary to examine closely various physicochemical properties of the bulk drug and consider test results on the compatibility with additives. Therefore, the risk that water has adverse effects on the stability of bepotastine benzenesulfonate cannot be easily inferred.	preferable form of the active pharmaceutical ingredient contained in the oral administration preparation in Citation 1, it is rather natural that a person skilled in the art selects the dosage form. ... The fact that bulk drugs stable in crystal can be combined in eye lotions does not exclude the possibility that bulk drugs stable in crystal be combined in a solid state. There is no relation between the way of carrying out a pharmacological test and the final form of the medicament. (2) Regarding judgment on Difference 2 ... The stability test in Citation 1 suggests that bepotastine benzenesulfonate is affected by water. ... To solid preparations such as the Invention, there is no reason to add acid or alkali as an additive component on purpose. After formulation, they are stored so as to avoid the effects of light, heat, and the like, as a matter of course. Therefore, water is substantially the only problem. Water contained in additives and the atmosphere may affect the stability of the preparation even after formulation. Therefore, when choosing additives, it is a natural consideration for a person skilled in the art to avoid water, which is a factor to cause racemization.
Judgment by the Court (1) Regarding judgment on Difference 1 A <u>The solid formulation such as tablets, granules, and capsules is a common dosage form of medicaments to be administered orally, as Appeal Decision points out that it is highly versatile. Therefore, with the disclosure of the medicine for oral administration in Citation 1, a person skilled in the art immediately assumes solid preparations such as tablets, granules, capsules and the like as dosage forms of this medicine.</u> ... Just because active pharmaceutical ingredients stable in a crystalline state may be formulated into eye lotions, which are solutions, it does not follow that formulation of bulk drugs stable in a crystalline state into a solid preparation such as a tablet is prevented. Just because, in a pharmacological test to be conducted to show pharmacologic properties of a compound, test substances were administered in solution or suspension for convenience, it does not follow that it is not prevented that a person skilled in the art assumes solid preparations, which are common as a dosage form of medicine. (2) Regarding judgment on Difference 2	

... Citation 1 discloses that hygroscopic active pharamaceutical ingredients have a problem of physicochemical stability, andwhen pharmaceuticals are produced with such active pharamaceutical ingredients, it is difficult to secure and maintain the quality of the pharmaceuticals. Since the hygroscopicity is considered to be a problem, Citation 1 is found to point out water as a cause of the problem of physicochemical stability of pharmaceuticals.

... Citation 1 finds that crystal of bepotastine benzenesulfonate is less hygroscopic and discloses that it has suitable properties as pharmaceuticals. Therefore, it is considered that a person skilled in the art who has understood, from the statement of Citation 1, that water is a cause of the problem of physicochemical stability of pharmaceuticals would try to avoid effects of water, when he/she intends to formulate bepotastine benzenesulfonate, so that water does not adversely affect the physicochemical stability of the formulation of bepotastine benzenesulfonate.

(43)-13

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.1.2(1)
Classification of the Case	43: Whether or not difference between Claimed Invention and main cited invention can be deemed as a workshop modification
Keyword	

1. Bibliographic Items

Case	"Rapid setting cement composition" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 19, 2014 (2012 (Gyo KE) No. 10423)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-532594 (National Publication of International Patent Application No. 2005-537208)
Classification	C04B 28/04
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Yoshinori TOMITA, Judge: Ichiro OTAKA, Judge: Yoshiki TANAKA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to adding alkanolamine to a hydraulic cement such as portland cement, and forming a slurry with water under conditions that provide an initial slurry temperature of at least 90°F to achieve extremely fast setting of cementitious compositions to form cement-base products, such as cement boards.

(2) State of the Art

(i) Citation (Cited Invention): JP 2000-233959A (found in the Appeal Decision)

"A high-early-strength cement composition to prepare a concrete product, comprising the following (a') and (c')-(f'):

(a') portland cement and clinker ground material;

(c') sand;

(d') triethanolamine as a cement hardening accelerator for (a');

(e') sufficient water to prepare a slurry ;

(f') a naphthalenesulfonate high-performance water reducing agent;

the slurry being at an ambient temperature when components (a') and (c')-(f') are mixed to form the high-early-

strength cement composition." (cited from the Court Decision)

(ii) Well-known art (Well-known Example 1 to 3) (found in the Appeal/Trial Decision)

"....Generally, the kneading (mixing) temperature is increased for hardening acceleration when components are mixed to prepare cement compositions." (cited from the Court Decision)

(3) The Claims (Amended) (Claimed Invention)

[Claim 19]

A composition for preparing a cement board, comprising the following (a)-(e):

(a) portland cement;

(b) mineral additive;

(c) aggregate;

(d) as an accelerator for components (a) and (b) an alkanolamine ;

(e) sufficient water to prepare a slurry ;

the slurry being at a temperature of at least 90°F when components (a)-(e) are mixed to form the composition.

(4) Procedural History

July 10, 2003	:	Patent application (priority date: August 29, 2002, USA)
November 30, 2009	:	Decision of refusal
April 1, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-6832) Amendment (See the aforementioned "The Claims")
July 20, 2012	:	Appeal Decision that "the request for the appeal is to be dismissed."

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

Appeal Decision (cited from the Court Decision)
The ...differences between the Claimed Invention and the Cited Invention found in the Appeal Decision are as follows. F Difference 5 Whereas the Claimed Invention is a composition "comprising the following (a)-(e)" and "<u>being at a temperature of at least 90°F</u> when components (a)-(e) are mixed," the Cited Invention is a composition "comprising the following (a') and (c')-(f')" and "<u>being at an ambient temperature</u> when components (a') and (c')-(f') are mixed to form the high-early-strength cement composition." ...It is an idea which a person skilled in the art could easily conceive to apply the aforementioned well-known art for the hardening acceleration, which is one of the objects. The determination of the kneading (mixing) temperature in such an application is considered to be a matter of workshop modification (a matter determined within trial and error) which any person skilled in the art can determine appropriately in light of

balance with the fluidity of the cement composition slurry and the strength of the cured slurry ...
Decision

Allegations by Plaintiff	Allegations by Defendant
...The problem to be solved by the Claimed Invention is to accelerate the initial curing to result in a completion time of setting of ..., most preferably, less than 10 minutes ....and the Claimed Invention aims to accelerate setting to improve productivity by promoting the formation of ettringite. Meanwhile, the problem to be solved by the Cited Invention is ...to delay the initial curing, and the Cited Invention aims to suppress the formation of ettringite to provide sufficient workability, because the formation of ettringite occurs too fast to maintain the desired workability. The problem to be solved by the Cited Invention is opposite of the problem to be solved by the Claimed Invention. Therefore, the combination of the Cited Invention with the well-known art to increase the kneading (mixing) temperature for hardening acceleration only leads to the idea of increasing the temperature from the curing stage after the concrete placing, but not the idea of increasing the kneading (mixing) temperature when components are mixed to form a cement composition. Thus, the Citation and the well-known art cannot be a cause or motivation of the claimed invention. ...In the Cited Invention, in which the kneading is carried out at ambient temperature which cannot be controlled, there is no idea of controlling the slurry temperature to a predetermined temperature. Therefore, there is no cause or motivation to combine the Cited Invention with the well-known art of controlling the slurry temperature higher and increasing the kneading temperature for hardening acceleration. ...The common general knowledge that	Since the mixing temperature of slurry is approximately 10-50°C from the common general knowledge as of the filing ..., it is apparent that also in the Cited Invention the mixing is carried out in such a temperature range. ...Whether a temperature range of more than 30°C or a temperature range of 30°C or less is selected is a matter of whether the setting property or strength is to be prioritized. A person skilled in the art could easily conceive the idea of selecting a temperature range of more than 30°C, as in the Claimed Invention, in prioritizing the setting property in the Cited Invention. Moreover, the working-effect resulted from the selection is just a balanced combination of the setting property (fluidity) and strength within the range predictable for a person skilled in the art. Therefore, the Appeal Decision found it a matter of workshop modification in light of balance with fluidity and strength. ...It can be neither considered that the technical problems to be solved by the Claimed Invention and by the Cited Invention are completely opposite, nor that there is no cause or motivation to combine the Citation and the well-known art. In the Cited Invention, it is a matter of course to carry out the mixing in a temperature range of the common general knowledge of those skilled in the art to mix cement. Therefore, the Plaintiff's allegation that there is no cause or motivation to combine the Cited Invention with the well-known art of controlling the slurry temperature (kneading temperature) high on the assumption that there is no idea of controlling the slurry temperature (kneading temperature) to a predetermined temperature in the Cited Invention has

increasing the slurry temperature results in the reduction of strength serves as a negative factor for combining the Cited Invention, which has no idea of controlling the slurry temperature to a predetermined temperature, with the well-known art of increasing the kneading temperature for hardening acceleration ... The Claimed Invention is an invention of a ...slurry composition having a setting speed to improve productivity and strength to bear actual use by adjusting the composition of cement composition and the kneading temperature. Because of the common general knowledge that hardening at a high temperature results in the reduction of strength, ...even a person skilled in the art could not expect the very fast setting effect. Furthermore, the Claimed Invention is completed as a very fast setting cement composition having sufficient strength, by going beyond the conventional common general knowledge and setting the kneading temperature high. The Appeal Decision overlooked the superior effects of the Claimed Invention and erred on the judgement on whether it could be easily conceived.	no grounds. ...The common general knowledge that increasing the slurry temperature results in the reduction of strength is not such a negative factor that a person skilled in the art gives up an application to the Cited Invention of the well-known art of increasing the kneading temperature for hardening acceleration. The Claimed Invention is not specified in the claims regarding the content of triethanolamine, which is required for the result of the working example and the absence of high alumina cement and gypsum. Therefore, the aforementioned effect cannot be regarded as a working-effect of the entire scope of claims. Slurries having a balanced combination of the setting property and strength are commonly known (the Citation (paragraph [0021], [0037], [Table 6]), Exhibit A9 (Table 1), Exhibit A31 (paragraphs [0021], [0022])). Moreover, the aforementioned effect is a predictable effect for a person skilled in the art that the setting completion time is shortened by increasing the slurry temperature.

Judgment by the Court

...Correctly, Difference 5 (Difference 5 found in the Judgment by the Court is hereinafter referred to as "Difference 5'.") should be found as follows.

B Difference 5'

Whereas the claimed invention is a composition "comprising the following (a)-(e)" and "when components (a)-(e) are mixed to form the composition," the slurry "is at a temperature of at least 90°F," the Cited Invention is a composition "comprising (a') and (c')-(f')," but the temperature of the slurry is unknown when these components are mixed .

Hereinafter, it is considered whether the Appeal Decision errs on the judgement on whether it could be easily conceived based on Difference 5' ...between the Claimed Invention and the Cited Invention.

(1) Regarding the judgement on whether Difference 5' could be easily conceived.

A The problem to be solved by the Cited Invention is ...as follows: regarding the production of concrete products in a short time, a conventional method takes time from the molding of concrete to the removal of forms and is desired to have higher efficiencies in the rotation of mold. ... In the method of curing at a high temperature after molding, forms can be removed in a short time, ...but it was difficult to obtain desired workability (easiness

of pouring and placing the concrete into mold) because the formation of ettringite occurs in a short time. Therefore, the problem to be solved by the Cited Invention is to provide cement that maintains good workability until the placement of concrete is finished, but harden early after the concrete is placed in a mold to produce high-strength concrete.

B Then, it is considered that the Cited Invention basically aims to produce concrete products in a short time, as a premise, and to harden concrete early for the purpose. Moreover, from ...the Citation, ...to "harden concrete early" includes to "set concrete early." Thus, it can be understood that the Cited Invention aims to set concrete early in order to produce concrete products in a short time. Therefore, in the Cited Invention, there is a cause or a motivation to apply means to set concrete even earlier in order to produce concrete products in a shorter time....

C ...the Cited Invention aims to maintain good workability until the placement of concrete is finished, because it will become difficult to obtain desired workability if the formation of ettringite occurs too fast and the concrete sets too early. Then, it can be understood that the Cited Invention aims, for the purpose of maintaining good workability, to prevent concrete from setting too early until the placement of concrete is finished.

However, this does not prevent applying means to set concrete even earlier in the Cited Invention. The reason why it becomes difficult to obtain desired workability is ...that concrete sets too early. In the Cited Invention, even if means to set concrete even earlier is applied, good workability is maintained unless the conditions that set concrete too early is adopted. Early setting and the maintenance of good workability can be compatible each other.

As above, because the Cited Invention aims, for the purpose of maintaining good workability, to prevent concrete from setting too early until the placement of concrete is finished, it does not follow that it is prevented to apply means to set concrete even earlier in order to produce concrete products in a shorter time. Therefore, there is a cause or a motivation to apply such means.

D ...it was well-known art prior to the priority date of the Application to increase, when the ingredients constituting concrete are mixed, the temperature of kneaded ingredients (increase the temperature of slurry) for acceleration of hardening (setting). ... In the Cited Invention, the specific temperature of slurry when the ingredients constituting the composition are mixed is a matter which a person skilled in the art can decide as appropriate depending on the purpose such as how early the concrete is to be set. It is considered that a person skilled in the art could easily conceive the idea of setting the temperature of slurry to "a temperature of at least 90°F."

(43-1)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1(Note 1) and 3.1.2(1)
Classification of the Case	43-1: Whether or not workshop modifications are taken into consideration when applying the sub cited invention to the main cited invention
Keyword	

1. Bibliographic Items

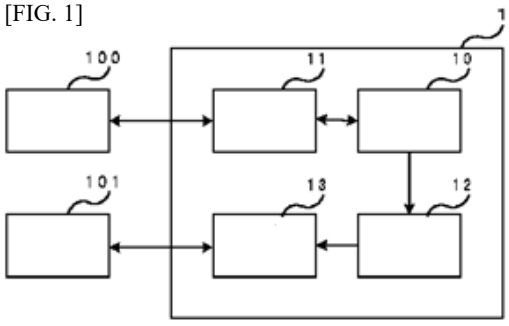
Case	""Information processing system and method, and medium storing information processing program running on computer" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 30, 2008 (2007 (Gyo KE) No. 10155)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2000-64192 (JP 2001-256356A)
Classification	G06F 17/60
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Naoki ISHIHARA, Judge: Yuuji KOGA, Judge: Ken ASAI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide information of sales price so that a user or a vendor can efficiently obtain information such as market price or lowest price, concerning goods for which multiple sales prices can be set according to vendor.

[FIG. 1]



100, 101 means for processing information
10 means for storing price
11 means for coping with vendors
12 means for storing order
13 means for coping with users

The claimed invention, comprising steps of: coping with vendors for storing/updating sales price that each vendor adopts for each of goods concerning a plurality of vendors, in association with information of vendors based on the input by vendors; storing orders for storing/updating, as the information of price order, extracted sales price, and the corresponding vendor's information within a prescribed upper number in order of lower price on each of goods; coping with users for outputting, for users, the information of price order, being read based on the input by users, and further comprising steps of

notification for notifying users of the fact of variation when sales price varies, concerning the goods designated by users. By these steps, the claimed invention provides information of sales price so that a user or a vendor can efficiently obtain information such as market price or lowest price concerning goods for which multiple sales prices can be set according to vendor.

(2) State of the art

(i) Citation 1 (Cited Invention 1):JP H9-251468A (Finding of Trial Decision)

"A goods retrieving system, comprising: a means for storing price that each vendor sets for each of goods, in association with the name of the vendors, concerning a plurality of vendors;

a receiving means for updating price stored, in association with the name of the vendor based on the information of goods received from a POS system of vendors;

a storing means of sorted price for storing price sorted in order of lower price on every type of goods and corresponding names of vendors;

a processing section for storing and updating as sorted data, on storing means of sorted price, price and corresponding name of the vendor sorted in order of lower price on every type of goods;

a sending section for providing consumers with sorted data selected based on access by consumers." (cited from the Court Decision)

(ii) Citation 2 (Cited Invention 2): JP H9-330355A (Finding of Trial Decision)

"To notify the situation of goods such as variation of price on a customer's terminal device, so that a customer can understand the situation of goods such as variation of sales price without customer's time-consuming investigation, when the price of the goods picked up by a customer varies"

(3) The Claims (Claimed Invention)

[Claim 1] An information processing system, comprising: a means for storing a price that each vendor sets for each of goods, in association with the information of the vendor, concerning a plurality of vendors;

a means coping with vendors for updating sales price stored, in association with the information of vendors based on the input by vendors;

a storing means of price order for storing and updating as the information of price order, extracted sales price and corresponding information of vendors within a prescribed upper number in order of lower price on every type of goods;

a means coping with users for outputting, for users, the information of price order read out based on input by users;

a notifying means for notifying users of the fact that lowest value of sales price varies, the fact that variation rate of lowest value of sales price exceeds a prescribed value or the fact that lowest value of sales price becomes not more than a prescribed value, with regard to the goods designated by users.

(4) Procedural History

March 8, 2000	:	Filing of Patent Application
May 27, 2003	:	Decision of Refusal
June 30, 2003	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2003-12181)
July 30, 2003	:	Amendment of Proceeding (See above "The Claims")
March 23, 2007	:	Trial Decision of "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">[Difference 3]
An information processing system in the claimed invention comprises a means for notifying users of the fact that the lowest value of sales price varies, the fact that variation rate of lowest value of sales price exceeds a prescribed value or the fact that the lowest value of sales price becomes not more than a prescribed value, with regard to the goods designated by users, while that in the cited invention does not.
... it is common knowledge in society that a consumer uses, as one determination material, the investigation of the situation of lowest value of goods, and Citation 1 states "a processing section 12 sorts the information of goods stored in file 14 in order of lower price, after sorting on every type of goods (Step S3). A goods retrieving system 1 discloses the processed information on the Internet 6 (Step S4)," and in consideration of already deliberated matters, said disclosed information is "always latest," and thus it is apparent that Cited Invention 1 inherently includes requests that a consumer can always understand the latest situation of lowest value.
Accordingly, in Cited Invention 1 a person skilled in the art could easily conceive of setting up, for the goods designated by a user, a notifying means for notifying said user of the fact that lowest value of sales price varies, by applying the technology of the invention as stated in Citation 2, so that a consumer can always understand the latest situation of lowest value.
That is, the person skilled in the art could easily conceive of the constitution pertaining to Difference 3 as stated in the claimed invention, based on the inventions as stated in Cited Invention 1 and Citation 2. (cited from the Court Decision)</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) The trial decision has made a determination that "it is apparent that Cited Invention 1 inherently includes requests that a consumer can always understand the latest situation of lowest value (hereinafter, this request is referred to as "the request")," but this decision is erroneous, as follows.
A Citation 1 states the merit of a vendor with regard</td><td>Allegations by Defendant
Since Citation 2 states "notifying the situation of goods such as variation of price on a customer's terminal device, so that a customer can understand the situation of goods such as variation of sales price without the customer's time-consuming investigation, when price of goods picked up by a customer varies," it is not especially difficult that a person skilled in the</td></tr>
</table>

to the sending of the "information of latest goods", but does not state the merit of a consumer with regard to the above matter. B Accordingly, in Cited Invention 1, the sending of the "information of latest goods" and the fact that the information consequently disclosed in a goods retrieving system is "always the latest" are not discussed in association with the merit of a consumer. Thus, it is not considered that Cited Invention 1 inherently includes the request. ... on the premise of above, there are errors in the reasoning of the trial decision as "applying the technology of the invention as stated in Citation 2, "so that a consumer can always understand the latest situation of lowest value" in Cited Invention 1". ... According to the statement of Citation 2, the constitution as disclosed in said citation that the notification is made to a customer "when the price of goods varies" does not presume the existence of a plurality of vendors, it should be understood as the constitution that the notification is made to a customer when the price of the goods adopted by one vendor varies. Therefore, it is apparent that Citation 2 does not disclose the concept of "lowest value" which presumes the existence of a plurality of vendors. Accordingly, in case of applying the constitution as disclosed in Citation 2 to Cited Invention 1, a person skilled in the art will conceive of the constitution that the notification is made to a customer when the price of the goods adopted by one vendor varies, and cannot easily conceive of the constitution of the claimed invention pertaining to Difference 3 that "the notification is made to a user when the lowest value of sales price varies."	art encountering Cited Invention 1 and Citation 2 attempts to modify Cited Invention 1 so that a user can always understand the latest situation of lowest value without user's investigation in many times, by applying the technology of the invention as stated in Citation 2.

Judgment by the Court

... As mentioned above 1, Cited Invention 1 inherently includes the request. Thus, it is reasonable to recognize that, by applying to Cited Invention 1, the constitution as disclosed in Citation 2 that the information of goods is notified to a customer at any time of notice and by any way of notice, after replacing said "any time of notice" with "when the lowest value of sales price varies," so that a consumer can always understand the latest situation of lowest value, a person skilled in the art could easily conceive of "a notifying means for notifying users of the fact that lowest value of sales price varies, with regard to the goods designated by users" (the constitution of the claimed invention pertaining to Difference 3). In that case, even if the invention itself as stated in Citation 2 does not include the concept of "lowest value," in light of the request which Cited Invention 1 inherently includes, it may be naturally selected to replace "any time of notice" of the constitution as disclosed in Citation 2 with "when the lowest value of sales price varies." Therefore, such plaintiff's assertion cannot be adopted that "in case of applying the constitution as disclosed in Citation 2 to Cited Invention 1, a person skilled in the art will conceive of the constitution that the notification is made to a customer when the price of the goods adopted by one vendor varies."

(43-1)-2

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1(Note 1) and 3.1.2(1)
Classification of the Case	43-1: Whether or not workshop modifications are taken into consideration when applying the sub cited invention to the main cited invention
Keyword	

1. Bibliographic Items

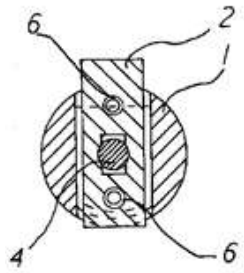
Case	"A brake device for linear motion" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 29, 2008 (2007 (Gyo KE) No.10295)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H7-104524 (JP H8-261257A)
Classification	F16D 63/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Tetuhiro NAKANO, Judge: Yoshiyuki MORI, Judge: Katumi SHIBUYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide a brake device for linear motion cutting off partially an inner peripheral surface of a brake part 2, and decreasing parallel reaction to force of brake operation and increasing perpendicular reaction.

[FIG. 1]



(2) State of the art

(i) Citation 1 (Invention of Citation 1):JP S57-052404Y (Finding of Trial Decision)

"A braking device 2 comprising: a cylindrical body 4 of a braking device attached to a cylindrical body 3; slidable a braking plate 5 of the braking device 2 connected to the outer periphery of a piston rod 1; a braking part 12 pressingly contacted to the piston rod 1 by sliding of the braking plate 5, braking the piston rod 1 by friction between two parts." (cited from the Court Decision)

(ii) Citation 2 (Invention of Citation 2):JP S59-223551A(Finding of Trial Decision)

To "cut off a part of the inner surface of a cylinder of brake metal 5 in a brake device for a pneumatic cylinder"

(3) The Claims (Claimed Invention)

[Claim 1] A brake device for linear motion, being characterized by: removing a majority of parallel reaction to a rotation moment and increasing perpendicular reaction to said rotation moment by making a brake part partially contact with the outer periphery of a guide rod, in the brake device using a brake force of a slidable body, friction between said guide rod and said brake part generated by setting up the guide rod along with motion of the slidable body that makes linear motion, and attaching the brake part to the outer periphery of said guide rod, and giving to said brake part the rotation moment along with a plate including the main axis of said guide rod.

(4) Procedural History

March 23, 1995	:	Filing of Patent Application (See above "The Claims")
November 12, 2004	:	Decision of Refusal
December 17, 2004	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2004-26751)
June 18, 2007	:	Trial Decision that "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">Citation 2 states that, a part of the inner surface of a cylinder of brake metal 5 is cut off in a braking device for a pneumatic cylinder. In this way, it is apparent that the brake metal 5 partially contacts with the outer periphery of a piston rod 1, by cutting off a part of the inner surface of a cylinder of brake metal 5.
The purpose of cutting off a part of the inner surface of the cylinder of the brake metal 5 in Citation 2 is to reduce the weight of a rod metal 4, 11 set up between a rod end block 2, a braking cylinder block 10, and a piston rod 1 in a braking device. Since the invention pertaining to Citation 1 and the braking device of Citation 2 are common in terms of each being a braking device of a cylinder, it is recognized that a person skilled in the art could easily conceive of adopting the above matter of citation 2 in the braking plate 5 pertaining to the invention of Citation 1, for reducing the weight on the edge part wall of a body 4 of a braking device 2 and an edge part wall of a cylinder's main body 3 pertaining to the invention of Citation 1.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
An air cylindrical braking device uses as braking force, the value that weight on piston rod in the perpendicular direction is multiplied by coefficient of friction, and the invention of Citation 1 uses as a part of braking force the value obtained by multiplying the weight from the edge part wall by coefficient of friction. Therefore, it is better that the above weight is</td><td>Allegations by Defendant
There is no technical impediment in adopting the matter of cutting a part of the inner surface of cylinder of brake metal 5 as stated in Citation 2 in braking plate 5 of the invention of Citation 1, for reducing the weight on edge part wall, doing as above should be taken into account by a person skilled in the art or is at least the matter of design to be optionally adopted.</td></tr>
</table>

not reduced and remains a large value. To reduce the weight on the edge part wall is not meaningful as above, and reduces the function as brake device of the invention of Citation 1, in this meaning, there is no room, in any respect, to apply the constitution of cutting off a part as stated in Citation 2, for reducing the weight on the edge part wall of the invention of Citation 1.	

Judgment by the Court

Plaintiff asserts that there is a lack of motivation to apply to the invention of Citation 1 the constitution of cutting a part as stated in Citation 2.

However, to reduce the working force for generating brake force in a brake device is a technical problem that a person skilled in the art naturally attempts to solve in view of durability of brake device or the like, and thus it is recognized that there is motivation to apply Citation 2 to the invention of Citation 1.

... to cut the inner surface of the cylinder to the degree that the sliding face of a piston rod is not damaged and to set thickness of plate to the degree that braking force is generated, when applying the technology of Citation 2 to the invention of Citation 1 are the matters of workshop modification that a person skilled in the art can optionally conceive of.

(43-1)-3

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.1.1(Note 1) and 3.1.2(1)
Classification of the Case	43-1: Whether or not workshop modifications are taken into consideration when applying the sub cited invention to the main cited invention
Keyword	

1. Bibliographic Items

Case	"Safety elevator" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, March 25, 2014 (2013 (Gyo KE) No.10278)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2006-175440 (JP2008-1512A)
Classification	B66B 1/14
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Ryuichi SHITARA, Judge: Rika NISHI, Judge: Koki KAMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

A fingerprint comparator is installed in an elevator. Ordinarily, a service of destination floor is separated by a fingerprint comparator. If fingerprint is authenticated by a fingerprint comparator, a button of destination floor can be temporarily registered, and then if a button of destination floor is pushed within prescribed time, a door is closed and moving direction is determined. In a state that each of safety devices regularly work and that a car door and each landing floor door are closed, after a door-closing inspection circuit and a safety circuit are activated, an elevator runs toward destination floor.

(2) State of the art

(i) Publication 1 (Invention as stated in Publication 1) : JP H5-008951A (Finding of Appeal Decision)

"An elevator for security, comprising: palm or fingerprint identification and detection device 6 installed in a car of an elevator; a destination floor registration circuit equipped with a circuit including palm or fingerprint identification and detection device 6, bio ID timer 14 and bio ID timer connection 14a; a run door 9 and landing floor doors 3; running when destination floor is registered." (cited from the Court Decision)

(ii) Publication 2 (Invention as stated in Publication 2): JP H10-017233A (Finding of Appeal Decision)
"A safety elevator, equipped with a safety circuit for confirming open-and-close of a car door and landing floor doors; running when all of a car door and landing floor doors are closed and destination floor is registered."

(3) The Claims (Claimed Invention)
[Claim 1] A safety elevator for security, characterized in that personal authentication such as fingerprint authentication, pupil authentication, palm authentication and password keyboard is only installed in a car of an elevator, and a destination floor button registration circuit incorporating a personal authentication circuit is installed, and a safety circuit for confirming open-and-close of a car door and landing floor doors is installed, and said destination floor button registration circuit is different from previous-term(error of "said") safety circuit, an elevator can run when all of said car door and said landing floor doors are closed and destination floor is registered.

(4) Procedural History

June 26, 2006	:	Filing of Patent Application
December 28, 2011	:	Amendment of Proceeding (See Above "The Claims")
June 22, 2012	:	Decision of Refusal
August 9, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2012-16577)
September 14, 2013	:	Appeal Decision that "the request for appeal is dismissed."

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

Appeal Decision
In an elevator, to make destination floor button registration circuit to be different circuit from safety circuit for confirming open-and-close of a car door and landing floor doors is well-known technology before filing of the application (See, for example, JP S55-31769A [especially, 2nd row from the bottom line of lower right field of page 2 to 11th row of upper left field of page 3, 1st to 4th row of upper right field of page 3, 3rd to 10th row of lower left field of page 3, 2nd to 14th row of upper left field of page 4, and 2nd row from the bottom line of upper right field to 4th row and figure 1 of lower left field of page 4], JP H2-132088A [especially, 9th to 14th row of upper left field of page 2, 4th to 18th row of lower right field of page 2, and 2nd row from the bottom line of upper right field of page 3 to 8th row and FIG. 1 of lower left field], JP H6-1554A[especially, paragraph [0009] to paragraph [0013], and FIG. 1 and FIG. 2] and the microfilm of Japanese Utility Model Application No. H1-2111(JPH2-94877U) [especially, 8th row of page 4 to 5th row and FIG. 1 of page 5 of the description], etc. Hereinafter referred to as "Well-Known Technology 2"). Accordingly, in the invention as stated in Publication 1, when applying the invention as stated in Publication 2 for the purpose of solving well-known problem, a person skilled in the art could easily conceive

<table>
<tr><td colspan="2">of constituting the matter specifying the invention pertaining to Difference 2 by adopting Well-Known Technology 2 as an embodiment means.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The appeal decision has found and determined that, in the invention as stated in Publication 1, when applying the invention as stated in Publication 2 for the purpose of solving well-known problem, a person skilled in the art could easily conceive of constituting the matter specifying the invention pertaining to Difference 2 by adopting Well-Known Technology 2 as an embodiment means. However, the invention has inventive activity as follows, and these matters are not stated in any of citations.
Therefore, there are errors in finding and determination of the appeal decision.
(1) inventive activity that loses the recognition of the invention outside of a car
(2) inventive activity that recognizes only inside of a car
(3) inventive activity that treats inside of a car as one recognition device
(4) inventive activity that keeps safety only by one recognition device at the inside of a car
(5) inventive activity that a car can run toward a destination floor, even when pulled from outside
(6) inventive activity that a car does not run toward a destination floor, even when people rides on a car
(7) inventive activity that a car door does not open, even when a car runs toward a destination floor with people</td><td>Allegations by Defendant
In an elevator, for safety running, to install a safety system that a car can run only when all doors of the entrances of a car and a hoistway are closed is well-known technical problem (Exhibit A4, A5) that a person skilled in the art of elevators commonly knows, as set forth in Enforcement Ordinance of Construction Building Standards Act, and it is the problem to be naturally recognized in the design of elevators. Thus, the invention as stated in Publication 1 inherently includes the problem that above safety system should be installed.
In addition, the invention as stated in Publication 2 can be said to be a specific example, and plaintiff admits that the constitution of said security system is same one as the invention.
On the other hand, in an elevator, as indicated in Exhibit A6 and A9, it is well-known technology (Well-Known Technology 2) to make a destination floor button registration circuit to be different from a security circuit for confirming open-and-close of a car door and landing floor doors.
Accordingly, in the invention as stated in Publication 1, when applying the invention as stated in Publication 2 for the purpose of solving well-known problem, a person skilled in the art could easily conceive of adopting Well-Known Technology 2 as an embodiment means.</td></tr>
<tr><td colspan="2">Judgment by the Court
(2) Well-Known Problem
In view of the statement of JP S61-166489A (Exhibit A4) (lowest row of lower left field of page 1 to 6th row of lower right field of page 1) and the statement of JP S61-221079A (Exhibit A5) (4th row to 11th row of lower right field of page 1), it is recognized that, in an elevator, for safety operation, to install a security system that a car can move up and down only when all doors of the entrances of a car and a hoistway are closed, as set</td></tr>
</table>

forth in Enforcement Ordinance of Building Construction Standards Act, was well-known technical problem before filing of the application,.

Accordingly, it is recognized that the invention as stated in Publication 1 inherently includes the problem that, for safety operation, such a security system should be installed that a car can move up and down only when all doors of the entrances of a car and a hoistway are closed.

(3) Well-Known Technology

In light of the statement of JP S55-31769A (Exhibit A6) relating to the invention title of which is "an elevator control device" (2nd row from the bottom line of lower right field of page 2 to 11th row of upper left field of page 3, 1st to 4th row of upper right field of page 3, 3rd to 10th row of lower left field of page 3, 2nd to 14th row of upper left field of page 4, and 2nd row from the bottom line of upper right field to 4th row and figure 1 of lower left field of page 4), the statement of JP H2-132088A (Exhibit A7) relating to the invention the title of which is "an elevator control device" (9th to 14th row of upper left field of page 2, 4th to 18th row of lower right field of page 2, and 2nd row from the bottom line of upper right field of page 3 to 8th row and figure 1 of lower left field), the statement of JP H6-1554A (Exhibit A8) relating to the invention the title of which is "an elevator operation device" (paragraph [0009] to paragraph [0013], and FIG. 1 and FIG. 2) and the statement of the microfilm of Japanese Utility Model Application No. H1-2111(JPH2-94877U) (Exhibit B5) relating to the device the title of which is "an elevator operation device" (8th row of page 4 to 5th row and FIG. 1 of page 5 of the description), it is recognized that, in an elevator, it was well-known technology before filing of the application (Well-Known Technology 2) that a destination floor button registration circuit was a separate circuit from a safety circuit for confirming open-and-close of a car door and an elevator hall door.

(4) Determination on Easily Conceiving

In light of recognition of above (1) to (3), it is recognized that a person skilled in the art could easily conceive of constituting the matter specifying the invention pertaining to Difference 2 by applying the invention stated in Publication 2 and using Well-Known Technology 2 as the embodiment therefor of the invention of Publication 2, for the purpose of solving the problem as recognized in above (2), with regard to the invention as stated in Publication 1.

(43-1)-4

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.1.1 (Note 1) and 3.1.2(1)
Classification of the Case	43-1: Whether or not workshop modifications are taken into consideration when applying the sub cited invention to the main cited invention
Keyword	

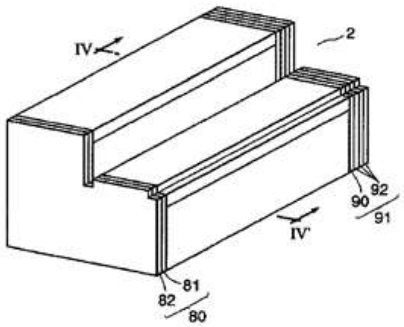
1. Bibliographic Items

Case	"Gallium-nitride-based light emitting element" (trial for invalidation) Intellectual Property High Court Decision, Nov. 26, 2014 (2014 (Gyo KE) No. 10079)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-202726 (JP 2002-100830A)
Classification	H01S 5/028
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding judge: Setsu SHIMIZU, Judge; Yasushi NAKAMURA, Judge: Yuki NAKATAKE

2. Overview of the Case

(1) Summary of Claimed Invention

[Fig. 3]



The claimed invention is of a gallium-nitride-based light emitting element the time of high-power operation be suppressed to improve an operating life, and, in addition, that is of high slope efficiency and high reliability. On a mirror surface in the light emission side, one or more low reflecting coating layers having refractive indexes lower than that of gallium nitride are laminated in a manner that the refractive indexes become lower in turn starting from the light-emission-side mirror surface, and the first low reflecting coating immediately above the light-emission-side mirror surface is formed of one kind of a material selected from a group consisting of ZrO2, MgO, Al2O3, Si3N4, AlN, and MgF2. In addition, on the light-reflection-side mirror surface, a passivation film made up of one kind selected from a group consisting of ZrO2, MgO, Si3N4, AlN, and MgF2 is formed, and, a high reflecting coating made by laminating on the passivation film low refractive index layers and high refractive index layers alternately is formed.

(2) State of the art

(i) A1 (cited invention 1): JP 2000-049410A (finding of the trial decision)

"A nitride semiconductor laser device including: a nitride semiconductor laser diode; and a protecting layer disposed on a laser end face of the nitride semiconductor laser diode,

wherein the protecting layer includes

$Al_{1-x-y-z}Ga_xIn_yB_zN$ ($0 \leq x, y, z \leq 1$, and $0 \leq x+ y + z \leq 1$) that is transparent relative to light oscillated by the nitride semiconductor laser diode,

wherein the nitride semiconductor laser diode includes:

a multiquantum well active layer made of

$In_uGa_{1-u}N/In_vGa_{1-v}N$ ($0 \leq u, v \leq 1$); and further

a reflecting layer, being in contact with the protecting layer and configured to reflect light oscillated by the nitride semiconductor laser diode,

wherein the reflecting layer has a lamination structure made by laminating a first layer and a second layer having different refractive indexes from each other alternately, and

wherein the first layer and the second layer respectively includes SiO2 and TiO2, or two kinds of $Al_{1-x-y-z}Ga_xIn_yB_zN$ ($0 \leq x, y, z \leq 1$, and $0 \leq x + y + z \leq 1$) that are transparent relative to light oscillated by the nitride semiconductor laser diode and have different refractive indexes from each other,

the nitride semiconductor laser diode including

a multiquantum well active layer made of undoped In0.02Ga0.98N/In0.15Ga0.85N,

wherein a protecting layer is formed on a front face and a rear face of the multiquantum well active layer; and

wherein a reflecting layer made by laminating an SiO2 layer and a TiO2 layer alternately into five pairs is formed on the protecting layer disposed on the rear face." (extracted from the decision)

(ii) A2 (cited invention 2): JP H3-142892 (finding of the trial decision)

"A semiconductor laser element in which, at least one resonator end face of a pair of opposing resonator end faces includes: a heat dissipation dielectric film formed on the resonator end face; and a passivation film formed on the heat dissipation dielectric film,

wherein the heat dissipation dielectric film has a thermal conductivity higher than a thermal conductivity of the passivation film, and

wherein the passivation film has a water-resistant property higher than a water-resistant property of the heat dissipation dielectric film (refer to claim 1), and

wherein the heat dissipation dielectric film is an AlN film (refer to claim 2)."

(3) The Claims (the present invention 1)

[Claim 1] A gallium-nitride-based light emitting element comprising a resonator structure comprising a light-emission-side mirror surface and a light-reflection-side mirror surface on respective end faces of a stripe-shaped emission layer,

wherein, on the light-emission-side mirror surface, two or more low reflecting coatings having a refractive

index lower than a refractive index of gallium nitride are laminated such that refractive indexes become lower in turn from the light-emission-side mirror surface, and a first low reflecting coating in contact with the light-emission-side mirror surface comprises one kind selected from the group consisting of ZrO_2, MgO, Al2O3, Si3N4, AlN and MgF2, and

wherein, on the light-reflection-side mirror surface, a passivation film of a single layer comprising one kind selected from a group consisting of ZrO2, MgO, Si3N4, AlN, and MgF2 is formed, and, in contact with the passivation film, a high reflecting coating made by laminating low refractive index layers and high refractive index layers alternately in a manner starting from a low refractive index layer and making a h g igh refractive index layer be final is formed.

(4) Procedural History

Nov. 2, 2007	:	Registration of establishment of patent right (refer to "The Claims" mentioned above)
Mar. 30, 2012	:	Demand for a trial for patent invalidation by the plaintiff (Invalidation 2012-800038)
Nov. 14, 2012	:	Trial decision that said "the demand for trial in question will not stand." (the first trial decision)
Sep. 19, 2013	:	Decision to the effect that the first trial decision is rescinded (2012 (Gyo KE) No. 10435: the first Decision)
Feb. 20, 2014	:	Trial decision that said "the demand for trial in question will not stand." (the second trial decision)

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

<table>
<tr><td colspan="2">Trial decision</td></tr>
<tr><td colspan="2">"While an AlN protecting layer has good thermal conductivity, it requires a passivation film to prevent degradation and transformation due to reaction with moisture in an air atmosphere. However, the material of a protecting layer expressed by the above-mentioned general expression is not limited to AlN, and thus, in the cited invention, a motive to select AlN that requires an additional component of a passivation film is not found. ... In the cited invention, even if AlN is selected as the material of a film adjoining the light-emission-side mirror surface and it is supposed that a passivation film is provided on the film, it cannot necessarily lead to laminating, on the film (AlN layer), a film having a refractive index lower than the refractive index of the film (AlN layer) adjoining the light-emission-side mirror surface.
Therefore, it cannot be said that a person skilled in the art would be able to easily arrive at adopting, in the cited invention, the constitution of the invention 1 concerning the difference 2." (extracted from the decision)</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The material of a protecting layer in the cited invention is selected from a viewpoint that its lattice</td><td>Allegations by Defendant
In A1, only an invention related to a protecting layer of a general expression is stated. Therefore, in</td></tr>
</table>

constant and thermal expansion coefficient are consistent with those of a nitride semiconductor laser diode compared with a conventional protecting layer, while the AlN protecting layer of A2 is selected for a reason of good thermal conductivity. From such a viewpoint, the trial decision determined that it cannot be said immediately that an AlN protecting layer is selected in the cited invention. However, even if AlN is selected in the cited invention because it is superior in thermal expansion coefficient and lattice matching property compared with the related art, whereas it is selected due to a good thermal conductivity in A2, it is not inhibited to combine the technology of A2 with the cited invention. Furthermore, in the cited invention (A1), there is no description that a material having good thermal conductivity is unsuitable as a material of a protecting layer. Being superior in thermal expansion coefficient and lattice matching property and having good thermal conductivity are properties that are compatible as a material for a protecting layer. Accordingly, there is no obstacle to select AlN as a material of a protecting layer of the cited invention and combine it with the technology of A2.	order to be able to say that adopting a protecting layer of AlN that is a specific composition instead of a protecting layer of such general expression (or, within the such general expression) is easily arrived at, a positive reason and motive to lead to that is absolutely essential. This is obvious also from a fact that the above-mentioned general expression is "$Al_{1-x-y-z}Ga_xIn_yB_zN$ ($0 \leq x, y, z \leq 1$, and $0 \leq x+ y + z \leq 1$) including AlN" and this includes exactly unlimited combinations. However, ...because there is no statement or suggestion about such reason and motive at all in A1 and also in the other citations, it cannot be said that the differences 2 and 3 are easily envisioned. ...
Judgment by the Court ... When, after arriving at selecting AlN from the options of the general expression of A1, AlN is used as a passivation film, focusing attention on a problem that it reacts with moisture in an air atmosphere and is degraded and transformed, and, further employing a passivation film including Al2O3 as a configuration to solve that problem corresponds to a case of so-called "easiness of easiness", that is, a case where, based on an idea that could easily be arrived at from the cited invention, further applying the technology stated in A2 is easy. As a consequence, a special effort is required to arrive at a configuration concerning the difference 2 and 3 based on the cited invention, and, thus, it cannot be said that it is easy for a person skilled in the art (in addition, although it is unclear from the statement of A1 that there is the above-mentioned problem when AlN is used as a passivation film, if it is, as some posit, understood that such problem is a self-explaining problem, selecting AlN daringly from the general expression of A1 regardless of such problem leads to non-easiness in itself.).	

C Meanwhile, in an allegation of the plaintiff in the trial stage, there is a statement that is presumed to have made an allegation to the effect that, by combining the inventions of A2 and A1, it is easy to select AlN of A2 as a passivation film (the middle column of page 5 of the trial decision). Therefore, consideration will be also made about a point that the configuration concerning the differences 2 and 3 is reached by combining A2 with the cited invention and selecting AlN, and, at the same time, selecting Al_2O_3 that is a working example of A2 as a passivation film.

(A) A1 relates to a nitride semiconductor laser device, and its technological problem to be solved is to provide a nitride semiconductor laser device that prevents deterioration of a laser diode in both end faces, and that has a longer life and higher reliability than those of conventional ones. On the other hand, although the invention A2 is an invention that relates to a semiconductor laser element, a quality of material of a semiconductor material that is a premise is an AlGaAs system, an InGaAlP system, or an InGaAsP system (lines 17-20 in the left upper column of page 5).

Then, in A1, there is stated a problem solving principle that, by making a protecting layer be "a layer including $Al_{1-x-y-z}Ga_xIn_yB_zN$ ($0 \leq x, y, z \leq 1$, and $0 \leq x+ y + z \leq 1$) including AlN, " lattice matching between the protecting layer and the nitride semiconductor laser diode is realized, and the thermal expansion coefficients of the two become consistent with each other. However, whatever numeral is substituted for this general expresssion, "N" is inevitably included in the composition. Therefore, considering that "N" is included in an active layer of a "nitride semiconductor laser device" at all times, it can be presumed that lattice matching as to crystals of the nitride system is taken into consideration. As a consequence, it is hard to say that adopting, in the cited invention pertinent to a nitride system laser device, a protecting layer according to A2 that is used for an end face of a semiconductor device not including "N" in its active layer is arrived at easily.

Accordingly, it cannot be found that there is motivation to immediately apply a passivation film of A2 as a protecting layer in A1.

(Reference)

Intellectual Property High Court Decision, May 12, 2010 (2009 (Gyo KE) No. 10256). Also refer to: Hanrei Jiho vol. 2095 page 108; and Hanrei Times Vol. 1359, page 220).

(45)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

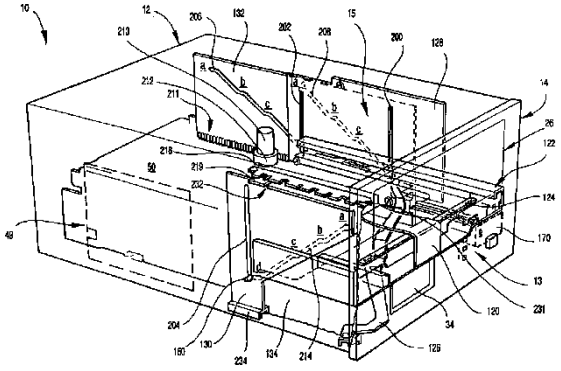
1. Bibliographic Items

Case	"Autochanger" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, April 28, 2005 (H17 (Gyo-KE) 10059)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H5-114557 (JP H6-20363A)
Classification	G11B 15/68
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division: Presiding Judge Tetsuhiro NAKANO, Judge Gaku OKAMOTO, and Judge Takuya UEDA

2. Overview of the Case

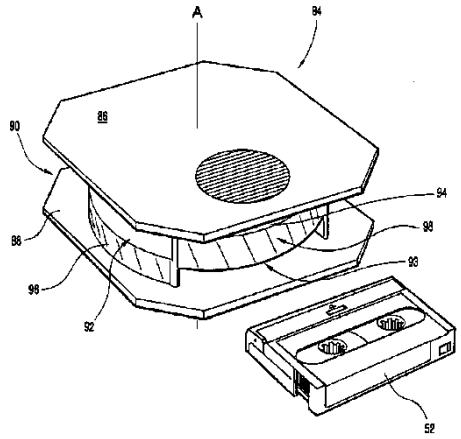
(1) Summary of Claimed Invention

[FIG. 2]

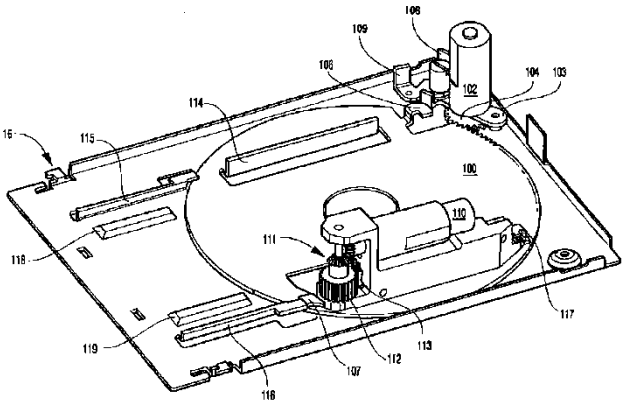


The claimed invention provides an autochanger which is able to be compact whilst permitting easy access to stored recording media items without the need for complicated mechanical assemblies for moving the recording media items within the autochanger. An autochanger 10 for DAT cartridges 52 includes a 5 1/4 inch form factor housing 12 within which are arranged a tape drive mechanism 50, a magazine 84 for holding six DAT cartridges and a transfer mechanism 13 for transporting the DAT cartridges between a storage area 15 and the tape drive mechanism 50. A turntable 100 is provided at a lower side of an upper panel of the housing 12 to rotate the magazine 84 about 180 degrees so that all DAT cartridges 52 in the magazine 84 are accessible from a single direction.

[FIG. 7]



[FIG. 8]

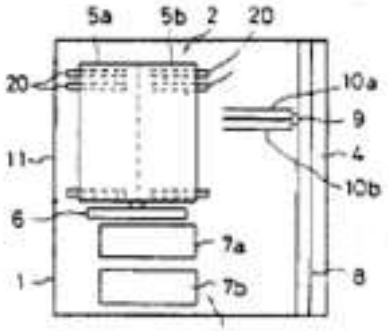


(2) State of the Art

(i) Citation (Exhibit A14): JP H2-9058A

A plurality of housing parts 5a and 5b are rotated in a horizontal plane by rotation drive means 6, and one of those is selected and made opposed to transportation means 4. Therefore, in spite of increase in the number of the housing parts 5a and 5b, an installation space is not drastically increased.

[FIG. 2]



(ii) Well-Known Art (Well-Known Documents of Exhibit A15, Exhibit A16, and Exhibit A17) (Finding of Appeal/Trial Decision)

"...A magazine ...supporting a plurality of recording media items and configured to be housed in the storage area together with the plurality of supported recording media items is made insertable into and removable from an auto-changer. Thereby, the auto-changer can be compactified, and an operation can be simplified..."

(Summary from the judgment)

(3) The Claims (Amended) (Claimed Invention)

[Claim 1] Apparatus (10) for storing plural items of recording media (52) and for transferring the plural media items (52) to and from a mechanism (50) for reading and/or writing to the media items (52), said apparatus comprising: a storage area (15) for storing a plurality of the media items (52) so that there are a plurality of said media items (52) simultaneously spaced around a common axis of rotation (A, B) for said media items and there are a plurality of said media items (52) simultaneously spaced along said axis (A, B), said mechanism (50) being fixedly located adjacent to said storage area (15), said axis (A, B) passing through said mechanism (50); a magazine (70, 84) holding a plurality of said media items (52), and configured so as to be insertable into and removable from the storage area

(15) together with said media items (52), and that can be accessible from at least two sides; means for rotating said magazine (70, 84) so as to permit access to any of the media items (52) stored in the storage area (15) via at least two sides of said magazine (70, 84) from only one direction transverse to said axis (A, B), and thereby rotating the stored media items (52) as one body about said axis (A, B) and; transfer means (13) operable to collect said media items (52) from said one direction and to transfer said media items (52) between the storage area (15) and said mechanism (50).

(4) Procedural History

May 17, 1993	:	Patent Application (the Date of Claim of Priority: May 15, 1992, Great Britain)
August 21, 2001	:	Decision of Refusal
December 3, 2001	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2001-021500)
December 27, 2001	:	Amendment (Refer to the above "The Claims")
September 25, 2003	:	Appeal/Trial Decision of "The request for this case trial and appeal is not established."

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

Appeal Decision (cited from the Court Decision)
...Because the claimed invention is considered to be easily invented for a person skilled in the art by taking account of an art that had been well-known at the filing of this case to an art described in ...the cited publication ...distributed prior to the filing, the claimed invention cannot receive a patent according to Article 29(2) of Patent Act ... ... The appeal/trial decision finds a difference ...between the claimed invention and the invention disclosed in the cited publication (hereinafter, referred to as a cited invention" ...) as follows. (Difference) "In the claimed invention, for the purpose of exchanging a cassette, "a magazine is configured so as to be insertable into and removable from the storage area together with the held media items". On the other hand, in the cited invention, it is described that the magazine is housed in the storage area together with the held media items. However, in a working example, the magazine is fixed and arranged in the storage area rotatably but unremovably, and a cassette can be thrown and exchanged from the exterior to the magazine by opening an opening and closing lid 11 provided at an opposite side to the transfer means." ... Since all of the claimed invention, the cited invention, and the well-known commonly-used arts belong to a common technical field of an autochanger for recording media, it is considered that a person skilled in the art can easily conceive to replace the fixed and arranged magazine in the cited invention with one insertable into and removable from the storage area by applying these well-known commonly-used arts to the cited invention. Thus, it is not recognized that this difference is particular.
Decision

<table>
<tr><td>Allegations by Plaintiff

The insertable and removable magazine described in Exhibit A15 has a rotary table to itself, and the magazine described in Exhibit A16 and Exhibit A17 has a turntable to itself, and those magazines themselves do not rotate. That is, the magazines do not rotate as a whole. On the contrary, the magazine of the claimed invention is configured so that the magazine itself is made rotate, that is, so that the magazine is made rotate as a whole. Accordingly, configurations of both magazines are clearly different from each other. In configurations of this case respective well-known documents, because an insertion/removal operation of the movable turntable is performed as well as a case part of the magazine, in response to the operation, a special mechanism for locking/releasing such the movable part to the apparatus with certainty is required. On the other hand, the claimed invention without movable part in the magazine itself, does not require such the mechanism. In addition, the claimed invention can further simplify the configuration of the magazine. Further, because the locking/releasing mechanism with the inserted/removed movable body, such as a turntable, is not required on the apparatus main body side, the claimed invention is excellent in terms of stability and certainty in operations of the apparatus main body.</td><td>Allegations by Defendant

The well-known art that the appeal/trial decision found together with a list of this case respective well-known documents, points a technical idea of exchanging in unit of magazine holding the plurality of recording media by configuring the magazine holding the plurality of recording media items so as to be insertable into and removal from the autochanger, and does not include a point of view about whether or not the magazine itself rotates in the finding of the well-known art. With respect to the configuration that the magazine is rotated as a whole, the appeal/trial decision founds this as an identical features between the claimed invention and the cited invention, and the plaintiff does not argue this point.

In addition, for not having the movable bodies like a turntable to the magazine itself, these are only individual specific components described in this case respective well-known documents, and the appeal/trial decision does not find the well-known commonly-used art including the components. In addition, although the plaintiff insists that the claimed invention is excellent in terms of stability and certainty by not requiring a locking and releasing function with the movable body to the apparatus main body, the universal operation/working-effect cannot be grasped from the configuration part of "the magazine is configured so as to be insertable into and removable from the storage area together with the held media items (52)".</td></tr>
<tr><td colspan="2">Judgment by the Court

The point of view of "the configuration of the magazine can be further simplified, and because the engaging/releasing mechanism with the inserted/removed movable body, such as a turntable, is not required on the apparatus main body side, the claimed invention is excellent in terms of stability and certainty in operations of the apparatus main body." that is alleged by the plaintiff as an effect obtained from configuring the magazine so as to be rotated as a whole, is no more than one ordinarily assumed from its configuration, and is not considered particular. In the claimed invention, as alleged by the plaintiff,, the main body of the apparatus</td></tr>
</table>

does not require the engaging and releasing function with "a movable body" of the magazine because the magazine has no movable part such as a turntable. However, on the other hand, on the main body of the apparatus, the turntable (100) for rotating the magazine to enable the transfer means (13) to collect the recording media is required, and the mechanism for moving the magazine to a predetermined position on the turntable becomes complicated (see the paragraph [0035] of descriptions [Exhibit A2] at the filing of this case). Based on the above statements, in the claimed invention, the configuration of the magazine is simplified, but on the contrary, the configuration of the main body of the appratus becomes complicated, and therefore it cannot always be considered that the claimed invention is excellent in terms of stability and certainty of the main body of the appratus.

(45)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

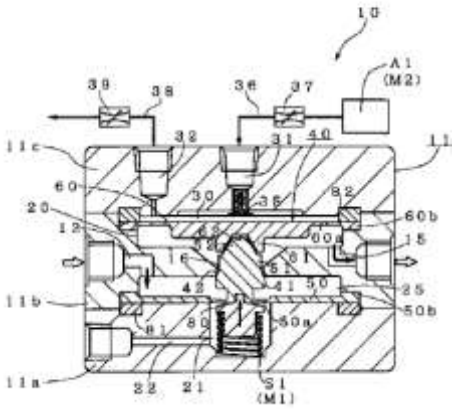
1. Bibliographic Items

Case	"Flow control valve" (Trial for Correction) Intellectual Property High Court Decision, May 31, 2005 (2005 (Gyo KE) No. 10294)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-370486 (JP 2000-193106A)
Classification	F16K 31/126
Conclusion	Dismissal
Related Provision	Article 29(2) and Article 126(4)
Judges	IP High Court Fourth Division, Presiding judge Tomokazu TSUKAHARA, Judge Masatoshi TANAKA, Judge Tatsufumi SATO

2. Overview of the Case

(1) Summary of Claimed Invention

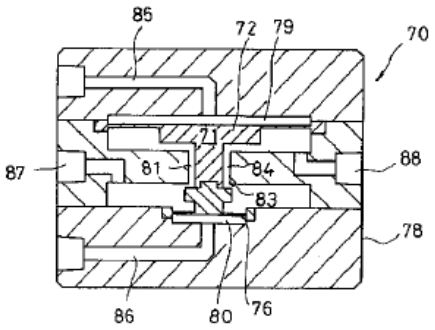
[FIG. 1]



The present invention prevents the deterioration and damage of the valve or the production of dusts in the valve even if an outlet of the valve shows a load increase. A valve 10 for controlling the flow rate of fluid comprises of a body 11 having a chamber 20, a valve plug 41 opening and closing a valve seat, a first diaphragm 50 arranged in the vicinity of an inlet, and a second diaphragm 60 arranged in the vicinity of the outlet. Each diaphragm is installed in the chamber 20, and divides the chamber into a first pressure chamber 21, a valve chamber 25, and a second pressure chamber 30. A first pressurizing unit M1 and second pressurizing unit M2 is respectively configured to always apply constant pressure to the valve chamber through each of the first diaphragms 50 and second diaphragms 60. The first diaphragm 50 is integrated with a first member 51 having the valve plug 41, and the second diaphragm 60 is integrated with a second member 61 removably engaged with the first member 51.

(2) State of the art (Decision of the Trial Decision)

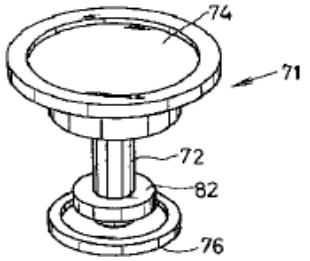
[FIG. 4]



(i) Citation 1 (Cited invention 1): JP H6-295209A

"1. A valve 70 for controlling the flow rate of fluid, comprising a valve body 78 and a valve element 71, the valve body defining a chamber that involves an inlet 87 for receiving fluid to be controlled on one side, a wall surface inside valve chamber for passing the fluid that faces a flow rate controller 82, and an outlet 88 for discharging the fluid on the other side, the valve element consisting of the flow rate controller 82 closely separated to the wall surface inside valve chamber, a second diaphragm 76 arranged in the vicinity of the inlet 87, and a first diaphragm 74 arranged in the vicinity of the outlet 60,

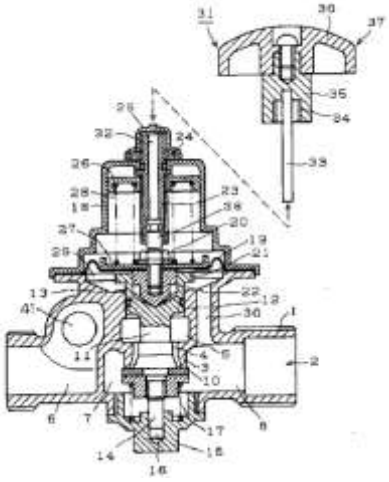
[FIG. 5]



each diaphragm is installed in the chamber with an outer periphery fixed to the valve body 78, and divides the chamber into a pressure chamber 80 outside the second diaphragm 76, a valve chamber 81 enclosed by the second diaphragm 76 and the first diaphragm 74, and a pressure chamber 79 outside the first diaphragm 74, the valve chamber includes the inlet 87, a wall surface inside valve chamber facing the flow rate controller 82, and an outlet 88, the pressure chamber 80 and pressure chamber 79 are provided with first pressurizing gas and second pressurizing gas, respectively, to always apply constant pressure to the valve chamber 81 through the second diaphragm 76 and first diaphragm 74,

the second diaphragm 76 of the valve element 71 is integrated with a lower half of a rod 72 having the flow rate controller 82 and the first diaphragm 74 is integrated with a upper half of the rod 72 screwed with the lower half of the rod 72." (Cited from the Court Decision)

[FIG. 1]



(ii) Citation 2 (Cited invention 2): JP H7-19370A

"1. A fluid control valve, comprising a valve body 1, a valve element stem 11, a diaphragm 19 in which a diaphragm stem 21 is fixed, and a piston 13 into which the diaphragm stem 21 is intruded, the valve body 1 involves a primary path 6 being an inlet for receiving fluid to be controlled on one side, a valve seat 3 for passing the fluid, and a secondary path 8 being an outlet for discharging the fluid on the other side, the valve element stem 11 fixes a valve element 10 for opening and closing the valve seat 3 and extends upward and penetrates through a valve seat hole 4, the diaphragm 19 is arranged in the secondary path 8, and the piston 13 is engaged with a upside of the valve element stem 11, wherein the fluid control valve is configured to prevent for applying excessive force to between the valve element 10 and valve seat 3 by the separation of the valve element stem 11 and diaphragm stem 21." (Cited from the Court Decision)

(3) The Claims (Corrected) (Claim 1 only)

[Claim 1] A valve (10) for controlling the flow rate of fluid, comprising a body (11) and a valve mechanism (40), the body defining a chamber (20) that involves an inlet (12) for receiving fluid to be controlled on one side, a valve seat (16) for passing the fluid, and an outlet (15) for discharging the fluid on the other side, ... wherein the first diaphragm (50) of the valve mechanism (40) is integrated with a first member (51) having the valve plug (41) and the second diaphragm (60) is integrated with a second member (61) removably engaged with the first member, and wherein the valve is configured to prevent the production of dust particles between the valve plug and the valve seat by the separation of the first member and the second member.

(4) Procedural History

September 2, 2003 : Filing of Request for Trial for Correction (Teisei No. 2003-39185) (see the above "The Claims")

February 9, 2004 : Trial Decision to “Dismiss the trial”

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

Appeal Decision (Cited from the Court Decision)
(4) Comparison of the present corrected invention with the cited invention 1 (B) Difference 2 "In the corrected invention, the second member integrated with the second diaphragm is removably engaged with the first member having the valve plug, and the production of dust particles may be prevented between the valve plug and the valve seat by the separation of the first member and the second member. On the other hand, in the cited invention 1, the upper half of the rod 72 integrated with the first diaphragm 74 is not removably engaged with the lower half having the flow rate controller 82, thus the production of dust particles may not be prevented between the valve plug (flow rate controller 82) and the valve seat (wall surface inside valve chamber facing the flow rate controller 82)" B With regard to the difference 2 "It would also be well-known for a person skilled in the art that the control valve such as the valve for controlling the flow rate of fluid ... in a clean environment such as semiconductor manufacturing equipment, ... the valve used in such environment is likely to produce particles between the valve plug and the valve seat by applying excessive force to therein .... Thus, it should be said that preventing the production of dust (particles) between the valve plug and the valve seat by not applying excessive force to therein when applying the control valve in the clean environment such as semiconductor manufacturing equipment could be well-known technical problem for a person skilled in the art. The citation 2, like the valve for controlling the flow rate of fluid disclosed in the citation 1, discloses the invention of the control valve, in which the valve element is contacted with the valve seat by the diaphragm arranged in the secondary, for opening and closing the valve port. In the control valve, the diaphragm stem

integrated with the diaphragm is removably engaged with the valve element stem having the valve element in order to prevent for not applying excessive force to between the valve element and the valve seat. Then it would have been obvious for a person skilled in the art to removably engage the upper half of the rod 72 integrated with the first diaphragm 74 (the second member integrated with the second diaphragm) with the lower half having the flow rate controller 82 (the first member having the valve plug), to prevent excessive force to be applied therein by applying the cited invention 2 to the cited invention 1"

C With regard to the working effects

"Since the working effects obtained by the corrected invention would be only predictable from the suggested mattes in the inventions of citations 1 and 2, the corrected invention would have been obvious for a person skilled in the art by applying the cited invention 2 to the cited invention 1."

Decision

Allegations by Plaintiff

2 ...(Overlook of unpredictable remarkable effects)

Even if it would be obvious to combine the cited inventions 1 and 2, the corrected invention could obtain the unconceivable remarkable effects.

The corrected invention could obtain each of the effects (1)..., (2)..., and (3)... concurrently and synergistically. Thereby, the corrected invention ..., as shown in the test report and it's magnified photograph, ... could have groundbreaking, considerable and remarkable effects, ... could be highly evaluated. On the other hand, the cited invention 1 could not prevent the production of dust particles between the valve element and valve seat, and the cited invention 2 could allow that dust caused from the sliding part of guide bar and closing valve spring is contaminated in fluid. Thus, it is wholly different between the technical thoughts of the corrected invention and the cited inventions 1 and 2. The effects obtained by the corrected invention would be unpredictable from the suggested matters in the citations 1 and 2.

Allegations by Defendant

2 ...(Overlook of unpredictable remarkable effects)

The plaintiff alleges that the remarkable effects obtained by the corrected invention would be unpredictable from the technical matters suggested in the citations 1 and 2.

However, as stated above, it would be apparent that the production of dust may be prevented between the valve element and valve seat by not applying excessive force between the valve element and valve seat when applying the fluid control valve of the cited invention 2 in the clean environment such as semiconductor manufacturing equipment. Thus, a person skilled in the art could easily predict that the whole valve chamber obtains the effects for preventing the production of dust by applying the cited invention 2 to the cited invention 1.

...The trial decision is not erroneous in determining that "the effects obtained by the corrected invention would be only predictable from the suggested matters in the citations 1 and 2".

Judgment by the Court

2 With regard to (overlook of unpredictable remarkable effects)

The plaintiff alleges that the corrected invention could obtain each of the following three effects

concurrently and synergistically, and these effects would be unpredictable, considerable and remarkable: (1) a fluid passing through the valve chamber does not contact with the pressurizing unit, and the production of dust caused by the contact may be prevented; (2) the valve chamber has no diaphragm inside, and the production of dust caused by sliding the valve stem may be prevented; and (3) the production of dust particles may be prevented between the valve plug and the valve seat.

However, the aforementioned effects (1) and (2) would be obtained by the configuration provided in the cited invention 1, and the aforementioned effect (3) would be obtained by applying the cited invention 2 to the cited invention 1. Thus, it should be said that a person skilled in the art could easily predict that the whole valve chamber obtains the effects for preventing the production of dust by applying the cited invention 2 to the cited invention 1, and it could not recognize that the effects are unpredictable, considerable and remarkable in light of the evidence presented by the plaintiff. Therefore, the trial decision is not erroneous in determining that "the effects obtained by the corrected invention would be only predictable from the suggested matters in the inventions of the citations 1 and 2".

(45)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

Case	"Traffic means load weight self display device" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 30, 2007 (H18(Gyo-KE) 10222)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-320651 (JP H10-129338A)
Classification	B60P 5/00
Conclusion	Dismissal
Related Provision	Article 29(2), (Former) Article 17bis(5), Article 126(4), and Article 53(1)
Judges	IP High Court Fourth Division: Presiding Judge Tomokatsu TSUKAHARA, Judge Naoki ISHIHARA, and Judge Teruhisa TAKANO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention, for the purpose of preventing traffic accidents and damages to roads caused by excessive weight of loads, measures a weight of cargos loaded on traffic means and informs an external third party by means of various informing systems, and thereby, makes a driver psychologically refrain from illegal excessive loading, or facilitates the crackdown by the police to reduce illegal overloading.

(2) State of the Art

(i) Citation: CD-ROM of JP H7-5918U (Finding of Appeal/Trial Decision)

"... The citation discloses an invention (the cited invention) of "a system and the like measuring a weight of cargos loaded on a vehicle, such as a truck, and provided with a display unit at a proper place on the vehicle, such as on a lateral face of a loading platform of a vehicle rear part, for the purpose of displaying the measurement result to an external third party". (Summary from the judgment)

(ii) Well-known Art (Finding of Appeal/Trial Decision)

"A display system projecting an image and the like is conventionally well-known art". (Summary from the judgment)

(3) The Claims (Amended) (Only Claim 2 is Described) (This Case Amended Invention)

[Claim 2] A system and the like of measuring a weight of cargos loaded on traffic means, self-displaying the measured weight to an external third party, and projecting the measured weight on an outer wall and the like of the traffic means to the external third party,

or a system of displaying or projecting the measured weight from the inside of a window glass,

or a system of mounting a display device at an upper part of a ceiling,

or a system, or wired, wireless, sound wave, magnetic, or optical communication that only policemen or the like and people who are involved can extract contents of the load weight if there are privacy issues,

or a display system that only policemen or the like and people who are involved have a command.

(Among the inventions alternatively included in this case amended invention, an invention of "a system and the like of measuring a weight of cargos loaded on the traffic means, self-displaying the measured weight to an external third party, projecting the measured weight on an outer wall and the like of the traffic means to the external third party" is hereinafter referred to as "this case amended invention 1", similar to the appeal/trial decision.)

(4) Procedural History

June 24, 2003 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2003-14495), Amendment (refer to the above "The Claims)

March 22, 2006 : Appeal/Trial Decision of "The request for this case trial and appeal is not established."

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

Appeal Decision (cited from the Court Decision)	
... A difference ... between this case amended invention 1 and the cited invention ... is as follows. <Difference> While "a system and the like of displaying" on the outer wall and the like of the traffic means is "a system and the like of projecting" in this case amended invention 1. On the other hand, it is "a system provided with a display unit" in the cited invention. (2) Accordingly, in consideration about the above difference, an display system projecting an image and the like is a conventionally well-known art, ... and whether a system using an analog type display unit is employed, or the well-known system of projecting and displaying an image is employed, is merely a matter that can be arbitrarily selected as necessity of a person skilled in the art. In addition, it is not considered that the operation/working-effect taken by this case amended invention 1 is more than that predicted from the cited invention and the well-known art.	
Decision	
Allegations by Plaintiff ... "Applications of examination and trial and appeal in Patent Act modified in 1994, etc." of	Allegations by Defendant In ... this case amended description ..., there is no descriptions that mentions remarkable

Japanese Patent Office (... hereinafter referred to as "applications of examination and trial and appeal") ... ..."The applications of examination and trial and appeal" says "in a case where the invention related to the claims has effects that are advantageous and qualitatively different from that of the cited invention, or in a case where the invention related to the claims has qualitatively the same advantageous but prominent effects, and these are not predicted from a state of the art by a person skilled in the art, the presence of inventive step is presumed by this fact." (Page 66, Lines 16-20) Thus, increasing easily a display size only by changing a magnification of projection is peculiar to the display system by projection, and is qualitatively different effect from the effects of the cited invention, and predictability of a person skilled in the art is not a problem.	operation/working-effects taken by the display system by projection in comparison with the other display system. Accordingly ... allegations by the plaintiff has not grounds in the descriptions, and improper.

Judgment by the Court

...It is obvious that a word of "the cited invention" of the above description in "Procedures for examination and trial and appeal" is not limited to the invention related to a so-called main citation, and is used while including the inventions related to a sub citation, in the context of the use of the word of "the cited invention" in the descriptions of "even in a case where it seems that a person skilled in the art can easily conceive, at a glance, by a combination of a plurality of cited inventions" described immediately before the above description. If so, the well-known art having the function similar to the function of the inventions of the sub citations should also be included in "the cited invention" of this description. In addition, it is found that the display system by projection as an image display system to the external third party in the vehicle was the well-known art at the time of filing the application, and also the well-known art has the similar function to the invention of the sub citation in this case. From those, even if the display system by projection has the specific feature that the display size can be easily increased only by changing the magnification of projection, it cannot be considered that such specific feature always bring the effect different from “the cited invention” of the above description in “Procedrues for examination and trial and appeal”. In addition, even if "the claimed invention" has a different effect from the cited invention, in a case where the different effect can be predicted from the state of the art by a person skilled in the art, the presence of inventive step is not always inferred just because the different effect is taken.

(45)-4

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

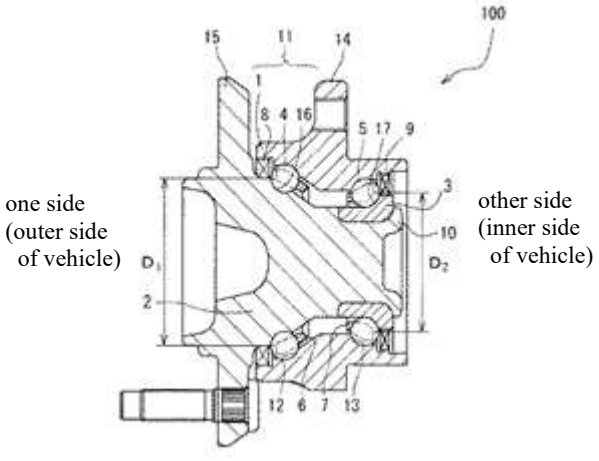
Case	"Rolling bearing device" (Trial for Invalidation) Intellectual Property High Court Decision, January 30, 2012 (2011 (Gyo KE) No. 10158)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2002-270208 (JP 2004-108449A)
Classification	F16C 19/18
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding judge Shuhei SHIOTSUKI, Judge Kenjiro FURUYA, Judge Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

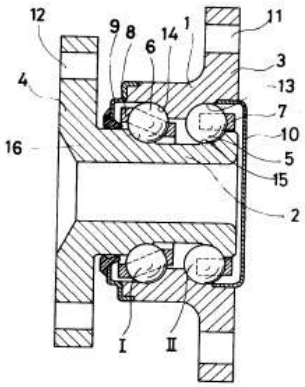
In the rolling bearing device 100 of the present invention, a pitch diameter D_1 of a group of rolling elements at one side in shaft direction is set to be larger than a pitch diameter D_2 at other side in the shaft direction by effectively utilizing a space 11 between a flange 15 of an inner ring member and thus a flange 14 of an outer ring member. Whereby, a distance between bearing load centers of the groups of rolling elements of each row can be increased. As a result, the rigidity can be improved and its lifetime can be elongated in the rolling bearing device without enlarging the device.

[FIG. 1]



(2) State of the art (Determination of the Trial Decision)

(i) Exhibit A1 (Invention of Exhibit A1): JP S57-6125A



[FIG. 1]

"A unit bearing with flange comprising: an integrated inner ring (2) having a flange (4) at an outer side of vehicle on an outer peripheral surface at one side in shaft direction and two lines of orbit grooves (16) and (15) in shaft direction on an outer peripheral surface at other side in the shaft direction;

an outer ring (1) having two lines of orbit grooves (14) and (13) in the shaft direction facing the two lines of orbit grooves (16) and (15) of the inner ring (2) respectively in diameter direction on the inner surface, and a flange (3) at inner side of vehicle on the outer peripheral surface at the other side in the shaft direction than the orbit groove (14); and

two lines of ball lines (6) and (5) consisting of multiple balls (6) and (5) interposed between the orbit grooves (14) and (13) of the outer ring (1) and the orbit grooves (16) and (15) of the inner ring (2),

a diameter of orbit (I) toward the flange (4) formed between the orbit groove (14) of the outer ring (1) and the orbit groove (16) of the inner ring (2) is increased in order to increase more the load capacity, whereby more of a number of balls (6) in line toward the flange of the inner ring may be incorporated." (Cited from the Court Decision)

(ii) State of the art of rolling bearing device (well-known matters)

[1] With regard to type of rolling bearing device

"It could understand that at the time when the present Application was filed, a person skilled in the art have selected and used either a hub unit integrated with the inner ring such as Invention of Exhibit A1 , and a hub unit with a separate inner ring engaging the inner ring of inner side of vehicle and integrating the inner ring of outer side of vehicle with the hub shaft such as the present invention 1, as appropriate, based on the requirement specification according to type of vehicle and the design perspective of enterprise." (Cited from the Court Decision)

[2] With regard to the problem of rolling bearing device

"It could understand that it is well-known matter to consider the lifetime, load capacity or rigidity (hereinafter the rigidity means "moment rigidity" unless the particular annotation is set) as the problem in the rolling bearing device, and a person skilled in the art have discussed whether to weigh the lifetime or load capacity, to weigh the rigidity, or to balance the both in designing the rolling bearing device based on the requirement specification according to type of vehicle and the design perspective of enterprise." (Cited from the Court Decision)

[3] With regard to factor to impact on moment rigidity of rolling bearing device

"It could understand that the moment rigidity of the rolling bearing device could be improved by increasing a distance between the bearing load centers, and the distance could be calculated geometrically and mechanically from a pitch diameter of rolling elements, a sphere center distance of the rolling elements, and a contact angle of the rolling elements and orbit surface ....

Both of the load capacity and moment rigidity are improved more or less in both the cases the diameter of the rolling elements is increased and the number of rolling elements is increased in the rolling bearing device. However, it could understand that since the diameter of the rolling elements covered by a circle length of fixed pitch circle and the number of the rolling elements are related to the transaction on the condition that the pitch diameter

is fixed for example when the pitch diameter cannot be changed in design, there is an inverse correlation between the load capacity and rigidity." (Cited from the Court Decision)

(3) The Claims (After correction) (Claim 1 only) (The present invention 1)

[Claim 1] A rolling bearing device comprising: an inner ring member consisting of a hub shaft that has a flange at an outer side of vehicle on an outer peripheral surface at one side in shaft direction and an inner ring rotatably engaged and integrated with an outer peripheral surface at other side in the shaft direction of the hub shaft, and having two lines of a first and second inner ring orbit planes in the shaft direction on the outer peripheral surface at the other side in the shaft direction of the hub shaft and on the outer peripheral surface of the inner ring;

an outer ring member having two lines of a first and second outer ring orbit planes in the shaft direction that face the two lines of a first and second inner ring orbit planes of the inner ring member on the inner peripheral surface in diameter direction respectively, and a flange at an inner side of vehicle on the outer peripheral surface at the other side in the shaft direction than the first outer ring orbit plane;

two lines of a first and second groups of rolling elements interposed between the first and second outer ring orbit planes of the outer ring member and the first and second inner ring orbit planes of the inner ring member,

a ration of a pitch diameter D_1 of the first group of rolling elements in the shaft direction of outer side of vehicle and a pitch diameter D_2 of the second group of rolling elements of inner side of vehicle are set between the flanges of the inner ring member and outer ring member, such that $D_1 > D_2$, the pitch diameter D_1 of the first group of rolling elements at outer side of vehicle is set to be larger by effectively utilizing a space between the flanges of an inner ring member and outer ring member,

the ration between the pitch diameter D_1 and D_2 is set such that $D_1 <= 1.49 * D_2$, and

a diameter of each rolling element of the first group of rolling elements is set to be smaller than a diameter of rolling element of the second group of rolling elements and the number of rolling elements of the first group of rolling elements is increased than the number of rolling elements of the second group of rolling elements in order to increase a distance between bearing load centers compared to the same diameters of the rolling element of the first group of rolling elements and second group of rolling elements.

(4) Procedural History

September 11, 2009	:	Filing of Request for Trial for Patent Invalidation by Defendant (Muko No. 2009-800198)
December 21, 2009	:	Filing of Request for Correction by Plaintiff (Patentee)
August 3, 2010	:	First Trial Decision to Accept the correction, and to "Invalid the patent"
September 10, 2010	:	Suit against the First Trial Decision by Plaintiff
November 9, 2011	:	Filing of Request for Trial for Correction by Plaintiff
November 26, 2011	:	Decision to Rescind the First Trial Decision
December 17, 2010	:	Filing of Request for Correction (The Present Correction) (see the above "The Claims") in the Present Invalidation Trial after remand (Correction Trial deemed to be withdrawn)

April 14, 2011 : Present Trial Decision to Accept the correction and "Invalid the patent"

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

Appeal Decision (Cited from the Court Decision)	
[Differences between the present invention 1 and Invention of Exhibit A1] · Difference 1 In the present invention 1, the inner ring member consists of the hub shaft and "the inner ring rotatably engaged and integrated with outer peripheral surface at the other side in shaft direction of the hub shaft", and has two lines of a first and second inner ring orbit planes in the shaft direction "on the outer peripheral surface" at other side in the shaft direction of the hub shaft and "on the outer peripheral surface of the inner ring". On the other hand, since the inner ring member integrates the hub shaft with the inner ring, "integrated inner ring (2) has two lines of orbit grooves (16) and (15) in the shaft direction on the outer peripheral surface at the other side in the shaft direction" in Exhibit A1. · Difference 2 In the present invention 1, "the pitch diameter D_1 of the first group of rolling elements of outer side of vehicle is set to be larger by effectively utilizing a space between the flanges of an inner ring member and outer ring member, the ration between the D_1 and D_2 are set such that $D_1 <= D_2$". On the other hand, D_1 and D_2 are set such that $D_1 > D_2$ to increase more the load capacity, but it is unclear how much D_1 is larger relative to D_2 in Exhibit A1. · Difference 3 In the present invention 1, "a diameter of each rolling element of the first group of rolling elements is set to be smaller than a diameter of rolling element of the second group of rolling elements in order to increase a distance between bearing load centers compared to the same diameters of rolling element of the first group of rolling elements and second group of rolling elements. On the other hand, ... the magnitude ratio is unclear between the diameters of two lines of ball (6) and (5), but these can be recognized to be the same from the common general technical knowledge and drawings in Exhibit A1. The basic functions and features obtained from the rolling bearing device would be predictable from the geometrically and mechanically review and test in which the type (constitution) of rolling bearing device, the diameter of rolling elements, pitch diameter of rolling elements, the number of rolling elements, the distance between bearing load centers and so on are set ... shown in the above well-known matters. However, the present invention 1 would not obtain the effects unpredictable for a person skilled in the art from the inventions disclosed in Exhibit A1 and well-known matters.	
Decision	
Allegations by Plaintiff 4 The present invention 1 could obtain the working effects that the improved rigidity by increasing the distance between bearing load centers,	Allegations by Defendant 4 The original description of the present application did not disclose the working effects that the shaft diameter of the hub shaft at the outer side of

the improved rigidity by increasing the number of the balls of the rolling elements at orbit, the improved rigidity by increasing the hub shaft at the outer side of vehicle, and the improved rigidity by decreasing amount of displacement around the lowest edge of the flange by increasing the PCD at the outer side of vehicle and decreasing the ball diameter of the rolling elements are collectively achieved, without enlarging the bearing device by adopting the constitutions according to the differences 1-3. Thus, a person skilled in the art would not have easily predicted such effects.	vehicle could be increased by increasing the PCD of orbit at the outer side of vehicle of the bearing device and by decreasing the ball diameter of the rolling elements and the rigidity of bearing device could be improved by decreasing amount of displacement at the lowest edge of the flange at the outer side of vehicle. Thus, the working effects alleged by plaintiff would be only obvious and not be unpredictable and considerable for a person skilled in the art. The working effects of the present invention 1 would have been only inevitably predictable for a person skilled in the art from the well-known art and basic technical matters pertaining to the rolling bearing device at the time when the Application was filed.

Judgment by the Court

4 The working effects of the present invention 1 are that "the rigidity could be improved and its lifetime could be elongated in the rolling bearing device without enlarging the device" by increasing the distance between bearing load centers (a person skilled in the art would easily predict such effects by applying the well-known art to ... Invention of Exhibit A1, and simulating the constitution of rolling bearing device assumed. Note that the effects would be only easily predictable for a person skilled in the art in that the improved rigidity by relatively increasing the PCD at one orbit and increasing the number of the balls of the rolling elements inserted, the improved rigidity of the bearing device by increasing the hub shaft at the outer side of vehicle, and the improved rigidity of the bearing device by decreasing amount of displacement around the lowest edge of the flange could be achieved from the constitution of the rolling bearing device assumed by applying the well-known art to Invention of Exhibit A1 and removing the differences. Thus, the working effects of the present invention 1 would be only easily-predictable for a person skilled in the art, and the determination of the trial decision stating those effects is not erroneous.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	Consideration of experimental results submitted after filing the patent application

1. Bibliographic Items

Case	"Method for inducing tumor-specific cytotoxicity" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 28, 2012 (2010 (Gyo KE) No. 10203)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2155, page 89
Application No.	Japanese Patent Application No. 2000-514993 (National Publication of International Patent Application No. 2001-519148)
Classification	C12N 15/09
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division Presiding judge: Shuhei SHIOTSUKI, Judge: Tomoko MANABE, Judge: Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is useful in cancer therapy, and relates to the specific expression of heterologous genes, particularly genes encoding cytotoxic products, in tumor cells.

(2) State of the Art (Finding of appeal decision)

(i) Citation 1: National Publication of International Patent Application No. H9-504955

"In the citation 1, an expression signal, that is a promoter, included in defective recombinant virus being a recombinant vector for gene therapy of cancer, is inactive in normal cells and shows activity in tumor cells." (cited from the Court Decision)

(ii) Citations 3 to 6

"It is evident from the statement of the citation 3 that before the priority date, it was publicly known that H19 gene is abundantly expressed in a number of different embryo tissues from the initial stage of embryo to the fetal period, the expression of H19 gene is suppressed after the birth, and H19 gene is expressed in various kinds of tumor including childhood and adult bladder cancer.

On the basis of this publicly known matter, a person skilled in the art usually understands that since H19

gene is not expressed in normal tissues and is expressed in various kinds of tumor including bladder cancer after the birth, a sequence, that is a promoter, regulating the expression of H19 gene functions so that H19 gene preferentially expresses in adult tumor cells similar to an α-fetoprotein promoter and the expression of H19 gene is suppressed in childhood and adult normal cells (non-diseased cells)

A promoter regulating the expression of H19 gene has already been known publicly with the statements of citations 4, 5 and 6." (cited from the Court Decision)

(3) The Claims (Amended) (Claimed Invention 1)

[Claim 1] A vector for expressing a sequence in a tumor cell, the vector comprising a polynucleotide comprising a H19 regulatory sequence operably linked to a heterologous sequence encoding a cytoxic gene product, wherein the tumor cell is a bladder cancer cell or bladder cancer.

(4) Procedural History

October 4, 1998	:	Patent application (date from which priority is claimed : October 3, 1997 in the United State)
January 18, 2006	:	Decision of refusal
April 24, 2006	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2006-7782)
January 14, 2010	:	Amendment (present amendment) (see the above-mentioned "The Claims")
February 9, 2010	:	Appeal decision that the request for appeal against the examiner's decision of refusal is not established

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

Appeal Decision (cited from the Court Decision)
A person skilled in the art could make the claimed invention 1 at the time of the priority date by combining matters stated in the cited invention 1 and citations 3 to 6, and the claimed invention 1 lacks inventive step. ·Difference (i) The claimed invention 1 prescribes that the regulatory sequence is a regulatory sequence of "H19", on the other hand, the cited invention 1 does not prescribe it. ·Difference (ii) The claimed invention 1 prescribes that the tumor cell is a bladder cancer cell or bladder cancer, on the other hand, the cited invention 1 does not specify it. ... (1) Difference (i) ...A person skilled in the art could have easily arrived that the promoter regulating the expression of H19 gene is used as an expression signal stated in the citation 1, that is a promoter, included in defective recombinant virus, which is inactive in normal cells and shows activity in tumor cells, on the basis of the citation 3. As it is evident from the statements of the citations 4 to 6, a person skilled in the art would have been able to easily use

the promoter of H19 gene.

... (2) Difference (ii)

Since the citation 3 states "bladder cancer" in a tumor list in table 1, a person skilled in the art would have been able to easily select bladder cancer cells or bladder cancer as the tumor cells.

Decision

Allegations by Plaintiff	Allegations by Defendant
...For a person skilled in the art, it was not easy to find a promoter capable of specifically expressing a heterologous sequence in tumor cells at high level among a number of promoters of publicly known gene which is preferentially expressed in tumor cells (cancer cells). ...The citation 1 states that a transgene is expressed in hepatic tumor cells using AFP promoter or IGF-IIP3 promoter. However, in practice, under control of a chimeric promoter EBNA1-RE/TP1, thymidine kinase gene (tk) of herpes simplex virus, β-galactosidase gene (βgal) of Escherichia coli and chloramphenicol acetyltransferase gene (CAT) are expressed using recombinant adenovirus in tumor cells infected with EBV (since EBV exhibits a characteristic antigen in infected cells, an induced promoter is used with this antigen as a clue.). Consequently, the citation 1 does not state and suggest that H19 gene is introduced and expressed in tumor cells; H19 promoter and H19 enhancer are used so as to cause the expression; and a vector is created using the regulatory sequence of H19 gene and is used for cancer therapy. Since bladder cancer is not developed by virus infection, it is difficult to apply the cited invention 1 in which adenovirus is infected to bladder cancer. ...The citations 3 to 6 do not state and suggest that H19 promoter and H19 enhancer have capacity to highly express a transgene in bladder tumor cells; and a vector is created using the regulatory sequence of H19 gene and is used for cancer therapy.	...A person skilled in the art considers whether a promoter with a desired character has necessary activity, or whether the promoter can be used or not. Even if a promoter does not have high activity capable of expressing a transgene by the time a promoter of certain gene is practically used for therapy, the use of the promoter is not hesitated in a case that the promoter is specifically expressed in tumor cells. Once mRNA transcriptase is bound to a promoter, thereby starting transcription of gene, it is common general knowledge for a person skilled in the art that the expression activity is exhibited regardless of whether the target is a homogenous gene or a heterologous gene. Since table 1 and the like in the citation 3 states that H19 gene is specifically expressed in tumor cells, it is evident that H19 promoter is functioned (exhibited sufficient expression activity), and it is not logically impossible for a person skilled in the art to consider use of the regulatory sequence. ...At the time of the priority date, silencing was not widely known in a person skilled in the art and a technique for expressing a transgene using a promoter has already been conventional means of a person skilled in the art. Even if there was potential that a desired result was not obtained by silencing in vivo, it was evident that a person skilled in the art tried to express a transgene using H19 promoter. ...Consequently, there is no error in the judgement, about inventive step of the component related to the difference (ii) by appeal decision, that a person skilled in the art could have easily selected bladder cancer cells

...The appeal decision ignores the statement related to examples that H19 promoter did not express a transgene and H19 enhancer was inactive, only cites an example that the regulatory sequence of H19 gene showed activity, and denies inventive step of the component related to the difference (i). Consequently, the judgement of the appeal decision is inaccurate. ...Purposes in the citations 4 to 6 are not therapy for bladder cancer and are completely different from the purpose of the claimed invention 1. Thus, there is no motivation in which the invention stated in the citations 3 to 6 is applied to the cited invention 1. Even if it is applied, a person skilled in the art could not have easily arrived the difference (ii). ...H19 enhancer has tissue-specific activity. At the time of the priority date, it was unclear that a vector in which the regulatory sequence of H19 gene is utilized has effect for therapy for bladder cancer. The inventor of the claimed invention 1 firstly found knowledge that a vector expressing a heterologous sequence (transgene) capable of damaging tumor cells by the regulatory sequence comprising H19 promoter and H19 enhancer, has effect for therapy for bladder cancer. The working-effect is particularly prominent which cannot be predicted by citations. ...Although the plaintiff submitted the reference at the state of appeal and explained the prominent effect of the claimed invention 1, the appeal decision did not take the explanation into consideration because these articles are published after filing the patent application. The appeal decision not taking the above-mentioned reference into consideration is inaccurate because the present specification states that the vector of the claimed invention 1 has effect. Therefore, according to references 1, 2, 4 and 10 (Exhibit A10, Exhibit A11, Exhibit A13 and Exhibit A19) at the appeal, the vector of the claimed invention	or bladder cancer as the tumor cells. (3) Section 9 being examples of the originally attached description (paragraph [0077] and [0078]) only states a general method of gene therapy using H19 regulatory sequence in a mouse model of bladder carcinoma, and does not state about a concrete method when it is practically administered to mice. About experimental results, section 9 only states that the bladder carcinoma in the experimental group of mice are reduced in size and necrosis is occurred as compared to the bladder carcinoma in the control group of mice, and does not completely state concrete result of measuring carcinoma and a condition of necrosis, thus the experimental result cannot be objectively ascertained. In section 9, "result and consideration" existed in other examples are not stated. Further, the experimental results of other examples are stated in the past tense, on the other hand, the experimental results in section 9 is stated in the present tense, thus it is questionable whether the experiment is practically performed. If the plaintiff practically performs the experiment, the result was easily stated in the originally attached description (see P. Ohana et al, “USE OF H19 REGULATORY SEQUENCES FOR TARGETED GENE THERAPY IN CANCER”, published in 2002, Int. J. Cancer Vol. 98, pages 645 to 650, Exhibit B6), and the statement (paragraph [0078]) of working-effect in the description is merely a desire. Any document submitted by the plaintiff as reference is published after filing the patent application. Indicating such statement of lack of materiality as disclosure of the working-effect of the invention causes significant imbalance between the applicant who files the patent application with only speculation about many potentials without ascertaining the working-effect by any experiment, and a third party who discloses sufficiently ascertained data as of the filing, since the

1 comprising H19 regulatory sequence operably linked to a diphtherial toxin (DT-A) has particularly prominent effect for therapy for bladder cancer and high safety without side effects.	applicant submits data in the name of reference and certificate of experimental results in which effect is ascertained after filing the patent application and obtains patent right. This is against principle of first-to-file system and against purpose of Patent System granting exclusive right as compensation of dedication.

Judgment by the Court

(2) ...Paragraph [0078] in the description states that the example in which gene therapy using H19 regulatory sequence is subjected to mice with a chemically induced bladder tumor, "the size, number, and necrosis of tumors are compared between the control and experimental groups, expression of Pseudomonas toxin is found to co-localize with expression of H19 in the bladder tumors from the experimental group of mice, additionally, the bladder tumors in the experimental group of mice are reduced in size and necrotic as compared to the bladder tumors in the control group of mice". (In addition, it is evident that the last sentence is correctly "size in bladder carcinoma is reduced and necrosis of bladder carcinoma is occurred.") Further, it is evident that in the experiment for bladder tumor using mice, size in bladder tumor is significantly reduced and necrosis of tumor cells is occurred.

In addition to hereinbefore, the following statement about the effect of a vector using the regulatory sequence of H19 gene is existed in pages 1 to 18 in "The Oncofetal H19 RNA in human cancer, from the bench to the patient" (Cancer Therapy, volume 3, published in 2005, reference 1 at the appeal, Exhibit A10), which is an article in which the inventors of the claimed invention 1 are entered as authors: (A) when administering a vector using a promoter inducing a gene (DT-A) which produces diphterial toxin to mice affected with bladder cancer (tumor), the average weight of tumor was reduced to 40% with respect to control mice; (B) when administering a vector (DTA-H19) using a promoter inducing DT-A to nude mice affected with human bladder cancer (tumor), control mice not administered increased the volume of tumor 2.5 times, on the other hand, in the administered mice, the increase rate of tumor is significantly reduced, and necrosis of tumor cells is occurred in a wide range; (C) when administering the above-mentioned vector DTA-H19 to rats affected with bladder cancer (tumor), the average value of size in carcinoma is reduced to 95% with respect to control rats; and (D) when transurethrally administering the above-mentioned vector DTA-H19 to two patients with intractable superficial bladder cancer (tumor), the volume of tumor is reduced to 75%, necrosis of tumor cells is occurred, and they did not recur transitional cell carcinoma (TCC) even after 14 months (17 months for one patient). Further, references submitted by the plaintiff, a document entitled "1.1 Compassionate Use Human Clinical Studies" (reference 2 at the appeal, Exhibit A11), and an article in which the inventors of the claimed invention 1 are entered as authors, "Plasmid-based gene therapy for human bladder cancer" (QIAGEN NEWS 2005, reference 4 at the appeal, Exhibit A13), have the statement related to the effect generally similar to the above-mentioned (D).

Although paragraph [0078] in the description does not state the working-effect with concretely numeric value included, it is evident the above-mentioned (A) and (B) are within the range of the statement of the

working-effect about the claimed invention 1, which is stated in the above-mentioned paragraph. Even if the experimental results of Exhibit A10 is taken into consideration as supplement of the experimental result in the description, it does not cause unfairness between the applicant and third party in relation to first-to-file system.

Therefore, the claimed invention 1 has particularly advantageous effect that a person skilled in the art cannot predict from the citations 1 and 3 to 6, ...at the time of the priority date, a person skilled in the art could not have easily made the claimed invention 1, and the claimed invention 1 does not lack inventive step.

It is questionable that a person skilled in the art could have easily made the claimed invention 1 by applying the inventions or technical matters stated in the citations 3 to 6 to the cited invention 1. The working-effect provided by the claimed invention 1 is particularly advantageous which cannot be predicted by a person skilled in the art, and the claimed invention 1 does not lack inventive step. Accordingly, the judgement of the appeal decision in which inventive step of the claimed invention 1 is denied is inaccurate.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

Case	"Shoe-press belt" (trial for invalidation) Intellectual Property High Court Decision, Nov. 13, 2012 (2012 (Gyo KE) No. 10004)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-343712 (JP 2002-146694A)
Classification	D21F 3/00
Conclusion	Admitted
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Toshihumi SHIBATA, Judge: Rika NISHI, Judge: Akira CHINO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is of a belt for papermaking that can prevent occurrence of a crack, the belt being formed by a reinforcement base material and thermosetting polyurethane in a unified manner, the reinforcement base material being buried in the polyurethane, and an outer periphery surface and an inner periphery surface of the belt being formed of the polyurethane, wherein the polyurethane forming the outer periphery surface is formed of a composition including: urethane prepolymer having an isocyanate group at an end; and a hardening agent containing dimethylthiotoluenediamine.

(2) State of the art

(i) Exhibit A1 (cited invention 1): JP H11-247086A (finding of the trial decision)

"A shoe-press belt, including: an endless first resin layer formed at a surface of a rotatable mandrel having a polished surface; a base fabric layer made by arranging a fabric piece that uses a high-strength thread for at least one of intersecting threads around the outer periphery of the first resin layer in an all-round manner and in a manner that the high-strength thread is arranged along the shaft direction of the mandrel; a thread winding layer made by

winding a high-strength thread around the outer periphery of the base fabric layer in a circumferential direction in a spiral manner; and an endless second resin layer formed on the outer periphery of the thread winding layer, wherein the second resin layer is in contact with the first resin layer through the base fabric layer and the thread winding layer, and wherein resin of the first resin layer and the second resin layer is made up of thermosetting urethane resin (prepolymer: Takenate L2395 [produced by Takeda Pharmaceutical Company Limited], and a hardening agent: 3, 3'-dichloro-4, 4'-diaminodiphenylmethane)" (extracted from the decision)

(ii) Exhibit A2 (cited invention 2): "High Polymer Related Technology Information, Polyfile 1999, Vol. 36, No. 419, Jan., 1999", pp 1, 37, 38 and 72: Taiseisya Ltd., Publication Division, issued on Jan. 10, 1999 (finding of the trial decision)

"ETHACURE300 that is a hardening agent for thermosetting polyurethane, using at least 3, 5-dimethylthio-2, 6-toluenediamine or 3, 5-dimethylthio-2, 4-toluenediamine as active ingredient"

(3) The Claims (claimed invention)

[Claim 1]

A shoe-press belt comprising a reinforcement base material and thermosetting polyurethane in a unified manner, the reinforcement base material being buried in the polyurethane,

an outer periphery surface and an inner periphery surface of the shoe-press belt being formed of the polyurethane,

wherein polyurethane forming the outer periphery surface includes a composition containing urethane prepolymer having an isocyanate group at an end and a hardening agent containing dimethylthiotoluenediamine.

(4) Procedural History

Jul. 15, 2005	:	Registration of establishment of patent right (refer to the above-mentioned "The Claims")
Apr. 14, 2011	:	Demand for trial for patent invalidation by the plaintiff (Invalidation No. 2011-800059)
Nov. 30, 2011	:	Trial decision that said that "the patent as to the invention according to claim 1 is made to be invalid."

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

Trial decision
"It can be said that Exhibit A2 is a printed publication that strongly motivate to use the cited invention 2 as a hardening agent of thermosetting polyurethane instead of MOCA..., and, even if the effect asserted by the demandee (decision note: plaintiff) is found, it can be done to use the cited invention 2 in the cited invention 1 instead of MOCA that is the hardening agent of the cited invention 1 without exerting special creative power. Therefore, the effect in question is just nothing but one that has been confirmed" (extracted from the decision)

Decision	
Allegations by Plaintiff The trial decision determined that, to use the cited invention 2 in the cited invention 1 instead of MOCA that is the hardening agent of the cited invention 1 can be done without exerting special creative power, and, therefore, even if an unpredictable effect is found in the present invention 1, it must be said that the effect in question is just nothing but one having been confirmed, and the difference A could have been easily arrived at. However, in determination of easily-arrived property of an invention, when action and an effect of the invention is remarkable or special, the point that the action and effect of the invention is remarkable or special can be an important decision-making factor that leads to a conclusion that the invention in question was not easily arrived. According to [Table 1] in the present description, when samples 1 to 3 (the present invention 1) and samples 4 to 6 (comparison examples) are compared, there is a difference of at least 1.60 million times in the number of cycles until a crack occurs on a surface of the test piece 37. Therefore, an unpredictable, particularly remarkable or special effect for preventing a crack occurrence is found in the present invention 1. Accordingly, the above-mentioned action and effect of the present invention 1 should be an important decision-making factor as a remarkable or special effect to lead to a conclusion that the present invention 1 was not easily arrived, and, thus, it is an error that the trial decision handled this as "just nothing but one that has been confirmed" and did not make it even be a decision-making factor in determination of an easily-arrived property of the present invention 1.	Allegations by Defendant (Relating to allegation by the plaintiff that "although, about the present invention 1 and the cited inventions 1 and 2, the trial decision made a finding only of the constitutions of the inventions, not only finding about the constitutions of the inventions, but also finding about "significance of an invention" should be made considering a problem to be solved and an effect and the like in determining an easily-arrived property. ...") The plaintiff failed to make finding of the present invention 1, and, thus, also failed to make finding of the difference between the present invention 1 and the cited invention 1. The plaintiff has made allegation pertinent to an effect on the premise of such fallacious allegation, and, therefore, the premise itself is an error, and the allegation is unreasonable.

Judgment by the Court

At first glance, as the trial decision has determined, it appears as if a person skilled in the art who comes into contact with Exhibit A2 easily arrives at the constitution of the present invention by using ETHACURE300 instead of MOCA from the safety point of view.

B However, as has been described above, the cited invention 1 is an invention to provide a good shoe-press belt that increases, in order to improve a weak point in the conventional art that a dimension change in the CMD direction is easily caused to cause a reduced belt life, the strength in CMD direction along with MD direction, and that produces an effect that enables maintaining a running state of a high dimension accuracy and good stabilization for a long period of time, and the cited invention 2 is an invention to provide a safe hardening agent without any carcinogenicity and the like. In contrast to these, the present invention 1 is an invention that produces an effect that, by using a hardening agent containing dimethylthiotoluenediamine as a hardening agent to be used at the time of forming polyurethane constituting the outer periphery surface of a shoe-press belt, occurrence of a crack in the polyurethane constituting the outer periphery surface of the belt can be prevented, and, especially, as described below, it is found that it produces a remarkable effect that even a person skilled in the art cannot estimate from the state of the art as of the filing of the present patent.

That is, according to the present description (A10), there is stated in a working example that a test is performed in a way that both ends of a test piece of 20 mm width and 420 mm length in the length direction were held by a holding member, a metallic round bar of 25 mm in diameter having a smooth surface was put to the inside of the intermediate part of the test piece to apply tension, the test piece was reciprocated in a range of 10 cm width while supplying lubricating oil between the inner surface of the test piece and the round bar from a nozzle, and sliding was repeated between the inner surface of the test piece and the round bar, and the number of cycles trips (the number of times of durability) until a crack occurred on a surface of the test piece was measured ([0089]). The test is one to repeat sliding between the inner surface of a test piece and a round bar, and, thus, it is understood as simulating the shoe press. As a result of the test, there is stated that samples 1 to 3 using DMTDA (dimethylthiotoluenediamine (ETHACURE300)) as a hardening agent and samples 4 to 6 using MOCA as a hardening agent were compared, and the number of times of durability about the latter was 100,000 times to 900,000 times, whereas that of the former was 2,500,000 to 2,250,000 ([Fig. 1]). Therefore, the difference between those is noticeable.

According to the above-mentioned statement, it is found that, by using a hardening agent containing dimethylthiotoluenediamine as a hardening agent, occurrence of a crack is suppressed noticeably. Then, about such effect, there is no description or suggestion in Exhibition A1 and Exhibition A2, and there is no evidence to suggest that such effect could be predicted by a person skilled in the art at the time of filing of application. As a consequence, it should be said that the effect that, by using a hardening agent containing dimethylthiotoluenediamine as a hardening agent, occurrence of a crack is significantly suppressed is a remarkable one that cannot be predicted even by a person skilled in the art from Exhibition A1 and Exhibition A2, and also from the state of the art as of the filing of the present patent application.

Meanwhile, regarding the remarkable effect, the defendant has only pointed out an error of the allegations

by the plaintiff, and did not make a specific objection.

Even if there is a case where a person skilled in the art who comes into contact with Exhibit A2 is motivated to use ETHACURE300 instead of MOCA from a safety point of view, considering that the present invention 1 produces a remarkable effect that can prevent occurrence of a crack in polyurethane constituting the outer periphery surface of a belt and that cannot be presumed even by a person skilled in the art, it cannot be said that the present invention 1 is an invention that is arrived at easily by a person skilled in the art, and it is found that it has an inventive step. Therefore, the present invention 1 cannot be made to be invalid.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

Case	"Detergent composition"(Trial for Invalidation) Intellectual Property High Court Decision, February 27, 2013 (2012 (Gyo KE) No.10177)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2225, page 124
Application No.	Japanese Patent Application No. H8-194727 (JP H9-221697A)
Classification	C11D 7/60
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division Presiding judge: Toshiaki IIMURA, Judge: Kimiko YAGI, Judge: Shinji ODA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is related to a detergent composition which has excellent washing effect and good biodegradability, is used in a washing process in the food industry and hard surface washing in various industrial processes, and comprises alkali metal hydroxide, aminodicarboxylic acid diacetates and glycolates.

(2) State of the Art (Finding of Appeal Decision)

(i) Document of Exhibit A1 (Cited Invention 1b): UK Patent No. 1,439,518

"A non-toxic and non-polluting, biodegradable sequestrating composition which contains 60 wt.% of trisodium of N, N-dicarboxymethyl-2-aminopentanedioic acid obtained by the simultaneous introduction of a solution of monochloracetic acid and a solution of caustic soda into an aqueous solution of monosodium of glutamic acid, wherein (a) the alkali is used in an amount such that the pH of the reaction medium is maintained at 9.2 to 9.5; (b) the reaction is carried out at a temperature in the range from 70 to 75°C; and (c) 2.6 mol of monochloracenic acid is used per mol of glutamic acid, and further contains 12 wt.% of sodium glycolate which is impurities generated by a secondary reaction of the reaction, and sodium chloride of an amount so that the total amount becomes 100 wt.%."

(cited from the Court Decision)

(ii) Document of Exhibit A2: JP S50-3979A

"A non-toxic and non-polluting, biodegradable sequestrating composition which contains 60 wt.% of sodium of glutamic acid diacetate obtained by reacting monochloracetic acid with disodium of aminodicarboxylic acid in an alkali aqueous medium so as to couple a nitrogen atom of an amino group in aminodicarboxylic acid to a carboxymethyl group, and further contains 12 wt.% of sodium glycolate which is a byproduct generated by a secondary reaction of the reaction, and salt of an amount so that the total amount becomes 100 wt.%." (cited from the Court Decision)

(3) The Claims (only Claim 1 stated) (Present Invention 1)

[Claim 1] A detergent composition comprising sodium hydroxide, salt of aspartic acid diacetate and/or salt of glutamic acid diacetate, and sodium glycolate, wherein the amount of blending of sodium hydroxide is 0.1 to 40 wt.%.

(4) Procedural History

July 24, 1996	:	Patent application by defendant (patentee) (date from which priority is claimed: December 11, 1995)
April 25, 2008	:	Registration of establishment of patent right (see the above-mentioned "The Claims")
August 25, 2011	:	Request for trial for patent invalidation by plaintiff (Muko No. 2011-800147)
April 12, 2012	:	Appeal decision that the request is not established

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

Appeal Decision (cited from the Court Decision)
C Difference between Present Invention 1 and Cited Invention 1b (c) Difference 3' The present invention 1 comprises "sodium hydroxide" and prescribes that the amount of blending of sodium hydroxide is 0.1 to 40 wt.% of the composition, on the other hand, the cited invention 1b does not prescribe whether sodium hydroxide is included. (d) Difference 4' The present invention 1 does not prescribe the reason why "sodium glycolate" is included, on the other hand, the cited invention 1b prescribes that "sodium glycolate" is included as "impurities generated by a secondary reaction". ...A person skilled in the art could have easily made a component related to the difference 4' in the present invention 1, on the basis of the cited invention 1b and the document of Exhibit A2. Even if it is assumed that the difference 4' in the present invention 1 does not have substantial difference, the effect of the present invention 1 exceeds the range that can be predicted by the statement of documents of Exhibit A1 and A 2 and the like. Consequently, a person skilled in the art would not have been able to easily make the present invention from the

cited invention 1b, the document of Exhibit A2 and the like.

Decision

Allegations by Plaintiff

The appeal decision judged that the effect of the present invention 1 for improving a detergent property by comprising sodium glycolate in the detergent composition cannot be predicted. Thus, the effect of the present invention 1 exceeds the range that can be predicted by the statement of Exhibit A1 to Exhibit A6 and is exceptional. Accordingly, the present invention 1 is not easily arrived.

In a case that one composition stated in one document publicly known simultaneously has a constituent feature X and a constituent feature Y, the determination that the presence or absence of inventive step is estimated by predictability of effect of the combination of the constituent feature X and the constituent feature Y, is inaccurate. Since the composition has both of the constituent feature X and the constituent feature Y, the composition has already exhibited the effect with the combination.

The detergent composition comprising a sequestrating composition OS_1 comprising 60 wt.% of salt of glutamic acid diacetate and 12 wt.% of sodium glycolate has already been known. Thus, although it is ascertained thereafter that the combination of salt of glutamic acid diacetate and sodium glycolate increases a washing effect, there is no difference in a constitution, and the effect has already been inherent in the publicly known detergent composition. Consequently, finding inventive step of the present invention 1 in the term of effect is inaccurate.

Allegations by Defendant

...The detergent composition of the present invention 1 comprises sodium hydroxide, salt of aspartic acid diacetate and/or salt of glutamic acid diacetate, and sodium glycolate as main components. The detergent composition of the present invention 1 has detergent capacity similar to a detergent of the prior art comprising salt of ethylenediaminetetraacetic acid (EDTA) as a main component by adding sodium glycolate to salt of aspartic acid diacetate and/or salt of glutamic acid diacetate, and simultaneously has prominent working-effect excellent in biodegradability.

A person skilled in the art generally deems that glycolate is an acid cleaning agent, and does not deem that glycolate is a component of a detergent composition used in a strong alkali condition as long as there is no special intension.

The present invention 1 has found that the prominent effect improving detergent capacity to the same extent as detergent composition having salt of EDTA as a main component is obtained by the combination of three components which contradict the common general knowledge of a person skilled in the art at the priority date of the patent.

Judgment by the Court

...The plaintiff alleges that the detergent composition comprising a sequestrating composition OS_1 comprising salt of glutamic acid diacetate and sodium glycolate has already been known. Thus, although it is ascertained thereafter that the combination of salt of glutamic acid diacetate and sodium glycolate increases a

washing effect, the effect has already been inherent in the known detergent composition, and it is unreasonable to acknowledge the inventive step of the present invention 1 in terms of effect.

The document of Exhibit A1 discloses a sequestrating composition OS_1 comprising 60 wt.% of salt of glutamic acid diacetate and 12 wt.% of sodium glycolate, but does not disclose that sodium hydroxide is included in the detergent composition comprising OS_1.

The present invention 1 (the detergent composition comprising sodium hydroxide, salt of aspartic acid diacetate and/or salt of glutamic acid diacetate, and sodium glycolate as main components) was not publicly known before the priority date of the patent, and the effect in the present invention 1 cannot be predicted by the publicly known detergent composition of the document of Exhibit A1, etc. ....

Accordingly, the detergent composition of the present invention 1 is constituted by a component different from the sequestrating composition of the cited invention 1b. Conventionally, a person skilled in the art has understood that sodium glycolate is impurities generated by a secondary reaction which inhibits the production of sodium of glutamic acid diacetate with high yield. On the other hand, the present invention 1 has ascertained that combining sodium glycolate is useful in increasing the washing effect. Further, combining sodium glycolate is an essential component in the present invention 1. Thus, this is one of the factors which should be taken into consideration, in finding inventive step of the present invention 1.

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	Experimental results submitted after filing of the application

1. Bibliographic Items

Case	"Thermostable ribonuclease H" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 18, 2013 (2012 (Gyo KE) No. 10252)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2006-167465 (JP 2006-288400A)
Classification	C12N 15/09
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Toshifumi SHIBATA, Judge: Gaku OKAMOTO, Judge: Eiko TAKEMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

The Claimed Invention is polypeptides having an RNase H activity highly useful in genetic engineering which comprise a specific amino acid sequence and have a thermostable ribonuclease H activity, genes encoding these polypeptides, transformants transformed with recombinant DNA, and polypeptides having a thermostable ribonuclease H activity which is obtained by culturing the transformants.

(2) State of the art

(i) Cited document 3 (The Cited Invention 1): J. Bacteriol. (1998) vol. 180, no. 23, p. 6207-6214 (Identified by the Appeal Decision)

"We have cloned the gene encoding RNase HII (RNase HIIPk) from hyperthermophilic archaeon Pyrococcus kodakaraensis KOD1 by screening of a library for clones that suppressed the temperature-sensitive growth phenotype of an rnh mutant strain of Escherichia coli. This gene was expressed in the rnh mutant strain of E. coli, the recombinant enzyme was purified, and its biochemical properties were compared with those of E. coli RNases HI and HII. RNase HIIPk is composed of 228 amino acid residues (molecular weight, 25,799) and acts as a

monomer. Its amino acid sequence showed little similarity to those of enzymes that are members of the RNase HI family of proteins but showed 40, 31, and 25% identities to those of Methanococcus jannaschii, Saccharomyces cerevisiae, and E. coli RNase HII proteins, respectively. The enzymatic activity was determined at 30°C and pH 8.0 by use of an M13 DNA-RNA hybrid as a substrate. Under these conditions, the most preferred metal ions were Co2+ for RNase HIIPk, Mn2+ for E. coli RNase HII, and Mg2+ for E. coli RNase HI. The specific activity of RNase HIIPk determined in the presence of the most preferred metal ion was 6.8-fold higher than that of E. coli RNase HII and 4.5-fold lower than that of E. coli RNase HI. Like E. coli RNase HI, RNase HIIPk and E. coli RNase HII cleave the RNA strand of an RNA-DNA hybrid endonucleolytically at the P-O3' bond. In addition, these enzymes cleave oligomeric substrates in a similar manner. These results suggest that RNase HIIPk and E. coli RNases HI and HII are structurally and functionally related to one another." (abstract) is described,

"The nucleotide sequence reported in this paper has been deposited in the DDBJ database under accession No. AB012613." (page 6208, lines 53 to 55 in the right column) is described,

In Figure 1, alignment of RNase HII sequences from bacteria, archaea, and eucarya including P. kodakaraensis KOD1 is described, and the ranges for the four sequence motifs (Motif I to IV) which are well conserved in the RNase HII sequences are shown above the sequences,

In Figure 4B, sites and extents of cleavage by RNase HIIPk and E. coli RNases HI are described, and sites of cleavage of the 29-bp DNA-RNA-DNA-DNA substrate with RNase HIIPk are described in "c." of Figure 4B,

"... It is clear that RNase HIIPk cannot cleave either the DNA-RNA junction or the RNA-DNA junction. However, RNase HIIPk and E. coli RNase HII can cleave the 29-bp DNA-RNA-DNA-DNA substrate at the 5' end of the last ribonucleotide at the RNA-DNA junction, whereas E. coli RNase HI cannot cleave it at this site." (page 6213, lines 20 to 25 in the left column) is described. (cited from Appeal Decision)

(3) The Claims (Claimed invention amended)

[Claim 1] A polypeptide having a thermostable ribonuclease H activity and capable of cleaving a strand including an RNA strand of a double-stranded DNA including one RNA in one strand, which is selected from the group consisting of:

(a) a polypeptide having the amino acid sequence of SEQ ID NO: 47 or 57;

(b) a polypeptide having an amino acid sequence in which at least one amino acid residue is deleted, added, inserted or substituted in the amino acid sequence of SEQ ID NO: 47 or 57;

(c) a polypeptide encoded by a nucleic acid that is hybridizable to nucleic acids of SEQ ID NO: 46 or 56 or complementary strands thereof under stringent conditions.

(4) Procedural History

June 16, 2006	:	Filing of Patent Application (Priority Date of Original Application: September 14, 2000)
June 19, 2009	:	Decision of Refusal
September 18, 2009	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2009-17666)

Filing of the Amendment (see the above "The Claims")

May 28, 2012 : Dismissal of the above Amendment, Appeal Decision that "the appeal of the case was groundless."

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

Appeal Decision	
... the appellant alleges in the reason of appeal that the polypeptides of the Claimed Invention amended have the ribonuclease H activity under the extremely low concentration of magnesium. Although, in the paragraph [0219] in the description, it is stated that the enzyme activity was observed by the method stated in Example 3-(5) and a reaction solution containing 4 mM magnesium acetate is stated in Example 3-(5), details of the activity are not stated. In FIG. 3 of cited documents 3, effect of metal ion concentrations on RNase HIIPk activity is described, and it is also described that only 4 mM magnesium chloride has an enzyme activity. In this point, the Claimed Invention amended does not have prominent effect. Although the appellant submits experimental data about this point in the reason of appeal, the appellant's allegation is the allegation not based on the description since the effect based on the experimental data is not stated in the description.	
Decision	
Allegations by Plaintiff Setting aside the case where "Effect of the Invention" is not stated in the originally attached description, if "Effect of the Invention" is stated to such an extent that a person skilled in the art can recognize or suppose, considering experimental results supplemented after filing of the application, as long as exceeding the extent of the statement, should be approved and whether to approve or not should be fairly determined. Since a person skilled in the art can rationally suppose the effect of the polypeptides of the Claimed Invention amended that sufficiently high ribonuclease H activity is exhibited under the extremely lower concentration of magnesium compared with 4 mM in conventional RNase H, from the statement of the description, and the effect is substantially disclosed in the description, the experimental data should be considered. As it is clear from (B) experimental results in experimental data submitted in the appeal procedure, the	Allegations by Defendant In the description, it is not stated that the Claimed Invention amended has high activity under the concentration of 1 to 4 mM magnesium and has highest ribonuclease H activity under the concentration of 2 mM magnesium. The fact that the activity is exhibited under the extremely low concentration of magnesium is first showed by the experimental data submitted in the appeal procedure. In this case, the presumption of inventive step by approving prominent effect on the basis of the experimental data submitted after filing of the application cannot be permitted from the fairness between the applicant and third party, and the experimental data cannot be considered in determining inventive step.

polypeptides of the Claimed Invention amended has high activity under the concentration of 1 to 4 mM magnesium and has highest ribonuclease H activity under the concentration of 2 mM magnesium ((B) experimental results in page 4, Exhibit A9).	

Judgment by the Court

The plaintiff alleges that the experimental data described in Exhibit A9 should be considered. However, as stated above, regarding the amended claimed invention, the effect in that sufficiently high RNase H activity is exhibited under the extremely lower concentration of magnesium compared with the conventional RNase H such as 4 mM is not stated in the description. Thus, the above experimental data showing the effect is beyond an extent that a person skilled in the art can suppose from the statement of the description, and thus cannot be considered.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

Case	"Acid addition salt of optically active piperidine derivative" (Trial for Invalidation) Intellectual Property High Court Decision, July 24, 2013 (2012 (Gyo KE) No. 10206)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2226, page 93
Application No.	Japanese Patent Application No. 2000-32961 (JP 2000-198784A)
Classification	A61K 31/4545
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division Presiding judge: Ryuichi SHITARA, Judge: Rika NISHI, Judge: Masaya TANAKA

2. Overview of the Case

(1) Summary of Claimed Invention

Since it is generally known that each optical isomer has different pharmacological activity, safety, metabolic rate and protein binding rate, it is necessary to provide a pharmacologically preferable isomer to a pharmaceutical product. The claimed invention has found that (S)-ester has more excellent activity than that of (R)-ester in evaluation tests of inhibitory effect of death due to a histamine shock and a homologous PCA reaction using guinea pigs, and the present compound in which the absolute configuration is an (S) form has an excellent optical isomer acting as a body of antihistaminic activity and antiallergic activity in vivo.

Further, it is desirable that pharmaceutical products have excellent physicochemical stability for ensuring high quality. The claimed invention has found that a lot of acid addition salts of the present compound in which the absolute configuration is an (S) form are oily material or hygroscopic crystal, but benzene sulfonate thereof is obtained as crystal with low hygroscopicity and excellent preservation stability, thus the benzene sulfonate is a compound especially suitable for pharmaceutical products.

(2) State of the Art

(i) Publication of Exhibit A2 (Invention of Exhibit A2): Publication of amendment prescribed by Patent Act Article

17bis about JP H2-25465A and JP S63-175142A (Finding of Appeal Decision)

"Antihistaminic agent comprising benzene sulfonate of 4-[4-[(4-chlorophenyl) (2-pyridyl) methoxy]-1-piperidyl] butanoic acid as an active ingredient."(cited from the Court Decision)

(ii) Publication of Exhibit A75: Separation Process, Vol.25, No. 5 (Finding of Decision)

"As common general knowledge at the priority date of the patent, it has been widely known that there may be difference in effect on living organisms among optical isomers. For recent technical progress about asymmetric synthesis and optical resolution, it has been found that a chemical compound having different effect on living organisms among the optical isomers is not used as a racemic form by itself, but is used as an optical isomer." (cited from the Court Decision)

(3) The Claims (only Claim 1 stated) (Patented Invention 1)

[Claim 1] A pharmaceutical composition comprising benzene sulfonate of (S)-4-[4-[(4-chlorophenyl) (2-pyridyl) methoxy] piperidyl] butanoic acid, wherein the (R) form is not substantially included.

(4) Procedural History

February 10, 2000	:	Patent application by defendant(patentee) (date from which priority is claimed: December 26, 1996)
August 6, 2010	:	Registration of establishment of patent right (see the above-mentioned "The Claims")
June 9, 2011	:	Request for trial for invalidation by plaintiff (Muko No. 2011-800097)
April 23, 2012	:	Appeal decision that request for the trial is not established

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

Appeal Decision (cited from the Court Decision)
Since a person skilled in the art could not have easily made the patented invention 1 on the basis on the publication of Exhibit A2 and the like, the patent related to the patented invention 1 does not violate the provisions of Patent Act Article 29(2). (2) Difference between the invention Exhibit A2 and the patented invention 1 found by the appeal decision is as follows. C Difference The patented invention 1 prescribes that 4-[4-[(4-chlorophenyl) (2-pyridyl) methoxy] piperidyl] butanoic acid constituting benzene sulfonate of 4-[4-[(4-chlorophenyl) (2-pyridyl) methoxy] piperidyl] butanoic acid of an active ingredient in a pharmaceutical composition is an (S) form and the (R) form is not substantially included, on the other hand, the invention Exhibit A2 does not specify the optical isomer. (4-[4-[(4-chlorophenyl) (2-pyridyl) methoxy] piperidyl] butanoic acid is referred to as "the present compound", hereinafter)
Decision

Allegations by Plaintiff	Allegations by Defendant
(A) The appeal decision judges that the present specification states the result of a pharmacological test which indicates that the (S) form is more excellent than the (R) form, and it can be understood that there is a difference in effect as a pharmaceutical composition between the (S) form and the racemic body. However, this judgement is inaccurate. The present specification states data comparing the pharmacological effect between (S)-ester (fumarate of (S)-ethyl butyrate) and (R)-ester (fumarate of (R)-ethyl butyrate). The difference in effect of the racemic body, as well as the (S) form and (R) form of the present compound unesterified, is not comprehensible (B) It is very often that only one of two kinds of optical isomer constituting the racemic body has desired biological activity. Thus, even if the (R) form-ester has more excellent effect that the (S) form-ester, it is extremely ordinarily found among optical isomers. (C) The fact that the (R) form of the present compound does not show any effect has been elucidated in an examination report of the manager of National Institute of Health Science. The examination report states that the (R) form does not have influence on general observation of symptoms and a circulatory system. Thus, the (S) form of the present compound shows only about twice the effect compared to the racemic body, and there is no prominent effect supporting inventive step of the patented invention.	The plaintiff alleges that the judgement of the appeal decision about the effect of the patented invention is inaccurate. However, about the pharmacological effect of the patented invention, the appeal decision found that it is interpreted that the qualitative difference in effect between the (S) form and the racemic body of the present compound as a pharmaceutical composition can be understood, the present composition constituting besilate of the active ingredient, from the examination results. There is no error in the judgement of the appeal decision.

Judgment by the Court

The present specification (Exhibit A1) states that in the evaluation test of inhibitory effect of death due to a histamine shock, (S)-ester has about 43 times stronger activity than (R)-ester, and in the evaluation test of inhibitory effect of a homologous PCA reaction, (S)-ester has about 100 times stronger effect that (R)-ester. The present specification concludes that the (S) form of the present compound is a superior optically active

substance, based on the comparison between the (S) form and (R) form of ester of the present compound, and acts as an activator in vivo.

A certificate of experimental results states that as a result of a pharmacological test about histamine-induced contraction in the ileum removed from guinea pigs, benzene sulfonate of the (S) form of the present compound showed about 7 times activity compared to the racemic body. Further, it is supported by the statement in which as a result of an examination similar to the evaluation test of inhibitory effect of death due to a histamine shock stated in the present specification, benzene sulfonate of the (S) form of the present compound showed about three times survival rate compared to the racemic body.

The (S) form of the present compound, compared to the (R) form, has activity equal to or higher than the difference in biological activity between two kinds of optical isomer constituting the racemic body that a person skilled in the art usually deems.

Consequently, benzene sulfonate of the (S) form of the present compound has the prominent pharmacological effect, which a person skilled in the art cannot predict, compared to benzene sulfonate of the racemic body of the present compound being the invention Exhibit A2 found by the appeal decision.

...The plaintiff alleges that the present specification states the data comparing the pharmacological effect between (S)-ester (fumarate of (S)-ethyl butyrate) and (R)-ester (fumarate of (R)-ethyl butyrate), and the difference in effect of the racemic body, as well as the (S) form and (R) form of the unesterified compound of the present invention is not comprehensible at all.

...The present specification states that (S)-ester has superior activity than (R)-ester in evaluation tests of inhibitory effect of death due to a histamine shock and a homologous PCA reaction, and an (S)-pyperidine derivative represented by formula (I) being a metabolite of (S)-ester has pharmacological effect similar to (S)-ester. Further, the present specification states that benzene sulfonate and benzoate of (S)-pyperidine derivative (I) are superior optically active substances having antihistaminic activity and antiallergic activity, act as activators in vivo, show excellent physicochemical stability, and have character suitable as pharmaceutical products. Consequently, it should be said that the present specification states and discloses that the (S) form of the present invention has superior activity than the (R) form.

...The pharmacological examination stated in the certificate of experimental results stated that benzene sulfonate of the (S) form of the present compound showed about 7 times activity compared to the racemic body. This numerical value exceeds the difference in activity if it is assumed that only one of two kinds of optical isomer has biological activity and the other has no biological activity, that is, twice the difference.

Accordingly, the (S) form of the present compound, compared to the (R) form, has activity equal to or higher than the difference in biological activity between two kinds of optical isomer constituting the racemic body that a person skilled in the art usually deems.

...The plaintiff alleges that in the report, the (R) form does not have influence on general observation of symptoms and a circulatory system, the (S) form of the present compound shows only about twice the effect compared to the racemic body, and there is no prominent effect supporting the inventive step of the patented invention.

However, the above-mentioned report only states "the (R) form of an optical isomer had no effect" and thus it is unclear to which result using the degree of dose in any pharmacological test the statement is based on.

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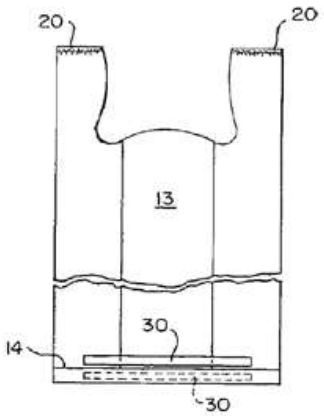
Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

Case	"A plastic bag with gore" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 31, 2013 (2013 (Gyo KE) No.10078)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-559768 (National Publication of International Patent Application No. 2003-525177)
Classification	B65D 33/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Setsu SHIMIZU, Judge: Akira IKESHITA, Judge: Takaaki SHINTANI

2. Overview of the Case

[FIG. 14]



(1) Summary of Claimed Invention

A plastic T-shirt bag of the claimed invention comprises: gores in side parts; a seal line (14) in bottom parts; plastic form in a tube shape, formed by extrusion molding. A connected point (24) between a fold at the inside of gores and a seal line (14) is weakest area in bottom parts. Reinforcing tape (30) is extended across this two wake areas, and absorbs the force applied when articles are put in the bag.

(2) State of the art

(i) Cited Document 1 (Cited Invention 1) : The description of US Patent No. 4812055 (Finding of Appeal Decision)

"A thermoplastic-resin underwear bag 10 including a tube of thermoplastic-resin film with gores in side parts comprising: gores having respectively, an inside fold at the inside, a heat seal 18 in bottom parts across an inside fold and a handle 22 formed in gore parts of bag 10, wherein a seal region 26 is set for reducing the tendency that a connected point 24 between an inside fold and a heat seal 18 in bottom parts becomes weak when articles are put in bag 10" (cited from the Court Decision)

(ii) Cited Document 2: The microfilm of Japanese Utility Model Application No. S56-014737 (JP S57-129050U)
(Finding of Appeal Decision)
"In a plastic bag, to prevent the breakage of a seal line that is weak in strength and easily broken, by a reinforcing tape as a reinforcement means separated from a plastic film layeredly adhered to a seal line"

(3) The Claims (Claimed Invention)
[Claim 1] A plastic T-shirt bag, comprising: a tube of a plastic film having gores in side parts; each gore having respectively, an inside fold, a seal line in bottom parts across said inside fold and a handle formed in gore parts of a bag; an reinforcement means separated from said plastic film extended across said each inside fold, attached on a bottom of the bag, overlaid on the proximity of the seal line or on the seal line; said reinforcement means not adhered to parts where a handle of a bag is formed; said reinforcement means reducing the tendency that a connected point between said inside fold and said seal line becomes weak when articles are put in a bag.

(4) Procedural History

February 15, 2001	:	Filing of Patent Application (The date of priority claim : February 15, 2000/US)
February 22, 2011	:	Decision of Refusal
June 30, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-14005)
June 18, 2012	:	Amendment of Proceeding (See above "The Claims")
November 5, 2012	:	Above amendment of proceeding is rejected, Appeal Decision that "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision</td></tr>
<tr><td colspan="2">...
In addition, the effect generated by Claimed Invention 1 is foreseeable by a person skilled in the art from the inventions as stated in Cited Document 1 and Cited Document 2, and is not especially outstanding.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
... The experiment result as stated in the written oath of the applicant (Exhibit A7) indicates that the claimed invention generates more outstanding effect than Cited Invention 1.
In addition, paragraph [0036] and [0037] of the description of the application (Exhibit A3) states that "by setting a reinforcing strip (a reinforcement means), the thickness of a gore area 22A is 1.5 times larger than that of a non-gore area 22B, otherwise, if</td><td>Allegations by Defendant
Even if the claimed invention is more effective than Cited Invention 1 in respect to intensity for breakage, it does not mean that the effect of the claimed invention is not foreseeable from Cited Invention 1 and Cited Invention 2. By applying a reinforcing tape as stated in Cited Document 2 to Cited Invention 1, the invention satisfying all of constituent requirements of the claimed invention can be acquired, and similarly as the claimed invention, the invention generates</td></tr>
</table>

a reinforcing strip is not set, the thickness of a gore area is twice as large as that of non-gore area 22B. By improving (lessening) this ratio of thickness, the intensity of a connected point 24 is strengthen." Accordingly, to set a separated reinforcement means make the intensity more strengthen than to make same thickness of a film. Above matters are not stated in Cited Document 1 as the invention relating to a T-shirt bag, even more, it is not foreseeable from Cited Invention 2 as the invention relating to a non-gore bag.	reinforcing effect by a reinforcing tape. Furthermore, there is no reason for recognizing that a reinforcing tape generates more outstanding effect by reinforcing a connected point than by reinforcing other parts, and such explanation is not stated in the description, etc. of the application. Accordingly, it is predicted that the reinforcing effect by the reinforcing tape of the claimed invention and the reinforcing effect by the reinforcing tape of the invention acquired by applying the reinforcing tape as stated in Cited Document 2 to Cited Invention 1 is similar degree. Therefore, the effect generated by the claimed invention is foreseeable by a person skilled in the art from Cited Invention 1 and Cited Invention 2, and is not especially outstanding.

Judgment by the Court

Plaintiff has filed the written oath (Exhibit A7) to the effect that the claimed invention generates outstanding effect. Certainly, it is recognized that, within the scope of the experiment of Exhibit A7, the constitution as setting a reinforcing strip has higher intensity for breakage of a connected point 24 than the constitution as setting a seal area 26. However, it is apparent that the intensity for breakage of a connected point 24 is largely affected by the technical condition of a seal area 26 or the technical condition of a reinforcing strip or the like. Exhibit A7 does not indicate the detail of these technical conditions, and, in consideration of the number of the results of the experiments, it cannot be said that the experiments were made in various conditions. Therefore, as Plaintiff has asserted, it is considered that, in view of the experiment results of Exhibit A7, the claimed invention does not necessarily generate more outstanding effect than Cited Invention 1. From the first, in order that the claimed invention obtains an inventive step on the ground that the claimed invention generates the outstanding effect, there is necessity of generating the larger effect than that expected to be obtained by the combination of Cited Invention 1 and Cited Invention 2, and even if the claimed invention generates the larger effect than Cited Invention 1, it does not demonstrate that the effect of the claimed invention is outstanding.

Moreover, as Plaintiff has asserted, even if to set a supporting means separated from a film makes higher intensity than to make same thickness of a film, the constitution as applying the statement of Cited Document 2 to Cited Invention 1 similarly generates the above effect. Therefore, even if there is no statement in Cited Documents 1 and 2, it means that the effect is merely confirmed, and thus it is not recognized that the effect is especially outstanding.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.1
Classification of the Case	45: Advantageous effect in comparison with the cited invention
Keyword	

1. Bibliographic Items

Case	"(+)-2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonyl ethyl]-4-acetylamino isoindoline-1,3-dione, methods of using and compositions thereof"(Appeals against an Examiner's Decision) Intellectual Property High Court Decision, August 7, 2014 (2013 (Gyo KE) No. 10170)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-577877 (National Publication of International Patent Application No. 2005-525386)
Classification	A61K 31/4035
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Ryuichi SHITARA, Judge: Shigeru OSUGA, Judge: Shinji ODA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a stereometrically pure (+)-2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonyl ethyl]-4-acetylamino isoindoline-1,3-dione, substantially free of its (-) isomer, and prodrugs, metabolites, polymorphs, salts, solvates, hydrates, and clathrates thereof. Also, the claimed invention is methods of using and pharmaceutical compositions comprising the (+) enantiomer of 2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonyl ethyl]-4-acetylamino isoindoline-1,3-dione. The methods include methods of treating and/or preventing disorders ameliorated by the reduction of levels of TNF-α or the inhibition of PDE4.

(2) State of the art

(i) Citation 1 (Cited Invention): International Publication No. WO00/25777 (Finding of the Trial Decision)

"A pharmaceutical composition comprising 2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonylethyl]-4-acetylamino isoindoline-1,3-dione; a pharmaceutically acceptable carrier, a diluent and an excipient" (cited from

the Court Decision)

(3) The Claims (Present amended invention)

[Claim 1] A pharmaceutical composition comprising stereometrically pure (+)-2-[1-(3-Ethoxy-4-methoxyphenyl)-2-methylsulfonylethyl]-4-acetylaminoisoindoline-1,3-dione, or a pharmaceutically acceptable salt, solvate or hydrate; and a pharmaceutically acceptable carrier, excipient or diluent.

(4) Procedural History

March 20, 2003	:	Patent application (Priority date: March 20, 2002 and January 7, 2003, United states)
May 17, 2010	:	Decision of Refusal
September 24, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-21522)
September 24, 2010	:	Written amendment (see the aforementioned "The Claims")
February 4, 2013	:	Trial Decision that "the request for the Present Trial is dismissed."

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

Appeal Decision (cited from the Court Decision)
(5) Examination of the Difference ... since the "2-[1-(3-ethoxy-4-methoxyphenyl)-2-methylsulfonylethyl]-4-acetylamino isoindoline-1,3-dione" (hereinafter, referred to as a "compound of cited invention") in the cited invention has one chiral center, while it is obvious that there are two optical isomers therefor of (+)-enantiomer and (-)-enantiomer, it is recognized according to the statement of the aforementioned (2) III. That the compound of cited invention can be present as such an optical isomer. Here, it is recognized that there is the technical general knowledge prior to the priority date for the present case that a drug having chirality has a difference in a degree of binding it with a receptor depending on its optical isomer, and that a difference in the strength of pharmacological activity is created, a quite different pharmacological action is shown, and only optical isomer compatible with its purpose should be provided for the drug having chiral center in its structure (see the aforementioned (3)). Hence, since it can be also naturally presumed that the compound of cited invention has a different in the strength of pharmacological activity and shows the quite different pharmacological action, it is easily conceivable for a person skilled in the art that two compounds which are pure as the optical isomer for the compound of cited invention are obtained by mechanically separating thereof or preparing it with chiral form according to the statement of the aforementioned (2) III. in the Citation 1, and one of the two compounds, which are compatible with the purpose of using for the treatment of "psoriatic" stated in the aforementioned (2) II. in the Citation 1 is assigned as an active component to achieve the present claimed invention. (6) Regarding the assertion made by the Demandant The Demandant has asserted in the amended written notice of appeal dated November 18, 2010 and the

written answer dated April 26, 2012, a gist that apremilast (pure (+)-enantiomer according to the present amended invention) correctively has a high activity strength, a preferred therapeutic index (a ratio of an amount of a therapeutical drug exerting a desired therapeutical effect and of an amount of the therapeutical drug showing a unacceptable level of side effect) and a good oral bioavailability, and superiority of apremilast in the therapy of psoriatic especially as an oral drug against the corresponding racemic body or (-)-enantiomer has been proved and that such a remarkable efficacy of apremilast cannot be presumed at all.

However, there had been the technical general knowledge prior to the priority date for the present application that it is often that a biological activity of a racemic body is remarkably reduced by 1/2 or lower in comparison with those in an effective optical isomer, there is a difference in a degree of binding it with a receptor based on the variety of optical isomers whereby there is a difference in the strength of the pharmacological activity and that stereochemistry of a pharmaceutical product has a great role for absorption, distribution, metabolism, excretion and side effect thereof (see the aforementioned (3) I. and III). Accordingly, it is easily predictable for a person skilled in the art that either of the aforementioned two optical isomers for the compound of cited invention will have a good activity strength and therapeutic index in comparison with the racemic body or the other optical isomer. In addition, it cannot be said to be a particular difficulty that, upon measuring an inhibitory action against TNFα and PDE IV and various indices relating to inflammation, (+)-enantiomer among the two optical isomers for the compound of cited invention is good in these inhibitory action and the indices in comparison with those in the racemic body or (-)enantiomer such that it is presumed that the enantiomer is superior in the therapy of psoriatic.

In addition, since amended Claim 1 does not recite the oral administration, it cannot be said that the "good oral bioavailability" is the effect of the present amended invention which is specified by the matters recited in amended Claim 1.

Decision

Allegations by Plaintiff	Allegations by Defendant
(2) Oversight of the remarkability of the effect (Reason 2 for cancellation) A The present amended invention is to provide a new oral systemic therapy for psoriasis, which is superior than those in the conventional therapy. Even if it is publicly known that a racemic body of a chiral compound has a constant pharmacological effect, where the pure optical isomer has a remarkable effect in comparison with those in the racemic body, the inventive step for a drug of the optical isomer can be appreciated. It cannot be said that the Citation 1 substantially discloses the pharmacological effect of the compound of cited invention, and the remarkable	(2) In response to the oversight of the remarkability of the effect (Reason 2 for cancellation) A The Demandant asserts that the present amended invention is to provide a new oral systemic therapy for psoriasis, which is superior than those in the conventional therapy. However, in the description of the present application (hereinafter, referred to as "present description"), psoriasis is merely one of various examples as inflammatory diseases. While the use of "therapy for psoriasis" in the present amended invention is added by the present amendment, what it is elucidated is that the present amended invention is

effect for the present compound can be recognized in comparison with the racemic body of the compound of cited invention.

If it is treated that the racemic body contains 50% of impurities, it cannot be explained that one of the two optical isomers shows 2 folds or more in the pharmacological activity in comparison with those in the racemic body, and whether or not it has the pharmacological activity greater than 2 folds in comparison with those in the racemic body should be as a criterion for determining the remarkability of the effect. In addition, upon determining the remarkability of the effect of the present compound, not only is each data individually compared and evaluated, but also the inhibitory activity of TNF-α should be evaluated in consideration of importance in relation to the effect of the therapy for psoriasis.

B Remarkability of the physiological activity

(A) Selective inhibitory activity against PDE4

The inhibitory activity of the present compound for PDE4 is about 1.1 folds of those in the corresponding racemic body and about 8.3 folds of those in (-)isomer. In addition, the PDE specificity ratios as calculated based on the result of the assay is stated in the latter column of Table 1, and Table 1 indicates that the present compound inhibits PDE4 with higher selectivity than those in the corresponding racemic body and (-)isomer.

Contrary thereto, the Citation 1 only suggests that the compound of formula 1 inhibits both of PDE3 and PDE4, and does not disclose an action that the present compound specifically inhibits PDE4.

(B) Activity of elevating cAMP concentration

It should be surprising that the present compound shows about 2.8 folds in the strong activity of elevating cAMP concentration in comparison with those in the corresponding racemic body, and this effective for the therapy of psoriasis is after filing the present application. In addition, the present amended invention does not specify the oral systemic therapy. As mentioned above, it cannot be said that the present amended invention is to provide a new oral systemic therapy of psoriasis which is superior than the conventional therapy, and the usage of the therapy for psoriasis, one of the inflammatory diseases which are variously exemplified would be merely stated in the Claims.

A person skilled in the art who read the Citation 1 can recognize that the compound of cited invention has the inhibitory activity of PDE4 and the inhibitory activity of TNF-α and can treat the inflammatory diseases and the like including psoriasis, for which the production of PDE4 and TNF-α is mediated by these activities, and can understand that any of specific compounds which were manufactured in the Example is used for prohibiting desired actions of TNF-α and PDE4. Further, since the present amended invention is an invention of the pharmaceutical composition for treating psoriasis, what the inventive step is appreciated is not enough that the present compound has a difference in any activities and the like as a compound in comparison with the racemic body in the cited invention, and it is necessary to exert the remarkable effect as the pharmaceutical composition for treating psoriasis, which goes beyond the expectation of a person skilled in the art in comparison with the cited invention, the drug composition containing the racemic body. Even though there is a difference between the two optical isomers constituting the racemic body of the cited invention in any of drug kinetics and side effect in addition to various indices relating to the inflammation stated in the Citation 1, these do not readily mean that the pharmaceutical composition for treating psoriasis exerts a remarkable

cannot be expected at all.

(C) Inhibitory action of producing LTB4

In the assay in human neutrophile, the present compound inhibits the production of LTB4 with about 8.1 folds in comparison with those in the corresponding racemic body. This result shows a high effect that the present compound suppresses the deterioration of inflammation of psoriasis by the inhibitory activity of producing LTB4 which is extremely superior in comparison with those in the corresponding racemic body.

(D) Inhibitory activity of producing TNF-α

The inhibitory activity of producing TNF-α for the present compound was about 1.5 folds than the activity of the corresponding racemic body, about 4 folds in the assay in human whole blood obtained from the other donor, about 2.5 folds in the assay in human PBMC, and about 20 folds in the assay in mouse serum. These results show that the present compound has an extremely superior inhibitory activity of producing TNF-α, which goes beyond the expectation of a person skilled in the art in comparison with those in the corresponding racemic body.

(E) Inhibitory action of producing IL-2 and IFNγ

In the assay of inhibiting the production of IL-2 in human PBMC, the activity of the present compound had about 3.6 folds than those in the corresponding racemic body, and in the assay of inhibiting the production of IFN-γ in human PBMC, the activity thereof had about 3.7 folds. These results show that the present compound has a superior therapeutic effect for psoriasis, which goes beyond the expectation of a person skilled in the art in comparison with those in the corresponding racemic body.

C Regarding the bioavailability

(A) Water solubility

It has been known that the active compound as effect which goes beyond the expectation of a person skilled in the art.

B Remarkability of the physiological activity

(A) Selective inhibitory activity against PDE4

According to the upper column of Table 1 in the present description, the present compound merely shows about 1.1 folds in the inhibitory activity of PDE4 in comparison with those in the corresponding racemic body, and it cannot be said that the compound has a remarkable inhibitory effect of PDE4 which goes beyond the expectation of a person skilled in the art.

(B) Activity of elevating cAMP concentration

According to Example 6 of the present description, it can be said that the present compound has about 2 folds of the activity of elevating cAMP in comparison with those in the racemic body in human PBMC, and the claimed invention has about 2.8 folds in the activity of elevating cAMP in comparison with those in the racemic body in human neutrophile. However, these results mean that there is a difference in the activity of elevating cAMP concentration based on the types of cells. In addition, it cannot be said that 2 folds or 2.8 folds for the present compound in comparison with those in the racemic body is a remarkable activity of elevating cAMP which goes beyond the expectation of a person skilled in the art in comparison with those in the racemic body, even though it is often to experience as stated in Exhibit A3 that the biological activity of the racemic body is remarkably decreased by 1/2 or lower in comparison with those in the effective optical isomer.

(C) Inhibitory activity of producing LTB4

If it was known that the PDE4 inhibitor inhibits the production of LTB4 which promotes to increase neutrophile in the inflammation tissue, it is easily conceivable for a person skilled in the art to confirm the inhibition of producing LTB4 relating to the

orally administered is adsorbed at upper region of intestinal tract where pH is typically varied from week acid to week base. Therefore, the solubility of the active component in this pH region affects the bioavailability when it is orally administered. The water solubility of the present compound at pH 7.4 was about 3.5 folds than those in the corresponding racemic body. (B) Bioavailability (biological utilization rate) The present compound had a remarkable high exposure after orally administering to male and female rat, in comparison with those in the corresponding racemic body and (-)isomer. IV Regarding low emetic effect as side effect It has been known prior to the priority date for the present application that an inhibitor for PDE4 has emetic action as main side effect. However, it has been proved that the present compound does not induce an emetic event (vomiting and nausea) and a particular behavioral change in the dosage exerting the anti-inflammatory action in the conscious ferret model. On the contrary, the Citation 1 does not mention that the inhibitor for PDE4 has the emetic effect.	inflammation for the compound of cited invention and its optical isomer for which the Citation 1 suggests the application to the inflammatory disease by the inhibition activity of PDE4. In addition, it is impossible that the degree of the activity in biological body is readily presumed from the degree of the activity out of the biological body, a lot of mediators are responsible for the inflammation, and LTB4 is merely one of a lot of mediators responsible for the inflammation. Accordingly, it cannot be construed that the present compound has an effect of 8.1 folds in comparison with those in the racemic body, even though the present compound has out of biological body about 8.1 folds in the inhibition activity of producing LTB4 in comparison with the racemic body. (D) Inhibition activity of producing TNF-α Both activities of the present compound and the corresponding racemic body cannot be compared if both thereof are subjected to the same experiment using a sample from the same donor. Nevertheless, the written report of experimental result submitted by the Plaintiff (Exhibit A23. Referred to as an "Exhibit A23 Report") does not state what experiment was performed for the racemic body using what sample or mouse. If both are simply compared with each other, the degrees of about 1.5 folds, about 2.5 folds and about 4 folds in the ratio of the activity of the present compound relative to those in the racemic body cannot be said that the present compound has the remarkable inhibition activity of producing TNF-α which goes beyond the expectation for a person skilled in the art. In addition, since TNF-α is merely one of mediators responsible for the inflammation, it cannot be construed that the numerical value of about 20 folds in the activity of the present compound relative to those in the racemic body has the effect of about 20 folds for

	the therapy of psoriasis. (E) Inhibition action of producing IL-2 and IFN-γ If it is known that IL-2 and IFN-γ is responsible for the inflammation, it is easily made for a person skilled in the art to confirm these. Since there is a doubt that the result of the racemic body stated in the Exhibit A23 report is a result obtained by performing the same experiment using the same sample in Example 6 of the present description, it cannot be disputed about the remarkability for the inhibition activity of producing IL-2 and IFN-γ for the present compound simply upon comparing the result of the racemic body stated in the Exhibit A23 report and the result of the present compound in the aforementioned Example 6. Even if both are simply compared with each other, it cannot be said that the degrees of about 3.6 folds and about 3.7 folds in the ratio of the activity of the present compound relative to those in the racemic body have the remarkable inhibition activity of producing IL-2 and the inhibition activity of producing IFN-γ for the present compound, which goes beyond the expectation for a person skilled in the art. In addition, the degree of the activity in biological body cannot be readily presumed from the degree of the activity out of biological body, and no evidence can be found that it has been known at the time of the priority date for the present application that IL-2 and IFN-γ among various mediators responsible for the inflammation are especially related to psoriasis. Accordingly, it cannot be construed that the present compound has the effect of about 3.6 folds and about 3.7 folds relative to those in the corresponding racemic body also for the therapy of psoriasis. C Regarding the bioavailability (A) Water solubility Since the present amended invention comprising

	not only for oral administration but also for various dosage form, the present compound is superior in water solubility in comparison with those in the racemic body of the cited invention to a certain degree. Even if the water solubility affects the bioavailability for the oral administration, it cannot be said that this is an effect on which the present amended invention as a whole, encompassing the various dosage forms including the oral administration, exerts. (B) Bioavailability (Biological utilization rate) The present description does not state that it is superior in the bioavailability. In addition, since it has been known that the bioavailability for the oral administration is affected only by the solubility, and is largely affected by the metabolism within the biological body (Exhibit B6), it cannot be also said that it cannot be presumed that it is also superior in the bioavailability according to the statement of the present description that the present compound has a higher water solubility to a certain degree than those in the racemic body. D Regarding low emetic effect as side effect If it has been known prior to the priority date for the present application that the inhibitor for PDE4 has a main side effect of emetogenicity, it is naturally made by a person skilled in the art to confirm whether or not it has the side effect of emetogenicity, even though there is no statement focusing on the side effect of emetogenicity in the Citation 1. In addition, since the amount for anti-inflammation is introduced using the suppression of increasing neutrophile in bronchoalveolar as an index, it cannot be said that the amount for anti-inflammation as introduced herein is an amount for anti-inflammation effective for the therapy of psoriasis, even if it can be said in any event that the amount is amounts for anti-inflammation in chronic obstructive

	pulmonary disease, chronic inflammatory pulmonary disease and asthma. Hence, it cannot be said that the statement of the present description proves that the present compound does not create the side effect of emetic at the amount for administration effective for the therapy of psoriasis. In addition, it cannot be also said that the pharmaceutical composition for therapy of psoriasis comprising the present compound can remarkably reduce the incidence of the side effect, which goes beyond the expectation by a person skilled in the art, in comparison with a drug composition comprising the corresponding racemic body.

Judgment by the Court

(1) Regarding a standard for evaluating an effect of an optical isomer as a medicament

... it has been widely recognized prior to the priority date for the present application, that the pharmacological activity of the racemic body is necessarily 1/2 of those in the effective optical isomer due to the fact that other optical isomer competitively inhibits the one optical isomer having a pharmacological activity and that a reaction that the one optical isomer is converted in the biological body into the other optical isomer. There are several cases not only a case that one optical isomer does not affect on the pharmacological activity of the other optical isomer at all, but also a case that the activity of the other optical isomer may be affected because the pharmacological action of the other optical isomer is inhibited by presenting the one optical isomer, and because of the one optical isomer is exchanged into the other optical isomer having an activity in the biological body, and it can be sufficiently supposed that the activity of the racemic body may be largely different from 1/2 of those in the optical isomer.

Hence, even though the optical isomer can be easily conceived as a constituent, whether or not the inventive step is appreciated for the optical isomer based on that the pharmacological activity of the optical isomer is remarkable in comparison with those in the publicly-known racemic body should be explored whether the pharmacological activity of the optical isomer is unexpectedly remarkable for a person skilled in the art, in comprehensive consideration of the significance and the nature of the pharmacological activity in comparison with those in the racemic body for the optical isomer, of the difference in the pharmacological activities being originated from the biological body or in vitro, of the recognition by a person skilled in the art relating to the compound and other circumference. It is reasonable to construe that it should not be simply determined according to the constant standard that the pharmacological activity has 2 folds in comparison with those in the racemic body.

(2) Regarding the remarkability of the effect for the present compound

Upon keeping the aforementioned (1) in mind, the effect of the present compound is compared and examined with the effect of the compound of cited invention which is the racemic body, as follows.

A Inhibition activity to PDE4

According to the upper column of Table 1 in the present description, IC50 of the inhibition activity of PDE4 for the present compound is 73.5 nM, which is merely about 1.1 folds, in comparison with 81.8 nM, which is IC50 for the racemic body.

In addition, according to the lower column of Table 1 in the present description, while for the specificity ratio of PDE4 against PDE1, the compound of cited invention is higher than the present compound, for the specificity ratio of PDE4 against PDEs 2, 3, 5 and 6, the present compound is higher than the compound of cited invention. In addition, the Citation 1 states that the compound of formula I encompassing the compound of cited invention is used for inhibiting the undesired action of PDE4 (paragraphs [0038] and [0039] of Exhibit A2), and is effective for inhibiting PDE3 and PDE4 (paragraph [0014] of Exhibit A2). According to such a statement, a person skilled in the art can understand that the compound of cited invention is suitable especially for inhibiting PDE4. Therefore, to have a specificity of the present compound for PDE4 is an expectable effect from the statement of the Citation 1.

B Activity of elevating cAMP concentration

The Example 6 (assay of elevating cAMP) of the present description states that, in the assay of elevating cAMP concentration using human PBMC, EC50 for the present compound was 1.58 μM, indicating about 2 folds in the activity for the racemic body (3.09 μM), and in the assay using human neutrophile, EC50 for the present compound was 4570 nM, indicating about 2.8 folds in the activity for the racemic body (12589 nM).

However, ... it cannot be said to a length that it is readily an unexpected remarkable effect based on the reason that the present compound has about 2 folds and about 2.8 folds in the activity of elevating cAMP concentration. In addition, the assay of elevating cAMP in the Example 6 is of using PBMC which was isolated out of the biological body, and it is unclear whether or not the degree of elevating in the case of administering it within the biological body is the same. Accordingly, it is not enough to recognize to be an unexpected remarkable effect in the therapy for psoriasis based on the effect stated in the aforementioned Example 6.

The Plaintiff argues that while there is a correlation between the inhibition activity of PDE4 and the activity of elevating cAMP since cAMP concentration is elevated as the result of inhibiting PDE4, it is in an unexpectable range that the activity of elevating cAMP concentration is strong as about 2 folds and about 2.8 folds in comparison with those in the racemic body, even though the present compound has about 1.1 folds in the inhibition activity of PDE4 relative to those in the racemic body (Upper column of Table 1). However, even if it can be apparently understood to be a relationship that to be high in the inhibition activity of PDE4 is to be high in the activity of elevating cAMP concentration according to the mechanism of suppressing the degradation of cAMP by inhibiting PDE4, it cannot be believed to a length that there is no factor, within the cells, affecting on cAMP concentration except PDE4 (it can be understood, from the statement in the Example 6 in the present description that the activity of elevating cAMP concentration is varied on the type of cells in use, that there will be present, within the cells, except PDE4 as a factor affecting cAMP concentration). Accordingly, it is not reasonable that the degrees in the strengths of both activities are correlated to evaluate

these.

C Inhibition activity of producing LTB4

According to Table 2 in the present description, IC50 of the inhibition activity of producing LTB4 for the present compound is 2.48 nM, about 8.1 folds in the strength relative to those in the racemic body (20.1 nM). However, it is mentioned in the aforementioned (1) to be readily an unexpected remarkable effect, based on that the activity for the optical isomer has larger than 2 folds relative to those in the racemic body. In addition, since the aforementioned Table 2 is of using neutrophile which was isolated out of the biological body, it cannot be recognized to a length that the present compound has the remarkability which goes beyond the expectation in the effect of therapy for psoriasis from the statement of the inhibition activity of LTB4 in Table 2, in consideration that it is unclear whether or not the degree of the activity is the same in the case of administering it to the biological body (for example, Exhibit A5 states an example that the difference in the activities is only 1.4 folds within the biological body while (S) body has 160 folds in the activity relative to those in (R) body, out of the biological body.).

D Inhibition activity of producing TNF-α

The values of the inhibition activity of TNF-α for the present compound stated in the Example 3 in the present description were high to be about 1.5 folds in human whole blood, about 4 folds in another human whole blood, about 2.5 folds in human PBMC and about 20 folds in mouse serum, in comparison with the values for the racemic body stated in the Exhibit A23 report submitted by the Plaintiff (Exhibit A23). However, it is mentioned in the aforementioned (1) that it is readily an unexpected remarkable effect based on that the activity of the optical isomer is larger than 2 folds relative to those in the racemic body. In addition, even if it is strong in the activity to be about 1.5 to 4 folds in the human samples, the Example 3 in the present description and the Exhibit A23 report were obtained using blood, PBMC or serum which were isolated out of the biological body. Accordingly, in consideration that it is unclear whether or not the degree of the activity is the same in the case of administering it within the biological body, it cannot be recognized to a length that it is the remarkable effect which goes beyond the expectation for a person skilled in the art based thereon. In addition, while the value of the inhibition activity of TNF-α was about 20 folds in the strength in mouse serum, this regard is focused on keeping in mind that the pharmaceutical composition for therapy of psoriasis in the present amended invention is applied for human. Accordingly, since it cannot be said to a length that the effect in the human sample is remarkable as mentioned above, the determination for the inventive step for the present amended invention is not affected by that the effect in the mouse sample is somewhat high.

Therefore, it cannot be recognized to be the remarkability of the effect for the present compound based on the inhibition activity of producing TNF-α according to the assertion made by the Plaintiff.

E Inhibition action of producing IL-2 and IFN-γ

The values of the inhibition activity of producing IL-2 and the inhibition activity of producing IFN-γ for the present compound stated in the Example 6 of the present description were about 3.6 folds and about 3.7 folds, respectively, in comparison with the values for the racemic body stated in the Exhibit A23 report submitted by the Plaintiff (Exhibit A23). However, it can be sufficiently supposed that the activity of the optical isomer

is larger than 2 folds relative to those in the racemic body, as mentioned in the aforementioned (1). In addition, the inhibition activity of producing IL-2 and the inhibition activity of producing IFN-γ in the Example 6 of the present description were of using PBMC which was isolated out of the biological body. Accordingly, in consideration that it is unclear whether or not the degree in the activity in the case of administering it within the biological body is the same, it cannot be recognized to be unexpectedly remarkable in the effect of the therapy for psoriasis according to the aforementioned statement of the inhibition activity.

F Solubility

According to the Example 8 (water solubility) in the present description, the solubility for the aqueous buffer having pH 7.4 is 0.012 mg/mL for the present compound, about 3.5 folds relative to those in the racemic body (0.0034 mg/mL). However, it has been generally believed that when a solubility of a drug in a range of pH 1 to 7 is equal to or less than 1 mg/mL, it laregely affects on gastrointestinal absorption, that is, bioavailability (Exhibit B5). Accordingly, it is believed that the present compound and of course the racemic body were compounds having a disadvantage in gastrointestinal absorption, that is, bioavailability, based on the result of Example 8. It cannot be recognized that the present compound has a particularly remarkable effect in the solubility.

G Bioavailability

The Plaintiff submitted the Exhibit A23 report, indicated that the blood concentrate/ion of the present compound is higher than that in the racemic body in the oral and intravenous administration to rat and cynomolgus, and argued that the result of the bioavailability in the Exhibit A23 report should be considered in the determination of the inventive step for the present amended invention, since a person skilled in the art can recognize from the statement relating to the solubility in the present description that the present compound is superior in the bioavailability.

However, there is no statement relating to the bioavailability in the present description. In addition, the solubility of the present compound to the aqueous buffer stated in the Example 8 of the present description does not speculate to have high bioavailability, as mentioned in the aforementioned F. In addition, the blood concentration after the oral administration and the intravenous administration of the drug is largely affect not only on the solubility, but also the dosage form, and the action in the biological body, including absorption, degradation, excretion and metabolism. Accordingly, the result of the administration test for animals stated in the Exhibit A23 report cannot be inferred from the statement of the present description, and should not be considered in the determination of the inventive step for the present amended invention.

H Effect of therapy for psoriasis (result for the clinical test)

The Plaintiff has asserted that it was proved in the clinical test that the present compound has the superior physiological activity and bioavailability for psoriasis, upon submitting the evidences relating to the clinical test (Exhibits A24 to A28).

However, as mentioned in the aforementioned 1(4), it could be understood from the Citation 1 that the compound of cited invention has the therapeutical effect to the inflammatory diseases including psoriasis. In addition, any of the evidences do not prove that the present compound has a particular remarkable effect in the

therapy for psoriasis, in comparison with those in the compound of cited invention. Therefore, the evidences relating to the clinical test (Exhibits A24 to A28) does not affect in determining the inventive step for the present amended invention.

I Low emetic action as a side effect

The Example 8 (LPS-induced lung neutrophilia ferret model) of the present description states that ED50 in suppressing to increase neutrophile in bronchoalveolar upon orally administering the present compound and after exposing LPS with aerosol was 0.8 mg/kg, and threshold emetic dose was 10 mg/kg and therapeutic index was 12, which were estimated.

However, since it has been known prior to the priority date for the present application that the inhibitor of PDE4 has emetogenicity as the main side effect (Exhibit A30), it is speculated that a person skilled in the art who understood from the statement of the Citation 1 that the compound of cited invention can be used as a medicament having the inhibition activity of PDE4 will examine the presence or absence of emetogenicity upon evaluating its optical isomer. In addition, there is no evidence that it can be sufficiently recognized that the present compound has a reduced emetogenicity which goes beyond the expectation for a person skilled in the art, in comparison with the racemic body. Therefore, the reduction of emetogenicity does not support the inventive step for the present amended invention.

(3) Summary

As mentioned in the aforementioned (2), it cannot be recognized to a length that any of the effects of the present amended invention, which are figured out from the present description, are a particularly remarkable going beyond a range which can be expected for a person skilled in the art in comparison with the cited invention. In addition, even though three aspects of the pharmacological action, the bioavailability and the low side effect are comprehensively evaluated, it is not enough to appreciate the inventive step, in consideration that the present compound is of being merely introduced from the result of selecting (+)isomer from the two optical isomers for the compound of cited invention, according to the technical general knowledge, at the time of the priority date for the present application, that the racemic body is separated into its optical isomers each pharmacological action and the like are examined and the suitable one for the purpose are selected.

(46)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	Drive circuit" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, July 19, 2007 (2006 (Gyo KE) No. 10488)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2002-310091 (JP 2004-147435A)
Classification	H02M 3/155
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge Nobuyoshi TANAKA, Judge Yuji KOGA, Judge Ken ASAI

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention provides a drive circuit having a light adjusting function of light-emitting elements such as a LED (Light Emitting Diode) in a PWM (Pulse Width Modulation) method. Under the objective of the present invention that the influence of the changes in temperature or power supply voltage and the element variations can be restrained in order to output a pulse current with a constant level, the drive circuit, for a first transistor for turning on or off a drive current to light-emitting elements, controls to turn on or off the first transistor based on a driving pulse signal when a current is supplied to the light-emitting elements, and turns off the first transistor when a current is not supplied to the light-emitting elements.

(2) State of the art

(i) Citation (Cited invention): International Publication No. WO 2001/45470 (Determination of Court Decision)

"It could recognize that ...the LED lamp device disclosed in the citation has the problem that when using the commercial alternating-current power supply as the power supply for the LED lamp, the power input for a time period in which a voltage is higher than or equal to a constant voltage wastes, and results in high loss only by directly connecting a rectified wave of an alternating-current voltage (full-wave rectification) to the LED. Then it could

recognize that the LED lamp device is capable of emitting light to the LED in low loss by supplying power for only part of a time period in which the voltage is higher than or equal to a constant voltage, even when using the commercial alternating-current power supply"

"the LED lamp device disclosed in the citation, ...the current supplied to the LED lamp 106 is controlled to flow constant current by the switching control circuit 322, for example by supplying a constant power to the LED lamp 106 for only part of a time period in which the voltage is higher than or equal to 40 V of the wave of the fully rectified wave obtained from the commercial alternating-current power supply" (Cited from the Court Decision)

(ii) Well-known art

"...a means for adjusting the strength of light using a PWM light adjusting technique, that is, Pulse Width Modulation ..." (Cited from the Court Decision)

(3) The Claims (Amended) (The present invention)

[Claim 1] A drive circuit for supplying power to light-emitting elements driven in a manner of PWM light adjusting comprising:

a first transistor as a switching element of a switching power supply having a output terminal coupled to light-emitting elements;

a detecting circuit for detecting current flowing in the light-emitting elements;

an error signal generating circuit for comparing the detection signal supplied from the detecting circuit with a reference signal and generating an error signal corresponding to the comparison result;

a comparing circuit for generating a driving pulse signal to control to turn on or off the first transistor based on the error signal and a cyclic signal,

the first transistor is controlled to turn on or off based on the driving pulse signal when a current is supplied to the light-emitting elements, and the first transistor is off when a current is not supplied to the light-emitting elements.

(4) Procedural History

January 17, 2005	:	Filing of Claim Amendments (see the above "The Claims")
March 17, 2005	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2005-4644)
September 13, 2006	:	The Appeal Decision to "Dismiss the appeal"

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

Appeal Decision (Cited from the Court Decision)
...since the present invention would have been obvious for a person skilled in the art based on ..."the citation", the invention disclosed in ..., the well-known art and the common technical matters. Thus, the present invention should be unpatentable under Article 29(2). The appeal decision recognized the differences ...between the present invention and the cited invention as follows ...in deriving the above conclusion.

(3) Differences

The present invention relates to the drive circuit for supplying power to the light-emitting elements "driven in a manner of the PWM light adjusting", and "the first transistor is controlled to turn on or off based on the driving pulse signal when a current is supplied to the light-emitting elements, and the first transistor is off when a current is not supplied to the light-emitting elements". On the other hand, for the cited invention, the citation does not disclose such PWM light adjusting drive to the light-emitting elements, and the operation of the PWM light adjusting drive and the switching element 316 is unclear.

"It could not be said that ... it has the particular difficulty for enabling the PWM light adjusting drive for the LED lamp 106." ...

Decision

Allegations by Plaintiff	Allegations by Defendant
...the cited invention, the feedback (negative feedback) control is performed such that the current flowing in the LED lamp 106 is constant, and the power supply unit of the cited invention controls to turn on or off the switching element 316 such that the energizing current of the LED lamp 106 is constant when the AC input voltage is higher than or equal 40V. By applying the PWM light adjusting drive for turning on or off the energization of the LED lamp 106 to the cited invention having the above technique in the case where the LED lamp 106 is not energized, that is, the current flowing in the LED lamp 106 is zero, the switching control circuit 322 operates to increase the current supplied to the LED lamp 106 by controlling the current flowing in the LED lamp 106 described above to be constant. Thus, although the current does not need to be supplied in the LED lamp 106, the power is supplied, thereby the power supply unit itself is to be destroyed. Since the PWM light adjusting drive is adopted in the cited invention, the above disadvantage occurs. Therefore, the appeal decision is erroneous in determining that "enabling the PWM light adjusting drive for the LED lamp 106 does not have the particular difficulty".	...the power supply unit of the cited invention switches from a current feedback control to a voltage feedback control, and the switching control circuit 322 is controlled to limit the output voltage, when the LED lamp 106 and the power supply unit are not connected. Thus there is no risk of destruction of the power supply unit as alleged by the plaintiff even if adopting the PWM light adjusting drive in the cited invention. Therefore, the allegations of the plaintiff are inappropriate stating that the power supply unit itself is to be destroyed by applying the PWM light adjusting drive to the cited invention.

Judgment by the Court

There is no dispute between the parties that the means for adjusting the strength of light using ...the PWM light adjusting technique ...itself is well-known art. The present invention has the objective for adjusting the variation of the amount of light emitted by changing the pulse current of the LED lamp due to long-time lighting and so on (paragraphs 0008 to 0011 of the specification of the present application), and there should not be necessarily the general motivation. However, in order to determine whether or not it is easy for a person skilled in the art to apply the PWM light adjusting technique to the cited invention, it would be necessary to discuss the technical difficulty described below, and it could not determine that only based on the motivation.

...the LED lamp device of the citation is to supply the constant power to the LED lamp 106 ...for only part of a time period in which the voltage is higher than or equal to 40 V of the wave of the fully rectified wave obtained from the commercial alternating-current power supply . Also, the current to be supplied to the LED lamp 106 is controlled to be the constant current by the switching control circuit 322. On the other hand, the PWM light adjusting technique is to turn on or off the current to be supplied to the light-emitting elements in a constant cycle, it could not be directly applied to the LED lamp device of the citation.

...it could not be necessarily said that it is adequately persuasive to confirm the technical explanation pertaining "the destruction of the power supply" and so on alleged by the plaintiff on the grounds that it is difficult for a person skilled in the art to apply the PWM light adjusting technique to the cited invention. However, it is possible to goodly interpret the above means that, since the LED lamp of the cited invention is controlled such that the flowing current is constant while the PWM light adjusting drive adopted by the present invention controls to turn on or off the current flowing in the LED, the plaintiff points out the obstructive factor for the both inventions to accord with the controlling method. Therefore, even if it does not reach to "the destruction of the power supply" alleged by the plaintiff, the appeal decision is erroneous in determining that there would be no difficulty for a person skilled in the art to apply the PWM light adjusting technique to the cited invention without the adequate discussion pertaining the obstructive matters for applying the PWM light adjusting technique to the cited invention.

From the above, even if there is a general demand for adjusting the light-emitting strength and the PWM light adjusting technique was well-known as means for adjusting, there are obstructive matters for applying the PWM light adjusting technique to the LED lamp device of the second or third embodiment of the citation, and there is little motivation for applying the PWM light adjusting technique to the cited invention for a person skilled in the art who contacts the description of the citation. Therefore, it could not be said that the configuration relating to the differences can be easily conceived.

(46)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	"Detergent composition" (Trial for Invalidation) Intellectual Property High Court Decision, November 10, 2010 (2010 (Gyo KE) No. 10104)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-194727 (JP H9-221697A)
Classification	C11D 7/60
Conclusion	Acceptance
Related Provision	Article 29(2) and Article 123(1)(ii)
Judges	IP High Court Fourth Division, Presiding judge: Takaomi TAKIZAWA, Judge: Tomonari HONDA, Judge: Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide a detergent which is superior in the washing effect and has good biodegradability, in use for process washing in food industry and for washing a hard surface in various industrial processes, and relates to a detergent for hard surface containing sodium hydroxide, aspartic acid diacetates and/or glutamic acid diacetates, and sodium glycolate as main component.

(2) State of the Art

(i) Citation 1 (Cited Invention 1): JPS50-3979A

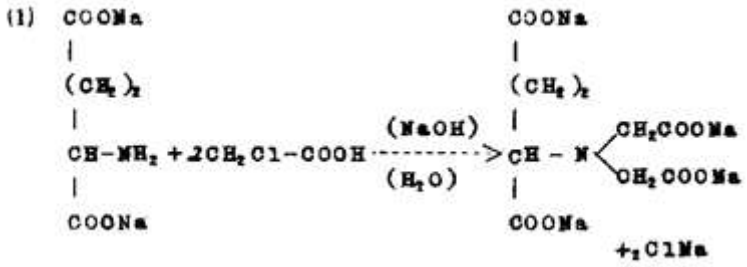
"A The Cited Invention 1 relates to a metal ion sealing agent composition containing 60 weight% of "sodium salt of N,N-bis(carboxymethyl)glutamic acid" and 12 weight% of "sodium glycolate" produced by a secondary reaction ...

B ...

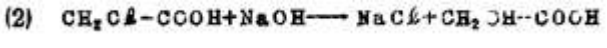
...the metal ion sealing agent composition containing a derivative of N,N-dicarboxymethyl amino acid ...is manufactured by reacting monochloroacetic acid and disodium salt of amino dicarboxylic acid in an alkaline

aqueous medium to bind carboxymethyl group to nitrogen atom of the amino group of the amino dicarboxylic acid. ...The reaction according to the present invention is a substitution reaction in the alkaline aqueous medium, and is indicated as the next formula [see reaction formula (1)] ... One of substantial causes that it is difficult to obtain a derivative in which amino group of the amino dicarboxylic acid is substituted with two carboxymethyl groups with high yield is that monochloroacetic acid is hydrolyzed. That is, sodium glycolate is produced by this secondary reaction [see reaction formula (2)]. Therefore, in order to prevent this defect, it is necessary to perform the above-mentioned substitution reaction and to gradually only add the alkaline compound under the presence of a free monochloroacetic acid such that the reaction of formula (1) is performed and the reaction of formula (2) is prevented ..." (cited from the Court Decision. The following reaction formula is cited from JP S50-3979A)

Reaction formula (1)



Reaction formula (2)



(Irreversible reaction) Glycolic acid

(ii) Citation 2 (Cited Invention 2): DE4240695A1 (published on June 9, 1994)

"...the Cited Invention 2 relates to ... aqueous alkaline detergent composition, and ...is the aqueous alkaline detergent composition in which 2 to 50 weight% of hydroxide of alkali metal such as sodium hydroxide is compounded and ...glutamic acid-N,N-diacetatic acid is contained and is a technique of containing sodium hydroxide as a component ..." (cited from the Court Decision)

(iii) Each content of well-known examples 1 to 3

"The well-known examples 1 to 3 state a technique in which a detergent composition containing a metal ion sealing agent is used as an active component for washing the hard surface ..." (cited from the Court Decision)

(iv) Difference 2 between the Present Invention 1 and the Cited Invention 1

"while the Present Invention 1 contains sodium hydroxide and is specified as "content of sodium hydroxide being 0.1 to 40 weight% of the composition", the Cited Invention 1 is not specified as containing sodium hydroxide" (cited from the Court Decision)

(3) The Claims (corrected) ("Present Invention 1" and "Present Invention 2", in this order)

[Claim 1] A detergent composition containing sodium hydroxide, aspartic acid diacetates and/or glutamic acid diacetates, and sodium glycolate and the content of sodium hydroxide being 0.1 to 40 weight% of the composition.

[Claim 2] The detergent composition according to claim 1, containing 5 to 30 weight% of sodium hydroxide, 1 to 20 weight% of aspartic acid diacetates and/or glutamic acid diacetates and 0.1 to 0.3 weight parts of sodium

glycolate relative to 1 weight part of aspartic acid diacetates and/or glutamic acid diacetates.

(4) Procedural History

July 13, 2009	:	Request for Trial for patent Invalidation made by the Defendant (Muko No. 2009-800152)
October 5, 2009	:	Request for Correction made by the Plaintiff (Patentee) (Present Correction) (see "The Claims" as mentioned above)
March 2, 2010	:	The Trial Decision that the Present Correction is upheld and the Present Patent is invalid

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">The Present Trial Decision has determined that ...the Present Correction is upheld, and the Present Invention should be invalid under the provision of Article 123(1)(ii) of the Patent Act ..., since the Present Invention could be easily conceivable for a person skilled in the art based on ..."the Cited Invention 1" and "the Cited Invention 2", ...and the well-known art stated in the well-known examples 1 to 3 and the like ...
...concerning the Difference 2, it has been determined to be a well-known technique that to contain sodium hydroxide as its component in the detergent composition containing a metal ion sealing agent ...in use for washing the hard surface ..., based on the Citation 2 and the well-known examples 1 to 3.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) To contain sodium hydroxide
To specify "content of sodium hydroxide being 0.1 to 40 weight% of the composition" in the Present Invention 1 means that the composition is placed in a highly alkalic condition by adding "sodium hydroxide" to "...glutamic acid diacetates" and "sodium glycolate".
On the other hand, there is no description in the Citation 1 to contain sodium hydroxide, and the Citation 1 is of adjusting the experimental system into weak alkali of 8 to 11 in pH.
(2) Relationship with the Citation 2 and the like
The Citation 2 and the well-known examples 1 to 3 are documents in which to add sodium hydroxide is described among the documents which try to use ...the</td><td>Allegations by Defendant
(1) To contain sodium hydroxide
The Plaintiff has asserted that there is a technical significance for the highly alkalic condition.
However, the alkaline agent is only used to have 5 wt% in concentration of sodium hydroxide in the Example and the Comparative Example ... Therefore, the difference of the effect on between the condition of pH 11 or higher (around 0.1 weight% of sodium hydroxide) and the condition of pH 11 or lower is unclear, and any technical advantages of the highly alkalic condition against the weak alkali condition (pH 11 or lower) have not been argued and proved.</td></tr>
</table>

metal ion sealing agent ...which does not cause any environmental problems, is not of disclosing the well-known art which can generalize the use of sodium hydroxide.	

Judgment by the Court

... the metal ion sealing agent composition of the Cited Invention 1 consists of ..." N,N-bis(carboxymethyl) glutamic acid sodium salt" and ..."sodium glycolate", it is necessary to cause the reaction (1) and not to cause the reaction (2), since sodium glycolate is produced by the "secondary reaction" represented by the reaction formula (2) as one of causes that it is difficult to obtain N,N-bis(carboxymethyl) glutamic acid (represented by the reaction formula (1)) with high yield ... Accordingly, in the metal ion sealing agent composition of the Cited Invention 1, the compositon "N,N-bis(carboxymethyl) glutamic acid sodium salt" is an indispensable component, but "sodium glutamic acid" which is a composition of the aformentioned component is not only necessary to exert the effect of the metal ion sealing agent but also is one of causes in which " N,N-bis(carboxymethyl) glutamic acid sodium salt " as the indispensable component cannot be produced with high yield. So, it can be said that the Cited Invention 1 is an invention of a metal ion sealing agent composition exclusively exerting the metal ion sealing action by "N,N-bis(carboxymethyl) glutamic acid sodium salt".

...it can be said that the Cited Invention 2 is an invention using alkali such as ...sodium hydroxide and a complex forming agent as active components for washing the hard surface.

(4) Concerning the Present Invention

... Example 6 corresponds to the detergent composition of the Present Invention, on the other hand, Comparative Example 3 contains the equivalent amount of sodium hydroxide and glutamic acid diacetate tetrasodium to those in Example 6, but does not contain sodium glycolate ...

...it can be said that the detergent composition of Example 6 provides the working-effect that the effect for washing is significantly increased by compounding at least sodium glycolate, it should be said that the detergent composition according to the Present Invention is an invention containing sodium glycolate as an indispensable component in the composition.

(5) Applying the Cited Invention 2, etc to the Cited Invention 1

.. the Cited Invention 1 is the metal ion sealing agent composition containing N,N-bis(carboxymethyl) glutamic acid sodium salt as one in the component, this ...sodium salt is a common component to glutamic acid-N,N-diacetate ...in the Cited Invention 2.

...in consideration of the Cited Invention 1 and the Cited Invention 2 and their technical filed, since it can be said that it is the well-known art that the detergent composition containing the metal ion sealing agent is used as an active component for washing the hard surface, it can be said that the Cited Invention 1 is also an invention relating to the technical field of the washing action and belongs to the same technical field to the Cited Invention 2.

...the Cited Invention 2 is not an invention of the metal ion sealing agent composition containing sodium glycolate. In addition, in the Cited Invention 1, ,the invention of the metal ion sealing agent composition

contains, sodium glycolate, however sodium glycolate is not indispensable in the metal ion sealing agent composition, rather unnecessary in the composition.

Hence, it could be easily conceivable for a person skilled in the art when a detergent composition containing a metal ion sealing agent is used as an active component for washing the hard surface and, the Cited Invention 2 is combined with the Cited Invention 1 and sodium hydroxide is added to the metal ion sealing agent of the Cited Invention 1. However, it should be said that there is an inhibitory factor in that to add sodium hydroxide to the metal ion sealing agent composition including sodium glycolate, not an indispensable component,, since it is necessary not to cause the reaction of the reaction formula (2) which produces sodium glycolate in the Citation 1. It should be said that there is no motivation in the first place to combine the Cited Invention 2 with the Cited Invention 1 as long as the inhibitory factor is removed, and it cannot be said that this combination is easily conceivable for a person skilled in the art.

(46)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

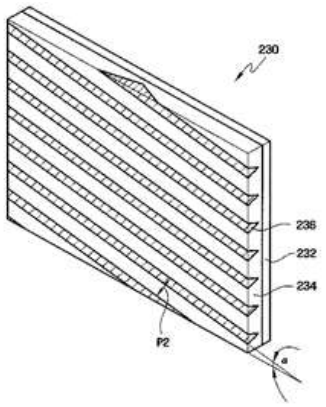
Case	"Outside light shielding layer, filter for display apparatus including the same, and display apparatus including the same" (Appeal against an Examiner's Decision)□Intellectual Property High Court Decision, Dec. 6, 2011 (2011 (Gyo KE) No. 10092)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2006-129227 (JP 2006-313360A)
Classification	G09F 9/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding judge: Shuhei SHIODSUKI, Judge: Kenziro HURUTANI, Judge: Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is of an outside light shielding layer that can improve a contrast ratio in a bright-room condition to prevent a moire phenomenon, the outside light shielding layer including a base material 232 made up of a transparent resin material and light shielding patterns 236 formed on one surface of the base material 232 in a manner being separated from each other at a predetermined interval, wherein a bias angle α between the traveling direction of the light shielding pattern 236 and the long side of the base material 232 is 5 degrees to 80 degrees.

[Fig. 3]



(2) State of the art

(i) Printed publication 1 (cited invention 1): JP 2001-034183A (finding of the appeal decision)

"A filter plate 20 disposed in front of a display surface of a plasma display panel including a plurality of pixels

adjacent to each other at a pitch Q in a vertical direction, the filter plate 20 comprising:

a filter substrate 6; and

a plurality of black light shielding bodies 1 of an eaves shape, the light shielding bodies 1 being formed on one surface of the filter substrate 6, being arranged along a vertical direction at a predetermined pitch S in parallel with each other, extending in a horizontal direction in a straight line manner, and forming a stripe structure,

wherein the light shielding bodies are arranged such that a condition

Q/S = n + 1/2 (n is a positive integer)

is held between the pixel pitch Q of the plurality of pixels and the vertical pitch S of the light shielding bodies in the vertical direction, and

wherein the filter plate 20

has a function to block incident light from outside the panel; that is, illumination light and natural light, to improve bright-room contrast of a display image while a moire pattern is almost prevented from being viewed and an aperture ratio and transmissivity change depending on the width of the light shielding body." (extracted from the decision)

(ii) Printed publication 2 (cited invention 2): JP S59-104602A (finding of the appeal decision)

"A light shielding layer of a light shielding plate that can transmit horizontal incident light and block light coming from an oblique direction, and, when applied to the front face of a CRT and a display for outdoor use in particular, allows contrast of an image to be improved, the light shielding layer including:

a transparent plastic substrate of various kinds such as acrylic resin and the like,

grooves formed on one surface of the substrate at equal intervals in parallel with each other, the grooves being filled by black ink or paint and dried,

wherein a face of the filled-and-dried member in the side exposing outside the groove is exposed outside the transparent plastic substrate,

wherein a width of the groove is 50 μm to 150 μm, preferably 70 μm to 100 μm, in view of securing transmission efficiency of the light shielding plate for horizontal incident light and of securing a light shielding effect due to filling a composition having a light shielding property, and

wherein a pitch of the grooves; that is, a total of an clearance between grooves and a width of a groove, is 100 μm to 1000 μm depending on a depth of the grooves, preferably 200 μm to 500 μm."

(3) The Claims (claimed invention)

[Claim 1]

A filter for a display apparatus, comprising:

a filter base including an electromagnetic wave shielding layer of a conductive mesh type; and

an outside light shielding layer formed on one surface of the filter base, the outside light shielding layer including: a base material of a transparent resin material; and a light shielding pattern made by forming a plurality of grooves on one surface of the base material at a constant period in a manner separated from each other, and by filling a black material inside each of the plurality of grooves, and the outside light shielding layer having a

proportion of an area occupied by the light shielding pattern to the one surface of the base material of 20% to 50%, wherein a bias angle α between a traveling direction of the light shielding pattern and a long side of the base material is 5 to 80 degrees,

wherein, in the bias angle α and a bias angle β between an extended line of the conductive mesh and the long side of the base material, a bias angle difference (β - α) is 5 to 40 degrees or 50 to 75 degrees.

(4) Procedural History

May 8, 2006	:	Patent application (date of claim of priority: May 4, 2005, Korea)
Aug. 8, 2007	:	Decision of refusal
Nov. 12, 2007	:	Request for Appeals against an Examiner's Decision of Refusal (Objection No. 2007-30646) Amendment (refer to the above-mentioned "The Claims")
Nov. 1, 2010	:	Appeal decision that said that the above-mentioned amendment is dismissed, and "the present demand for appeal will not stand."

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

Appeal decision
"About (difference 1) Both the cited invention 1 and the cited invention 2 are inventions pertinent to a filter and a light shielding plate provided with a light shielding layer arranged on the front face of a display for the purpose of contrast improvement, and are inventions belonging to an identical technical field. In addition, a light shielding body of an eaves shape included in the cited invention 1 corresponds to "eaves" disclosed in the printed publication 2 as a related art ..., and the cited invention 2 is an invention that has been made in view of a weak point that "eaves" have. Therefore, it is found that to combine the cited invention 2 with the cited invention 1; that is, instead of a light shielding body of an eaves shape formed on one face of a transparent substrate of the cited invention 1, to adopt one made by forming a plurality of grooves on a surface of a transparent plastic substrate of various kinds such as acrylic resin at a constant period in a manner separated from each other and filling and drying black ink or paint to make it a matter specifying the invention relating to the above-mentioned (difference 1) (A) could be easily arrived at by a person skilled in the art. Then, on this occasion, it is found that to what extent a proportion of an area occupied by the light shielding pattern to the one face of the base material should be made is, as stated in the printed publication 2, a design matter set by a person skilled in the art accordingly from the point of view of a transmission efficiency of horizontal incident light and a light shielding effect (for example, in the cited invention 2, a desirable range of the width of the groove is 70 μm to 100 μm, and a desirable range of the pitch of the grooves is 200 μm to 500 μm, and, therefore, a proportion of an area occupied by the light shielding pattern to the one face of the base material becomes 24% (= 85 μm /350 μm) when it is calculated using the intermediate value of each range, with the calculated value being included in the range of 20 to 50% of the claimed invention.). Accordingly, it is not

found that there is difficulty in making it be a matter specifying the invention concerning the above-mentioned (difference 1) (B)." (extracted from the decision)

Decision

Allegations by Plaintiff

The cited invention 2 is an invention having a constitution in which, in order to solve space-related problems, parallel grooves are formed on one surface of a transparent plastic substrate at a constant interval, and black ink or the like is filled in those grooves, and reflection light at the substrate surface cannot be absorbed.

As a consequence, there is a difference between the constitution of a filter plate having a light shielding body of the cited invention 1 and the constitution of a light shielding plate of the cited invention 2, and there is also a difference in whether it is an invention to solve space-related problems or not, and, further, the light shielding plate of the cited invention 2 is inferior to the filter plate having the light shielding body of the cited invention 1 in a function to block incident light from the upper side. Therefore, there is no motivation to combine the cited invention 1 and the cited invention 2, or there is an obstructive factor to combination them.

Allegations by Defendant

The cited invention 1 and the cited invention 2 are inventions that have an objective to improve contrast of a display, and relate to a filter and a light shielding plate including a light shielding layer in front of the face of a display and, and, thus, they belong to an identical technical field. In addition, the cited invention 2 is an invention made in view of a weak point of a light shielding body of an eaves shape that is a related art. As a consequence, there is motivation to combine the cited invention 1 with the cited invention 2.

Meanwhile, as functions and properties required for a light shielding filter in front of a display, not only blocking light coming from the upper side, but also durability and the like are required, and the configuration of the light shielding filter is determined also in view of the size of the filter, easiness in manufacturing, and a manufacturing cost and the like. As a consequence, even though performance to block incident light from the upper side is degraded to some degree, if other functions and the like are improved, it does not lack motivation to change the configuration by combining the cited invention 2.

Therefore, there is no error in the determination of the appeal decision as to an easily-arrived property of the configuration concerning the difference 1.

Judgment by the Court

... The plaintiff alleges that, because a light shielding plate of the cited invention 2 is inferior to a filter plate with a light shielding body of the cited invention 1 in a function to block incident light from the upper side, there is no motivation to combine the cited invention 1 and the cited invention 2, or there is an obstructive factor to combine those. Definitely, the light shielding plate of the printed publication 2 is a plate adopting a configuration of a light shielding body of a groove shape, and it is conceivable that an effect to shield

circumstance light coming from a diagonally upper direction is slightly small compared with the filter of the bcited invention 1 adopting a configuration of the light shielding body of an eaves shape overhanging to the outside. However, even though there is a disadvantage that a light shielding performance against circumstance light incident from a diagonally top direction is degraded under a bright-room condition, if advantages due to adopting the configuration of the cited invention 2 surpass the disadvantage, motivation to combine the cited invention 2 with the cited invention 1 does not lack in a person skilled in the art. On the other hand, in the paragraph [0038] of the printed publication 1, there is a statement that "in addition to a function to absorb outside light, mechanical strength is required in the light shielding body 1.", and, in the configuration of the cited invention 2 in which a coloring agent is filled in fine grooves, there is an advantage, compared with the configuration of the light shielding body of an eaves shape of the cited invention 1, that it is possible to supplement the mechanical strength of a light shielding plate by the strength of the substrate itself. In addition, as has been described above, the cited invention 2 has an advantage of solving a space-related problem that is the disadvantage of the light shielding body of an eaves shape and of making it possible to make the thickness of a light shielding plate small. Therefore, it cannot be said that the advantages due to combining the cited invention 2 with the cited invention 1 are small for a person skilled in the art, and the advantages do not fall below the disadvantage caused by the combination. As a consequence, it can be said that, even if there is a lack of motivation to combine the cited invention 2 with the cited invention 1 for a person skilled in the art, it cannot be said that slight decline of a light shielding performance against circumstance light from a diagonally top direction is an obstructive factor to combine the two above-mentioned inventions, and, thus, the above-mentioned allegation by the plaintiff cannot be adopted.□

(46)-4

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	"Heavy metal fixing reatment agent" (Trial for Invalidation) Intellectual Property High Court Decision, December 22, 2011 (2010 (Gyo KE) No. 10097)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H7-313845 (JP H8-224560A)
Classification	B09B 3/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Yasuhito INOUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention has an technical idea that piperazine-N-carbodithioic acid or piperazine-N,N'-biscarbodithioic acid (Present Compound) can fix a heavy metal in fly ash, and relates to a heavy metal fixing treatment agent in fly ash, comprising the Present Compound.

(2) State of the Art

(i) Citation 1 (Cited Invention 1): JP H3-231921A (Identification of Trial Decision)

"a metal scavenger used for fixing a heavy metal in fly ash, comprising a polyamine derivative containing at least one of a dithiocarboxy group: -CSSH or its salt as the N-substituting group in which an active hydrogen bounded to nitrogen atom of a polyamine molecule having 500 or less in molecular weight and having primary amine and/or secondary amine is substituted,

a polyethyleneimine derivative containing at least one dithiocarboxy group: -CSSH or its salt as the N-substituting group in which an active hydrogen bounded to nitrogen atom of a polyamine molecule having 5000 or more in average molecular weight and having primary amine and/or secondary amine is substituted." (cited from the Court Decision)

(3) The Claims (Claim 6 is only described) (Present Invention 6)

[Claim 6] A heavy metal fixing treatment agent in fly ash comprising one of piperazine-N-carbodithioic acid or piperazine-N,N'-biscarbodithioic acid or mixture thereof or these salts thereof.

(4) Procedural History

December 1, 1995	:	Patent Application by a Defendant (Patentee) (Priority date: December 2, 1994)
January 24, 2003	:	Registration of establishment of the patent right (see "The Claims" as mentioned above)
June 11, 2008	:	Request for Trial for Invalidation by the Plaintiff (Muko No. 2008-800106)
February 26, 2010	:	Trial Decision that "the request for the Present Trial is dismissed"

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">(1) The reason stated in the Present Trial Decision is that ...(iv) since the invention is not easily made based on the Cited Invention 1 ..., the Present Invention could not be invalidated.
(2) The Coincidence and the Differences 1 and 2 between the Present Invention 6 and the Cited Invention 1 ..., which has been identified in the Present Trial Decision are as follows.
B Coincidence: A heavy metal fixing treatment agent in fly ash, comprising carbodithioic acid or its salt of polyamine
C Difference 1: In the Present Invention 6, carbodithioic acid or its salt of polyamine is "piperazine-N-carbodithioic acid or piperazine-N,N'-biscarbodithioic acid or mixture thereof or these salts thereof, while in the Cited Invention 1, a polyamine derivative containing at least one dithiocarboxy group or its salt as the N-substituting group in which an active hydrogen bounded to nitrogen atom of a polyamine molecule having 500 or less in molecular weight and having primary amine and/or secondary amine is substituted.
D Difference 2: the heavy metal fixing treatment agent in fly ash in the Present Invention 6 comprises one of <u>piperazine-N-carbodithioic acid or piperazine-N,N'-biscarbodithioic acid</u> or mixture thereof or these salts thereof, while the metal scavenger used for fixing heavy metal in fly ash in the Cited Invention 1 comprises <u>the polyamine derivative, ...the polyethyleneimine derivative</u>.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(2) ...there is an error in the Trial Decision that inventive step is determined from a view whether or not the result of stability test described in the present specification can be presumed without determining whether or not the arrangement of the Differences 1 and 2 could be easily conceivable.</td><td>Allegations by Defendant
(1) The Citation 1 does not describe and suggest that the Present Compound is used as an indispensable active ingredient for the heavy metal fixing treatment agent in fly ash to provide working-effects of high in fixing the heavy metal and thermally stable ...</td></tr>
</table>

Rather, considering the Difference 1, ...it is publicly-known general rule that dithiocarbamate derived from secondary amine generates carbon bisulfide by heating or degrading with the addition of acids, not generates hydrogen sulfide. Accordingly, focusing on the heating, to select piperazine could be easily conceivable for a person skilled in the art. In addition, secondary amines not containing a primary amino group among the polyamine stated in the Citation 1 is only piperazine. Therefore, a person skilled in the art could be easily conceivable that piperazine is selected as the polyamine described in the Citation 1 for preventing generation of hydrogen sulfide. (3) ...since it had been obvious that a polyamine derivative having a dithiocarboxy group with pyperazine skeleton as the functional group can be used alone for the metal scavenger in fly ash, it is extremely conceivable to arrange the heavy metal fixing treatment agent by using a polyamine derivative as active ingredient among the polyamine derivative and the polyethylene imine derivative in the cited invention 1.	(2) Considering the Difference 1, ...it had been perceived that the metal complex derived from pyperazine is inferior in heat resistance (Exhibit A41 and Exhibit A52), and it had been pointed out that it is gradually degraded at neutrality or lower (Exhibit A14), has large decomposition rate constant than those of other secondary amine derivatives (Exhibit A7), and is instable for heat and inexpedience for large scale precipitation (Exhibit A70 and Exhibit B11). Accordingly, there is an inhibitory factor for a person skilled in the art to focus on the pyperazine among the matters of the Citation 1. (3) Considering the Difference 2, ... Rather, in the Cited Invention 1, polyethylene imine derivatives are added for improving the metal scavenger comprising the polyamine derivative. What the polyethylene imine derivative is excluded therefrom to arrange the polyamine derivative alone makes it worse, and could not be easily conceived of by a person skilled in the art based on the description of the Citation 1.

Judgement by the Court

(1) Concerning the Difference 1

...the Citation 1 does not describe and suggest to apply the configuration of the Difference 1 in the Present Invention 6 as the heavy metal fixing treatment agent in fly ash (to select each of the Present Compounds), and the Present Invention has a remarkable working effect of the heavy metal fixing property, which cannot be expected by a person skilled in the art.

(2) Concerning the Difference 2

...the Cited Invention 1 solves the problem that heavy metals including especially chrome (III) in the fly ash do not have enough fixing property when the polyamine derivative having a dithiocarboxy group as the functional group is used alone for the metal scavenger, by means of preparing a mixture of the Present polyamine derivative having ethylene diamine and the like as its skeleton with the Present polyethylene imine derivative as polymer molecules.

Therefore, the configuration of the Difference 2 in the Cited Invention 1 is an indispensable to the Cited Invention 1. Not only does the Citation 1 describe and suggest to exclude the configuration of the Difference

2 from the Cited Invention 1 but also the fixing property for the heavy metal such as chrome (III) and the like becomes insufficient for the problem solving when such configuration is excluded. Accordingly, there is an inhibitory factor to conceive of a metal scavenger in fly ash having such configuration based on the Citation 1.

Therefore, it should be said that a person skilled in the art who reads the Citation 1 could not be easily conceived of the configuration of the Difference 2 in the Present Invention 6.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

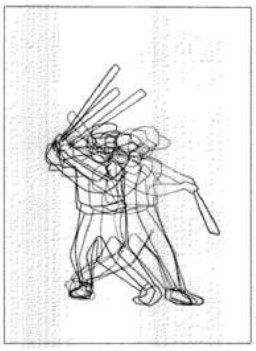
1. Bibliographic Items

Case	"An information processing apparatus including an input system using a stroboscope" (appeal against an examiner's decision) Intellectual Property High Court Decision, Jul. 17, 2012 (2011 (Gyo KE) No. 10098)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2002-346052 (JP 2004-085524A)
Classification	G01B 11/00
Conclusion	Admitted
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Toshihumi SHIBATA, Judge: Takeshi OKAMOTO, Judge: Eiko TAKEMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

[Fig. 11]



In a golf game system (10), a game console (12) that is an information processing apparatus and an input device (14) of a golf club shape are included, an image taking unit (28) is housed inside a housing (16) of the game console, and the image taking unit includes an image sensor (40) and an infrared-emitting diode (42). By the infrared-emitting diode, infrared light is intermittently irradiated to a predetermined range of the upper side of the image taking unit, and, therefore, the image sensor photographs a reflector included in the golf-club-shaped input device moving within the range intermittently. By processing such strobe images of the reflector, a speed and the like to be input of the game console are calculated. According to the claimed invention, it is possible to give input to a computer and a game console in real time using a stroboscope.

(2) State of the art

(i) Printed publication 1 (the invention stated in the printed publication 1): JP H4-241885A (finding of the appeal decision)

"A control means for a golf game simulator to make a CPU 3 perform image processing of image data photographed in a multiple and high speed manner by making a strobe light 20 emit light intermittently, the control means comprising:

the strobe light 20;

CCD cameras 14 and 15 to carry out high speed multiple photographing of a golf ball 13 and a golf club 34 in concurrence with intermittent light emission of the strobe light 20;

a CPU 3 to binarize image data output from the CCD cameras 14 and 15 to perform recognition of external form shapes of the golf ball 13 and the golf club 34, calculate an approaching direction of a club head, a hitting point position, a ball speed, and a flying out angle, calculate from these pieces of data a backspin amount and a sidespin amount of the ball 13, calculate a ballistic course of the ball to calculate flying positions, and indicate each flying position, a drop position, rolling, and a stop position of the ball on a course map shown on a CRT display 10; and

a CPU 5 to which the data is transmitted to display the ballistic course of the ball on a screen 9." (extracted from the decision)l

(ii) Printed publication 2 (the invention stated in the printed publication 2): JP H10-222285A (finding of the appeal decision)

"That, in an information processing apparatus ([image extraction apparatus]. Here, [ ] indicates a term of the printed publication 2; the same shall apply hereinafter.), photographing is performed at the time of light emission and at the time of non-emission of a stroboscope ([illumination light] or [a light emitting means 101]), and calculation of information is performed based on a difference between an image signal obtained at the time of light emission ([an image obtained by irradiating the illumination light to a target object] or [an image obtained by light-reception by a first light-receiving means 109]) and an image signal obtained at the time of non-emission ([an image of the target object obtained under a circumstance where only light of the outside light is illuminating] or [an image obtained by light-reception by a second light-receiving means 110])" (extracted from the decision)

(iii) Printed publication 3 (the invention stated in the cited invention 3): JP 2001-209487A (finding of the appeal decision)

"That, in an information processing apparatus ([a brushstroke communication system]. Here, [ ] indicates a term of the printed publication 3; the same shall apply hereinafter), by making an object ([writing tool]) include a recursive reflector ([recursive reflection member]), an image of the recursive reflector ([recursive reflection member]) becomes readily distinguishable from a taken image, and, thus, detection of a directing position of the object ([writing tool]) becomes easy" (extracted by the decision)

(3) The Claims (claimed invention)

[Claim 1]

An information processing apparatus provided with an input system using a stroboscope, the information

processing apparatus comprising:

a stroboscope;

an image taking means for photographing an object at each of a time of light emission and a time of non-emission of the stroboscope;

a first means for calculating, based on a difference between an image signal at a time of light emission of the stroboscope and an image signal at a time of non-emission of the stroboscope, a part or all of information on a position, a size, a speed, acceleration and a motion locus pattern of the object; and

a second means for performing information processing based on the information calculated by the first means,

wherein the object includes a recursive reflector.

(4) Procedural History

Nov. 28, 2002	:	Patent application (date of claim of priority: Jun. 27, 2002)
Feb. 7, 2009	:	Amendment (refer to the above-mentioned "The Claims")
Jul. 2, 2009	:	Decision of refusal
Sep. 24, 2009	:	Request for Appeals against an Examiner's Decision of Refusal (Objection No. 2009-17930)
Feb. 9, 2011	:	Appeal decision that said that "the present request for appeal will not stand."

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

Appeal decision
(Difference 1) A point that, in the claimed invention, image taking means photographs an object "at each of the time of light emission and the time of non-emission (of the stroboscope)", and calculation of information is performed based on "a difference between an image signal at the time of light emission and an image signal at the time of non-emission", whereas, in the invention stated in the printed publication 1, the image taking means photographs an object only at the time of light emission, and calculation of information is also performed only based on an image signal at the time of light emission. ... (Difference 3) A point that, in the claimed invention, a photographed object "includes a recursive reflector," whereas, in the invention stated in the printed publication 1, it does not include a recursive reflector. ... (About difference 1) ...In an information processing apparatus such as the invention stated in the printed publication 1, that noise components other than an object should be removed as needed according to an environment that is used is only a common issue that should be assumed by a person skilled in the art naturally. In addition, the technology

stated in the printed publication 2 that removes the above-mentioned noise components based on such common issue was publicly known before the priority date of the present application. Therefore, it could be easily arrived at by a person skilled in the art to, when, in the invention stated in the printed publication 1, there is a risk that noise components such as illumination is caused, apply the matters of the technology stated in the printed publication 2 of photographing "at each of the time of light emission and the time of non-emission of a stroboscope", and, in addition, performing calculation of information based on "a difference between an image signal at the time of light emission and an image signal at the time of non-emission".

...

(About difference 3)

...Both of the invention stated in the printed publication 1 and the technology stated in the printed publication 3 are ones that detect the position of an object from a photographed image, and, therefore it could be easily arrived at by a person skilled in the art to apply, in the invention described in the printed publication 1, the matter that an object of the technology stated in the printed publication 3 "includes a recursive reflector" in order to perform detection of the position of the object with ease.

Decision

Allegations by Plaintiff	Allegations by Defendant
The objective of the technology stated in the printed publication 2 is, as is stated in paragraph [0021], to provide an input device that can input a movement in a simplified way without having to attach a color marker or a light emitting unit to a part of a hand and a body. On the other hand, the technology stated in the printed publication 3 is an invention that attaches a recursive reflection material (this corresponds to a marker) to an input means (writing tool). Therefore, it inhibits the objective of the technology stated in the printed publication 2 to apply the technology stated in the printed publication 2 and the technology stated in the printed publication 3 to the invention stated in the printed publication 1 at the same time. Accordingly, when the technology stated in the printed publication 2 is tried to be applied to the invention stated in the printed publication 1, the technology stated in the printed publication 3 cannot be applied to the invention stated in the printed	The paragraph [0021] of the printed publication 2 referred to by the plaintiff is one describing a related art, and its statement is as follows. "[0021] .....In addition, there are apparatus in which a color marker or a light emitting unit is attached to a part of a hand or body and detected by an image to capture a shape and a movement and the like of the hand or body, and some of those are being used practically. In consideration of convenience of a user however, it is a large disadvantage that such device (color marker or the like) needs to be attached in every operation, and, thus, this restricts an application range to a great extent. Furthermore, as is seen in the example of a data glove, in an apparatus that uses such device in a way attaching it to a movable portion such as a hand, durability easily becomes a problem." As is obvious from this statement, the paragraph explains that, when "a color marker or a light emitting unit is attached to a part of a hand or body of a user to be detected by an image, and a shape and movement of the hand or body are" recognized, there is a problem

publication 1. Adversely, when an attempt is made to apply the technology stated in the printed publication 3 to the invention stated in the printed publication 1, the technology stated in the printed publication 2 cannot be applied to the invention stated in the printed publication 1. As above, there exists an obstructive factor against combining each of the technologies stated in the printed publication 2 and the printed publication 3 to the invention stated in the printed publication 1 at the same time. B Accordingly, the determination of the appeal decision that "the claimed invention is an invention that could be invented by a person skilled in the art with ease based on the invention stated in the printed publication 1 as well as technologies stated in the printed publications 2 and 3" is an error.	that "the devices need to be attached in every operation" and the like. In other words, it only describes a problem in a case where a marker and the like is attached to a part of a hand or body, but it does not describe a case where a marker and the like is attached to an article and the like other than a hand and body. The invention according to the printed publication 1 to which, the present appeal decision assumes, the technology stated in the printed publication 2 is applied takes "the golf ball 13 and the external form shape of the golf club 34" as a recognition target, and thus it has no relation with the above-mentioned problem. It is obvious for a person skilled in the art that the technology stated in the printed publication 2 that has been found in the present appeal decision is a technology that can be applied to an object of any kind, and, therefore, in the present appeal decision, an obstructive factor for combination that has been alleged by the plaintiff does not exist.

Judgment by the Court

In the technology stated in the printed publication 2, it is not assumed that a color marker or a light emitting unit is attached to a target object, whereas the technology stated in the printed publication 3 is an invention in which a recursive reflection member is attached to an input means (writing tool). Therefore, the two have contradictory constitution with respect to attachment of a marker (recursive reflection member). Accordingly, it should be said that there is an obstructive factor in combining the invention stated in the printed publication 2 and the invention stated in the printed publication 3 with the invention stated in the printed publication 1 at the same time. Therefore, the determination of the appeal decision in question that " the claimed invention could be easily invented by a person skilled in the art based on the invention stated in the printed publication 1 and the technologies stated in the printed publication 2 and the printed publication 3" (page 9, lines 28-30) is an error.

(4) About allegations by the defendant

The defendant alleges that: the paragraph [0021] of printed publication 2 is a paragraph that describes that, when "a color marker or a light emitting unit is attached to a hand or a part of body of a user and detected by an image, and a shape and movement of the hand or body" are recognized, that "the device needs to be attached in every operation" and the like becomes a problem, and, thus, it only describes a problem when attaching a marker or the like to a hand or a part of body, but does not describe about a case of attaching a marker and the like to

an article and the like other than a hand or body; and, therefore, the invention according to printed publication 1 to which, the present appeal decision assumes, the technology stated in the printed publication 2 is applied is one that takes "external form shapes of a golf ball 13 and a golf club 34" as recognition targets, and has no relation with the above-mentioned problem, and, thus, the combinational obstructive factor that has been alleged by the plaintiff does not exist.

However, ... the technology stated in the printed publication 2 does not assume to attach a color marker and a light emitting unit, and, therefore, the allegation by the defendant cannot be adopted.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	"Communication system using pseudo period series" (Trial for Invalidation) Intellectual Property High Court Decision, September 12, 2012 (2011 (Gyo KE) No. 10242)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H5-144033 (JP H7-143110A)
Classification	H04L 7/027
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding judge: Makiko TAKABE, Judge: Yasuto INOUE, Judge: Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention provides a communication scheme using a pseudo period series. The pseudo period series, when information to be transmitted is (b), uses a signal (a_{n-L}, ..., a_{N-1}, a_0, ..., a_{L-1}) with length N+2L as a transmission signal, and receives the information (b) through a matching filter for a signal (a_0, a_1, ..., a_{N-1}) with length N, thereby the signal designed as the period series is made available in an approximate synchronizing state. The present invention solves the problem that although the desired reception output is obtained from the input of the period series of an infinite length, the reception output is obtained from the input of the period series of a finite length different from the desired reception output.

(2) State of the Art

(i) Citation 2 (Cited Invention 2): JP H5-7196A (Determination of the Court Decision)

"Since ... in the cited invention 2, the clock signal as "series 2" is added with the "series 1" multiplied by the information signal, and formed to be a transmission signal. Also in the receive side, the driving clock is controlled using the signal from the transmitter. Thus, it is designed based on the assumption for synchronizing the clock signal at the transmission side and the driving clock of the pseudo noise code generator at the receive side to

facilitate the synchronization of the PN codes.

Also, the demodulator has the roles for both of the synchronization and information demodulation by the correlation output of the receiving signal and the output of the PN code generator at the receive side.

Further, the output of the correlator is passed through the low-pass filter for filtering the frequency component which is higher than or equal to the information signal band, thereby the information signal is output in the correlator before being passed through the low-pass filter.

Moreover, the PN codes are not used as a transmission and receive signal in one period of the period series, but are output continuously as an output signal of the pseudo noise code generator." (Cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] A communication system using a pseudo period series configured to, when information to be transmitted is (b), use a signal (an-L, aN-1, a0, ..., aL-1) with length N+2L as a transmission signal, and receive the information (b) through a matching filter with respect to a signal (a0, a1, ..., aN-1) with length N.

(4) Procedural History

September 22, 2000	:	Registration of Establishment of Patent Right (see the above "The Claims")
August 20, 2010	:	Filing of Request for Trial for Patent Invalidation by Plaintiff (Muko No. 2010-800144)
March 22, 2011	:	Trial Decision to "dismiss the trial"

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

Appeal Decision (cited from the Court Decision)
... (3) It could not be obvious for a person skilled in the art by combining the cited invention 3, the cited invention 4 and so on with the cited invention 2. B the citation 2: JP H5-7196A (Published on January 14, 1993. Exhibit A2). C the citation 3: Specification of US Patent No. 5127025 (Published on June 30, 1992. Exhibit A7). ... the relation between the present invention and the cited invention 2 ... the cited invention 2: The cited invention 2 adopts the communication scheme of using the signal obtained by multiplying the information signal to be transmitted by the PN codes as a transmission signal, and receiving the information signal through the correlator that uses the codes same as the PN codes used in transmission ... the difference 2: With regard to "the signal obtained by multiplying (b) by the codes as a transmission code" and "the communication scheme", the present invention adopts the communication scheme of using "the (b) ... with length N+2L" as a transmission signal, and "using the pseudo period series", and the cited invention 2 adopts the communication scheme of using "the signal obtained by multiplying (b) by the PN codes" as a transmission signal

... the difference 3: With regard to the correlating means, the present invention uses "the matching filter for the signal (a0, a1, ..., aN-1) with length N", and the cited invention 2 uses "the correlator using the codes same as the PN codes used in transmission"

Decision

Allegations by Plaintiff

A It could be said that the citation 3 disclosed a core part of the configuration according to the difference 2 of using the pseudo period series signal as a transmission signal and the configuration according to the difference 3 of correlating the receiving signal and the pre-pseudo cycled code series.

B It could be said that the citation 3 disclosed the configuration of using the pseudo cycled M series signal as a preamble signal, as well as the common characteristic of the M series signal for obtaining a pure output by passing the pseudo cycled M series signal through the matching filter for the original M series signal. Therefore, it could be said that it would have been obvious for a person skilled in the art to discuss to adopt the code pattern disclosed in the citation 3 when designing the communication system in the spread spectrum communication scheme.

C The problem to be solved of the present invention was well-known that the correlation value is output from the input of the period series of a finite length differently from the desired output obtained from the input of the period series of an infinite length ... at the time when the present Application was filed. The citation 3 disclosed ... solutions of the present invention. Although the preamble of the cited invention 3 is not used as a spread signal like the PN codes of the cited invention 2, it is common general matter for a person skilled in the communication field to adopt the code pattern used in a certain communication system in other

Allegations by Defendant

A The appeal decision recognized that since the preamble signal disclosed in the citation 3 is not to spread information, the cited invention 3 does not relate to the scheme of transmitting and communicating information, and it would not conceivable to apply the preamble signal for acquiring synchronization of the cited invention 3 to the spread signal of the cited invention 2.

It could be said that using the same codes between a receive side and a transmission side would be common general technical knowledge at the time when the cited invention 2 was invented. Thus, it should be said that different codes were not be used between a receive side and a transmission side at that time.

The allegation of the plaintiff only corresponds to explanation of a part of the configuration of the present invention and the working effects by replacing them mutually, and does not support that there is no obstructive factor for adopting the configuration of the cited invention 3 in the cited invention 2.

B Since the matching filter alleged by the plaintiff to be equivalent to the accumulator is different from the matching filter of the present invention, and is not equivalent to the accumulator and ROM of the cited invention 1. Thus, it could not conceive the present invention by applying the code series of the cited invention 3 to the cited invention 2 when the cited invention 2 uses the accumulator that is a narrowly-defined correlator.

communication system depending on the objectives and the effects. Thus, it could recognize the adequate motivation for adopting the pseudo period series of the preamble of the cited invention 3 in the code series of the spread code of the cited invention 2, and there is no obstructive factor.	

Judgement by the Court

(2) With regard to the differences 2 and 3

B In the cited invention 2, ... the clock signal as "series 2" is added with the "series 1" multiplied by the information signal, and formed to be a transmission signal, and also in the receive side, the driving clock is controlled using the signal from the transmitter. Thus, it is designed based on the assumption for synchronizing the clock signal at the transmission side and the driving clock of the pseudo noise code generator at the receive side to facilitate the synchronization of the PN code, and it is apparent that the cited invention 2 does not have the recognition for receiving the signal in the approximate synchronizing state. in the cited invention 2 for adopting the M series codes pertaining to transmit and receive the signal in the approximate synchronizing state disclosed in the citation 3.

C In the cited invention 2, the demodulator has the roles for both of the synchronization and information demodulation by the correlation output of the receiving signal and the output of the PN code generator at the receive side. It could be said that in order to obtain such mutual correlation, the correlator using the codes same as the PN codes used in transmission is the configuration required for achieving the objectives of the cited invention 2.

Therefore, It should be said that since the correlator using the codes same as the PN codes used in transmission is the required configuration in the cited invention 2, there should be an obstructive factor for adopting the matching filter for the signal with length N (i.e. of different codes).

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

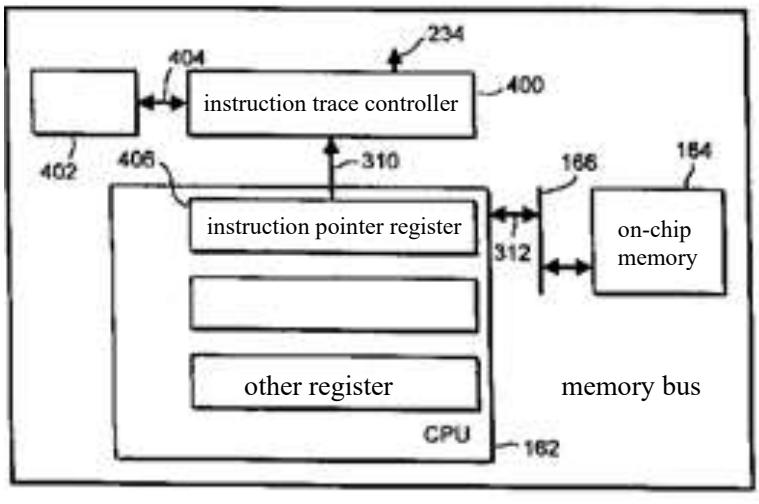
Case	"Instruction trace supply system" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, September 27, 2012 (2011 (Gyo KE) No. 10320)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H9-349884 (JP H10-240572A)
Classification	G06F 11/28
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Toshifumi SHIBATA, Judge: Rika NISHI, Judge: Akira CHINO

2. Overview of the Case

(1) Summary of Claimed Invention

(Determination of the Court Decision)

[FIG. 12]



"A single chip integrated circuit device comprising: (1) an on-chip CPU (*164*) including a fetch circuit for fetching instructions from a memory, an execution circuit for executing the instructions and an instruction pointer register 406 for holding sequentially instruction pointers, the instruction pointers has addresses of instructions executed by a CPU (*162*) in the memory, the execution circuit of the CPU (*162*) is operable to cause the fetch circuit to initiate to fetch instructions from new memory locations and to generate a control signal, the control signal indicates the discontinuity that one of the addresses is not an address next to previous one of these addresses in the memory; (2) an instruction trace controller (*400*) operable to monitor the addresses, connected in trace storage locations, and for storing selected one

of the addresses in the trace locations in response to detecting that the one of the addresses is not the address next to the previous one of the addresses in the memory." (Cited from the Court Decision, the italic face numbers are added)

(2) State of the Art

(i) Citation 1 (the cited invention): JP H5-158734A (Determination of the Court Decision)

"The cited invention could be recognized as follows: (1) the cited invention relates to a device for outputting the execution state of a microprocessor having a built-in cache memory device for instruction outside the microprocessor; (2) the microprocessor, when having a built-in cache for instruction, if the built-in cache is hit, does not output the execution state of the instruction outside, and cannot trace the instruction executed by the microprocessor only by recording the information for the address bus and data bus of the microprocessor; (3) on the other hand, the cited invention has the problem that the storage device is required to have more storage capacity to recording the addresses of all instructions, outputting always the execution information of the microprocessor outside results in degradation in performance of the microprocessor, and in the method for outputting the execution information of the microprocessor only when tracing the instruction executed by the microprocessor, the execution environment changes considerably depending on whether or not the instruction is traced and obtaining the accurate information is difficult; and (4) in order to solve the problems, the cited invention comprises an instruction completion signal indicating the completion of the instructions executed, a branch signal indicating the branch, an instruction execution counter for counting the number of instructions, an address calculation part for calculating and outputting the addresses of the branch destination instructions, and bus controller." (Cited from the Court Decision)

(3) The Claims (Amended) (The present invention)

[Claim 1] A single chip integrated circuit device comprising:

an on-chip CPU including a fetch circuit for fetching instructions from a memory, an execution circuit for executing the instructions and an instruction pointer register for holding sequentially instruction pointers, the instruction pointers has addresses of instructions executed by a CPU in the memory, the execution circuit of the CPU is operable to cause the fetch circuit to initiate to fetch instructions from new memory locations and to generate a control signal, the control signal indicates the discontinuity that one of the addresses is not an address next to previous one of these addresses in the memory;

an instruction trace controller connected to the CPU via a bus, the instruction trace controller is operable to receive via the bus instruction pointers held sequentially in the instruction pointer register and to monitor the addresses of the received instruction pointers, and the instruction trace controller is connected in trace storage locations and stores selected one of the received addresses in the trace locations,

wherein the instruction trace controller receives via the bus from the CPU the control signal transmitted to the instruction trace controller concurrently with the instruction pointers, and stores the selected one of the received addresses in the trace locations based on the detection of the control signal.

(4) Procedural History

December 19, 1997	:	Filing of Patent Application (Priority Date: December 19, 1994, United Kingdom)
January 29, 2007	:	Decision of Refusal
May 7, 2007	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2007-12853)
December 28, 2007	:	Filing of Claim Amendments (see the above "The Claims")
May 24, 2011	:	Appeal Decision to "Dismiss the appeal"

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">... the present invention would have been obvious for a person skilled in the art based on the invention disclosed in JP H5-158734A (... referred to as "Reference 1", and the invention disclosed in Reference 1 is referred to as "the cited invention". ...) and well-known art, and are unpatentable under the Article 29(2).
... the differences between the cited invention ... and the present invention ... are followings.
A Difference 1
With respect to storing in the trace locations the candidate addresses to be traced that are received based on the detection of the control signal, the present invention adopts the configuration of receiving the instruction pointers held sequentially in the instruction pointer register and selecting one of the addresses based on the detection of the control signal transmitted concurrently with the instruction pointers, while the cited invention adopts the configuration of receiving the branch destination addresses and writing the addresses in the trace device based on the bus address information generated from the branch instruction signal.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
... incorrect determination of the obviousness according to the difference 1 ...
The appeal decision recognized and determined that since transmitting all instruction pointers to the instruction trace controller of the present invention does not obtain the considerable effects, it would be obvious for a person skilled in the art to transmit all instruction pointers to the instruction trace controller and select, by the control signal indicating the discontinuous addresses, the addresses to be stored by the instruction trace controller.
However, the appeal decision is erroneous in recognizing and determining as above of. That is,
A The control signal of the present invention</td><td>Allegations by Defendant
... incorrect determination of the obviousness according to the difference 1 ...
A The plaintiff alleged that the present invention has the considerable effects for simplifying the control of the CPU and the circuit configurations by transmitting to the instruction trace controller without selecting the instruction pointers by the CPU, while the cited invention should not have the above effects due to the more complex operations in which the addresses to be stored are selected by the instruction execution part 50 and bus interface controller 60.
However, the plaintiff does not have the appropriateness in alleging as above. That is, the configurations are well-known art (Exhibit A2, Exhibit</td></tr>
</table>

is for controlling the fetch circuit by the execution circuit of the CPU, and the execution circuit of the present invention should not generate a new signal for tracing. Such configurations does not require for selecting the instruction pointers to be transmitted to the instruction trace controller in the CPU side and generating an additional signal for the instruction trace, and obtains the considerable effects for simplifying the control of the CPU pertaining to the instruction trace and simplifying the circuit configurations of the CPU. On the other hand, the cited invention has the configurations with more complexity than the present invention, in which the addresses to be traced (i.e. output) are selected by the instruction execution part 50 and the bus interface controller 60, and could not obtain the effects for simplifying the control of the CPU and simplifying the circuit configurations. Also, the configurations of the present invention does not require for generating the branch instruction signal 51 by the instruction execution part 50 and providing the branch address register 70 for storing the branch addresses until the satisfaction of the branch conditions are notified by the branch instruction signal 51, like the cited invention. ... B The problem of the cited invention is for controlling an amount of execution information output, and the microprocessor is configured to output the branch destination addresses and the number of instructions executed until the instructions are branched to the branch destination addresses. Since the cited invention has such problem and solutions, modifying the configuration as to transmit all addresses of the instructions to be executed to the bus interface controller 60 does not accord with its objectives. Since the bus interface controller 60 is for controlling the input and output with the external	A4 and Exhibit B3) that in the device for tracing the execution instructions of the CPU, when the discontinuity of change in the addresses of the output of the execution address values, the address values are recorded by the means connected to the CPU. Thus, it would have been easily-conceivable for a person skilled in the art to configure, when the discontinuity of change in the addresses is detected in the bus interface controller 60 connected to the CPU, to record the address values in the cited invention according to the above well-known art. Also, the embodiment of the present invention provides the mechanism for selecting the branch addresses to be stored to store the addresses in the register. Thus, it could not be said that the effects of the present invention that "transmitting to the instruction trace controller without selecting the instruction pointers by the CPU simplifies the control of the CPU and the circuit configurations" eventually have slightly differences to select the addresses to be stored in the branch address register on the single chip, by the register side on the instruction trace controller, not by the instruction execution part side, and are considerable. B The plaintiff alleges that the cited invention has the problem to reduce an amount of information required for tracing information, and configures to output the branch destination addresses and the number of instructions executed until the instructions are branched to the branch destination addresses, but configuring to transmit all addresses to be executed to the bus interface controller 60 does not accord with its objectives. However, the plaintiff does not appropriateness in alleging as above. That is, Reference 1 discloses the technical thought for outputting the branch destination addresses not to be output by the bus interface controller also to the bus interface controller and

devices, transmitting all addresses of the instructions to be executed to it results in degradation in performance of the bus interface controller 60 as well as performance of the entirety of the microprocessor. C From the above, it is not easily conceive the configuration to transmit all addresses of the instructions to be executed to the bus interface controller 60, and the appeal decision is erroneous in determining the obviousness according to the difference 1.	outputting the branch destination addresses by the bus interface controller only when executing the indirect branch instructions. Thus, it could not be said that changing to transmit all addresses of the instructions to be executed to the bus interface controller does not accord with the objectives of the cited invention.

Judgement by the Court

... in the cited invention, the instruction addresses in the case that the branch does not occur are calculated in the instruction pre-fetch part 10 and the branch destination addresses are calculated by the address calculation part. Thus, it could not be said that it would be obvious to modify the configuration so as to extract, from among all addresses output from the instruction pointer register, only the discrete addresses required for instruction trace by using the control signal indicating the discontinuity in addresses instead of the branch destination addresses calculated by the address calculation part.

Since the cited invention is designed for the purpose of controlling the amount of execution information to be output by ... outputting the branch destination addresses in the first place, there is no motivation to arrive at the configuration for outputting all addresses of the instructions to be executed, instead of using the branch destination addresses to be output by the address calculation part, by which such purpose can be achieved. Rather from the disclosure of Reference 1, the cited invention has the configuration in which the execution state of the instructions is not output in the address bus and data bus of the microprocessor in the case that a built-in cache hit occurs. Moreover, as long as the cited invention has such configuration, it is designed based on the assumption that the execution information of the microprocessor is output outside the processor, this would generate a bus conflict and degrade the performance of the microprocessor. Thus, there is an obstacle factor for configuring to output all addresses of the instructions to be executed in the cited invention ....

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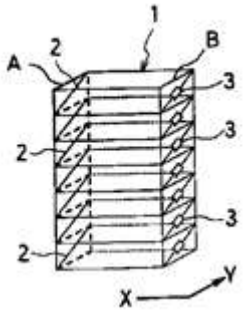
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	"Vibration control frame" (Trial for invalidation) Intellectual Property High Court Decision, Sep. 25, 2013 (2012 (Gyo KE) No. 10398)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-26928 (JP 2002-227449A)
Classification	E04H 9/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Ryuichi SITARA, Judge: Masaya TANAKA, Judge: Atsuki KAMIYA

2. Overview of the Case

[Fig. 1]



(1) Summary of Claimed Invention

The claimed invention is of a vibration control frame to reduce a response of a structural object at the time of earthquake and strong wind. The frame is designed in a manner that a balance of stiffness and mass is lost so as to cause a torsion vibration relative to shaking in the horizontal direction, and damping devices are installed on a flexible structure plane in the far side from the center of the torsion intensively.

(2) State of the art

(i) Document A1 (invention A1): "Paper: Research pertinent to earthquake response properties of a reinforced-concrete-structure stiffness eccentricity building to which a hysteretic damper is added" (Proceedings of the Japan Concrete Institute, vol. 21, No. 3, pp. 1147-1152. (Finding of the trial decision)

"A building to which is applied vibration control reinforcement to give quake resistance to reduce torsion response components of a building to the building by adding a hysteretic damper,

wherein the building has a degraded quake resistance due to influence of torsion, and the center of rigidity and

the center of gravity are eccentric,

wherein a stiffness element exists in a structure plane of the outer periphery of the building and an interior portion of the building,

wherein there exist a structure plane (Y2) in the side closer to the center of rigidity than the center of gravity, and a structure plane (Y5) that is arranged opposing the structure plane (Y2) and in the side farther from the center of rigidity than the structure plane (Y2), and hysteretic dampers are installed on the structure plane (Y5) intensively, and

wherein a ratio of distances to the center of rigidity from the structure plane (Y2) and the structure plane (Y5) that are opposing is about 1.35 to 1.5: 1." (extracted from the decision)

(ii) Well-known art

"That, when a viscosity damper or a viscoelastic damper is used as a vibration control mechanism of a building, a vibration control effect to mitigate earthquake force is exerted" (document A6: "Vibration Control of a Twisted Building (Experimental Research on the Effect of Viscous Damper Against Torsion Vibration)" (Summaries of technical papers of annual meeting Architectural Institute of Japan (Kanto region), Sept., 1993, pp. 643-644), and document A8: "Utilization of a Viscoelastic Damper to a Wooden House of a Conventional Construction Method No. 4: Vibration experimentation for existing damper-added wooden houses" (Summaries of technical papers of annual meeting Architectural Institute of Japan (Kyushu region), Sept., 1998, pp. 893-894), and document A14: JP 2000-179180A)

(3) The Claims (claimed invention)

[Claim 1]

A vibration control frame to reduce a vibration response of a structural object by attaching a damping device,

wherein a frame of the structural object is designed in a manner to make a center of rigidity and a center of gravity become eccentric by making a balance of stiffness of a structure plane or mass of the structural object be lost so as to generate a torsion vibration against shaking in a horizontal direction, and

wherein a structure plane in a side closer to the center of rigidity than to the center of gravity is made to be a rigid structure plane, a structure plane that is arranged opposed to the rigid structure plane and is in a side of a farther distance from the center of rigidity than to the rigid structure plane is made to be a flexible structure plane, damping devices are installed intensively in the flexible structure plane compared with the rigid structure plane, and exerts a vibration control effect at times of a small earthquake and also a large earthquake.

(4) Procedural History

Mar. 11, 2011	:	Registration of establishment of patent right
Dec. 22, 2011	:	Demand for a trial for patent invalidation (Invalidation No. 2011-800263)
Mar. 19, 2012		Demand for correction by the plaintiff (patent owner) (refer to the above-mentioned "The Claims")

Jun. 2, 2009 : Appeal decision that said that "The correction is admitted. ...The patent as to the invention according to claim 1 is invalid."

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

<table>
<tr><td colspan="2">Appeal decision</td></tr>
<tr><td colspan="2">(Difference 2)
A point that the present invention 1 "exerts a vibration suppression effect at the time of a small earthquake and also at the time of a large earthquake," while there is no statement about whether the invention A1 exerts such vibration suppression effect.
...
It is easily arrived at by a person skilled in the art to adopt, instead of a hysteretic damper of the invention A1, a conventionally well-known speed dependence damper (oil damper, viscosity damper and the like) such as..., and achieve the constitution of the difference 2 of the present invention 1.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...The invention A1 realizes an objective of securing quake resistance that is comparable to a non-eccentricity model by giving stiffness to an eccentricity model by the initial stiffness of a hysteretic damper before its breakdown (elastic region) to bring the eccentricity model close to the non-eccentricity model.
On the other hand, a speed dependence damper such as an oil damper disclosed in the documents A6 to A8 and A14 is not a damper whose properties differ before and after a breakdown as is the case of a hysteretic damper, and it cannot be expected that it has stiffness to bring an eccentricity model close to a non-eccentricity model (stiffness corresponding to initial stiffness of a hysteretic damper).
As a consequence, when, in the invention A1, a speed dependence damper disclosed in the document A6 and the like is employed instead of a hysteretic damper, an eccentricity building cannot be brought close to a non-eccentricity building, in other words, the aforementioned working-effect of the invention A1 cannot be obtained, and, thus, the objective of the</td><td>Allegations by Defendant
Even though the invention A1 adopts a hysteretic damper, there existed a speed dependence damper of a variable stiffness type according to the well-known art at that time, and, by this, it is possible to give initial stiffness also to a speed dependence damper. Therefore, the statement of "hysteretic damper" of the document A1 cannot be an obstructive factor for a material change to a speed dependence damper.</td></tr>
</table>

invention A1 to secure quake resistance comparable to that of a non-eccentricity model cannot be achieved. Therefore, it should be said that there is an obstructive factor for a person skilled in the art to employ a speed dependence damper instead of a hysteretic damper of the invention A1.	

Judgment by the Court

Generally, what form and type of a vibration control damper should be adopted as a vibration control mechanism of a structural object is a matter that can be determined by a person skilled in the art arbitrarily in consideration of the structure of a structural object, an installation location of a vibration control damper, a necessary vibration control effect and the like. Therefore, it is found that it is a matter that a person skilled in the art can easily conceive of without awaiting particular suggestion on the occasion of designing a structural object to install a vibration control mechanism that exercises a vibration control effect not only on the occasion of a large earthquake but also a small earthquake so as to avoid or reduce property damages and human damages in the structural object by an earthquake.

The plaintiff alleges that: [1] in the invention A1, there is no motivation existing for employing, instead of a hysteretic damper giving initial stiffness to a frame, a speed dependence damper such as an oil damper and a viscosity damper that do not give initial stiffness to a frame, [2] because the technical problem to be solved by the invention A1 exists in a point to secure quake resistance comparable to that of a non-eccentricity model by giving stiffness to an eccentricity model by an initial stiffness of a hysteretic damper before a breakdown, there is an obstructive factor about adopting a speed dependence damper in the invention A1 instead of a hysteretic damper.

However, as is indicated in the above mentioned (4), it is found that, in the invention A1, it is easily arrived at adopting, instead of a hysteretic damper, a speed dependence damper that " exerts a vibration control effect on the occasion of a small earthquake and also on the occasion of a large earthquake" without particular suggestion and motivation. Furthermore, even though the invention A1 is one that exerts an earthquake-proof effect before a breakdown of a hysteretic damper by its initial stiffness, it cannot be said that, in the invention A1, use of a speed dependence damper that exerts a vibration control effect even on the occasion of a small earthquake by which a hysteretic damper is not broken down is inhibited, considering the proximity of technical fields between an earthquake-proof structure and a vibration control structure, that is, the commonality of problems to be solved and the commonality of actions and functions to be exercised, and also considering that each of an earthquake-proof structure and a vibration control structure can be selected accordingly from well-known various structures arbitrarily.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	"Polymerized coating metal pipe"(trial for invalidation) Intellectual Property High Court Decision, Apr. 16, 2014 (2013 (Gyo KE) No. 10191)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 9-145869 (JP H10-315295A)
Classification	B29C 47/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Yoshinori TOMITA, Judge: Ichiro OTAKA, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is of a polymerized coating metal pipe that has excellent corrosion resistance without damaging resistance to chipping and resistance to splash, can be produced with ease, has weak peeling strength to allow stripping work to be performed simply, and has corrosion resistance of a pipe-end processing portion without deterioration, and a method for producing the same. A metal pipe is made by performing polymerization coating of: a first layer including resin capable of being extrusion-molded, the resin having adhesion strength to a surface-treated layer applied to an outer periphery surface of the metal pipe; and a second layer disposed on the outer periphery surface of the first layer, the second layer including resin having resistance to chipping and capable of being extrusion-molded, and peeling strength between the first layer and the second layer is 75 g/cm or less. The first layer made up of resin having adhesion strength to the surface-treated layer applied to the outer periphery surface of the metal pipe is extrusion-molded, and, in addition, the second layer made up of resin having resistance to chipping is extrusion-molded on the outer periphery surface of the first layer to make the both resin layers be contacted and polymerized in an approximately non-adhesive bonding state.

(2) State of the art

(i) Citation 1 (cited invention): JP H9-011398A (finding of the trial decision)

"A corrosion-resistant and flying-stone-resistant resin coating structure in a stainless steel pipe, the resin coating structure including: an epoxy-resin-base adhesive bonding layer formed on an outer periphery surface of a single winding stainless steel pipe by dip coating; a fluorine resin layer, formed on the epoxy-resin-base adhesive bonding layer, the fluorine resin layer increasing an adhesion property between each layer by being interposed as an intermediate layer; a polyamide resin adhesion layer of a film thickness of 100 μm formed on the fluorine resin layer by performing extrusion-coating of PA12; and a polyolefin resin layer of a film thickness of 800 μm having resistance to flying stones, the polyolefin resin layer being formed by extrusion-coating of high density polyethylene to the polyamide resin adhesion layer by adhesive polymerization." (extracted from the decision)

(3) The Claims (the present invention)

[Claim 1] A polymerized coating metal pipe made by performing polymerization coating of: a first layer comprising polyamide resin, polypropylene, or polyethylene that has adhesion strength to a surface-treated layer or a primer layer applied to an outer periphery surface of a metal pipe, the first layer being formed by extrusion molding; and a second layer disposed on an outer periphery surface of the first layer by extrusion molding and comprising polyolefin system resin or polyamide system resin having resistance to chipping, wherein

- peeling strength between the first layer and the second layer is 75 gf/cm or less, and
- only the second layer is broken away from the first layer of the polymerized coating metal pipe

(4) Procedural History

Jul. 24, 2009	:	Registration of establishment of patent right (refer to the above-mentioned "The Claims")
Oct. 11, 2012	:	Demand for a trial for patent invalidation (Invalidation No. 2012-800165)
Jun. 19, 2013	:	Trial decision that said that "the present demand for a trial will not stand."

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

Trial decision
...The invention of Exhibit A1 is an invention that takes it as a problem to be solved "to provide a corrosion-resistant and flying-stone-resistant resin coating structure in a thin small diameter stainless steel pipe formed by depositing a protective material having corrosion resistance together with resistance to flying stones that can sufficiently protect the pipe, even if the pipe is arranged under floor as a supply pipe of brake oil, fuel and the like of an automobile in particular and used under conditions such as causing damages due to flying stones, dirt and the like, from those damages sufficiently" (the paragraph [0004] of Exhibit A1), and, in order to solve that problem, it was found out "to use a stainless steel pipe as a pipe material, and form a resin layer directly on it to secure an adhesion property" (the paragraph [0005] of the same). Thus, in Exhibit A1, there is no statement and suggestion to the effect that a surface-treated layer is formed on the outer periphery surface of the stainless

steel pipe by a plating film and the like. Rather, it can be said that, in the corrosion-resistant and flying-stone-resistant resin coating structure in a stainless steel pipe of Exhibit A1, improvement of corrosion resistance is achieved not by a surface-treated layer such as a plating film, but by using a stainless steel pipe, and, therefore, there is no inevitability to apply surface processing further on the outer periphery surface of such stainless steel pipe.

As a consequence, about applying a surface-treated layer on the outer periphery surface of a stainless steel pipe, there is no statement or suggestion in Exhibit A1, and, in addition, it cannot be supposed that to form a surface-treated layer on the outer periphery surface of a stainless steel pipe could be easily arrived at for a person skilled in the art....In Exhibit A1, there is no statement or suggestion about a surface-treated layer, and also there is no inevitability in applying a surface-treated layer on the outer periphery surface of a stainless steel pipe.

Moreover, it is not found that there exists motivation to adopt, in place of a stainless steel pipe of the invention of Exhibit A1, a structure having a surface-treated layer on the outer periphery surface of a steel pipe, and, therefore, in the invention of Exhibit A1, even if any of Exhibits A2-5 is taken into consideration, it cannot be said that a person skilled in the art would be able to easily arrive at the constitution of the matter specifying the invention concerning the above-mentioned difference 1.

Decision

Allegations by Plaintiff	Allegations by Defendant
For a reason that, in A1, there is no motivation to adopt a steel pipe structure including a steel pipe and a surface-treated layer in place of a stainless steel pipe adopted in order to solve its to-be-solved problem, the present trial decision determined that a person skilled in the art cannot easily arrive at the idea of making the stainless steel pipe of the cited invention be a metal pipe on which a surface-treated layer is applied. However, at the time of the present application, it was well known that an average steel pipe easily gets rusted and lacks corrosion resistance, and that, as a steel pipe having corrosion resistance, there were steel pipes on which a plating film of such as Zn, Al or the like is formed on the outer periphery surface of a steel pipe, and, on the surface of that plating film, a chromate treatment that is a chemical conversion treatment by chromate salt is applied, as well as stainless steel pipes and the like (Exhibits A6, and 12-16). Then, stainless steel has a feature that, although	In Exhibit A1, it is clearly stated that, as a problem to be solved, the constitution that arranges surface processing to a metal pipe has a technical problem. In addition, although the cited invention is supposed to be an invention to form a resin layer on a stainless pipe that is a pipe material "directly," the term "directly" here means, as is the case with the present invention, directly without being meditated by a "surface-treated layer." The cited invention has been granted the registration of establishment by making progress from a conventional "metal pipe" and a "surface-treated layer" to the constitution of a "stainless steel pipe," and, therefore, to substitute the two is synonymous with denying the patentability of the cited invention. Accordingly, in the cited invention, it should be said that a "stainless steel pipe" and constitution of a "metal pipe" and a "surface-treated layer" cannot be substituted with each other.

it generally has strong corrosion resistance in comparison with a metal pipe having a surface-treated layer, price is high, and workability is not good. Therefore, a person skilled in the art used to select a metal pipe based on required corrosion resistance, economic efficiency, and workability. Therefore, in a person skilled in the art coming into contact with Exhibit A1, whether to use a stainless steel pipe stated in Exhibit A1 just as it is or whether to change it to a metal pipe having a surface-treated layer is a design matter that should be selected accordingly. In addition, a stainless pipe is a high-priced metal pipe compared with a steel pipe, and, thus, it should be said that, in the automobile component industry to which cost reduction is strongly required, even positive motivation to adopt a metal pipe having a surface-treated layer in place of a stainless steel pipe is found.	

Judgment by the Court

The cited invention is an invention in which, in order to achieve the objective of excellent corrosion resistance and flying stone resistance, a resin layer is formed directly on a metal pipe that is a stainless steel pipe and the adhesion property between the metal pipe and the resin layer is increased.

...

As a consequence, about the cited invention, when another layer such as a surface-treated layer as stated in the present invention is formed between a stainless steel pipe and a resin layer so as not to make it be a constitution that a resin layer is formed directly on a metal pipe that is the stainless steel pipe, the resin layer and the metal pipe are not in contact with each other directly, resulting in denying the objective of the cited invention of increasing an adhesion property between the metal pipe and the resin layer. From this reason, it should be said that there is an obstructive factor to make it be such constitution.

Accordingly, it cannot be said that a person skilled in the art could easily arrive at the constitution of the present invention concerning the difference 1 based on the cited invention.

Therefore, there is no error in the present trial decision concerning the difference 1.

(46)-10

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

Case	"Transparent film" (Trial for Invalidation) Intellectual Property High Court Decision, September 25, 2014 (2013 (Gyo KE) No. 10339)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-192754 (JP 2005-29588A)
Classification	C08J 5/18
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Tadao ISHII, Judge: Masaya TANAKA, Judge: Atsuki KAMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a transparent film which does not generate acetic acid by hydrolysis with time caused by environmental changes and which exhibits excellent transparency, is a transparent film comprising an ethylene/vinyl acetate copolymer and an acid-acceptor particle dispersed in the copolymer, and is a transparent film where the content of the acid-acceptor particle is equal to or less than 0.5 mass% based on the copolymer and the average particle size of the acid-acceptor particle is equal to or less than 5 μm.

(2) State of the art

(i) Exhibits A (Cited Invention 1): JP H9-027633A (Identification of Trial Decision)

"A sealing film for solar cell which is interposed between a cell for solar cell and a transparent plate or the cell and a back cover, comprising a copolymer membrane of ethylene-vinyl acetate, to which a retardant is added." (cited from the Court Decision)

(3) The Claims (Claimed invention)

[Claim 1]

A transparent film comprising an ethylene/vinyl acetate copolymer and an acid-acceptor particle dispersed in the copolymer,

wherein the acid-acceptor particle is a metal oxide (except metal oxides of Sn, Ti, Si, Zn, Zr, Fe, Al, Cr, Co, Ce, In, Ni, Ag, Cu, Pt, Mn, Ta, W, V and Mo), a metallic oxide or a mixture thereof,

the content of the acid-acceptor particle is 0.01 to 0.5 mass% based on the copolymer, and the average particle diameter is equal to or less than 5 μm,

a ratio of the content of vinyl acetate in the ethylene/vinyl acetate copolymer is 20 to 36 mass%,

the ethylene/vinyl acetate copolymer is further crosslinked by a crosslinking agent, and

the transparent film is used as a sealing membrane for solar cell, or a transparent adhesive layer for laminated glass for heat reflective glass through which a deposition metal membrane is inserted between a glass and a transparent film.

(4) Procedural History

June 24, 2011	:	Registration to establish a patent right (see the aforementioned "The Claims")
December 25, 2012	:	Request for trial for invalidation (Muko No. 2012-800210)
March 25, 2013	:	Request for correction made by the Defendant (Patentee) (see the aforementioned "The Claims")
November 19, 2013	:	Trial decision that "... the correction is approved. The request for the present trial is dismissed."

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

<table>
<tr><td colspan="2">Trial decision</td></tr>
<tr><td colspan="2">Exhibit A1 simply exemplifies a plurality of substances as a retardant, and there is no statement to motivate that the retardant is limited to an inorganic hydroxide such as aluminium hydroxide and magnesium hydroxide. In addition, since it states, for the content of the retardant, that "it is enough that the amount of these retardants is 70 weight parts or lower relative to 100 weight parts of EVA resin, preferably 1 to 50 weight parts" (Indication of Exhibit A1D), there is no statement to motivate to intentionally limit the content of "0.01 to 0.5 mass% based on the copolymer", which does not constitute the preferable range. Rather, it can be recognized to be an inhibitory factor. ...</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The statement of "1 to 50 weight parts" is consistently for the preferable range, the content of the acid-acceptor particle in the present invention 1 is objectively encompassed within "70 weight parts or lower" stated in Exhibit A1 document. Accordingly,</td><td>Allegations by Defendant
The retardant and the acid-acceptor are commonly used for a person skilled in the art to be absolutely different in its function and property. In addition, the retardant cannot obtain its effect if it is not used to contain a relatively large quantity thereof. When the</td></tr>
</table>

the range of the content of the retardant stated in Exhibit A1 document does not exclude the range of the content of the acid-acceptor particle in the present invention 1.	inorganic hydroxide is used as the retardant, there is the technical general knowledge to contain the large quantity of, for example, 130 parts based on 100 parts of resin. On the contrary, when the inorganic hydroxide is used as the acid-acceptor, it can be construed that, depending on its use and the supposed amount of creating an acid, the content necessary for neutralizing the acid is adjusted. The content thereof is recited in the present invention 1 to be 0.01 to 0.5 mass% based on the copolymer. As mentioned above, the inorganic hydroxide is absolutely different in its working effect when it is used as the retardant and as the acid-acceptor, and the range of the content as contained and the like are absolutely different. Accordingly, even though there is the statement of the inorganic hydroxide in Exhibit A1 document as one example of the retardants, the document does not suggest any problem that the acid-acceptor should be used, since there is no statement relating to the acid-acceptor at all. In addition, there is no motivation to combine the Exhibit A1 invention with the technical general knowledge relating to the acid-acceptor. Rather, since the inorganic hydroxide will not function as the retardant when the amount thereof is decreased, there is an inhibitory reason to combine thereof. Further, there is no motivation at all in Exhibit A1 document that the inorganic hydroxide decreasing the transparency of the film is contained as the retardant in the transparent film. In order not to decrease the transparency of the film, to set its amount to be extremely low is against the purpose of improving the retardancy in the Exhibit A1 invention. Accordingly, there is an inhibitory reason to set the content to be the range recited in the present invention 1.

Judgment by the Court

(4) Regarding obviousness of the present invention 1

... in the light of the technical general knowledge that when an inorganic retardant is used such that a resin is arranged to be retardancy, the inorganic retardant is used to be at least several ten % or more relative to the amount of the resin, sometimes a larger amount than that of the resin, it should be said that there is an inhibitory reason that the content of the retardant in the Exhibit A1 invention is reduced to 0.01 to 0.5 mass%, which is lower than the range of the content stated in Exhibit A1 document as the preferable content.

In addition, there is no statement and no suggestion in Exhibit A1 document for the average particle diameter of the retardant, and a motivation to be set the average particle diameter as 5 μm or lower cannot be found.

Therefore, it cannot be recognized that the constituent of the present invention 1 according to the Difference 1' is easily conceivable for a person skilled in the art, even though the statement of Exhibit A1 document and the technical general knowledge are considered.

(46)-11

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2 3.2.2
Classification of the Case	46: Whether or not there is any condition that blocks application of the sub cited invention to the main cited invention (negative teaching)
Keyword	

1. Bibliographic Items

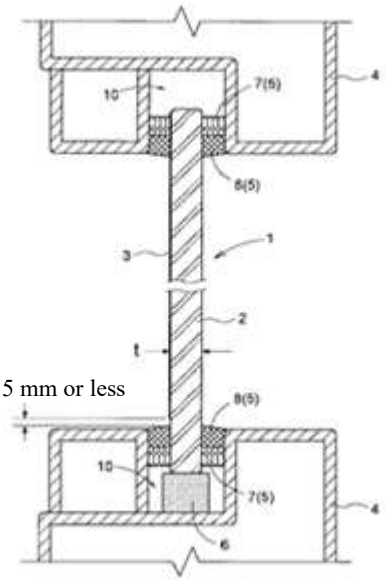
Case	"Assembly structure of fire-resistant glass, fire-resistant glass door, and fire-resistant glass window" (appeal against an examiner's decision) Intellectual Property High Court Decision, Jan. 28, 2015 (2014 (Gyo KE) No. 10120)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2005-18663 (JP 2005-207226A)
Classification	E06B 5/16
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding judge: Ryuichi SHITARA, Judge: Asayo OYORI, Judge: Akihumi HIRATA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is of an assembly structure of fire-resistant glass that is free from production and quality problems, increases safety at the time of glass breakage, and, in addition, is free from degrade of fireproof performance. Specifically, it is an assembly structure of fire-resistant glass made by attaching a glass plate body 2 to a metal holding frame 4, wherein the glass plate body 2 includes a polyester resin film 3 coated on its plate surfaces integrally and has heat resistance and transparency, and wherein a holding material 5 of at least one selected from the group consisting of a nonflammable backup material, a sealant for fire protection, and an elastic holding material made of metal is filled between the glass plate body 2 and the holding frame 4 over the entire perimeter without any space to attach the glass plate body within the holding frame.

[Fig. 1]



(2) State of the art

(i) Printed publication 1 (the invention of the printed publication 1): JP H9-032432A (finding of the appeal decision)

"A fire-resistant glass support structure of a type-A fire-retarding door, wherein a periphery part of a fire-resistant glass is pinched and supported by a frame body and a bead, wherein a flame retardant seal is applied to clearances between the fire-resistant glass and the frame body and bead, wherein an elastic flame-retardant material is made to intervene between an upper frame constituting the frame body and the fire-resistant glass, wherein a backup material 12 of a ceramic fiber is made to intervene between an upper bead 7a, a lower frame 1b, a lower bead 7b, a vertical frame 1c, and a lateral bead 7c and a fire-resistant glass 3, wherein a steel material or a stainless material is used as the frame body and the bead, and wherein a glass plate such as a low-expansion reinforcement glass plate and a soda lime reinforcement glass plate is used as a fire-resistant glass" (extracted from the decision)

(ii) Printed publication 2: JP H3-34842A

"That, conventionally, coating (laminating) a glass plate surface with a polyester resin film having heat resistance and transparency in an exposed manner has been performed with the purpose of preventing scattering at the time of glass breakage and securing a heat resistance property"

(iii) Publication of Exhibit A22: Registered utility model No. 3032848

"Technology to perform adhesive bonding of a polyester film on the whole surface of a partition window glass with the purpose of preventing scattering and ultraviolet light transmission"

(iv) Publication of Exhibit A23: National Publication of International Patent Application No. H3-506056

"A technology to stick a polyester film to all over a bulletproof glass with the purpose of preventing fracture and scattering of rubble"

(3) The Claims (the claimed invention)

[Claim 1]

An assembly structure of fire-resistant glass comprising a glass plate body attached to a metal holding frame,

wherein a polyester resin film having heat resistance and transparency is coated on a plate surface of the glass plate body integrally in a manner that the polyester resin film is exposed on the plate surface of the glass plate body, and

wherein a holding material including a fire protection sealant and one of a nonflammable backup material and a metal elastic holding material is filled between the glass plate body and the holding frame over a whole perimeter without any space to attach the glass plate body within the holding frame.

(4) Procedural History

Jan. 26, 2005	:	Patent application (application date of original application: Aug. 23, 2000)
Nov. 28, 2011	:	Decision of refusal
Mar. 1, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2012-

4051)

Jul. 1, 2013 : Amendment (refer to the above-mentioned "The Claims")

Apr. 2, 2014 : Appeal decision that said that "the present Request for Appeals will not stand."

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

Appeal decision	
Also in a fire-resistant glass of the invention of the printed publication 1, adding functions of such as safety improvement such as preventing scattering of glass and the like and preventing ultraviolet light is a matter naturally considered by a person skilled in the art. Furthermore, seen from the technical matters stated in the above-mentioned printed publication 3, making a resin film be of a form exposed on the glass plate was also known. Therefore, to apply the above-mentioned well-known technology to the invention of the printed publication 1 is a matter that could be easily achieved by a person skilled in the art. In addition, when discussing about a point that the claimed invention is of a fire-resistant glass assembly body, that is, when discussing about a working-effect of satisfying a predetermined fireproof performance, the fire-resistant glass support structure of the invention of the printed publication 1 is a structure that has a predetermined fireproof performance in itself, and, in addition, it was also known that, as the nature of polyester, it has a flame retardant property (for example, there is described in paragraph [0011] of JP H6-48786A that, about polyethylene terephthalate that is one of representative of polyester resin, "the reason to use a polyethylene terephthalate film (hereinafter, a PET film) as a constituent material of an intermediate layer in the present invention is that this film has a flame retardant property, ..."). As a consequence, it is within the scope of prediction of a person skilled in the art that a structure made by coating a fire-resistant glass support structure of the invention of the printed publication 1 that has fireproof performance in itself with a polyester resin film can satisfy predetermined fireproof performance, and, therefore, it cannot be said that it is a particular working-effect. Therefore, it is a matter that could have been achieved easily by a person skilled in the art to make the invention of the printed publication 1 be constitution concerning the difference 1.	
Decision	
Allegations by Plaintiff A fire-resistant glass is evaluated under extremely high temperature conditions such as flame in case of fire contacting with a glass plate, whereas a safety glass does not need elements pertinent to temperature and it is only necessary to prevent scattering of rubble when the glass plate is broken. It can be said that, as a resin film to be used for coating a glass plate, when it comes to fire-resistant glass, a person skilled in the art considers that a nonflammable	Allegations by Defendant As an aspect to coat fire-resistant glass with a resin film, there are two kinds of aspects, that is an aspect to make the resin film be exposed on a glass plate surface, and an aspect to sandwich it by glass plates, and it can be said that the both satisfy a fire retarding function and a glass scattering prevention (safety) function. Polyester resin itself is a well-known material and widely used common material, and it is known that it

resin film such as a fluorine based resin film should be used, whereas, when it comes to safety glass, he/she thinks that the resin film only has to be a resin film that does not break off together with glass when the glass is broken, and, thus, there is a wide selection range relatively. Therefore, technical fields and problems to be solved differ substantially between one made by coating fire-resistant glass with a resin film and one made by coating safety glass with a resin film. ...	has a certain degree of flame retardant property (Exhibit A8, Exhibit B2). Furthermore, it is also known that, if that polyester resin film is thin, flame retardant property of a degree that is comparable to a noncombustible material or a degree that ignition can be prevented can be secured (Publication of Exhibit A8, Exhibits B3 and 4). As a consequence, it is easy for a person skilled in the art to coat fire-resistant glass with a polyester resin film in a manner exposed on a plate surface of the glass plate, and, therefore, there is no error in the finding and determination of the appeal decision.

Judgment by the Court

According to the printed publication 2..., Publication of Exhibit A22 ..., Publication of Exhibit A23 ..., it is found that coating, with the purpose of giving glass a function to prevent glass breakage and scattering, a glass plate surface with a polyester resin film having transparency in an exposed manner was well-known art before the present application (hereinafter, referred to as "the present well-known art".). ...

As the aforementioned finding, although the invention of the printed publication 1 is of a fire-resistant glass support structure of a type-A fire-retarding door, it is assumed that such glass is installed in an open space where people live, and, therefore, it is a to-be-solved problem that is considered naturally by a person skilled in the art to add a function to prevent scattering at the time of glass breakage (the plaintiff has not contested this.) to the glass. Then, as has been described above, considering that it is a well-known art to coat, with the purpose of giving a function to prevent glass breakage and scattering to glass, a glass plate surface with a polyester resin film having transparency in an exposed manner, it can be said that it is a matter that could have been easily arrived at by a person skilled in the art to, in order to add that function, apply the present well-known art to glass of the invention of the printed publication 1 to coat it with a polyester resin film.

...However, glass of the invention of the printed publication 1 is glass having an objective of fire retarding, whereas the present well-known art has a different objective and there is no statement in particular about applying it to such fire retarding glass. Therefore, it becomes a problem whether or not a person skilled in the art thinks that the function of the invention of the printed publication 1 as fire-resistant glass is damaged by applying the present well-known art, that is, whether there is an obstructive factor as to a person skilled in the art applying the present well-known art to the invention of the printed publication 1.

B Accordingly, consideration will be made about matters that were known before the present application as properties of a polyester resin film. ...It is found that it was a well-known fact before the present application that a polyester resin film is a material that is hard to be burnt among transparent films. ...It is found that it was known before the present application that, although gas caused by a PET film decomposed by being heated through glass is flammable, if the amount of gas is small and the density is thin, the gas is not ignited.

C As a consequence, while a polyester resin film is flammable, it was known that it is of a flame retardant property among transparent films, and there are cases where, even if it is gasified, flame is not generated according to its amount, and, therefore, it cannot be said that there is an obstructive factor to apply this to the invention of the printed publication 1 that is of fire-resistant glass.

(47)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.3(1)
Classification of the Case	47: Hindsight when determining on inventive step
Keyword	

1. Bibliographic Items

Case	"Xylitol compositions for treating upper respiratory conditions" (appeal against an examiner's decision) Intellectual Property High Court Decision, March 25, 2009 (2008 (Gyo KE) No. 10261)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-537427 (National Publication of International Application No. 2002-507548)
Classification	A61K 31/045
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Toshiaki IIMURA, Judge: Noriaki SAIKI, Judge: Kazuhide SHIMASUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is "a nasal irrigation composition" which is an aqueous solution comprising a prescribed amount of xylitol, and is administered in each nostril. A preparation of the invention has effect for treating/preventing nasal inflammation and infection.

(2) State of the art

(i) Citation 1 (cited invention): International Publication No. WO1998/03165 (finding of Appeal Decision)

"The cited invention is "a liquid preparation for oral administration, for treating respiratory infections caused by S. pneumoniae which comprises 400 mg of xylitol per 1 mL of an aqueous solution." ... (written appeal decision, page 5, lines 1 to 3)." (cited from the Court Decision)

(ii) Citation 2: National Publication of International Patent Application No. H6-507404 (finding of Court Decision)

"... Citation 2 provides a method for treating diseases in which "the infection site" is limited to "the lower respiratory tract", and it is disclosed that a preferable embodiment of the method is particle aerosol administration

of an anti-inflammatory agent and anti-infections agent directly into the lower respiratory tract being the infection site." (cited from the Court Decision)

(3) The Claims (Amended) (Claimed invention)

[Claim 1] A nasal irrigation composition for nasal administration to a human in need of said composition, for treating or preventing nasal congestion, recurrent sinus infection, or nasal infection or inflammation of accompanied with bacteria,

wherein the composition comprises 1 to 20 grams of xylitol in aqueous solution in 100 cc of the aqueous solution.

(4) Procedural History

March 24, 1999	:	Filing of International Patent Application (Priority date: March 24, 1998, US)
February 3, 2004	:	Decision of Refusal
May 6, 2004	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2004-9407)
December 28, 2007	:	Amendment (see the above "The Claims")
May 4, 2008	:	Appeal decision of "dismiss the appeals."

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

Appeal Decision (cited from the Court Decision)
... The claimed invention is the invention that a person skilled in the art could easily conceive concerned from the inventions described in International Publication No. WO98/03165 (hereinafter referred to as "Citation 1") and National Publication of International Patent Application No. H6-507404 (hereinafter referred to as "Citation 2"), and cannot be granted a patent under Article 29(2) of the Patent Act ... In the above judgement, the invention described in Citation 1 (hereinafter referred to as "cited invention") and Corresponding feature and Difference between the claimed invention and cited invention which has been found by the Appeal Decision are as follows. (2) Corresponding feature A composition for being administered to a human in need of said composition, for treating of preventing recurrent sinus infection, or nasal infection accompanied with bacteria, which comprises xylitol in an aqueous solution ... Difference 1 The claimed invention is a nasal irrigation composition for nasal administration, on the other hand, the cited invention is a liquid preparation for oral administration ... The appeal decision found that ... "In Citation 2, it is described that, for treating infectious respiratory tract diseases, an anti-infectious agent is topically administered, and a smaller dosage than systemic administration can be administered into nose being the infection site (summary point (G))." ... "Therefore, when treating upper respiratory infection by administering xylitol in Citation 1, a person skilled in the art could easily conceive of a

nasal irrigation preparation for nasal administration, by adopting administration into the infection site with a smaller dosage than systemic administration, namely nasal administration, instead of oral administration." ...

Decision

Allegations by Plaintiff

Since it is clearly found in the written appeal decision that the infection site in the Cited Invention 2 is "the lower respiratory tract", the finding of the infection site as "nose" in comparison and judgement of the Appeal Decision is erroneous and illegal.

In the Cited Invention 2, the infection site is the lower respiratory tract such as lung, and aspiration with aerosol is the only method for effectively topical administration of corticosteroid as a drug. Therefore, a person skilled in the art could not combine the cited invention of oral administration of xylitol to the upper respiratory tract being the infection site, with the Cited Invention 2. Especially, since persons skilled in the art in the claimed invention are expected to be persons involved in medical or medicine service, a different prescription is used depending on an agent, infection site and dosage form, and it is commonly recognized that the concern about side effects is greater even if a fundamentally different invention is used as reference without careful consideration, a person skilled in the act could not combine the cited invention with the Cited Invention 2.

Allegations by Defendant

(A) ... As described above, it is natural that Citation 2 ... relates to general infection respiratory tract diseases in "the lower respiratory tract" and "the upper respiratory tract".

(B) Assuming that Citation 2 relates to diseases in the lower respiratory tract, the advantage that "a drug in a higher concentration can be delivered to an affected tissue with a total dosage administered to a patient that is less than that required for systemic administration, and thereby, known side effects caused by the drug, the dosage of which is higher, are avoided" is provided by the topical administration, and therefore, a person skilled in the art can necessarily understand that the advantage can be obtained by performing topical administration not only for diseases in "the lower respiratory tract" but also for diseases in the "the upper respiratory tract".

(C) Assuming so, a person skilled in the art who came upon Citation 2 could have easily conceived of an idea that topical nasal administration which is capable of delivering the drug to the infection site as a higher density and in a smaller total dosage as compared to oral administration, and therefore is helpful in avoiding side effects, is adopted instead of oral administration in the "cited invention" relating to treating the upper respiratory tract infection. Further, as described above, since an aerosol and nasal irrigation composition are well-known as a form of intranasal administration, it is not difficult to select a nasal irrigation composition as the embodiment of intranasal administration.

Judgment by the Court

B Erroneous finding of matters described in Citation 2

... Citation 2 discloses a method for treating diseases in which "the infection site" is limited to "the lower respiratory tract", and also discloses that ... direct administration of an anti-inflammatory agent and an anti-infectious agent to "the lower respiratory tract" being the infection site are a preferable embodiment of treatment.

In that case, ... relating to the described matter in Citation 2 of "In a preferred embodiment, the anti-inflammatory agent and the anti-infectious agent are administered directly into the lower respiratory tract of the host. The anti-inflammatory agent and/or the anti-infectious agent may be administered intranasally. The anti-inflammatory agent and/or the anti-infectious agent may be administered intranasally in the form of aerosol particles.", it is should be understood that the described matter of "may be administered intranasally." means administration into nose from each nostril being an entrance of passage, for directly administering aerosol particles of an anti-inflammatory agent and anti-infectious agent to "the lower respiratory tract" being the infection site, and it cannot be understood that the above described matter means administration of an anti-inflammatory agent and anti-infectious agent to nose, for treating nose, assuming that nose itself is the infection site.

Accordingly, the above finding of the appeal decision that "In Citation 2, it is described that an anti-infectious agent can be administered into nose being the infection site (summary point (G))." is erroneous.

...

As for the requirement for patentability provided in Article 29(2) of the Patent Act, it is required for the party who determines that the claimed invention is unpatentable ... to demonstrate the process of determination that the requirement is satisfied. Determination as to satisfaction of the requirement of patentability provided in Article 29(2), that is, a person skilled in the art would have been able to easily conceive of the claimed invention in the application based on the prior art, should be made on the basis of whether or not a person skilled in the art would have been able to easily arrive the characteristic features of the claimed invention in the application as compared to the prior art (the difference from the prior art in the constitution), starting from the standard of the prior art. In this respect, needless to say, it is necessary to identify the content of the prior art accurately. ... When determining whether or not a person skilled in the art could have easily conceived of the invention, in order to preclude, to the greatest possible extent, any postmortem, illogical or subjective determination, the party who makes a determination should be careful, in the process of identifying the "problem" targeted by the invention or the content of the prior art, to avoid taking into consideration, unconsciously, the "means for solving the problem" or "results of solution" provided by the invention.

(47)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3 (1)
Classification of the Case	47: Hindsight when determining on inventive step
Keyword	

1. Bibliographic Items

Case	"Device for material processing with laser." (Trial for Invalidation) Intellectual Property High Court Decision, October 12, 2011 (2010 (Gyo KE) No. 10282)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-500602 (JP H10-500903A)
Classification	B23K 26/36
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Yasushi SHOJI, Judge: Toshiya YAGUCHI

2. Overview of the Case

(1) Summary of Claimed Invention

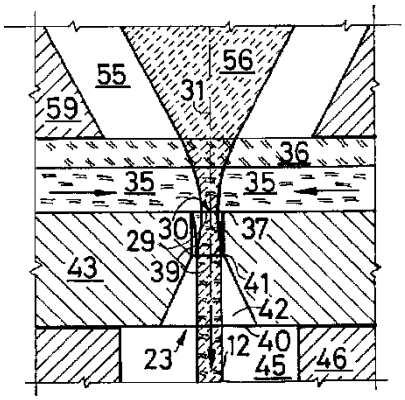


Fig. 3

The invention is a device designed for processing materials with a laser and with a processing module that forms a liquid-beam (12) and that combines a laser beam converged by focus unit with a liquid beam (12). Liquid type is selected so as to have adequate small beam absorption coefficient. In beam direction toward combined place, at possibly nearest of a focus cone (56) tip range, liquid velocity is beforehand given at high degree in a beam path so as not to cause formation of a heat lens in a liquid scope between a focus optical system and a focus. Namely a thermal lens leads part of a beam on a nozzle wall and damages it. Using an electrically insulated nozzle and liquid, and selecting high velocity rate to the extent that beam liquid charging is done, can make increase velocity of removal of material significantly.

(2) State of the Art

(i) Document of Exhibit A1 (Invention of Exhibit A1): EP No. 0515983 A1 (finding of trial decision)

"Material ablation methods with a converged laser beam comprising: a liquid beam (32) drawing a laser beam (10) being formed by a nozzle (20) and being directed to workpiece in need of processing;

chamber (30) being formed, allocated on top surface of the nozzle (20) and at upper side of the nozzle (20), and supplying liquid for formation of the liquid beam (32) below under-surface of a window (36) transparent to the laser beam (10);

the nozzle (20) having an inlet opening of a beam path of a nozzle, and for introducing a laser beam (10) to a liquid beam (32) acting as a laser beamguide, a laser beam (10) being converged in a place of an inlet opening of a beam path (44) of a nozzle (20), and quasi-stationary and quasi-steady state of pressurized liquid fluid being ensured in a chamber 30."
(Cited from the judgment)

(3) The Claims (Corrected) (claim 1 is only specified) (the corrected invention 1)
[Claim 1] Material processing methods with a converged laser beam comprising:

a liquid beam (12) drawing a laser beam (3) being formed by nozzle (43), and being directed to a workpiece (9) in need of processing;

a disk-shaped liquid supply space (35) being formed, allocated on top surface of the nozzle (43) and at upper side of the nozzle (43), and supplying liquid for formation of the liquid beam (12) below under-surface of a window (36) transparent to the laser beam (3);

the nozzle (43) having a nozzle inlet opening (30) of a beam path (23) of a nozzle, and for introducing a laser beam (3) to a liquid beam (12) acting as a laser beamguide, the laser beam (3) being converged in a place of the nozzle inlet opening (30) of the beam path (23) of a nozzle;

liquid supplied to the disk-shaped liquid supply space (35) being lead to flow from peripheral area to the nozzle inlet opening (30), inside the disk-shaped liquid supply space (35) where height of the window (36) from the nozzle (43) being set with no space of liquid dammed up around the nozzle inlet opening (30);

flow rate of liquid in focus cone tip range (56) of a laser beam being decided at sufficiently high degree by that means;

accordingly, in focus cone tip range (56), formation of a thermal lens being oppressed within a place of a part of laser beam not damaging a nozzle wall.

(4) Procedural History

May 22, 1995	:	International patent application by the plaintiff (patentee) (priority date: May 30, 1994 / Germany)
May 27, 2005	:	Patent registration
June 30, 2008	:	A request for a trial for patent invalidation by the defendant (Muko No. 2008-800124)
May 11, 2009	:	The first judgment of invalidating the patent
September 15, 2009	:	A suit against trial decision instituted by the plaintiff (2009 (Gyo KE) No. 10277)
December 11, 2009	:	A request for a trial for correction by the plaintiff (Teisei No. 2009-390151)

(See above "The Claims")

January 19, 2010 : The first decision to rescind trial decision
(This decision resulted in re-opening of examination of said trial for invalidation, and above request for trial for correction was regarded as a request for correction)

August 25, 2010 : The JPO decision of "Accept correction. ...Invalidate the patent. "

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

Appeal Decision (cited from the Court Decision)	
B ...the JPO determined ...Difference 1, 2 ...between the corrected invention 1 and Invention of Exhibit A1 are as follows. (d) Difference 2 "The difference exists in the following point. As to supplying liquid to liquid supply space, the corrected invention 1 is that comprising 'liquid supplied to the disk-shaped liquid supply space (35) being lead to flow from peripheral area to a nozzle inlet opening (30), inside the disk-shaped liquid supply space (35) where height of the window (36) from the nozzle (43) being set with no space of liquid dammed up around the nozzle inlet opening (30); flow rate of liquid in a focus cone tip range (56) of a laser beam being decided at sufficiently high degree by that means; accordingly, in a focus cone tip range(56), formation of a heat lens being oppressed within a place of a part of laser beam not damaging a nozzle wall,' while Invention of Exhibit A1 is that comprising a 'quasi-stationary and quasi-steady state of pressurized liquid fluid being ensured in a chamber 30' and it is uncertain about 'formation of a thermal lens being suppressed'." ...the JPO determined as follows: "Where a cause of inconvenience is ascertained, it is natural to remove said cause. A 'thermal lens' is formed as a result of a continuous supply of laser beam energy to liquid. Therefore, a person ordinarily skilled in the art can naturally arrive at the 'idea' of making liquid flow smoothly in the scope where a laser beam transmits, as a means of restraining the 'formation of a thermal lens.'"	
Decision	
Allegations by Plaintiff ...The JPO's logic, which considers Invention of Exhibit A1 as a main cited document, is that a person ordinarily skilled in the art can naturally arrive at the 'idea' of making liquid flow smoothly. However, Invention of Exhibit A1, which vows to put liquid in a "quasi-stationary state," or in other word, to "make liquid flow not smoothly," and the corrected invention 1, which makes liquid flow smoothly, differs originally in the technical idea. Therefore, the change in thinking is necessary for arriving at the idea of	Allegations by Defendant ...In Invention of Exhibit A1, since liquid flow in a state of layered jet goes out from an inflated chamber, there are always some sort of flow of liquid fluid in the inflated chamber in the liquid supply space. Thus, the difference between the Invention of Exhibit A1 and the corrected invention 1 concerning liquid flow in liquid supply space is only setting high or low flow velocity of liquid. Accordingly, in the Invention of Exhibit A1, in order to ensure that liquid flows smoothly, it is the best way to modify the degree of flow velocity of liquid

making liquid flow smoothly based on Invention of Exhibit A1, and it is essential to be motivated by suggestion of other cited documents, or the like. Consequently, the JPO's the logic determines, without such motivation, that the "idea" of making liquid flow smoothly can be naturally arrived at, and is a sort of afterthought and is erroneous.	which originally flows so as to make liquid flow quickly. Here, the change in thinking is not necessary. Therefore, above assertion of the plaintiff is groundless.

Judgement by the Court

...However, even if it is clarified that a "thermal lens" is formed as a result of a continuous supply of laser beam energy to liquid, means for solving the problem, that is, means for removing the cause, are not limited to one. There may be multiple means for solving the problem in cases where energy is supplied continuously, including "making liquid flow smoothly" and restraining energy absorption itself by using a combination of types of laser and liquid in which the energy absorption power is low.

Furthermore, in the present invention, Invention of Exhibit A1, which is the primary citation, is recognized as an invention which solves the prescribed problem by putting liquid in a "quasi-stationary state." Therefore, it must be said that the change in the way of thinking is necessary for arriving at the idea of "making liquid flow smoothly," which differs from the original idea of putting liquid in a "quasi-stationary state," based on Invention of Exhibit A1.

Consequently, the logic described above in the trial decision to the effect that the "idea" of making liquid flow smoothly can be naturally arrived at is a sort of afterthought and is erroneous.

(48)-1

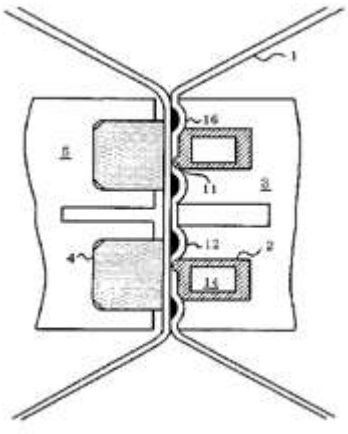
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(2)
Classification of the Case	48: After pointing out the relation of technical field and problems to be solved between Claimed Invention and main cited invention, to try for reasoning based on the main cited invention
Keyword	

1. Bibliographic Items

Case	"Heat-sealing apparatus" (appeal against an examiner's decision) Intellectual Property High Court Decision, Mar. 25, 2009 (2008 (Gyo KE) No. 10305)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-225547 (JP 2000-53110A)
Classification	B65B 51/10
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Toshiaki IIMURA, Judge: Noriaki SAIKI, Judge: Kazuhide SIMASUE

2. Overview of the Case

[Fig. 11]



(1) Summary of Claimed Invention

The claimed invention is of a heat-sealing apparatus that makes liquid and dirt having entered extremely small irregularities of a tube inner surface outflow outside a seal band area together with melting resin to achieve complete sealing properties, and, in addition, that can achieve heat sealing that is free from occurrence of cracks due to melting resin having outflowed into inside the container and that is superior in compression strength. In a heat-sealing apparatus in which an enveloping material 1 made up of a laminated body including a synthesis resin layer is made to be tubular, and the tubular enveloping material is heat-sealed below the liquid level in a transverse manner using a sealing jaw 3 including a high-frequency wave coil 2 having a projection thread 11 in a flat operating surface and an opposing jaw 5, a groove 16 capable of forming a synthesis resin pool adjacent to an external side of a seal band in the container inner surface side is provided in the operating surface of the high-frequency wave coil 2.

(2) State of the art

(i) Citation (cited invention): JP H8-230834A (finding of the appeal decision)

"A heat-sealing apparatus that makes an enveloping material 10 made up of a laminated body including a polyethylene resin layer 56 be a tubular enveloping material 11, and heat-seals the tubular enveloping material using a seal block 19 having an inductor 31 and a dolly 93 below the liquid level in a transverse manner, wherein a groove 75 capable of forming a synthesis resin pool is provided in an end outer than a convex portion 71 of a seal portion S on an operating surface of the seal block." (extracted from the decision)

(ii) Well-known example 1 (well-known art 1), well-known example 2 (well-known art 2): JP S55-104613 U, JP H54-088073 U (finding of the appeal decision)

"That, by constructing a groove, into which synthesis resin flows, sufficiently deep, a synthesis resin pool portion formed at a portion where the groove is provided is made to be a portion of non-adhesion that is not heat-sealed"

(3) The Claims (claimed invention)

[Claim 1] A heat-sealing apparatus in which an enveloping material made up of a laminated body including a synthesis resin layer is made to be tubular, and the tubular enveloping material is heat-sealed using a pair of openable pressure members having a heating mechanism below a liquid level in a transverse manner, wherein, on an operating surface of at least one of the pressure members, a groove capable of forming a synthesis resin pool is provided adjacent to an external side of a seal band in a container inner surface side.

(4) Procedural History

Aug. 10, 1998	:	Patent application (refer to the above-mentioned "The Claims")
Dec. 20, 2007	:	Decision of refusal
Jan. 18, 2008	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2008-1551)
Jul. 2, 2008	:	Appeal decision that said that "The present Request for appeals will not stand."

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

Appeal Decision
"It is found that a synthesis resin pool portion of the cited invention that is formed at a portion of an end of a seal band where a groove is provided includes foreign substances, and, thus, it does not contribute so much to sealing performance. In addition, as is stated in pp. 4-6 of the micro film of Japanese Utility Model Application No. S54-1227 (JP S55-104613 U [Decision Note: Exhibit A2]) or pp. 3-4 of the micro film of Japanese Utility Model Application No. S52-160306 (JP S54-88073 U [Decision Note: Exhibit A3]), for example, it is a well-known matter that, by constructing a groove into which synthesis resin flows sufficiently deep, a synthesis resin

pool portion formed at a portion where the groove is provided is made to be a portion of non-adhesion that is not heat-sealed. Therefore, it is also found that it could be achieved easily by a person skilled in the art to allocate, in the cited invention, a synthesis resin pool portion that does not contribute so much to sealing performance adjacent to an external side of a seal band as a portion not functioning as a seal band. In addition, it is found that it can be easily arrived at by a person skilled in the art that, by this, a thin synthesis resin layer having excellent sealing properties free from foreign substances is formed in a seal band, and a seal edge becomes straight and free from irregularities toward outside the seal band."(extracted from the decision)

Decision

Allegations by Plaintiff

The claimed invention is "an invention in which, by providing a groove capable of forming a synthesis resin pool adjacent to an external side of a seal band that is a heating region, even in a state performing heat-sealing by applying heat and pressure to a synthesis resin layer of an enveloping material with a pressure member of a heat-sealing apparatus, melting resin that flows into the synthesis resin pool is cooled at once, making it possible to form a resin pool that is free from irregularities and is of a uniform width certainly". On the other hand, the cited invention does not have such "groove" structure, and, thus, it is not an invention in which synthesis resin that has flowed into a groove forms a synthesis resin pool of a uniform width and a seal edge becomes straight and free from irregularities toward outside a seal band. Furthermore, it is different in a point that there is no description or suggestion about "that, in a seal band, a thin synthesis resin layer that has excellent sealing properties and is free from foreign substances is formed" and "that seal edge becomes straight and free from irregularities toward outside a seal band".

Accordingly, there is an error in the determination of appeal decision that said that "it could have been easily arrived at by a person skilled in the art from the cited invention that, in a seal band, a thin synthesis resin layer that has excellent sealing properties and is free from foreign substances is

Allegations by Defendant

...It can be an easily speculated matter for a person skilled in the art to make the depth and width of a groove in the cited invention be of a degree that all of or almost all of resin that flows in is stored, and if it is such groove, the groove is approximately the same as a groove stated in paragraph [0023] of the description of the present application, that is, a groove having "...a groove width and a groove depth ...that is set...such that the groove is filled with resin that outflows from a seal band ...and a synthesis resin pool is formed", and, therefore, the groove comes to sit outside the seal band in terms of the description of the present application, and it is a portion that does not function as a seal band.

In addition, in the cited invention, a groove 75 is at an end of a sealing portion S that corresponds to a high-frequency wave coil, and a portion of the high-frequency wave coil more inside than the groove is heated and compressed to be a seal band, and, therefore, the synthesis resin pool portion (retention portion) comes to be adjacent to the external side of the seal band.

formed, and a seal edge becomes straight and free from irregularities toward outside a seal band".	

Judgment by the Court

(1) About easiness in applying a well-known example to a cited invention

...It can be said that the technical significance of the constitution concerning the difference of the cited invention that "a groove capable of forming a synthesis resin pool is provided at an end of a seal band" is in a point that, in order to solve a problem that, due to melted synthesis resin inevitably flowing out excessively beyond the region of a sealing portion S, an amount of synthesis resin that contributes to heat-sealing becomes small in the sealing portion S to fail to obtain suitable joint strength, and, in addition, synthesis resin having flowed out from the sealing portion S is solidified to cause a crack in the inside of a packaging container sometimes, synthesis resin that is about to flow out beyond the region of the sealing portion S is made to be retained at an end within a sealing portion, and, by this, flow of synthesis resin is blocked so as not to flow out from the region of the sealing portion S, or flow out excessively. ..., It can be said that the constitution concerning the difference of the claimed invention that "a groove capable of forming a synthesis resin pool is provided adjacent to an external side of a seal band in the container inner surface side" exists in a point that, in order to solve a problem that, when washing away melted synthesis resin along with foreign substances from a seal band to the inside of the container so as to form a thin synthesis resin layer having excellent sealing properties, outflowing synthesis resin does not protrude uniformly and a wavy melting resin bead is formed in a fringe portion inside the container sometimes, synthesis resin having outflowed from the seal band is made to flow into a groove, and, by this, protrusion of synthesis resin to the inside of the container is regulated so as not to form wavy melting resin beads in a fringe portion inside the container.

C Consideration of easily-arrived property

The difference between the claimed invention and the cited invention exists in a point that, "in the claimed invention, a groove capable of forming a synthesis resin pool is provided adjacent to an external side of a seal band, whereas, in the cited invention, it is provided at an end of a seal band" (not contested). At first glance, the difference between the claimed invention and the cited invention gives the impression that the difference is only an installation location of "groove" that forms a synthesis resin pool and the difference in their constitution is extremely small.

However, as mentioned above, it should be said that there is a large difference in the to-be-solved problems and the means for solving the problems in a point that, according to the difference in an installation location of the "groove", the claimed invention provides means for solving the problem of avoiding formation of wavy melting resin beads inside the container by synthesis resin having outflowed from a seal band, whereas, the cited invention provides means for solving the problem of regulating protrusion of synthesis resin from a seal band to secure a resin quantity in the seal band.

Therefore, consideration will be made about whether the claimed invention could be easily arrived at by taking the cited invention as a starting point, and applying the well-known examples (Exhibits A2, A3).

The cited invention is an invention that makes "joint strength be maintained" by securing an amount of polyethylene resin that contributes to heat-sealing in a synthesis resin pool portion provided within a seal band , and, therefore, it cannot be said that it is easy to reach the constitution of the claimed invention indicating a to-be-solved problem and a means for solving the problem that are different from those of the cited invention, by simply pointing out the well-known examples (Exhibits A2, A3) that disclose that "a synthesis resin pool portion formed at a portion where a groove is provided is made to be a portion of non-adhesion that is not heat-sealed", and applying that well-known technology. The cited invention is a technology aimed at maintaining joint strength, whereas the well-known art is a technology that is not related to contributing to maintaining joint strength. Therefore, it cannot be determined that, by applying the well-known art to the cited invention that has a different to-be-solved problem from the claimed invention, a proof proposition that "it was easy to reach the constitution of the claimed invention" was able to be proved logically.

(2) Summary

As mentioned above, it should be said that there is an error in the determination of the appeal decision that said that, by applying the well-known example to the cited invention, the constitution concerning the different point of the claimed invention was able to be arrived at, that is, the decision that said "it is also found that it could be achieved easily by a person skilled in the art to arrange a synthesis resin pool portion that does not contribute so much to sealing performance in the cited invention as a portion that is adjacent to an external side of a seal band, and that does not function as a seal band.", without pausing to consider points other than that.

(48)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(2)
Classification of the Case	48: After pointing out the difference of technical field and problems to be solved between the claimed invention and the main cited invention, to try for reasoning based on the main cited invention
Keyword	

……

1. Bibliographic Items

Case	"Water treatment apparatus" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, March 17, 2011 (2010 (Gyo-KE) No. 10237)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2122, Page 118, HANREI TIMES No. 1383, Page 357
Application No.	Japanese Patent Application No. 2008-157503 (JP 2009-297679A)
Classification	C02F 1/78
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Yasuto INOUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention enhances the treatment capacity in a sewage treatment apparatus by increasing the contact area of sewage water with gas to increase the dissolving amount of gas such as ozone to the sewage water (water to be treated) in the sewage treatment apparatus using a pressure vessel under the problem of insufficient capacity for decomposition treatment of organic solvent such as trichlorethylene. The sewage treatment apparatus comprises an ozone generator coupled to a supply port of a pressure vessel through an ejector and a sprayer coupled to the supply port provided within the pressure vessel, thereby an inside of the pressure vessel is put under high pressure by mixing the ozone and the water to be treated with the ejector and spraying the water to be treated mixed with the gas ozone in the pressure vessel, and organic contamination is decomposed by increasing the contact area of the ozone with the water to be treated and dissolving the ozone into the water to be treated by spraying.

(2) State of the art

(i) Citation 1 (Cited Invention): JP 2001-198450A

"... (B) As a prior art, in the case of oxidative decomposition of an organic substance in a material to be reacted by hydrothermal reaction, the material to be reacted, water and oxidant are pressurized and supplied to the heated reactor to react them. In this case, if the material to be reacted contains an appropriate amount of water, the water does not need to be supplied. As a result of reaction, the organic substance is decomposed oxidatively, and a high temperature and high pressure fluid composed of water and carbon dioxide and a reacted product including a solid such as ash and salts in dry or slurry state are obtained ([0003]). In such hydrothermal reaction process, the material to be treated such as organic waste liquid to be decomposed is pressurized with a high pressure pump, and supplied to the reactor. The liquid to be treated is supplied at a constant flow rate and reacted hydrothermally to maintain the hydrothermal reaction in a steady state at the reactor. However, there is a problem in which it is difficult for reaction in the steady state due to that when the behavior in the material to be reacted is changed, the reaction state (combustion state) in the reactor is changed ([0004]).

(C) The cited invention has proposed the hydrothermal reactor capable of reacting by supplying the material to be reacted with substantially the same flow rate without stopping reaction, as well as returning easily to the steady state ([0006])." (cited from the Court Decision)

"(E) In the cited invention, the material to be reacted contains materials to be treated hydrothermally such as oxidative reaction and hydrolysis reaction in a supercritical or subcritical state of water. The material to be reacted such as excess mud from organic material and activated sludge in waste liquid from a factory, etc. is supplied to the reactor in a state in which it is mixed with oxidant, and reacted hydrothermally ([0009]). If the material to be reacted contains organic material and oxidant, they are supplied to the reactor separately or by mixture, and reacted hydrothermally. Such hydrothermal reaction system contains water in addition to the material to be reacted. Further, the hydrothermal reaction system may be added with catalyser and neutralizer, etc. as needed. They can also be supplied to the reactor separately or by mixture with the material to be reacted ([0010])." (cited from the Court Decision)

(3) The Claims (before Amendment) (Claimed invention)

[Claim 1] A water treatment apparatus comprising: a pressure vessel including a supply port for water to be treated provided on an upper part and a discharge port provided on an under part; a conduct line connected to the supply port of the pressure vessel and configured to supply the water to be treated; an ozone generator coupled to the conduct line; an ejector coupled to the ozone generator; and a sprayer coupled to the supply port provided within the pressure vessel.

(4) Procedural History

June 11, 2009	:	Amendment (Refer to the above "The Claims")
July 14, 2009	:	Decision of Refusal
October 28, 2009	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2009-20849), Amendment (The Amendment)

June 7, 2010 : Appeal Decision to Decline the amendment and "Dismiss the appeal"

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">(1) Grounds for the Appeal Decision is that ... the Amendment is declined, the subject matter of the present application is considered according to the claimed invention, and it can be easily invented by a person skilled in the art based on ... the cited invention, ... the invention disclosed in the Citation 2 and well-known example, etc., ... therefore, the claimed invention cannot be patented.
(2) The Appeal Decision recognized the commonalities between the claimed invention and the cited invention as below.
B Commonality: A water treatment apparatus comprising: a pressure vessel including a supply port for water to be treated provided on an upper part and a discharge port provided on an under part; a conduct line connected to the supply port of the pressure vessel and configured to supply the water to be treated; and a sprayer coupled to the supply port provided within the pressure vessel</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
A It is necessary not only to compare whether there are units constituting the apparatus and their arrangement but consider whether a chemical reaction mechanism progressing in the apparatus is identical in the similarity determination of the chemical reaction apparatuses. Appeal Decision is erroneous in determining the claimed invention and the cited invention relate to same techniques in that they relate to the pressure vessel without considering the chemical mechanism at all..
C The cited invention has the title of invention "hydrothermal reactor," and it is apparent that the cited invention utilizes the reaction utilizing hydrothermal properties.
D ... the claimed invention utilizes an ozone oxidation action and uses the pressure vessel to increase the dissolving amount of ozone by increasing the pressure of ozone, whereby the cited invention utilizes oxidation action and hydrolytic action of supercritical or subcritical water. It is apparent that the chemical reaction mechanisms for decomposing</td><td>Allegations by Defendant
A The cited invention is conceivable for a person skilled in the art based on matters mentioned in the Citation 1, and it is appropriate to recognize the cited invention within the scope required for comparing with the claimed invention.
... since the chemical apparatus is used under a variety of reaction condition in accordance with the usage, the difference in chemical reaction mechanism does not necessarily lead to the difference in chemical apparatus.
It is apparent that the hydrothermal reactor of the cited invention has a capability for decomposing organic material in the material to be treated, so the cited invention belongs to "treatment apparatus." Typically, a means for treating industrial wastewater from factory, etc. belongs to the technical field of "water treatment" (Exhibit B1). "The material to be reacted supplied to the reactor mixed with organic material in waste liquid from a factory, etc. and water" corresponds to the "water to be treated", and is supplied to decomposing treatment as water to be treated</td></tr>
</table>

organic material are different between them, thus both of inventions are different in the technical field. ... since the claimed invention and the cited invention are different in terms of chemical reaction mechanism for decomposing organic material, the Appeal Decision is erroneous in determining that both of the chemical apparatuses relate to same techniques. As a result, the Appeal Decision is erroneous in determining that the hydrothermal reaction apparatus of the cited invention and the water treatment apparatus of the claimed invention have the commonality as the "treatment apparatus."	containing organic material. Thus, the hydrothermal reactor of the cited invention belongs to the category of the water treatment apparatus. Therefore, the Appeal Decision is not erroneous in determining that the "hydrothermal reactor" of the cited invention and the "water treatment apparatus" of the claimed invention have the commonality as the "treatment apparatus" since "hydrothermal reactor" of the cited invention performs hydrothermal reaction.

Judgment by the Court

A The Appeal Decision recognized that the "hydrothermal reactor" of the cited invention and the "water treatment apparatus" of the claimed invention have the commonality as the "treatment apparatus" in that the "hydrothermal reactor" of the cited invention performs hydrothermal reaction, and determined that they have the commonality in terms of "treatment apparatus" without substantively comparing the prodessing details of each.

B The "water treatment apparatus" of the claimed invention relates to an apparatus for treating water to be treated, and water is the subject of beng treated ([0001] and [0006]), whereas the "hydrothermal reactor" of the cited invention relates to an apparatus for performing hydrothermal reaction, and water is a medium for producing a supercritical or a subcritical state of water to stimulate the oxidative decomposition of organic materials. Thus, it cannot be said that water itself is the subject of being treated ([0003] [0009] [0010]).

As such, it can be said that both of inventions are different in terms of a role of water, and they are also different in the technical field.

The technical meanings of "water treatment" and "hydrothermal reaction treatment" ..., it cannot be said that the "hydrothermal reaction treatment" of the cited invention belongs to "water treatment." Besides, since they are different in the technical field, it cannot be said that the cited invention is appropriate for citation.

...

2 Revocation reason 2 (Fallacy in recognition and determination of difference 2)

(1) Difference 2

The difference 2 is that the claimed invention is not specified as the "water treatment," whereas the cited invention is specified as the "hydrothermal treatment."

As stated in the (1), the cited invention is prerequisite for the hydrothermal reaction which oxidizing, etc. a material to be reacted. under the high temperature and high pressure water in the supercritical or subcritical state. Thus, it cannot be said that, based on the cited invention, a person skilled in the art could have easily arrived at the "water treatment apparatus" of the claimed invention in which a treatment is performed under

approximately 0.4 MPa pressure in the vessel, due to changing the prerequisite for the cited invention. In addition, the pressure resistant vessel of the cited invention which is prerequisite to be used under high temperature and high pressure is different from the pressure vessel of the claimed invention, thus, the claimed invention does not suggest that the vessel is used under the high temperature because of using ozone. Therefore, it could not have been easily arrived at the difference 2.

(2) Allegations by Defendant

A Defendant alleged that the conditions of temperature and pressure applying to the treatment apparatus of the cited invention is not limited to the range of the high temperature and high pressure such as the supercritical or subcritical state, rather these conditions encompasse the range beyond 100 degrees. In addition, Defendant alleged that since the claimed invention does not describe the matter for specifying the conditions of temperature and pressure, a person skilled in the art could have easily arrived at applying the treatment apparatus of the cited invention to the water treatment at the lower temperature and lower pressure than that in the hydrothermal reaction. Defendant submitted the Exhibits B4 to B6 in relation to the temperature and pressure range in the subcritical state.

However, the Exhibit B4 described that the water can reach over 100 degrees and the reaction speed can be increased considerably by using an autoclave which is a closed vessel used for hydrothermal treatment. But, it does not describe clearly how much temperature and pressure range the high temperature and high pressure aqueous system for decomposing and detoxifying harmful material refers to, and describes no specific relation with hydrothermal reaction. The Exhibit B5 illustrated that the hydrothermal reaction means the reaction in which the high temperature and high pressure are maintained under the water, and the condition range is specified between 0.1 MPa and 8.6 MPa, and between 100 degrees and 300 degrees, but it is the condition of hydrothermal reaction required for obtaining solubilizing treatment water. In addition, the Exhibit B5 illustrated that in the hydrothermal reaction with oxidant in relation to the cited invention, the pressurization over 4.0 MPa and the heating between 250 degrees and 600 degrees are illustrated ([0010] [0012]), and in the embodiment using microwave, the condition with 5.1 MPa and 265 degrees are illustrated ([0061] to [0063]). The Exhibit B6 only illustrated the temperature "between 121 degrees and 232 degrees (between 250 degrees and 450 degrees Fahrenheit)" as the subcritical temperature under the condition that thermal energy from hydrothermal reaction is used to adjust and pre-warm the supplied material, in the context that the supplied compound material is increased in temperature to the supercritical temperature using oxidative reaction by splaying oxidant at the critical pressure and subcritical temperature after pressurization to supercritical temperature, and it cannot be said to illustrate the temperature in which the hydrothermal reaction is performed at pressure of not more than critical pressure.

In defining a subcritical state, both of the conditions of temperature and pressure should be discussed. But, the logic of the Appeal decision is not appropriate in that the range in the subcritical state is recognized only from the condition of temperature.

The pressure resistant vessel of the cited invention having prerequisite for using under the condition of the high temperature and high pressure is different from the pressure vessel of the claimed invention in required

pressure resistance and thermal resistance, and size and shape in relation to the pressure resistance and thermal resistance. Thus, it cannot be said that the claimed invention could have been easily arrived at based on the cited invention which is prerequisite for hydrothermal treatment. Even if the difference in the role of water is not taken into consideration, it cannot be said that it is supposed the condition of the high temperature under which ozone is desorbed in the claimed invention, since the claimed invention dissolves ozone to water to be treated in the high concentration. Thus, the difference 2 could not have been easily arrived at.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(2)
Classification of the Case	48: After pointing out the difference of technical field and problems to be solved between claimed invention and main cited invention, to try for reasoning based on the main cited invention
Keyword	

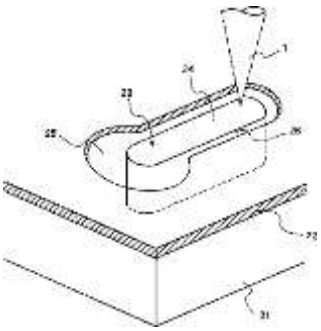
3. Bibliographic Items

Case	"Laser beam machining method" (Trial for Invalidation) Intellectual Property High Court Decision, July 31, 2013 (2012 (Gyo KE) No. 10305)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H10-127628 (JP H11-320142A)
Classification	B23K 26/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Ryuichi SHITARA, Judge: Rika NISHI, Judge: Masaya TANAKA

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 2]



The claimed invention removes only a covering material 22 of a hole-making start portion 23 in the removing process of the covering material 22 when machining with a laser beam 1 using assist gas, workpieces (22 and 21) provided with the covering material 22 on a surface for the purpose of preventing the protection effect by the covering material from reducing, and machining for a short time. At the hole-making start portion 23, more assist gas is supplied, but this configuration can prevent the covering material 22 from expanding and being detached at the hole-making start portion 23.

(2) State of the art

(i) Publication of Exhibit A1 (Invention of Exhibit A1): JP H7-241688A (Finding of Trial Decision)

"A laser beam machining method comprising: a process of printing a protective sheet 5 on a cut machining

surface route 102 under a machining condition different from that in a cut machining when machining a work 4 provided with the protective sheet 5 on the surface with a laser beam 100 using an assist gas 300; and a cut machining process of irradiating the laser beam 100 on the cut machining surface route 102 of the work 4 on which the protective sheet 5 is printed and machining the work 4, wherein the protective sheet 5 is printed on a printed surface 101 along the cut machining surface route 102 in the printing process." (cited from the Court Decision)

(ii) Well-known art (Publication of Exhibit A2, Publication of Exhibit A3)

"… the technique is recognized to be the well-known art in which, when machining a workpiece provided with a covering material on the surface with a laser beam, the workpiece is machined with a laser beam with high energy, after a covering material is removed preliminarily with a laser beam with low energy for preventing the covering material from being welded on the workpiece and carbonizing to be printed on the workpiece" (cited from the Court Decision)

(3) The Claims (Only Claim 3 is shown) (The present invention 1)

[Claim 3] A laser beam machining method for machining a workpiece provided with a covering material on the surface with a laser beam using an assist gas comprising: a first machining process of removing the covering material on a final machining track under a machining condition different from that in a final machining; and a second machining process of irradiating a laser beam on a predetermined track of the workpiece on which the covering material is removed, and machining the workpiece, wherein the covering material is removed in a range of a machining start portion and/or a machining end portion on the final machining track in the first machining process.

(4) Procedural History

January 16, 2004	:	Patent registration (see the aforementioned "The Claims")
February 15, 2012	:	Request for Trial for Patent Invalidation by Plaintiff (Muko No. 2012-800011)
July 19, 2012	:	Appeal Decision to "Dismiss the appeal"

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

Appeal Decision
Difference 1: The first machining process of the present invention 1 is the process of "removing" the covering material, whereas that of the Invention of Exhibit A1 is the process of "printing" the covering material. Since the "covering material" of the Invention of Exhibit A1 is "desirable to remain with being adhered until the final process of manufacturing a product" in order to protect the workpiece "weighted for appearance," the Invention of Exhibit A1 "purposes for "remaining the covering material" on the workpiece" … … the well-known art "removes the covering material on the final machining track" in order to "prevent the covering material from being welded on the workpiece" in the same technical field of the Invention of Exhibit A1 relating to the laser machining method. That is, such well-known art is inconsistent with "remaining" the covering material on the workpiece "with

being adhered" in order to "protect the workpiece," for which Invention of Exhibit A1 purposes.

The assertion of the requester cannot be adopted in asserting that "the Invention of Exhibit A1 is replaceable with the well-known art since it has the common problem to be solved for preventing the laser machining from being adversely affected" … because the problem be solved for "remaining the covering material" of the Invention of Exhibit A1 is inconsistent with the problem of "removing the covering material" of the well-known art.

Therefore, the difference 1 cannot be considered to be easy in which the process of "printing" of the Invention of Exhibit A1 is replaced with the process of "removing."

Decision

Allegations by Plaintiff	Allegations by Defendant
… the Invention of Exhibit A1 employs the process of "printing" protective sheet in order to prevent the protective sheet from being detached. The protective sheet is detached due to that the assist gas is flowed into between the protective sheet and the work. Thus, it is obvious that the process of "removing" the protective sheet in the area into which the assist gas is flowed can be replaced with the process of "printing" the protective sheet. … It can recognize, from the Publication of Exhibit A2 and the Publication of Exhibit A3, that the laser machining method is a well-known art including, when machining a workpiece provided with a covering material on the surface with a laser beam for the laser machining without detaching the covering material and damaging the workpiece, the first process of removing only the covering material using a laser with faint output, and the second process of cutting the workpiece on which the covering material is removed using a laser with strong output. The Invention of Exhibit A1 and the above well-known art belong to the same technical field in terms of the laser machining of the workpiece on which the covering material is covered. In addition, they have the common problem to be solved for the laser cut machining without detaching the covering material in the laser machining of the workpiece on which the covering material is	The evaluations are inconsistent for printing the protective sheet (protective material, covering) on the work (base material) between the Invention of Exhibit A1, and the Publication of Exhibit A2 and the Publication of Exhibit A3. That is, the Invention of Exhibit A1 purposes strongly for printing the protective sheet, whereas the inventions disclosed in the Publication of Exhibit A2 and the Publication of Exhibit A3 removes the protective sheet to prevent it. Therefore, there is no motivation to replace the process of printing of the Invention of Exhibit A1 with the process of removing disclosed in the Publication of Exhibit A2 and the Publication of Exhibit A3, and it has apparent hindrance.

covered. Thus, it would be only engineering expedient for a person skilled in the art to replace the process of “printing” the protective sheet with the process of “removing” the protective sheet in the area into which the assist gas is flowed in the Invention of Exhibit A1.	

Judgment by the Court

The present invention 1 and Invention of Exhibit A1 have a commonality in that they relate to a laser beam machining method for machining a workpiece provided with a covering material on the surface with a laser beam using an assist gas … In addition, the present invention 1 and the Invention of Exhibit A1 have a commonality in that they machines the covering material in a first process under a machining condition different from that in a final machining in order to prevent the covering material from being detached due to that the assist gas is flowed into between the workpiece and covering material during a laser machining ...

However, the present invention 1 and Invention of Exhibit A1 are different in that the former removes preliminarily the covering material, whereas the latter prints preliminarily a protecting sheet (covering material) on a work (workpiece) in order to prevent the protecting sheet from being detached. Publication of Exhibit A1 does not disclose or suggest that the protecting sheet is removed preliminarily. Thus, there is no motivation to remove preliminarily the protecting sheet in order to prevent the protecting sheet of Invention of Exhibit A1 from being detached.

...

It can recognize from the above statements of the Publication of Exhibit A2 and the Publication of Exhibit A3, that the technique is recognized to be a well-known art in which, when machining the workpiece provided with the covering material on the surface with a laser beam, the workpiece is machined using a laser beam with high energy after the covering material is removed preliminarily using a laser beam with low energy in order to prevent the covering material from being welded on the workpiece, and carbonizing to be printed on the workpiece.

However, the Invention of Exhibit A1 prints preliminarily the protective sheet on the work in order to prevent the protective sheet from being detached due to that the assist gas is flowed into between the work and the protective sheet, whereas the above well-known art removes the covering material in order to prevent the covering material from being welded on the workpiece, and not to prevent the covering material from being detached due to that the assist gas is flowed into between the work and the covering material. There is no description about assist gas in the Publication of Exhibit A2 and the Publication of Exhibit A3, and does not describe that the covering material is detached due to that the assist gas is flowed into between the work and the protective sheet. Thus, it cannot be said that there is motivation to replace the process of printing preliminarily the protective sheet on the work with the process of removing preliminarily protective sheet in the Invention of Exhibit A1, since the process of "removing the covering material" in the well-known art and the process of "printing the protective sheet on the work" in the Invention of Exhibit A1 are not replaceable each other.

C From the above, it cannot be said that it would have been conceivable for a person skilled in the art to replace the process of printing preliminarily the protective sheet on the work with the process of removing preliminarily the protective sheet in the Invention of Exhibit A1.

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2,3.3(2)
Classification of the Case	48: After pointing out the relation of technical field and problems to be solved between Claimed Invention and main cited invention, to try for reasoning based on the main cited invention
Keyword	

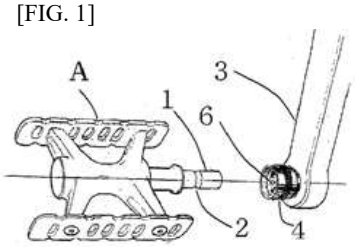
1. Bibliographic Items

Case	"A device for attaching pedal of bicycle" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, August 28, 2013 (2012 (Gyo KE) No.10448)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2006-232007 (JP2008-55935A)
Classification	B62M 3/08
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding Judge: Toshiaki IIMURA, Judge: Kimiko YAGI, Judge: Shinji ODA

2. Overview of the Case

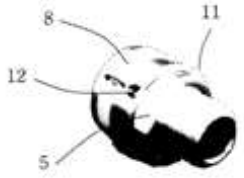
(1) Summary of Claimed Invention

[FIG. 1]



The invention is to obtain a freely-attachable device for attaching a pedal shaft eliminating a risk that a pedal comes off by accidental force. A device for attaching a pedal shaft of bicycle, comprising: combination of a receiving tool attached to an attaching hole of pedal shaft in a pedal crank and a pedal shaft equipped with a locking recessed part where a locking body is locked in an outer periphery; said receiving tool composed of a screw collar inserted by a pedal shaft and a locking body attached to a through-hole formed in a screw collar and a stopper collar that is attached to outside of the screw collar slidably and locks or releases said locking body in a pedal shaft; a spring being set between said screw collar and stopper collar; the lock of said locking body and locking recessed part being released, by matching the position of a protrusion in said screw collar and a groove set in a stopper collar and by sliding a stopper collar.

[FIG. 3]



(2) State of the art

(i) Exhibit A4 (First Citation) (Invention of Exhibit A4): JP2000-289680A (Finding of Appeal Decision)

"A device for attaching a pedal of bicycle, comprising: combination of a receiving tool attached to an attaching hole 5 of a pedal shaft 1 of a pedal crank 3 and a pedal shaft 1 equipped with a locking recessed part 2 where spherical locking body 4 is locked in outer periphery;

said receiving tool

composed of a screw collar 6 having an inner diameter equivalent to outer periphery of a pedal shaft 1, a locking body 4 attached to a through-hole 7 formed in said screw collar 6 and a cap 8 slidably attached to outside of said screw collar 6;

said cap 8 having a protruding stopper part 9 keeping in a locking state, a locking body 4 in a locking recessed part 2 of said pedal shaft 1, by pressing said locking body 4 toward center axis of a screw collar 6;

a spring 11 being set between said screw collar 6 and said cap 8;

a spring 11 being set, as accelerating said screw collar 6 and said cap 8; the lock of said locking body 4 and locking recessed part 2 being released by sliding a cap 8" (cited from the Court Decision)

(ii) Exhibit A5 (Second Citation) (Invention of Exhibit A5): the Microfilm of Japanese Utility Model Application No.S60-047930 (JP S61-164884U)

"The constitution as accelerating a pressing part of a lock ball with
a spring, for keeping a lock ball as locked in a connecting groove of a plug by pressing a lock ball"

(3) The Claims (Claimed Invention)

[Claim 1] A device for attaching a pedal of bicycle, comprising: combination of a receiving tool attached to an attaching hole of a pedal shaft of a pedal crank and a pedal shaft equipped with a locking recessed part where spherical locking body is locked in outer periphery;

said receiving tool

composed of a screw collar having an inner diameter equivalent to outer periphery of a pedal shaft, a locking body attached to a through-hole formed in said screw collar and a stopper collar slidably attached to outside of said screw collar;

said stopper collar having a protruding stopper part keeping in a locking state, a locking body in locking recessed part of said pedal shaft, by pressing said locking body toward center axis of a screw collar;

a spring being set between said screw collar and said stopper collar;

said spring being set as accelerating a screw collar and a stopper collar in farther or closer direction and as applying force in the rotating direction, between a screw collar and a stopper collar;

a protrusion being formed at the outside of said screw collar, and a groove in the direction of shaft being formed in a peripheral wall of a stopper collar for moving of said protrusion;

the position of said groove and said protrusion matched by rotating said stopper collar;

the lock of said locking body and locking recessed part being released by sliding a stopper collar

(4) Procedural History

August 29, 2006	:	Filing of Patent Application
July 11, 2011	:	Amendment of Proceeding (See above "The Claims")
January 18, 2012	:	Decision of Refusal
May 1, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2012-7987)
November 7, 2012	:	Appeal Decision that "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision</td></tr>
<tr><td colspan="2">The claimed invention and the cited invention are "a device for attaching a pedal of bicycle," and above 3.(1)(B) of conventional problems of [the problem to be solved] states that "if a locking screw between a pedal shaft and a crank is not tightly connected, it causes a pedal to come off in running." Accordingly, it is the problem to be naturally paid attention that a pedal shaft and a crank should be tightly connected in "a device for attaching a pedal of bicycle," and it is recognized that the cited invention suggests the tight connection.
In addition, both of "a receiving tool" of the claimed invention and "a receiving tool" of the cited invention serve as a connector for the cross-sectional circular object of connection, and the means of both inventions for locking and releasing are common with a "pipe connector" as disclosed in Second Citation.

Thus, a person skilled in the art could easily conceive of making of the constitution pertaining to above difference that "spring being set as accelerating a screw collar and a stopper collar in farther or closer direction and as applying force in the rotating direction, between a screw collar and a stopper collar; a protrusion being formed at the outside of said screw collar, and a groove in the direction of shaft being formed in a peripheral wall of a stopper collar for the moving of said protrusion; the position of said groove and said protrusion matched by rotating said stopper collar; the lock of said locking body and locking recessed part being released by sliding a stopper collar" by adopting the constitution as disclosed in Citation 2 in a means in the cited invention for locking and releasing a locking body and a locking recessed part.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
Since there is no motivation to combine the invention as stated in Exhibit A5 (hereinafter referred to as "the invention of Exhibit A5") with the invention of Exhibit A4, the appeal decision has errors in determination on easily conceiving.
(1) Technical Relevance
A device for attaching a pedal of bicycle as stated in the claimed invention is a device for attaching a</td><td>Allegations by Defendant
When comprehensively thinking in respect to the following points, the claimed invention can be easily conceived by combining the invention of Exhibit A5 with the invention of Exhibit A4.
(1) Technical Relevance
The invention of Exhibit A4 is that a pedal shaft is inserted in an attaching hole or a receiving part of a crank and is locked in a state as easily attachable, and</td></tr>
</table>

pedal to a crank of bicycle, and also for locking a receiving part in a cylindrical shape in a crank and for inserting and locking a pedal shaft in this locked receiving tool. On the other hand, "a pipe connector" of the invention of Exhibit A5 is a device for connecting a "pipe" with each other, and a device where a plug part formed in the edge of a pipe is inserted and locked in a large diameter part formed in the edge of "a socket" lying between two pipes. In this way, the claimed invention is a device for connecting "a crank" with "a pedal shaft," while the invention of Exhibit A5 is a device for connecting "a pipe" with "another pipe". Accordingly, both inventions are in common in terms of a device for inserting and locking one material to be connected in another material. However, it is merely the common point in view of generic concept. The "pipe" is vacant in the inner space, and comprises the use and function that liquid goes through the inner space, while there is no such use and function in a pedal shaft. In addition, a connecting part of "a pipe connector" constitutes a part of "socket" and "pipe" as necessary materials for connecting two pipes with each other, while "a receiving tool" in a device for attaching a pedal is specially added to a crank for constituting a connecting device. There is no technical relevance between the invention of Exhibit A4 on the premise of use in a dynamic state and the invention of Exhibit A5 on a premise of use in a static state. In this way, there is no concrete common point between both technologies, and thus it should be said that there is no technical relevance between the claimed invention and the invention of Exhibit A5. (2) Similarity in Problems It is practically natural that a pedal shaft and a crank are in a locked state so as not to come off in a	Exhibit A4 discloses a freely-attachable locking method as inserting one material in another material. The freely-attachable locking method as inserting one material in another material is well-known technology that is generally known as a locking method as using a "socket" and a "plug" and is applied in various use (Exhibit B1 or 5). Although it is a pipe connector, Exhibit A5 discloses a locking method as using a socket and a plug, that is, discloses the technology concerning a freely-attachable locking method as inserting one material in another material. In this way, the invention of Exhibit A4 and the invention of Exhibit A5 are common, in view of the locking method as using a socket and a plug, in other words, in view of the freely-attachable locking method as inserting one material in another material, and there is technical relevance between them. In addition, concerning the locking method as using a socket and a plug, there are various structures (Exhibit B1 or 5), and among them, the invention of Exhibit A4 and the invention of Exhibit A5 "serve as a connector of the object in a cross-sectional circular state and are also common in terms of a means for locking and releasing." As mentioned above, there is technical relevance among the claimed invention, the invention of Exhibit A4 and the invention of Exhibit A5. (2) Similarity in Problems The problem of the claimed invention is "to eliminate a risk that a pedal comes off by accidental force." Since "to eliminate a risk that a pedal comes off accidentally" is the general problem to be naturally required for a device for attaching a pedal of bicycle, there is similar problem in the invention of Exhibit A4. In addition, Exhibit A5 states, as the problem, the

regular use. The statement of Exhibit A4 that "non-tightly-locked state causes a pedal to come off in running" merely means above matter, and it cannot be read from the statement that further tightness and hardness of the separation are required. Accordingly, Exhibit A4 is not considered to disclose or suggest the problem as stated in the claimed invention. (3) Similarity in Action and Function There is difference in action and function between the claimed invention that a pedal shaft is connected with a receiving tool installed in a crank and the invention of Exhibit A5 that aims at the connection of each pipe. Thus, it cannot be said that both action and function are common. (4) Suggestion in the Content of Exhibit A4 Exhibit A4 does not state the suggestion of the necessity of further intensity and hardness of the separation, and also there is no technical relevance between the claimed invention and the invention of Exhibit A5, and there is no common point in terms of action and function. Certainly, the claimed invention is different from the invention of Exhibit A4, in that it satisfies more certainty and generates the effect of obtaining the appearance that it "seems to be safety" in comparison with the invention of Exhibit A4, but the invention of Exhibit A4 satisfies the prescribed "hardness of the separation". Therefore, there is no necessity of combining the invention of Exhibit A5 with the invention of Exhibit A4 for solving the problem.	prevention of the accidental separation of connected socket and plug (6th-12th row, page 2 of Exhibit A5). Concerning the locking method as using a socket and a plug, it is common that the invention of Exhibit A4 and the invention of Exhibit A5 have the problem of preventing a socket and a plug from being separated. the problem of the claimed invention as "eliminating a risk that a pedal comes off by accidental force" is the statement concerning a risk that a pedal (corresponding to a plug) is separated from a screw collar (corresponding to a socket) by accidental force, and thus the invention of Exhibit A4 and the invention of Exhibit A5 are common in terms of the problem to be solved. (3) Similarity of Action and Function Though the claimed invention, the invention of Exhibit A4 and the invention of Exhibit A5 are different in terms of the concrete object to be connected, each of them aims at making the object to be connected, easily attachable and serve as the connector of the object to be connected, and has common action and function with the others. (4) Suggestion in content of Exhibit A4 In order to solve the problem of accidental separation of a pedal shaft that is understood as the general problem in Exhibit A4, it is sufficiently prospected to adopt, as the object for obtaining tight connection, the constitution of Exhibit A5 that "serves as a connector of the object to be connected in a cross-sectional circular shape similarly as the invention of Exhibit A4 and has a common means for locking and releasing" and that has a means for eliminating a risk that a plug accidentally comes off from a socket.
Judgment by the Court The problem to be solved in the claimed invention is "to eliminate a risk that a pedal comes off by accidental force." On the other hand, Exhibit A4 states that, conventionally, a pedal of bicycle, where screws are equipped	

with a pedal shaft and a pedal crank, is locked by tightening both screws, and a pedal shaft gains the force in the direction of rotation in running a bicycle, and thus, if a locking screw in a pedal shaft and a crank are not tightly connected, it causes a pedal to come off in running, and accordingly, a person with the art of bicycle maintenance is only allowed to attach a pedal, but it has been requested that a purchaser in mail-order can attach a pedal, that in folding type bicycle, if the size at the time of folding is aimed to be minimalized, the protruding degree of a pedal is more lessen, that heavy-user can easily attach or detach a pedal, and the like ([0002], [0003]). Furthermore, the invention of Exhibit A4 states that "the invention is a device for attaching a pedal that does not require the art for attachment and can be easily attached. In addition, since a pedal and a crank are locked in the direction of a shaft, even if a pedal has relatively simple structure, there are few risks that a pedal comes off in running a bicycle "([0005]).

According to the above matters, it is understood that, in the invention of Exhibit A4, the problem to be solved is "to prevent accidental separation of a pedal shaft," and the claimed invention and the invention of Exhibit A4 are common in terms of the problem to be solved.

... Exhibit A5 indicates the problem to be solved as stated in the invention of Exhibit A4, that is, the problem to be solved that "with regard to the constitution as accelerating with a spring 11, a cap 8 keeping in a locking state, a locking body 4 in a locking recessed part 2 of a pedal shaft 1 by pressing said locking body 4, a cap 8 is prevented from sliding against the acceleration of a spring 11 when an operator does not intend to." The invention of Exhibit A4 and the invention of Exhibit A5 are common in that the problem to be solved is to prevent the separation of a socket and a plug in a locking method as using a socket and a plug.

In addition, Exhibit A5 indicates the constitution as "matching the position of a groove and a protrusion by rotation."

Therefore, it should be said that the constitution in the claimed invention pertaining to the difference from the invention of Exhibit A4 could be easily conceived by applying a means for solving the problem as stated in the invention of Exhibit A5.

(48)-5

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2, 3.3(2)
Classification of the Case	48: After pointing out the relation of technical field and problems to be solved between Claimed Invention and main cited invention, to try for reasoning based on the main cited invention
Keyword	

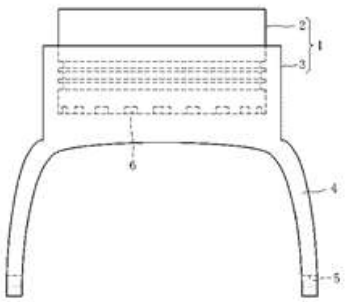
1. Bibliographic Items

Case	"A joint device"(Appeals against an Examiner's Decision) Intellectual Property High Court Decision, September 3, 2013 (2013 (Gyo KE) No.10034)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2009-184095 (JP2011-38553A)
Classification	F16D 1/06
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Syuhei SHIOMI, Judge: Yasushi NAKAMURA, Judge: Yuki NAKATAKE

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



The claimed invention is a joint device to tighten connection between a first joint member made by welding and a second joint member casting-in the first joint member, and to prevent deformation of first joint member and separation of second joint member. A joint device 1, comprising: a first joint member 2 in good weldability connected with an object to be connected by welding; a second joint member 3 made of iron cast formed integrally with the first joint member 2, by casting-in a portion of first joint member 2 in an exposed state, wherein the first joint member 2 is arranged with an interval in the circumferential direction of a side face embedded in the second joint member 3 and is equipped with a plurality of notches 6 extended from outer edge of side face to the center and having inner wall surfaces with an interval in the circumferential direction of side face, and an interval between inner wall surfaces is enlarged as closer to outer edge of side face.

(2) State of the art

(i) Publication 1 (Cited Invention): JP2001-099367A (Finding of Appeal Decision)

"A complex joint member connected with a pipe P, comprising:

a cylindrical part 20 in good weldability connected with said pipe P by welding;

a main body 1 made of iron cast formed integrally with said cylindrical part 20, by casting-in a portion of said cylindrical part 20 in an exposed state." (cited from the Court Decision)

(ii) Publication 2 (Invention of Publication 2): JP H9-168807A (Finding of Appeal Decision)

"A carbide ring (2), arranged with an interval from a side face embedded in insert metal (30) in the circumferential direction of side face, comprising corrugated faces (21) extended from outer edge of side face to the center and having inner wall surfaces with an interval in the circumferential direction of side face, and formed in a way that an interval between inner wall surfaces is enlarged as closer to outer edge of side face" is stated or suggested.

(3) The Claims (Claimed Invention)

[Claim 1] A joint device connected with an object to be connected, comprising:

a first joint member in good weldability connected with said object to be connected by welding and a second joint member made of iron cast formed integrally with said first joint member, by casting-in a portion of said first joint member in an exposed state;

said first joint member comprising, a plurality of notches arranged with an interval from a side face embedded in said second joint member in the circumferential direction of said side face and extended from an outer edge of said side face to the center and having inner surfaces formed as vertical to said side face and formed with an interval in the circumferential direction of said side face;

An interval between said inner wall surfaces being enlarged, as closer to an outer edge of side face.

(4) Procedural History

August 7, 2009	:	Filing of Patent Application
August 24, 2011	:	Amendment of Proceeding (See above "The Claims")
January 24, 2012	:	Decision of Refusal
April 26, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2012-7737)
December 25, 2012	:	Appeal Decision that "the request for appeal is dismissed."

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

Appeal Decision
... In a complex joint member of the cited invention, in order to tighten the integrity of a main body 1 and a cylindrical part 20 against the torsional force (torque), by applying the technical means as stated in Publication 2 and the conventionally well-known technical means to the side face of a cylindrical part 20, a person skilled

in the art can easily conceive, with no technical difficulty, of making the constitution of claimed invention pertaining to above difference, in a way that a joint member is arranged with an interval from a side face embedded in the main body 1 in the circumferential direction of a side face and comprises corrugated faces (notch part) extended from outer edge of side face to the center and formed as vertical to the side face and having inner wall surfaces with an interval in the circumferential direction of a side face, and an interval between inner wall surfaces is enlarged as closer to outer edge of side face, and there is no particular circumstances to hinder the conceiving.

Decision

Allegations by Plaintiff	Allegations by Defendant
... the technical field as disclosed in Publication 1 does not relate to the technical field where strong torsional force is always necessary to transmit a rotary drive torque such as a universal joint that the claimed invention assumes, and thus cannot disclose or suggest the problem to be solved that is common with the claimed invention. ... a complex roll (a rolling mill roll) as disclosed in Publication 2 entirely does not have the relevance of technical field and the similarity of problems, to a joint device of the claimed invention that is applied to the object (for example, a universal joint) to be connected on which strong torsional force (rotary drive torque) works. In addition, since the invention of Publication 2 binds both edge faces (both side faces) of carbide ring (2) by insert metal (30), it constitutes the technical idea that the idle is prevented by making the difference in height of corrugated face to be 1 mm or less. Accordingly, the invention of Publication 2 originally does not have the problem of itself that a first joint member comes off from a second joint member similarly as the claimed invention. Moreover, in case of a corrugated face where an inner wall surface is formed in a continuous waveform, similarly as Figure 6 of Publication 2, a torsional force is dispersed in the direction of shaft line of a first joint member, and as a result, the force works in such a direction that a first joint member and	Since the claimed invention widely assumes the joint device on which torsional force works, the invention of Publication 2 and the claimed invention are similar in terms of the technical problem as integrating two members in the rotating direction against torsional force that relatively works between two members. Accordingly, if the force works in a way that two members are separated (detached) from each other at the time when a torsional torque works, due to "a corrugated face where an inner wall surface is formed in a continuous waveform," as a solution, it is not difficult for a person skilled in the art to modify the design in consideration of the well-known technology as making the shape of corrugated face to be such an inner wall surface as vertical to a side face so that such force may not work, and if deliberating on the working force between both members, it is the matter as easily foreseeable by the person skilled in the art.

a second joint member are separated (detached) from each other, and a first joint member is separated due to an interval between inner wall surfaces (each contact surfaces). Thus, it is different from the constitution that is the problem to be solved in the claimed invention.	

Judgment by the Court

The cited invention has, ... the similar problem with the claimed invention in terms of further tightening the integrity of a first member and a second member.

However, as the defendant's assertion, the claimed invention is not limited to a universal joint, but describes "in cases where the member welded to a joint part gains torsional force or the like, there is a risk that a joint part comes off from the main body of a connecting part or a joint part deforms" (paragraph [0002] of Exhibit A3) and also describes the objectives that "even if torsional force or the like is applied, tightening the integrity of a welded first member and a second member casting-in said first joint member," "preventing a first joint member from the deformation and from the separation from a second joint member" ((paragraph [0004] of Exhibit A3), while Publication 1 pertaining to Cited Invention does not state above matters.

...

... as mentioned above, the invention of Publication 2 relates to a roll for rolling steel wire materials or bar materials, while the claimed invention and the cited invention relate to a joint device. Thus, there is difference in terms of the technical field. In addition, even if a carbide ring 2 as stated in the invention of Publication 2 can be said to be in a cylindrical shape, the arrangement structure of carbide ring 2 as stated in the invention of Publication 2 and the main body 1 of a roll (insert metal 30), to be different from the arrangement structure of a first joint member (cylindrical part 20) and a second joint member (main body 1) as stated in the claimed invention and the cited invention, a carbide ring 2 is entirely embedded in the main body of a roll, and thus it is the structure that a carbide ring 2 does not come off from the main body 1 of a roll. Therefore, the invention of Publication 2 is different in terms of the problem to be solved from the cited invention that the integrity of the main body and cylindrical part is required for the detachment prevention capable of locking the main body in case that tension or compression force works.

Therefore, even if the cited invention and the invention of Publication 2 are common in terms of the technology relating to complex parts that make multiple parts formed integrally by insert metal molding, it cannot be said that a person skilled in the art can easily conceive of applying the invention of Publication 2 to the cited invention.

(48-1)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 2 3.3(2)(Note 1)
Classification of the Case	48-1: Relation of problem to be solved between the main cited invention and sub sited invention, and relation of problem to be solved between Claimed Invention and the main cited invention
Keyword	

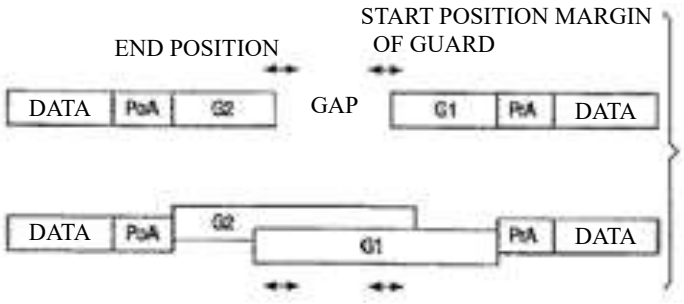
1. Bibliographic Items

Case	"A multi-layer record carrier, and producing method and recording method" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 23, 2012 (2011 (Gyo KE) No.10298)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2002-553766 (National Publication of International Patent Application No.2004-517425
Classification	G01B 7/007
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding Judge: Takaomi TAKIZAWA, Judge: Makiko TAKABE, Judge: Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 7]



The invention relates to a multi-layer record carrier and a method of producing the record carrier and a method of recording a data on the record carrier, and a data is written in a unit of data block on the track of at least two information layers. A first guard field is written at the first of data block, and a second guard field is written at the last of said data block. Power at light-concentrated spot on deepest information layer of said at least two information layers is substantially maintained at the optimum value, by setting the length of a first guard field and a second guard field so that the end position of the second guard field of previous data block is arranged within a region of the first guard field of subsequent data block. By above way, the gap portion between a first guard

field and a second guard field is prevented. Instead, the length of a first guard field and a second guard field is set equivalent to the sum (abbreviated) of the value of a half of the diameter of the record beam in the upper layer of at least two information layers when the lower layer of at least two information layers is focused and the value of a gap allowable at the maximum between two layers. By above way, when a user data is read out or recorded, the regions where the beam transmits in information layer have uniform characteristics. At least two information layers are arranged by measuring optimally and arranging the alignment mark such as header spoke at the predetermined measurement points.

(2) State of the art

(i) Citation (Cited Invention): JP H4-258852A (Finding of Appeal Decision)

"A method for recording and reproducing by a disk recording and reproducing device for recording in a magneto-optical disk as record medium in a unit of prescribed data quantity (for example, 32 sectors + a few sectors for linking) comprising: recording data being clustered in each of a certain number (32 items) of sectors; each 5 items of sector L1 to L5 for linking being arranged among these clusters and connected with next cluster; sector L1 to L5 for linking being, for example, assigned dummy data such as 0 and when one cluster, for example, cluster Ck in the number of k are recorded, not only 32 items of sectors of this cluster Ck but also each 3 of previous and after sectors for linking, that is, 3 items of sector L3 to L5 at the side of cluster Ck - 1 (run-in block) and 3 items of sector L1 to L3 at the side of cluster Ck + 1 (run-out block) in a unit of 38 sectors in total being required to be recorded; at that point, these 38 sectors of recording data being transmitted from a memory to an encoder; an interleave processing being made in this encoder; the distance of 108 frames at the maximum (corresponding to around 1.1. sectors) being sorted; when next cluster Ck + 1 is recorded, among 5 numbers of sector L1 to L5 for linking between cluster Ck, 3 items of sector L3 to L5 being used as ruin-in block; thus sector L3 being recorded in multiple times." (Cited from the Court Decision)

(ii) Well-Known Technology (Finding of Appeal Decision)

"In an optical disk (including a magneto-optical disk), for capacity enlargement, two parallel information layers are equipped (See, for example, paragraph [0001] to [0004] and figure 1 of Claim 4 of JP H9-282710A, paragraph [0001] to [0004] and figure 1 of JP2000-311384A, paragraph [0001] to [0007], [0071] and figure 4 of JP H9-198709A, [0003], [0018] and figure 1 of JP H9-63112A, paragraph [0035] and figure 6 of JP2000-57648A, especially, in JP H9-282710A, JP H9-63112A, JP H9-63112A, JP2000-57648A, a device for magneto-optical recording is stated.)"

(3) The Claims (Claimed Amended Invention)

[Claim 4] A method for recording data on a multi-layer record carrier that is equipped with at least two substantially-parallel information layers, comprising : a/) a first writing step for writing a data in a unit of data block on the track of said at least two information layers, /b) a second writing step for writing a first guard field including dummy data at start position of data block and writing a second guard field including dummy data at end position of data block, furthermore, /c) setting step for setting the length of said first guard field and said second guard field so that end

position of said second guard field of previous data block is set within a region of said first guard field of subsequent data block.

(4) Procedural History

December 7, 2001	:	Filing of Patent Application (the Date of Priority claim: December 22, 2000, March 9, 2001/Europe)
April 14, 2008	:	Decision of Refusal
July 22, 2008	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2008-18520)
August 21, 2008	:	Amendment of Proceeding (See above "The Claims")
May 9, 2011	:	Above Amendment of Proceeding is rejected, Appeal Decision that "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision</td></tr>
<tr><td colspan="2">Concerning a record medium of a disk recording and reproducing device, the problem as making a larger capacity generally exists.
In addition, with regard to a recording motion that an information layer ordinarily makes against one record medium, unless there is circumstance that requires to change the motion, it is natural that two information layers similarly make same recording motion.
Thus, concerning "a magneto-optical disk as a record medium" of cited invention, for capacity enlargement, by adopting the equipment of two parallel information layers of above well-known technology, a person skilled in the art can easily conceive of making a "multi-layer" record carrier that is equipped with "at least two substantially parallel" information layers of claimed amended invention.
On this occasion, it is natural that the recording of cited invention that "when one cluster, for example, cluster Ck in the number of k are recorded, not only 32 items of sectors of this cluster Ck but also each 3 of previous and after sectors for linking, that is, 3 items of sector L3 to L5 at the side of cluster Ck - 1 (run-in block) and 3 items of sector L1 to L3 at the side of cluster Ck + 1 (run-out block) in a unit of 38 sectors in total are required to be recorded" is made in two parallel information layers (corresponding to that a data is written in a unit of data block on the track of said "at least two" information layers of claimed amended invention).</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The claimed amended invention relates to a method of data recording in a multi-layer record carrier that is equipped with at least two substantially parallel information layers. If there is a gap between a guard field G2 and a guard field G1 that write dummy</td><td>Allegations by Defendant
Plaintiff asserts that there is no opportunity to apply the double-layered structure to cited invention.
However, with regard to the record medium of a disk recording and reproducing device, the problem as making a larger capacity generally exists, and cited</td></tr>
</table>

data in upper information layer, the light transmission rate of upper information layer may be different depending on the existence of the gap, and it adversely affects the writing of data in lower information layer. Thus, by making a guard field G2 and a guard field G1 duplicated and have uniform light transmission rate, the claimed amended invention prevents adverse effect to the writing of data in lower information layer. On the other hand, the invention as stated in Citation relates to a recording method on the disk with only one information layer, and thus the concept of multi-layer such as upper information layer and lower information layer does not exist. Accordingly, above problem of the claimed amended invention that is specific to the double-layered structure cannot be easily conceived from the invention as stated in Citation. In addition, there is no opportunity to apply the double-layered structure to the invention as stated in Citation. Therefore, the determination of appeal decision pertaining to Difference 1 and 2 is erroneous.	invention naturally includes such problem. In addition, in the field of optical recording and reproducing technology, for capacity enlargement, it is well-known that the record carrier is equipped with two parallel information layers, and it can be said that to make an information layers to be multi-layer was technical movement in this field. A person skilled in the art can easily conceive of the constitution of the claimed amended invention by the equipment of two parallel information layers as the well-known technology for capacity enlargement, according to technical movement, concerning such a recording method generally made against one information layer as cited invention.

Judgment by the Court

Plaintiff asserts that since the concept of multi-layer such as an upper information layer and a lower information layer does not exist in the cited invention, the problem of the claimed amended invention as preventing the adverse effect to the writing of a data in the lower information layer by making the uniform light transmission rate, that is specific to the double-layered structure, cannot be conceived form Cited Invention, and the like.

However, it is as stated in above (3) that, in Cited Invention, there is motivation to apply the well-known technology as stated in A to F of above (1). Moreover, since it is apparent that there is motivation to apply the above well-known technology to Cited Invention, a person skilled in the art can easily conceive of making the constitution of the Claimed Amended Invention pertaining to Difference 1, by applying the above well-known technology to Cited Invention. In addition, as mentioned in above (4), when making a multi-layer record carrier that is equipped with at least two substantially parallel information layers by applying the above well-known technology to Cited Invention, a person skilled in the art naturally makes the recording in each information layer by means of the recording method as stated in Cited Invention, and it is as deliberated in above 3 that, as a result, in each information layer where the recording is made by the recording method as stated in Cited Invention, dummy data assigned for the sector for linking are mutually duplicated in the linking sector L3 among clusters.

Accordingly, when making a multi-layer record carrier that is equipped with at least two substantially parallel information layers by applying above well-known technology to Cited Invention, in each information layer, the sector L3 for linking assigned dummy data among the clusters is recorded in multiple times, and there is no gap in each information layer. Thus, it is apparent from the constitution for a person skilled in the art that when the light which transmits an upper information layer of a multi-layer record carrier and which reaches a lower information layer is irradiated, the light transmission rate in the upper information layer is uniform.

Therefore, the Claimed Amended Invention has the problem that "by making the uniform light transmission rate, it prevents the adverse effect to the writing of a data in lower information layer," while even if Cited Invention does not have such problem, it is possible to arrive at same solution means (constitution) for the purpose of solving different technical problems, actually, when the constitution of the Claimed Amended Invention pertaining to Difference 1 is made by applying the above well-known technology to Cited Invention, there is no gap in each information layer. Thus, even if Cited Invention does not have multiple information layers, it is not considered that the constitution similar to the Claimed Amended Invention cannot be conceived, and plaintiff's assertion is unreasonable.

(Reference)

See Intellectual Property High Court Decision, October 4, 2006 (2005 (NE) No.10111), Intellectual Property High Court Decision, May 27, 2009 (2008 (Gyo KE) No.10413, 2009 (Gyo KE) No.10078)

(49)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3 (3)
Classification of the Case	49: Reasoning when applying well-known art
Keyword	

1. Bibliographic Items

Case	"Process and device for authentication" (Trial for Invalidation) Intellectual Property High Court Decision, February 27, 2007 (2006 (Gyo KE) No. 10203)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-133741 (JP 2001-319186A)
Classification	G06K 7/00
Conclusion	Partial Acceptance, Partial Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge Tomokazu TSUKAHARA, Judge Naoki ISHIHARA, Judge Teruhisa TAKANO

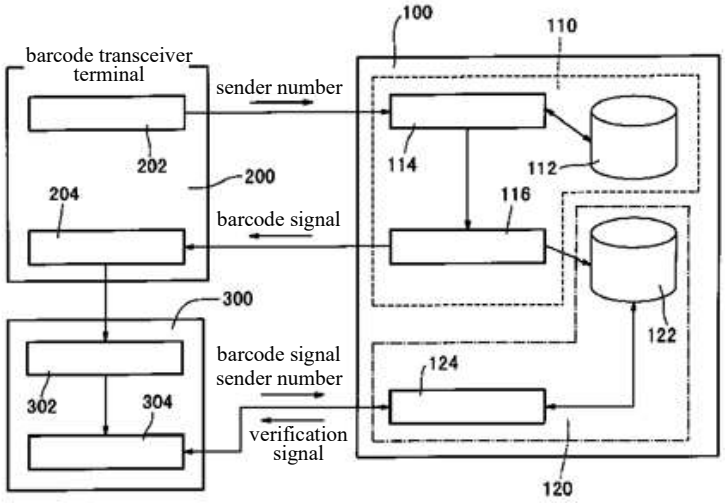
[FIG. 1]

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention provides an authentication method for authenticating a person's identity etc., in a quite different scheme from the conventional one.

The present invention generates a barcode for a customer registered in customer database 112, transmits the barcode to a sender number of the customer, and registers the barcode in a barcode database 122. In the time of authentication, the barcode transmitted from an identification requester is received, it is determined whether the received barcode matches the one recorded in the barcode database 122, and a verification signal is transmitted to the identification requester if matched.



100	identity verifying device	120	barcode discriminator
110	barcode assigning unit	122	barcode database
202	barcode request unit	124	barcode checking unit
204	barcode receive unit	302	barcode reader
112	customer database	304	barcode validation unit
114	barcode generator		
116	barcode transfer facility		

(2) State of the Art (Determination of the Trial Decision)

(i) Cited invention 2 (Invention of Exhibit A3): JP 2000-10927A

"An authentification method using a temporary password comprising:

an authentification device receiving a user PHS number from a user PHS terminal over a PHS public line;

the authentification device determining whether or not the user PHS number matches registered information;

the authentification device generating a temporary password when the user PHS number matches the registered information;

the authentification device notifying the temporary password to the user PHS terminal of the user PHS number over the PHS public line;

the authentification device being queried from a remote connection device that receives a temporary password and user ID presented by a user using a user PC;

the authentification device determining whether or not the temporary password and user ID are registered responsive to the query from the remote connection device;

the authentification device, if the temporary password and user ID are determined to be registered responsive to the query, notifying the determined results to the remote connection device" (Cited from the Court Decision)

(3) The Claims (After correction) (Claim 1 only) (Claimed Invention 1)

[Claim 1] An identity verifying method using a barcode displayed on a mobile phone, the identity verifying method

comprising: an identity verifying device receiving from a mobile phone of a party as a customer desiring identity verification a barcode request signal including a sender number of the party over a communication line; identity verifying device determining whether or not customer data of the party is registered in a customer database; the identity verifying device generating a barcode uniquely for the party when the customer data of the party is registered in the customer database; the identity verifying device transmitting the barcode to the mobile phone of the party's sender number over a communication line, and storing the barcode in a barcode database; the identity verifying device receiving a barcode displayed on the mobile phone and presented by the party, and read by a barcode reader of an identity verification requester requesting verification and transmitted from the identity verification requester over the communication line; the identity verifying device determining whether or not the received barcode matches a barcode registered in the barcode database; the identity verifying device, when the received barcode is registered in the barcode database, transmitting to the identity verification requester a signal indicating that the party's identity presented the barcode by the mobile phone is verified over the communication line.

(4) Procedural History

March 31, 2005	:	Filing of Request for Trial for Patent Invalidation by Defendant (Muko No. 2005-80099)
December 16, 2005	:	Filing of Request for Correction by Plaintiff (Patentee) (see the above "The Claims")
March 22, 2006	:	Trial Decision to Accept the correction and "Invalid the patent"

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

Appeal Decision (Cited from the Court Decision)
...It is different between the present invention 1 and the cited invention 2 as followings. (Difference 1) In the cited invention 2, a first authentification code is "temporary password", a second authentification code is "temporary password and user ID", and the second authentification code is input in a user PC and received by the remote connection device. On the other hand, in the present invention 1, both the first authentification code and second authentification code are "barcode", are displayed in the mobile phone, and are read by the barcode reader of the identity verification requester. With regard to the difference 1 "The temporary password" of the cited invention 2 is displayed as a character message on the user PHS terminal. Since Exhibit A4 discloses the code format such as character, symbol or barcode as identification information, it should be determined as appropriate what code is used as the first authentification code or second authentification code. Since Exhibit A2 discloses that one for displaying the barcode as the authentification code when using the mobile phone for authentification, it would have been obvious to use the barcode as the authentification code. Also, when using the barcode as the authentification code, using the barcode reader as the input device would

be only an inevitable result.

For example, JP H10-69553A (Exhibit A1), as disclosed in paragraph 0013, discloses that (A) the scheme in which the user uses an input device such as keyboard and OCR device for the character information printed in paper, (B) the scheme in which the user uses the barcode reader for the barcode printed in paper, and (C) the scheme in which the user uses an information reader such as media drive device for the information stored in the removal storage medium. Thus, it would have used inevitably the input device as appropriate depend on the display format of information to be input and information storing means.

Decision

Allegations by Plaintiff	Allegations by Defendant
...In the cited invention 2, "the temporary password" and user ID received from the identity verifying device are input by the party desiring identity verification (user) using the PC of the party. In the system of the cited invention 2, even if "the temporary password" is replaced with the barcode, it would not be different from using "the temporary password" in the security level as long as the barcode is read in the party's side. Thus in using the barcode, it is not advantageous and the additional cost is need for installing the barcode reader in the party's (user's) PC to read the barcode. Therefore, it is unimaginable for a person skilled in the art to replace "the temporary password and user ID" of the cited invention 2 with the barcode.	...Since the barcode has the advantage that it is undeciphered for human and easy to input (read) data compared to the character message, it should not be said that is not advantageous in using the barcode in light that the barcode has been widely prevalent at the time when the present Application was filed (May 2, 2000). Also, the installing cost for a barcode reader is not technical obstructive factor for combining the barcode with the cited invention 2, it is apparent to easily combine them from the technical point. Accordingly, the allegation by Plaintiff is not appropriate. Note that it would have been well-known art that the barcode was used for personal identification at the time when the present Application was filed.

Judgment by the Court

...Exhibit A1 discloses that ... (paragraph 0113) as determining in trial. From this disclosure of Exhibit A1, it could be recognized that the authentification code (user code information) has a wide variety of types, and the input means (input devices) are different depending on the types. Thus, it is apparent that a person skilled in the art determines what type of authentification code is selected by considering, such as the objective for using the code, advantages and disadvantages for using the respective code, and circumstances where the code is used (whether or not the inputter is identification requester or party desiring identity verification, input place is area dominated by the requester or area dominated by the party, and the requester and party are facing). It should not be said it is easy to apply the particular authentification code not considering the above, only based on that the code is well-known or publicly known.

The trial decision determined determines that "since Exhibit A2 disclosed one for displaying the barcode as the authentification code when using the mobile phone for authentification, it would have been easily use the barcode as the authentification code".

...There is no condition in the cited invention 2: the context in which using the barcode is rationalized as the authentification code in Exhibit A2, particularly the circumstances such as in the shop in which it is required to consider other customer's eyes; the advantage for preventing the fraud (the requester and party are facing in the area dominated by the requester, and the requester can input the authentification code using the device of the requester); and the disadvantage (the barcode reader does not have the general versatility) could be compensated by using the barcode reader for a number of customers. Therefore, it is erroneous that, not considering the above, it would have been obvious for a person skilled in the art to apply the barcode to the cited invention 2 as the authentification code by the reason that Exhibit A2 discloses one for displaying the barcode as the authentification code when using the mobile phone for authentification.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(3)
Classification of the Case	49: Reasoning when applying well-known art
Keyword	

1. Bibliographic Items

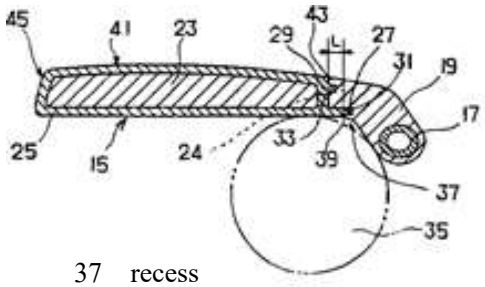
Case	"Golf club head" (Trial for Invalidation) Intellectual Property High Court Decision, May 22, 2007 (2006 (Gyo KE) No. 10342)
Source	Website of Intellectual Property High Court
Application No.	Japanese Utility Model Application No. H1-149965 (JP H3-88570U)
Classification	A63B 53/04
Conclusion	Acceptance
Related Provision	Utility Model Act 3(2)
Judges	IP High Court Fourth Division, Presiding judge Naoki ISHIHARA, Judge Yuji KOGA, Judge Hiroki MORISHITA

2. Overview of the Case

(1) Summary of Claimed Device

The present device is a golf club head comprising a face section 15 and a hosel section 19 formed with different members, a recess 37 with a larger curvature than an outside-diameter curvature of a golf ball 35 used is formed between the face section 15 and the hosel section 19, and a border line 39 of a connection section connecting the face section 15 and the hosel section 19 is positioned in the recess 37, thereby the golf ball 35 is prevented from being contacted with the border line 39 of the face section 15 and the hosel section 19.

[FIG. 2]



37 recess

35 golf ball

(2) State of the Art

(i) Exhibit A1 (Devices stated in Exhibit A1): JP S63-62303U (Determination of the Trial Decision)

"It could recognize that Exhibit A1 discloses a golf club head comprising a flange section 2 formed with a light metal such as aluminum and so on, and a hosel section formed with a molding non-iron metal with a larger

specific gravity than the light metal, a recess is formed between the flange section 2 and the flange section 2 side of the hosel section that is the opposite side of a shaft insert section of the hosel section, and a border line of a connection section of the flange section 2 and the hosel section is positioned in the recess". (Cited from the Court Decision)

(ii) Well-Known Art (Exhibit A4-1 to Exhibit A4-5 and Exhibit A10-1 to Exhibit A10-15)

"It is reasonable to recognize 'making the curvature of a recess between the face section and the hosel section of a golf club (iron) larger than the outside-diameter curvature of a golf ball used' as well-known art, which was commonly seen at the time of filing of the application for utility model registration in question" (Cited from the Court Decision)

Forming the recess between the face section and the hosel section is well-known art.

(3) The Claims (After correction) (The present device)

[Claim 1] A golf club head comprising at least a face section and a hosel section formed with different members, a recess with a larger curvature than an outside-diameter curvature of a golf ball used is formed between the face section and the face section side of the hosel section that is on the opposite side of a shaft insert section of the hosel section, and a border line of a connection section of the face section and the hosel section is positioned in the recess.

(4) Procedural History

August 12, 2005	:	Request for Trial for Utility Model Invalidation by Plaintiff (Muko No. 2005-80246)
November 8, 2005	:	Request for Correction by Defendant (Holder of Utility Model Right) (see the above "The Claims")
June 12, 2006	:	Trial Decision to "Accept the correction and Dismiss the trial"

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

Appeal Decision (Cited from the Court Decision)
(Differences) "In the present device, 'the recess with the larger curvature than the outside-diameter curvature of the golf ball used is formed between the face section and the face section side of the hosel section that is on the opposite side of the shaft insert section of the hosel section, and the border line of the connection section of the face section and the hosel section is positioned in the recess.' On the other hand, device stated in Exhibit A1 does not have the constitution in which the recess with the larger curvature than the outside-diameter curvature of the golf ball is formed." B Determination of the differences ...Exhibit A1 discloses the golf club head comprising the face section and the hosel section formed with different member. However, the device stated in Exhibit A1 just discloses ..., and does not provide the golf club head for ensuring the prevention for the golf ball from being contacted with the border line of the face section and the

hosel section as constituted in the present device.

Also, since Exhibit A1 does not disclose the drawings showing the relation between the recess and the ball, it could not be recognized to be disclosed that the recess with the larger curvature than the outside-diameter curvature of the golf ball used is formed between the face section and the face section side of the hosel section that is on the opposite side of the shaft insert section of the hosel section.

The requester of a trial submitted evidence Japanese Design Publication No. 440197, the similarity 1 of Japanese Design Publication No. 538764 and the similarity 1 of Japanese Design Publication No. 578068, and argued that "forming the recess with the larger curvature than the outside-diameter curvature of the golf ball used" is well-known on the grounds that these Design Gazettes disclose an angle of about 120 (120 degrees) between the face section and the face surface of the face section side of the hosel section. However these Design Gazettes does not disclose the premised constitution of the golf club head comprising the face section and the hosel section formed with different member, and the drawings showing the relation with the ball. Thus, rfrfvthese Design Gazettes could not be recognized to have the grounds for determining easiness of the constitution of the present device according to the differences based on the problem to ensure the prevention for the golf ball from being contacted with the border line of the face section and the hosel section.

Decision

Allegations by Plaintiff	Allegations by Defendant
...Since "forming the recess with the larger curvature than the outside-diameter curvature of the golf ball used" would be well-known art at the time of filing of the application for utility model registration in question, and it is apparent that the constitution of the present device according to the difference would have been easily conceivable by applying this well-known art to the device stated in Exhibit A1, the determination of the trial decision with regard to the above differences is erroneous.	...The allegations by Plaintiff would have no grounds that forming the recess with the larger curvature than the outside-diameter curvature of the golf ball used is common general technical knowledge and well-known art. ...Even if the technical matter was known that the recess with the larger curvature than the outside-diameter curvature of the golf ball used is formed between the face section and the face section side of the hosel section that is on the opposite side of the shaft insert section of the hosel section in the golf club, Exhibit A1 has no concept for ensuring the prevention for the golf ball from being contacted with the border line of the face section and the hosel section. Thus there is no motivation for combining the above technical matters with the device stated in Exhibit A1.

Judgment by the Court

...It could recognize that twenties kinds of golf clubs have the recess between the face section and the hosel section with the larger curvature than the outside-diameter curvature of the golf ball. If assuming that the recess between the face section and the hosel section according to the twenties kinds of golf clubs (iron) distributed by

the variety of makers has the larger curvature than the outside-diameter curvature of the golf ball, it is reasonable to recognize "making the curvature of a recess between the face section and the hosel section of the golf club (iron) larger than the outside-diameter curvature of the golf ball used" as well-known art, which was commonly seen at the time of filing the application for utility model registration in question.

...Since the above well-known art was commonly seen in the golf club (iron), and the obstructive factor could not be found for adopting the above well-known art with regard to the curvature of the recess between the face section and the hosel section in the device stated in Exhibit A1, it should be said that a person skilled in the art could attempt to apply the above well-known art to the device stated in Exhibit A1 as appropriate even without special motivation. Therefore, it should be said that it could be easily achived by a person skilled in the art to make the constitution of the present device according the differences by adopting the above well-known art with regard to the curvature of the recess between the face section and the hosel section in Exhibit A1 regardless of recognizing the problem to ensure the prevention for the golf ball from being contacted with the border line of the face section and the hosel section.

(49)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(3)
Classification of the Case	49: Reasoning when applying well-known art
Keyword	

1. Bibliographic Items

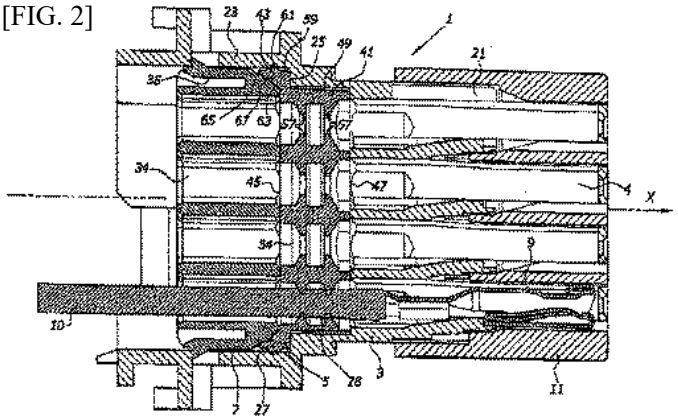
Case	"Grommet-type joint" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, December 11, 2012 (2011 (Gyo KE) No. 10443)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2008-505740 (National Publication of International Patent Application No. 2008-536276)
Classification	H01R 13/52
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge Toshifumi SHIBATA, Judge Takeshi OKAMOTO, Judge Eiko TAKEMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention provides the aforementioned-type of grommet-type joint improved for the electrical connector, a flange (43) of the joint axially projects rearwards from the rear side (45) of the plug member (41), the contact area of the flange with an inner surface (27) is at least partially offset with respect to the rear side (45) in the axial direction (X).

[FIG. 2]



(2) State of the Art

(i) Exhibit A1 (The cited invention): JP 2002-289292A (Determination of the Appeal Decision)

"A water-proof connecter for proofing water between an electric wire and a connector housing by arranging the water-proof plug in a water-proof plug storage chamber provided with the connector housing and by engagement between the connector housing and a rear holder to be attached the water-proof plug storage chamber

of the connector housing,

wherein the water-proof plug comprises integrated multiple first seal parts in the shape of a cylinder, a second seal part in the shape of a skirt and multiple electric wire pulling-out holes formed across rear ends of the first seal parts and a rear part of the second seal part in an axial direction of the electric wire, rib part being a skirt part of the second seal part projects outwards from part other than the rib part being rear part of the second seal part and frontwards from the first seal parts in the axial direction of the electric wire, the rib part of the second seal part is provided with lip part adhered and abutted to an inner wall of a rib storage groove, the projected rib part is partially offset with respect to the rear part of the second seal part in the axial direction,

wherein the connector housing comprises a rib storage groove 26 for storing the second seal part, and

wherein the rear holder comprises a electric wire pulling-out hole and a cylinder part, the electric wire pulling-out hole corresponds the electric wire pulling-out holes continuously in the axial direction of the electric wire, the cylinder part constitutes of a periphery adhering part and a pressure fitting part in a front end of the cylinder part, the peripheral adhering part provides water-proof function by being adhered and abutted to a peripheral lip parts of the first seal parts, the cylinder part provides water-proof function by adhering the front end of the rib part attached as a squeeze of the water-proof plug in a inserting direction of the rear holder, and the rib storage groove, by pressing force the second seal part into an inner wall of the rib storage groove." (Cited from the Court Decision, Reference numbers omitted)

(ii) Exhibit A2: JP S58-29576U (Determination of the Court Decision)

"It could recognize that Exhibit A2 discloses (1) the problem to be solved that an outer diameter of a water-proof plug body is changed due to insertion of an electric wire into an electric wire inserting hole d, that is, extension of the water-proof plug body outside in the diameter direction and decreasing of the adhesiveness of a seal part located outside in the diameter direction (between b and e), (2) the solutions that a circular groove is interposed between the electric wire inserting hole d and the seal part, (3) the working effect that change in shape of the water-proof plug body is covered by an inner space of the circular groove, and degradation of water-proof sealing effect is restrained" (Cited from the Court Decision)

(3) The Claims (Amended) (The present invention)

[Claim 1] An electrical connector comprising an insulating housing (3), a grommet-type joint (5) engaged (erroneously described in Japanese) with and arranged in the insulating housing (3), and grid (7), the grommet-type joint (5) comprises a plug member (41) and at least one peripheral flange (43), the plug member (41) has multiple passages (54) for a front side (47) and a rear side (45), and a wire, the passages extend from the rear side (45) to the front side (47) in an axial direction (X), the flange is provided to be sealingly engaged with a peripheral inner surface (27) of the connector housing (3), the flange (43) projects axially outwards from the plug member (41), and backwards from the rear side (45) of the plug member (41), a contact area of the inner surface (27) and the flange (43) is at least partially offset with respect to the rear side (45) in the axial direction (X), the grid (7) comprises axial passages (34) corresponding to the passages (54) of the grommet-type joint (5), the grid (7) is fixed in the insulating housing (3) in a predetermined position where the flange (43) is supported, whereby the flange (43) axially compressed in the insulating housing (3).

(4) Procedural History

April 11, 2005	:	Filing of International Patent Application
April 22, 2010	:	Decision of Refusal
August 31, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2010-19648)
June 14, 2011	:	Filing of Claim Amendment and Written Opinion (see the above "The Claims")
August 16, 2011	:	Appeal Decision to “Dismiss the appeal”

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

<table>
<tr><td colspan="2">Appeal Decision (Cited from the Court Decision)</td></tr>
<tr><td colspan="2">(1) The present invention would have been obvious for a person skilled in the art based on the invention described in JP 2002-289292A (Exhibit A1) distributed prior to the time when the present Application was filed (hereinafter "the cited invention") and the well-known matters. Therefore the present invention is unpatentable under Article 29(2).
(B) Difference 2
"In the present invention, the flange axially projects backwards from the rear side of the plug member, and the contact area of the inner surface and the flange is at least partially offset with respect to the rear side in the axial direction. On the other hand, in the cited invention, the flange axially projects frontwards from the front side of the plug member, and the contact area of the inner surface and the flange <u>is at least partially offset with respect to the front side in the axial direction. The above difference is the positions where the flanges are and the directions in which flanges project.</u>"
...the appeal decision recognized that it would be well-known matter that "the mutual impact is undesirable due to the adherence of a packing and an electric wire in a water-proof plug for connector and the adherence of the packing and a housing" citing Exhibit A2. Assuming the above, the appeal decision recognized that "the rib part 67 of the second seal part 62 is projected in departing direction from the first seal part 61, that is, projected backwards when arranging the rib part 67 of the second seal part 62 in the rear side of the first seal part 61 (Decision Notes: The underlined parts are hypothetical configurations 2)" ....</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
C It was indispensable technical element for the invention according to claim 1 of Exhibit A1 that the rib storage groove is provided with the housing, and it was indispensable technical element for the invention according to claim 2 of Exhibit A1 that the lip part is stored in the rib storage groove. By applying the configuration that the rib part 67 axially</td><td>Allegations by Defendant
B The second seal part 62 of the cited invention may be designed to be adhered to the inner 20a and a rear holder 70 and keep the airtightness as disclosed in paragraph 0022 of Exhibit A1. Thus, even if it was disclosed that the rib storage groove is recited in the claims of Exhibit A1 and the lip part is stored in the rib storage groove, the obviousness</td></tr>
</table>

projects backwards from the rear side of the first seal part 61 in the cited invention, the configuration would not be provided that the rib part 67 is stored in the rib storage groove 26. Therefore, there is no motivation to provide the configuration that the rib 67 projects backwards in Exhibit A1. D A person skilled in the art would not be easily-conceivable to exclude the water-proof function by the peripheral lip part 64 and the peripheral adhering part 75 based on the disclosure of Exhibit A1 considering that providing the water-proof function by the peripheral lip part 64 and the peripheral adhering part 75 of the water-proof plug 60 is the point of the cited invention. Also, as stated above, the hypothetical configuration itself would exclude the indispensable technical element of the cited invention that the second seal part 62 is arranged in the rear side of the first seal part 61 and the rib part 67 projects backwards as described above. Therefore, it would not be obvious for a person skilled in the art to provide the configuration that the rib part 67 projects frontwards.	according to the difference 2 should not be determined differently based on that. Also, since a person skilled in the art would inevitably understand the technical meaning that the second seal part 62 with being offset is provided in the cited invention, there is inevitably a motivation to provide the configuration that the rib 67 projects backwards. The rib storage groove would obtain a larger squeeze by adherence of the second seal part in the shape of a skirt with the rear holder 70, and it would be apparent that the rib storage groove may be sealed with the first seal parts in another position in the axial direction. Thus, the rib storage groove may be provided in not only the housing but also in the rear holder and so on. Therefore, it should not be said that the second seal part could not be provided with being offset backwards.

Judgment by the Court

...the problem to be solved of Exhibit A2 would be derived from that the electric wire inserting hole d into which the electric wire is inserted and the seal part between the taper surface e and the fitting wall b are facing inside and outside in the diameter direction. If both are not facing in the diameter direction, the impact would not reach the seal part due to change in the outer diameter of the water-proof plug body by the insertion of an electric wire, whereby the same problem would not occur. From the above, even when recognizing that it would be well-known matter that "the mutual impact is undesirable due to the adherence of the packing and the electric wire in the water-proof plug for connector and the adherence of the packing and the housing" citing Exhibit A2, the same would be applied to the configuration that the adherence part of the packing and the electric wire and the adherence part of the packing and the housing are facing in the diameter direction, but not be applied to the configuration that both are not facing in the diameter direction.

D Considering the adherence part of the packing and the electric wire and the adherence part of the packing and the housing in the cited invention, it could understand that both are not facing in the diameter direction, and are out of position in the axial direction ...in the configuration of embodiments in Exhibit A1

which the appeal decision regarded to be grounds in recognizing the cited invention. Therefore, the impact would not reach the seal part due to change in the outer diameter of the water-proof plug body by the insertion of an electric wire and the well-known matter recognized by the appeal decision would not be applied that "the mutual impact is undesirable due to the adherence of the packing and the electric wire in the water-proof plug for connector and the adherence of the packing and the housing" in the cited invention.

...The appeal decision only stated that "it would be well-known matter that the mutual impact is undesirable due to the adherence of the packing and the electric wire in the water-proof plug for connector and the adherence of the packing and the housing for example as disclosed in Exhibit A2 ..." ....But, the appeal decision stated no grounds that the well-known matter, differently from Exhibit A2, is applicable to the configuration in which the adherence parts of the packing and the housing are not facing in the diameter direction in the cited invention. Thus, the reasoning should be lacked that the direction in which the rib part projects dares to be changed from frontwards to backwards, that is the hypothetical configuration 2 is applied.

Therefore, the determination of the appeal decision should lack the reasoning to apply the hypothetical configuration 2 to the cited invention, and be erroneous.

(49-1)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(3)
Classification of the Case	49-1: Whether or not determination on inventive step is allowed after finding a well-known art covering multiple technical fields
Keyword	

1. Bibliographic Items

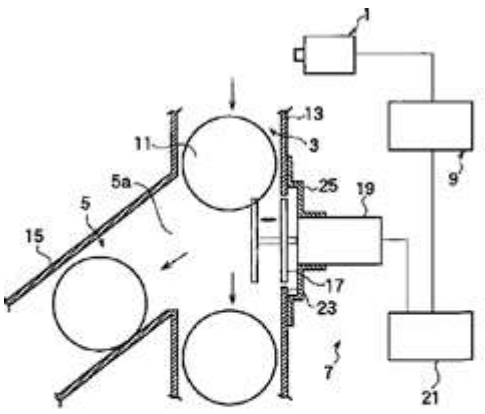
Case	"Discrimination target deflection apparatus" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, Jan. 31, 2007 (2005 (Gyo KE) No. 10523)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-34353 (JP 2001-222732A)
Classification	G07D 3/14
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division: Ryoichi MIMURA, presiding judge, Yuji KOSEKI, judge, Kazuhide SHIMASUE, judge

2. Overview of the Case

(1) Summary of Claimed Invention

In order to perform discrimination and sorting of a medal (coin) rapidly in amusement facilities and the like, the claimed invention comprises: a discrimination unit 1 continuously discriminating a continuously moving medal 11; a route 3 to make, after discrimination of the medal 11, the medal 11 move continuously according to discrimination speed of the discrimination unit 1; a deflection route 5 communicated with one side of the route 3; a deflection drive unit 7, provided in another side of the route 3 opposite the deflection route 5, to operate according to a discrimination signal of the discrimination unit 1 and flick the medal 11 moving on the route 3 toward the deflection route 5; and a control unit 9 to perform driving control of the deflection drive unit 7 according to the discrimination signal of the discrimination unit 1.

[FIG. 1]



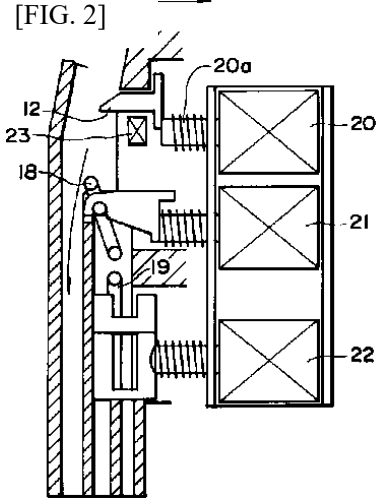
1 SENSOR
9 CONTROL CIRCUIT
19 SOLENOID
21 DRIVE CIRCUIT

(2) State of the Art

(i) The citation (the cited invention): JP H6-309543A (the finding of the appeal decision)

"A coin discrimination apparatus, comprising: a coin route having a slanted route bottom face provided in a lower side of a coin slot; a coin discrimination sensor, provided along the coin route, to determine true and false of a put-in coin; a true-coin gate, provided in a lower side of an end of the coin route, to sort a coin according to true and false of the coin; a false-coin route, provided in a lower side of the true-coin gate, being in communication with the coin route, and branching to one side of the coin route; and a CPU and the like deflecting a false-coin to the false-coin route, by making the true-coin gate protrude/sink in the coin route by turning a solenoid on/off based on a signal from the coin discrimination sensor.(cited from the Court Decision; Fig. 2 is extracted from JP H6-309543A)

[FIG. 2]



(ii) Well-known example: JP H9-108638A

"[Technical Field] The present invention relates to a grain sorting machine, and, in more detail, to a grain sorting machine to: image a grain or a grain group moving in a predetermined transfer path under irradiation light from a predetermined light source by a predetermined image taking means; based on a density value of a taken image and a predetermined standard density value, determine whether said grain is a defective product or not, or whether said grain group includes a defective product or not; and discriminate said grain or grain group based on said determination result...."

"[0027] In this way, a large density value change is caused only when a grain or a grain group (defective product) other than a selection target product is moving in a predetermined transfer path, and, therefore, it is possible to perform determination of a defective product easily by recognizing that large density value change." (Hereinbefore, extracted from JP H9-108638A)

(iii) Exhibit B3 evidence: JP S58-10882U

A sorting apparatus of eating utensils, having a transfer device on a conveyor, said transfer device being attached to a solenoid 5 for making a lever 6 swing, a lower end of the lever 6 being made to contact with an eating utensil on the conveyor.

(iv) Exhibit B4 evidence (JP H2-77610A)

An automatic object sorting apparatus used when performing automatic sorting of an article of an indeterminate form such as shellfish and various kinds of industrial products by sizes or colors, the automatic object sorting apparatus: sorting an object on a belt conveyor 5 by a color tone; and making the object be sprung out onto a classification belt 21 by a springing-out piece 20.

(v) Exhibit B5 evidence: JP S64-38316A

There are stated a sorting apparatus of a to-be-dispatched object, in which a dispatch destination sorting control device 3 to automatically sort the to-be-dispatched object to a dispatch destination corresponding to an identification code and the like of the to-be-dispatched object, and,
a driving mechanism to perform sorting of a to-be-dispatched object 1, upon receiving a signal from the dispatch destination sorting control device 3.

(3) The Claims (Amended) (only Claim 1 is stated) (the claimed invention)
[Claim 1] A discrimination target deflection apparatus, comprising:
a discrimination unit to continuously discriminate a discrimination target moving continuously; a route to make, after discrimination of said discrimination target, said discrimination target move continuously according to a discrimination speed of said discrimination unit; a deflection route communicated with one side of said route; a deflection drive unit, including a deflection plate provided in an aperture provided in other side of said route opposite said deflection route, to make said deflection plate protrude/sink in said route by high speed driving according to a discrimination signal of said discrimination unit, and flick a discrimination target moving in said route toward said deflection route; and a control unit to perform driving control of said deflection drive unit according to a discrimination signal of said discrimination unit.

(4) Procedural History

February 17, 2003	:	Amendment (refer to the above-mentioned "The Claims")
December 12, 2003	:	Decision of refusal
January 16, 2004	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2004-1301), amendment
May 9, 2005	:	The appeal decision that said the amendment on Jan. 16, 2004 is dismissed; and "the appeal in question will not stand."

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

Appeal Decision (cited from the Court Decision)
...Because the claimed invention could be invented by a person skilled in the art easily based on ..."the citation" ...and well-known technological means (for example, JP H9-108638A ..."referred to as the well-known example".), it cannot be granted a patent in accordance with the provisions of Patent Act Article 29(2). On the occasion of conducing to the above-mentioned conclusion, the difference between the claimed invention and the cited invention was found... as follows. (3) Difference (b) A point that, about making a discrimination target be deflected, whereas, in the former, a deflection plate is provided in an aperture opposite a deflection route, and a discrimination target is flicked toward a deflection route by the deflection plate, in the latter, a deflection route is provided in the lower side of the

aperture, and a discrimination target is deflected to the deflection route by a true-coin gate including an aperture.(Hereinafter, it is called "Difference 2" as with the appeal decision.)

Decision

Allegations by Plaintiff

(2) Because the cited invention relates to a "coin discrimination apparatus", and the technology of the well-known example relates to a "grain sorting machine", the technologies of the cited invention and the well-known example have different technical fields. In addition, whereas the cited invention is an invention to sort a coin that is a discrimination target by switching static states of a protrusion state and a sunk state of the true-coin gate 12, and thus it does not convert motional energy of protrusion/sinking into collision energy of flicking, the technology of the well-known example has a constitution to transmit motional energy of protrusion of a solenoid plunger 52 to a plate spring 48 as collision energy, and give collision energy to a re-selection target grain via the plate spring 48 moved by collision energy to flick it (paragraph [0027] of the well-known example), and thus the technical significance of "protrusion/sinking" is completely different, and it is not possible to combine the technology of the well-known example to the cited invention.

(3) Although the technology of the well-known example does not have a problem if it is for a lightweight discrimination target such as a grain, when flicking a coin (the citation) which is heavier than a grain by high speed driving, there is a risk of causing conflicting movement between the plate spring and the plunger by elasticity and inertia of the plate spring itself. On the one hand, when increasing a spring constant of the plate spring in order to suppress this conflicting movement, there is a risk that high speed driving becomes impossible, and,

Allegations by Defendant

Although, it is true that the cited invention is of a "coin discrimination apparatus" and the one illustrated as a well-known example is of a "grain sorting machine," to make a discrimination target move to a deflection route by directly pressing it is a matter performed in various sorts of fields, as shown in JP S58-10882U...(Exhibit B3), JP H2-77610A (Exhibit B4), and JP S64-38316A (Exhibit B5). When taking into consideration that the technical means of "pressing a discrimination target" is being carried out irrespective of the weight of a discrimination target, a matter that there is a difference between the technical fields of the citation and the well-known example, and a matter that there is a difference in weight of discrimination targets are not obstructive events on the occasion of applying the technical means of "flicking a discrimination target" of the well-known example to the citation. In addition, when weights of discrimination targets is different, to what degree a flicking force (the strength of a plate spring) and the like should be made is a design matter of a person skilled in the art, and it is not found that there is a special difficulty in designing this....

(3) Because, in the claimed invention, there is no limitation that a discrimination target is a "weighty object" such as a medal, and the only limitation is to flick a discrimination target by a deflection plate, a working-effect can be estimated within that limit, and the weight of a discrimination target that is not limited in the claims at all does not have an influence on judgment of a working-effect. There is also no reason in the affirmation of the plaintiff and the like

therefore, there is an obstructive event in applying the technology of the well-known example to the citation. The technology of the well-known example is unsuitable for discriminating a weighty discrimination target such as a medal by high speed driving, and it cannot adopt a constitution to make a deflection route and aperture (deflection plate) be opposite each other, and flick a discrimination target by the deflection plate toward the deflection route.	related to a working-effect, and, thus, there is no fault in the determination of the appeal decision.

Judgment by the Court

Although there is an error in part of the finding about the cited invention, there is no fault in the finding of "a false-coin route, communicated with a coin route, and branching to one side of the coin route is provided", and, therefore, there is no fault in having made, based on this finding, the finding about point of Difference 2.

(2) The plaintiffs make affirmation that (a) because the technologies of the cited invention and the well-known example are of different technical fields, and, technical significance of "protrusion/sinking" differs absolutely, the technology of the well-known example cannot be combined to the cited invention, (b) in the well-known technical means, when flicking a coin of the citation which is heavier than a grain by high speed driving, there is a risk of causing conflicting movement between the plate spring and the plunger by elasticity and inertia of the plate spring itself, and, further, when increasing a spring constant of the plate spring in order to suppress this conflicting movement, there is a risk that high speed driving becomes impossible, and, therefore, there is an obstructive event in applying the well-known example to the citation.

However, in the claims, there is no statement limiting that a discrimination target of the claimed invention is a medal, or a statement suggesting that a discrimination target is heavy, and, further, it does not impose some sort of limiting conditions on a deflection plate and the like for a reason of heavy discrimination targets, and, therefore, affirmation of the plaintiff and the like related to weight of a discrimination target is not based on the statement of the claims.

Although the cited invention is of a "coin discrimination apparatus", and the one illustrated as the well-known example is a "grain sorting machine," it is found that moving a discrimination target to a deflection route by directly pressing it is being performed in various sorts of fields, according to evidence from Exhibit B3 to Exhibit B5. Also, when taking into consideration that a technical means of "pressing a discrimination target" is carried out irrespective of the weight of a discrimination target, a matter that the technical fields of the citation and the well-known example differ, and a matter that there is a difference in weight of discrimination targets are not obstructive events on the occasion that the technical means of "flicking a discrimination target" in the well-known example is applied to the citation. Furthermore, to make a flicking force (strength of a plate spring) and the like be a force appropriate for a weight when weights of discrimination

targets is different is a design matter of a person skilled in the art, and, thus, it is not found that there is a special difficulty. Accordingly, the above-mentioned affirmation of the plaintiffs cannot be adopted.

(50)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(6)
Classification of the Case	50: In determining on inventive step, to take into consideration condition such as commercial success or desired for since long ago
Keyword	

1. Bibliographic Items

Case	"Heat insulating cooking utensil" (Trial for Invalidation) Intellectual Property High Court Decision, September 27, 2007 (2007 (Gyo KE) No. 10146)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H5-49648 (JP H6-86732A)
Classification	A47J 27/00
Conclusion	Dismissal
Related Provision	Article 29(2) and Article 123(1)(ii)
Judges	IP High Court Second Division, Presiding judge: Tetsuhiro NAKANO, Judge: Yoshiyuki MORI, Judge: Katsuumi SHIBUYA

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention relates to a heat insulating cooking utensil comprising a heat insulating pot with a stainless vacuum double bottle and an internal vessel (cooking pot) contained in the heat insulating pot, by which cooking is possible without further heating. The present invention is characterized in that a handle provided in the internal vessel extends outside an outer vessel through a notch of the outer vessel, thereby the handle is not heated even after the cooking, the utensil can be carried easily, and heat is retained.

(2) The Claims (After correction) (The present corrected invention)

[Claim 1] A heat insulating cooking utensil comprising an outer vessel with a vacuum heat insulating structure and an inner vessel contained removably in the outer vessel, wherein a heat insulating lid member is arranged in a mouth opening of the outer vessel, a handle part is provided in the inner vessel, and an end of the handle part is inserted between a notch of the heat insulating lid member and the outer vessel to extend outside the outer vessel.

(3) Procedural History

April 11, 1989 : Filing of Utility Model Application by Non-Party Company (Japanese Utility

		Model Application No. H1-42088)
March 10, 1993	:	Filing of Converted Application into Patent by Non-Party Company
March 13, 1996	:	Registration of Establishment of Patent Right
October 19, 2004	:	Registration of Transfer of Patent Right (Transferred from Non-Party Company to Plaintiff (Patentee))
September 20, 2006	:	Filing of Request for Trial for Patent Invalidation by Defendant (Muko No. 2006-80186)
December 11, 2006	:	Filing of Request for Correction by Plaintiff (see the above "The Claims")
March 27, 2007	:	Trial Decision to Accept the correction and ... "Invalid the patent"

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

<table>
<tr><td colspan="2">Appeal Decision (Cited from the Court Decision)</td></tr>
<tr><td colspan="2">(I) The trial decision ... "commercial successes derived from the present corrected invention is considered to be derived from a large number of relevant patents other than the present patent in addition to the present patent and marketing strategy."</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
... ten percent differences in performance of products are considerable in business activity. Thus, it should be said that the trial decision is irrelevant to assessing inventive step in determining that "it could not be directly said that heat insulating performance is lowered beyond cooking.". Also, the trial decision is illegal in that the actual condition of business activity is taken no notice that several percent differences in performance impact considerably on product competitiveness and govern volume of sales.
... even if there is patents other than the present patent, it could not deny the fact that the present corrected invention contributed considerably to commercial successes of said product based on the above. Seeing the time-series of the present patent, the present application was filed at the beginning of the product development, and the present patent is, although the structure is simple, regarded as a basic invention for said product. The product and sales performance beyond three million for several ten</td><td>Allegations by Defendant
H Commercial successes do not depend on only the excellence of patent products as well as are achieved by the combination of a variety of non-technical factors such as consumer demand matched with the times. Thus, it is generally inappropriate to regard commercial successes as the grounds for the prominence of the working effects (the grounds for inventive step of inventions). The plaintiff alleged the sales performance of the plaintiff's products. However, such products have been protected by a large number of patents, and sold exclusively for a long term under the condition that no competing product. Thus, the sales performance should not be regarded as the grounds for the prominence of the working effects of the present corrected invention.</td></tr>
</table>

years from sales release should be based on the presence of the present corrected invention. It should be allowed in assessing inventive step by analyzing commercial successes based on the specific circumstances.	

Judgement by the Court

... the plaintiff alleges that the actual condition of business activity should be taken notice that several percent differences in performance impact considerably on product competitiveness and govern volume of sales. However, a person skilled in the art would easily predict that adopting the structure to provide the notch in the heat insulating lid member for closing the opening of the outer vessel and put the handle part of the inner vessel outside the outer vessel from the notch results in retaining considerable heat insulating performance. It could not recognize the specific grounds for predicting to produce the differences in performance that impact considerably on product competitiveness. Thus, the allegation by the plaintiff of the actual condition of business activity should not have the grounds for positive inventive step of the present corrected invention.

Moreover, the plaintiff also alleges the commercial success of the products according to the present corrected invention. However, commercial successes should be caused by a variety of factors such as relevant patents other than the present patent, advertising or sales abilities. Thus, even if the product according to the present corrected invention is commercially successful, it could not derive directly the condition for positive inventive step from that success.

(50)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 2, 3.3(6)
Classification of the Case	50: In determining on inventive step, to take into consideration condition such as commercial success or desired for since long ago
Keyword	

1. Bibliographic Items

Case	"Omnidirectional tilt and vibration sensor" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, March 26, 2014 (2013 (Gyo KE) No. 10176)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-551464 (JP 2008-532208A)
Classification	H01H 35/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding judge: Takashi SHIMIZU, Judge: Akira IKESHITA, Judge: Takaaki SHINTANI

2. Overview of the Case

(1) Summary of Claimed Invention

"... It could recognize the followings. The present invention is generally related to sensors, and more particularly is related to an omnidirectional tilt and vibration sensor (paragraph 0002). Conventionally, tilt switches having a single metallic ball are used to switch electrical circuits ON and OFF depending on an angle of inclination of the tilt switch (paragraphs 0003 and 0004). Such tilt switch generally is not useful in detecting minimal motion (paragraph 0005). Also, existing vibration sensor has the problem that the many portions of the vibration sensor result in more time required for assembly, in addition to higher cost (paragraphs 0006 to 0008). For the purpose of solving the problem, the sensors according to the present invention comprise a first electrically conductive element, a second electrically conductive element, an electrically insulative element, and a plurality of electrically conductive weights located within a cavity of the sensor, the first electrically conductive element and the second electrically conductive element with predetermined dimensions are fitted in the electrically insulative element." (Cited from the Court Decision)

(2) State of the Art

(i) Citation 1 (Exhibit A1): JP 2003-161653A

"... It could recognize the followings. The cited invention is generally related to vibration sensors (paragraph 0001). Conventionally, vibration sensors have the problem that the many portions required for the structure require a wide variety of assembly process, thereby more time and works are required for assembly and manufacture, and reducing the cost is difficult as well as promoting the downsized electronic devices is difficult in response to recently-downsizing of a wide variety of electronic devices as devices to be used due to the complex structure (paragraph 0003). For the purpose of solving the problem, the vibration sensors comprise two electrode members, each having has the same structure simplified as electrode member, and one forming insulator or non-electrically conductive cylindrical body as single attaching means for these electrode members. The sensors require only the sum of three portions to constitute a sensor body, thereby attaching electrode members having the majority of assembly process is considerably facilitated and the entirety is drastically downsized with very simple and robust structure (paragraph 0004)." (Cited from the Court Decision)

(3) The Claims (No change before and after filing the written amendment described below) (the present invention)
[Claim 1] A sensor, comprising: a first electrically conductive element; a second electrically conductive element; an electrically insulative element connected to the first electrically conductive element and the second electrically conductive element; and a plurality of electrically conductive weights located within a cavity of the sensor, wherein the cavity is defined by at least one surface of the first electrically conductive element, at least one surface of the electrically insulative element, and at least one surface of the second electrically conductive element, the first electrically conductive element further comprises a first diameter on a proximate portion of the first electrically conductive element and a second diameter on a distal portion of the first electrically conductive element, where the second diameter is smaller than the first diameter, the second electrically conductive element further comprises a first diameter on a proximate portion of the second electrically conductive element and a second diameter on a distal portion of the second electrically conductive element, where the second diameter is smaller than the first diameter, a distal portion of the first electrically conductive element faces to a distal portion of the second electrically conductive element, the electrically insulative element is further defined as having a proximate end and a distal end, where at least the distal portion of the first electrically conductive element fits within a proximate end of the electrically insulative element, and where at least the distal portion of the second electrically conductive element fits within a distal end of the electrically insulative element.

(4) Procedural History

January 17, 2006	:	Filing of International Patent Application (Priority date: January 18, 2005, US)
August 12, 2011	:	Decision of Refusal
December 16, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-27250), Filing of Claim Amendment (see the above "The Claims")
February 14, 2013	:	Appeal Decision to Decline the amendments and "Dismiss the appeal"

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

Appeal Decision (Cited from the Court Decision)

(Differences)

In the present invention, the specific structure in which the first electrically conductive element and second electrically conductive element fit within the electrically insulative element means the structure ..., in the cited invention, ... structure.

It could be said that the citation 2 (JP S50-067974A. Exhibit A2) or the citation 3 (the specification of US Patent No. 5672856. Exhibit A3) discloses the specific structure in which "the first electrically conductive element and second electrically conductive element fit within the electrically insulative element"....

The working effects of the present invention would not be beyond the prediction of a person skilled in the art from the cited invention, the citation 2 or the citation 3.

Decision

Allegations by Plaintiff	Allegations by Defendant
The prominent working effects are supported by commercial successes of the plaintiff's product. That is, although the plaintiff have been produced and sold the sensors with the product numbers SQ-SEN-001P, SQ-SEN-003P and SQ-SEN-200 as seismic sensors, as shown in the graph and the table (Exhibit A11) the products worked by the present invention (product number SQ-SEN-200, Exhibit A10) have been drastically increased sales since the start of production and sales in 2005 compared to the products not worked by the present invention (product numbers SQ-SEN-001P and SQ-SEN-003P, Exhibit A8 and Exhibit A9), for example, the sales of 2.6 million dollars was achieved in 2011 (approximately 23 times of sales in 2005).	From the disclosure of the email of the plaintiff's customers (Exhibit A13 and Exhibit A14), it could be recognized that the plaintiff's products (SQ-SEN-200) were highly evaluated by customers in terms of its lifetime, sensitivity, cost, size and power consumption. Generally, sales of products and evaluations by customers depend on not only the working effects of the invention according to the product, but also quality, sensitivity, lifetime, size, power consumption, cost, marketing effort, due date, and market size etc. of product. Also, in the US market, even if increasing sales compared to the conventional plaintiff's products, this could be recognized to be caused by the specificity in the US market. Further, since the conventional plaintiff's products having the structure different from that of the cited invention are compared, the above should not have an affect on determining the obviousness based on the cited invention. Therefore, it could not acknowledge the inventive step of the present invention based on the commercial successes.

Judgement by the Court

The plaintiff alleges that the product worked by the present invention (product number SQ-SEN-200, Exhibit A10) drastically increased the sales compared to products not worked by the present invention due to that the surface mount soldering technique enables the product to attach to the PCB, and has been highly evaluated by customers in terms of the structure and operation, thus, such commercial success should be

analyzed as an indirect fact to support to affirmatively infer the existence of inventive step.

However, the effects by using the surface mount soldering technique to attach the product to the PCB are not obtained by the structure specified in the present invention. The plaintiff only alleges that the sales were increased compared to the conventional products. Since the plaintiff could not demonstrate that the above effects are obtained based on the prominent effects of the present invention compared to the effects obtained by combining the citation 1 to the citation 3, it could not adopt the allegations of the plaintiff.

(51)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51: Concerning finding of Claimed Invention (overlooking differences)
Keyword	

1. Bibliographic Items

Case	"Method for preparing polyester resin copolymerized with 1,4-cyclohexanedimethanol" (Trial for Correction) Intellectual Property High Court Decision, June 6, 2006 (2005 (Gyo KE) No. 10564)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-403432(JP 2001-323054A)
Classification	C08G 63/78
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding judge: Hisao SATO, Judge: Ichiro OTAKA, Judge: Kazuhide SHIMASUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention provides a method for preparing polyester resin copolymerized with 1,4-cyclohexanedimethanol comprising the steps of: esterifying terephthalic acid with a whole glycol component comprising ethylene glycol and 1,4-cyclohexanedimethanol such that a ratio of the whole glycol component to the terephthalic acid is within a predetermined molar ratio; and polycondensing the esterified reaction product in the presence of titanium-based compound as a polycondensation catalyst and carboxy phosphonic acid typed compound as a stabilizer, and the polyester resin has lower metal content and has improved clarity and color, than those of a conventional polyester resin.

(2) Common general knowledge and the like to be considered

(i) Exhibit B1: Edited by Bunichi Tamamushi and other 7 persons, "Iwanami Rikagaku Jiten, Supplemented third edition", Iwanami Shoten Publishers, second printing published on October 20, 1981.

"Butyl ...means monovalent alkyl group C_4H_9-, Abbreviation Bu, including 4 types: n-butyl $CH_3CH_2CH_2CH_2$-, isobutyl $(CH_3)_2CHCH_2$-, secondary butyl $CH_3CH_2CH(CH_3)$-, tertiary butyl $(CH_3)_3C$-."...

"Propyl ...means monovalent alkyl group C_3H_7-. It may be stated as abbreviation Pr, including two types of n-

propyl $CH_3CH_2CH_2$- and isopropyl $(CH_3)_2CH$-."..." (cited from the Court Decision)

(ii) Exhibit A8: Written by Yoshiyuki Urushibara, "Yuki-kagaku Meimeiho Yosetsu (third edition)", Asakura Publishing Co., Ltd., published on October 25, 1973

""List of basic names This list is of placing all of "List of Radical Names" gathered from Chapters A, B and C, attached on Regulation in 1965 of the IUPAC Nomenclature of Organic Chemistry in the order of Japanese syllables. Asterisk (*) is added on the name which is used only for unsubstituted group."

""isobutyl* $(CH_3)_2CH \cdot CH_2$-"

"isopropyl* $(CH_3)_2CH$-"

"butyl $CH_3 \cdot [CH_2]_2 \cdot CH_2$-"

"propyl $CH_3 \cdot CH_2 \cdot CH_2$-" (cited from the Court Decision)

(iii) Exhibit A11: Edited by Michinori Oki and the others, "Kagaku Daijiten", Tokyo Kagaku Dojin Co., Ltd., first edition, first printing published on October 20, 1989.

""butyl ...name of group $CH_3CH_2CH_2CH_2$- in organic compounds. It may be stated as n-butyl. ...Butyl, isobutyl, *s*-butyl and *t*-butyl may be correctively stated as butyl." ...

"*s*-butyl ...name of group $CH_3CH_2CH(CH_3)$- in organic compounds"...

"*t*-butyl ...name of group $(CH_3)_3C$- in organic compounds"...

"propyl ...name of group $CH_3CH_2CH_2$- in organic compounds"..." (cited from the Court Decision)

(3) The Claims (after corrected) (corrected invention of the present case)

[Claim 1] A method for preparing polyester resins copolymerized with 1,4-cyclohexanedimethanol comprising the steps of:

esterifying terephthalic acid with ethylene glycol and 1,4-cyclohexanedimethanol in a range of 10 to 90 molar% of the whole glycol component at a heating condition of 230 to 270°C under a pressure condition of 0.1 to 3.0 kg/cm^2 without using any catalysts such that a molar ratio of the whole glycol component to the terephthalic acid is within 1.1 to 3.0; and

polycondensing said esterified reaction product at a heating condition of 250 to 290°C under a reduced pressure condition of 400 to 0.1 mmHg in the presence of titanium-based compound as a catalyst selected from the group consisting of tetrapropyl titanate, tetrabutyl titanate and copolymer of titanium dioxide and silicon dioxide such that the weight of titanium thereof is within 5 to 100 ppm relative to the final weight of polymer, and in the presence of triethyl phosphono acetate as a stabilizer such that the weight of phosphorous thereof is within 10 to 150 ppm relative to the final weight of polymer.

(4) Procedural History

December 28, 2000	:	Japanese Patent Application (Priority date: May 17, 2000, Korea)
July 13, 2001	:	Registration of establishment of the patent right
October 29, 2004	:	Request for trial for correction (Teisei No. 2004-39245) (See the above-described "The Claims")
March 1, 2005	:	Trial Decision that "the request for the present trial is dismissed"

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

Appeal Decision (cited from the Court Decision)	
(1) ....it decided that the present corrected invention could be easily conceivable for a person skilled in the art based on ...the cited invention ...and ...the invention stated in Publication 2, and that the present corrected invention could not be independently granted a patent at the time of filing the patent application under the provision of Article 29(2) of the Patent Act. (2) ...the present trial decision decided that while each wording of "propyl" and "butyl" of "tetrapropyl titanate" and "tetrabutyl titanate" in the present corrected invention indicates "n-propyl" and "n-butyl" in its narrow sense and "generic concept of n-propyl and i-propyl" and "generic concept of n-butyl, i-butyl, s-butyl and t-butyl" in its broad sense, respectively, there is no description in the corrected specification indicating that these wordings should be understood in each sense, that these wording could not be settled in either of the narrow sense or the broad sense and that either of the present corrected invention in which these are supposed to have the narrow senses (hereinafter, referred to as "narrow corrected invention") and of the present corrected invention in which one or both of these wordings are supposed to have the broad senses (hereinafter, referred to as "broad corrected invention") can be applied for the decision mentioned in the above-described (1).	
Decision	
Allegations by Plaintiff Each wording of "propyl" and "butyl" of "tetrapropyl titanate" and "tetrabutyl titanate" in the present corrected invention has been stated according to the nomenclature of organic chemistry and it should be interpreted to have the narrow sense. That is, "propyl" means a group represented by a formula $CH_3CH_2CH_2$- and "butyl" means a group represented by a formula $CH_3[CH_2]_2CH_2$-, according to the nomenclature of organic chemistry (Exhibit A8). ...in the light of the provision that "a wording is used to have a usual meaning and is used through whole text of the specification. Provided that this shall not apply in a case that the wording is sought to use to have a special meaning, when the meaning for the wording is defined to use it." in Remark 8, Form 29 in the Regulations under the Patent Act, when each wording of "propyl" and "butyl" is used to have its broad senses explanation to have the same should be	Allegations by Defendant For example, in Exhibit B1 (Pages 1149 and 1192 of Edited by Bunichi Tamamushi and other 7 persons, "Iwanami Rikagaku Jiten, Supplemented third edition", Iwanami Shoten Publishers, second printing published on October 20, 1981, it explains that both of "propyl" and "butyl" have broad senses. Exhibit B1 is a dictionary widely used in the art of chemistry, and it cannot be said that the meaning of the wording stated therein does not have the "usual meaning". Therefore, it cannot be said that the present corrected invention contains the narrow corrected invention as a gist, does not contain the broad corrected invention.

stated in the corrected specification. However, since there is no description to have such a meaning in the specification, it should be interpreted that each wording of "propyl" and "butyl" is used to have its narrow senses, that is, is stated according to the nomenclature of organic chemistry.	

Judgment by the Court

(1) There is no particular description for the technical significance of each wording of "propyl" and "butyl" of "tetrapropyl titanate" and "tetrabutyl titanate" in the claims (Claim 1) of the present corrected invention. So, a general meaning of each wording of "propyl" and "butyl" will be examined.

...according to the description of Exhibit B1 and Exhibit A8 and Exhibit A11, it can be thought that while each wording of "propyl" and "butyl" is used to have its narrow sense (n-propyl and n-butyl) followed by the nomenclature of organic chemistry, these wordings are also commonly used to have its broad sense (generic concept of n-propyl and i-propyl and generic concept of n-butyl, i-butyl, s-butyl and t-butyl). Accordingly, it should be said that "tetrapropyl titanate" and "tetrabutyl titanate" in the present corrected invention could not be unambiguously and clearly understood either the narrow sense tetrapropyl titanate and/or the narrow sense tetrabutyl titanate, or the broad sense tetrapropyl titanate and/or the broad sense tetrabutyl titanate.

(2) There is no particular definition for "tetrapropyl titanate" and "tetrabutyl titanate" ...in the statement of the detailed explanation of the invention ...in the corrected specification and it cannot be confirmed to be any description that "propyl" in "tetrapropyl titanate" and "butyl" in "tetrabutyl titanate" are used to have its narrow senses. In addition, there is no description that names of compounds are followed by the nomenclature of organic chemistry.

(4) ...even though the statement of the detailed explanation of the invention in the corrected specification is reviewed, it can be said that "propyl" and "butyl" of "tetrapropyl titanate" and "tetrabutyl titanate" in the present corrected invention cannot be determined whether they are used for the narrow senses or the broad senses.

...it is reasonable to construe and determine the wording to have the broad sense upon determining novelty and inventive step of the patented invention when the technical significance of a wording stated in the claims cannot be unambiguously and clearly understood and can be interpreted to have both of its broad sense and its narrow sense even though the statement of the detailed explanation of the invention is reviewed. The reason is that if the patented invention in which the wording is interpreted to have its broad sense is affirmed to have novelty and inventive step, it should be natural to be affirmed to have these when the wording is interpreted to have its narrow sense, and that if the patented invention in which the wording is interpreted to have its broad sense is denied to have novelty or inventive step there is no room for confessing to have novelty or inventive step without examining whether or not these inventions in which the wording is interpreted to have its narrow sense is affirmed to have novelty or inventive step (even if novelty and inventive step is confessed when the wording is interpreted to have its narrow sense, it is needless to say that the patentability of the patented

invention cannot be affirmed on the assumption that the wording is interpreted only to have its narrow sense, since the wording can be also interpreted to have its broad sense).

Accordingly, it should be interpreted that "propyl" and "butyl" of "tetrapropyl titanate" and "tetrabutyl titanate" in the present corrected invention mean "generic concept of n-propyl and i-propyl" and "generic concept of n-butyl, i-butyl, s-butyl and t-butyl" respectively. Therefore, it should be said that "tetrapropyl titanate" and "tetrabutyl titanate" in the present corrected invention mean the broad sense tetrapropyl titanate and the broad sense tetrabutyl titanate. So, the assertion made by Plaintiff cannot be accepted.

(51)-2

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 2.
Classification of the Case	51: Concerning finding of Claimed Invention (overlooking differences)
Keyword	

1. Bibliographic Items

Case	"Preparation for direct tableting and preparation method of supplement agent" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 27, 2009 (2008 (Gyo KE) No. 10166)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-310741 (JP 2003-116966A)
Classification	A61J 3/06
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Hiroaki IMAI, Judge: Chieko SHIMIZU

2. Overview of the Case

(1) Summary of Claimed Invention

The Claimed Invention is a new granulation of a preparation for direct tableting or supplement agent for direct tableting containing a pharmaceutical active component. The method is a thermal adhesion granulation to prepare a composition for direct tableting or supplement agent that is characterized by containing a mixture that uses all or some of the following ingredients A) through C) and forming granules by heating the mixture up to a temperature range of about 30°C to about 130°C and rotating and blending it in a hermetically sealed system under the conditions of containing about 0.1 to 20% of initial moisture and/or about 0.1 to 20% of pharmaceutically acceptable organic solvent: A) about 5 to 99 wt.% of one or more types of diluted excipient and/or about 0 to 99 wt.% of pharmaceutical active component; B) about 1 to 99 wt.% of binder; and C) about 0 to 10 wt.% of disintegrating agent, as needed.

(2) Disclosure of Detailed Explanation of the Invention

(B) Conventional Technology

•"In U.S. Patent No.5840769, it is stated that a direct tableting aid is manufactured by using microcrystalline

cellulose (MCC) as a diluent, PVP as a binder, and crosslinked polyvinylpyrrolidone (crospovidone) as a disintegrating agent. This product can be manufactured by well-known wet granulation performed in mixer granulation, Shugi granulation, extrusion granulation, perforated plate granulation, or fluidized bed granulation. Wet granulation in which an excipient (diluent or disintegrating agent) or a pharmaceutical active component and, for example, PVP as a binder are used is commonly used dissolving in water or organic solvent. Although the wet granulation is widely used, the wet granulation has a lot of defects." (Exhibit A, paragraph [0005])

•"Wet granulation needs to add a large amount of liquid to a suitable tank and facility controlled, and water added in wet granulation must be removed. Thus, a drying step is needed; a facility for drying is also necessary; manufacturing steps are more complicated; energy necessary in steps is increased; and a lot of cost and time are needed. Using a large amount of organic solvent as solution for granulation causes troubles for operators and environment. Therefore, special prevention is necessary to avoid explosion and protect operators when contacting the solvent." (paragraph [0007])

•"Other defect of wet granulation is that, for example, excessive moisture has a harmful effect on the active component in a tablet preparation. For example, in wet granulation considered by U.S. Patent No.6,103,219, in a case where microcrystalline cellulose is exposed in excessive moisture, the compressibility is extremely lowered. The main factor is that cellulose fiber is converted and the strength of tablet is lowered, thus a lot of MCC must be added to maintain the compressibility. Especially, in a case where a component having high activity is included, increasing MCC causes high cost in manufacturing steps, and more importantly the volume of tablet is increased, and this tablet is hardly swallowed in oral administration. The problem in which the compressibility of microcrystalline cellulose is lowered in wet granulation has not been solved." (paragraph [0008])

(C) Problem to be solved by the Invention

•"The purpose of the present invention is to develop a new granulation in which extremely smaller amount of moisture is used compared with conventional wet granulation and the content of solvent is reduced." (paragraph [0010])

(D) Solution for the Problem to be Solved by the Invention

•"A method of the present invention, named "Thermal adhesion granulation (TAG)", is a special granulation, and the detailed explanation is as follows." (paragraph [0017])

•"The present invention provides a granulation of a preparation for direct tableting (containing a pharmaceutical active component) or supplement agent for direct tableting (not containing a pharmaceutical active component). In the granulation, following components A) and B) are added in a hermetically sealed bottle, and rotated and heated up to about 30 to 130°C, preferably about 40 to 110°C, more preferably about 60 to 105°C. The content of moisture or pharmaceutically acceptable organic solvent is about 0.1% to 20%. Granules are formed by blending and rotating the following components in a hermetically sealed system.

A) about 5 to 99 wt.%, preferably about 10 to 90 wt.% of component comprising about 0 to 99 wt.% of one or more types of excipient (filler) suitable for tableting, and/or most preferably about 10 to 90 wt.% of pharmaceutical active component; B) about 1 to 95 wt.%, preferably about 5 to 50 wt.% of binder, with respect to the total preparation weight; and C) about 0 to 10 wt.% of disintegrating agent, as needed. A disintegrating agent can be added before or after granulation of a mixture of the components A) and B)." (paragraph [0018])

- "In the present invention, granulation of components A), B), and C) as needed is necessarily performed in a hermetically sealed system. The initial content of moisture which is measured using a moisture measuring apparatus (e.g., Ohaus, Japan) is about 0.1 to 20%, preferably about 2 to 15%, most preferably about 4 to 10%. The granulation can be performed with pharmaceutically acceptable organic solvent (e.g., ethanol) contained, and the initial content of solvent is about 0.1 to 20%, preferably about 0.1 to 10%, most preferably about 0.5 to 5%." (paragraph [0019])
- "A binder of the component B) can be selected from soluble polyvinylpyrrolidone (PVP), hydroxypropyl-cellulose (HPC), hydroxypropyl methylcellulose (HPMC), low-substituted hydroxypropylcellulose (L-HP C), sodium carboxymethylcellulose, methyl cellulose, ethyl cellulose, sugar and the other, and a combination thereof. The binder is preferably polyvinylpyrrolidone or hydroxypropylcellulose. ..." (paragraph [0024])
- "A preferable binder of the invention used in specific examples is soluble polyvinylpyrrolidone (PVP) and is commonly used as a binder for tablets in drug industries, in wet granulation or direct tableting as a kind of powder of fine dispersion. ..." (paragraph [0026])
- "Since granulation is performed in a hermetically sealed system, granulation in a TAG system under the low content of moisture or solvent can be performed. Vapor (moisture included in added solvent and powder) generating in a heating step is prevented from being released from the system, and usage of solution for granulation can be a maximum. Thus, granulation can be completed under addition of the smallest amount of moisture or solvent. In general, the moisture inside diluent can be moved to binder in a heating step. In a case where heat distributed on a container for granulation is not uniform, which is observed in a TAG system in detail, moisture is coagulated in an area whose temperature is lower than that of inner wall of a container while heating powder. Since binder, for example PVP, has high absorbency in normal, all moisture, especially moisture in a coagulated state, present in a system is absorbed in the binder, and the binder has viscosity. Therefore, before granulation, binder is uniformly dispersed in a state of fine powder with diluent in an active component, particles are adhered to each other with the viscosity of binder, and finally granules are formed while rotating in the hermetically sealed container. ..." (paragraph [0028])
- "Thermal adhesion granulation of the present invention is quite different from conventional wet granulation. The differences are as follows.

1) In thermal adhesion granulation, a small amount of moisture is added in a mixture containing diluent and binder. On the other hand, in conventional wet granulation, binder is dissolved in solution for granulation, and diluted excipient is blended.

2) Thermal adhesion granulation can be defined as a "dry type" manufacturing step, and the essential liquid for granulation (water or organic solvent) is extremely little compared with conventional wet granulation.

3) Except a drying step, wet granulation is usually performed at room temperature. On the other hand, in thermal adhesion granulation, heating is necessary to promote the formation of granules.

4) In a blending step in wet granulation, an instrument having a blade, arm, propeller, chopper or other mechanical mixing function (e.g., a planetary mixer used for cutting granulation and high-speed mixing granulation machine) is necessarily used, a mixture or mass of powder and liquid is mixed to achieve the step, or solution of binder (fluidized bed granulation) is sprayed while powder is suspended in thermal air current. The former granules are

formed by passing all wet mass through, the latter granules are formed by coating particles with binder solution. In thermal adhesion granulation, wet powder is heated and rotated in a container, and is gradually aggregated with the aid of binder, thereby granules are formed.

5) In wet granulation, a drying step and a polishing step are necessary after granulation, and granules with desired size are formed. On the other hand, in the present invention, the content of moisture in a mixture is extremely low, thus these steps are not necessary.

6) Generally, conventional granulation is all performed in an opened system. On the other hand, thermal adhesion granulation of the present invention is performed in a hermetically sealed system." (paragraph[0030]) (cited from the Court Decision)

(3) The Claims (the Claimed Invention)

[Claim 1] A thermal adhesion granulation to prepare a composition for direct tableting or supplement agent that is characterized by containing a mixture that uses all or some of the following ingredients A) through C) and forming granules by heating the mixture up to a temperature range of about 30°C to about 130°C and rotating and blending it in a hermetically sealed system under the conditions of containing about 0.1 to 20% of initial moisture and/or about 0.1 to 20% of pharmaceutically acceptable organic solvent:

A) about 5 to 99 wt.% of one or more types of diluted excipient and/or about 0 to 99 wt.% of pharmaceutical active component;

B) about 1 to 99 wt.% of binder; and

C) about 0 to 10 wt.% of disintegrating agent, as needed.

(4) Procedural History

October 5, 2001	:	Filing of Patent Application
February 21, 2005	:	Filing of the Amendment (see the above "The Claims")
May 17, 2005	:	Decision of Refusal
August 19, 2005	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2005-15928)
December 10, 2007	:	Appeal Decision that "the appeal of the case was groundless."

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

Appeal Decision
"... Since "manufacturing method of granulated substance" of the cited invention is to manufacture granulated substance by heating, and corresponds to "thermal adhesion granulation" of the Claimed Invention" (cited from the Court Decision)
Decision

Allegations by Plaintiff	Allegations by Defendant
From the terms of "thermal adhesion", "heat", "adherence" and "type" can be associated, however, the specific content (e.g., whether "heat" means "heating", whether "adherence" is caused by "heat", etc.) is not directly clear from the term. In "thermal adhesion granulation" of the Claimed Invention, "adherence" is not caused by heating, but by that the heat of moisture is lost by a temperature difference of inner wall of a rotating container. (C) Therefore, "thermal adhesion granulation" of the Claimed Invention is understood from the statement of the detailed explanation of the invention, as stated above, and is a new granulation different from conventional heating granulation. ...	With respect to the Claimed Invention, the statement of Claims is clear and there is no special matter that the statement of the detailed explanation of the invention should be taken into consideration, thus Appeal Decision that "thermal adhesion granulation" of the Claimed Invention is a method of manufacturing granulated substance by heating has no error. ...

Judgment by the Court

A The term "thermal adhesion granulation" as used in the Claimed Invention is not a well-known term in general, as that showing one of the types of granulation. Although Claim 1 amended (Claimed Invention) ... refers to the step of heating, it contains no statements on the adhesion other than the term "thermal adhesion granulation".

Moreover, although it may be presumed from the term "thermal adhesion granulation" that "heat" and "adhesion" have some kind of relationship with granulation, further meanings remain unclear.

B Therefore, when the statement of the detailed description of the invention is considered and examined, ...

It is found that the detailed description of the invention in the description states the following.

The purpose of the Claimed Invention is to enable granulation by a small amount of water or organic solvents whereas the conventional wet granulation has a disadvantage that requires a drying process due to the necessity of adding a large amount of water or organic solvents. Thus, in the Claimed Invention, granulation is performed by heating the mixture of various materials that contain about 0.1 to 20% of initial moisture or organic solvents (such as ethanol) in a hermetically sealed system, having the vapor generated from diluents, etc., in the heating step condense at the areas with a lower temperature in the inner wall of the container without being released outside and having such vapor absorbed by a binder such as polyvinylpyrrolidone (PVP), which has a high hygroscopic property, and thereby generating a viscous property in the binder and making the surrounding particles adhere thereto. This granulation method is newly developed to be different from the conventional wet granulation method and is named "thermal adhesion granulation".

D As such, the "thermal adhesion granulation" as prescribed in the Claimed Invention may be understood as referring to a granulation wherein a viscous property is generated in the binder by the condensed moisture and the surrounding particles are made to adhere thereto by making use of the phenomenon that the vapor

generated by heating the mixture of a diluted excipient, pharmaceutical active component, binder, etc. condenses in a hermetically sealed system.

The defendant alleges that the statements in Claims is clear in relation to the Claimed Invention, that there are no special circumstances to take into consideration the statements of the detailed description of the invention, and thus, that there are no errors in Appeal Decision that the "thermal adhesion granulation" of the Claimed Invention is a method of manufacturing a granulated substance by applying heat. However, it would not be allowed to take into consideration the statement of the detailed description of the invention unless there are any special circumstances only in relation to the finding of the gist of the invention related to the patent application. In interpreting the meaning of the term stated in Claims, it is natural to take into consideration the statement of the detailed description of the invention and drawings that are contained in a set of documents for the patent application, and thus the defendant's allegation mentioned above cannot be accepted.

(51)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51: Concerning finding of Claimed Invention (overlooking differences)
Keyword	

1. Bibliographic Items

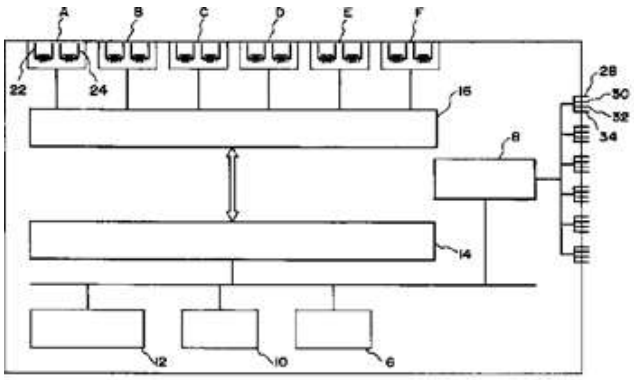
Case	"Coupled type computer" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, April 26, 2012 (2011 (Gyo KE) No.10336)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-286469 (JP 2002-99350A)
Classification	G06F 3/00
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division Presiding judge Toshiaki IMURA, Judge Kimiko YAGI, Judge Akira CHINO

2. Overview of the Case

(1) Summary of Claimed Invention

"When a multitude of computers are cluster connected to constitute an aggregated supercomputer, there are problems in the claimed invention that an aggregated volume of computers connected to each other by cords is large, a space to accommodate cords in a huge volume is needed, work of coupling the computers is troublesome, or the like. Hence, in order to solve these problems, a computer component such as an input/output interface *(14)* or the like of each of computers that constitute an aggregated computer is built into a casing having a multifaceted shape, a cordless-type signaling element coupled to the input/output interface *(14)* is arranged on each face of the casing, and furthermore, capturing and outputting a signal from other computers

[FIG. 5]



6 CPU
8 Switch regulator
10 Memory
12 Flash memory
14 Input/output interface
16 Multiple switch router

are performed through a multiple switch router *(16)* having a "signal selection" and "bypass function". (Extracted from the decision. Note, however, that the italic numerals have been added.)

(2) Disclosure of Detailed Description of the Invention

"[0007] The signaling elements 22, 24 arranged on each face of the casing 4 are connected to an input/output interface 18 by way of a multiple switch router 16. The multiple switch router 16 is configured to discriminate a frequency or code signal to selectively capture data and perform output and bypass processing..." (Extracted from the decision)

"[0014] When a hexahedron of a computer 2 is electromagnetically coupled to an adjacent computer 2, the multiple switch router 16 operates as an opening/closing gate that performs either conduction or blocking of data and uses a frequency, time, and a code to select a data transmission route.

[0015] In FIG. 5, when input/output ports formed of the signaling elements 22, 24, each being arranged on six faces of the casing 4, are designated A, B, C, D, E, F, any ports, for example, A, B, C, D, can be opened and any ports, for example, E, F, can be closed by setting to a required value a frequency band of each of the respective ports A, B, C, D, E, F of the multiple switch router 16. Capturing and outputting of data corresponding to the set frequency band from the closed ports E, F are prevented.

[0016] In addition, the multiple switch router 16 can form a side channel, more specifically, a by-pass, between any ports. When a required bypass setting control signal is inputted to the multiple switch router 16, a bypass is formed between the ports A and F, for example, and data transferred to the port A is transmitted to the port F through the bypass without being captured into the input/output interface 14. In this manner, each of the computers 2 can select a signal transmission route by itself, and there is no need to provide a special signal transmission route controller." (Extracted from the decision)

(3) The Claims (Amended) (Stating only Claim 1) (Claimed invention)

[Claim 1] A coupled computer for coupling multiple adjacent computers of the same structure to each other to constitute an aggregated computer, wherein a computer component such as a CPU or a memory ICU and an input/output interface is built in each of multiple casings having a multifaceted shape, a cordless type input/output signaling element is each arranged on each face of each of the casings having a multifaceted shape, a multiple switch router having a signal selection and bypass function is built in each of the casings having a multifaceted shape, the input/output signaling element provided on each face of the casing is connected to the input/output interface in the casing, two-way data transfer is enabled between an input/output signaling element provided on each face of the casing and an input/output signaling element of other computers through an input/output signaling element provided on each face of other casing adjacent thereto, and multiple input/output signaling elements provided on each face of the casings are connected to the input/output interface in the casings by way of the multiple switch router, so that capturing and outputting of a signal from the other computers by the input/output signaling elements are performed through the multiple switch router having the signal selection and bypass function and so that a bypass can be formed by the multiple switch router between the multiple cordless type input/output signaling elements arranged on each face of the casing.

(4) Procedural History

April 12, 2010	:	Procedure amendment (See "The Claims" described above.)
July 2, 2010	:	Decision of refusal
September 29, 2010	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2010-21814)
September 16, 2011	:	Appeal decision of "The request for appeals and trials of this case is not valid."

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">Contents of the cited invention found by the appeal decision and identical features of the same invention and the claimed invention... are as described below:
(2) Identical features
A coupled computer for coupling multiple adjacent computers of the same structure to each other to constitute an aggregated computer, wherein a computer component such as a CPU or a memory ICU and an input/output interface is built in each of multiple casings having a multifaceted shape, a cordless type input/output signaling element is each arranged on each face of each of the casings having the multifaceted shape, the input/output signaling element provided on each face of the casing is connected to the input/output interface in the casing, two-way data transfer is enabled between the input/output signaling element provided on each face of the casing and an input/output signaling element of any of other computers through an input/output signaling element provided on each face of other casing adjacent thereto, and multiple input/output signaling elements provided on each face of the casings are connected to the input/output interface in the casings, so that capturing and outputting of a signal from the other computers by the input/output signaling elements are performed.
D Difference 4
While the claimed invention is specified to perform capturing and outputting of a signal from other computers by an input/output signaling element "through the multiple switch router having the signal selection and bypass function", the cited invention is not specified as such.
...Finding that a router unit of the invention described in the Citation 2 corresponds to the multiple switch router of the claimed invention...</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...According to paragraph [0015] in the description of the application concerned, "multiple" in the multiple switch router of the claimed invention refers to a signal multiplexing function to select a data transfer route by using a frequency, time, and a code.</td><td>Allegations by Defendant
A It is only stated that the multiple switch router of the claimed invention has the signal selection... and bypass function, and the description of the application concerned does not state or suggest that a frequency, time, and code are used or that a limitation</td></tr>
</table>

In the claimed invention, a bypass formed between input/output ports by the multiple switch router inevitably forms a data transfer route in two ways. Thus, in any case in which only one-way data transfer is possible, it cannot be stated that a bypass is formed between the input/output ports. In addition, in the claimed invention, since the input/output signaling element is arranged on each face of the casing having the multifaceted shape and connected to the multiple switch router, the multiple switch router has a configuration of at least four inputs and four outputs (six inputs and six outputs in a hexahedron) for the input/output ports. In contrast, the Citation 2 has only two inputs and two outputs or three inputs and three outputs. Therefore, the router unit of the invention described in the Citation 2 does not correspond to the multiple switch router of the claimed invention.	should be made thereto. Then, the "multiple" in the multiple switch router of the claimed invention simply means a signal multiplexing capability which a router naturally has and which is a prerequisite to select a data transfer route, and the router unit described in the Citation 2 is also same as such a multiple switch router. In addition, even if the "multiple" in the multiple switch router of the claimed invention means the signal multiplexing capability to select a data transfer route by using a frequency, time and a code, it cannot be stated on the ground of the "multiple" of the multiple switch router of the claimed invention that a "bypass" is limited to one that transfers data in two ways, because even a one-way bypass selects a data transfer route by using a frequency, time, and a code when transmitting data.

Judgment by the Court

(1) Regarding errors in finding of and determination on the "multiple switch router"

A First of all, significance of the "multiple switch router" according to the claimed invention is reviewed. In the claims (Claim 1) according to the claimed invention, it is stated that the multiple switch router (1) "connects multiple input/output signaling elements provided on each face of the casing to the input/output interface in the casing...", (2) "has the signal selection and bypass function to capture and output a signal from the other computers by the input/output signaling elements ..., and (3) "(make) it possible to form a bypass between the multiple cordless type input/output signaling elements arranged on each face of the casing". However, the significance of the multiple switch router has some parts that are not necessarily unambiguously clear. Thus, reference is also made to the statement of the description of the application concerned.

According to the statement ... in the description of the application concerned, it is found that the claimed invention is designed to perform capturing and outputting of a signal from other computers through the multiple switch router having the "signal selection" and "bypass function".

Then, according to paragraphs [0007], [0014], [0015], and [0016] in the description of the application concerned, it is found that (1) the above-mentioned "signal selection" function is a collective designation of the function to select a signal to selectively capture data that an own computer should capture of data from other computers, and the function to select a signal to select a signal transmission route including a formed bypass, and (2) the above-mentioned "bypass function" is to form a bypass to transmit data between the input/output terminals without being captured into the input/output interface. Furthermore, according to paragraph [0015]

in the description of the application concerned, it is interpreted that any example, as exemplification of "using a frequency, time, and a code to select a data transmission route", in which multiple signals configured to be mutually separated depending on a frequency band set for each port are transmitted, ... assumes that the "multiple switch router" transmits multiple signals in a state in which they can be mutually separated by discrimination using a frequency or the like.

Then, it can be stated that the "multiple switch router" in the claimed invention has functions to (1) operate as an opening/closing gate that performs conduction and blocking of data, and close a port to prevent capturing or outputting of the data by setting a frequency band for each port to a predetermined value, (2) form a bypass between ports without providing a special signal transmission route controller when each computer uses a frequency, time, and a code to select a data transmission route, and (3) transmit the data from a port to a port without capturing the data into the input/output interface of said computer when the bypass is formed, and that the "multiple" means that multiple signals are transmitted physically by one transmission route so that they can be mutually separated.

With the above, it is understood that the "multiple switch router" according to the claimed invention means a router that operates as a switch to perform conduction or blocking of data and that transmits multiple signals in a mutually separable state, and does not include any router that does not transmit multiple signals in a mutually separable state.

(51)-4

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51: Concerning finding of Claimed Invention (overlooking differences)
Keyword	

1. Bibliographic Items

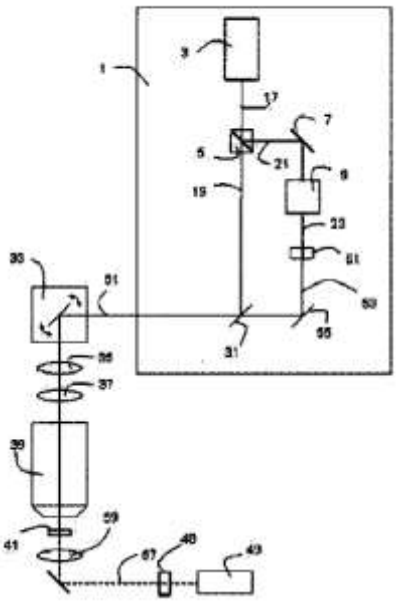
Case	"Light source device for illumination in scanning microscopic inspection" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 30, 2012 (2011 (Gyo KE) No.10221)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-348265 (JP 2002-196252A)
Classification	G02B 21/06
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division Presiding judge Shuhei SHIOTSUKI, Judge Tomoko MANABE, Judge Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention can provide a light source device for illumination in scanning microscopic inspection which is stable, is easily adjustable, and can realize high resolution at a low cost, the light source device for illumination in scanning microscopic inspection having an electromagnetic energy source (3) which emits a ray (17) of one wavelength, being placed with a means (5) for forming at least two split rays (19 and 21) by spatially splitting the ray (17) behind the electromagnetic energy source (3), and being disposed with an intermediate element (9) for changing the wavelength at least at one split ray (21).

[FIG. 3]



(2) Disclosure of Detailed Description of the Invention

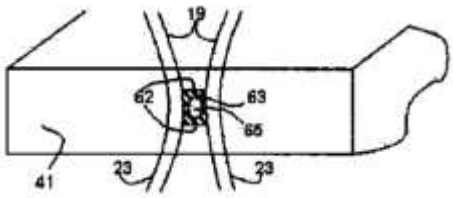
"·Paragraph [0021]

"Fig. 3 shows a scanning microscope of the present invention

having a non-scanning type configuration and taking a form of multiphoton excitation. While a light source device 1 shown in Fig. 1 is basically used for illumination, the scanning microscope further includes means which has an effect on a focused form (the means is configured as a λ/2 plate 61 and passed by only a center part of a cross section of the split ray 53). The split ray 53 passing through the λ/2 plate 61 is reflected by the mirror 55 and directed to the dichroic ray coupler 31 where the split ray 53 is coupled with the split ray 19 to form the illumination ray 51 emitted from the light source device 1. Illumination of the sample 41 is performed similar to the device in Fig. 2. Excitation of an area of the sample 41 is caused by a component (this having a wavelength of the split ray 19) of the illumination ray 51. Induction release (emission) is caused by another component (this having a wavelength of the split ray 23) of the illumination ray 51. With the λ/2 plate 61, the latter component of the illumination ray 51 has focus (form) the inner side of which is empty (hollow) (having no light component in the center). Thus, a(n) (induced) radiation space (volume) is limited (or reduced) in all directions of that space, and accordingly axial and horizontal resolution is increased."

·Paragraph [0023]

【図４】



"Fig. 4 clearly shows spatial arrangement of the first split ray 19 and the second split ray 23 inside or on a surface of the sample 41 to be inspected. Because diameter (or thickness) of the second split ray 23 is larger than the first split ray 19, the first split ray 19 is fully surrounded by the second split ray 23 in a focus area. The second split ray 23 has a focused form the inner side of which is empty. Superimposition of the first and the second split rays 19 and 23 defines a three-dimensional superimposed area (illustrated as a hatched cross section area in Fig. 4) 63 in the focus area. An area which is the focus area of the first split ray 19 and which resides in a hollow part of the second split ray 23 defines a radiation space 65." (Cited from the Court Decision)

(3) The Claims (Amended) (Amended invention)

[Claim 1] A light source device for illumination in STED scanning microscope inspection wherein the light source device has one electromagnetic energy source (3) which emits a ray (17) of one wavelength, means (5) for forming at least two split rays (19, 21) by spatially splitting the ray (17) is placed behind the electromagnetic energy source (3), intermediate elements (9, 25) for changing the wavelength are disposed in at least one split ray of the at least two split rays (19, 21), the intermediate elements (9, 25) change wavelengths of split rays passing through the intermediate elements (9, 25), so that the first split ray (19) of the at least two split rays (19, 21) is directly projected onto the sample (41) where a first focus area (62) is optically excited, the second split ray (21) of the at least two split rays (19, 21) is projected onto a second focus area of the sample (41) where a superimposed area (63) is formed, only a sample area irradiated with the first split ray 19 only is detected, and thereby a sample area excited by the first split ray (19) in the superimposed area (63) is induced to return to ground state, and focused form changing means (61) is arranged in the second split ray (21).

(4) Procedural History

November 14, 2001 : Patent application (Date of claim of priority: November 14, 2000/Germany)

March 13, 2009	:	Amendment (See "The Claims" described above.)
April 22, 2009	:	Decision to reject the amendment described above, decision of refusal
August 28, 2009	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2009-15839)
February 28, 2011	:	Appeal decision of "The request for a trial of this case is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">[Identical features of the invention stated in the Cited Document 1 and the amended invention]
The point in which the invention stated in the Cited Document 1 and the amended invention are "a light source device for illumination in STED scanning microscope inspection wherein
they have an electromagnetic energy source;
a wavelength of a second ray is set so that a first ray of at least two rays is directly projected onto a sample where a first focus area is optically excited, a second ray of the at least two rays is projected onto a second focus area of the sample where a superimposed area is formed, only a sample area irradiated with the first ray only is detected, and thereby a sample area excited by the first ray in the superimposed area is induced to return to ground state; and
focused form changing means is arranged in the second ray."</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...A "focused form" referred in the amended invention literally means a "form of focus", especially, a "form of focus" of the second split ray (see paragraph [0021], for example). In addition, the "focused form changing means" referred in the amended invention represents means for changing a form of focus of a ray passing through this means.
Then, the splitter and the mirror referred in the Cited Document 1 do not correspond to the "focused form changing means" referred in the amended invention, and it cannot be stated that the "focused form changing means" referred in the amended invention is arranged in the second ray of the Cited Document 1. Hence, the finding of the identical features and differences against this is an error.</td><td>Allegations by Defendant
(1) According to paragraphs [0021] and [0023] in the description of the application concerned, a "focused form" of the amended invention represents arrangement of rays at a focused position which is a position where rays are squeezed most or a position that forms a beam waist by diffraction limit. The "focused form changing means" also represents means for changing arrangement of the second split ray at the focused position to a form the inner side of which is empty.
On the other hand, also in the invention stated in the Cited Document 1, since the arrangement of rays at the focused position is changed so that stimulated rays are divided into two by a splitter and a mirror to be symmetrically misaligned to each other by a same distance from the center axis in opposite directions, more specifically, the form has empty inner side</td></tr>
</table>

	thereof, the splitter and the mirror correspond to the "focused form changing means".

Judgment by the Court

...In the the claims of the amended invention, regarding the "focused area" and the "focused form changing means", it is simply stated that "the first split ray (19) of the at least two split rays (19, 21) is directly projected onto the sample (41) where a first focused area (62) is optically excited, the second split ray (21) ... is projected onto a second focused area of the sample (41) where a superimposed area (63) is formed,", and "the focused form changing means (61) is arranged in the second split ray (21)". Thus, although it can be comprehended that the above-mentioned "focused form changing means" is provided in the middle of an optical path of the "second split ray (21)" and has such a meaning that the "focused form changing means" is a means for changing a form in which the split ray is in focus, those skilled in the art cannot comprehend, only from the statement in the claims, a specific configuration thereof or an operation/working effect of the amended invention. Then, when looking at the statement of the detailed explanation of the invention ... in the description of the application concerned, there is the statement ... regarding the "focused form changing means" described above.

Then, it should be stated that the "focused form changing means" referred to in the amended invention represents a means for changing a form of focus made by the second split ray (21) of the split rays split by the split ray forming means (5) on a surface of or an inner side of a sample, for example, a means for changing a form of focus of the second split ray (21) so that, as shown in Fig. 4, an annular focus (irradiated part) of the second split ray (21, stimulated ray) can surround the outer side of a sample and make the inner side empty.

....As described above, in the amended invention, the "focused form changing means" changes a form of focus made by the second split ray (21) on a surface of or an inner part of a sample so that, for example, the focus (irradiated part) of annular second split ray (21, stimulated ray) can surround the outer side while the inner side is empty. Thus, it should be stated that the invention stated in the Cited Document 1 and the amended invention are different from each other in whether or not devices provided on an optical path of the second split ray (21) for the amended invention or on an optical path of the stimulated ray in the invention stated in the Cited Document 1 respectively change a form of focus.

Hence, in the finding of the identical features ... made by the appeal decision, the part "the focused form changing means is provided in the second ray" is an error.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51: Concerning finding of Claimed Invention (overlooking differences)
Keyword	

1. Bibliographic Items

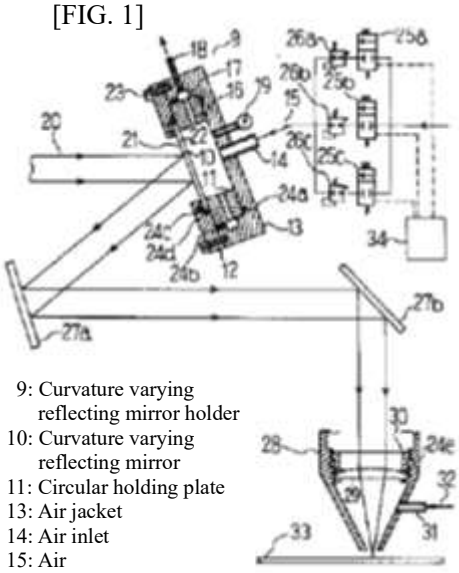
Case	"Laser processing device" (Trial for invalidation) Intellectual Property High Court Decision, December 25, 2012 (2012 (Gyo KE) No.10082)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H7-12513 (JP H8-318383A)
Classification	C07C 233/20
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court First Division, Presiding judge Toshiaki IIMURA, Judge Kimiko YAGI, Judge Shinji ODA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention has a problem to be solved, which is provision of a laser processing device capable of not only changing a curvature of a laser beam reflection member at a high speed, but also freely controlling the curvature, as needed, wherein in a configuration in which a space is provided on an opposite side (rear surface side) of a reflection surface of the laser beam reflection member, and while a gas is supplied to the space from a fluid supply path, the gas is discharged from the space via a fluid discharge path, the curvature of the laser beam reflection member is changed by increasing or decreasing pressure to supply the gas to the space.

[FIG. 1]



9: Curvature varying reflecting mirror holder
10: Curvature varying reflecting mirror
11: Circular holding plate
13: Air jacket
14: Air inlet
15: Air
18: Air outlet
20: Laser beam
21: Laser beam reflection surface
22: Laser beam non-reflection surface (rear surface)
25a, 25b, 25c: Electromagnetic valve
26a, 26b, 26c: Regulator
27a, 27b: Reflection mirror
28: Processing head
29: Processing lens
33: Processed item
34: Control device

(2) Disclosure of Detailed Description of the Invention (Working example)

"[0031] Then, a fluid action circuit is configured in which after passing through the plurality of air passages 16 that are provided at equally-spaced intervals in the circular holding plate 11 and exiting to the air passage 17 formed in a periphery of the circular holding plate 11, the air 15 supplied from the air inlet 14 is discharged from the air outlet 18 provided at one location of the air jacket 13. Since the curvature varying reflecting mirror 10 is made spherical due to this fluid pressure, the curvature varying reflecting mirror can be used as a spherical mirror (a convex mirror, in this case). ... In addition, since the curvature of that curvature varying reflecting mirror 10 also changes as the fluid pressure changes, ... switching of the curvature between three levels becomes possible. In addition, with fluid pressure that works with a supply amount of fluid to be supplied to the fluid action circuit, the curvature of the curvature varying reflecting mirror 10 can be changed almost simultaneously with a command of the control device 34.... (Extracted from the decision) "

Note that regarding the working example, the air outlet 18 is opened to the atmosphere and there is provided no circulating path configured to return a gas from the air outlet 18 to the air inlet 14.

(3) Common general knowledge deliberated, or the like

Exhibit A1 (Description of German Utility Model No. 9407288) cited in the appeal decision states an invention of a laser cutting machine for increasing or decreasing a curvature of a metal circular plate by forming a space on a rear surface side of the metal circular plate which reflects a laser beam and supplying pressure water to the space through a water flow pipe, while discharging the pressure water from the space through another water flow pipe. In the invention of Exhibit A1, water is circulated from a water flow pipe on the discharging side to a water flow pipe on the supplying side.

(4) The Claims (After corrected) (Claimed Invention of this case)

[Claim 1] In a laser processing device for collecting a laser beam outputted from a laser oscillator using a light collecting optical member to perform processing such as cutting, welding, or the like, the laser processing device, comprising a laser beam reflection member provided in a transmission line of the laser beam and configured to elastically deform due to gas pressure; a reflection member support unit configured to support a peripheral area of the laser beam reflection member and form a space on an opposite side of a laser beam reflection surface together with the laser beam reflection member; a fluid supply means provided in the reflection member support unit and configured to supply gas to a space of the reflection member support unit; an electropneumatic valve configured to continuously switch gas supply pressure; and a fluid discharge means provided in the reflection member support unit and configured to discharge gas from the space of the reflection member support unit, wherein the space has a sealed structure excluding the fluid supply path and a fluid discharge path which is a separate unit of the fluid supply path, and wherein the laser processing device is such configured that gas passing through the fluid discharge path is discharged to the outside by the fluid discharge means, and gas pressure needed for the laser beam reflection means to elastically deform on the opposite side to the laser beam reflection surface is applied between the fluid supply means and the fluid discharge means.

(5) Procedural History

September 14, 2010	:	Request by Plaintiff for trial for patent invalidation (Muko No. 2010-800162)
December 7, 2010	:	Request for correction by Defendant (Patentee)
April 14, 2011	:	Primary appeal decision "The correction shall be approved. ... The patent shall be invalidated"
May 19, 2011	:	Defendant entering a lawsuit for reverse of appeal decision (2011 (Gyo KE) No. 10168)
August 10, 2011	:	Request by Defendant for a trial for correction (Teisei No. 2011-390096) (This case corrected) (See "The Claims" described above.) (It was considered later that the request for correction was made.)
October 7, 2011	:	Decision that the primary appeal decision shall be reversed. The examination of Muko No. 2010-800162 is restarted.
January 24, 2012	:	The appeal decision on this case that "the correction shall be approved. The request for a trial of this case is dismissed."

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

Appeal Decision (cited from the Court Decision)
Differences between the invention of this case and the invention of Exhibit A1 are as follows: (5) Difference 3

The point that while in the invention of this case, "gas passing through the fluid discharge path is discharged to the outside by the fluid discharge means", in the invention of Exhibit A1, fluid passing through the fluid discharge path is not discharged to the outside by a fluid pipe that is a separate unit of the fluid pipe 14.

The reason for the appeal decision is as stated in the separate appeal decision transcription. Shortly, ...regarding the difference 3, it was decided that the patent related to the invention of this case cannot be invalidated because it cannot be stated that those skilled in the art can easily conceive this invention based on the invention of Exhibit A1 and well-known technical matters.

Decision

Allegations by Plaintiff	Allegations by Defendant
"discharged to the outside" in the patent of this case means that gas exits from the fluid discharge means to the outside of the space in the reflection member supportunit. The difference 3 found by the appeal decision does not exist, and the finding of the appeal decision is thus an error. "outside" is not a technical term but simply a statement that corresponds with "inside". Thus, unless a different definition is otherwise stated in the detailed explanation of the invention, it is appropriate to interpret that "discharged to the outside" means that gas exits from the fluid discharge means to the outside of the space in the reflection member support unit. Paragraph [0003] ... of the description related to the patent of this case explains the prior art technology shown in Fig. 8. The "outside" in the statement "pressure of the inside of the container 1 falls below pressure of the outside" or the statement "pressure in the container 1 can be made higher than the outside" is only used as a word representing a part which is not the inside of the container 1. It is appropriate to interpret that "gas is discharged to theoutside by the fluid discharge means" in the invention of this case means that gas exits the fluid discharge means to the outside of the space in the reflection member support unit. Since also in the invention of Exhibit A1, from within the sealed space formed by the metal circular plate having	While in the invention of Exhibit A1, pressure water circulates, the invention of this case is different in that gas is discharged without circulating. Therefore, ... there is no room to interpret that simply "outside of the space in the reflection member support unit" is all "outside" without assuming that there exists a difference in whether or not ... belongs to the sealed space. Exhibit A1 discloses circulation of pressure water, which is a cooling medium. Then, due to the need to circulate, ... both of the supply path and the discharge path for the pressure water in the reflection member support unit are contained in one sealed structure. In contrast to this, in the invention of this case, ... gas "is discharged to the outside". The correction to clearly indicate this is the words "discharged to the outside" related to the correction of this case, ... meaning exiting to the outside of the sealed structure communicating with the reflection member support unit. "If "outside" was interpreted as "outside of the space in the reflection member support unit", ... the wording added by the correction of this case "discharged to the outside" would not make any sense. However, looking at the development of the correction of this case and the statements in the description prior to the correction of this case, the difference in the arrows assigned to the "air outlet 18" in Fig. 2 and Fig. 3 of the description of this case, in particular, it is

the mirror surface 12 and the mirror case 13, pressure fluid is discharged from a fluid pipe, which is a separate unit of the fluid pipe 14 that is connected to the inside of the space, the difference 3 does not exist.	obvious that the wording "discharged to the outside" corresponds with Fig. 2, and there is no reason to interpret that the correction to add this wording makes no sense.

Judgment by the Court

In the claims related to the invention of this case, it is stated that "a fluid discharge means configured to discharge gas from the space of the reflection member support unit, wherein the space has a sealed structure excluding the fluid supply path and a fluid discharge path which is a separate unit of the fluid supply path, ... gas passing through the fluid discharge path is discharged to the outside by the fluid discharge means". The "fluid discharge means" in the same configuration refers to means configured to discharge gas to the outside of the "space in the reflection member support unit". Thus, "gas passing through the fluid discharge path is discharged to the outside by the fluid discharge means" of the invention of this case means that "gas passing through fluid discharge path is discharged to the outside of the space in the reflection member support unit", and it is obvious from the wording in the claims that "discharged to the outside" means "discharged to the outside of the space in the reflection member support unit" and that there is no other exceptional limitation. It is shown also in the statement in the description of this case that similarly, "discharged to the outside" is "discharged to the outside of the space of the reflection member support unit".

On the other hand, also in the invention of Exhibit A1, from within the sealed space formed by the metal circular plate having the mirror surface 12 and the mirror case 13, pressure water is discharged from a fluid pipe, which is a separate unit of the fluid pipe 14 that is connected to the inside of the space.

Both of the invention of this case and the invention of Exhibit A1 are "discharged to the outside", and there is no difference related to difference 3. Therefore, ... the finding of the appeal decision has an error.

In this respect, ... regarding the significance of "discharged to the outside", ..., Defendant alleges that it is wrong to interpret that simply "outside of the space in the reflection member support unit" is all "outside". However, Defendant's allegation is an allegation not based on the statement in the claims and cannot be adopted.

As described above, the finding of the appeal decision that on the assumption that "it can be stated that the technical matter identified by the statement of 'discharged to the outside' is being discharged to a peripheral space surrounding a space which is made a sealed structure", this point is the difference 3 from the invention of Exhibit A1.

(51)-6

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51: Concerning finding of Claimed Invention (overlooking differences)
Keyword	

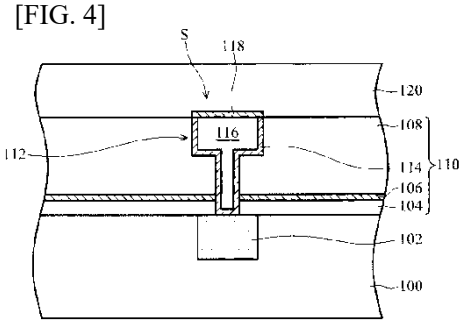
1. Bibliographic Items

Case	"Wiring Structure" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 23, 2013 (2012 (Gyo KE) No. 10243)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2006-157253 (JP 2006-344965A)
Classification	H01L 21/768
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division Presiding judge Akihiro DOI, Judge Ichiro OTAKA, Judge Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 4]



In a wiring structure composed of a substrate 100 having a conductive material 102, a composite low-k dielectric layer 110 overlying the substrate and having at least one stress-harmonizing layer 106 interposed therein, and a conductive feature formed on the composite low-k dielectric layer 110 and passing through the at least one stress-harmonizing layer 106 to electrically connect the conductive material 102, the claimed invention (the invention according to claim 6) can prevent a problem that occurs in a damascene structure while improving reliability of the wiring structure by having the stress-harmonizing layer 106, which is configured to harmonize stress in the composite low-k dielectric layer, composed of oxygen-containing silicon carbide ($Si_aC_bO_c$) where the a is from 0.8 to 1.2, the b is from 0.8 to 1.2, and the c is from 0 to 0.8 exclusive of 0, so that tensile stress generated by the low-k dielectric layer 110 composing the wiring structure is harmonized.

(2) The Claims (Amended) (Only Claim 6 stated) (Claimed invention)

[Claim 6] A wiring structure comprising a substrate having a conductive material, a composite low-k dielectric layer

overlying the substrate and having at least one stress-harmonizing layer interposed therein, and a conductive feature formed on the composite low-k dielectric layer and passing through the at least one stress-harmonizing layer to electrically connect the conductive material, wherein the stress-harmonizing layer configured to harmonize stress in the composite low-k dielectric layer is composed of oxygen-containing silicon carbide ($Si_aC_bO_c$) where the a is from 0.8 to 1.2, the b is from 0.8 to 1.2, and the c is from 0 to 0.8 exclusive of 0.

(3) Procedural History

June 6, 2006	:	Patent application (Date of claim of priority: June 6, 2005/US)
August 6, 2010	:	Submission of a written amendment (see the above-mentioned The Claims") and a written opinion
October 28, 2010	:	Final rejection
February 23, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-4045)
February 21, 2012	:	Appeal decision of "The request for a trial of this case is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">The appeal decision on this case, while finding it well-known that the Blok stated in the well-known example is an SiC film formed by the PECVD method using organic silicon gas and contains inevitable traces of oxygen, determined that a person skilled in the art would have easily conceived that in the cited invention, the well-known technology being taken into consideration, a material of the stress-harmonizing layer is composed of oxygen-containing silicon carbide ($Si_aC_bO_c$) as with the claimed invention, where the a is 0.8 to 1.2, the b is 0.8 to 1.2, and the c is 0 to 0.8 exclusive 0.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
Since it is stated in the description of the application concerned ([0012]) that "the stress-harmonizing layer is composed of oxygen-containing silicon carbide ($Si_aC_bO_c$) ...", even for the wording "the c is from 0 to 0.8 exclusive of 0" stated in the claims, a person skilled in the art can easily imagine that the wording indicates silicon carbide which is intentionally caused to contain oxygen to the extent that oxygen can produce an effect thereof...</td><td>Allegations by Defendant
There is no interpretation other than the interpretation that
the statement of "the c is from 0 to 0.8 exclusive of 0" in the claims of the claimed invention cannot be interpreted in any sense other than that as the wording indicates, the c is in the range from a small value, which is as close to 0 as possible, to 0.8 (more specifically, the c is in the range from a small value, at which the ratio of oxygen in $Si_aC_bO_c$ is as close to 0 as possible, to 0.8).</td></tr>
</table>

Judgment by the Court

Regarding the wording of "the c is from 0 to 0.8 exclusive of 0" stated in the claims of the claimed invention, it can neither be stated that the technical significance thereof cannot be clearly understood unambiguously nor stated at a glance in light of the statement ([0012]) in the description of the application concerned cited by Plaintiff that the above-mentioned wording in the claims is a clerical error. Therefore, the finding of the claimed invention should be made based on the statement in the claims.

(51-1)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51-1: Interpretation on whether the claim is an open claim (invention that can contain other constitution than constitution of the claim), or a closed claim (invention limited to the constitution of the claim)
Keyword	

1. Bibliographic Items

Case	"Polyamide- polyarylene sulfide blends" (Opposition to the grant of a patent) Tokyo High Court July 7, 2003 (2002 (Gyo KE) No. 232)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H1-97256 (JP H2-123159A)
Classification	C08L 77/06
Conclusion	Partial acceptance, partial dismissal
Related Provision	Article 29(1)(iii) and Article 29(2)
Judges	Tokyo High Court, 13th civil chamber, Presiding Judge: Katsumi SHINOHARA, Judge: Gaku OKAMOTO, Judge: Naoki HAYATA

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention is to provide a blend of a polyphthalamide component and a polyarylene sulfide component, wherein the polyphthalamide comprises at least two different recurring units selected from the group consisting of terephthalamide unit, isophthalamide unit and adipamide unit, and the polyphthalamide component when filled with 33 weight % glass fibers and having a heat deflection temperature at 264 psi according to ASTM D-648 of 240°C or higher, and a filled composition based thereon having utility in molding and other applications.

(2) The Claims (Present invention 1)

"[Claim 1] A composition comprising a blend of a polyamide component and a polyarylene sulfide component, wherein said polyamide component is a polyphthalamide comprising at least two recurring units selected from the group consisting of terephthalamide unit, isophthalamide unit and adipamide unit, and the polyphthalamide has a heat deflection temperature at 1820 kPa (264 psi) according to ASTM D-648 of at least 240°C, when filled with 33 weight percent glass fibers."

(3) Procedural History

May 15, 1998	:	Registration to establish a patent right (see the aforementioned "The Claims")
February 3, 1999	:	Opposition to the grant of a patent (Igi No. 11-70326)
March 15, 2001	:	Decision "... to revoke the patent."

3. Portions of Court Decision

<table>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
While it has been recognized that the present inventions 1 to 13 are of which the glass fiber is filled, the aforementioned each invention is not of which the glass fiber is filled, and there is an error on this point in the present decision.</td><td>Allegations by Defendant
Claim 1 of the Claims in the present description (Exhibit A1) states that "composition comprising a blend of a polyamide component and a polyarylene sulfide component", and does not state "component comprising a blend only containing a polyamide component and a polyarylene sulfide component".</td></tr>
<tr><td colspan="2">Judgment by the Court
The Defendant has asserted that Claims 1 to 9 naturally encompasses an invention of a component comprising a blend only containing a polyamide component and a polyarylene sulfide component from the claims and also the detailed description of the invention both described in the present description (Exhibit A1), ... and that there is no error in the recognition for the present inventions 1 to 13.
(3) Here, it will be examined whether or not the glass fiber is filled in the "composition comprising a blend of a polyamide component a polyarylene sulfide component" recited in Claim 1 of the Claims in the present invention 1. ... according to Table 13 (page 24) and Table 14 (page 25) of the present description (Exhibit A1), when the glass fiber is added to the composition of the polyamide component and the polyarylene sulfide component, it is clear that the physical property such as flexural strengths and the like is changed. ... while the physical property such as flexural strengths and the like is an important property for the composition of the present invention having utility in molding, there is no statement in the Claims that the glass fiber is contained as a component of the composition, as mentioned above. Rather, the Claims state that "composition comprising a blend of a polyamide component and a polyarylene sulfide component, ... the polyphthalamide has a heat deflection temperature at 1820 kPa (264 psi) according to ASTM D-648 of at least 240°C, when filled with 33 weight percent glass fibers based on the total weight of the polyphthalamide and the glass fiber". Hence, it is reasonable to construe that the glass fiber is not a component of the composition of the blend and that the glass fiber is not contained in the "composition comprising a blend of a polyamide component and a polyarylene component" of the present invention 1.</td></tr>
</table>

(51-1)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 2.
Classification of the Case	51-1: Interpretation on whether the claim is an open claim (invention that can contain other constitution than constitution of the claim), or a closed claim (invention limited to the constitution of the claim)
Keyword	

1. Bibliographic Items

Case	"Control-type rectifier bridge circuit comprising an overvoltage protection circuit" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, August 8, 2012 (2011 (Gyo KE) No. 10358)
Source	Website of Intellectual Property High Court, HANREI JIHO No. 2172, page 97
Application No.	Japanese Patent Application No. 2000-564288 (National Publication of International Patent Application No. 2002-523008)
Classification	H02P 9/10
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division Presiding judge Makiko TAKABE, Judge Yasuhito INOUE, Judge Iwao SAITO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention aims to provide a control-type rectifier bridge circuit comprising an overvoltage protection circuit by which peak of a voltage generated when load is open is made lower than the conventional technology, wherein the control-type rectifier bridge circuit for a power generator having a plurality of phase windings and one excited winding is configured as a self-control-type rectifier bridge circuit including an MOS field effect transistor, a voltage protection circuit is inserted to this type of rectifier bridge circuit when the load is reduced quickly and a load damp voltage is generated, and the voltage protection circuit is shorted as the excited winding is shut off by feeding back to a battery any energy accumulated in the excited winding in the case of quick interruption, and as the power generator winding drives a low-side transistor or a high-side transistor accordingly when the load is quickly reduced.

(2) Disclosure of Detailed Explanation of the Invention (Finding of Decision)

"The claimed invention relates to a control-type rectifier bridge circuit comprising an overvoltage

protection circuit for a three-phase power generator used in a vehicle, and has an advantage that peak of a voltage to be generated when a load is open is made lower than the conventional technology."

Reduction of an output voltage of a power generator is achieved by interruption of an excitation current. However, since a reverse voltage is induced in the excitation winding when the excitation current is interrupted, two diodes are provided. When the excitation current is interrupted, specifically, when transistors V11, V21 are prevented, magnetic energy accumulated in the excitation winding is fed back to a battery.

In the case of load damp, in particular, more specifically, in an operating condition in which a load of the power generator is reduced as quickly as possible, quick reduction of a generated load damp voltage is required. However, the reduction is executed especially quickly by semiconductor valves V31, V41.

Therefore, the claimed invention is not to attempt to protect a reverse voltage, which is generated due to interruption of the excitation current and induced to the excitation winding as a "overvoltage", but to quickly reduce (protect) the load-damp voltage generated in an output voltage of the power generator as "overvoltage" in an operating condition in which the load of the power generator is quickly reduced." (Extracted from the decision)

(3) The Claims (Amended) (Claimed invention)

[Claim 1] In a control-type rectifier bridge circuit for a power generator having a plurality of phase windings and one excitation winding wherein the control-type rectifier bridge circuit has a rectifier element configured as an MOS field effect transistor, the rectifier element is connected to a phase winding of the power generator, a voltage sent by the rectifier element from the power generator is rectified before being supplied to a battery (B) and an electric load, level of the voltage of the power generator is controlled by affecting an excitation current passing through the excitation winding via a voltage control circuit, a protection circuit is arranged in the excitation winding, magnetic energy accumulated in the excitation winding is converted into electric energy when the protection circuit quickly reduces the electric load and then fed back to the battery (B) and the excitation winding is shut off, the control-type rectifier bridge circuit for the power generator having the plurality of phase windings and one excitation winding wherein the protection circuit has two semiconductor switches (V11, V21), the two semiconductor switches are series-connected to the excitation winding and connected to the battery (B) in parallel, a first diode (V31) is arranged in parallel to a series circuit of the first semiconductor switch (V11) and the excitation winding (E), and furthermore, a second diode (V41) is arranged in parallel to a series circuit of the second semiconductor switch (V21) and the excitation winding (E).

(4) Procedural History

July 27, 1999	:	International patent application (Date of claim of priority: August 5, 1998/Germany)
April 1, 2009	:	Final rejection
August 5, 2009	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2009-13910)
April 19, 2011	:	Amendment (See "The Claims" described above.)(Amendment of this case)
June 21, 2011	:	Appeal decision of "The request for a trial of this case is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">... The claimed invention could be easily invented by a person skilled in the art based on the invention stated in the citation of A below and the matters stated in the well-known examples 1 and 2 of B and C below...
In addition, considering as a prerequisite for its determination that a configuration of the claimed invention of "a protection circuit has two semiconductor switches (V11, V21) can be interpreted in two ways of (1) a configuration that "a protection circuit has two or more semiconductor switches"(Interpretation 1) and (2) a configuration of "a protection circuit has only two semiconductor switches" (Interpretation 2), the appeal decision of this case found identical features and differences ... of the claimed invention and the cited invention when each of the interpretations is made.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) ...Regarding Interpretation 1 ...
...The appeal decision of this case made determination for two separate cases that the protection circuit of the claimed invention has two or more semiconductor switches (Interpretation 1) and that the protection circuit of the claimed invention has only two semiconductor switches (Interpretation 2).
However, in claim 1, it is stated that "the protection circuit has two semiconductor switches, the two semiconductor switches are series-connected to the excitation winding", and also in the detailed explanation, the working example of the case in which the semiconductor switches are only two is explained. Therefore, it is obvious from the statement of the claim and the description of this case that the claimed invention assumes the case that the semiconductor switches are only two...
In addition, also from the standpoint of the idea of protection and effects, it is not possible that the number of semiconductor switches is any number other than two. This is because only a magnetization function suffices when residual excitation energy is extinguished by a circuit phenomenon as in the claimed invention, and thus the semiconductor switches are two...</td><td>Allegations by Defendant
(1) ...Regarding Interpretation 1 ...
The claim 1 does not state "only two". Thus, the semiconductor switches in the protection circuit may be more than two. Therefore, a protection circuit having four semiconductor switches are also included...</td></tr>
</table>

Judgment by the Court

(1) Determination based on Interpretation 1

...The claims states "two semiconductor switches", and the detailed explanation of the invention of the description of the application also states the working example of the case in which there are two semiconductor switches (transistors and there is no statement of the case in which there are the semiconductor switches the number of which exceeds two.

Therefore, in the claimed invention, the protection circuit has two semiconductor switches, and it is not necessary to separately determine Interpretation 1 and Interpretation 2: Interpretation 1 on the assumption that the protection switch has two or more semiconductor switches and Interpretation 2 on the assumption that the protection switch has only two semiconductor switches. Hence, the determination on the finding in the appeal decision of this case that was made based on Interpretation 1 is an error in that respect.

...Even if it was interpreted regarding the claimed invention that the protection circuit had two or more semiconductor switches, the determination on ... differences in that case is ... an error.

(52)-1

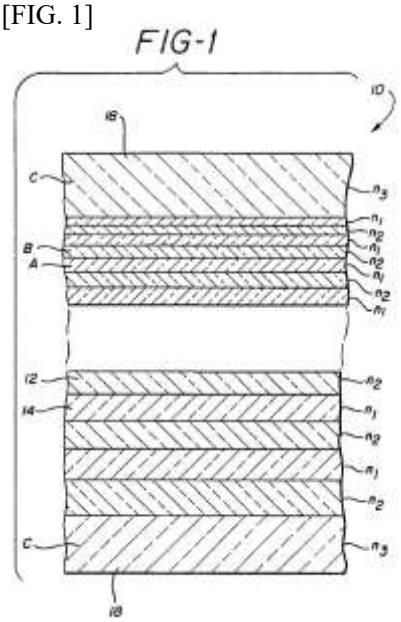
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	Hindsight

1. Bibliographic Items

Case	"Moldable Reflecting Multilayer Object" (Appeals against an Examiner's Decision of Refusal) Intellectual Property High Court Decision , March 28, 2007 (2006 (Gyo KE) No. 10211)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H6-511080 (National Publication of International Patent Application No. H8-503312)
Classification	G02B 5/08
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division Presiding judge Ryoichi MIMURA, Judge Yuji KOGA, Judge Kazuhide SHIMASUE

2. Overview of the Case

[FIG. 1]

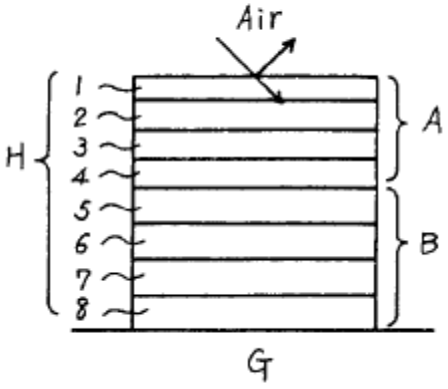


(1) Summary of Claimed Invention

…… The claimed invention provides a moldable multilayer reflecting pol substantially uniform wide bandwidth across substantially all ranges of a visible spectrum and presenting substantially uniform reflection appearance. The moldable multilayer reflection polymer object contains first and second heterogeneous high polymers, and includes a sufficient number of alternate layers of the first and the second high polymers so that at least 40% of visible light entering the object is reflected. A total of optical thickness of a repeating unit of a high polymer has optical thickness in a range exceeding approximately 190 nm. Refractive indexes of the first and the second high polymers differ from each other by at least 0.03. Furthermore, the layer has a gradient of thickness of the repeating unit of the optical layer so that a wavelength from primary reflection from the thinnest repeating unit and the thickest repeating unit of the optical layer differs by at least twice.

(2) Overview of paper publication 2 invention

[FIG. 3]



"...in a half mirror in which a high-refractive-index dielectric and a low-refractive-index-dielectric which are transparent in a visible wavelength region are alternately laminated on a substrate to be multiple layers, in order to solve the problem that while almost flat spectral characteristics can be obtained across the visible region, a reflectance there of is approximately 50% and not suitable for use in a main mirror of a single-lens reflex camera, when in a half mirror in which a high-refractive-index dielectric and a low-refractive-index-dielectric which are transparent in a visible wavelength region are alternately laminated on a substrate to be multiple layers, the number of all layers L consists of 7 to 10 layers and the layers are made a first layer, a second layer... in the order from the air side to the substrate side, and the layers are such divided that those from the air side to the L/2 layer are made group A and the layers more on the substrate side than on the air side are made group B if the number of all layers L is even, while the layers from the air side to (L+1/2) layer are made group A and the layers more on the substrate side than on the air side are made group B if the number of all layers L is odd, use of a configuration that optical film thickness of the layer whose optical film thickness is largest in the group A is made smaller than the optical film thickness of the layer whose optical film thickness is smallest in the group B makes it possible to obtain the half mirror having a reflectance of approximately 55% to 80% and flat spectral characteristics. (Extracted from the decision)

(Example 1)
Table 2

	Refractive index	Optical film thickness		
Air	1．0			
1st layer (1)	2．12	0．225λ	Group A	H
2nd layer (2)	1．385	0．246λ		
3rd layer (3)	2．12	0．222λ		
4th layer (4)	1．385	0．341λ		
5th layer (5)	2．12	0．409λ	Group B	
6th layer (6)	1．385	0．419λ		
7th layer (7)	2．12	0．438λ		
Substrate (G)	1．52			

(Example 3)
Table 4

	Refractive index	Optical film thickness		
Air	1．0			
1st layer (1)	2．3	0．144λ	Group A	H
2nd layer (2)	1．47	0．242λ		
3rd layer (3)	2．3	0．229λ		
4th layer (4)	1．47	0．220λ		
5th layer (5)	2．3	0．370λ	Group B	
6th layer (6)	1．47	0．341λ		
7th layer (7)	2．3	0．402λ		
8th layer (8)	1．47	0．467λ		
Substrate (G)	1．52			

(3) The Claims (Amended) (Only Claim 2 is stated) (Claimed invention)

[Claim 2] A moldable polymer multilayer reflecting object presenting substantially uniform reflection appearance across substantially entire range of a visible spectrum, including at least first and second heterogeneous high polymers, and including a sufficient number of alternate layers of the first high polymer and the second high polymer so that at least 40% of visible light entering an object is reflected, the moldable polymer multilayer reflecting object wherein in substantially most of individual layers of the object, a refractive index of the first high polymer differs from that of the second high polymer by at least approximately 0.03 in an object having optical thickness in a range in which a total of optical thickness of the repeating unit of the high polymer exceeds approximately 190 nm, and furthermore, the layer has a gradient of thickness of a repeating unit of an optical layer so that a wavelength of primary reflection from the thinnest repeating unit of the optical layer differs by at least twice from that of primary reflection from the thickest repeating unit.

(4) Procedural History

October 5, 1993	:	International patent application (Date of claim of priority: October 29, 1992)
February 20, 2003	:	Amendment (See the "The Claims" described above.)
April 8, 2003	:	Final rejection
July 14, 2003	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-13402)
December 14, 2005	:	Appeal decision of "The request for an appeal of this case is dismissed."

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

Appeal Decision (cited from the Court Decision)

...The claimed invention can be easily invented by a person skilled in the art based on ... the paper publication 1 invention ... and the paper publication 2 invention, and cannot be patented in accordance with the provisions of the Patent Act, Article 29(2)....

The difference of the claimed invention and the paper publication 1 invention ... found by the appeal decision is ... as follows.

(Difference 3)

While in the claimed invention, ... the layer has a gradient of thickness of the repeating unit of the optical layer so that a wavelength of primary reflection from the thinnest repeating unit of the optical layer differs by at least twice from that of primary reflection from the thickest repeating unit, there is no statement to that effect in the paper publication 1 invention.

...the finding of the appeal decision that in the paper publication 2, "a multilayer film in which a high-refractive-index dielectric and a low-refractive-index dielectric are laminated alternately and with a gradient in optical thickness of each layer in order to cause it to have high reflection characteristics across the entire visible light is disclosed" (the written appeal decision, page 5, lines 21 to 23), and the finding of the appeal decision that because of the paper publication 2, "in order to cause it to have the reflection characteristics across the entire visible light, laminating two layers of different refractive indexes and having a gradient in the optical layer" (the written appeal decision, last line on page 5 to first line on page 6) is publicly known ...

Decision

Allegations by Plaintiff	Allegations by Defendant
Since the publication 2 ... does not show the configuration that a gradient is provided in optical film thickness across the layer, ...any of the findings of the appeal decision is an error. A The publication 2 shows no configuration that in each layer, the optical film thickness gradually thickens at a certain rate. Even when looking at the working example ... in the publication 2, there are some parts where the optical thickness is thin as the optical layer thickness is reversed between any layers even though the layer is closer to the substrate, when the layers are made a first layer, a second layer, ... a n^{th} layer in the order from the air side to the substrate side. As such, the publication 2 does not show the configuration that the gradient is transversely, provided in the optical film thickness in all layers (more specifically, the optical thickness gradually	A "Repeating" in a "repeating unit" means "doing the same thing (matter) many times, repeating." (Koujien dictionary, fifth edition), and the "repeatineg unit" means a unit of repeating the same thing. In addition, ... in the publication 1 and Exhibit B1 to Exhibit B3, there is the statement that coincides with the "repeating unit" in the claimed invention which is configured by making one pair of two types of polymer with different refractive indexes a unit. It is also stated that a wavelength reflection of which is desired is designed based on the optical thickness of the repeating unit by using the following calculating formula to determine a wavelength to be reflected from the "optical thickness of the repeating unit". Therefore, both of the concept of the "repeating unit" and designing the optical film thickness (optical thickness) based on the "repeating unit" are publicly known, and it is obvious to a person skilled in the art

thickens in a consistent manner). B(A) Citing Exhibit B1 ..., Exhibit B2 ..., and Exhibit B3..., the Defendant alleges that it is obvious to a person skilled in the art that a design must be made based on optical thickness of a repeating unit when it is desired to reflect light of a certain wavelength. However, the sequential lamination of continuous phase adjacent layers having different refractive indexes in the light reflective multilayer film stated in Exhibit B1 or Exhibit B3 is not same as the repeating unit in the claimed invention. If an optical reflective film is configured using two types of polymer with different refractive indexes, light reflection occurs at a boundary of the layers with different refractive indexes. Thus, if an attempt is made to achieve reflection between the layers, there is no other alternative but to alternately dispose two types of polymer to be used. However, this is an entirely different technical idea from the idea that for these layers, a combination of two types of adjacent layers is made one unit as a pair and all layers are considered lamination of the repeating units. (B) Although the Defendant alleges that the configuration that the gradient is provided in the optical layer thickness across the layer is stated in Table 4 in the publication 2, it is an error. While the publication 2 discloses the technical idea of alternately laminating a high-refractive-index dielectric and a low-refractive-index dielectric, the technical idea of considering adjacent two layers one unit as a pair and configuring a laminated boy by repeating the unit is neither stated nor suggested. This is simply shown in the fact that an odd number of layers are present in the working example, and it is naturally forecast that the number of all layers is odd. In addition, as described in (a) above, the technical idea of considering adjacent two layers one	that designing should be performed based on the optical thickness of the repeating unit when it is desired to reflect light of a certain wavelength. B When looking at Table 4 ... in the publication 2 from the standpoint of A above,... is stated a layer configuration of a half mirror having a 8 layer configuration consisting of alternate layers of a high-refractive-index dielectric layer and a low-refractive-index dielectric layer, and a repeating unit is repeated four times (a first layer and a second layer, a third layer and a fourth layer, ... a seventh layer and an eighth layer). Then, the optical film thickness of the repeating unit is 0.386λ in the repeating unit consisting of the first layer and the second layer, 0.449λ in the repeating unit consisting of the third layer and the fourth layer, ..., 0.869λ in the repeating unit consisting of the seventh layer and the eighth layer, and the optical thickness gradually thickens in a consistent manner. It can be stated that the configuration that a gradient of the optical thickness is provided across the layer is stated. The publication 2 invention sets optical thickness of individual components without referring to the optical thickness of the repeating unit. However, as described in A above, in the publicly known configuration of multilayer film reflector, alternate layers with different refractive indexes are a basis of the configuration as an indispensable element thereof. Thus, naturally, the optical thickness of the repeating unit that two adjacent layers are made one unit as a pair is also taken into consideration. As such, in the publication 2, the repetition of alternate layers of a high-refractive-index dielectric layer and a low-refractive-index dielectric layer can also be considered a laminated body with the repeating unit as a unit. Thus, it should be stated that the technical idea of considering adjacent two layers one

unit as a pair and configuring a laminated boy by repeating the unit is neither publicly known nor obvious. However, given that the publication 2 invention forecasts that the number of all layers is odd, it should be stated that the technical idea of the publication 2 conflicts with the above-mentioned technical idea of making adjacent two layers a repeating unit.	unit as a pair and configuring a laminated boy by the repeating unit is stated. In addition, although the Defendant points out that in the publication 2 invention, it is forecast that the number of all layers is odd, a substrate used in a base of the alternate layers made by laminating an odd number of layers as stated in the publication 2 is virtually used as a dielectric layer having the refractive index of around 1.5, and consequently constitutes one unit with adjacent dielectric layer. Thus, the Defendant's indication does not prevent the idea of considering two adjacent layers one unit as a pair. C ...The publication 2 states the configuration of providing a gradient of the optical thickness transversely in all layers, and the finding of the publication 2 invention in the appeal decision is not an error.

Judgment by the Court

...It can be stated that the publication 2 only discloses that with the configuration that the number of all layers L to be laminated is divided to two groups of the air side (group A) and the substrate side (group B), and the optical film thickness of the layer whose optical film thickness is largest in the group A is smaller than the optical film thickness of the layer whose optical film thickness is smallest in the group B, the half mirror having a reflectance of approximately 55% to 80% and flat spectral characteristics can be obtained, and it cannot be stated that the publication 2 states that the half mirror is caused to have high reflection characteristics across the entire visible light region by causing the optical thickness of the layers of dielectrics to be laminated to have a gradient.

Certainly, looking at the working example 3 in the publication 2 ..., it is found that the optical thickness (total of two layers) of each unit sequentially increases from the air side to the substrate side when two adjacent layers are considered one unit as a pair. However, the publication 2 has no statement on making adjacent high-refractive-index layer and low-refractive-index layer a pair and considering it as an optical layer of one unit. In addition, in light of the number of laminated layers being odd in the working example 1..., it is obvious that adjacent high-refractive-index layer and low-refractive-index layer are not treated as the optical layer of one unit as a pair. Then, there is no statement explaining how optical film thickness of each dialectic layer in each working example is defined, the optical film thickness is shown by using the design wavelength of λ, and it is stated that this design wavelength λ is 550 nm. Thus, it cannot be interpreted either that layer thickness of each dielectric layer of the half mirror stated in the publication 2 is defined based on the wavelength. In addition, ...since the working example in which the number of layers is odd is present in the publication 2, ... it

cannot be stated ...that only for the working example 3 in which the number of layers is even..., a person skilled in the art recognizes the film thickness of two dielectrics with different refractive indexes as a pair, as an optical layer of one unit.

In addition, the Defendant alleges the following: Even in the working example in the publication 2 in which the number of layers is odd, if the substrate is considered one dielectric layer, the substrate and adjacent dielectric layer constitute one unit of two dielectrics with different refractive indexes. Thus, the fact that in the publication 2, the working example in which the number of layers is odd is disclosed does not prevent the idea of making two layers of adjacent dielectrics with different refractive indexes a pair and considering it one unit. However, the publication 2 does not state that the substrate is considered one dielectric layer, and Tables 1 to 8 which shows thickness of the dielectric layers and does not state the optical thickness of the substrate. In addition, in Tables 2 to 8, "H" representative of the half mirror unit is shown excluding the air and the substrate. Thus, it should be stated that it is unreasonable to consider the substrate as one dielectric layer for the working example in which the number of layers is odd, of those stated in the publication 2. In addition, if the substrate was considered one dielectric layer, the working example in which the number of layers is even would lack an adjacent dielectric layer which is paired with the substrate is missing. The Defendant's allegations mentioned above cannot be adopted.

D With the above, it should be stated that the finding made in the appeal decision that in the publication 2 ,""a multilayer film in which a high-refractive-index dielectric and a low-refractive-index dielectric are laminated alternately and with a gradient in optical thickness of each layer in order to cause it to have high reflection characteristics across the entire visible light is disclosed" and also the finding that "in order to cause it to have the reflection characteristics across the entire visible light, laminating two layers of different refractive indexes and having a gradient in the optical layer" is publicly known are the finding errors that are made in attempting to seek to see the content of the claimed invention in the statement of the publication 2 after learning the claimed invention.

(52)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	

1. Bibliographic Items

Case	"Straight Pipe Type Coriolis Flowmeter Assembly" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, October 24, 2011 (2010 (Gyo KE) No. 10405)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-506453 (National Publication of International Patent Application No. 2003-503692)
Classification	G01F 1/84
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Third Division Presiding judge Toshiaki IIMURA, Judge Kimiko YAGI, Judge Akira CHINO

2. Overview of the Case

(1) Summary of Claimed Invention

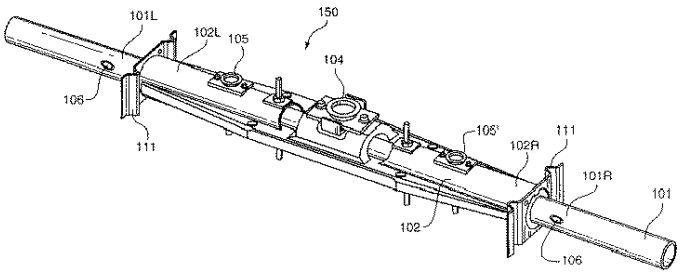
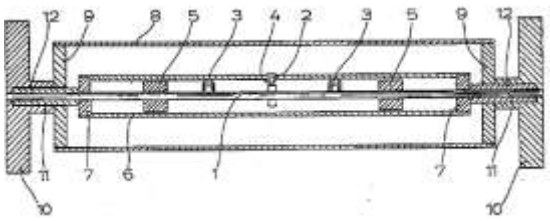


FIG. 7

The claimed invention is a method (1000) for manufacturing a straight pipe type Coriolis flowmeter. When using local heating to connect a flow pipe assembly (150) including a balance bar (102) and a flow pipe (101) to two points in a casing (103), the method reduces damages by expansion of a component due to local overheating or damages to electric parts in the casing (103) by mounting a case connection unit (111) to each end of the flow pipe assembly (150) and connecting the case connection unit (111) to a bracket on an inner surface of the casing (103).

(2) Matters stated in Cited Publication 2 (JP H5-248913A)

[FIG. 8 [FIG. 1 of the cited paper publication 2]]



"[0010] In the present invention, a compensating cylinder 6 is provided and a Coriolis conduct 1 is disposed in the compensating cylinder 6. Then, the Coriolis conduit 1 and the compensating cylinder 6 are coupled to each other in such a form that relative motion in an axial direction is eliminated, and are coupled to each other via a coupling ring 7 connected to the compensating cylinder 6 on the end side part in all of working examples shown. The coupling ring 7 is coupled to the compensating cylinder 6 by welding or hard soldering. It is also possible to thread the coupling ring 7 into the compensating cylinder 6 at the end side part. Advantageously, the coupling ring 7 is made of a same material as a material of the Coriolis conduit 1. The Coriolis conduct is coupled by welding or hard soldering, advantageously, by vacuum hard soldering. (Extracted from the decision)

(3) The Claims (Amended)(Claimed invention)

[Claim 1] A method (1000) for manufacturing a Coriolis flowmeter having a straight flow pipe (101) formed of first metal, comprising a step (1001) of bonding the straight flow pipe to a balance bar (102) which surrounds a part of the straight flow pipe (101) directed in substantially parallel to a vertical axis of the straight flow pipe (101) so that the straight flow pipe (101) and the balance bar (102) form a flow pipe assembly (150) and a step (1002) of installing a drive system (104) and detectors (105 to 105') to the straight flow pipe (101) and the balance bar (102), the method for manufacturing a Coriolis flow meter further including a step (1003) of inserting the flow pipe assembly (150) into an opening of a casing (103) formed of second metal which is different from the first metal, a step (1004) of using local heating to attach each end of the flow pipe assembly (150) to at least two points of the casing (103), a step (2002) of making the attaching each end of the flow pipe assembly (150) consist of installing a case connection unit (111) to each end of the flow pipe assembly (150) near each end of the balance bar (102), and a step (3002) of connecting, at each end of the casing (103), the case connection unit (111) to a bracket (133) located on an inner surface of the casing (103) and having substantially similar characteristics to the first metal.

(4) Procedural History

June 23, 2000	:	International patent application (Date of claim of priority: June 30, 1999/USA)
June 4, 2007	:	Final rejection
September 5, 2007	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2007-24327)
May 31, 2010	:	Amendment (See the "The Claims" described above.)
August 23, 2010	:	Appeal decision that the request for an appeal against decision of refusal is dismissed.

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">The appeal decision ... the invention stated in ..."cited publication 2" ... (hereinafter referred to as "cited invention 2"), after finding identical features and differences between the same invention and the claimed invention, the configuration of the claimed invention according to the difference 1 can be easily conceived by a person skilled in the art ... based on the cited invention 2. ...
(1) Content of the cited invention 2
A method for manufacturing a mass and flow measurement device formed of titanium or titanium alloy, having an Coriolis conduit 1 and a connecting conduit 11, which are integrally configured, and operating according to the Coriolis principle, the method for manufacturing the mass and flow measurement device, which operates according to the Coriolis principle, further comprising:
coupling the Coriolis conduit 1 and the connecting conduit 11 to a compensating cylinder 6 which is directed parallel to a vertical axis of the Coriolis conduit 1 and the connecting conduit 11 and covers a part of the Coriolis conduit 1 and the connecting conduit 11 and to a coupling ring 7 to form an assembly consisting of the Coriolis conduit 1, the connecting conduit 11, the compensating cylinder 6, and the coupling ring 7,
installing a vibration generator 2, a vibration arm 4, and a measurement pickup 3 in the Coriolis conduit 1 and the compensating cylinder 6,
making disposing the assembly in a receiving cylinder 8 formed of stainless steel and attaching each end of the assembly to the receiving cylinder 8 to mount each end of the assembly consist of installing a connection flange 10 at each end of the assembly near each end of the compensating cylinder 6 and the coupling ring 7, and
connecting, at each end of the receiving cylinder 8, the connection flange 10 to the coupling ring 9 located on the inner surface of the receiving cylinder 8 and each formed of stainless steel.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) The cited publication 2 relates to an invention of product and shows arrangement as a structure of a Coriolis flowmeter. However, the cited publication 2 does not clearly show a specific manufacturing method, and thus an invention of a specific manufacturing method cannot be found.</td><td>Allegations by Defendant
(1) When the invention for which a patent is sought is an invention of a method of manufacturing a product, in a publication defined by the Patent Act Article 29(1)(iii), which is contrasted with the invention for which a patent is sought, it is necessary that a configuration for manufacturing the product be disclosed to the limit necessary for contrasting with the content of the invention for which a patent is sought, and it suffices. ... according to the drawing of ... the mass and flow rate measurement device of the cited publication 2... and the description, at the limit necessary for contrast with the claimed invention, a person skilled in the art can recognize a specific series of manufacturing processes from a structure of the</td></tr>
</table>

	mass and flow rate measurement device, shape of components thereof, relative arrangement relation, or the like.

Judgment by the Court

...The publication 2 states that the coupling ring 7 and the compensating cylinder 6 are coupled by welding or hard soldering or threading, and the Coriolis conduit 1 is connected by welding or hard soldering, advantageously, by vacuum hard soldering, and shows a method of manufacturing a structure unit consisting of the coupling ring 7, the compensating cylinder 6, and the Coriolis conduit 1 (paragraph [0100]). However, the publication 2 neither states nor suggests a method of manufacturing an entire Coriolis flow meter. In addition, the publication 2 neither states nor suggests a procedure to install an electronic device which is closely related to the problem to be solved by the invention concerned. With this, it is not possible to find the method of manufacturing the entire Coriolis mass and flowmeter on the ground of the statements on a method of bonding a part of the Coriolis mass and flow meter.

Therefore, the finding by the appeal decision for the cited publication 2 that ... the manufacturing method of the Coriolis mass and flow meter is disclosed is an error.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	

1. Bibliographic Items

Case	"Flexible Polyurethane Material" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, July 17, 2013 (2012 (Gyo KE) No. 10300)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-544752 (National Publication of International Patent Application No. 2002-512294)
Classification	C08G 18/40
Conclusion	Acceptance
Related Provision	Article 29(1)(iii)
Judges	IP High Court First Division, Presiding judge: Toshiaki IIMURA, Judge: Kimiko YAGI, Judge: Shinji ODA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide an optically transparent polyurethane (cover) that is flexible, durable and weather resistant, and is a flexible polyurethane material and relating to a solvent free, two-component polyurethane.

(2) Summary of Cited invention

(i) Citation (Cited invention): JP S56-37253A (identification of appeal decision)

"adhesive layer comprising polyurethane having lower than 10 in shore hardness by heating and curing a biuret containing 1850 g of polyether polyol and 716 g of 1,6-hexamethylene isocyanate under the presence of 0.19 g of dibutyl tin dilaurate" (cited from the Court Decision)

(3) The Claims (Amended) (claimed invention 1) (as described upon segmentation)

[Claim 1]

a with primary aliphatic isocyanate crosslinking,

b and with at least 25 weight% of primary polyisocyanate crosslinking,

c and exhibiting a flexural modulus of 1.0×10^8 pascals or less,

d a storage modulus of 1.0×10^8 pascals or less,

e and a Shore A hardness of less than 94

f a polyurethane,

g wherein said polyurethane

h a Hoffman scratch-hardness test result of 2 or less,

i and a color shift, in accordance with heat aging test ASTM D2244-79, within 1 delta E

j exhibits either one or both of the properties, or does not exhibit

k polyurethane.

(hereinafter, referred to as "feature a", "feature b", "feature c" and the like for individual constituent features)

(4) Procedural History

March 19, 1999	:	International Patent Application (Priority date: April 22, 1998, USA)
January 29, 2009	:	Decision of refusal
May 7, 2009	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2009-9616)
February 16, 2012	:	Amendment (see the above-mentioned "The Claims")
April 10, 2012	:	Appeal decision of the request being invalid

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">The claimed invention 1 is the invention stated in the Citation and fall within Article 29(1)(iii) of the former Patent Act No. 41 of 1999 (hereinafter, simply referred to as "Article 29(1)(iii) of the Patent Act"), since the differences 1 and 2 which are the difference between ...the claimed invention 1 and ...the inventions stated in "Citation" (...hereinafter, referred to as "cited invention") is not a substantial difference.
The content of the cited invention, and coincidence and difference between the claimed invention 1 and the cited invention, which have been identified in the appeal decision, are as follows:
(2) Coincidence
There is "a polyurethane with primary aliphatic isocyanate crosslinking and at least 25 weight% of primary polyisocyanate crosslinking"
A Difference 1
The difference in that while the claimed invention 1 limits the Shore A hardness, the flexural modulus and the storage modulus of a polyurethane, the cited invention does not recite such a limitation.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
A Error in the identification of the cited invention</td><td>Allegations by Defendant
A Response to the error in the identification of the cited invention</td></tr>
</table>

While the appeal decision has identified that the cited invention relates to an invention of "polyurethane", stated in the Citation is "polyol containing urethane bond", not "polyurethane", and there is an error in the above-mentioned identification of the appeal decision. Claim 1 of the Citation states "comprising a polyol component and a polyvalent isocyanate component and a ratio in numbers of isocyanate groups to hydroxyl groups is from 0.2 to 0.6 by using an excess amount of the polyol component" and the ratio in numbers of isocyanate groups to hydroxyl groups is a range of "0.2 to 0.6" in all of the examples including the Example 1 stated in the Citation. In addition, the Citation states that "In this mixture, a reaction product as polymerized is not a polyurethane in a strict sense. This is a sort of polyol containing polyurethane group, since it contains an excess amount of components having hydroxyl group." (Page 3, right upper column, Lines 10 to 13). As mentioned above, the reaction product of the polyvalent isocyanate component and the polyol component, stated in the Citation is originated from the polyol component with an excess amount in use, is "polyol containing urethane bond", not "polyurethane". C Error in the determination that the Difference 1 is not a substantial difference While the determination on the Appeal decision is on the premise that the cited invention relates to polyurethane, there is an error in the premise, since the cited invention relates to "polyol" having a reactive hydroxyl group at its end, not "polyurethane", as mentioned above.	(A) The Citation clearly states that the cited invention has polyurethane as a component. Since "poly" is a prefix indicating 2 or more numbers, and it can be said if a compound has 2 or more of urethane bond formed in its molecular structure by the reaction of isocyanate group and hydroxyl group, the compound can be said as polyurethane, the cited invention is an invention of polyurethane as its component. In addition, the claimed invention 1 is not that the ratio of NCO/OH in polyurethane is limited to be a specific range. C Concerning the error in the determination that the Difference 1 is not a substantial difference ...the cited invention relates to a polyurethane elastomer, similar to the claimed invention 1, and has <u>less than 10 in the Share A hardness</u>. Accordingly, there is no error in the determination of the Appeal decision that the cited invention complies with the feature e and has a high probability to comply with the feature c and the feature d.
Judgment by the Court (1) Concerning the error in the identification of the cited invention According to the Kagaku Dai-jiten (Exhibit A14), "polyurethane" is a generic name of polymer substance	

having urethane bond -NHCOO- in its main chain. In addition, the reaction product in the cited invention is a polymer substances obtained by reacting polyether polyol which is a polyol component and 1,6-hexamethylene diisocyanate which is a polyvalent isocyanate component, is in that both components are bound with polyurethane bond -NHCOO-, and corresponds to "polyurethane" according to the above-mentioned definition. Therefore, there is no error in the appeal decision that the reaction product in the cited invention was identified as "polyurethane".

(3) Concerning the error in the determination that the Difference 1 is not a substantial difference

The appeal decision has determined that (i) the polyurethane in the cited invention overlapped with the requirement (feature e) of "Shore A hardness of less than 94" which is the c.//haracteristic of the polyurethane in the claimed invention 1 according to the common general knowledge since the polyurethane in the cited invention has lower than 10 in shore hardness and (ii) it can be understood that there is a high probability that the polyurethane in the cited invention meets the feature c and the feature d in the claimed invention 1, since the polyurethane in the cited invention is sufficiently low in the shore hardness (that is, soft), and that the Difference 1 is not a substantial difference.

However, there is an error in the determination that the appeal decision is not a substantial difference, as mentioned below.

Polyurethane has a variety of hardness (firmness) of "Shore 10A to 90D" (Exhibit B1). On the other hand, as mentioned above, while the polyurethane in the cited invention is stated to have "lower than 10 in shore hardness", it is not clear whether or not the "shore hardness" in the description indicates "Shore A hardness", and what degree of hardness "Shore hardness 10" is.

Therefore, , it should be said that there is the error in the determination that the Difference 1 is not a substantial difference from the facts that the polyurethane in the cited invention is overlapped with the requirement of "shore A hardness of less than 94" which is the characteristic of the polyurethane in the claimed invention 1, and that there is high probability to meet the feature c and feature d in the claimed invention 1 based only on the description that the polyurethane in the cited invention has "lower than 10 in shore hardness"., .

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	

1. Bibliographic Items

Case	"Exhaust Gas Purifying System" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, May 26, 2014 (2013 (Gyo KE) No. 10248)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2008-103684 (JP 2009-52542A)
Classification	F01N 3/24
Conclusion	Acceptance
Related Provision	Article 29(1)(iii)
Judges	IP High Court Second Division, Presiding judge: Setsu SHIMIZU, Judge: Yasushi NAKAMURA, Judge: Yuki NAKATAKE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide an exhaust gas purifying system capable of achieving compact catalyst systems and ensuring compatibility between reduction of NOx and oxidation of hydrocarbons, in consideration of a problem that, in the conventional methods, it is difficult to ensure compatibility between reduction of NOx and oxidation of hydrocarbons and lowering fuel efficiency and requirement a large amount of catalyst storage and quantity is unavoidable in order to purify the exhaust gas, and is characterized in that hydrocarbons which have been completely combusted in the conventional method is incompletely combusted and partially oxidized to generate hydrogen so that it is provided for the reduction of NOx.

(2) Summary of the cited invention

Citation 1 (JP 2003-311152A) (See "3. Portions of Appeal/Trial Decisions relevant to the Holding" in the Appeal Decision)

(3) The Claims (Amended) (Amended invention)

[Claim 1] An exhaust gas purifying system for an internal combustion engine, the system comprising:

a NOx trapping agent which absorbs NOx when an excess air ratio (λ) of exhaust gas is more than 1, and releases NOx when λ is 1 or less;
a purifying catalyst; and
an oxygen concentration controller which controls oxygen concentration in the exhaust gas,
wherein, when λ of the exhaust gas is more than 1, NOx is adsorbed to the NOx trapping agent, and
when λ of the exhaust gas is 1 or less, NOx is released from the NOx trapping agent and the oxygen concentration controller controls the oxygen concentration of the exhaust gas at an inlet of the purifying catalyst between 0.8 and 1.5% by volume, so that the partial oxidized reaction of hydrocarbon is induced to reduce NOx by utilizing the partial oxidation.

(4) Procedural History

April 11, 2008	:	Japanese Patent Application (Priority date: August 1, 2007)
July 17, 2012	:	Decision of refusal
October 17, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2012-20370)
October 17, 2012	:	Amendment (See the above-mentioned "The Claims")
July 22, 2013	:	Dismissal of the above-mentioned Amendment, Appeal decision that "the request for the present appeal is dismissed."

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

Appeal Decision (cited from the Court Decision)
A The Appeal Decision has identified the cited invention stated in Citation 1 that "an exhaust gas purification system of an engine 4 such as an automotive lean burn engine or a direct injection gasoline engine comprising: a NOx absorber for absorbing NOx in an oxygen-rich atmosphere in which the oxygen concentration in the exhaust gases is high and releasing NOx during rich burn operation in which the engine combustion condition falls into the vicinity of the ideal air-fuel ratio or the excess air ratio λ≤1; precious metal such as Pt, Rh and the like; and emission control means 8 for changing the oxygen concentration in the exhaust gases, wherein the NOx is absorbed in the NOx absorber in the oxygen-rich atmosphere in which the oxygen concentration in the exhaust gases is high, and the NOx is released from the NOx absorber during the rich burn operation in which the engine combustion condition falls into the vicinity of the ideal air-fuel ratio or the excess air ratio λ≤1, the oxygen concentration comprising the NOx absorber and the precious metal in the emission control means 8 in the exhaust gases at the inlet of a catalyst for purifying exhaust gases 1 is controlled to be 2.0 or less, hydrocarbon is partially oxidized and activated to promote the reducing reaction of NOx, and in turn the conversion efficiencies of hydrocarbon and NOx are improved." Among them, the Appeal Decision has identified that "hydrocarbon is partially oxidized and activated" as a mechanism providing the working-effect

<table>
<tr><td colspan="2">that the conversion efficiencies of hydrocarbon and NOx are improved.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
...Ce-Zr-Pr mixed oxide is a different component than the NOx absorber and the precious metal in the Citation 1, and stated as a most characteristic matters specifying the invention which has a large contribution to complete the invention. Nevertheless, it has to say that there is an error in the identification of the cited invention that "Ce-Zr-Pr mixed oxide" is lacked to omit a part of the matters specifying the invention.</td><td>Allegations by Defendant
(1) In an identification of a cited invention, to evaluate a patentability of an amended invention (or an invention prior to the amendment), may be performed within a requisite boundary. It is not that matters which have a characteristic in the Citation 1 itself (for example, the matters specifying the invention according to Claim 1) are necessarily identified.
...in the identification of the cited invention, it is not that to include "Ce-Zr-Pr mixed oxide" is necessarily identified, and there is no error in the Appeal Decision that the arrangement of the catalyst in the cited invention has identified as "catalyst for purifying exhaust gases 1 comprising the NOx absorber and the precious metal".</td></tr>
<tr><td colspan="2">Judgment by the Court
Certainly, "invention described in a publication" pursuant to Article 29(1)(iii) of the Patent Act is as one of prior arts to be considered upon determining novelty and inventive step of the invention for which a patent is sought by an applicant. When "the invention described in a publication" is of a patent publication, it is not that the matters specifying the invention in the claims in a patent publication have to be necessarily identified. On the other hand, as long as "the invention" described in a publication", it is natural that such an invention should be "creation of technical ideas utilizing the laws of nature" (Article 2(1) of the Patent Act), and when such a technical idea is not disclosed in a publication, it cannot be accepted as a cited invention.
In this case, as mentioned above, although the effect that "hydrocarbon is partially oxidized and activated to promote the reducing reaction of NOx, and in turn the conversion efficiencies of hydrocarbon and NOx are improved" has been identified as the cited invention, the Appeal Decision has identified with omission of "Ce-Zr-Pr mixed oxide" which is an indispensable component for providing the working-effect. Therefore, the Appeal Decision has not identified a necessary technical means for providing the working-effect, and it cannot be identified that the cited invention identified by the Appeal Decision is the prior invention stated in the Citation 1.</td></tr>
</table>

(52)-5

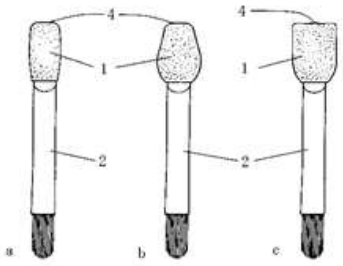
Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 3
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	

1. Bibliographic Items

Case	"A make-up tip"(Appeals against an Examiner's Decision) Intellectual Property High Court Decision, January 28, 2015 (2014 (Gyo KE) No.10131)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2010-7777 (JP2011-143137A)
Classification	A45D 34/04
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Tadao ISHII, Judge: Masaya TANAKA, Judge: Kouki KAMITYA

2. Overview of the Case

[FIG. 2]



(1) Summary of Claimed Invention

The claimed invention, comprising: an edge part of application tip made in a linear or a planar state, the edge part preferably having 5-12 mm of width and 1-8 mm of thickness; a make-up tip whose application part can be composed of a base material and a skin layer formed in its surface; application surely made as intended to a part such as eyelid, width of an eyelid fold, inner corners of eyes that needs delicate application.

(2) The Matter as Stated in Cited Publication 1 (the Microfilm of Japanese Utility Model Application No. S60-203064 (JP H2-112211U))

" 'Claims of Utility Model Registration' of Cited Publication 1 states the device (hereinafter referred to as "Device 1") of 'an application tool for make-up, comprising a core material whose application body has elasticity and a skin made of urethane form with ultrafine-pores that covers its surface,' and the 'detailed explanation of the device' states that, concerning the conventional technology, there is a problem that a fine powder as the material of cosmetic is extremely superfine and easily enters into deep part of urethane form pores of an application body, and thus the application to skin, etc. becomes difficult and application unevenness is easily generated, and an application body

loses elasticity and becomes unsuitable for use in case that a cosmetic left in pores is oxidized and solidified, and the like (the conventional technology and its problem), as the solution of this problem, an application tool for make-up pertaining to the Device 1, comprising a core material whose application body has elasticity and an urethane form skin with ultrafine-pores that covers its surface (the constitution of the device) , by above way, superfine powder solidified cosmetic is attached and easily and evenly applied to skin, etc. without entering deepest part of pores, and generates the effect that cosmetic is hardly left in pores and does not lose elasticity and can be used in a good condition for a long term (the effect of the device), concerning the skin of an application body of an application tool for make-up pertaining to the Device 1, the embodiment states that 'the polyurethane form available at the commodity name of "RUBYCELL" produced by Toyopolymer Co., Ltd. that has water and oil absorption is preferable.' (6th to 8th row of 9th sheet) (Exhibit A3)." (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] A make-up tip, comprising: an edge part of application tip made in a linear or planar shape; a porosity base material other than fiber bundle, formed in one edge of supporting tool by adhesive or outsert molding.

(4) Procedural History

January 18, 2010	:	Filing of Patent Application
October 26, 2011	:	Decision of Refusal
January 31, 2012	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2012-1824) Amendment of Proceeding (See above "The Claims")
October 16, 2012	:	Above amendment of proceeding is rejected, Appeal Decision that "the request for appeal is dismissed." (Original Appeal Decision)
August 9, 2013	:	Court Decision that the original appeal decision is cancelled
April 4, 2014	:	Appeal Decision that "the request for appeal is dismissed."

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

<table>
<tr><td colspan="2">Appeal Decision</td></tr>
<tr><td colspan="2">The invention as stated in Cited Publication 1 that the appeal decision has found (Cited Invention)
"An application tool for make-up, comprising: a tip part of an application body being in a round shape; an application body made of open-cell polyurethane form being equipped with one edge part of shaft." (cited from the Court Decision)</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
Cited Publication 1 states, as the conventional technology, an application tool for make-up only made of open-cell urethane form. However, a person skilled in the art who understood whole of the</td><td>Allegations by Defendant
When certifying the cited invention, it is necessary that the technical ideas are certified in just proportion. Thus, it is apparent that the cited invention certified by the appeal decision can be understood as a</td></tr>
</table>

document does not only understand the conventional technology but also understands that there is a problem for using it in use of solidified cosmetic and that an application tool for make-up same as the conventional technology should not be adopted, and that as a result, an application tool for make-up in use of solidified cosmetic as stated in Claims of Utility Model Registration of the document should be used. In addition, the person skilled in the art can understand that an application tool for make-up as stated in Claims of Utility Model Registration of Publication 1 is to solve the problem in use of solidified cosmetic and other than above problem is not taken into account. Accordingly, if the conventional technology is only certified as the cited invention, it also should be certified that the application tool for make-up is in use of solidified cosmetic. However, the appeal decision overlooks above point and is erroneous.	unit of technical ideas from the statement concerning above conventional technology of Cited Publication 1.

Judgment by the Court

(2) The point ([2]) that an application tool for make-up is in use of solidified cosmetic

When certifying the cited invention, it is sufficient that the items corresponding to the matter specifying the invention in the claimed invention are just adequately certified, and it can be said that the cited invention does not need to be certified with unnecessarily limitation apart from the correspondence with the matter specifying the invention in the claimed invention, unless there are special circumstances.

Accordingly, since a make-up tip of the claimed invention does not limit any type of applied cosmetic as the matter specifying the invention, there is no error in the appeal decision which does not certify that an application tool for cosmetic of the cited invention is in use of solidified cosmetic when certifying the cited invention.

When deliberating on easily conceiving of the constitution of the claimed invention, it should be considered in some cases that an application tool for make-up of the cited invention is in use of the application of solidified cosmetic with regard to the presence of the motivation to combine the cited invention with other well-known technology, nevertheless, it cannot be said that there is error in certification of the cited invention.

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 3
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	

1. Bibliographic Items

Case	"Polyalkylsilsesquioxane particulates"(Opposition to the grant of a patent) Intellectual Property High Court Decision, December 21, 2017 (2017 (Gyo KE) No.10072)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.2013-208478 (JP 2013-256676A)
Classification	C08G 77/04
Conclusion	Acceptance
Related Provision	Article 29(1)(iii)
Judges	IP High Court Second Division, Presiding Judge: Yoshiyuki MORI, Judge: Sanae NAGATA, Judge: Ken FURUSHO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to polyalkylsilsesquioxane particulates whose hygroscopic property in storage is decreased, and to polyalkylsilsesquioxane particulates that can be used as a diffusing agent or various additives because of their low moisture content and low content of surface silanol groups.

(2) Cited Invention (Document of Exhibit A1): JP H1-185367 A (Finding of Decision)

“In a four-necked flask equipped with a thermometer, a reflux condenser and a stirrer, 1,000 parts of hexamethyldisilazane and 1,000 parts of polymethylsilsesquioxane powder having an average particle diameter of 5 μm and obtained by hydrolyzing and condensing a methyltrialkoxysilane and/or a partial hydrolysate thereof and ammonia or an aqueous solution of an amine were charged, stirred and retained at 25° C for 15 hours. The treated mixture was then vacuum filtered through filter paper and dried in a drier of 200℃ to obtain the surface treated completely spherical polymethylsilsesquioxane powder whose sediment weight percentage in methanol water containing 60 wt% of methanol is 3%”. (Cited from the Court Decision)

(3) The Claims (only Claim 1) (Present Invention)

[Claim 1] Polyalkylsilsesquioxane particulates which are spherical particles containing silanol groups in an

amount of 1.3% or less, and have such water repellency that the particulates are not dispersed in water and a 10% (v/v) methanol solution after stirring the water and solution mixed with the particulates for one minute at 300 rpm respectively.

(4) Procedural History

May 1, 2015	:	Registration of establishment of the patent
December 17, 2015	:	Opposition to the granted patent (Igi No. 2015-700324)
November 16, 2016	:	Ruling to revoke the patent

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

<table>
<tr><td colspan="2">Ruling (Cited from the Court Decision)</td></tr>
<tr><td colspan="2">B Present Invention 1
(A) Comparison of Present Invention 1 and Cited Invention
(Identical feature)
“Polymethylsilsesquioxane particulates which are spherical particles and have water repellency.”
(Difference 1)
While particulates “contain silanol groups in an amount of 1.3% or less” in the Present Invention 1, the amount of silanol groups contained in particulates is not known in the Cited Invention.
(Difference 2)
Concerning water repellency of particulates, while “particulates are not dispersed in water and a 10% (v/v) methanol solution after stirring the water and solution mixed with the particulates for one minute at 300 rpm respectively” in the Present Invention 1, “sediment weight percentage in methanol water containing 60 wt% of methanol is 3%” in the Cited Invention.
(B) Judgment
The certificate of experimental results (Exhibit A4 and hereinafter referred to as the “Certificate of Exhibit A4”, and experiments indicated in the certificate of Exhibit A4 are hereinafter referred to as the “Experiments of Exhibit A4”) shows that the re-experiments of embodiment 1 described in the document of Exhibit A1 reveal “polymethylsilsesquioxane particulates in the Cited Invention contain silanol groups in an amount of 0.08%”. Thus, the difference 1 is not a substantial difference.
The certificate of Exhibit A4 shows that the re-experiments of embodiment 1 described in the document of Exhibit A1 reveal the polyalkylsilsesquioxane particulates of the Cited Invention have such water repellency that “the particulates are not dispersed in water and a 10% (v/v) methanol solution after stirring the water and solution mixed with the particulates for one minute at 300 rpm respectively”. Thus, the difference 2 is not a substantial difference.
From the above, the Present Invention 1 is considered identical to the Cited Invention.</td></tr>
<tr><td colspan="2">Court Decision</td></tr>
<tr><td>Allegations by Plaintiff</td><td>Allegations by Defendant</td></tr>
</table>

(1) Regarding the method for preparing pre-surface -treated polymethylsilsesquioxane among the constitutions of the Cited Invention found by the Ruling, Embodiment 1 of the document of Exhibit A1 only discloses that "it was obtained from JP S60-13813A (Note of the Court Decision: Exhibit A5, hereinafter referred to as the "Document of Exhibit A5)." … (2) The experiments of Exhibit A4 are not the re-experiments as accurate reproduction of the Cited Invention, as clarified below. … C The experimental methods of the experiments of Exhibit A4 differ from those described in the document of Exhibit A1 in a number of aspects, and thus the experiments of Exhibit A4 are not the reproduction of embodiment 1 of the document of Exhibit A1. Particularly, the following seven aspects can affect the properties of particulates deemed as the matters specifying the Present Invention such as "particle shape, water repellency, amount of silanol groups, and weight change rate relative to heat amount": 1.Difference in methyltrichlorosilane content of methyltrimethoxysilane; 2.Difference in chlorine content of polymethylsilsesquioxane particulates; 3.Difference in average particle size of pre-surface-treated polymethylsilsesquioxane; 4.Difference in mobility and shape of pre-surface-treated polymethylsilsesquioxane; 5.Presence or absence of a crushing step (In the experiments of Exhibit A4, "a crushing step using a jet mill," which is not described in embodiment 1 of Exhibit A1, is added because pre-surface-treated polymethylsilsesquioxane was in massive form; 6.Setting of stirring rate, titration rate, titration method (titration amount per drop and titration rate) for preparing pre-surface-treated polymethylsilsesquioxane; 7.Drying temperature, drying time, and washing treated mixture or not.	(2) The experiments of Exhibit A4 can be recognized as a reproduction of embodiment 1 of the document of Exhibit A1. … C … (B)… It is justified to consider as reproduction experiments conducted according to an embodiment published in the patent gazette under the conditions which are presumed from omitted or simplified conditions of the embodiment based on common technical knowledge. In addition, since such omitted or simplified conditions are regarded as matters not directly or closely related to the implementation of the invention of the application concerned, they do not lessen the credibility of the experiments. The description of the experiments of Exhibit A4 follows the descriptions of embodiment 1 of the document of Exhibit A1 and of embodiment 1 of the document of Exhibit A5, and there is no difference between the two in many aspects including amount ratio of compounds added to the reaction system and reaction temperature. Furthermore, according to the description of the document of Exhibit A5, it is not necessary to identify the manufacturer and article No. of "a 28% ammonia solution" and "methyltrimethoxysilane" used in embodiment 1 of Exhibit A1, and matters such as "stirring rate", "titration method", "temperature after cooling and cooling rate", and "collection method", "number of times of washing", "drying temperature", and "drying time" of the product, are regarded as not directly or closely related to the implementation of the invention disclosed in the document of Exhibit A5. Thus, it is reasonable to implement embodiment 1 of the document of Exhibit A1 based on common technical knowledge. Therefore, it is groundless not to consider the experiments of Exhibit A4 as accurate reproduction of embodiment 1 of Exhibit A1 when various conditions

	unknown in embodiment 1 of Exhibit A1 (including embodiment 1 of Exhibit A5) are presumed based on common technical knowledge and such conditions are not indicated in the certificate of Exhibit A4. (C) … Accordingly, it cannot be said that the experiments of Exhibit A4 are not a reproduction of embodiment 1 of Exhibit A1 even if there are a difference in methyltrichlorosilane content of methyltrimethoxysilane and a difference in chlorine content of polymethylsilsesquioxane particulates. (D) … It is reasonable to suppose that the average particle size of pre-surface-treated polymethylsilsesquioxane is about 5 μ m. Thus, it cannot be said that the experiments of Exhibit A4 are not a reproduction of embodiment 1 of Exhibit A1 even if the average particle size of pre-surface-treated polymethylsilsesquioxane was not measured. …

Judgment by the Court

3 Reason for Cancellation 1 (Error in Finding of Cited Invention)

… (2) Finding of silanol groups amount and water repellency of the powder of the Cited Invention

A Polymethylsilsesquioxane particulates used in embodiment 1 of the document of Exhibit A1 are those with "an average particle size of 5 μ m obtained by the method disclosed in the document of Exhibit A5". The Decision found the silanol groups amount and water repellency of polymethylsilsesquioxane particulates of the Cited Invention based on the finding that the experiments of Exhibit A4 are the re-experiments of embodiment 1 of the document of Exhibit A1 and the experiments of Exhibit A4 show that polymethylsilsesquioxane particulates contain silanol groups in an amount of 0.08% and have such water repellency that "the particulates are not dispersed in water and a 10% (v/v) methanol solution after stirring the water and solution mixed with the particulates for one minute at 300 rpm respectively".

However, … the experiments of Exhibit A4 cannot be recognized as a reproduction of embodiment 1 of Exhibit A1 as follows:

B The experiments of Exhibit A4 cannot be recognized as a reproduction of embodiment 1 of Exhibit A1 in at least 1) Stirring condition and 2) Chlorine content of a raw material – methyltrimethoxysilane according to a comparison of the method of embodiment 1 of the document 1 of Exhibit A1 including embodiment 1 of Exhibit A5 and the experiments of Exhibit A4.

(A) Stirring Condition

It is known that the particle size of polymethylsilsesquioxane particulates depends on stirring condition during manufacture.

Embodiment 1 of the document of Exhibit A5 does not mention stirring rate and the experiments of Exhibit A4 do not specify stirring rate, too. Thus, the particle size of polymethylsilsesquioxane particulates obtained in the experiments of Exhibit A4 cannot be presumed from experiment conditions. In addition, in the experiments of Exhibit A4, the particle size of polymethylsilsesquioxane particulates deemed as obtained from the re-experiments of embodiment 1 of Exhibit A5 was not measured. Therefore, it cannot be found that the particle size of polymethylsilsesquioxane particulates deemed as obtained from the re-experiments of embodiment 1 of Exhibit A5 in the experiments of Exhibit A4 is 5 μm which is the particle size of polymethylsilsesquioxane powder used in embodiment 1 of Exhibit A1.

(B) Chlorine content of a raw material – methyltrimethoxysilane

From the above, it is understood that methyltrimethoxysilane (of embodiment 1 of Exhibit A5) has a chlorine content of 5ppm.

However, in the experiments of Exhibit A4, the chlorine content of methyltrimethoxysilane used as a raw material for the re-experiments of embodiment 1 of Exhibit A5 was not measured. Thus, it cannot be found that the chlorine content of methyltrimethoxysilane used in experiments of Exhibit A4 and the chlorine content of methyltrimethoxysilane used in embodiment 1 of Exhibit A5 are the same. Therefore, it cannot be found that alkoxysilanes were hydrolyzed and condensed in the experiments of Exhibit A4 in the same way as in embodiment 1 of Exhibit A5, and consequently, it cannot be found that the obtained polymethylsilsesquioxane particulates are the same as those obtained in embodiment 1 of Exhibit A5.

C From the above, polymethylsilsesquioxane particulates used in the experiments of Exhibit A4 cannot be considered identical to those used in embodiment 1 of Exhibit A1. In consequence, it cannot be found that the silanol groups amount and water repellency of polymethylsilsesquioxane particulates obtained in the experiments of Exhibit A4 are the same as those of embodiment 1 of Exhibit A1 and the Present Invention 1 is identical to the Cited Invention for this reason.

(52)-7

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 3
Classification of the Case	52: Concerning finding of the cited invention (including well-known art, etc.) (including overlooking of related differences)
Keyword	

1. Bibliographic Items

Case	"Pyrimidine derivative" (Trial for Invalidation) Intellectual Property High Court Decision, April 13, 2018 (2016 (Gyo-KE) Nos. 10182 and 10184)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H04-164009 (JP H05-178841 A)
Classification	C07D 239/42
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Special Division, Chief judge: Misao SHIMIZU, Judge: Makiko TAKABE, Judge: Yoshiyuki MORI, Judge: Toshihiko TSURUOKA, Judge: Reiko MORIOKA

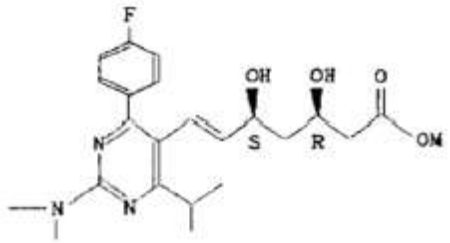
2. Overview of the Case

(1) Summary of the Claimed Invention

The present invention relates to a compound inhibiting HMG-CoA reductase activity represented by a predetermined general formula.

(2) State of the Art

(i) Cited Invention 1 (Invention of Exhibit A1): JP H03-501613 A (Finding of Decision)



a compound (M=Na) (Quotation from the text of decision)

(ii) Exhibit Ko 2 (JP 1989-261377 A)

"... Exhibit Ko 2 describes a compound represented by general formula (I). The compound has a pyrimidine

ring, and substituent groups at the 2-, 4-, and 6-positions of the pyrimidine ring, and shows good inhibiting effects in HMG-CoA reductase (3-hydroxy-3-methyl-glutaryl coenzyme A reductase).” (Quotation from the text of decision)

※ General formula (I):

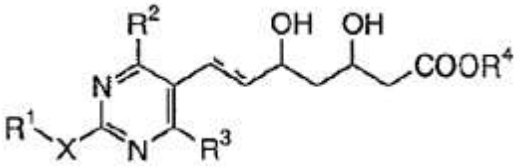
(I)

(3) The Claims (After Amendment) (Present Invention)

[Claim 1]

A compound represented by the following formula (I):

[Formula 1]



(where

R^1 is a lower alkyl;

R^2 is a phenyl substituted with halogen;

R^3 is a lower alkyl;

R^4 is hydrogen or a calcium ion forming a hemicalcium salt;

X is an imino group substituted with an alkylsulfonyl group;

the dashed line represents the presence or absence of a double bond.)

or a ring-closed lactone body thereof.

(4) Procedural History

May 16, 1997	:	Registration of establishment of the patent
June 30, 2014	:	Demand for correction trial by the defendant (patent right holder) (See the “Claims” above)
March 31, 2015	:	Demand for trial to invalidate a patent by a plaintiff (Invalidation Trial No. 2015-800095)
July 5, 2016	:	Trial decision to the effect that "the demand for the trial was groundless"

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

Trial decision (quotation from the text of decision)

… (B) Common features and differences between Invention 1 and Exhibit Ko 1 Invention

[Difference]

(1-i)

In Invention 1, X is an imino group substituted with an alkylsulfonyl group, whereas in the Exhibit Ko 1 Invention it is an imino group substituted with a methyl group …

(C) Determination whether or not the difference from the cited invention can be easily conceived

a Difference (1-i)

(b) Motivation from Exhibit Ko 2 Invention

The compound of general formula I of Exhibit Ko 2 also provides an HMGCoA reductase inhibitor with a pyrimidine ring as a basic skeleton and substituents at the 2-, 4-, and 6- positions, which is in common with the Invention, like the compound of formula I of Exhibit Ko 1. The compounds included in both might partially overlap depending on a selected substituent group, but the compound of general formula (I) of Exhibit Ko 2 does not have exactly the same selectable range of substituent groups of the pyrimidine ring as the compound of the formula I of Exhibit Ko 1, but is respectively specified as a compound having a separate chemical structural formula. Given the chemical structural formula of the compound, it may become a candidate for HMG-CoA reductase inhibitor. Further, it cannot be said that compounds with different structures may have the same HMG-CoA reductase inhibiting activity. Therefore, …, there is no motivation in the first place to substitute the dimethylamino group of the Exhibit Ko 1 Invention with the substituent group not disclosed in Exhibit Ko 1 on the basis of the description of Exhibit Ko 2.

Further, each of "R^1," "R^2," and "R^3" of the compound of general formula (I) of Exhibit Ko 2 has numerous alternatives. In contrast, what is described as a specific working example where at least "X" and "A" have the same structure as in the Exhibit Ko 1 Invention is only … Working Example 8 … . Exhibit Ko 2 fails to describe one that selects "-NR^4R^5" for "R^3". Further, regarding the compounds in which "-NR^4R^5" is substituted, Exhibit Ko 2 not does describe a production method thereof, nor pharmacological tests of HMG-CoA reductase inhibiting activity, … ."

Consequently, it cannot be said first of all that the specification technically supports the compound in which "methyl" and "methylsulfonyl (SO_2CH_3)" are selected for "R^4" and "R^5" just in a possible substituent group of "-NR^4R^5" that could be selected from numerous alternatives for "R^3" of the general formula (I) described in Exhibit Ko 2. It cannot be deduced from this description that there is a motivation to replace "dimethylamino group" of the Exhibit Ko 1 Invention with "-$N(CH_3)(SO_2CH_3)$."

Court Decision

Allegations by Plaintiff	Allegations by Defendant
No. 51 (1) B Exhibit Ko 2 describes a method for the synthesis of the compound of general formula (I) ... . Thus a person ordinarily skilled in the art could understand the	The above argument of No. 5, 1(1) B is intended to negate the inventive step of the Invention by combining Exhibit Ko 1 with Exhibit Ko 2 and Ko 16, which corresponds to the change of the gist of the

method for the synthesis of compound where "NR^4R^5" was selected for "R^3."

Exhibit Ko 2 discloses that the compound of general formula (I) has an activity to the extent that it may be a pharmaceutical product capable of suppressing the biosynthesis of cholesterols (page 19, right bottom column, lines 2 to 11). Thus, a person ordinarily skilled in the art could understand that the compound where "NR^4R^5" was selected for "R^3" might have an activity to the extent that it might be a pharmaceutical product capable of suppressing the biosynthesis of cholesterols.

… Exhibit Ko 16, which was publicly known before the priority date, discloses Compounds 2r to 2w as compounds within a scope of general formula (I) of Exhibit Ko 2 having a pharmacophore of an HMG-CoA reductase inhibitor of dihydroxyheptenoic acid structure, and having the same structures in "X" and "A" as the Exhibit Ko 1 Invention. All of these compounds have an HMG-CoA reductase inhibiting activity, which is shown as data (Table I).

Further, the production method is also described… .

Regarding the compounds of Working Examples 8 and 23 in the working examples of Exhibit Ko 2 with the same structure in "X" and "A" as the Exhibit Ko 1 Invention, Exhibit Ko 16 and Ko 73 to Ko 75, which were publicly known before the priority date, respectively describe compounds with very similar structures … .

In view of this publicly known information, it can be recognized that there is all the more technical support of the compound of general formula (I) of Exhibit Ko 2 having an HMG-CoA reductase inhibiting activity.

Therefore, it can be seen from the publicly known documents before the priority date that a plurality of

statement of the demand. Therefore, it is not permitted.

Even if the aforesaid argument of No. 5, 1(1)B should be approved, the argument by Plaintiffs is not reasonable as in the following items a and b.

(a) Exhibit Ko 2 lists a great number of alternatives for R^1, R^2, and R^3 in the compounds of general formula (I). There are at least 21.2 million species for a substituent group listed for R^3 of "particularly preferable compound" (Exhibit Ko 80).

… Exhibit Ko 2 lacks any specific description of even a compound having $-NR^4R^5$, … at the 2-position of the pyrimidine ring. Therefore, there is no motivation to focus on $-NR^4R^5$, which is not included in "particularly extremely preferable compound" of R^3, and further intentionally select a methyl group and a methylsulfonyl group for R^4 or R^5 of $-NR^4R^5$ from numerous substituent groups.

(b) Plaintiffs argue that "one can find technical support of HMG-CoA reductase inhibiting activity for the compounds of general formula (I) of Exhibit Ko 2," since Exhibit Ko 16, and Ko 73 to Ko 75 disclosed before the priority date that "a compound with a very similar structure" to the compounds of Working Examples 8 and 23 of Exhibit Ko 2 had a HMG-CoA reductase inhibiting activity. However, it is not permissible to argue as if the inhibiting activity of a compound with a different structure might apply to the compound of Working Examples of Exhibit Ko 2 by use of ambiguous language such as "a compound with a very similar structure."

… if a person ordinarily skilled in the art who reads Exhibit Ko 1 should modify the Exhibit Ko 1 Invention, the candidate would fall within the scope of formula I. Similarly, if one selects a substituent group at the 2-position of the pyrimidine ring from Exhibit Ko 2, the candidate falls within the range of R^3. However, R^3 extends to a large number of substituent groups. In

compounds in the scope of general formula (I) of Exhibit Ko 2 have data showing an activity. Thus it should be found that every compound represented by general formula (I) of Exhibit Ko 2 is a compound in which HMG-CoA reductase inhibiting activity is prima facie expected in the whole scope, similarly to Exhibit Ko 1. Accordingly, there is a motivation to substitute "dimethylamino group" of Exhibit Ko 1 Invention with "-N(CH_3)(SO_2CH_3)" on the basis of the description of Exhibit Ko 2 to obtain a compound of the Invention.	order to overcome the difference (1-i), -NR^4R^5 (R^4: methyl, R^5: methylsulfonyl) should be selected from them. Exhibit Ko 2 lists a large number of functional groups for R^3. To select the functional group making a difference (-NR^4R^5, R^4: lower alkyl, R^5: alkylsulfonyl) from these functional groups and combine with the Exhibit Ko 1 Invention, some suggestion or motivation of the combination is necessary. There is no suggestion or motivation in Exhibit Ko 2 for a person ordinarily skilled in the art to select particularly -NR^4R^5 from R^3, and a functional group making the above difference therefrom, and combine with Exhibit Ko 1 Invention.

Judgment by the Court

(5) Determination of differences between Invention 1 and the Exhibit Ko 1 Invention

A Determination whether or not the Difference (1-i) from the cited invention can be easily conceived

(B) b. According to the aforesaid a, Exhibit Ko 2 describes a compound represented by general formula (I). The compound has a pyrimidine ring, and substituent groups at the 2-, 4-, and 6-positions of the pyrimidine ring, and shows good inhibiting effects in HMG-CoA reductase (3-hydroxy-3-methyl-glutaryl coenzyme A reductase).

(C) a. As in the aforesaid item (B), the compound of general formula (I) of Exhibit Ko 2 is intended to provide an HMG-CoA reductase inhibitor, like the compound of general formula I of Exhibit Ko 1. They are common in that they have a pyrimidine ring and substituent groups at the 2-, 4-, and 6-positions of the pyrimidine ring. The compound of the Exhibit Ko 1 Invention is encompassed into the compound represented by general formula (I) of Exhibit Ko 2.

Exhibit Ko 2 describes "-NR^4R^5" as an alternative of substituent group R^3 at the 2-position of the pyrimidine ring of a "particularly preferable compound" among the compounds represented by general formula (I) of Exhibit Ko 2, and also describes "methyl group" and "alkylsulfonyl group" as an alternative for R^4 and R^5.

Plaintiffs did not particularly argue, however, that there are numerous alternatives of R^3 in "particularly preferable compound" of Exhibit Ko 2, and the number is at least 20 million. The compound where R^3 is "-NR^4R^5, and R^4 and R^5 are "methyl" and "alkylsulfonyl" is one alternative among 20 million or more.

Further, Exhibit Ko 2 not only describes "particularly preferable compound" but also "particularly extremely preferable compound," which fails to describe "-NR^4R^5" as an alternative of R^3.

Furthermore, Exhibit Ko 2 describes … working examples of the compound having the same structure as the Exhibit Ko 1 Invention in X and A of the general formula (I) of Exhibit Ko 2. It fails to describe "- NR^4R^5" for R^3.

Consequently, although Exhibit Ko 2 describes an alkylsulfonyl group, it is impossible for a person ordinarily skilled in the art to find from the description of Exhibit Ko 2 any circumstances where "-NR^4R^5" is positively or preferentially selected as R^3 of the general formula (I) of Exhibit Ko 2. It is difficult to find any circumstances to select "-NR^4R^5, and further select "methyl" and "alkylsulfonyl" for R^4 and R^5.

Therefore, it cannot be seen that the technical idea of changing the group at the 2-position of the pyrimidine ring into "-$N(CH_3)(SO_2R')$" may be extracted from Exhibit Ko 2. It cannot be said that Exhibit Ko 2 describes the structure according to the above difference (1-i). The combination of the Exhibit Ko 1 Invention with the Exhibit Ko 2 Invention may not result in the structure according to the difference (1-i) of the Invention.

Consequently, … , it cannot be recognized that Invention 1 was easily conceivable by a person ordinarily skilled in the art by combining the Exhibit Ko 1 Invention and the Exhibit Ko 2 Invention.

(52-1)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 3.2(2)
Classification of the Case	52-1: Concerning finding of the cited invention as the generic concept
Keyword	

1. Bibliographic Items

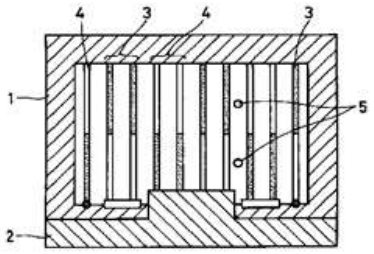
Case	"A heat treating furnace equipped with furnace heater" (Trial for Invalidation) Intellectual Property High Court Decision, September 27, 2012 (2011 (Gyo KE) No.10385)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H3-304688 (JP H5-141875A)
Classification	F27D 11/02
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Toshifumi SHIBATA, Judge: Gaku OKAMOTO, Judge: Hideko TAKEMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is furnace heater: capable of making even, a temperature distribution state along the direction of height of furnace; comprising furnace heater 3, 4 set vertically to furnace bottom and set in parallel along the direction of side of furnace, heating part 3a, 4a of each heater respectively equipped with different part along the direction of length.

[FIG. 1]



(2) The Matter as Stated in JP H3-156284A (Exhibit A1)

"(Industrial field of application)

The invention relates to a batch baking furnace that constantly provides even and fresh atmospheric gas with baking objects by stirring protective atmospheric gas and obtains even temperature distribution in a furnace."(10-14th row of lower right field of Page 1)

"(Conventional technology)

Generally, for baking of ceramic electronic part material such as ceramic dielectric of ceramic capacitor and

ceramic piezoelectric substrate of piezoelectric resonator, tunnel furnace or batch baking furnace is used as those cross-section and vertical-section are respectively indicated in, for example, FIG. 3 and FIG. 4 (Note added by the court decision: See drawings of attached sheet).

.....above baking objects accommodated in each case at the inner space of a furnace body 3 are baked by the heat of heaters 8 in U shape made of silicon carbide suspended from a ceiling part 1c of said furnace body 3 to a furnace floor 1b. Furthermore, from an atmospheric gas charging port 9 set through a furnace wall 1d next to a furnace wall 1a equipped with above opening port 4, as indicated by Arrow A1, atmospheric gas is charged in a furnace body 3, and in the atmospheric gas, above baking objects are baked. From an exhaust gas discharging port 11 set through one furnace side wall 1e facing with a furnace side wall 1 d equipped with an atmospheric gas charging port 9, exhaust gas generated in said furnace body 3 is, as indicated by Arrow A2, discharged outside of said furnace body 3.

.....the dirty gas including binder and tar generated in the course of baking is discharged from an exhaust gas discharging port 11." (15th row of lower right field of Page 1 ~ 11th row of upper right field of Page 2)

"(The problem to be solved by the invention)

By the way, in above conventional baking furnace, there are problems that a majority of atmospheric gas charged into furnace body 3 retains near furnace floor 1b after contacting a sagger 2 and surrounding around a sagger 2, as a result, stagnation of atmospheric gas is not only generated but temperature difference is generated between the charge side and the discharge side of atmospheric gas across a sagger 2, and depending on the position of case or the position inside case in a sagger 2, quality of baking goods is different.

The objective of the invention is to provide a baking furnace where good quality products are obtained, by the contact of constantly fresh and even temperature atmospheric gas with all baking objects." (12th row of upper right field of Page 2 ~ 5th row of lower left field of Page 2)

"(Means for solving the problem)

For above objective, the invention relates to a baking furnace for baking the baking objects arranged in a furnace body, charging atmospheric gas in a furnace body having closed space accommodating baking objects at the inside, comprising: two furnace wall, two furnace side wall, a ceiling part and a furnace floor;

a base plate where cases accommodating baking objects are placed, having space between furnace side wall of above furnace body and one furnace side wall opposed thereto, and constituting a sagger by being supported by column arranged on a furnace floor of above furnace body with a space from above furnace body and being stacked in multiple stages; a fan made of heat resistant material rotating in a furnace body by being driven by a driving motor arranged outside a furnace body and by being supported by above one furnace wall; an atmospheric gas charging port being opened at upstream side of air flow of a furnace body by the fan; an exhaust gas discharging port discharging exhaust gas generated in a furnace body, being opened at downstream of air flow of a furnace body by the fan." (6th row of lower left field of Page 2 ~ 4th row of lower right field of Page 2)

"(Action)

Atmospheric gas charged from above atmospheric gas charging port flows from upstream to downstream of air flow by the action of a fan. In that course, almost all atmospheric gas charged into a furnace body invades into cases and contact baking objects. Exhaust gas generated from a baking part by baking is forcibly discharged from

exhaust gas discharging port of a furnace body outside of a furnace body by the action of above fan, a part of discharged exhaust gas returns again to atmospheric gas charging port and flows again toward cases after going through the space between a base plate and a furnace floor of a furnace body, and circulation of hot wind is generated." (11th row of lower right field of Page 2 ~ 2nd row of upper left field of Page 3)

"(Effect of invention)

According to the invention, since high-temperature atmospheric gas in a furnace body is forcibly stirred by the action of a fan equipped with a furnace body, atmospheric gas and temperature distribution are even in a furnace body and also baking objects constantly contact flesh atmospheric gas, and thus good quality products can be made." (9th row of upper left field of Page 3 ~ 15th row of the same)

"A cross section and a vertical section of one embodiment of a baking furnace pertaining to the invention are respectively indicated in FIG. 1 and FIG. 2 (Note added by the court decision: See drawings of attached sheet).

Above baking furnace 21 is, similarly as the baking furnace as explained in FIG. 3 and FIG. 4, a door opening and closing type batch furnace where a door 25 connected by hinge in a freely opening and closing state with one furnace wall 21a against a port 24 equipped with one furnace wall 21a constitutes a part of said furnace wall 21a of a furnace body, in order to put and bring baking objects accommodated in cases constituting a sagger 22 by being stacked in multiple stages.

.....

Between above fan 28 and sagger 22 in a furnace body 23, heaters 33 in U shape that are, for example, made of silicon carbide are suspended from a ceiling part 21c of a furnace body 23 to the vicinity of above base plate 27. In addition, between above sagger 22 and another furnace side wall 21e of a furnace body 23, similarly as above, heaters 33 in U shape made of silicon carbide are also suspended from a ceiling part 21c of a furnace body 23 to the vicinity of a furnace floor 21b." (4th row of upper right field of Page 3 ~ 5th row of lower right field of the same) (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] A heat treatment furnace, characterized by: heat treatment space formed by a main body of a furnace including a furnace side wall and a furnace floor closing a bottom part of a main body of a furnace; said heat treatment space comprising multiple furnace heaters, inserted (abbreviated) in the substantially vertical direction, and mutually arranged in parallel along said furnace side wall, set different multiple parts along the vertical direction, using any of said different multiple parts as heating parts; said heating parts of said multiple furnace heaters respectively set at different position along vertical direction.

(4) Procedural History

June 8, 2001	:	Registration of Patent Right
March 9, 2009	:	Request for Amendment by Defendant (Patentee) (See above "The Claims")
April 21, 2009	:	Trial Decision that above amendment is approved
March 15, 2011	:	Request for trial for invalidation of patent by plaintiff (Muko No.2011-800041)
October 12, 2011	:	Trial Decision that "the request for trial is dismissed."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">Cited invention certified by the trial decision (the invention as stated in Exhibit A1)
"A baking furnace for baking baking objects, arranged in a furnace body, having a closed space comprising two furnace wall, two furnace side wall, a ceiling part and a furnace floor, comprising:
a door connected by hinge in a freely opening and closing state with a furnace wall, constituting a part of one furnace wall;
a base plate where cases for accommodating baking objects are placed, having space between furnace side wall and one furnace side wall opposed thereto, and constituting a sagger by being supported by column arranged on a furnace floor; a fan rotating in a furnace body by being supported by one furnace wall; between a fan and a sagger, two heaters in U shape made of silicon carbide being, in parallel, suspended from a ceiling part to the vicinity of a base plate, further, between above sagger and another furnace side wall, heaters in U shape made of silicon carbide being also, in parallel, suspended from a ceiling part to the vicinity of a furnace floor." (cited from the Court Decision)</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The cited invention is to improve the conventional technology as stated in FIG. 3 and FIG. 4 by making a fan 28 supported by one furnace side wall (left part of a furnace side wall in FIG. 1/FIG. 2) 21d. Accordingly, in the cited invention, it should be considered that a heater became far from the left part of a furnace side wall 21d by sliding to the area between a fan 28 and a sagger 22 due to the equipment of a fan 28 in a furnace, and considering FIG. 3 and FIG. 4 that two heaters are arranged in parallel along a furnace side wall, the cited invention should be certified as follows.
"A baking furnace for baking baking objects, arranged in a furnace body, having a closed space comprising two furnace wall, two furnace side wall, a ceiling part and a furnace floor, comprising:
a door connected by hinge in a freely opening and closing state with a furnace wall, constituting a part of one furnace wall;
a base plate where cases for accommodating</td><td>Allegations by Defendant
It can be understood that plaintiff asserts that the structure of the cited invention should be determined to be same as that of the conventional technology lacking a fan 28, in consideration of FIG. 3 and FIG. 4 as the conventional technology. However, compared with the conventional technology, the cited invention features the equipment of a fan 28 in a furnace, and it is not reasonable that the cited invention is certified on the assumption that the feature does not exist. The cited invention asserted by plaintiff is the novel constitution that combines the constitution of the conventional technology of Exhibit A1 (FIG. 3, FIG. 4) with that of the cited invention (FIG. 1, FIG. 2), and there is difficulty in certifying such novel constitution based on the statement of Exhibit A1. In addition, in Exhibit A1, the cited invention requires a fan 28. In this regard, the constitution that a fan 28 of the conventional technology (FIG. 3, FIG. 4) does not exist, and heaters 8 are arranged in parallel along a furnace side wall 1d is modified and excluded. Accordingly, the constitution</td></tr>
</table>

baking objects are placed, having space between furnace side wall and one furnace side wall opposed thereto and constituting a sagger by being supported by column arranged on a furnace floor; a fan rotating in a furnace body by being supported by one furnace wall; between a fan and a sagger, two heaters in U shape made of silicon carbide being, in parallel, suspended along a furnace side wall from a ceiling part to the vicinity of a base plate, further, two heaters in U shape made of silicon carbide being also, in parallel, suspended along a furnace side wall from a ceiling part to the vicinity of a furnace floor."	of Exhibit A1 that a fan 28 of the conventional technology (FIG. 3, FIG. 4) does not exist, and heaters 8 are arranged in parallel along a furnace side wall 1d does not constitute "the matter stated commonly in the inventions pertaining to patent application." Therefore, Plaintiff's assertion concerning the certification of the cited invention is erroneous, and the determination of the trial decision is reasonable.

Judgment by the Court

Plaintiff's assertion cannot be adopted. ...The cited invention features the constitution that a fan 28 is equipped in a furnace in order to solve the problem of a baking furnace as described in FIG. 3 and FIG. 4 as the conventional technology. Thus, it is not admitted that the cited invention is certified on the assumption that the feature does not exist, for it means that the invention is certified, ignoring the most important matter among the elements that constitute a unit of technical ideas as stated in citation. In the cited invention, the temperature in a furnace is kept even, in a way that high-temperature atmospheric gas caused by the heat of heaters is forcibly stirred by a fan 28 driven by a driving motor arranged outside of a furnace and supported by one furnace wall. Accordingly, it is reasonable that heaters 33 are arranged in the area between a fan 28 and a sagger 22 accommodating baking objects, and the constitution that heating bodies are arranged in parallel along a furnace side wall cannot be assumed.

(52-1)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3. 2(2)
Classification of the Case	52-1: Concerning finding of the cited invention as the generic concept
Keyword	

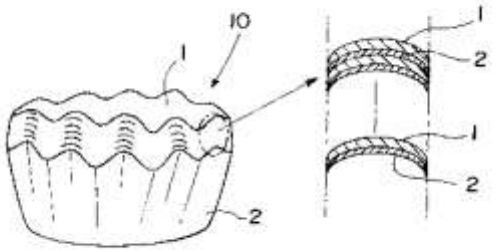
1. Bibliographic Items

Case	"Mmanufacturing method of an edible container set" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, Dec. 19, 2012 (2012 (Gyo KE) No. 10099)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2005-113382 (JP 2006-288276A)
Classification	A23L 1/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division: presiding judge Shodai DOI, judge Yasuhito INOUE, judge Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



An object of the claimed invention is to provide an edible container set that uses a dried laver as a material and is superior in productivity and quality. The claimed invention obtains an edible container 10 by performing stacking in a manner sandwiching an interleaving paper 2 composed of a double-faced silicone paper between a dried laver (a sheet-shaped ingredient) 1 and a dried laver (a sheet-shaped ingredient) 1 , and, in a state arranging a cardboard 3 in its lowest part, performing heat pressing.

(2) Matters stated in the citation 1 (the cited invention): JP S61-274667A (finding of the Court Decision)

"(A) Claim (1) "a process for making an edible container using a laver as a material, comprising: molding, after giving flexibility to a dried laver by bringing dried laver into contact with heated vapor, the dried laver into a

predetermined eating utensil shape while sandwiching the dried laver by a pair of retainers; and, heating the molded product while still maintaining the molding state for solidification."

(B) The present invention relates to a process for making an edible container using a laver as a material.

(C) Conventionally, although there are various edible containers, a laver cannot be easily made into a container shape, and it is difficult to use as a material of an edible container. An object of the present invention is to provide a method for manufacturing an edible container using a laver having particular texture, flavor, and the like as a material, and to expand a utilization method of a laver. The present invention has achieved said object by the method stated in Claim (1).

(D) In the present invention, there is used, as a dried laver, a large dried laver prepared by an ordinary method after being punched out into a predetermined shape.

(E) After placing a dried laver on a convex retainer, by making only a plunger move down without making a concave retainer move down, the middle part of the dried laver is sandwiched between the plunger and the convex retainer, and in this state, flexibility is given by making heated vapor circulate between the convex retainer and the concave retainer and contact only the peripheral part of the dried laver.

(F) Next, the concave retainer is made to move down, and the peripheral part of the dried laver that protrudes from the plunger and has been given flexibility is sandwiched between the convex retainer and the concave retainer, and the dried laver is molded into a predetermined edible container shape.

(G) After that, when a molded product obtained by said molding is heated while still maintaining that molding state; that is, while still maintaining the convex retainer and the plunger in the moving down state, the molded product in question is dried and solidified and edible containers of various kinds of shapes can be obtained. It is possible to perform heating (initial firing) by, for example, heating the convex retainer from its inside by an arbitrarily means.

(H) It is preferred that, after finishing said heating, the concave retainer and the plunger are made to rise, the edible container is kept in a state being positioned between the retainers, and dried air, for example, is brought into contact with the edible container to cool and dry it further, and, then, the plunger is made to move down and the dried and solidified edible container is taken out.

(J) Although, the thus obtained edible container can has an arbitrary shape depending on concave and convex shapes of retainers, when an edible container is molded in a tapered form in a manner that it widens from the bottom part toward the mouth part, it can be stacked as shown in Fig. 12.

(K) The process of the present invention for making an edible container using a laver as a material has an effect that, by skillfully utilizing characteristics of a dried laver that flexibility is formed by humidity, an edible container having an arbitrarily shape such as a cup-shape or the like can be obtained without damaging particular luster, color, flavor and taste of a dried laver. In addition, it is possible for an edible container obtained by the present invention to, on the occasion of its use, make atmosphere of diet more pleasant by being served food, and to enhance preference by causing synergistic interaction between the texture, taste and aromatic odor of the served food and the texture, taste and aromatic odor of the dried laver, and, therefore, a value as an edible container is extremely high." (cited from the Court Decision)

(3) The Claims (Amended) (the amended claimed invention)

[Claim 1] A manufacturing method of an edible container set having a plurality of edible containers molded by applying a heat press to a sheet-shaped dried laver, comprising: a step of stacking, by sandwiching an interleaving paper between a sheet-shaped dried laver and a sheet-shaped dried laver, a plurality of sheet-shaped dried lavers and a plurality of interleaving papers, and, further stacking in a manner arranging interleaving papers on upper and lower surfaces of a stacked body in question and arranging a cardboard in a lowest part of said stacked body; a step of punching out said stacked body including a sheet-shaped dried laver, an interleaving paper and a cardboard into a predetermined shape; a molding step of, using a heat press molding machine having a female die, a positive die corresponding to said female die and a holding mold provided above said female die together with said positive die, a molding face of said female die being heated, bringing said cardboard in said punched out stacked body into contact with a molding face of said female die, performing heat press by bringing an interleaving paper in the upper surface of said punched out stacked body into contact with said positive die, and molding said sheet-shaped dried laver, interleaving paper and cardboard; and an extrusion step of extruding a sheet-shaped dried laver, an interleaving paper and a cardboard having been molded from said heat press molding machine, and forming an edible container set.

(4) Procedural History

December 18, 2009 : Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2009-25137),
Amendment (amendment in question) (refer to the above-mentioned "The Claims")

February 7, 2012 : The appeal decision that stated that the amendment in question is dismissed; and "the demand for appeal in question will not stand."

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

Appeal Decision (cited from the Court Decision)
..."The cited invention" ...found by the appeal decision in question ... is as follows. A The cited invention: A process for producing a stacked edible container using a laver as a material, comprising the steps of: after punching out a large dried laver prepared by an ordinary method into a predetermined shape and imparting flexibility by bringing heated vapor into contact with the punched dried laver, molding, while sandwiching the middle part of the dried laver between a plunger and a convex retainer, a dried laver of a predetermined edible container shape by sandwiching a peripheral part of the dried laver protruding from the plunger between the convex retainer and the concave retainer; while still maintaining the molding state, heating the dried laver by heating the convex retainer from its inside, and forming the dried laver into an edible container shape; and after making the concave retainer and the plunger rise, by making the plunger move down, taking out an edible container; and stacking obtained edible containers.
Decision

Allegations by Plaintiff	Allegations by Defendant
... In the citation 1, it is stated that, by imparting flexibility by heated vapor, molding of a dried laver into an edible container shape is performed, and, after that, a molded product obtained by this is solidified by heating. Here, heating is not for molding, but is performed in order to evaporate moisture due to vapor that has been brought into contact to give flexibility at the time of molding, and to make the molded product be dried and solidified. In other words, the invention stated in the citation 1 is not an invention to mold a dried laver by heat pressing using a heat press molding machine. In addition, in the citation 1, it is only stated that a dried and solidified edible container can be stacked after being taken out from between a convex retainer and a concave retainer, and a manufacturing method of each edible container is stated. Therefore, there is no description about a manufacturing method of a stacked edible container. C According to the above, the invention stated in the citation 1 should be found as follows. "A process for producing an edible container using a laver as a material, comprising: punching out a large dried laver prepared by an ordinary method into a predetermined shape; imparting flexibility to the punched out dried laver by, after sandwiching the middle part of a dried laver between a plunger and a convex retainer, bringing the laver into contact with heated vapor; while sandwiching a periphery part of the flexibility-imparted dried laver protruding from the plunger between the convex retainer and the concave retainer, molding the dried laver into a predetermined edible container shape; while still maintaining a molding state, by heating the convex retainer from inside, causing said molded product to be dried and fixed by heating; and after making the	A About performing molding of a dried laver by imparting flexibility by vapor, the "eating utensil shape sandwiching molding process by a pair of retainers" is stated after the "process of imparting flexibility" in the claims of the citation 1, whereas , when taking into consideration of the statement of Detailed Description of the Invention of the citation 1, it is found that the process of the latter is a process to "mold a dried laver between a convex retainer and a concave retainer into a predetermined edible container shape by sandwiching a peripheral part of the dried laver between the plunger and the convex retainer". Accordingly, the invention stated in the citation 1 according to the affirmation of the plaintiff not only mistakes order of "a process of giving flexibility" and "an eating utensil shape sandwiching molding process by a pair of retainers", but also there is no technological meaning in such order. ...It can be said that the cited invention is not an invention to perform, as the plaintiff's affirmation stated, molding of a dried laver into an edible container shape by imparting flexibility by heated vapor and, after that, cause a molded product obtained by this be dried and solidified by heating, but, rather, is an invention in which "heating" exists as a final process of molding, and molding is cause to be completed by "heating". Therefore, there is no fault in the appeal in question that made the finding about the cited invention as "by heating a dried laver by heating a convex retainer from inside, making it into an edible container shape". B Because, in the citation 1, there are statements about manufacturing a plurality of edible containers of the same shape, and stacking obtained edible containers to make them in a stacked state, and,

concave retainer and the plunger rise, taking out an edible container by making the plunger move down"	therefore, there is no fault in the appeal in question that made a finding about the cited invention as a "manufacturing method of stacked edible containers in which obtained edible containers are stacked", the obtained edible containers being obtained by, after making a concave retainer and a plunger rise, making the plunger move down, and taking out the edible containers.

Judgment by the Court

The invention stated ...in the citation 1, includes the following processes.

**Regarding items within the parentheses placed at the end of each of the following steps, refer to the above "2.(2) Matters stated in the citation 1 (the cited invention)")*

Process (a): a process of punching out a large dried laver prepared by an ordinary method into a predetermined shape (above-described ...(D)...)

Process (b): a process of placing the dried laver on a convex retainer (above-described ...(E)...)

Process (c): a process of holding the middle part of the dried laver between a plunger and the convex retainer (above-described ...(E)...)

Process (d): a process of imparting flexibility, by bringing heated vapor into contact with the dried laver while still maintaining the positional relationship of process (c) (above-described ...(E)...)

Process (e): a process of holding the periphery part of the dried laver extending outside from the plunger (that is, the part to which flexibility is imparted) between the convex retainer and the concave retainer, and molding the dried laver into a predetermined edible container shape (above-described ...(F)...)

Process (f): a process of heating the dried laver, by heating the convex retainer from its inside while still maintaining the positional relationship of process (e), to make the dried laver be dried and solidified and to be of an edible container shape (above-described ...(G)...)

Process (g): a process of taking out an edible container by, after moving the concave retainer and the plunger up, moving the plunger move down (above-described ...(H)...)

Process (h): a process of stacking obtained edible containers (above-described ...(I)...)

(A) In the cited invention for which a finding was made by the appeal decision in question, ...among said each processes stated in the citation 1, process (d) is stated following process (a), and, next, after stating that "while holding the middle part of the dried laver between the plunger and the convex retainer," process (e) and processes following process (e) are stated in series; however, processes (b) and (c) are not clearly specified.

As a matter of fact, it is not only obvious that process (b) is performed certainly when a dried laver is processed by molding equipment, but also this point is not a point to become a difference against the amendment invention in question.

In addition, process (c) clarifies, together with process (d), the specific aspect of bringing heated vapor into contact with a dried laver. However, the technical idea of the invention stated in the citation 1 is an idea that, after imparting flexibility by bringing heated vapor into contact with a dried laver, an edible container is molded by heat pressing, and, therefore, on the occasion of comparison of the invention stated in the citation 1 and the amendment invention in question, it is only needed to identify that the contact in question is performed in advance of molding the edible container, and thus it is not necessary to identify its specific aspect. Moreover, the appeal decision in question has made clear, by making a finding of process (e) and the subsequent processes sequentially after stating "while holding the middle part of a dried laver between the plunger and the convex retainer," that, on the occasion of molding the dried laver, the middle part of the dried laver is held between the plunger and the convex retainer, and flexibility is imparted to the dried laver before molding an edible container.

Accordingly, there is no fault in the appeal decision in question having made a finding of the cited invention without manifesting process (b) and (c), and, in addition, it should be said that there is no fault in the finding of the cited invention according to the appeal decision in question because it is based on the other processes of the invention stated in the citation 1.

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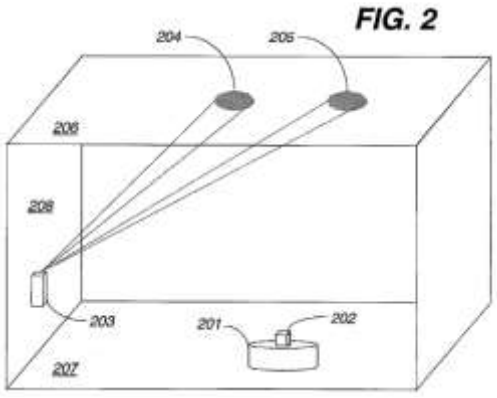
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.2(2)
Classification of the Case	52-1: Concerning finding of the cited invention as the generic concept
Keyword	

1. Bibliographic Items

Case	"A method of positon estimation system and the appratus of the same using reflecting light source" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, Aug. 9, 2013 (2012 (Gyo KE) No. 10436)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2007-506413 (JP 2007-530978A)
Classification	G01B 11/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division: Ryuichi SHITARA, presiding judge, Rika NISHI, judge, Masaya TANAKA, judge

2. Overview of the Case

(1) Summary of Claimed Invention



The claimed invention has an object to make a robot which performs floor cleaning by traveling a room interior to autonomously move to a dock station for self-battery charge, and includes: a light source 203 to project two light spots 204 and 205 modulated by different modulation patterns to a face 206; a detector 202, attached to an object 201, to detect reflection light from a light spot; and a data processing device to identify a light spot based on a modulation pattern and measure a position and posture of the object 201 based on a location of the two light spots.

(2) Summary of the cited invention (the finding of the appeal decision)

"A The contents of the cited invention

"A system for detecting a current position and direction of an unmanned vehicle 20, comprising: a plurality of fluorescent tubes Li, arranged on a ceiling, for emitting a plurality of rays of light Ei; an ITV camera 21 and a light-receiving unit 22 mounted on an unmanned vehicle 20 so as to detect said plurality of rays of light Ei; and a calculation circuit CPU 33 for calculating, based on coordinates gi of said plurality of rays of light Ei, position P and direction (posture) δ of said unmanned vehicle 20, wherein

said plurality of rays of light Ei are modulated by modulation frequencies Fi different from each other, and wherein

said calculation circuit CPU 33 including said ITV camera 21 and light-receiving unit 22 is constituted so as to identify that, by collating modulation frequency Fi with a table of an illuminating lamp data memory 34, real images corresponding to a full image Li' are to be a plurality of rays of light Ei. (here, i = 1-N.)"" (cited from the Court Decision)

(3) The Claims (Amended) (the claimed invention amended)

[Claim 1] A position estimation system for estimating a position of an object, comprising:

one or more light sources for projecting at least two light spots on a face undergoing emission of light upwardly without being meditated by a light reflection member;

a detector attached to said object so as to detect reflection light from said at least two light spot; and

a data processing device for measuring a position and posture of said object based on locations of said at least two light spots; wherein

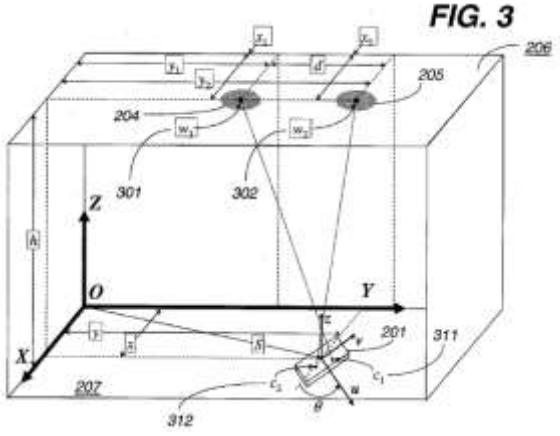
while one certain light spot among said at least two light spots is projected by light modulated by a first modulation pattern, another light spot among said at least two light spots is projected by light modulated by a second modulation pattern different from said first modulation pattern; and wherein

said data processing device including said detector is constituted so as to distinguish two light spots based on at least said first modulation pattern and said second modulation pattern.

(4) Disclosure of Detailed Description of the Invention

"In Fig. 3, a geometric model associated with the embodiment of the present method and apparatus already-stated relating to Fig. 2 is shown diagrammatically. A ceiling 206 exists at height h over the floor 207. A point w1301 exists in the center of gravity of a first spot 204, and a point w2302 exists in the center of gravity of a second spot 205. In the embodiment shown here, a global coordinate system having the x axis, the y axis, and the z axis is defined, and it is also called a global standard coordinate system." (extract of [0045] of the application concerned)

FIG. 3



"In an embodiment of Description of the application concerned (Exhibit A5), it is stated to, as a position estimation system to realize the claimed invention amended, estimate an absolute position of an object (a position of the object relative to the environment) in coordinate axes prescribed in advance." (extracted from the judgment paper)

(5) Procedural History

March 25, 2005	:	International patent application (Priority date: Mar. 29, 2004, United States)
April 12, 2011	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2011-7706), Amendment (refer to "The Claims" mentioned above)
August 16, 2012	:	An appeal decision that said the above amendment is dismissed; and "the demand for appeal in question will not stand."

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

<table>
<tr><td colspan="2">The appeal decision</td></tr>
<tr><td colspan="2">"The unmanned vehicle 20," "current position and direction," "detection," "the system for detecting a current position and direction," "ceiling," "a plurality of fluorescent tubes Li," "mounted," "the ITV camera 21 and the light-receiving unit 22," "coordinates gi," "position P and direction (posture)δ," "calculation," and "the calculation circuit CPU 33" in the invention stated in the citation 1 correspond to "object," "position," "estimation," "position estimation system," "certain face," "one or more light sources," "attached," "detector," "location," "position and posture," "measurement," and "data processing device" in the claimed invention as amended, respectively.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
(1) About the cited invention, the appeal decision made a finding as "a system for detecting a current position and direction of the unmanned vehicle 20". However, the position estimation system stated in the citation 1 is a system that estimates, on the premise that the system in question possesses in advance the coordinates of fluorescent tubes provided on a ceiling in a fixed manner, a position of an unmanned vehicle based on the coordinates, and, therefore, an estimated position is not a relative position to a fluorescent tube, but it is an absolute position in the environment ([0009], [0012], [0017]-[0022], [0029] of the citation 1, Fig. 4).</td><td>Allegations by Defendant
A calculation circuit (CPU 33) of the citation 1: identifies a position and direction of an unmanned vehicle relative to fluorescent tubes, by obtaining, based on a pixel address of an image center of a fluorescent tube image (bright area) photographed by an ITV camera, a tilt angle and pan angle of the image center seen from the unmanned vehicle; based on identification of the fluorescent tube by the light-receiving unit, reads the coordinate of the image center from the illuminating lamp data memory; and identifies a position and direction of the unmanned vehicle ([0017]-[0022], Fig. 4, Fig. 6 of Exhibit A1). Accordingly, the cited invention is a system for</td></tr>
</table>

	detecting a current position and direction of the unmanned vehicle 20 ([0001], [0005] of Exhibit A1).

Judgment by the Court

The plaintiff alleges that a position estimated by a position estimation system of the citation 1 is not a relative position to a fluorescent tube, and is an absolute position in an environment. However, in a judgment of inventive step of the claimed invention after amendment, it is necessary to make a finding of the cited invention to the extent that is needed in comparison with the claimed invention afer amendent based on the statement of the citation 1, and, so long as there is no prescription, about "a position and posture of an object" in claim 1 of the claimed invention after amendment, whether it is a relative position or an absolute position, there is no need to make a finding that a position estimated by a position estimation system of the citation 1 is an absolute position in an environment.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3. 2(2)
Classification of the Case	52-1: Concerning finding of the cited invention as the generic concept
Keyword	

1. Bibliographic Items

Case	"Salary calculation method and salary calculation program" (Appeal against an Examiner's Decision) Intellectual Property High Court Decision, Jul. 4, 2017 (2016 (Gyo KE) No. 10220)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2014-217202 (JP 2016-085562A)
Classification	G06Q 10/10
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division: presiding judge Makiko TAKABE, judge Yu YAMAKADO, judge Ryo KATASE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is relating to a salary calculation method to provide a salary calculation by cloud computing with enterprises,

wherein the method is targeting small and medium sized enterprises and the like, capable of significantly simplifying salary calculation work by:

performing salary calculation for each employee in a concerned month by using preliminarily stored company information and employee information;

displaying on a web browser, at least a part of the calculation result of the salary calculation together with a confirmation button of the calculation result; and

allowing the calculation result of each employee in the

[Fig.5]

concerned month to be confirmed upon clicking or tapping the confirmation button.

(2) Cited documents

“ (a) Well-known document 2 (Exhibit A6)

According to descriptions of Technical field ([0001]), Background art ([0002]), Problem to be solved by the invention ([0011]), Advantageous effects of the invention ([0015]), Best embodiments ([0018], [0025], [0027]~[0029], [0036]) in well-known document 2, well-known document 2 is found to state that a system having an application server which provides a salary payment function is comprised of the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of the company as well as employee information, and employees' mobile terminals that enable entry or updating of information such as the employee's correspondent financial institution, account and e-mail address and whether or not to request advance payment on a designated date.

(b) Exhibit A7 (Publication of Unexamined Patent Application No. 2001-290923)

According to descriptions of Technical field to which the invention in Exhibit A7 belongs ([0001]), Problem to be solved by the invention ([0009]), Embodiments ([0010], [0011], [0013], [0014], [0020], [0021]) as well as FIG. 1 and FIG. 3 (see drawings of attached sheet), Exhibit A7 is found to state that a system having an application server which provides a salary payment function is comprised of the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of the company as well as employee information, and employees' mobile terminals that enable entry or updating of each employee's attendance information.

(c) Exhibit B9 (Publication of Unexamined Patent Application No. 2001-273389)

According to descriptions of Technical field to which the invention in Exhibit B9 belongs ([0001]), Problem to be solved by the invention ([0007]), Embodiments ([0012], [0015], [0016], [0019], [0020]) as well as FIG. 1 (see drawings of attached sheet), Exhibit B9 is found to state that a system having an application server which provides a salary payment function is comprised of the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of the company as well as employee information, and employees' mobile terminals that enable entry or updating of each employee's arrival and quitting time information.

(d) Exhibit B10 (Publication of Unexamined Patent Application No. 2003-30477)

According to descriptions of Technical field to which the invention in Exhibit B10 belongs ([0001]), Problem to be solved by the invention ([0004]), Embodiments ([0013]~[0015], [0022]~[0026]) as well as FIG. 2 (see drawings of attached sheet), Exhibit B10 is found to state that a system having an application server which provides a salary payment function is comprised of the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of the company as well as employee information, and employees' mobile terminals that enable entry or updating of each employee's attendance information (for example, the arrival and quitting time and taking of paid holidays).” (Cited from the Court Decision)

(3) The Claims (Amended) (Claim 1 only) (Claimed Invention)

[Claim 1]

A salary calculation method by cloud computing provided with enterprises, whrein the method comprising steps of:

recording company information including the salary regulations of the company and employee information related to each employee of the company on a server;

performing salary calculation for each employee in a concerned month by using the company information and the employee information on the server;

displaying on a web browser of a terminal of a person in charge of accounting of the company, at least a part of the calculation result of the salary calculation together with a confirmation button of the calculation result on the server; and

allowing the calculation result of each employee in the concerned month to be confirmed by the sever based on clicking or tapping the confirmation button only, upon clicking or tapping the confirmation button,

wherein the employee information comprises information entered by employees that may affect the salary calculation, which is entered by displaying the web page to be used by each employee to enter information on the web browser of each employee's mobile terminal.

(4) Procedural History

October 24, 2014	:	Filing of Patent Application
November 4, 2015	:	Decision of Refusal
December 3, 2015	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2015-21527), Amendment (refer to "The Claims" mentioned above)
August 16, 2016	:	Appeal Decision “the request for appeal for this case is dismissed.”

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

Appeal Decision (Cited from the Court Decision)
This Appeal Decision, with respect to Difference 5, found and determined that, since the item of [information on dependents] is contained in FIG.2 of Cited document and generally information on dependents is employee information that may affect the salary calculation, “a system having an application server which provides a salary payment function is comprised of the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of the company as well as employee information, and employees' mobile terminals that enable entry or updating of employee information” is the well-known art (well-known art indicated in well-known document 2) before the date of filing this application, and that it is a matter of design which should be selected by a person ordinarily skilled in the art at his/her discretion to decide the specific employee information to be entered by each employee using their own employee terminals, and then that “in the cited invention, before the date of filing this application, a person

ordinarily skilled in the art could have easily conceived of the structure of displaying the web page to be used by each employee to enter information entered by employees (information on dependents) that may affect the salary calculation on the web browser of each employee's own mobile terminal as in the Claimed Invention by applying well-known arts or ordinary structures to well-known document 2 and others, instead of the structure of entering the information on dependents of each employee based on employees' reports".

Decision

Allegations by Plaintiff

(2) The errors in identifying the well-known art

As of the date of filing this application, a salary calculation software on cloud do not have a function of entering employee information from employees' terminals, needeless to say a function of entering employee information that may affect the salary calculation. Thus, it was not at least the well-known art. In addition, it was not at least the well-known art to prepare IDs for employees as a basis of the art.

In this Appeal Decision, based on well-known document 2 only it is found that it was the well-known art before the date of filing this application to make a system having an application which provides a salary payment function comprised of employees' mobile terminals that enable entry or updating of employee information, in addition to the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of the company as well as the employee information. However, this is the error in finding the well-known art. Well-known document 2 only states that personal information that may not affect the salary calculation and information on correspondent financial institution and account are entered as employee information.

(3) There is an obstructive factor for applying the well-known art to the cited invention

According to the above (2) in the Allegations by Plaintiff, the cited document and the well-known document 2 belong to different technical fields. Thus,

Allegations by Defendant

(2) No errors in identifying the well-known art

Reasons for finding a state of the art as of the date of filing this application would not be limited to a state of the art concerning a salary calculation system implemented as cloud-salary service, and a state of the art concerning the ASP salary calculation system (salary calculation system provided on a server accessible via the internet) should also be considered.

The description of this application states that the Claimed Invention can be made by a web server which provides cloud computing ([0025]), but it does not show more specific system structure than the statement. Thus, there is no error in identifying the well-known art as referred to in this Appeal Decision which states the concept that cloud computing as a basis of the Claimed Invention includes ASP service.

The structure in which employee information is entered from employees' terminals in a salary calculation system provided on a server accessible via the internet is disclosed in well know document 2 and Exhibit A7 which is the background art of the cited inventions as well as Exhibit B9 (Publication of Unexamined Patent Application No. 2001-273389) and Exhibit B10 (Publication of Unexamined Patent Application No. 2003-30477). ([0016] of Exhibit B9, ([0015], [0025] of Exhibit B10)

Therefore, there is no errors in identifying the well-known art in this Appeal Decision.

(3) There is no obstructive factor for applying the well-known art to the cited invention

it is not easy to apply the art contained in well-known document 2 to cited invention. Also, in the cited invention, information entered by employees that may affect the salary calculation is registered on the salary database 3 as fixed items from certified tax accountants' terminals 10, and this is carried out in accordance with an authority given to certified tax accountants only, and also this invention adopt the above structure as a problem which is to carry out salary calculation work smoothly with eternal experts for small and medium sized enterprises or small-scale business operators. Thus, when this may be changed, it is inevitable that the above problem cannot be solved. Therefore, there is obviously an obstructive event concerning entering information entered by employees (information on dependents) that may affect the salary calculation from terminals different from certified tax accountants' terminals 10, and especially from employees' terminals which are not experts' terminals. Furthermore, with respect to judgment related to Difference 5, this Appeal Decision refers to Exhibit A7 (Publication of Unexamined Patent Application No. 2001-290923) (see page 18). However, Exhibit A7 is denied as the background art in the cited document and eliminated ([0004]), and it cannot be considered that a person ordinarily skilled in the art who read the cited document would apply such art to the cited invention.	According to the above (2) in the Allegations by Defendant, the cited invention and the art stated in the well-known document 2 belong to the same technical field. Also, the obvious problem in the salary calculation system is common that the Claimed invention and the cited invention enable a person in charge of salary payment to reduce burden of salary calculation work and to carry out salary calculation work smoothly. Whether fixed items or updated items which are required for salary calculation are entered from external experts' terminals or from employees' terminals would solve this problem in either way. Thus, there is no obstructive event concerning entering information on dependents not from certified tax accountants' terminals, but from employees' terminals. Furthermore, Exhibit A7 states the structure in which employees' mobile terminals including PDA terminals or mobile phones used by employees are used to enter attendance data, notified data and personal data for salary calculation, and such structure was the well-known art before the date of filing this application. Thus, there is no obstructive factor for applying such structure to the cited invention, and a person ordinarily skilled in the art could have easily conceived of applying such structure to the cited invention. Applying the above structure contained in Exhibit A7 to the cited invention would not be eliminated just because it is indicated as the background art in the cited document.
Judgment by the Court 3 Regarding the errors in determining whether or not a person ordinarily skilled in the art could have easily conceived of Difference 5 … (2) With respect to the well-known art identified in this appeal decision … Well-known document 2, Exhibit A7, Exhibit B9 and Exhibit B10 are found to have disclosed that a system having an application server which provides a salary payment function is comprised of the user company's terminal that enables entry of company information including the salary cut-off date and salary payment date of	

the company as well as employee information, and employees' mobile terminals that enable entry or updating of the following information: [i] information such as the employee's correspondent financial institution, account and e-mail address and whether or not to request advance payment on a designated date (well-known document 2); [ii] each employee's attendance information (Exhibit A7) ; [iii] information on the arrival and quitting time of each employee (Exhibit B9) ; and [iv] each employee's attendance information (for example, the arrival and quitting time and taking of paid holidays). However, they do not disclose a generic concept such as "the system being comprised of employees' mobile terminals that enable entry or updating of the overall information related to employees (employee information) in addition to the user company's terminal" or "employees' mobile terminals that enable entry or updating of the information entered by employees (information on dependents) in addition to the user company's terminal" nor do they contain any suggestion of such concept.

Thus, based on well-known document 2, Exhibit A7, Exhibit B9 and Exhibit B10, the court held that the well-known art found in this Appeal Decision cannot be identified. Moreover, it cannot be also found that "it is a matter of design which should be selected by a person ordinarily skilled in the art at his/her discretion to decide the specific employee information to be entered by each employee using their own employee terminals", as found in this Appeal Decision based on the existence of such well-known art.

(3) Motivation

The claimed invention is … to provide a salary calculation method and a salary calculation program targeting small and medium sized enterprises and the like, capable of significantly simplifying salary calculation work (Description of this application [0002]~[0006]).

Furthermore, in the claimed invention, the employee information that may affect the salary calculation, such as the information on dependents, is entered from each employee's own mobile terminal by displaying the web page to be used by each employee to enter information on the web browser of such terminal for the purpose of automating the salary calculation, which may change depending on the information specific to each employee such as the number of dependents (date of birth, date of entering the company or attendance information, in addition to the number of dependents), thus freeing the person in charge of salary payment from troublesome work (Description of this application [0035]).

On the other hand, … the invention stated in the cited document has been made to enable multiple business operators' terminals, … multiple business operators and multiple experts with expertise such as certified tax accountant and certified social insurance consultant to carry out salary calculation and other procedures smoothly.

Therefore, a person ordinarily skilled in the art who read the cited document would not find any suggestions concerning the specific problem to be solved by the Claimed Invention and it is difficult to find that such person ordinarily skilled in the art could have conceived of the structure of the Claimed Invention related to Difference 5 by adopting the structure of entering the information on dependents of each employee from each employee's own mobile terminal instead of the structure of entering the information on dependents of each employee from an expert terminal.

Also, the cited invention has a structure in which a time recorder is connected to the business operator's

terminal to collect attendance data of employees, and this data is transmitted to a salary calculation server device to calculate salary. Thus, even if it is an obvious problem to reduce burden of salary calculation work for a person in charge of salary payment and to carry out salary calculation work smoothly as the Defendant alleges, in order to solve the problem, there is no motivation for applying the structure of the Claimed Invention related to Difference 5 by adopting the structure of entering attendance information by displaying on a web browser of employees' terminals, instead of the above structure.

(Reference)

See Intellectual Property High Court Decision, August 8, 2012 (2011 (Gyo KE) No.10360).

(53)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 3.1.1 and 3.1.2
Classification of the Case	53: Whether or not the invention can be deemed to be an invention that was described in a distributed publication or an invention that was made publicly available through electric telecommunication lines
Keyword	Matters recognized from equivalents to the descriptions

1. Bibliographic Items

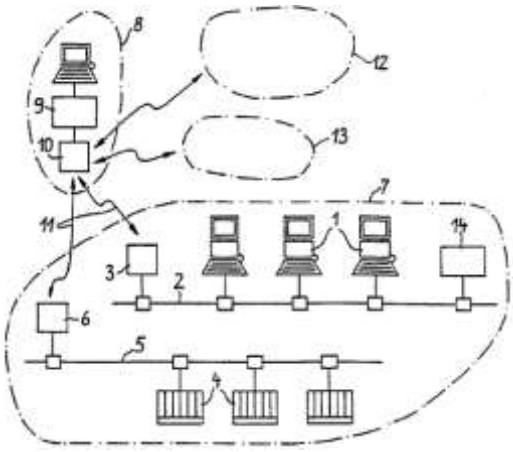
Case	"A Process automation system" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, April 28, 2010 (2009 (Gyo KE) No.10163)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No.H10-504651 (National Publication of International Patent Application No.2000-514220)
Classification	G05B 19/418
Conclusion	Dismissal
Related Provision	Article 29(1)(iii)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Tomoko MANABE, Judge: Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

A terminal (1) in an operation-/monitoring level and an automation device (4) in an automation level in the vicinity of process in a process automation system communicate with a master computer (9) through sending-/receiving devices (3, 6, 10) and a data transfer media (11) (wireless connection, telecommunication network). These can be set in a calculation center as a supercomputer and can also control other process automation systems (12, 13).

[FIG. 1]



(2) Cited Invention 1

"(A) A semiconductor manufacturing device, comprising: a semiconductor manufacturing line system managing a plurality of element process facilities group; an administrative department system administrating a progress management of the products manufactured in a semiconductor manufacturing line, an instruction of manufacturing

conditions for element process facilities group and an instruction of manufacturing conditions for operators in element process facilities group; and an electronic file management computer (a computer for process management) conducting a total process management by connecting the semiconductor manufacturing line system with the administrative department system.
(B) A plurality of facilities group management computers and products management computers in a semiconductor manufacturing line system are connected with communication network in a state that information can be transferred. In addition, a plurality of each-department management computers in an administrative department system are connected with communication network in a state that information can be transferred.
(C) An electronic file management computer (a computer for a process management) creates an electronic file for process management by combining the manufacturing management information of electronic files which a plurality of each-department management computers have, and comprises: a function for managing a creating process of an electronic file for process management; a function for managing information transfer of each electronic file by designating sending and receiving address between a plurality of facilities group management computers and a plurality of each-department management computers; a management function of document examination, approval and validity in each administrative department or element process facilities group; a function for storing a manufacturing management information of each electronic file and a facilities management information as a backup in an electronic file for process management." (cited from the Court Decision)

(3) The Claims (Claimed Invention)
[Claim 1] A process automation system, comprising: a terminal (1) for operation and monitoring of process, connected with a 1st sending/receiving device (3) that exists in a operation/monitoring layer; a automation device (4) connected with a 2nd sending/receiving device (6) through a process bus that exists in lower automation layer; a master computer (9) connected with a 3rd sending/receiving device (10), wherein said master computer is arranged at the outside of said operation/monitoring layer and said automation layer, and said 3rd sending/receiving device (10) communicates with said 1st and 2nd sending/receiving device (3, 6) through a data transfer media (11), and a data is exchanged between said operation/monitoring layer and said automation layer through a master computer (9) and at that time, said process bus is not linked with said terminal.

(4) Procedural History

July 3, 1997	:	Filing of Patent Application (The date of priority claim of original application: July 8, 1996 Germany)
September 22, 2006	:	Decision of Refusal
December 28, 2006	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No.2006-28998)
February 5, 2008	:	Amendment of Proceeding (See above "The Claims")
February 3, 2009	:	Appeal Decision that "the request for appeal is dismissed."

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

Appeal Decision

(Certification of Cited Invention in Appeal Decision. Cited from the Court Decision.)

<Cited Invention 1>

"A semiconductor manufacturing device, comprising: a plurality of each-department management computers 25 ~ 29 for managing a progress management of the products manufactured in a semiconductor manufacturing line, an instruction of manufacturing conditions for element process facilities group 101 ~ 10n, an instruction of manufacturing conditions for operators of element process facilities group 101 ~ 10n, connected with a sending/receiving device that exists in an administrative department system 2; facilities group management computers 111 ~ 11n connected through communication network with a sending/receiving device that exists in a semiconductor manufacturing line system 1; an electronic file management computer 3 connected with a sending/receiving device, wherein a sending/receiving device connected with an electronic file management computer 3 communicates with a sending/receiving device that exists in an administrative department system 2 and a sending/receiving device that exists in a semiconductor manufacturing line system 1 through communication network for an electronic file management computer, and a data inputted in an each-department management computer 25 is transferred to a facilities group management computer 111 of a semiconductor manufacturing line system 1 through an electronic file management computer 3 and at that time, a communication network of a semiconductor manufacturing line system 1 is not directly linked with a communication network of an administrative department system 2."

Decision

Allegations by Plaintiff	Allegations by Defendant
(A) A Sending/Receiving Device The appeal decision has determined that "... it is apparent that each of an administrative department system 2, a semiconductor manufacturing line system 1 and an electronic file management computer 3 has a sending and receiving device." (1st row from the bottom line of Page 5 to 2nd row of Page 6) However, Citation 1 states that "an administrative department system 2 and an electronic file management computer 3, and a semiconductor manufacturing line system 1 and an electronic file management computer 3 are connected through communication network," but it can be said that an electronic file management computer 3 has a sending and receiving device based on the statements of "a data is transferred from an each-department management computer 25 to an electronic file	A Sending/Receiving Device Plaintiff asserts that Citation 1 does not state that a sending and receiving device exists in a semiconductor manufacturing line system 1 and an administrative department system 2 and that Citation 1 does not suggest such matter. However, Citation 1 states that "in addition, a process management computer is equipped with a function for managing information transfer of an electronic file by designating sending and receiving address between a plurality of facilities group management computer and a plurality of each-department management computers, in that way, it enables, for example, to efficiently manage flow of electronic files by managing an electronic file with identification information such as meaningful classification codes and also enables to ensure the

management computer 3" (paragraph [0047]), "a data is transferred from an each-department management computer 27 to an electronic file management computer 3" (paragraph [0049]), " a data is transferred from an each-department management computer 28 to an electronic file management computer 3" (paragraph [0050]), "a data is transferred from an electronic file management computer 3 to facilities group management computer 111" (paragraph [0054]) . However, above statements do not include the statement that a sending/receiving device exists in a semiconductor manufacturing line system 1 and an administrative department system 2, and do not suggest such matter.	confidentiality of products information." (paragraph [0021]), "furthermore, an electronic file management computer 3 has a function for managing automatically, information transfer of electronic files 11 (1) a ~ 11 (n) a, 11 (1) b ~ 11 (n) b that a plurality of facilities group management computers 11 (1) ~ 11 (n) have and electronic files 25a, 25b, 26a, 27a, 27b, 28a, 28b, 29a that a plurality of each-department management computers 25 ~ 29 have, by a transfer program or the like, based on identification information of an electronic file ... a function for storing the manufacturing management information and facilities management information of each of electronic files 11 (1) a ~ 11 (n) a, 11 (1) b ~ 11 (n) b, 25a, 25b, 26a, 27a, 27b, 28a, 28b, 29a in a process management electronic file 3 a as a backup." (paragraph [0039]), ""thus, according to a semiconductor manufacturing device of the embodiment, by managing total process by connecting an electronic file management computer 3 between facilities group management computers 11 (1) ~ 11 (n) and each-department management computers 25 ~ 29 of an administrative department system 2 ... " (paragraph [0056]). Accordingly, an electronic file management computer 3 as a process management computer comprises: a function for managing information transfer of each electronic file by designating sending and receiving address; a function for managing information transfer automatically by a transfer program or the like, based on identification information of an electronic file; a function for storing a manufacturing management information and a facilities management information as a backup; and a function for managing total process. An electronic file management computer 3 is required for comprising above multiple types of functions to mutually exchange a data between a semiconductor manufacturing line system 1 or an administrative department system 2.

	Thus, Citation 1 is considered to suggest that an electronic file management computer 3, a semiconductor manufacturing line system 1 and an administrative department system 2 respectively have a sending and receiving device, and mutually exchange a data. In addition, Citation 1 states that "these facilities group management computers 11 (1) ~ 11 (n) and a products management computer 12 are constituted by regular personal computer and word processor and the like." (paragraph [0032]), and "these each-department management computers 25 ~ 29 are constituted by regular personal computer and word processor and the like." (paragraph [0036]). In communication between personal computers, originally, it is technical common knowledge that mutual data exchange is necessary when communication is established, and as of the date of July 8, 1996 (Heisei 8) that is the date of priority claim of the application, it was well-known matter that a sending and receiving device is used when regular personal computer communicates (38th - 41st row of Field 1 of JP H5-260117A [the name of the invention "a communication controlling device," the applicant Ricoh co., ltd., the publication date October 8, 1993, B1], and 49th row of Field 4 ~ 35th row of Field 5 and FIG. 3 of Drawings of JP H5-218967A [the name of the invention "beam communication system," the applicant ORII:KK, the publication date August 27, 1993, B2]). Accordingly, it is apparent that each-department management computers 25, 27, 28 of an administrative department system 2 do not only comprise a sending device that sends files for communication but also a receiving device, and similarly, it is apparent that facilities group management computers 11 (1) ~ 11 (n) and a products management computer 12 are not only a receiving device that receives files but also a sending

	device. ...

Judgment by the Court

In Citation 1, as mentioned above, the technical matters are stated. A plurality of facility group management computers and product management computers in a semiconductor manufacturing line system are connected in a state that information can be transferred, through a communication network, and a plurality of each-department management computers of an administrative department system are connected in a state that information can be transferred, through a communication network. In addition, an electronic file management computer has a function for managing information transfer of each electronic file by connecting the semiconductor manufacturing line system with the administrative department system, and by designating sending and receiving address between the plurality of facility group management computers and the plurality of each-department management computers. Thus, between the electronic file management computer and the semiconductor manufacturing line system, and between the electronic file management computer and the administrative department system, a communication network for transferring information is considered to exist. In addition, when a computer is connected in a state that information can be transferred through a communication network, intervention of a device with sending and receiving functions is the matter that can be said to be the common general knowledge in the technical field of computer networks, and any of the electronic file management computer, the each-department management computer of the administrative department system, the facility group management computer of the semiconductor manufacturing line system and the product management computer are connected in a state that information can be transferred through a communication network. Therefore, it is recognized that each of them is a device with sending and receiving functions, namely, is connected in a state that information can be transferred through a "sending/receiving device."

Therefore, concerning the appeal decision's certification of Cited Invention 1, it is not considered that there is an error in certifying "a sending/receiving device that exists in an administrative department system 2," "facility group management computers 11 (1) ~ 11 (n) that exist in a semiconductor manufacturing line system 1, and are connected with a sending/receiving device through a communication network" and "an electronic file management computer 3 connected with a sending/receiving device."

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1 and 3.1.2
Classification of the Case	53: Whether or not the invention can be deemed to be an invention that was described in a distributed publication or an invention that was made publicly available through electric telecommunication lines
Keyword	Instruction manual of a product, Period of distribution of a product

1. Bibliographic Items

Case	"Motor control apparatus" (Trial for Invalidation) Intellectual Property High Court Decision, June 9, 2011 (2010 (Gyo KE) No. 10272)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2003-386421 (JP 2005-149182A)
Classification	G05B 19/416
Conclusion	Dismissal
Related Provision	Article 29(1)(iii)
Judges	IP High Court Fourth Division. Presiding judge Takaomi TAKIZAWA, Judge Yasuhito INOUE, Judge Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is directed to the technical problem of allowing the number of speed command pulse equivalent to a total amount of movement of mobile objects to be obtained easily without the need of performing complicated calculations and the like. The claimed invention is configured to carry out the interpolation processing, on the basis of the speed command, for calculating approximate paths of the mobile objects each controlled by the corresponding each of the pulse train input type motors; count the number of pulses of the speed command pulses from the interpolation start position to the interpolation end position; in the trace mode for obtaining the total number of pulses, not output to an external device the drive pulse that has been generated on the basis of the speed command pulses; and in the normal operation mode for actual operation, output the drive pulse to the external device.

(2) Outline of Invention Described in Distributed Publication (Findings of Trial Decision)

(i) Citation 1 (the Cited Invention): Compact PCI MOTOR CONTROL MODULE ACP-425, User's Manual (indication of Published May 9, 2003 is provided in its last page.)

"...A high-performance four-axis motor control board adapted to output pulses for each of a plurality of stepping motors for driving these stepping motors, the motor control board comprising: an IPC710 for carrying out interpolation processing on the basis of the speed command pulse and generating the pulse; a DRIVE PULSE COUNTER for counting the number of pulses of the speed command pulses; and a CompactPCI interface for reading the count value of the DRIVE PULSE COUNTER by a device external to the high-performance four-axis motor control board, the high-performance four-axis motor control board including as its operating modes, an interpolation mode and a through mode." (Extracts taken from the court decision)

(3) The Claims (Only claim 1 is described) (the Invention 1)

[Claim 1] A motor control apparatus adapted to output drive pulses for each of a plurality of pulse train input type motors for driving each of the pulse train input type motors, the apparatus being characterized by the fact that it comprises an interpolation control unit configured to carry out interpolation processing on the basis of speed command pulses and generate the drive pulses, a total pulse number count unit configured to count the number of pulses of the speed command pulses from an interpolation start position to an interpolation end position, and a pulse output control unit configured to control whether or not the drive pulses are output to a device external to the motor control apparatus; the apparatus has, as operating modes, a trace mode for obtaining a total number of pulses and a normal operation mode for actual operation; and the pulse output control unit is configured to not output the drive pulse to the device external to the motor control apparatus in the trace mode, and configured to output the drive pulse to the device external to the motor control apparatus in the normal operation mode.

(4) Procedural History

November 17, 2003	:	Filing of a patent application by Defendant (Patentee)
April 28, 2006	:	Registration of establishment of the patent right (See the above-described "The Claims.")
August 31, 2009	:	Filing of a request for a trial for patent invalidation by Plaintiff (Muko No. 2009-800186)
July 12, 2010	:	Trial Decision dismissing the request for trial

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

Appeal Decision (cited from the Court Decision)
...It reads as follows: It cannot be said that the claimed invention would have been easily arrived at by a person skilled in the art by applying the matters described in ...Citation 2 and ...Citation 3 to the invention (...which is referred to as "the Cited Invention") described in Citation 1 of ...the item A described below. A Citation 1: Compact PCI MOTOR CONTROL MODULE ACP-425, User's Manual (An indication "Published on May 9, 2003" appears in the last page...)
Decision

Allegations by Plaintiff	Allegations by Defendant
A A quarterly magazine titled "Transistor Gijutsu" and published on March 1, 2003 describes the commercial release of the product in question of the cited invention ...it is described in an article on the Internet of Nikkei Inc. ...and on the Web page of Avaldata Corporation ...that the shipment of the cited invention was on March 1 of the same year. In view of these facts, it is clear that Citation 1 was distributed soon after the same date...	A The Product in question (ACP-425) of Citation 1 was sold on December 22, 2003 (Exhibit B3), which is after the filing date of the Patent Application (November 17 of the same year). Accordingly, Citation 1 is not a publication distributed prior to filing of the Patent Application.

Judgment by the Court

Citation 1 is an instruction manual (User's Manual) of the four-axis interpolation motor control module ACP-425, which is a product of Avaldata Corporation. As the date of publication of the first edition, the indication "May 9, 2003" is provided in the last page thereof. Also, it is clear from rules of thumb that distribution of an instruction manual to be distributed to many and unspecified users takes place close to commercial release of the product is taken into consideration along with the article on the Internet stating that Avaldata Corporation started to accept orders of the ACP-425 on December 2, 2002 and the product was scheduled to be shipped on March 1, 2003 ..., the description of the Web page of Avaldata Corporation announcing the same content ...and the advertisement in "Transistor Gijutsu " of March of the same year, in which Avaldata Corporation announced commercial release of the ACP-425. Considering the facts described above together, it is recognized that Citation 1 was distributed around May of the same year prior to the filing date of the patent application (November 17, 2003) at the latest. Accordingly, the evidence (Exhibit B3) that is not consistent with this finding cannot be adopted.

...It is found that Citation 1 was publicly known as a publication distributed prior to the filing date of the patent application.

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 3 3.1.1 and 3.1.2
Classification of the Case	53: Whether or not the invention can be deemed to be an invention that was described in a distributed publication or an invention that was made publicly available through electric telecommunication lines
Keyword	Matters recognized from equivalents to the descriptions

1. Bibliographic Items

Case	"Biocide composition with synergistic action" (Trial for Invalidation) Intellectual Property High Court Decision, October 24, 2011 (2010 (Gyo KE) No. 10245)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2000-509290 (National Publication of International Patent Application No. 2001-515016)
Classification	A01N 43/80
Conclusion	Acceptance
Related Provision	Article 29(1)(iii)
Judges	IP High Court Third Division, Presiding judge: Toshiaki IIMURA, Judge: Akira IKESHITA, Judge: Eiko TAKEMIYA

2. Overview of the Case

(1) Summary of Claimed Invention

A composition containing 1,2-benzoisothiazolin-3-one as an addition to substances that can be infected by harmful microorganisms, in which the composition has at least two active biocidal substances, one of which is 2-methylisothiazolin-3-one. However the composition excludes a composition containing 5-chloro-2-methylisothiazolin-3-one.

(2) Matter Stated in Exhibit A1

"[1] In a method of obtaining direct positive color photograph, the problem to be solved is to perform antibacterial and antifungal measures for photosensitive material and protect performance of photographs from lowering, by blending publicly known antiseptic agent and antifungal agent in photosensitive material, and considering a component of developing solution; [2] As means for the problem to be solved, in a method of treating photosensitive material for color photographs with color developing solution, sensitive material for direct positive color photograph comprising at least one kind of antibacterial agent and antifungal agent represented by general formulas (1) to (3)

which is included in at least one layer on a support of photosensitive material (Note in Court Decision: the combination stated of compounds having antibacterial and antifungal effect is more than 1400.), the color developing solution composed of at least one kind of compounds represented by general formulas (4) to (6), and a compound of sulfurous acid, is indicated; [3] In a compound group (2) to be targeted as a combination, not only MIT (2-1) but also CMIT (2-2) are listed, and BIT (3-1) is listed in a compound group (3); and [4] In Example 1, an example of a combination of MIT and BIT is indicated, a sample of No. 107 described in [Table 1] is photosensitive material for photographs that contains gelatin as a component of hydrophilic colloid, and 0.5 g of MIT and 0.5 g of BIT are contained per 1 kg of gelatin (paragraphs [0001] to [0008], [0029] to [0031], [0131])" (cited from the Court Decision)

(3) The Claims (Claimed Invention 1)

[Claim 1] A biocide composition as an addition to substances that can be infected by harmful microorganisms, in which the composition has at least two active biocidal substances, one of which is 2-methylisothiazolin-3-one, (Note in Court Decision: hereinafter, including a case of transcribing the statement of the description, often referred to as "MIT"), and the composition is characterized in that it contains 1,2-benzoisothiazolin-3-one (hereinafter, including a case of transcribing the statement of the description, often referred to as "BIT") as an more active biocidal substance, a composition containing 5-chloro-2-methylisothiazolin-3-one (hereinafter, including a case of transcribing the statement of the description, often referred to as "CMIT") being excluded.

(4) Procedural History

August 3, 2007	:	Registration of establishment of the patent right (see above "The Claims")
December 25, 2008	:	Request for Trial for Invalidation by the Defendant (Muko No. 2008-800291)
March 29, 2010	:	Trial decision that "patents granted to the inventions claimed in claims 1 through 7 and 18 shall be invalid."

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

Appeal Decision
(Cited from the Court Decision) "Trial Decision judges that, with respect to the description, [1] from the description of U.S. Patent No. 5,466,818 (Exhibit A40) cited as that MIT can be prepared, MIT is obtained by separating a mixture of CMIT and MIT, a substance in which less than 1/245 of CMIT is contained in MIT is substantially pure MIT; [2] In the paragraph [0021] of the description, it is stated that the reaction product obtained thereby can be purified, e.g., by column chromatography, it is common knowledge of a person skilled in the art that a specific substance is not perfectly removed even by column chromatography, it is understood that "CMIT is not contained" means "a little amount of CMIT is allowed" in the Claimed Invention, and if the difference between the content of CMIT in the Claimed Invention and the content of CMIT in the Invention of Exhibit A1 is not made clear, Difference C is not substantially different.

<table>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
... The invention of Exhibit A1 in which only MIT is described is formally distinguished from the Claimed Invention with a requirement of "CMIT is not contained."
"CMIT is not contained" means "CMIT is not substantially contained", and also means "the microbiologically active amount of CMIT is not contained." This requirement substantially distinguishes the Claimed Invention and the Invention of Exhibit A1. Namely, MIT of the Invention of Exhibit A1 is clearly distinguished from the Claimed Invention with antifungal effect (effect against Aspergillus niger) supporting the presence of CMIT.
Therefore, the Claimed Invention and the Invention of Exhibit A1 can be distinguished without specifically making clear "the content" of CMIT that inevitably exists, and since novelty of the Claimed invention cannot be denied, the trial decision denying novelty of the Claimed invention has an error.</td><td>Allegations by Defendant
In the description, it is not stated that whether "CMIT is not substantially contained" allows a little amount of CMIT and how to obtain "MIT substantially not containing CMIT", and Example corresponding to the Claimed Invention 1 only discloses a combination of MIT and BIT.
The Example of the combination of MIT and BIT corresponding to the Claimed Invention 1 is stated in the description of the basic application, on the other hand, a technical constituent of "CMIT is not contained" is not stated and "CMIT is not contained" is not a problem to be solved by the invention, in the description of the basic application.
In Exhibit A1, a composition consisting of a combination of MIT and BIT is stated. For understanding Invention of Exhibit A1, the common general knowledge of a person skilled in the art as of the priority date should be considered similarly to the Claimed Invention 1, and there is no ground for distinguishing the Claimed Invention 1 and the Invention of Exhibit A1.</td></tr>
<tr><td colspan="2">Judgment by the Court
Article 29(1) of the Patent Act provides that any person who has made an invention may be entitled to obtain a patent except publicly known inventions, publicly worked inventions, and inventions described in a publication prior to the patent application. The purpose of Article 29(1) is that an invention of the application (the invention) should be entitled to obtain a patent as long as the patent is not accepted (not proved) to be a publicly known invention, a publicly worked invention, or an invention described in a publication, before filing of the application.
Comparing the invention and inventions publicly known before filing of the application (hereinafter, often referred to as "publicly known invention"), in a case where a publicly known invention is an invention in which all constituent features stated in Claims of the invention are satisfied, it is clear that the invention cannot be entitled to obtain a patent (The invention does not have novelty.). On the other hand, in a case where a publicly known invention is an invention in which only some of the constituent features stated in Claims of the invention are satisfied, the invention can be entitled to obtain a patent (The invention has novelty.). However, in the latter case, if a publicly known invention only satisfies "some of constituent features" and is not referred to</td></tr>
</table>

"other constituent features" at all, the publicly known invention includes a wide technical scope and thus does not remove the invention logically. Thus, for example, the description which explains the content of a publicly known invention is supposed, and the conclusion may be "an invention in which other constituent features are limited, and the publicly known invention satisfies all constituent features of the invention." However, in a case where all constituent features of the invention is not described in a publication, an invention described or explained in the publication in which constituent features of the invention are satisfied not until supposing the invention described in the publication, the invention described in the publication is not an invention described in the publication under the provision of Article 29(1) of the Patent Act. Assuming that such case falls under Article 29(1), it is considerably difficult to protect inventions appropriately, and this contravenes the purpose of the Patent Act. In the above case, whether to be entitled to obtain a patent should be considered by the presence of sufficiency of inventive step and other requirement for patentability.

...

In Exhibit A1 and the cited documents, with respect to MIT used as a composition of an antimicrobial and antifungal agent, "CMIT is not contained" is not referred to and a defect caused by containing CMIT are not described. Thus, in Exhibit A1, a technical idea that avoids a defect caused by containing CMIT is not indicated. It is understood that a person skilled in the art reading Exhibit A1 does not recognize that an invention limited by the constituent feature of "CMIT is not contained" is described, but recognizes that in Exhibit A1, an invention having a comprehensive concept of "an invention containing CMIT" is described. ..., [1] in the Invention of Exhibit A1, as stated above, the problem caused by containing CMIT is not indicated, [2] further, in the Invention of Exhibit A1, CMIT is described in a specific example (2-2) of a compound represented by a general formula (2), [3] at the priority date, only a mixture of MIT and CMIT was on the market for MIT available for a person skilled in the art (Exhibit A7, Exhibits A34 to 39, Exhibit B6), [4] with an effect of a supplementary examination, the plaintiff confirms whether MIT used in Examples indicated in Table 2 of Exhibit A1 contains CMIT, and as a result, it is supposed that Examples is not composed of pure MIT, but MIT includes CMIT (Exhibits A25, 28, 42, 43), and [5] the description of the patent application filed by the same applicant as Exhibit A1 states "a synthesizing method of MIT cannot avoid the generation of CMIT and the mixture of MIT and CMIT is unwillingly used", and "it is difficult to obtain a single MIT, and the mixture of MIT and CMIT is not separated when used due to a high manufacturing cost" (Exhibit A46 which was filed in March, 2004). As of the filing date of the Invention (priority date), generally, summing up the facts such as the presumption that the above description is accepted, it is rationally understood that a person skilled in the art has recognized that MIT used in the Invention of Exhibit A1 naturally includes CMIT, and there is no possibility that a compound in which CMIT is removed therefrom with a high manufacturing cost is used.

Therefore, it cannot be approved that, though there is Examples consisting of MIT and BIT in Exhibit A1, the invention satisfying constituent features of "CMIT is not contained" is stated or disclosed from the statement of Examples.

(53)-4

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1 and 3.1.2
Classification of the Case	53: Whether or not the invention can be deemed to be an invention that was described in a distributed publication or an invention that was made publicly available through electric telecommunication lines
Keyword	Catalogue, Period of distribution of a catlogue

1. Bibliographic Items

Case	"Heat storage type floor heating system using midnight electric power in highly heat-insulating and highly airtight housing" (Trial for Invalidation) Intellectual Property High Court Decision, November 29, 2011 (2011 (Gyo KE) No. 10116)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2002-130323 (JP 2003-322351A)
Classification	F24D 11/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Second Division. Presiding judge Shuhei SHIOTSUKI, Judge Kenjiro FURUYA, Judge Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention provides a heat storage type floor heating system configured for supplying midnight electric power to a sheathed heater embedded in an underfloor concrete layer, causing the heater to generate a heat, and thereby performing heat storage in this concrete layer; and heating the entire housing space by virtue of the radiation heat of the floor surface and the convection heating of the warmed air by warming a floor surface by radiating the heat during the day time and warming the air that circulates between the underfloor space and the indoor space via an air passage hole extending through the floor surface. The claimed invention thus provides a heat storage type floor heating system which can be installed easily with low initial and running costs through unitization.

(2) Outline of Invention Described in Distributed Publication (Findings of the Court Decision)

(i) Exhibit A1 (the Cited Invention): "technical document of the midnight electric power utilizing electric heat storage floor heating system"(with an indication stating that the content as of March 2001 is included in this

document) (created by Plaintiff)

"...The technical document of Exhibit A1 describes in detail the features of the above heat storage type heating system, its system configuration, components, drawings, installation procedures, and operation method. Further, the Hokkaido Jutaku Shimbun News dated February 5, 2002 (Exhibit A2) describes that examples of applications of the heat storage type heating system sold, etc. by Plaintiff abound in the Tohoku Region and that Plaintiff was inviting sales agents for the above heat storage type heating systems sold, etc. by Plaintiff " (Extracts taken from the court decision)

(3) The Claims (Only claim 1 is cited therefrom.) (the Invention 1)

[Claim 1] A heat storage type floor heating system characterized by the fact that: a continuous footing part in a highly insulating and highly airtight housing with the heat loss coefficient of 1.0 to 2.5 kcal/m^2·h·°C is blocked from the influence of the outside air temperature using a heat insulation material to ensure sufficient airtightness; a moisture-proof sheet, a heat insulation material, and a concrete layer which is a heat storage layer are stacked upon the ground surface in the continuous footing part; in the heat storage layer, a heat emitting body supplying midnight electric power and storing the heat in the heat storage layer forms an embedded heating apparatus; the inner space of the housing is warmed by radiation from the heat storage layer; the continuous footing part and a base are secured to each other via an airtight packing to increase the airtightness; a concrete embedded sheathed heater unit is constituted by a plurality of heater sections connected in parallel or in series by a lead wire in a unitized manner, the heater sections being constructed by placing a ferrochrome wire in a stainless steel pipe, filling the space between the stainless steel pipe and the ferrochrome wire with a magnesium oxide, and coating the outer portion of the stainless steel pipe with a polypropylene tube, and the lead wire being constructed by coating a copper wire with heat- resistant vinyl; the concrete embedded sheathed heater unit is embedded in the concrete layer by one round of concrete placing after being placed and fixed on a metallic bar arranged at the time of bar arrangement; the sheathed heater is configured to be controlled by detection by a temperature sensor in units of blocks constituted by one unit or a plurality of units; and at a predetermined position of the floor surface, there is formed a slit adapted to be opened and closed, which is an air passage hole extending from the indoor space to the underfloor space such that twenty-four-hour low-temperature heating of the living space is achieved by the temperature of the floor surface raised by virtue of the radiation of the stored heat, the secondary radiation heat from the temperature-raised floor surface, and the natural convection of the temperature-raised air in the underfloor space into the indoor space via the slit.

(4) Procedural History

May 2, 2002	:	Filing of a patent application by Plaintiff (Patentee)
May 14, 2004	:	Registration of establishment of the patent right (See the above-described "The Claims.")
April 28, 2010	:	Filing of a request for a trial for patent invalidation by Defendant (Muko No. 2010-800081)
March 3, 2011	:	Trial Decision invalidating the patent

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">The Invention 1 ...is an invention described in Exhibit A1.
Exhibit A1 is a technical document created by Plaintiff. In view of its content, it is recognized that the document was distributed to sales agents or the like in a manner that does not invoke confidentiality obligations. Although the date of distribution is not identified, it is described in Exhibit A1 that "the content of this technical document is that as of March 2001." Also, there exist more than one brochure of Plaintiff that includes explanations of the underfloor sill heat storage technique, and these brochures each include a statement that the content is that as of December 2000 (Exhibit A3), November 2001 (Exhibit A17), and September 2002 (Exhibit A18), respectively. In view of these facts and in light of the fact that brochures are frequently updated and the reference period of the contents is also updated in response to the frequent updating, it is presumed that Exhibit A1 was also delivered around March 2001 in correspondence to the above description. Also, in view of the fact that the Hokkaido Jutaku Shimbun News issued on February 5, 2002 (Exhibit A2) states that Plaintiff had been inviting sales agents for selling components associated with the heat storage type floor heating systems including the "underfloor sill heat storage technique" and that the heat storage type heating systems were actually sold, and the fact that there are brochures having the indications "as of December 2000" (Exhibit A3) and "as of November 2001" (Exhibit A17), respectively, as stated above, and considering the fact that such a brochure of a product is used for sales of the product, it is recognized that Plaintiff had examples of actual applications and the like of the heat storage type heating system as of February 2002. If it is so, there is no reason to refrain from distributing the technical document of Exhibit A1 necessary for installation of the system. Accordingly, it is recognized that Exhibit A1 was distributed prior to filing of the Patent Application.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The Trial Decision found that Exhibit A1 had been distributed prior to filing of the Patent Application.
However, as can be appreciated from Exhibit A41 to Exhibit A49 (statements of delivery of technical documents, written statement of the printing company that printed the technical documents, the written statements of the representative of Plaintiff, etc.), Exhibit A1 was distributed on or after the filing date of the Patent Application. Consequently, the Trial Decision made an erroneous finding associated therewith.</td><td>Allegations by Defendant
Plaintiff alleges that "it is clear from Exhibit A41 to Exhibit A49" without specifically rebutting the determinations of the Trial Decision.
However, the Trial Decision, which reflects the careful examination of the evidences submitted by Defendant as well as the contents of descriptions of Exhibit A41 to Exhibit A49 submitted by Plaintiff at the stage of trial proceedings, provided specific reasons and determined that the period of distribution of Exhibit A1 had been prior to filing of the Patent Application, and found that the appeal board could not rely on Exhibit A41 to Exhibit A49 whose descriptions are unnatural. As such, the trial decision in no way erred in its finding and determination.</td></tr>
</table>

Judgment by the Court

(1) ...it is noted that Plaintiff is a company whose business is related to sales, etc. of heat storage type electric floor heating systems that utilize midnight electric power. As documents created by Plaintiff with regard to the above-identified heat storage type heating system, the technical documents (Exhibit A1 and Exhibit A29) and brochures (Exhibit A3, Exhibit A10, Exhibit A17, and Exhibit A18) are available. At the end of each of these materials, the following indications indicate that the contents of these materials are those as of December 2000 (Exhibit A3), March 2001 (Exhibit A1), November 2001 (Exhibit A17), May 2002 (Exhibit A29), September 2002 (Exhibit A18), and July 2006 (Exhibit A10), respectively. Also, the technical document of Exhibit A1 describes in detail the features of the above heat storage type heating system, its system configuration, components, drawings, installation procedures, and operation method. Further, the Hokkaido Jutaku Shimbun News dated February 5, 2002 (Exhibit A2) describes that examples of actual applications of the heat storage type heating system sold, etc. by Plaintiff abound in the Tohoku Region and that Plaintiff had been inviting sales agents.

(2) As stated in the foregoing section (1), with regard to the above heat storage type heating system, in view of the fact that there exist a number of technical documents and brochures which differ from each other in their reference dates associated with the content of descriptions, and that distinct reference dates are used even when they only differ from each other by several months, it is recognized that these technical documents and brochures were updated as required in response to changes made in their contents and were created in a period corresponding to or adjacent to the period described as the reference dates of these technical documents and brochures.

In addition, it is found that the technical document of Exhibit A1, in light of its content, is a technical document necessary for installation of the above heat storage type heating system and to be distributed to many and unspecified users and/or construction contractors at the time of selling of the system. ...it is found that Plaintiff realized a number of actual installations of the heat storage type heating system by February 2002. As such, it is reasonable to recognize that the technical document of Exhibit A1 was also distributed around March 2001 or February 2002 at the latest.

Accordingly, the findings of the Trial Decision regarding the period of distribution of Exhibit A1 is not erroneous.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1 and 3.1.2
Classification of the Case	53: Whether or not the invention can be deemed to be an invention that was described in a distributed publication or an invention that was made publicly available through electric telecommunication lines
Keyword	

1. Bibliographic Items

Case	"Utilization of carbazole compound for treatment of congestive heart failure" (Trial for Invalidation) Intellectual Property High Court Decision, October 16, 2013 (2012 (Gyo KE) No. 10419)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-523982 (JP H10-513463A)
Classification	A61K 31/404
Conclusion	Acceptance
Related Provision	Article 29(1)(iii)
Judges	IP High Court Third Division, Presiding judge: Ryuichi SHITARA, Judge: Rika NISHI, Judge: Masaya TANAKA

2. Overview of the Case

(1) Overview of the Invention of This Case (Identification of the Decision)

"... Heart failure is a cardiac disorder with high mortality, and a drug to reduce mortality caused by heart failure is said to be desired. However, in general, β-blockers are said to be contraindicated for patients with heart failure because they lower the cardiac function. It is understood that, in a recent study, the administration of a β-blocker, metoprolol or bisoprolol, did not show improved mortality compared with the administration of a placebo, whereas the administration of carvedilol, one of the β-blockers, to patients with heart failure was found to reduce the mortality of the patients by 67% compared with the administration of a placebo. It is also understood that the invention of this case 1 is an invention related to a drug, wherein the active ingredient(s) of the drug is carvedilol alone or combined with one or more therapeutics selected from a group consisting of angiotensin-converting enzyme inhibitors, diuretics and cardiotonic glycosides; and the drug is used to substantially reduce mortality caused by ischemic congestive heart failure in mammals receiving background therapy with a diuretic, angiotensin-converting enzyme inhibitor and/or digoxin in a similar manner in terms of symptoms of Class II to IV, and the drug is administered for 6 months or longer after a challenge period with a low dose of carvedilol." (Cited from the court

decision)

(2) Overview of the Invention Described in the Publication

(i) Description of Document of Exhibit A1: Journal of Cardiovascular Pharmacology, Vol. 19, Addendum 1: pp. S62-S67 (1992), "Can intravenous β-blockade predict long-term hemodynamic benefit in chronic congestive heart failure secondary to ischemic heart disease? " Prabir DasGupta, et al.)

"Carvedilol is a new non-selective β-adrenergic receptor antagonist having an additional α-blocking (i.e., vasodilating) action (13, 14). ...we planned this preliminary general study to evaluate the efficacy of carvedilol on chronic heart failure secondary to ischemic heart disease, and to determine whether the efficacy of long-term administration is effectively predicted or not by the response to the "initial dose" via the intravenous (i.v.) administration of carvedilol"

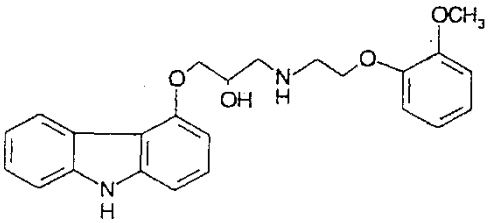
"...the study group consists of 17 patients (11 males and 6 females; 68 years old in average, between 50 to 78 years old)."

"Of 17 patients, 12 completed the long-term administration of 8 weeks. Two patients developed orthostatic hypotension after the first administration. Symptoms of heart failure worsened in a patient. One patient developed unstable angina. At the initial stage of the study, another patient sustained MI and then died."

"After the 8-week therapy with oral administration of carvedilol, hemodynamic measurements were repeated. ...in contrast to acute reaction to the intravenous administration, remarkable improvements are noted in many hemodynamic parameters after the long-term therapy with carvedilol. Significant decrease was noted in average systolic blood pressure, heart rate, pulmonary artery wedge pressure, right atrial pressure, and systemic vascular resistance, and improvement in the symptoms accompanied in 11 of 12 patients. No change in cardiac index was noted, but significant increase in average stroke volume index was noted after 8 weeks. Similarly, left ventricular ejection fraction significantly increased from the baseline after the long-term therapy. However, only small temporary increase was recorded after the intravenous administration of carvedilol."(Cited from the court decision)

(3) The Claims (after Correction of This Case) (Only Claim 1 Described) (the Invention 1 of This Case)

[Claim 1] Use of carvedilol for manufacturing a drug to administer for 6 months or longer after a challenge period with a low dose of carvedilol, wherein carvedilol is a β-adrenergic receptor antagonist as well as α_1-adrenergic receptor antagonist, has a structure below, and is used alone or combined with one or more additional therapeutics, said therapeutics being selected from a group consisting of angiotensin-converting enzyme inhibitors, diuretics and cardiotonic glycosides, wherein the drug substantially reduces mortality caused by ischemic congestive heart failure in mammals receiving background therapy with a diuretic, angiotensin-converting enzyme inhibitor and/or digoxin in a similar manner in terms of symptoms of Class II to IV.



(4) Procedural History

February 7, 1996	:	the patent application by the defendant (the date from which priority is claimed: February 8, 1995, in Germany)
April 16, 2004	:	the registration of establishment of the patent right
September 13, 2007	:	the request of the trial for patent invalidation by the plaintiff (Muko No. 2007-800192)
March 4, 2009	:	the first appeal decision that the patent of this case is invalid
April 13, 2009	:	the presentation by the defendant of the action to reverse appeal decision, the request of the trial for correction
June 8, 2009	:	the decision to reverse the first appeal decision
March 29, 2010	:	admission of the correction, the second appeal decision that the patent of this case is invalid
May 6, 2010	:	the presentation by the defendant of the action to reverse appeal decision for the above second appeal decision
June 2, 2010	:	the request of the trial for correction by the defendant (Teisei No. 2010-390052)
December 15, 2010	:	the third appeal decision that the request of the trial for correction does not materialize
January 20, 2011	:	the presentation by the defendant of the action to reverse appeal decision for the above third appeal decision
November 30, 2011	:	the court decision to reverse the above third appeal decision
January 19, 2012	:	the fourth appeal decision to approve the correction (the correction of this case) (see "The Claims" above)
March 6, 2012	:	the court decision to reverse the above second appeal decision
October 31, 2012	:	the appeal decision of this case that "the request of trial of this case is dismissed"

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

Appeal Decision (cited from the Court Decision) **hereinafter, the italicized letters are addition to the cited parts.*
C The invention of this case is not identical to the invention stated in the literature (A) below (hereinafter, the "Invention Exhibit A1") ..., and also was not easily invented based on Invention Exhibit A1 or Invention Exhibit A2. (A) ... Exhibit A1. ... is called the "Document of Exhibit A1". ...*(see "Overview of the Invention Described in the Publication" above)*

Decision

Allegations by Plaintiff

The appeal decision determined that it could not be said that "based on the purpose of the study in Exhibit A1, there were circumstances to interpret as the administration being expected to continue further after 8 weeks passed, for example, for 6 months or longer"....

However, as of the priority date of the invention of this case, in the clinical setting of congestive heart failure, it was a well-known fact that the long-term administration of a β-blocker such as metoprolol was provided ..., and it was believed that the long-term, for example, several months or longer, administration was necessary for the development of a long-term effect.... Because the purposes of the treatment of congestive heart failure were improved quality of life, ...and improved survival rates, ..., it was evident that the long-term administration of the drug was essential as a therapeutic approach. Moreover, because, before the priority date of the invention of this case, a clinical study to observe the improvement of mortality by the long-term administration of carvedilol to patients with heart failure was in progress ..., the "long-term administration" of carvedilol described in Document of Exhibit A1 can be understood to obviously include the length of the administration of the drug of 6 months or so.

Therefore, the above decision of the appeal decision is wrong.

Allegations by Defendant

(1) about Document of Exhibit A1

What is stated in Document of Exhibit A1 is a study with quite a limited number of cases of "17 patients with chronic heart failure caused by ischemic heart disease" for the purpose of investigation of improvement of symptoms and in addition, of which five patients dropped out of the study. Moreover, in the study described in Document of Exhibit A1, the comparison with patients receiving a placebo was not provided and it is impossible to objectively verify that the improved outcomes of 12 cases were due to the treatment or natural course. Further, a serious error that carvedilol, similar to other β-blockers, causes up-regulation is involved in Invention Exhibit A1. Thus, the credibility of the description in Document of Exhibit A1 is low, of which a medical specialist in heart failure is also aware, "judgment of improved prognostic effect by the long-term administration in ischemic heart disease based on the data with low credibility such as those in the Exhibit A1 paper being obviously avoided" ....

Therefore, Document of Exhibit A1 is of extremely low significance as a document to support the effect of carvedilol, and also Document of Exhibit A1 is not said to disclosure the invention to use carvedilol for treatment of ischemic congestive heart failure as a completed use invention.

Judgment by the Court

A About Document of Exhibit A1

...in order to say that the medicinal invention is disclosed in a document, a pharmacological study stated in the aforementioned document is required to be a study to reasonably infer that the chemical substance as an active ingredientof the drug has a medical use of interest, but not to be a large randomized clinical study as required for drug approval.

...in Document of Exhibit A1, for various hemodynamic parameters in each patient, the baseline values at

the start of the study and the values after 8 weeks passed were compared and evaluated as "remarkable improvements are noted in many hemodynamic parameters". In addition, in Tables 1 and 2 and FIG. 2, values of various hemodynamic parameters and the changes thereof are shown, and there is not enough evidence to demonstrate that these values are erroneous. Thus, from the study described in Document of Exhibit A1, it can be reasonably inferred that carvedilol is used for treatment of ischemic congestive heart failure, and therefore, it can be said that Document of Exhibit A1 discloses the invention as a completed use invention in which carvedilol is used for treatment of ischemic congestive heart failure, and also Document of Exhibit A1 has significance as a document to support the effect of carvedilol.

The study stated in Document of Exhibit A1 has a limited number of cases of 17 patients, of which five patients dropped out of the study, which does not affect the judgment above. Moreover, absence of comparison with a placebo does not affect the judgment above, either, unless the evidence is demonstrated that the common general knowledge exists that, in the patients with heart failure or medical history thereof similar to those who participated in the study described in Document of Exhibit A1, improved hemodynamic parameters shown in Document of Exhibit A1 occur without the administration of carvedilol.

The indication by the defendant that a ...error is involved in Document of Exhibit A1 is understood as the inaccurate description of ...in "Discussion" of Document of Exhibit A1. This describes the reasons for the experimental data shown in Document of Exhibit A1, but not the experimental data themselves, and there is no sufficient evidence to admit that there is inaccurate description of the experimental data themselves. Therefore, even if there is an error in Document of Exhibit A1 as indicated by the defendant, it cannot be said that Document of Exhibit A1 does not have significance as a document to support the effect of carvedilol.

There is no other evidence sufficient to admit the low credibility of the description of Document of Exhibit A1, and therefore, the above allegation by the defendant is not reasonable.

(54)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1(1)b
Classification of the Case	54: Whether or not the invention that was described or posted in a distributed publication as a cited invention (for invention of product, whether or not it is described or posted so that it can be manufactured, and, for invention of method, whether or not it is described so that it can be used)
Keyword	

1. Bibliographic Items

Case	"Photo-curable resin composition" (Trial for Invalidation) Intellectual Property High Court Decision, Sep. 14, 2006 (2005 (Gyo KE) No. 10553)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-19510 (JP 2002-220551A)
Classification	G03F 7/004
Conclusion	Dismissal
Related Provision	Article 29(2), Article 123(1)(ii)
Judges	IP High Court First Division: Katsumi SHINOHARA, presiding judge, Mitsuru SHISHIDO, judge, Yoshiaki SHIBATA, judge

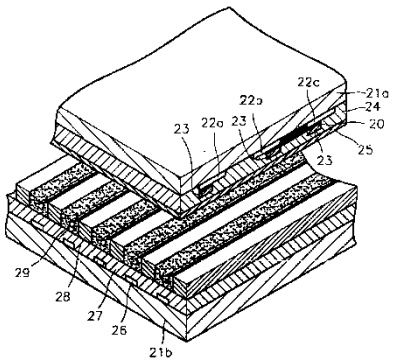
2. Overview of the Case

(1) Summary of Claimed Invention

In order to solve a problem of such as, in a conventional composition for a black layer used for a bus electrode of a black and white two-layer structure formed on a front face of a glass substrate of a plasma display panel (PDP), sufficient blackness for contrast enhancement of a screen cannot be obtained because it tarnishes in a reddish manner on the occasion of burning, the claimed invention makes, as a black layer composition in question, a composition contain (A) a black fine particle of tricobalt tetroxide (Co_3O_4), (B) an organic binder, (C) a photo-polymerizable monomer and (D) a photopolymerization initiator, and, by this, provides a photo-curable resin composition that can solve such issues of such as enabling to obtain sufficient blackness even after burning.

(2) Summary of the cited invention (the citation 1) (JP 2000-251744A)

[FIG. 1]



There is being disclosed a technical matter that a black matrix layer 20 disclosed in the citation 1 is formed of an insulation property material in which oxidative products and black pigments are mixed with a glass powder, and a black matrix layer 20 formed between a scanning electrode 22b and a common electrode 22c between which sustained discharge occurs makes the both be insulated from each other, whereas, in the black matrix layer 20 formed between the scanning and common electrodes 22b, 22c and a bus electrode 23, electrification becomes possible regardless of being an insulation property material. In particular, as a reason that the black matrix layer 20 that is an insulation property material becomes possible to be electrified, description that "because the thickness of the black matrix layer 20 is thin, conducting particles contained in said common and scanning electrodes 22a and 22b are diffused to said black matrix layer 20 by heat diffusion during heat treatment, and electrification becomes possible between said common and scanning electrodes 22a, 2b and said bus electrode 23." has been made.

(3) The Claims (only claim 1 is stated)

[Claim 1] A photo-curable resin composition containing a black layer composition used for a bus electrode of a black and white two-layer structure, and not containing conductive fine particles, said black layer composition containing: (A) a tricobalt tetroxide (Co_3O_4) black fine particle; (B) an organic binder; (C) a photo-polymerizable monomer; and (D) a photopolymerization initiator.

(4) Procedural History

Mar. 26, 2004	:	Registration for patent right establishment (refer to the above-mentioned "The Claims")
Sep. 3, 2004	:	Demand for trial for patent invalidation by the defendant (Muko No. 2004-80141)
May 24, 2005	:	The appeal decision that says that "...the patent in question is invalidated."

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

Appeal Decision (cited from the Court Decision)
...In the appeal decision, there is stated that, ...in [0024] of ...the citation 1, "because the thickness of the black matrix layer 20 is thin, conducting particles contained in said common and scanning electrodes 22a and 22b are diffused to said black matrix layer 20 by heat diffusion during heat treatment, and electrification becomes possible between said common and scanning electrodes 22a, 22b and said bus electrode 23.". For this reason, it is considered that, among the portions of the black matrix layer 20, a portion located between the common and scanning electrodes 22a, 22b and the bus electrode 23 becomes a portion having conductivity, and it constitutes a part of the electrification path. Therefore, in this constitution, the bus electrode to compensate for conductivity of the common and scanning electrodes 22a, 2b is constituted of the black matrix layer 20 in the above-mentioned portion and the bus electrode 23 laminated on this, substantially. In other words, it can be

said that, among portions of the black matrix layer 20, a portion located between the common and scanning electrodes 22a, 22b and the bus electrode 23 constitutes the black layer of the bus electrode of the two-layer structure substantially. ...

Decision

Allegations by Plaintiff

...While "a conducting particle contained in the common and scanning electrodes 22a, 22b" of paragraph [0024] is understood as meaning a conducting particle contained in an ITO (indium tin oxide) film (hereinafter, "ITO film"...), it is still unclear about what is this conducting particle, and therefore, it is totally unclear whether a conducting particle in such ITO film diffuses to the black matrix layer 20 by heat treatment or not, as long as the material of the black matrix layer 20 is not specified. Furthermore, in the citation 1, nothing has been shown about a method to make a conducting particle in an ITO film diffuse to a black matrix layer by heat diffusion.

Accordingly, because the citation 1 includes a part that is not stated in a manner being feasible for a person skilled in the art about how to secure conductivity while using an insulation property material (the black matrix layer 20), a person skilled in the art cannot figure out the cited invention 1 as a technical idea.

...Although, in the citation 1, there is stated that "an insulation property material in which oxidative products and black pigments are mixed with glass powder becomes to be capable of being electrified by applying heating process", and that "the reason of becoming capable of being electrified is that a conducting particle of an ITO film constituting common and scanning electrodes is due to heat diffusion", all of the above-mentioned statement matters would be unthinkable in the common general knowledge of a person skilled in the art at the time of

Allegations by Defendant

In the citation 1, there is stated that: the black matrix layer 20 is formed of an insulation property material made by combining oxidative products and black pigments with glass powder, and of a material of photosensitivity; the black matrix layer 20 is provided between the common and scanning electrodes 22a, 22b and the bus electrode 23 with a thin thickness dimension; and, when heating process is applied on the occasion of providing the black matrix layer 20, electrification becomes possible between the common and scanning electrodes 22a, 22b and the bus electrode 23. Accordingly, in the cited invention 1, both the technological constitution that an insulation property material including black pigments for constituting the black matrix layer 20 is provided between the common and scanning electrodes 22a, 22b and the bus electrode 23 with a thin thickness dimension by applying heating process, and a working-effect that, by employing such constitution, electrification between the common and scanning electrodes 22a, 22b and the bus electrode 23 becomes possible are obvious. Therefore, a person skilled in the art can obtain a desired effect by iteratively implementing the invention, and, thus, the cited invention 1 is completed as invention.

application of the application in question, that is, these are matters that cannot be understood as a technical idea that uses the law of nature. Therefore, it cannot be said that the cited invention 1 is completed as invention. ...	

Judgment by the Court

About the statement of heat diffusion in question, what is a conducting particle contained in the common and scanning electrodes 22a, 22b, and whether the conducting particle in such ITO film diffuses to the black matrix layer 20 by heat treatment or not are problems of a theoretical proof as why the electrification technology in question arises, and, thus, it is not a case that, if this is not clarified, the electrification technology in question cannot be implemented.

...The feasibility of the electrification technology in question is proofed, along with problem points and technological issues of the prior art, by the above-mentioned specific constitution and a manufacturing method of the constitution in question, and the problem of theorizing the electrification technology in question that "electrification becomes possible", that is, about statement of heat diffusion in question, what is a conducting particle contained in the common and scanning electrodes 22a, 22b, and whether a conducting particle in such ITO film diffuses to the black matrix layer 20 by heat treatment or not do not have direct relation with the problem of feasibility of the electrification technology in question.

...Because the electrification technology in question of the citation 1 is proofed by the above-mentioned specific constitution and a manufacturing method of the constitution in question along with problem points and technological issues of the prior art, and there is no particular situation to make its implementation difficult, it is obvious that it is constituted as a technology that is specific and objective to a degree that a person skilled in the art can achieve a desired technological effect by implementing it repeatedly. As a consequence, it cannot be said that the cited invention 1 has not completed as invention. Furthermore, even if, among persons skilled in the art who have come into contact with the above-mentioned statement of the citation 1, there is a person who thinks that all of the statement matters in question would be unthinkable in the common general knowledge of a person skilled in the art at the time of the application in question, that is, these are matters that cannot be understood as a technical idea that uses the law of nature, it does not always remain within the range of the prior common general knowledge necessarily as long as it is being disclosed as a feasible invention as mentioned above. Therefore, that does not govern the above-mentioned conclusion.

Accordingly, the above-mentioned affirmation of the plaintiff that says that the cited invention 1 cannot be said as a completed invention on the basis of the common general knowledge of a person skilled in the art at the time of the application in question cannot be also adopted.

(54)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1(1)b
Classification of the Case	54: Whether or not the invention that was described or posted in a distributed publication as a cited invention (for invention of product, whether or not it is described or posted so that it can be manufactured, and, for invention of method, whether or not it is described so that it can be used(52-1
Keyword	

1. Bibliographic Items

Case	"Fuel oil for gasoline engines" (Trial for Invalidation) Intellectual Property High Court Decision, December 26, 2007 (2006 (Gyo KE) No. 10316)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H6-294153 (JP H7-207285A)
Classification	C10L 1/04
Conclusion	Dismissal
Related Provision	Article 29(1)(iii), Article 123(1)(ii)
Judges	IP High Court Third Division, Presiding judge: Ryouichi MIMURA, Judge: Kazuhide SHIMAZUE, Judge: Hiroyuki UEDA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a fuel oil for gasoline engines having superior operability, and low emission, unleaded high octane numbers, wherein the fuel oil for gasoline engines has certain distillation characteristics, the Research Octane Number of each of the fractions being 70 or higher, and the autoexhaust index expressed by a certain equation, the benzene content and the sulfur content being of less than a certain value, and the Research Octane Numbers being in the range of from 89 to 92.

(2) State of the Art

In the citation that is the publication (1) distributed before the priority date of the patent of this case, the regular gasolines marked with "1-1R" or "1-5R," respectively, are disclosed, and the invention of the "1-1R gasoline" described in the citation (hereinafter, "the cited invention") relates to a fuel oil for gasoline engines having certain distillation characteristics, the certain octane numbers, the aromatic compound content and the benzene content in a certain ranges, and the Research Octane Numbers being within a certain range.

The "1-1R gasoline" of the cited invention was commercially available in Japan before the priority date of this case.

The values of distillation characteristics of the "1-1R gasoline" are approximately equal to the average values of the distillation test results of Japanese regular gasolines known before the priority date of this case, and the "1-1R gasoline" has the average characteristics of the regular gasolines commercially available before the priority date of this case in all of the benzene content, octane numbers, and hydrocarbon (aromatic and olefin) constitution.

(3) The Claims (after Correction) (the Invention of This Case)

[Claim 1] A fuel oil for gasoline engines characterized in that

(1) a fraction with the boiling point of no higher than 25°C accounts for from 3 to 10 volume %, a fraction with the boiling point of between 25°C or higher and no higher than 75°C accounts for from 35 to 50 volume %, a fraction with the boiling point of between 75°C or higher and no higher than 125°C accounts for from 25 to 40 volume %, a fraction with the boiling point of between 125°C or higher and no higher than 175°C accounts for from 10 to 30 volume %, and a fraction with the boiling point of 175°C or higher accounts for 5 volume % or less;

(2) the Research Octane Number of each of the above fractions is 70 or higher;

(3) an autoexhaust index Y expressed by the equation (I) is 5 or less

$$Y=1.07BZ+0.12TO+0.11EB+0.05XY+0.03C_9{}^{+}A+0.005\,[100-(BZ+TO+EB+XY+C_9{}^{+}A)] \quad ...(I)$$

[wherein BZ is the benzene content, TO is the toluene content, EB is the ethylbenzene content, XY is the xylene content, and C9+A is the content of aromatic compounds with 9 or more carbons (all are amounts in volume % contained in the fuel oil).];

(4) the benzene content is 1 volume % or less, the sulfur content is 40 ppm or less, and the oxygen-containing compound content is 0 volume %; and

(5) the Research Octane Numbers are from 89 to 92.

(4) Procedural History

November 29, 1994	:	the patent application by the plaintiff (the patentee) (the date from which priority is claimed: November 30, 1993)
February 23, 2001	:	the registration of establishment of the patent right
March 11, 2002	:	the request of correction by the plaintiff in the examination process of Igi No. 2001-72969 (see "The Claims" above)
March 10, 2005	:	the request of trial for patent invalidation by the defendant (Muko No. 2005-80074)
May 29, 2006	:	the appeal decision as "the patent is invalid"

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

Appeal Decision (cited from the Court Decision)

... The invention of this case could be easily invented by a person skilled in the art based on the invention described in the publication (1) below that was distributed before the priority date of the patent of this case (hereinafter, "the priority date of this case"), and therefore, the patent of the invention of this case is in violation of the regulation of Article 29(2) of the Patent Act, and should be invalid in accordance with Article 123(1)(ii) of the same Act. ...

(1) Kenji Ishihara, Tadataka Yamashita, "The Characteristics and Constitutions of Automobile Gasolines", Toyo University Engineering Department Study Reports, Volume 25, July 31, 1990, pp. 103 -114 (Exhibit A1, hereinafter, "the citation"; the regular gasolines marked with "1-1R" or "1-5R", respectively, in the citation are called "1-1R gasoline" and the like corresponding to the aforementioned marks.)

Decision

Allegations by Plaintiff	Allegations by Defendant
In general, for manufacturing a fuel oil for gasoline engines (hereinafter, merely a "gasoline"), multiple gasoline bases are combined. In the attempt to manufacture the gasoline with the aforementioned constitution solely based on the information on the component composition, numerous trials and errors are required to select gasoline bases and investigate their proportions in the combination. Thus, even when the information on the component composition is available, unless types of gasoline bases and their proportions in the combination are known, it is difficult for even a person skilled in the art to manufacture the gasoline having the aforementioned constitution. Although the component composition of the 1-1R gasoline of the cited invention is described in the citation, the manufacturing method thereof is not described therein, and therefore, even a person skilled in the art cannot manufacture it easily. Because it is difficult to manufacture the 1-1R gasoline, it is extremely difficult to devise the invention of this case by starting from the citation, and therefore, the cited invention should be inappropriate as the publicly known invention to deny the inventive step.	... The invention of this case is a gasoline, an invention of "product". Because the composition of the cited invention, which is a "product", is stated in the publication before the priority date of this case, said invention is the publicly known invention to deny the inventive step, namely, which is an appropriate "invention stated in a distributed publication" in accordance with Article 29(1)(iii) of the Patent Act. In addition, the citation states the gasolines already commercially available as of September 1989, i.e., before the priority date of this case, in terms of the component composition, etc., necessary for the study report. The 1-1R gasoline of the cited invention was one of the gasolines on the market, and therefore, having no description of the proportions of the gasoline bases in the combination, etc., in the citation, however, does not imply that the 1-1R gasoline cannot be manufactured, or is a fictitious gasoline or the like.

Judgment by the Court

...As for the publicly known inventions to deny the inventive step, the suitable interpretation of an invention pertinent to Article 29(1)(iii) of the same ACT is that in order to identify an invention as the "invention stated in the publication distributed" before the patent application in accordance with the Article 29(1)(iii), when a person skilled in the art sees the aforementioned publication up to the degree necessary for comparison with the contents of the patented invention, etc., specified by the description of the claims, it is necessary as well as sufficient to disclose the contents of the technical idea thereof to the extent that the technical idea can be practiced on the basis of the state of the art as of the patent application. For example, when the patented invention, etc., is an invention of "product," although as for the description of the publication that is compared with the patented invention, etc., it is necessary to disclose the composition of that "product" up to the degree necessary for comparison with the contents of the patented invention, etc., if a person skilled in the art can obtain or manufacture and use that "product" based on the description of the aforementioned publication and the common general knowledge as of the filing, it is not always necessary to disclose a specific method to manufacture that "product" in the aforementioned publication, and also if it is possible to obtain or manufacture and use, not the specific "product" itself stated in the aforementioned publication, but a "product" having the composition identical to that of the "product" up to the degree necessary for comparison with the contents of the patented invention, etc., it should be sufficient.

Moreover, when gasoline that satisfies the predetermined component compositon is manufactured, combining properly multiple gasoline bases and making adjustments thereto are conventional means (the description in the paragraph [0008] in the specification of this case is interpreted as presupposing this.). It is reasonable to conclude that the 1-1R gasoline was manufactured in a similar way.

... Aside from exactly reproducing the constitution of the components of the 1-1R gasoline described in the citation, it is suitable to recognize that a person skilled in the art could obtain or manufacture and use a gasoline having the composition identical to that of said 1-1R gasoline based on the description of the citation and the common general knowledge as of the priority date of this case up to the degree necessary for comparison with the contents of the patented invention specified by the description of the claims in the specification of this case.

(54)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1(1)b
Classification of the Case	54: Whether or not the invention that was described or posted in a distributed publication as a cited invention (for invention of product, whether or not it is described or posted so that it can be manufactured, and, for invention of method, whether or not it is described so that it can be used)
Keyword	

1. Bibliographic Items

Case	"Fuel oil for gasoline engine" (Trial for Invalidation) Intellectual Property High Court Decision, December 26, 2007 (2006 (Gyo KE) No. 10316)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H6-294153 (JP H7-207285A)
Classification	C10L 1/04
Conclusion	Dismissal
Related Provision	Article 29(1)(iii) and Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Ryoichi MIMURA, Judge: Kazuhide SHIMASUE, Judge: Hiroyuki UEDA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide a lead-free high-octane fuel oil for gasoline engine which is superior in the driving performance of automobile and low pollution, and wherein (1) a fraction having a boiling point of less than 25°C is 3 to 10 volume%, a fraction having a boiling point of 25°C or higher and less than 75°C is 35 to 50 volume%, a fraction having a boiling point of 75°C or higher and less than 125°C is 25 to 40 volume%, a fraction having a boiling point of 125°C or higher and less than 175°C is 10 to 30 volume% and a fraction having a boiling point of 175°C or higher is 5 volume% or lower, (2) the research method octane value for the aforementioned each fraction is 70 or more, (3) an exhaust gas index Y represented by a formula of $Y=1.07BZ+0.12TO+0.11EB+0.05XY+0.03C9+A+0.005\ [100-(BZ+TO+EB+XY+C9+A)]$ [BZ, TO, EB, XY, C9+A indicate contents of benzene, toluene, ethylbenzene, xylene, an aromatic group having 9 or more carbons] is 5 or lower, (4) the content of benzene is 1 volume% or lower, and the sulfur is 40 ppm or lower, and (5) the research method octane value is 89 to 92.

(2) Citation (cited invention): Kenji ISHIHARA and Tadataka YAMASHITa, "Property and composition of automobile gasoline", Research report, Faculty of Science and Engineering, Toyo University, Vol. 25, July 31, 1990, pages 103 to 114 (Identification of Trial Decision)

"A fuel oil for gasoline engine wherein
(1) a fraction having a boiling point less than 25°C is 6.7 to 6.8 volume%, a fraction having a boiling point of 25°C or higher and less than 75°C is 40.3 to 42.8 volume%, a fraction having a boiling point of 75°C or higher and less than 125°C is 30.5 to 33.2 volume%, a fraction having a boiling point of 125°C or higher and less than 175°C is 16.4 to 16.7 volume% and a fraction having a boiling point of 175°C or higher is 3.1 to 3.3 volume%,
(2) the research method octane value for the aforementioned each fraction is 76.5 or more,
(3) an exhaust gas index Y represented by a formula (I) of
Y=1.07BZ+0.12TO+0.11EB+0.05XY+0.03C9+A+0.005 [100-(BZ+TO+EB+XY+C9+A)] [BZ indicates content of benzene, TO indicates content of toluene, EB indicates content of ethylbenzene, XY indicates content of xylene, C9+A indicates content of an aromatic group having 9 or more carbons] is 5.2 to 5.3,
(4) the content of benzene is 2.51 to 2.54 volume%, and the research method octane value is 91.9."

(3) The Claims (Present invention)
[Claim 1]
A fuel oil for gasoline engine, wherein
(1) a fraction having a boiling point less than 25°C is 3 to 10 volume%, a fraction having a boiling point of 25°C or higher and less than 75°C is 35 to 50 volume%, a fraction having a boiling point of 75°C or higher and less than 125°C is 25 to 40 volume%, a fraction having a boiling point of 125°C or higher and less than 175°C is 10 to 30 volume% and a fraction having a boiling point of 175°C or higher is 5 volume% or lower, (2) the research method octane value for the aforementioned each fraction is 70 or more, (3) an exhaust gas index Y represented by a formula (I) of
Y=1.07BZ+0.12TO+0.11EB+0.05XY+0.03C9+A+0.005 [100-(BZ+TO+EB+XY+C9+A)] [BZ indicates content of benzene, TO indicates content of toluene, EB indicates content of ethylbenzene, XY indicates content of xylene, C9+A indicates content of an aromatic group having 9 or more carbons] is 5 or lower, (4) the content of benzene is 1 volume% or lower, and the sulfur is 40 ppm or lower, and (5) the research method octane value is 89 to 92.

(4) Procedural History

February 23, 2001	:	Registration to establish a patent right
	:	Opposition to the grant of a patent (Igi No.2001-72969)
March 11, 2002	:	Request for correction made by the Plaintiff (patentee) (see the aforementioned "The Claims")
May 22, 2002	:	Decision that "the correction is permitted. ... the patent according to Claim 1 is invalidated."
May 31, 2004	:	Court Decision that the Decision is invalidated (2002 (Gyo KE) No. 363).

June 30, 2004 : Decision that "the correction is permitted. ... the patent according to Claim 1 is maintained."

March 10, 2005 : Request of Trial for Invalidation by the Defendant (Muko No. 2005-80074)

May 29, 2006 : Trial Decision that "... the patent for the invention according to Claim 1 shall be invalidated."

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

<table>
<tr><td colspan="2">Trial Decision</td></tr>
<tr><td colspan="2">Since the present invention is easily conceivable for a person skilled in the art based on the inventions stated in Exhibit A1, Exhibit A3, Exhibit A9, Exhibit A12, Exhibit A15, Exhibit A16, Exhibit A19, Exhibit A20, Exhibit A28 and Exhibit A31, which are publication distributed prior to filing the present patent application in Japan or foreign countries, the present patent violates the provision of Article 29(2) of the Patent Law and constitutes Article 123(1)(ii) of the Law.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
While the Citation states the component composition of 1-1R gasoline according to the cited invention, does not state a method for producing the same, a person skilled in the art cannot easily produce the same. Since it is difficult to produce the 1-1R gasoline, it is extremely difficult to reach the present invention therefrom as the starting point. Accordingly, it should be said that the cited invention is not eligible for a publicly-known invention for denying the inventive step.</td><td>Allegations by Defendant
Since the present invention is an invention of "product" as a gasoline, and since the constituent of the cited invention as the "product" is stated in the publication prior to the priority date for the present case, the invention is enough to treat as a publicly-known invention for denying the inventive step, that is, as the "invention stated in the "Inventions that were described in a distributed publication" recited in Article 29(1)(iii) of the Patent Law.
In addition, the Citation is of stating the component composition and the like necessary for the research report, for the gasoline which has been already marketed at the time of September 1989 prior to the priority date for the present case, and the 1-1R gasoline according to the cited invention is one of the aforementioned marketed gasolines. Accordingly, even if the Citation does not state the composition ratio and the like of the gasoline base material, it shall not be that the 1-1R gasoline cannot be produced and that it is an ideal gasoline.</td></tr>
</table>

Judgment by the Court

1 Regarding eligibility for the cited invention as a publicly-known invention

The Plaintiff has asserted that the cited invention is not eligible for the publicly-known invention for denying the inventive step. However, the assertion made by the Plaintiff is unreasonable, as follows.

(1) The Article 29(2) of the Patent Law recites that "Where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.". In addition, it is said for the invention constituting Article 29(1)(iii) of the Patent Law among the publicly-known invention for denying the inventive step for the patented invention or the invention for which a patent is sought (hereinafter, referred to as a "patented invention and the like".), in order to determine it as the "inventions that were described in a distributed publication" prior to the filing of the patent application recited in (iii) of the same paragraph, it is necessary to disclose the content of the technical idea to a degree such that the technical idea can be practiced, within the limit necessary for comparing with the content of the patented invention and the like specified by the statement of the Claims when a person skilled in the art reads the publication based on the technical level at the time of the filing of the patent application, and it is reasonable to construe it to be enough. For example, where the patented invention and the like is an invention of "product", while it is necessary to disclose the constitution of the "product" within the limit necessary for comparing with the content of the patented invention and the like, as a statement of the publication which will be compared with the patented invention and the like, if a person skilled in the art can obtain or produce the "product" for use the same based on the statement of the publication and the technical general knowledge at the time of the filing of the patent application, it is not necessary to disclose a specific method for producing the "product" in the publication. In addition, it should be said to be enough if it is possible to be available for or produce a "product" for use the same which is identical in its constitution with the "product" within the limit necessary for comparing with the content of the patented invention and the like, it is not necessary the specific "product" itself stated in the publication.

(2) It will be examined, from the aforementioned viewpoint, for the assertion made by the Plaintiff that while the Citation states the component composition of the 1-1R gasoline according to the cited invention, since the Citation does not state a method for producing the same, it is difficult to produce the 1-1R gasoline.

A According to the evidences (Exhibits A1 and A16, and Exhibits B1, B5, B7, B16 and B17) and the entire import of the oral argument, it can be recognized that: [1] the 1-1R gasoline according to the cited invention is a gasoline which has been marketed in Japan at the time of September 1989 which is prior to the priority date for the present case (Exhibit A1); [2] the evaporation property of the 1-1R gasoline is almost the same as the average value in the result of the evaporation test for the Japanese regular gasoline (JIS 2 level gasoline) which has been known at the time of 1982, prior to the priority date for the present case, and has the average property of the marketed regular gasoline (prior to 1991 containing MTBE) prior to the priority date for the present case, regarding any of the benzene content, the octane value and the composition of hydrocarbon (aromatic group and olefin) (Exhibit A1 and Exhibits B1, B5, B7, B16 and B17); [3] At the time of August 1992, which is prior

to the priority date for the present case, in Japan, it is considered that the mixed ratio of the main gasoline base materials are 0 to 5% in butane, 10 to 15% in light naphtha and isomerized gasoline, 30 to 60% in reformate, 20 to 50% in FCC gasoline, 0 to 10% in alkylate, and 0 to 5% in MTBE (methyl tertiary butyl ether), and it is recognized that reformate, FCC gasoline and light naphtha are the main gasoline base materials (Exhibit A16); and [4] it is recognized that the property (calculated value) of the gasoline (gasoline c), in which reformate (base material A stated in the description for the present case), FCC gasoline (base material C stated in the same as above) and light naphtha (base material stated in Exhibit B3) are mixed such that FCC gasoline and light naphtha are the maximum within the range of the mixing ratio stated in Exhibit A16, is almost the same as the 1-1R gasoline, and that it only differs from the present invention in the benzene content and the Y value.

In addition, when the gasoline satisfying the predetermined component composition is produced, it is the conventional means that a plurality of gasoline base materials is appropriately mixed and adjusted (it is construed that paragraph [0008] in the description for the present case is stated based thereon.), and it is reasonable to recognize that it is obvious for a person skilled in the art that the 1-1R gasoline is also produced by the same method.

B According to the aforementioned A, whether or not the component composition of the 1-1R gasoline stated in the Citation is strictly reproduced, it is reasonable, for the gasoline identical in its constituent with the aforementioned 1-1R gasoline within the limit necessary for comparing with the content of the present invention specified by the statement of the Claims in the description for the present case, to recognize that a person skilled in the art was able to obtain or produce for use the same based on the statement of the Citation and the technical general knowledge at the time of the priority date for the present case.

(3) Therefore, there is no error in the trial decision that the cited invention is compared with the present invention as the publicly-known invention recited in Article 29(1)(iii) of the Patent Law for determining whether the present invention has the inventive step or not. The assertion made by the Plaintiff cannot be accepted.

(54)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.1(1)b
Classification of the Case	54: Whether or not the invention that was described or posted in a distributed publication as a cited invention (for invention of product, whether or not it is described or posted so that it can be manufactured, and, for invention of method, whether or not it is described so that it can be used)
Keyword	

1. Bibliographic Items

Case	"Pprocess for preparation of 4-amino-1-hydroxybutylidene-1,1-bisphosphonic acid and its salt" (Trial for invalidation) Intellectual Property High Court Decision, August 19, 2010 (2009 (Gyo KE) No. 10180)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H2-152494 (JP H3-101684A)
Classification	C07F 9/38
Conclusion	Acceptance
Related Provision	Article 29(2) and Article 123(1)(ii)
Judges	IP High Court First Division: Presiding judge: Tomokazu TSUKAHARA, Judge: Yasushi SHOJI, Judge: Toshiya YAGUCHI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to a solid state pharmaceutical composition for the treatment or prevention of diseases involving bone resorption, comprising 4-amino-1-hydroxybutylidene-1,1-bisphosphonic acid monosodium salt trihydrate as an active ingredient.

(2) Summary of the cited invention

(i) Document of Exhibit A7 (Invention of Exhibit A7): Page 106 of the Abstract distributed at 3rd International Symposium of Drug Analysis held in Antwerp, Belgium (Identification of the Trial Decision)

""A pharmaceutical preparation comprising bone absorption inhibitor 4-amino-1-hydroxybutane-1,1-diphosphonic acid monosodium salt trihydrate as an active ingredient""

"It is also obvious that "4-amino-1-hydroxybutane-1,1-diphosphonic acid monosodium salt trihydrate" in Invention of Exhibit A7 is the same compound of "4-amino-1-hydroxybutylidene-1,1-bisphosphonic acid monosodium salt

trihydrate" in the Present Inventions 6 and 7, with different expression." (cited from the Court Decision)

(3) The Claims ("Present Invention 6" and "Present Invention 7" in this order)

[Claim 6] A solid state pharmaceutical composition for the treatment or prevention of diseases involving bone resorption, comprising 4-amino-1-hydroxybutylidene-1,1-bisphosphonic acid monosodium salt trihydrate as an active ingredient.

[Claim 7] The solid state pharmaceutical composition of claim 6, the composition is a tablet.

(4) Procedural History

June 11, 1990	:	Japanese Patent Application filed by the Plaintiff (Patentee) (Priority date: June 9, 1989, USA)
January 27, 1995	:	Registration of establishment of the patent right (See "The Claims" as mentioned above)
April 8, 2008	:	Request for Trial for patent invalidation made by the Defendant (Muko No. 2008-800062)
February 25, 2009	:	Trial Decision that the Present Inventions 6 and 7 are invalid

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">...Since the Present Inventions 6 and 7 could be easily conceivable for a person skilled in the art based on Invention of Exhibit A7, the patent has granted by violating the provision of Article 29(2) of the Patent Act.
(1) Content of Invention of Exhibit A7
...Since Document of Exhibit A7 states that trihydrate of 4-amino-1-hydroxybutana-1,1-diphosphonic acid monosodium salt is present, it is natural to consider for a person skilled in the art that 4-amino-1-hydroxybutane-1,1-diphosphonic acid monosodium salt is crystallized from its solution to obtain its trihydrate, and that if the hydration number of 4-amino-1-hydrocybutane-1,1-diphosphonic acid monosodium salt obtained from the crystallization of the solution exceeds 3, its trihydrate can be easily obtained by decreasing the hydration number with heating and drying it upon appropriately selecting its conditions.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
1 Reason 1 for Cancellation (error in interpretation of provision and application of provision)
(1) Document of Exhibit A7 only discloses a constitution of a new chemical substance "4-amino-1-hydroxybutylidene-1,1-bisphosphonic acid monosodium salt trihydrate", there is no description to</td><td>Allegations by Defendant
1 Response to the Reason 1 for Cancellation (error in interpretation of provision and application of provision)
...since the description of Document of Exhibit A7 is a description to an extent in which a method for manufacturing its new substance can be understood based on the logical determination of the description of</td></tr>
</table>

an extent in which a method for manufacturing the same can be understood, and the method for manufacturing the same cannot be found in the common general knowledge and the like at the time of the priority date for the present patent. So, it cannot be said that Document of Exhibit A7 states an invention "a pharmaceutical preparation comprising bone absorption inhibitor 4-amino-1-hydroxybutylidene-1,1-diphosphonic acid monosodium salt trihydrate as an active ingredient."	Exhibit A5 to Exhibit A8, Exhibit A10, and Exhibit A12 to Exhibit A14, as determined in the Trial Decision, there is no ground for the Reason for Cancellation made by the Plaintiff.

Judgment by the Court

2 Concerning the Reasons 1 to 5 for Cancellation

(1) There is no dispute between parties concerned that the present trihydrate in the Present Inventions 6 and 7 is a new chemical substance, Document of Exhibit A7 does not describe and suggest a method for manufacturing the same while Document of Exhibit A7 states an equivalent chemical formula of the organic compound with the present trihydrate, and the same has been perceived in the Trial Decision.

So, in such a case, an issue is primarily raised whether or not Document of Exhibit A7 is a "publication" recited in Article 29(1)(iii) as a premise for applying the provision of Article 29(2) of the Patent Act.

By the way, while Article 29(1) of the Patent Act provides that a patent cannot be granted for "the invention stated in the publication distributed ...prior to the filing of the patent application" recited in item 3 in the same paragraph, it is needless to say to be necessary that the constituent of the product invention is disclosed in the publication in order to recognize that the "invention of product" is stated in the above-mentioned "publication". In light that the invention is a creation of technical ideas (see Article 2(1) of the Act), it should be said to be necessary that the technical idea of the present invention is disclosed to an extent such that a person skilled in the art who reads the publication can practice the technical ideas based on the common general knowledge at the time of filing the patent application without exerting any creativity such as consideration and trial-and-errors.

Especially, when the product is a new chemical substance, there are quite few to be difficult that a method for manufacturing and availability of the new chemical substance can be found. So, in order to recognize that the technical ideas are disclosed in the publication, it should be generally said to be necessary that there is a description to an extent such that its method for manufacturing can be understood, not only that the constitution of the substance is disclosed. In addition, when there is no description in the publication to an extent such that the method for manufacturing can be understood, it should be said to be necessary that a person skilled in the art who reads the publication can find its method for manufacturing and availability based on the common general knowledge at the time of filing the patent application without exerting any creativity such as consideration and trial-and-errors.

(2) For the present case, ..., since it cannot be said that there is a description in Document of Exhibit

A7 to an extent such that the method for manufacturing can be understood, it will be necessary that a person skilled in the art who reads Document of Exhibit A7 can find a method for manufacturing the present trihydrate and its availability based on the common general knowledge at the time of filing the patent application without exerting any creativity such as consideration and trial-and-errors, in order to recognize that Document of Exhibit A7 corresponds to the "publication" recited in Article 29(1)(iii) of the Patent Act, according to the criteria for determination as mentioned in the item (1).

(3) ...in the present case, an issue is raised whether or not a common general knowledge had been present at the time of filing the present application wherein the common general knowledge is that a person skilled in the art who reads the description of Document of Exhibit A7 can find the method for manufacturing the present trihydrate and its availability without exerting any creativity such as consideration and trial-and-errors on the premise of the description of Document of Exhibit A7 ... In the present case, it should be said that it cannot be perceived that such a common general knowledge had been present at the time of filing the present application.

...according to the above-mentioned matters, the Reason 1 for Cancellation asserted by the Plaintiff is reasonable ...

(55)-1

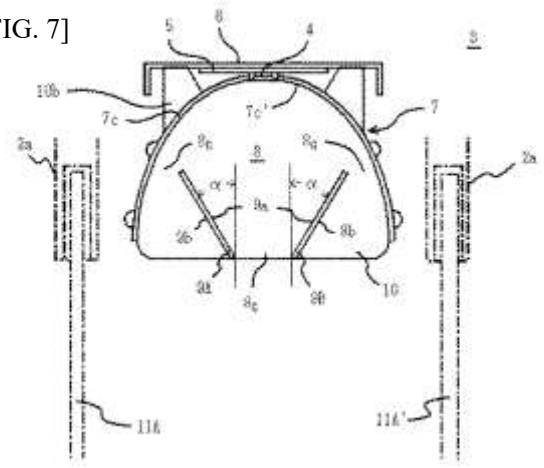
Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.3
Classification of the Case	55: Whether or not the invention can be deemed as an invention that was publicly known
Keyword	Non-disclosure Agreement

1. Bibliographic Items

Case	"Light Source Device" (Trial for Invalidation) Intellectual Property High Court Decision, July 11, 2012 (2011 (Gyo KE) No. 10271)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2009-179005 (JP 2010-114065A)
Classification	F21S 2/00
Conclusion	Dismissal
Related Provision	Article 29(1)(i)
Judges	IP High Court Second Division, Presiding judge Shuhei SHIOTSUKI, Judge Akira IKESHITA, Judge Kenjiro FURUYA

2. Overview of the Case

[FIG. 7]



(1) Summary of Claimed Invention

The light source device 3 according to the claimed invention comprises: an LED 4 having strong directivity; a reflective hood 7 having a reflecting surface therein for reflecting the illumination light from this light source; and a pair of first and second polarizing reflective plates 9A and 9B for polarizing the illumination light from the LED 4 in a specific direction. The first and second polarizing reflective plates 9A and 9B are each made of a plate material having a specific length and width and a high reflection rate on front and rear surfaces. At least one light source 4 is secured to the bottom portion of the reflective hood 7. A predetermined interval is provided between the first and second polarizing reflective plates 9A and 9B and the reflecting surface of the reflective hood 7 such that a predetermined interval with respect to each other is provided with the optical axis passing through the zero direction angle of the light source 4 residing therebetween, wherein the reflective plates 9A and 9B are arranged such that

they each have a predetermined inclination angle α with respect to the optical axis so that the interval in the vicinity of the light source is large and the interval further away is small. As such, it is made possible to provide a light source device capable of illumination by specifying a desired illumination area where the range of illumination is not centralized and is suitably dispersed even when a light source having strong directivity is used.

(2) Content of Non-Disclosure Agreement Concerning "LED Flat Panel Product" (Exhibit A5)

"(Purpose of the Agreement)

Section 1: Party X (Note added by the court decision: Defendant) and Party Y (Note added by the court decision: Plaintiff), for the purpose of examining the feasibility and other aspects of the joint development business (hereinafter referred to as "the Business") by Party X and Party Y concerning the LED flat panel product developed by Party X (hereinafter referred to as "the Product"), disclose or provide information held by Each Party to the other Party (hereinafter referred to as "the Receiving Party"), and Receiving Party receives the disclosure or offer of the information as Confidential Information.

(Applicable Range)

Section 2: The provisions as set forth in the Agreement shall apply to any and all information, documents and/or materials provided or disclosed in any and all negotiations concerning the Business between Party X and Party Y; provided, however, after conclusion of the Agreement, between Party X and Party Y...

(Definition of Confidential Information)

Section 3: The Confidential Information as used in the Agreement shall mean any and all information, documents and/or materials such as business information, know-how, technical information, and management information that are disclosed or provided by the party who discloses the information (hereinafter referred to as the "Disclosing Party") to Receiving Party, whether orally, by means of documents, electronic mail or electronic data storage medium, or any other methods and means, whether in a tangible or intangible form, and that are clearly marked "Confidential" or other marking of similar nature by a paper medium or an electromagnetic record from the Disclosing Party to Receiving Party. If Receiving Party made reproduction or adaptation of the Confidential Information, the documents and/or materials created as a result of the reproduction or adaptation shall be treated as the Confidential Information.

2 ...

3 ...

(Non-Disclosure Obligations Regarding Confidential Information)

Section 5: Receiving Party shall keep the Confidential Information ...in strict confidence for Disclosing Party, and shall not disclose, provide, or divulge all or part of the confidential information to third parties without the prior written consent of Disclosing Party." (Extracts taken from the court decision)

(3) The Claims (Only claim 1 is cited therefrom.) (The Invention 1)

[Claim 1] A light source device comprising: a highly directional point light source; a reflective hood that has a bottom portion on which the point light source is secured and a pair of side reflective portions opposing to each other extending outward by a predetermined length from opposing sides of the bottom portion and having open end

portions, an inner space of a specific volume being defined by the bottom portion and the pair of side reflective portions inside, and an inner wall surface being formed of a reflective surface; a pair of first and second polarizing reflective plates that polarize irradiation light from the point light source to a specific direction, wherein
the first and the second polarizing reflective plates are each made of a plate material having a specific length and width and a high reflection rate on front and rear surfaces, at least one such point light source is secured on the bottom portion of the reflective hood, the first and the second polarizing reflective plates are tilted by a specific angle α with respect to an optical axis passing through the zero direction angle of the point light source so that a specific gap is provided between the first and second polarizing reflective plates and the reflective surface of the reflective hood, and a specific gap is provided between the first and second polarizing reflective plates with the optical axis in between in such a manner that the gap is larger at a portion closer to the point light source and the gap is smaller at a portion away from the point light source.

(4) Facts and Procedural History

December 13, 2007	:	Entry into non-disclosure agreement (Exhibit A5) between Plaintiff and Defendant (Patentee)
September 30, 2008	:	Sales and delivery of the products of the cited invention by Defendant to Plaintiff
July 31, 2009	:	Filing of a patent application (priority date: October 7, 2008)
June 18, 2010	:	Registration of establishment of the patent right (See the above-described "The Claims.")
December 6, 2010	:	Filing of a request for a trial for patent invalidation by Plaintiff (Muko No. 2010-800221)
July 15, 2011	:	Trial Decision dismissing the request for trial

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

Appeal Decision (cited from the Court Decision)
It is found that Plaintiff and Defendant concluded the Non-Disclosure Agreement for the "LED flat panel product" and accordingly Plaintiff and Defendant are under non-disclosure obligations also with regard to the "SE type special reflector flatter." Even if the "SE type special reflector flatter" is not the "LED flat panel product" in the meaning of the Non-Disclosure Agreement, the "SE type special reflector flatter" was jointly developed by Defendant and Plaintiff with a number of rounds of discussions held between Defendant and Plaintiff such that the product has a suitable configuration for use in the electric display device manufactured by Plaintiff. In addition, the Plaintiff company, which should be quite conversant with the structure of the product, ordered the manufacture thereof to Defendant. Accordingly, it is clear that the both parties were in a close relationship in development of the "SE type special reflector flatter" and they are under the non-disclosure obligations for each other under the social standards or in accordance with commercial practices. Further, considering the particular business relationship in which Plaintiff manufactured and sold the product at issue in response to the request by Plaintiff who is in such a non-disclosure relationship, the product

at issue is not intended to be sold to an unspecified person. Consequently, it cannot be said that the fact of selling on September 30, 2008 rendered the "SE type special reflector flatter" publicly known.

Decision

Allegations by Plaintiff

Since the Non-Disclosure Agreement, in light of the language of Section 1, is intended to be applicable to the "LED flat panel products developed by Party X," it is clear that the products using the reflector techniques are not included therein ...in addition, with regard to the "Basic Licensing Agreement" is a licensing agreement concerning the products using the "flatter techniques" as the preamble of the agreement explicitly recites the term "flatter techniques," which means that the "reflector techniques" is not included in the applicable range of the agreement.

In other words, it is natural to interpret any of the relevant written agreements such that they were not intended for the products using the "reflector techniques," specifically, the "SE type reflector flatter." Moreover, in terms of the time series, the "flatter techniques" owned by Defendant were disclosed in accordance with the Non-Disclosure Agreement to Plaintiff, commercialization was examined, and determination was made that the commercialization is feasible, and thus the stage has shifted to the licensing agreement for the "flatter techniques." This is the sequence of the related facts. These facts and developments also justify this interpretation. Specifically, both parties, in any of the agreements, contemplated the "flatter techniques."

Allegations by Defendant

1 In accordance with the Non-Disclosure Agreement concluded between Plaintiff and Defendant (Exhibit A5), Plaintiff and Defendant were also "under non-disclosure obligations regarding the "SE type special reflector flatter," and even if, *in arguendo*, the "SE type special reflector flatter" is not the "flat panel product" in the meaning of the Non-Disclosure Agreement, it is clear that Plaintiff and Defendant were in a close relationship in development of the "SE type special reflector flatter" and were under the non-disclosure obligations under the social standards or in accordance with commercial practices ...the fact that the "SE type special reflector flatter " (the product of the cited invention) was sold and delivered from Defendant to Plaintiff ...on September 30, 2008 does not cause the feature of the "SE type special reflector flatter" to become a "publicly known invention" prior to the priority date of the patent application.

2 ...the paper-based Non-Disclosure Agreement (Exhibit A5) concerning the joint development business of the LED flat panel product was exchanged between Plaintiff and Defendant, and after that, an electronic mail (Exhibit B1) requesting implementation of confidentiality obligations was transmitted on January 24, 2008 from Mr. A who works for Plaintiff to Defendant. Defendant, who has been engaged in the development business, recognized that the product at issue are normally treated as being included in the applicable range of the non-disclosure agreement even in the absence of such a request for implementation of confidentiality obligations.

Judgment by the Court

...It is found that Plaintiff and Defendant agreed on December 13, 2007 to launch a joint development business concerning the product ...developed by Defendant, and ...concluded the Non-Disclosure Agreement (Exhibit A5) concerning the confidential information including technical information and know-how associated with the product that Defendant offered to Plaintiff.

...According to the contract, the Non-Disclosure Agreement applies to the information, documents, and/or materials to be provided or disclosed in any and all negotiations associated with "the Business" between Plaintiff and Defendant (Section 2), the Confidential Information in the context of the Non-Disclosure Agreement refers to "any and all information, documents, and/or materials ...the party who discloses the information to Receiving Party ..." (Section 3), and "the Business" refers to the joint development business by Defendant and Plaintiff regarding the product ...developed by Defendant (Section 1). Accordingly, the joint development by Plaintiff and Defendant for developing the "SE type special reflector flatter," which is the LED flat panel product according to the joint development by Defendant and Plaintiff, is encompassed by the Business to which the Non-Disclosure Agreement is applicable. As such, it is clear that Plaintiff is under the non-disclosure obligations for Defendant based on the Non-Disclosure Agreement regarding the technical information that is provided or disclosed in any and all negotiations associated with the "SE type special reflector flatter."

Plaintiff alleges that both parties contemplated the "flatter techniques" in concluding the Non-Disclosure Agreement and the agreement does not apply to the "reflector techniques" which both parties did not contemplate. However, the Confidential Information in the context of the Non-Disclosure Agreement refers to "any and all information, documents and/or materials" (Section 3) as mentioned above, and thus there is no reasonable ground to interpret that only "flatter techniques" are included therein.

Just for the record, according to Exhibit B1, it is noted that "A" who works for Plaintiff sent an electronic mail to Defendant on January 24, 2008, requesting that the technical features of the Plaintiff's product related to the development of this time be also handled in accordance with the import of this Non-Disclosure Agreement, and that Plaintiff also acted on an assumption that the Non-Disclosure Agreement also applies to the product of the cited invention. Plaintiff alleges that the Non-Disclosure Agreement does not apply to the finished product, but it is a matter of course that the non-disclosure obligations are effective regarding the technical information to which the agreement is applicable until filing of the patent application, and thus the allegations by Plaintiff are not reasonable.

(55)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.3
Classification of the Case	55: Whether or not the invention can be deemed as an invention that was publicly known
Keyword	

1. Bibliographic Items

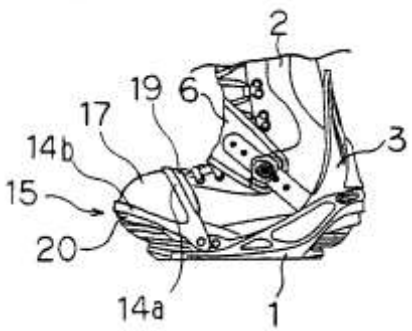
Case	"Binding for snowboard" (Trial for Invalidation) Intellectual Property High Court Decision, March 26, 2014 (2013 (Gyo KE) No. 10178)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2004-21212 (JP 2004-154593A)
Classification	A63C 9/02
Conclusion	Dismissal
Related Provision	Article 29(1)(i)
Judges	IP High Court Fourth Division, Presiding judge Yoshinori TOMITA, Judge Yoshiki TANAKA, Judge Akimitsu ARAI

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a binding for snowboard in which a buckle is attached to an end of a band 15, the band 15 being constituted by one belt 14a for fastening an upper portion of the tiptoe of a boot and the other belt 14b for fastening a leading end portion of the tiptoe of the boot so that fastening can be performed by this buckle. With this configuration, the fastening takes place simultaneously via the upper portion of the tiptoe of the boot and via the leading end portion of the tiptoe.

[FIG. 1]



(2) Publicly Known Invention (Findings of Court Decision)

"A: According to the Photograph 5 of Report of Exhibit A2 (Exhibit A2), ...the digits of 1 to 12 are arranged in a dial-like manner on the reverse side (bottom side) of the MTX of Report of Exhibit A2, wherein the digits "00" are inscribed in the central portion of the dial-like arrangement and downward arrows that point to the number 7 are inscribed such that the digits "00" reside therebetween (the Marking).

B: Brochure of Exhibit A3 (Exhibit A3) is a brochure of the "DRAKE" brand for the 2001-2002 seasons. The MTX appears in this Brochure of Exhibit A3.
C: "World of Sports - World Sports Trade Messe ISPO 2001 Winter" was held in Munich of Germany on 4 to 7 February, 2001 and "THE SIA SNOW SPORTS SHOW" was held in Las Vegas of the United States of America on 9 to 13 March of the same year (the Trade Shows). Northwave participated in the Trade Shows and exhibited the MTX (Exhibit A5 to Exhibit A8).
D: A sports equipment shop, Val Surf, ordered the MTX (a total of 20 pairs including L and M sizes) on February 27, 2001 to Northwave (Exhibit A9, Exhibit A10).
E: List of Exhibit A36 describes the fact that 720 pairs of the MTX were being packed for shipment on May 30, 2001 (Exhibit A36).
F: The MTX is introduced with photographs in the magazine of Exhibit A63, which was published by January 2001 at the latest (Exhibit A63)." (extracts taken from the court decision)

(3) The Claims (after Correction) (Only claim 1 is cited therefrom.)
[Claim 1] A binding for a snowboard comprising: a base plate 1; a first band 9a whose first end is attached to a first side of the base plate 1; a second band 9b whose first end is attached to a second side of the base plate 1, the second side being opposed to the first side of the base plate; a band 15 constituted by a portion fastening the upper portion of the tiptoe of the boot and an other portion fastening the leading end portion of the tiptoe of the boot; and a buckle 16, an end of the band 15 being fixed to either of the one band and the other band, and on other end of the band 15 being fixed to the other of the one band and the other band via the buckle such that the upper portion of the toe portion and the tip portion of the boot are allowed to be simultaneously fastened.

(4) Procedural History

January 29, 2004	:	Filing of a patent application by Defendant (Patentee) (Original filing date: June 14, 2001)
November 30, 2007	:	Registration of establishment of the patent right
August 31, 2012	:	Filing of a request for a trial for patent invalidation by Plaintiff (Muko No. 2012-800137)
November 30, 2012	:	Request for correction by Defendant (See the above-described "The Claims.")
May 20, 2013	:	Appeal Decision admitting the above request for correction and Trial Decision dismissing the request for trial

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

Appeal Decision (cited from the Court Decision)
...(1) It cannot be recognized that the invention (...which is referred to as "Invention of Exhibit A2") of the binding for snowboard (product name "DRAKE MATRIX" ...which is referred to as "MTX") shown in illustrated in the Report on Taking of Photographs (Exhibit A2 ...which is referred to as "Report of Exhibit A2")

was in the publicly known state prior to filing of the original patent application ...

Decision

Allegations by Plaintiff

(1) With Regard to Whether or not MTX is Publicly Known

...In Report of Exhibit A2 ...the digits of 1 to 12 are arranged in a dial-like manner on the reverse side (bottom side) of the photographed MTX, wherein the digits of "00" are inscribed in the central portion of the dial-like arrangement and downward arrows that point to the number 7 are inscribed such that the digits of "00" reside therebetween (...which is referred to as "the Marking"). It is not uncommon that the year and month of manufacture is described on a product, and it is natural that the digits of 1 to 12 indicate months and the digits of "00" indicate the last two digits of a year by the Western calendar system.

...the Trade Shows ...are ...major trade fairs, and ...paper-based documents such as brochures are provided. In June 2001, ...the sales manager created a written statement stating that ...the MTX was exhibited at the trade show of March 2001, Brochure of Exhibit A3 was distributed, and the MTX gained good reputation (Exhibit A34, which is hereinafter referred to as "Written Statement of Exhibit A34").

D ...List of Exhibit A36, which was created by an MTX dealer at the time of shipment of products ...states that the 720 pairs of the MTX was ...stacked upon the pallet. Accordingly, it is clear that preparation for shipment of the MTX was being carried out on May 30, 2001 at the latest, on which List of Exhibit A36 was created...

Allegations by Defendant

(1) With Regard to Whether or not MTX is Publicly Known

A Report of Exhibit A2 does not include any descriptions or suggestions of the meanings and the definitions of these digits indicated by the Marking. Also, there is no other evidence that supports the meanings and the definitions of these digits. As such, it cannot be said that the meanings and the definitions of these digits, etc. are clear.

Accordingly, it is not possible to identify the date of manufacture and the date of distribution of the MTX on the basis of the digits, etc. indicated by the Marking.

B Even when the MTX appears in Brochure of Exhibit A3, Brochure of Exhibit A3 does not include descriptions or suggestions of the date of publication or the date of distribution, which leaves unidentified the date of manufacture and the date of distribution of the MTX.

There is no evidence or suggestion that shows the fact that Brochure of Exhibit A3 was distributed or retail stores or the like saw and ordered the MTX in the Trade Shows. In addition, no other evidence exists that shows the fact that would substantiate the existence of these facts. Moreover, it is not identified that the MTX of Report of Exhibit A2 is really identical with the one appearing in Brochure of Exhibit A3.

C Even when the product called "DRAKE F60 L MTX" described in List of Exhibit A36 was stacked on the pallet on May 30, 2001 and shipped two or three days later, this fact is in no way directly followed by another fact that the MTX of Report of Exhibit A2 was placed in a publicly known state prior to filing of the original application.

Judgment by the Court

A With Regard to MTX

(A) ...In view of the feature of the Marking, it is possible that "00" indicate the last two digits of the year by the Western calendar system and "7" indicates the month, and the possibility that the MTX of Report of Exhibit A2 was manufactured around July 2000 cannot be denied.

Meanwhile, at that point, ...Written Statement of Exhibit A34 (Exhibit A34) which was created by the Northwave's person in charge ...describes that ...the MTX manufactured around the summer of 2000 is a sample item for merchandising. In addition, Plaintiff alleges that the MTX of Report of Exhibit A2 is the one at the stage of manufacturing a prototype model, and as a general cycle for manufacturing of products related to snowboards, it is common that development of new products for 2001 ...season is started around the summer of ...2000. However, it is difficult to rely on these facts and substantiate the date of manufacture of the MTX of the above Report of Exhibit A2.

(B) ...Brochure of Exhibit A3 includes a photograph of the MTX, but the details of the shape of the MTX are not identified from the photograph, and it does not include specific descriptions regarding the shape of the MTX. Accordingly, it cannot be recognized that the MTX of Report of Exhibit A2 and the MTX described in Brochure of Exhibit A3 have the same structure.

...There is not clear and reasonable evidence to find that Brochure of Exhibit A3 was distributed in the Trade Shows (although Written Statement of Exhibit A34 states that Brochure of Exhibit A3 was distributed in the Trade Shows, Written Statement of Exhibit A34 was created ...about 12 years after the year of the Trade Shows, and the possibility cannot be denied that the place of employment of a person who created the Written Statement ...has an interest in the validity of the patent...In view of these facts, the description in question of Written Statement of Exhibit A34 cannot be adopted).

(D) Since List of Exhibit A36 only describes the product name and the model number of the MTX, the List leaves the specific shape of the MTX at that point unidentified, and it cannot be found that the MTX of Report of Exhibit A2 and the MTX described in List of Exhibit A36 have the same structure.

B With Regard to Whether or Not Invention of Exhibit A2 is Publicly Known

...It is possible to infer the fact that the brochure in which the MTX appears was distributed and the fact that a prototype product of the MTX was exhibited in the Trade Shows or a finished product of the MTX was commercially available prior to filing of the original application (June 14, 2001).

However, there is no appropriate reasonable evidence sufficient to find that a prototype model of the MTX of Report of Exhibit A2 was manufactured around July 2000. Also, the specific shape of the MTX exhibited in the Trade Shows, described in Brochure of Exhibit A3, and made commercially available, is unknown in light of all the evidence on the record. Further, there is no sufficient evidence to find that each of the above MTXs and the MTX of Report of Exhibit A2 have the same structure. As such, the time remains unknown when the MTX of Report of Exhibit A2 was placed in the publicly known state.

Therefore, it cannot be said that the Invention of Exhibit A2 was publicly known at the time of the Trade Shows (February 4 to 7, 2001 and March 9 to 13 of the same year) as long as the specific shape of the MTX that was publicly known at that point cannot be ascertained.

(56)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.4
Classification of the Case	56: Whether or not the invention can be deemed to be a publicly worked invention
Keyword	

1. Bibliographic Items

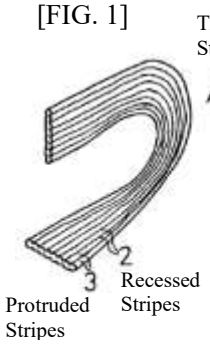
Case	"Thin konjac having striped surface" (Trial for Invalidation) Intellectual Property High Court Decision, June 30, 2005 (2005 (Gyo KE) No. 10061)
Source	Website of Intellectual Property High Court
Application No.	Japanese Utility Model Application No. S63-124955 (JP H02-046589U)
Classification	A23L 1/212
Conclusion	Acceptance
Related Provision	Article 3(1)(i) and (ii), and Article 3(2) of the Utility Model Act
Judges	IP High Court Second Division, Presiding judge Tetsuhiro NAKANO, Judge Ichiro OTAKA, Judge Naoki HAYATA

2. Overview of the Case

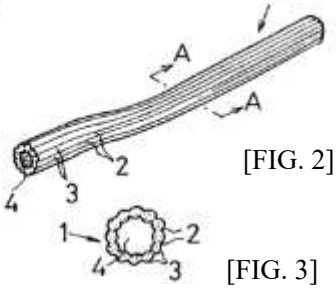
(1) Summary of Device as Claimed in Application Concerned

The device as claimed in the application concerned relates to a thin konjac (konnyaku) having striped surface that includes, on its surface, multiple recessed stripes 2 and protruded stripes 3, whose thick part is equal to or less than 3 millimeters in thickness as illustrated in the figures.

[FIG. 1]



[FIG. 2]



[FIG. 3]

(2) Outline of the Invention According to Embodiment Thereof (Findings of the Trial Decision)

"(A) With regard to the "Shabu-Shabu Konjac" that A Foods manufactured and sold prior to filing of the patent application, there exist discovered items on which the date stamps of "Manufactured 60.10.27" or "Manufactured 60.11.1" are printed, respectively (items 1 to 3 of Exhibit A30, Exhibit A31, and item 2 of Exhibit A33). Incidentally, the discovered items were discovered on February 29, 2004 in a bucket in the old factory of A Foods (items 1, 54, and 79 of Exhibit A53).

(B) The shape and the structure of the konjac which is the content of the discovered item has a number

of concaves and convexes on its surface in the longitudinal direction, and the thick part of the convex portion is equal to or less than 3 millimeters in thickness, and the thin part of the concave portion is made in the semi-transparent striped patterns, and the same as the "thin konjac having a striped surface" according to the Device (item 1 of Exhibit A53).

(C) The manufacturing time of the discovered item is, as indicated by the date stamp printed on its package bag, October 27, 1985 and November 1 of the same year, and both of them were manufactured prior to filing of the patent application (items 1 to 3 of Exhibit A30 and item 1 of Exhibit A53).

This point is also supported by the following facts." (extracts taken from the court decision)

(3) The Claims (the Device)

[Claim 1] A thin konjac having a striped surface, the konjac being formed by extruding a thread-like konjac via an extruding nozzle including independent multiple nozzles arranged adjacent to each other in one or two rows such that the thread-like konjac has the thickness equal to or less than 3 millimeters, immediately making the extruded thread-like konjac into a single body by joining ends of the thread-like konjac to each other in a width direction thereof, the thread-like konjac having multiple recessed stripes (2) and protruded stripes (3) on its surface, the stripes extending in a longitudinal direction of the Konjac, a thick part of the protruded stripes (3) being equal to or less than 3 millimeters, and semi-transparent striped patterns being formed in a thin part of the recessed stripes (2).

(4) Procedural History

September 24, 1988	:	Filing of an application for registration of a utility model by Defendant (the holder of utility model right)
December 11, 1998	:	Registration of establishment of the utility model right (See the above "The Claims.")
July 15, 2002	:	Filing of a request for a trial for invalidation of the utility model by Plaintiff (Muko No. 2002-35295)
January 28, 2004	:	Appeal Decision dismissing the request for appeal

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

Appeal Decision (cited from the Court Decision)
...Demandant alleges that the Device is not patentable under Article 3(1)(i) or (ii) or Article 3(2) of the Utility Model Act because the "thin konjac having a striped surface" in accordance with the Device has the structure identical with or almost the same structure as that of the "Konjac for shabu-shabu" of A Foods Industry Co., Ltd. (hereinafter referred to as "A Foods"), which was openly manufactured and sold as late as in 1982 prior to filing of the patent application (the fact of the above manufacturing and selling is hereinafter referred to as the "Fact of Public Working"). In response to this allegation, in view of the documentary evidence (...) and references (...) presented by Demandant, testimonies of witnesses B, C, D, E, F. and G (...), and the results of observation (...), they do not constitute the ground to find the existence of the Fact of Public Working, and the utility model registration for the Device cannot be invalidated.

Decision	
Allegations by Plaintiff (A) A Foods has been openly manufacturing and selling to many dealers since around 1983 to the present, the Konjac named "Shabu-Shabu Konjac" (hereinafter referred to as "the Konjac") which has the same shape and structure as those of the discovered items (Exhibit A79 to Exhibit A120). (B) The Konjac was developed around the autumn of 1981 by C who is the managing director of A Foods. The perforated plate (the perforated plate (Exhibit A5, Exhibit A10) that was originally created by C for use in manufacturing of the Konjac may hereinafter particularly be referred to as "the Perforated Plate") was produced by C himself after the perforated plate in which holes are yet to be formed was purchased from I Industries Co., Ltd. (hereinafter referred to as "I") and was processed by C himself (Exhibit A5, Exhibit A10, Exhibit A16, Exhibit A17, Exhibit A80, and Exhibit A85). (C) The apparatus for manufacturing of the Konjac of A Foods was configured by using a conventional device on an as-is basis, which A Foods had been using to manufacture ito-konjac (konjac noodles), and substituting the perforated plate for the Ito-Konjac by the perforated plate for the Konjac (having hole pitches of around 1 millimeter) for attachment thereto. Also, the method for manufacturing Konjac relies on the same manufacturing conditions as those of the manufacturing of the ito-konjac that had been carried out by A Foods except for use of the above manufacturing apparatus (Exhibit A10, Exhibit A29, Exhibit A79, Exhibit A80). (D) The packaging bag of the "Shabu-Shabu Konjac" that was produced for the first time by A Foods in November 1983 has the indication of "patent	Allegations by Defendant A Plaintiff alleges that the Konjac was developed around the autumn of 1981 by C who is the managing director of A Foods, and as the evidence in favor of this allegation, Plaintiff presented the record of transactions with I, etc. (Exhibit A16, Exhibit A17). ...The record of transactions with I does not support the Plaintiff's allegation that the perforated plate originally produced by C was made on the basis of the perforated plate purchased from I in 1981. In contrast, in view of the fact that the "Plain Suita" was sold by I to A Foods on September 5, 1987, it is reasonable to find that the truth is that the hole forming operation was subsequently started by C and this led to development of the Konjac. In conclusion, the allegation of this case by Plaintiff shifts the facts by about six years to the past. B Also, according to the content of the deposition by C as well as the written statement created by C in the trial case, it follows that C had never conducted experiments before he formed holes in the entire perforated plate, but this is a far-fetched consequence. C Careful examination of the large amount of transaction slips and other documents submitted by Plaintiff (Exhibit A100 to Exhibit A120) shows that the "Shabu-Shabu Konjac" with delivery price of 208 yen and retail price of 298 yen and indicated by "A Shabushi," suddenly appears in the slip dated November 20, 1989 (Exhibit A105). In view of the fact mentioned above, the very high price commodity that suddenly appeared in November 20, 1989 is the product resulting from the working of the "thin konjac having a striped surface" according to the Device, which has an added value relative to the previous commodities. Hence, it is understood that the

pending." This indication was provided because A Foods developed the Konjac, A Foods sought patent protection as A Foods which had been engaged in manufacturing and selling of konjac for a long time never saw such a commodity at the time of development. Although A Foods did not in fact file a patent application for the Konjac, the fact of the indication of "patent pending" per se is the evidence of the fact that A Foods developed the Konjac.	product was handled with a high price about one and half times as high as those of the conventional ones.

Judgment by the Court

(1) With Regard to Discovered Item

...In the first place, as mentioned above, the date stamp of "Manufactured 1985.10.27" or "Manufactured 1985.11.1" is printed on the discovered item, and it is inferred from the above date stamp that the discovered items were manufactured on October 27, 1985 or on November 1 of the same year, respectively, unless there is found a special circumstance of suspected fabrication of the discovered items as such or the date stamps printed thereupon or any other special circumstances.

(2) With Regard to the Fact of Invention Being Publicly Worked

A In view of the entire import of the oral argument and (...) evidence, the following fact can be found.

(A) It was well-known to konjac (konnyaku) manufacturers prior to 1981 that ito-konjac (konjac noodles) swells after being extruded from the holes provided in the perforated plate and thus becomes larger than the size of the hole via which it was extruded, and as a result it may happen that during the manufacturing of the ito-konjac, a plurality of ito-konjacs are inadvertently adhered to each other.

(B) C who is a managing director of A Foods, when E who works for R Co. Ltd. (hereinafter referred to as "R") suggested him "to develop a konjac on which the sauce is readily caught" around the autumn of 1980, conceived manufacturing of a konjac product which could be obtained by aligning multiple ito-konjacs in the length direction and intentionally adhering them to each other. The conventional perforated plate for Ito-Konjac had large hole pitches such that the extruded Ito-Konjacs are not adhered to each other, and any perforated plate having small hole pitches causing adhesion of the Ito-Konjacs was not commercially available. As such, C purchased a perforated plate in which holes are yet to be formed, from I where A Foods had usually purchased konjac manufacturing devices and equipment, and then C himself formed holes having small hole pitches in a perforated plate .

(C) A Foods purchased, from I, four perforated plates in which holes are yet to be formed on May 11, 1981. Around that time, C started manufacturing of the perforated plate having holes in small pitches based on the purchased perforated plate in which holes were yet to be formed. C installed a hand-held type drill on a drill stand, attached a metallic table thereto, fixed a wooden stage obliquely to this table, placed thereupon the perforated plate in which holes were yet to be formed, holding the perforated plate by his left hand, operated the drill installed on the stand by his right hand, and thus formed holes one at a time. A drill having a diameter

of 0.9 millimeter was used, and the hole pitches were made to be around 1 millimeter. Meanwhile, it was a demanding work to make holes while ensuring that the drill is not bent or broken and that the adjacent holes are not connected to each other. Also, it took several months to complete forming of 300 or more holes in one single perforated plate. After that, A Foods purchased from I, on September 2, 1981, another four perforated plates in which holes were not formed, and further three perforated plates of the same type on October 30, 1981. Thus, C continued, through trial and error, to produce a perforated plate for the Konjac.

(D) In this manner, A Foods in fact started to manufacture the Konjac at its old factory in July 1983 at the latest.

The manufacturing method uses the existing devices and components that have been used in manufacturing of ito-konjac such as a konjac neri-ki (kneading machine), a nagashi-kama (pot with water flow) and the perforated plate attaching tool and, in place of the perforated plate for ito-konjac, uses the perforated plate (with hole pitches of around 1 millimeter) produced by C attached to the apparatus for manufacturing the Konjac. The structure and shape of the Konjac thus manufactured are a thin konjac having a striped surface and having the same feature as that of the Konjac of the discovered items.

(E) For A Foods, at the outset of manufacturing of the Konjac, it was the test marketing in R and whether or not to shift to full-scale sales was not decided at all. For this reason, A Foods packed it by a plain transparent film and then delivered it with the existing label of "Kishimen Style Konjac" adhered thereto. After that, A Foods, around October 26, 1983, ordered to Q a packaging material with the name of "Shabu-Shabu Konjac" provided thereon as the packaging material for the Konjac. After this packaging material was delivered on November 24 of the same year, A Foods started to sell the Konjac with the name of "Shabu-Shabu Konjac."

B When the facts found as described in the above item A. are all taken into consideration, it is reasonable to recognize that A Foods publicly worked the thin konjac having a striped surface that is identical with "the konjac haing a striped surface" in accordance with the Device around in November 1983 at the latest when A Foods started full-scale manufacturing and selling of the Konjac.

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.4
Classification of the Case	56: Whether or not the invention can be deemed to be a publicly worked invention
Keyword	

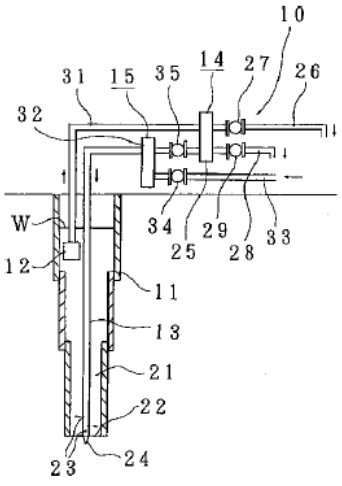
1. Bibliographic Items

Case	"Hot spring water pumping device"(Trial for Invalidation) Intellectual Property High Court Decision, September 8, 2005 (2005 (Gyo KE) No. 10113)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H07-181083 (JP H09-4358A)
Classification	E21B 43/00
Conclusion	Dismissal
Related Provision	Article 29(1)(ii)
Judges	IP High Court Second Division, Presiding judge Tetsuhiro NAKANO, Judge Ichiro OTAKA, Judge Koji HASEGAWA

2. Overview of the Case

(1) Summary of Claimed Invention

[FIG. 1]



An object of the claimed invention is to increase the temperature of water without heating it with a boiler. In accordance with the claimed invention, a casing 11 is prodded in the ground and a pit is formed therein. The water in the pit is pumped up by a draw pump 12. A water feed pipe 13 is inserted into a deep layer part in the pit. The water feed pipe 13 has a drain port 23 at the end portion of the deep layer part. A water dividing unit of a water feed unit 14 is connected to the drain pipe 31 of the draw pump 12 and the water feed pipe 13. A water supply pipe 26 is connected to the water dividing unit. A water feed valve 27 controls the quantity of water feed of the water supply pipe 26 and the quantity of water feed to the water feed pipe 13. Part of the water of the drain pipe 31 is fed to the water feed pipe 13 via the water dividing unit. In particular, the water feed pipe 13 is fixed to the hole bottom 22 by a pointed end 24 stuck into a hole bottom 22. By this configuration, the claimed invention provides the working effect of "preventing damage to the components due to oscillation caused by the force of the water discharged via the drain port 23."

(2) Outline of Worked Invention (Invention of Akema Onsen Hot Spring): Test run conducted by Defendant at Akema Onsen Hot Spring for eight days from June 6, 1995 (Findings of the Trial Decision)

" ...'An apparatus for temperature raising and volume increasing of a hot spring well, the apparatus comprising: a hot spring submerged pump that includes a pumping-up pipe; a water return pipe arranged in the deep layer part of a hole of a hot spring well, the water return pipe including a water discharge pipe at a lower end thereof, wherein the hot spring submerged pump and the water return pipe being provided in a hot spring well; and a thermal induction promoting device connected to the pumping-up pipe, the water return pipe, and a hot spring supply pipe, the thermal induction promoting device being configured to divide the hot water into a portion supplied to the hot spring supply pipe and the other portion supplied to the water return pipe, the water return pipe being configured to supply water into the hot spring well, wherein the water is supplied from another well via a pipe.'" (Extracts taken from the court decision)

(3) The Claims (after Correction) (Only claim 1 is cited therefrom.) (the Invention 1)

[Claim 1] A hot spring water pumping device comprising: a casing prodded in a ground to form a pit therein; a draw pump adapted to pump up water in the pit; a water feed pipe inserted into a deep layer part in the pit and secured to a hole bottom of the pit, wherein the water feed pipe has a drain port arranged at an end portion of the deep layer part; and a water feed unit adapted to supply water to the water feed pipe, the water feed unit including a water dividing unit connected to the drain pipe of the draw pump and to the water feed pipe, a water supply pipe being connected to the water dividing unit, and a water feed valve adapted to control the quantity of water feed of the water supply pipe.

(4) Procedural History

June 22, 1995	:	Filing of a patent application by Defendant (Patentee)
May 28, 1999	:	Registration of establishment of the patent right
October 31, 1999	:	Filing of an opposition to granting of a patent by a corporation A, the representative director of which is Plaintiff (1999 Igi No. 74083)
July 25, 2000	:	Filing of a request for correction by Defendant (See the above-described "The Claims.")
September 29, 2000	:	Decision admitting the correction and maintaining the patent of ...claims 1 to 3
September 17, 2003	:	Filing of a request for a trial for patent invalidation by Plaintiff (Muko No. 2003-35399)
October 13, 2004	:	Trial Decision dismissing the request for trial

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

Trial Decision

The "Invention of Akema Onsen Hot Spring" was worked for eight days from June 6, 1995 prior to filing of the Patent Application in the site of Akema in shimizu-cho, Oodate-shi. For the following reasons, it cannot be said that the Invention in question was publicly worked.

(A) According to the written statement dated July 23, 2004 by Demandant and Exhibit A26, it is stated that Demandant was present at the site, Akema conducted trial operation for the reduction to practice of "the Invention of Akema Onsen Hot Spring," at the time of which President Hatazawa and other two or three persons of Hachiyo Boring, three officials of the village office of Taishin-mura Village, Nishi-Shirakawa-gun District, Fukushima Prefecture, and six employees of Demandee company visited the site and observed the trial operation (...).

However, the place at which the invention was worked is in the site of Akema, and no allegations or evidence were presented by Demandant concerning the specific state in which the site actually was. As a result, it is not possible to conclude that the situation was such that an outsider could freely enter the site or an outsider could see the state of working of the invention. Rather, it is presumed that free entry into the site in question was difficult because the site is privately owned by Akema.

(B) Demandant alleges that a visit was made by President Hatazawa and other two or three persons of Hachiyo Boring, three officials of the village office of Taishin-mura Village, Nishi-Shirakawa-gun District, Fukusima Prefecture, and six employees of Demandee company in the period of eight days from June 6, 1995 when "the Invention of Akema Onsen Hot Spring" was worked and that the visitors were able to see the invention. In response to this allegation by Demandant, the Board of Appeal conducted an interrogation on August 23, 2004 requesting to submit evidence, if any, that should substantiate the above fact. However, no evidence was submitted by Demandant.

(C) The Patentee Akema stated as follows in an announcement in a newspaper: "we are scheduled to file an application for utility model registration at an early date" (an interview of Sales Chief, Mr. Ishigaki in Exhibit A23 published on June 14, 1995); and "we will soon file an application for utility model registration and the products will be released ...most of which will be related to trade secrets..." (Exhibit A25 published on June 19, 1995). It is presumed that, at this point, he was thinking about filing of an application for utility model registration or a patent application and accordingly thought that "the Invention of Akema Onsen Hot Spring" should be kept in confidence to the extent possible.

(D) At the point when the Invention in question was worked, a business partnership contract was concluded between Akita Technical Research Institute whose President is Demandant and Akema concerning status improving techniques for hot spring well, hot spring heat recovery and utilization techniques, geothermal utilization techniques, etc. (Exhibit A13, Exhibit B1). Pursuant to Section 12 of the contract, both parties were under confidentiality obligations. Further, the contract was effective at that time. As such, it cannot be said that the fact of Demandant having seen "the Invention of Akema Onsen Hot Spring" rendered the Invention in question publicly known.

(E) No other evidence was submitted that would substantiate the fact that the "Invention of Akema Onsen Hot Spring" was publicly worked.

(4) Summary

Consequently, since it cannot be said that "the Invention of Akema Onsen Hot Spring" was publicly worked prior to filing of the Patent Application, the Device does not fall within Article 29(1)(ii) or Article 29(2) of the Patent Act, and the reasons 1 and 2 for invalidation do not exist.

Decision

Allegations by Plaintiff	Allegations by Defendant
...JPO's Examination Manual (42.03A) states that Article 29(1)(ii) of the Patent Act defines a case where an invention was publicly worked even when the publicly worked invention is not publicly known. Also, Tokyo High Court Decision January 20, 1976 (HANREI TIMES No. 337, page 283) ruled that an invention is publicly known as long as there is the possibility of inspection thereof. The invention at issue was worked at the site of the hot spring well (Akema Hot Spring) that was being drilled in the material stockyard of Defendant in an open state outside of buildings, and at that point, the site in question was about five meters away from the wire net fence installed on the boundary between the site and the sidewalk without any screens provided there. Hence, it was in a "state readily viewable" from the pedestrians and people passing through the roads.	The Trial Decision is not erroneous in having denied the fact of public working of the Invention on the grounds that "the place at which the invention was worked is in the site of Akema; no allegations or evidence were presented by Demandant concerning the specific state in which the site actually was, making it impossible to conclude that the situation was such that an outsider could freely enter the site or an outsider could see the state of working of the invention; rather, it is assumed that free entry into the site in question was difficult because the site is privately owned by Akema" (page 8, lines 16 to 21). In particular, the feature of "a water feed pipe inserted into a deep layer part in the pit and secured to the hole bottom of the pit, wherein the water feed pipe has a drain port arranged at the end portion of the deep layer part" cannot be seen because the pit is provided in the deep layer part in the pit.

Judgment by the Court * *The text portions in italics denote correction of apparent omissions.*

On May 15, 1995, a trial operation of the equipment/device completed by Defendant was conducted at Ayabe Onsen Hot Spring. Following this, on May 16, 21, and 22 of the same year, the trial operation was conducted at the same site, but the temperature at the opening part of the well was not more than 26.4°C and the increase in the spring water was not observed.

Defendant transferred the above equipment/device from Ayabe Onsen Hot Spring to Akema Onsen Hot Spring and conducted a trial operation of the equipment/device a ("test for transfer of the hot spring improvement device") for eight days from June 6, 1995 to June 13 of the same year at Akema Onsen Hot Spring. At the time of the trial operation, Plaintiff was present at the site.

...The Trial Decision defined the content of the trial operation conducted by Defendant at Akema Onsen Hot Spring for eight days starting from June 6, 1995 as "the Invention of Akema Onsen Hot Spring" and identified the content as follows: "An apparatus for raising a temperature and increasing a volume of a hot spring well, the apparatus comprising: a hot spring submerged pump that includes a pumping-up pipe; a water return pipe arranged in the deep layer part of a hole of a hot spring well, the water return pipe including a water

discharge pipe at a lower end thereof, wherein the hot spring submerged pump and the water return pipe being provided in a hot spring well; and a thermal induction promoting device connected to the pumping-up pipe, the water return pipe, and a hot spring supply pipe, thermal induction promoting device being configured to divide the hot water into a portion supplied to the hot spring supply pipe and the other portion supplied to the water return pipe, the water return pipe being configured to supply water into the hot spring well, wherein the water is supplied from another well via a pipe" (page 7, lines 14 to 18). Further, The Trial Decision determined that, when the content is construed as an invention, it was worked for eight days from June 6, 1995 prior to filing of the Patent Application in the site of Defendant in shimizu-cho, Oodate City. However, as no evidence was submitted that should substantiate the fact that it was publicly worked at that site, and the Trial Decision determined that it cannot be said that the Invention was publicly worked (page 8, line 6 to page 10, line 11).

In response to this, Plaintiff alleges that this invention was worked at the site of the hot spring well (Akema Onsen Hot Spring) that was being drilled in the material stockyard of Defendant in an open state outside of any building, and at that point, the site in question was about five meters away from the wire net fence installed on the boundary between the site and the sidewalk without any screens provided there and it was in a "state readily viewable" from the pedestrians and people passing through the roads, and thus alleges that the above determination of the Trial Decision is erroneous.

B. In response to the above allegations by Defendant, the hot spring well in the site of Defendant is, according to the foregoing findings, located in the Defendant's site that Defendant used as the material stockyard, and wire net fence was installed on the boundaries between the above site and the public road, and at the time of the "test for transfer of hot spring improvement device" being conducted, entry therein of third parties was prohibited. Accordingly, even when third parties was basically able to see, from a public road, the state of the content being carried out as alleged by Plaintiff, the details of "the state of being inserted into a deep layer part in the pit and secured to the hole bottom of the pit and having the drain port arranged at the end portion of the deep layer part," which is the essential part of the Corrected Invention 1 (identical with that of the Invention 1), could not be seen by third parties beyond the above possibility of being seen from the public road. Also, no situation was found where the content of the invention was to be disclosed to third parties if they wish. As such, the Invention 1 was worked while it remained in secret and it cannot be recognized that the Invention 1 was publicly worked (just for the record, with regard to the above mentioned the "test for transfer of hot spring improvement device" that was conducted on and starting from June 6, 1995, the test in question appeared in the Hokiroku Shimbun dated June 14, 1995 (item (1) of Exhibit A11) and in the Oodate Shimpo dated June 19 of the same year (item (2) of Exhibit A11). However, even in light of these articles, the specific content of the Invention 1 cannot be identified).

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Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 3, 3.1.4
Classification of the Case	56: Whether or not the invention can be deemed to be a publicly worked invention
Keyword	

1. Bibliographic Items

Case	"Dust collection bag for vacuum cleaner" (Trial for Invalidation) Intellectual Property High Court Decision, April 10, 2006 (2005 (Gyo KE) No. 10384)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H07-108293 (JP H07-265234A)
Classification	A47L 9/14
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division, Presiding judge Tomokatsu TSUKAHARA, Judge Teruhisa TAKANO, Judge Tatsubumi SATO

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention relates to a dust storage bag for a vacuum cleaner. The claimed invention is an invention configured, so as to be readily attached to the dust collection sections of various vacuum cleaners, by integrating by adhesion a main body of the bag and a paper mouth sheet having an introduction port for introducing dusts, the paper mouth sheet including an attaching hole and a perforation.

(2) Outline of Publicly Worked Invention (Findings of Trial Decision)

(i) A paper pack (Article 1 Prior to Application) of Exhibit Ken Exhibit A1: a vacuum cleaner paper pack (type without a recessed section) of Matsushita Electric Industrial Co., Ltd. (described in a brochure of vacuum cleaners created by Matsushita Electric Industrial Co., Ltd. and published in November 1982)

"...The Article 1 Prior to Application is ...a paper mouth sheet (20) having an introduction port (21) for introducing dusts..."

"...a small hole is provided at a position on a virtual line extending from the center of the introduction port in a direction that is vertical with respect to one side of the paper mouth sheet, the small hole having a very small inner diameter relative to the inner diameter of the introduction port." (Extracts taken from the court decision)

(ii) A paper pack (Article 2 Prior to Application) of Exhibit Ken Exhibit A2: a vacuum cleaner paper pack (type having a recessed section) of Matsushita Electric Industrial Co., Ltd. (described in a brochure of vacuum cleaners created by Matsushita Electric Industrial Co., Ltd. and published in September 1985)
"...differs from Article 1 Prior to Application in that it includes a recessed portion (68) for ensuring one side of the paper mouth sheet to be adapted to the shape of the dust collection section of the vacuum cleaner, except for which the shape and dimensions are identical with those of the Article 1 Prior to Application..." (Extracts taken from the court decision)

(3) The Claims (Only claim 1 is cited therefrom.) (the Invention 1)
[Claim 1] A dust storage bag for a vacuum cleaner configured by integrating by adhesion a main body of the bag and a paper mouth sheet having an introduction port for introducing dusts, characterized by the fact that the paper mouth sheet includes an attaching hole and a perforation according to which the paper mouth sheet is bent and taken away so as to be adapted to a shape of a dust collection section of various vacuum cleaners, and that the position of the attaching hole is on the surface of the paper mouth sheet where bag main body is not provided, and the position is defined to be 90 degrees rightward away from the perforation with respect to the introduction port serving as the center.

(4) Procedural History

May 1, 1987	:	Filing of application for design registration (Japanese Design Application No. S62-17549)
June 28, 1993	:	Filing of new application for design registration for part of the above application for design registration (Japanese Design Application No. H5-19956)
April 7, 1995	:	The above new application for design registration converted into patent application
September 19, 1996	:	Registration of establishment of the patent right (Patentee was the Plaintiff withdrawn from the suit) (See the above-described "The Claims.")
September 5, 2003	:	Filing of a trial for patent invalidation by Defendant (Muko No. 2003-35374)
June 16, 2004	:	Trial Decision invalidating the patent
February 22, 2005	:	Patent right transferred to Intervener (date of registration in Patent Register) (Subsequently, Plaintiff withdrew from the suit.)

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

Appeal Decision (cited from the Court Decision)
According to the written answer dated December 5, 2003 submitted in the proceedings of the Invalidation Trial, it is noted that Demandee does not have the intention to dispute the fact that the Article 1 Prior to Application or the Article 2 Prior to Application was publicly worked prior to the filing date of the Patent Application. In addition, according to Exhibit A1-1 and Exhibit A1-2, the Article 1 Prior to Application appears in the

brochure of the vacuum cleaners created by Matsushita Electric Industrial Co., Ltd. and published in November 1982 prior to filing of the Patent Application for the patented invention. Accordingly, it can be inferred that, at the time of that month, it was manufactured and sold as a dust storage bag for a vacuum cleaner manufactured by Matsushita Electric Industrial Co., Ltd.

Also, according to Exhibit A2-1 and Exhibit A2-2, the Article 2 Prior to Application appears in the brochure of the vacuum cleaners created by Matsushita Electric Industrial Co., Ltd. and published in September 1985 prior to filing of the Patent Application for the patented invention. Accordingly, it can be inferred that, at the time of that month, it was manufactured and sold as a dust storage bag for a vacuum cleaner manufactured by Matsushita Electric Industrial Co., Ltd.

Further, the above inference of the invention being publicly worked is consistent with the fact that a filter bag for a vacuum cleaner having the same configuration as that of the Article 1 Prior to Application is described by way of example in the Description and the drawings (in particular, see FIG. 2) of the patent application for the invention of the vacuum cleaner filed on November 25, 1983 by Matsushita Electric Industrial Co., Ltd. (see JP S60-114229A (Exhibit B6 of this action) laid open on June 20, 1985 prior to the filing date of the Patent Application).

In view of the foregoing facts, it can be concluded that the Article 1 Prior to Application and the Article 2 Prior to Application were publicly worked prior to the filing date of the Patent Application.

Decision

Allegations by Plaintiff	Allegations by Defendant
Articles 1 and 2 Prior to Application as such do not have the date of manufacture printed thereon, ...the date of manufacture is not printed on the dust collection bag appearing in the Brochure, either. Further, the "notches" as mentioned in the Trial Decision are not printed on these dust collection bags. It is likely that Articles 1 and 2 Prior to Application did not originally have the notches, and it is considered that the Articles 1 and 2 Prior to Application were made by Defendant after filing of the Patent Application. Also, it appears that there are printed digits in the above Brochures though it is not clear what date is meant by them. Meanwhile, it is unclear when, where and for what purpose these Brochures were printed, and there is no evidence that may substantiate that they were distributed to many unspecified persons. Further, there is no description or suggestions of the above notches in JP S60-114229A	...Brochures were distributed to general consumers at stores or the like ...also, the products appearing in the Brochures were sold to consumers as the products as of those dates described in the same Brochures. Among the dust collection bags appearing in these Brochures, ...comparison of the shapes of the produces makes it clear that the dust collection bag of type "AMC-Pl" is the Article 1 Prior to Application (Exhibit B9-1), and ...the dust collection bag of type "AMC-DPl" is the Article 2 Prior to Application (Exhibit B9-2). Also, it is made clear that the dust collection bags appearing in these Brochures are both a dust collection bag having notches upon reading of the enlarged pictures (Exhibit B5) of the dust collection bags described in Exhibit B4. ...It is clear that ...the dust collection bag of the Article 1 Prior to Application was openly sold by

(Exhibit B6) cited by the Trial Decision. Consequently, Exhibit B6 cannot be relied upon to conclude that the Articles 1 and 2 Prior to Application were publicly worked.	Matsushita Electric Industrial Co., Ltd. during the period from 1982 when the Brochure of Exhibit B4-1 was published to 1983. With regard to the Article 2 Prior to Application, it is clear that ...the dust collection bag of the Article 2 Prior to Application was openly sold by Matsushita Electric Industrial Co., Ltd. during the period from 1985 when the Brochure of Exhibit B4-2 was published to 1987.

Judgment by the Court

(1) First, Article 1 Prior to Application is to be examined.

...The dust collection bags are described in Exhibit B4-1-1 which is a brochure as of November 1982 of the vacuum cleaners and the like and Exhibit B4-1-2 which is a brochure of the same type of products and the like as of July 1983, both of which were manufactured by Matsushita Electric Industrial Co., Ltd. (Exhibit B5-1 and Exhibit B5-2 are enlarged pictures thereof, respectively) It is recognized that (1) they are the dust collection bags for a vacuum cleaner whose paper mouth sheet and bag main body are integrally formed in the similar manner as in the case of the Article 1 Prior to Application, and (2) their paper mouth sheets have the same shape and structure as those of the Article 1 Prior to Application, and the introduction port, perforation, small hole, and notches (at two regions) provided in the paper mouth sheet have the same shapes and the same positional relationships as those of the corresponding sections of the Article 1 Prior to Application, and (3) their bag main body includes the descriptions enclosed by the arrows indicating the insertion direction as well as the indication of a frame in a similar manner as in the case of the Article 1 Prior to Application, In view of the foregoing, Article 1 Prior to Application is identified to be the dust collection bag of type AMC-P1 that had been manufactured and sold by Matsushita Electric Industrial Co., Ltd. prior to filing of the Patent Application, and it is thus found that the dust collection bag that includes the paper mouth sheet having the same configuration and shape as those of the paper mouth sheet of the Article 1 Prior to Application was manufactured and sold prior to filing of the Patent Application.

B Just for the record, it is noted, as alleged by Intervener, that the date of manufacture is not printed on the Article 1 Prior to Application. Meanwhile, when the Article 1 Prior to Application is compared with the dust collection bag appearing in Exhibit B4-1-2, they do not differ in the shapes and configurations of their paper mouth sheets as well as the descriptions of the bag main bodies. As such, it is recognized that they were manufactured and sold substantially at the same period...

...It is clear that the dust collection bag of the Article 1 Prior to Application was manufactured and sold by around February 1987 at the latest.

(2) Next, the Article 2 Prior to Application is to be examined

A ...The dust collection bags are described in Exhibit B4-2-1 which is a brochure as of September 1985 of the vacuum cleaners and the like and Exhibit B4-2-2 which is a brochure of the same type of products and

the like as of January 1987, both of which were manufactured by Matsushita Electric Industrial Co., Ltd (Exhibit B5-3 and Exhibit B5-4 are enlarged pictures thereof, respectively). It is recognized that (1) they are dust collection bags for a vacuum cleaner whose paper mouth sheet and bag main body are integrally formed in the similar manner as in the case of the Article 2 Prior to Application, and (2) their paper mouth sheet has the same shape and structure as those of the Article 2 Prior to Application, and the introduction port, perforation, small hole, and notches (at two regions) provided in the paper mouth sheet have the same shapes and the same positional relationships as those of the corresponding sections of the Article 2 Prior to Application, and (3) their bag main body includes the descriptions enclosed by the arrows indicating the insertion direction as well as the indication of a frame in a similar manner as in the case of the Article 2 Prior to Application,

In view of the foregoing, the Article 2 Prior to Application is identified to be the dust collection bag of type AMC-DP1 that had been manufactured and sold by Matsushita Electric Industrial Co., Ltd. prior to filing of the Patent Application, and it is thus found that the dust collection bag that includes the paper mouth sheet having the same configuration and shape as those of the paper mouth sheet of the Article 2 Prior to Application was manufactured and sold prior to filing of the Patent Application.

B With regard to the Article 2 Prior to Application, it is noted, as alleged by Intervener, that the date of manufacture is not printed on the Article 2 Prior to Application, and the Article 2 Prior to Application, the dust collection bag of Exhibit B4-2-1, and the dust collection bag of Exhibit B4-2-2 differ from each other in the indications of their bag main bodies and the like as determined in the foregoing. It may thus be considered that their periods of manufacturing and selling differ from each other. However, according to the revision history of Exhibit B4-6-1 which is identified to be the design drawings of the dust collection bag of AMC-DP1 type, ...it is reasonable to recognize that the Article 2 Prior to Application was manufactured and sold by January 1987 at the latest.

(3) ...There is not an unnatural aspect that may indicate that the two notches of the Articles 1 and 2 Prior to Application were subsequently created.

(4) Intervener alleges that it is unidentified when, where and for what purpose the above Brochures were printed and no evidence is found that shows that they were distributed to many unspecified persons. However, according to the content of the Brochures, it is clear that the Brochures in question were created to be distributed via dealers and the like to many and unspecified clients. Also, the date or the given point of time of the commodities appearing in the brochures can be understood from the descriptions of the Brochures. Hence, the court does not adopt the allegations by Intervener.

(57)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 4 3.
Classification of the Case	57: Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify a product using the use of the product in the claim
Keyword	

1. Bibliographic Items

Case	"An electrostatic latent image developing toner" (Opposition to the grant of a patent) Intellectual Property High Court Decision, August 31, 2006 (2005 (Gyo KE) No.10665)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H5-284559 (JP H7-114204A)
Classification	G03G 9/08
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Ryoichi MIMURA, Judge: Yuji KOGA, Judge: Kazuhide SHIMASUE

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is to provide an electrostatic latent image developing toner that uses a polyester resin as main binder component and is compounded by 1-5 wt. % of Fischer-Tropsch wax. In low fixing temperature, excellent fixing property can be obtained, and reducing power consumption and accelerating a device are possible. In addition, the generation of offset, especially, high temperature offset is prevented, and fixation of cleaner-less is possible. Furthermore, the generation of drum-filming can be prevented, and the entire performance is excellent.

(2) State of the art

(i) Publication 1 (Cited Invention): JP H3-139663A (Finding of Decision)

"A toner for heat-fixing, using thermoplastic resin such as polyester, styrene-butylacrylate copolymer whose softening point is in 90-150 °C range as a binder, and being grinded and classified after melting and mixing a toner component compounded by at least one or more types of wax whose melting point is lower than said thermoplastic resin, as mold releasing agent" (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] An electrostatic latent image developing toner, comprising: a grinded toner, using a polyester resin whose softening point is in 120-140 °C range as main binder component, and made by being grinded and classified, after melting and mixing a toner component compounded by 1-5 wt. % of a Fischer-Tropsch wax whose melting point is in 90-110 °C range that is lower than softening point of said polyester resin and by low-molecular-weight polyolefin wax such as polyethylene wax and polypropylene wax; being used in a way as fixing on paper by making a toner image formed with said toner to contact with a heat-fixing roller that does not have a cleaner pad.

(4) Procedural History

February 14, 2003	:	Registration of Patent Right
	:	Opposition to the grant of a patent (Igi No.2003-72540)
February 22, 2005	:	Request for amendment by Plaintiff (Patent holder) (See above "The Claims")
July 8, 2005	:	Decision that "amendment is accepted. ... the patent is revoked."

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

Decision
Difference 3: concerning a heat-fixing roller for fixation of toner image, in the present invention, a heat-fixing roller for using fixation of toner image is not equipped with a cleaner pad, while in the embodiment invention as stated in Publication 1, it is not stated that a heat-fixing roller is such constitution. ... when examining on Difference 3, an electrophotographic device has been conventionally requested to be downsized and lightened. Thus, it is well-known problem that a heat-fixing roller for fixation of toner image is not equipped with a supplemental device (See, for example, the statements of paragraph [0003], [0004] of JP H4-316074A and the statements of upper right field of Page 2 to Page 3 of JP H4-188153A). In addition, in a toner for heat-fixing as stated in Publication 1, offset is evaluated in such a fixation test as observing a roller with a heat roller external fixing machine that does not have a cleaner pad and is equipped with an upper roller made of fluorine resin and with a lower roller made of silicon rubber, and Table 1 as the test result states that, in any of the embodiment 1, 3 and 4, offset is not generated within a range of certain degree of temperature. Thus, it can be predicted that, in an electrostatic latent image developing toner using a polyester resin whose softening point is in 120-140 °C range as main binder component, and compounded by 1-5 wt. % of a Fischer-Tropsch wax whose melting point is in 90-110 °C range that is lower than softening point of said polyester resin and by low-molecular-weight polyolefin wax such as polyethylene wax and polypropylene wax, offset is not generated within a range of certain degree of temperature, and it is apparent that, if offset-resistant performance of a toner is excellent, there is no need of equipping a heat-fixing roller with a cleaner pad. Accordingly, a person skilled in the art can easily conceive of using such electrostatic latent image developing toner in a heat-fixing roller equipped with a cleaner pad.
Decision

Allegations by Plaintiff	Allegations by Defendant
It is admissible that "an electrophotographic device has been conventionally requested to be downsized and lightened. Thus, it is well-known problem that a heat-fixing roller for fixation of toner image is not equipped with a supplemental device" as the premise of determination of Difference 3 in the decision. However, the decision ignores the industrial meaning that the major problem that a heat-fixing roller is not equipped with a supplemental device was solved by the present invention for the first time, and thus is erroneous.	The scope of claims in the amended description states that "the use in a way as fixing on paper by making a toner image formed with said toner to contact with a heat-fixing roller that does not have a cleaner pad". However, it cannot be said that the statement means that the constitution of the present invention is limited.

Judgment by the Court

Claim 1 of the claims of the amended description has the statement added in the amendment that "the use in a way of fixing on paper by making a toner image formed with said toner to contact with a heat-fixing roller that does not have a cleaner pad."... each statement of paragraphs [0002], [0006] and [0024] of the description is same before and after the amendment, and only states that it is preferable to "use in a way of fixing on paper by making a toner image formed with said toner to contact with a heat-fixing roller that does not have a cleaner pad." ... an electrophotographic device has been requested to be downsized and lightened before the filing of the application, and it is recognized that it was well-known problem that a heat-fixing roller for fixation of toner image does not include a supplemental device. Thus, the "use in a way of fixing on paper by making a toner image formed with said toner to contact with a heat-fixing roller that does not have a cleaner pad" is not considered to be new use and is merely an obvious method of use for a person skilled in the art.

Accordingly, in the statement of Claim 1 of the claims of the amended description, the wording of "used in a way of fixing on paper by making a toner image formed with said toner to contact with a heat-fixing roller that does not have a cleaner pad" only indicates the subjective recognition for the intended use of "a toner" pertaining to the present invention, and with regard to the present invention as the invention of products, is not considered to mean the limitation of the constitution.

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Relevant portion of Examination Guidelines	Part III Chapter 2 Section 4.3
Classification of the Case	57: Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify a product using the use of the product in the claim
Keyword	Use invention

1. Bibliographic Items

Case	"Wrinkling suppressing agent" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, November 29, 2006 (2006 (Gyo KE) No. 10227)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-066079 (JP H9-255548A)
Classification	A61K 8/97
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding Judge: Tetsuhiro NAKANO, Judge: Yoshiyuki MORI, Judge: Kouichi TANAKA

2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention provides a wrinkling suppressing agents containing, as active ingredient, Thujopsis dolabrata or its extracts. It has excellent effects in preventing formation of wrinkles induced by skin exposure to ultraviolet radiation and is useful as a prophylactic agent for external use for skin aging especially for wrinkles.

(2) State of the art

(i) Cited document 1 (Cited Invention): JP H5-345719A (Identification of Appeal Decision)

"Skin whittening cosmetic composition including, as active ingredient, soluble in organic solvents, monohydric or polyhydric lower alcohols or mixtures thereof each having intermediate polarity, among the extract components from the plants belonging to Cupress aceae." (cited from the Court Decision)

(3) The Claims (Claimed Invention)

[Claim 1] A wrinkling suppressing agent by using Thujopsis dolabrata or its extract as an active ingredient.

(4) Procedural History

March 22, 1996	:	Patent Application
November 7, 2002	:	Decision of Refusal
December 19, 2002	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2002-24450)
January 20, 2003	:	Amendment (See the above "The Claims")
March 24, 2006	:	Appeal Decision to "Dismiss the appeal"

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

<table>
<tr><td colspan="2">Appeal Decision (cited from the Court Decision)</td></tr>
<tr><td colspan="2">When the composition of Citation A (Note added by the court decision: "Cited document" in Principal Action. Hereafter the same.) is applied to skin, which has the same active ingredient in almost the same amount, wrinkling suppressing effect should have been achieved along with whitening effect. The difference mentioned above is merely considered as a difference in expression that is, the effect of Thujopsis dolabrata extracts, an active ingredient in the composition, is recognized as whitening effect and so identified it as skin whitening cosmetic composition, or as wrinkling suppressing effect and so identified it as wrinkling suppressing agent. In other words, the claimed invention is considered as nothing more than a skin whitening cosmetic composition containing Thujopsis dolabrata extracts of Citation A that has a newly found wrinkling suppressing effect, which generates no exceptional use being novel. ...skin darkening and pigmentation of skin are, along with the formation of wrinkles, the phenomena exemplary to damage beauty and the prevention thereof is aimed to obtain cosmetic effect to keep skin healthy and beautiful regardless of troubles of skin tan and wrinkles already exist. In addition, the composition of Citation A and the wrinkling suppressing agent of the claimed invention are both used for the user expecting the cosmetic effect that provide the same effect. Thus, it is not considered to create an external agent for novel use.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The use of known skin external agent having Thujopsis dolabrata extracts as active ingredients for wrinkle suppressing agent is grounded in the technological effect newly found which is a technical feature specified in function. Furthermore, this technical feature, not stated in cited document, may inherently be generated when skin whitening cosmetic composition containing Thujopsis dolabrata extracts of cited document is implemented, however, a wrinkle suppressing agent having Thujopsis dolabrata extracts</td><td>Allegations by Defendant
The active ingredients of "wrinkle suppressing agent" of the claimed invention such as Thujopsis dolabrata extracts and the active ingredients of "skin whitening cosmetic composition" of Cited Invention are not different in the amount and also the forms they may take would not be different, such that the "skin whitening cosmetic composition" of Cited Invention applied to skin should provide "whitening effect" as well as "wrinkle suppressing effect." Furthermore, the effect like "wrinkle suppressing effect" is highly</td></tr>
</table>

of the claimed invention as an active ingredient is novel. ... the above judgement by Appeal Decision alleging that the difference between the wrinkle suppressing agent and skin whitening cosmetic composition is merely a matter of expression is erroneous. ...skin darkening and pigmentation of skin and the formation of wrinkles are completely different phenomena in terms of affected area, cause and mechanism, so that these are not considered as same phenomena that damage beauty. Also, the wrinkle suppressing agent is used for those who expect to suppress formation or growth of wrinkles on face and the skin whitening cosmetic composition is used for those who expect improvement/prevention of spots and freckles and the like caused by sunburn. Thus, these products are not used for the users expecting the same effect.	visible and tactile to five senses, so that the user can easily experience the effects when "skin whitening cosmetic composition" is applied/used to skin. Therefore, it is not possible to merely recognize the effects and clearly distinguish the "skin external agent" which claims such effects as mentioned above and the known "skin whitening cosmetic composition" as different products and to recognize that "skin external agent" creates exceptional novel use.

Judgement by the Court

The defendant alleges that it is not possible to recognize that the claimed invention creates an exceptional novel use on the basis of the rationale that the "skin whitening cosmetic composition" of Cited Invention applied to skin should provide "skin-whitening effects" as well as "wrinkle-inhibitory effects (anti-wrinkle effects)," and the effects like "wrinkle-inhibitory effects" are highly visible and tactile to the five senses, so that a user can easily experience these effects when "skin whitening cosmetic composition" is applied/used on his/her skin.

However, although the "skin whitening cosmetic composition" of Cited Invention applied to skin provides "skin-whitening effects" as well as "wrinkle-inhibitory effects," no prior art document is found stating to that effect being provided by the time of filing of the present application and thus, it is not possible to acknowledge that the "wrinkle-inhibitory effects" are known to be provided.

...In "COSMETIC HANDBOOK (Keshohin Handbook)" edited by Shigeru SEKINE, a representative director of Nikko Chemicals Co., Ltd., Nikko Chemicals Co, Ltd. etc. (published November 1, 1996, Exhibit B1), "lactic acid" (page 469, "Tables 3, 6") and "magnesium salt of L-ascorbic acid phosphoric acid ester" (page 463, right column; page 465, left column) are stated as having both skin-whitening effects and wrinkle - inhibitory effects. However, these are substances different from "Thujopsis dolabrata or its extracts" set forth in the claimed invention and even if they have both the skin-whitening effects and wrinkle-inhibitory effects, it is not acceptable that a person skilled in the art at the time of filing of the present application could recognize Cited Invention to have effects also on "wrinkles." In addition, cosmetics having both the skin-whitening effects and wrinkle-inhibitory effects are listed in Exhibits B3 to B5 but these cosmetics are the source from the homepages dated back in July 31, 2006 and the active ingredients thereof are the substances different from

"Thujopsis dolabrata or its extracts" set forth in the claimed invention. Thus, it is not acceptable that a person skilled in the art at the time of filing of the present application could recognize Cited Invention to have effects also on "wrinkles" even though the cosmetics having both the skin-whitening effects and wrinkle-inhibitory effects are listed in the homepages.

Furthermore, ... it is not acceptable that a person skilled in the art at the time of filing of the present application could recognize Cited Invention to have effects also on "wrinkles" even if the cosmetics are common in applying to skin by expecting preventive effects from skin troubles caused by skin exposure to ultraviolet radiation among cosmetic effects.

Therefore, none of the allegations by the defendant can be adopted.

(6) To summarize, it is not acceptable that a person skilled in the art at the time of filing of the present application could recognize "skin whitening cosmetic composition" of Cited Invention to have effects also on "wrinkles," and thus the use of the claimed invention of "wrinkle-inhibitory" is recognized to provide a new use that is different from the "skin whitening cosmetic composition" of Cited Invention.

(58)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 4, 4.
Classification of the Case	58: Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify the invention of subcombination by using a matter related to other subcombination in the claim
Keyword	

1. Bibliographic Items

Case	"Liquid container" (Trial for invalidation) Intellectual Property High Court Decision, February 8, 2011 (2012 (Gyo KE) No. 10056)
Source	Website of Intellectual Property High Court, HANREI TIMES No.1357, page 190
Application No.	Japanese Patent Application No. 2004-330952 (JP 2006-142484A)
Classification	B41J 2/175
Conclusion	Acceptance
Related Provision	Article 29(2)
Judges	IP High Court Second Division, Presiding judge Shuhei SHIOTSUKI, Judge Tomoko MANABE, Judge Minoru TANABE

2. Overview of the Case

(1) Summary of Claimed Invention

In a liquid ink container that can be attached to or removed from a recording device including liquid ink container position detection means configured to detect an installation position of the liquid ink container by using a common signal line to installation positions of a plurality of liquid ink containers in a recording device such as an ink jet printer or the like to carry out emission control of a display such as a LED and receiving light with light receiving means so that the emission control of the display that identifies the installation positions of the liquid ink containers can be carried out, the claimed invention comprises a contact that can be electrically connected with a device-side contact, an information holding unit capable of holding color information indicating an ink color of at least liquid ink container, a light emitting unit configured to emit light for projection to the light receiving means, and a control unit configured to control emission of the light emitting unit depending on a signal related to color information to be inputted from the contact and the color information held by the information holding unit.

(2) The Claims (After correction) (Only Claim 1 stated) (Invention 1 of this case)

[Claim 1] A liquid ink container, comprising:

a carriage that has a plurality of liquid ink containers installed and moves;
a device-side contact that can be electrically connected with a contact included in the liquid ink container; and
one light receiving means for position detection which are such arranged that the opposed liquid ink containers switch places as a result of the movement of the carriage and which receive light from a light emitting unit of the liquid ink container,
the liquid ink container, having;
liquid ink container position detection means configured to detect installation positions of the liquid ink containers by receiving the light with the light receiving means; and
an electric circuit having wiring electrically connected in common to the device-side contact which is connected to the contact of each of the installed liquid ink containers and configured to generate a signal related to color information, wherein
in the liquid ink container that can be attached to or removed from the carriage of a recording device wherein the light emitting unit of the liquid ink container of an ink color identified depending on a position of the carriage is illuminated, and based on light reception result of that light, the liquid ink container position detection means detects an installation position of the liquid ink container, the liquid ink container, having:
the contact that can be electrically connected with the device-side contact;
an information holding unit capable of holding color information indicating an ink color of at least liquid ink container;
the light emitting unit configured to emit light for projection to the light receiving means; and
a control unit configured to control emission of the light emitting unit depending on a signal related to the color information to be inputted from the contact and the color information held by the information holding unit.

(3) Procedural History

November 15, 2004	:	Patent application by the Defendant (patentee) (Date of claim of priority: December 26, 2003)
April 14, 2006	:	Setting and registration of the patent
May 19, 2009	:	Request for a trial for patent invalidation by the Defendant (Muko No. 2009-800101)
August 3, 2009	:	Request for correction by the Defendant (patentee) (See the "The Claims" described above.)
January 26, 210	:	Appeal decision of "The corrections are allowed. ... The patent shall be invalidated."

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

Appeal Decision (cited from the Court Decision)
The invention 1 of this case is an invention of a liquid ink container, and it depends on a configuration on the side of a recording device whether or not the recording devices includes light receiving means configured to receive light from a light emitting unit of the liquid ink container ... Thus, the limitation of 'for projection to the light receiving means' does not limit a configuration of the light emitting unit of the liquid ink container.

In addition, provision in the recording device of the light receiving means configured to receive light from the light emitting unit of the liquid ink container is ... what a person skilled in the art can easily achieve by applying the well-known art, and in such a case, the light emitting unit of the liquid ink container is a "light emitting unit configured to emit light for projection to light receiving means".

In light of the above, a person skilled in the art can easily make it possible to comprise the configuration related to the difference 2 of the invention 1 of this case in the cited container invention, based on the well-known technology.

Decision

Allegations by Plaintiff	Allegations by Defendant
(1) The requirement of "emitting light to be projected to the light receiving means" stated in the invention 1 of this case provides a destination where light emitted by the light emitting unit of the liquid ink container is transmitted. On the one hand, arrangement or the like of the light emitting unit is identified so that light is transmitted to the destination (transmission destination). Therefore, it is obvious that a specific structure of the light emitting unit is identified so that the light emitting unit fulfills a required function. Then, the above-mentioned requirement of "emitting light to be projected to the light receiving means" shall limit the structure of (the light emitting unit of) the liquid ink container. Hence, although the appeal decision determines that the above-mentioned requirement does not limit the configuration of the light emitting unit of the liquid ink container, it is an error.	(1) The invention 1 of this case is an invention related to a liquid ink container, and a configuration on the side of the recording device in which the liquid ink container is installed shall not limit the configuration of the liquid ink container. Thus, a configuration to which light projected from the light emitting unit is directed does not limit the configuration of the liquid ink container, either. Furthermore, even if only an object of light, which is "for projection to the light receiving means", is stated in the claims, that does not identify the configuration of the light emitting unit to be provided in the liquid ink container. (2) As stated in (1) above, the invention 1 of this case is an invention related to a liquid ink container, and a configuration on the side of the recording device in which he liquid ink container is installed shall not limit the configuration of the liquid ink container.

cvJudgment by the Court

(2) It is obvious that the claims of the invention 1 of this case is as stated earlier, that according thereto, the configuration of the invention 1 of this case relates to the liquid ink container assuming a system which combines the liquid ink container and the recording device which installs it, and that a specific liquid ink container dedicated to the system, paired with a configuration of the recording device corresponding thereto, constitutes the invention.

Therefore, in deliberation of how easy it is to conceive the invention 1 of this case, it is an error to exclude presence of the recording device to make deliberations, and it can be stated that the limitation in the difference 2 of "for projection to the light receiving means" limits the configuration of the light emitting unit of the liquid

ink container. Thus, the determination of the appeal decision about the difference 2 that is contrary thereto is an error.

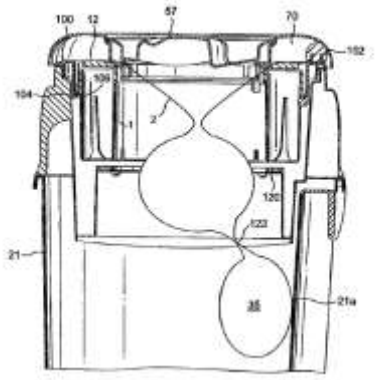
(58)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 4, 4.
Classification of the Case	58: Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify the invention of subcombination by using a matter related to other subcombination in the claim
Keyword	

1. Bibliographic Items

Case	"Waste storage device" (Trial for invalidation) Intellectual Property High Court Decision, October 11, 2011 (2011 (Gyo KE) No. 10043)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2009-135619 (JP 2009-263138A)
Classification	B65F 1/06
Conclusion	Dismissal
Related Provision	Article 29(1)(iii), Article 29(2), Article 36(6)(ii)
Judges	IP High Court Second Division Presiding Judge Shuhei SHIOTSUKI, Judge Kenjiro FURUYA, Judge Minoru TANABE

[FIG. 4]



2. Overview of the Case

(1) Summary of Claimed Invention

The claimed invention is a storage apparatus for storing wastes such as a baby diaper or the like and a cassette used therein. The claimed invention is such configured that a cassette 1 through the center of which tubing 2 is pulled out downward is equipped in a compartment in the upper part of the storage device.

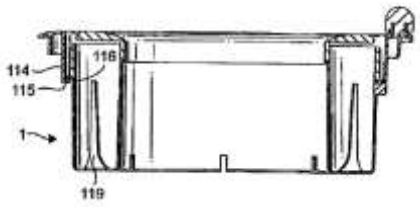
(2) Disclosure of Detailed Description of the Invention (Finding of the appeal decision)

"...In the patent description of this case, regarding the above-mentioned 'configuration that is provided in the outer wall to support and rotate the waste storage cassette, protrudes from the outer wall, and is equipped to engage with a waste storage cassette rotation device provided within the compartment', in [0017], there is the statement on 'engagement' for 'rotating' the waste storage cassette that 'the rotatable disk engages with the cassette and the cassette can be manually twisted or rotated without touching the cassette itself or the tubing'.

Furthermore, regarding the 'engagement' for 'rotation', although it is not for the engagement of 'configuration ... protruding from the outer wall ... (of) the waste storage cassette' and 'waste storage cassette rotation device', in the patent description of this case, it is stated in [0023] that 'the annular flange 106 on the cassette is placed on the configuration formed in the compartment itself, and the disk 100 includes a configuration like a plurality of notches in the cassette and a configuration like a plurality of protrusions having engagement action. In any case, cassette rotation means which is simpler and has less resistance to rotate is provided.' and in [0026] that 'The protrusion 118 protruding from a lower surface of the outer cylindrical wall engages with a concave or a hole 119 in the cassette 1 in order to ensure complete rotation engagement." and that "A plurality of axially-directed ribs engaging with cooperating protrusions on the rotatable disk 100 and ot[[FIG. 6] ı unit can be carried.

In addition, in [0026], the expression 'engagement' is not used, although it is also stated that '(the inner cylindrical wall 114 hangs down from the inner end of the ring 110, and) as can be seen from Fig. 6, includes an annular support flange 115 protruding to the inner direction which specifies the shoulder which supports the cassette 1 on the base thereof. The cassette 1 includes, on the outer wall thereof, an annular flange or lip 116 resting on the support flange 115 and protruding to the outer direction.' and that the cassette 'includes the annular flange or lip 116 resting on the support flange 115 and protruding to the outer direction". (Extracted from the decision)

【図 6】



(3) The Claims (Only claim 9 stated) (Patented invention 1)

[Claim 9] A waste storage cassette for being rotatably mounted in a compartment which is equipped in an upper part of a waste storage device, the waste storage cassette having an inner wall defining an almost cylindrically shaped core, an outer wall, a storage unit containing waste storage tubing provided between the inner wall and the outer wall, and a configuration that, to support and rotate the waste storage cassette, is provided on the outer wall, protrudes from the outer wall, and is equipped to engage with a waste storage cassette rotation device provided within the compartment, the waste storage cassette being configured to be suspended from the waste storage cassette.

(4) Procedural History

June 5, 2009	:	Patent application by the Defendant (patentee) (Date of claim of priority: October 23, 2003/UK)
November 6, 2009	:	Setting and registration of the patent (See the "The Claims" described above.)
March 29, 2010	:	Request for a trial for patent invalidation by the Defendant (Muko No. 2010-800055)
January 4, 2011	:	Appeal decision that the request for the trial is dismissed.

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

Appeal Decision (cited from the Court Decision)
...The following are obvious: The matter regarding the waste storage device, 'for being engaged with a

waste storage cassette rotation device provided in a compartment which is equipped in an upper part of a waste storage device and being rotatably mounted' is the matter to identify a device and a state in which the 'waste storage cassette' itself is disposed. In addition, 'to engage with a waste storage cassette rotation device, to support and rotate the waste storage cassette' is the matter to identify the 'configuration that protrudes from the outer wall" of the 'waste storage cassette'. Furthermore, 'configured to be suspended from the waste storage cassette' is the matter to identify how the 'waste storage cassette' itself is disposed. Then, these matters for identifying are clear and, on the whole, the 'waste storage cassette' is clear.

Decision

Allegations by Plaintiff	Allegations by Defendant
...The statement in the claims of the patented invention 1 is ambiguous on whether content of the invention is truly the "waste storage cassette" itself or contains "a combined structure of the waste storage cassette and the waste storage device (waste storage cassette rotation device or the like)", ... which will unfairly restrict activities of third parties involved in manufacturing or sales. (1) If the patented invention 1 is an invention relating to the "waste storage cassette", the configuration of the "waste storage cassette" itself should be an issue when finding identical features and differences between the patented invention 1 and the cited invention 1. This is because use of a "waste storage cassette" by attaching it to a rotation device is very commonplace and merely a matter belonging to common general knowledge, and does not have any technical significance in a relation with an invention of a "waste storage cassette". ... The "engagement" in "to be engaged with the waste storage cassette rotation device" ... in the statement of the claims of the patented invention 1 is a term clearly having a meaning of "engage" as normal significance that said term has. ... The working effect of reliably fixing a relative position of the "waste storage cassette" and the "waste storage cassette rotation device" with respect to a rotation direction is simply achieved only by the configuration of a plurality of notches in the	As the appeal decision explains and indicates, it is obvious that the statement of "for being engaged with a waste storage cassette rotation device provided in a compartment which is equipped in an upper part of a waste storage device and being rotatably mounted" is the matter to identify a device and a state in which the 'waste storage cassette" itself is disposed. It is obvious that the statement of "to engage with a waste storage cassette rotation device, to support and rotate the waste storage cassette" is also the matter to identify the "configuration that protrudes from the outer wall" of the "waste storage cassette". Furthermore, it is obvious that the statement of "configured to be suspended from the waste storage cassette" is also the matter to identify how the "waste storage cassette" itself is disposed. In addition, these matters for identifying themselves are clear and the identified "waste storage cassette" is also clear. A general significance of "engagement" has a meaning of "two members are mutually engaged or a concave corresponds with a protrusion and is caught, thus rendering positions (relation) of both members to be 'engaged' immovable". ... The appeal decision follows such a general significance to interpret the significance of "engagement" referred to in the patented invention 1 or the like. Thus, the appeal decision does not violate the decision of the Supreme Court on the lipase case, and in the ... PCT description

"waste storage cassette" or the concaves or holes in the "waste storage cassette", which are a configuration other than the "configuration that protrudes from the outer wall of the waste storage cassette". However, the appeal decision does not question an "engagement" aspect of the "configuration that protrudes from the outer wall of the waste storage cassette" and the "waste storage cassette rotation device". Although there are no special circumstances such as that the technical significance of the statement in the claims cannot be understood clearly and unambiguously, or the like, the appeal decision, after reviewing the statement in the patent description in detail, looks at irrelevant other configurations, interprets the significance of the above-mentioned "engagement" as "having a configuration in which two objects interlock or a relative position of both is fixed as a result of the two objects engaging with each other or a protrusion thereof and a corresponding concave being caught", and finds the patented invention 1. The appeal decision accordingly finds the identical features and differences of the patented invention 1 and the cited invention 1, and thus such a finding of the appeal decision is an error.	in English which serves as a basis of the description of this case, the English word "engage" having a significance of "engaging a gear, etc." or the like is used as a word corresponding to the "engagement" referred to in the patented invention 1 or the like. Even if the "engagement" referred to in the patented invention 1 or the like is not clear unambiguously in the statement in the claims, it is interpreted by considering paragraph [0017] or the like in the description of this case that the above-mentioned "engagement" has the general significance as described above. Thus, even in such a case in which the "engagement" is not clear unambiguously, the interpretation of the "engagement" in the appeal decision does not violate the above-mentioned decision of the Supreme Court.

Judgment by the Court

The statement in the claims of Claim 9 (patented invention 1) ends with the "waste storage cassette", and it is indicated in the presentation of statement that it is an invention of the "waste storage cassette". In addition to this, ...it is natural that the element of "for being rotatably mounted in a small chamber which is equipped in an upper part of a waste storage device" ... requires that the waste storage cassette" has the structure to be mounted in the compartment of the upper part of the waste storage device and has the structure to be rotatable in the compartment, ...and is one matter specifying the configuration of the "waste storage cassette". In addition, ... the element of "is provided on the outer wall, protrudes from the outer wall, ... to engage with a waste storage cassette rotation device provided within the small chamber" is also a specific structure for implementing the above-mentioned rotatable configuration of the "waste storage cassette", and one matter specifying the configuration of the "waste storage cassette" .... Similarly, the element of "configured to be suspended from the waste storage cassette"... also requires that the "waste storage cassette" has a structure that

allows it to be suspended from the waste storage cassette rotation device, and one matter specifying the configuration of the "waste storage cassette". Therefore, it is obvious that the matters specifying the invention of the "waste storage cassette" are stated in the scope of claim of Claim 9, ... and it cannot be said that due to the content of the statement, the commercial activities of third parties involved in manufacturing or sales of the " waste storage cassette" will be unfairly restricted. Then, the invention for which a patent is sought (patented invention 1) is clearly stated in the claims of Claim 9 and the determination on sufficiency of the requirement of clarity (Patent Act, Article 36(6)(ii)) made by the appeal decision that explains and indicates accordingly is not an error.

...Since any of the elements such as "for being rotatably mounted in a small chamber which is equipped in an upper part of a waste storage device" or the like stated in the claim of Claim 9 is the matter to specify the configuration of the "waste storage cassette" and all of such matters specifying the invention are combined to specify one invention (see the Patent Act, Article 36(5)), whether or not the invention has inventive step in a relation with previous inventions can not be determined until the matters specifying the invention stated in the claims are reviewed as a whole. Thus, even if some of the matters specifying the invention belong to the common general knowledge, it is not appropriate to exclude this to find the invention.

...In determination of the significance of the "engagement" referred to in the patented invention 1 (Claim 9), since in the claims, there is the statement of "to support and rotate the waste storage cassette" before the statement of "a configuration that is provided on the outer wall, protrudes from the outer wall, and is equipped to engage with a waste storage cassette rotation device provided within the small chamber", the configuration (part) of the "waste storage cassette" "provided on the outer wall, protrudes from the outer wall" must "engage" with the "waste storage cassette rotation device" so that the configuration (part) can support the "waste storage cassette" externally and rotate the "waste storage cassette" in the small chamber". Therefore, it is obvious that the above-mentioned "engagement" must be in the aspect in which the configuration (part) of the "waste storage cassette" "provided on the outer wall, protrudes from the outer wall" can support the "waste storage cassette" externally and rotate the "waste storage cassette" in the small chamber.

Incidentally, on page 44 of "Collection of Patent Technical Terms (2nd edition)" that covers general terms used in a patent description, as an example of "engagement", there is the statement of "the right and left gears engage and rotation is transmitted. A receiving member and a movable protrusion engage and a door is closed.". Thus, when the word "engagement" is used in a patent description, it can be stated that the word is used in the sense that "two members are mutually engaged or a concave corresponds with a protrusion and is caught, thus rendering positions (relation) of both members to be 'engaged' relatively immovable". Therefore, this understanding of the meaning of "engagement" is general.

Then, it is interpreted that the "engagement" referred to in the patented invention 1 also refers to rendering a relative positional relation of the "waste storage cassette" and the waste storage cassette rotation device unchanged (immovable) by, for example, the outer wall protrusion part (configuration) of the "waste storage cassette" and a part of the waste storage cassette rotation device engaging with each other so as to support the "waste storage cassette" from the outside and to make the "waste storage cassette" rotatable in the small

chamber.

(58)-3

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 4, 4.
Classification of the Case	58: Finding of the invention and novelty and inventive step of the invention according to the claim that includes a description trying to identify the invention of subcombination by using a matter related to other subcombination in the claim
Keyword	

1. Bibliographic Items

Case	"Information Processing Device and Method, and Program" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 10, 2022 (2021 (Gyo KE) No. 10056)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2016-067886 (JP 2016-201106A)
Classification	G06Q 50/18
Conclusion	Dismissal
Related Provision	Article 29(1)(iii), Article 29(2)
Judges	IP High Court Third Division Presiding Judge Tamotsu SHOJI, Judge Takuya UEDA, Judge Michinori TSUNO

2. Overview of the Case

(1) Summary of Claimed Invention

The Invention in the Application is an information processing device operated by a first user comprising a gazette notifying means for notifying a server of the contents of the gazette concerning the intellectual property rights wanted to utilize, a response receiving means for receiving a predetermined response from second users' terminal via the server, and a response notifying means for notifying the server of the predetermined response.

It is hereby possible to easily present a large number of candidates who want to exploit the intellectual property rights to the holders of those rights, etc. who wish to effectively utilize their intellectual property rights.

(2) The Claims "amended" (Only Claim 1 is described.) "Amended Invention in the Application" (Claim Components described)

[Claim 1]

(A) an information processing device operated by a first user, and

(B) a gazette notifying means for identifying an intellectual property right that has not been used in a business but that the first user wants to effectively utilize from among one or more intellectual property rights held by the first user, and for notifying a server of information in the gazette concerning the intellectual property right as first information including information that serves as the basis for the extraction of second information and third information by the server;
(C) in the server ;
(C1) a predetermined character, figure, symbol, or a combination thereof, among the contents of a first document that may be included in the gazette identified by the first information notified by the gazette notifying means, is extracted as the second information;
(C2) a predetermined character, figure, symbol, or a combination thereof related to extracted aforementioned second information, among the contents of a second document that may be included in the gazette, is extracted as the third information;
(C3) among the plurality of the second users who have registered the prescribed characters, figures, symbols, or combinations thereof as fourth information beforehand, persons who have registered the fourth information related to extracted aforementioned third information, are determined as persons to be notified;
(C4) the information on the intellectual property right concerned is notified to the terminal of the persons to be notified as fifth information;
(C5) sixth information to the effect that the persons to be notified are interested in the intellectual property right related to the fifth information is obtained from the terminal of the persons to be notified;
(C6) based on the sixth information, information indicating at least existence of a person having an interest in the intellectual property right among the plurality of the second users is generated as seventh information;
(C7) when the seventh information generated as a result of notification of the first information by the information processing device is transmitted to the information processing device;
(D) a receiving means for receiving the seventh information; and
(E) an information processing device comprising above.

(3) Procedural History

October 23, 2019	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2019-14077), Amendment of Proceeding (See above "The Claims")
March 11, 2021	:	Dismissing the Amendment, Appeal Decision to "Dismiss the appeal"

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

Trial Decision (cited from the Court Decision)
(2) Identification of the Amended Invention in the Application (a) Claim components specifying the information processing device

The Amended Invention of Claim 1 in the Application is an invention pertaining to "an information processing device (operated by a first user)" according to the description of the claim components (A) and (E).

In the Amended Invention in the Application, the claim components (C), (C1) through (C7) are the claim components to specify the server which is notified the information in the gazette (as first information) from the information processing device and transmits seventh information which is accepted by the information processing device, but not the claim components to specify the information processing device directly.

In this view, it can be said that the claim components that specify the Amended Invention in the Application are the above claim components (A), (B), (D), and (E).

Decision

Allegations by Plaintiff

(1) The information processing device in the Amended Invention in the Application should be considered as a set of an invention with the server.

In identifying the Amended Invention in the Application, the trial decision in this case is premised on "Example 1" in "4.1.2 Cases where an element relevant to "another subcombination" specifies only "another subcombination" and does not specify a structure, function, etc. of the claimed subcombination invention at all" in "4. Expression Specifying the Invention of subcombination by Elements of “Another subcombination” of Part III, Chapter 2, Section 4, in the Examination Guidelines for Patent and Utility Model (see Exhibit 1, "Excerpts from the Examination Guidelines for Patents and Utility Models".)

However, the Amended Invention in the Application has completely different components from "Example 1". That is, the Amended Invention in the Application relates to "an information processing device operated by a first user" and has as its subject matter "to easily present a large number of candidates who want to exploit the intellectual property rights to the holders of those rights etc. who wish to effectively utilize their intellectual property rights" (paragraph [0005] of the Specification in the Application, etc.). As a means to solve the problem, it is premised on a

Allegations by Defendant

In the Amended Invention in the Application, the fact that the server, which is "another subcombination", receives the notification of the first information and transmits the seventh information generated as a result of the notification of the first information does not specify the structure, function, etc. of the information processing device, which is the invention of "subcombination". In this regard, the Amended Invention in the Application has something in common with "Example 1" of "4.1.2" in the Examination Guidelines, and the plaintiff's argument that the Amended Invention in the Application is different from "Example 1" of "4.1.2" is unreasonable.

In addition, the Plaintiff asserts that the "information processing device" of the Amended Invention in the Application is a dedicated terminal for "presenting candidates for exploitation of intellectual property rights," but the Amended Invention in the Application is not an information processing device as a dedicated terminal in a system consisting of a "server" and an "information processing device. Although the Plaintiff relies on the judgment in Case No. 2010 (Gyo-ke) 10056, the invention pertaining to the "liquid ink container" in the above case constitutes an invention in which a specific liquid ink container and a corresponding recording device constitute a set, which is different from this case.

system that combines a server that compiles information on a plurality of persons to be notified (business operators), terminals operated by the plurality of persons to be notified, and an information processing device operated by the holder of the rights, etc. In this way, the information processing device of the Amended Invention in the Application relates to the device that constitutes the above system, and the information processing device described in the Amended Invention in the Application can be regarded as a dedicated terminal for "presenting candidates for exploitation of intellectual property rights" in relation to the above task, and clearly constitutes the invention as a set with configuration of the server. Even the judgment of the Intellectual Property High Court, 2010 (Gyo KE) 10056 applies to this case, it is incorrect to exclude the existence of the server from its review identifying the Amended Invention in the Application.	

Judgment by the Court

(1) Identification of the gist of the Invention

… The Amended Invention in the Application is an invention of each device to be combined (an invention of subcombination) with respect to the invention of an overall device consisting of combination of two or more devices, and it is understood from the description of claim 1 of the claims that it is an invention relating to an information processing device operated by the first user. However, there are exceptional circumstances in which the technical meaning described in the claims cannot be unambiguously and clearly understood because the description of claim 1 of the claims describes the contents of processing in a server, which is another device other than the information processing device.

Therefore, the gist of the Amended Invention in the Application is identified by referring to the description of the detailed description of the invention in the Description in the Application.

Incidentally, in the case of an invention of subcombination, it is necessary to identify the gist of the invention by understanding what matters concerning "other devices" described in the claims mean from the aspect of its shape, structure, constituent element, composition, operation, function, property, characteristics, an act or action, use, etc. (hereinafter referred to as "a structure, function, etc.") to specify the invention of the claims. From this perspective, in the case where the matter concerning the "other device" is a matter specifying only the "other device" and does not specify any structure, function, etc. of the invention of the

claim, the matter concerning the "other device" is a matter specifying only the "other device" and does not specify any structure, function, etc. of the invention of the claim, the matters concerning "other devices" have no meaning to specify the invention of the claim. Thus, it should be reasonable to exclude this and to identify the gist of the invention of the claim in question.

From the above viewpoints, the Amended Invention of the Application is reviewed as follows.

…

(4) Regarding the claim components (C), (C1) through (C7)

Claim Components (C) , (C1) through (C7) of the Amended Invention in the Application describes the matters where a server that receives notification (transmission) of information (first information) in a gazette concerning intellectual property rights from an information processing device, extracts second information from the first information, extracts third information, determines persons to be notified from the third information and fourth information, notifies the information in the gazette to terminals of the persons to be notified as fifth information, and then, receives sixth information from the terminals of the persons to be notified, generates seventh information and transmits it to the information processing device. Those are, in sum, for specifying processing performed by a server, and not for specifying processing performed by an information processing device. In other words, the processing of what processing is performed on information notified by the information processing device and what information is generated and sent to the information processing device is the processing performed by the server on its own and does not affect the processing performed by the information processing device.

On the other hand, the information processing device transmits the first information to the server and receives the seventh information from the server. However, the function of the information processing device is only the function of transmitting the prescribed information to the server and receiving the prescribed information from the server, and the function is not affected or restricted by the above claim components (C), (C1) through (C7). In this way, the claim components (C), (C1) through (C7) do not specify the function or operation of the information processing device in any way.

Therefore, in identifying the Amended Invention in the Application, the gist of the Amended Invention in the Application should be identified not considering that the claim components (C), (C1) through (C7) be regarded as matters specifying the invention, and there is no error in the trial decision to the same effect.

(59)-1

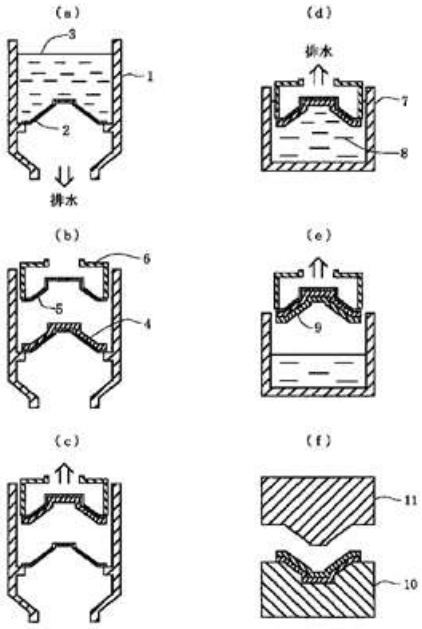
Relevant portion of Examination Guidelines	Part III Chapter 2 Section 4.5.
Classification of the Case	59: Finding of the invention and novelty and inventive step of the invention according to a claim that includes a description trying to identify the product with the manufacturing method in the claim
Keyword	

1. Bibliographic Items

Case	"A method of manufacturing diaphragms for speaker" (Trial for Invalidation) Intellectual Property High Court Decision, December 7, 2006 (2005 (Gyo KE) No. 10775)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-343884 (JP 2003-116199A)
Classification	H04R 31/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Ryoichi MIMURA, Judge: Yuji KOGA Judge: Kazuhide SHIMASUE

2. Overview of the Case

[Process chart 1]



(1) Summary of Claimed Invention

The claimed invention reduces the amount of waste water and industrial waste produced from the papermaking process of diaphragms for speaker and provides a stable correlation bonds. A primary papermaking net 2 is fixed to a plow tank 1 to which a primary raw material 3 is loaded. Waste water is discharged from the bottom of the plow tank 1 and the primary stock 4 is strained. A papermaking base 6 to which a secondary papermaking net 5 is fixed is disposed in the tank and the secondary papermaking net 5 and the papermaking base 6 are lowered to absorb a primary paper stock 4 before it is raised. Then, the papermaking base 6 is dropped into the secondary raw materials 8 in the plow tank 7 for a predetermined time to perform an upside down plow by which the waste water is discharged from the upper part of the papermaking base 6, so that the secondary stock 9 is superimposed on the

primary stock 4. Finally, the stock consisting of the primary stock 4 and the secondary stock 9 superimposed are transferred above the gold net 12 which is fixed to the mold 10, followed by heat pressing molding using the mold 11 as superimposed or non-pressing molding using hot air. The structure of the diaphragm includes a material with large Young's modulus suited on the outer surface and a material suitable to inner damage and bending rigidity on the inner surface.

[Process chart 1]
#1 waste water

(2) State of the art
(i) Exhibit A1 (Invention of Exhibit A1): JP S48-050003A (Determination of the Appeal Decision)

"A method of manufacturing a speaker cone paper (corresponds to a diaphragms for speaker referred to in the present invention) having a multilayer structure ... a specific method of manufacturing includes a plow tank and at least two fabric materials having different freeness, strength and acoustic energy loss, one of which fabric material is deposited on a plow net provided in the plow tank for a certain time and then the other fabric material is added there, so that both are laminated to be integrated through a process in which a portion of the former fabric material beginning to deposit being mixed with the latter fabric material."

(ii) Exhibit A2 (Invention of Exhibit A2): JP S57-010638A (Determination of the Appeal Decision)

"For a manufacturing apparatus of a diaphragms for speaker having a multilayer structure comprising a plow tank and a mold. A manufacturing process includes, firstly, forming a wood pulp layer on the surface of the mold which works as a diaphragm by sinking the mold into the tank filled with any given material, for example, wood pulp, so as to make the mold absorb the material and secondly, forming above the wood pulp layer a synthetic fiber layer by sinking the mold into the tank filled with different material, for example, liquid material including synthetic fiber so as to make the mold absorb the material."

(iii) Exhibit A3 (Invention of Exhibit A3): JP H1-101105A (Determination of the Appeal Decision)

"A manufacturing process of manufacturing mineral board material which has cement as a main element in which an aqueous solution consisting of cement and fiber applied to a belt is strained using round net cylinder to form a thin film only of cement element having fiber orientation (so-called cylinder paper making method) and supplying the thin film with a slurry consisting of silica, cement element and reinforcing fiber from a flow box (so-called Fourdrinier papermaking method), so that the thin film and the slurry superimposed are rewound by a making roll and when the rewound sheet gets the required thickness the sheet is cut and pressed flat."

(iv) Exhibit A4 (Invention of Exhibit A4): US1927902A (Determination of the Appeal Decision)

"The method of manufacturing diaphragms for dynamic radio loud speakers or diaphragms used in sound amplifying and reproducing units by which the sheet forming device is immersed in the tank with liquid and the liquid is run from the lower portion to the upper portion of the screen 12 of the sheet forming device, so that the

stock is deposited at the lower portion of the screen."

(v) Exhibit A5 (Invention of Exhibit A5): JP H8-232200A (Determination of the Appeal Decision)

"A manufacturing process of producing multilayered papermaking good containing a granular layer comprising opening fine squeeze water holes 9 on the entire surface, soaking into suspension in raw material tanks 1 to 3 a mold 8 to which a vacuum chamber 11 having a suction tube 10 connected to the upper part of it is serially attached, depressurizing the vacuum chamber 11 by the suction tube 10, and discharging liquid component of the suspension from the upper part of the mold 8 through the squeeze water holes 9 and the suction tube 10, and by depositing the suspended materials to the outer surface of the mold 8, a shielding layer a of a particulate material is formed on the surface of the mold 8 in the first raw material tank 1, a granule layer b, etc. is formed on top of the shielding layer a in the second raw material tank 2 and a coating layer c is formed on top of the granule layer b etc. in the third raw material tank 3.

(3) The Claims (The present inventions 1 and 2)

[Claim 1] A method of manufacturing diaphragms for speaker having a multilayered structure including at least a plurality of papermaking processes and a multilayered plow papermaking technique is used in which the stock laminated in the primary papermaking is transferred to the second papermaking net and, while the state of being absorbed is kept, it is placed in the stock dispersing solution contained in the plow tank prepared for the second papermaking and thereafter, so that the water is discharged from the upper part of the plow tank.

[Claim 2] A diaphragms for speaker having multilayered structure using the method of manufacturing according to Claim 1, wherein two or more layers are superimposed to be deposited.

(4) Procedural History

February 6, 2004	:	Registration of Establishment of Patent Right (see the above "The Claims")
December 9, 2004	:	Filing of Request for Trial for Patent Invalidation by Plaintiff (Muko No. 2004-80253)
September 27, 2005	:	Appeal Decision to "Dismiss the trial"

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

Appeal Decision
(1) A The present invention 1, with regard to a method of manufacturing a diaphragms for speaker characterized to have a multilayered structure, requires, "using a multilayered plow papermaking technique involving a plurality of papermaking processes, in which the stock laminated in the primary papermaking is transferred to the second papermaking net and, while the state of being absorbed is kept, it is placed in the stock dispersing solution contained in the plow tank prepared for the second papermaking and thereafter, so that the water is discharged from the upper part of the plow tank." Whereas Invention of Exhibit A1, being the same in the method of manufacturing a speaker cone paper (corresponds to a diaphragms for speaker in

the present invention 1) having a multilayered structure, but the specific method of manufacturing is different in the method of manufacturing of the present invention 1. Invention of Exhibit A1 requires, "a plow tank and at least two fabric materials having different freeness, strength and acoustic energy loss, one of which fabric material is deposited on a plow net provided in the plow tank for a certain time and then the other fabric material is added there, so that both are laminated to be integrated through a process in which a portion of the former fabric material beginning to deposit being mixed with the latter fabric material," which is significantly different from the method of manufacturing in the present invention 1 in terms of formation and it does not disclose nor suggest the above-mentioned requirement of the present invention 1. Also, by assuming Invention of Exhibit A1 to be intended for manufacturing by means of single straining of a multilayered cone paper, it is totally unexpected to employ in Invention of Exhibit A1 the method of manufacturing including a plurality of papermaking processes as required in the present invention 1 as mentioned above.

B Invention of Exhibit A2 and the present invention 1 are both methods of manufacturing a diaphragms for speaker having multilayered structure and are common in having at least a plurality of papermaking processes and also in using a multilayered plow papermaking technique in which the stock (wood pulp layer in Invention of Exhibit A2) laminated in the primary papermaking is placed in the dispersing solution (liquid material including synthetic fiber in Invention of Exhibit A2) contained in the plow tank prepared for the second papermaking and thereafter. However, in the present invention 1, "the stock laminated in the primary papermaking is transferred to the second papermaking net and, while the state of being absorbed is kept, it is placed in the stock dispersing solution contained in the plow tank prepared for the second papermaking and thereafter, so that the water is discharged from the upper part of the plow tank," whereas in Invention of Exhibit A2, it is different (hereinafter, "difference") in that, the stock (wood pulp layer in Invention of Exhibit A2) laminated on a mold in the primary papermaking is being kept on the mold and placed in the stock dispersing solution contained in the plow tank prepared for the second papermaking and thereafter. The present invention 1 having a structure relates to the above-mentioned difference is not something at which a person skilled in the art could have easily arrived by combining with Inventions of Exhibit A1 to A5.

(2) The present invention 2 is the invention stated by citing the present invention 1 that relates to a diaphragms for speaker having a multilayered structure in which two or more layers are overlaid to be deposited by using the method of manufacturing in the present invention 1. Accordingly, the present invention 2 is not something at which a person skilled in the art could have easily arrived based on Inventions of Exhibit A1 to A5 for the same reason as given to the present invention 1.

Decision

Allegations by Plaintiff	Allegations by Defendant
4 Grounds for Revocation 4 (Fallacy in finding and determination of the present invention 2) The finding and determination of the Appeal Decision on the present invention 1 is a mistake, as described above 1 to 3, and the finding and	4 On Grounds for Revocation 4 (Fallacy in finding and determination of the present invention 2) The finding and determination of the Appeal Decision on the present invention 1 is not a mistake, as described above 1 to 3, and the finding and

determination of the Appeal Decision on the present invention 2 is also a mistake for the same reason.	determination of the Appeal Decision on the present invention 2 is also not a mistake for the same reason.

Judgement by the Court

4 On Grounds for Revocation 4 (Fallacy in finding and determination of the present invention 2)

(1) The present description (Exhibit A7) states Claim 2 in the Claims to read "a diaphragms for speaker having a multilayered structure in which two or more layers are overlaid to be deposited by using the method of manufacturing in Claim 1," and thus the present invention 2 is obviously "the invention of product" rather than "the invention of manufacturing method" although it is stated by citing Claim 1 which is "invention of manufacturing method." That is to say, the statement of Claims, which relates to a product while encompassing a process related to the product therein, applies to so-called product-by-process claims.

...the claimed manufacturing method should merely be intended to serve as an index to uniquely identify the configuration of "product" as a result of the manufacturing and, although a product which is manufactured by a manufacturing method different from the claimed method of manufacturing, as long as the configuration of the "product" is objectively identical, it is reasonable to recognize it as being encompassed by the claimed invention.

In this sense, in the examination on the novelty and inventive step of the present invention 2 which is an "invention of product," the statement in the above-mentioned Claims of "using the method of manufacturing in Claim 1" should be considered not to be defined to meet the requirement of "invention of a method of manufacturing" but is defined for nothing more than the purpose of specifying the configuration of the product, namely, "a diaphragms for speaker having a multilayered structure." Accordingly, the gist of the present invention 2 should be understood to relate to the final product of "A diaphragms speaker having a multilayered structure" itself. In other words, the present invention 2 which objectively has the same configuration as the "a diaphragms for speaker having a multilayered structure" manufactured by the manufacturing method as set forth in the present invention 1 is deemed to incorporate the present invention 1 even though "a diaphragms for speaker having a multilayered structure" is manufactured by the manufacturing method different from the one claimed in the present invention 1.

Therefore, the present invention 1 of "invention of method of manufacturing" is not deemed to have been easily arrived by a person skilled in the art based on Inventions of Exhibits A1 to A5, but the present invention 2 of "invention of product," with the rationale such as the existence of prior art "product" having a configuration which is objectively identical with or similar to that of the present invention 2, is not deniable for its novelty and inventive step.

(2) However, in this case, the ground for invalidation of the present invention 2 (invention of product) alleged by plaintiff (requester) during the trial proceedings focused only on the present invention 2 lacking inventive step for the same reason as the present invention 1 (invention of a method of manufacturing) lacking inventive step, and did not argue the reason inherent to the present invention 2 that is "invention of product," which leaves no dispute between the two party concerned (a matter of whether or not the "diaphragms for speaker having a multilayered structure" which objectively has the same configuration as the "diaphragms for

speaker having a multilayered structure" manufactured by the manufacturing method as set forth in the present invention 1 has been easily arrived by a person skilled in the art is not the subject of the Appeal).

The Appeal Decision on the patent as set forth in the present invention 1 is found to have no fault in the decision of "Dismiss the appeal" as discussed in the above sections 1 to 3.

Eventually, the Appeal Decision on the patent as set forth in the present invention 2 is found to have no fault in the decision of "Dismiss the appeal," and was appropriate in view of this conclusion. The allegations by the plaintiff on grounds for revocation 4 are considered to have no reason.

(Reference)

Comments on Supreme Court Decision Second Petty Bench June 5, 2015 (2014 (Ju) 1204)

"The statement of Claims attached to the application form serves as a basis of delimiting the technical scope of the patented invention (Patent Act 70 (1)) and also a basis of identifying of the gist of the claimed invention in the application for patent, which is premised on the examination of the patent requirement prescribed in Patent Act 29 and the like (see Decision of the Supreme Court, 2nd Petty Bench, 1987 (Gyo TSU) 3, March 8, 1991; 45-3, page 123 Minshu 123)." Moreover, the patent is supposed to be on invention of product, invention of process, or invention of method of manufacturing the product, and in the case where the patent is on the invention of product, the effect of the patent right encompasses any product with an identical structure or feature, regardless of the manufacturing method.

Therefore, even when Claims of the patent applied to the invention of product states method of manufacturing the product, the gist of the invention is appropriate to recognize that the product is identified as the product having the same structure or feature with the product manufactured using the method of manufacturing the product."

(60)-1

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 4.6.
Classification of the Case	60: Novelty and inventive step of the invention according to a claim that includes a description trying to identify the invention using numerical limitation
Keyword	

1. Bibliographic Items

Case	"Two-piece solid golf ball" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, February 28, 2006 (2005 (Gyo KE) No. 10436)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H8-71135 (JP H9-239067A)
Classification	A63B 37/00
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Hisao SATO, Judge: Kazuhide SHIMASUE, Judge: Yasuhito, OKINAKA

2. Overview of the Case

(1) Summary of Claimed Invention

In a two-piece solid golf ball comprising a solid core and a cover having a number of dimples covering the solid core, the solid core has such a distribution of hardness on a JIS-C hardness scale that a surface hardness is 85 degrees or below and a center hardness is lower than the surface hardness by 8-20 degrees, and the hardness within 5 mm inside the core surface is up to 8 degrees lower than the surface hardness. The cover has hardness higher than the surface hardness of the core by 1-15 degrees and a gage of 1.5-1.95 mm. The number of dimples is 360-450. Since the hardness distribution of the core and cover, the gage of the cover, and the number of dimples are optimized, the ball is improved in flight distance, controllability and hitting feel.

(2) State of the art

(i) Invention stated in a publication: JP H6-098949A (Determination of the Appeal Decision)

"A two-piece golf ball comprising a core and a cover having a number of dimples covering the core, the core has such a distribution of hardness on a JIS-C hardness scale that a surface hardness is between 78-88 degrees and a center hardness is lower than the surface hardness by 5-30 degrees or below, and the hardness within 5 mm

inside the core surface is up to 0-2 degrees lower than the surface hardness. The cover is made of ionomer resin containing Himilan 1706 and Himilan 1605 by 1:1 ratio and a gage of the cover is 1.5-2.1 mm."

(3) The Claims (Amended invention)

[Claim 1] A two-piece solid golf ball comprising: a solid core having diameter of 37-41 mm and a cover having a number of dimples covering the solid core, the solid core has such a distribution of hardness on a JIS-C hardness scale that a surface hardness is 85 degrees or below and a center hardness is lower than the surface hardness by 10-17 degrees or below, and the hardness within 5 mm inside the core surface is up to 8 degrees lower than the surface hardness. The hardness of the cover is between 77-86 degrees and a surface hardness is higher than the surface hardness by 2-5 degrees and a gage is 1.5-1.95 mm, the number of dimples is 360-450.

(4) Procedural History

March 1, 1996	:	Patent Application
June 24, 2003	:	Decision of Refusal
July 24, 2003	:	Request for Appeals against an Examiner's Decision of Refusal (Fufuku No. 2003-14110)
August 22, 2003	:	Amendment (see the above "The Claims")
March 15, 2005	:	Dismissing the Amendment, Appeal Decision to "Dismiss the appeal"

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

<table>
<tr><td colspan="2">Appeal Decision</td></tr>
<tr><td colspan="2">Difference 2: In the amended invention, a cover has hardness on a JIS-C hardness scale in a range of 77-86 degrees and is higher than the surface hardness of core by 2-5 degrees. On the other hand, the invention stated in a publication is not clear on these degrees.
... the cover hardness being higher than the surface hardness of core by 2-5 degrees is found not to have exceptional significance of critical range. ...when the amended invention is compared with the cited invention stated in a publication, the cover hardness defined to be 77-86 degrees is found not to have exceptional technical significance of critical range, and recognized as values a person skilled in the art could have appropriately selected.
Also, the working effect applied by the amended invention is considered nothing more of the level that a person skilled in the art could have expected and not exceptional.</td></tr>
<tr><td colspan="2">Decision</td></tr>
<tr><td>Allegations by Plaintiff
The appeal decision that determines "the working effect applied by the amended invention is considered nothing more of the level that a person skilled in the art could have expected and not</td><td>Allegations by Defendant
The plaintiff alleges that Example 2 of the present description is advantageous to the Comparative Example 3 in the working effect. However, such comparison is acceptable only in the comparisons</td></tr>
</table>

exceptional." (Written appeal, page 5) is a mistake. (1) As stated above, the cover material disclosed in the publication is exactly the same as the composition D used in Comparative Example 3 shown in Tables 2 and 4 of the present description having JIS-C hardness of 93 degree which is significantly high degree. In addition, the Comparative Example 3 of the present description, when compared with Example 2 (Example 3 as filed) is inferior in flying distance, controllability, and hitting feel, so that it is clear that the working effect of the amended invention is not achieved when the cover material (composition D) is used. ... (2) The appeal decision overlooks the difference in effect on the property of flying distance and controllability. The Comparative Example 3 and Example 2 (Example 3 as filed) in the present description show the differences in carry of 1.8 m and total of 1.5 m with evident of sufficient difference in flying distance. Also, the controllability as stated in the present description is the property of iron in easiness to produce intentional hook (easiness to produce intentional hooks and slices) and the capability of stopping easily on green when approached with a short iron, which is completely different from the feel of ball. The publication does not focus on the controllability in the first place while it is one of the purposes of the amended invention. Thus, it is not possible to immediately presume the working effect of the publication to be comparable with the amended invention.	representative of covers in the JIS-C hardness of 83 to 93, of the difference in the JIS-C hardness of the cover and the surface of core in 3 degrees, and 13 degrees. These comparisons do not serve as the basis of showing the significant working effect in all the cases of the cover having the JIS-C hardness between 77-86 and the JIS-C hardness of the cover having 2-5 degrees higher than the hardness of the surface of the core. The three parameters of "flying distance," "hitting feel" and "controllability" described as the working effect in the amended invention are, in the first place, capabilities generally required in the technical field of golf ball and it is not considered as heterogeneous to the effect of the invention stated in the publication. Also, it is a well-known matter that the hitting feel (shot feeling) and the controllability improve with the softened cover (softening) (Exhibit B1-3). In addition, having the invention of the publication and a cover is to be provided, it is a matter a person skilled in the art could have normally done to evaluate the above capabilities and to select an appropriate material out of several materials that are applicable for the cover.
Judgement by the Court ... with regard to the technical significance of the cover and the surface of core of the amended invention having "the difference in hardness in 2-5 degrees," it has no other meaning but a range other than this is avoided since the difference in hardness of less than 1 degree results in lower repulsive property leading to shorter flying distance and the difference in hardness of larger than 10 degrees results in the decrease in hitting feel. The significance of critical range in so-called numerical limitation is not found, so that it should be considered as	

merely a design matter that a person skilled in the art could have appropriately done as necessary that the invention stated in the publication makes the hardness of the cover set to be "8-15 degrees" harder than the hardness of the surface of core (within a range of the hardness of the surface core in the amended invention) to be "2-5 degrees" harder in using the well-known cover material.

...

The plaintiff alleges that the appeal decision of determining that "the working effect obtained from the amended invention is of the level a person skilled in the art can expect, which is not considered to be exceptional" is a mistake.

(1) However, as stated above, since the numerical limitation in the amended invention with respect to the hardness of the cover and the difference in the hardness between the cover and the surface of the core is found to have no exceptional significance of critical range, and the application of a configuration of the difference 2 in the amended invention to the invention stated in the publication is merely a design matter that a person skilled in the art could have done as necessary, the working effect obtained from the amended invention is not exceptional but determined to be of the level a person skilled in the art could expect. Thus, the determination of the appeal decision which determined on the same grounds is considered reasonable and the above allegation by the plaintiff is not acceptable.

(60)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 4, 6.
Classification of the Case	60: Novelty and inventive step of the invention according to a claim that includes a description trying to identify the invention using numerical limitation
Keyword	

1. Bibliographic Items

Case	"Probe needle for semiconductor device test" (Trial for Invalidation) Intellectual Property High Court Decision, March 1, 2006 (H17 (Gyo-KE) 10503)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H11-241690 (JP 2000-147004A)
Classification	G01R 1/067
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Fourth Division: Presiding Judge Tomokatsu TSUKAHARA, Judge Teruhisa TAKANO, and Judge Tatsubumi SATO

2. Overview of the Case

(1) Summary of Claimed Invention

In this case second invention, for the purpose of elongating contact life of a probe needle for testing an electrode pad (having a thickness of about 0.8 μm) of a general integrated semiconductor device, such as a DRAM, a curvature radius r of a spherical curved surface at a tip end part of the testing probe needle is set to $10 \leq r \leq 20$ μm, and a surface roughness thereof is set to 0.4 μm or less. Thereby, the number of contact times until the testing probe needle reaches its life span is increased to enhance the contact life.

(2) State of the Art

"... In Principal Action of Exhibit A3, ... it is only described that a tip end of a probe is formed in a spherical shape, and there is no description related to the curvature radius and the surface roughness.

... In Principal Action of Exhibit A4 ..., as a prior art, it is described that "a tip end is formed in a cone shape having a diameter of about 50 μ-30 μ, (It means a shape that a vertex end of the cone shape is almost spherical-surfaced. Hereinafter, referred to as a cone spherical shape.) ... the conventionally-used probe needle of the probe card, as described above, is almost in a spherical shape having a diameter of about 30-50 μm". Although the spherical diameter of 30-50 μm can be converted into a curvature radius of 15-25 μm, there is no description related

to the surface roughness.

... In Principal Action of Exhibit A5 ..., No.1-5 tip end part curvature radiuses and surface roughnesses are described in Table 2. A tip end part curvature radius of "0.6R-4R" and a surface roughness of "0.60-0.90 μm at the maximum roughness, Ry 0.61-0.93 μm" (the maximum roughness cannot take an evaluation length of the maximum height Ry based on Japanese Industrial Standard (JIS)) is shown ...

...In Principal Action of Exhibit A6 ..., it is only described that a probe pin with a good surface property can be manufactured by reducing the surface roughness of the tip end part, and there is no description about numerical value ranges for the curvature radius and the surface roughness.

In addition, ... Principal Actions of Exhibit A7 to Exhibit A10 ... are shown as common general technical knowledge to a person skilled in the art related to general matters about the surface roughness, and there is no description related to the curvature radius and the surface roughness of the tip end of the testing probe needle. (Summary from the judgment)

As described above, although there are publicly known documents that describe that the tip end part of the probe needle is a spherical curved surface, there is no publicly known document that describes a technical matter of "a curvature radius r is set to $10 \leq r \leq 20$ μm, and a surface roughness thereof is set to 0.4 μm or less".

According to the description in the descriptions of this case patent, it is described that, in a case where a conventional flat needle is used, the needle reaches its life span at the number of contact times of about 500. (A contact resistance becomes larger than 1 ohm, and contact failures are generated.)

(3) The Claims (Corrected) (Only Claim 2 is Described) (Invention 2 of This Case)

[Claim 2] A probe needle for testing a semiconductor device that presses a tip end part against an electrode pad of the semiconductor device and electrically makes said tip end part and said electrode pad contact with each other to test an operation of the semiconductor device, wherein said probe needle is configured by a lateral face part and the tip end part, said tip end part has a spherical curved surface, a curvature radius r of said above-mentioned curved surface is set to $10 \leq r \leq 20$ μm, and a surface roughness thereof is set to 0.4 μm or less.

(4) Procedural History

August 27, 1999	:	Patent Application (the Date of Claim of Priority: August 31, 1998)
April 22, 2002	:	Registration of Establishment of Patent Right
July 16, 2004	:	Request for Trial for Patent Invalidation by Plaintiff (Muko No.2004-80105)
October 4, 2004	:	Request for Correction by Defendant (Patentee) (Refer to the above "The Claims")
April 18, 2005	:	Trial Decision of "The correction is received. The request for trial is not established."

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

Appeal Decision (cited from the Court Decision)
B Ground for Invalidation 2 (Violation of Article 29(2) of Patent Act)

(A) About This Case Second Invention (Invention 2)

d Accordingly, when this case second invention and ... inventions described in ... Principal Actions of Exhibit A3 to Exhibit A6 ... are compared with each other, ... there are no descriptions nor suggestions in ... Principal Actions of Exhibit A3 to Exhibit A6 ...about a point of "setting the curvature radius r of the curved surface to $10 \leq r \leq 20$ μm, and setting the surface roughness thereof to 0.4 μm or less" that is a matter specifying the invention of this case second invention (hereinafter, referred to as "a constitution A"). Thus, it cannot be considered that this point is easily achieved. ...

In addition, this case second invention takes an operation/working-effect described in the descriptions.

Accordingly, it cannot be considered that this case second invention can be invented easily by a person skilled in the art on the basis of the inventions described in ... Principal Actions of Exhibit A3 to Exhibit A6.

Decision

Allegations by Plaintiff

C Based on the above-mentioned statements, the constitution A of this case second invention can only be considered not to be related to the effect described in the corrected descriptions as far as "the electrode pad thickness of about 0.8 μm" is assumed, and is not different from the conventionally and publicly known probe needle for testing a semiconductor device. On the basis of the description in Exhibit A3 of "a part contacted with the electrode pad, of the probe is formed in a spherical surface" ..., the description in Exhibit A4 of "a cone shape having a diameter of about 50 μ-30 μ" ..., the descriptions in Exhibit A5 of "(the maximum roughness is) preferably 1 μm or less, and more preferably, 0.8 μm or less" ...and of ..."the maximum roughness of 0.6 μm" , and the description in Exhibit A6 of "a probe pin with a good surface property can be manufactured by reducing the surface roughness of the tip end part" ..., and the like, it should be considered that a person skilled in the art can easily invent the constitution A.

A As shown in FIG. 8 (a characteristic diagram indicating a relation between the surface roughness of the probe needle and the number of contact times with the contact resistance larger than 1 ohm, according to the second embodiment), the contact life of the probe needle is significantly elongated when the surface roughness of the tip end of the probe needle is 0.4 μm or less, and there is a quantitatively remarkable difference in effects between the inside and the outside of the 0.4 μm. Therefore, a numerical value of "0.4 μm" has significance of critical range, and this limitation of a numerical value is closely related to the effects of "generating a shear to the electrode pad" described in the corrected descriptions. ... In the corrected descriptions, it is described that, even in a case where the thickness of the electrode pad is set to a value other than 0.8 μm, the number of contact times can be drastically increased at the surface roughness of about 0.4 μm or less.

Judgment by the Court

The constitution A of this case second invention has "the curvature radius r of the curved surface of $10 \leq r \leq 20$ μm, and the surface roughness of 0.4 μm or less", and there are no descriptions about this configuration A in Exhibit A3 to Exhibit A6. In addition, as described above at 1, this case second invention can take a

particular operation/working-effect that the number of contact times can be drastically increased by comprising the configuration A. Thus, it cannot be considered that this case second invention can be invented by a person skilled in the art easily on the basis of the inventions described in Exhibit A3 to Exhibit A6.

... "The number of contact times can be drastically increased when the surface roughness is about 0.4 μm or less" described at a paragraph [0045] of the original descriptions is appropriate for that having the curvature radius r of $10 \leq r \leq 20$ μm shown in the first embodiment. Since this case second invention takes a particular operation/working-effect that the number of contact times can be drastically increased even if the electrode pad thickness is not specified, the constitution A of this case second invention does not assume "the electrode pad thickness of about 0.8 μm.

(60)-3

Relevant portion of Examination Guidelines	Part III Chapter 2 Section 4.6.
Classification of the Case	60: Novelty and inventive step of the invention according to a claim that includes a description trying to identify the invention using numerical limitation
Keyword	

1. Bibliographic Items

Case	"Dull finish metallic foil and exhaust gas catalyst carrier for automobile" (Trial for Invalidation) Intellectual Property High Court Decision, January 26, 2009 (2008 (Gyo KE) No. 10210)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. H1-155057 (JP H3-23309A)
Classification	B01J 35/04
Conclusion	Dismissal
Related Provision	Article 29(2)
Judges	IP High Court Third Division, Presiding Judge: Norio SAIKI, Judge: Kazuhide SHIMASUE, Judge: Hiroyuki UEDA

2. Overview of the Case

(1) Summary of Claimed Invention

The present invention relates to an exhaust gas catalyst metallic foil of automobile constituted by dull finish metallic foil having uniform surface roughness and the method of manufacturing thereof. The present invention is characterized in that the metallic foil constituting a metal honeycomb prepared for carrying out dull finishing is used and the surface roughness (Rmax) defined by JIS (B 0601-1970) is 0.7-2.0 pm, preferably 1.0-1.5 n. The method of manufacturing the metallic foil includes, for example, performing cold roll using a mill roll with polish finishing to the level of #80-120 is used to obtain a dull finish metallic foil having a surface roughness Rmax 0.7-2.0 μm. Moreover, the present invention is also an exhaust gas catalyst carrier of automobile manufactured by using the above-mentioned metallic foil as a foil material that forms a honeycomb.

(2) State of the art

(i) Exhibit A12 (Invention of Exhibit A12): 117th Joint Symposium of the Technology of Plasticity (October 7, 1988, by The Japan Society for Technology of Plasticity and The Japan Society of Mechanical Engineers) (Determination of the Appeal Decision)

"Stainless foil having excellent heat resistance used as a catalyst metal carrier for a part of diesel particulate active reduction system, the surface form of which as the important quality in terms of function that may contribute to the improvement in the fatigue property allows a wide range of machining to the surface treatment material depending on the roll roughness selected."

(3) The Claims (The present invention 1)

[Claim 1] Rough surface finish metal foil characterized in that the metal foil of heat resistant stainless steel used for an exhaust gas catalyst carrier for automobiles having a brazed structure has the surface roughness Rmax of 0.7-2.0 □m.

(4) Procedural History

December 4, 1998	:	Registration of Establishment of Patent Right (see the above "The Claims")
March 13, 2007	:	Filing of Request for Trial for Patent Invalidation by Plaintiff (Muko No. 2007-800049)
April 22, 2008	:	Appeal Decision to "Dismiss the trial"

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

Appeal Decision
It is obvious by comparing Invention of Exhibit A12 and the present invention 1 that "stainless foil" of Invention of Exhibit A12 corresponds to "metal foil" of the present invention. From this, these two inventions are common as both are drawn to "metal foil of heat-resistant stainless steel sheet used for an exhaust gas catalyst carrier for automobiles" except for the difference as mentioned below. Difference a: The present invention 1 "has a brazed structure," whereas Invention of Exhibit A12 is not specified as such. Difference b: The present invention 1 is drawn to "rough surface finish metal foil has the surface roughness Rmax of 0.7-2.0μm," whereas Exhibit A12 is drawn to "Stainless foil, the surface form of which as the important quality in terms of function that may contribute to the improvement in the fatigue property allows a wide range of machining to the surface treatment material depending on the roll roughness selected," which constitution is not specified. The above-mentioned Differences a and b, as determined together: (i) Firstly, considering the technical significance of the present invention 1 that "has a brazed structure," and "has the surface roughness Rmax of 0.7-2.0μm," the present description states that "the metallic foil of the present invention constituting a honeycomb shape has the surface roughness set as Rmax 0.7-2.0μm, which is rough compared to normal compressed foil roughness of Rmax 0.2-0.3μm and has a rough finishing. Accordingly, the wettability of the binder for fixing brazing filler metal is improved and allows the binder to achieve uniformly effective adherence to the contact portion of the flat plate and corrugated plate that constitute honeycomb. And thus, the adherence of the brazing filler metal is improved and the brazing property after the

brazing heat treatment becomes excellent." (page 2, column 4, lines 24-30). From this statement, "the surface roughness Rmax of 0.7-2.0μm" is determined as a significance feature that leads the metal foil "having a brazed structure" to improve the adherence of the brazing filler metal as well as the brazing property. ... It can be said that Exhibit A12 seems to have no statement or suggestion for the relation to "a brazed structure."

From these points, it is not acceptable to consider that a person skilled in the art could have easily conceived of the configuration according to the present invention 1 with regard to Differences a and b.

Also, the present invention 1, by having a configuration of Differences a and b, can have the significant effects stated in the present description.

Decision

Allegations by Plaintiff	Allegations by Defendant
The Appeal Decision determined is erroneous in that "by applying a configuration of Differences a and b, significant effect stated in the present description is achieved" (Trial decision page 19, lines 18 and 19) based on the statement of "a stainless steel foil constituting a honeycomb structure (Note added by the court decision: honeycomb structure, honeycomb like structure) generally is used in the cold roll state and the surface is characteristic in that the mill roll with polish finishing to the level of #600 is used, the surface roughness is extremely small such as Rmax 0.2-0.3μm and has extremely shiny surface" (Exhibit A37, page 2, left column, lines 19-23). In the present description, a part that states "the surface is characteristic in that the mill roll with polish finishing to the level of #600 is used, the surface roughness is extremely small such as Rmax 0.2-0.3μm and has extremely shiny surface" contradicts the fact. Moreover, the experiment stated in [FIG. 2] in the present description is not clear with regard to the criteria of evaluation on wettability as well as the experimental condition, so that it is not reproducible. Moreover, it is not considered as significant working effect but matters long been known that the rough surface of the binder has better wettability or, in the brazing, rough surface has larger tensile strength (Exhibits A17-19, 22).	The defendant alleges that the statement in the present description of "the surface is characteristic in that the mill roll with polish finishing to the level of #600 is used, the surface roughness is extremely small such as Rmax 0.2-0.3μm and has extremely shiny surface" is against the fact. However, the allegation of the plaintiff is groundless since it is not an evidence-based allegation. According to Exhibit A35, A36 and A29, it is clear that, prior to the present patent application, when stainless steel foil is manufactured, that having shiny surface appearance is the most natural selection, so that the above statement of the present description is not against the fact.

Judgement by the Court

In the present invention 1, it was found that the surface roughness Rmax 0.2-0.6μm exhibits significantly inferior wettability but the surface roughness Rmax 0.7μm or more exhibits the improved wettability as the wettability rank advances 2-3 and even though the surface roughness exceeds Rmax 2.0μm, the excellent wettability remains without any significant change. The numerical limitation of the present invention 1 is deemed to hold significant implication beyond search for optimization or suitability of the numerical range, to the heat-resistant stainless steel used for an exhaust gas catalyst carrier for automobiles still in the experimental stage as anticipated to take over the ceramic carrier catalyst (Exhibit A13) which had been in the center of an exclusive territory in the automobile carrier market. ...

Based on the evidences (Exhibits A29, A35 and A36), in the stainless steel foil manufacturing prior to the present patent application, it is recognized that the foil having shiny surface was conventionally manufactured. There is no further evidence found in the statement of the present description relative to prior art that shows that the statement is against the fact other than the above-mentioned statement. Therefore, the allegation by the plaintiff that the present invention 1 does not have a significant working effect on the premise that the above-mentioned statement relative to the prior art is against the fact lacks the premise, and cannot be adopted.

(62)-1

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 5
Classification of the Case	62: Whether or not exception to lack of novelty (Article 30) can be applied
Keyword	

1. Bibliographic Items

Case	"Two-part bicarbonate-based solution for peritoneal dialysis or continuous renal auxotherapy" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, August 30, 2007 (2006 (Gyo KE) No. 10559)
Source	Website of Intellectual Property High Court
Application No.	Japanese Patent Application No. 2001-167510 (JP 2002-370988A)
Classification	A61K 33/10
Conclusion	Dismissal
Related Provision	(Former) Article 30(1)
]Judges	IP High Court Fourth Division, Presiding judge: Nobuyoshi TANAKA, Judge: Yuji KOGA, Judge: Ken ASAI

2. Overview of the Case

(1) Procedural History

"The Plaintiff applied for a patent on June 1, 2001 on an invention whose title of the invention is "TWO-PART BICARBONTE-BASED SOLUTION FOR PERITONEAL DIALYSIS OR CONTINUOUS RENAL AUXOTHERAPY". When filing this case, the Plaintiff claims application of the Patent Act Article 30(1), and submitted the International Publication No. WO01/17534 (Note of abstract creator: No demand for international preliminary examination has been made, and transfer to Japan (the due date was May 10, 2001) was not performed) as a document certifying that the claimed invention is an invention prescribed in the same section. However, since the Plaintiff receives a decision of refusal dated September 27, 2004, the Plaintiff made a request for a trial and appeal on December 24, 2004. JPO examined the above-mentioned demand for trial as a case of Fufuku No. 2004-26338, and as a result, made the appeal decision that "The request for trial and appeal of this case is dismissed" on August 28, 2006 and a copy of the appeal decision was delivered to the Plaintiff on September 7, same year" (Extracted from the decision)

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

Appeal Decision	
The international publication pamphlet (International Publication No. WO01/17534) submitted as a document certifying the fact published in paper publication is one internationally published on March 15, 2001 based on the international application (International application No. PCT/US00/20486) made by the applicant of the application concerned on July 27, 2000 (claim of priority September 10, 1999, USA), and the international publication by this pamphlet was carried out by International Bureau based on the provision of the Patent Cooperation Treaty Article 21. Therefore, it cannot be stated that with this, a person who filed an international patent application voluntarily published the invention in the paper publication.	
Decision	
Allegations by Plaintiff 2 "Error in interpretation of the wording "published in paper publication" Even if "publishing in paper publication" should be interpreted as a case in which "a person entitled to the demand for international preliminary examination voluntarily and independently published in paper publication", it should be stated that Patent Act Article 30(1) applies to the application of this case. (1) Since in disclosure to publication of unexamined patent applications, independent intention of a disclosing person is more respected than disclosure to academic literature or newspaper, and since the Patent Act Article 30(1) applies to academic literature or newspapers, naturally, the same provision should also apply to publication of unexamined patent applications. (2) There is no longer a room for Supreme Court 1986 (Gyo TSU) No. 160 incident that ruled on the disclosure to publication of unexamined patent applications/decision of November 10, 1989 (Mincho Volume 43, No. 10, 1116 page. Hereinafter referred to as "Supreme Court decision of 1989") to be applied to this case due to legal reform conducted thereafter or changes in social circumstances. (3) In light of the history of legislative process of the Patent Act Article 65(2) which was added by Law No. 91 of 1970, it is assumed that "disclosure" is	Allegations by Defendant 2 "Error in interpretation of the wording "published in paper publication" (1) ... However, the case in which "a person entitled to the demand for international preliminary examination voluntarily and independently published in paper publication" is interpreted as working as a main subject when publishing, and mostly, independence of the act of publishing is called into question. ...The intent of international publication is not to provide an applicant with a forum to publish an invention, and it is intended to have the public utilize technical information by publishing it. Irrespective of whether an applicant has an intention to disclose, as part of the international patent application procedure, an international publication pamphlet is issued after a certain period of time has elapsed, and there is no room therein for an applicant to get independently involved. (2)... However, higher academic evaluation of publication of unexamined patent applications does not affect determination on independence of publication. In addition, according to Exhibit Exhibit B2, there are few opinions that disclosed publication of an applicant himself should be an exception to lack of novelty and no such a change in the social circumstances as alleged by the Plaintiff is seen.

concerned with applicant's intention, that is to say, it corresponds to case in which an applicant independently publishes. (4) A patent applicant files a patent application to protect an invention. As the effect of application and disclosure, an applicant, more specifically, a person entitled to the demand for international preliminary examination published in paper publication may acquire a right to demand compensation, and undergoes patent protection. Thus, patent application and disclosure are based on an independent action of the applicant. (5) Also in international patent application, a right to demand compensation is generated by international publication. It can be stated that similar to (4), international publication is publication based on an applicant's voluntary action. (6) Due to the revision of the Patent Act, the earlier publication system (same Act Article 64(2)) was introduced, and it was made clearer that a subject's act of publication is an applicant. (7) The system similar to the earlier publication system described in (6) above has already been established for international patent application, as of filing of international publication of this case. In addition, it has been introduced in Europe and USA. (8) Since the Plaintiff who filed an international patent application of this case filed the international patent application, knowing that the Patent Cooperation Treaty, Article 21 is applied and that the claimed invention is disclosed by an international publication official gazette, the Plaintiff had an intention to disclose the claimed invention by the pamphlet of this case, which thus falls under voluntary publication.	(3) The intent of the patent application disclosure and the system of right to (demand) compensation is ..., the act of patent application is identified with the act of disclosure, it cannot be stated that an applicant who performed the act of patent application voluntarily published in the publication of unexamined patent applications, which is paper publication. It cannot be stated, either, that a subject of intention to generate the right to demand compensation is an applicant. The Plaintiff's allegations in the 3-2 (3) or (5) regarding the patent application disclosure system or right to demand compensation does not affect the interpretation of "publishing in paper publication" in the Supreme Court decision of 1989. The Plaintiff's allegation does not affect "publishing in paper publication" in the Supreme Court decision of 1989, as with the international publication and generation of the right to demand compensation, either. (4) For earlier publication of patent application by an applicant, earlier publication is requested to serve a different purpose from publication of an invention, such as, to protect in the case in which the applicant has implemented the invention prior to disclosure (...), or to request for effect of excluding later applications in the Patent Act Article 29 or Article 29(2), etc. Therefore, the earlier publication system should not be interpreted in association with the Patent Act Article 30(1), and it cannot be stated that "a subject's act of publication is an applicant" based on the earlier publication system. Also for international patent application, even if there is the earlier publication system, it cannot be stated that "a subject's act of publication is an applicant."
Judgement by the Court 2 Error in interpretation of the wording "published in a publication"	

(2) The case of the Supreme Court decision of 1989 is a case in which it is fought whether or not disclosure by a Japanese or a foreign publication of unexamined patent application falls under "a person who has a right to obtain the patent ... discloses in paper publication". In this case, the disclosure by a publication of unexamined patent application is published by the commissioner based on the provisions of the Patent Act, and it is ruled that it cannot be stated that a person who has a right to obtain the patent voluntarily and independently published said invention in the publication. From a standpoint of a relation between the case and the ruled matter, it is understood that "a case in which a person who has a right to obtain the patent voluntarily and independently published in the publication" as determined in the Supreme Court decision 1989 is not included in a case of systematic disclosure as part of the patent application procedure, like disclosure by a publication of unexamined patent application. The Supreme Court decision of 1989 did not determine whether it is “independent” or not based on the content of intention of a person who has a right to obtain the patent of individual specific matters, therefore, it is understood whether or not it is "independent" should be determined by the system based on interpretation of the provisions of Japanese and foreign laws which define disclosure of an invention, and not determined by the specific intention of the person who has a right to obtain the patent. Even if the intention of the person who has a right to obtain the patent, it is also obvious from the case and the ruled matter that filing a patent application with being aware that the invention will be published later and accepting the publication thereof does not also fall under "independent" stated in the Supreme Court decision of 1989.

The international publication by the international publication pamphlet. When an international patent application is filed, the international publication is performed by International Bureau based on the provision of the Patent Act Article 21 and the right to demand compensation may be generated by the international publication. They are common to the publication by the publication of unexamined patent application. It is also common to the publication of the foreign publication of unexamined patent application in terms of the international publication being not a patent application filed to Japan.

(3) According to the above, it can be concluded that it can be derived from the content of the rule of the Supreme Court decision of 1989 that the publication by the pamphlet of this case does not fall under the case in which "a person who has a right to obtain the patent voluntarily and independently published in a publication" stated in the Supreme Court decision of 1989.

(62)-2

Relevant portion of Examination Guidelines	Part III, Chapter 2, Section 5
Classification of the Case	62: Whether or not exceptions to lack of novelty (Article 30) can be applied
Keyword	

1. Bibliographic Items

Case	"NK Cell Activator" (Appeals against an Examiner's Decision) Intellectual Property High Court Decision, November 30, 2017 (2016 (Gyo KE) No. 10279)
Source	Website of Intellectual Property High Court
Application No.	Japan Patent Application No. 2013-55183 (JP 2013-173746A)
Classification	A61K 31/715
Conclusion	Dismissal
Related Provisions	former Article 30 (1) and former Article 30 (4)
Judges	IP High Court Second Division, Presiding Judge: Yoshiyuki MORI, Judge: Reiko MORIOKA, Judge: Ken FURUSHO

2. Overview of the Case

(1) Procedural History

" (1) The Plaintiff filed the patent application on July 9, 2004 for the invention whose title is "NK CELL ACTIVATOR" (2004-203601, hereinafter referred to as "Application A" (priority claim under the Patent Act, Article 41, the priority date December 12, 2003, 2003-414258 [hereinafter referred to as the "Basic Application X", Exhibit A2], Exhibit A3). Then, the Plaintiff filed the patent application as a divisional application of the "Application A" on October 13, 2010 (2010-230889, hereinafter referred to as the "Original Application of the Present Application", Exhibit A4). After that, the Plaintiff filed the patent application as a divisional application of the "Original Application of the Present Application" on March 18, 2013 (2013-55183, hereinafter referred to as the "Present Application", Exhibit A5, Exhibit A7).

(2) As for the Basic Application X, the Plaintiff had submitted the "a document stating that he seeks the application of the paragraph (1)" of the former Patent Act, Article 30 (4) to the Commissioner of the Patent Office at the same time when the "Basic Application X" was filed (described as [remarks]in the Basic Application X), and then within 30 days from the filing date, he submitted the Printed Publication A (The Approaches by Carbohydrate Engineering, Technology Development for Multipurpose Use of Carbohydrate, New Food Creation Technology Research Association, November 20, 2003, pages 172-189, Exhibit A1) as so-called "a document to certify that the

claimed invention is applicable to the provision of paragraph (1)" of the said Article, which is stipulated in the paragraph (4) of the said Article, to the Commissioner of the Patent Office (Exhibit A6).

As for the Application A, the Plaintiff did not submit "a document stating that he seeks the application of the paragraph (1)" of the former Patent Act, Article 30 (4), to the Commissioner of the Patent Office at the same time when the "Application A" was filed.

(3) Since the Plaintiff had received the decision of refusal dated February 23, 2015 against the present application, he filed an appeal against the examiner's decision of refusal (Fufuku 2015-10465. Exhibit A12) and simultaneously amended the claims (Exhibit A13) on June 3, 2015, and amended the claims on July 26, 2016 (the number of claims is 6, hereinafter referred to as "the Amendment", Exhibit A16).

On November 22, 2016, the Japan Patent Office made an appeal decision that the "the request for appeal for this case is dismissed", and the Transcript of the Decision was sent to the Plaintiff". (Cited from the Court Decision)

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

Appeal Decision (Cited from Court Decision)
(1) Whether or not the provision of former Patent Act 30, Article (1) prior to its amendment in 2011 can be applied A When examining whether or not the provision of the former Patent Act, Article 30 (1) can be applied to Application A, the paragraph (4) of the said Article stipulates the procedures that "any person seeking the application of the paragraph (1) or the preceding paragraph shall submit to the Commissioner of the Patent Office, at the time of filing of the patent application, a document stating thereof and, within thirty days from the date of filing of the patent application, a document proving the fact that the invention which has otherwise fallen under any of the items of Article 29 (1) is an invention to which the preceding paragraph may be applicable." Unless the applicant duly competed the procedures stipulated in paragraph (4) of the said Article, he is not entitled to the remedial actions under paragraphs (1) to (3) of the said Article, i.e., the exceptions to the principles of Lack of Novelty, and the applicant may not seek the application of the paragraphs (1) to (3) of the said Article by the subsequent completion of the procedures if he failed to compete the procedures in the patent application stipulated in the paragraph (4) of the said Article. (Tokyo District Court Decision, 2001 (Gyo U), No. 284, dated May 22, 2002. Further, the former Patent Act, Article 41 (2) prior to its amendment in 2004, stipulates that "for inventions among those claimed in a patent application containing a priority claim under paragraph (1), for those that are stated in the description, scope of claims for a patent or utility model registration or drawings … originally attached to the application of the earlier application on which the priority claim is based …, the said patent application shall be deemed to have been filed at the time when the earlier application was filed, in the case of the application of Article 29, the main clause of Article 29-2, Articles 30(1) to (2), 39(1) to (4)... (underlined by the court) . However, Article 41 (2) of the said Act does not stipulate that the procedures under the former Patent Act 30 (4) prior to its amendment in 2011, which had to be fulfilled at the time when the Application A was filed, shall be deemed to have been fulfilled at the time when the Basic Application X was filed.

Accordingly, the demandant (plaintiff) failed to submit "a document stating to that effect" stipulated under Article 30 (4) of the said Act to the Commissioner of the Patent Office at the same time when application A was filed and thus failed to fulfill the procedural requirements. Therefore, he is not entitled to seek the application of the paragraph (1) of the said Article as for the Application A.

Decision

Allegations by Plaintiff	Allegations by Defendant
2 Estimating the possible dates of the priority claim under the Paris Convention, Article 4(B), it should be interpreted that priority date based on the internal priority system became available when the earlier application was filed. 3 Further, the priority right of the earlier application will have an immediate effect under the Patent Act,41 (2) by claiming priority under the former Patent Act, Article 41 (1) prior to its amendment in 2004, and submitting the documents stipulated in paragraph (4) of the said Act at the same time when the application was filed, to the Commissioner of the Patent Office; in other words, for inventions among those claimed in a patent application claiming priority described in the description, etc. originally attached to the application (hereinafter referred to as original description, etc.) of the earlier application on which the priority is based, the said patent application shall be deemed to have been filed at the time when the earlier application was filed, in the case of application of Article 29 (decision on novelty, etc.), the former Patent Act 30 (1) to (3) prior to its amendment in 2011 (the effects of exceptions to lack of novelty), the former Patent Act, Article 39 prior to its amendment in 2004 (decision on earlier or subsequent application) shall be deemed to have been filed at the time when the earlier application was filed. 4 As for the application claiming priority for which the procedures stipulated in the former Patent Act, Article 30 (4) prior to its amendment in 2011 has been fulfilled when the basic application was filed, the	1 According to the former Patent Act, Article 30 (4) prior to its amendment in 2011, any person seeking the application of the Exceptions to Lack of Novelty stipulated in the paragraph (1) of the said Article, shall submit a document stating to that effect (herein after referred to as "paragraph (4) document" to the Commissioner of the Patent Office at the same time when the patent application is filed, and shall submit a document to certify that the invention is applicable for the Exceptions to Lack of Novelty (hereinafter referred to as "paragraph (4) certificate" to the Commissioner of the Patent Office within 30 days from the filing date. Therefore, if the applicant seeks the application of the Exception to Lack of Novelty stipulated in the paragraph (1) of the said Article for the claimed invention(s), he is required to submit the paragraph (4) document to the Commissioner of the Patent Office at the same time when the application is filed, and shall submit the paragraph (4) certificate to the Commissioner of the Patent Office within 30 days from the filing date of the patent application (hereinafter collectively referred to as "paragraph (4) procedures), therefore, the applicant is not entitled to seek the application of the Exceptions to Lack of Novelty unless he submitted these documents. The same principle applies equally to a patent application whether it be a new patent application as part of the patent application (divisional application) stipulated in the former Patent Act, Article 44 (1) prior to its amendment in 2006, or a patent application claiming priority (patent application claiming internal

priority right of the inventions contained in the original description at the time when the basic application was filed becomes effective, judging from the nature of the said internal priority right. As for the invention(s) for which the procedures stipulated in the said paragraph was fulfilled, the effect on claiming priority for this invention is produced by completing the procedures under the former Patent Act, Article 41 (4) prior to its amendment in 2004; in other words, the Patent Act, Article 29 (decision on novelty, etc.), Article 30 (1) to (3) prior to the amendment in 2011 (effects of exceptions to lack of novelty) shall be deemed to have been filed at the time when the basic application was filed. For the effects to be produced by the application of the provisions of Novelty and Inventive Step (Patent Act, Article 29) among the effects to be produced by the said priority claim, the effects could have been produced by the exceptions to lack of novelty (Article (1) to (3) when the procedures under the former Patent Act, 30 (4) prior to its amendment in 2011, have been fulfilled. Thus, the effects including the said effects must have been produced by claiming priority for the novelty of the invention(s) described in the patent application. Hence, the effects to be produced by the application of the provisions of novelty/inventive step and the effects to be produced by the exceptions to lack of novelty should not be discussed separately. Further, as explained in paragraph 3 above, the said invention of the application can be converted into a patent application claiming priority by completing the procedures stipulated in the former Patent Act, Article 41 (4) prior to its amendment in 2004, so it is natural to think that any additional and special procedures (submitting the documents stating to that effect at the same time when the application is filed, or submitting the certifying documents within 30 days from the	priority) stipulated in the former Patent Act, Article 41 (1) prior to its amendment in 2004. .. According to the Ordinance for Enforcement of the Patent Act, Article 31 (1) prior to its amendment in 2011, stipulates that "an applicant who files a patent application claiming priority under the Patent Act, Article 41 (1), may omit submission of the certificate which was submitted at the time when the earlier application was filed unless any changes are made under the Patent Act, Article 30 (4), by informing the Patent Office to that effect on the application documents.", however, obviously the above provision was established on the premise that the applicant is required to submit the paragraph (4) certificate at the time when a patent application claiming internal priority is filed. 2 … Since a patent application claiming internal priority is different from a divisional application or a converted application in nature, it is not possible to discuss these applications on the same basis. Further, the Ordinance of the Ministry of Economy, Trade and Industry, No.132 was established on December 28, 1999 in line with the enactment of the Act No. 41 in 1999. Under the former Patent Act, Article 31, which falls under the said Ordinance, an applicant was required to submit the paragraph (4) certificate for a divisional application, a converted application and a patent application claiming internal priority in the same manner. However, it is obvious that the applicant is exempt form submitting the paragraph (4) certificate due to the simplified procedure established by the Act, No. 41 in 1999, only when he files a divisional application and a converted application. It is evident from the procedural history that the simplified procedure shall only be applied to a divisional or a converted application. 3 … We found no legal basis to treat a patent

filing date) which correspond to the ones stipulated in the former Patent Act, Article 30 (4) prior to its amendment in 2011, are not required. Therefore, the former Patent Act, Article 41 prior to its amendment in 2004, does not set out the special procedures which correspond to the ones stipulated in the former Patent Act, Article 30 (4) prior to its amendment in 2011.	application claiming internal priority differently from a regular patent application. 4 … As explained above, even though the paragraph (4) document and the paragraph (4) certificate were duly submitted when the basic application was filed, the plaintiff's case lacks legal basis, because the provision stipulating that the paragraph (4) document and the paragraph (4) certificate shall be deemed to have been submitted at the time when the patent application claiming internal priority was filed, which is different from the said basic application, and the provision stipulating that the applicant is exempt from submitting the paragraph (4) document at the time when the patent application claiming internal priority is filed, are not included in the patent related laws and regulations.

Judgement by the Court

1 The former Patent Act, Article 30 (4) prior to its amendment in 2011 stipulates … as the procedural requirements for seeking the application of paragraph (1) of the said Article, however, in terms of the applicable "patent applications", the paragraph (4) of the said Article provides no such specific provision to exempt specific types of applications from the procedural requirements.

Further, it is obvious that the patent application claiming priority under the former Patent Act, Article 41 prior to its amendment in 2004 (hereinafter referred to as "patent application claiming internal priority") is a different and independent application from the basic application since the former is stipulated as the "patent application claiming priority under the provision of the preceding paragraph" in the paragraph (2) of the said Article.

Accordingly, the applicant is required to submit the paragraph (4) document and the paragraph (4) certificate by the due date to seek the application of the paragraph (1) of the said Article for the inventions contained in the patent application claiming priority to fulfill the procedural requirements under the paragraph (4) of the said Article, unless, with regard to a patent application claiming internal priority, there is a specific provision which stipulates that the application of the former Patent Act, Article 30 (4) prior to its amendment in 2011 is excluded, or that the procedural requirements under the said paragraph are exempted.

2 In this context, we examined whether or not, with regard to a patent application claiming internal priority, there is a specific provision which stipulates that the application of the former Patent Act, Article 30 (4) prior to its amendment in 2011 is excluded, or that the procedural requirements under the said paragraph are exempted. As for the divisional application, the former Patent Act, Article 44 (4) prior to its amendment in 2006 stipulates that the paragraph (4) document and the paragraph (4) certificate, which had been submitted for the original

patent application, shall be deemed to have been submitted to the Commissioner of the Patent Office at the same time when the divisional application was filed, however, as for a patent application claiming internal priority, there is no such a provision.

As for a patent application claiming internal priority, even though the other provisions in the Patent Act have been thoroughly examined, a specific provision which stipulates that the application of the former Patent Act, Article 30 (4) prior to its amendment in 2011 is excluded, or that the procedural requirements under the said paragraph are exempted, is not found.

3 … It cannot be said that as for the inventions described in the original description attached to the basic application, the applicant can seek the application of the said provision unless he satisfies the procedural requirements again at the time when he files a patent application claiming internal priority, even if he had fulfilled the procedural requirements when the basic application was filed.

4 Accordingly, as for the inventions claimed in the patent application claiming internal priority (including the inventions described in the original descriptions, etc. attached to the basic application), it should be said that, in order to seek the application of the former Patent Act, Article 30 (1) prior to its amendment in 2011, the applicant is required to submit the paragraph (4) document and the paragraph (4) certificate by the due date as the procedural requirements under the paragraph (4) of the said Article, and that the said procedures should not be omitted even if he submitted the paragraph (4) document and the paragraph (4) certificate when the basic application was filed.

(Reference)

Also refer to the Trial Decision, December 24, 1997 (Fufuku 7-19963), Tokyo High Court Decision, April 26, 1971 (1966 (Gyo KE) No. 175), Tokyo High Court Decision, October 28, 1981 (1980 (Gyo KE) No. 160), Tokyo High Court Decision, September 26, 2002 (2002 (Gyo KE) No. 78), Tokyo High Court Decision, December 16, 2002 (2001 (Gyo KE) No. 85), and Tokyo High Court Decision, March 10, 2005 (2004 (Gyo WA) No. 11289).