Case Study on Inventive Step

February 2010

(translated in June 2010)

Intellectual Property Policy Committee, Industrial Structure Council,
Patent System Subcommittee,
Committee on Examination Standards

Notes:

- The contents of “Reference court decision” is translated by JPO, and it is not the court’s official translation.
- When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

Introduction

The Examination Guidelines for Patent and Utility Model (hereinafter referred to as “the Examination Guidelines”) are summaries of basic concepts regarding the application of relevant laws such as the Patent Act and have been well-established as standards for examination by examiners. Although the Examination Guidelines do not fall into a law and bylaws, reference to the Examination Guidelines enables examiners to examine patent applications in line with the purpose of the Patent Act in a fairer and more efficient manner. At the same time, applicants are also able to understand the standards for examination on the requirements for patentability and appropriateness of amendments more accurately so that they are able to go through more appropriate procedures in preparing descriptions and responding to a notification of reasons for refusal.

In addition, the Examination Guidelines are expected to play a role as a means to clarify policies regarding the application of the Patent Act by reflecting the technical, industrial and social trends into the operation of patent system on a timely basis. They have in fact played such a role. In an approach toward international harmonization, the Examination Guidelines can be one of the means for comparing and harmonizing the patent system and operation of various countries, although there are certain restrictions. Moreover, it is also necessary to rapidly respond to the revision of the patent system and new court decisions.

The Committee on Examination Standards, in inspecting the Examination Guidelines, reached a consensus that it should not be revised unnecessarily in light of stable granting of patent rights and stability of granted patents, whereas the Examination Guidelines has been required to promptly review depending on the revision of the system, new court decision, the developments of new technology, and the change in the international situation. The Committee concluded that, as a result of the inspection, it will not only revise the Examination Guidelines when necessary, but also offer the materials which will make it easier to understand the Examination Guidelines.

This material covers court decisions on inventive step and summarizes the points to note in applying the Examination Guidelines to specific cases. This is to be provided to (assistant) examiners and system users as reference to help them better understand the Examination Guidelines. However, it should be noted that the content of holding and summary of each court decision cannot be generalized directly.

We sincerely expect that this material will contribute to better understanding of the Examination Guidelines, and improvement in stability of patents and predictability of examination.

1. Finding of cited invention

(Examination Guidelines Part II, Chapter 2: Novelty and Inventive step)

2.4 Principle of Method of Determining whether a Claimed Invention Involves an Inventive Step

(3) The method of finding a claimed invention and cited inventions, and comparing the two, set forth in "Method of Determining whether a Claimed Invention is Novel" (see 1.5.1 to 1.5.4) is also applied to the determination of the inventive step requirement.

The finding of claimed inventions and cited inventions, and the comparison of claimed inventions with cited inventions are the bases for determining novelty and inventive step. Below are court decisions in which the finding of cited inventions is an issue in determining inventive step. In most lawsuits in which inventive step was an issue and the judgment made by the Japan Patent Office (JPO) was held to be incorrect, it was judged that finding of the cited invention was forcedly approximated to the claimed invention in finding the cited invention from the cited document.

[Reference court decision]

○**Intellectual Property High Court, March 28, 2007 (2006 (Gyo-ke) 10211 "Formable reflection multilayer object")**

In this example, the trial decision found the cited invention by treating a pair of layer with a high refractive index and layer with a low refractive index in proximity each other as one unit of optical layer. This finding was judged to be mistakenly made because the content of the claimed invention was unreasonably sought to be found in the description of document 2 with the claimed invention in mind.

(Excerpt from "judgment of this Court")

It is certain that Examples 3, 4 and 7 of document 2 indicate that the optical thickness of each unit (total of thickness of two layers) sequentially increases from the air side to the substrate side when a pair of adjacent two layers is treated as one unit. However, document 2 does not describe treating a pair of layer with a high refractive index and layer with a low refractive index in proximity each other as one unit of optical layer at all. In addition, it is clear that the layer with a high refractive index and the layer with a low refractive index in proximity each other are not treated as one unit of optical layer in document 2 based on the fact that the number of laminated layers is an odd number in Examples 1, 2, 5 and 6. In document 2, how the optical film thickness of each dielectric layer in each example is not explained, and the optical film thickness is shown using a design wavelength λ. As this design wavelength is described as 550nm, it cannot be understood

either that the film thickness of each dielectric layer of semitransparent mirror described in document 2 was set based on a wavelength that was designed to reflect. In addition, in document 2, as there exists examples where the number of layers is an odd number as mentioned above, it is not possible for a person skilled in the art to recognize that the film thickness of a pair of two neighboring dielectrics having different refractive index as one-unit optical layer with regard only to Examples 3, 4 and 7 in which the number of layers described in document 2 is an even number.

The defendant asserts that, in case of the examples in which the number of layers is an odd number among the examples in document 2, the substrate is also regarded as one-unit dielectric layer because the combination of the substrate and the adjacent dielectric layer forms one unit of two dielectric with different refractive index and accordingly the fact that an example including odd numbered layers is disclosed in document 2 is not an obstacle to the concept that two adjacent layers of dielectric with different refractive index is regarded as a pair, that is to say, one unit. However, document 2 does not describe that the substrate is recognized as one dielectric layer, or Table 1 to 8 in which the thickness of dielectric layers is shown do not describe the optical film thickness of the substrate. In addition, in Table 2 to 8, “H” which stands for half-silvered flat mirror part excludes air and the substrate. Based on these reasons, there is no choice but judgment that it is unreasonable to recognize the substrate as one dielectric layer regarding the examples including odd-numbered layers among the examples in document 2. At the same time, when regarding the substrate as one dielectric layer, the examples in which the number of layers is even number mean lack of adjacent dielectric layer that is to form a set with the substrate, therefore the said claim by the defendant cannot be adopted.

d. In conclusion, it cannot help but decide that the finding was mistakenly made because the content of the claimed invention was unreasonably sought to be found in the description of document 2 with the claimed invention in mind in the trial decision which identified that document 2 “discloses laminated multilayer films that are laminated alternately with high refractive dielectric and low refractive dielectric whose optical thickness was provided with gradient in order to allow the entire visible light a high reflection characteristic”, and that “laminating two layers having different refractive index and allowing an optical layer thickness gradient in order to provide the entire visible light with a high reflection characteristic” are publicly known based on document 2.

○Intellectual Property High Court Decision, March 25, 2009 (2008 (Gyo-ke) 10261 “Xylitol concoction for treatment of condition of upper respiratory tract”)

In this example, the defendant asserted that the description of cited document 2 was understood to include that the affected area is “upper respiratory tract” in the light of well-known arts in the finding of the cited invention. However, the court made a decision that, even if it is publicly known that intranasal administration can be chosen as an administration route, the

description cannot be understood to include “upper respiratory tract” contrary to the clear description repeated in the cited document 2 that it is for providing a treatment method for a disease of “lower respiratory tract”.

(Excerpt from “Judgment of this Court”)

b. Erroneous finding of matters described in the cited document 2

In (A) to (D) above, the cited document 2 discloses a treatment method only subject to diseases whose “infected area” is “lower respiratory tract.” In (E) to (G) above, it is disclosed that direct administration of an anti-inflammatory agent and an anti-infective agent to “lower respiratory tract,” an infected area, is a desirable form of treatment.

If that is the case, the part of the description that “agent may be administered inside the nose” in the said (G) “In a desirable form, the said anti-inflammatory agent and the said anti-infective agent are administered directly to the lower respiratory tract of the host. The said anti-inflammatory agent and/or the said anti-infective agent may be administered inside the nose. The said anti-inflammatory agent and/or the said anti-infective agent may be administered inside the nose in the form of aerosol particles” should be understood that aerosol particles are administered to “inside the nose” from the nostril which is the entrance to passing route in order to directly administer the said anti-inflammatory agent and the said anti-infective agent to the “lower respiratory tract,” which is an affected area. It cannot be understood that the said anti-inflammatory agent and the said anti-infective agent are administered to the nose for the purpose of treating the nose on the assumption that the nose itself is an infected area.

Therefore, the said finding of the trial decision that “the cited document 2 describes the anti-infective agent can be administered to the nose, an infected area (summary of matters (G))” is incorrect.

c. Judgment on the assertion of the defendant in connection with the erroneous finding of matters described in the cited document 2

In response, the defendant asserts that a person skilled in the art can understand the description that “The said anti-infective agent can be administered locally, orally, in the vein or in the abdominal cavity. Local administration is desirable. The first advantage of local administration of a treatment agent is that a higher concentration of agent can be delivered to an infected tissue with a lower total dose to patients than what is required for systemic administration, enabling to avoid known side effects of a high dose agent, for example, systemic administration of corticosteroid” mentions an infectious respiratory disease not only of “lower respiratory tract” but also of “upper respiratory tract. This is because the fact that nasal administration as well as oral administration can be chosen as an administration route with regard to “the anti-infective agent” for various infectious respiratory diseases was well known before the priority date of this application.

However, the said assertion of the defendant cannot be adopted.

It is natural to interpret that the said description in connection with the defendant's citation is about a disease whose infected area is "lower respiratory tract" based on the description which repeatedly mentions that the cited document 2 is for providing a treatment method for a disease whose infected area is "lower respiratory tract" as mentioned. At the same time, even if it is publicly known that "intranasal administration" as well as "oral administration" can be chosen as an administration route of "anti infectious agent" for a respiratory disease, this cannot constitute a ground to interpret the description of the cited document 2 as one that includes "upper respiratory tract" contrary to the clear description repeated in the cited document 2 that it is for providing a treatment method for a disease of "lower respiratory tract." Therefore, the said assertion of the defendant cannot be adopted.

2. So-called "matter of design variation"

(Examination Guidelines Part II, Chapter 2: Novelty and Inventive step)

2.5 Specific Example of Reasoning

(1) Selecting an optimal material, workshop modification of design, mere juxtaposition of features

1. Selection of an optimal material, workshop modification of design, etc.

Among exercises of ordinary creativity of a person skilled in the art are a selection of an optimal material from publicly known materials which achieve a specific object, an optimization of a numerical value range, a replacement with equivalents, and a workshop modification of design in applying specific technology. When the difference of a claimed invention in comparison falls only under these categories, it is usually considered that a person skilled in the art could have easily arrived at it, unless otherwise there is another ground for inferring inventive step.

Below are court decisions whose issue was whether the difference between the present invention and the cited invention (hereinafter simply referred to as "the difference") was selecting optimal material, workshop modification of design, etc. (hereinafter referred to as "the matter of design variation").

(Reference court decision)

○**Intellectual Property High Court Decision, February 21, 2008 (2005 (Gyo-ke) 10506, "Dielectric-barrier discharge lamp and irradiating equipment")**

The point of difference is a numerical range (rate of specific OH-group) and a precondition (wavelength of emitted light) to cause the working-effect (technical significance) of that numerical range is not specified at all in the present invention. Therefore, the court judged that the numerical range does not have any special technical significance and that it is not more than a mere matter of design variation [an optimization of a numerical value range].

(Excerpt from "judgment of this Court")

(2) Judgment

Claim 1 and Claim 2 in the scope of claims of this description do not describe at all wavelength of emitted light. In addition, in the detailed description of the present invention, no description is found which indicates that paying attention to 160nm shown in Figure 4 as a wavelength for checking the transmittance is significant in specifying the rate of a specific OH-group in the present invention. There found no ground that lowering the rate of specific OH-group for wavelengths other than 160nm increases the transmittance as described in Figure 4.

If that is the case, although the it is understood that lowering the rate of specific OH-group increases the transmittance of vacuum-ultraviolet light having 160nm of wavelength, the increase in the transmittance of vacuum-ultraviolet light having 160nm of wavelength does not create any special technical significance in the present invention in which the wavelength of emitted light is not specified in the description.

Therefore, it cannot be understood from the description of this specification that, specifying the rate of specific OH-group as less than 0.36 brings working-effect (technical significance) of reducing the damage caused by irradiating ultraviolet light with successful controlling the absorption of vacuum-ultraviolet light by quartz glass itself.

(Omission)

(4) Summary

Based on the above-mentioned discussion, there found no technical significance in paying attention to the specific OH-group and specifying its rate in the present invention and they are not more than a mere matter of design variation.

○**Intellectual Property High Court Decision, May 22, 2003 (2002 (Gyo-ke) 126, "Improved non-loosening-type drawbar assembly")**

The objective of the second cited document is to easily insert the end of the male connecting member to the cavity formed at the end of the female connecting member. Accordingly, in applying the structure described in the second cited document to the connecting part described in the first cited document, it is one of the options which can be adopted as appropriate by a person skilled in the art to select downside as a direction for insertion of the male connecting member so that it is easy to insert and to place the member in a manner that the cavity formed at the end of the female connecting member is opened downwardly [a workshop modification of design in applying specific technology]. The trial decision which denied inventive step was supported as mentioned above.

(Excerpt from "judgment of this Court")

(2) Placing of the cavity part of the female connecting member with opening downwardly

The plaintiff asserts that there is an error in the judgment of trial decision that placing the female connecting member in a manner that the cavity part of it is opened downwardly is a natural matter of design variation when the constituent described in the second cited document is adopted for the connecting part in connection with a non-loosening-type drawbar assembly.

a. In the second cited document, there are descriptions such as "another objective of this invention is to provide equipment relatively easy to assemble and disassemble to fix a bearing assembly so as to be detachable to the articulated connector used to connect a pair of adjacent ends of a

railway vehicle semi-permanently" (Reference Kou No.7, Column 3, lines 43~48, translated page 5, lines 17~19), "the cavity 26 is formed at the second end of the female connecting member 30. At least, a part of the second end 14 of the male connecting member 20 and the hole 16 pierced at a prescribed part of the second end of the male connecting member 20 is included in the cavity 26" (Reference Kou No.7, Column 5, lines 47~52, translation page 7, lines 26~28), "the cavity 26 opened near the upper surface and the front surface.....the opening 38 is pierced at each prescribed part of a pair of the side wall parts 36. Each opening 38 at least includes the slot-shaped part near the upper surface of each side wall part 36" (Reference Kou No.7, Column 5, lines 67~Column 6, line 5, translated page 8, lines 4~7), "the articulated connector 10 includes the bearing assembly 40. The bearing assembly 40 includes the almost-spherical member 42. At least a prescribed part of the spherical member 42 is fit to the hole part 16 pierced at a prescribed part of the second end 14 of the male connecting member 20" (Reference Kou No.7, Column 6, lines 7~13, translated page 8, lines 9~11), "A pair of the shaft members 46 protrudes outwardly at a certain length from the surface on the both sides in an axial-direction of the spherical member 42. One of the pair of shaft members 46 is fit to one of the opening 38 formed on a pair of side wall parts 36 of the cavity 26 formed at the second end of the female connecting member 30" (Reference Kou No.7, Column 6, lines 33~39, translated page 8, lines 21~23), and "the articulated connector 10 of this invention can be formed by fixing the bearing assembly 40 to the female connecting member 30 and by engaging the male connecting member 20 to the female connecting member 30" (Reference Kou No.7, Column 6, lines 47~52, translation page 8, lines 27~29).

Judging from the description above, it is clear that the articulated connector described in the second cited document has been so designed that the spherical member 42 placed in the hole part 16 of the second end 14 of the male connecting member 20 is easily inserted to the cavity 26 formed at the second end of the female connecting member 30 in assembling the connector.

At the time of the said insertion, it is understood from the said description of the second cited document that a pair of axial members 46 of the spherical member 42 needs to be engaged from the slot-shaped part of the opening 38 where the cavity 26 is opened upwardly. Therefore, it is clear that the second end 14 of the male connecting member 20 has to be inserted from the upper part opened on the cavity 26 formed at the second end of the female connecting member 30.

b. In a case where the said constituent described in the second cited document is adopted for the connecting part of non-loosening-type drawbar assembly described in the first cited document, in inserting the second end 14 of the male connecting member 20 to a part where the cavity 26 of the female connecting member is opened to connect them, it is a matter naturally taken into account, based on the said disclosed matter of the second cited document and technical common general technical knowledge, to place the connecting members in a manner that they can be inserted from an easier direction from a viewpoint of workability.

(Omission)

If that is the case, in connecting and assembling the connecting members under the floor of a railroad vehicle, it is clear that the inserting first the male connecting member 20 from the upper part is difficult, because it is obstructed by the railroad vehicle's floor. Therefore, selecting downside as a direction of insertion other than upside is merely one of the available options on a timely basis when selecting a direction easy to insert the male connecting member 20, that is, placing the female connecting member 30 in a manner that the cavity 26 formed at the second end of the female connecting member 30 is opened downwardly.

○**Intellectual Property High Court Decision, June 2, 2005 (2005 (Gyo-ke) 10112 "Stretching molded container made of cyclic olefinic copolymer")**

In this example, although the defendant asserted that the difference in terms of numerical range is just a value which can be set appropriately by a person skilled in the art according to the degree of acceptable bleaching [an optimization of a numerical value range], the court made a judgment that the numerical range cannot be set appropriately because this limitation of number solved a specific problem and had a technical significance to achieve a desired effect and that the said problem to be solved is new,

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(Excerpt from "judgment of this Court")

(4) 1) For the difference a, the defendant asserts that the attempt to apply a publicly or widely known art which eases molecular orientation in stretching molding as of filing this patent application is a natural act for a person skilled in the art who got an idea of the bleaching phenomenon due to molecular orientation therein in the cited invention called "stretching molded container at least whose outer surface is made of cyclic olefinic copolymer," and the application of the invention in document 4 is nothing but an ordinary act. 2) For the difference b, the defendant also asserted that, in applying the invention in document 4 to the cited invention, a desired outcome, that is, controlling the degree of ease of molecular orientation of cyclic olefinic copolymer on the outer surface of container in order to obtain an expected degree of bleaching is an ordinary act for a person skilled in the art.

However, even if it was, as in the assertion 1) above by the defendant, easy for a person skilled in the art to achieve to obtain "a stretching molded container made of cyclic olefinic copolymer whose molecular orientation on the outer surface thereof" by applying the invention in document 4 to the cited invention, since generation of white turbidity due to attachment of fingerprint is a new problem to be solved, in relation to the said new problem, there is no motivation to control the degree of ease of molecular orientation for providing for the constituent element b which is an optimized range of haze value obtained at the application test using the said petroleum mixture of this invention. Therefore, the said assertion 2) by the defendant cannot be adopted.

(5) In addition, the defendant asserts that 1) as the value (haze value 20%) in the constituent element b is a degree of bleaching the plaintiff tolerates, in another word, merely a value which can be set appropriately by a person skilled in the art according to his acceptable degree of bleaching, the value of 20% itself does not have a critical significance, and 2) an evaluation by haze value obtained at the application test using petroleum mixture of this invention is not the sole method of identifying a degree of orientation of the outer surface of container or ease of orientation, and there is no difference as a product between the stretching molded container identified by haze value obtained at the application test using petroleum mixture of this invention and a stretching molded container identified by another test method. Therefore, in this invention 1 which is an invention of product, identifying a haze value obtained at the application test using petroleum mixture of this invention and maintaining the haze value less than 20% do not have a special technical significance.

However, in the constituent element b, specifying the range of haze value obtained at the application test using petroleum mixture of this invention has a technical significance of solving a specific problem of white turbidity caused by attachment of fingerprint and obtaining a desired effect, and the said problem is new as mentioned in (2) and (3) above. If that is the case, a person skilled in the art who does not know the problem itself would never conduct a test on haze value when the petroleum mixture of this invention is applied, and it is clear that the range of haze value cannot be set appropriately. Therefore, the said assertion 1) of the defendant is wrong.

3. Specific cause or motivation

(Examination Guidelines Part II, Chapter 2: Novelty and Inventive step)

2.5 Specific Examples of Reasoning (2) Probable cause or motivation

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"2.4 Principle of Method of Determining whether a Claimed Invention Involves an Inventive Step" in the Examination Guidelines describes as follows:

(1) Whether or not a claimed invention involves an inventive step is determined whether the reasoning that a person skilled in the art could have easily arrived at a claimed invention based on cited inventions can be made by constantly considering what a person skilled in the art would do after precisely comprehending the state of the art in the field to which the present invention pertains at the time of the filing.

That is to say, consideration about whether or not there is an appropriate cause or motivation is made by comprehensively taking into consideration various factors such as cited invention, a technical field of the present invention and a state of the art of the relevant technical field, then a ground of the cause or motivation should be described if an notification of reasons for refusal is prepared.

Some court decisions are shown below as reference.

[Reference court decision]

[Close relation of technical fields]

○**Tokyo High Court Decision, July 23, 2002 (2000 (Gyo-ke) 388, "Engine ignition device")**

In this example, close similarity of technical fields could serve as a cause or motivation to combine document 1 and document 2. At the same time, under a situation where universal and well-known problems to be solved exist, regardless of whether or not the problem of the present invention are shown in a document, the court supported the trial decision which denied inventive step because there is a motivation to apply the constituent of document 2 to the invention of document 1

(Excerpt from "judgment of this Court")

(2) According to the contents of descriptions in document 1 and document 2 identified above, the invention described in document 1 relates to an ignition device of internal-combustion engine for motor vehicles powered by a battery. The ignition device described in document 2 is identified as an ignition device for internal-combustion engines equipped with its battery charged with output

from an AC generator as a DC power source. Moreover, it is clear that the content of description in document 2 does not exclude its application to motor vehicles so that the invention described in document 1 and the ignition device described in document 2 are similar in the technical field of "an ignition device for on-vehicle internal-combustion engine powered by a battery."

The decision focused on close similarity of the technical fields of document 1 and document 2, and a person skilled in the art could have easily arrived at the constituent (constituent in connection with the difference 1) to charge the battery in document 1 with output from the AC generator by applying the constituent described in document 2 to the invention in document 1. Therefore, there is no error in the judgment.

Then, close similarity of the technical fields mentioned above could also serve as a cause or motivation to combine document 1 and document 2.

(3) The plaintiff asserts that there is not a problem of corrected invention in document 1 and document 2 so that there is no cause or motivation to combine matters described in both documents, and that therefore, a person skilled in the art could not easily arrive at the application of the constituent of document 2 to the invention described in document 1.

However, Reference Otsu No.1 and Reference Otsu No.2 describe that an engine is started by output from AC generator in a case where the battery voltage drops as shown in the said (1)-c. Also they describe the fact that, in that case, the engine cannot be ignited because of low output of the AC generator, and as a means to solve such a problem, the constituent in which output from a rectifier connected to the AC generator is directly connected to the second side of ignition coil (Reference Otsu No.1) or the constituent which inserts an adjusting resistance (Reference Otsu No.2) are shown. Both of them suggest a means to enable start-up of engines using output from the AC generator in a case where battery voltage drops. These examples indicate that the problem of corrected invention that "enabling start-up of engines even in a case where battery voltage drops" asserted by plaintiff is recognized as a universal in the field of ignition device of internal-combustion engine including motor vehicle and well-known problem to a person skilled in the art.

In such situation where a universal or a well-known problem exists, it can be said that there exists a cause or motivation to apply the constituent of document 2 to the invention of document 1 regardless of whether a problem of corrected invention is presented in document 1 and document 2. Moreover, there is no obstructive factor in reaching the constituent that the battery of document 1 is charged with output from the AC generator by applying the constituent described in document 2 to the invention described in document 1. Therefore, the assertion by the plaintiff with regard to this point cannot be adopted.

[Close relation of technical fields]

○**Intellectual Property High Court Decision, October 11, 2006 (2005 (Gyo-ke) 10717**

"Siloxane or siloxane derivative as an encapsulating medium for organic light-emitting element")

In this example, the judgment was that where it is expected that, with state of the art as of filing, replacement of the constituent of the main cited invention with the constituent of the sub cited invention could not achieve the original objective of the constituent of the main cited invention, even if they fall under the same technical field, a person skilled in the art could not easily arrive at such replacement.

(Excerpt from "judgment of this Court")

In addition, according to the said description of document 1, although the overcoat layer in the cited invention 1b has to be one that could substantially flatten the concave-convex surface of light dispersal part, there is no evidence to prove that siloxane in the cited invention 3 has a property suitable to flattening in terms of formation method and film thickness. On the contrary, in the light of the description of said document 3 and the description of Gazette Publication No.1989-307247, it does not seem to be suitable to flattening. If so, even if the light-emitting part (organic EL element in cited invention 1b and laminated structure in cited invention 3) is covered with coating layer (overcoat layer in cited invention 1b and siloxane in the cited invention 3) both in the cited invention 1b and the cited invention 3 and they fall under the same technical field called organic light-emitting element, that is not enough to reason that a person skilled in the art could have easily arrived at the use of siloxane in the cited invention 3 instead of overcoat layer in the cited invention 1b.

Although the defendant asserts that the use of siloxane as a flattening film is a well-known technical matter as shown in Gazette Publication No.1989-307247 (Reference Otsu No.1) and Gazette Publication No.1990-123754 (Reference Otsu No.2), said Gazette Publication No.1989-307247 states that the oxide film formed by CVD method is not suitable to flattening because it is very thin as described above and that the forming method for flattened layer by siloxane (page 3, left-top column line 3-page 3, right-bottom column line 6) is not achieved by CVD method. This also applies to film formation by siloxane described in Gazette Publication No.1990-123754 (page 3, right-top column, the last line ~ page 3, left-bottom column line 14). In addition, the flattened film described in these documents should be formed not on an organic light-emitting element device like in the cited invention 1b and the cited invention 3 but on a semiconductor device. Moreover, there is not an enough evidence to prove that it is known that an organic light-emitting element can be treated in the same manner as a semiconductor element with regard to the damage received during the process of protection layer formation. Even if each document mentioned above describes the formation of flattened film using siloxane by methods other than a CVD method in semiconductor devices, that does not prove that it could be easily achieved by a person skilled in the art to form the protection film of siloxane disclosed in document

3 which describes “electrical insulation high-molecular compound such as polysiloxane which can form film by CVD method [plasma polymerization method (plasma CVD)]” and “it is desirable to inhibit property degradation of light-emitting layer and counter electrode in the process of protection layer formation as much as possible from a viewpoint of obtaining long-life organic EL elements and it is particularly desirable to place a protection layer under the vacuum environment by PVD method or CVD method” as mentioned above by means of methods other than CVD method under vacuum environment and to use it for the flattened film instead of the overcoat layer in the cited invention 1b.

The defendant asserts that the use of overcoat layer in the cited invention 1b in exchange for siloxane in the cited invention 3 could easily occur to a person skilled in the art who seeks to use a better material. However, siloxane described in the cited invention 3 cannot be recognized to have a suitable property to flattening as already mentioned, and it cannot be “a better material” in exchange for overcoat layer described in the cited invention 1b. Therefore, the said assertion by the defendant cannot be adopted.

[Close similarity of problem to be solved]

○**Tokyo High Court Decision, November 1, 2001 (2000 (Gyo-ke) 238 “Drink bottle coated with carbon film”)**

In this example, against the assertion by the plaintiff that the present invention and the cited invention have different technical problems and that there is no cause or motivation which could arrive at the invention based on the cited invention, the Court supported the trial decision which denied inventive step, finding that what should be questioned is not a technical problem of the present invention but whether or not a technical problem enough to constitute a cause or motivation leading to the constituent of the present invention is found in matters other than the present invention such as the cited invention, and that a technical problem enough to constitute a cause or motivation leading to the present invention is recognized in the cited invention.

(Excerpt from “judgment of this Court”)

e. As mentioned above, as its technical problem of the cited invention 1 is to increase gas-barrier property, it can be said that there is enough cause or motivation to use other objects which have good gas-barrier property instead of silicon oxide thin film used in that invention (this point can be emphasized more if having a property prone to crack or detachment was well known to a person skilled in the art in a case where silicon oxide SiOx thin film is used as a coating material as asserted by the plaintiff). Therefore, if another object which has good gas-barrier property and does not have a particular obstacle for the use of drink bottles comes to the knowledge in addition to the cited invention 1, it is clear that there is no particular difficulty in arriving at the constituent

which uses it instead of silicon oxide thin film in the cited invention 1. Moreover, as mentioned above, it was well known that rigid carbon film had a gas-barrier property and it was publicly known as a cited invention that the rigid carbon film can be applied to drink bottles. Therefore, arriving at the constituent which uses rigid carbon film instead of silicon oxide thin film used in the cited invention 1 based on the cause or motivation to solve the technical problem of increasing gas-barrier property could easily be achieved. It is permitted, therefore, that the trial decision admits easiness for arriving at the present invention 1 based on the cited invention 1, the cited invention 2 and the said well-known matters unless there is a particular circumstance which impedes it, and what falls under the said particular circumstance is not proven by all proofs in this case. As a result, the trial decision is correct without mentioning the appropriateness of finding (1)-c[3] in the trial decision.

(3) The plaintiff asserts that there is no cause or motivation to arrive at the present invention 1 based on the cited invention1 because the present invention 1 and the cited invention 1 have different technical problems.

However, the assertion of the plaintiff is nothing but an error. This is because the assertion of the plaintiff is based on the obvious assumption that the cause or motivation which arrives at the constituent in the present invention 1 does not exist other than in recognition of technical problem of the present invention 1, and there is no need to argue that such assumption cannot be admitted (In general, it is not unusual to take the same action from different motivation. Inventions are no exceptions and there is no surprise if different technical problems can be solved by the same constituent). The question to be asked is not whether a technical problem of the present invention 1 is found in cited invention 1 and the like other than the present invention 1, but whether technical problem appropriate enough to be a cause or motivation for arriving at the constituent of the present invention 1. There is not a problem even if the said technical problem is identical to that of the present invention 1, but it does not need to be the same. Therefore, in consideration of easiness for arriving at the constituent of the present invention 1, though it is necessary to reveal the technical problem of the cited invention 1, it is meaningless to argue on the technical problem of the present invention 1 (even if the problems of both inventions have similarity, it is nothing but an afterthought).

In addition, the technical problem (improvement of gas-barrier property) enough to constitute a cause or motivation which leads to the present invention 1 is recognized in the cited invention 1 as already mentioned. Thus, the assertion by the defendant cannot be adopted.

[Close similarity of problem to be solved]

○**Intellectual Property High Court Decision, July 19, 2007 (2006 (Gyo-ke) 10488 "Drive circuit")**

In this example, the court judged that it is necessary to consider technical difficulty to judge whether that combination is easy although there is a general cause or motivation to combine the cited document with the well-known art, and that whether that combination is easy cannot be judged only by the cause or motivation. And then the judgment was made that there is a situation which impedes the combination of the cited document with the well-known art, so that the cause or motivation is fragile and it could not have easily arrived at the constituent in connection with the difference.

(Excerpt from “judgment of this Court”)

(3) The plaintiff asserts that the cited document does not describe PWM light control operation of LED lamp at all, and that the cause or motivation to provide light control function using PWM light control operation does not necessarily exist in the cited invention that is based on continuous lighting of the LED lamp 106.

However, there is no conflict between parties concerned over the fact that a method of adjusting the light intensity using PWM light control technology, that is, pulse width modulation, is a well-known art, and its purpose is to control fluctuation in the amount of emitted light due to change in pulse current of LED lamp caused by prolonged lighting, etc. in the present invention (paragraphs [0008] ~ [0011] in the description of application concerned). Therefore, there exists a general cause or motivation. It is necessary, however, to consider technical difficulty described below to see whether the application of PWM light control technology to the cited invention is easy for a person skilled in the art and it cannot be judged only by a cause or motivation

(Omission)

(5) The plaintiff asserts that it is difficult for a person skilled in the art to arrive at the application of PWM light control technology to the cited invention, while the defendant argues contrarily.

a. In the LED lamp equipment both of the second working example and of the third working example in the cited document, a certain amount of electric power is fed to the LED lamp 106 only during a period, for example, of more than 40V out of wavy voltage obtained by full-wave rectification of commercial AC power as shown in Figure 4 of the cited document. In addition, current fed to the LED lamp 106 is controlled to be constant current by the switching control circuit 322.

On the other hand, the PWM light control technology turns current fed to a light-emitting element on and off at a constant frequency and cannot be directly applied to the LED lamp equipment in the cited document.

b. The defendant asserts that there is no problem to turn current fed to the LED lamp 106 on and off in the case of the third working example in the cited document and cites the description of (1)-d concerning the third working example in the cited document as a reason for it. According to this description, the power-supply equipment part of the third working example usually makes the

switching control circuit function as a current feedback switch. If current fed to the LED lamp 106 is turned on and off by applying the PWM light control technology, it is switched to function as a voltage feedback switch when current is off so that there is not a particular problem.

However, the switching control circuit usually functions as a voltage feedback switch in the description of said (1)-d, but it only states that it is controlled to function as current feedback switching power source when the LED lamp 106 is connected and does not disclose a specific constituent to realize such function.

In addition, current fed is turned on and off at a frequency of about 150Hz with the LED lamp 106 connected if PWM is modulated under a condition where the LED lamp 106 is connected. However, in the circuit in the third working example, the flywheel diode 317 (having a function to feedback current), the inductor 315 (having a function to go against change of current) and the condenser 620 (having a function to accumulate electric charge) are connected and therefore the circuit configuration has time element for response.

Based on this point, it is hard to believe that the switching control circuit quickly switches to voltage feedback-type when current is off and to current feedback-type when current is on under a condition where current flowing through the LED lamp 106 is turned on and off at about 150Hz. If that is the case, it is natural to understand that the description of said (1)-d in the cited document has the content not more than that the circuit normally functions as voltage feedback switching power source and functions as current feedback switching power source in the case where current control-type load such as LED is connected, and that it does not suppose automatic switching when fed current is turned on and off with the LED lamp 106 connected.

(6) It is hard to say that technical explanation on “destruction of power source,” etc., which the plaintiff asserted as the reason why it is difficult for a person skilled in the art to apply the PWM light control technology to the cited invention, is not necessarily persuasive enough to understand. However, the purpose of LED lamp of the cited invention is controlled for flowing current to be constant, while that of PWM light control operation adopted in the present invention is to control current flowing in LED on and off, so that it is possible to take in good part that the plaintiff points out an obstructive factor that the methods of control in both cases do not fit. Therefore, even if “destruction of power source” does not occur as asserted by the plaintiff, it was wrong for the trial decision to judge that a person skilled in the art could have easily achieved the application of PWM light control technology to the cited invention without sufficient consideration on circumstances which impede the application of PWM light control technology to the cited invention.

As described above, even if there is a general request for controlling light emission intensity and the PWM emitting technology is well known as its means, the cause or motivation is fragile for a person skilled in the art who came to contact with the description of cited document to apply the PWM light control technology to the cited invention, and he could not easily arrive at the constituent in connection with the difference, because there is a condition which impedes the application of PWM light control technology to LED the lamp equipment in the second working

example or the third working example in the cited document.

[Close similarity of problem to be solved]

○**Intellectual Property High Court Decision, December 25, 2007 (2007 (Gyo-ke) 10148 "Production method of film container")**

In this case, inventive step of the present invention was affirmed because not only there is no cause or motivation but also there exists a factor to obstruct the application in terms of application of said well-known technology to the cited invention, although the cited invention and the present invention have a similar problem and the art of difference is well known.

(Excerpt from "judgment of this Court")

If that is the case, it can be said that the cited invention also adopted the constituent in connection with the difference 1 (in laminate film in which two or more OPP films are laminated, releasing wax is applied to at least one side of one OPP films for coating) in order to solve the problem of thermal adhesion of films by thermal press molding.

d. Therefore, there is no error in the trial decision that "the purpose of coating releasing wax" of the cited invention.....is basically similar to the conventional problem that "films are thermally attached each other so that it becomes difficult to peel them off after molding even if one tries to peel them off in order to separately take out the container, which significantly lowers workability" as described in the specification of this case.

(2) Circumstances surrounding the art of matting as of filing the patent application concerned

a. Matting is an art in which fine projections and depressions are formed on a processed surface for purposes such as reducing the coefficient of friction on the surface, preventing the accumulation of static electricity and removing the gloss of the processed surface. There is no dispute over this point between the parties.

According to the descriptions in Known References 1 to 4, it can be confirmed that the aforesaid art of matting was an art known to a person ordinarily skilled in the art when the patent application in question was filed.

b. On the other hand, Reference Otsu No.15 states that "any desired unevenness created on the surface of the decorative sheet used in the foil decorating process … may be lost due to heat and pressure in the process," Reference Otsu No.16 says that "pressurization of film using a heated roll or a pressing machine results in melting of the film surface and in a loss of mat finish,". And Reference Otsu No.17 mentions that "the uneven surface of the sheet obtained from transfer of a mat roll disappears after thermal forming." Although well-known Reference 1 has descriptions noting that "the food container for cooking in this invention is a result of forming the aforementioned food container material using a publicly known forming method, such as the

thermal compression method" and that "a cup-shaped food container for cooking … was obtained by forming this food container material using the thermal compression method," even in consideration of these descriptions, it can be recognized that a person ordinarily skilled in the art thought that it was likely that the matted surface vanished after heat and pressure were simultaneously applied to it. There exists no other evidence that affects this recognition.

(Omission)

(3) Degree of ease of arriving at replacement of coating of mold release wax in the cited Invention with matting

a. The cited document, as shown in the said (1), may be deemed to identify thermal adhesion between films as a result of thermal process forming as a problem. However, it neither discloses nor suggests the art of matting as a means of solving this problem.

b. The well-known examples 2 and 3 have no description stating or implying that a matted resin membrane or plastic sheet is formed into a container or suchlike by applying heat and pressure. Given that, as mentioned in the said (2)-b above, the technical significance of matting was thought to be lost as described above after concurrent application of heat and pressure to the matted surface, it should be understood that there was no motivation to introduce the art of matting stated in well-known examples 2 or 3 to the cited Invention for the purpose of solving the problem of thermal adhesion between films resulting from the thermal press forming process or that there existed even a factor hindering the introduction.

(Omission)

f. In light of all that is examined above, the judgment of the trial decision that "it could have been easily achieved by a person skilled in the art to set the processing to "coat releasing wax" in the cited invention as an invention specific matter of this invention in connection with the difference 1 by replacing it with the above-mentioned well-known process of matting on container's surface" is incorrect, because that judgment was made by misinterpreting the technical significance of matting described in the well-known example 1 and the well-known example 4 in relation to the said specific problem facing this invention and the cited invention.

[Close similarity of problem to be solved]

○**Intellectual Property High Court Decision, March 29, 2007 (2006 (Gyo-ke) 10422 "Water-proof and divergent shoe sole for footwear")**

In this example, the defendant asserted that layering synthetic resin on the peripheral part where the top surface of leather sole is exposed is enough to improve waterproof property [problem] and that would inevitably lead to the constituent in connection with the difference. However, the court judged that the assertion did not have any supportive evidence because the cited document describes that "(waterproof property) is fully effective" and the cited document and

the well-known example do not mention nor indicate coating “with upper member made of impermeable material (well-known example)” in order to further enhance water-proof property, and that the defendant afterwards added the reasoning for the constituent in connection with the difference of the present invention afterwards.

(Excerpt from “judgment of this Court”)

(3) On the other hand, as the Reference Kou No.1 describes that “although the water-proof cloth was placed with lamination on the stepping part on the upper surface of the main sole 1 in this working example, it can be placed in a manner that it is laminated on the entire upper surface of the main sole 1. Discomfort due to water infiltration or heat damage inside the shoe is significant in particular on the stepping side in the sole so that placing the water-proof cloth 2 with lamination only at the stepping part is sufficiently effective as shown in this working example” (page 4, last paragraph - page 5, second paragraph). Therefore, the example describes that although water-proof property increases by placing the water-proof cloth 2 with lamination on the entire upper surface of the leather main sole 1, air permeability decreases and the problem of discomfort due to heat damage inside the shoe arises in that case. On the other hand, in order to solve that problem, a technical thought of coating with upper member made of an impermeable material with through-holes to keep air permeability of the water-proof cloth is not mentioned nor indicated.

The defendant asserts that water-proof property is ensured by the water-proof member 2 at a part where the water-proof member 2 is placed with lamination in the cited invention so that it is enough to laminate synthetic resin on a part where the upper surface of the leather main sole 1 is exposed and the water-proof member 2 is not laminated with lamination in order to further improve waterproof property. He also asserts that a person skilled in the art could have easily arrived at coating a part where the upper surface of the leather main sole 1 is exposed alongside circumference with synthetic resin, because a part where the upper surface of the leather main sole 1 is exposed is the circumference of the leather main sole 1, and that coating a part where the upper surface of the leather main sole 1 is exposed along the circumference with synthetic resin could inevitably result in synthetic resin with through-holes.

It is true that if synthetic resin is laminated on a part where the upper surface of the leather main sole 1 is exposed for improving water-proof property in the cited invention, “upper member made of impermeable materials with through-holes” can be adopted, that is, water-proof property of the cited invention can be improved by adopting the constituent of the present invention’s difference, because a part where the upper surface of the leather main sole 1 is exposed is the circumference. However, the cited invention describes that water proof property is achieved by laminating “water-proof member with permeability” and that “laminating the water-proof cloth 2 with lamination only on the stepping part (Note of the judgment: Equivalent to “film made of permeable and water-proof materials” in the present invention) is effective enough” (Second

paragraph, page 5 of Reference Otsu No.1 description). Therefore, it concludes that such placement is enough.

The cited document does not describe nor indicate "coating with upper member made of impermeable materials" in order to further improve water-proof property, and Reference Kou No.2 document or Reference Kou No.4 document that the trial decision cites as a well-known art does not describe it either. Therefore, it cannot be said that a person skilled in the art could easily arrive at adopting of the constituent in connection with the difference of the present invention of coating with upper member made of impermeable materials with through-holes in order to keep permeability of water-proof cloth. The said assertion by the defendant is baseless and the defendant afterwards added the reasoning for the constituent of the difference of the present invention afterwards. Therefore, it cannot be adopted.

[Close similarity of function, work or operation]

○**Tokyo High Court Decision, February 14, 1991 (1989 (Gyo-ke) 90 "Filtration equipment of cooking oil such as tempura oil")**

The cited document 1 and the cited document 2 are similar with regard to function and operation, and their technical matters are not necessarily in different technical fields, so that a part of the description of the cited document 1 is easily replaced with the constituent of the description of the cited document 2. Therefore, the trial decision which denied inventive step was supported.

(Excerpt from "judgment of this Court")

(1) The constituent of storage layout of filter elements in the device is merely a placing of filter elements made of a number of laminated paper filter bodies formed in a sheet shape on the bottom part in the main container, as described in the said charge of finding. In addition, there is no conflict between parties concerned that the finding of the trial decision in the cited document 1 describes "oil filtration container for tempura oil, etc. in which nets with small meshes are placed as filter and larger nets are placed over them at the bottom part in the bottom-less tubular container whose upper surface is opened." Therefore, the device is similar to a device described in the cited document 1 except the specific constituent of filtration part which uses filter elements as pointed out in the trial decision, and there found no other differences (thus, there is no passing over the differences between the device and that described in the cited document 1 in the trial decision). If so, there is no conflict between parties concerned that the cited document 2 (Publication of unexamined utility model application No. 1979-73574) describes that "the filtration equipment characterized by placing the pressure receiving board on the upper surface of filter elements made of laminated paper, storing them in the cartridge container, forming an opening which introduces stock solution into the upper surface of cartridge container, and forming an

opening for taking out filtrate which reaches the central passage to filter elements on the bottom surface." According to Reference Kou No.5 (cited document 2) in which there is no conflict over completion, since the filtration equipment described in the cited document 2 has common functions to the filtration part of the oil filtration container described in the cited document 1 as filtration equipment for removing solid from liquid, it is not particularly difficult to arrive at the device by replacing it with the filtration part described in the cited document 1. The document which the trial decision cited as cited document 2 (Reference Kou No.5 above) is a document of unexamined utility model application, and only mentions a simple explanation of claim of utility model and drawings. If it is possible to refer to the description of all disclosed specifications (Reference Kou No.6) equivalent to the cited document 2, and according to it, even if the device of the cited document 2, as asserted by the plaintiff, relates to filtration equipment for lubricant oil of internal-combustion engine of motor vehicles, etc. and intends to remove impurities such as oxidation products essentially existing in lubricant oil, the constituent itself of storage arrangement of filter elements in the device is merely a constituent which places filter elements at the bottom part of the main container. In addition, both the cited documents 1 and 2 are similar with regard to operation and function that they are filtration equipment to remove solid from liquid. Taking into account the purpose and problem generally required as filtration equipment, since their technical matters are not necessarily in different technical fields, there would not be particularly difficulty in arriving at the use of filtration equipment described in the cited document 2 instead of the filtration part described in the cited document 1.

[Close similarity of function, work or operation]

○**Intellectual Property High Court Decision, October 6, 2005 (2005 (Gyo-ke) 10382 "Cleansing pad")**

In this example, the court judged that there was not a particular difficulty in converting the hair brush in the cited device to a cleansing pad because the device and the cited device are similar in basic structure and working effect (operation and function) and their technical fields are also similar. Therefore, the trial decision which denied inventive step was supported.

(Excerpt from "judgment of this court")

a. Considering the technical field, operation and function, etc. of the device, it relates to "a cleansing pad used for make-up removing" (Paragraph [0001]) according to the claim of utility model and detailed explanation of the device, and the conventional brush as shown in Reference Kou No.6 cannot clean stains up in a delicate manner by fitting it to asperity of the face. Therefore, in order to "clean stains in the pores and keratotic plug rapidly and smoothly" (Paragraph [0003]), it is recognized that working effect that "the pad smoothly fits asperity of the face and cleans even

stein in the pores and keratotic plug rapidly and smoothly" (Paragraph [0024]) will be exercised by adopting the constituent described in claim 1.

b. On the other hand, according to document 1 (Reference Kou No.3), the cited device is "a hair brush which integrally constitutes a number of combs 4 made of the same material as the substrate 1 on the entire surface of soft synthetic resin substrate 1" (claim of utility model) and "it is for styling hair with the combs 4 by holding the both sides of the substrate 1" (page 2, lines 12 - page 2, lines 14). And it is recognized that working effect that "as the substrate 1 is made up of thin sheets of soft synthetic resin....., it is possible to use it for styling hair with the all combs 4 by curving it according to a user's head shape. Moreover, the combs 4 are made of the same soft synthetic resin material as the substrate 1 and formed integrally with the substrate 1 so that they are soft in texture." (page 2, second line from the bottom - page 3, line 5) will be exercised.

Although the cited device does not mention clearly, it is a well-known matter, as shown in the trial decision Reference Kou No.2 and Kou No.3, that a hair brush whose substrate is made of soft synthetic resin and which has combs made of the same material as the substrate as in the cited device can be also used as a hair-washing brush. That is to say, the trial decision Reference Kou No.2 describes that "a washing brush characterized by setting a contoured part cut (2) by placing a cut at the half length of palm-size flexible synthetic resin sheet on which comb-shaped projections (1) are lined uniformly on one side-surface excluding the contoured part and by setting a cut for refraction (3) by placing a plurality of parallel cuts having an appropriate length which does not reach to the contoured part to avoid the said lining comb-shaped projections (1)" (page 1, line 5 - page 1, line 13), "this device relates to the improvement of washing brush.....for hair washing" (page 1, line 15 - page 1, line 16), and also indicates that the brush whose main body is made of synthetic resin and which has brush-shaped projections can be used for washing hair. In addition, the trial decision Reference Kou No.3 describes that "the device relates to a brush made of soft synthetic resin, easily retained by inserting the index finger and, and used for washing hair and smoothing the hair down with the brush equipped in a small rupture shape on the wrong side" (page 1, 2 lines from the bottom on the left column - page 1, line 2 on the right column) and discloses that the hair brush whose main body is made of soft synthetic resin and has small ruptures (combs) can be used for both hair styling and hair washing. Additionally, it is clear from empirical rules that not only hair but also scalp is washed at the time of hair washing.

c. Based on a and b above, the cleansing pad (face-washing brush) in connection with the device and the hair brush (hair-washing brush) in connection with the cited device are (1) both often used at a restroom or a washroom and by applying the brush part to the body's skin to wash that part, (2) have the brush part made up of a number of projections on one side of thin-sheet shape main body and are common in the basic structure that the main body and projections are integrally made up of soft synthetic resin, and (3) have flexibility as a whole and are also similar in working effect that they fits according to asperity of head or face. Therefore, the both devices are similar in their technical fields, functions and working effects, so that there would not be a particular difficulty

in converting the hair brush of the cited device to the cleansing pad in connection with the device.

[Suggestions shown in the contents of cited inventions]

○**Intellectual Property High Court decision, January 28, 2009 (2008 (Gyo-ke) 10096 "Connecting member for circuit")**

The court judged that it is not recognized that there is a suggestion to use specific materials (which are not explicitly described) by focusing only on further improvement of compatibility and adhesiveness in the cited document, because there is no description that there is a particular problem of compatibility and adhesiveness in it, and there are other factors to be considered in preparing resin composition. Therefore, also taking other facts into consideration the trial decision which concluded that a person skilled in the art could have easily arrived at the present invention was incorrect.

(Excerpt from "judgment of this court")

On the other hand, the said 1 and the cited document (2) describe that "phenoxy resin.....has properties such as good compatibility and adhesiveness because its structure is similar to that of epoxy resin" (paragraph [0007] in Reference Kou No.4) and there is no description that there is a particular problem of compatibility and adhesiveness. There are other factors to be considered such as heat resistance, insulating property, rigidity and viscosity in preparing resin composition for connecting member for circuit. Therefore, it is not recognized that there is a suggestion to use bisphenol-F phenoxy resin by focusing only on further improvement of compatibility and adhesiveness. Moreover, although bisphenol-F phenoxy resin was generally an already known resin as of filing the applications (Reference Otsu No.2 and Otsu No.3), there is not any proof to prove that it was known that the resin could also improve connection reliability and repair easiness of the connecting member for circuit.

In addition, bisphenol-F phenoxy resin has a problem that it is less heat resistant than bisphenol-A phenoxy resin. That is to say, according to "Journal of Applied Polymer Science Vol.7, pp.2135-2144 (1963)" (Reference Kou No.6), the glass transfer point of bisphenol-F phenoxy resin (based on chemical structure, equivalent to Polymer No.2 in TABLE I on page 2138 in Reference Kou No.6) is "80 degrees," while that of bisphenol-A phenoxy resin (based on chemical structure, equivalent to Polymer No.3 in TABLE II on page 2139 in Reference Kou No.6) is "100 degrees" so that bisphenol-F phenoxy resin has a lower heat resistance. In the light of properties of the said bisphenol-F phenoxy resin, it could not be easy for a person skilled in the art to use less heat-resistant bisphenol-F phenoxy resin instead of bisphenol-A phenoxy resin (PKHA) (paragraph [0022] in Reference Kou No.4) on which no particular problems are reported as a phenoxy resin used for connecting member for circuit for which good heat resistance is required.

(Omission)

Considering the above-mentioned facts comprehensively, it cannot be said that a person skilled in the art could easily arrive at the use of bisphenol-F phenoxy resin with regard to phenoxy resin in the invention described in the cited document, and the trial decision which judged that the amended invention cannot be patented separately as of filing based on the provision of the Patent Act, Article 29, Paragraph 2 is incorrect. That mistake affects the conclusion of the trial decision.

4. Well-known art

(Examination Guidelines Part IX, Procedure of Examination, Section II, Details)

7.2 Decision of Refusal

Where the notified reasons for refusal are still unsolved even in response to the notice of reasons for refusal, decision of refusal should be made regardless of whether the notice is "the first" or "the final" one (Patent Act Article 49).

(Omitted)

Practically, the following points should be remarked.

(1) (Omitted)

(2) (Omitted)

(3) Obsessed by the notified reasons for refusal, the examiner should not make an unreasonable decision such as additionally referring to new prior art documents. In deciding on refusal, the examiner should not refer to the new prior art except for the well-known art or the commonly used art.

The Examination Guidelines Part IX, chapter II, 7.2(3) states that "In deciding on refusal, the examiner should not refer to the new prior art except for the well-known art or the commonly used art". Therefore, the decision of refusal can be made by newly citing prior art documents in order to demonstrate the ground of such well-known art, which is publicly known in the technical field and no doubt known to a person skilled in the art.

On the other hand, if a matter described in documents cited as a ground of the well-known art is not well known, it becomes a different reason from "the notified reason for refusal" in the notification of reason for refusal which is already notified. Therefore, the examiner should notify a new notification of reason for refusal and should offer an opportunity for the applicant to express his opinions.

[Reference court decision]

○**Tokyo High Court Decision, May 26, 1992 (1990 (Gyo-ke) 228 "A method of controlling relative humidity of soil environment and a device to achieve it")**

Whether or not a notification of reason for refusal is required again when another reason for refusal is found should be judged based on whether an opportunity for the applicant to exercise the protection right is deprived and protection of interests guaranteed for the applicant is lacking. In this example, the court judged that even if the trial decision judged that there is no inventive step by adding well-known matters, it should be understood that it does not fall under a new reason for refusal.

(Excerpt from “judgment of this Court”)

The notification system of reasons for refusal is to provide an applicant with an opportunity, when an examiner (trial examiner) finds a reason for refusing the application, to submit a written opinion and a written amendment of procedure if necessary and to promote appropriate operation of the patent application system, by notifying him of that effect. Therefore, whether a notification of reason for refusal is required again when an trial examiner finds a different reason for refusal from the reason for examination based on the provision of the Patent Act Article 159, Paragraph 2 should be judged based on whether an opportunity for the applicant to exercise the protection right is deprived and protection of interests guaranteed for the applicant is lacking. (In that case, when the notification of reason for refusal has already been issued, and a demand for trial is disagreed based on a reason other than the reason for examination decision, an opportunity for explanation and protection is given to the applicant through a written opinion, so that there is no lack of protection of interests without re-notification of reason for refusal).

Therefore, in this trial procedure, judgment is made on whether a notification of reason for refusal is required as a case where a reason for refusal different from the reason for examination is found, when the first invention is judged not to have inventive step based on the first cited document and the second cited document shown in the notification of reason for refusal as well as well-known matters not shown in them.

According to the main point of the said reason for trial, the well-known matter identified in the trial decision relates to the existence of a material called high-absorption polymer before the time of filing this application and properties of the relevant high-absorption polymer. It indicates, therefore, that the said matter is a well-known art to a person skilled in the art, that is, a well-known and a commonly used art, in the light of state of the art as of filing this application.

Since the well-known and commonly used art is familiar to a person skilled in the art and commonly used, it can be said that a person skilled in the art no doubt understands its technical contents without showing them in the notification of reason for refusal. In addition, in a case where there is still a difference from the relevant invention based only on technical documents cited in the notification of reason for refusal which states that the present invention in connection with application does not have inventive step, a person skilled in the art could often understand that it means that there is no inventive step by replacing the well-known and commonly used art.

(Omission)

Moreover, the plaintiff asserts the fact that the notification of reason for refusal does not include the well-known example 1 and the well-known example 3 as a reason for violation against the said law’s article. However, the well-known and commonly used art is much familiar to a person skilled in the art. Therefore, it is enough to identify the well-known and commonly used technical contents and it is not necessary to cite all grounds. In another word, whether there is violation against the said law’s article in trial procedure in this case is a question of whether it is necessary to notify

again a reason for refusal to which the said well-known matter is added, not a question of whether it is necessary to cite the well-known example. Thus, the said assertion by the defendant has no ground.

○**Intellectual Property High Court Decision, December 20, 2006 (2006 (Gyo-ke) 10102 "A method of adjusting sheet tension, sheet tension adjusting device and core for sheet role")**

In this example, a matter regarded to be described in document 2 at the stage of examination was regarded as a well-known art at the trial stage. However, the court judged that the matter was not recognized as a well-known matter and there was infringement of procedure because an opportunity for expressing opinions was not offered to the applicant.

(Excerpt from "Judgment of This Court")

As described in the said holding, the plaintiff has argued over the finding that document 2 describes control of load against rotation based on the winder data and the drawing data through the examination procedure and the trial procedure.

As the defendant also points out, a well-known art is merely an art generally known in that technical field and to a person skilled in the art. Therefore, even if the trial decision is made that there is no inventive step by adding well-known matters not shown in the notification of reason for refusal in the trial procedure, it should be understood that in principle it does not fall under a new reason for refusal (e.g. refer to Tokyo High Court Decision, May 26, 1992(1999 (Gyo-ke) No.228)).

However, in this case, the constituent in connection with the difference between the amended invention and the cited invention 1 is an important part of the amended invention. Therefore, an examiner mistakenly judged that the constituent in connection with the said difference was described in document 2 and notified and decided to refuse the application. Although the plaintiff had argued over the finding based on document 2 in the examination procedure and the trial procedure, the trial decision mistakenly recognized the constituent in connection with the difference based on a well-known art instead of document 2, which was not substantially shown in the examination procedure,. Furthermore, that well-known art is not recognized to be well-known like the universal principle and a highly common/basic matter to a person skilled in the art. In such a case, it can be said that a reason different from the reason of refusal was found in the trial against examiner's decision of refusal, so that it was necessary to provide the plaintiff, the applicant, with an opportunity to express his opinions by issuing a new notification of reason for refusal from a viewpoint of guaranteeing procedural appropriateness required by the notification system of reasons for refusal. Since the trial decision used the said well-known art as a basis for judging the difference, this failure of procedure clearly affects the conclusion of the trial decision.