### **Appeal Decision**

Appeal No. 2016-10124

Tokyo, Japan Appellant

RUIFAN JAPAN LTD.

Tokyo, Japan Patent Attorney

### SHIRASAKA & PATENT PARTNERS

Tokyo, Japan Patent Attorney SHIRAS

SHIRASAKA, Hajime

The case of appeal against the examiner's decision of refusal of Japanese Patent Application No. 2015-213999, entitled "Rod-type Light" (the application published on March 31, 2016, Japanese Unexamined Patent Application Publication No. 2016-42474) has resulted in the following appeal decision:

## Conclusion

The appeal of the case was groundless.

### Reason

1. History of the procedures and the Invention

The present application was filed on May 29, 2012 as Japanese Patent Application No. 2012-122301 (hereinafter, referred to as "original application"), a part thereof was filed on December 7, 2012 as a new patent application (Japanese Patent Application No. 2012-267879), and further, a part thereof was filed on October 30, 2015 as a new patent application. The history of the procedures is as follows:

February 5, 2016	Notice of reasons for refusal
March 10, 2016	Submission of the written opinion and written amendment
March 29, 2016	Examiner's decision of refusal
July 5, 2016	Submission of the request for appeal and written
amendment	
March 14, 2017	Notice of reasons for refusal
May 22, 2017	Submission of the written opinion and written amendment
June 23, 2017	Notice of reasons for refusal
August 28, 2017	Submission of the written opinion and written amendment

The inventions relating to Claims 1 to 8 of the present application are recognized to be as specified by the matters described in Claims 1 to 8 in the scope of claims which were amended by the amendment dated August 28, 2017, and the invention relating to Claim 1 (hereinafter, referred to as "the Invention") is as follows: "[Claim 1]

A rod-type light provided with:

a cylindrical body part;

a light emitting part which is arranged inside the body part and emits light;

a head part which is provided on a front end of the body part;

a holding part which is coupled with the body part and used for being gripped by a hand;

a power supply part which is provided inside the holding part and supplies power to the light emitting part;

a control part which is provided inside the holding part and controls light emission conditions of the light emitting part; and

a switch part which is provided outside the holding part and instructs the control part to switch the light emission conditions; wherein

the body part is coupled with the holding part by being inserted into the holding part;

the light emitting part is arranged at a part of the body part which is inserted into the holding part;

the light emitting part includes a light emitting diode for emitting white light and by using light emitting bodies that are light emitting diodes, allows the light emitting bodies to emit light of a plurality of luminous colors; and

the control part can switch the illuminance of each of the light emitting bodies according to the number of times the switch part is pressed."

2. Cited Invention and matters described in Cited Document

(1) Cited Invention

In RUIFAN Japan "King Blade Max (dimensions of light emitting part:  $\phi$  30 mm × H: 150 mm; total length: 250 mm), JAN code: 4562342920072" which was cited in the reasons for refusal notified by the body on March 14, 2017 (hereinafter, referred to as "the reasons for refusal by the body") and was sold in Japan before filing the original application, it is recognized that the following invention (hereinafter, referred to as "the Cited Invention") is implemented.

[Cited Invention]

"A rod-type light provided with:

a cylindrical body part;

a light emitting part which is arranged inside the body part and emits light;

a head part which is provided on a front end of the body part and shields the light emitted by the light emitting part;

a holding part which is coupled with the body part, provided with a hole at a side surface thereof, and used for being gripped by a hand;

a power supply part which is provided inside the holding part and supplies power to the light emitting part;

a heat dissipating part which is provided so as to be adjacent to the hole inside the holding part and dissipates heat generated by the light emitting part; wherein

the body part is coupled with the holding part by being inserted into the holding part;

the light emitting part is arranged at a part of the body part which is inserted into the holding part; wherein

(A) the body part is constituted of a transparent cylindrical synthetic resin and has a cylindrically rounded orange film inserted thereinside;

(B) the body part and holding part are separately constituted and they are detachable from each other due to screwed coupling so as to allow separation and coupling;

(C) a control substrate for controlling light emission conditions of the light emitting part is provided, which is arranged inside the holding part and causes light emission while changing various light emission conditions according to a switch operation;

(D) a protrusion for attaching a strap is formed on the holding part;

(E) an end part on the head part side of the body part is closed and a cap-like object is provided in its inner side; and

(F) a switch for instructing switching of the light emission conditions of the light emitting part is provided on the bottom of the holding part and causes light emission while changing various light emission conditions according to a switch press operation."

The finding of the above Cited Invention was based on a matter which was considered to have no dispute between the parties of the case in the court decision 2015 (Gyo-Ke) 10069 (rendition of decision on January 14, 2016). The court case is a litigation rescinding the trial decision against the decision of the case of trial regarding the invalidation (Invalidation No. 2014-800030) of the patent (Japanese Patent No. 5324681) relating to the original application (Japanese Patent Application No. 2012-122301) that is a patent application as a division source of the present application. The plaintiff who is one of the parties of the court case is an appellant of this case of appeal.

In addition, it has been confirmed by ex officio from Demandant's Exhibit No. 1 of the invalidation trial case described above that the Cited Invention is one used at a concert, at a live show, or outdoors and that to cause "light emission while changing various light emission conditions according to a switch (press) operation" in "(C)" and "(F)" above is to perform "a four-step light quantity adjustment."

### (2) Cited Document 1

Japanese Unexamined Patent Application Publication No. 2000-90702 (hereinafter, referred to as "Cited Document 1") that was cited in the reasons for refusal by the body and distributed in Japan before filing of the original application includes the following description.

Underlines are added by the body. The same shall apply hereinafter.

# A

"[0001]

[Field of the Invention] The present invention relates to a stick light. [0002]

[Background Art] As a tool to liven up the atmosphere at a concert venue or night amusement park, a stick light (also referred to as a pen light or cheer light) is used. ... [0003]

[Problem to be Solved by the Invention] The conventional stick light uses only one light emitting diode as a light source. Therefore, it is poor in variety of luminous colors; that is, it lacks fun. Then, the present invention aims at providing a stick light of a novel configuration having various light emission modes."

## В

"[0012] The stick light of this invention allows selection of various luminous modes. A stick light is normally used in a dark venue and therefore, a switch for selection cannot be seen in many cases. Then, in the example, the above seven colors (red, yellow, green, blue-green, blue, purple, and white) are associated with each other in a predetermined order <u>so as to have one of the seven colors selected in this order when a</u> <u>switch operation is performed.</u> Specifically, each time the switch is pressed once, the <u>color is changed in the order of "red  $\rightarrow$  yellow  $\rightarrow$  green  $\rightarrow$  blue-green  $\rightarrow$  blue  $\rightarrow$  purple  $\rightarrow$  white (and repeated in this order)." ...</u>

# [0013]

[Example] An example of the present invention is described below. ... The grip part 10 is cylindrical in shape and a center part of a front thereof is notched. At the notched part, <u>a color select switch (first switch) 11</u> and a mode select switch (second switch) 13 are provided.

[0014] ... <u>The light source part 30 is provided with three light emitting diodes of a red</u><u>light emitting diode 30R, a green light emitting diode 30G, and a blue light emitting</u><u>diode 30B.</u> These light emitting diodes are controlled by the control device 41 shown in FIG. 4. ... Although the lamp-type color light emitting diodes 30R, 30G, and 30B are used in the light source part 30 in this example, <u>chip-type light emitting diodes can</u><u>be used instead</u>. Further, one lamp of one package including chips of those colors can <u>also be used</u>.

[0015] The rod-shaped light emitting body 50 (light guide body) has a solid cylindrical shape and a tip end part thereof has a spherical surface. Meanwhile, a base end part thereof is inserted into the cap 15 and faces the light source part 30." ... Light emitted from the light source part 30 is introduced from the base end part into the rod-shaped light emitting body 50. The introduced light is irregularly reflected by silica fine powder within the rod-shaped light emitting body 50 and is emitted from the whole surface of the rod-shaped light emitting body 50 with substantially uniform brightness. Thus, the whole of the rod-shaped light emitting body 50 emits light of the color of the light source part 30.

[0016] The control device 41 includes a CPU 42 and a memory 44. The CPU 42 executes various controls described below on the basis of control programs stored in the memory 44. In the memory 44, data on the on/off state of each of the light emitting diodes required for making the whole light source part 30 emit light of any color of red, yellow, green, blue-green, blue, purple, or white is stored. In addition, a first counter of the control device 41, which is not illustrated, has seven values and the seven values correspond to the above seven colors. This first counter takes the first value following the seventh value. When the color select switch 11 is pressed, a value of the first counter is incremented by one and data corresponding to the counter value are called from the memory 44. The CPU 42 controls the drivers 45R, 45G, and 45B on the basis of the data. For example, when a color selected by the switch 11 is red and data for causing the light source part 30 to emit red light is read from the memory 44, the CPU 42 controls the drivers 45R, 45G, and 45B so that only the red light emitting diode 30R is illuminated. Further, when a color selected by the switch 11 is yellow and data for causing the light source part 30 to emit yellow light is read from the memory 44, the CPU 42 controls the drivers 45R, 45G, and 45B so that the red light emitting diode 30R and green light emitting diode 30G are illuminated and the blue light emitting diode 30B is not illuminated."

С

"[0022] <u>The light emission intensity of each light emitting diode</u> and the flashing timing thereof <u>can be arbitrarily adjusted</u>. Therefore, <u>it is understood that the stick light</u> of the example <u>can provide light emission modes other than the one described above by</u>

#### changing the control program in the memory 44."

3. Comparison / judgment

(1) Comparison

The Invention and the Cited Invention are compared.

The "cylindrical body part" in the latter corresponds to the "cylindrical body part" in the former.

The "light emitting part which is arranged inside the body part and emits light" in the latter corresponds to the "light emitting part which is arranged inside the body part and emits light" in the former.

The "head part which is provided on a front end of the body part and shields the light emitted by the light emitting part" in the latter corresponds to the "head part which is provided on a front end of the body part" in the former.

The "holding part which is coupled with the body part, provided with a hole at a side surface thereof, and used for being gripped by a hand" in the latter corresponds to the "holding part which is coupled with the body part and used for being gripped by a hand" in the former.

The "power supply part which is provided inside the holding part and supplies power to the light emitting part" in the latter corresponds to the "power supply part which is provided inside the holding part and supplies power to the light emitting part" in the former.

The "control substrate for controlling light emission conditions of the light emitting part" "which is arranged inside the holding part and causes light emission while changing various light emission conditions according to a switch operation" in "(C)" in the latter corresponds to the "control part which is provided inside the holding part and controls light emission conditions of the light emitting part" in the former.

The "switch for instructing switching of the light emission conditions of the light emitting part" "provided on the bottom of the holding part" in "(F)" of the latter corresponds to the "switch part which is provided outside the holding part and instructs the control part to switch the light emission conditions" in the former.

The feature of "the body part is coupled with the holding part by being inserted into the holding part" in the latter corresponds to the feature of "the body part is coupled with the holding part by being inserted into the holding part" in the former.

The feature of "the light emitting part is arranged at a part of the body part which is inserted into the holding part" in the latter corresponds to the feature of "the light emitting part is arranged at a part of the body part which is inserted into the holding part" in the former.

The "control substrate for controlling light emission conditions of the light emitting part" in "(C)" of the latter causes the light emitting part to emit light "while changing various light emission conditions according to a switch operation" and therefore, its feature is identical to the feature of "the control part can switch the illuminance of each of the light emitting bodies according to the number of times the switch part is pressed" in the former in terms of only " the control part can switch the light emission conditions of the light emitting part by pressing of the switch part."

The "rod-type light" of the latter corresponds to the "rod-type light" of the former.

Then, it can be said that the corresponding features and different features

between them are as follows:

[Corresponding features]

"A rod-type light comprising:

a cylindrical body part;

a light emitting part which is arranged inside the body part and emits light;

a head part which is provided on a front end of the body part;

a holding part which is coupled with the body part and used for being gripped by a hand

a power supply part which is provided inside the holding part and supplies power to the light emitting part;

a control part which is provided inside the holding part and controls light emission conditions of the light emitting part; and

a switch part which is provided outside the holding part and instructs the control part to switch the light emission conditions; wherein

the body part is coupled with the holding part by being inserted into the holding part;

the light emitting part is arranged at a part of the body part which is inserted into the holding part;

the control part can switch the light emission conditions of the light emitting part by pressing of the switch part."

[Different feature 1]

The Invention provides the feature that "the light emitting part includes a light emitting diode for emitting white light and by using light emitting bodies that are light emitting diodes, allows the light emitting bodies to emit light of a plurality of luminous colors"; whereas, the Cited Invention does not specify the light emitting part as such. [Different feature 2]

The Invention allows the control part to "switch the illuminance of each of the light emitting bodies according to the number of times the switch part is pressed"; whereas, the Cited Invention varies the light emission conditions of the light emitting part according to a switch operation, but the contents of the light emission conditions are not clear.

(2) Judgment

The above different features are examined below.

A Matter described in Cited Document 1

According to "2. (2) A, B, and C" above, it can be said that the Cited Document 1 describes:

(A) the light source part 30 is constituted of three light emitting diodes of a red color light emitting diode 30R, a green color light emitting diode 30G, and a blue color light emitting diode 30B, or constituted by one package including three-color light emitting diode chips (refer to paragraph [0014]);

(B) the light source part 30 can emit light of a plurality of colors including white color (refer to paragraphs [0012] and [0016]);

(C) each time the color select switch 11 is pressed, a value of the counter is incremented by one and data corresponding to the counter value is called from the memory 44, and the CPU 42 controls the drivers 45R, 45G, and 45B on the basis of the data so as to control illumination of the light emitting diodes, thereby obtaining a luminous color corresponding to the counter value (refer to paragraph [0016]);

(D) when a color selected by the switch 11 is red, only the red light emitting diode 30R is illuminated (refer to paragraph [0016]); and

(E) the light emission intensity of each of the light emitting diodes constituting the light source part 30 can be arbitrarily adjusted (refer to paragraph [0022]).

In addition, it is recognized that (F) the description in the (E) above indicates that the "luminous color corresponding to the counter value" in (C) above can represent a light emission mode including not only luminous color but also illuminance.

B Regarding Different feature 1

In comparison between the Invention and the above matter described in Cited Document 1, the feature of "the light source part 30 is constituted of three light emitting diodes of a red color light emitting diode 30R, a green color light emitting diode 30G, and a blue color light emitting diode 30B" in A (A) above of the latter indicates that illumination of the light emitting diodes is controlled so as to obtain a plurality of luminous colors, as described in A (C) above; and therefore, it is identical to the feature of "the light emitting part includes a light emitting diode for emitting white light and by using light emitting bodies that are light emitting diodes, allows the light emitting bodies to emit light of a plurality of luminous colors" of the former only in that "the light emitting part allows the light emitting bodies to emit light of a plurality of luminous colors by using the light emitting bodies that are light emitting diodes."

The appellant alleges the following in the written opinion dated August 28, 2017. "(3) Regarding reason 1

A judge recognized in the notice of reasons for refusal (note for the body; dated June 23, 2017) that the requirement stipulated in Article 17-2(3) of the Patent Act was not satisfied.

Against this, the applicant made amendment to limit the original Claim 1 to obtain a new Claim 1, as mentioned in the above grounds for amendment.

Specifically, in new Claim 1, the constituent component of 'the light emitting part includes a light emitting diode for emitting white light and, by using a light emitting body that is the light emitting diode for emitting white light, allows light emitting bodies to emit light of a plurality of luminous colors' has been changed to the constituent component of 'the light emitting part includes a light emitting diode for emitting diode for emitting white light emitting diode for emitting bodies that are light emitting diodes, allows the light emitting bodies to emit light of a plurality of luminous colors'.

The examiner stated that 'mixing other colors into a white color is neither described nor suggested.' ... Then, in the amendment of this time, an explicit description about mixing with a white color is avoided because there is no direct description about it in the specification, and it has been made clear that the light emitting part is such that 'a light emitting diode for emitting white light' and 'light emitting bodies to emit light of a plurality of luminous colors'. "

According to the above allegation, the matter of "the light emitting part includes a light emitting diode for emitting white light and by using light emitting bodies that are light emitting diodes, allows the light emitting bodies to emit light of a plurality of luminous colors" in the Invention is recognized to exclude the feature that a diode for emitting white light and other color light emitting diodes are simultaneously made to emit light to obtain a mixed color.

In addition, it can be said to have been a well-known matter before the filing of the original application that colored light emitting diodes such as red, green, and blue light emitting diodes and a white light emitting diode are combined and made to emit light of each single color or light of a single white color, as described in, for example, Registered Utility Model Publication No. 3087329 (refer to paragraphs [0010], [0024], and [0025]) and Japanese Unexamined Patent Application Publication No. 2001-101901 (refer to paragraph [0021]). (It should be noted that mixing into a white color is also described in Unexamined Patent Application No. 2001-101901.)

It is recognized that the Cited Invention is one used at events such as a concert, etc. and in view of its use, it can be said that a person skilled in the art can easily conceive of causing emission of light of various luminous colors and there is a sufficient motivation to employ the matter described in Cited Document 1, that is a technical matter for similar use. In addition, in the matter described in Cited Document 1, not only light of each color but also light of a white color is emitted and therefore, it can be said that a person skilled in the art can add a white one as a light emitting body or a packaged light emitting diode, based on the above well-known matter.

Thus, it can be said that a person skilled in the art could have easily conceived of the configuration of the Invention related to the different feature 1 based on the matter described in Cited Document 1 and the well-known matter.

#### C Regarding the Different feature 2

In comparison between the Invention and the above matter described in Cited Document 1, the "color select switch 11" of the latter corresponds to the "switch part" of the former; and the feature of the latter that the CPU 42 controls the illumination of the light emitting diodes according to a value obtained by counting the number of times the color select switch 11 is pressed, to obtain a luminous color and illumination corresponding to the counter value corresponds to the feature of "the control part can switch the illuminance of each of the light emitting bodies according to the number of times the switch part is pressed" in the former.

Accordingly, it can be said that the configuration of the Invention relating to the Different feature 2 is described in Cited Document 1.

As mentioned in B above, it can be said that there is a sufficient motivation to apply the matter described in Cited Document 1 to the Cited Invention. Therefore, it can be said that a person skilled in the art can easily conceive of applying, when applying the matter relating to the light source part 30 described in Cited Document 1 and the above well-known matter of adding a white light emitting diode, also the matter relating to illumination control of the light emitting diodes by the color select switch 11 which is a matter relating to the control thereof and is described in Cited Document 1 to the light emitting part of the Cited Invention.

Then, it can be said that a person skilled in the art could have easily conceived of the configuration of the Invention related to Different feature 2 based on the matter described in Cited Document 1 and the well-known matter.

In addition, considering the working effect of the Invention, it can be predicted from the Cited Invention, the matter described in Cited Document 1, and the wellknown matter and is not remarkable. Thus, the Invention could have been easily made by a person skilled in the art based on the Cited Invention, the matter described in Cited Document 1, and the well-known matter.

4. Closing

As described above, the invention relating to Claim 1 of the present application (the Invention) could have been easily made by a person skilled in the art based on the Cited Invention, the matter described in Cited Document 1, and the well-known matter; thus, the appellant should not be granted a patent for the Invention in accordance with the provisions of Article 29(2) of the Patent Act.

Accordingly, the present application should be rejected without examining inventions relating to the other claims of the present application.

Therefore, the appeal decision shall be made as described in the conclusion.

October 23, 2017

Chief administrative judge: SHIMADA, Shinichi Administrative judge: HIRATA, Nobukatsu Administrative judge: WADA, Yuji