Decision on Opposition

Opposition No. 2016-700992

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Since, regarding the decision as of December 26, 2017 made on the opposition to the granted patent related to Japanese Patent No. 5905698, entitled "Polishing cushioning material", the Intellectual Property High Court has issued a decision revoking a part concerning the inventions according to Claims 3 and 4 (Heisei 30 (Gyo-Ke) No. 10023, March 14, 2019), after having carried out further examination regarding the inventions according to the claims of the part for which the decision has been revoked, a decision is made as follows.

Conclusion

The correction of the scope of claims of Japanese Patent No. 5905698 shall be approved as the corrected scope of claims attached to the written correction request regarding Claims [3, 4] after correction.

The patents concerning Claims 3 and 4 of Japanese Patent No. 5905698 are maintained.

Reason

No. 1 The main history of the opposition to a granted patent of the case, and the main history of the First Decision of the case and the court decision of cancellation of the case are as follows.

October 7, 2011	Filling of the application concerning Japanese Patent No. 5905698 (hereinafter, referred to as the "the Patent") (Japanese Patent Application No. 2011-223146)
March 25, 2016	Registration of establishment of the patent right of the Patent
April 20, 2016	Issue of the patent publication concerning the Patent
October 17, 2016	Submission of a written opposition (Opposition No. 2016-700992, Patent Opponent: Shunji Date)

As of January 18, 2017	Notice of reasons for revocation
March 10, 2017	Submission of a written opinion
As of June 23, 2017	Notice of reasons for revocation (advance notice of decision)
August 9, 2017	Interview of the panel with the Patentee
August 28, 2017	Submission of a written correction request and a written opinion
As of September 19, 2017	Notice of reasons for refusal of correction
October 20, 2017	Submission of a written opinion
As of December 26, 2017	Decision on opposition (hereinafter, referred to as "the First Decision")
February 10, 2018	Filing of a suit against the First Decision (Heisei 30 (Gyo-Ke) No. 10023)
March 14, 2019	Sentence of Court decision on the suit against the First Decision (Hereinafter, referred to as "the Court Decision of Cancellation")
As of June 7, 2019	Notice of reasons for revocation
As of August 7, 2019	Submission of a written opinion
September 24, 2019	Notice of reasons for revocation (advance notice of decision)
November 25, 2019	Submission of a written correction request and a written opinion

Incidentally, although a notice to the effect that an opportunity to submit a written opinion would be given to the Patent Opponent, Shunji Date, was issued as of December 17, 2019 based on the provisions of Article 120(5)(v) of the Patent Act, the Patent Opponent did not submit a written opinion.

Since the Intellectual Property High Court has issued the Court Decision of Cancellation against the First Decision that "within the decision that was made on December 26, 2017 by the Japan Patent Office on the case of the opposition No. 2016-700992, a part concerning Claims 3 and 4 of Japanese Patent No. 5905698 is revoked.", further examination will be performed under the provisions of Article 181(2) of the Patent Act.

No. 2 Binding effects of the Court Decision of Cancellation and the contents of the Court Decision of Cancellation

1. Binding effects of the Court Decision of Cancellation

In a suit against a decision regarding a case of an opposition to a granted patent, when a court decision of cancellation of a decision has become final and conclusive, although an administrative judge must perform further examination regarding the relevant opposition case and make a decision following the provisions of Article 181(2) of the Patent Act, the binding effects of the above-mentioned court decision of cancellation extends to a re-examination and re-decision under the provisions of the Administrative Case Litigation Act Article 33(1). Then, since such binding effects extend over recognition of fact and legal judgment necessary for deriving the main text of a court decision, recognition of fact and legal judgment of this panel are bound by the

recognition and the legal judgment of the Court Decision of Cancellation.

2. Contents of the Court Decision of Cancellation
(1) Regarding judgment of Article 29(2) of the Patent Act on the inventions according to Claims 3 and 4

In the First Decision, it was recognized that the structure of the invention concerning a high function thin polyurethane sheet, product name "Nippalay EXT", made by NHK SPRING Co., Ltd. (hereinafter, referred to as the "Publicly Known Invention") is "a laminated sheet constituted by integrally laminating a polyurethane resin foam sheet on a non-foaming polyethylene terephthalate (PET) sheet (thickness of 50 μm)", and that the values of physical properties of the Publicly Known Invention are "tensile strength: 1.5 MPa, elongation: 150%, Shore A hardness: 32", and, on the premise of the relevant recognition, it was judged that the inventions according to Claims 3 and 4 of the Patent are ones that could have been invented by a person skilled in the art with ease based on the Publicly Known Invention and the invention described in Cited Document 1 (Evidence A No. 7); however, in The Court Decision of Cancellation, recognition of fact and legal judgment were performed as indicated below.

A. "In the present case, there is no evidence that is sufficient for recognizing that the matter that Nippalay EXT has a structure of 'a laminated sheet constituted by integrally laminating a polyurethane resin foam sheet on a non-foaming polyethylene terephthalate (PET) sheet (thickness of 50 μm)' was in the state that it was able to be publicly known before the present application." (The written court decision, page 53, lines 6 to 2 from the bottom)

B. "It should be concluded that a person skilled in the art coming into contact with the catalog of Evidence A No. 5 recognizes that the reason that, while there are descriptions of all values of the physical properties of six items regarding Nippalay EXG, the columns of 'tensile strength', 'elongation', and 'Shore A hardness' among the six items of Nippalay EXT are blank is that these physical property values cannot be measured or these are different from the physical property values of Nippalay EXG. In addition, it is recognized that: a polyurethane resin foam sheet such as Nippalay EXG is spongy and has a flexible nature, whereas, a PET film has toughness since it is crystalline resin and is used as various kinds of base films; and it was a matter of common general technical knowledge at the time of the filing of the present application that a laminated body made by laminating materials of different physical properties is one whose physical properties as a whole can be changed by the properties and conditions of the constitutional members (Evidence A No. 26). In light of such common general technical knowledge, it cannot be said that a person skilled in the art coming into contact with the catalog of Evidence A No. 5 understands that 'tensile strength', 'elongation', and 'Shore A hardness' of Nippalay EXT have values that are the same as each numerical value of Nippalay EXG that is a polyurethane resin foam sheet.

According to the above, it cannot be said that the above-mentioned recognition methods of respective numerical values of 'tensile strength', 'elongation', and 'Shore A hardness' in the values of the physical properties of Nippalay EXT of the decision are appropriate, and thus it cannot be acknowledged that the matter that these respective numerical values are values that are the same as the values of Nippalay EXG described

in the catalog of Evidence A No. 5 is a matter that could have been publicly known at the time of the filing of the present application." (The written court decision, page 54, line 8 from the bottom to page 55, line 12)

C. "There is no evidence that is sufficient for recognizing that, when the samples attached to the catalog of Evidence A No. 5 are measured in accordance with JIS Standards and the like, 'tensile strength', 'elongation', and 'Shore A hardness' of Nippalay EXT and Nippalay EXG become the same values. Similarly, even if 'Product inspection performance table' (as for Nippalay EXG, Appendix ○4 of Evidence A No. 38) to be provided on the occasion of delivery of a product to a customer by NHK SPRING Co., Ltd. was able to be obtained from the maker, it cannot be recognized that the matter that 'tensile strength', 'elongation', and 'Shore A hardness' of the values of the physical properties of Nippalay EXT are values that are the same as the values of Nippalay EXG described in the catalog of Evidence A No. 5 was a matter that could have been publicly known at the time of the filing of the present application." (The written court decision, page 56, lines 10 to 18; note that "○4" is an alternative notation of a circled number 4)

D. "It should be concluded that, in Publicly Known Invention of the recognition of the decision, there is an error in at least the recognition of 'tensile strength', 'elongation', and 'Shore A hardness', and, therefore, the recognition of Publicly Known Invention in the decision is in error.
...

According to the above, without examining the remaining points, it is recognized that the decision failed in the recognition of Publicly Known Invention, and, as a result, failed in the recognition of the corresponding features between Invention 3 and the Publicly Known Invention, and overlooked the different features.

Therefore, the judgment on the inventive step in the decision that Invention 3 could have been invented by a person skilled in the art with ease based on the Publicly Known Invention and the invention described in Evidence A No. 7 (the decision and Cited Document 1) is in error. In a similar fashion, the judgment in the decision on the inventive step of Invention 4 which includes all the matters specifying Invention 3 is also in error." (The written court decision, page 57, lines 4 to 14)

(2) Regarding judgment concerning Article 29-2 of the Patent Act on the invention according to Claim 3

The First Decision recognized that, regarding the invention described in Japanese Patent Application No. 2012-67537 (the application related to Evidence A No. 3; hereinafter, referred to as "Prior Application"), "the support layer made of foamed urethane is Nippalay EXT", and that, in Nippalay EXT, "each value of the physical properties of thickness, density, tensile strength, elongation, Shore A hardness, and 25% compression stress is within the numerical value range of each value of the physical properties of a laminated sheet of the invention according to Claim 3", and it was judged that the invention according to Claim 3 of the Patent was identical with the invention described in the Prior Application; however, in the Court Decision of Cancellation, the recognition and legal judgment as indicated below have been made.

A. "Although it is described in the description of Prior Application, as Example 1, that 'Nippalay EXT' is used as 'the support layer made of foamed urethane' ([0093]), there is no description about 'tensile strength', 'elongation', and 'Shore A hardness' of this support layer or Nippalay EXT.

In addition, it cannot be recognized that a matter that, among the physical property values of Nippalay EXT, 'tensile strength', 'elongation', and 'Shore A hardness' are the same as the values of Nippalay EXG described in the catalog of Evidence A No. 5 was in the state that it could have been publicly known before the filing of the present application." (The written court decision, page 59, lines 12 to 19)

B. "The judgment of the decision that says that Invention 3 is an invention identical with the invention of Prior Application is in error" (The written court decision, page 59, lines 5 to 4 from the bottom)

No. 3 Suitability of the correction according to the correction request

(1) Claims 3 and 4 of the scope of claims before the correction request

The conclusion of the First Decision is that "in the request for correction as of August 28, 2017, the correction of the scope of claims of Japanese Patent No. 5905698 is approved as the corrected scope of claims attached to the written correction request regarding Claims [1-2] after correction. The patents for Claims 3 and 4 of Japanese Patent No. 5905698 are to be revoked. The opposition to the granted patent regarding the patents according to Claims 1 and 2 of Japanese Patent No. 5905698 shall be dismissed.", and, while the part concerning Claims 3 and 4 are cancelled by the Court Decision of Cancellation as described above, the remainder of the First Decision has become final and conclusive.

Furthermore, since, regarding the Patent, the request for correction (hereinafter, referred to as "he Correction Request") was filed on November 25, 2019, it is deemed that the request for correction about Claims 3 and 4 of the request for correction filed on August 28, 2017 was withdrawn (Article 120-5(7) of the Patent Act).

Accordingly, Claims 3 and 4 of the scope of claims of the Patent before the Correction Request are as follows.

"[Claim 3]

A cushioning material for polishing comprising: a laminated sheet constituted by integrally laminating a foam sheet and a synthesis resin non-foam sheet; and an adhesive layer integrally laminated on one surface of the foam sheet, wherein

the laminated sheet (excluding a laminated sheet having a penetration hole in an area including a center part) has a thickness of 0.3 to 3.0 mm, a density of 450 to 600 kg/m^3, tensile strength of 1.0 to 2.0 MPa, elongation of 140 to 160%, Shore A hardness of 25 to 40, and 25% compression stress of 0.30 to 0.50 MPa.

[Claim 4]

The cushioning material for polishing according to Claim 3, wherein

an adhesive layer is further laminated and integrated on the other surface of the foam sheet."

(2) Contents of the correction

The contents of correction according to the Correction Request are to correct

the recitation of Claim 3 before the Correction Request that
"the laminated sheet (excluding a laminated sheet having a penetration hole in an area including a center part) has a thickness of 0.3 to 3.0 mm, a density of 450 to 600 kg/m^3, tensile strength of 1.0 to 2.0 MPa, elongation of 140 to 160%, Shore A hardness of 25 to 40, and 25% compression stress of 0.30 to 0.50 MPa"
to
"the laminated sheet (excluding a laminated sheet having a penetration hole in an area including a center part) has a thickness of 0.3 to 3.0 mm measured using a displacement gage at a measuring load 80 g, a density of 450 to 600 kg/m^3 calculated by dividing a weight by a volume, tensile strength of 1.0 to 2.0 MPa measured in conformity with JIS K6400, elongation of 140 to 160% measured in conformity with JIS K6400, Shore A hardness of 25 to 40 measured using a Durometer prescribed in JIS K6253 in a face on which the foam sheet is arranged, and 25% compression stress of 0.30 to 0.50 MPa that is a stress at the time of compressing the laminated sheet in a thickness direction from the face on which the foam sheet is arranged until a thickness of the laminated sheet becomes 25% of a thickness before compression at a compression speed of 1 mm/min."
, and to correct Claim 4 that refers to Claim 3 in a similar fashion. In addition, the Correction Request is a request that was requested for a group of Claims [3, 4].

(3) Suitability of the purpose of the correction

Regarding "thickness", "density", "tensile strength", "elongation", "Shore A hardness", and "25% compression stress" of Claim 3 before the Correction Request, although how these values are measured is not necessarily clear only from the recitation of Claim 3, it is made clear by the correction of the above-mentioned (2) that "thickness" is "measured using a displacement gage at a measuring load 80 g", that "density" is "calculated by dividing a weight by a volume", that each of "tensile strength" and "elongation" is "measured in conformity with JIS K6400", that "Shore A hardness" is "measured using a Durometer prescribed in JIS K6253 in a face on which the foam sheet is arranged", and that "25% compression stress" is "a stress at the time of compressing the laminated sheet in a thickness direction from the face on which the foam sheet is arranged until a thickness of the laminated sheet becomes 25% of a thickness before compression at a compression speed of 1 mm/min.". Therefore, the correction of the above-mentioned (2) is a correction for the purpose of clarification of ambiguous statement.

(4) Existence of new matters and existence of extension and change of the scope of claims

Among the corrections of the above-mentioned (2), it is described in paragraph [0108] of the description of the Patent that "thickness" is a value that is "measured using a displacement gage at a measuring load 80 g", it is described in paragraph [0109] that "density" is "calculated by dividing a weight by a volume", it is described in paragraphs [0110] and [0111] that "tensile strength" and "elongation" are ones that are "measured in conformity with JIS K6400", it is described in paragraph [0112] that "Shore A hardness" is one that is "measured using a Durometer prescribed in JIS K6253 in a face on which the foam sheet is arranged", and it is described in paragraph [0113] that "25% compression stress" is "a stress at the time of compressing the laminated sheet in a thickness direction from the face on which the foam sheet is arranged until a thickness of the laminated sheet becomes 25% of a thickness before compression at a compression

speed of 1 mm/min.". Therefore, the contents of correction of the above-mentioned (2) are the matters described in the description of the Patent.

In addition, it is obvious that the correction of the above-mentioned (2) is not a correction that substantially enlarges or alters the scope of claims.

(5) Summary

As described above, the correction according to the Correction Request is aimed at matters prescribed in Article 120-5(2) proviso No. 3 of the Patent Act, and, in addition, complies with the provision of Article 126(5) and (6) of the same Act as applied mutatis mutandis pursuant to the provisions of Article 120-5(9) of the same Act.

Therefore, the correction of the scope of claims shall be approved with respect to Claims [3, 4] after correction as the corrected scope of claims attached to the written correction request.

No. 4 The Invention after correction

The inventions according to Claims 3 and 4 corrected by the Correction Request (hereinafter, referred to as "Inventions 3 and 4") are as specified by the following matters recited in Claims 3 and 4 of the corrected scope of claims.

"[Claim 3]

A cushioning material for polishing comprising: a laminated sheet constituted by integrally laminating a foam sheet and a synthesis resin non-foam sheet; and an adhesive layer integrally laminated on one surface of the foam sheet, wherein

the laminated sheet (excluding a laminated sheet having a penetration hole in an area including a center part) has a thickness of 0.3 to 3.0 mm measured using a displacement gage at a measuring load 80 g, a density of 450 to 600 kg/m^3 calculated by dividing a weight by a volume, tensile strength of 1.0 to 2.0 MPa measured in conformity with JIS K6400, elongation of 140 to 160% measured in conformity with JIS K6400, Shore A hardness of 25 to 40 measured using a Durometer prescribed in JIS K6253 in a face on which the foam sheet is arranged, and 25% compression stress of 0.30 to 0.50 MPa that is a stress at the time of compressing the laminated sheet in a thickness direction from the face on which the foam sheet is arranged until a thickness of the laminated sheet becomes 25% of a thickness before compression at a compression speed of 1 mm/min..

[Claim 4]

The cushioning material for polishing according to Claim 3, wherein

an adhesive layer is further laminated and integrated on the other surface of the foam sheet."

No. 5 Outline of the reasons for revocation (advance notice of decision)

Outline of the notification notified to the Patentee in the reasons for revocation (advance notice of decision) by the body as of September 24, 2019 (hereinafter, referred to as "Advance Notice of Decision"), in which it has been judged that there are reasons for revocation with respect to the patents according to Inventions 3 and 4, is as follows.

1. Reason for revocation 1 (Advance Notice of Decision, No. 6, 3. Reason for revocation 1 (1))

Since the detailed description of the invention of the Patent has an error in the

description of Table 1, and it cannot be said that there is a description to a degree that a person skilled in the art can carry out Inventions 3 and 4, the patents according to Inventions 3 and 4 are ones that were given to a patent application that does not meet the requirement stipulated in Article 36(4)(i) of the Patent Act (hereinafter, may be referred to as "Enablement Requirement").

2. Reason for revocation 2 (Advance Notice of Decision, No. 9 New reasons for revocation)

It cannot be said that, in the detailed description of the invention of the Patent, an invention that satisfies the numerical value ranges of tensile strength, elongation, and Shore A hardness specified in Inventions 3 and 4 is described substantially, and, therefore, the patents for Inventions 3 and 4 are ones that were granted to a patent application that does not satisfy the requirement stipulated in Article 36(6)(i) of the Patent Act (hereinafter, it may be referred to as "Support Requirement").

Incidentally, it is as judged in Advance Notice of Decision that the reason for revocation 1(2) and the reason for revocation 2 in the notice of reasons for revocation as of June 7, 2019 have no reason.

No. 6 Descriptions of the description of the Patent and Evidence A No. 5

1. Descriptions of the description of the Patent

"[Technical field]

[0001]

The present invention relates to a polishing cushion material used to fix an object to be polished and an abrasive to a polishing machine when the object to be polished is polished to improve flatness.

[Background Art]

[0002]

Chemical mechanical polishing (hereinafter, also referred to as "CMP") is performed on the surface of a substrate such as a silicon wafer used for a semiconductor device or a glass substrate used for a liquid crystal display or the like in order to enhance its flatness. In CMP, an abrasive called an abrasive cloth or a polishing pad is attached to a surface plate of a polishing machine with a double-sided adhesive tape or the like, an object to be polished such as a silicon wafer or a glass substrate is fixed to a rotating plate, and the object to be polished is polished by relatively sliding the object and the abrasive in a pressurized state.

[0003]

Further, in the conventional CMP, a polishing cushioning material is interposed between the rotating plate and the object to be polished or between the surface plate and the polishing material to make uniform the pressing force applied to the surface of the object to be polished, thereby improving the flatness of the object to be polished. For example, in Patent Document 1, a polishing cushion material made of a foamed polyurethane resin is attached with an adhesive to the surface of the rotary plate facing the surface plate, and the polishing cushion material is impregnated with water to cause the object to be polished be held in an adsorptive manner.

...

[Summary of Invention]

[Problem to be solved by the invention]
[0005]

As the wiring of semiconductor devices is becoming finer and finer, it is desirable to further improve the surface flatness of the semiconductor devices. In addition, in order to reduce the polishing load on an object to be polished such as a semiconductor device, it is necessary to perform polishing processing more uniformly with a low pressing force. Therefore, in order to make the pressure to be applied to the surface to be polished of the object to be polished more uniform, improvement of cushioning properties is required to a cushioning material for polishing. However, in the conventional cushioning material for polishing, if it is intended to simply improve the cushioning properties, the rigidity is reduced and the material becomes too soft, and there is a problem that the object to be polished and the abrasive cannot be held flat.
[0006]

Therefore, an object of the present invention is to provide a polishing cushioning material capable of exhibiting excellent cushioning properties even during polishing processing with low pressing force and capable of holding an object to be polished and an abrasive material flat."
"[0102]
(Example 1)
...
[0104]

Then, an acrylic adhesive layer prepared as described above was laminated on one side of a polyurethane resin foam sheet (made by NHK SPRING Co., Ltd., trade name: Nippalay EXG), and, by laminating a rubber-based adhesive layer prepared as described above on the other side of this polyurethane resin foam sheet, and rolling a rubber roll set to be heated at 40 degrees C. on each surface of the resulting laminate, the polyurethane-based resin foam sheet, the acrylic adhesive layer and the rubber-based adhesive layer were integrally laminated. Thereby, the acrylic adhesive layer 12a was integrally laminated on one surface of the polyurethane resin foam sheet 11, and the rubber adhesive layer 12b were integrally laminated on the other surface of the polyurethane resin foam sheet 11, and the cushioning material for polishing shown in FIG. 2 was obtained.
[0105]
(Example 2)

An acrylic adhesive layer (thickness 50 μm) was prepared on a release film in the same manner as in Example 1. Further, a rubber-based adhesive layer (thickness 80 μm) was prepared in the same manner as in Example 1 on another release film.
[0106]

Next, an acrylic adhesive layer prepared as described above was laminated on a non-foaming polyethylene terephthalate (PET) sheet (thickness of 50 μm) of a laminated sheet (made by NHK SPRING Co., Ltd., product name: Nippalay EXT) constituted by integrally laminating a polyurethane resin foam sheet on the PET sheet, and, on the polyurethane resin foam sheet of the laminated sheet, a rubber-based adhesive layer prepared as described above was laminated. By rolling a rubber roll set to be heated at 40 degrees C. on each of the both sides the resultant laminated body, the laminated sheet, the acrylic adhesive layer, and the rubber-based adhesive layer were integrally laminated. As a result, the acrylic adhesive layer 22a was integrally laminated

on the PET sheet 21b of the laminated sheet 21, and the rubber-based adhesive layer 22b was integrally laminated on the polyurethane resin foam sheet 22a of the laminated sheet 21 to obtain the cushioning material for polishing shown in FIG. 4.

...

[0109]

(Density)

The weight of a test piece obtained by cutting a polyurethane resin foam sheet or a laminate sheet into vertical and horizontal dimensions of 10 cm × 10 cm was measured, and the density [kg/m^3] was calculated by calculating the value (W/V) made by dividing the measured weight (W [kg]) by a calculated volume (V [m^3]) that was determined from the vertical and horizontal dimensions and thickness of the test piece.

[0110]

(Tensile strength)

The tensile strength [MPa] was measured in accordance with the method defined in JIS K6400.

[0111]

(Elongation)

Measurement of elongation [%] was performed in accordance with the method defined in JIS K6400.

[0112]

(Shore A Hardness)

Shore A hardness was measured using a Durometer defined in JIS K6253. In addition, about the laminated sheet, Shore A hardness was measured about the surface where the polyurethane resin foam seat of the lamination sheet was arranged.

[0113]

(25% compression stress)

Measurement of 25% compression stress was performed in a way that a test piece is prepared by cutting a polyurethane resin foam sheet and a laminate sheet into a plane square shape of 30 mm × 30 mm, and a stress when the test piece was compressed in its thickness direction to a thickness of 25% of the thickness of the test piece before compression at a compression rate of 1 mm/min was measured. In addition, with regard a test piece which uses a lamination sheet, the measurement of 25% compression stress was performed with respect to the surface where the polyurethane resin foam sheet of the test piece was arranged."

"Table 1

"

2. Descriptions of Evidence A No. 5

Evidence A No. 5 (hereinafter, referred to as "A-5") is a catalog, entitled "High-density thin sheet-shaped urethane Nippalay NIPPALAY", issued by NHK SPRING Co., Ltd. on May, 2008, and, in the column "2-1. Physical property values", there is a description regarding "EXG" that "thickness" is "1.25" mm, "density" is "550" kg/m^3, "tensile strength" is "1.5" MPa, "elongation" is "150"%, "A-hardness Shore-A" is "32", and "25% compression stress" is "0.4" MPa.

In addition, regarding "EXT", although there are descriptions that "thickness" is "0.8/1.0" mm, "density" is "550" kg/m^3, "25% compression stress" is "0.4" MPa, the items of "tensile strength", the columns of "elongation" and "A-hardness Shore-A" are

blank.

No. 7 Judgment on the reason for revocation 1
1. The ground that it was judged that the description of Table 1 is in error

In Advance Notice of Decision, the body judged, on the ground of the following two matters mainly, that the respective descriptions of the numerical values of tensile strength, elongation, and Shore A hardness of Example 2 in Table 1 in the detailed description of the invention of the Patent is an error, and thus it was judged that, even if a person skilled in the art acquires a laminated sheet called Nippalay EXT in order to implement Inventions 3 and 4, it is not possible to satisfy the numerical value ranges of Inventions 3 and 4, and Inventions 3 and 4 cannot be implemented.

(1) Ground for error 1

In Example 1 of Table 1, Nippalay EXG that is a polyurethane resin foam sheet is used ([0104]), and, in Example 2, Nippalay EXT in which a non-foaming PET sheet is integrally laminated on a polyurethane resin foam sheet is used ([0106]).

Then, the tensile strengths and elongations of Example 1 and those of Example 2 are identical with each other, Shore A hardness is approximately identical, and the densities and 25% compression stresses are identical ([Table 1]).

It is possible to acknowledge that it was a matter of common general technical knowledge at the time of the present application that a polyurethane resin foam sheet such as Nippalay EXG has a spongy and a flexible nature, whereas a PET film has toughness since it is crystalline resin and is used as various kinds of base films, and that, in a laminated body made by laminating materials of different physical properties, physical properties as a whole can be changed by the properties and states of component members thereof (the above-mentioned No. 2, 2.(1)B.). Therefore, it cannot be said that a person skilled in the art having such common general technical knowledge understands that the values of the physical properties of Nippalay EXG and the values of the physical properties of Nippalay EXT are the same values, but, instead, the person rather understands that any of the numerical values is in error; here, the physical property values of Nippalay EXG were publicly known before the application of the present application (see the above-mentioned No. 7, 2.) and are identical with each numerical value of Example 1 of Table 1, and, therefore, there is a high possibility that the numerical values of Example 2 are incorrect.

(2) Ground for error 2

The Patentee has admitted, on pages 12 to 14 of the plaintiff written brief No. 2 (June 28, 2018) of the suit concerning the Court Decision of Cancellation, that, when the Patentee measured the physical properties of Nippalay EXT (Evidence A No. 38 of the suit), all of the numerical values of density, tensile strength, elongation, and Shore A hardness deviated from the numerical value ranges specified in Invention 3. The numerical values in question of the density, tensile strength, elongation, and Shore A hardness of the measured Nippalay EXT are different from the physical property values of Example 2 of Table 1.

2. Examination of the ground that it was judged that the description of Table 1 is in error
(1) Regarding ground for error 1

A. Although both of Example 1 and Example 2 of Table 1 include a polyurethane resin foam sheet (hereinafter, referred to as "Foam Sheet"), regarding thickness, it is 1.25 mm in Example 1, whereas, in Example 2, it is 0.8 mm, and, since Example 2 further includes a non-foaming PET sheet (hereinafter, simply referred to as "PET Sheet"), it is obvious that the thickness of Foam Sheet itself in Example 2 is smaller than that of Example 1.

On the premise that the Foam Sheet in Example 1 is thick, whereas, in Example 2, the Foam Sheet is thin and a PET Sheet is laminated on it, each numerical value will be examined.

B. Regarding tensile strength, since the Foam Sheet of Example 2 is thinner than that of Example 1, it can be said that the strength of the Foam Sheet itself is low; however, there is a possibility that the strength is large because a non-foaming PET Sheet is laminated, and thus it cannot be said that a total tensile strength of Foam Sheet and PET Sheet that are laminated is never identical with the strength of Example 1. Therefore, it cannot be determined that the description of Table 1 is in error, on the ground that tensile strengths of Example 1 and Example 2 are identical.

C. Regarding elongation, although it can be said that elongation of the Foam Sheet itself of Example 2 is larger than that of Example 1 because the Foam Sheet of Example 2 is thinner than that of Example 1, there is a possibility that, as a result of a non-foaming PET Sheet being laminated on it, elongation becomes small, and, therefore, it cannot be said that the elongation as a whole of Foam Sheet and PET Sheet that are laminated is never identical with the elongation of Example 1. Therefore, it cannot be determined that the description of Table 1 is in error, on the ground that the elongations of Example 1 and Example 2 are identical.

D. Since Shore A hardness is measured in Example 2 with regard to a surface on which the Foam Sheet is arranged ([0112]), it is likely that Shore A hardness of Example 2 is approximately identical with that of Example 1 made of the Foam Sheet. Therefore, it cannot be determined that the description of Table 1 is in error, on the ground that Shore A hardness of Example 1 and that of Example 2 are approximately identical.

E. Since 25% compression stress is measured with regard to a surface on which Foam Sheet is arranged in Example 2, ([0113]), it can be said that there may be cases where the 25% compression stresses of Example 2 is identical with that of Example 1 made of the Foam Sheet. Therefore, it cannot be determined that the description of Table 1 is in error, on the ground that 25% compression stresses of Example 1 and Example 2 are identical.

F. Regarding density, if the volume and weight of the PET Sheet of Example 2 are small compared to those of the Foam Sheet, it cannot be said that the densities of Example 1 and Example 2 are never identical. Therefore, it cannot be determined that the description of Table 1 is in error, on the ground that the densities of Example 1 and Example 2 are identical.

G. As above, by the ground for error 1, it cannot be said that the description of

Table 1 is in error.

(2) Regarding the ground for error 2

Although the Patentee has described, in the Plaintiff written brief No. 2 of the suit concerning the Court Decision of Cancellation, that the measured values of the physical properties of Nippalay EXT deviate from the numerical value ranges specified in Invention 3, the gist of that description is to say that the physical properties of Nippalay EXT have large variation, and the physical property values of all Nippalay EXT products are not always within the numerical value range specified in Invention 3.

That is, in products of Nippalay EXT, while there are ones whose physical property values deviate from the numerical value range specified in Invention 3 as the above-mentioned measured values, the possibility that there exist products that are within the numerical value ranges cannot be denied, and, therefore, it cannot be determined that the description of Table 1 is in error on the ground that the above-mentioned measured values are outside the numerical value ranges specified in Invention 3.

(3) Summary

As instructed in the above-mentioned (1) and (2), by the ground for error 1 and ground for error 2, it cannot be said that the description of Table 1 in the detailed description of the invention of the Patent is an error.

Then, in products of Nippalay EXT, since the possibility that there exist ones whose physical property values are within the numerical value ranges specified in Invention 3 cannot be denied, it should be concluded that a person skilled in the art can implement Inventions 3 and 4 by adopting ones that are within the numerical value ranges specified in the Invention 3 as a polishing cushioning material.

Therefore, by the reason for revocation 1 in Advance Notice of Decision, the patents for Inventions 3 and 4 cannot be revoked.

No. 8 Judgment on the reason for revocation 2

The reason for revocation 2 is that, on the premise that it cannot be said that the invention that satisfies the numerical value ranges of tensile strength, elongation, and Shore A hardness specified in Inventions 3 and 4 is not substantially described in the detailed description of the invention of the Patent, Inventions 3 and 4 do not meet the Support Requirement; however, as examined in the above-mentioned No. 7, it is hard to say that there is an error in the description of Table 1 of the detailed description of the invention of the Patent, and it cannot be denied that an invention that satisfies the numerical value ranges of tensile strength, elongation, and Shore A hardness specified in Inventions 3 and 4 is described in the detailed description of the invention; therefore, by the reason for revocation 2 in the Advance Notice of Decision, the patents for Inventions 3 and 4 cannot be revoked.

No. 9 Regarding a ground for opposition to the grant of a patent that was not adopted in the notice of reasons for revocation

1. Ground for opposition to the grant of a patent according to Article 29(2) of Patent Act

The ground for opposition to the grant of a patent according to Article 29(2) of the Patent Act is that, regarding the Publicly Known Invention (the above-mentioned No. 2, 2.(1)), on the premise of the following two points, Inventions 3 and 4 are ones that

would have been invented with ease by a person skilled in the art based on the Publicly Known Invention and well-known art (the written opposition, page 25, line 7 from the bottom to page 27 line 1).

(Premise 1) The structure of the Publicly Known Invention is "a laminated sheet constituted by integrally laminating a Foam Sheet and a synthesis resin non-Foam Sheet".
(Premise 2) The Publicly Known Invention satisfies the numerical value ranges of thickness, density, tensile strength, elongation, Shore A hardness, and compression stress according to Inventions 3 and 4.

However, in the Court Decision of Cancellation, a recognition that denies the above Premise 1 (the above-mentioned No. 2, 2.(1)A.) and a recognition that denies the above-mentioned Premise 2 (the above-mentioned No. 2, 2.(1)B. to D.) have been made, and the relevant recognitions bind the body; therefore, these result in the consequence that the grounds for opposition according to Patent Act Article 29(2) lack premise, and thus, by the relevant grounds for opposition, the patents for Inventions 3 and 4 cannot be revoked.

2. Grounds for opposition to the grant of a patent according to Article 29-2 of the Patent Act

The grounds for opposition according to Article 29-2 of the Patent Act are that, regarding "Nippalay EXT made by NHK SPRING Co., Ltd." described in the Prior Application (the above-mentioned No. 2, 2.(2)), on the premise of the following two points, Invention 3 is identical with the invention described in the description, the scope of claims, or the drawings originally attached to the application of Prior Application (the written opposition, page 18, line 6 to page 19, line 3).

(Premise 3) The structure of "Nippalay EXT made by NHK SPRING Co., Ltd." described in the Prior Application is "a laminated sheet constituted by integrally laminating a Foam Sheet and a synthesis resin non-Foam Sheet".
(Premise 4) "Nippalay EXT made by NHK SPRING Co., Ltd." described in the Prior Application satisfies the numerical value ranges of thickness, density, tensile strength, elongation, Shore A hardness, and compression stress according to Invention 3.

However, in the Court Decision of Cancellation, a recognition that denies the above Premise 4 (the above-mentioned No. 2, 2.(2)A.) was made, and the relevant recognition binds the body; therefore, the grounds for opposition according to Article 29-2 of the Patent Act lacks premise, and thus it results in the consequence that, by the relevant grounds for opposition, the patent for Invention 3 cannot be revoked.

No. 10 Closing

As described above, by the reasons for revocation in Advance Notice of Decision and the grounds for opposition described in the written opposition, the patent for Inventions 3 and 4 cannot be revoked.

Furthermore, no other reason for revoking the patents according to Inventions 3 and 4 is found.

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

March 18, 2020

Chief administrative judge: KEMMOKU, Shoji
Administrative judge: KARIMA, Hironobu
Administrative judge: OGAWA, Satoshi