

Appeal decision

Appeal No. 2018-15727

Appellant SANYO BUSSAN CO., LTD.

Patent Attorney NAKAMURA, Toshiyuki

The case of appeal against the examiner's decision of refusal of Japanese Patent Application No. 2017-75294, entitled "Game Machine", [the application published on July 6, 2017, Japanese Unexamined Patent Application Publication No. 2017-119180, the number of claims (2)] has resulted in the following appeal decision:

Conclusion

The examiner's decision is revoked.

The invention of the present application shall be granted a patent.

Reason

No. 1 History of the procedures

The present application is a divisional application (Japanese Patent Application No. 2017-75294) filed on April 5, 2017 from Japanese Patent Application No. 2012-159040 filed on July 17, 2012 (hereinafter, referred to as "Original application"), a written amendment was submitted on May 6, 2017, reasons for refusal were notified as of January 30, 2018, and a written opinion was submitted on April 7 of the same year. Then, a decision of refusal was issued as of August 22 of the same year (date of delivery: August 28 of the same year), and, against this, a request for appeal against the examiner's decision of refusal was made on November 28, and, at the same time, an amendment (hereinafter, referred to as "the Amendment") was submitted.

No. 2 Propriety of the Amendment

1 Details of amendment

(1) Regarding Claim 1

The Amendment includes an amendment to make Claim 1 of the Scope of

Claims be

"A game machine comprising:

an operation member having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;

a substrate provided on the operation member in such a way that its front side faces a player side and its back side faces an opposite side relative to the player; and

a first light emitting means which is provided on the back side of the substrate, which is capable of irradiating light in the second state to a side located on an end side of the storage area and positioned in the first state, and which irradiates light to the side positioned in the first state during a displacement operation from the first state to the second state."

(Hereinafter, referred to as "Amended matter 1". The underlines were added by the body; the same applies hereinafter.)

(2) Regarding Claim 2

The Amendment includes an amendment to make Claim 2 of the Scope of Claims be

"A game machine comprising:

a plurality of operation members having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;

a substrate provided on an operation member on a front side among the plurality of operation members that are arranged overlapping each other back and forth, wherein, in the first state, at least one or more operation members are provided on a back side of the operation member on the front side, wherein, as the second state, a part of a base end of the operation member on the front side in a side of movement direction toward the second state is capable of being arranged at a position where the part of the base end does not overlap with the operation members on the back side, and wherein a front side of the substrate faces the player and a back side of the substrate is faces an opposite side relative to the player; and

a second light emitting means provided at a position that is in the back side of

the substrate and is on the part of the base end of the operation member on the front side in the side of movement direction, which is capable of irradiating light toward the back side that is approximately vertical to the substrate, and which irradiates light toward the back side that is approximately vertical to the substrate during displacement operation from the first state to the second state."

(hereinafter, referred to as "Amended matter 2").

2 Examination regarding propriety of the Amendment

(1) Regarding Amended matter 1

Amended matter 1 of the Amendment is one including an amendment to amend the statement of "from the first state to a second state" in Claim 1 before the Amendment to "from the first state to the second state", and this amendment falls under the category of ones aimed at the matters prescribed in Article 17-2(5)(iii) of the Patent Act, because, as viewed from the other statements of Claim 1, it is obvious that "second state" in the statement of "from the first state to a second state" is one that corresponds to "second state" described in advance of that portion, and, therefore, Amended matter 1 is one that corrects "a second state" as an error to "the second state".

(2) Regarding Amended matter 2

Amended matter 2 of the Amendment is one that includes amending the statement of "in a first state" in Claim 2 before the Amendment to "in the first state", and, in a similar fashion, amending the statement of "the front side operation member" to "the operation member on the front side", amending the statement of "from the first state to a second state" to "from the first state to the second state", and, as viewed from the other statements of Claim 2, it is obvious that "a first state" in the statement of "in a first state" corresponds to "a first state" described before that portion, and that "a second state" in the statement of "from the first state to a second state" corresponds to "a second state" described before that portion. In addition, in Claim 2 before the Amendment, the statement of "a front side operation member" does not exist and instead there is a statement of "an operation member on a front side", and, therefore, it is obvious that "front side operation member" in the statement of "the front side operation member" corresponds to "an operation member on a front side".

Therefore, Amended matter 2 of the Amendment is for correcting "first state" that is an error of "the first state", "the front side operation member" that is an error of "the operation member in the front side", "a second state" that is an error of "the second

state", and, therefore, Amended matter 2 falls under the category of ones aimed at the matters prescribed in Article 17-2(5)(iii) of the Patent Act.

(3) Regarding the provisions of Article 17-2(3) of the Patent Act

Since it is obvious that the Amendment is one that was made within the matters described in the Description, the Scope of Claims, or the Drawings originally attached to the present application, it complies with the provision of Article 17-2(3) of the Patent Act.

(4) Conclusion regarding the Amendment

From the above, the Amendment was made legally.

No. 3 The Invention

As above, the Amendment was made legally, and, therefore, the inventions according to Claims 1 and 2 of the present application (hereinafter, referred to as "Invention 1" and "Invention 2") are recognized as ones that are specified by the matters described in Claims 1 and 2 of the Scope of Claims amended by the Amendment, and thus the inventions are specified by the following matters when separately described in a manner assigning reference characters A to H.

<Invention 1>

"D A game machine comprising:

A an operation member having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;

B a substrate provided on the operation member in such a way that its front side faces a player side and its back side faces an opposite side relative to the player; and

C a first light emitting means which is provided on the back side of the substrate, which is capable of irradiating light in the second state to a side located on an end side of the storage area and positioned in the first state, and which irradiates light to the side of the substrate positioned in the first state during a displacement operation from the first state to the second state."

<Invention 2>

"H A game machine comprising:

E a plurality of operation members having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;

F a substrate provided on an operation member on a front side among the plurality of operation members that are arranged overlapping each other back and forth, wherein, in the first state, at least one or more operation members are provided on a back side of the operation member on the front side, wherein, as the second state, a part of a base end of the operation member on the front side in a side of movement direction toward the second state is capable of being arranged at a position where the part of the base end does not overlap with the operation members on the back side, and wherein a front side of the substrate faces the player and a back side of the substrate faces an opposite side relative to the player; and

G a second light emitting means provided at a position that is in the rear surface side of the substrate and is on the part of the base end of the operation member on the front side in the side of movement direction, which is capable of irradiating light toward the back side that is approximately vertical to the substrate, and which irradiates light toward the back side that is approximately vertical to the substrate during displacement operation from the first state to the second state."

No. 4 Outline of the examiner's decision

The outline of the examiner's decision is as follows.

It is recognized that the inventions according to Claims 1 and 2 of the present application are identical to the inventions according to Claims 1 and 2 of the following application filed on the same day as Original application, and the inventions according to the following application have been patented and consultation cannot be held about that. Therefore, Appellant should not be granted a patent for these claims in accordance with the provisions of Article 39(2) of the Patent Act.

Note

The application filed on the same date: Japanese Patent Application No. 2012-159038 (Japanese Patent No. 5924171)

Meanwhile, in the examiner's decision, Japanese Unexamined Patent Application Publication No. 2012-115509 was also cited as a document that indicates a matter that was well-known before the Original application.

No. 5 The inventions according to the application filed on the same date

The inventions according to Claims 1 and 2 of the application that was filed on the same date and cited in the reasons for refusal stated in the examiner's decision (hereinafter, referred to as "Same-date-application invention 1" and "Same-date-application invention 2") are as follows. In this connection, the reference characters a to h are ones that correspond to the reference characters A to H that have been assigned to Invention 1 and Invention 2.

<Same-date-application invention 1>

"d A game machine comprising:

- a an operation member having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;
- b a substrate provided on the operation member in such a way that its front side faces a player side and its back side faces an opposite side relative to the player; and
- c a first light emitting means having a light emitting means which is provided on the back side of the substrate, and which is capable of irradiating light in the second state to a side located on an end side of the storage area and positioned in the first state."

<Same-date-application invention 2>

"h A game machine comprising:

- e a plurality of operation members having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is arranged in a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;
- f a substrate provided on an operation member on a front side among the plurality of operation members that are arranged overlapping each other back and forth, wherein, in

the first state, at least one or more operation members are provided on a back side of the operation member in the front side, wherein, as the second state, a part of a base end of the operation member on the front side in a side of movement direction toward the second state is capable of being arranged at a position where the part of the base end does not overlap with the operation members on the back side, and wherein a front side of the substrate faces the player and a back side of the substrate faces an opposite side relative to the player; and

g a second light emitting means provided at a position that is in the back side of the substrate and is on the part of the base end of the front-side operation member in the side of movement direction, which irradiates light toward the back side that is approximately vertical to the substrate."

No. 6 Comparison, Examination

1 Regarding Invention 1

(1) Comparison between Invention 1 and Same-date-application invention 1

Invention 1 and Same-date-application invention 1 will be compared.

A Regarding constitutions A, B, and D of Invention 1

The constitutions A, B, and D of Invention 1 and the constitutions a, b, and d of Same-date-application invention 1 are identical in terms of wording.

B Regarding constitution C of Invention 1

When "a first light emitting means which is provided on the back side of the substrate, which is capable of irradiating light in the second state to a side located on an end side of the storage area and positioned in the first state, and which irradiates light to the side of the substrate positioned in the first state during a displacement operation from the first state to the second state" in constitution C of Invention 1 and "a first light emitting means having a light emitting means which is provided on the back side of the substrate, and which is capable of irradiating light in the second state to a side located on an end side of the storage area and positioned in the first state" in constitution c of Same-date-application invention 1 are compared, it is obvious that, also in Invention 1, the first light emitting means is provided with a light emitting means, and, therefore, the two are identical in a point of having a first light emitting means which is provided on the back side of the substrate, and which is capable of irradiating light in the second state to a side

located on an end side of the storage area and positioned in the first state.

C Corresponding feature and different features

From the above-mentioned A and B, Invention 1 and Same-date-application invention 1 are identical in the following point.

<Corresponding Feature>

D A game machine comprising:

A an operation member having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;

B a substrate provided on the operation member in such a way that its front side faces a player side and its back side faces an opposite side relative to the player; and

C' a first light emitting means which is provided on the back side of the substrate, and which is capable of irradiating light in the second state to a side located on an end side of the storage area and positioned in the first state.

Then, the two have the following different feature.

<Different Feature 1> (Regarding constitution C of Invention 1)

A point that, regarding a first light emitting means which is capable of irradiating light to a side located on an end side of the storage area and positioned in the first state, in Invention 1, it is one which emits light to a side of the substrate positioned in the first state during a displacement operation from the first state to the second state, whereas, in Same-date-application invention 1, that point is not specified.

(2) Examination

The above-mentioned Different Feature 1 will be examined below.

On the occasion of judging on identity when the other application is of an invention according to an application filed on the same date, it can be said that Invention 1 and Same-date-application invention 1 are identical when, in either of the cases of the following (A) and (B), Invention 1 and Same-date-application invention 1 can be said to be identical inventions.

(A) When it is assumed that Invention 1 is an invention according to the earlier application (hereinafter, referred to as "the Earlier application invention"), and Same-date-application invention 1 is an invention according to the later application (hereinafter, referred to as

"the Later application invention").

(B) When it is assumed that Same-date-application invention 1 is the Earlier application invention, and Invention 1 is the Later application invention.

Then, even if there are different features between the Earlier application invention and the Later application invention, when the different features fall under the category of any the following a, b, and c, it can be said that the two are substantially identical.

a A case of a very minor difference in a embodying means for solving the problems to be solved (addition, deletion, conversion, or the like of a well-known art and a commonly used art which does not exert a new effect).

b A case of a difference as a result of expressing a matter specifying the invention of the Earlier application invention as a generic concept in the Later application invention.

c A case of a difference in just category expression (for example, a difference in an expression form such as an invention of "product" or an invention of "method").

Therefore, first, in the case of the above-mentioned (B); that is, in the case when assuming that Same-date-application invention 1 is the Earlier application invention and Invention 1 is the Later application invention, the above a, b, c will be discussed below.

<Regarding a>

Whether or not the above-mentioned Different Feature 1 is addition, deletion, conversion, or the like of a well-known art and a commonly used art which does not exert a new effect will be examined hereinafter.

As illustrated in the statement that "the movable accessory 28 is configured to be movable with respect to the game board 2, and performs various kinds of performances by, for example, operating while causing the light emitting element to emit light according to progress of a game by a player." in paragraph [0027] of Japanese Unexamined Patent Application Publication No. 2012-115509, which was shown as a well-known art before Original application in the examiner's decision, it was recognized as a well-known art before Original application to make a movable member operate while causing a light emitting element embedded in the movable member to emit light.

However, the constitution of Invention 1 concerning the above-mentioned Different Feature 1 is not one in which an operation member is just made to operate while causing the first light emitting means to emit light, and the first light emitting means is one that "irradiates light" to "a side positioned in the first state" (an end side of the storage area), and is one that "irradiates light" to "a side positioned in the first state" (an end side of the storage area) during a displacement operation from the first state to the second state. Therefore, it is one that operates a movable member while irradiating light in a predetermined direction by a light emitting element embedded in the movable member, and thus the relevant constitution is different from one that just operates a movable member while causing a light emitting element embedded in the movable member to emit light, and thus it cannot be said that it was a well-known art before Original application.

Further, as Appellant alleges in the written request for appeal, Invention 1 is one that exerts an effect that "during a displacement operation of an operation member, an irradiation range and an irradiation position by a light emitting means vary", by having the constitution concerning Different Feature 1 mentioned above.

In view of the above, it cannot be said that the constitution concerning the above Different Feature 1 of Invention 1 is one which is addition, deletion, conversion, or the like of a well-known art and a commonly used art which does not exert a new effect, and it cannot be said that it is a very minor difference in an embodying means for solving the problems to be solved, and, therefore, Different Feature 1 does not fall under the above-mentioned a.

<Regarding b>

Invention 1 that has been assumed to be the Later application invention is one made by performing a constitutional specification to Same-date-application invention 1 that has been assumed to be the Earlier application invention by the constitution concerning Different Feature 1, and, therefore, it is obvious that Different Feature 1 is not one in which the matters specifying the invention of the Earlier application invention is expressed as a generic concept in the Later application invention, and thus Different Feature 1 does not fall under the above-mentioned b.

<Regarding c>

It is obvious that Invention 1 and Same-date-application invention 1 do not fall under a case of a difference in just category expression (for example, a difference in an expression form such as an invention of "product" or an invention of "method").

Accordingly, in the examination about the case of the above-mentioned (B), it cannot be said that Invention 1 and Same-date-application invention 1 are identical.

Therefore, without examining about the case of the above-mentioned (A), it cannot be said that Invention 1 and Same-date-application invention 1 are identical.

2 Regarding Claim 2 of the present application

(1) Comparison between Invention 2 and Same-date-application invention 2

Invention 2 and Same-date-application invention 2 will be compared.

A Regarding constitutions E, F, and H of Invention 2

Constitutions E, F, and H of Invention 2 and constitutions e, f, and h of Same-date-application invention 2 are substantially identical in terms of wording.

B Regarding constitution G of the Invention 2

When "a second light emitting means provided at a position that is on the back side of the substrate and is on the part of the base end of the operation member on the front side in the side of movement direction, which is capable of irradiating light toward the back side that is approximately vertical to the substrate, and which irradiates light toward the back side that is approximately vertical to the substrate during displacement operation from the first state to the second state" in constitution G of Invention 2 and "a second light emitting means provided at a position that is on the back side of the substrate and is on the part of the base end of the front-side operation member in the side of movement direction, which irradiates light toward the back side that is approximately vertical to the substrate" in constitution g of Same-date-application invention 2 are compared, the two are identical in a point of substantially having a second light emitting means provided at a position that is on the back side of the substrate and is on the part of the base end of the front side operation member in the side of movement direction, which irradiates light toward the back side that is approximately vertical to the substrate.

C Corresponding feature and different features

From the above-mentioned A and B, Invention 2 and Same-date-application invention 2 are identical in the following point.

<Corresponding Feature>

"H A game machine comprising:

E a plurality of operation members having a decoration part visible to a player, capable of being displaced to a first state in which the operation member is arranged at an end side of a storage area for storing the decoration part and a second state in which the operation member is moved to a center side of the storage area, and provided in such a way that the decoration part is visible to the player in the first state and the second state;

F a substrate provided on an operation member on a front side among the plurality of operation members that are arranged overlapping each other back and forth, wherein, in the first state, at least one or more operation members are provided on a back side of the operation member in the front side, wherein, as the second state, a part of a base end of the operation member on the front side in a side of movement direction toward the second state is capable of being arranged at a position where the part of the base end does not overlap with the operation members on the back side, and wherein a front side of the substrate faces the player and a back side of the substrate faces an opposite side relative to the player; and

G' a second light emitting means provided at a position that is on the rear surface side of the substrate and is on the part of the base end of the front-side operation member in the side of movement direction, which irradiates light toward the back side that is approximately vertical to the substrate."

Then, the two have the following different feature.

<Different Feature 2> (Relating to constitution G of Invention 2)

A point that, relating to a second light emitting means which irradiates light toward the back side that is approximately vertical to the substrate, in Invention 2, it is one that irradiates light during displacement operation from the first state to the second state, whereas, in Same-date-application invention 2, such point is not specified.

(2) Examination

Different Feature 2 will be discussed below.

As examined in "1 Regarding Invention 1" mentioned above, whether or not Different Feature 2 falls under any of the above a, b, and c will be discussed below assuming the case where Same-date-application invention 2 is the Earlier application invention, and Invention 2 is the Later application invention as indicated in the above-mentioned (B).

<Regarding a>

As pointed out in the above-mentioned "1 Regarding Invention 1", although it

is recognized that to operate a movable member while causing a light emitting element embedded in the movable member to emit light was a well-known art before Original application, it was not recognized as a well-known art before Original application to operate a movable member while irradiating light in a predetermined direction by a light emitting element embedded in the movable member.

In view of the above, in the constitution concerning Different Feature 2 of Invention 2, it cannot be said that it was a well-known art before Original application that "a second light emitting means which irradiates light toward the back side that is approximately vertical to the substrate" "irradiates light" "during displacement operation from the first state to the second state".

In addition, Invention 2 is one that exerts an effect that "during a displacement operation of an operation member, an irradiation range and an irradiation position by a light emitting means vary", which is alleged by Appellant, by the second light emitting means "irradiating light toward the back side that is approximately vertical to the substrate during displacement operation from the first state to the second state".

Therefore, it cannot be said that the constitution concerning Different Feature 2 of Invention 2 is one which is addition, deletion, conversion, or the like of a well-known art and a commonly used art which does not exert a new effect, and it cannot be said that it is a very minor difference in an embodying means for solving the problems to be solved, and thus the above Different Feature 2 does not fall under the above a.

<Regarding b>

Invention 2 that has been assumed to be the Later application invention is one made by performing a constitutional specification to Same-date-application invention 2 that has been assumed to be the Earlier application invention by the constitution concerning Different Feature 2, and, therefore, it is obvious that Different Feature 2 is not one in which the matters specifying the invention of the Earlier application invention are expressed as a generic concept in the Later application invention, and thus Different Feature 2 does not fall under the above-mentioned b.

<Regarding c>

It is obvious that Invention 2 and Same-date-application invention 2 do not fall under a case of a difference in just category expression (for example, a difference in an expression form such as an invention of "product" or an invention of "method").

Accordingly, in the examination about the case of the above-mentioned (B), it

cannot be said that Invention 2 and Same-date-application invention 2 are identical.

Then, without examining about the case of the above-mentioned (A), it cannot be said that the Invention 2 and Same-date-application invention 2 are identical.

3 Summary

Therefore, it cannot be said that Invention 1 is identical with Same-date-application invention 1, and, in addition, it cannot be said that Invention 2 is identical with Same-date-application invention 2.

No. 7 Closing

From the above, regarding the present application, even if the reasons for refusal stated in the examiner's decision are examined, it may not be concluded that it should be rejected by these reasons.

In addition, beyond that, no reasons for refusal were found.

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

June 25, 2019

Chief administrative judge: TETSU, Toyoo

Administrative judge: TAKAHASHI, Yusuke

Administrative judge: SHIMADA, Hideaki