

Judgments of Intellectual Property High Court, Third Division

Date of the Judgment: 2006.7.11

Case Number: 2005 (Gyo-Ke) No.10264

Title (Case):

A case wherein the court dismissed the plaintiff corporation's request for rescission of the JPO's trial decision made in a trial for correction that denied the existence of an inventive step (and therefore the independent patentability) in its invention described in Claim 1 after the proposed correction (hereinafter referred to as "Corrected Invention 1") by using the invention described in Publication 1 (hereinafter referred to as "Invention of Publication 1" as the primary reference and the inventions described in Publications 2 and 3 as the supplementary reference). In doing so, the court, although observing that the trial decision erred in its reasoning because it would not be easy to apply the teachings of Publication 3 to the Invention of Publication 1, finally found that the trial decision, which was made based on a comparison between Corrected Invention 1 and each of the inventions described in Publications 1 to 3, to deny the independent patentability of Corrected Invention 1 was acceptable in its conclusion because the existence of an inventive step in Corrected Invention 1 may be denied by regarding the invention described in Publication 3 (hereinafter referred to as "Invention of Publication 3") as the primary reference and the inventions described in Publications 2 and 1 as the supplementary reference and applying teachings of the supplementary references to the primary reference.

Reference: Article 29(2) of the Patent Act

Summary of the Judgment:

The plaintiff instituted this lawsuit to seek rescission of the JPO's decision in a trial for correction which refused to accept the plaintiff's request for correction granted to the invention named "Fashion wig" on the grounds that Corrected Invention 1 was unpatentable independently under Article 29(2) of the Patent Act because the invention could easily be made by a person skilled in the art based on the Invention of Publication 1, the teachings of Publication 2, and the teachings of Publication 3.

The plaintiff argued that the invention of "Wig" disclosed in Publication 1 was designed to be inserted in one's hair in the same way as an ordinary comb is used. The plaintiff also pointed out that the "comb teeth" must be separated from one another on one side in order to be inserted into one's hair and therefore that there would be an impediment in changing it to have "bases" to hold the "comb teeth" on both sides.

In response, the defendant (JPO) argued that the conclusion of its trial decision would be unaffected even if the reason for rescission of the JPO's decision claimed by the plaintiff had good grounds, because the lack of an inventive step in Corrected Invention 1 had been proven by regarding Publication 3 as the primary reference and Publications 1 and 2 as supplementary reference.

This court dismissed the plaintiff's request by holding as follows:

If the teaching of Publication 3, i.e. several bases designed to support both sides of the elastic linear parts, is applied to the invention of Publication 1 in order to obtain the feature of Corrected Invention 1 identified as Difference 2, in other words, if the "bases" are introduced to hold both sides of the "comb teeth," the free side of the "comb teeth," which are vital for a comb to function as a comb, would disappear. Consequently, the users would be unable to insert it into his hair. This means that the Invention of Publication 1 would be altered in the opposite direction from its original purpose. In this lawsuit, no sufficient evidence has been submitted to prove that the above-mentioned feature described in Publication 3 had already been well-known in the field of wigs. Thus, it cannot be said that a person skilled in the art could easily arrive at Corrected Invention 1 by applying the above-mentioned teaching of Publication 3 to the Invention of Publication 1, even if the fact that Publication 3 pertains to the same technical field (wigs) is taken into consideration.

In a lawsuit to seek rescission of the JPO's decision of a trial for patent invalidation, it is not permitted to claim any publicly-known fact about which no decision was made in the trial. The same should be applicable to a lawsuit for rescission of a decision of a trial against an examiner's decision of refusal (1967 (Gyo-Tsu) No.28, the judgment of the Grand Bench of the Supreme Court of March 10, 1976, Minshu Vol. 30, No.2, 79). The same should also apply to a lawsuit to seek rescission of the decision of a trial for correction. In sum, it is prohibited to claim in a lawsuit for revocation any matter as an invention that falls under any of the items of Article 29(1) of the Patent Act (including the case where these items are applied under Paragraph (2) of the said Article; hereinafter the same), unless the matter has been examined as an invention that falls under any item of Article 29(1) of the Patent Act in a trial for invalidation or a trial against an examiner's decision of refusal or unless the matter has been examined as an invention that falls under any of the items of Article 29(1) of the Patent Act when making a judgment in a trial for correction as to whether the invention defined by the proposed corrected claim was independently patentable at the time of the filing of patent application.

However, as far as a publicly-known fact examined in a trial is concerned, an act of making an argument that is different from a trial decision on identical and different points observed in comparison with the invention subject to the trial or, in the case where there is more than one publicly-known fact that has been examined, an act

of making an argument that is different from a trial decision with regard to the combination thereof, is not necessarily considered to go beyond the scope of comparison between the invention and any publicly-known fact(s) that has been examined in a trial.

Therefore, an act of making such argument in a lawsuit for rescission is not necessarily prohibited.

This is a lawsuit in which the plaintiff seeks rescission of the trial decision not to accept its request for trial for correction. In the trial decision, the JPO compared the invention defined by the proposed corrected claims (Corrected Invention 1) with the inventions disclosed in Publication 1 to 3 by using the invention disclosed in publication as the primary reference and the inventions described in Publications 2 and 1 as the supplementary reference, and found that a person ordinarily skilled in the art could easily make Corrected Invention 1 based on those referenced inventions and therefore Corrected Invention 1 was not patentable independently at the time of the filing of the patent application.

The defendant argues in this lawsuit that, even if the reasoning based on the above-mentioned comparison employed in the trial decision has an error, there is no legitimate reason to rescind the trial decision because it is correct to determine that Corrected Invention 1 could easily be made by a person ordinarily skilled in the art when comparing Corrected Invention 1 with the references by using the invention disclosed in Publication 3 as the primary reference and the inventions disclosed in Publication 2 and Publication 1 as the supplementary reference. Regarding this argument, it should be noted that each of the inventions described in Publications 1 to 3 is a publicly-known fact that has been examined as an invention that falls under Article 29(1) (iii) of the Patent Act in the trial proceedings.

In addition, the trial decision not only found the features of Corrected Invention 1 that were identical to or different from the Invention of Publication 1 but also found the features of Corrected Invention 1 that were identical to each of the inventions described in Publication 3 by stating that: “The ‘elastic linear bends 1 to 4’ described in Publication 3, which have hair fixed onto themselves, are equivalent to the ‘elastic linear parts’ of Corrected Invention 1. Furthermore, the ‘supporting parts 13 to 16,’ specified in Publication 3, which are designed to fix the above-mentioned bends 1 to 4 on both sides, are equivalent to the ‘supporting parts’ of Corrected Invention 1. Thus, Publication 3 may be considered to be describing the feature that the supporting parts support the elastic linear parts on both sides, i.e., the features of Corrected Invention 1 identified as Differences 2 and 4” (Trial Decision., page 8, lines 30 to 36).

In this way, the trial decision was made based on the result of a substantive comparative examination.

Thus, in this case, not only the invention disclosed in Publication 1 but also the invention disclosed in Publication 3 can be regarded as a publicly-known fact falling

under the category of the invention specified in Article 29(1) (iii) of the Patent Act that has been examined in substance vis-?-vis Corrected Invention 1 in the trial. For this reason, the defendant should be permitted to make such argument as a preliminary claim in this lawsuit. Hence, if the defendant's preliminary claim has good grounds, there would be no reason that could justify the rescission of the trial decision.

When the invention described in Publication 3, "a wig consisting of supporting parts, elastic linear bends supported by the said supporting parts on both sides and aligned on the said supporting parts at fixed intervals, and hair fixed onto the said bends in such a way that it covers the said supporting parts," is compared with Corrected Invention 1, it can be found that the two inventions are identical in that both of them are "a wig consisting of supporting parts, elastic linear bends supported by the said supporting parts on both sides and aligned on the said supporting parts at fixed intervals, and hair implanted at least on the said elastic linear parts," and they are different in Differences 1 to 3.

It is a commonly-used technique in the technical field of wigs for voluming up users' natural hair to comb their hair in the direction opposite to their natural hair streams in order to pull out some of their natural hair through the wigs. Therefore, it would be reasonable to conclude that any person ordinarily skilled in the art could come up with the idea of having a wig user to use a comb, brush, etc., to pull out some of his hair in order to blend the wig into his natural hair. Based on these grounds, the idea of making the intervals between "elastic linear parts" wide enough to allow the user to pull out some of his natural hair for the purpose of blending the wig into his natural hair should be considered to be within the scope of design variation that a person ordinarily skilled in the art could naturally think of.

It is reasonable to conclude that a person ordinarily skilled in the art could easily apply the teachings of Publication 1 and common general technical knowledge to the Invention of Publication 3 in order to make a fashion wig designed to volume up the thinning hair by artificial hair that has the same hair color as the user's as required by the features of Corrected Invention 1 identified as Differences 1 and 3 and could also easily determine the intervals between elastic linear parts in such a way that allows a wig user to comb or brush his hair with the wig on in the direction opposite to his natural hair stream in order to pull out some of his natural hair from the wig.

Publication 2 can be regarded to be disclosing the feature that stoppers are attached onto the backside of the supporting parts that touch the user's natural hair. In other words, it is correct to say that Publication 2 specifies the feature of Corrected Invention 1 identified as Difference 2.

It is therefore correct to consider that a person ordinarily skilled in the art could easily make an invention that has the feature of Corrected Invention 1 identified as Difference 2 by applying the teaching of Publication 2 to Invention of Publication 3.

It is obvious that, if the teaching of Publication 1 is applied to the Invention of Publication 3, an invention whose “elastic linear parts are supported by supporting parts on both sides” would have the same effects as Corrected Invention 1 (such application would easily be made as mentioned earlier). Based on these grounds, it should be concluded that the effects of Corrected Invention 1 could be predictable by a person ordinarily skilled in the art.

Hence, Corrected Invention 1 is an invention that a person skilled in the art could easily make based on the Invention of Publication 3, the teachings of Publication 1, the teachings of Publication 2, and common general technical knowledge. Also, the effects of

Corrected Invention 1 do not involve unpredictability because those effects could be predicted by a person ordinarily skilled in the art based on Invention of Publication 3, the teachings of Publication 1, the teachings of Publication 2, and common general technical knowledge.

Thus, although the reasoning employed in the trial decision that a person ordinarily skilled in the art could arrived at the feature of Corrected Invention 1 identified as Difference 2 by applying the teaching of Publication 3 to the Invention of Publication 1 is mistaken, the conclusion of the trial decision made based on a comparison between Corrected Invention 1 and the inventions described in Publications 1 to 3 that Corrected Invention 1 is unpatentable independently under Article 29(2) of the Patent Act is correct because a person ordinarily skilled in the art could easily make Corrected Invention 1 by applying the teachings of Publication 1 and the teachings of Publication 2 to the Invention of Publication 3.

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