

Judgments of Intellectual Property High Court, First Division

Date of the Judgment: 2006.6.29

Case Number: 2005 (Gyo-Ke) No.10490

Title (Case):

A case wherein, in the litigation for rescinding the decision of the trial against an examiner's decision of refusal on the invention of an optical detector of a sheet paper identification device, the court revoked the trial decision that refused the patent application for the invention due to lack of an inventive step. In concluding so, the court found that the trial decision erred in finding that the differences identified by comparison with the cited invention (paper-layer sensing device), which in fact has different problems to be solved and different purposes from those of the disputed invention, were a mere design variation of prior art technologies found in a closely-related technical field, despite the fact that these differences show new technical features for the art of sheet paper identification devices (those devices have been made based on a different technical idea from the cited invention), and also despite the fact that no suggestion or motivation to incorporate these features into the disputed invention are shown in either the cited invention or the art well-known since before the filing of the patent application for the disputed invention. The court also held that, in addition to the above-mentioned illegality of the trial decision, the defendant's arguments made before the court is impermissible because the defendant's attempt to change the primary reference from the cited invention to another art, which was positioned as a well-known art at the phase of the JPO's trial, is a gross deviation from the scope of proceedings in litigation for rescinding the JPO's trial decision.

Reference: Article 29(2) of the Patent Act

Summary of the Judgment:

The plaintiff filed a patent application for the invention named "optical detector of sheet paper identification device" and received an examiner's decision of refusal. In the trial filed against the examiner's decision of refusal, the plaintiff received a trial decision that the disputed invention was unpatentable because any party skilled in the art may have been able to easily make the invention based on publicly-known documents or well-known information. In response, the plaintiff filed a request for rescission of the trial decision. This court rescinded the trial decision by holding as follows:

"Differences 1 to 3 of the disputed invention may be, if put more accurately, restated as adoption of an optical detector, which may be characterized by Differences 1 and 2, in a type of device identified in Difference 3. In other words, Differences 1 and

2 are pointed out based on the presumption that the optical detector is for use in a device identified in Difference 3. Moreover, as mentioned as Difference 3 in the trial decision, the disputed invention is about a “sheet paper identification device.” On the other hand, the cited invention, which is about a technology related to a sheet paper-layer sensing device, is different from the disputed invention in terms of the problems to be solved and the purposes to be achieved, which has also been recognized by the defendant. Therefore, although it would be permissible to argue Differences 1 and 2 separately from Difference 3 in order to understand the constitution or structure of the disputed invention, one must examine the inventive step of the disputed invention in full consideration of the mutual relationships among Differences 1 to 3.”

“The constituent features of this invention identified as Differences 1 and 3 consist of new technical features that exist neither in the cited invention nor the well-known device [“optical detector of sheet paper identification device having an even number of pairs of light emitting elements and light receiving elements designed to identify sheet paper by irradiating light through sheet paper and comparing the transmitted light with the set standards”]. These constituent features enables the pair of a light emitting element and a light receiving element to irradiate light to detection points that vary depending on the detection line, receive transmitted light from those detection points carrying different patterns, colors, etc., printed thereon, analyze the transmitted light containing information about the printed pattern and color, etc. unique to each of those points, and compare the analysis results with the set standards in order to identify sheet paper. In sum, these constituent features make it possible for a sheet paper identification device to conduct identification operation by use of pairs of light emitting elements and light receiving elements under the technical idea of use of plural detection lines.”

“The above-mentioned trial decision [the constituent feature of the said invention identified as Difference 1 is a mere design variation] seems to have been made based on the presumption that a sheet paper-layer sensing device and a sheet paper identification device belong to the same technical field or closely-related technical fields.

However, the two devices differ in that a sheet paper-layer sensing device is used to detect the number of each type of sheet papers by using the nature of light where the difference in the volume of lights received at the light receiving elements would become larger between different type of sheet papers when the light went through the sheet papers several times, while a sheet paper identification device is used to identify a type of sheet paper from other types by using information about the printed pattern and color, etc. contained in the light transmitted through detection points.

Therefore, the two are different from each other in terms of their functions, effects, and specific technical features required, even if the two can be regarded to be the same in that both of them have constituent features of ‘an optical detector consisting of light

emitting elements that irradiate light to parts of sheet paper conveyed in a set direction, light guiding parts that optically guide the transmitted lights from the parts of the sheet paper to other places different from the parts of the said sheet paper, and light receiving elements that receive the transmitted light from those other parts of the said sheet paper, with these light emitting elements, light guiding parts, and light receiving elements located in different positions on the route to convey the said sheet paper.’ For this reason, a sheet paper-layer sensing device and sheet paper identification device should be considered different even though the two belong to closely-related technical fields. Appropriate motivation needs to exist in order to justify the argument that an ordinary person might easily arrive at the idea that such constituent features of a sheet paper-layer sensing device can also be used for a sheet paper identification device. Therefore, adoption of such constituent features in a sheet paper identification device should be regarded as something more than a mere design variation.

Another reason for denying the argument that a sheet paper-layer sensing device and a sheet paper identification device may be treated alike is that the technical idea of plural detection lines in the disputed invention is unnecessary for a sheet paper-layer sensing device whereas the idea has important technical meaning for a sheet paper identification device.

For these reasons, the trial decision made a mistake in that it concluded that it was nothing more than a mere variation of design to add the constituent features of the disputed invention identified as Difference 1 and Difference 3, which is based on the technical idea of plural detection lines, to the cited invention that does not involve the technical idea of plural detection lines.”

“The defendant argues that the well-known device and the cited invention are the same in the structure of the optical detector and that therefore, nothing would prevent the application of the technical features in the cited invention that requires light to penetrate sheet paper more than once.

This defendant’s argument seems to be made by changing the primary reference for their argument from the cited invention to the well-known device. However, at the stage of the trial proceedings, as stated in the reason for the trial decision that “the optical detector of a sheet paper identification device consisting of light emitting elements that irradiate light to parts of sheet paper and light receiving elements that receive the transmitted light is a technical feature that had been well-known even before the filing of the said application” (the last paragraph of page 4 of a certified copy of the trial decision), the well-known device was regarded as a “technical feature that had been well-known even before the filing of the said application” and not considered as a cited invention that should be compared with the disputed invention. In addition, the well-known device has never been compared to the disputed invention. Under these circumstances, the argument made based on change of the primary reference at the phase

of lawsuit is not permissible because it would be a gross deviation from the scope of proceedings in litigation for rescinding the JPO's trial decision, as held in the judgment of the Grand Bench of the Supreme Court of March 10, 1976, Minshu Vol. 30, No.2, 79. In addition, as already mentioned, the disputed invention and the cited invention are different in the problems and purposes that the inventions are aimed at solving and achieving to begin with. Furthermore, the constituent features of the disputed invention identified as Difference 1 and Difference 3 are neither disclosed nor suggested in the cited invention or the well-known device, and it is difficult to find appropriate motivation to obtain the said constituent features by combining these two."

(The explanations shown in square brackets are added by the author of this summary.)

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