

Date	October 4, 2011	Court	Intellectual Property High Court, Second Division
Case number	2010 (Gyo-Ke) 10298		
○ A case in which, in response to a request for a trial against an examiner's decision of refusal of a patent application for the invention entitled "Reversing washing method and power transmission mechanism," the JPO rendered a decision dismissing an amendment made at the time of filing the request for a trial, without notifying reasons for refusal, and denying the inventive step of the invention as claimed in the application concerned, through a combination of cited inventions; the court rescinded the JPO decision on the grounds that the trial procedures are defective and that the determination of inventive step is erroneous			

References:

Articles 17-2, Article 50, and Article 29, paragraph (2) of the Patent Act

1. The plaintiff received a decision of refusal of a patent application for the invention entitled "Reversing washing method and power transmission mechanism" (Patent Application No. 2003-536518). In response, the plaintiff filed a request for a trial against the examiner's decision of refusal and also made an amendment (the "Amendment") to the description. However, the Amendment was dismissed and the plaintiff received a JPO decision to the effect that the request for a trial is to be dismissed. Therefore, the plaintiff filed this case to seek rescission of the JPO decision.
2. The JPO ruled that the invention after the Amendment falls under amendments designed to restrict the scope of claims as set forth in Article 17-2, paragraph (4), item (ii) of the Patent Act prior to the revision by Act No. 55 of 2006 for which the provisions then in force shall remain applicable pursuant to Article 3, paragraph (1) of the Supplementary Provisions revised by said Act but that the invention is not independently patentable at the time of filing the application pursuant to the provisions of Article 29, paragraph (2) of the Patent Act, as a person ordinarily skilled in the art would have been able to easily make the invention by applying the gear mechanism part (Cited Invention 2) described in cited document 2 (microfilm of Utility Model Application No. 1986-179182 (Unexamined Utility Model Publication No. 1988-85495)) in the washing machine with a power transmission mechanism (Cited Invention 1) described in cited document 1 (Unexamined Patent Publication No. 1984-171588) as well as using well-known art. Based on this ruling, the JPO determined that the Amendment does not conform to the provisions of Article 126, paragraph (5) of the Patent Act prior to the revision, as applied *mutatis mutandis* pursuant to Article 17-2, paragraph (5) of said Act and thus should be dismissed

pursuant to the provisions of Article 53, paragraph (1) of said Act, as applied *mutatis mutandis* pursuant to Article 159, paragraph (1) of said Act by replacing terms. Cited Document 2 was presented for the first time in the hearing in the trial, but reasons for refusal have not been notified.

The JPO then ruled that a person ordinarily skilled in the art would have been able to easily make the invention before the Amendment based on Cited Inventions 1 and 2 and well-known art, and denied the inventive step of said invention.

3. The Intellectual Property High Court mentioned as outlined below and ruled that the trial procedures are defective and that the determination of inventive step is erroneous. Based on this ruling, the Intellectual Property High Court rescinded the JPO decision and upheld the plaintiff's claim.

"The main clause of Article 50 of the 1994 Act provides that where an examiner intends to render a decision of refusal, he/she shall notify the applicant of the reasons therefor and give the applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose. Pursuant to Article 17-2, paragraph (1), item (i) of said Act, the applicant is given an opportunity to make amendments within the designated time limit. These provisions are also applied *mutatis mutandis* to cases where any reason for refusal, other than the one addressed when rendering a decision of refusal, is found in the course of a trial against an examiner's decision of refusal. Unlike during the examination stage, there is no opportunity to make amendments in the trial procedures unless a notice of reasons for refusal is given (as a matter of course, there is no room to make amendments in a lawsuit to seek rescission of a JPO decision). Also unlike when receiving a decision of refusal, there is no longer any opportunity to make amendments when the applicant receives a JPO decision to the effect that a request for a trial against an examiner's decision of refusal is to be dismissed (JPO decision of refusal). Therefore, this point is harsh on the demandant of a trial who is the applicant. According to the aforementioned provisions of the Patent Act, even in the case where an amendment lacks the independent patentability requirement, the JPO may dismiss the amendment at the time of rendering a decision without giving a notice of reasons for refusal. However, in some cases, it could be necessary to consider such handling as going against appropriate procedures in patent application examination procedures, including trial procedures, as handling that lacks basic principles for ensuring appropriate patent application examination procedures, taking into account that it may cause the aforementioned harsh consequences on the demandant of a trial who is the applicant."

"There are the following circumstances concerning the dismissal of the Amendment in

this case: (i) The constitution subject to the Amendment is significantly limited compared to the constitution before the Amendment. That is, the invention before the Amendment was described in a general way as follows: In a washing machine which includes a driving force input terminal and two driving force output terminals and is to generate bidirectional driving, the mechanism to transmit driving force is a 'gear box which can convert driving force input into two driving force outputs.' The Amendment specifies the specific constitution of the gear in the gear box focusing on two sets of gear parts, in line with the content of a working example indicated in drawings, etc., and it is related to the constitution of the amended invention. However, it was necessary to determine whether this new limitation could have been easily arrived at by a person ordinarily skilled in the art by adding presently new publicly known documents. (ii) A publicly known document presented in the hearing has not been presented in the notices of reasons for refusal given up to then. (iii) As a result of the hearing, the plaintiff suggested specific amendments and submitted a written opinion requesting the JPO to give a notice of reasons for refusal. (iv) As determined below, it is impossible to approve applying the matters described in newly presented Cited Document 2. Taking into account these circumstances in this case, and considering the fact that the JPO dismissed the Amendment designed to restrict the scope of claims, which was made together with filing a request for a trial against the examiner's decision of refusal, on the grounds of the lack of inventive step only by indicating the document cited before and Cited Document 2 that is different from well-known art in a written hearing, without notifying reasons for refusal, it is inevitable to conclude that said dismissal of the Amendment goes against appropriate procedures as handling that lacks basic principles for ensuring appropriate patent application examination procedures. In this case, it should be said that before denying the inventive step of the specific constitution of the gear that was amended in a restrictive manner, based on the new publicly known art that indicates said constitution, the JPO should have given the applicant an opportunity to make further amendments and to submit a written opinion in the trial procedures by giving a notice of reasons for refusal, which includes said new publicly known art as a ground for refusal. The JPO decision rendered without going through this procedure is defective, and this procedural defect is an illegal one that should affect the conclusion of the JPO decision."

"The power transmission mechanism of the washing machine of Cited Invention 1 and the power transmission mechanism of the counter propeller of ships, etc. of Cited Invention 2 belong to different technical fields and also significantly differ in the design concept. It cannot be said that a person ordinarily skilled in the art in the

technical field of washing machines is familiar with the art related to ships. Therefore, it is difficult to seek a similar art in the counter propeller, which is an art unique to the field of ships, etc., when developing and improving the power transmission mechanism of washing machines. In addition, as a washing machine is ordinarily installed on the floor and used in stable condition, it is generally not necessary to think of the problem of the antitorque caused by the rotation of an agitator or a washing tub. Accordingly, it is difficult for a person ordinarily skilled in the art to apply the matters described in Cited Invention 2 concerning a counter propeller, which are essentially not required in the field of washing machines, to Cited Invention 1."

Judgment rendered on October 4, 2011; the original was received on the same day; court clerk
2010 (Gyo-Ke) 10298, Case of Seeking Rescission of a JPO Decision

Date of conclusion of oral argument: September 13, 2011

Judgment

Plaintiff: Haier Group

Plaintiff: *Haier Electric Appliances International Co., Ltd.*

Plaintiffs' counsel patent attorney: IKEUCHI Hiroyuki

TORAOKA Keiji

Defendant: Commissioner of the Japan Patent Office

Designated representative: SHOMURA Miwa

CHIBA Shigenari

NAGAYA Yojiro

KUROSE Masakazu

TAMURA Masaaki

Main Text

The JPO decision rendered regarding Trial against Examiner's Decision of
Refusal No 2008-21115 on May 10, 2010 shall be rescinded.

The defendant shall bear the court costs.

Facts and reasons

No. 1 Judicial decision sought by the plaintiffs

The same as the main text of this judgment.

No. 2 Background

This is an action to seek rescission of a JPO decision dismissing a request for a trial against an examiner's decision of refusal in relation to a patent application. The issues are the illegality of a failure to give a notice of reasons for refusal before rendering a ruling dismissing an amendment and the lack of fulfillment of the independent patentability requirement. Incidentally, hereinafter, "Plaintiff" refers to both plaintiffs.

1. JPO proceedings

The Plaintiff filed a patent application (Patent Application No. 2003-536518; date of international publication: April 24, 2003; date of national publication: February 24, 2005; Publication of Japanese Translation of PCT International Application No. 2005-505393; the "Patent Application") in relation to an invention titled "reversing washing method and power transmission mechanism" with an international application date of June 12, 2002 (a priority claim under the Paris Convention: October 18, 2001 (priority date); People's Republic of China (priority country)). However, the Plaintiff received an examiner's decision of refusal dated May

15, 2008. Therefore, the Plaintiff filed a request for a trial against the examiner's decision of refusal on August 18 of the same year and, at the same time, made an amendment (the "Amendment") to the description on September 8 of the same year.

The JPO examined the aforementioned request for a trial as Trial against Examiner's Decision of Refusal No. 2008-21115, and conducted a hearing dated October 20, 2009. The Plaintiff submitted a written reply dated April 9, 2010. However, the JPO dismissed the Amendment on May 10 of the same year and also rendered a decision to the effect that the "request for a trial is to be dismissed." A certified copy of the JPO decision was served to the Plaintiff on May 20 of the same year (an addition of 90 days to the statute of limitations for filing an action).

2. Gist of the invention claimed in the Patent Application

Before and after the Amendment, the invention claimed in Claim 1 in the scope of claims of the Patent Application is as follows.

(1) Before the Amendment

"A power transmission mechanism (8) for generating a bidirectional drive that is suited for use in a washing machine, which is comprised of a drive power input terminal and two drive power output terminals, one of which is connected to agitator shaft (10) to rotate said agitator shaft in a particular direction and another one of which is connected to inner tub shaft (11) to rotate said hollow inner tub shaft in another direction, and also comprises a gear box that can convert a drive power input into two drive power outputs, which is characterized by the following: said hollow inner tub shaft extends through a shaft hole provided on the upper wall of said gear box (13) and is also placed in said gear box; and said hollow inner tub is rotatable within said shaft hole" (hereinafter referred to as the "Invention Before the Amendment").

(2) After the Amendment

"A power transmission mechanism for generating a bidirectional drive that is suited for use in a washing machine, which comprises a drive power input terminal and two drive power output terminals, one of which is connected to agitator shaft (10) to rotate said agitator shaft in a particular direction and another one which is connected to hollow inner tub shaft (11) to rotate said hollow inner tub shaft in another direction, and also comprises gear box (13) that converts a drive power input into two drive power outputs, which is characterized by the following: said gear box has shaft holes on the upper and lower end walls, respectively, and said hollow inner tub shaft extends through said shaft hole provided on said upper end wall and is rotatably placed in said gear box; two pairs of gear shafts (29 and 16) are placed in the gear shaft holes formed on said upper and lower end walls of said gear box, respectively; two pairs of gear parts (15 and 28) are placed in said two pairs of gear shafts, respectively and engage with each other; said agitator shaft is concentrically placed inside said hollow inner tub shaft and rotates therein; the

lower end of said agitator shaft extends beyond the lower end of said hollow inner tub shaft; external gear (30) placed at said lower end of said agitator shaft (10) engages with one (15) of said two pairs of gear parts; external gear (12) placed at said lower end of said hollow inner tub shaft (11) engages with another one (28) of said two pairs of gear parts; main drive shaft (20) is placed inside said gear box, and its lower end passes through said shaft hole on said lower end wall of said gear box and also extends downward and outward; external gear (24) placed at the upper end of said main drive shaft (20) engages with said one (15) of said two pairs of gear parts" (hereinafter referred to as the "Amended Invention").

3. Essential points of the reasons for the JPO decision

(1) The Amended Invention falls under an amendment made for the purpose of restricting the scope of claims as set forth in Article 17-2, paragraph (4), item (ii) of the Patent Act prior to revision by Act No. 24 of 2002 for which the provisions then in force shall remain applicable pursuant to Article 3, paragraph (1) of the Supplementary Provisions revised by said Act (which is described as Article 3, paragraph (1) of the Supplementary Provisions revised by Act No. 55 of 2006 in the JPO decision). However, the Amended Invention is an invention that a person ordinarily skilled in the art could have easily made based on Publication 1 Invention described in Publication 1 (Publication of Unexamined Patent Application No. 1984-171588; Exhibit Ko No. 1), Publication 2 Invention described in Publication 2 (microfilm of Utility Model Application No. 1986-179182 (Publication of Unexamined Utility Model Application No. 1988-85495); Exhibit Ko No. 2), and well-known art. Therefore, it was not independently patentable at the time of the filing of the Patent Application pursuant to the provisions of Article 29, paragraph (2) of the Patent Act. Consequently, the Amendment does not comply with the provisions of Article 126, paragraph (5) of the aforementioned Patent Act prior to revision, as applied *mutatis mutandis* pursuant to Article 17-2, paragraph (5) of said Act, and it should be dismissed pursuant to the provisions of Article 53, paragraph (1) of said Act, as applied *mutatis mutandis* pursuant to Article 159, paragraph (1) of said Act after the deemed replacement.

In addition, the Invention before the Amendment is an invention that a person ordinarily skilled in the art could have easily made based on Publication 1 Invention and well-known art. Therefore, it is not patentable pursuant to the provisions of Article 29, paragraph (2) of the Patent Act.

(2) The findings of Publication 1 Invention and Publication 2 Invention, the findings of common features and differences between the Amended Invention and Publication 1 Invention, and determinations concerning differences are as follows.

[Publication 1 Invention]

"Drive mechanism part 29 of a washing machine for generating a bidirectional drive which is comprised of an internal gear part 31 to which the rotation of motor rotor 39 is transmitted and

two drive power output terminals, one of which is connected to shaft 32 of the agitator body in order to rotate said shaft 32 of agitator body in a particular direction and another one which is connected to shaft 30 of hollow washing and dehydration tub 6 to rotate said shaft 30 of hollow washing and dehydration tub 6 in another direction, and is also comprised of a planetary gear mechanism that converts the rotation of motor rotor 39 into two drive power outputs, wherein said shaft 32 of agitator body is concentrically placed inside said shaft 30 of hollow washing and dehydration tub 6 and rotates therein and the lower end of said shaft 32 of the agitator body extends beyond the lower end of said shaft 30 of hollow washing and dehydration tub 6."

[Publication 2 Invention]

"A turnover device for a contra-rotating propeller wherein the rotation of main diesel engine 1 causes the rotation of forward propeller 6 in one direction after going from input gear 3-1 of input shaft 2a through large gear for outer shaft 3-7 and hollow outer shaft 5 while it causes the rotation of backward propeller 7 in another direction after going from input gear 3-1 through the first small gear 3-2, flexible shaft 3-3, the second small gear 3-4, large gear for inner shaft 3-5, and inner shaft 4."

[Common features between the Amended Invention and Publication 1 Invention]

"A power transmission mechanism for generating a bidirectional drive that is suited for use in a washing machine, which comprises a drive power input part and two drive power output terminals, one of which is connected to the agitator shaft to rotate said agitator shaft in a particular direction and another one which is connected to the hollow inner tub shaft to rotate said hollow inner tub shaft in another direction and also comprises a gear mechanism part that converts a drive power input into two drive power outputs, wherein said agitator shaft is concentrically placed inside said hollow inner tub shaft and rotates therein and the lower end of said agitator shaft extends beyond the lower end of said hollow inner tub shaft."

[Differences between the Amended Invention and Publication 1 Invention]

(Difference 1)

In the Amended Invention, the entire structure of the "drive power input part" of the power transmission mechanism is a "gear box" which comprises a "drive power input terminal." On the other hand, it is not a "gear box" but rather the "internal gear part 31 to which the rotation of motor rotor 39 is transmitted" in Publication 1 Invention.

(Difference 2)

In the Amended Invention, the "gear mechanism part" of the power transmission mechanism is one whose structure is as follows: "the gear box has shaft holes on the upper and lower end walls, respectively, and said hollow inner tub shaft extends through said shaft hole provided on said upper end wall and is rotatably placed in said gear box; two pairs of gear shafts (29 and 16) are placed in the gear shaft holes formed on said upper and lower end walls of said gear box,

respectively; two pairs of gear parts (15 and 28) are placed in said two pairs of gear shafts, respectively, and engage with each other; external gear (30) placed at said lower end of said agitator shaft (10) engages with one (15) of said two pairs of gear parts; external gear (12) placed at said lower end of said hollow inner tub shaft (11) engages with another one (28) of said two pairs of gear parts; main drive shaft (20) is placed inside said gear box, and its lower end passes through said shaft hole on said lower end wall of said gear box and extends downward and outward; external gear (24) placed at the upper end of said main drive shaft (20) engages with said one (15) of said two pairs of gear parts." On the other hand, the "gear mechanism part" of the power transmission mechanism in Publication 1 Invention is a "planetary gear mechanism."

[Determinations concerning the differences in the JPO decision]

(Regarding Difference 1)

Giving machine elements a unit structure is a matter that can be done as needed. Therefore, there is no difficulty found in applying this well-known art to Publication 1 Invention to make it one that pertains to Difference 1.

(Regarding Difference 2)

It is a mere matter of design variation to try to change the "planetary gear mechanism" of Publication 1 Invention to Publication 2 Invention regarding cost, man-hours, and other matters.

Taking into account Difference 1 in applying Publication 2 Invention, the mechanism of Publication 2 Invention is arranged in the "gear box." Therefore, "input shaft 2a (main drive shaft)," "inner shaft 4 (agitator shaft)," and "external shaft 5 (inner tub shaft)," which are the input or output shaft, naturally extend through the "shaft holes" on the "walls" of the "gear box." It is thus natural to provide a pair of gear shafts in the "shaft holes" on the "walls" of the "gear box."

Moreover, in power transmission using gears, it is not unusual to change the positions where constituent elements are placed and to increase or decrease the number of gears along with such a change due to a design requirement. Therefore, there is no difficulty found in dividing the function of "input shaft 2a" and "input gear 3-1" of Publication 2 Invention and making them into two members, specifically, "main drive shaft (20)" and one (29) of the two "pairs of gear shafts (29 and 16)," and "external gear (24)" and one (15) of the two "pairs of gear parts (15 and 28)."

Regarding the point that there are "two pairs" of gear shafts and gear parts, it is well-known to adopt a symmetric structure in consideration of a transmission balance, as seen in paragraph [0011] in Publication of Unexamined Patent Application No. H5-234911 (Exhibit Ko No. 5). It is a simple matter that can be done appropriately.

Therefore, Difference 2 is not special.

(omitted)

No. 5 Court decision

1. Regarding Ground for Rescission 1 (violation of laws and regulations in the trial procedures)

(1) The Plaintiff alleges as follows: The JPO denied existence of an inventive step in the Amended Invention by using a different cited document from the documents cited in the examiner's decision of refusal, and the Plaintiff was not given an opportunity to submit a written opinion in relation to a reason for refusal that differs from those stated in the examiner's decision of refusal; therefore, there is a defect of violation of the provisions of Article 50 of the Patent Act, as applied *mutatis mutandis* pursuant to Article 159, paragraph (2) of said Act, in the trial procedures; said defect is an illegal one that affects the conclusion of the JPO decision.

(2) First of all, looking at the progress of this case with a focus on documents presented by the examiner and the trial examiner before the JPO decision was rendered, the examiner's decision of refusal rendered in the examination procedure (Exhibit Ko No. 11) presented Publication 1 (Publication of Unexamined Patent Application No. 1984-171588) and a publicly known document, Publication of Unexamined Patent Application No. 1978-25072 (Exhibit Ko No. 3) as well as Publication of Japanese Translation of PCT International Application No. 1997-500709 and the microfilm of Utility Model Application No. 1992-27639 (Publication of Unexamined Utility Model Application No. 1993-87352). On the other hand, in the written hearing (Exhibit Ko No. 15), which was presented in the trial after the Amendment that was made by the Plaintiff at the same time as the filing of the request for a trial, the JPO newly presented Publication 2 (microfilm of Utility Model Application No. 1986-179182 (Publication of Unexamined Utility Model Application No. 1988-85495) and the microfilm of Utility Model Application No. 1988-111582 (Publication of Unexamined Utility Model Application No. 1990-32822)) in addition to Publication 1, and thereby offered to the Plaintiff the content of the written report on reconsideration by the examiner before trial to the effect that the Patent Application should be refused. The JPO required the Plaintiff to reply regarding said hearing though the Plaintiff is unable to make an amendment prescribed in Article 17-2 of the Patent Act unless a new notice of reasons for refusal is given. In response, the Plaintiff submitted a written reply (Exhibit Ko No. 16) to the effect that the Amendment fulfills the independent patentability requirement and that the Plaintiff demands that the JPO give the Plaintiff an opportunity to further amend claim 1, while presenting a draft amendment. However, the JPO rendered the decision without giving such an opportunity.

(3) With regard to the legal provisions that are disputed in relation to the Patent Application, Article 17-2 and Article 50 of the Patent Act revised by Act No. 26 of 1993 are applicable. The Amendment is one made within 30 days from the date on which a request for a trial against an

examiner's decision of refusal is filed, which falls under Article 17-2, paragraph (1), item (iii) of the 1994 Act. Therefore, it is necessary to fulfill the requirements provided for in paragraphs (3) to (5) of said Article. Article 126, paragraph (4) of said Act, as applied *mutatis mutandis* to an amendment made for the purpose of restricting the scope of claims pursuant to Article 17-2, paragraph (5) of said Act, provides that "an invention ... must be one which could have been patented independently at the time of filing of the patent application." Consequently, the Amendment must fulfill the "independent patentability requirement."

On the other hand, Article 53 of said Act provides that an amendment pertaining to Article 17-2, paragraph (1), item (ii) of said Act shall be dismissed by a ruling if it does not comply with the provisions of paragraphs (3) to (5) of said Article. Said Article is applied *mutatis mutandis* to a trial against an examiner's decision of refusal pursuant to Article 159, paragraph (1) of said Act after the deemed replacement. Moreover, the proviso to Article 50 of said Act provides that even in the case of rendering an examiner's decision of refusal, the examiner is not required to notify the applicant of reasons for refusal when he/she dismisses an amendment. The proviso to said Article is applied *mutatis mutandis* to a trial against an examiner's decision of refusal pursuant to Article 159, paragraph (2) of said Act after the deemed replacement. Therefore, an amendment made on the occasion of filing a request for a trial against an examiner's decision of refusal should be dismissed not only when it falls under addition of a new matter or goes against the purpose of amendment but also when it does not fulfill the independent patentability requirement: such as novelty and an inventive step. In that case, the examiner is not required to notify the reasons for refusal.

The main clause of Article 50 of the 1994 Act provides that where the examiner intends to render an examiner's decision of refusal, he/she shall notify the applicant of the reasons therefor and give the applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose. Pursuant to Article 17-2, paragraph (1), item (i) of said Act, the applicant is given an opportunity to make an amendment within the designated time limit. These provisions are also applied *mutatis mutandis* to the cases where any reason for refusal, other than those described in the examiner's decision of refusal, is found in the course of a trial against the examiner's decision of refusal. Unlike during the examination stage, there is no opportunity to make an amendment in the trial procedures unless a notice of reasons for refusal is given (as a matter of course, there is no room to make an amendment in an action to seek rescission of a JPO decision). Also unlike the situation where one receives an examiner's decision of refusal, there is no longer any opportunity to make an amendment when the applicant receives a JPO decision dismissing a request for a trial against an examiner's decision of refusal (JPO decision of refusal). This point is highly unfavorable for the demandant of a trial who is an applicant. According to the aforementioned provisions of the Patent Act, the JPO may

also dismiss an amendment on the occasion of rendering a decision without giving a notice of reasons for refusal in the cases where the amendment does not fulfill the independent patentability requirement. However, there may be cases where such handling should be considered as going against appropriate procedures in patent application examination procedures, including trial procedures, due to the lack of basic principles for ensuring appropriate patent application examination procedures, in light of the fact that it may cause the aforementioned harsh consequences for the demandant of a trial who is the applicant.

(4) There are the following facts as circumstances concerning the dismissal of the Amendment in this case. [i] The structure that is covered by the Amendment is significantly limited compared to the structure before the Amendment. Specifically, in the Invention before the Amendment, a mechanism for a drive power transmission in a washing machine for generating a bidirectional drive which is comprised of a drive power input terminal and two drive power output terminals is described in a general way as a "gear box that can convert a drive power input into two drive power outputs." However, the Amendment specifies the specific structure of the gears in the gear box, focusing on two pairs of gear parts (15 and 28), in line with the content of the working example indicated in drawings, etc., and it relates to the structure of the Amended Invention. However, this new limitation was one that requires a determination concerning whether the new limitation could have been easily conceived of by a person ordinarily skilled in the art in consideration of additionally presented new publicly known documents. [ii] A publicly known document presented in the hearing was one that had not been presented in the notices of reasons for refusal given up to that point. [iii] As a result of the hearing, the Plaintiff submitted a written opinion suggesting a draft further amendment and requesting the JPO to give another notice of reasons for refusal. [iv] As determined in 2 below, it is unacceptable to apply the matters described in Publication 2, which was newly presented. Taking into account these circumstances of this case, it is inevitable to conclude that the JPO dismissed the Amendment, which was made at the same time as the filing of a request for a trial against an examiner's decision of refusal and which restricted the scope of claims, without notifying any reasons for refusal and only by presenting Publication 2, which is neither the document cited in the past nor well-known art, as a reason for lack of an inventive step in the written hearing and that such handling goes against appropriate procedures in that it lacks basic principles for ensuring appropriate patent application examination procedures. In this case, even in the trial procedures, before denying involvement of an inventive step in the specific structure of the gear amended in a restrictive manner based on a new publicly known art that indicates said structure, the JPO should have given the applicant an opportunity to make a further amendment and submit a written opinion by giving a notice of reasons for refusal, which includes said new publicly known art as a ground for the denial. The JPO decision rendered

without going through this process is defective, and said procedural defect is an illegal one that should affect the conclusion of the JPO decision. Therefore, there is a reason for Ground for Rescission 1 alleged by the plaintiff.

(5) The defendant alleges as follows: The 1993 revision was made for the purpose of correcting inequality between applications which are barely amended owing to utilization of the multiple claim system from the beginning of the filing procedures and applications which are excessively amended and thereby ensuring expeditious examinations and trials; the system was designed wherein an amendment made after receipt of the last notice of reasons for refusal or an amendment made on the occasion of filing a request for a trial against an examiner's decision of refusal is immediately dismissed if it is unlawful.

The 1993 revision can certainly be regarded as being intended to ensure expeditious examinations and trials through restriction of the purposes of an amendment, etc., as alleged by the defendant. However, even if the 1993 revision was made for such purpose and repeated amendments are not favorable, it is necessary to guarantee appropriate procedures for the framework of responding to reasons for refusal that had not been presented up to then. Though separate consideration is required in relation to applications which have been excessively amended, the fact remains that the JPO is not permitted to draw a conclusion in its decision that the Amended Invention lacks the independent patentability requirement and could have been easily conceived of by a person ordinarily skilled in the art without presenting the new publicly known art in a notice of reasons for refusal based on the aforementioned facts of this case.

The defendant alleges as follows: In the hearing, the defendant presented the content of the written report on reconsideration by the examiner before trial and requested the Plaintiff to make a reply if it has any opinions, and also specifically presented Publication 2 and stated that the Amended Invention lacks an inventive step based on the content thereof; in response to this, the Plaintiff submitted the written reply dated April 9, 2010, and argued against Publication 2 and other cited documents in detail and alleged that the Amended Invention involves an inventive step; therefore, it cannot be said that the Plaintiff was not given any opportunity to express opinions in this regard.

However, the aforementioned procedure was a mere presentation of Publication 2 in the hearing, and was not a request for submission of a written opinion by giving a notice of reasons for refusal. Therefore, it lacks the guarantee of procedures for the Plaintiff, who had presented a draft amendment and demanded that the JPO give an opportunity to make an amendment and also planned to make an amendment in response to newly presented Publication 2. Such procedure lacks the perspective of protecting inventions and realizing appropriate trial procedures, as indicated above.

2. Regarding Ground for Rescission 4 (an error in the determination concerning an inventive

step in relation to Difference 2)

(1) The Plaintiff alleges as follows: Turnover device 3 of Publication 2 is one that is "used mainly for a ship" wherein the forward propeller is mounted on outer shaft 5 and the backward propeller is mounted on inner shaft 4; the art relating to the propeller of a ship is an extremely specialized art while a washing machine for which the power transmission mechanism of the Amended Invention is used is a kind of electric home appliance that is familiar to general consumers; in addition, the drive mechanism of a propeller of a ship is very large while that of a washing machine is relatively small; thus, there is a large design difference between those drive mechanisms; consequently, it is impossible to apply Publication 2 Invention, which belongs to a different technical field from that of washing machines, to Publication 1 Invention relating to washing machines.

(2) According to considerations based on the above, the Amended Invention relates to a "power transmission mechanism suited for use in a washing machine," and Publication 1 Invention relates to a "one-tub washing and dehydration machine with a washing and dehydration tub." Both inventions relate to a relatively small power transmission mechanism mounted on electric appliances used in general households. On the other hand, Publication 2 Invention relates to a "turnover device for a contra-rotating propeller used mainly for a ship," that is, a very large power transmission mechanism used for the purpose of driving a propeller of a ship, etc. It is technically clear that there is a large difference in design concept between such power transmission mechanism to wash lightweight clothes and such power transmission mechanism to propel a heavy ship. Therefore, the Amended Invention/Publication 1 Invention and Publication 2 Invention are recognized as belonging to different technical fields.

Moreover, according to Publication 1, the problem to be solved in Publication 1 Invention is recognized as "lessening damage to fabric and unevenness of washing and providing a one-tub washing and dehydration machine with excellent detergency": that is, improvement of detergency, on the premise of the problem in conventional washing machines, specifically, "causing significant damage to fabric and unevenness of washing because washing is conducted only by the rotation movement of the agitator body without the rotation movement of the washing and dehydration tub itself." On the other hand, according to Publication 2, the problem to be solved in Publication 2 Invention is recognized as "providing a turnover device for a contra-rotating propeller which realizes convenience in terms of layout and structural downsizing and weight saving by making it possible to lessen the torque transmission by the small gear and flexible shaft compared to conventional ones as well as by making it possible to lessen the face-to-face dimension." The contra-rotating propeller mentioned here refers to a mechanism wherein a sub propeller that rotates in the opposite direction of the rotation of the main propeller is provided for the purpose of eliminating the antitorque caused by the rotation

of the main propeller. It is technically recognized as one used mainly for an airplane or a ship, etc. for the following reasons. Specifically, as a flight vehicle or a ship that runs in the air or on water is unstable compared to objects resting on the ground and traveling bodies that run on the ground, the higher the speed of the rotation of the main propulsive propeller, the higher its tendency to tilt toward the opposite direction becomes. Therefore, it is necessary to restrain the tilt of the flight vehicle or ship caused by the rotation of the main propeller by providing a sub propeller and rotating it in the opposite direction to the rotation of the main propeller.

In that case, the problem to be solved differs significantly between Publication 1 Invention and Publication 2 Invention in that the former is an art intended to improve detergency for clothes while the latter is an art unique to a ship, etc. which is originally intended to stabilize the posture of a ship, etc.

(3) As mentioned above, the power transmission mechanism of the washing machine of Publication 1 Invention and that of the contra-rotating propeller of a ship, etc. of Publication 2 Invention belong to different technical fields and also significantly differ in the design concept. Therefore, it cannot be said that a person ordinarily skilled in the art in the technical field of washing machines is familiar with the art relating to ships. Consequently, it is difficult for such person to seek a similar art in the contra-rotating propeller, which is an art unique to the field of ships, etc., when developing and improving the power transmission mechanism of washing machines. In addition, as a washing machine is ordinarily installed on the floor and used in a stable condition, it is generally not necessary to think of the problem of the antitorque caused by the rotation of an agitator or an inner tub.

Accordingly, it is difficult for a person ordinarily skilled in the art to apply the matters described in Publication 2 relating to a contra-rotating propeller, which are essentially not required in the field of washing machines, to Publication 1 Invention, and there is a reason for Ground for Rescission 4 alleging this point.

(4) Regarding the points mentioned above, the defendant alleges that Publication 1 Invention and Publication 2 Invention belong to the same technical field in that both of them are power transmission mechanisms and that they have common functions, specifically, converting one drive power input into two drive power outputs and transmitting power.

However, it is necessary to be cautious about determining the ease of combining publicly known arts for which problems to be solved differ significantly, merely based on the fact that both publicly known arts belong to a highly-versatile general technical field of power transmission mechanisms. The defendant's allegation is thus unacceptable.

The defendant also alleges that the statement in Publication 2, "used mainly for a ship," is a mere indication of an example and that it is obvious that the turnover device using a gear mechanism itself has versatility that enables use for other purposes than for ships in terms of its

structure.

However, it is obvious that even if it is stated in the description that a technical field in which the invention is applied is indicated as an example, it is not easy to apply other arts in all technical fields. In the case of intending to deny involvement of an inventive step in an invention which was filed by combining multiple inventions such as in this case, it is necessary to specifically consider the technical fields, problems to be solved, motivation for combination, etc. of the inventions, respectively. As mentioned above, Publication 1 Invention and Publication 2 Invention not only belong to different technical fields but also significantly differ in the problem to be solved. The motivation for combining them is also unclear. Consequently, the defendant's allegation is unacceptable.

No. 6 Conclusion

As mentioned above, there are reasons for Grounds for Rescission 1 and 4 alleged by the Plaintiff.

Therefore, the Plaintiff's claim shall be upheld, and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Second Division

Presiding judge: SHIOTSUKI Shuhei

Judge: SHIMIZU Misao

Judge: FURUYA Kenjiro