Date	September 20, 2011	Court	Intellectual Property High Court, Second Division
Case number	2010 (Gyo-Ke) 10369		
○ A case in which, regarding a patent for the invention entitled "Method of supplying food-drink containers and device therefor," the court cast aside the plaintiff's assertion of lack of inventive step and maintained the JPO decision to the effect that a request for a trial for patent invalidation is to be dismissed			

References:
Article 29, paragraph (2) of the Patent Act

1. Background

The defendant filed a patent application for the invention entitled "Method of supplying food-drink containers and device therefor," which is an invention concerning a method of supplying food and drink in response to customers' orders with the use of a carrier device in a rotating sushi bar and a device used for said method. The establishment of the patent was registered on November 30, 2007 (Patent No. 4046467; the number of claims is 10). However, Excera Co., Ltd. (which was subsequently bought out by the plaintiff) filed a request for a trial for patent invalidation with regard to the inventions claimed in claims 4, 7, 8, and 1 to 3 (Invalidation Case No. 2008-800108). The Japan Patent Office (JPO) rendered the first decision to the effect that the patent for the inventions claimed in claims 4, 7, 8, and 1 to 3 is to be invalidated. In response, the defendant filed a lawsuit with the Intellectual Property High Court to seek rescission of the first decision, and also filed a request for a trial for correction with the JPO. Consequently, the first decision was rescinded pursuant to Article 181, paragraph (2) of the Patent Act. After that, the defendant filed a request for correction, which includes deleting claims 2 to 4, 7, and 8, moving forward claims 5, 6, 9, and 10 to claims 2 to 5 in order of precedence, and revising part of the statements in the claims (Correction). In response, the JPO rendered the following second decision (hereinafter merely referred to as the "Decision") on October 21, 2010: "The correction is accepted. The request for the trial for patent invalidation is dismissed."

Consequently, the plaintiff filed this lawsuit to seek rescission of the JPO decision.

Incidentally, regarding the plaintiff's assertion of lack of inventive step mainly based on the cited document of Evidence Kou No. 8 (Unexamined Patent Publication No. 1999-164764), the JPO ruled as follows: In the invention described in said publication (Invention of Evidence Kou No. 8), the minimum number of staff members, who are supposed to work exclusively at the rotating dining table, pick up plates carried by a

high-speed carrier lane, and customers are not supposed to pick them up. Therefore, there is no room to be motivated to apply the invention described in Evidence Kou No. 4 (Unexamined Patent Publication No. 1986-135611) which is based on the premise that customers pick up relevant plates. Based on this ruling, the JPO instructed that the invention claimed in claim 1 (Invention) is not an invention which a person ordinarily skilled in the art would have been able to easily make based on the inventions described in Evidence Kou No. 8. etc. and well-known art. In addition, with regard to the plaintiff's assertion of lack of inventive step mainly based on the cited document of Evidence Kou No. 10 (microfilm of Utility Model Application No. 1984-200672), the JPO ruled that there is no room to be motivated to apply the invention described in Evidence Kou No. 4 (Invention of Evidence Kou No. 4) to the invention described in Evidence Kou No. 10 (Invention of Evidence Kou No. 10) which is to solve a different problem, as the dual food-drink conveyer described in said publication is not supposed to receive orders from customers and carry ordered items. Based on this ruling, the JPO instructed that the Invention is not an invention which a person ordinarily skilled in the art would have been able to easily make based on the invention of Evidence Kou No. 10, etc. and well-known art.

2. Summary of the decision of the Intellectual Property High Court

The Intellectual Property High Court ruled that the JPO's determination of inventive step in the decision is not erroneous and dismissed the plaintiff's claim, holding mainly as follows.

(1) The JPO's finding that customers are not supposed to pick up plates carried by a high-speed carrier lane in the Invention of Evidence Kou No. 8 is not erroneous. Evidence Kou No. 8 points out an advantage of going through the hands of staff members (employees) in terms of the provision of services to customers. In addition, it is undeniable that the level of the quality of services for customers differs between the case where customers receive plates on which items they have ordered are placed from the hands of the staff members of a sushi bar and the case where customers pick up plates carried by a high-speed carrier lane for themselves. Moreover, when having customers pick up plates for themselves, there is no other choice but to lower the speed of the high-speed carrier lane to some extent. This goes against the purpose stated in paragraph [0015] of Evidence Kou No. 8 to the effect that it is possible to keep the speed of a high-speed carrier lane high, with emphasis on work efficacy, compared to the speed of a crescent–type chain conveyor which is kept low for the purpose of making it easier for customers to pick up plates. Therefore, even if one of the technical problems to be solved by the Invention of Evidence Kou No. 8 is laborsaving, the "the

minimum number of staff members" mentioned in Evidence Kou No. 8 does not include zeroing the number of staff members. As customers are not supposed to pick up plates carried by a high-speed carrier lane in the Invention of Evidence Kou No. 8, there is no room to be motivated to apply the Invention of Evidence Kou No. 4, which is based on the premise that customers themselves would pick up the plates that are carried toward them. For the same reason, there is little need to make the distinction between ordered food and drinks (plates) and others clearer by differentiating the height of a high-speed carrier lane which carries ordered items and that of an ordinary crescent-type chain conveyor which carries other foodstuffs; therefore, there is no room to be motivated to adopt such constitution. Consequently, a person ordinarily skilled in the art was unable to easily arrive at the constitution pertaining to differences 3 and 4 at the time when the application was filed. The JPO decision is thus not erroneous in terms of the determination of whether a person ordinarily skilled in the art was able to easily arrive at the constitution.

(2) Evidence Kou No. 10 neither states nor suggests that customers who sit outside the carrier device send orders and that food and drinks ordered by customers are carried to the vicinity of the relevant customers using a different carrier route from the ordinary carrier route. Even if the inner carrier device (carrier means) of the device of the Invention of Evidence Kou No. 10, which is designed to improve the amount supplied, etc., can be used exclusively for carrying ordered food and drinks as a matter of logic, that is absolutely nothing more than a matter at the level of the possibility of choice of a constitution of the device. Taking into account that Evidence Kou No. 10 does not disclose any means of moving the carrier device to a voluntary position and stopping it there, it is not supposed that cooks receive orders from customers and carry the ordered food and drinks to the vicinity of the customers by placing them on a conveyer. Then, there is no room to be motivated to apply the Invention of Evidence Kou No. 4, etc. to the Invention of Evidence Kou No. 10. Therefore, the determination of inventive step in the JPO decision to this effect is not erroneous.