Date	September 8, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2010 (Gyo-Ke) 10404		

○ If a judgment rescinding a JPO decision, to the effect that a request for a trial for invalidation is to be dismissed, became final and binding, and then a JPO decision, to the effect that a correction designed to restrict the scope of claims is to be made, becomes final and binding, the binding force of the judgment rescinding the JPO decision, which was rendered on the premise of the gist of the invention based on the scope of claims before the correction, is interrupted and does not naturally extend to a subsequent JPO decision, though there is room to say that the findings and determinations in the scope that is not affected by said correction may be handled otherwise.

○ A case in which, regarding differences between the cited invention and the invention before the correction subject to a judgment rescinding a JPO decision to the effect that a request for a trial for invalidation is to be dismissed, the court ruled that the gist of the invention has been changed both substantively and formally by a JPO decision to the effect that the correction is to be made, and ruled that the binding force or any effect equivalent thereto of the judgment rescinding the JPO decision does not extend to a subsequent JPO decision

References:

Articles 128 and 181 of the Patent Act and Article 33 of the Administrative Case Litigation Act

Summary of the Judgment

The plaintiffs are the joint owners of the patent for the invention entitled "Device for controlling forming die in a punch press machine." Regarding the request for a trial for patent invalidation filed by the defendant, the JPO rendered the first decision to the effect that the request for a trial is to be dismissed; however, the first judgment rescinding said first decision of the JPO became final and binding and the JPO rendered the second decision to the effect that the patent is to be invalidated. As a JPO decision to the effect that the correction is to be made became final and binding during the period when the lawsuit to seek rescission of the JPO's second decision was pending, the second judgment rescinding the second decision became final and binding. However, the JPO rendered a decision to the effect that the patent is to be invalidated thereafter. The plaintiffs filed this case to seek rescission of said JPO Decision to the effect that the patented invention could be easily arrived at based on the cited invention.

The Intellectual Property High Court determined that the JPO Decision is erroneous

in determining differences and overlooks a prominent working-effect and that the invention could not be easily arrived at based on the cited invention. The defendant asserted that the findings and determinations of the first judgment concerning part of difference 2' and difference 1' between the invention before the first correction and the cited invention have a binding force or an effect equivalent thereto, and that the case should be handled as having been settled in order to contribute to the one-round settlement of disputes. However, the Intellectual Property High Court upheld the plaintiffs' claim, holding as follows.

"If a judgment is rendered to rescind a JPO decision to the effect that the patented invention could not have been easily made based on a specific cited invention, on the grounds that the patented invention could have been easily made, and the judgment becomes final and binding, assertions of the parties concerned to the effect that the patented invention could not have been easily made based on the cited invention and a JPO decision to the same effect are intercepted in the subsequent trial procedures. Consequently, the JPO rendered a decision to the effect that the patent is to be invalidated. However, if the judgment rescinding the JPO decision became final and binding, and then a JPO decision, to the effect that the correction designed to restrict the scope of claims is to be made, becomes final and binding, new requirements are added to the scope of claims after the restriction and the gist of the invention is changed (see Supreme Court; 1995 (Gyo-Tsu) 204; March 9, 1999; judgment of the Third Petty Bench; Minshu, Vol. 53, No. 3, at 303); therefore, the binding force of the judgment rescinding the JPO decision that was rendered on the premise of the gist of the invention based on the scope of claims before the correction is interrupted and does not naturally extend to a subsequent JPO decision, though there is room to say that the findings and determinations in the scope that is not affected by said correction may be made otherwise. …

Therefore, the binding force of the first judgment that was rendered on the premise of the gist of the invention based on the scope of claims before the first correction is interrupted and does not naturally extend to a subsequent JPO decision, though there is room to say that that the findings and determinations in the scope that is not affected by said correction may be made otherwise.

The defendant asserts that whether differences before the correction and those after the correction are the same should be determined not formally but substantively, … and asserts that the findings and determinations of the first judgment concerning part of difference 2' and difference 1' between the invention before the first correction and

the cited invention have a binding force or an effect equivalent thereto, and that the case should be handled as having been settled in order to contribute to the one-round settlement of disputes. However, in light of the fact that an invention is constituted through an organic and inseparable combination of some constituent features, it is not considered reasonable to examine further smaller elements of the differences. In addition, … regarding the aforementioned differences, the gist of the invention was changed both substantively and formally.

Consequently, the binding force or an effect equivalent thereto of the first judgment concerning the invention before the first correction does not extend to the JPO Decision."

Judgment rendered on September 8, 2011; the original was received on the same day; court clerk

2010 (Gyo-Ke) 10404 Case of Seeking Rescission of a JPO Decision

Date of conclusion of oral argument: August 25, 2011

Judgment

Plaintiff: Komatsu Ltd.

Plaintiff: Komatsu Industries Corp.

Defendant: Amada Co., Ltd.

Main Text

1. A JPO decision rendered for Invalidation Trial No. 2007-800014 on November 24, 2010 shall be rescinded.

2. The defendant shall bear the court costs.

Facts and reasons

No. 1 Claims

The same as paragraph 1 of the main text.

No. 2 Outline of the case

In the procedures mentioned in 1. below, the plaintiffs allege that there are grounds for rescission mentioned in 4. for the JPO decision in question (a summary of the reasons thereof is in 3.), which is described in the written JPO decision (copy) attached to this judgment. In said decision, the JPO invalidated the plaintiffs' patent for the invention of Claim 1 (mentioned in 2.) in response to a request for a trial for patent invalidation filed by the defendant in relation to said patent. Based on this allegation, the plaintiffs instituted this action to seek rescission of said JPO decision.

1. Developments in procedures that led to this action

(1) The plaintiffs are the joint owners of the patent right for Patent No. 3727445 (hereinafter referred to as the "Patent"; the application was filed on July 18, 1997; establishment of the patent right was registered on October 7, 2005), which is for an invention titled "device for controlling a forming die in a punch-press machine" (Exhibit Ko 16).

(2) On January 25, 2007, the defendant filed with the JPO a request for a trial for patent invalidation in relation to the Patent, and the request was kept pending as Invalidation Trial No. 2007-800014.

On August 27 of the same year, the JPO rendered a decision that dismissed the request for a trial (Exhibit Ko 19; hereinafter referred to as the "First JPO Decision").

On October 5 of the same year, the defendant instituted an action to seek rescission of the First JPO Decision (2007 (Gho-Ke) 10338). On June 30, 2008, the Intellectual Property High Court rendered a judgment rescinding the First JPO Decision (Exhibit Ko 7; hereinafter referred to as the "First Judgment"). The judgment became final and binding.

(3) On August 22, 2008, the plaintiffs filed a request for correction of the statements in Claim 1 in the scope of claims, etc. (hereinafter referred to as the "First Correction"). On October 24 of the same year, the JPO accepted the First Correction and rendered a judgment to the effect that the Patent was to be invalidated (Exhibit Ko 20; hereinafter referred to as the "Second JPO Decision").

On December 5 of the same year, the plaintiffs instituted an action to seek rescission of the Second JPO Decision (2008 (Gyo-ke) 10464).

(4) On February 24, 2009, the plaintiffs filed a request for a trial for correction of the statements in Claim 1 in the scope of claims, etc. (hereinafter referred to as the "Second Correction"; Correction Trial No. 2009-390020). In response, the JPO rendered a decision accepting the Second Correction (Exhibit Ko 17; hereinafter referred to as the "JPO Decision Accepting the Correction") on September 16 of the same year. The JPO Decision Accepting the Correction became final and binding. The invention after the Second Correction is referred to as the "Invention," and the corrected description (Exhibit Ko 18; Exhibit Ko 16 in relation to the drawings) is referred to as the "Description."

(5) On October 29, 2009, the Intellectual Property High Court rendered a judgment rescinding the Second JPO Decision (Exhibit Ko 21; hereinafter referred to as the "Second Judgment") in relation to the aforementioned case (2008 (Gyo-Ke) 10464). The judgment became final and binding.

(6) The JPO further examined Invalidation Trial No. 2007-800014, and rendered a decision to the effect that the Patent was to be invalidated (hereinafter referred to as the "JPO Decision") on November 24, 2010. On December 2 of the same year, the plaintiffs received the service of a certified copy of the JPO Decision.

2. Gist of the Invention

The gist of the Invention stated in Claim 1 after the Second Correction is as follows. Slashes in the text indicate line breaks in the original text.

A device for controlling a forming die in a punch-press machine with a punch and a die using a forming die, for which the amount that an object's form is processed can be changed depending on the amount of strokes, to process the form of an object, and can also do punch processing, which is characterized by having:

[a] material memory storage and thickness memory storage, each of which stores the material data and thickness data, respectively, of the object to be processed, and are read from a

processing program;

[b] die-information memory storage, which stores press-motion numbers corresponding to die numbers in the processing program;

[c] common data memory storage, which stores the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed, including the forming position of either said punch or said die;

[d] change data memory storage, which stores material and thickness correction data, which is for changing the forming position of either said punch or said die depending on the material and thickness of the object to be processed, for each press-motion number;

[e] press-drive data-generation part, which refers to a press-motion number corresponding to a mounted die from said die-information memory storage at the time of processing, based on said processing program, / generates the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed, including the forming position of either said punch or said die, from said common data memory storage, / corrects the forming position of either said punch or said die based on the setting value data corresponding to the material and thickness of the object to be processed, which is based on the referred material and thickness correction data for each press-motion number, and which was transferred from said change data memory storage, and generates drive data for driving the press shaft based on the detailed setting data of press motions, including the corrected forming position; and

[f] a press-drive control part, which controls the drive of the press based on the drive data generated at said press-drive data-generation part.

3. Gist of the reasons given in the JPO Decision

(1) The reasons given in the JPO Decision are in short as follows. As the Invention is one that a person ordinarily skilled in the art could have easily made based on the invention described in the cited document mentioned in A. below (hereinafter referred to as the "Cited Invention") and the art, etc. described in Well-Known Examples 1 to 3, the patent pertaining to the Invention was granted in violation of the provisions of Article 29, paragraph (2) of the Patent Act, and it should be invalidated pursuant to the provisions of Article 123, paragraph (1), item (ii) of said Act.

A. Cited document: Publication of Unexamined Patent Application No. 1991-294135 (Exhibit Ko 1)

B. Well-Known Example 1: Publication of Unexamined Patent Application No. 1993-282021 (Exhibit Ko 2)

C. Well-Known Example 2: Publication of Unexamined Patent Application No. 1992-367332 (Exhibit Ko 3)

D. Well-Known Example 3: Publication of Unexamined Patent Application No. 1992-270015 (Exhibit Ko 4)

(2) Incidentally, the Cited Invention and common features and differences between the Invention and the Cited Invention as found in the JPO Decision are as follows.

A. Cited Invention: In a device for controlling tools in a drilling machine that processes the drilling of a printed circuit board, a device for controlling tools in a drilling machine that executes a drilling command according to a tool's processing-condition data by using a means for reading a processing program, on which the processing tool's tool number is recorded, and memory storage that stores the processing-condition data corresponding to the tool number recorded on the processing program (including the number of rotations of the tool and the drilling speed) depending on the material of the printed circuit board and the number of layers of thereof, and based on the tool number read from the processing program at the time of processing based on the processing program

B. Common features: Being a device for controlling processing tools in a machine that processes an object with a processing tool, which has data memory storage for the detailed setting data of processing that corresponds to a processing tool number, a processing-drive data-generation part that reads the processing tool number from a processing program and generates drive data for driving the processing shaft based on the detailed setting data of processing that corresponds to the processing tool number at the time of processing based on the processing program, and a processing drive control part that controls the drive of processing based on the drive data generated at the processing-drive data-generation part

C. Difference 1: The processing machine and processing tool of the Invention are described as a "forming die in a punch-press machine with a punch and a die using a forming die, for which the amount that an object's form is processed can be changed depending on the amount of strokes, to process the form of an object, and can also do punch processing." On the other hand, those of the Cited Invention are described as "tools in a drilling machine that does the drilling processing of a printed circuit board."

D. Difference 2: The Invention has "[a] material memory storage and thickness memory storage, each of which stores the material data and thickness data, respectively, of an object to be processed, and are read from a processing program, [b] die-information memory storage, which stores press-motion numbers corresponding to die numbers in the processing program, [c] common data memory storage, which stores the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed, including the forming position of either said punch or said die, [d] change data memory storage, which stores material and thickness correction data, which is to change the forming position of either said punch or said die depending on the material and thickness of

the object to be processed, for each press-motion number," as well as "[e] press-drive data-generation part, which refers to a press-motion number corresponding to a mounted die from said die-information memory storage at the time of processing, based on said processing program, generates the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed including the forming position of either said punch or said die, from said common data memory storage, corrects the forming position of either said punch or said die based on the setting value data corresponding to the material and thickness of the object to be processed, which is based on the referred material and thickness correction data for each press-motion number, and which was transferred from said change data memory storage, and generates drive data for driving the press shaft based on the detailed setting data of press motions, including the corrected forming position, and [f] a press-drive control part, which controls the drive of the press based on the drive data generated at said press-drive data-generation part. On the other hand, it is unclear whether the Cited Invention has material memory storage and thickness memory storage. In addition, the Cited Invention neither has die-information memory storage, which stores press-motion numbers corresponding to die numbers, nor a separate way to store common data and change data as processing condition data, nor does it generate drive data from those data in reference to a press-motion number at the time of processing.

4. Grounds for rescission

An error in the determination concerning whether the Invention could have been easily conceived of by a person ordinarily skilled in the art

(1) An error in the determination concerning differences

(2) Overlooking of a prominent function and effect

No. 3 Allegations of the parties

(omitted)

No. 4 Court decision

1. Regarding the Invention

(1) Problems to be solved of the Invention

The Invention relates to a device for controlling a forming die in a punch-press machine. Conventional art had the following problems: [i] Die adjustment and confirmation by trial punching are necessary in each production process wherein the material and thickness of an object to be processed differ, and it is thus less productive; [ii] In a hydraulically driven punch-press machine in which the setting value of a press motion needs to be changed, it is possible to save the effort of die adjustment and confirmation by trial punching, but an

operator would be required to manually change press motions whenever the material or thickness of an object to be processed is changed in the mode of automatic/continuous operation while simultaneously using a material-supply device, etc.; [iii] One of the methods for avoiding the problem mentioned in [ii] above is to make multiple dies for the same form processing adjusted for each material and thickness in advance, and mount them on the punch-press machine to operate it; but in this case, it would be necessary to prepare multiple dies, which would lead to high production costs, and the turret and magazine parts to house the dies would be used more than necessary, making it impossible, in the case of continuous operation based on a production plan, for such parts to house all dies required therefor; it is thus necessary to lessen the planned amount of production in one continuous operation or shorten the hours of continuous operation; [iv] In conventional art that allows changes in the amount of press strokes within a certain appropriate range, multiple types of dies necessary for each forming processing need to be prepared, and the same problem as mentioned in [iii] above arises therein ([0003]).

(2) Means for solving the problems

The Invention was made to solve these problems. The purpose of the Invention is to provide a device for controlling a forming die in a punch-press machine that eliminates the need to make arrangements, such as die adjustment and exchange, even in the case of a change in the thickness or material of an object to be processed, and can do the desired form processing with a single die ([0004]).

The Invention uses a forming die for which the amount that an object's form is processed can be changed depending on the amount of strokes; and if automatic operation is conducted by using this forming die, the material data and thickness data described in a processing program are stored in the material memory storage and thickness memory storage, respectively. After this processing, the following processing motions are executed in order according to the command of the processing program. [i] First, the forming die is mounted on the press part according to the die exchange command of the processing program. Then, the relevant die number that is stored in the die-information memory storage is searched and referenced based on the die number data of the mounted forming die, and press-motion number data based on this die number is transferred to the common data memory storage and the change data memory storage. [ii] The common data memory storage transfers the detailed setting value of the relevant press-motion number to the press-drive data-generation part based on the transferred press-motion number data. The change data memory storage searches the relevant material and thickness data based on the transferred press-motion number data, and transfers the relevant setting vale data to the press-drive data-generation part according to the data stored in the material memory storage and data stored in the thickness memory storage. [iii]

Next, the press-drive data-generation part creates data for actually driving the press shaft based on the data transferred from the common data memory storage and the change data memory storage and the thickness data stored in said thickness memory storage. [iv] Then, in the press drive control part, the punch shaft or the die shaft is driven by a punching motion command based on the created data, and the required form processing is executed ([0007]).

The Invention is premised on the use of different forming dies. The dies differ in die information based on die numbers, i.e., type of die allocated to a die number (punching, forming, incusing, etc.) and shape thereof (expressing the shape into which an object to be processed is processed by the die, such as round, square, rectangle, burring, and upper half shear), as well as the long side (diameter), short side (pitch), radius (height), etc. which express the size into which the die processes an object. Therefore, the Invention can do various types of processing ([0017]).

(3) Functions and effects

The functions and effects of the Invention are as follows: [i] eliminates the need for making arrangements such as die adjustment and exchange, even when there is a change in the material or thickness of an object to be processed, making it possible to do the desired form processing with a single die, and thereby eliminating the need for die adjustment and confirmation by trial punching and making it possible to increase productivity even in the case of conducting productions in which the material and thickness of the object to be processed vary; [ii] eliminates the need for an operator to manually change press motions even when there is a change in the material or thickness of an object to be processed in the mode of automatic/continuous operation while simultaneously using a material-supply device, etc., thereby making it possible to realize an unmanned/less-manned operation and to increase productivity; [iii] differently from a conventional operation method wherein multiple dies used for the same forming processing are adjusted for each material and thickness in advance and are mounted on a punch-press machine, requires only one turret station for mounting a die on the punch-press machine, thereby making it possible to mount other dies on vacant stations, leading to a reduction of the number of times of arrangement and expectation of further increase in productivity; and [iv] reduces the number of dies used for the same form processing, thereby leading to expectation of a reduction of running costs ([0008]).

(4) Regarding the punch-press machine

As mentioned above, the Invention is one relating to a device for controlling a punch-press machine that does both form processing and punch processing. Machine tools, in a broad sense, include machines for plastic processing and those for removal processing. A punch-press machine is a machine for plastic processing. Incidentally, a press refers to a machine that does form processing with two or more paired tools (dies) by placing a material to be processed

between the tools and having the tools mutually approach in association with each other, and it is also designed to support by itself the reaction of the processing force that arises between the tools (Exhibit Ko 24).

(omitted)

3. Regarding a ground for rescission (an error in the determination concerning whether the Invention could have been easily conceived of by a person ordinarily skilled in the art)

(omitted)

(4) Whether the Invention could have been easily conceived of by a person ordinarily skilled in the art

As mentioned above, the Invention cannot be considered to be one that a person ordinarily skilled in the art could have easily made by applying well-known art, such as Well-Known Examples 1 to 3, to the Cited Invention.

4. Regarding the allegations of the defendant

(1) Regarding the binding force of a judgment rescinding a JPO decision

When a judgment rescinding a JPO decision becomes final and binding in an action to seek rescission of a JPO decision on a trial for patent invalidation, the trial examiner further examines the trial case pursuant to the provisions of Article 181, paragraph (5) of the Patent Act and renders a decision thereafter. However, as an action to seek rescission of a JPO decision is subject to the Administrative Case Litigation Act, the binding force of said judgment rescinding a JPO decision extends to a subsequent examination or JPO decision pursuant to the provisions of Article 33, paragraph (1) of said Act. This binding force extends to finding facts and making legal determinations that are necessary to elicit the main text of a judgment. Therefore, the trial examiner is not permitted to make any finding or determination that conflicts with the aforementioned findings and determinations in the judgment rescinding a JPO decision. Therefore, in the subsequent trial procedures, the trial examiner should not permit the parties to repeat the same allegations as they have made by stating that any of the findings and determinations in the reasons for the judgment, to which the binding force of the judgment rescinding a JPO decision extends, is erroneous or to give new proof to support the aforementioned allegations. A JPO decision rendered by the trial examiner according to the binding force of the judgment rescinding a JPO decision is legitimate to that extent, and it is naturally impossible to rule that such JPO decision is illegitimate, in a subsequent action to seek rescission of a JPO decision. As long as the trial examiner is thus subject to the binding

force of the main text of the judgment rescinding a JPO decision, including the reasons thereof, in a subsequent action to seek rescission of a JPO decision, the parties' act of criticizing a subsequent JPO decision rendered according to said binding force as illegitimate is nothing more than criticizing the determination in the judgment rescinding a JPO decision, which has become final and binding, as illegitimate in itself. Therefore, such criticism cannot serve as a ground for illegitimacy (rescission) of a subsequent JPO decision (see 1988 (Gyo-Tsu) 10, judgment of the Third Petty Bench of the Supreme Court of April 28, 1992, Minshu, Vol. 46, No. 4, at 245).

Therefore, with regard to a JPO decision to the effect that the patented invention is not considered to be one that could have been easily made by a person ordinarily skilled in the art based on a specific cited document, if a judgment is rendered to rescind it on the grounds that the patented invention could have been easily made by a person ordinarily skilled in the art and said judgment becomes final and binding, the parties' allegation and a JPO decision to the effect that the patented invention is not considered to be one that could have been easily made by a person ordinarily skilled in the art based on the cited document are intercepted in the subsequent trial procedures, which results in the rendering of a JPO decision invalidating the patent.

However, if a judgment rescinding a JPO decision becomes final and binding and then a JPO decision that accepts correction designed to restrict the scope of claims becomes final and binding, new requirements are added to the scope of claims after the restriction and the gist of the invention is changed (see 1995 (Gyo-Tsu) 204, judgment of the Third Petty Bench of the Supreme Court of March 9, 1999, Minshu, Vol. 53, No. 3, at 303). Therefore, the binding force of the judgment rescinding the JPO decision that was rendered on the premise of the gist of the invention, based on the scope of claims before the correction, is interrupted and cannot be considered to naturally extend to a subsequent JPO decision, though there is room to say that the findings and determinations in the scope that is not affected by said correction may be made otherwise.

(2) Developments in relation to this case

A. First Judgment

(A) The First Judgment rescinded the First JPO Decision to the effect that the request for a trial for patent invalidation pertaining to Claim 1 before the First Correction (as indicated in Attachment 1) is to be dismissed.

(B) In said judgment, differences between the invention before said correction and the Cited Invention were found as follows.

Difference 1': The invention before the First Correction does form processing by using a punch-press machine with a forming die for which the amount of processing can be changed

depending on the amount of strokes. On the other hand, the Cited Invention does drilling processing by using a drilling machine with tools.

Difference 2': The invention before the First Correction has [a][i] material memory storage and thickness memory storage, each of which stores the material data and thickness data, respectively, of an object to be processed that are read from a processing program, [ii] die-information memory storage, which stores press-motion numbers corresponding to die numbers in the processing program, [iii] common data memory storage, which stores the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed, and [iv] change data memory storage, which stores the detailed setting data of press motion for each press-motion number that is changed depending on the material and thickness of the object to be processed, and [b] refers to a press-motion number corresponding to a mounted die from the die-information memory storage at the time of processing based on the processing program, and thereby generates the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed from said common data memory storage, [c] generates the detailed setting data of press motions that are changed depending on the material and thickness of the object to be processed from said change data memory storage, and [d] generates drive data for driving the press shaft based on these detailed setting data. On the other hand, it is unclear whether the Cited Invention has material memory storage and thickness memory storage. In addition, the Cited Invention neither has die-information memory storage, which stores press-motion numbers corresponding to die numbers, nor a separate way to store common data and change data as processing condition data, nor does it generate drive data from those data at the time of processing.

(C) In the First Judgment, the court determined as follows: [i] a person ordinarily skilled in the art could have easily conceived of a structure that has "die-information memory storage" pertaining to Difference 2' based on the Cited Invention; [ii] regarding Difference 2', a person ordinarily skilled in the art can easily conceive of a structure that "stores common data and change data in separate memory storages as data for processing and generates drive data by changing the prescribed data in common data depending on the material and thickness of an object to be processed at the time of processing based on a processing program"; and [iii] there is no special difficulty in relation to Difference 1'.

B. The Correction

The JPO Decision Accepting the Correction designed to restrict the scope of claims became final and binding while the action to seek rescission of the Second JPO Decision to the effect that the Patent is to be invalidated was pending, and the court rendered the Second Judgment to the effect that the Second JPO Decision is to be rescinded.

The invention before the First Correction subject to the First Judgment was corrected as described in No. 2, 2 above through the JPO Decision Accepting the Correction. The corrected parts are underlined in Attachment 2. Thereby, the gist of the invention was changed, and differences between the Invention and the Cited Invention became as Differences 1 and 2 mentioned in No. 2, 3 above. Therefore, the binding force of the First Judgment that was rendered on the premise of the gist of the invention based on the scope of claims before the First Correction has been interrupted and cannot be considered to naturally extend to a subsequent JPO decision, though there is room to say that the findings and determinations in the scope that are not affected by said correction may be made otherwise. This is also clearly stated in the Second Judgment.

(3) Regarding the allegations of the defendant

A. The defendant alleges that whether differences before the correction and those after the correction are the same should be determined not formally but substantially. The defendant alleges that the findings and determinations concerning the following in the First Judgment have a binding force or an effect equivalent thereto: [i] the part relating to the "die information memory part" in Difference 2', [ii] the part relating to the statement "stores common data and change data in separate memory storages as data for processing and generates drive data by changing the prescribed data in common data depending on the material and thickness of an object to be processed at the time of processing based on a processing program" in Difference 2', and [iii] Difference 1'. The defendant also alleges that the case should be handled as having been settled in order to contribute to one-round settlement of disputes.

B. However, in light of the fact that an invention is constituted through an organic and inseparable combination of some constituent features, it is not considered reasonable to examine even smaller elements of differences.

In addition, regarding [ii] above, the correction designed to make clear that the "forming position of either the punch or the die" is changed and corrected, i.e., the Invention controls multiple forming dies, that is, the punch and the die, changes and corrects the forming position of not only the punch but also the die, and prescribes the relative control timing of the punch and the die as a control parameter, was made through the JPO Decision Accepting the Correction, and the gist of the Invention was changed both substantially and formally.

Furthermore, regarding [iii] above, in the same manner as [ii] above, the correction designed to clearly indicate that the Invention controls a punch-press machine with a punch and a die was made through the JPO Decision Accepting the Correction, and the gist of the Invention was changed both substantially and formally.

C. Consequently, the binding force or an effect equivalent thereto of the First Judgment concerning the invention before the First Correction does not extend to the JPO Decision.

5. Conclusion

On these grounds, the JPO Decision should be rescinded.

Intellectual Property High Court, Fourth Division

Presiding judge: TAKIZAWA Takaomi

Judge: TAKABE Makiko

Judge: SAITO Iwao

(Attachment 1)

A device for controlling a forming die in a punch-press machine, which uses a forming die, for which the amount that an object's form is processed can be changed depending on the amount of strokes, to process the form of an object, which is characterized by having:

[a] material memory storage and thickness memory storage, each of which stores the material data and thickness data, respectively, of the object to be processed, and are read from a processing program;

[b] die-information memory storage, which stores press-motion numbers corresponding to die numbers in the processing program;

[c] common data memory storage, which stores the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed;

[d] change data memory storage, which stores the detailed setting data of press motion for each press-motion number that is changed depending on the material and thickness of the object to be processed;

[e] press-drive data-generation part, which refers to a press-motion number corresponding to a mounted die from said die-information memory storage at the time of processing, based on said processing program, generates the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed from said common data memory storage, generates the detailed setting data of press motions that are changed depending on the material and thickness of the object to be processed from said change data memory storage, and generates drive data for driving the press shaft based on these detailed setting data; and

[f] a press-drive control part, which controls the drive of the press based on the drive data generated at said press-drive data-generation part.

(Attachment 2)

A device for controlling a forming die in a punch-press machine with a punch and a die, which uses a forming die, for which the amount that an object's form is processed can be changed depending on the amount of strokes, to process the form of an object, and can also do punch processing, which is characterized by having

[a] material memory storage and thickness memory storage, each of which stores the material data and thickness data, respectively, of the object to be processed, and are read from a processing program;

[b] die-information memory storage, which stores press-motion numbers corresponding to die numbers in the processing program;

[c] common data memory storage, which stores the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed, including the forming position of either said punch or said die;

[d] change data memory storage, which stores material and thickness correction data, which is for changing the forming position of either said punch or said die depending on the material and thickness of the object to be processed, for each press-motion number;

[e] press-drive data-generation part, which refers to a press-motion number corresponding to a mounted die from said die-information memory storage at the time of processing based on said processing program, / generates the detailed setting data of press motion for each press-motion number that is unrelated to the material and thickness of the object to be processed, including the forming position of either said punch or said die, from said common data memory storage, / corrects the forming position of either said punch or said die based on the setting value data corresponding to the material and thickness of the object to be processed, which is based on the referred material and thickness correction data for each press-motion number, and which was transferred from said change data memory storage, and generates drive data for driving the press shaft based on the detailed setting data of press motions, including the corrected forming position; and

[f] a press-drive control part, which controls the drive of the press based on the drive data generated at said press-drive data-generation part.