Date	January 31, 2011	Court	Intellectual Property High Court, Third Division
Case number	2010 (Gyo-Ke) 10075		
– A case in which, with regard to a JPO decision that invalidated a patent for an invention titled "exhaust fan filter and its manufacturing method," the court explained the approach for determining whether a person ordinarily skilled in the art could have easily arrived at the patented invention.			

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

Numbers of related rights, etc.: Invalidation Trial No. 2009-800070, Patent No. 3561899

Summary of the Judgment

1. In this case, the court rescinded a JPO decision that invalidated a patent for an invention titled "exhaust fan filter and its manufacturing method" in response to a request for a trial for patent invalidation.

In this judgment, the court explained as follows with regard to the approach for determining whether a person ordinarily skilled in the art could have easily arrived at the patented invention.

Since the issue of whether or not a person ordinarily skilled in the art could have easily arrived at the relevant invention based on an invention that falls under any of the items of Article 29, paragraph (1) of the Patent Act needs to be determined in a comprehensive manner, the mere fact that "it was easy to adopt a specific structure to solve the problem" is insufficient for finding that the invention could have been easily made, and it may be necessary to find that "it was easy to set the problem to be solved." In other words, if "it was easy to adopt a specific structure to solve the problem," but "uniqueness can be found in the setting or viewpoint of the problem to be solved," it cannot be necessarily found that the invention could have been easily arrived at by a person ordinarily skilled in the art. In this respect, since the determination of whether or not "it was easy to set the problem to be solved" would be based on the determination of whether or not the idea in itself could have been easily arrived at by a person ordinarily skilled in the art, it is easily affected by ex-post facto and subjective decisions. In order to prevent such decisions from being made, it is essential to have a logical explanation based on evidence. In addition, as the basis for such determination, it is extremely important to accurately identify the problem to be solved that was intended by the invention in order to reach a conclusion on the issue of whether or not the invention could have been easily arrived at by a person ordinarily skilled in the art.

2. Having explained as above, the court made the following findings and determination, and rescinded the JPO decision.

Invention 1 aims to solve the problem that "in an exhaust fan filter comprised of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material." The solution provided by Invention 1 is "to use a water-based emulsion adhesive that contains film-forming polymers, in manufacturing exhaust fan filters so that the metal filter frame and the non-woven fabric filter material, which are tightly glued together under ordinary circumstances, could be easily separated if they are immersed in water, since water decreases the adhesive power of the adhesive." In contrast, with regard to the cited invention, there is no statement or disclosure, etc. relevant to the problem to be solved that was intended by Invention 1 and the solution thereof, but rather the cited invention is described as an invention made based on the premise that the filter would be disposed of without being separated from the filter cover.

It cannot be found that, in the JPO Decision, the JPO presented an explanation based on an evidence-based objective and reasonable logic with respect to the findings that a person ordinarily skilled in the art could have easily arrived at the fact that the setting of the problem to be solved by Invention 1 and the solution thereof would be achieved.

The JPO Decision contains an error because the JPO failed to accurately identify the problem to be solved by the Invention and, based on that error, found that the Inventions could have been easily arrived at by a person ordinarily skilled in the art.

Judgment rendered on January 31, 2011
2010 (Gyo-Ke) 10075 Case of Seeking Rescission of a JPO Decision
Date of conclusion of oral argument: November 30, 2010

Judgment

Plaintiff: Nippon Nontekkusu KK

Plaintiff: Nippon Foil Mfg. Co., Ltd.

Counsel patent attorney of the abovementioned two plaintiffs: OKUMURA Shigeki

Defendant: Toyo Aluminium Ekco Products Co., Ltd.

Counsel patent attorney: FUJII Atsushi

Counsel attorney: HIRANO Kazuhiro

Counsel patent attorney: YAMASAKI Hirofumi

Main text

1. The trial decision rendered by the JPO on January 25, 2010 with respect to the Invalidation Trial Case No. 2009-800070 shall be rescinded.
2. The court costs shall be borne by the defendant.

Facts and reasons

No. 1 Claims

The same as those mentioned in the main text.

No. 2 Undisputed facts between the parties

1. Background, etc. to the procedures at the JPO

The plaintiffs hold a patent for an invention titled "exhaust fan filter and its production process" (Date of application: July 10, 2000; Date of registration: June 11, 2004; hereinafter referred to as the "Patent").

On March 30, 2009, the defendant filed a request for a trial for patent invalidation with respect to the Patent (Invalidation Trial Case No. 2009-800070). In response to this, on January 25, 2010, the JPO, after completing the oral proceedings on November 17, 2009, rendered a trial decision to the effect that "the patent granted for the inventions stated in Claims 1 through 4 of the Patent shall be invalidated" (hereinafter referred to as the "JPO Decision"), and on February 4, 2010, the transcript of the JPO Decision was served to the plaintiffs.

2. Scope of claims

The statements in Claims 1 through 4, which are among the scope of claims contained in the description of the Patent (Exhibit Ko No. 37; hereinafter referred to as the "Description"), are as follows (hereinafter the inventions stated in Claims 1 through 4 shall be referred to as "Invention 1" through "Invention 4," respectively, and in some cases, such inventions may be collectively referred to as the "Inventions").

[Claim 1]

An exhaust fan filter comprising a metal filter frame and non-woven fabric filter material that is adhered to the metal filter frame by covering the opening in the metal filter frame, which is characterized by adhering said metal filter frame and non-woven fabric filter material with a water-based emulsion adhesive that contains film-forming polymers.

[Claim 2]

An exhaust fan filter stated in Claim 1 wherein the glass transition point of the film-forming polymer is -10°C to +30°C.

[Claim 3]

A method for manufacturing an exhaust fan filter in which a non-woven fabric filter material is adhered to a metal filter frame by covering the opening provided in said metal filter frame, which is characterized by comprising the step of applying a water-based emulsion adhesive, that contains film-forming polymers, on the surface of the opening edge part and/or crosspiece part provided in said metal filter frame and then depressing the non-woven fabric filter material to the coated surface and applying heat thereto, thereby adhering the non-woven fabric filter material to the opening edge part and/or crosspiece part.

[Claim 4]

A manufacturing method for an exhaust fan filter stated in Claim 3 wherein the glass transition point of the film-forming polymer is -10°C to +30°.

3. Reasons of the JPO Decision

(1) The reasons for the JPO Decision are as mentioned in the written copy attached to the judgment. In short, the JPO first made the following findings with respect to Inventions 1 through 4.

A. Invention 1 could have been easily made by a person ordinarily skilled in the art based on the invention stated in Exhibit Ko No. 1-1 (the microfilm of Utility Model Application No. 1983-136320; the contents of the invention found in the JPO Decision are the same as those of Invention A mentioned in (2) below; hereinafter referred to as "Invention A"), the statements in Exhibit Ko No. 2 (Publication of Unexamined Patent Application No. 1995-188632) and the well-known arts stated in Exhibits Ko No. 10 (Publication of Unexamined Patent Application No. 1999-129645), No. 11 (Publication of Unexamined Patent Application No. 1976-48408) and No. 24 (Publication of Unexamined Patent Application 2000-126523).

B. Invention 2 could have been easily made by a person ordinarily skilled in the art based on Invention A, the statements in Exhibit Ko No. 2 and the well-known arts stated

in Exhibits Ko No. 4 (Publication of Unexamined Patent Application No. 1989-152056), No. 10, No. 11 and No. 24

C. Invention 3 could have been easily made by a person ordinarily skilled in the art based on the invention stated in Exhibit Ko No. 1-1 (the contents of said invention found in the JPO Decision are the same as those of Invention B stated in (2) below; hereinafter referred to as "Invention B"), the statements in Exhibit Ko No. 2, and the well-known arts stated in Exhibits Ko No. 10, No. 11, No. 16 (Publication of Unexamined Patent Application No. 1998-245537), No. 24 and No. 29 ("Saishin Laminēto Kakō Binran (Latest Lamination Handbook)," June 30, 1989, Converting Technical Institute at 75 through 92).

D. Invention 4 could have been easily made by a person ordinarily skilled in the art based on Invention B, statements in Exhibit Ko No. 2 and the well-known arts stated in Exhibits Ko No. 4, No. 10, No. 11, No. 16, No. 24 and No. 29.

Based on these findings, the JPO found that the Patent falls under the requirement prescribed in Article 29, paragraph (2) of the Patent Act and thus should be invalidated pursuant to the provisions of Article 123, paragraph (1), item (ii) of said Act.

(2) The contents of Invention A and Invention B found in the JPO Decision are as follows.

Invention A

"A filter cover for a range hood comprising a flange part of a filter cover that is integrally formed by a metal foil that serves as the seat to mount the filter cover on the circumferential edge of the range hood's opening, a rise wall on the inner circumferential edge of the flange part, a grid part on the lower end of the rise wall, a flame-retardant or flame-resistant non-woven fabric filter attached to the grid part with glue, and a magnet to stick onto the range hood that is attached to the flange part."

Invention B

"A method for manufacturing a filter cover for a range hood wherein the cover, which has a rise wall on the inner circumferential edge of the flange part of the filter cover that serves as the seat to mount the filter cover on the circumferential edge of the range hood's opening, and a grid part on the lower end of the rise wall, is integrally formed by a metal foil, and a magnet that sticks to the range hood is attached to the flange part, and wherein a flame-retardant or flame-resistant non-woven fabric filter is adhered to the grid part by applying glue to the inner side of the grid part in the filter cover for range hood."

(3) The common features and differences found between Invention 1 and Invention A and those between Invention 3 and Invention B in the JPO Decision are as follows (with

respect to Inventions 2 and 4, the statements shall be omitted)

A. Common features between Invention 1 and Invention A

An exhaust fan filter comprising a metal filter frame and a non-woven fabric filter material that is adhered to said metal filter frame by covering the opening in the metal filter frame, wherein said metal filter frame and non-woven fabric filter material are adhered together with glue.

B. Differences between Invention 1 and Invention A (Difference A)

With respect to the adhesive, while a water-based emulsion adhesive that contains film-forming polymers is used in Invention 1, no such adhesive is used in Invention A.

C. Common features between Invention 3 and Invention B

A method for manufacturing an exhaust fan filter by adhering the non-woven fabric filter material to the metal filter frame by covering the opening provided in the metal filter frame, wherein glue is applied to the surface of the opening edge part and/or the crosspiece part provided in said metal filter frame and the non-woven fabric filter material is adhered to the opening edge part and/or the crosspiece part.

D. Differences between Invention 3 and Invention B (Difference C)

In Invention 3, the non-woven fabric filter material and the metal filter frame are adhered together by applying a water-based emulsion adhesive that contains film-forming polymers and then depressing the non-woven fabric filter material to the coated surface and applying heat thereto, while in Invention B, there is no step of using such adhesive or adhering the non-woven fabric filter material to the coated surface by depressing the non-woven fabric filter material and applying heat thereto.

No. 3 Allegations of the parties

1. The plaintiffs' allegations concerning the grounds for rescission

The JPO Decision contains the following errors: [i] errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously identifying the Inventions and the well-known arts stated in Exhibits Ko No. 10, No. 11 and No. 24 (ground for rescission 1); [ii] errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously finding the problems to be solved by the Inventions and well-known arts (Exhibits Ko No. 18, No. 19 and No. 32 (Exhibit Otsu No. 2 used in the trial)) (ground for rescission 2); and [iii] errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously identifying the well-known arts stated in Exhibit Ko No. 2 (ground for rescission 3).

(omitted)

No. 4 Court decision

The court found that the ground for rescission 2 (errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously identifying the problems to be solved by the Inventions and well-known arts (Exhibits Ko No. 18, No. 19 and No. 32)) alleged by the plaintiffs is well-grounded and, thus, the JPO Decision should be rescinded for violating Article 29, paragraph (2) of the Patent Act, without the need to examine other issues.

1. Introduction

(1) The determination of whether or not the Inventions could have been easily conceived of by a person ordinarily skilled in the art and the problem to be solved by the Inventions

With respect to the determination of whether or not the relevant invention could have been easily conceived of by a person ordinarily skilled in the art based on an invention that falls under any of the items of Article 29, paragraph (1) of the Patent Act (hereinafter this invention shall be referred to as the "cited invention"), the objective and reasonable method to make such determination should be to first examine an invention that is state of the art and is most similar to the relevant invention (the "primarily cited invention") and then take into consideration other cited invention(s) (the "secondarily cited invention") along with the primarily cited invention, and thereby determine whether or not a person ordinarily skilled in the art could have easily conceived of the relevant invention's structure that is different from that of the primarily cited invention (the characteristic part of said invention). The relevant invention's structure that is different from that of the primarily cited invention (the structural characteristics of said invention) consists of an addition or change of a new technical structure in order to solve a problem that could not be solved by the state of the art. Thus, in determining whether or not the relevant invention could have been easily conceived of by a person ordinarily skilled in the art, it is necessary and essential to accurately identify the problem to be solved (function and effect, etc.) that was intended by the invention and to comprehensively determine in relation thereto the issues of "whether or not it was easy to establish the problem to be solved" and "whether or not it was easy to adopt a specific structure to solve the problem." As stated above, since the issue of whether or not the invention could have been easily conceived of by a person ordinarily skilled in the art shall be determined in a comprehensive manner, the mere fact that "it was easy to adopt a specific structure to solve the problem" is insufficient for finding that the invention could have been easily made, and it may be necessary to find that "it was easy

to establish the problem to be solved." In other words, even if "it was easy to adopt a specific structure to solve the problem," "in a case where uniqueness can be found in the establishment or viewpoint of the problem to be solved" (for example, in a case where a problem that would not be generally conceived of is established), it cannot be necessarily found that the invention could have been easily conceived of by a person ordinarily skilled in the art. On the other hand, since the determination of whether or not "it was easy to establish the problem to be solved" would be based on the determination of whether or not the idea could have been easily conceived of by a person ordinarily skilled in the art, it is easily affected by ex-post facto and subjective decisions. In order to prevent such decisions from being made, it is essential to have a logical explanation based on evidence. In addition, as the basis for such determination, it is extremely important to accurately identify the problem to be solved that was intended by the invention in order to reach a conclusion on the issue of whether or not the invention could have been easily conceived of by a person ordinarily skilled in the art.

Based on the abovementioned standpoints, the court shall examine the appropriateness of the determination made in the JPO Decision with respect to the issue of whether or not the Inventions could have been easily conceived of by a person ordinarily skilled in the art.

(2) Regarding the contents of the reasons of the JPO Decision

The logic used in the JPO Decision in determining that the Inventions could have been easily conceived of by a person ordinarily skilled in the art is as follows.

A. Inventions 1 and 2

The JPO found that the common features of Invention 1 and Invention A are that they are both "an exhaust fan filter comprising a metal filter frame and a non-woven fabric filter material that is adhered to the metal filter frame by covering the opening in the metal filter frame, wherein the metal filter frame and non-woven fabric filter material are adhered together with glue." In addition, the JPO found that the two inventions differ in the point that, with respect to the adhesive, while a water-based emulsion adhesive that contains film-forming polymers is used in Invention 1, no such adhesive is used in Invention A.

Next, the JPO stated the following logic in concluding that a person ordinarily skilled in the art could have easily conceived of the structure related to the abovementioned difference. [i] According to the statements in paragraphs [0003] through [0006] in the Description, the problem to be solved by Invention 1 is "to enable (easy) separation and disposal of the metal filter frame and non-woven fabric filter material after the exhaust fan filter has been used." In addition, it was a well-known

technical problem "to enable (easy) separation and disposal of the metal filter frame and non-woven fabric filter material after the exhaust fan filter had been used" (Exhibits Ko No. 18, No. 19 and No. 32); [ii] Exhibit Ko No. 2 mentions an adhesive compound whose component dissolves or swells and separates by an aqueous solution and states that an adhesive compound has a commonality with glue if it is regarded as a bond that bonds multiple substances (Exhibits Ko No. 27 and No. 34); and thus [iii] a person ordinarily skilled in the art who read Exhibit Ko No. 2 would have the motivation to select an adhesive compound whose component dissolves or swells and separates in order to solve the problem mentioned above.

Based on this logic, the JPO concluded that, in order to solve the problem mentioned above, a person ordinarily skilled in the art could have used, without any difficulty, "a water-based emulsion adhesive that contains film-forming polymers" as the adhesive to be used in Invention A in order to easily separate the metal filter frame and non-woven fabric filter material at the time of disposal of the exhaust fan filter.

With respect to Invention 2, the JPO found that the same determinations may be made as in the case of Invention 1, since Invention 2 is made by adding to Invention 1 the matters to specify the invention that "the glass transition point of the film-forming polymer is -10°C to +30°C."

B. Inventions 3 and 4

With respect to Invention 3 and Invention B, the JPO found that they have the common feature in that they are both "a method for manufacturing an exhaust fan filter by adhering the non-woven fabric filter material to the metal filter frame by covering the opening provided in the metal filter frame, wherein glue is applied to the surface of the opening edge part and/or the crosspiece part provided in the metal filter frame, and the non-woven fabric filter material is adhered to the opening edge part and/or the crosspiece part." Meanwhile, the JPO found that the two inventions differ in that, "in Invention 3, non-woven fabric filter material is adhered to the metal filter frame by applying a water-based emulsion adhesive that contains film-forming polymers and depressing the non-woven fabric filter material to said coated surface and applying heat thereto, while in Invention B, there is no such step of using the adhesive or adhering the non-woven fabric filter material to the metal filter frame by depressing the non-woven fabric filter material and applying heat thereto." Next, the JPO stated the following logic in concluding that a person ordinarily skilled in the art could have easily conceived of the abovementioned difference. With respect to the difference, the JPO found that, as with the case mentioned in A. above, a person ordinarily skilled in the art could have used, without any difficulty, "a water-based emulsion adhesive that contains

film-forming polymers" as the adhesive in order to easily separate the metal filter frame and non-woven fabric filter material at the time of disposal of the exhaust fan filter in order to solve the well-known problem of enabling easy "separation and disposal of the metal filter frame and non-woven fabric filter material after the use of the exhaust fan filter." The JPO further found that a person ordinarily skilled in the art could have also applied such adhesive and depressed the non-woven fabric filter material to the coated surface and applied heat thereto without any difficulty. Based on these findings, the JPO determined that Invention 3 could have been easily made by a person ordinarily skilled in the art based on Invention B, statements in Exhibit Ko No. 2 and the well-known arts stated in Exhibits Ko No. 10, No. 11, No. 16, No. 24 and No. 29.

With respect to Invention 4, the JPO found that the same determinations may be made as in the case of Invention 3, since Invention 4 is made by adding to Invention 3 the matters to specify the invention that "the glass transition point of the film-forming polymer is -10°C to +30°C."

2. Regarding the appropriateness of the JPO Decision

There are errors in the JPO Decision in that it failed to accurately identify the problem to be solved by the Inventions. Moreover, the JPO erroneously concluded that the Inventions could have been easily conceived of by a person ordinarily skilled in the art based on an erroneously identified problem to be solved. The reasons are as follows.

(1) Fact finding

A. Statements in the Description

(omitted)

(2) Determination

A. As found above, the objective of Invention 1 is to enable easy separation of the metal filter frame and non-woven fabric filter material by using, in adhering the metal filter frame and non-woven fabric filter material, a glue that is capable of achieving strong adhesive bonding under ordinary circumstances but that has the predisposition to decrease the adhesive power between metal and non-woven fabric when water is applied and by immersing the used exhaust fan filter with the aim of solving the following defects found in conventional exhaust fan filters: conventional exhaust fan filters were manufactured by a method wherein the metal filter frame is created by providing a thermosensitive adhesive film on the whole surface of one side of the aluminum foil, applying to such film molding such as bulging or protruding and providing an opening by punching, and the non-woven fabric filter material is adhered

to the metal filter frame in a manner covering the opening of the metal filter frame and by depressing such material and applying heat thereto and melting and solidifying the thermosensitive adhesive. Accordingly, the adhesive bonding between the metal filter frame and non-woven fabric filter material was too strong to separate them without tearing the non-woven fabric filter material.

As such, it may be found that Invention 1 aims to solve the problem that "in an exhaust fan filter comprised of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material." The solution provided by Invention 1 is "to use a water-based emulsion adhesive that contains film-forming polymers, in manufacturing exhaust fan filters so that the metal filter frame and the non-woven fabric filter, which are tightly glued together under ordinary circumstances, could be easily separated if they are immersed in water, since water decreases the adhesive power of the adhesive."

In contrast, as found above, Invention A cited by the JPO from a document is "a filter cover for a range hood comprising a flange part of the filter cover integrally formed by a metal foil that serves as the seat to mount the filter cover on the circumferential edge of the range hood’s opening, a rise wall on the inner circumferential edge of the flange part, a grid part on the lower end of the rise wall, a flame-retardant or flame-resistant non-woven fabric filter attached to said grid part with glue and a magnet for sticking onto the range hood attached to said flange part." It is different from Invention 1, which provides a solution for the problem that "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material." Exhibit Ko No. 1 does not contain any statements or disclosure, etc. relevant to the problem to be solved that was intended by Invention 1 and the solution thereof but rather states that Invention A is based on the premise that the filter would be disposed of without being separated from the filter cover.

B. In this regard, the JPO first found that the problem to "enable (easy) separation and disposal of the metal filter frame and non-woven fabric filter material after the use of the exhaust fan filter" was well-known based on the references stated in Exhibits Ko No. 18, No. 19 and No. 32 mentioned above, and, therefore, a person ordinarily skilled in the art who read Exhibit Ko No. 2 could have easily selected glue that had a component

that dissolved or swelled in order to solve the abovementioned problem.

However, the JPO Decision is unreasonable in that it failed to show any reasonable grounds for the logic used in concluding that a person ordinarily skilled in the art could have easily conceived of the structure related to the difference between Invention 1 and the cited invention (Invention A) based on the finding that the abovementioned problem is well-known.

Moreover, even if the statements in Exhibits Ko No. 18, No. 19 and No. 32 are examined in detail, none of the statements suggest the same problem to be solved as that of Invention 1, i.e., "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material."

More specifically, it can be said that [i] although Exhibits Ko No. 18, No. 19 and No. 32 show an art that enables easy disposal of the metal filter frame and filter material after the exhaust fan filter has been used, all of them show an art different from that of the invention, which is based on the premise that the metal filter frame and filter material are "adhered together with glue"; that [ii] the filter for range hoods stated in Exhibit Ko No. 18 is not "an exhaust fan filter" comprising a metal filter frame and a non-woven fabric filter "that are tightly glued together," but instead is made with an objective "to simplify the attachment to the metal mesh filter by replacing the metal foil with a moldable fiber non-woven fabric and to enable easy disposal of the product as a whole as domestic waste without separating each component at the time of disposal after the use"; it is different from Invention 1 in terms of the problem to be solved and the solution thereof; and that [iii] Exhibit Ko No. 19 states an invention that aims to provide an exhaust fan cover that consists of an exhaust fan cover frame body made of metal foil and a filter using metal fiber, which eliminates the need to separate the filter and exhaust fan cover frame body and hardly poses a problem, even if the product as a whole is disposed of as waste, and thus excels in workability upon disposal as waste and can be easily recycled; it is different from Invention 1 in terms of the means to solve the problem. In other words, while the objective of Invention 1 is to enable easy separation of the filter frame and filter, the inventions stated in Exhibits Ko No. 18 and No. 19 are intended to improve working efficiency by eliminating any problems at the time of disposal of the product as a whole as waste; Invention 1 has established a completely different problem to be solved and the solution thereof, and thus such Exhibits cannot be found to have suggested an art that enables a person ordinarily skilled in the art to

easily conceive of the structure of Invention 1, which is different from those of such inventions.

C. As found above, Exhibits Ko No. 18, No. 19 and No. 32 contain no suggestions concerning the problem to be solved and the solution thereof with respect to the structure related to the difference between Invention 1 and Invention A (Difference A), i.e., "with respect to the adhesive, while a water-based emulsion adhesive that contains film-forming polymers is used in Invention 1, no such adhesive is used in Invention A."

Accordingly, it cannot be found that, in the JPO Decision, the JPO presented an explanation based on an evidence-based objective and reasonable logic with respect to the findings that a person ordinarily skilled in the art could have easily conceived of the fact that the following problem to be solved established in Invention 1 and the solution thereof would be achieved: "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use."

As stated above, Exhibit Ko No. 2 states an invention that [i] relates to a water-soluble adhesive composition that may be used as an adhesive compound of a masking tape or label that is capable of dissolving or swelling and separating by an aqueous solution and the manufacturing method of such composition; that [ii] intends to solve the problem of protective tapes used in the field of electronic materials and chip-fixing adhesive tapes used in mechanically polishing ceramic chips that adhesive component residue is required to be water-washable from the perspective of conservation of the global environment and that they are also required to have high removability and strong adhesiveness to eliminate easy separation; and that [iii] solves the abovementioned problem by using an aqueous adhesive composition characterized by containing a polymer that contains as the essential monomer component monomer produced by esterifying (meth)acrylate having terminal OH groups and that is neutralized with phosphoric acid.

However, as stated above, as long as the references stated in Exhibits Ko No. 18, No. 19 and No. 32, etc. have not mentioned to establish the problem that "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use," it cannot be said that a person ordinarily skilled in the art could have easily conceived of the structure of Invention 1, which is different from that of Invention A, by applying the invention stated in Exhibit Ko No. 2 to Invention A. More specifically, it cannot be

found that the statements in Exhibit Ko No. 2 suggest that a person ordinarily skilled in the art may conceive of the characteristic feature of Invention 1 ("to use a water-based emulsion adhesive that contains film-forming polymers (that tightly glues the metal filter frame and non-woven fabric filter material under ordinary circumstances but whose adhesive power decreases when it is immersed in water and thereby enables easy separation of the metal filter frame and non-woven fabric filter material)") based on Invention A. Therefore, it cannot be said that a person ordinarily skilled in the art could have easily conceived of the idea to apply the invention stated in Exhibit Ko No. 2 to Invention A.

Accordingly, the JPO has erroneously found that a person ordinarily skilled in the art who read Exhibit Ko No. 2 could have used without any difficulty "a water-based emulsion adhesive that contains film-forming polymers" in Invention A in order to easily separate the metal filter frame and non-woven fabric filter material at the time of disposal of the exhaust fan filter (this issue would not be affected by the determination on whether or not the adhesive compound stated in Exhibit Ko No. 2 and the adhesive stated in Exhibits Ko No. 10, No. 11 and No. 24 are equivalent to "a water-based emulsion adhesive that contains film-forming polymers"), and thus the determination made in the JPO Decision that a person ordinarily skilled in the art could have easily conceived of Invention 1 based on such finding is also erroneous.

The reasons mentioned above also apply to Inventions 2 through 4.

(3) As stated above, in the JPO Decision, the JPO failed to accurately identify the problem to be solved by the Inventions and, based on that error, found that the Inventions could have been easily conceived of by a person ordinarily skilled in the art and thus the JPO Decision should be rescinded.

3. Summary

As stated above, the ground for rescission 2 alleged by the plaintiffs is well-grounded and thus, without the need to determine other issues, the JPO Decision that invalidated the patent granted for the Inventions is illegal and should be rescinded.

No. 5 Conclusion

Accordingly, the plaintiffs' allegations are well-grounded and therefore, the JPO Decision shall be rescinded and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Third Division

Presiding Judge: IIMURA Toshiaki

Judge: SAIKI Norio

Judge: TAKEMIYA Hideko

Judgment rendered on January 31, 2011
2010 (Gyo-Ke) 10075 Case of Seeking Rescission of a JPO Decision
Date of conclusion of oral argument: November 30, 2010

Judgment

Plaintiff: Nippon Nontekkusu KK

Plaintiff: Nippon Foil Mfg. Co., Ltd.

Counsel patent attorney of the abovementioned two plaintiffs: OKUMURA Shigeki

Defendant: Toyo Aluminium Ekco Products Co., Ltd.

Counsel patent attorney: FUJII Atsushi

Counsel attorney: HIRANO Kazuhiro

Counsel patent attorney: YAMASAKI Hirofumi

Main text

1. The trial decision rendered by the JPO on January 25, 2010 with respect to the Invalidation Trial Case No. 2009-800070 shall be rescinded.
2. The court costs shall be borne by the defendant.

Facts and reasons

No. 1 Claims

The same as those mentioned in the main text.

No. 2 Undisputed facts between the parties

1. Background, etc. to the procedures at the JPO

The plaintiffs hold a patent for an invention titled "exhaust fan filter and its production process" (Date of application: July 10, 2000; Date of registration: June 11, 2004; hereinafter referred to as the "Patent").

On March 30, 2009, the defendant filed a request for a trial for patent invalidation with respect to the Patent (Invalidation Trial Case No. 2009-800070). In response to this, on January 25, 2010, the JPO, after completing the oral proceedings on November 17, 2009, rendered a trial decision to the effect that "the patent granted for the inventions stated in Claims 1 through 4 of the Patent shall be invalidated" (hereinafter referred to as the "JPO Decision"), and on February 4, 2010, the transcript of the JPO Decision was served to the plaintiffs.

2. Scope of claims

The statements in Claims 1 through 4, which are among the scope of claims contained in the description of the Patent (Exhibit Ko No. 37; hereinafter referred to as the "Description"), are as follows (hereinafter the inventions stated in Claims 1 through 4 shall be referred to as "Invention 1" through "Invention 4," respectively, and in some cases, such inventions may be collectively referred to as the "Inventions").

[Claim 1]

An exhaust fan filter comprising a metal filter frame and non-woven fabric filter material that is adhered to the metal filter frame by covering the opening in the metal filter frame, which is characterized by adhering said metal filter frame and non-woven fabric filter material with a water-based emulsion adhesive that contains film-forming polymers.

[Claim 2]

An exhaust fan filter stated in Claim 1 wherein the glass transition point of the film-forming polymer is -10°C to +30°C.

[Claim 3]

A method for manufacturing an exhaust fan filter in which a non-woven fabric filter material is adhered to a metal filter frame by covering the opening provided in said metal filter frame, which is characterized by comprising the step of applying a water-based emulsion adhesive, that contains film-forming polymers, on the surface of the opening edge part and/or crosspiece part provided in said metal filter frame and then depressing the non-woven fabric filter material to the coated surface and applying heat thereto, thereby adhering the non-woven fabric filter material to the opening edge part and/or crosspiece part.

[Claim 4]

A manufacturing method for an exhaust fan filter stated in Claim 3 wherein the glass transition point of the film-forming polymer is -10°C to +30°.

3. Reasons of the JPO Decision

(1) The reasons for the JPO Decision are as mentioned in the written copy attached to the judgment. In short, the JPO first made the following findings with respect to Inventions 1 through 4.

A. Invention 1 could have been easily made by a person ordinarily skilled in the art based on the invention stated in Exhibit Ko No. 1-1 (the microfilm of Utility Model Application No. 1983-136320; the contents of the invention found in the JPO Decision are the same as those of Invention A mentioned in (2) below; hereinafter referred to as "Invention A"), the statements in Exhibit Ko No. 2 (Publication of Unexamined Patent Application No. 1995-188632) and the well-known arts stated in Exhibits Ko No. 10 (Publication of Unexamined Patent Application No. 1999-129645), No. 11 (Publication of Unexamined Patent Application No. 1976-48408) and No. 24 (Publication of Unexamined Patent Application 2000-126523).

B. Invention 2 could have been easily made by a person ordinarily skilled in the art based on Invention A, the statements in Exhibit Ko No. 2 and the well-known arts stated

in Exhibits Ko No. 4 (Publication of Unexamined Patent Application No. 1989-152056), No. 10, No. 11 and No. 24

C. Invention 3 could have been easily made by a person ordinarily skilled in the art based on the invention stated in Exhibit Ko No. 1-1 (the contents of said invention found in the JPO Decision are the same as those of Invention B stated in (2) below; hereinafter referred to as "Invention B"), the statements in Exhibit Ko No. 2, and the well-known arts stated in Exhibits Ko No. 10, No. 11, No. 16 (Publication of Unexamined Patent Application No. 1998-245537), No. 24 and No. 29 ("Saishin Laminēto Kakō Binran (Latest Lamination Handbook)," June 30, 1989, Converting Technical Institute at 75 through 92).

D. Invention 4 could have been easily made by a person ordinarily skilled in the art based on Invention B, statements in Exhibit Ko No. 2 and the well-known arts stated in Exhibits Ko No. 4, No. 10, No. 11, No. 16, No. 24 and No. 29.

Based on these findings, the JPO found that the Patent falls under the requirement prescribed in Article 29, paragraph (2) of the Patent Act and thus should be invalidated pursuant to the provisions of Article 123, paragraph (1), item (ii) of said Act.

(2) The contents of Invention A and Invention B found in the JPO Decision are as follows.

Invention A

"A filter cover for a range hood comprising a flange part of a filter cover that is integrally formed by a metal foil that serves as the seat to mount the filter cover on the circumferential edge of the range hood's opening, a rise wall on the inner circumferential edge of the flange part, a grid part on the lower end of the rise wall, a flame-retardant or flame-resistant non-woven fabric filter attached to the grid part with glue, and a magnet to stick onto the range hood that is attached to the flange part."

Invention B

"A method for manufacturing a filter cover for a range hood wherein the cover, which has a rise wall on the inner circumferential edge of the flange part of the filter cover that serves as the seat to mount the filter cover on the circumferential edge of the range hood's opening, and a grid part on the lower end of the rise wall, is integrally formed by a metal foil, and a magnet that sticks to the range hood is attached to the flange part, and wherein a flame-retardant or flame-resistant non-woven fabric filter is adhered to the grid part by applying glue to the inner side of the grid part in the filter cover for range hood."

(3) The common features and differences found between Invention 1 and Invention A and those between Invention 3 and Invention B in the JPO Decision are as follows (with

respect to Inventions 2 and 4, the statements shall be omitted)

A. Common features between Invention 1 and Invention A

An exhaust fan filter comprising a metal filter frame and a non-woven fabric filter material that is adhered to said metal filter frame by covering the opening in the metal filter frame, wherein said metal filter frame and non-woven fabric filter material are adhered together with glue.

B. Differences between Invention 1 and Invention A (Difference A)

With respect to the adhesive, while a water-based emulsion adhesive that contains film-forming polymers is used in Invention 1, no such adhesive is used in Invention A.

C. Common features between Invention 3 and Invention B

A method for manufacturing an exhaust fan filter by adhering the non-woven fabric filter material to the metal filter frame by covering the opening provided in the metal filter frame, wherein glue is applied to the surface of the opening edge part and/or the crosspiece part provided in said metal filter frame and the non-woven fabric filter material is adhered to the opening edge part and/or the crosspiece part.

D. Differences between Invention 3 and Invention B (Difference C)

In Invention 3, the non-woven fabric filter material and the metal filter frame are adhered together by applying a water-based emulsion adhesive that contains film-forming polymers and then depressing the non-woven fabric filter material to the coated surface and applying heat thereto, while in Invention B, there is no step of using such adhesive or adhering the non-woven fabric filter material to the coated surface by depressing the non-woven fabric filter material and applying heat thereto.

No. 3 Allegations of the parties

1. The plaintiffs' allegations concerning the grounds for rescission

The JPO Decision contains the following errors: [i] errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously identifying the Inventions and the well-known arts stated in Exhibits Ko No. 10, No. 11 and No. 24 (ground for rescission 1); [ii] errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously finding the problems to be solved by the Inventions and well-known arts (Exhibits Ko No. 18, No. 19 and No. 32 (Exhibit Otsu No. 2 used in the trial)) (ground for rescission 2); and [iii] errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously identifying the well-known arts stated in Exhibit Ko No. 2 (ground for rescission 3).

(omitted)

No. 4 Court decision

The court found that the ground for rescission 2 (errors in finding that the Inventions could have been easily conceived of by a person ordinarily skilled in the art by erroneously identifying the problems to be solved by the Inventions and well-known arts (Exhibits Ko No. 18, No. 19 and No. 32)) alleged by the plaintiffs is well-grounded and, thus, the JPO Decision should be rescinded for violating Article 29, paragraph (2) of the Patent Act, without the need to examine other issues.

1. Introduction

(1) The determination of whether or not the Inventions could have been easily conceived of by a person ordinarily skilled in the art and the problem to be solved by the Inventions

With respect to the determination of whether or not the relevant invention could have been easily conceived of by a person ordinarily skilled in the art based on an invention that falls under any of the items of Article 29, paragraph (1) of the Patent Act (hereinafter this invention shall be referred to as the "cited invention"), the objective and reasonable method to make such determination should be to first examine an invention that is state of the art and is most similar to the relevant invention (the "primarily cited invention") and then take into consideration other cited invention(s) (the "secondarily cited invention") along with the primarily cited invention, and thereby determine whether or not a person ordinarily skilled in the art could have easily conceived of the relevant invention's structure that is different from that of the primarily cited invention (the characteristic part of said invention). The relevant invention's structure that is different from that of the primarily cited invention (the structural characteristics of said invention) consists of an addition or change of a new technical structure in order to solve a problem that could not be solved by the state of the art. Thus, in determining whether or not the relevant invention could have been easily conceived of by a person ordinarily skilled in the art, it is necessary and essential to accurately identify the problem to be solved (function and effect, etc.) that was intended by the invention and to comprehensively determine in relation thereto the issues of "whether or not it was easy to establish the problem to be solved" and "whether or not it was easy to adopt a specific structure to solve the problem." As stated above, since the issue of whether or not the invention could have been easily conceived of by a person ordinarily skilled in the art shall be determined in a comprehensive manner, the mere fact that "it was easy to adopt a specific structure to solve the problem" is insufficient for finding that the invention could have been easily made, and it may be necessary to find that "it was easy

to establish the problem to be solved." In other words, even if "it was easy to adopt a specific structure to solve the problem," "in a case where uniqueness can be found in the establishment or viewpoint of the problem to be solved" (for example, in a case where a problem that would not be generally conceived of is established), it cannot be necessarily found that the invention could have been easily conceived of by a person ordinarily skilled in the art. On the other hand, since the determination of whether or not "it was easy to establish the problem to be solved" would be based on the determination of whether or not the idea could have been easily conceived of by a person ordinarily skilled in the art, it is easily affected by ex-post facto and subjective decisions. In order to prevent such decisions from being made, it is essential to have a logical explanation based on evidence. In addition, as the basis for such determination, it is extremely important to accurately identify the problem to be solved that was intended by the invention in order to reach a conclusion on the issue of whether or not the invention could have been easily conceived of by a person ordinarily skilled in the art.

Based on the abovementioned standpoints, the court shall examine the appropriateness of the determination made in the JPO Decision with respect to the issue of whether or not the Inventions could have been easily conceived of by a person ordinarily skilled in the art.

(2) Regarding the contents of the reasons of the JPO Decision

The logic used in the JPO Decision in determining that the Inventions could have been easily conceived of by a person ordinarily skilled in the art is as follows.

A. Inventions 1 and 2

The JPO found that the common features of Invention 1 and Invention A are that they are both "an exhaust fan filter comprising a metal filter frame and a non-woven fabric filter material that is adhered to the metal filter frame by covering the opening in the metal filter frame, wherein the metal filter frame and non-woven fabric filter material are adhered together with glue." In addition, the JPO found that the two inventions differ in the point that, with respect to the adhesive, while a water-based emulsion adhesive that contains film-forming polymers is used in Invention 1, no such adhesive is used in Invention A.

Next, the JPO stated the following logic in concluding that a person ordinarily skilled in the art could have easily conceived of the structure related to the abovementioned difference. [i] According to the statements in paragraphs [0003] through [0006] in the Description, the problem to be solved by Invention 1 is "to enable (easy) separation and disposal of the metal filter frame and non-woven fabric filter material after the exhaust fan filter has been used." In addition, it was a well-known

technical problem "to enable (easy) separation and disposal of the metal filter frame and non-woven fabric filter material after the exhaust fan filter had been used" (Exhibits Ko No. 18, No. 19 and No. 32); [ii] Exhibit Ko No. 2 mentions an adhesive compound whose component dissolves or swells and separates by an aqueous solution and states that an adhesive compound has a commonality with glue if it is regarded as a bond that bonds multiple substances (Exhibits Ko No. 27 and No. 34); and thus [iii] a person ordinarily skilled in the art who read Exhibit Ko No. 2 would have the motivation to select an adhesive compound whose component dissolves or swells and separates in order to solve the problem mentioned above.

Based on this logic, the JPO concluded that, in order to solve the problem mentioned above, a person ordinarily skilled in the art could have used, without any difficulty, "a water-based emulsion adhesive that contains film-forming polymers" as the adhesive to be used in Invention A in order to easily separate the metal filter frame and non-woven fabric filter material at the time of disposal of the exhaust fan filter.

With respect to Invention 2, the JPO found that the same determinations may be made as in the case of Invention 1, since Invention 2 is made by adding to Invention 1 the matters to specify the invention that "the glass transition point of the film-forming polymer is -10°C to +30°C."

B. Inventions 3 and 4

With respect to Invention 3 and Invention B, the JPO found that they have the common feature in that they are both "a method for manufacturing an exhaust fan filter by adhering the non-woven fabric filter material to the metal filter frame by covering the opening provided in the metal filter frame, wherein glue is applied to the surface of the opening edge part and/or the crosspiece part provided in the metal filter frame, and the non-woven fabric filter material is adhered to the opening edge part and/or the crosspiece part." Meanwhile, the JPO found that the two inventions differ in that, "in Invention 3, non-woven fabric filter material is adhered to the metal filter frame by applying a water-based emulsion adhesive that contains film-forming polymers and depressing the non-woven fabric filter material to said coated surface and applying heat thereto, while in Invention B, there is no such step of using the adhesive or adhering the non-woven fabric filter material to the metal filter frame by depressing the non-woven fabric filter material and applying heat thereto." Next, the JPO stated the following logic in concluding that a person ordinarily skilled in the art could have easily conceived of the abovementioned difference. With respect to the difference, the JPO found that, as with the case mentioned in A. above, a person ordinarily skilled in the art could have used, without any difficulty, "a water-based emulsion adhesive that contains

film-forming polymers" as the adhesive in order to easily separate the metal filter frame and non-woven fabric filter material at the time of disposal of the exhaust fan filter in order to solve the well-known problem of enabling easy "separation and disposal of the metal filter frame and non-woven fabric filter material after the use of the exhaust fan filter." The JPO further found that a person ordinarily skilled in the art could have also applied such adhesive and depressed the non-woven fabric filter material to the coated surface and applied heat thereto without any difficulty. Based on these findings, the JPO determined that Invention 3 could have been easily made by a person ordinarily skilled in the art based on Invention B, statements in Exhibit Ko No. 2 and the well-known arts stated in Exhibits Ko No. 10, No. 11, No. 16, No. 24 and No. 29.

With respect to Invention 4, the JPO found that the same determinations may be made as in the case of Invention 3, since Invention 4 is made by adding to Invention 3 the matters to specify the invention that "the glass transition point of the film-forming polymer is -10°C to +30°C."

2. Regarding the appropriateness of the JPO Decision

There are errors in the JPO Decision in that it failed to accurately identify the problem to be solved by the Inventions. Moreover, the JPO erroneously concluded that the Inventions could have been easily conceived of by a person ordinarily skilled in the art based on an erroneously identified problem to be solved. The reasons are as follows.

(1) Fact finding

A. Statements in the Description

(omitted)

(2) Determination

A. As found above, the objective of Invention 1 is to enable easy separation of the metal filter frame and non-woven fabric filter material by using, in adhering the metal filter frame and non-woven fabric filter material, a glue that is capable of achieving strong adhesive bonding under ordinary circumstances but that has the predisposition to decrease the adhesive power between metal and non-woven fabric when water is applied and by immersing the used exhaust fan filter with the aim of solving the following defects found in conventional exhaust fan filters: conventional exhaust fan filters were manufactured by a method wherein the metal filter frame is created by providing a thermosensitive adhesive film on the whole surface of one side of the aluminum foil, applying to such film molding such as bulging or protruding and providing an opening by punching, and the non-woven fabric filter material is adhered

to the metal filter frame in a manner covering the opening of the metal filter frame and by depressing such material and applying heat thereto and melting and solidifying the thermosensitive adhesive. Accordingly, the adhesive bonding between the metal filter frame and non-woven fabric filter material was too strong to separate them without tearing the non-woven fabric filter material.

As such, it may be found that Invention 1 aims to solve the problem that "in an exhaust fan filter comprised of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material." The solution provided by Invention 1 is "to use a water-based emulsion adhesive that contains film-forming polymers, in manufacturing exhaust fan filters so that the metal filter frame and the non-woven fabric filter, which are tightly glued together under ordinary circumstances, could be easily separated if they are immersed in water, since water decreases the adhesive power of the adhesive."

In contrast, as found above, Invention A cited by the JPO from a document is "a filter cover for a range hood comprising a flange part of the filter cover integrally formed by a metal foil that serves as the seat to mount the filter cover on the circumferential edge of the range hood’s opening, a rise wall on the inner circumferential edge of the flange part, a grid part on the lower end of the rise wall, a flame-retardant or flame-resistant non-woven fabric filter attached to said grid part with glue and a magnet for sticking onto the range hood attached to said flange part." It is different from Invention 1, which provides a solution for the problem that "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material." Exhibit Ko No. 1 does not contain any statements or disclosure, etc. relevant to the problem to be solved that was intended by Invention 1 and the solution thereof but rather states that Invention A is based on the premise that the filter would be disposed of without being separated from the filter cover.

B. In this regard, the JPO first found that the problem to "enable (easy) separation and disposal of the metal filter frame and non-woven fabric filter material after the use of the exhaust fan filter" was well-known based on the references stated in Exhibits Ko No. 18, No. 19 and No. 32 mentioned above, and, therefore, a person ordinarily skilled in the art who read Exhibit Ko No. 2 could have easily selected glue that had a component

that dissolved or swelled in order to solve the abovementioned problem.

However, the JPO Decision is unreasonable in that it failed to show any reasonable grounds for the logic used in concluding that a person ordinarily skilled in the art could have easily conceived of the structure related to the difference between Invention 1 and the cited invention (Invention A) based on the finding that the abovementioned problem is well-known.

Moreover, even if the statements in Exhibits Ko No. 18, No. 19 and No. 32 are examined in detail, none of the statements suggest the same problem to be solved as that of Invention 1, i.e., "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use, so as to make it possible to separately dispose of components for each material."

More specifically, it can be said that [i] although Exhibits Ko No. 18, No. 19 and No. 32 show an art that enables easy disposal of the metal filter frame and filter material after the exhaust fan filter has been used, all of them show an art different from that of the invention, which is based on the premise that the metal filter frame and filter material are "adhered together with glue"; that [ii] the filter for range hoods stated in Exhibit Ko No. 18 is not "an exhaust fan filter" comprising a metal filter frame and a non-woven fabric filter "that are tightly glued together," but instead is made with an objective "to simplify the attachment to the metal mesh filter by replacing the metal foil with a moldable fiber non-woven fabric and to enable easy disposal of the product as a whole as domestic waste without separating each component at the time of disposal after the use"; it is different from Invention 1 in terms of the problem to be solved and the solution thereof; and that [iii] Exhibit Ko No. 19 states an invention that aims to provide an exhaust fan cover that consists of an exhaust fan cover frame body made of metal foil and a filter using metal fiber, which eliminates the need to separate the filter and exhaust fan cover frame body and hardly poses a problem, even if the product as a whole is disposed of as waste, and thus excels in workability upon disposal as waste and can be easily recycled; it is different from Invention 1 in terms of the means to solve the problem. In other words, while the objective of Invention 1 is to enable easy separation of the filter frame and filter, the inventions stated in Exhibits Ko No. 18 and No. 19 are intended to improve working efficiency by eliminating any problems at the time of disposal of the product as a whole as waste; Invention 1 has established a completely different problem to be solved and the solution thereof, and thus such Exhibits cannot be found to have suggested an art that enables a person ordinarily skilled in the art to

easily conceive of the structure of Invention 1, which is different from those of such inventions.

C. As found above, Exhibits Ko No. 18, No. 19 and No. 32 contain no suggestions concerning the problem to be solved and the solution thereof with respect to the structure related to the difference between Invention 1 and Invention A (Difference A), i.e., "with respect to the adhesive, while a water-based emulsion adhesive that contains film-forming polymers is used in Invention 1, no such adhesive is used in Invention A."

Accordingly, it cannot be found that, in the JPO Decision, the JPO presented an explanation based on an evidence-based objective and reasonable logic with respect to the findings that a person ordinarily skilled in the art could have easily conceived of the fact that the following problem to be solved established in Invention 1 and the solution thereof would be achieved: "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use."

As stated above, Exhibit Ko No. 2 states an invention that [i] relates to a water-soluble adhesive composition that may be used as an adhesive compound of a masking tape or label that is capable of dissolving or swelling and separating by an aqueous solution and the manufacturing method of such composition; that [ii] intends to solve the problem of protective tapes used in the field of electronic materials and chip-fixing adhesive tapes used in mechanically polishing ceramic chips that adhesive component residue is required to be water-washable from the perspective of conservation of the global environment and that they are also required to have high removability and strong adhesiveness to eliminate easy separation; and that [iii] solves the abovementioned problem by using an aqueous adhesive composition characterized by containing a polymer that contains as the essential monomer component monomer produced by esterifying (meth)acrylate having terminal OH groups and that is neutralized with phosphoric acid.

However, as stated above, as long as the references stated in Exhibits Ko No. 18, No. 19 and No. 32, etc. have not mentioned to establish the problem that "in an exhaust fan filter consisting of a metal filter frame and a non-woven fabric filter material that are adhered together with glue, the frame and the filter, which are tightly glued together under ordinary circumstances, should be made easily separable after use," it cannot be said that a person ordinarily skilled in the art could have easily conceived of the structure of Invention 1, which is different from that of Invention A, by applying the invention stated in Exhibit Ko No. 2 to Invention A. More specifically, it cannot be

found that the statements in Exhibit Ko No. 2 suggest that a person ordinarily skilled in the art may conceive of the characteristic feature of Invention 1 ("to use a water-based emulsion adhesive that contains film-forming polymers (that tightly glues the metal filter frame and non-woven fabric filter material under ordinary circumstances but whose adhesive power decreases when it is immersed in water and thereby enables easy separation of the metal filter frame and non-woven fabric filter material)") based on Invention A. Therefore, it cannot be said that a person ordinarily skilled in the art could have easily conceived of the idea to apply the invention stated in Exhibit Ko No. 2 to Invention A.

Accordingly, the JPO has erroneously found that a person ordinarily skilled in the art who read Exhibit Ko No. 2 could have used without any difficulty "a water-based emulsion adhesive that contains film-forming polymers" in Invention A in order to easily separate the metal filter frame and non-woven fabric filter material at the time of disposal of the exhaust fan filter (this issue would not be affected by the determination on whether or not the adhesive compound stated in Exhibit Ko No. 2 and the adhesive stated in Exhibits Ko No. 10, No. 11 and No. 24 are equivalent to "a water-based emulsion adhesive that contains film-forming polymers"), and thus the determination made in the JPO Decision that a person ordinarily skilled in the art could have easily conceived of Invention 1 based on such finding is also erroneous.

The reasons mentioned above also apply to Inventions 2 through 4.

(3) As stated above, in the JPO Decision, the JPO failed to accurately identify the problem to be solved by the Inventions and, based on that error, found that the Inventions could have been easily conceived of by a person ordinarily skilled in the art and thus the JPO Decision should be rescinded.

3. Summary

As stated above, the ground for rescission 2 alleged by the plaintiffs is well-grounded and thus, without the need to determine other issues, the JPO Decision that invalidated the patent granted for the Inventions is illegal and should be rescinded.

No. 5 Conclusion

Accordingly, the plaintiffs' allegations are well-grounded and therefore, the JPO Decision shall be rescinded and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Third Division

Presiding Judge: IIMURA Toshiaki

Judge: SAIKI Norio

Judge: TAKEMIYA Hideko