

Date	September 28, 2011	Court	Intellectual Property High Court, Third Division
Case number	2010 (Gyo-Ke) 10351		
<p>– A case in which, in an action to seek rescission of a JPO decision that drew a conclusion that a person ordinarily skilled in the art can easily conceive of the structure pertaining to a difference between the invention claimed in the patent application and the cited invention based only on said specific cited invention and a specific well-known technical matter, the court ruled that the determination in the JPO decision that a person ordinarily skilled in the art can easily conceive of the structure pertaining to the difference of the invention claimed in the patent application based on the cited invention is erroneous because there is no motivation to adopt the structure of the invention claimed in the patent application by applying the well-known matter to the cited invention.</p> <p>– A case in which the court ruled that the determination in the JPO decision is erroneous in that it drew a conclusion, without showing any reason, that it is easy for a person ordinarily skilled in the art to conceive of the structure pertaining to the difference, though it is reasonable to understand that when there is no problem to be solved in the structure of the cited invention nor is there any statement suggesting choosing another form, choosing another well-known form that may cause a problem should be avoided unless there are special circumstances.</p>			

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

The plaintiff received an examiner's decision of refusal in relation to an invention titled "odor-neutralizing and liquid-absorbing trash bags" (the "Invention"), and filed a request for a trial against the examiner's decision of refusal. The JPO ruled that the Invention is not patentable pursuant to the provisions of Article 29, paragraph (2) of the Patent Act as it is an invention that a person ordinarily skilled in the art could have easily made based on the invention described in Publication 1 and a well-known matter. Based on this ruling, the JPO rendered a decision dismissing the request. In the decision, the JPO determined that a person ordinarily skilled in the art could have easily conceived of the difference by applying the well-known matter found in the publication to the cited invention. The plaintiff instituted this action to seek rescission of the JPO decision.

In this judgment, the court held as outlined below, and rescinded the JPO decision.

In the cited invention, an absorbent polymer layer is used as an absorber, and is coated and integrated with the inner surface of a plastic bag. Therefore, it is rational to understand that the form thereof is stably maintained and is also kept even when

absorbing water. In that case, there is no motivation to adopt a structure of arranging a liquid permeable liner adjacent to the absorber in the cited invention for the purpose of avoiding the situation where "consumers have accidental and undesirable contact with the absorber that has been almost or completely saturated with liquid trash." The well-known reference describes an art of arranging a liquid permeable liner adjacent to an absorber. However, it lacks validity to draw a conclusion, by abstracting the content of the cited invention, the features of the Invention, the function that illustrates the technical meaning of the difference between the inventions, the purpose of the Invention or the problem to be solved by the Invention, , the method for solving the problem, etc., that the proposition to be proven – "it is easy for a person ordinarily skilled in the art to conceive of the structure pertaining to the difference of the Invention by applying the aforementioned technical matter to the cited invention" – is naturally established based on the idea that the arts of arranging a liquid permeable liner adjacent to an absorber in general are uniformly well-known.

Publication 1 provides a description that antimicrobial zeolite, which is an odor-neutralizing composition, is kneaded into the absorber, but there is no statement suggesting that a problem to be solved exists in kneading and that another form is chosen in place of kneading. On the assumption that a form of adhering antimicrobial zeolite on an absorbent polymer layer is chosen in place of kneading, a person ordinarily skilled in the art expects that there will be a problem of dropout of antimicrobial zeolite powder from the surface of the absorber. Therefore, it is reasonable to understand that choosing a form that may cause a problem in place of kneading of the cited invention is a means that should be avoided unless there are special circumstances.