

Date	January 17, 2017	Court	Intellectual Property High Court, Fourth Division
Case number	2016 (Gyo-Ke) 10087		
<p>– A case in which the court ruled that in an action to seek rescission of a JPO decision, it is permissible for the court to examine and decide on an allegation additionally made during the court proceedings based on a new ground for invalidation of a patent wherein the cited invention used as the secondary cited invention in the request for an invalidation trial was used as the primary cited invention, and the cited invention used as the primary cited invention in the same request was used as the secondary cited invention.</p>			

References: Articles 123, 167, and 178 of the Patent Act

Numbers of related rights, etc.: Patent No. 4465408

#### Summary of the Judgment

The plaintiff filed a request for an invalidation trial for the patent held by the defendants, but the JPO rendered a decision to dismiss the request. Accordingly, the plaintiff filed this action to seek rescission of the JPO decision. During the trial proceedings before the JPO, the plaintiff argued that the patented invention could have been easily arrived at by a person ordinarily skilled in the art by [i] choosing Cited Invention 1 as the primary cited invention and combining it with Cited Invention 2, or by [ii] choosing Cited Invention 3 as the primary cited invention and combining it with Cited Invention 1 or Cited Invention 2. However, during the court proceedings of this action, the plaintiff alleged the illegality of the JPO decision based on the previous arguments, and also alternatively alleged that the patented invention could have been easily arrived at by a person ordinarily skilled in the art by choosing Cited Invention 2 as the primary cited invention and combining it with Cited Invention 1 or Cited Invention 3.

In this judgment, the court held as follows. Cited Inventions 1 to 3 are publicly known facts that were examined by the JPO during the trial proceedings as inventions falling under Article 29, paragraph (1), item (iii) of the Patent Act. Both parties have agreed to have the plaintiff's alternative allegation examined and decided by the court, and they do not wish for this issue to go through examination and decision by the JPO. Except for this issue, the parties have made allegations and shown proof thoroughly for the other issues. Therefore, the court determined that from the perspective of solving the dispute at one time, it is permissible for the court to examine and decide on the alternative allegation. Having examined the plaintiff's allegations, the court determined that all of them are groundless, and dismissed the plaintiff's claim.

Judgment rendered on January 17, 2017; the original was received on the same day; court clerk  
2016 (Gyo-Ke) 10087 Case of Seeking Rescission of JPO Decision

Date of conclusion of oral argument: November 30, 2016

#### Judgment

Plaintiff: X

Defendant: Hamano Plating Co, Ltd.

Defendant: Y

#### Main Text

1. All of the plaintiff's claims shall be dismissed.
2. The plaintiff shall bear the court costs.

#### Facts and reasons

##### No. 1 Claims

The JPO decision made on March 7, 2016, concerning Invalidation Trial No. 2015-800092 shall be rescinded.

##### No. 2 Outline of the case

###### 1. Developments in procedures at the JPO, etc.

(1) The defendants filed a patent application (the "Patent Application"; Patent Application No. 2009-174851; Date of filing of the original application for utility model registration on which the patent application is based: May 1, 2008) for an invention titled "surface decorative structure of an article and method of processing for the same" on July 28, 2009, and establishment of the patent right (Patent No. 4465408; hereinafter referred to as the "Patent") was registered on February 26, 2010.

(2) On March 30, 2015, the plaintiff filed a request for an invalidation trial in relation to the patents pertaining to Claims 1 to 8 in the scope of claims of the Patent, and the JPO examined this case as Invalidation Trial No. 2015-800092.

(3) On March 7, 2016, the JPO rendered a decision (hereinafter referred to as the "JPO Decision") to the effect that "The request for a trial shall be dismissed," as stated in (a copy of) the written decision attached to this judgment, and a certified copy of the written decision was served to the plaintiff on the 16th of the same month.

(4) On April 8, 2016, the plaintiff filed this action to seek rescission of the JPO Decision.

###### 2. Statement of the scope of claims

The statements in Claims 1 to 8 of the scope of claims are as follows (Exhibit Ko 51). Hereinafter the inventions pertaining to the Patent are referred to as "Patented Invention 1," etc.

in accordance with the number assigned to each claim, and these inventions are collectively referred to as the "Patented Inventions." In addition, the description and drawings (Exhibit Ko 51) are collectively referred to as the "Description." Incidentally, a "slash" mark in the text indicates a part where a new line starts in the original text (the same applies hereinafter).

[Claim 1] A surface decorative structure of an article which is characterized in that a metal coated layer (2), to which a metal material with at least metallic luster is fixed in a layered manner, is formed on the surfaces that are positioned on the front and back sides of a base material (1) made of a transparent or semi-transparent plastic material having translucency / while separation parts (21) are symmetrically provided on the front and back sides of at least part of this metal coated layer (2) by emitting laser beam, and in these separation parts (21), the surface of said base material (1) is exposed, thereby forming a decorative pattern (P) by a difference between the appearance of said base material (1) and the metallic luster of the remaining metal coated layer (2), / and with base material (1) and metal coated layer (2) being exhibited, respectively, their surfaces are coated with a clear-coating layer (3) made of a synthetic-resin material having translucency, thereby protecting the surfaces of decorative pattern (P).

[Claim 2] A surface decorative structure of an article stated in Claim 1 which is characterized in that metal coated layer (2) is formed by any one of electric plating; electroless plating, such as chemical plating and substitution plating; vacuum plating, such as vacuum vapor deposition, sputtering, ion plating, ion-beam vapor deposition, physical vapor deposition (PVD), and chemical vapor deposition (CVD); and hot dipping.

[Claim 3] A surface decorative structure of an article stated in Claim 1 or 2 which is characterized in that the metal material of metal coated layer (2) is any one of metal, such as aluminum, titanium, molybdenum, zinc, cobalt, nickel, chrome, gold, silver, copper, and iron; alloy, such as brass (Cu-Fe), stainless steel (Fe-Ni-Cr), and bronze (Cu-Sn); and silicon oxide, titanium oxide, indium tin oxide (ITO), diamond-like carbon (DLC), titanium nitride, and titanium carbide.

[Claim 4] A surface decorative structure of an article stated in any one of Claims 1 to 3 which is characterized in that the synthetic-resin material of clear-coating layer (3) is colorless and transparent resin, including organic resin such as acrylic, polyester, urethane, polyolefin, fluorine, epoxy, vinyl-acetate, and chloroprene resin; organic resin mixed with inorganic polymer, ultraviolet curable resin, and electron beam curable resin.

[Claim 5] A method of processing for a surface decorative structure of an article which is characterized in that metal coated layer (2), which comprises a metal material with at least metallic luster, is fixed in a layered manner to the surfaces that are positioned on the front and back sides of base material (1) made of a transparent or semi-transparent plastic material having

translucency, / the front and back sides of the surfaces of said base material (1) are symmetrically exposed by separating separation parts (21) that are provided on at least part of this metal coated layer (2) by emitting laser beam, thereby exhibiting a decorative pattern (P) by a difference between the appearance of said base material (1) and the metallic luster of the remaining metal coated layer (2), / with base material (1) and metal coated layer (2) being exhibited, respectively, their surfaces are coated with a synthetic-resin material having translucency to form a clear-coating layer (3), thereby protecting the surfaces of said decorative pattern (P) produced by metallic luster with this clear-coating layer (3).

[Claim 6] A method of processing for a surface decorative structure of an article stated in Claim 5 wherein the metal coated layer (2) is formed by any one of electric plating; electroless plating, such as chemical plating and substitution plating; vacuum plating, such as vacuum vapor deposition, sputtering, ion plating, ion-beam vapor deposition, physical vapor deposition (PVD), and chemical vapor deposition (CVD); and hot dipping.

[Claim 7] A method of processing for a surface decorative structure of an article stated in Claim 5 or 6 which is characterized in that the metal material making up the metal coated layer (2) is any one of metal, such as aluminum, titanium, molybdenum, zinc, cobalt, nickel, chrome, gold, silver, copper, and iron; alloy, such as brass (Cu-Fe), stainless steel (Fe-Ni-Cr), and bronze (Cu-Sn); and silicon oxide, titanium oxide, indium tin oxide (ITO), diamond-like carbon (DLC), titanium nitride, and titanium carbide.

[Claim 8] A method of processing for a surface decorative structure of an article stated in any one of Claims 5 to 7 which is characterized by that the synthetic-resin material making up the clear-coating layer (3) is colorless and transparent resin, including organic resin such as acrylic, polyester, urethane, polyolefin, fluorine, epoxy, vinyl-acetate, and chloroprene resin; organic resin mixed with inorganic polymer, ultraviolet curable resin, and electron beam curable resin.

### 3. Gist of the reasons given in the JPO Decision

(1) The reasons given in the JPO Decision are as stated in (a copy of) the written decision attached to this judgment. In short, the Patented Inventions violate none of [i] the clarity requirement, [ii] the support requirement, and [iii] the enablement requirement, and they are not inventions which a person ordinarily skilled in the art would have been able to easily make based on [a] the invention stated in Cited Document 1 mentioned below (hereinafter referred to as "Cited Invention 1") and the invention stated in Cited Document 2 mentioned below (hereinafter referred to as "Cited Invention 2") or based on [b] the invention stated in Cited Document 3 mentioned below (hereinafter referred to as "Cited Invention 3"), Cited Invention 1, and Cited Invention 2.

A. Cited Document 1: Publication of Unexamined Patent Application No. 2008-73736 (Exhibit Ko 3)

B. Cited Document 2: Publication of Unexamined Patent Application No. 2002-362099 (Exhibit Ko 4)

C. Cited Document 3: Publication of Unexamined Patent Application No. 1989-251689 (Exhibit Ko 5)

(2) Comparison between the Patented Inventions and the cited inventions, etc.

Cited Invention 1, common features and differences between Patented Inventions 1 and 5 and Cited Invention 1, Cited Invention 3, common features and differences between Patented Inventions 1 and 5 and Cited Invention 3, and Cited Invention 2 are found as follows in the JPO Decision.

A. Cited Invention 1

[Invention of a product] An electrode for a biosensor wherein a metal layer comprising a lamination of precious metal and other metal materials by the sputtering method, vacuum vapor deposition method, electron beam vapor deposition method, ion plating method, etc. is formed on the surfaces that are positioned on the front and back sides of a polymer film base material whose total light transmittance is over 80% / while laser-processed parts where the metal layers on both sides are simultaneously removed are symmetrically provided on the front and back sides on at least part of this metal layer by using Q switched pulse laser, and the surfaces of said polymer film base material are exposed at these laser-processed parts, thereby forming the laser-processed parts.

[Invention of a process] A method of processing an electrode for a biosensor wherein a metal layer comprising a lamination of precious metal and other metal materials by the sputtering method, vacuum vapor deposition method, electron beam vapor deposition method, ion plating method, etc. is fixed in a layered manner on the surfaces that are positioned on the front and back sides of a polymer film base material whose total light transmittance is over 80%, / the metal layers on both sides are simultaneously removed by using Q switched pulse laser, thereby forming the laser-processed parts where the front and back sides of the surfaces of said base material are symmetrically exposed.

B. Common features between Patented Invention 1 and Cited Invention 1

A structure of an article wherein a metal coated layer, to which a metal material with at least metallic luster is fixed in a layered manner, is formed on the surfaces that are positioned on the front and back sides of a base material made of a transparent or semi-transparent plastic material having translucency / while separation parts, which are provided by emitting laser beam, are symmetrically provided on the front and back sides on at least part of said metal coated layer, and the surfaces of said base material are exposed at said separation parts.

C. Differences between Patented Invention 1 and Cited Invention 1

(A) Difference 1

Patented Invention 1 is a "surface decorative structure of an article" wherein a "decorative pattern is formed by a difference between the appearance of the base material and the metallic luster of the remaining metal coated layer." On the other hand, Cited Invention 1 is an "electrode for a biosensor" wherein "laser-processed parts are formed" on the front and back sides.

(B) Difference 2

In Patented Invention 1, "with the base material and metal coated layer being exhibited, respectively, their surfaces are coated with a clear-coating layer made of a synthetic-resin material having translucency, thereby protecting the surfaces of said decorative pattern produced by metallic luster." On the other hand, Cited Invention 1 is not of such structure.

D. Common features between Patented Invention 5 and Cited Invention 1

A method of processing an article wherein a metal coated layer, which comprises a metal material with at least metallic luster, is fixed in a layered manner on the surfaces that are positioned on the front and back sides of a base material made of a transparent or semi-transparent plastic material having translucency, / and the front and back sides of the surfaces of said base material are symmetrically exposed by separating the separation parts, which are provided on at least part of this metal coated layer, by emitting laser beam.

E. Differences between Patented Invention 5 and Cited Invention 1

(A) Difference 1'

Patented Invention 5 is a "method of processing for surface decoration" wherein a "decorative pattern is exhibited by a difference between the appearance of the base material and the metallic luster of the remaining metal coated layer." On the other hand, Cited Invention 1 is a "method of processing an electrode for a biosensor" wherein "laser-processed parts, where the front and back sides of the surfaces of the base material are symmetrically exposed, are formed."

(B) Difference 2'

In Patented Invention 5, "with the base material and metal coated layer being exhibited, respectively, a clear-coating layer is formed by coating the surfaces of the base material and metal coated layer with a synthetic-resin material having translucency, thereby protecting the surfaces of said decorative pattern (P) produced by metallic luster with this clear-coating layer." On the other hand, Cited Invention 1 is not of such structure.

F. Cited Invention 3

[Invention of a product] A coated base plate wherein one of the surfaces, which are positioned on the front and back sides of a base plate that can let laser beam through, is coated with a transparent conductive film or a metal thin film and the other surface is coated with a metal thin film made of Cr, etc. / while the prescribed pattern, which is formed by simultaneously removing the emitted parts of said films by emitting laser beam, is symmetrically provided on

the front and back sides of said base plate on at least part of these films, / and a transparent insulating film is formed on the entire surface of said conductive film after said pattern is formed, thereby protecting the surfaces of said conductive film.

[Invention of a process] A method /of processing a coated base plate wherein one of the surfaces, which are positioned on the front and back sides of a base plate that can let laser beam through, is coated with a transparent conductive film or metal thin film and the other surface is coated with a metal thin film made of Cr, etc., / the prescribed pattern, which is symmetrically exposed on the front and back sides of said base plate, is formed by simultaneously removing the emitted parts of said films by emitting laser beam, / and a transparent insulating film is formed on the entire surface of said conductive film after said pattern is formed, thereby protecting the surfaces of said conductive film.

#### G. Common features between Patented Invention 1 and Cited Invention 3

A structure of an article wherein a metal coated layer, to which a metal material with at least metallic luster is fixed in a layered manner, is formed on the surfaces that are positioned on the front and back sides of the base material / while separation parts that are provided by emitting laser beam are symmetrically formed on the front and back sides on at least part of this metal coated layer, and the surfaces of said base material are exposed at these separation parts.

#### H. Differences between Patented Invention 1 and Cited Invention 3

##### (A) Difference X

In Patented Invention 1, the base material is a "base material made of a transparent or semi-transparent plastic material having translucency." On the other hand, in Cited Invention 3, it is a "base plate that can let laser beam through."

##### (B) Difference Y

In Patented Invention 1, a "surface decorative structure of an article" wherein a "decorative pattern is formed by a difference between the appearance of the base material and the metallic luster of the remaining metal coated layer, and with the base material and metal coated layer being exhibited, respectively, their surfaces are coated with a clear-coating layer made of a synthetic-resin material having translucency, thereby protecting the surfaces of the decorative pattern by said metallic luster." On the other hand, in Cited Invention 3, a "coated base plate wherein a transparent insulating film is formed on the entire surface of said conductive film after said pattern is formed, thereby protecting the surfaces of said conductive film."

#### I. Common features between Patented Invention 5 and Cited Invention 3

A method of processing an article wherein a metal coated layer, which comprises a metal material with at least metallic luster, is mounted on the surfaces that are positioned on the front and back sides of the base material, / and separation parts, which are provided on at least part of this metal coated layer, are separated by emitting laser beam, thereby having the front and back

sides of the surfaces of said base material be symmetrically exposed.

#### J. Differences between Patented Invention 5 and Cited Invention 3

##### (A) Difference X'

In Patented Invention 5, the base material is a "base material made of a transparent or semi-transparent plastic material having translucency." On the other hand, in Cited Invention 3, it is a "base plate that can let laser beam through."

##### (B) Difference Y'

Patented Invention 5 is a "method of processing for surface decoration" wherein "a decorative pattern is exhibited by a difference between the appearance of the base material and the metallic luster of the remaining metal coated layer, / and with the base material and metal coated layer being exhibited, respectively, a clear-coating layer is formed by coating the surfaces of the base material and the metal coated layer with a synthetic resin material having translucency, thereby protecting the surfaces of the decorative pattern produced by metallic luster with this clear-coating layer." On the other hand, Cited Invention 3 is a "method of processing a coated base plate" wherein "a transparent insulating film is formed on the entire surface of said conductive film after said pattern is formed, thereby protecting the surfaces of said conductive film."

#### K. Cited Invention 2

Providing a thin-film metal layer that is patterned into the prescribed shape and a colored protection layer made of a transparent or semi-transparent resin, such as acrylic, urethane, and epoxy resin, outside said thin-film metal layer, on a base material, on which a color-painted layer is formed, in a fishing rod or golf shaft.

#### 4. Grounds for rescission

- (1) Error in the determination concerning the clarity requirement (Ground for Rescission 1)
- (2) Error in the determination concerning the support requirement (Ground for Rescission 2)
- (3) Error in the determination concerning the enablement requirement (Ground for Rescission 3)
- (4) Errors in the determinations concerning whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions (Ground for Rescission 4)

A. Error in the determination concerning whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by citing Cited Document 1 as the primary cited document

B. Error in the determination concerning whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by citing Cited Document 3 as the primary cited document

C. Whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by citing Cited Document 2 as the primary cited document

(omitted)

#### No. 4 Court decision

##### 1. Regarding the Patented Inventions

(1) The scope of claims pertaining to the Patented Inventions is as stated in No. 2, 2. above. The Description (Exhibit Ko 51) roughly states as follows.

##### A. Technical field

This invention concerns a surface decorative structure of an article ... and a method of processing for the same ([0001]).

##### B. Background art

As is well known, a design property is sought for the shape of an article as regards jewelry, such as eyeglass frames, watches, and accessories, as well as portable telephones, and besides, colors and patterns on the surface of the article and texture are important elements that constitute a design ([0002]).

A conventional known example of the ways for decorating an article is subjecting the entire surface of a base material of the article to metal-plating uniformly ... ([0003]).

However, as for such a surface decoration ... only varies the texture of the article's surface ([0005]).

In consequence, such a decorative effect is so monotonous that it does not represent decorative property more than the /texture, and therefore, it lacks unexpectedness and cannot surpass the beauty produced by the shape of the base material of the article itself. In addition, a high-class image produced by metallic luster is likely to be reversed and spoiled due to the monotonous covering means ([0006]).

##### C. Problem to be solved of the invention

This invention was created in view of the aforementioned dissatisfaction with the conventional way of decorating an article, and its purpose is to provide a surface decorative structure of an article that can be easily processed and form a decorative pattern of an optional design with a high-class image thanks to metallic luster, and if desired, can form a third-dimensional decorative pattern, and a method of processing for the same ([0007]).

##### D. Effect of the invention

This invention ... makes it possible to form a decorative pattern of an optional design with a high-class image thanks to metallic luster by a simple processing ([0013]).

In addition ... it is made possible to provide another symmetric separate part on the opposite surface of the base material ... so as to form a three-dimensional decorative pattern. Therefore, it can be said that this invention is extremely highly worthy of being practically available in

surface processing of accessories ([0014]).

#### E. Embodiments of the invention

The embodiments of this invention are explained based on Figures 1 to 3 (see Attachment 1). In Figure 1, sign (1) indicates a base material, and this base material (1) is made of a transparent or semi-transparent plastic material having translucency. Sign (2) indicates a metal coated layer, and this metal coated layer (2) comprises a metal material with at least metallic luster that is fixed in a layered manner to both front and back sides of said base material (1) ([0017]).

By doing so, laser beam that passed through base material (1) forms another symmetric separation part (21) on the opposite surface (back side) of said base material (1) as well, so that it can form decorative pattern (P) ([0018]).

Still more, sign (3) indicates a clear-coating layer. This clear-coating layer (3) is made of a synthetic-resin material having translucency ([0019]).

Then, in order to construct a decorative structure according to this invention, metal coated layer (2), to which a metal material with at least metallic luster is fixed in a layered manner, is formed on both front and back sides of base material (1). ... ([0020])

In order to form this metal coated layer (2), any one of electric plating; electroless plating, such as chemical plating and substitution plating; vacuum plating, such as vacuum vapor deposition, sputtering, ion plating, ion-beam vapor deposition, physical vapor deposition (PVD), and chemical vapor deposition (CVD); and hot dipping can be adopted. In this embodiment, the layer can be assuredly and strongly fixed in a layered manner by using the ion plating of the sputtering system that is excellent in fixation ([0022]).

Concretely, base material (1) is fitted in an ion plating device and has its surface subjected to bombard cleaning in argon atmosphere. In doing so, from the viewpoint of fixation, for pre-treatment, the surface of said base material (1) is preferably subjected to etching processing. Next, titanium plating is formed on said surface as metal coated layer (2) by the ion plating of the sputtering system ([0023]).

Incidentally, metal, such as aluminum, titanium, molybdenum, zinc, cobalt, nickel, chrome, gold, silver, copper, and iron; alloy, such as brass (Cu-Fe), stainless steel (Fe-Ni-Cr), and bronze (Cu-Sn); and silicon oxide, titanium oxide, indium tin oxide (ITO), diamond-like carbon (DLC), titanium nitride, and titanium carbide, etc. can be adopted as a metal material of said metal coated layer (2). Silver and aluminum whose reflection rate is high are preferably used ([0024]).

Moreover, among said metal materials, regarding alloy materials, the vacuum vapor deposition method and ion plating method are not appropriate as there is a difference between alloy components in the speed of sublimation. Therefore, the ultra-high vacuum sputtering method, etc. are adopted. In addition, oxides and nitrides can be generated by atmosphere gas within the chamber ([0025]).

Next, separation part (21) is provided on at least part of metal coated layer (2), and the surface of said base material (1) is exposed at this separation part (21). Thereby, decorative pattern (P) is formed by a difference between the appearance of said base material (1) and the metallic luster of the remaining metal coated layer (2) ([0026]).

In this embodiment, separation part (21) in metal coated layer (2) is provided by emitting laser beam (YAG) to a part to be separated to remove the portion marked by a cross (X) in the figure (see Figure 2). In doing so, regarding a position to which laser beam is emitted, a computer numerical control (NC control) program can be used, and in addition, the position can be linked with the data of the decorative pattern (P) that was designed on the computer ([0027]).

After that, the surface of decorative pattern (P) produced by metallic luster is protected by coating the surfaces of base material (1) and metal coated layer (2) with a clear-coating layer (3) made of a synthetic-resin material having translucency, with base material (1) and metal coated layer (2) being exhibited, respectively (see Figure 1). According to this embodiment, a three-dimensional decorative pattern can be formed by a simple processing ([0028]).

The decorative structure of this embodiment thus formed can simply form a decorative pattern of an optional design with a high-class image thanks to metallic luster by a difference between the appearance of the surface of base material (1) and the metallic luster of the remaining metal coated layer (2) (see Figure 3) ([0032]).

#### F. Industrial applicability

This invention can be used for the surface decoration of jewelry such as eyeglass frames, watches, and accessories, as well as portable telephones ([0034]).

#### (2) Features of the Patented Inventions

According to the statements in (1) above, the features of the Patented Inventions are recognized as follows.

A. The Patented Inventions concern a surface decorative structure of an article and a method of processing for the same ([0001]).

B. A design property is sought for the shape of an article as regards jewelry, such as eyeglass frames, watches, and accessories, as well as portable telephones, and besides, colors and patterns on the surface of the article and texture are important elements that constitute a design ([0002]). A conventional known example of the ways for decorating the article is subjecting the entire surface of a base material of an article to metal-plating uniformly ([0003]).

However, such a surface decoration only varies the texture of the article's surface ([0005]), and it is so monotonous that it does not represent decorative property more than the texture, and therefore, it lacks unexpectedness and cannot surpass the beauty produced by the shape of the base material of the article itself. In addition, a high-class image produced by metallic luster was likely to be reversed and spoiled due to the monotonous covering means ([0006]).

C. The Patented Inventions were created in view of the aforementioned dissatisfaction with the conventional way of decorating an article, and its purpose is to provide a surface decorative structure of an article that can be easily processed and form a decorative pattern of an optional design with a high-class image thanks to metallic luster, and if desired, can form a third-dimensional decorative pattern, and a method of processing for the same ([0007]).

D. The Patented Inventions (Claims 1 and 5) are a method of processing for a surface decoration of an article which is characterized in that a metal coated layer, which comprises a metal material with at least metallic luster, is fixed in a layered manner to the surfaces that are positioned on the front and back sides of a base material made of a transparent or semi-transparent plastic material having translucency ([0017], [0020], and [0022] to [0025]); a decorative pattern is exhibited by a difference between the appearance of said base material and the metallic luster of the remaining metal coated layer by separating separation parts that are provided on at least part of said metal coated layer by emitting laser beam to symmetrically expose the front and back sides of the surface of said base material ([0018], [0026], [0027], and Figure 2); and a clear-coating layer is formed by coating the surfaces of the base material and metal coated layer with a synthetic-resin material having translucency, with the base material and the metal coated layer being exhibited, respectively, thereby protecting the surfaces of said decorative pattern produced by metallic luster with this clear-coating layer ([0019], [0028], and Figure 1) (Claim 5); and a surface decorative structure of an article formed by said method of processing (Claim 1).

E. The decorative structure of an article according to the Patented Inventions can simply form a decorative pattern of an optional design with a high-class image thanks to metallic luster by a difference between the appearance of the surface of the base material and the metallic luster of the remaining metal coated layer ([0032] and Figure 3). Therefore, the aforementioned purpose can be achieved.

2. Regarding Ground for Rescission 1 (error in the determination concerning the clarity requirement)

(1) Regarding the "metal material" in the Patented Inventions

A. The Patented Inventions are inventions for a "surface decorative structure" (Claims 1 to 4) and a "method of processing for a surface decoration" (Claims 5 to 8). The scope of claims states as follows with regard to the "metal material" in the Patented Inventions.

(A) metal coated layer (2), to which a metal material with metallic luster is fixed in a layered manner (Claims 1 and 5)

(B) on ... metal coated layer (2), in ... separation parts (21), the surface of said base material (1) is exposed, thereby forming a decorative pattern (P) by a difference between the appearance of said base material (1) and the metallic luster of the remaining metal coated layer (2) (Claim 1)

(C) the surfaces of said base material (1) are ... exposed ... separation parts (21) that are provided on ... metal coated layer (2) ... thereby exhibiting a decorative pattern (P) by a difference between the appearance of said base material (1) and the metallic luster of the remaining metal coated layer (2) (Claim 5)

B. According to A. above, in the Patented Inventions, the "metal material" is specified as a material "with metallic luster." Then, whether a certain substance falls under "metal" is not unambiguously clear (Exhibits Otsu 21 to 24). The Description also states alloys and other materials that are not just metals as those included in the metal material, and it specifically states as follows: "... metal, such as ...; alloy, such as ...; and silicon oxide, titanium oxide, indium tin oxide (ITO), diamond-like carbon (DLC), titanium nitride, and titanium carbide, etc." ([0024]). Furthermore, a decorative pattern (P), which is necessary for solving the problem in the Patented Inventions, is formed by a difference between the metallic luster produced by "metal coated layer (2)" to which this "metal material" is fixed in a layered manner and the appearance of base material (1) whose surfaces are exposed at separation parts (21), and no other property unique to metal is used. Therefore, it is reasonable to understand that materials that are hardly considered to fall under metal are also included in the aforementioned "metal material" if only they produce metallic luster while being fixed in a layered manner.

(2) Regarding the allegations of the plaintiff

A. The plaintiff alleges that the Patent lacks clarity [i] because Claims 3 and 7 include titanium oxide in the "metal material" despite the fact that titanium oxide does not fall under "metal" as it lacks conductive property and ductility unique to metal and [ii] because titanium oxide does not have metallic luster even if it is included in the "metal material."

However, even if titanium oxide is generally considered not to fall under metal, it cannot be said that the meaning and content of the "metal material with metallic luster" are not clear because materials that produce metallic luster while being fixed in a layered manner are also included in the "metal material" as mentioned in (1) above. Then, there is the following statement in Publication of Unexamined Patent Application No. 1995-2522 (Exhibit Ko 22): "[0002] ... a titanium oxide film made by fixing titanium oxide particles on a support ... has a high light reflectance, and the color tone of its reflection is beautiful silver. Therefore, it is used for ... as a material for decoration ...." Thus, a titanium oxide film sometimes produces silver-toned metallic luster. Therefore, it is clear that "titanium oxide" falls under the "metal material" in the Patented Inventions, and the Patent does not lack clarity at all.

B. The plaintiff alleges that Claims 3 and 7 lack clarity because the meaning of diamond-like carbon (DLC) stated in Claims 3 and 7 itself is unclear and Claims 3 and 7 include diamond-like carbon (DLC) in the "metal material."

Diamond-like carbon (DLC) is stated in publicly known documents prior to the filing of the

original application for the Patented Inventions, specifically, Patent Gazette No. 3372493 ([0002] in Exhibit Ko 23), Patent Gazette No. 2953673 (lines 7 to 16 in the right column of page 2 in Exhibit Ko 24), Publication of Unexamined Patent Application No. 1996-161726 ([0013] and [0014] in Exhibit Ko 25), Publication of Unexamined Patent Application No. 2000-160340 ([0002] in Exhibit Ko 42), Publication of Unexamined Patent Application No. 2004-279382 ([Claim 12], [Claim 13], [Claim 16], [0018], and [0031] in Exhibit Ko 43), and Publication of Unexamined Patent Application No. 2006-321232 ([0010], [0011], and [0024] in Exhibit Otsu 30). According to the statements in these documents, "diamond-like carbon (DLC)" stated in Claims 3 and 7 is recognized as having been known by persons ordinarily skilled in the art as a well-known material as of the filing date of the original application for the Patented Inventions. Therefore, it is impossible to say that the statements in Claims 3 and 7 are unclear on the grounds that the Description uses the notation "diamond-like carbon (DLC)."

Moreover, as DLC coat is recognized as having black-toned metallic luster ([0018] and [0031] in Exhibit Ko 43 and [0024] in Exhibit Otsu 30), "diamond-like carbon (DLC)" stated in Claims 3 and 7 is recognized as falling under the "metal material" in the Patented Inventions.

C. The plaintiff alleges that Claims 3 and 7 lack clarity because they include silicon oxide in the "metal material" despite the fact that silicon oxide does not fall under "metal" as it lacks conductive property and ductility.

However, a silicon oxide coat comprising  $\text{SiO}_x$  ( $X < 2$ ) produces metallic luster, taking into account that there is a statement to the effect that "In the case of sputtering with actuation gas whose oxygen concentration is 25 vol% or less, the produced coat is  $\text{SiO}_x$  ( $X < 2$ ) with metallic luster" (line 29 in the right column of page 108 to line 1 of the left column of page 109) in "Corrosion Behaviour of Inconel 617 Coated with Silicon Oxides in Impure Helium" ("The Journal of the Iron and Steel," vol. 71, no. 10 (1985); Exhibit Ko 38-1). Therefore, it is clear that "silicon oxide" stated in Claims 3 and 7 falls under the "metal material" in the Patented Inventions. Consequently, Claims 3 and 7 do not lack clarity at all.

D. The plaintiff alleges that the content of the phrase "such as ..." in the statement of the scope of claims is not clear.

However, Claim 2 specifies the means of forming metal coated layer (2) by citing Claim 1. Specifically, it states as follows and limits said means of forming to any of "electric plating," "electroless plating," "vacuum plating," and "hot dipping": "A surface decorative structure of an article stated in Claim 1 which is characterized in that metal coated layer (2) is formed by any one of electric plating; electroless plating ... vacuum plating ... and hot dipping." Then, the statements "such as chemical plating and substitution plating" and "such as vacuum vapor deposition, sputtering, ion plating, ion-beam vapor deposition, physical vapor deposition (PVD), and chemical vapor deposition (CVD)" are to indicate the examples of "electroless plating" and

"vacuum plating," respectively, out of the aforementioned means of forming, and they are not intended to limit "electroless plating" and "vacuum plating." In addition, "electroless plating" and "vacuum plating" are well-known among persons ordinarily skilled in the art. Therefore, the statements themselves are not unclear. Consequently, it cannot be immediately said that the statements in Claim 2 are unclear only because they include the phrase "such as ...."

Furthermore, regarding Claims 3, 4, and 6 to 8, the statement "... such as" is used to indicate the examples of the immediately preceding terms in all of these claims, and it is not intended to limit those terms. In addition, those terms are not unclear as statements in all of these claims. Therefore, it cannot be immediately said that these statements in Claims 3, 4, and 6 to 8 are unclear only because they include the phrase "such as ...."

### (3) Summary

Therefore, there is no reason for any of the plaintiff's allegations about lack of clarity.

### 3. Regarding Ground for Rescission 2 (error in the determination concerning the support requirement)

#### (1) Regarding the method of forming a silicon oxide coat

A. Regarding the method of forming a silicon oxide coat, the following is stated in publicly known documents prior to the original application for the Patented Inventions.

#### (A) Publication of Unexamined Patent Application No. 1996-164595 (Exhibit Ko 29)

As packaging materials ... for example, a film wherein a vapor deposition film is formed by such means as vacuum vapor depositing or sputtering inorganic oxide, such as silicon oxide ..., as stated in U.S. Patent No. 3442686 and Publication of Examined Patent Application No. 1988-28017, etc., on a polymer film by a method of forming, such as vacuum vapor deposition method and sputtering method, has been developed ([0005]).

... by a vacuum vapor deposition device based on the resistive heating method, silicon oxide was vapor-deposited about 40-nm thick on the resin layer ... ([0029]).

#### (B) "Corrosion Behaviour of Inconel 617 Coated with Silicon Oxides in Impure Helium" ("The Journal of the Iron and Steel," vol. 71, no. 10 (1985); Exhibit Ko 38-1)

One surface of the strip-shaped Inconel 617 was coated with ... silicon oxide ( $\text{SiO}_x$ ;  $0 < X \leq 2$ ) using a magnetron sputter system by the reactive sputtering method. The sputter actuation gas was  $\text{Ar} + Y\text{vol}\% \text{O}_2$  of 4Pa ( $0 \leq Y \leq 40$ ) (argon gas containing Yvol% oxygen), and R.F. input was 1kW (lines 10 to 17 in the left column of page 108).

B. According to the statement in A. above, it is recognized that the fact that the "silicon oxide" film stated in Claims 3 and 7 can be formed by means such as a vacuum vapor deposition method, sputtering method, and reactive sputtering method was a matter well-known among persons ordinarily skilled in the art as of the filing date of the original application for the Patented Inventions. All of these means of forming correspond to "vacuum vapor deposition"

and "sputtering," which are the examples of "vacuum plating" stated in Claims 2 and 6, which are cited in Claims 3 and 7, respectively.

In addition, the statement in the Description "... among ... metal materials ... oxides and nitrides can be generated by atmosphere gas within the chamber" ([0025]) is recognized as a statement suggesting that "silicon oxide" that is an "oxide" can be formed by "chemical vapor deposition (CVD)" which is stated as one example of "vacuum plating" in Claims 2 and 6.

Then, in Claims 2 and 6, the means of forming metal coated layer (2) is specified as "any one of electric plating; electroless plating ... vacuum plating ... and hot dipping." Therefore, it is clear that there is no ground for determining that "silicon oxide" must be formed by "electric plating" among the aforementioned several means of forming. The same also applies to "aluminum," "iron," "nickel," etc.

As mentioned above, the Description includes a statement suggesting that "silicon oxide" stated in Claims 3 and 7 can be formed by "vacuum plating" stated in Claims 2 and 6, and it is clear to persons ordinarily skilled in the art in light of the common general technical knowledge as of the filing date of the original application for the Patented Inventions that "silicon oxide" can be formed by "vacuum plating" stated in Claims 2 and 6. Then, it is also clear to persons ordinarily skilled in the art that "aluminum," "iron," and "nickel" that are well-known thin film materials can also be formed by any one of the aforementioned several means of forming.

Therefore, the statements in the claims are within the scope in which a person ordinarily skilled in the art can recognize that the problem to be solved of the invention can be solved in light of the common general technical knowledge as of the filing date of the original application, and the Patented Inventions are those stated in the detailed explanation of the invention.

#### (2) Regarding the "metal material"

The statements in Claims 3 and 7 do not eliminate the inclusion of sodium and uranium in the "metal" stated as an example of the "metal material." However, it is common general technical knowledge among persons ordinarily skilled in the art that sodium has the nature of vigorously reacting with water and that uranium is a radioactive metal harmful to the human body. Therefore, when seeing the Description, a person ordinarily skilled in the art understands that it is natural not to plan to use these metals for the Patented Inventions, which are inventions for a "surface decorative structure" (Claims 1 to 4) and a "method of processing for surface decoration" (Claims 5 to 8).

As mentioned above, it is clear that sodium and uranium are not included in the metal material of the Patented Inventions. Therefore, it cannot be said that the Patented Inventions fail to fulfill the support requirement on the grounds that the method of forming a coated layer comprising such metal is not stated in the detailed explanation of the invention.

#### (3) Summary

Consequently, there is no reason for the plaintiff's allegation to the effect that the Patented Inventions fail to fulfill the support requirement.

4. Regarding Ground for Rescission 3 (error in the determination concerning the enablement requirement)

(1) Regarding state of the art as of the filing date

Regarding the conditions for forming a thin film of materials that were specified as the "metal material" in Patented Inventions 3 and 7, there are the following statements in publicly known documents prior to the filing date of the original application for the Patented Inventions.

A. Specific conditions (composition and pressure of sputter actuation gas) for forming a thin film by a ion-beam sputter system or by a vapor deposition method are stated in Patent Gazette No. 3913902 ([0066], [0068], [0072], and [0073] in Exhibit Ko 28).

B. Specific conditions (temperature and current density) for forming a thin film by electric plating are stated in Publication of Unexamined Patent Application No. 1994-270597 ([0009] in Exhibit Ko 30).

C. Specific conditions (composition of gas, etc.) for forming a carbon thin film by the ECR plasma CVD method are stated in Publication of Unexamined Patent Application No. 1996-161726 ([0014] to [0016] in Exhibit Ko 25).

D. Specific conditions (evaporation source, electron gun, gas, film formation pressure, accelerating voltage, anode voltage, and filament voltage) for forming dry titanium nitride plating by the ion plating method, specific conditions (temperature, pH, and current density) for forming wet nickel plating by the wet plating method, specific conditions (target, sputtering gas, film formation pressure, target applied electric power, and bias voltage) for forming dry titanium plating by the sputtering method, specific conditions (gas, film formation pressure, guide bush voltage, anode voltage, and filament voltage) for forming a DLC coat by the CVD method, and specific conditions (target, sputtering gas, film formation pressure, target applied electric power, and bias voltage) for forming dry aluminum alloy plating by the sputtering method are stated in Publication of Unexamined Patent Application No. 2004-279382 ([0037], [0041], [0046], [0048], and [0052] in Exhibit Ko 43).

E. In addition, as mentioned in 3.(1)A.(B) above, specific conditions (composition of sputter actuation gas and R.F. input value) for forming silicon oxide ( $\text{SiO}_x$ ;  $0 < X \leq 2$ ) by the reactive sputtering method are stated in Exhibit Ko 38-1.

(2) Regarding the statement of the detailed explanation of the invention

In the detailed explanation of the invention in the Description, regarding the method of forming metal coated layer (2), there is the statement that "... any one of electric plating; electroless plating ... vacuum plating ... and hot dipping can be adopted" ([0022]). In addition, regarding the "ion plating method" that is included in the aforementioned "vacuum plating," it is

stated that, from the viewpoint of fixation, the surface of base material (1) is preferably subjected to pre-treatment and titanium plating is formed thereafter ([0023]). Moreover, the metal material of metal coated layer (2) is stated ([0024]). However, specific conditions in the aforementioned method of forming are not stated.

However, the aforementioned method of forming and metal material themselves are not especially new, and according to the statements in (1) above, they are both recognized as having been well-known among persons ordinarily skilled in the art as of the filing date of the original application for the Patented Inventions. When seeing the statement of the detailed explanation of the invention, a person ordinarily skilled in the art can determine specific conditions according to a method of forming without the need for excessive trial and error even if specific conditions are not stated. Therefore, the statement of the detailed explanation of the invention is recognized as being clear and sufficient as to enable any person ordinarily skilled in the art to work the Patented Inventions.

### (3) Summary

Therefore, there is no reason for the plaintiff's allegation to the effect that the Patented Inventions fail to fulfill the enablement requirement.

5. Ground for Rescission 4 (errors in the determinations concerning whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions)

#### (1) Regarding Cited Invention 1

A. Cited Document 1 (Exhibit Ko 3) roughly states as follows.

##### (A) Scope of claims

[Claim 1] A laser processing method wherein the metal layers of a double-sided metallized film, which comprises a polymer film base material whose total light transmittance is over 80%, are removed and the metal layers on both sides are simultaneously removed by using Q switched pulse laser as a laser that goes through the polymer film base material.

[Claim 2] A laser processing method stated in Claim 1 wherein said metal layers of both sides are 50 nm or less in thickness.

[Claim 3] A method of manufacturing an electrode for a biosensor wherein the metal layers of a double-sided metallized film are removed by the laser processing method stated in Claim 1 or 2.

##### (B) Technical field

This invention is a laser processing method intended to provide an optional shape on a base material made of a lamination of thin films, and in more detail, it concerns a laser processing method wherein the metal layers formed on both sides of a metallized film are removed into an optional shape ([0001]).

In addition, this invention concerns a method of manufacturing an electrode for a biosensor wherein the metal layers of a double-sided metallized film are removed by the aforementioned

laser processing method ([0002]).

#### (C) Background technology

An enzyme electrode method is suggested as a measuring method for a biosensor that simply determines the quantity of a specific component in a biological sample ([0003]).

An enzyme electrode wherein an electrode comprising a measurement pole, an opposite pole, and a reference pole is formed on an insulating base material and an enzyme layer ... is formed on this electrode is used in this enzyme electrode method. ... ([0004])

The electrode member of the enzyme electrode can be formed by providing a laminated precious metal layer of gold, platinum, palladium, etc. on an insulating polymer film base material by the sputtering method, etc. and removing part of said precious metal layer by laser processing ... ([0006]).

Furthermore, a biosensor of the system wherein enzyme electrodes are formed on both sides of an insulating base material is suggested ... With said biosensor, use of the same enzyme for multiple enzyme electrodes can enhance the reliability of determination of quantity. In addition, use of different enzymes for multiple enzyme electrodes enables simultaneous determination of the quantity of multiple components in sample solution ([0007]).

On the other hand, a method wherein laminated metal layers are provided on both sides of a transparent insulating base material and the metal layers on both sides are simultaneously removed by laser processing is suggested ... ([0008])

However, there was a problem that in the case of forming an electrode by removing the metal layers on both sides of the metallized film by using such a method, the metal layers on both sides cannot be completely removed by a single laser scanning and part of the metal layers remains on the insulating base material ([0009]).

#### (D) Problem to be solved of the invention

This invention is intended to provide an excellent laser processing method wherein an electrode is formed by simultaneously and completely removing the metal layers on both sides of a metallized film in consideration of such background of prior art ([0010]).

#### (E) Means for solving the problem

This invention adopts the following means to solve said problem. That is, the laser processing method according to this invention is a laser processing method wherein the metal layers of a double-sided metallized film, which comprises a polymer film base material whose total light transmittance is over 80%, are removed and the metal layers on both sides are simultaneously removed by using Q switched pulse laser as a laser that goes through said polymer film base material ([0012]).

Moreover, this invention is a method of manufacturing an electrode for a biosensor wherein the metal layers of a double-sided metallized film are removed by said laser processing method

([0013]).

(F) Effect of the invention

According to this invention, the metal layers on both sides can be simultaneously and completely removed by a single laser scanning ... this invention can provide an excellent laser processing method for forming an electrode used for a biosensor that is equipped with electrodes on both sides ... ([0014]).

(G) Best embodiment of the invention

This invention made it clear that said problem can be solved at once by using a special laser, Q switched pulse laser, as a laser that goes through the polymer film base material of the metallized film ... ([0015]).

In this invention, the term "metallized film" means a film wherein laminated metal layers are provided on both sides of a polymer film base material. According to this invention, the metal layers on both sides of the metallized film are removed and the polymer film base material is exposed at the part to which laser beam was emitted ([0016]).

The cross-section view of the metallized film before laser processing in this invention is indicated in Figure 1 (see Attachment 2). Said metallized film composes polymer film base material (1) and metal layers (2) and (3) ([0017]).

Figure 2 (see Attachment 2) indicates the cross-section view of the metallized film after laser processing in this invention. Laser processed parts (4) are the parts to which laser beam was emitted, and the metal layers on both sides are removed and polymer film base material (1) is exposed there ([0018]).

The polymer film base material of the metallized film in this invention is required to be made of a material that can let laser beam through. That is, total light transmittance measured based on JIS-K-7105 (1981 version) is required to be over 80%, and it is preferably over 85% and more preferably over 87%. If total light transmittance is lower than 80%, said polymer film base material is damaged due to accumulation of heat thereon, which is not preferable ([0019]).

Any metal can be used as a metal material which constitutes said metal layer if it is resistant to oxidization and is conductive. However, in particular, precious metals, such as gold, platinum, palladium, silver, ruthenium, rhodium, osmium, and iridium, are preferable because they can be suitably used for an electrode intended to electrically ascertain changes by chemical reactions, for example, an enzyme electrode for a biosensor, as they have good chemical stability. ... ([0024]).

The sputtering method, vacuum vapor deposition method, electron beam vapor deposition method, ion plating method, etc. can be cited as the methods of providing laminated metal layers on both sides of the metallized film in this invention. Among these, the sputtering method is especially preferable from the perspectives of the uniformity of thickness and adhesiveness,

etc. of the metal layer ([0026]).

Use of Q switched pulse laser is essential for the laser processing in this invention. Said Q switched pulse laser means laser which provides pulse oscillation and whose half width is over 10 nanoseconds but 300 nanoseconds or less. Use of said Q switched pulse laser makes it possible to simultaneously and completely remove the metal layers on both sides by a single laser scanning. Laser beam which provides continuous oscillation or whose half width is more than 300 nanoseconds is not preferable because it cannot completely remove the metal layers on both sides by a single laser scanning. In addition, pulse laser whose half width is less than 10 nanoseconds is not preferable either because it causes damage to the metallized film due to the rapid accumulation of heat on the metallized film ([0027]).

(H) Industrial applicability

This invention is used especially suitably as an excellent laser processing method for forming an electrode for a biosensor which has electrodes on both sides ... ([0051]).

B. Determination of Cited Invention 1, etc.

(A) The plaintiff does not dispute the technical content determined in the JPO Decision (No. 2, 3.(2)A) with regard to the determination of Cited Invention 1, but alleges that the subject of Cited Invention 1 is not limited to an electrode for a biosensor and that Cited Invention 1 is a highly general-purpose invention.

According to [Claim 1], [0001], [0008] to [0010], and [0051] in Cited Document 1, Cited Invention 1 can be said to be one that is especially suitably used for an electrode for a biosensor, but the subject of processing is not limited to an electrode for a biosensor, and Cited Invention 1 is recognized as technology pertaining to a laser processing method for removing the metal layers on both sides.

(B) Therefore, Cited Invention 1 is not an invention limited to an electrode for a biosensor but an invention pertaining to a laser processing method for removing the metal layers on both sides. Therefore, the JPO Decision contains an error in its determination that Cited Invention 1 is an invention limited to an electrode for a biosensor. More correctly, Cited Invention 1 should be determined as follows.

[Invention of a product] A product wherein a metal layer, which comprises a lamination of precious metal and other metal materials by the sputtering method, vacuum vapor deposition method, electron beam vapor deposition method, ion plating method, etc., is formed on the surfaces that are positioned on the front and back sides of a polymer film base material whose total light transmittance is over 80% / while laser-processed parts where the metal layers on both sides are simultaneously removed are symmetrically provided on the front and back sides on at least part of this metal layer by using Q switched pulse laser, and the surfaces of said polymer film base material are exposed at these laser-processed parts, thereby forming the

laser-processed parts.

[Invention of a process] A method of processing a product wherein a metal layer comprising a lamination of precious metal and other metal materials by the sputtering method, vacuum vapor deposition method, electron beam vapor deposition method, ion plating method, etc. is fixed in a layered manner on the surfaces that are positioned on the front and back sides of a polymer film base material whose total light transmittance is over 80%, / the metal layers on both sides are simultaneously removed by using Q switched pulse laser, thereby forming the laser-processed parts where the front and back sides of the surfaces of said base material are symmetrically exposed.

(C) Common features between Patented Invention 1 and Cited Invention 1 are as follows.

A structure of an article wherein a metal coated layer, to which a metal material with at least metallic luster is fixed in a layered manner, is formed on the surfaces that are positioned on the front and back sides of a base material made of a transparent or semi-transparent plastic material having translucency / while separation parts, which are provided by emitting laser beam, are symmetrically provided on the front and back sides on at least part of said metal coated layer, and the surfaces of said base material are exposed at said separation parts.

C. Features of Cited Invention 1

According to the statements in A. above, the features of Cited Invention 1 are recognized as follows.

(A) Cited Invention 1 concerns a laser processing method for removing metal layers formed on both sides of a metallized film into an optional shape ([0001] and [0002]).

(B) An enzyme electrode wherein an electrode comprising a measurement pole, an opposite pole, and a reference pole is formed on an insulating base material and an enzyme layer is formed on this electrode has been conventionally used in the enzyme electrode method suggested as a measuring method for a biosensor, ([0003] and [0004]). The electrode member of said enzyme electrode can be formed by providing a laminated precious metal layer on an insulating polymer film base material by the sputtering method, etc. and removing part of said precious metal layer by laser processing ([0006]). Furthermore, a biosensor of the system wherein enzyme electrodes are formed on both sides of an insulating base material is suggested, which makes it possible to enhance the reliability of determination of quantity and to simultaneously determine the quantity of multiple components ([0007]).

On the other hand, a method wherein laminated metal layers are provided on both sides of a transparent insulating base material and the metal layers on both sides are simultaneously removed by laser processing is suggested ([0008]). However, there was a problem in that the metal layers on both sides cannot be completely removed by a single laser scanning and part of the metal layers remains on the insulating base material ([0009]).

(C) Cited Invention 1 is intended to provide an excellent laser beam machining method wherein an electrode is formed by simultaneously and completely removing the metal layers on both sides of a metallized film in consideration of such background of prior art ([0010]).

Cited Invention 1 ([0012] and [0013]) is a laser processing method wherein a metal layer ([0026]) comprising a lamination of precious metal and other metal materials ([0024]) by the sputtering method, vacuum vapor deposition method, electron beam vapor deposition method, ion plating method, etc. is fixed in a layered manner on the surfaces that are positioned on the front and back sides of a polymer film base material ([0019]) whose total light transmittance is over 80%, the metal layers on both sides are simultaneously removed by using Q switched pulse laser ([0015] and [0027]), thereby forming the laser-processed parts where the front and back sides of the surfaces of said base material are symmetrically exposed, and a product formed by said processing method.

(D) In Cited Invention 1, the metal layers on both sides can be simultaneously and completely removed by a single laser scanning by using Q switched pulse laser as a means of simultaneously removing the metal layers fixed in a layered manner on both sides of the polymer film base material. Therefore, Cited Invention 1 can solve the conventional problem ([0014] and [0015]).

(2) Regarding Cited Invention 2

A. Cited Document 2 (Exhibit Ko 4) roughly states as follows.

(A) Art to which the invention pertains

Concerning a fishing rod or golf shaft having a decorative layer which can exploit the color tone of the foundation layer and furthermore can have the glittering appearance be shown and which is also light in weight ([0001]).

(B) Prior art

Various decorations have been applied to sports gear, such as finishing rods and golf shafts ... For example, Publication of Unexamined Patent Application No. 1993-153886 discloses a fishing rod wherein ... [the foundation layer] to which the prescribed paint is applied [, that is,] a coated film, is formed on the external surface of the rod material, seals on which patterns, such as marks and characters, are printed are attached to the external surface of the coated film, and ... a painted film is formed on the external surface of the seals ("First Prior Art") ([0002]).

Moreover, with weight saving of fishing tools and sports gear, the weight of the parts relating to decoration, such as a painted layer, in the total weight of members has been increasing, becoming a major cause of preventing the weight saving .... Therefore ... For example, Publication of Unexamined Patent Application No. 1995-79669 discloses an article wherein a thin laminated metal layer is provided on a synthetic resin foundation layer that is formed on the external surface of the body of the article and ... is used as a decorative layer.

("Second Prior Art") ([0003])

(C) Problem to be solved of the invention

However, the First Prior Art causes concavities and convexities by reason of logos and patterns, and abrasion at convex parts becomes a problem in these articles that are handled directly with hands. Therefore, it is not preferable. In addition, in the Second Prior Art ... the article has a certain uniform appearance. In trying to add the trade name, marks ... characters ... and patterns including decorations, it was necessary to further add processes ..., which made work more cumbersome and also caused an increase in costs ([0004]).

Therefore, the purpose of this invention is to easily and inexpensively provide a member that can present glittering appearance, taking advantage of the appearance of the color-painted foundation layer by changing the shapes of the color-painted foundation layer and the metal layer outside it and can also create a pattern with the texture (stereoscopic effect). In addition, the surface thereof is flat without irregularity, and therefore, an appearance and shape that is very preferable for handling can be obtained ([0005]).

(D) Means for solving the problem

... this invention is to express various shapes and color tones, including characters and patterns, by combining a resin decorative layer that is formed on the body of the base material and is colored and a thin metal layer that is formed outside said decorative layer. The metal layer ... can be made into a preferred shape ... can maintain a flat surface without irregularity because it is a thin film. Furthermore, this invention tries to improve quality by providing a transparent or semi-transparent protection layer on the metal layer or the resin decorative layer, and can also obtain a wide variety of rich color tones thanks to a synergetic effect with the paint on the bottom layer ([0006]).

(E) Embodiments of the invention

... For example, fishing rods, golf shafts, and those similar thereto fall under the members having a decorative layer to which this invention is applicable, and for example, the trade name, marks such as an indication of the manufacturer, characters indicating the function of the article, etc., and patterns including decorations, are applied on the decorative layer ([0007]).

Figure 1 (see Attachment 3) is the cross-section view pertaining to one embodiment of this invention. In this embodiment, color-painted layer 2 is formed on base material 1, and there are thin-film metal layer 3 that is patterned into the prescribed shape and a transparent or semi-transparent colored protection layer that is formed outside said thin-film metal layer 3 ([0008]).

Thin-film metal layer 3 ... be formed outside this colored resin decorative layer 2. As a method of forming ... thin-film metal layer on member body 1, for example, a physical vapor deposition (PVD) method, such as the sputtering method, vacuum vapor deposition method, and

ion plating methods, is used ([0011]).

This thin-film metal layer can be made into various shapes by masking processing using masking resin or seal, etc., and can express patterns and color tones that are full of originality through combination with colored resin decorative layer 1 that is the foundation ([0012]).

Thin-film metal layer 3 can be made of gold, silver, copper, iron, chrome, titanium, nickel, aluminum, palladium, or alloy thereof ... nitrides, carbides, carbonitrides, oxides, etc. of these metals are also adapted ([0013]).

The film thickness of thin-film metal layer 3 is not especially limited, but it is preferably between 0.01 to 5  $\mu\text{m}$  in terms of touch, and is also preferably within the range between 0.05 to 1  $\mu\text{m}$  in consideration of color tone and costs ([0014]).

Protection layer 4 can be formed by a transparent or semi-transparent resin, such as acrylic, urethane, epoxy resin. This protection layer 4 protects the foundation and also presents delicate color shade by a synergetic effect with metal layer 3 that is the foundation and colored resin decorative layer 1 if it is slightly colored. This can make the article be even more original ([0015]).

Masking layer 5 can be any masking resin or seal, etc. that is used for plating, and is not especially limited ([0016]).

#### (F) Effect of the invention

This invention makes it possible to express characters and logos of various shapes, patterns, and color tones by combining a colored resin decorative layer, a thin-film metal layer, and a protection layer on a fishing rod or golf shaft, etc. which is required to be lightweight and have design property, and can also provide an article presenting flat appearance with a comfortable touch without irregularity. In conventional methods, painting of the foundation was intended to obtain a smooth surface. On the other hand, this invention can simply and inexpensively provide an article with excellent design property through coloring, taking advantage of this painting of the foundation ([0017]).

#### B. Determination of Cited Invention 2

(A) Cited Document 2 (Exhibit Ko 4) is recognized as describing Cited Invention 2 (No. 2, 3.(2)K. above) as determined in the JPO Decision.

(B) The plaintiff alleges that the subject of the art of Cited Invention 2 is not limited to surface protection and that Cited Invention 2 also discloses the art of applying a pattern intended for decoration.

However, Cited Invention 2 as determined in the JPO Decision is not limited to surface protection. Therefore, the aforementioned allegation of the plaintiff differs in its premise, and there is thus no reason therefor.

#### C. Features of Cited Invention 2

According to the statements in A. above, the features of Cited Invention 2 are recognized as follows.

(A) Cited Invention 2 concerns a fishing rod or golf shaft having a decorative layer ([0001]).

(B) In the past, various decorations have been applied to sports gear, such as fishing rods and golf shafts. Examples of articles that have been known include a fishing rod wherein a coated film is formed on the external surface of the rod material, seals on which patterns, such as marks and characters, are printed are attached to the external surface of the coated film, and a painted film is formed on the external surface of the seals ("First Prior Art") ([0002]) and an article wherein, for the purpose of weight saving of a decorative layer, a thin laminated metal layer is provided on a synthetic resin foundation layer that is formed on the external surface of the body of the article and is used as a decorative layer ("Second Prior Art") ([0003]).

However, in the First Prior Art, abrasion at convex parts became a problem as a result of occurrence of concavities and convexities on the surface, and in the Second Prior Art, there was a problem that addition of processes is required to add additional patterns, which makes work more cumbersome and causes an increase in costs ([0004]).

(C) In consideration of the aforementioned problems, the purpose of Cited Invention 2 is to easily and inexpensively provide a member that can present glittering appearance, taking advantage of the appearance of the color-painted foundation layer by changing the shapes of the color-painted foundation layer and the metal layer outside it and can also create a pattern with the texture ([0005]).

(D) In Cited Invention 2, the aforementioned purpose was achieved by providing a thin-film metal layer that is patterned into the prescribed shape and a colored protection layer made of a transparent or semi-transparent resin, such as acrylic, urethane, and epoxy resin, outside said thin-film metal layer, on a base material, on which a color-painted layer is formed, in a fishing rod or golf shaft, etc. ([0006] to [0008] and [0011] to [0016]).

(E) Cited Invention 2 makes it possible to express characters and logos of various shapes, patterns, and color tones by combining a colored resin decorative layer, a thin-film metal layer, and a protection layer on a fishing rod or golf shaft, etc. which is required to be lightweight and have design property, and can also provide an article presenting flat appearance with a comfortable touch without irregularity ([0017]).

(3) Regarding Cited Invention 3

A. Cited Document 3 (Exhibit Ko 5) roughly states as follows.

(A) Industrial applicability

This invention concerns a simultaneous pattern formation method wherein a pattern is formed on both sides of a base plate coated with a thin film (from the fifth line to the second line from the bottom in the left column of page 1).

(B) Prior art

The photo-etching method is often used in the case of drawing the same pattern on thin films that are formed on both sides of a base plate, respectively (lines 6 to 8 in the right column of page 1).

The disadvantages of the aforementioned photo-etching method can be summarized as follows.

[i] The number of processes in the pattern formation process is large, and the process is complex and is non-productive. Furthermore, the large number of processes leads to the large number of production facilities.

[ii] The processing of etching solution is expensive, and the etching process requires skills. In addition, it is difficult to manage works.

[iii] A mask (original plate) is required for each different pattern shape.

[iv] Time and skills are required for adjusting the position of the mask in order to make the patterns on the front and back sides be same.

[v] As a photomask is used, the shape of the mirror is limited to those with a flat surface. It is difficult to apply the photo-etching method to a curved mirror.

[vi] The photo-etching method is not suitable for multiproduct production. Or, the production cost is high (line 12 in the upper right column to line 8 in the lower left column of page 2).

(C) Problem to be solved of the invention

The purpose of this invention is to provide a simultaneous pattern formation method which shortens the process by making it possible to simultaneously draw a pattern on thin films formed on both sides of a base plate without using a photomask or photoresist and can also form a highly accurate and qualitatively stable pattern on both sides of a base plate without requiring skills (from the ninth to third line from the bottom in the lower left column of page 2).

(D) Means for solving the problem and function and effect

(Structure) ... in the simultaneous pattern formation method according to this invention, laser beam is emitted from either of the sides of a base plate, which has a transparent conductive film or metal thin film on one side and a metal thin film on the other side and can let laser beam through, according to the desired pattern shape, thereby simultaneously removing the emitted parts of both of the aforementioned films to form the prescribed pattern on the front and back sides of the base plate.

Incidentally, it is preferred to form a transparent insulating film on the entire surface of said conductive film after the formation of the pattern for the purpose of protecting said conductive film.

(Function) According to the aforementioned structure, as a result of laser beam passing through the base plate, the parts of both films to which laser beam was emitted are melted and

evaporated, and the ground of the base plate is exposed. Therefore, if the laser beam or the base plate is scanned or moved according to the prescribed pattern shape, the prescribed pattern is simultaneously and identically formed on the front and back sides of the base plate. ...

(Effect) As a pattern is simultaneously formed by laser beam, the pattern formation process can be significantly shortened, and a position gap hardly occurs between the patterns on the front and back sides and the accuracy of the pattern positions is improved. Furthermore, the work processes are reduced because it is not necessary to use any masks or resists. In addition, the problem of waste liquid treatment ... does not arise because chemical treatment is not necessary. Furthermore, a pattern can be formed even where a base plate has a curve, which increases the freedom of choice of a pattern shape and pattern width. ... it is easier to respond to multiproduct production (the first line from the bottom in the lower left column of page 2 to line 5 in the upper right column of page 3).

#### (E) Working example

Figures 1 and 2 (see Attachment 4) indicates thin films, which are formed on both sides of transparent glass plate 3, which is the base plate, and in more detail, mirror 1 made by forming pattern 2 on metal thin film (Cr, etc.) 5 and transparent conductive film (ITO film) 4. Incidentally, Figure 2 is the II-II cross-section view of Figure 1. Both of said films 4 and 5 can be formed on both sides of transparent glass plate 3 by the vapor deposition method or sputtering method. In addition, transparent glass plate 3 can be either flat or curved (lines 9 to 16 in the upper right column of page 3).

Such mirror can electrically detect the degree of clouding of a mirror surface, and it can be used for an outer mirror of an automobile, etc. (lines 17 to 19 in the upper right column of page 3). This mirror 1 is formed as follows. That is, conductive film 4 and metal film 5 are formed on either side of transparent glass plate 3 and on the other side thereof, respectively, by the vapor deposition method or sputtering method, which is the same as the prior art indicated in Figure 5 (line 20 in the upper right column to line 4 in the lower left column of page 3).

Next, ... pattern formation process is indicated in Figure 3 (see Attachment 4). ... laser beam 10 emitted from a laser oscillator that is not indicated in the figures is converged with collecting lens 11, and the position of collecting lens 11 is adjusted so that focal point 12 is positioned near the surface of mirror 1 or inside transparent glass plate 3, thereby emitting laser beam 10 to mirror 1. ... As indicated in the figure, emitted laser beam 10 passes through transparent glass plate 3. As a result of emission of laser beam 10, the parts where laser beam 10 passed through on transparent conductive film 4 and metal thin film 5 facing it are simultaneously removed, and thereby, pattern grooves 2a and 2b are formed. Therefore, if laser beam 10 is scanned according to a pattern shape to be formed, pattern 2 as drawn in Figure 1 is identically and simultaneously formed on the front and back sides of mirror 1 (line 8 in the

lower left column to line 4 in the lower right column of page 3).

Furthermore, in this working example, as indicated in Figure 2, transparent insulating film 9 having good abrasion resistance, for example  $\text{SiO}_2$ , was formed on transparent conductive film 4, that is, the entire surface of mirror 1, by the vapor deposition method, etc., in order to protect said film 4 (lines 8 to 12 in the upper left column of page 4).

The explanation thus far showed an example wherein one of the thin films is formed with a transparent film. However, depending on the usage, it is possible to form both films with metal thin films and simultaneously form a pattern by emitting laser beam in the same manner as stated above. Figure 4 (see Attachment 4) indicates an example of a variation in the case where metal thin films 5 and 13 are formed on both sides of transparent glass plate 3. In the figure, (I) is the cross-section view of the state where a pattern is formed, and (II) is the cross-section view of the state where the entire surface of one side is coated with transparent insulating film 9, respectively (the second line from the bottom in the upper left column to line 7 in the upper right column of page 4).

#### B. Determination of Cited Invention 3

(A) Cited Document 3 (Exhibit Ko 5) is recognized as describing Cited Invention 3 as determined in the JPO Decision (No. 2, 3.(2)F. above).

(B) The plaintiff alleges that the art of Cited Invention 3 is not specialized in capacitance measurement but is general art relating to pattern formation by laser beam.

However, Cited Invention 3 as determined in the JPO Decision pertains to a "coated base plate," and its usage is not specialized in capacitance measurement. Therefore, the aforementioned allegation of the plaintiff differs in its premise, and there is thus no reason therefor.

#### C. Features of Cited Invention 3

According to the statements in A. above, the features of Cited Invention 3 are recognized as follows.

(A) Cited Invention 3 concerns a simultaneous pattern formation method wherein a pattern is formed on both sides of a base plate coated with a thin film (A.(A) above).

(B) The photo-etching method was often used in the case of drawing the same pattern on thin films that are formed on both sides of a base plate, respectively, in the past. However, the photo-etching method has many disadvantages (A.(B) above). In consideration of those disadvantages, the purpose of Cited Invention 3 is to provide a simultaneous pattern formation method which shortens the process by making it possible to simultaneously draw a pattern on thin films formed on both sides of a base plate without using a photomask or photoresist and can also form a highly accurate and qualitatively stable pattern on both sides of a base plate without requiring skills (A.(C) above).

(C) Cited Invention 3 is a method of processing a coated base plate wherein either of the surfaces that are positioned on the front and back sides of a base plate that can let laser beam through is coated with a transparent conductive film or a metal thin film and the other surface is coated with a metal thin film made of Cr, etc., the prescribed pattern is formed by simultaneously removing the emitted parts of said films by emitting laser beam and symmetrically exposing said parts on the front and back sides of said base plate, and a transparent insulating film is formed on the entire surface of said conductive film after said pattern is formed, thereby protecting the surfaces of said conductive film (A.(D) and (E) above) and a coated base plate formed by said processing method.

(D) As a pattern is simultaneously formed by laser beam in Cited Invention 3, the pattern formation process can be significantly shortened, and a position gap hardly occurs between the pattern on the front and back sides and the accuracy of the pattern positions is improved. Furthermore, the work processes are reduced because it is not necessary to use any masks or resists. In addition, the problem of waste liquid treatment does not arise because chemical treatment is not necessary. Furthermore, a pattern can be formed even where a base plate has a curve, which increases the freedom of choice of a pattern shape and pattern width. Therefore, it is easier to respond to multiproduct production (A.(D) above).

(4) Regarding an error in the determination concerning whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by citing Cited Document 1 as the primary cited document

A. Regarding differences

As stated in (1)B. above, Cited Invention 1 is an invention pertaining to a laser processing method wherein metal layers on both sides are removed. Therefore, differences between Patented Invention 1 and Cited Invention 1 are recognized as follows.

(A) Patented Invention 1 is a "surface decorative structure of an article" wherein a "decorative pattern is formed by a difference between the appearance of the base material and the metallic luster of the remaining metal coated layer." On the other hand, Cited Invention 1 is a product wherein "laser-processed parts are formed" on the front and back sides.

(B) In Patented Invention 1, "with the base material and metal coated layer being exhibited, respectively, their surfaces are coated with a clear-coating layer made of a synthetic-resin material having translucency, thereby protecting the surfaces of said decorative pattern produced by metallic luster." On the other hand, Cited Invention 1 is not of such structure (as stated in No. 2, 3.(2)C.(B) above).

B. Regarding whether a person ordinarily skilled in the art would have been able to easily conceive of the differences

Cited Invention 1 is an invention pertaining to a laser processing method, and is not limited

to an electrode for a biosensor. However, even in the case of using Cited Invention 1 for decorative purposes, Cited Invention 1 has metal layers that are symmetrically formed on the front and back sides of a polymer film whose total light transmittance is over 80%. On the other hand, according to [0006], [0012], and [0017] in Cited Document 2, a color-painted layer (the painted layer that serves as the foundation of the thin-film metal layer is colored) is recognized as essential in terms of decoration in Cited Invention 2. Therefore, it is recognized that there is a disincentive to combining Cited Invention 2 with Cited Invention 1.

### C. Summary

Consequently, it is hardly recognized that a person ordinarily skilled in the art would have been able to easily conceive of Patented Invention 1 based on Cited Invention 1, and the same also applies to Patented Inventions 2 to 4, which are obtained by further limiting Patented Invention 1. Furthermore, in the same manner as Patented Invention 1, it is hardly recognized that a person ordinarily skilled in the art would have been able to easily conceive of Patented Invention 5, which is a process patent, and the same also applies to Patented Inventions 6 to 8, which are obtained by further limiting Patented Invention 5. As mentioned in (1) above, the JPO Decision contains an error in its determination of Cited Invention 1, but contains no error in its conclusion to the effect that a person ordinarily skilled in the art would not have been able to easily conceive of the Patented Inventions based on Cited Invention 1.

(5) Regarding an error in the determination concerning whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by citing Cited Document 3 as the primary cited document

#### A. Regarding differences

Differences between Patented Invention 1 and Cited Invention 3 are recognized as stated in No. 2, 3.(2)H. above.

B. Regarding whether a person ordinarily skilled in the art would have been able to easily conceive of the differences

(A) Cited Invention 3 is an invention pertaining to a simultaneous pattern formation method wherein a pattern is formed on both sides of a base plate, and its usage is not limited to an outer mirror of an automobile, etc. However, a specific example of Cited Invention 3 is one that can be used for an outer mirror of an automobile, etc. as one that electrically detects the degree of clouding of a mirror surface with the pattern formed on the base plate, and it belongs to a field that has little relevance to decoration and it is neither disclosed nor suggested that said invention is used for decorative purposes.

In this regard, the plaintiff alleges that it is common general technical knowledge that laser processing technology is used a lot for processing for decorative purposes (Exhibits Ko 65 to 75). However, even if laser processing technology is widely used for decoration, it cannot be

immediately said that a person ordinarily skilled in the art would have been able to easily conceive of diverting Cited Invention 3, for which decorative usage has been neither disclosed nor suggested, into decorative purposes. Then, even if Cited Invention 1 is combined with Cited Invention 3, it does not lead to a structure having a "clear-coating layer made of a synthetic-resin material having translucency" of Patented Invention 1.

(B) In addition, while Cited Invention 3 has the front and back sides of a base plate that can let laser beam through, a color-painted layer (the painted layer that serves as the foundation of the thin-film metal layer is colored) is recognized as essential in terms of decoration in Cited Invention 2 as mentioned in (4)B above. Therefore, it is recognized that there is a disincentive to combining Cited Invention 2 with Cited Invention 3.

### C. Summary

Consequently, it is hardly recognized that a person ordinarily skilled in the art would have been able to easily conceive of Patented Invention 1 based on Cited Invention 3, and the same also applies to Patented Inventions 2 to 4, which are obtained by further limiting Patented Invention 1. Furthermore, in the same manner as Patented Invention 1, it is hardly recognized that a person ordinarily skilled in the art would have been able to easily conceive of Patented Invention 5, which is a process patent, and the same also applies to Patented Inventions 6 to 8, which are obtained by further limiting Patented Invention 5.

(6) Regarding whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by citing Cited Document 2 as the primary cited document

A. Whether it is appropriate to make an allegation by citing Cited Document 2 as the primary cited document

In an action to seek rescission of a JPO decision made concerning an invalidation trial, it is not permitted to allege a publicly known fact which was not examined and determined in the trial (1967 (Gyo-Tsu) 28, judgment of the Grand Bench of the Supreme Court of March 10, 1976, *Minshu*, Vol. 30, No. 2, at 79).

However, as far as publicly known facts examined in the trial are concerned, regarding the act of making an allegation that differs from the JPO decision in relation to common features with and differences from the invention subject to the trial, or the act of making an allegation that differs from the JPO decision in relation to combination of multiple publicly known facts in the case where multiple publicly known facts were examined and determined, it cannot be immediately said that these acts themselves exceed the framework of comparison with publicly known facts which were examined and determined in the trial. Therefore, it cannot be construed that such allegations are always prohibited in an action to seek rescission of a JPO decision.

As mentioned above, the JPO determined that a person ordinarily skilled in the art would not have been able to easily conceive of the Patented Inventions [i] by citing Cited Invention 1

as the primary cited document and combining Cited Invention 2 with it and [ii] by citing Cited Invention 3 as the primary cited document and combining Cited Invention 1 or 2 with it. As the premise thereof, the JPO also determined Cited Invention 2. The plaintiff alleges that the finding and determination in the JPO Decision are illegal in relation to [i] and [ii] and also alleges as a backup that a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by combining Cited Invention 1 or 3 with Cited Invention 2 while citing Cited Invention 2 as the primary cited document. The defendants also permit said allegations to be examined and determined in this action.

Cited Inventions 1 to 3 are publicly known facts that were examined as those falling under the inventions set forth in Article 29, paragraph (1), item (iii) of the Patent Act. Both of the parties permit the court to examine and determine whether a person ordinarily skilled in the art would have been able to easily conceive of the Patented Inventions by combining Cited Invention 2, which was recognized as the secondary cited document in the JPO Decision, with Cited Invention 1 or 3, both of which were recognized as the primary cited document in the JPO Decision, while citing Cited Invention 2 as the primary cited document in this action, and do not wish to go through examination and determination at the JPO. It is reasonable to understand that the court is permitted from the perspective of one-time solution of a dispute to examine and make a determination on the aforementioned allegations of the plaintiff in this case for which the allegations and proof of the parties in this regard have been thoroughly made.

Incidentally, as a result of the court's determination on the aforementioned allegations of the plaintiff, it is found that if the JPO decision to dismiss the request becomes final and binding, the plaintiff, who is one of the parties, is not permitted, pursuant to Article 167 of the Patent Act, to file again a new request for an invalidation trial to the effect that a person ordinarily skilled in the art would have been able to conceive of the Patented Inventions by combining Cited Invention 2 with Cited Invention 1 or 3 while citing Cited Invention 2 as the primary cited document. If the JPO Decision is rescinded, its binding force extends to the resumed trial.

#### B. Regarding the differences

As mentioned in (4)B above, a "color-painted layer" is essential in terms of decoration in Cited Invention 2, and the subject on which a "color-painted layer" is formed is specified as a fishing rod or golf shaft in Cited Invention 2.

Therefore, differences between Patented Invention 1 and Cited Invention 2 are recognized as follows: "In Patented Invention 1, the base material is a transparent or semi-transparent material having translucency, metal coated layers are formed on the front and back sides of the base material, and separation parts are symmetrically provided on the front and back sides by emitting laser beam to part of the metal coated layers. On the other hand, in Cited Invention 2, a separation part is provided on a fishing rod or golf shaft by conducting the masking processing

when forming a metal coated layer on one side of the base material on which a color-painted layer is formed."

C. Regarding whether a person ordinarily skilled in the art would have been able to easily conceive of the differences

(A) As mentioned in (4)B above, as a color-painted layer is an essential structure of Cited Invention 2, there is a disincentive to combining Cited Invention 1, which has a polymer film base material whose total light transmittance is over 80%, with Cited Invention 2. Furthermore, Cited Invention 2 concerns a decoration of a tube-shaped member, and it should be considered as involving considerable difficulty in providing metal layers inside and outside a tube.

(B) Moreover, as mentioned in (5)B.(B) above, as Cited Invention 3 has the front and back sides of the base plate which can let laser beam through, there is a disincentive to combining Cited Invention 3 with Cited Invention 2 for which a color-painted layer is an essential structure.

D. Summary

Therefore, it is hardly recognized that a person ordinarily skilled in the art would have been able to easily conceive of Patented Invention 1 based on Cited Invention 2, and the same also applies to Patented Inventions 2 to 4, which are obtained by further limiting Patented Invention 1. Furthermore, in the same manner as Patented Invention 1, it is hardly recognized that a person ordinarily skilled in the art would have been able to easily conceive of Patented Invention 5, which is a process patent, and the same also applies to Patented Inventions 6 to 8, which are obtained by further limiting Patented Invention 5.

6. Conclusion

As mentioned above, there is no reason for all of the grounds for rescission alleged by the plaintiff. Therefore, the plaintiff's claim shall be dismissed, and the judgment shall be rendered in the form of the main text.

Intellectual Property High Court, Fourth Division

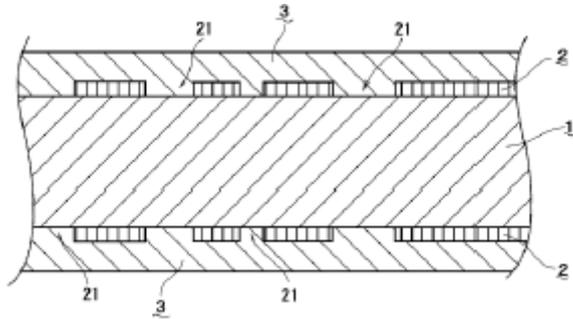
Presiding judge: TAKABE Makiko

Judge: FURUKAWA Kenichi

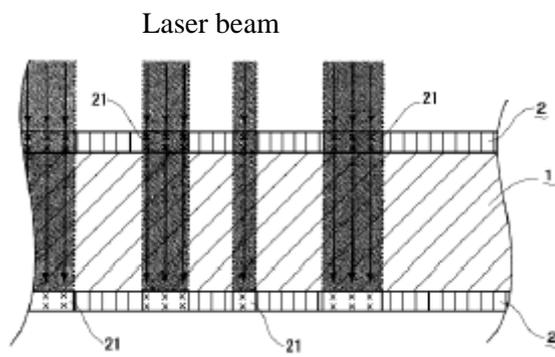
Judge: SUZUKI Wakana

Attachment 1 (Patented Inventions)

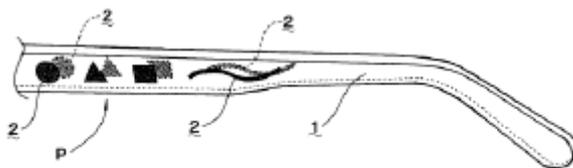
[Figure 1]



[Figure 2]

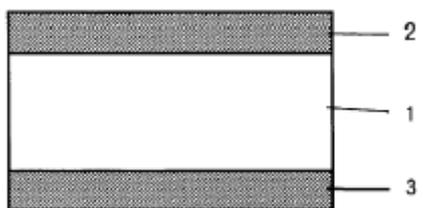


[Figure 3]

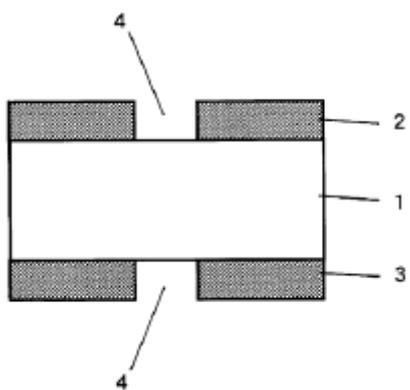


Attachment 2 (Cited Invention 1)

[Figure 1]

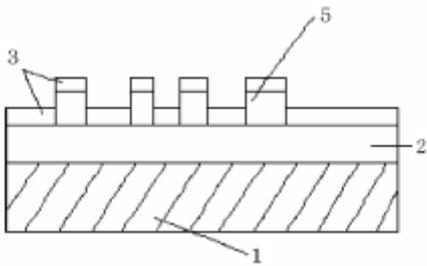


[Figure 2]



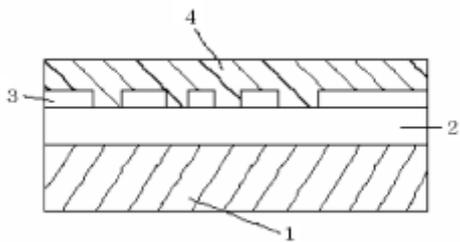
Attachment 3 (Cited Invention 2)

[Figure 1]



Cross-section view indicating the masking process of the metal decorated layer pertaining to the working of this invention

[Figure 2]



Cross-section view indicating the final process of the metal decorated layer pertaining to the working of this invention

Attachment 4 (Cited Invention 3)

Figure 1

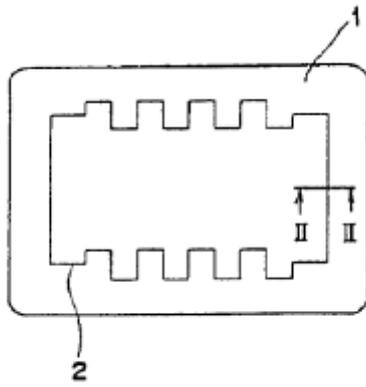


Figure 2

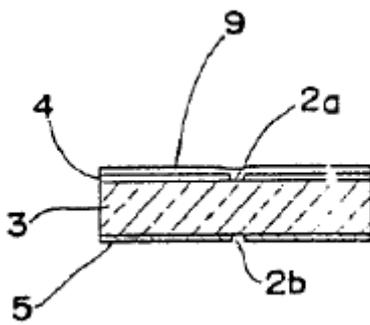


Figure 3

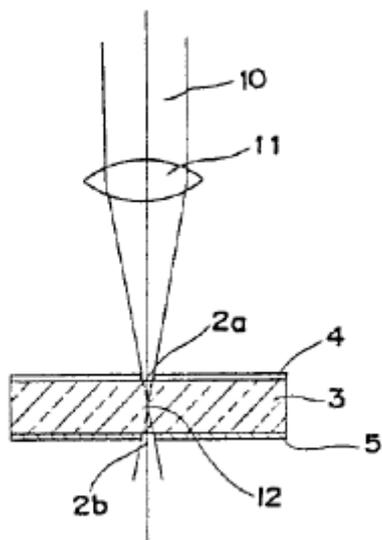


Figure 4

