Patent Right	Date	March 9, 2023	Court	Intellectual Property High Court, Fourth Division
	Case number	2022 (Gyo-Ke) 10030		
- A case in which a patent revocation decision in which correction was not allowed has been rescinded on the grounds that matters corrected in a request for correction as filed during procedures of an opposition to a granted patent correspond to restriction and that there is no addition of new matter.				

Case type: Rescission of Patent Revocation Decision

Result: Granted

References: Article 120-5, paragraph (2), item (i), and paragraph (9), and Article 126, paragraph (5) of the Patent Act

Related rights, etc.: Patent No. 6547817

Revocation Decision: Opposition No. 2019-701046

Summary of the Judgment

1. The Opponent filed an opposition to a granted patent with regard to the Plaintiff's patent (Patent No. 6547817) titled "LAMINATE OF POLYESTER RESIN COMPOSITION," on December 20, 2019.

During procedures of the opposition to the granted patent, the Plaintiff filed a request for correction and made correction as follows: in the scope of claims, the recitation "according to any one of Claims 1 to 3" in Claim 4 was corrected to read "according to Claim 2 or 3", and Claims 5 to 14 which depend on Claim 4 were corrected similarly (Correction Matter 1); Claim 4 was made to be independent Claim 15 by resolving a dependence relationship in which Claim 4 depends on Claim 1, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" was added immediately before "." at the end (Correction Matter 2); and Claims 8 to 14 were also made to be independent claims by resolving a dependence relationship in which each of Claims 8 to 14 depends on Claim 4 which further depends on Claim 1, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" was added immediately before "." at the end (Correction Matters 3 to 9).

(Claim 1 before correction)

A laminate having at least two layers,

wherein a first layer consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester

consisting of a diol unit and a dicarboxylic acid unit as a main component, wherein said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester,

wherein a second layer consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material.

(Claim 4 before correction)

The laminate according to any one of Claims 1 to 3, wherein said resin composition further comprises an additive.

(Claim 15 after correction)

A laminate having at least two layers,

wherein a first layer consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit as a main component, and further comprises an additive, wherein said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester,

wherein a second layer consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material (except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film).

2. The Japan Patent Office determined as follows: [i] in Correction Matters 2 to 9, adding the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is to specify the constituent feature "on the laminate" other than the constituent feature "a laminate having at least two layers" in an invention according to Claim 4 in the scope of claims, and is not to specify the constituent feature "a laminate having at least two layers" itself and specifications such as

properties and shape of the layer which constitutes the laminate in the invention according to Claim 4 in the scope of claims before correction of the present case, and thus, such adding the matter does not correspond to the purpose of "restriction of the scope of claims" provided in item (i) of the proviso to Article 120-5, paragraph (2) of the Patent Act and does not also correspond to any of purposes provided in items other than item (i) of the proviso to the same paragraph as well, and therefore, the correction of the present case cannot be allowed; and [ii] Present Inventions 1 to 14 before correction lack an inventive step.

3. In a suit of the present case, the Japan Patent Office added an assertion that the request for correction of the present case adds new matter.

4. The Court rescinded the revocation decision of the present case on the following grounds: [i] since Claim 1 before correction merely specifies "a laminate having at least two layers" with regard to "a laminate", the laminate according to Claim 1 before correction includes a laminate (hereinafter referred to as "laminate A") consisting of "a first layer", "a second layer", and "a vapor-deposited film of an inorganic oxide" and "a gas barrier coated film is provided on the vapor-deposited film", and Correction Matter 2 can be deemed to exclude laminate A from the laminate according to Claim 1 before correction including "laminate A", which narrows a technical invention of the invention according to Claim 4 before correction, and thus, Correction Matter 2 corresponds to the purpose of restriction of the scope of claims; [ii] even if the presence or absence of addition of new matter, which was not examined / determined in the opposition procedures, may be examined / determined in the present case, excluding "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" according to Correction Matter 2 does not have any influence on a technical problem "to provide a laminate having a layer consisting of a resin composition containing a carbon neutral polyester using biomass ethylene glycol and to provide a laminate of a polyester resin film which bears comparison in physical properties such as mechanical properties with a laminate produced from a raw material obtained from a conventional fossil fuel" ([0008]), and thus, no new technical matter has been introduced.

Judgment rendered on March 9, 2023
2022 (Gyo-Ke) 10030 Case of seeking rescission of a decision to revoke a patent
Date of conclusion of oral argument: December 21, 2022

Judgment

Plaintiff: Dai Nippon Printing Co., Ltd.

Defendant: Commissioner of the Japan Patent Office

Main text

1. A decision rendered by the Japan Patent Office (JPO) on Opposition No. 2019-701046 on March 22, 2022 shall be rescinded.

2. The defendant shall bear the court costs.

Facts and reasons

No. 1 Claim

The same gist as the main text.

No. 2 Outline of the case

1. Outline of Procedures, etc. at the JPO (undisputed by the parties)

(1) The Plaintiff filed an application of Patent Application No. 2010-244721 on October 29, 2010 (hereinafter referred to as the "filing date of the original application"). With regard to a part of the application of Patent Application No. 2010-244721, the Plaintiff filed a new application of Patent Application No. 2016-49799 on March 14, 2016. Further, with regard to a part of the application of Patent Application No. 2016-49799, the Plaintiff filed a new application on December 6, 2017, for which establishment of a patent right was registered on July 5, 2019 (Patent No. 6547817; Number of claims: 14; hereinafter, this patent will be referred to as the "Present Patent"), and the gazette in which the patent appears was issued on the 24th of the same month.

(2) With regard to the Present Patent, an opposition to a granted patent was filed on December 20, 2019. The Japan Patent Office examined this opposition as Opposition No. 2019-701046, issued a written notice of grounds for revocation on June 2, 2020, and issued a notice of grounds for revocation (an advance notice of decision) on January 26, 2021.

The Plaintiff submitted a written request for correction and a written opinion on March 29 of the same year, and submitted a written amendment to amend the request for correction in the above-mentioned written request for correction on April

23 of the same year (hereinafter, this amended request for correction will be referred to as the "Request for Correction of the Present Case," and the correction itself will be referred to as the "Correction of the Present Case").

The Japan Patent Office issued a written notice of grounds for rejection of correction on July 6, 2021. In response thereto, the Plaintiff submitted a written opinion on August 6 of the same year.

(3) The Japan Patent Office did not allow the Correction of the Present Case and rendered a decision that "The patent according to Claims 1 to 14 of Patent No. 6547817 shall be revoked" on March 22, 2022 (hereinafter referred to as the "Revocation Decision of the Present Case"), a certified copy of which was served on the Plaintiff on March 31, 2022.

(4) The Plaintiff instituted an action of the present case for seeking rescission of the Revocation Decision of the Present Case on April 28, 2022.

2. Recitation of Scope of Claims and Content of Correction of Present Case

The inventions according to Claims 1 to 14 of the Present Patent before the Correction of the Present Case (hereinafter referred to as "Present Invention 1," etc. and collectively referred to as the "Present Invention") and the content of the Correction of the Present Case are as follows.

(1) Present Invention

[Claim 1]

A laminate having at least two layers,

wherein a first layer consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit as the main component, wherein said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester,

wherein a second layer consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material.

[Claim 2]

The laminate according to Claim 1, wherein said resin composition further comprises a recycled polyester of a polyester in which the diol unit is a fossil fuel-

derived diol or a biomass-derived ethylene glycol, and the dicarboxylic acid unit is a fossil fuel-derived dicarboxylic acid.

[Claim 3]

The laminate according to Claim 2, wherein said resin composition comprises said recycled polyester in a range of 5 to 45 mass % with respect to the entire resin composition.

[Claim 4]

The laminate according to any one of Claims 1 to 3, wherein said resin composition further comprises an additive.

[Claim 5]

The laminate according to Claim 4, wherein said resin composition comprises said additive in a range of 5 to 50 mass % with respect to the entire resin composition.

[Claim 6]

The laminate according to Claim 4 or 5, wherein said additive is one or more selected from the group consisting of a plasticizer, an ultraviolet stabilizer, an anti-coloring agent, a matting agent, a deodorant, a flame retardant, a weatherproofing agent, an antistatic agent, a yarn friction reducer, a mold release agent, an antioxidant, an ion exchanger, and a coloring pigment.

[Claim 7]

The laminate according to any one of Claims 1 to 6, further having a third layer consisting of an inorganic substance or inorganic oxide.

[Claim 8]

A laminated film provided with the laminate according to any one of Claims 1 to 7.

[Claim 9]

A packaging bag provided with the laminate according to any one of Claims 1 to 7.

[Claim 10]

A sheet molded article provided with the laminate according to any one of Claims 1 to 7.

[Claim 11]

A label material provided with the laminate according to any one of Claims 1 to 7.

[Claim 12]

A lid material provided with the laminate according to any one of Claims 1 to 7.

[Claim 13]

A laminated tube provided with the laminate according to any one of Claims 1 to 7.

[Claim 14]

A packaging product provided with the laminate according to any one of Claims 1 to 7.

(2) Content of Correction of Present Case

A. Correction Matter 1 (Correction According to Claim 4 among Group of Claims Consisting of Claims 4 to 14)

The recitation "according to any one of Claims 1 to 3" in Claim 4 in the scope of claims is corrected to recite "according to Claim 2 or 3."

In addition, Claims 5 to 14, which depend on Claim 4, are also corrected in the same manner.

B. Correction Matter 2 (Correction According to Claim 15 after Correction)

By resolving a dependence relationship in which Claim 4 depends on Claim 1 in the scope of claims, original Claim 4 is made to be Claim 15 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

C. Correction Matter 3 (Correction According to Claim 16 after Correction)

By resolving a dependence relationship in which Claim 8 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 8 is made to be Claim 16 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

D. Correction Matter 4 (Correction According to Claim 17 after Correction)

By resolving a dependence relationship in which Claim 9 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 9 is made to be Claim 17 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

E. Correction Matter 5 (Correction According to Claim 18 after Correction)

By resolving a dependence relationship in which Claim 10 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 10 is made to be Claim 18 which is an independent claim, and the matter "(except for one in which a

vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

F. Correction Matter 6 (Correction According to Claim 19 after Correction)

By resolving a dependence relationship in which Claim 11 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 11 is made to be Claim 19 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

G. Correction Matter 7 (Correction According to Claim 20 after Correction)

By resolving a dependence relationship in which Claim 12 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 12 is made to be Claim 20 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

H. Correction Matter 8 (Correction According to Claim 21 after Correction)

By resolving a dependence relationship in which Claim 13 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 13 is made to be Claim 21 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

I. Correction Matter 9 (Correction According to Claim 22 after Correction)

By resolving a dependence relationship in which Claim 14 depends on Claim 4 which further depends on Claim 1 in the scope of claims, original Claim 14 is made to be Claim 22 which is an independent claim, and the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is added immediately before "." at the end.

(3) Group of Claims

With regard to Claims 4 to 14 before the Correction of the Present Case, since Claims 5 to 14 cite the recitation of Claim 4 to be corrected in the Request for Correction of the Present Case, the Correction of the Present Case is requested for a group of claims (4 to 14).

In the Correction of the Present Case, Claim 4 which depends on Claim 1 in the scope of claims is made in an independent form (Claim 15 in the scope of claims after the Correction of the Present Case), and Claims 8 to 14 which depend on Claim 4 which further depends on Claim 1 in the scope of claims are each made in an independent form (Claims 16 to 22 in the scope of claims after the Correction of the Present Case), which resolves a dependence relationship with Claim 1 and Claim 4 in the scope of claims. The Plaintiff, who is the Patentee, requests that if the correction for the purpose of resolving these dependence relationships, etc. is allowed, the correction for Claims 15 to 22 in the scope of claims after the Correction of the Present Case be each handled as a separate unit of correction.

3. Gist of Revocation Decision of Present Case

(1) The gist of grounds for Revocation Decision of the Present Case concerning the issues of the present case is the following: [i] in Correction Matters 2 to 9 of the present case, adding the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)" is to specify the constituent feature "on the laminate" other than the constituent feature "a laminate having at least two layers" in the invention according to Claim 4 in the scope of claims, and is not to specify the constituent feature "a laminate having at least two layers" itself and specifications such as properties and shape of the layers which constitute the laminate in the invention according to Claim 4 in the scope of claims before the Correction of the Present Case, and thus, Correction Matter 2 does not fall under the purpose of "restriction of the scope of claims" provided for in item (i) of the proviso to Article 120-5, paragraph (2) of the Patent Act and does not also fall under any of purposes provided for in items other than item (i) of the proviso to Article 120-5, paragraph (2) of the Patent Act as well, and therefore, the Correction of the Present Case cannot be allowed; [ii] Present Invention 1 could have been easily made by a person ordinarily skilled in the art on the basis of an invention stated in Unexamined Patent Application Publication No. 2007-210208 (hereinafter referred to as "Cited Document 4") (hereinafter referred to as the "Cited Invention") and the matter stated in Unexamined Patent Application Publication No. 2009-91694 (hereinafter referred to as "Cited Document 5") (details omitted), Present Inventions 2 and 3 could have been easily made by a person ordinarily skilled in the art on the basis of the Cited Invention, the matter stated in Cited Document 5, and the well-known art, and Present Inventions 4 to 14 could have been easily made by a person ordinarily skilled in the art on the basis of the Cited Invention, the matter stated in Cited Document 4 (relevant passages of

[0023], [0027], and [0028]), the matter stated in Cited Document 5, and the well-known art.

(2) Gist of Cited Invention Found by Revocation Decision of Present Case, Common Feature and Difference between Present Inventions 1 to 14 and Cited Invention, and Determination Whether Differences 1 and 2 from Cited Invention Can Be Easily Conceived

As stated in Attachment 1, 1.

4. Grounds for Rescission

(1) Error in Determination on Correction Requirement (Grounds 1 for Rescission)

(2) Error in Determination on Inventive Step of Present Invention Based on Cited Invention (Grounds 2 for Rescission)

(3) Violation of Procedure (Grounds 3 for Rescission)

(omitted)

No. 4 Judgment of this court

1. Present Invention

(1) The description of the present case contains statements on the Present Invention as shown in Attachment 2.

(2) According to the stated matters mentioned in (1) above, it can be found that the description of the present case contains the following disclosures on the Present Invention.

A. The Present Invention relates to a laminate having a layer which consists of a biomass polyester resin composition obtained from a plant-derived raw material, and more particularly to a laminate having a first layer which consists of a resin composition comprising polyester using a biomass-derived ethylene glycol as a diol component ([0001]).

B. In recent years, for the development of a recycling-oriented society, a departure from fossil fuels has been desired in the materials sector as well as in the energy sector, and the utilization of biomass which is so-called carbon neutral and renewable has been attracting attention ([0003]).

C. A problem of the Present Invention is to provide a laminate having a layer which consists of a resin composition containing a carbon neutral polyester using a biomass ethylene glycol, in which the laminate bears comparison in physical properties such as mechanical properties with a laminate produced from a raw material obtained from a conventional fossil fuel ([0008]).

D. The Present Invention achieves the above-mentioned object of the Present Invention by the structure "a laminate having at least two layers" comprising "a first layer" and "a second layer."

The "first layer" is a layer which "consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit as the main component, wherein said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester." Further, the "second layer" is a layer which "consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material" ([0009]).

E. By adopting the structure of the Present Invention, a laminate having a layer which consists of a carbon neutral resin can be achieved, the amount of fossil fuels used can be greatly reduced, and the environmental burden can be reduced. In addition, the laminate of the polyester resin composition of the Present Invention uses a polyester resin composition which bears comparison in physical properties such as mechanical properties with a laminate of a polyester resin composition produced from a raw material obtained from a conventional fossil fuel, and can therefore replace the conventional laminate of the polyester resin composition ([0020]).

2. Grounds 1 for Rescission (Error in Determination on Correction Requirement)

(1) Purpose of Correction

A. Correction Matter 2 is to make original Claim 4, which depends on Claim 1, to be Claim 15 which is a new independent claim, and to add the matter "(except for one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film)".

Since the "laminate" is merely specified as a "laminate having at least two layers" in Claim 1 before correction, the laminate as used herein includes a laminate consisting of "a first layer," "a second layer," and other optional layers. In this regard, "a vapor-deposited film of an inorganic oxide" and "a gas barrier coated film" "provided on the vapor-deposited film" also form a layer and thus correspond to these optional layers. Therefore, the "laminate" in Claim 1 before correction includes a laminate consisting of "a first layer," "a second layer," and "a vapor-deposited film of

an inorganic oxide" and "a gas barrier coated film" "provided on the vapor-deposited film" (hereinafter referred to as the "laminate A").

Then, Correction Matter 2 can be deemed to exclude the laminate A from the laminate according to Claim 1 before correction including the "laminate A." By specifying the laminate in this manner, a technical invention in the invention according to Claim 4 before correction is narrowed. Therefore, it is clear that Correction Matter 2 falls under the purpose of restriction of the scope of claims provided for in item (i) of the proviso to Article 120-5, paragraph (2) of the Patent Act.

B. The Defendant asserts, as mentioned in No. 3, 1(2)A(A) above, that Correction Matter 2 is not recited in such a manner that "a vapor-deposited film of an inorganic oxide" and "a gas barrier coated film" thereon which are made constituent features inside the "laminate" are excluded from the "laminate," but is recited in such a manner that one in which "a vapor-deposited film of an inorganic oxide" is newly provided "on" the "laminate," which corresponds to outside the "laminate," and "a gas barrier coated film" is further provided thereon is excluded, and that the scope itself of the "laminate" is not therefore restricted. However, the matter for specifying the Present Invention is not a laminate completed by "a first layer" and "a second layer," but falls under a so-called open claim in which the invention for which a patent is sought is specified as all laminates having "a first layer" and "a second layer." Thus, in specifying the specific layer structure included in the scope of the right, it is meaningless to formally distinguish between the inside and outside of the laminate (all of the layers outside "a first layer" and "a second layer" are constituent features of the "laminate" in the Present Invention). Further, as mentioned in A above, the specific content of "one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film" is a laminate provided with "a first layer" and "a second layer" as well as "a vapor-deposited film of an inorganic oxide" and "a gas barrier coated film" "provided on the vapor-deposited film," and thus cannot be distinguished from the laminate A. Therefore, Correction Matter 2 is a correction in which the laminate A is excluded from the laminate before correction, which restricts the scope of the "laminate."

In addition, the Defendant asserts that it should be deemed that a correction which makes "disclaimer" as in Correction Matter 2 of the present case may cause third parties to misunderstand the statement of the description, etc. and has high probability of giving unforeseen disadvantages to third parties. However, even if

there are such concerns as the Defendant asserts, it should be deemed to be an issue which should be examined concerning whether the claims after correction comply with the clarity requirement and the support requirement, etc. Thus, in any case, it is not reasonable to immediately regard this point as the reason why the correction is not allowed in the present case.

C. As mentioned in the foregoing, the Revocation Decision of the Present Case is erroneous in determining that Correction Matter 2 does not fall under the purpose of restriction of the scope of claims.

In addition, the Revocation Decision of the Present Case is erroneous also in determining that Correction Matters 3 to 9 do not fall under the purpose of restriction of the scope of claims.

(2) Presence or Absence of Addition of New Matter

A. Even if the presence or absence of addition of new matter which is not examined and determined in the opposition procedures could be examined and determined in the present case, it cannot be recognized that Correction Matter 2 adds new matter.

That is, in a case where a correction does not introduce new technical matter in relation to the technical matter which a person ordinarily skilled in the art derives by taking into overall consideration the entire statement of the description or drawings, it should be construed that the correction is made "within the scope of the matters indicated in the description or drawings." In this regard, excluding "one in which a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film is provided on the vapor-deposited film" according to Correction Matter 2 does not introduce new technical matter and does not add new matter.

The problem of the Present Invention is to provide a laminate having a layer which consists of a resin composition containing a carbon neutral polyester using a biomass ethylene glycol and to provide a laminate of a polyester resin film which bears comparison in physical properties such as mechanical properties with a laminate produced from a raw material obtained from a conventional fossil fuel ([0008]). However, excluding the matter mentioned above does not have any influence on this technical problem.

B. The Defendant asserts, as mentioned in No. 3, 1(2)A(B), that to the problem of the Present Invention, Correction Matter 2 adds "a vapor-deposited film of an inorganic oxide is provided on the laminate, wherein a gas barrier coated film" "on the vapor-deposited film" which is a means for solving a problem in the Cited Document thereby to add new technical matter, and that based on the added matter as

a premise, Correction Matter 2 excludes it and thus introduces new technical matter.

However, the technical matter which remains after excluding according to Correction Matter 2 does not have any new technical element as compared to that before the Correction of the Present Case. Therefore, the Defendant's assertion is not acceptable.

Further, all of other points asserted by the Defendant are not also acceptable in light of those already held in (1)B mentioned above.

C. Correction Matters 3 to 9 are similar to those mentioned in A and B above and also do not introduce new matter.

(3) Summary

As mentioned in (1) and (2) above, the Correction of the Present Case falls under the restriction of scope of claims and does not fall under the addition of new matter. The Defendant also asserts other matters at great length, but none of them are sufficient to affect the above-mentioned conclusion. Then, without going so far as to determine other issues, the Correction of the Present Case complies with the correction requirement, and the Revocation Decision of the Present Case is erroneous in determining to deny this. In this regard, since the Revocation Decision of the Present Case does not allow the Correction of the Present Case, the inventions according to Claims 15 to 22 after correction have not been determined on other requirements than the requirement of the purpose of correction, and it has not been finalized whether or not a patent can be granted.

Thus, it is clear that there is a possibility that the above-mentioned error in the determination affects the conclusion of the Revocation Decision of the Present Case.

Therefore, Grounds 1 for Rescission asserted by the Plaintiff are well founded.

3. Conclusion

As mentioned in the foregoing, since Grounds 1 for Rescission are well founded, the Revocation Decision of the Present Case shall be revoked without going so far as to determine other grounds for rescission, and the judgment is rendered as mentioned in the main text.

Intellectual Property High Court, Fourth Division

Presiding Judge: KANNO Masayuki

Judge: MOTOYOSHI Hiroyuki

Judge: OKAYAMA Tadahiro

(Attachment 1)

1. Gist of Cited Invention Found by Revocation Decision of Present Case, Common Feature and Difference between Present Inventions 1 to 14 and Cited Invention, and Determination Whether Differences 1 and 2 from Cited Invention Can Be Easily Conceived

(1) Cited Invention

A laminate material for packaging as a packaging bag, which is provided with a gas barrier laminate film, a printed layer, a laminating adhesive layer, and a heat sealable resin layer sequentially, wherein the gas barrier laminate film comprises a substrate consisting of a biaxially-oriented polyethylene terephthalate film, in which a vapor-deposited film of an inorganic oxide is provided on the substrate wherein a gas barrier coated film is provided on the vapor-deposited film, and wherein the heat sealable resin layer consists of a film or sheet of ethylene-α-olefin copolymer polymerized using a metallocene catalyst.

(2) Common Feature and Difference between Present Inventions 1 to 14 and Cited Invention

A. Common Feature

A laminate having at least two layers,

wherein a first layer consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit as the main component, and

wherein a second layer consists of a resin material.

B. Difference between Present Inventions 1 to 14 and Cited Invention

(A) Difference 1 (Common in Present Inventions 1 to 14)

With regard to the "first layer" which "consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit as the main component," in Present Invention 1, "said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester." In contrast, in the Cited Invention, this point is unclear.

(B) Difference 2 (Common in Present Inventions 1 to 14)

With regard to the "second layer" which "consists of a resin material," in

Present Invention 1, the "second layer" "consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material." In contrast, in the Cited Invention, this point is unclear.

(C) Difference 3 (Common in Present Inventions 2 to 6)

In Present Inventions 2 to 6, "said resin composition further comprises a recycled polyester of a polyester in which the diol unit is a fossil fuel-derived diol or a biomass-derived ethylene glycol, and the dicarboxylic acid unit is a fossil fuel-derived dicarboxylic acid." In contrast, in the Cited Invention, this point is unclear.

(D) Difference 4 (Common in Present Inventions 3 to 6)

Present Inventions 3 to 6, the resin composition "comprises said recycled polyester in a range of 5 to 45 mass % with respect to the entire resin composition." In contrast, in the Cited Invention, this point is unclear.

(E) Difference 5 (Common in Present Inventions 4 to 6)

In Present Inventions 4 to 6, "said resin composition further comprises an additive." In contrast, in the Cited Invention, this point is unclear.

(F) Difference 6 (Common in Present Inventions 5 and 6)

In Present Inventions 5 and 6, the resin composition "comprises said additive in a range of 5 to 50 mass % with respect to the entire resin composition." In contrast, in the Cited Invention, this point is unclear.

(G) Difference 7 (Present Invention 6)

In Present Invention 6, "said additive is one or more selected from the group consisting of a plasticizer, an ultraviolet stabilizer, an anti-coloring agent, a matting agent, a deodorant, a flame retardant, a weatherproofing agent, an antistatic agent, a yarn friction reducer, a mold release agent, an antioxidant, an ion exchanger, and a coloring pigment." In contrast, in the Cited Invention, this point is unclear.

(3) Gist of Grounds for Determination Whether Differences 1 and 2 from Cited Invention Can Be Easily Conceived

A. Difference 1

The matter stated in Cited Document 5 is deemed to be "a polyethylene terephthalate used for a sheet or film, which comprises: 50 mass % of a biomass polyethylene terephthalate which has a biomass-derived ethylene glycol as a diol unit and a fossil fuel-derived terephthalic acid as a dicarboxylic acid unit; and a polyethylene terephthalate consisting of a fossil fuel-derived raw material, wherein the polyethylene terephthalate consisting of a fossil fuel-derived raw material has a fossil fuel-derived ethylene glycol as a diol unit and a fossil fuel-derived terephthalic

acid as a dicarboxylic acid unit."

As a means of mitigating the depletion of petroleum resources and curbing the increase in atmospheric carbon dioxide which is a causative substance of global warming, it is a technical problem which can be normally considered by a person ordinarily skilled in the art to use polyethylene terephthalate using a biologically-produced biomass material as a raw material instead of polyethylene terephthalate consisting of only a petroleum-derived raw material. Thus, there is a motivation to use a biomass-derived polyethylene terephthalate as a material of "a biaxially-oriented polyethylene terephthalate film" in the Cited Invention.

With regard to an upper limit of "90 mass %" in Present Invention 1, its critical significance cannot be recognized.

Therefore, a person ordinarily skilled in the art could have easily conceived of making the structure of Present Invention 1 according to Difference 1 on the basis of the Cited Invention and the matter stated in Cited Document 5.

B. Difference 2

In concretizing the Cited Invention, a person ordinarily skilled in the art could have appropriately made "the heat sealable resin layer" which "consists of a film or sheet of ethylene-α-olefin copolymer polymerized using a metallocene catalyst" in the Cited Invention to be one which "consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material."

C. Remarkable Function and Effect

The function and effect achieved by Present Invention 1 cannot be recognized to be equal to or greater than the sum of the function and effect of the Cited Invention and the matter stated in Cited Document 5, and are not particularly remarkable.

2. Grounds 2 for Rescission (Error in Determination on Inventive Step of Present Invention Based on Cited Invention)

(1) Plaintiff's Assertion

A. Present Invention 1

(A) Error in Findings of Cited Invention and Findings on Common Feature and Difference

a. The Revocation Decision of the Present Case found the Cited Invention as mentioned in 1(1) above.

However, according to the judgment rendered with regard to Cases 2016 (Gyo-Ke) 10182 and 2016 (Gyo-Ke) 10184 by the Intellectual Property High Court, Special Division on April 13, 2018 (the so-called Grand Panel Judgment on the Pyrimidine

Case), if there are an enormous number of alternatives about the technical elements regarding the specification of the Cited Invention, unless there are circumstances under which a specific technical idea pertaining to a specific alternative should be actively or preferentially selected, the specific technical idea pertaining to the specific alternative cannot be extracted from the statement of the publication in question, and this cannot be found as the Cited Invention.

In this regard, Cited Document 4 discloses a great variety of substrates which constitute a gas barrier laminate film as well as processing methods in [0022] and [0023]. Among the numerous combinations of substrate resin types and producing methods, there are no circumstances under which the combination of biaxial orientation and a polyester resin should be actively or preferentially selected.

Thus, the Revocation Decision of the Present Case is erroneous in finding the Cited Invention.

b. Since the Revocation Decision of the Present Case is erroneous in finding the Cited Invention, it is also erroneous in finding the common feature and difference between the Cited Invention and the Present Invention.

(B) Error in Determination Whether Difference from Cited Invention Can Be Easily Conceived

Even based on the premise of the findings of the Cited Invention and the common feature and difference between Present Invention 1 and the Cited Invention in the Revocation Decision of the Present Case, it is erroneous in determining whether the difference from the Cited Invention can be easily conceived.

a. Difference 1

There is no motivation to apply a biomass-derived polyethylene terephthalate stated in Cited Document 5 as a PET resin of the "biaxially-oriented polyethylene terephthalate film" in the Cited Invention.

At the time of the filing date of the original application, the concept of carbon neutrality was not recognized as a well-known problem or common general technical knowledge which must be achieved even at the sacrifice of the performance of PET required for each intended use.

At least with regard to polyester resins, it is a matter of common general technical knowledge that their practical realization as a replacement for conventional fossil fuel-derived PET was considered to be particularly difficult due to effects of various impurities derived from biomass raw materials (Unexamined Patent Application Publication No. 2008-94884 [hereinafter referred to as "Exhibit Ko 17 document"], and Unexamined Patent Application Publication No. 2009-209145

[hereinafter referred to as "Exhibit Ko 18 document"]).

In addition, [i] in Cited Document 4, where maintaining transparency is an important problem, the problem of coloration due to impurities in ethylene glycol derived from biomass resources had not been solved at the time of the filing date of the original application (Exhibit Ko 18 document, [0006]), [ii] in the Cited Invention, where the substrate consists of the biaxially-oriented polyethylene terephthalate film, Exhibit Ko 17 document suggests in [0008] that the moldability of polyester is adversely affected, [iii] in the Cited Invention, where high heat resistance is required ([0010]), according to [0005] of International Publication No. WO 2013/035559 (hereinafter referred to as "Exhibit Ko 19 document"), even at the time of the priority date of the present case, it is considered that the problem of heat resistance in biomass PET could not have been solved, [iv] in the Cited Invention, where a gas barrier property is considered as an important problem, Unexamined Patent Application Publication No. 2015-36208 (hereinafter referred to as "Exhibit Ko 15 document") suggests in [0007] that gas barrier performance is remarkably affected by using biomass-derived polyesters, and Unexamined Patent Application Publication No. 2018-35338 (hereinafter referred to as "Exhibit Ko 21 document") in [0062] states that there was a problem that uneven density and unevenly distributed crystallinity were likely to occur in biomass-derived polyester resins. In view of the above, there is an obstructive factor to apply the structure of Difference 1 to the Cited Invention.

b. Difference 2

The Revocation Decision of the Present Case determines that, in concretizing the Cited Invention, a person ordinarily skilled in the art could have appropriately made "the heat sealable resin layer" which "consists of a film or sheet of ethylene-α-olefin copolymer polymerized using a metallocene catalyst" in the Cited Invention to be one which "consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material." However, the Revocation Decision of the Present Case does not provide the reasoning for using a biomass-derived raw material only for polyester in the first layer and for daring to adopt an aspect of the second layer which consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material while being conscious of carbon neutrality.

c. Remarkable Function and Effect

In Working Examples 1 to 3 of the description of the present case, a laminate which satisfies the structure of the Present Invention is used to compare with a film

prepared by replacing the above-mentioned biomass PET film with the conventional fossil fuel-derived PET film, and it is shown to bear comparison in physical properties with a laminate having layers consisting of the already-existing polyester film.

At the time of the priority date of the present case, the common general technical knowledge was that when using biomass polyester, the presence of impurities makes molding and processing difficult and particularly makes it difficult to fulfill the performance which can be utilized in oriented films, etc. In view of this common general technical knowledge at the time of the priority date of the present case, it can be deemed to be clear that the above-mentioned effect is beyond the scope where a person ordinarily skilled in the art could have predicted from the structure.

B. Present Inventions 2 to 14

All of Present inventions 2 to 14 directly or indirectly depend on Present Invention 1. Thus, the assertion mentioned in A above naturally applies to the determination of inventive step for Present Inventions 2 to 14.

(2) Defendant's Assertion

A. Present Invention 1

(A) Error in Findings of Cited Invention and Findings of Common Feature and Difference

a. The so-called Grand Panel Judgment on the Pyrimidine Case according to the citation by the Plaintiff differs from the present case in that in the Pyrimidine Case, there were an enormous number of alternatives including at least 20 million or more possibilities in the general formula with regard to technical elements for specifying the Cited Invention.

From the problem ([0011]), the means for solving the problem ([0145]), the statement on heat sealing ([0151] and subsequent paragraphs, in particular [0155] and [0157]), the statement of working examples ([0174] to [0222]), the description of the "substrate" which constitutes a gas barrier laminate film ([0022] and subsequent paragraphs, in particular [0023] and [0024]) in Cited Document 4, it can be deemed that Cited Document 4 states a laminate material for packaging as a packaging bag, which is provided with "a gas barrier laminate film, a printed layer, a laminating adhesive layer, and a heat sealing layer" sequentially, and the "gas barrier laminate film" in which the substrate is a biaxially-oriented polyethylene terephthalate film, and the "heat sealable resin layer" which consists of a film or sheet of ethylene-α-olefin copolymer polymerized using a metallocene catalyst.

Thus, the Revocation Decision of the Present Case is not erroneous in finding the Cited Invention.

b. Since the Revocation Decision of the Present Case is not erroneous in finding the Cited Invention, it is not also erroneous in finding the common feature and difference between the Cited Invention and the Present Invention.

(B) Error in Determination Whether Difference from Cited Invention Can Be Easily Conceived

a. Difference 1

It is a well-known technical problem "to provide polyethylene terephthalate using a biologically-produced biomass material as a raw material instead of polyethylene terephthalate consisting of only a conventional petroleum-derived raw material as a means of mitigating the depletion of petroleum resources and curbing the increase in atmospheric carbon dioxide which is a causative substance of global warming," which a person ordinarily skilled in the art can normally consider when handling PET. Thus, there is a motivation to apply the matter stated in Cited Document 5 (biomass-derived PET) to the Cited Invention.

The Plaintiff asserts that there is an obstructive factor to apply the structure of Difference 1 to the Cited Invention. However, Exhibit Ko 18 document does not point out the problem of biomass-derived raw materials. In addition, the biomass-derived raw material in the working examples of the Present Patent and the biomass-derived raw material in Cited Document 5 are both the same commercially available product (description of the present case, [0075]; Cited Document 5, [0030]). Even if there were problems such as heat resistance, gas barrier property, uneven density, and unevenly distributed crystallinity, it can be deemed that the practical realization in a similar manner to the Present Patent was possible. Thus, the Plaintiff's assertion is improper.

b. Difference 2

The motivation to use a biomass-derived raw material for any of the resin layers in the Cited Invention on the basis of general problems and well-known technical problems can be well recognized, and conversion to biomass as a product can be achieved by making any of the layers to be biomass-derived. Based on these, it is a design matter which could have been easily performed by a person ordinarily skilled in the art that only one of the two resin layers in the Cited Invention is made biomass-derived and the other layer is made conventionally petroleum fuel-derived.

c. Remarkable Function and Effect

The biomass-derived raw material in the working examples of Cited Document 5 is the same commercially available product as the biomass-derived raw material in the working examples of the Present Patent. Thus, the function and effect achieved

by the Present Invention are within the scope which a person ordinarily skilled in the art could have predicted from the Cited Invention and the matter stated in Cited Document 5.

B. Present Inventions 2 to 14

The Revocation Decision of the Present Case is not erroneous in determining an inventive step of Present Invention 1, and the Revocation Decision of the Present Case is also not erroneous in determining an inventive step of Present Inventions 2 to 14.

3. Grounds 3 for Rescission (Violation of Procedure)

(1) Plaintiff's Assertion

A. The Japan Patent Office has published "Flowchart of Opposition to Granted Patent (Detailed Version)" on its web page, showing the details of the procedures for filing an opposition to a granted patent (Exhibit Ko 22). In oppositions, the practice is established so that at least two opportunities to submit a written opinion and a request for correction are usually given through a first notice of grounds for revocation and an advance notice of decision. According to the above-mentioned flowchart, an advance notice of decision will be absolutely issued only when a reason for revocation pointed out in a first notice of grounds for revocation remains unresolved, and it is not supposed that an advance notice of decision is issued for a reason completely different from a reason for revocation notified in the first notice. In addition, from Article 12, paragraphs (1) and (2) of the Administrative Procedure Act, especially in the case of rendering adverse dispositions such as revoking a patent right once granted, an adverse procedure cannot be taken against the patentee contrary to the procedure published by itself unless there are special circumstances.

The advance notice of decision in the present case (Exhibit Ko 5) points out a new reason for revocation in which the primarily cited reference itself is completely different, and thus falls under the case where it cannot be determined that the patent can be revoked due to the noticed grounds for revocation in the above-mentioned flowchart.

Even if a new reason for revocation is notified, a first notice of grounds for revocation which is not an advance notice of decision should be notified.

In view of the foregoing, the issuance of the advance notice of decision on the basis of only the new reason for revocation is a procedure which remarkably deviates from the discretion of the administrative judge, and affects the conclusion of the decision.

B. Even if it is allowable to issue an advance notice of decision on the basis of

only a new reason for revocation, taking the special circumstances into consideration, it was necessary to ensure an opportunity to submit a written opinion and a written request for correction by issuing a new advance notice of decision. In the present case, such a procedure was not taken.

(2) Defendant's Assertion

A. In view of Article 120-5 of the Patent Act, the Act does not provide that the identical reason for revocation must be notified twice in a "notice of grounds for revocation" and in a subsequent "notice of grounds for revocation which is an advance notice of decision."

Article 12 of the Administrative Procedure Act does not apply to dispositions under the Patent Act pursuant to Article 195-3 of the Patent Act.

In an opposition to a granted patent, it is well known from the JPO's Manual for Trial and Appeal Proceedings that the second notice of grounds for revocation is, in principle, an "advance notice of decision."

B. Even if the notice of grounds for revocation was a "notice of grounds for revocation which is an advance notice of decision," there is no distinction under the Patent Act from a mere "notice of grounds for revocation," and in either case, an opportunity to submit a written opinion is given and the scope which can be corrected is the same. Therefore, it does not violate the provision of Article 120-5, paragraph (1) of the Patent Act to have failed to twice issue a notice of grounds for revocation citing Cited Document 4 as the primarily cited reference.

(Attachment 2)

[Technical Field]

[0001]

The present invention relates to a laminate having a layer which consists of a biomass polyester resin composition obtained from a plant-derived raw material, and more particularly to a laminate having a first layer which consists of a resin composition comprising polyester using a biomass-derived ethylene glycol as a diol component.

[Background Art]

[0003]

In recent years, as calls for the development of a recycling-oriented society increase, a departure from fossil fuels has been desired in the materials sector as well as in the energy sector, and the utilization of biomass has been attracting attention. Biomass is an organic compound photosynthesized from carbon dioxide and water, and is utilized thereby to become carbon dioxide and water again, a so-called carbon neutral renewable energy. Recently, the practical realization of biomass plastics using such biomass as raw materials has been progressing rapidly, and attempts are also being made to produce polyester, a general-purpose polymer material, from these biomass raw materials.

[Summary of the Invention]

[Problem to be Solved by the Invention]

[0007]

The present inventors focused on ethylene glycol, which is a raw material for polyesters, and obtained the findings that a polyester using a plant-derived ethylene glycol as a raw material instead of ethylene glycol obtained from a conventional fossil fuel bears comparison in physical properties such as mechanical properties with a polyester produced using ethylene glycol obtained from a conventional fossil fuel. In addition, the present inventors obtained the findings that a laminate having a layer which consists of such a biomass-derived polyester also bears comparison in physical properties such as mechanical properties with a laminate consisting of a raw material obtained from a conventional fossil fuel. The present invention is based on such findings.

[0008]

Therefore, an object of the present invention is to provide a laminate having a layer consisting of a resin composition containing a carbon neutral polyester using a biomass ethylene glycol and to provide a laminate of a polyester resin film which

bears comparison in physical properties such as mechanical properties with a laminate produced from a raw material obtained from a conventional fossil fuel.

[Means for Solving the Problem]

[0009]

A laminate according to the present invention has at least two layers,

wherein a first layer consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit as the main component, wherein said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester,

wherein a second layer consists of a resin material comprising a fossil fuel-derived raw material and does not comprise a resin material comprising a biomass-derived raw material.

[Advantageous Effect of the Invention]

[0020]

According to the present invention, in a laminate having at least two layers, a laminate having a layer consisting of carbon neutral resins can be achieved by that a first layer consists of a biaxially-oriented resin film, wherein a resin composition which constitutes said biaxially-oriented resin film comprises a polyester consisting of a diol unit and a dicarboxylic acid unit, wherein said polyester comprises: a biomass-derived polyester in which said diol unit is a biomass-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid; and a fossil fuel-derived polyester in which said diol unit is a fossil fuel-derived ethylene glycol and said dicarboxylic acid unit is a fossil fuel-derived terephthalic acid, wherein said biaxially-oriented resin film comprises 90 mass % or less of said biomass-derived polyester. Therefore, the amount of fossil fuels used can be greatly reduced as compared to the conventional art, and the environmental burden can be reduced. In addition, the laminate of the polyester resin composition of the present invention uses a polyester resin composition which bears comparison in physical properties such as mechanical properties with a laminate of a polyester resin composition produced from a raw material obtained from a conventional fossil fuel, and can therefore replace the conventional laminate of the polyester resin composition.