Patent Right	Date	July 25, 2023	Court	Intellectual Property High Court, Second Division
	Case number	2022 (Gyo-Ke) 10111		
- A case in which the court rescinded a decision made by the JPO on the basis that the interpretation of a cited invention in the JPO Decision runs counter to statements in a document containing the cited invention, and therefore the JPO Decision contains an error in the determination concerning an inventive step.				

Case type: Rescission of Trial Decision to Maintain
Result: Granted
References: Article 29, paragraph (2) of the Patent Act
Related rights, etc.: Patent No. 6062746
Decision of the JPO: Invalidation Trial No. 2021-800095

Summary of the Judgment

1. The Plaintiff filed a request for a trial for patent invalidation with the Japan Patent Office (JPO), alleging that the Defendant's patent for an invention titled "Vehicle door beltline molding" has grounds for invalidation of a lack of an inventive step based on Exhibit Ko 1 (Publication of Examined Patent Application No. 1990-11419) and violation of the clarity requirement. However, the JPO determined that the Patent cannot be invalidated based on either of the alleged grounds for invalidation, and rendered a decision that "the request for the trial is groundless" (the "JPO Decision"). In this case, the Plaintiff filed a suit to seek rescission of the JPO Decision, asserting that it contains an error in the determination concerning a lack of an inventive step.
2. In this judgment, the court found that the Plaintiff's claim is well-grounded, and rescinded the JPO Decision. The reasons for the judgment are as outlined below.
(1) In the JPO Decision, the JPO determined that a person ordinarily skilled in the art could not have easily conceived of Difference 1 between Invention 1 and Exhibit Ko 1 Invention 1 (a difference in that "a step that extends in an inward direction from a lower part of the vertical flange" is a step that extends "substantially horizontally" in an inward direction from a lower part of the vertical flange in Invention 1, whereas it is a step that extends "slightly downward" in the direction of the rising and lowering window glass side from a lower part of the vertical flange in Exhibit Ko 1 Invention 1). However, given that [i] the description in question has no statements concerning the technical significance of the fact that the step extends "substantially horizontally" and, in Invention 1, whether the step extends "substantially horizontally" or "slightly

downward" does not affect the operation and effect of the inventions in question (collectively, the "Invention") and that [ii] also no technical significance is found in the fact that the step extends "slightly downward" in Exhibit Ko 1 Invention 1, it is reasonable to find that replacing the step that extends "slightly downward" with a step that extends "substantially horizontally" in Exhibit Ko 1 Invention 1 is a matter of design which a person ordinarily skilled in the art could choose as appropriate, and that a person ordinarily skilled in the art could have easily conceived of making such a replacement.

(2) In the JPO Decision, the JPO also determined that a person ordinarily skilled in the art could not have easily conceived of Difference 3 between Invention 1 and Exhibit Ko 1 Invention 1 (a difference in that, with regard to "the beltline molding is mounted on a door panel," the beltline molding is mounted "on an upper edge of an outer panel of the door in the door glass raising and lowering area in a state in which the upper edge is held between the molding main body and the clinch flange" in Invention 1, whereas "the belt molding M is attached by being pushed into the door panel P on the car body side" in Exhibit Ko 1 Invention 1). However, while the "door panel P" of Exhibit Ko 1 Invention 1 is an outer panel, and in Exhibit Ko 1 Invention 1, the molding is "fitted into and engaged with" the upper side of the outer panel at parts other than the edge, it can be easily understood from statements in Exhibit Ko 1 that the molding is attached in a way that it holds the outer panel between its parts; hence it is reasonable to find that the phrase "attached by being pushed into the door panel P" in Exhibit Ko 1 Invention 1 refers to a state in which the molding is attached in a way that it holds the upper edge of the outer panel between its parts, meaning virtually the same as being mounted in a state in which the upper edge of the outer panel is "held between" its parts in Invention 1. Accordingly, Difference 3 is not a substantive difference.

In the JPO Decision, the JPO interpreted that the panel on the car body side is bent in a crank shape toward the near side in Figure 3 a. of Exhibit Ko 1, and found that, in Exhibit Ko 1 Invention 1, the molding is screwed to the door panel without being mounted in a state in which the door panel is "held between" its parts. However, this interpretation is erroneous as it is inconsistent with the rest of the statements in Exhibit Ko 1 and makes it impossible to realize the structure of Exhibit Ko 1 Invention 1.

(3) As described above, the Invention could have been easily conceived of by a person ordinarily skilled in the art based on the invention described in Exhibit Ko 1, and therefore has grounds for invalidation of a lack of an inventive step.

Consequently, the JPO Decision contains an error in the determination concerning an inventive step involved in the Invention, and the Plaintiff's claim is well-grounded.

Judgment rendered on July 25, 2023
2022 (Gyo-Ke) 10111 Case of seeking rescission of the JPO decision
Date of conclusion of oral argument: May 30, 2023

Judgment

Plaintiff: FALTEC Co., Ltd.

Defendant: Katayama Kogyo Co. Ltd.

Main text

1. The decision made by the Japan Patent Office ("JPO") on September 13, 2022, concerning the case of Invalidation Trial No. 2021-800095, shall be rescinded.
2. The Defendant shall bear the court costs.

Facts and reasons

No. 1 Claim

Same as the main text.

No. 2 Outline of the case

This case is a lawsuit to seek rescission of a decision made by the JPO to the effect that a claim for a trial for invalidation of a patent was groundless. The major issue is whether there is an error in the findings and determinations on an inventive step.

1. Outline of procedures

The Defendant filed an application for a patent for an invention titled "Vehicle door beltline molding" on January 21, 2013 and obtained the registration of the establishment of the patent right (Number of claims: 2) as Patent No. 6062746 on December 22, 2016 (hereinafter the patent shall be referred to as the "Patent" and the description and drawings related to the Patent shall be collectively referred to as the "Description"; Exhibit Ko 31).

The Plaintiff filed a claim with the JPO for a trial for invalidation of the Patent on November 4, 2021 and the JPO examined said claim as Invalidation Trial No. 2021-800095. The Defendant submitted a written request for correction dated January 28, 2022 (Exhibits Ko 18 through 20) to correct the claims and statements in the description of the Patent (hereinafter collectively referred to as the "Correction"). On September 13, 2022, the JPO approved the Correction and rendered the trial decision that "the claim for the trial in question is groundless" (hereinafter referred to as the "JPO Decision"). A certified copy of the decision was served upon the Plaintiff on September 27, 2022.

2. Summary of the invention

(1) The statements in Claim 1 after the Correction of the Patent are as stated below (the parts corrected by the Correction are underlined; hereinafter the invention related to Claim 1 after the Correction is referred to as "Invention 1"; Exhibits Ko 18, 19, and 31). The appropriateness of the determination in the JPO Decision where the Correction was approved is not disputed in this case.

"A beltline molding which is mounted on a vehicle door and is characterized by the following:

a beltline molding is comprised of a molding main body that extends from the door glass elevating unit to the door frame surface; and

a step cross-sectional shape unit that is folded back in the inner lower direction from the upper part of the molding main body;

wherein the step cross-sectional shape unit has a draining lip that slides and comes into contact with the door glass, a vertical flange that is folded back downward from the upper part of the molding main body, a step that extends substantially horizontally inward from the lower part of the vertical flange, and a hooking flange that extends downward from the edge of the step;

wherein the door glass elevating unit is clamped and mounted on the upper edge of a door's outer panel by the molding main body and the hooking flange;

wherein the draining lip, the step, and the hooking flange are removed from the part on the edge side, which is located on the surface of the door frame, so that the vertical flange remains, and the edge has section stiffness so that an end cap can be attached thereto."

(2) The statements in Claim 2 after the Correction of the Patent are as stated below (the parts corrected by the Correction are underlined; hereinafter the invention related to Claim 2 after the Correction is referred to as "Invention 2"; Invention 1 and Invention 2 are collectively referred to as the "Invention"; Exhibits Ko 18, 19, and 31).

"A beltline molding which is mounted on a vehicle door and is characterized by the following:

a beltline molding is comprised of a molding main body that forms a design surface and a step cross-sectional shape unit that is folded back in the inner lower direction from the upper part of the molding main body;

wherein the step cross-sectional shape unit has a vertical flange that is folded back downward from the upper part of the molding main body, a step that extends substantially horizontally inward from the lower part of the vertical flange, and a hooking flange that extends downward from the edge of the step;

wherein the beltline molding is clamped and mounted on the upper edge of a door's outer panel by the molding main body and the hooking flange; and

wherein the step cross-sectional shape unit has a draining lip that is a hooking flange and stands from inside of the step so that it slides and comes into contact with the door glass and a sub-lip that stands from the vertical flange so that it comes into contact with the outside of the draining lip."

3. Summary of the grounds for the JPO Decision

The summary of the grounds for the determination concerning the Invention is as stated below (the parts related to the determination on the Correction are omitted).

(1) The Plaintiff argued that the Patent should be invalidated based on Grounds for Invalidation 1 (lack of an inventive step concerning Invention 1 based on the invention described in Exhibits Ko 1, 2, 4, 5, and 10 through 14, and concerning Invention 2 based on Exhibits Ko 1 through 8 and 10 through 12, respectively) and Grounds for Invalidation 2 (violation of clarity requirements).

(2) Grounds for Invalidation 1 (lack of an inventive step concerning Invention 1 based on the invention described in Exhibits Ko 1, 2, 4, 5, and 10 through 14, and concerning Invention 2 based on Exhibits Ko 1 through 8 and 10 through 12, respectively)

A. Exhibits Ko 1 through 3

(A) Exhibit Ko 1 (Publication of Examined Patent Application No. 1990-11419) contains statements on Exhibit Ko 1 Invention 1 and Exhibit Ko 1 Invention 2 as follows.

a. Exhibit Ko 1 Invention 1

"A belt molding M which is fitted and fixed along the top margin of an automobile door, which is comprised of an outer surface coating unit that extends from the elevating window glass to the door sash and the top coating unit, and

a base coating unit that is folded back downward from the top coating unit;

wherein the base coating unit is comprised of top and bottom lips 14 and 15 that protrude diagonally towards the elevating window glass and come into contact with the glass window, as well as a vertical flange that is folded back downward from the top coating unit, a step that extends slightly downward from the lower part of the vertical flange in the direction of the elevating window glass side, and a part that extends downward from the edge of the step;

wherein the belt molding M is attached by being pushed into door panel P on the automobile body side;

wherein a flange 16 is formed by leaving a part of the top coating unit side for the specified length in the longitudinal direction of the edge that is located on the surface of the door sash and by cutting the base coating unit; and wherein an end cap 3 is

injected and molded on the edge."

b. Exhibit Ko 1 Invention 2

"A belt molding M which is fitted and fixed along the top margin of an automobile door,

which is comprised of an outer surface coating unit that forms a decorative surface 1a, a top coating unit, and a base coating unit that is folded back downward from the top coating unit;

wherein the base coating unit is comprised of a vertical flange that is folded back downward from the top coating unit,

a step that extends slightly downward from the lower part of the vertical flange in the direction of the elevating window glass side, and a part that extends downward from the edge of the step;

wherein the belt molding M is attached by being pushed into the door panel P on the automobile body side; and wherein the base coating unit is comprised of top and bottom lips 14 and 15 that protrude diagonally towards the elevating window glass and come into contact with the glass window."

(B) Exhibit Ko 2

Exhibit Ko 2 (Unexamined Patent Application Publication No. 2004-114883) states the following matters.

"A glass outer weather strip, which is attached along the upper edge of the door's outer panel of an automobile door;

wherein the glass outer weather strip is comprised of a mounting base that is a hard member comprised of hard synthetic resin, etc. and that is attached on the upper edge of the door's outer panel, and a glass seal lip that is a soft member comprised of a soft thermoplastic elastomer, etc. and that comes into contact with the outer surface of the door glass and seals a gap with the door glass;

wherein the mounting base forms a substantially inverted U-shaped cross section comprised of a side wall outside the automobile, an upper wall, and a side wall inside the automobile;

wherein the glass seal lip is bonded on the upper wall of the mounting base; wherein the upper wall of the mounting base has a protrusion that protrudes upward outside the automobile; wherein the glass seal lip is bonded on the protrusion; wherein the protrusion on the upper wall of the mounting base has a concave part in its inside; wherein the concave part continues to the inner space of the mounting base, which has a substantially inverted U-shaped cross section."

(C) Exhibit Ko 3

Exhibit Ko 3 (Unexamined Patent Application Publication No. 2004-224230) states the following matters.

"In a weather strip of the belt line molding 10a that is attached to the opening for an automobile door's door glass elevating unit, an automobile door beltline molding wherein a design lip 30 protrudes towards the door glass side in a length that does not come into contact with the door glass from around an upper edge of a base member 11 wherein the weather strip is attached to the door edge, which is a boundary with the door glass; wherein a draining lip 20a protrudes to the door glass side from the lower part with an interval from the base of the design lip 30 of the base member 11; and wherein the draining lip 20a slides and comes into contact with the door glass and bends in a state where it is being attached, and thereby forming a hollow with the design lip and the draining lip by firmly attaching a draining lip abdomen to a design lip edge 31."

B. Comparing Invention 1 and Exhibit Ko 1 Invention 1, they are common in the following common features and they are different in Differences 1 through 4.

[Common features]

"A beltline molding which is mounted on a vehicle door and is characterized by the following:

a beltline molding is comprised of a molding main body that extends from the door glass elevating unit to the door frame surface; and

a step cross-sectional shape unit that is folded back in the inner lower direction from the upper part of the molding main body;

wherein the step cross-sectional shape unit has a draining lip that slides and comes into contact with the door glass, a vertical flange that is folded back downward from the upper part of the molding main body, a step that extends inward from the lower part of the vertical flange, and a part that extends downward from the edge of the step;

wherein the door glass elevating unit is mounted on a door panel;

wherein the draining lip, the step, and the part that extends downward from the edge of the step are removed from the part on the edge side, which is located on the surface of the door frame, so that the vertical flange remains, and the edge can have an end cap."

[Difference 1]

Concerning "a step that extends inward from the lower part of the vertical flange," in Invention 1, it is a step that extends "substantially horizontally" inward from the lower part of the vertical flange, while in Exhibit Ko 1 Invention 1, it is a step that extends "slightly downward" from the lower part of the vertical flange in the direction of the elevating window glass side.

[Difference 2]

Concerning "a part that extends downward from the edge of the step," in Invention 1, it is "a hooking flange" that extends downward from the edge of the step, while in Exhibit Ko 1 Invention 1, it is "a part" that extends downward from the edge of the step.

[Difference 3]

Concerning "the beltline molding is mounted on a door panel," in Invention 1, "the door glass elevating unit is clamped" and mounted "on the upper edge of a door's outer panel by the molding main body and the hooking flange," while in Exhibit Ko 1 Invention 1, "the belt molding M is attached by being pushed into the door panel P on the automobile body side."

[Difference 4]

Concerning "the edge can have an end cap," in Invention 1, the edge "has section stiffness so that an end cap can be attached thereto," while in Exhibit Ko 1 Invention 1, "an end cap 3 is injected and molded" on the edge.

C. Differences 1 through 4

(A) Difference 1

a. The "step" in Exhibit Ko 1 Invention 1 "extends slightly downward from the lower part of the vertical flange in the direction of the elevating window glass side." If the term "substantially horizontally" is construed to refer to "almost horizontally" or "approximately horizontally," the step of the vertical flange in Exhibit Ko 1 Invention 1 cannot be deemed to be "substantially horizontally," and therefore, Difference 1 is a substantive difference.

b. In Exhibit Ko 1 Invention 1, there are no reasons to replace "the step that extends slightly downward" with "the step that extends substantially horizontally" and, in a beltline molding, it is not a well-known art before the filing of an application for the Patent to configure a beltline molding to comprise "a step that extends substantially horizontally."

The Plaintiff argued that Exhibit Ko 2 states that "a glass outer weather strip is comprised of a glass seal lip that slides and comes into contact with the door glass, a step on the protrusion inside the automobile, and a horizontal part that extends substantially horizontally inward from the lower part of the step." Therefore, the Plaintiff argued that a person ordinarily skilled in the art could have easily conceived of a step that extends "substantially horizontally." However, the matters stated in Exhibit Ko 2 do not show the configuration wherein the side wall inside the automobile is comprised of "a step that extends substantially horizontally."

The particulars for identifying the invention in Invention 1 related to Difference 1

above could not have been easily conceived of by a person ordinarily skilled in the art based on Exhibit Ko 1 Invention 1 and the matters stated in Exhibit Ko 2.

(B) Difference 3

a. The phrase, "clamped and mounted," is examined by understanding it as meaning that something is being held in a way of being pinched from both sides and mounted.

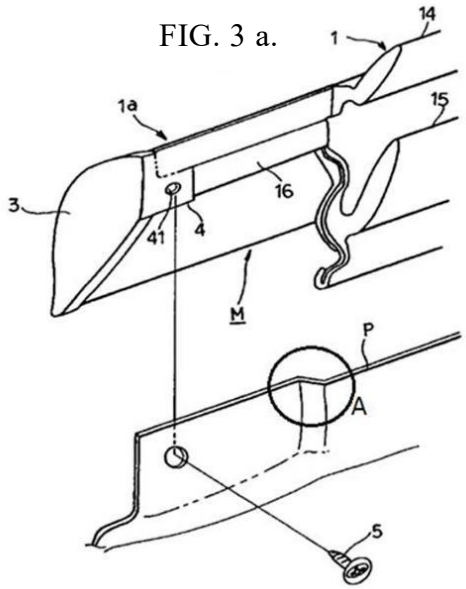
b. Referring to FIG. 3 a. and b. in Exhibit Ko 1, in Exhibit Ko 1 Invention 1, a panel on the automobile body side (door panel P) is screwed on a seat 4 with a tapping screw 5 from the front side of a molding M in FIG. 3 a. In addition, it can be seen that a panel on the automobile body side (door panel P) bends in a crank shape in the direction departing from lips 14 and 15, which means towards the front side, on the side where the panel on the automobile body side faces lips 14 and 15 of the molding M (see the part circled in circle A in the reference FIG. below). Then, in Exhibit Ko 1 Invention 1, in the state where a molding M is attached to the panel on the automobile body side (door panel P), the panel on the automobile body side (door panel P) is construed to be located on the front side of the molding M.

In other words, the phrase in Exhibit Ko 1 Invention 1, "the belt molding M is attached by being pushed into the door panel P on the automobile body side," means that the molding M is mounted on the panel on the automobile body side (door panel P), which is "door panel P on the automobile body side," by screwing, and therefore, it does not correspond to "clamped and mounted" in Invention 1.

Even if it is obvious based on common general technical knowledge that there is an "outer panel" in Exhibit Ko 1, its configuration and relationship with the belt molding M are not stated. Therefore, it cannot lead clearly to a component "that is clamped and mounted on the upper edge of a door's outer panel by the outer surface coating unit, top coating unit, and 'a part that extends downward from the edge of the step of the base coating unit'" based on the statement in Exhibit Ko 1 Invention 1, "the belt molding M is attached by being pushed into the door panel P on the automobile body side."

[Reference figure]

FIG. 3 a.



c. As seen in Exhibit Ko 10 (Unexamined Patent Application Publication No. 2009-143544), Exhibit Ko 11 (Unexamined Patent Application Publication No. 2006-298239), and Exhibit Ko 12 (Unexamined Patent Application Publication No. 2005-132215), clamping and mounting a door glass elevating unit on the upper edge of the door's outer panel by the molding main body and the hooking flange can be said to have been well-known art before the filing of an application for the Patent. In addition, Exhibit Ko 7 (Unexamined Patent Application Publication No. 2001-301469) and Exhibit Ko 8 (Unexamined Patent Application Publication No. 2006-88933) present an example where an automobile door on which a belt molding is mounted is comprised of an inner panel that forms the inside of the door, an outer panel that forms the outside of the door, and a door glass installed between them, and where the belt molding is mounted on the outer panel. However, in Exhibit Ko 1 Invention 1, the molding M is screwed onto the door panel P, and therefore, there is no motivation to apply the aforementioned well-known art to Exhibit Ko 1 Invention 1.

In addition, even if everything is replaced with well-known art, including matters related to screwing, in consideration of the shape of the door panel P in Exhibit Ko 1, it is naturally understood by a person ordinarily skilled in the art that further creation is required to achieve the replacement. However, the Plaintiff has not argued this point based on any evidence.

Therefore, the particulars for identifying the invention in Invention 1 related to

Deference 3 could not have been easily conceived of by a person ordinarily skilled in the art based on Exhibit Ko 1 Invention 1, the matters stated in Exhibit Ko 2, and well-known art.

(C) Difference 2

Even if setting a hooking flange was well-known art before the filing of an application for the Patent as seen in Exhibit Ko 2, Exhibit Ko 4 (Unexamined Patent Application Publication No. 2000-71763), and Exhibit Ko 5 (Unexamined Patent Application Publication No. 2005-119487), Exhibit Ko 1 has no statement on an outer panel and its configuration and relationship with the belt molding M, as stated above. Therefore, there are no grounds to adopt the well-known art in Exhibit Ko 1 Invention 1.

Therefore, the particulars for identifying the invention in Invention 1 related to Deference 2 could not have been easily conceived of by a person ordinarily skilled in the art based on Exhibit Ko 1 Invention 1, the matters stated in Exhibit Ko 2, and well-known art.

(D) Difference 4

In Invention 1, it is only specified that "the edge has section stiffness so that an end cap can be attached thereto," and it is not specified how the end cap is attached. In Exhibit Ko 1 Invention 1, "an end cap is injected and molded on the edge," and therefore, the end cap is attached by injection molding.

Based on the above, it could have been easily conceived of by a person ordinarily skilled in the art that the edge naturally has section stiffness or that the edge is configured at least as having section stiffness so that an end cap can be attached thereto.

Therefore, a person ordinarily skilled in the art could have easily conceived of whether Difference 4 is a substantive difference and have easily conceived of Difference 4 as the particular for identifying the invention in Invention 1 related to Difference 4 as mentioned above in Exhibit Ko 1 Invention 1.

(E) Whether Invention 1 could have been easily conceived of by a person ordinarily skilled in the art

As stated above, a person ordinarily skilled in the art could not have easily made Invention 1 based on the inventions stated in Exhibits Ko 1, 2, 4, 5, 10, and 11, Exhibit Ko 12 (Unexamined Patent Application Publication No. 2005-132215), Exhibit Ko 13 (Unexamined Patent Application Publication No. 1999-34757), and Exhibit Ko 14 (Unexamined Patent Application Publication No. 2005-35472).

D. Comparing Invention 2 and Exhibit Ko 1 Invention 2, they are common in the following common features and different in Differences 5 through 8.

[Common features]

"A beltline molding which is mounted on a vehicle door and is characterized by the following:

a beltline molding is comprised of a molding main body that forms a design surface and a step cross-sectional shape unit that is folded back in the inner lower direction from the upper part of the molding main body;

wherein the step cross-sectional shape unit has a vertical flange that is folded back downward from the upper part of the molding main body, a step that extends inward from the lower part of the vertical flange, and a part that extends downward from the edge of the step;

wherein the beltline molding is mounted on a door panel;

wherein the step cross-sectional shape unit has a draining lip that stands so that it slides and comes into contact with the door glass."

[Difference 5]

Concerning "a step that extends inward from the lower part of the vertical flange," in Invention 2, it is a step that extends "substantially horizontally" inward from the lower part of the vertical flange, while in Exhibit Ko 1 Invention 2, it is a step that extends "slightly downward" from the lower part of the vertical flange in the direction of the elevating window glass side.

[Difference 6]

Concerning "a part that extends downward from the edge of the step," in Invention 2, it is "a hooking flange" that extends downward from the edge of the step, while in Exhibit Ko 1 Invention 2, it is "a part" that extends downward from the edge of the step.

[Difference 7]

Concerning "the beltline molding is mounted on a door panel," in Invention 2, "the door glass elevating unit is clamped" and mounted "on the upper edge of a door's outer panel by the molding main body and the hooking flange," while in Exhibit Ko 1 Invention 2, "the belt molding M is attached by being pushed into the door panel P on the automobile body side."

[Difference 8]

Concerning "the step cross-sectional shape unit has a draining lip that stands so that it slides and comes into contact with the door glass," in Invention 2, the step cross-sectional shape unit that "has a draining lip that is a hooking flange and stands from inside of the step so that it slides and comes into contact with the door glass and a sub-lip that stands from the vertical flange so that it comes into contact with the outside of the draining lip," while in Exhibit Ko 1 Invention 2, the base coating unit is comprised

of "top and bottom lips 14 and 15 that protrude diagonally towards the elevating window glass and come into contact with the glass window."

E. Differences 5 through 8

(A) Differences 5 through 7

Differences 5 through 7 are substantively the same as Differences 1 through 3, respectively. Therefore, based on the same grounds as stated in C. above, the particulars for identifying the invention in Invention 2 related to Differences 5 through 7 could not have been easily conceived of by a person ordinarily skilled in the art based on Exhibit Ko 2 Invention 2, the matters stated in Exhibit Ko 2, and well-known art.

(B) Difference 8

According to the statements in paragraphs [0002] and [0003] of Exhibit Ko 3, the matters stated in Exhibit Ko 3 are construed to mean that the invention aims to provide a beltline molding that is effective in reducing the amount of material used and has a compact cross-sectional shape and high productivity while ensuring sound insulation performance equal or superior to that of a conventional beltline molding, which had upper and lower draining lips 120 and 121 doubly, as shown in FIG. 5, and thereby intended to facilitate the draining of rainwater, etc. and sound insulation.

On the other hand, Exhibit Ko 1 Invention 2 has top and bottom lips 14 and 15, and therefore, it has the inherent problem of reducing the amount of material used and forming a compact cross-sectional shape. Consequently, there is motivation to apply the matters stated in Exhibit Ko 3 to Exhibit Ko 1 Invention 2, and therefore, a person ordinarily skilled in the art could have easily conceived of applying the matters stated in Exhibit Ko 3 to Exhibit Ko 1 Invention 2 and setting said matter as the particular for identifying the invention in Invention 2 related to Difference 8.

(C) Whether Invention 2 could have been easily conceived of by a person ordinarily skilled in the art

As stated above, a person ordinarily skilled in the art could not have easily made Invention 2 based on the inventions stated in Exhibits Ko 1 through 5, and Exhibit Ko 6 (Unexamined Patent Application Publication No. 2001-138827), Exhibits Ko 7, 8, and 10 through 12.

(3) Grounds for Invalidation 2 (violation of clarity requirements)

The Inventions are all definitive, and therefore, the statements in the claims of the Patent fulfill the requirements set forth in Article 36, paragraph (6), item (ii) of the Patent Act and they cannot be invalidated based on Grounds for Invalidation 2.

No. 5 Determination of this court

1. Invention

(1) The Description has a statement as stated in Attachment 1 "Patent Gazette (Patent No. 6062746)" (the statement in the Attachment is before the Correction; the phrase, "step 13c of the hooking flange 13," in line 1 in [0013] of the Description was corrected to "step 13c, which is a hooking flange 13"). (Exhibits Ko 18, 20, and 31)

(2) Outline of the Invention

Based on the statement in (1) above, the Invention is related to a beltline molding that is mounted on the door glass elevating unit of an automobile door (front door and rear door of a passenger car, truck cabin door, and other doors in general). ([0001] and [0005]) The door panel of an automobile is comprised of an outer panel that forms the outside of the door and an inner panel that forms the inside of the door. The beltline molding (molding) is mounted on the upper edge of the outer panel and has a draining lip (seal lip) that slides and comes into contact with the outside of the door glass and drains rainwater. Since the beltline molding has a role as a design molding to decorate the beltline of the outside of the automobile, a design molding that is placed continuously from the outside of the door frame to the door glass elevating unit (upper edge of the outer panel) is also adopted. This type of beltline molding is required to remove the draining lip for the part located on the surface of the door frame. In existing beltline molding, if the draining lip, etc. are removed so that the design unit remains at the edge of the beltline molding, stiffness becomes insufficient and another member, the end cap, cannot be attached. Therefore, the end member was unified with the molding main body by injection molding or other measures were taken. However, unification by injection molding requires not only a special facility, but also requires a lap joint between the end member, which is injected and molded, and the molding main body. Consequently, there is a problem of poor appearance design ([0002]). In order to resolve these problems, the Invention aims to provide a beltline molding having an edge with excellent stiffness, excellent continuity over the whole length of the appearance design, and high-sealing performance with door glass ([0004]). The beltline molding is configured as stated in the claims ([0005]), and thereby, the beltline molding has a vertical flange that folds back downward from the top of the molding main body, wherein the vertical flange is left for the part located on the door frame surface so that the draining lip and hooking flange can be removed, and the section stiffness is secured while forming a substantially cross-sectional shape C by the molding main body and the vertical flange. Therefore, it has the effect that the end cap, which is another article, can be attached on the terminal section of the beltline molding. In addition, the beltline molding is formed in a step cross-sectional shape that has a hooking flange on the lower

side of the vertical flange so that it can have a double lip structure to press the draining lip and the side of the outside of the draining lip by a sub-lip. This double lip structure has effects not only to prevent dust, etc. from accumulating in the concave part of the step, but also to increase sealing properties with the door glass ([0009]).

2. Exhibit Ko 1 Inventions 1 and 2, the matters stated in Exhibit Ko 2, and the matters stated in Exhibit Ko 3

(1) Exhibit Ko 1 Inventions 1 and 2

A. Exhibit Ko 1 is a publication before examination of a patent application for an invention titled "Belt molding" published on March 14, 1990, and the detailed explanation of the invention and drawings contains statements as shown in Attachment 2 "Patent Gazette (1990-11419)." (Exhibit Ko 1)

B. Summary of Exhibit Ko 1 Inventions 1 and 2

(A) According to the statement in A. above, Exhibit Ko 1 Inventions 1 and 2 are related to the improvement of the terminal section of the belt molding for an automobile door. Part of the terminal section of the belt molding that is attached by fitting and fixing it along the automobile door's top margin is cut and removed to prevent it from interfering with the door sash and the corner piece. In order to prevent the decorating surface on the automobile body side from lifting up from the automobile body panel or from being bent, previously, on the decorating surface showing a substantially C-shaped cross-section by removing part of the terminal section of the molding main body, a base formed by resin molding on another article was fitted and fixed inside the C-shape. A screw hole was formed with the base and a nut was embedded and mounted on it. The base was tightened and fixed by a bolt inserted from the back of the automobile body side panel, and thereby, the terminal section was mounted and held on the automobile body panel. However, since the base had to be formed on another article and to be attached and fixed, there was a problem that the number of parts was large and the cost increased. In order to resolve this problem, the invention aims to provide a belt molding wherein the base formed on another article is omitted, and which is inexpensive and can be attached and fixed firmly on the automobile body side panel. In the belt molding related to Exhibit Ko 1 Inventions 1 and 2, a screw hole that passes through the core metal material is formed on a flange where part of the terminal section of the molding main body in the longitudinal direction is removed; the screw hole is retained; and the flange around the screw hole is also coated with synthetic resin that forms an end cap on the terminal section of the molding main body, and thereby, the belt molding is configured so that the terminal section of the molding can be screwed and fixed with a tapping screw, etc. on the automobile body side panel. In this way, the belt molding can

be anchored on the automobile body side panel by firmly screwing the screw hole formed on the flange and tapping screw. Therefore, the terminal section does not come off the automobile body side panel or clearance will not be created. Since the seat that covers the flange matches the shape of the automobile body side panel, it can be tightened with the tapping screw firmly, fulfills the role of buffer material, and also shows the sealing effect of preventing water, etc. from entering the hole.
(B) According to the statement in Exhibit Ko 1 in A. above, it is found that Exhibit Ko 1 stated Exhibit Ko 1 Invention 1 and Exhibit Ko 1 Invention 2 as was found in the JPO Decision in No. 2, 3. (2) A. (A) above.
(2) Matters stated in Exhibit Ko 2
A. Exhibit Ko 2 is a Patent Gazette regarding a patent application for an invention titled "Glass outer weather strip for automobile doors" published on April 15, 2004 and contains the following statements.
[Claims]
[Claim 1]

A glass outer weather strip, which is attached along the upper edge of the door's outer panel of an automobile door and is characterized by the following;

where the glass outer weather strip is comprised of a mounting base that is a hard member comprised of hard synthetic resin, etc. and that is attached on the upper edge of the door's outer panel, and a glass seal lip that is a soft member comprised of a soft thermoplastic elastomer, etc. and that comes into contact with the outer surface of the door glass and seals a gap with the door glass;

wherein the mounting base forms a substantially inverted U-shaped cross section comprised of a side wall outside the automobile, an upper wall, and a side wall inside the automobile; and

wherein the glass seal lip is bonded on the upper wall of the mounting base.
[Claim 5]

The glass outer weather strip for an automobile door stated in Claim 1, 2, 3, or 4; wherein the upper wall of the mounting base has a protrusion that protrudes upward outside the automobile; and wherein the glass seal lip is bonded to the protrusion.
[Claim 6]

The glass outer weather strip for an automobile door stated in Claim 5; wherein the protrusion on the upper wall of the mounting base has a concave part in its inside; and wherein the concave part continues to the inner space of the mounting base, which has a substantially inverted U-shaped cross section.
[0043]

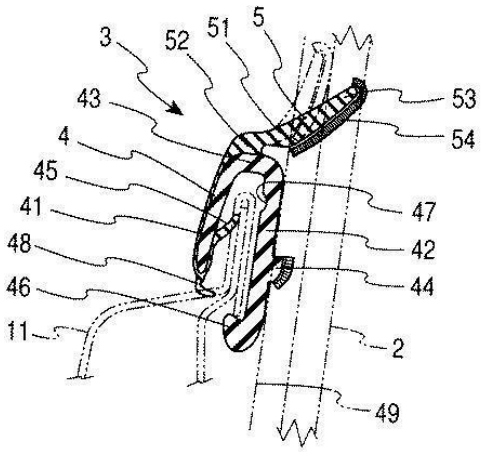
FIG. 5 shows a cross-section of a glass outer weather strip where the Invention is embodied with a different configuration and is a cross-sectional view at a position along A-A line in FIG. 7.

Compared with the configuration of the embodiment in FIG. 1, in the configuration of the embodiment in FIG. 5, outside the automobile of an upper wall 43 of a mounting base 4 has a protrusion 43b that protrudes upward; wherein there is a concave part inside the protrusion 43b; wherein the concave part continues to an inner space in the substantially inverted U-shaped cross-section of the mounting base 4. In addition, when compared with the configuration of the embodiment in FIG. 4, the configuration of the embodiment in FIG. 5 has a concave part inside the protrusion 43b in FIG. 4.

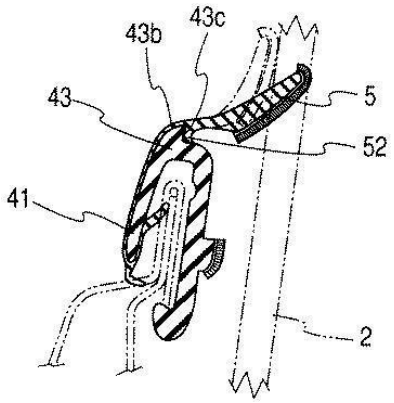
As shown in FIG. 5, since the concave part is created inside the protrusion 43b, there is no longer a thick part in the protrusion 43b and even thickness is obtained. For this reason, when cutting the glass outer weather strip 3 into the specified dimensions, cutting is easily done since there are no thick parts in the mounting base 4, which consists of a hard member.

In addition, the thickness of the mounting base 4 becomes even and a better balance at extrusion molding can be obtained as well as having no decline in the mounting base 4 due to heat-shrinkage after the molding.

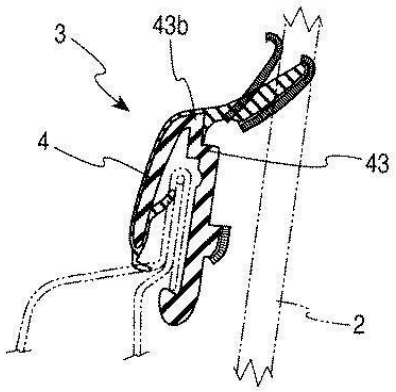
[FIG. 1]



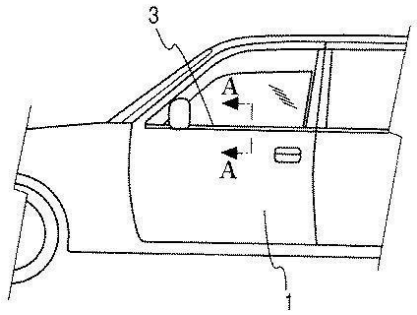
[FIG. 4]



[FIG. 5]



[FIG. 7]



B. Matters stated in Exhibit Ko 2

According to A. above, it is found that the matters stated in Exhibit Ko 2 are stated in Exhibit Ko 2 as were found in the JPO Decision in No. 2, 3. (2) A. (B) above.

(3) Matters stated in Exhibit Ko 3

A. Exhibit Ko 3 is a Patent Gazette regarding a patent application for an invention titled "Automobile door beltline molding" published on August 12, 2004 and contains the following statements.

[Claims]

[Claim 1]

In a weather strip of the belt line molding that is attached to the opening for an automobile door's door glass elevating unit, an automobile door beltline molding which is characterized by the following: a design lip protrudes towards the door glass side in a length that does not come into contact with the door glass from around an upper edge of a base member wherein the weather strip is attached to the door edge, which is a

boundary with the door glass; wherein a draining lip protrudes to the door glass side from the lower part with an interval from the base of the design lip of the base member; and wherein the draining lip slides and comes into contact with the door glass and bends in a state where it is being attached, and thereby, forming a hollow with the design lip and the draining lip by firmly attaching a draining lip abdomen to a design lip edge.

[0002]

[Prior art]

A beltline molding provided with a weather strip is attached to the outer side of the opening for an automobile's door glass elevating unit, which slides and comes into contact with the door glass with elastomeric force, seals between the door panel and the door glass, and thereby, prevents the entry of rainwater and dust and reduces wind noise, etc.

In the beltline molding, as shown in FIG. 5, which is a longitudinal cross-section view of a conventional beltline molding in a mounted state, the fin-shaped draining lips 120 and 121 made of a soft vinyl chloride resin or other soft resin with elasticity are doubly provided on an upper stage and a lower stage on a base member 111 made of a hard vinyl chloride resin or other hard resin, thereby facilitating the drainage of rainwater, etc. and sound insulation.

In addition, the beltline molding 100 is also required to have an appearance design property, and a design lip 130 is formed from the weather strip surface towards the door glass side.

These beltline moldings are manufactured by composite extrusion molding, etc., and further cost reduction is required.

As measures for cost reduction, the reduction of materials to be used and the compact and simple cross-sectional shape for easy manufacturing are deliberated.

However, there is the problem that the sound insulation performance is lowered only by decreasing the number of the draining lips from two pieces to one piece.

[0003]

[Problems to be solved by the invention]

In view of the above technical problems, the Invention aims to provide a beltline molding that is mounted on the outer side of the opening for the door glass elevating unit, which is effective in reducing the amount of material used while ensuring sound insulation performance equal or superior to that of a conventional beltline molding, and which has high productivity by forming a compact cross-sectional shape.

[0008]

FIG. 1 shows an example corresponding to a cross section of A-A line in FIG. 3 in

a state where a beltline molding corresponding to the invention stated in Claim 1 is attached.

In the weather strip of a belt line molding 10a, a design lip 30 protrudes from a base member 11 that is mounted on the end of a door 3, and a draining lip 20a protrudes to a door glass 4 side from a position with a specified clearance downward from the base of the design lip 30.

The design lip 30 protrudes from around the upper end of the base member 11 to the upper area of the door glass side up to a substantially intermediate position between the base member 11 and the door glass 4.

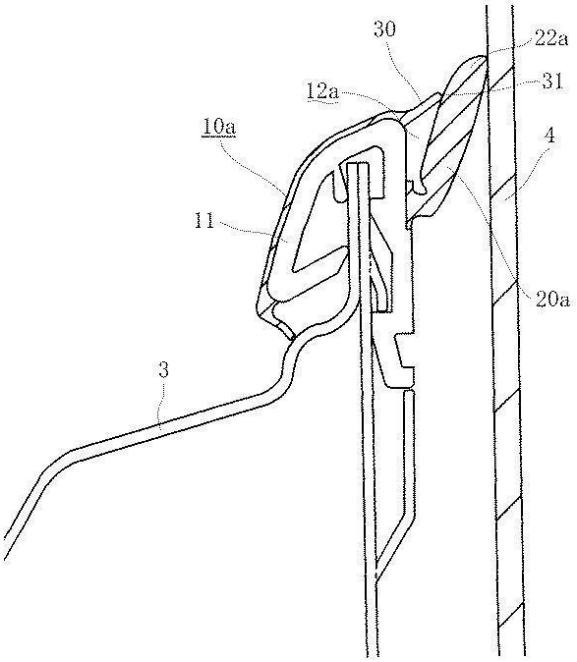
The draining lip 20a also protrudes obliquely upward, wherein its upper surface is raised from around the root anchored to the base member, and wherein its abdominal area is formed with thickness in a manner where the upper surface and lower surface are substantially parallel to each other.

The draining lip 20a bends when the end of the draining lip 20a slides and comes into contact with the door glass 4, and its abdominal area is firmly attached to the design lip edge 31 in the upper area.

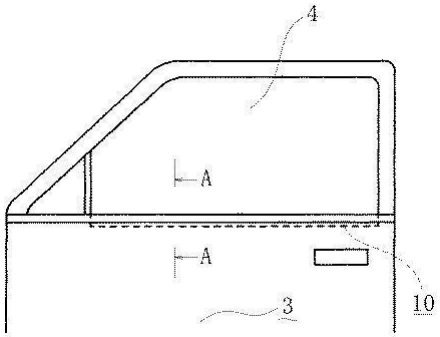
Thus, a hollow 12a is formed by the draining lip 20a, the design lip 30, and the base member 11.

The draining lip is designed to have an abdominal area where the upper surface and the lower surface are substantially parallel to each other and have thickness overall as described above, and therefore, further sound insulation effects can be obtained.

[FIG. 1]



[FIG. 3]



B. According to A. above, it is found that the matters stated in Exhibit Ko 3 are stated in Exhibit Ko 3 as were found in the JPO Decision in No. 2, 3. (2) A. (C) above.

3. Error in the determination in the JPO Decision concerning the grounds for invalidation due to the lack of an inventive step concerning Invention 1 (Grounds for Rescission 1 through 4)

All of the Grounds for Rescission 1 through 4 argued by the Plaintiff are that there is an error in the determination in the JPO Decision to the effect that with regard to Invention 1, there are no grounds for invalidation due to the lack of an inventive step based on Exhibit Ko 1. Therefore, the matters argued as Grounds for Rescission 1 through 4 are also examined below.

(1) Common features and differences

Comparing Invention 1 with Exhibit Ko 1 Invention 1 in 2. (1) B. (B) above, as it was found in the JPO Decision in No. 2, 3. (2) B. above, they share the following common features and they seem to be different in Differences 1 through 4. The term "belt molding" as used in Exhibit Ko 1 Inventions 1 and 2 and the term "beltline molding" as used in the Invention have the same meaning.

[Common features]

"A beltline molding which is mounted on a vehicle door and is characterized by the following:

a beltline molding is comprised of a molding main body that extends from the door glass elevating unit to the door frame surface; and

a step cross-sectional shape unit that is folded back in the inner lower direction from the upper part of the molding main body;

wherein the step cross-sectional shape unit has a draining lip that slides and comes into contact with the door glass, a vertical flange that is folded back downward from the upper part of the molding main body, a step that extends inward from the lower part of the vertical flange, and a part that extends downward from the edge of the step;

wherein the door glass elevating unit is mounted on a door panel;

wherein the draining lip, the step, and the part that extends downward from the edge of the step are removed from the part on the edge side, which is located on the surface of the door frame, so that the vertical flange remains, and the edge can have an end cap."

[Difference 1]

Concerning "a step that extends inward from the lower part of the vertical flange," in Invention 1, it is a step that extends "substantially horizontally" inward from the lower part of the vertical flange, while in Exhibit Ko 1 Invention 1, it is a step that extends "slightly downward" from the lower part of the vertical flange in the direction of the elevating window glass side.

[Difference 2]

Concerning "a part that extends downward from the edge of the step," in Invention 1, it is "a hooking flange" that extends downward from the edge of the step, while in Exhibit Ko 1 Invention 1, it is "a part" that extends downward from the edge of the step.

[Difference 3]

Concerning the expression, "the beltline molding is mounted on a door panel," in Invention 1, "the door glass elevating unit is clamped" and mounted "on the upper edge of a door's outer panel by the molding main body and hooking flange," while in Exhibit Ko 1 Invention 1, "the belt molding M is attached by being pushed into the door panel P on the automobile body side."

[Difference 4]

Concerning the expression, "the edge can have an end cap," in Invention 1, the edge "has section stiffness so that an end cap can be attached thereto," while in Exhibit Ko 1 Invention 1, "an end cap 3 is injected and molded" on the edge.

(2) Differences

A. Difference 1

(A) Concerning Difference 1, "a step that extends inward from the lower part of the

vertical flange" in Invention 1 is a step that extends "substantially horizontally" inward from the lower part of the vertical flange, while in Exhibit Ko 1 Invention 1, it is a step that extends "slightly downward" from the lower part of the vertical flange in the direction of the elevating window glass side. There is no dispute between parties concerning the fact that the door panel on which the molding in Exhibit Ko 1 Invention 1 is mounted is an outer panel. The term "in the direction of the elevating window glass side" as used in Exhibit Ko 1 Invention 1 is found to mean the same direction as "inward" (meaning inside the automobile) in Invention 1. Therefore, in Difference 1, whether a step extends "substantially horizontally" or "slightly downward" alone becomes a problem.

(B) In examining the above, there is no statement in the Description concerning the technical meaning that the step extends "substantially horizontally" inward from the lower part of the vertical flange. In addition, as stated in 1. (2) above, in the Invention, it is made possible to remove the draining lip and the hooking flange from the part located on the surface of the door frame except for the vertical flange, and substantially cross-sectional shape C is formed by the molding main body and the vertical flange while the section stiffness is secured in order to provide a beltline molding whose edge has excellent stiffness. In the terminal section of the beltline molding, the part located on the door frame surface is removed except for the vertical flange and the step is also removed. Therefore, if the step extends "substantially horizontally" or extends "slightly downward," it does not have any impact on the function and effects of the Invention. Then, it is not found that there is any technical meaning with a step designed to extend "substantially horizontally."

In Exhibit Ko 1 Invention 1 as well, it is not found that there is any technical meaning with the fact that the step extends "slightly downward" from the lower part of the vertical flange in the direction of the elevating window glass side (inward). Therefore, to configure the step that extends "slightly downward" to extend "substantially horizontally" in Exhibit Ko 1 Invention 1 is only a matter of design variation that a person ordinarily skilled in the art could have conceived of as necessary.

Based on the above, without the need to examine the matters stated in Exhibit Ko 2, it is reasonable to find that a person ordinarily skilled in the art could have easily conceived of adding a design change to the step to extend "substantially horizontally" in Exhibit Ko 1 Invention 1.

(C) Consequently, there is an error in the determination in the JPO Decision concerning whether a person skilled in the art could have easily conceived of Difference 1.

B. Difference 2

(A) Concerning Difference 2, "a part that extends downward from the edge of the step" is "a hooking flange" that extends downward from the edge of the step in Invention 1, while it is "a part" that extends downward from the edge of the step in Exhibit Ko 1 Invention 1.
(B) According to the statements in the Claims related to Invention 1, the "hooking flange" is "clamped and mounted on the upper edge of an outer panel by the molding main body and the hooking flange" in the door glass elevating unit (a part other than the edge) of a beltline molding. Therefore, the "hooking flange" in Invention 1 is found to refer to the part that is located in the opposite place across the molding main body (the outside of the downward U-shaped beltline molding) and an outer panel and that is attached in a way where the upper edge of the outer panel is pinched along with the molding main body. The aforementioned understanding conforms to the statements in the Description.
(C) Next, Exhibit Ko 1 contains no drawing that directly explains the positional relationship between the outer panel and the molding (beltline molding). However, there is a statement that the molding is one wherein "an outer surface of a core material formed by bending a metal strip material into a substantially U-shaped cross section is bonded with synthetic resin" (lines 23 through 25 of Section 1 of Exhibit Ko 1) and is "fitted and fixed along the automobile door's top margin" (lines 1 through 2 of Section 2 of Exhibit Ko 1). In addition, in consideration of the molding shape (see FIG. 1 a of Exhibit Ko 1) in Exhibit Ko 1 Invention 1, and the fact that, as stated in 2. (1) B. above, in Exhibit Ko 1 Invention 1, part of the terminal section of the beltline molding that is attached by fitting and fixing along the top margin of the automobile door (outer panel) is cut and removed with the aim of preventing it from lifting up; and in the part where part of it is not removed, the beltline molding itself is fitted and fixed on the automobile door, it is easily understood that in Exhibit Ko 1 invention 1, the outer panel is pinched and fixed between the outside of the core material of the beltline molding that is bent in a downward substantially U-shape (outside the automobile; the part shown as 11 in FIG. 1 a) and the inside thereof (inside the automobile: the part shown as 13 in FIG. 1 a). This understanding is considered to be natural in light of the fact that the shape of the beltline molding stated in Exhibit Ko 2 and Exhibit Ko 4 that is an invention related to the beltline molding, in the same manner as Invention 1 and Exhibit Ko 1 Invention 1, is one that is attached in a way where the outer panel is pinched between the outside and the inside of a member that is bent in a downward substantially U-shape (2. (2) above, [0017] of Exhibit Ko 4, etc.).
(D) In addition, in Invention 1, the part inside the automobile which is from the step to

the end (a step and a hooking flange) is removed from the "part located on the surface of the door frame," that is, the edge of the beltline molding. In Exhibit Ko 1, it is stated that "a flange 16 is formed by remaining part of the top side of a core material 10 and by removing a base 13 (see FIG. 1 b)" (lines 25 through 27 of Section 3 of Exhibit Ko 1). In consideration also of FIG. 1 a through c in Exhibit Ko 1 and [FIG. 1] through [FIG. 4] of the Description, the location to be removed and the shape of the part to be removed are almost the same in Invention 1 and Exhibit Ko 1 Invention 1.

(E) As stated above, it is reasonable to find that the "part" that extends downward from the edge of the step in Exhibit Ko 1 Invention 1 (the part shown as 13 in FIG. 1 a of Exhibit Ko 1) is the part corresponding to the "hooking flange" in Invention 1 and it is nothing more than that a special name is not provided thereto in Exhibit Ko 1 Invention 1. Therefore, it is not a substantive difference.

Consequently, Difference 2 is not a substantive difference, and therefore, there is an error in the JPO Decision related to Difference 2.

C. Difference 3

(A) Difference 3 is related to the expression, "the beltline molding is mounted on a door panel." In Invention 1, "the door glass elevating unit is clamped" and mounted "on the upper edge of a door's outer panel by the molding main body and the hooking flange," while in Exhibit Ko 1 Invention 1, "the belt molding M is attached by being pushed into the door panel P on the automobile body side." The "door panel P" in Exhibit Ko 1 Invention 1 is an outer panel and the location where the molding is attached is not different between Invention 1 and Exhibit Ko 1 Invention 1. Therefore, Difference 3 is a question as to whether the phrase used in Exhibit Ko 1 Invention 1, "attached by being pushed into," is different from the phrase used in Invention 1, "clamped" and mounted. The Description does not specially define the term, "clamped," as used in Invention 1. However, based on the literal meaning, it is construed to mean to hold something in a state of pinching it and the phrase, "clamped and mounted," is construed to mean to attach an item in a way of pinching it.

(B) In examining the above, in the detailed explanation of the invention of Exhibit Ko 1, it is stated as follows: "In the belt molding, an outer surface of a core material formed by bending a metal strip material into a substantially U-shaped cross section is bonded with synthetic resin and the lip that comes into contact with a glass window is formed integrally on its one side. And it is attached by fitting and fixing along the automobile door's top margin. Part of the terminal section is cut and removed to prevent it from interfering with the door sash and the corner piece. However, if the cut part is created, the part that fits and engages with the automobile body panel is lost. Therefore, the

decorating surface that is located on the automobile body side may be lifted up from the automobile body panel or may be bent." (line 23 of Section 1 through line 9 of Section 2 of Exhibit Ko 1). Therefore, it is found that the molding is fitted and engaged on the top side of the outer panel; however, the terminal section (end) where part of it is removed cannot be fitted and engaged as it is. Exhibit Ko 1 has the following statements: "In the belt molding related to the Invention, a screw hole that passes through the core metal material is formed on a flange where part of the terminal section of the molding main body in the longitudinal direction is removed; the screw hole is retained; and the flange around the screw hole is also coated with synthetic resin that forms an end cap on the edge of the molding main body, and thereby, the belt molding is configured so that the terminal section of the molding can be screwed and fixed with a tapping screw, etc. on the automobile body side panel." (lines 2 through 10 of Section 3); and "in order to install the molding M configured as stated above on the automobile body side panel, after substantially the entire length of the molding is pushed in the longitudinal direction into the door panel P on the automobile body side, a tapping screw 5 with a washer to be inserted from the back side of the door panel P is tightened in a screw hole 17 of a flange 16, and thereby, the terminal section side can be firmly fixed by screwing on the automobile body side panel (see FIG. 3 a and b)." (lines 11 through 18 of Section 4). Based on these statements, it is found that, in Exhibit Ko 1 Invention 1, concerning the edge, part of the molding main body is cut and removed; the part cannot be fitted and engaged with the top margin of an outer panel ("automobile door," "automobile body panel," "automobile body side panel," and "door panel P" of Exhibit Ko 1); and therefore that a screw hole is formed on the flange for the cut part and the edge is fixed on the outer panel by screwing.

Then, in Exhibit Ko 1 Invention 1, the molding is "fitted and engaged" on the top side of the outer panel in a part other than the edge. However, as found in B. above, it is easily understood that the molding is attached in a way of pinching the outer panel. Therefore, it is reasonable to find that the phrase, "attached by being pushed into," as used in Exhibit Ko 1 Invention 1 refers to a state where the molding is attached in a way of pinching the top margin of the outer panel substantively in the same way as expressed with the phrase, "clamped" and mounted, as used in Invention 1.

Based on the above, Difference 3 is not a substantive difference.

(C) In this regard, in the JPO Decision, it is determined that, concerning FIG. 3 a of Exhibit Ko 1, the panel on the automobile body side (door panel P) bends in a crank shape in the direction departing from lips 14 and 15, which means towards the front side, on the side where the panel on the automobile body side faces lips 14 and 15 of

the molding M, and that, in Exhibit Ko 1 Invention 1, the panel on the automobile body side (door panel P) is construed to be located on the front side of the molding M in a state where the molding M is attached to the panel on the automobile body side (door panel P). In the JPO Decision, it is found that, in Exhibit Ko 1 Invention 1, the door panel P is not pinched by the molding, but is located on the front side, and that the molding M is attached by screwing; and it is determined that Difference 3 could not have been easily conceived of by a person ordinarily skilled in the art. The Defendant also argued that the aforementioned findings in the JPO Decision are reasonable.

However, in Exhibit Ko 1, there are statements as shown in (B) above. According to said statements, it is found that the molding was attached in a way of pinching an outer panel in the part other than the edge but not attached by screwing. Therefore, the aforementioned finding in the JPO Decision is against the statements in Exhibit Ko 1.

Concerning FIG. 3 a of Exhibit Ko 1, it is difficult to read from said drawing alone as to whether the door panel P bends, or if it bends, to which side the door panel P bends, the front side or back side. However, in Exhibit Ko 1 Invention 1, "the base coating unit" of the belt molding M "is comprised of top and bottom lips 14 and 15 that protrude diagonally towards the elevating window glass and come into contact with the glass window" (2. (1), B. (B) above, No. 2, 3. (2) A. (A) a.), and therefore, lips 14 and 15 that come into contact with the glass window are formed on the front side of the molding M. Concerning the positional relationship between the molding M and door panel P, as was found in the JPO Decision, assuming that the door panel P (outer panel) is located on the front side of the molding M (meaning the window glass side), the door panel P is pinched between the lip formed on the molding M and the window glass and it hinders the lip from coming into contact with the window glass. Therefore, it should not be construed that the door panel P bends on the front side in FIG. 3 a of Exhibit Ko 1.

Based on the above, there is an error in findings in the JPO Decision as stated above concerning the positional relationship between the door panel and the molding in Exhibit Ko 1 Invention 1.

(D) Consequently, there is an error in the determination in the JPO Decision related to Difference 3.

D. Difference 4

In Difference 4, concerning the expression, "the edge can have an end cap," in Invention 1, the edge "has section stiffness so that an end cap can be attached thereto," while in Exhibit Ko 1 Invention 1, "an end cap 3 is injected and molded" on the terminal section. In Exhibit Ko 1 Invention 1, since an end cap is attached, it is found that a person ordinarily skilled in the art could have easily conceived of it having section

stiffness for attaching the end cap or at least that it has section stiffness.

Based on the above, Difference 4 is not a substantive difference or could have been easily conceived of by a person ordinarily skilled in the art. The Defendant does not dispute this point.

(3) Summary

As stated above, from among differences between Invention 1 and Exhibit Ko 1 Invention 1, Differences 1 and 4 could have been easily conceived of by a person ordinarily skilled in the art. Differences 2 and 3 are not substantive differences. Therefore, Invention 1 has grounds for invalidation due to the lack of an inventive step based on Exhibit Ko 1 Invention 1 and the determination in the JPO Decision related to an inventive step in Invention 1 contains an error.

Based on the above, the grounds for rescission due to the error in the determination in the JPO Decision related to an inventive step concerning Invention 1 argued by the Plaintiff are well-grounded (Grounds for Rescission 1 through 4).

4. Grounds for Rescission 5 (error in the determination in the JPO Decision related to an inventive step concerning Invention 2)

(1) Common features and differences

Comparing Invention 2 with Exhibit Ko 1 Invention 2 in 2. (1) B. (B) above, as it was found in the JPO Decision in No. 2, 3. (2) D. above, they are found to share the following common features and be different in Differences 5 through 8.

[Common features]

"A beltline molding which is mounted on a vehicle door and is characterized by the following:

a beltline molding is comprised of a molding main body that forms a design surface and a step cross-sectional shape unit that is folded back in the inner lower direction from the upper part of the molding main body;

wherein the step cross-sectional shape unit has a vertical flange that is folded back downward from the upper part of the molding main body, a step that extends inward from the lower part of the vertical flange, and a part that extends downward from the edge of the step;

wherein the beltline molding is mounted on a door panel;

wherein the step cross-sectional shape unit has a draining lip that stands so that it slides and comes into contact with the door glass."

[Difference 5]

Concerning "a step that extends inward from the lower part of the vertical flange," in Invention 2, it is a step that extends "substantially horizontally" inward from the

lower part of the vertical flange, while in Exhibit Ko 1 Invention 2, it is a step that extends "slightly downward" from the lower part of the vertical flange in the direction of the elevating window glass side.

[Difference 6]

Concerning "a part that extends downward from the edge of the step," in Invention 2, it is "a hooking flange" that extends downward from the edge of the step, while in Exhibit Ko 1 Invention 2, it is "a part" that extends downward from the edge of the step.

[Difference 7]

Concerning the expression, "the beltline molding is mounted on a door panel," in Invention 2, "the door glass elevating unit is clamped" and mounted "on the upper edge of a door's outer panel by the molding main body and the hooking flange," while in Exhibit Ko 1 Invention 2, "the belt molding M is attached by being pushed into the door panel P on the automobile body side."

[Difference 8]

Concerning the expression, "the step cross-sectional shape unit has a draining lip that stands so that it slides and comes into contact with the door glass," in Invention 2, the step cross-sectional shape unit that "has a draining lip that is a hooking flange and stands from inside of the step so that it slides and comes into contact with the door glass and a sub-lip that stands from the vertical flange so that it comes into contact with the outside of the draining lip," while in Exhibit Ko 1 Invention 2, the base coating unit is comprised of "top and bottom lips 14 and 15 that protrude diagonally towards the elevating window glass and come into contact with the glass window."

(2) Differences

A. Differences 5 through 7 are substantively the same as Differences 1 through 3. Concerning Differences 1 through 3, the statements on Exhibit Ko 1 Invention 1 apply to Exhibit Ko 1 Invention 2 without change concerning Differences 5 through 7. Therefore, based on the same grounds as 3. above, Difference 5 could have been easily conceived of by a person ordinarily skilled in the art and Differences 6 and 7 are not substantive differences.

B. Concerning Difference 8, it is reasonable to find that a person ordinarily skilled in the art could have easily conceived of it by applying the matters stated in Exhibit Ko 3 in 2. (3) B. above to Exhibit Ko 1 Invention 2. The Defendant does not dispute that Difference 8 could have been easily conceived of by a person ordinarily skilled in the art.

(3) Summary

As stated above, from among differences between Invention 2 and Exhibit Ko 1

Invention 2, Differences 5 and 8 could have been easily conceived of by a person ordinarily skilled in the art. Differences 6 and 7 are not substantive differences. Therefore, Invention 2 has grounds for invalidation due to the lack of an inventive step based on Exhibit Ko 1 Invention 2 and the determination in the JPO Decision related to an inventive step in Invention 2 contains an error.

Based on the above, Grounds for Rescission 5 argued by the Plaintiff are well-grounded.

5. Grounds for Rescission 6 (violation of procedures)

The Plaintiff argued that there was a violation of procedures in the JPO Decision. However, the matters that the Plaintiff pointed out are eventually an argument that there is an error in the determination related to an inventive step in the JPO Decision. Although there are grounds in said argument as stated in 3. and 4. above, in light of the process of the examination in the trial that is found based on evidence submitted in this case and the JPO Decision, it cannot be found that there are other reasons for rescission due to a violation of procedures in the JPO Decision.

No. 6 Conclusion

As stated above, the JPO Decision contains an error in the determination related to an inventive step concerning the Invention and the Plaintiff's claim has grounds. Accordingly, the judgment is rendered as indicated in the main text.

Intellectual Property High Court, Second Division
Presiding judge: HONDA Tomonari
Judge: ASAI Ken
Judge: KATSUMATA Kumiko

(Attachment 1: omitted)
(Attachment 2: omitted)