

Patent Right	Date	March 24, 2025	Court	Intellectual High Court, Third Division
	Case number	2024 (Gyo-Ke) 10049		
<p>- A case in which, with regard to a patent application for an invention titled "Vehicle," the court rescinded a decision of the Japan Patent Office (JPO) to the effect that the request for a trial against the examiner's decision of refusal is groundless, by holding that the determination of the JPO that the patented invention after the amendment could have been easily made by a person ordinarily skilled in the art based on the Cited Invention, well-known matters and well-known art is erroneous due to the lack of grounds and the failure to present the reasons for the determination.</p>				

Case type: Rescission of Appeal Decision of Refusal

Result: Granted

References: Article 29, paragraph (2), Article 17-2, paragraph (6), and Article 126, paragraph (7) of the Patent Act

Decision of the JPO: Appeal against Examiner's Decision of Refusal No. 2023-5963

### Summary of the Judgment

1. X filed a patent application for an invention titled "Vehicle" but received an examiner's decision of refusal. Accordingly, X filed an appeal against the examiner's decision of refusal and made an amendment to the procedures to amend Claim 1 among the claims (referred to below as the "Amendment").

The JPO determined that the invention specified in Claim 1 of the application in question (the "Application") after amendment through the Amendment (referred to below as the "Amended Invention") could have been easily made by a person ordinarily skilled in the art based on the Cited Invention, well-known matters, and well-known art and was not allowed to be patented independently upon the filing of a patent application pursuant to the provisions of Article 29, paragraph (2) of the Patent Act, and that the Amendment should be dismissed as it violates the provisions of Article 126, paragraph (7) of the Patent Act as applied mutatis mutandis pursuant to Article 17-2, paragraph (6) of the same Act. The JPO also determined that the invention specified in Claim 1 of the Application before amendment through the Amendment could have been easily made by a person ordinarily skilled in the art based on the Cited Invention, well-known matters, and well-known art and that the Application should be refused. Based on these determinations, the JPO rendered a decision to the effect that the request for a trial

against the examiner's decision of refusal is groundless (referred to below as the "JPO Decision").

The Plaintiff filed this lawsuit to seek rescission of the JPO Decision. As the grounds for rescission, the Plaintiff alleged an error in the JPO's determination concerning whether the invention in question could have been easily conceived of by a person ordinarily skilled in the art.

2. In this judgment, as summarized below, the court held as follows: the JPO's determination concerning whether the invention in question could have been easily conceived of by a person ordinarily skilled in the art is erroneous; the Amendment satisfies the requirements for the invention stated in the amended claim to be patented independently and is lawful; the invention stated in Claim 1 of the Application became the Amended Invention through the Amendment, and the Amended Invention could not have been easily made by a person ordinarily skilled in the art; accordingly, the conclusion of the JPO Decision is erroneous and the grounds for rescission argued by the Plaintiff are well-grounded.

(1) Differences between the Amended Invention and the Cited Invention found by the JPO contain the difference that "the Amended Invention is an invention of a vehicle or a drone configured to be turnable in a lean position, but it is not clear whether the Cited Invention is configured in that manner."

The JPO determined that it is not found particularly difficult to make the vehicle of the Cited Invention into a vehicle configured to be turnable in a lean position in consideration of well-known art, nor is it found particularly difficult to make the vehicle of the Cited Invention into a drone because a drone generally has a small energy storage device in the same manner as a vehicle configured to be turnable in a lean position.

(2) According to the statements in the description, etc. of the Application, it is found that the "vehicle configured to be turnable in a lean position" of the Amended Invention is a vehicle with wheels that runs on land by the rotation of these wheels and is configured to be turnable in a lean position.

The vehicle of the Cited Invention is found to have a driving force control device and an accelerator pedal, but the fact that an accelerator pedal can also be adopted in a "vehicle configured to be turnable in a lean position" was found to have been well-known among persons ordinarily skilled in the art before the filing of the Application. Therefore, it cannot be said that a person ordinarily skilled in the art would have immediately excluded a "vehicle configured to be turnable in a lean position" from the scope of the "vehicle" of the Cited Invention.

(3) The JPO explained as follows: "A vehicle configured to be turnable in a lean position

and its energy storage device are generally small, and accordingly, electric power that can be supplied from such energy storage device is low. This situation can be understood as presenting the same inherent problem as that in the case where the temperature of the battery of the Cited Invention declines. Furthermore, downsizing and weight reduction are general problems not only for energy storage devices, but are inherent problems naturally required to be solved also for the Cited Invention (omitted), and these problems are common to vehicles configured to be turnable in a lean position based on well-known art that generally have small energy storage devices. The JPO relied on the matters thus explained as a ground to determine that it is not found particularly difficult to make the vehicle of the Cited Invention into a vehicle configured to be turnable in a lean position.

However, regarding the point that "a vehicle configured to be turnable in a lean position and its energy storage device are generally small," grounds therefor have not been presented nor has any evidence been submitted.

Furthermore, supposing that it can be said that "a vehicle configured to be turnable in a lean position and its energy storage device are generally small," it may be said that when an energy storage device (battery) is small, the total electric power that can be supplied from that battery is low, but this does not immediately mean that the electric power supplied from that battery as of a certain point in time is low.

Based on the statements in the Cited Document, it can be found that the Cited Invention aims to solve the problem that when the temperature of the battery is low, the power that can be supplied from the battery is small. However, there is no sufficient basis to conclude that it is a problem that generally exists for a vehicle configured to be turnable in a lean position, that the power that can be supplied from its energy storage device (battery) is low. Therefore, it cannot be said that there is a commonality between the problem to be solved by the Cited Invention and the problem that "a vehicle configured to be turnable in a lean position" generally has, and it also cannot be found that a person ordinarily skilled in the art would have been motivated to make the vehicle of the Cited Invention into "a vehicle configured to be turnable in a lean position" in consideration of the commonality in their problems.

(4) A drone is an aircraft having rotary wings and flies in the air by rotating the rotary wings.

On the contrary, the vehicle of the Cited Invention runs as a result of the drive wheels conveying power to the road surface, and thus it is a vehicle that has wheels and runs on land by the rotation of the wheels.

Then, the vehicle of the Cited Invention, which runs on land by the rotation of the

wheels, and the drone of the Amended Invention, which flies in the air by rotating the rotary wings, are different in essence in terms of the configuration and the form of movement.

The JPO also found that "a vehicle having an engine, power generation electric motor, energy storage device and propulsive electric motor is a vehicle configured to be turnable in a lean position" is well-known art. However, there is no evidence sufficient to find that a drone "has an engine, power generation electric motor, energy storage device and propulsive electric motor." As a ground to determine that it is not found particularly difficult to make the vehicle of the Cited Invention into a drone, the JPO pointed out that a drone is "generally small and its energy storage device is also small in the same manner as a vehicle configured to be turnable in a lean position," but did not present any evidence sufficient to find this point.

(5) According to (3) and (4) above, the JPO determined that it is not found particularly difficult to make the vehicle of the Cited Invention into "a vehicle configured to be turnable in a lean position" and that it is not found particularly difficult to make the vehicle of the Cited Invention into a drone, but these determinations are erroneous as they both lack grounds and the JPO has failed to present reasons for making such determinations.

As the abovementioned determinations constitute the process of making a determination as to whether the Amended Invention could have been easily conceived of by a person ordinarily skilled in the art, as long as they are erroneous, the JPO's determination as to the ease of conceiving of the Amended Invention is also found to be erroneous.

(6) The Amended Invention could not have been easily made by a person ordinarily skilled in the art, and the Amendment satisfies the requirements for the invention stated in the amended claim to be patented independently (Article 17-2, paragraph (6) and Article 126, paragraph (7) of the Patent Act) and is lawful. The invention stated in Claim 1 of the Application became the Amended Invention through the Amendment, and the Amended Invention could not have been easily made by a person ordinarily skilled in the art. Accordingly, the conclusion of the JPO Decision to the effect that the Application should be refused is erroneous and the grounds for rescission argued by the Plaintiff are well-grounded.