

Patent Right	Date	January 21, 2020	Court	Intellectual Property High Court, First Division
	Case number	2019 (Gyo-ke) 10042		
<p>- A case in which, in the case of seeking an invalidation trial of the patent for the invention titled "MASSAGING MACHINE", the JPO decision was rescinded, since the JPO decision has no description on a part of the matters specifying the invention in relation with judgment on the clarity requirement and cannot be evaluated as substantial judgment, and has illegality of procedures which influences the conclusion of the JPO decision.</p> <p>- A case in which conformity to the requirement for amendment should be judged on all the amended matters related to the amendment as a whole, and the allegation that addition of a part of a Matter F is applicable to a new matter is only a part of allegation and evidence which forms a basis of an invalidation reason as violation of the requirement for amendment in relation to the present amendment and moreover, the judgment was substantially made in this JPO decision and thus, it was not judged that there was illegality influencing the conclusion of the JPO decision in the relation with the other invalidation reasons such as violation of the requirement for amendment and the like.</p>				

Case type: Rescission of Trial Decision to Maintain

Result: Granted

References: Article 17-2, paragraph (3), Article 29, paragraph (2), Article 36, paragraph (6), item (i), item (ii), Article 44 of the Patent Act

Number of related rights, etc.: Invalidation Trial No. 2018-800041, Patent No. 5009445

Summary of the Judgment

1. This case is a suit against a trial decision made by the JPO in which, when Plaintiff requested an invalidation trial for the patent by Defendant of the invention titled "MASSAGING MACHINE", the trial decision dismissing the request was made and thus, Plaintiff claimed the rescission thereof.

Plaintiff alleged errors in each of the judgments related to requirement for amendment, support requirement, clarity requirement, inventive step, and division requirement as reasons for rescission and moreover, since the JPO decision has defects in the procedure such as premature decision, deviation of judgment, and the like as below, the JPO decision should be rescinded.

That is, Plaintiff alleges in relation to the specifying matter of the "opening into which an arm of a treated person in a section seen after being cut off in a width direction" in the constituent feature F, there are invalidation reasons of violation of each of the requirement for amendment, the support requirement, and the clarity

requirement and lack of novelty / lack of inventive step caused by violation of the division requirement, and although Defendant counterargued in a written reply, judgment was not made in this JPO decision for each of the invalidation reasons in the trial procedure.

2. This judgment held substantially as follows on the allegation related to the judgment deviation and rescinded the JPO decision, since the JPO decision has deviation in the judgment on the clarity requirement, and trial judgment should be exhausted in this point.

(1) Clarity requirement

The JPO decision judged only on the constituent features G and L in the judgment on the clarity requirement, and there is no description in the "outline of Petitioner's allegation" or "judgment of the panel" on Constituent Feature F, and it cannot be evaluated that the judgment was substantially made.

Therefore, it can be considered that the JPO decision has illegality in procedure and this is illegality influencing the conclusion of the JPO decision.

(2) Violation of requirement for amendment, violation of division requirement, and support requirement

A. The JPO decision does not have explicit description on Constituent Feature F in relation with the invalidation reason alleged by Plaintiff such as violation of the requirement for amendment and the like.

However, conformity of the requirement for amendment should be judged as a whole for all the amendment matters in relation to the amendment, and the allegation that addition of a part of the Matter F is applicable to a new matter is only a part of allegation and evidence which forms a basis of an invalidation reason as violation of the requirement for amendment in relation to the present amendment and cannot be considered to be a separate invalidation reason independent thereof. Even if the judgment is missed, it does not immediately lead to deviation in the judgment on the invalidation reason.

Moreover, the "opening" specified in Constituent Feature F is the configuration which is the premise of Constituent Feature H ("the pair of holding portions are disposed so that each of the openings is directed to the side, and the openings face each other"), and it can be considered to be substantially judged also in this JPO decision that the addition of Matter H is not applicable to addition of a new matter.

And in ... the original Description ..., since the "holding portion" having a substantially semicircular cylindrical shape with a substantial C-shape on a sectional view is described, and it is described that the "opening portion" refers to a "missing

portion extending to a longitudinal direction" in the "holding portion" and has a width slightly larger than the thickness of an arm part of an adult having a general body build, through which the arm portion can be inserted into the holding portion, it is obvious that the "opening" specified in Constituent Feature F is a matter described in the original Description.

B. Moreover, the same applies to the allegation by Plaintiff referring to the lack of novelty / inventive step caused by violation of the division requirement on the premise of presence of addition of a new matter.

C. With regard to the support requirement as well, the JPO decision does not have an explicit description on Constituent Feature F.

However, ... similarly to the aforementioned A, even if decision on the part of Matter F is missed, it does not immediately lead to deviation in the judgment on the invalidation reason.

Moreover, as in the aforementioned A, the "opening" specified in Constituent Feature F is a configuration which is the premise of Constituent Feature H and can be considered to be substantially judged also in this JPO decision.

And ... Present Invention 1 includes all the configurations described in the present Description ... and is the invention described in detailed description of the invention within a range that a person ordinarily skilled in the art can recognize that a person ordinarily skilled in the art could solve the problem of the invention by detailed description of the invention. In addition, since the present Description also has a description similar to ..., it is also obvious that the "opening" specified in Constituent Feature F is supported by the description in the present Description.