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|--|-------------|---------------------|-------|--|
| Patent Right   | Date        | February 20, 2020   | Court | Intellectual Property High Court, Third Division |
|  | Case number | 2019 (Gyo-Ke) 10043 |       |  |
| - A case in which the invention titled "HIGH-CONTRAST TIRE PATTERN AND MANUFACTURE THEREOF" is judged to have no inventive step. |             |                     |       |  |

Case type: Rescission of Trial Decision to Maintain

Result: Granted

References: Article 29, paragraph (2), Article 126, paragraph (5) of the Patent Act

Related rights, etc.: Patent No. 5642795

Decision of JPO: Invalidation Trial No. 2016-800115

### Summary of the Judgment

1. The present case is a lawsuit that Plaintiff who made a request for a trial for patent invalidation for the patent right related to the invention held by Defendant and titled "HIGH CONTRAST TIRE PATTERN AND MANUFACTURE THEREOF" sought rescission of the JPO decision dismissing the request.

As reasons for rescission, Plaintiff alleged an error in judgment of the correction requirement (prohibition of addition of new matter), an error in judgment of inventive step, and the like.

2. The judgment held that the JPO decision has no error in judgment of the correction requirement but has an error in the judgment of inventive step, and rescinded the JPO decision as follows.

#### (1) Correction requirement

In the present description, the structure in which an average roughness Rz of 5  $\mu\text{m}$  to 30  $\mu\text{m}$  is provided at one-fourth below the tuft is disclosed, and application of a similar structure to the blade is also disclosed. Thus, to provide the average roughness Rz of 5  $\mu\text{m}$  to 30  $\mu\text{m}$  at one-fourth below the blade does not introduce a new technical matter by a person ordinarily skilled in the art in the relation with the technical matter led by integrating all the descriptions in the present description.

#### (2) Judgment of inventive step

A. Since Exhibit Ko 1 Invention (primarily cited reference) has an object to improve distinctive character of a display mark provided on a sidewall surface of a tire, it is considered that a person ordinarily skilled in the art would examine further improvement of the distinctive character of the display mark. Moreover, according to the description in Exhibit Ko 1, the improvement of distinctive character of the display mark is one of means for making appearance of the tire

excellent, and if there is means for further improving the appearance of the tire in Exhibit Ko 1 Invention, it is preferable.

Since the Exhibit Ko 2 document (secondarily cited reference) has a pneumatic tire as a technical field, the technical field is in common with Present Invention 3, and moreover, a phenomenon of damage on the appearance by deterioration over time is recognized as a problem, and a technical matter for solving this is described. Such phenomenon can occur in the entire tire including the display mark portion in Exhibit Ko 1 Invention, but then, the appearance of the tire in Exhibit Ko 1 Invention is damaged, and the distinctive character of the display mark is deteriorated.

Thus, the described matter of the Exhibit Ko 2 document is considered to be content suitable for further improvement of the tire appearance of Exhibit Ko 1 Invention including the display mark portion and thus, it can be considered that a person ordinarily skilled in the art would be sufficiently motivated to try combination of the described matter of the Exhibit Ko 2 document with Exhibit Ko 1 Invention.

The Exhibit Ko 2 document does not have an idea to improve contrast of the display mark, but even if so, the combination with Exhibit Ko 1 Invention is tried for another reason.

- B. When the matter described in the Exhibit Ko 2 document is applied to Exhibit Ko 1 Invention, on the basis of the description in the Exhibit Ko 2 document, a structure in which surface roughness of 5  $\mu\text{m}$  to 30  $\mu\text{m}$  is provided on the entire sidewall surface including the display mark portion is obtained.

Such structure is also interpreted to be included in Present Invention 3.

Thus, to apply the matter described in the Exhibit Ko 2 document to Exhibit Ko 1 Invention so as to have the structure of Present Invention 3 could have been easily conceived of.

- C. Inventive step is not found, either, in Present Inventions 1, 2, and 4 to 6.