

Patent Right	Date	May 28, 2020	Court	Intellectual Property High Court, First Division
	Case number	2019 (Gyo-Ke) 10075		
- A case in which it was found that Claims 7 and 8 in the invention titled "MANUFACTURE METHOD OF POLYOLEFIN-BASED STRETCHED FILM AND POLYOLEFIN-BASED STRETCHED FILM MANUFACTURED BY THE METHOD" could have been easily conceived of from the Cited Invention.				

References: Article 29, paragraph (1), paragraph (2), Article 36, paragraph (4), item (i), paragraph (6), items (i), (ii) of the Patent Act

Related rights, etc.: Patent No. 5934355, Invalidation Trial No. 2018-800048

Summary of the Judgment

1. Defendant is a patentee of the invention titled "MANUFACTURE METHOD OF POLYOLEFIN-BASED STRETCHED FILM AND POLYOLEFIN-BASED STRETCHED FILM MANUFACTURED BY THE METHOD" (number of claims: 8, hereinafter called the "Present Patent").

Plaintiff made a request for an invalidation trial for Claims 6 to 8, while Defendant made a correction request (Present Correction) for correction of a group of claims consisting of Claims 7 and 8.

The JPO approved the Present Correction and then, made the present JPO decision that "the claim for the present trial is not established.". The gist of the present JPO decision is [i] with regard to Present Inventions 6 to 8, lack of novelty/lack of inventive step on the ground of Cited Document 1 and the lack of inventive step on the ground of Cited Document 2 are not found; [ii] with regard to Present Inventions 7 and 8, double patenting in the relation with Cited Document 3 is not found; and [iii] with regard to Present Invention 6, there are no violations of enablement requirement, support requirement, and clarity requirement.

Plaintiff instituted the present lawsuit seeking rescission of the present JPO decision. The reasons for rescission are [i] error in judgment of novelty and inventive step on the ground of Cited Document 1 in relation with Present Inventions 6 to 8; [ii] error in judgment of inventive step on the ground of Cited Document 2 in relation with Present Inventions 6 to 8; [iii] error in judgment of double patenting on the ground of Cited Document 3 in relation with Present Inventions 7 and 8; [iv] error in judgment of the enablement requirement in relation with Present Invention 6; [v] error in judgment of the support requirement in relation with Present Invention 6; and [vi] error in judgment of the clarity requirement in relation with Present Invention 6.

2. The judgment rescinded the portion related to Claims 7 and 8 in the present JPO decision as follows and dismissed the remaining requests.

(1) Reason 1 for rescission

A. Different Feature 1-1 between Present Invention 6 and Cited Invention 1 is a substantial difference and could not have been easily conceived of from Cited Invention 1A.

B. It cannot be considered that Cited Invention 1A has motivation to conceive of the structure of Different Feature 1-3 and thus, Different Feature 1-3 could not have been easily conceived of from Cited Invention 1A.

C. According to the above, Present Invention 6 could not have been easily made by a person ordinarily skilled in the art on the basis of Cited Invention 1A, and the same applies to Present Inventions 7 and 8 citing this.

(2) Reason 2 for rescission

A. Different Feature 2-1 with Present Invention 6

There is motivation to use a complex film manufactured by co-extrusion of three layers including a polypropylene film layer with biaxial alignment in an intermediate layer as a base layer of Cited Invention 2A. On the other hand, since there is no allegation of hindrance grounds, the structure related to Different Feature 2-1 could have been easily conceived of by a person ordinarily skilled in the art by applying the prior art to Cited Invention 2A.

B. Different Feature 2-2 with Present Invention 6

The process of Cited Invention 2A and the cooling step of Present Invention 6 are different in purpose and the structure to be formed, and it cannot be considered that there is motivation to use the process of embossing an inverted gravure pattern of Cited Invention 2A as the second cooling step for forming an air channel in Present Invention 6. Therefore, the structure related to Different Feature 2-2 could not have been easily conceived of by a person ordinarily skilled in the art.

C. Different Feature 2-4 with Present Invention 7

The "thermal sealing resin layer" in Present Invention 7 and the "C layer made of ethylene/methacrylic acid co-polymer (C) with a melting point of 90°C" in Cited Invention 2B have no difference in a point that they are for "thermal lamination" and thus, Different Feature 2-4 is not a substantial difference.

D. Present Invention 8

Present Invention 8 limits the "first skin outer layer" of Present Invention 7 to a polyethylene-based resin and the like. There is motivation to employ the structure

disclosed in the prior art for the base layer of Cited Invention 2 as described above, and the limitation as above could also have been easily conceived of. On the other hand, there is no allegation of hindrance grounds. Thus, to use the layer structure of Cited Invention 2B for Present Invention 8 could have been easily conceived of by a person ordinarily skilled in the art and thus, Present Invention 8 could have been easily made by a person ordinarily skilled in the art on the basis of Cited Invention 2B.

E. Summary

Present Invention 6 was not easily conceivable from the invention described in Cited Document 2, but both of Present Inventions 7 and 8 could have been easily conceived from the invention described in Cited Document 2, and the reason 2 for rescission have grounds only for the portion related to Present Inventions 7 and 8.

(3) Reasons 4 to 6 for rescission

It can be considered that a person ordinarily skilled in the art could work Present Invention 6 from the description in the present Description and thus, Present Invention 6 does not violate the enablement requirement.

A person ordinarily skilled in the art who contacted the description in the present Description can recognize that Present Invention 6 can solve the problem that "to provide a manufacture method of a polyolefin-based stretched film which can lower the production cost of the product and is excellent in inter-layer adhesion and a polyolefin-based stretched film manufactured by the method in which, when a resin layer for thermal lamination is to be formed, a manufacturing process is simple, and time for the manufacture is reduced by enabling lamination forming in a continuous process by extrusion even in the case of a resin with a low melting point", and there is no violation of the support requirement in Present Invention 6.

The description in Claim 6 is not considered to be so unclear that gives unexpected disadvantage to a third party, but complies with the clarity requirement.