

Patent Right	Date	November 5, 2020	Court	Intellectual Property High Court, Third Division
	Case number	2019 (Gyo-Ke) 10132		
- A case in which the determination on novelty in the JPO decision made after the effect of priority claim on the basis of the Paris Convention was found has no errors.				

Case type: Rescission of Trial Decision to Maintain

Result: Dismissed

References: Article 29, paragraph (1), Article 43 of the Patent Act, Article 4F of the Paris Convention Treaty

Related rights, etc.: Patent No. 5575340

Decision of JPO: Invalidation Trial No. 2018-800023

Summary of the Judgment

1. This case is a suit seeking rescission of the JPO decision which dismissed the request for a trial for patent invalidation of the invention of "BRUNNIAN LINK MAKING DEVICE AND KIT".

2. The date of original application of the present patent is June 23, 2011 and included the claim of Paris priority on the basis of the U.S. provisional application made on November 5, 2010.

3. The petitioner of trial (Plaintiff of the present lawsuit) asserted as follows in relation to the claim of Paris priority.

(1) Since the Present Patent Invention includes a new matter to the U.S. provisional application document, the effect of the Paris priority claim may not be approved.

(2) The Present Patent Invention has the same contents as the moving image posted to a moving image posting site on March 29, 2011 (hereinafter referred to as the "Exhibit Ko 1 moving image").

(3) Since the effect of the Paris priority claim is not approved as in the aforementioned (1), the Exhibit Ko 1 moving image is the prior art document of the Present Patent Invention, and the Present Patent Invention lacks novelty/inventive step in relation with that.

4. The JPO decision did not employ the assertion by the petitioner of trial in the aforementioned 3.

5. The judgment held as follows and judged that the aforementioned determination in the JPO decision has no errors.

(1) Plaintiff asserts that the Paris priority claim is not approved, since the Present Patent Invention is an invention different from the invention described in the present U.S.

provisional application, and determination shall be made as follows.

(2) Accurately describing Plaintiff's assertion on this point, the Present Patent Invention includes a structure not in the present U.S. provisional application in four points; that is, [i] the pin includes the structure having a plurality of grooves; [ii] the structure in which the pin bar and the base are integrally molded is included; [iii] the structure of such a method that the pin bar is fitted not in the groove of the base but in a projecting portion on the base is included; and [iv] the structure in which the pin has not a groove but a gap penetrating the pin is included and thus, the Paris priority was denied, and as a result, the Present Invention lacks novelty and inventive step in relation with the Exhibit Ko 1 moving image and should be invalidated.

However, in view of the wording in claims, it is obvious that the Present Patent Invention includes the structure not including the points [i] to [iv] asserted by Plaintiff as new structure; that is, the structure as in the Example described in the description of the present U.S. provisional application (it is considered that Plaintiff does not deny this point, either.). But this structure constitutes one integrated and completed invention, and it is not such that the invention is completed only after the structures in [i] to [iv] are added. In such a case, according to the Article 4F of the Paris Convention, the priority cannot be denied or the patent application cannot be refused on the ground that the patent application made by claiming the Paris priority includes the constituent portion not included in the application on which the priority is based, but the Paris priority is denied only for the constituent portion not included in the application to be the basis. Thus, in order for the patent according to the patent application to be invalidated, not only is the patent found to include the constituent portion not included in the application on which the Paris priority is based, but the constituent portion should need to be found to lack novelty or inventive step in view of the Cited Invention. It is not only that such interpretation goes along with the wording in Article 4F of the Paris Convention, but without such interpretation, if a patentee filed a foreign application for the invention with the structure of A and then claimed Paris priority in our country after the invention B including that structure became publicly known and filed a patent application for the invention including the structures A + C; that is, the invention combining the structure A and the structure C not included in the foreign application but for which novelty and inventive step are found over the invention B, for example, although its foreign application regarding the structure A portion preceded the invention B, the priority was claimed, and the structure C is found to have novelty and inventive step over the invention B, the priority is denied even for the structure A only on the ground that the structure C not included in the foreign application is included, and the

patent application is refused as a conclusion. But such conclusion cannot be allowed under the Article 4F of the Paris Convention at all. The points [i] to [iv] can also become independent constituent portions of the invention, respectively, and thus, the novelty and inventive step for the Cited Invention need to be examined separately for each structure.

By examining the above from this viewpoint, the tool according to the Exhibit Ko 1 moving image is found to have the structure in the aforementioned [iii]. And the claim in the present patent invention only specifies the "plurality of pins supported on the base", and it is obvious that the structure in the aforementioned [iii] is included and thus, in this point, the present patent invention should be considered to lack novelty in relation with the Exhibit Ko 1 moving image. Therefore, in order to determine whether the Paris priority is approved or not, it is necessary to further determine whether or not the structure [iii] is the structure not included in the present U.S. provisional application. On the other hand, since it is not found that the tool according to the Exhibit Ko 1 moving image includes the structures in the aforementioned [i], [ii], and [iv], there is no room for the novelty to matter, and there is no assertion/verification enough to find that these structures lack inventive step over the invention according to the Exhibit Ko 1 moving image. Then, Plaintiff's assertion should be considered unreasonable even without determining whether or not these structures are not included in the present U.S. provisional application.

(3) By further determining on whether or not the structure [iii] is the structure not included in the present U.S. provisional application, it is sure that the U.S. provisional application document describes only the mode in which the pin bar is fitted in the groove provided in the base, but this is only the recitation of the Example, and even if the entire U.S. provisional application document is examined, it cannot be understood to describe that the mode of fixing the pin bar to the base is limited to the structure according to this Example. And the structure of the mode in which the recess portion is provided in the base, and the pin bar is fitted in the recess portion (recitation in the Example in the U.S. provisional application document), and the structure of the mode in which the projecting portion is provided on the base, and the pin bar is fitted in this projecting portion (the structure of [iii]) are exactly in the opposite relation, and it is common general technical knowledge that if one is conceived of, the other is naturally conceived of. Thus, even if there is no explicit recitation, since the structure in which the recess portion is provided in the base is described, the structure in which the projecting portion is provided on the base should be considered to be included within the assumption of the recitation.

Then, it cannot be considered that the structure according to [iii] is a structure not included in the present U.S. provisional application and thus, the assertion by Plaintiff on this point is also unreasonable.

(4) According to the above, the judgment in the present JPO decision that the present patent invention cannot be found to have the invalidation reason of lack of novelty and inventive step in relation with the Exhibit Ko 1 moving image has no errors in the conclusion. Thus, the Reason 1 for rescission has no grounds.

6. Regarding the JPO decision which judged that the request for a trial was dismissed for the remaining invalidation reasons (lack of novelty/inventive step from the Exhibit Ko 2 invention, lack of novelty/inventive step from the Exhibit Ko 10 invention, violation of clarity requirement, violation of amendment requirement) asserted by the petitioner of trial, it was judged that the determination on them did not have errors, either.

Judgment rendered on November 5, 2020

2019 (Gyo-Ke) 10132 A case of seeking rescission of the JPO decision

Date of conclusion of oral argument July 14, 2020

Judgment

Plaintiff: HANAYAMA Co., Ltd.

Defendant: Y

Main text

1. Plaintiff's claim is dismissed.
2. Plaintiff shall bear the court costs.

Facts and reason

No. 1 Claims

Among the decisions rendered by the Japan Patent Office for the case of Invalidation Trial No. 2018-800023 on August 26, 2019, the portion that "patent according to Claims 1, 3, 6, 7, 8, and 11 of the Patent No. 5575340 shall be maintained." shall be rescinded.

No. 2 Outline of the case

1. History, etc. of procedures at the JPO

(1) Defendant is a patentee of the patent No. 5575340 (hereinafter, referred to as the "Present Patent") of the invention titled "BRUNNIAN LINK MAKING DEVICE AND KIT".

(2) The application (Patent Application No. 2014-14615, hereinafter, referred to as the "Present Application") according to the Present Patent was made a new application on January 29, 2014 by dividing a part of Patent Application No. 2013-537663 (hereinafter, referred to as the "Original Application") with an international filing date of June 23, 2011 (priority claim under the Paris Convention was received by the foreign office on November 5, 2010 in the U.S.).

The U.S. provisional application "61/410,399" (hereinafter, referred to as the "Present U.S. Provisional Application") serving as the basis of the priority claim under the Paris Convention was filed on November 5, 2010. Defendant filed a PCT application (PCT/US2011/041553) based on the Present U.S. Provisional Application on June 23, 2011, entered the national phase, and filed the Original Application.

On March 29, 2011 before the aforementioned PCT application after the Present U.S. Provisional Application, a moving image (URL omitted) (Exhibit Ko 1-1. Hereinafter referred to as the "Exhibit Ko 1 moving image") titled "Lesson 1: How to make a 'Single' rubber band bracelet" was posted to a moving-image posting website.

(3) Defendant amended the scope of claims on January 30, 2014 (Exhibit Ko 25).

(4) Defendant amended the scope of claims on June 4, 2014 (Exhibit Ko 24. Hereinafter referred to as the "Present Amendment").

(5) Establishment of the patent right was registered on July 11, 2014.

(6) Plaintiff made a request for an invalidation trial (Invalidation Trial No. 2018-800023) for the patent of the invention according to Claims 1, 3, 6, 7, 8, 10, and 11 of the Present Patent on February 23, 2018. Upon receipt of an advance notice of the JPO decision as of February 27, 2019, Defendant made a request for correction (hereinafter, referred to as the "Present Correction") including deletion of Claim 10 and the like on May 17, 2019.

(7) The conclusion of the JPO decision made on August 26, 2019 was as follows:

"The scope of claims of Patent No. 5575340 is approved to be corrected for Claim 10 after the correction as the corrected scope of claims attached to the request for correction.

The patent according to Claims 1, 3, 6, 7, 8, and 11 of Patent No. 5575340 shall be maintained.

The reasons for invalidation of the patent according to Claim 10 of Patent No. 5575340 shall be dismissed.

Petitioner shall bear the trial costs."

(8) Upon service of the JPO decision on September 5, 2019, Plaintiff instituted this lawsuit on October 4 of the same year, seeking rescission of the portion in the JPO decision that maintained the patent.

2. Recitation in the scope of claims

(1) Neither of the parties disputes the judgment of the JPO decision on the Present Correction (the request for correction was approved, and the request for invalidation trial for the Claim 10 deleted by the correction was dismissed.).

(2) There is no change in the recitation in Claims 1 and 6 between before and after the

Present Correction, and they are as follows, respectively (hereinafter, the invention according to each claim shall be referred to as "Present Invention 1", "Present Invention 6" and the like, and simple term the "Present Invention" means both. The underlined portions are recitation after the amendment of the portions amended by the Present Amendment which will be described later.).

[Claim 1]

A device for making an item made of a series of links, the link being a Brunnian link and the item being a Brunnian link item, comprising:

a base; and

a plurality of pins supported on the base, wherein

each of the plurality of pins has an upper part for holding the link in a desired direction and an opening portion on a front surface side in a direction of a row of the pins of each of the plurality of pins, and the plurality of pins are disposed in a plurality of rows, separated from each other, and extend upward from the base.

[Claim 6]

A kit for making an item made of a series of links, the link being a Brunnian link and the item being a Brunnian link item, comprising:

a plurality of pins, each including an upper part for holding the link in a desired direction and an opening portion on a front surface side in a direction of a row of the pins of each of the plurality of pins and supported by the base with respect to each other; and

the plurality of pins are disposed in a plurality of rows, separated from each other, and extend upward from the base.

(3) Claim 3 is dependent on Claim 1, and Claims 7, 8, and 11 are dependent on Claim 6 and thus, they have such relations that, if the JPO decision on Claims 1 and 6 has errors, the decision on Claims 3, 7, 8, and 11 also has errors.

(4) The recitation in Claim 6 was as follows before the Present Amendment (Exhibit Ko 25). When the recitations before and after the Amendment are compared, the Present Invention 6 came to include such a mode in which each of the plurality of pins is directly fixed to the base ("not separated from the base") by the Present Amendment.

[Claim 6 before amendment]

A kit for making an item made of a series of links, comprising:

a plurality of pins, each including an upper part for holding the link in a desired direction and an opening portion on at least one of surfaces of each of the plurality of pins and supported with respect to each other; and

the plurality of pins include a row of offset pins separated from the base and extending upward.

(5) The recitation in Claim 10 deleted by the Present Correction was as follows:

[Claim 10 before correction]

The kit according to Claim 6, wherein

the opening portion is an access groove disposed along at least one side of each of the plurality of pins.

No. 3 Gist of the reasons given in the JPO decision

(When a document in a foreign language is cited in the judgment, translation described in the JPO decision was used, and obvious clerical mistakes were corrected.)

1. Reason 1 for invalidation (effect of priority claim not exerted)

[Assertion by invalidation requester (Present Plaintiff)]

The Present Invention is an invention different from the invention described in the application document of the Present U.S. Provisional Application in the following three points and thus, the effect of priority claim under the Paris Convention (hereinafter, referred to as the "Paris Priority") is not approved, and the priority date is June 23, 2011 (the filing date of the aforementioned PCT application). Then, the Present Invention lacks novelty or inventive step in relation with the Exhibit Ko 1 moving image which was made available for public use prior to the priority date.

(A) Point that a case in which one pin has a plurality of grooves is included;

(B) Point that such a change was made that an integral molding of the pin and the base was included; and

(C) Point that the "groove" was changed to the "opening portion"

[Judgment in JPO decision]

As described below, the Present Application is found not to introduce a new technical matter in relation with the technical matter introduced by integrating all the recitations in the application documents of the Present U.S. Provisional Application (Exhibit Ko 17. Hereinafter, referred to as the "U.S. Provisional Application Document") and thus, the effect of priority claim under the Paris Convention is found. Therefore, the reason 1 for invalidation is not established.

(A) Point that a case in which one pin has a plurality of grooves is included

Claim 10 including the structure that "the opening portion is an access groove disposed along at least one side of each of the plurality of pins" is deleted by the Present Correction. As a result, since there is no longer recitation in the Present

Application implying the case where the one pin has a plurality of the grooves, it cannot be considered that the Present Application introduced a new technical matter on the ground that the Present Application includes the aforementioned case.

(B) Point that such a change was made that an integral molding of the pin and the base was included

There are recitations in [Claim 1], the paragraphs [0002] to [0011], [0013] to [0015] and [0022] in the U.S. Provisional Application Document that, a kit for making a "unique wearable item" such as a bracelet or a necklace usually includes materials such as yarns and beads colored in different colors, and formation of an item depends on techniques and talents of an individual and thus, in view of necessity and demand for a kit which not only provides materials in such a way but also simplifies the formation for facilitating successful making of the item for people at many technical and artistic levels, by assuming that the item is a Brunnian link item, such a kit is provided that allows the Brunnian link item to be made by a simple method by using a Brunnian link assembling technique, so that people of various technical levels can make the Brunnian link item successfully.

Moreover, in the aforementioned recitation in the U.S. Provisional Application Document, the kit in the following (a) and (b) is described as a form for working the invention and as described above, it recites that any one of the kits allows formation of the Brunnian link item by the simple method and allows people with various technical levels to successfully make the Brunnian link item.

(a) A kit of an integral structure in which six pin bars 14, each having a plurality of pins 38 (note by judgment: found to be a clerical error of pin 32) defined in a single row and each pin 38 (the same as above) having an upper surface 34 extended outward from a side part 36 in order to prevent wrong opening of a rubber band during making of the link, and a groove 38 for providing a gap for insertion of a hook tool 16 used for moving an end part of the rubber band between the pins 32 formed, are aligned laterally and supported on a base template 12

(b) A kit of an integral structure by connecting two of the kits of (a) longitudinally or laterally, for example, by using joints 28, 30, 32, and 34 formed on the side of the base template 12

And either of the kits is nothing but a structure in which the pin bar 14 and the base template 12 are integrated and support the plurality of pins 32 as long as the plurality of pin bars 14 are supported on the base template 12 into the integral structure. Since the base template 66 is also found to be a concept of the "base", it can be understood that either of the kits has a structure in which the plurality of pins

are (indirectly) supported on the base (through a body portion of the pin bar) for making the Brunnian link item by a simple method and for successfully allowing making of the Brunnian link item by people of various technical levels, as long as the plurality of pin bars 14 are supported on the base into the integral structure.

Then, the kit recited in the U.S. Provisional Application Document also has an integral structure in which the plurality of pins are supported on the base and thus, the inclusion of the integral molding of the pin and the base in the Present Application does not fall under introduction of a new technical matter.

(C) Point that the "groove" was changed to the "opening portion"

In general, the "groove" has a meaning that "elongated dented spot in general" and the "opening" has a meaning of "a hole opened outward. Or the hole."

In the U.S. Provisional Application Document, Fig. 1, Fig. 5 to Fig. 7 illustrate the groove, and paragraph [0011] has recitation that "the side part 36 of each pin 32 includes a groove 38 in a longitudinal direction extending inward toward a center of the pin 32. The groove 38 provides a gap for insertion of a hook tool 16 (Fig. 1) used for moving an end portion of a rubber band between the pins 32." and thus, the "groove" has a meaning of the gap for insertion of the hook tool 16 used for moving the end portion of the rubber band between the pins 32.

Then, even if the gap for insertion of the hook tool of the pin is called the "groove" or the "opening portion", the actual form of the gap is not affected, and there is no obvious structural difference between the "groove" and the "opening portion" and thus, to call the gap the "opening portion" in the Present Application does not fall under the introduction of a new technical matter.

2. Reason 2 for invalidation (lack of novelty/inventive step with Exhibit Ko 2 as the primarily cited reference)

[Assertion by requester for invalidation (Present Plaintiff)]

Since the Present Invention is an invention recited in the Exhibit Ko 2 (U.S. Patent No. 1776561 gazette), it lacks novelty. Even if there is a difference, since it can be easily conceived of by the invention itself recited in Exhibit Ko 2 or application of well-known art, it lacks inventive step.

[Judgment in JPO decision]

(1) Finding of Cited Invention

The Exhibit Ko 2 discloses the following invention (Hereinafter, referred to as the "Exhibit Ko 2 Invention").

"A knitting device for knitting, comprising:

a board 1; and

a plurality of pins 3 mounted on the board 1, wherein

each of the plurality of pins 3 has a circular head part 7 and a string hole 6 on a front surface side in a direction of a row of the pins 3 of each of the plurality of pins 3, the plurality of pins 3 being disposed in two rows, separated from each other, and extending upward from the board 1."

(2) Comparison with Present Invention 1/determination

a. Comparison

[Common feature]

"A device for making an item made of a series of links, comprising:

a base; and

a plurality of pins supported on the base, wherein

each of the plurality of pins has an upper part and an opening portion on a front surface side in a direction of a row of the pins of each of the plurality of pins, and the plurality of pins are disposed in a plurality of rows, separated from each other, and extend upward from the base."

[Difference 1]

Point that Present Invention 1 is a device for making a "Brunnian link item" made of "Brunnian link", while the Exhibit Ko 2 Invention is a knitting device for knitting.

[Difference 2]

Point that Present Invention 1 has the upper part for holding the link in a desired direction, while the Exhibit Ko 2 Invention has the circular head part 7.

b. Technical meaning of Present Invention 1

According to the recitation in the present description and the like (referring to the contents of the patent gazette in the Exhibit Ko 15), the technical meaning of Present Invention 1 is to provide a device including all the structures of the "plurality of pins" disposed in a row, the "base", the "upper part", and the "opening portion on the front surface side in the direction of the row of the pins of each of the plurality of pins" and moreover a device having the technical matter of the "plurality of pins supported on the base" as means for solving the problem (hereinafter, referred to as the "Present Problem") to provide a method of making a "Brunnian link" not depending on the technique of an individual (hereinafter, referred to as the "Present Making Method").

The structure having the "upper part for holding the link in a desired direction" according to Difference 2 of Present Invention 1 is for holding the Brunnian link in the desired direction in making of the "Brunnian link" by the Present Making Method. The reason why the "upper part" is provided is, at a step of removing and rewinding the attachment of an elastic band "held" in the "direction of the row of the pins", by

holding the link in the desired direction when the hook is to be inserted into the gap of the opening portion, the upper part of each pin makes erroneous "opening" of the elastic band difficult to occur so that even a person with a poor technical level can make the "Brunnian link" easily. That is, the "upper part" according to Difference 2 is for solving the Present Problem.

c. Presence/absence of Difference 1

The presence/absence of Difference 1 is determined by whether or not application limitation that Present Invention 1 is a device for making a Brunnian link item (hereinafter, referred to as the "Present Application Limitation") is a substantial invention-specifying matter.

Regarding the invention-specifying matter according to the application limitation, as in a case where the application limitation can be interpreted to mean the shape, structure, composition, and the like (hereinafter, referred to as the "Structures and the Like") particularly suitable for the application by considering the recitation in the description and drawings as well as the common general technical knowledge at the time of filing, when the article to which the application limitation is applied is interpreted to mean the article particularly suitable for the application, the article should be interpreted to be an article having the Structures and the Like meant by the application limitation. Upon examination on this premise, the device of Present Invention 1 is an article particularly suitable for the application for "making the Brunnian link item" and can be interpreted to be the "article having the Structures and the Like meant by the application limitation" and thus, the Present Application Limitation is the substantial invention-specifying matter.

The Exhibit Ko 2 Invention is an invention of a knitting device for knitting, and Exhibit Ko 2 does not have recitation or suggestion related to the "Brunnian link". Moreover, there is no evidence, either, showing that solving of the Present Problem by using not only the Present Making Method but also the making method of the "Brunnian link" not depending on the technique of an individual or the device for making the "Brunnian link" was the common general technical knowledge at the time of the present filing date. Then, it cannot be considered that the "device for making the Brunnian link item made of the Brunnian link" is described in the Exhibit Ko 2.

Therefore, Difference 1 is a substantial difference.

d. How easily the structure according to Differences 1 and 2 could have been conceived of

(a) How easily it could have been conceived of from Exhibit Ko 2 itself

Exhibit Ko 2 does not have recitation or suggestion on the "Brunnian link".

There is no recitation or suggestion, either, on optimization of the structure of the upper part of the Exhibit Ko 2 Invention in order to solve the Present Problem; that is, the provision of the "upper part for holding the Brunnian link in a desired direction". Then, since Exhibit Ko 2 does not have motivation which leads to the structure of Present Invention 1 according to Differences 1 and 2, it cannot be considered that the structure could have been easily conceived of on the basis of Exhibit 2 itself.

(b) How easily it could have been conceived of by applying the well-known art

Exhibit Ko 3 (U.S. Patent No. 5426788 gazette), Exhibit Ko 4 (U.S. Design No. D592537S gazette), and Exhibit Ko 5 (U.S. Patent No. 1994659 gazette) disclose the "Brunnian link" or the "Brunnian link item". However, the "device for making the Brunnian link item made of the Brunnian link" is not disclosed in any of Exhibits Ko 3 to Ko 5, and Exhibits Ko 3 to Ko 5 cannot be considered to be well-known conventional art. Moreover, there is no recitation or suggestion that such device has the "upper part for holding the Brunnian link in the desired direction" in Exhibits Ko 3 to Ko 5.

As described above, none of Exhibits Ko 3 to Ko 5 discloses the structure of Present Invention 1 according to Differences 1 and 2, and there is no motivation which leads to such structure, either, and thus, it cannot be considered that the structure of Present Invention 1 according to Differences 1 and 2 could have been easily conceived of, regardless of how the recitations in the Exhibit Ko 2 Invention and Exhibits Ko 3 to Ko 5 are combined.

(3) Comparison with Present Invention 6 / determination

When Present Invention 6 is compared with the Exhibit Ko 2 Invention, since the difference is the same as Differences 1 and 2 between Present Invention 1 and the Exhibit Ko 2 Invention, it cannot be considered that Present Invention 6 lacks novelty/inventive step, on the grounds similar to the aforementioned (2) b to d.

3. Reason 3 for invalidation (lack of novelty/inventive step with Exhibit Ko 10 as primarily cited reference)

[Assertion by requestor for invalidation (Present Plaintiff)]

Since the Present Invention could have been easily conceived of on the ground of the invention described in Exhibit Ko 10 (U.S. Patent No. 7578146B2 gazette) as well as Exhibit Ko 8 (Utility Model Publication No. 1972-24774 gazette) and the well-known conventional art, it lacks inventive step.

[Determination in JPO decision]

(1) Finding of the Cited Invention

Exhibit Ko 10 discloses the following invention (hereinafter, referred to as the

"Exhibit Ko 10 Invention").

"A knitting machine 500, comprising:

a base portion structure 512; and

a plurality of pegs 510 mounted on the base portion structure 512, wherein

each of the plurality of pegs 510 has an expended upper end, and a groove or a channel on an outer surface side of the peg 510 of each of the plurality of pegs 510, and the plurality of pegs 510 are disposed in two rows, separated from each other, and extend upward from the base portion structure 512."

(2) Comparison with Present Invention 1 / determination

a. Comparison

[Common Feature]

"A device for making an item made of a series of links, comprising:

a base; and

a plurality of pins supported on the base, wherein

each of the plurality of pins has an upper part, the plurality of pins are disposed in a plurality of rows, separated from each other, and extend upward from the base."

[Difference 1]

Point that Present Invention 1 is a device for making the "Brunnian link item" made of the "Brunnian link", while the Exhibit Ko 10 Invention is a knitting machine.

[Difference 2]

Point that Present Invention 1 has the upper part for holding the link in the desired direction, while the Exhibit Ko 10 Invention has the enlarged upper end.

[Difference 3]

Point that, in Present Invention 1, each of the plurality of pins has the opening portion on the front surface side in the direction of the row of the pins, while in the Exhibit Ko 10 Invention, each of the plurality of pegs 510 has the groove or channel on the outer surface side of the peg 510.

b. How easily the structure according to Differences 1 and 2 could have been conceived of

For grounds similar to those of the aforementioned 2(2)d, it cannot be considered that the structure according to Differences 1 and 2 could have been easily conceived of.

c. How easily the structure according to Difference 3 could have been conceived of

(a) How easily it could have been conceived of from Exhibit Ko 10 itself

In Present Invention 1, the position of the opening portion is set to the "front surface in the direction of the row of the pins" in order to solve the Present Problem to

enable a person with a poor technical level to make the Brunnian link by limiting the direction in which the hook tool is operated for making the Brunnian link only in the front-and-rear direction. When the position of the opening portion is changed, the hook tool should be operated in a direction other than the front-and-rear direction, and the Present Problem cannot be solved.

Exhibit Ko 10 does not have any recitation or suggestion on the Brunnian link. Moreover, setting of the position of the opening portion to the "front surface in the direction of the row of the pins" for solving the Present Problem is not described or suggested, either.

Then, to have the structure of the "opening portion on the front surface side in the direction of the row of the pins" in Present Invention 1 instead of the structure of the "groove or channel on the outer surface side of the plurality of pegs" in the Exhibit Ko 10 Invention could not have been easily conceived of.

(b) How easily it could have been conceived of by applying the art described in Exhibit Ko 8

Exhibit Ko 8 describes a "scale for making a motif for clothes formed having a cross-shaped groove to such a degree that a sewing needle can be inserted on an upper part of each of a plurality of projections 2", but the Present Making Method does not disclose solving of the Present Problem by using the device for making the "Brunnian link", either.

Therefore, Exhibit Ko 8 does not disclose the "device for making the Brunnian link item made of the Brunnian link" and it is not a well-known conventional art from Exhibit Ko 8, either. Moreover, Exhibit Ko 8 does not describe or even suggest the "upper part for holding the Brunnian link in the desired direction".

As described above, since Exhibit Ko 8 does not disclose the invention-specifying matter of Present Invention 1 according to Difference 3 or there is no motivation, either, and thus, it cannot be considered that the invention-specifying matter of Present Invention 1 according to Difference 3 could have been easily conceived of, regardless of how the Exhibit Ko 10 Invention and the one described in Exhibit Ko 8 are combined.

(3) Comparison with Present Invention 6 / determination

When Present Invention 6 is compared with the Exhibit Ko 10 Invention, since the difference is the same as Differences 1 to 3 between Present Invention 1 and the Exhibit Ko 10 Invention, it cannot be considered that Present Invention 6 lacks novelty/inventive step, on grounds similar to the aforementioned (2) b and c.

4. Reason 4 for invalidation (violation of clarity requirement)

[Assertion by requester for invalidation (Present Plaintiff)]

Since it is not clear what member in the present description and the like the "opening portion" in Present Inventions 1 and 6 refers to, the Present Patent lacks clarity.

[Determination in the JPO decision]

Claims 1 and 6 have the "opening portion on the front surface side in the direction of the row of the pins", and the opening portion of the pin is supposed to be provided on the front surface side in the direction of the row of the pins and thus, it is sufficiently clear even without referring to the description and drawings.

5. Reason 5 for invalidation (violation of amendment requirement of the Present Amendment)

[Assertion by requester for invalidation (Present Plaintiff)]

In the recitation in the description, scope of claims, or drawings originally attached to the application for filing the Present Patent (Hereinafter, referred to as the "Original Description and the Like". Exhibit Ko 16), the "kit" was supposed to be made of the "base" and the "pin bar" as separate members. On the other hand, Present Invention 6 after the Present Amendment describes "the plurality of pins supported on the base with respect to each other" and does not have limitation by the "pin bar" but includes those in which each of the plurality of pins is directly fixed to the base and thus, the Present Amendment was not made within a range of the matter described in the Original Description and the Like.

[Determination in the JPO decision]

According to the recitation in the paragraphs [0002] to [0006], [0009] to [0015], [0019] to [0022], and [0024] to [0027] in the Original Description and the Like, the Original Description and the Like disclose the plurality of kits as embodiments of the invention for solving the Present Problem.

And any of the kits that have an integral structure by having the plurality of pin bars 14 supported on the base 12 or the base template 66 is nothing but the structure for supporting the plurality of pins 26 by the pin bars 14 and the base 12 or the base template 66 integrally, and this is also obvious from the recitation in paragraph [0011] that "in order to support the pins 26 in desired alignment ... one or some pin bars 14 are placed on some bases 12"; that is, the "pin 26" is a target of support. And since the base template 66 is found also to be a concept of the "base", the integral structure in which the plurality of pin bars 14 are supported on the base 12 or the base template 66 in any of the kits can be understood to have the structure in which the plurality of pins are (indirectly) supported on the base (through the body portion of the pin bar) in

order to solve the Present Problem.

Then, the Original Description and the Like can be considered to describe the structure of Present Invention 6 without limitation of the "pin bar" as the technical idea that can solve the Present Problem. Therefore, it cannot be considered that a new technical matter was introduced by the Present Amendment.

(omitted)

No. 5 Judgment of this court

1. Reason 1 for rescission (invalidation reason 1: effect of priority claim not exerted)

(1) Plaintiff asserted that the Paris Priority claim is not approved, since the Present Invention is an invention different from the invention described in the Present U.S. Provisional Application, and determination shall be made as follows.

(2) Accurately describing Plaintiff's assertion on this point, the Present Invention includes the structure not in the Present U.S. Provisional Application in four points; that is, [i] the pin includes the structure having a plurality of grooves; [ii] the structure in which the pin bar and the base are integrally molded is included; [iii] the structure of such a method that the pin bar is fitted not in the groove of the base but in a projecting portion on the base is included; and [iv] the structure in which the pin has not a groove but a gap penetrating the pin is included and thus, the Paris Priority was denied and as a result, the Present Invention lacks novelty and inventive step in relation with the Exhibit Ko 1 moving image and should be invalidated.

However, in view of the wording in claims, it is obvious that the Present Invention includes the structure not including the points [i] to [iv] asserted by Plaintiff as a new structure; that is, the structure as in the Example described in the description of the Present U.S. Provisional Application (it is considered that Plaintiff does not deny this point, either). But this structure constitutes one integrated and completed invention, and it is not such that the invention is completed only after the structures in [i] to [iv] are added. In such a case, according to Article 4F of the Paris Convention, the priority cannot be denied, or the Patent Application cannot be refused on the ground that the Patent Application made by claiming the Paris Priority includes a constituent portion not included in the application on which the priority is based, but the Paris Priority is denied only for the constituent portion not included in the application to be the basis. Thus, in order for the patent according to the Patent Application to be invalidated, not only is the patent found to include the constituent portion not included in the application on which the Paris Priority is based, but the constituent

portion should need to be found to lack novelty or inventive step in view of the Cited Invention. It is not only that such interpretation goes along with the wording in Article 4F of the Paris Convention, but without such interpretation, if a patentee filed a foreign application for the invention with the structure of A and then claimed Paris Priority in our country after Invention B including that structure became publicly known and filed a patent application for the invention including structures A + C; that is, the invention combining structure A and structure C not included in the foreign application but for which novelty and inventive step are found over Invention B, for example, although its foreign application regarding the structure A portion preceded Invention B, the priority was claimed, and structure C is found to have novelty and inventive step over Invention B, the priority is denied even for structure A only on the ground that structure C not included in the foreign application is included, and the patent application is refused as a conclusion. But such conclusion cannot be allowed under Article 4F of the Paris convention at all. The points [i] to [iv] can also become independent constituent portions of the invention, respectively, and thus, the novelty and inventive step for the Cited Invention need to be examined separately for each of the structures.

By examining the above from this viewpoint, according to Exhibit Ko 1, the tool according to the Exhibit Ko 1 moving image is found to have the structure in the aforementioned [iii]. And the claim in the Present Invention only specifies the "plurality of pins supported on the base", and it is obvious that the structure in the aforementioned [iii] is included and thus, in this point, the Present Invention should be considered to lack novelty in relation with the Exhibit Ko 1 moving image. Therefore, in order to determine whether or not the Paris Priority is approved, it is necessary to further determine whether or not structure [iii] is a structure not included in the Present U.S. Provisional Application. On the other hand, since it is not found that the tool according to the Exhibit Ko 1 moving image includes the structures in the aforementioned [i], [ii], and [iv], there is no room that the novelty matters, and there is no assertion/verification enough to find that these structures lack inventive step over the invention according to the Exhibit Ko 1 moving image. Then, Plaintiff's assertion should be considered unreasonable even without determining whether or not these structures are not included in the Present U.S. Provisional Application.

(3) By further determining on whether or not structure [iii] is a structure not included in the Present U.S. Provisional Application, it is certain that the U.S. Provisional Application Document describes only the mode in which the pin bar is fitted in the groove provided in the base, but this is only the recitation of the Example, and even if

the entire U.S. Provisional Application Document is examined, it cannot be understood to describe that the mode of fixing the pin bar to the base is limited to the structure according to this Example. And the structure of the mode in which the recess portion is provided in the base, and the pin bar is fitted in the recess portion (recitation in the Example in the U.S. Provisional Application Document) and the structure of the mode in which the projecting portion is provided on the base, and the pin bar is fitted in this projecting portion (the structure of [iii]) are exactly in the opposite relation, and it is common general technical knowledge that if one is conceived of, the other is naturally conceived of. Thus, even if there is no explicit recitation, since the structure in which the recess portion is provided in the base is described, the structure in which the projecting portion is provided on the base should be considered to be included within the assumption of the recitation.

Then, it cannot be considered that the structure according to [iii] is a structure not included in the Present U.S. Provisional Application and thus, the assertion by Plaintiff on this point is also unreasonable.

(4) According to the above, the judgment in the present JPO decision that the Present Invention cannot be found to have the invalidation reason of lack of novelty and inventive step in relation with the Exhibit Ko 1 moving image has no errors in the conclusion. Thus, the reason 1 for rescission has no grounds.

2. Reason 2 for rescission (invalidation reason 2: lack of novelty/inventive step from the Exhibit Ko 2 Invention)

(1) Finding of differences

The JPO decision found the differences between the Present Invention and the Exhibit Ko 2 Invention as follows.

[Difference 1]

Point that the Present Invention is a device (Present Invention 1) or a kit (the same 6) for making the "Brunnian link item" made of the "Brunnian link", while the Exhibit Ko 2 Invention is a knitting device for knitting.

[Difference 2]

Point that the Present Invention has the upper part for holding the link in the desired direction, while the Exhibit Ko 2 Invention has the circular head part 7.

Among them, Difference 1 relates to the application limitation. In order for the invention-specifying matter related to the application limitation to be a substantial invention-specifying matter, it is interpreted that the article to which the application limitation is applied is an article particularly suitable for the application, and the article needs to have the structure and the like meant by the application limitation

such as a case in which the application limitation can be interpreted to mean the shape, structure, composition, and the like particularly suitable for the application by considering the recitation in the description and drawings as well as the common general technical knowledge at the time of filing. However, since Difference 1 does not pay attention to the specific structure and the like of the device and cannot be considered to be a substantial invention-specifying matter, it is not reasonable to find this as an independent difference.

Thus, in this case, Differences 1 and 2 should be combined and found to be one Difference A as follows (the JPO decision also determines how easily it could have been conceived of by combining Differences 1 and 2 altogether and thus, even if finding of the differences can be considered to be an error, it does not affect the conclusion).

[Difference A]

Point that the Present Invention has the upper part for holding the "Brunnian link" in the desired direction in the device or the kit for making the "Brunnian link item" made of the "Brunnian link", while the Exhibit Ko 2 Invention has the circular head part 7.

Here, the "Brunnian link" is a link formed of a doubled and closed loop on itself so as to catch another closed loop in order to form a chain, and the "Brunnian link item" is interpreted to be an article constituted by the Brunnian link (paragraph [0004] in the present description and the like). And an elastic band is assumed to be a material thereof (the paragraphs [0002] and [0004] in the same). Moreover, the upper part for holding the Brunnian link made of the elastic band in the desired direction is interpreted to be an article having a diameter larger than a center portion below that such as an outward "flared shape" ([Claim 3] and paragraphs [0015] and [0016] of the same).

(2) How easily Difference A could have been conceived of

The circular head part 7 of the Exhibit Ko 2 Invention constitutes a part of a cotter pin 3 having a standard structure, and Fig. 1 in Exhibit Ko 2 illustrates that "a single yarn 9 is inserted through the cotter pin 3 in a zigzag manner" and describes that "the device can be adapted to various types of knitting". However, Exhibit Ko 2 does not have specific recitation on the knitting other than this, and there is no suggestion that the various types of knitting include the "Brunnian link". Moreover, since it is obvious that the single yarn 9 is different from the "Brunnian link" formed of the doubled and closed loop, it cannot be considered that adaptability of Exhibit Ko 2 to the making of the Brunnian link is disclosed only with the recitation that the device

can be adapted to the various types of knitting. Then, it cannot be considered that such technical idea that the circular head part 7 of the cotter pin 3 described in Exhibit Ko 2 holds the "Brunnian link" in the desired direction is disclosed, and Exhibit Ko 2 is not considered to disclose or suggest the upper part for holding the "Brunnian link" in the desired direction.

In the other evidences (Exhibits Ko 3 to Ko 14), too, the upper part for holding the "Brunnian link" in the desired direction is not described, and no suggestion on constitution to include such upper part is found.

Thus, a person ordinarily skilled in the art could not have easily conceived of a change of the structure of Difference A in the Exhibit Ko 2 Invention to the structure of the Present Invention.

(3) Plaintiff's assertion

a. Plaintiff asserts that, since the circular head part 7 of the Exhibit Ko 2 Invention also has the diameter of the upper part enlarged outward, accidental removal of the elastic band hooked by the pin can be prevented, and it has the structure and function similar to that of the "upper part" of the Present Invention in this point.

However, according to the recitation in Exhibit Ko 2 that "the cotter pin has a flat surface 8 which enables the yarn to be passed over the head part 7 and to be removed without excessively extending the yarn and thus, it is known to be an optimal type of pin to be used for a work", in the Exhibit Ko 2 Invention, the yarn to be knitted has little elasticity as compared with the elastic band and thus, the circular head part 7 has the flat surface 8 and an elliptic shape whose diameter is enlarged outward for the upper part to become slippery so that the yarn can be easily removed from the circular head part 7 of the pin 3 without being excessively extended. That is, although the circular head part 7 in the Exhibit Ko 2 Invention can be considered to have a function at least of retaining the yarn, it only retains the yarn having little elasticity. Rather, consideration is given so that the yarn can be easily removed, which should be considered to be a function different from that of the upper part of the Present Invention to prevent erroneous opening of the elastic band during making of the Brunnian link.

Therefore, Plaintiff's aforementioned assertion cannot be employed.

b. Plaintiff asserts that the fact that the Brunnian link can be made by knitting the elastic band by using Plaintiff's prototype machine made on the basis of the recitation in Exhibit Ko 2 (Exhibit Ko 27) also supports the assertion in the aforementioned a.

However, first, the pin used in the Exhibit Ko 2 Invention is the "cotter pin", whereas according to Exhibit Otsu 6 (Kenkyusha's New English-Japanese Dictionary,

fifth edition), a cotter pin is a "split pin (pin whose distal end is split-opened after being inserted)", and according to the drawing in Fig. 3 and the recitation that "the pin has elasticity, whereby it remains to be fixed in the recess portion 4" and that "the pin is held at an appropriate position but can be easily removed from the position", it is understood that there is a slight gap between the two legs before the pin is inserted, and when the two legs are picked up together in a state without a gap and pushed into the recess portion 4, the pin is held on the board 1 and thus, the pin does not require thickness and remains in the state "capable of easy removal" even after it is pushed into the recess portion 4. On the other hand, the pin of Plaintiff's prototype machine is obviously made of thick metal and is supposed to have a function which can hold the Brunnian link against elasticity of the band during making of the Brunnian link using the elastic band. Therefore, Plaintiff's prototype machine cannot be even considered to be made on the basis of the recitation in Exhibit Ko 2.

Moreover, according to the moving image in Exhibit Ko 27, the Brunnian link is knitted by inserting the hook between a dent formed between the two legs of the pin (corresponding to the "opening portion" in the Present Invention) and the elastic band and by lifting up the elastic band from below and removing it from the pin. However, according to the aforementioned recitation in Exhibit Ko 2, there is a small gap between the two legs of the cotter pin held on the board 1, and it is considered to be difficult to insert the hook between the pin and the yarn. Therefore, Plaintiff's prototype machine cannot be considered to be made on the basis of the recitation in Exhibit Ko 2 in this point, either.

Thus, Plaintiff's aforementioned assertion cannot be employed, either.

(4) As described above, the Present Invention is not identical to the Exhibit Ko 2 Invention and is not conceived of easily from the Exhibit Ko 2 Invention, either, and thus, the determination in the present JPO decision has no errors, and the reason 2 for rescission has no grounds.

3. Reason 3 for rescission (invalidation reason 3: lack of novelty/inventive step with Exhibit Ko 10 as primarily cited reference)

(1) Finding of differences

The JPO decision found the differences between the Present Invention and the Exhibit Ko 10 Invention as follows.

[Difference 1]

Point that the Present Invention is a device or a kit for making the "Brunnian link item" made of the "Brunnian link", while the Exhibit Ko 10 Invention is a knitting machine.

[Difference 2]

Point that the Present Invention has the upper part for holding the link in the desired direction, while the Exhibit Ko 10 Invention has the enlarged upper end.

[Difference 3]

Point that, in the Present Invention, each of the plurality of pins has the opening portion on the front surface side in the direction of the row of the pins, while, in the Exhibit Ko 10 Invention, each of the plurality of pegs 510 has the groove or the channel on the outer surface side of the peg 510.

Among them, Difference 1 relates to the application limitation, but it is not reasonable to find it as an independent difference as taught in the aforementioned 2(1) on Difference 1 between the Present Invention and the Exhibit Ko 2 Invention.

Thus, in this case, Difference 1 and Difference 2 between the Present Invention and the Exhibit Ko 10 Invention should be combined and found to be one Difference B as follows.

[Difference B]

Point that the Present Invention has the upper part for holding the "Brunnian link" in the desired direction in the device or the kit for making the "Brunnian link item" made of the "Brunnian link", whereas, in the Exhibit Ko 10 Invention, the peg has the enlarged upper end.

Moreover, Difference 3 should be also combined with Difference 1 and found to be as follows similarly.

[Difference C]

Point that, in the Present Invention, each of the plurality of pins has the opening portion on the front surface side in the direction of the row of the pin in the device or the kit for making the "Brunnian link item" made of the "Brunnian link", whereas, in the Exhibit Ko 10 Invention, each of the plurality of pegs 510 has the groove or the channel on the outer surface side of the peg 510.

(2) How easily Difference B could have been conceived of

In Exhibit Ko 10, no recitation is found indicating that the enlarged upper end in the Exhibit Ko 10 Invention has the function for holding the "Brunnian link" formed of a closed loop, not a twisted yarn or a yarn, in a desired direction and there is no suggestion on constitution to provide such function and thus, Exhibit Ko 10 cannot be considered to disclose the technical idea for holding the "Brunnian link" in the desired direction and does not disclose or suggest the upper part for holding the "Brunnian link" in the desired direction. Moreover, the other evidences do not recite the upper part for holding the "Brunnian link" in the desired direction and no suggestion is

found on constitution to provide such upper part.

Thus, to change the structure of Difference B in the Exhibit Ko 10 Invention to the Present Invention could not have been easily conceived of.

(3) How easily Difference C could have been conceived of

It cannot be found by any of the evidences that, by applying the common general technical knowledge in the field of knitting devices, there can be provided a device or a kit constituted such that each of the plurality of pins has the opening portion on the front surface side in the direction of the row of the pins and for making the "Brunnian link item" made of the "Brunnian link" which is a link formed by a doubled and closed loop on itself so as to capture another closed loop.

Thus, to change the structure of Difference 3 in the Exhibit Ko 10 Invention to the structure of the Present Invention could not have been easily conceived of.

(4) Plaintiff's assertion

a. Difference B

Plaintiff asserts that the structure in which the upper part of the pin is enlarged is a well-known art which was well-known at the time of filing of the Present Patent (Exhibits Ko 13 and Ko 14) and could have been easily conceived of by a person ordinarily skilled in the art. However, although Difference 1 is reasonably determined as Difference B by being combined with Difference 2, there is no recitation in any of the evidences, including Exhibits Ko 13 and Ko 14, indicating that the function of holding the "Brunnian link" formed not of a twisted yarn or a yarn but of a closed loop in the desired direction is provided, or there is no suggestion to constitute so as to have such function. Therefore, Plaintiff's assertion cannot be employed.

b. Difference C

Plaintiff asserts that the direction of the groove formed in the pin is changed as appropriate depending on what is to be knitted or is changed as appropriate to a direction with a higher frequency of use, and to change the direction of the groove in the pin as appropriate is a common general technical knowledge in the field of the knitting devices and a design matter that is normally taken care of by a person ordinarily skilled in the art and thus, to have the structure like Difference 3 (Difference C) could have been easily conceived of.

However, in view of the recitation in Exhibits Ko 7 and Ko 8 indicated by Plaintiff as examples of the common general technical knowledge, in Exhibit Ko 7, in response to the problem [0003] that "formation of a stripe pattern by color by means of simultaneous mixed use of wool yarns in different colors and insertion of warps as

necessary can be realized", a direction in which the knitting proceeds is right or left in [Fig. 4], while a yarn returning groove 3 is provided below the figure different from that by 90 degrees [0009]. In Exhibit Ko 8, in response to the problem [first column, lines 22 to 23] that "a mixed pattern is knitted by several wool yarns in different colors", a cross-shaped groove 3 is provided in an upper part of the projection 2 [Fig. 5] [first column, lines 30 to 32], and only a position or a direction of the groove is selected in accordance with the respective problems. Then, even if it can be considered to be a common general technical knowledge/design matter from these evidences that a general idea of changing the direction of the groove as appropriate in order to be able to realize a demand by the problem is applied to the knitting devices in general, it cannot be considered that the specific application thereof; that is, to conceive of the specific structure that the direction of the opening portion is set to the front surface side of the pin in response to the problem of making the Brunnian link item by using the elastic band as a material, was common general technical knowledge/design matter, and there are no other evidences sufficient to find the easiness.

Therefore, Plaintiff's aforementioned assertion cannot be employed.

(5) As described above, since the Present Invention could not have been easily conceived of from the Exhibit Ko 10 Invention, the present JPO decision has no errors, and the reason 3 for rescission has no grounds.

4. Reason 4 for rescission (invalidation reason 4: violation of clarity requirement)

(1) Fulfillment of clarity requirement

Invalidation reason 4 is that the recitation that the "opening portion on the front surface side in the direction of the row of the pins" in the Present Invention is unclear, and the Present Patent does not fulfill the clarity requirement.

The fulfillment of the clarity requirement is determined from a viewpoint of whether recitation in the scope of claims is sufficiently unclear to give an unexpected disadvantage to a third party on the basis of recitation in the scope of claims, and recitation in the description and drawings, as well as common general technical knowledge of a person ordinarily skilled in the art at the time of filing. By examining it from such viewpoint, the "opening portion" of the pin in the Present Invention is interpreted to mean such structure that can provide a gap for insertion of the hook between the side surface of the pin and the elastic band. In addition to the modifying wording that "on the front surface side in the direction of the row of the pins", by considering recitation in paragraphs [0014] and [0015] as well as the drawings in [Fig. 4] to [Fig. 9] in the present description and the like, it is found that a

person ordinarily skilled in the art could sufficiently understand that the "front access groove 40" in the recitation and drawings falls under the "opening portion" of the pin. Therefore, the aforementioned recitation cannot be sufficiently unclear to give an unexpected disadvantage to a third party. Since it is clear that the "opening portion 30" described in paragraph [0012] and [Fig. 5A] in the present description and the like is located on a bottom part of the pin 26 and is present at a portion separate from the "opening portion on the front surface side in the direction of the row of the pins", it does not affect the aforementioned understanding of a person ordinarily skilled in the art.

Therefore, the recitation that the "opening portion on the front surface side in the direction of the row of the pins" in the Present Patent fulfills the clarity requirement.

(2) Plaintiff's assertion

a. Plaintiff asserts that what the invalidation requester (Present Plaintiff) took up in the invalidation reason 4 is not the unclarity of the position of the "opening portion" but unclarity of the term "opening portion" itself.

However, as taught in the aforementioned (1), according to the recitation in the present description and the like, the fact that the "opening portion" means such structure that can provide a gap for insertion of the hook between the side surface of the pin and the elastic band, or more specifically, the "front access groove 40" in the present description and the like and the drawings falls under the "opening portion" is sufficiently clear for a person ordinarily skilled in the art.

Therefore, Plaintiff's aforementioned assertion cannot be employed.

b. The Patent Applicant (Present Defendant) submitted the procedural amendment (Exhibit Ko 22) as of January 29, 2014 which replaced the term "opening portion" with the "access groove" and it was found to be because, in the notice of reasons of refusal prior to that, integrity between the "opening portion" and the "access groove" in Claim 8 in the Original Application (Patent Application No. 2013-537663) became a problem and the problem was to be solved (see the written opinion submitted on the same day (Exhibit Ko 23)). Therefore, Defendant's aforementioned response cannot be considered to indicate that Defendant recognized that the term "opening portion" was unclear, or does not affect the determination of this case.

(3) As described above, since the term "opening portion" of the Present Invention is not unclear, the determination in the present JPO decision has no errors, and reason 4 for rescission has no grounds.

5. Reason 5 for rescission (invalidation reason 5: violation of amendment requirement of Present Amendment)

(1) Gist of the Present Amendment

The Present Amendment made on June 4, 2014 (Exhibit Ko 24) describes that "a plurality of pins supported on the base with respect to each other are provided" in relation to Present Invention 6. When this is compared with the recitation in Claim 6 before amendment, Present Invention 6 came to include the mode in which each of the plurality of pins is directly fixed to the base by the Present Amendment.

(2) Recitation in the Original Description and the Like

The Original Description and the Like (Exhibit Ko 16) describe that the device for easily knitting the Brunnian link item using the elastic band as a material is to be provided for the problem and the object of the invention, similarly to the U.S. Provisional Application Document and the present description and the like. Moreover, in the Original Description and the Like, the following kits [i] to [iv] are disclosed as embodiments of the invention, and it is described that the problem is solved by any of the kits [0027].

[i] A kit of an integral structure in which three pieces of pin bars 14, each having a plurality of pins 26 defined in a single row and each pin 26 having a flange-shaped upper part 38 with an outward flare shape in order to prevent erroneous opening of a rubber band during making of a link, and a front access groove 40 for providing a gap for insertion of a hook tool 16 used for moving an end portion of the rubber band between the pins 26 formed are aligned laterally and supported on the base 12 [0009] to [0015], [0020] to [0022]

[ii] A kit of an integral structure in which five pin bars 14, for example, are aligned laterally and supported on the base 12 by adding a pin bar 14 to the kit [i] [0019]

[iii] A kit of an integral structure in which six pin bars 14 are aligned laterally and held on the base template 66 [0024]

[iv] A kit of an integral structure in which two kits [iii], for example, are connected in a vertical direction or in a lateral direction by using joints 80 and 82 formed on a side of the base template 66 [0025], [0026]

(3) Presence/absence of addition of new matter

As described in the aforementioned (1), the Present Amendment describes that "a plurality of pins supported on the base with respect to each other are provided" in Present Invention 6. On the other hand, as described in the same (2), the Original Description and the Like describe the kits in the aforementioned (2) [i] to [iv] as embodiments of the invention in order to solve the problem of the Present Invention. However, in any of the kits, the pin bar 14 including the plurality of pins 26 is "supported" or "held" by the base 12 (see Fig. 1) or the base template 66 (see Fig. 17).

And since the pin 26 is integrally constituted with the pin bar 14, it is obvious that the plurality of pins 26 are "supported" also in the relation with the base 12 or the base template 66, and the finding of the same gist in the present JPO decision has no errors. Moreover, the finding in the present JPO decision on the inclusion of the base template 66 in the concept of the "base" also has no errors.

In the recitation in the Original Description and the Like, the pin bar 14 is constituted detachably with respect to the base 12 or the base template 66, but this is only the recitation of the Example, and such structure is for realizing various arrangement for the plurality of pins as in each of the kits [i] to [iv] in the aforementioned (2), and to have the structure in which the plurality of pins are detachable with respect to the base through the pin bar 14 is not indispensable for solving the problem of the Present Invention to provide a device for easily knitting the Brunnian link item with the elastic band as a material. Then, even if the structure in which the base and pin bar are detachable is described in the Example, it cannot be interpreted that such limitation was made in the Original Description and the Like.

Thus, the Present Amendment not limited to the structure through the pin bar 14 but describing that "the plurality of pins supported on the base with respect to each other are included" does not introduce a new technical matter in a relation with a technical matter introduced by integrating all the recitations in the Original Description and the Like and thus, it does not fall under the addition of a new matter.

(4) Plaintiff's assertion

Plaintiff asserts that the Present Amendment caused the one having each of the plurality of pins directly fixed to the base became to be included, but as described in the aforementioned (3), the "pin bar" is the structure for realizing various arrangements for the plurality of pins in the Example and is not a structure indispensable for solving the problem of the Present Invention and thus, it cannot be considered that the structure in which the pin bar is not present in the Original Description and the Like; that is, the technical idea that the pin is supported on the base without the "pin bar", is excluded as taught in the aforementioned (3).

Moreover, Plaintiff also asserts that "on the basis of the idea in the JPO decision that the pin supported on the base in Present Invention 6 includes the structure of integral molding of the pin and the base, it is obvious that such structure is not disclosed." However, the Present Amendment does not describe the specific structure of the integral molding in claims and thus, whether or not the structure of the integral molding is included in Present Invention 6 does not affect the determination on whether it falls under the addition of a new matter (it is only the problem of

interpretation of Present Invention 6.).

Thus, none of the aforementioned assertions by Plaintiff can be employed.

(5) As described above, since the Present Amendment does not add a new matter, the determination in the present JPO decision has no errors, and reason 5 for rescission has no grounds.

6. Conclusion

Thus, since none of the reasons for rescission of the JPO decision asserted by Plaintiff has grounds, Plaintiff's claims are dismissed.

Intellectual Property High Court, Third Division

Presiding Judge: TSURUOKA Toshihiko

Judge: UEDA Takuya

Judge: TSUNO Michinori