



Assessment of Inventive Step in Japan

Workshop Session 2 at FICPI Japan Symposium
Yokohama, December 4, 2008

Yuzuru Okabe
OKABE International Patent Office
Tokyo/Japan



Japanese Patent Law

Article 29 paragraph (2)

where an invention could easily have been made , prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of an invention or inventions referred to in the sub-paragraphs of paragraph (1), a patent shall not be granted for such an invention notwithstanding paragraph (1)

Process to evaluate inventive step

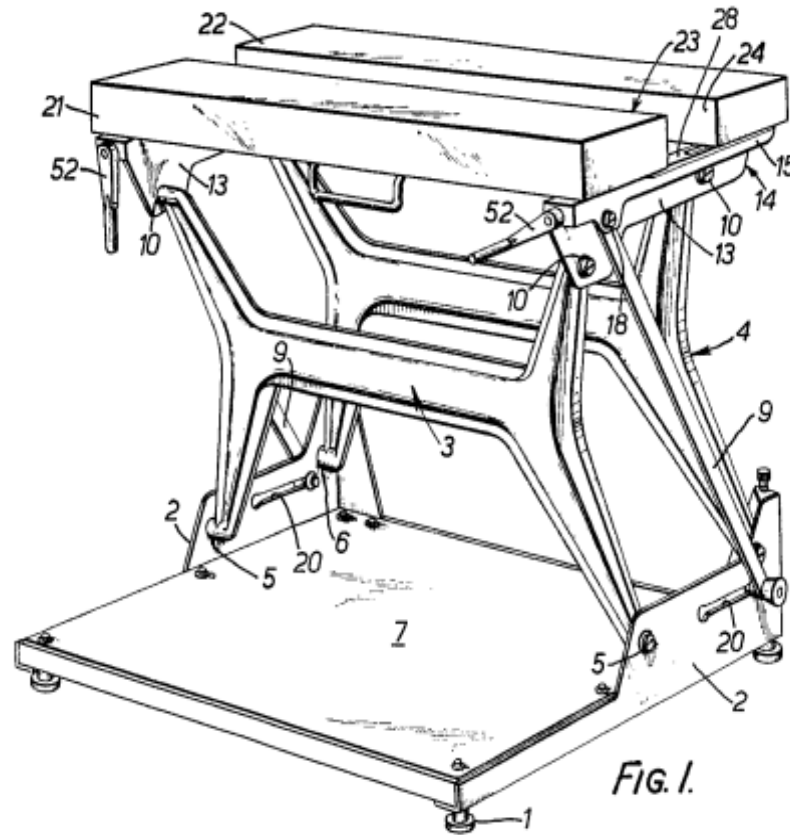
- (1) Choose primary prior art.
- (2) Compare claimed invention and the primary prior art to determine which element is the same and which element is different.
- (3) Try to find a theoretical ground for denying the inventive step of the claimed invention based on the primary prior art, other prior arts including well-known or commonly applied prior art and engineer's common knowledge.



Theoretical ground can be found in various ways e.g.

- Mere choosing optimal materials
- Mere change of design
- Mere aggregation of known arts

Present Invention (GB1267032)

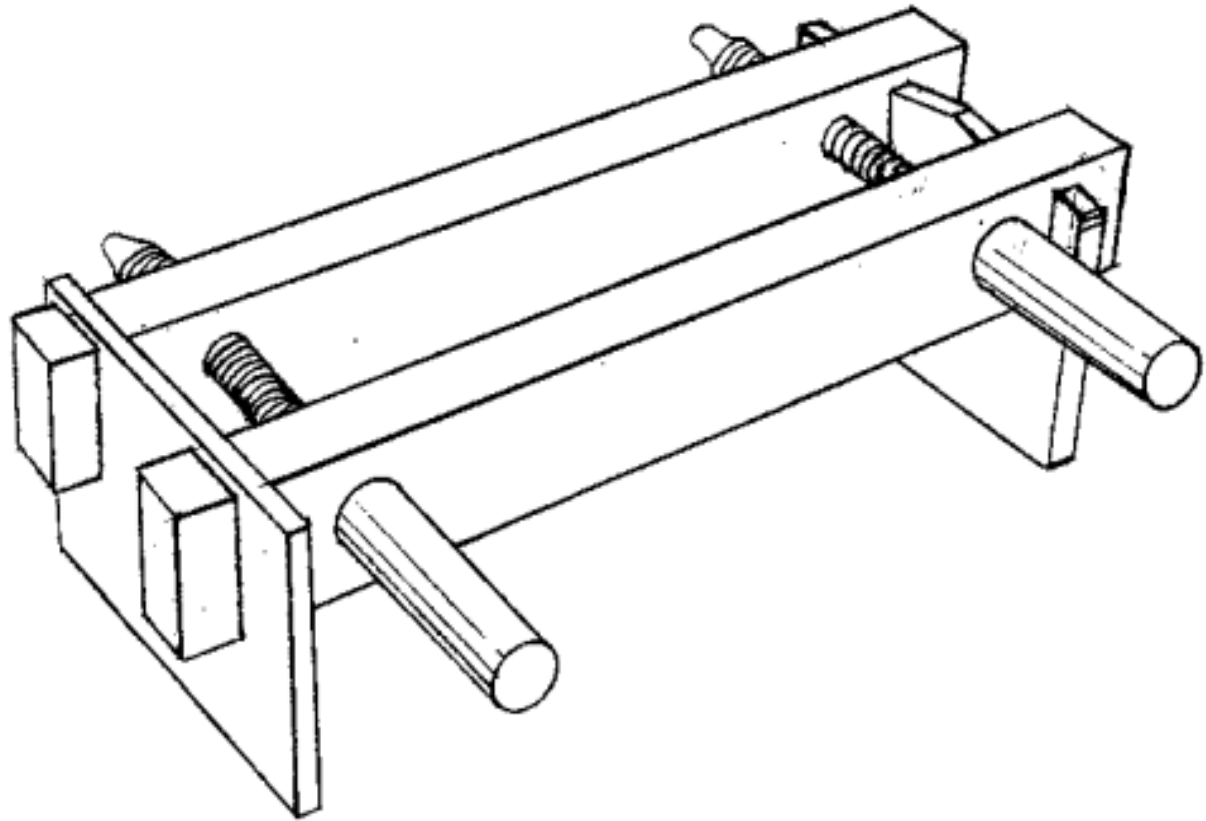


What is claimed is:

- (1) a work bench
- (2) a pair of elongated vice members disposed in side by side relationship
- (3) the vice member having their upper surfaces lying in substantially the same horizontal plane to form a working surface
- (4) the vice members being supported from below by a supporting structure
- (5) means being provided to prevent movement of each member upwardly away from the supporting structure

-
- (6) at least one of the vice members being capable of movement towards and away from the other vice member
 - (7) the said movement being caused by actuation of either one or both of a pair of spaced independently operable vice operating devices
 - (8) the vice operating devices are operatively coupled to at least one of the members by means which enables the gap between the vice members at one end thereof to be greater than the gap at the other end thereof.

Primary Prior Art



Features of Russel's Bookbinding Press

- (1) Bookbinding Press.
- (2) A pair of elongate vice members are disposed in side by side relationship and the vice members have their upper surfaces lying in substantially the same horizontal plane.
- (3) The vice members are supported from below by a supporting structure.
- (4) The vice members are capable of movement towards and away from the other vice member.
- (5) The movement of the vice member is caused by actuation of a pair of spaced independently operable vice operating devices.
- (6) The vice operating devices are operatively coupled to the vice members enabling the gap between the vice members at one end thereof to be greater than the gap at the other end thereof.

Common Feature

- A pair of elongated vice members are disposed in side by side relationship and the vice members have their upper surfaces lying in substantially the same horizontal plane.
- The vice members are supported from below by a supporting structure. The vice members are capable of movement towards and away from the other vice member.
- The movement of the vice member is caused by actuation of a pair of spaced independently operable vice operating devices.
- The vice operating devices are operatively coupled to the vice members enabling the gap between the vice members at one end thereof to be greater than the gap at the other end thereof.

Differences

Difference 1: Present invention is a work bench while the prior art is a bookbinding press.

Difference 2: The upper surface of the vice member of the present invention is for working surface.

Difference 3: The prior art has no means to prevent movement of each vice member upwardly away from the supporting structure.

Evaluation of the differences

Difference 1

Webster's 3rd Edition English Dictionary defines that a "work bench" is a strong heavy waist-high table on which the work esp. of mechanics, machinists, and carpenters is performed. The invention described in the patent is apparently a "work bench" as Webster defines. Work bench and bookbinding press are clearly different to each other in operation, function and structure.



Difference 2

As a “work bench”, it must have a flat working surface on which an article is put and working operation is performed. The unique feature of the present invention is that the upper surfaces of a pair of vice members serve as the working surface. The vice member of the prior art does not have such a secondary role.



Difference 3

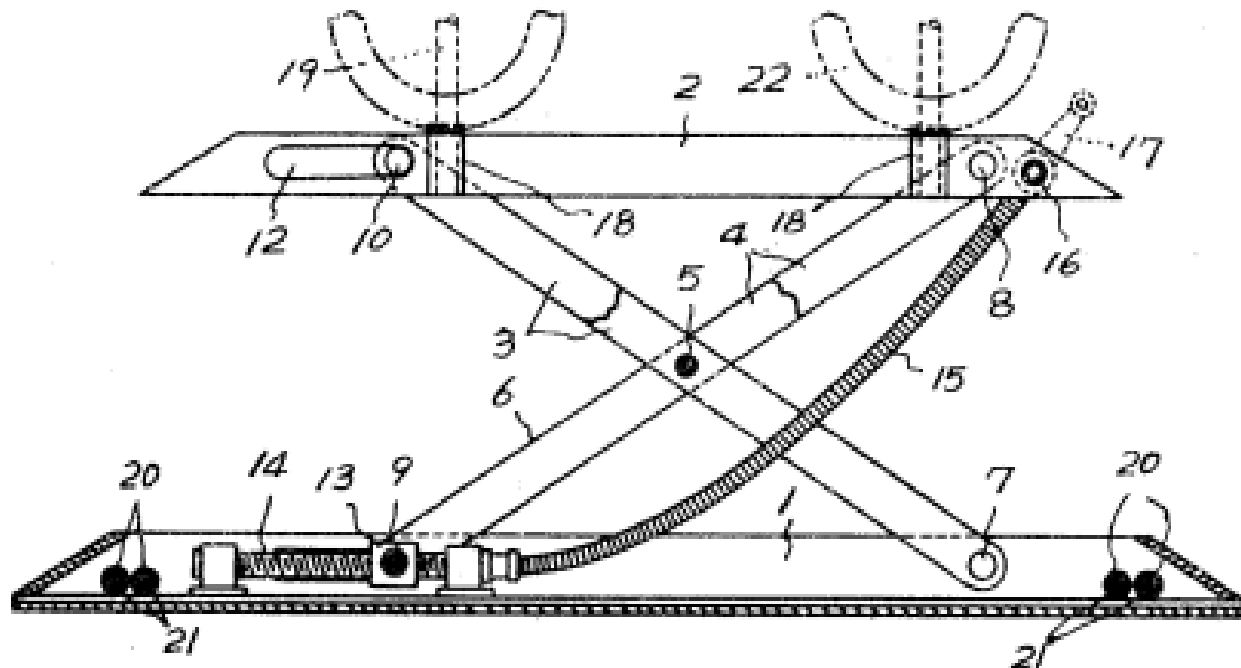
As a vice member built into a work bench, it must be securely supported and there must be something that prevents movement of each vice member upwardly away from the supporting structure. The bookbinding press does not need such a structure.

Conclusion

The all differences come from intrinsic difference between “work bench” and “bookbinding press”. And there is no logical reason how and why the bookbinding press of the prior art is to be modified to a work bench as claimed. The inventive step of the claimed invention is not denied.

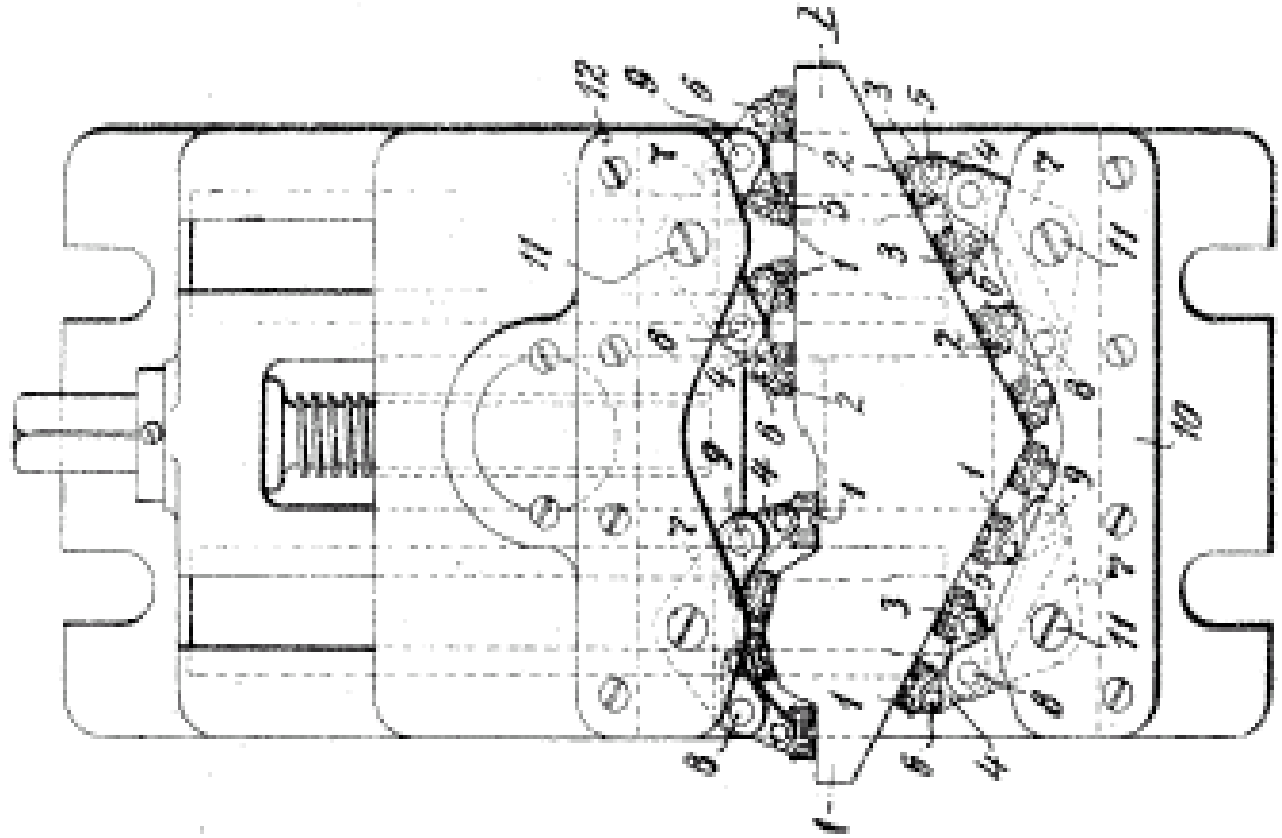
Prior Art cited in Japan 1

第2図

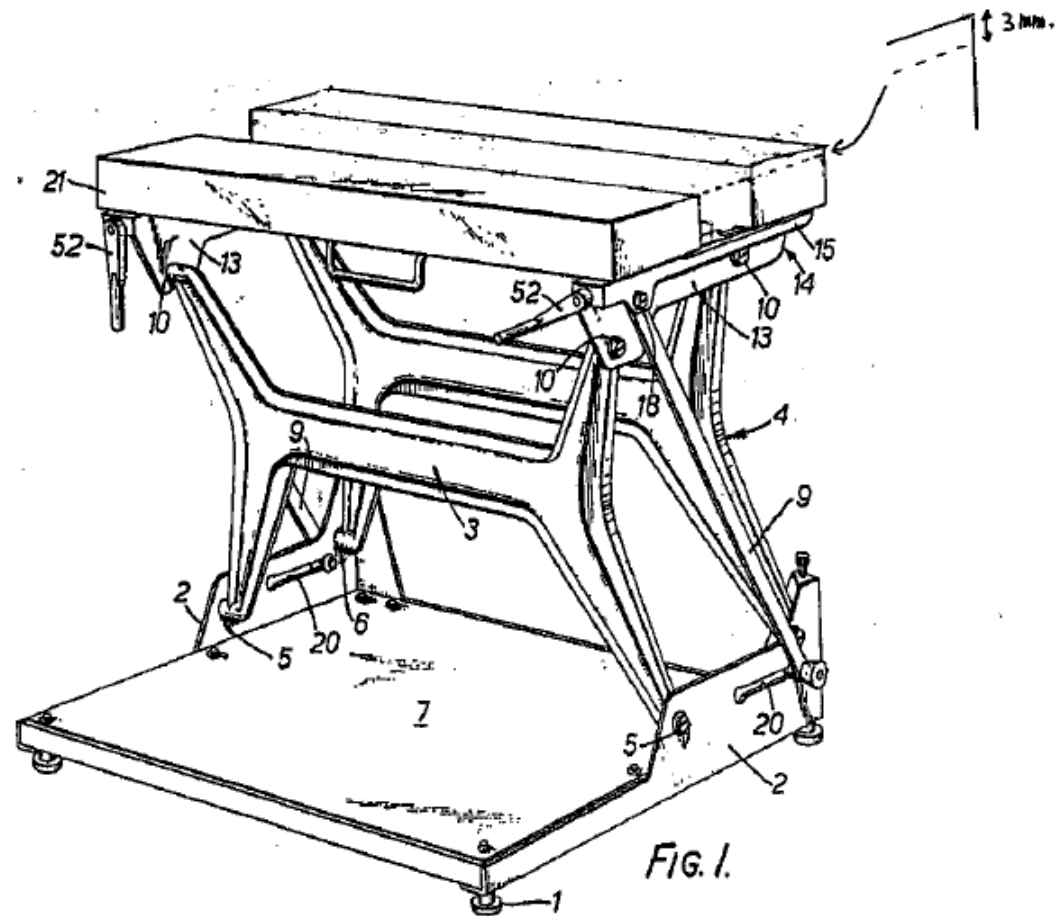


Prior Art cited in Japan 2

第一圖



Infringement Evaluation



Literal Infringement

- Claim element No.3: the vice member having their upper surfaces lying in substantially the same horizontal plane to form a working surface
- Under current practice in Japan, “substantially” is not allowed as it is indefinite.
- Regardless of the existence of “substantially”, the alleged products literally infringes the patent because 3mm height difference is negligible as the working surface of work bench.

Doctrine of Equivalent

Ball Spline Supreme Court Case

- (1) Replacement is not in the substantial part of the invention
- (2) Same purpose and same effect is achieved.
- (3) Replacement is obvious to skilled person in the art.
- (4) Alleged product is not obvious over prior arts.
- (5) File Wrapper Estoppels

In the present case:

- (1) 3mm height difference of vice member is not the core concept of the invention.
- (2) 3mm height difference provide no significant difference.
- (3) No difficulty in making 3mm height difference
- (4) 3mm height difference has no significant meaning
- (5) No estoppels.



Conclusion

Infringement under Doctrines of
Equivalent



THANK YOU !