

How to Determine Inventive Step

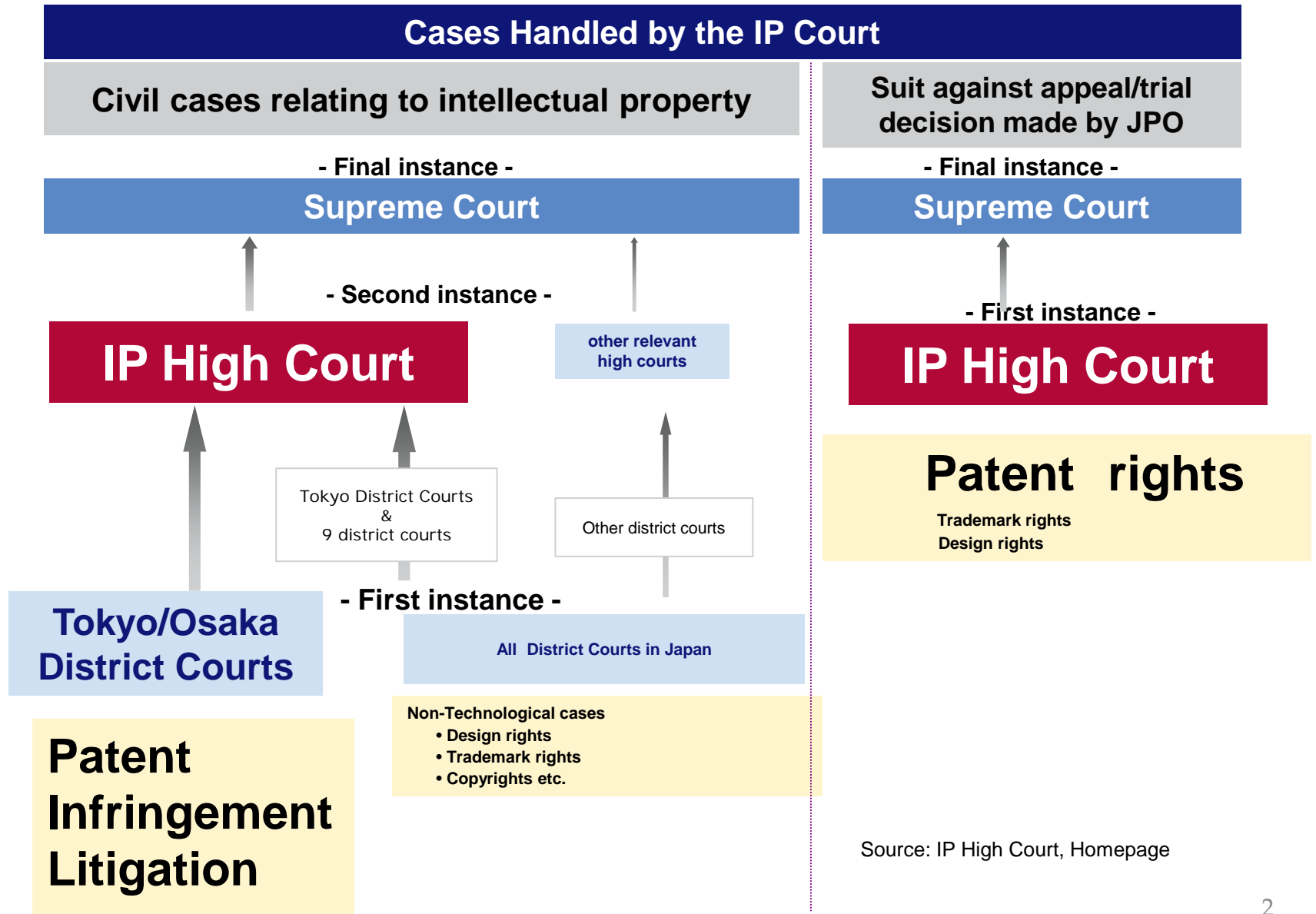
From the Perspective of Practice in JPO & IP High Court of Japan

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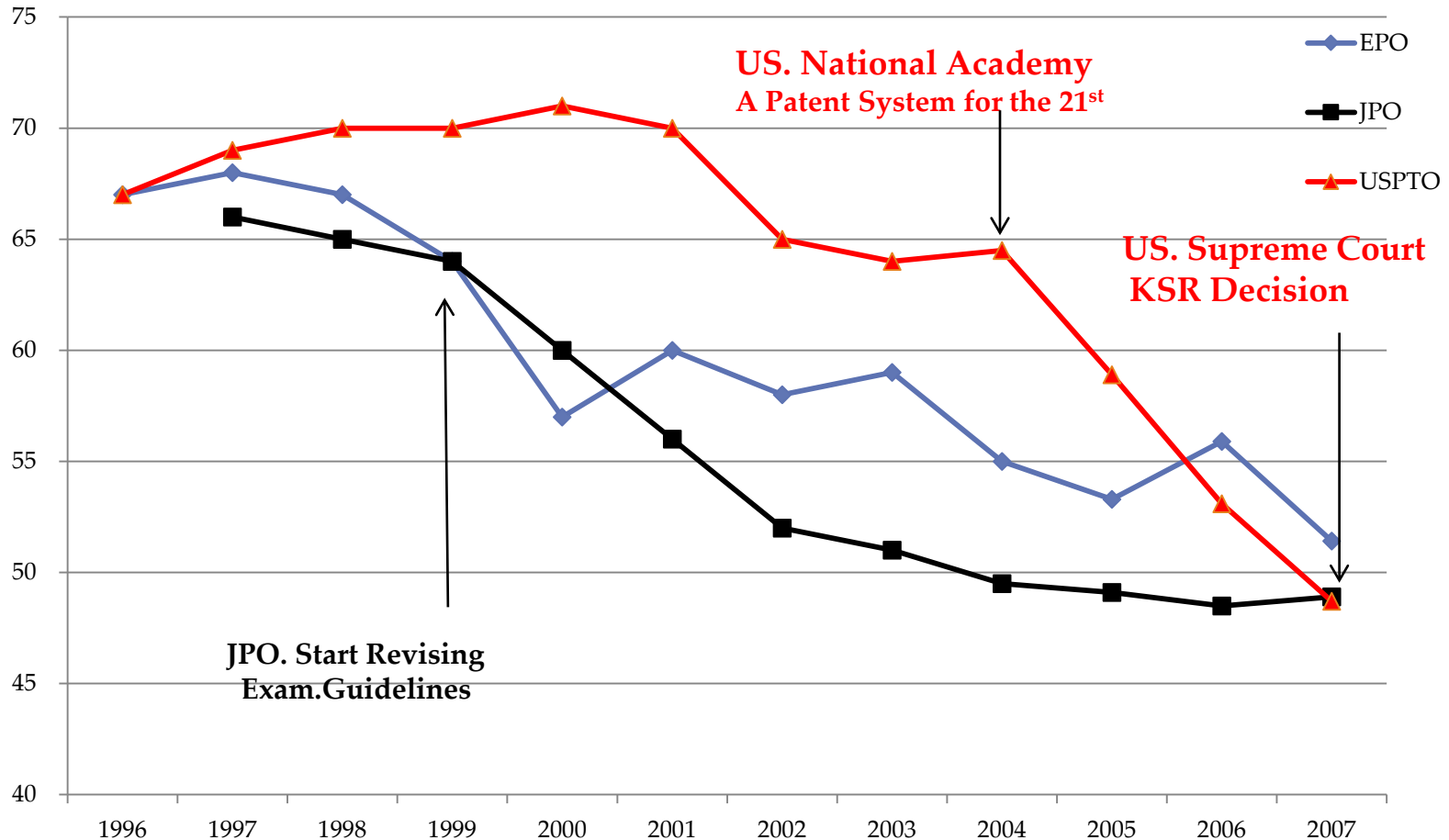
Jurisdiction



Source: IP High Court, Homepage

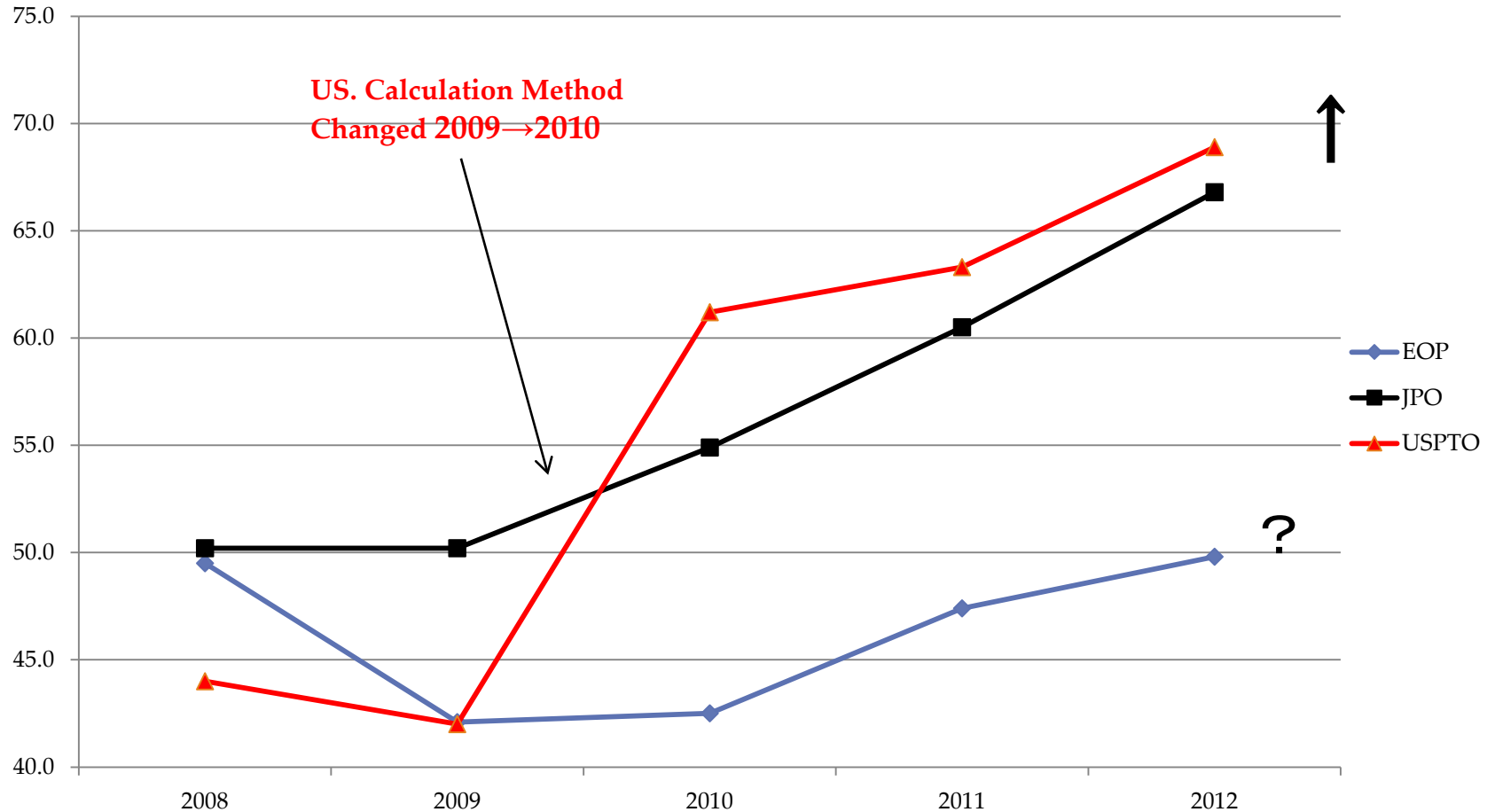
Patent Grant-rate in EPO,USPTO,JPO 1996-2007

Similar drop happened in Trilateral Offices

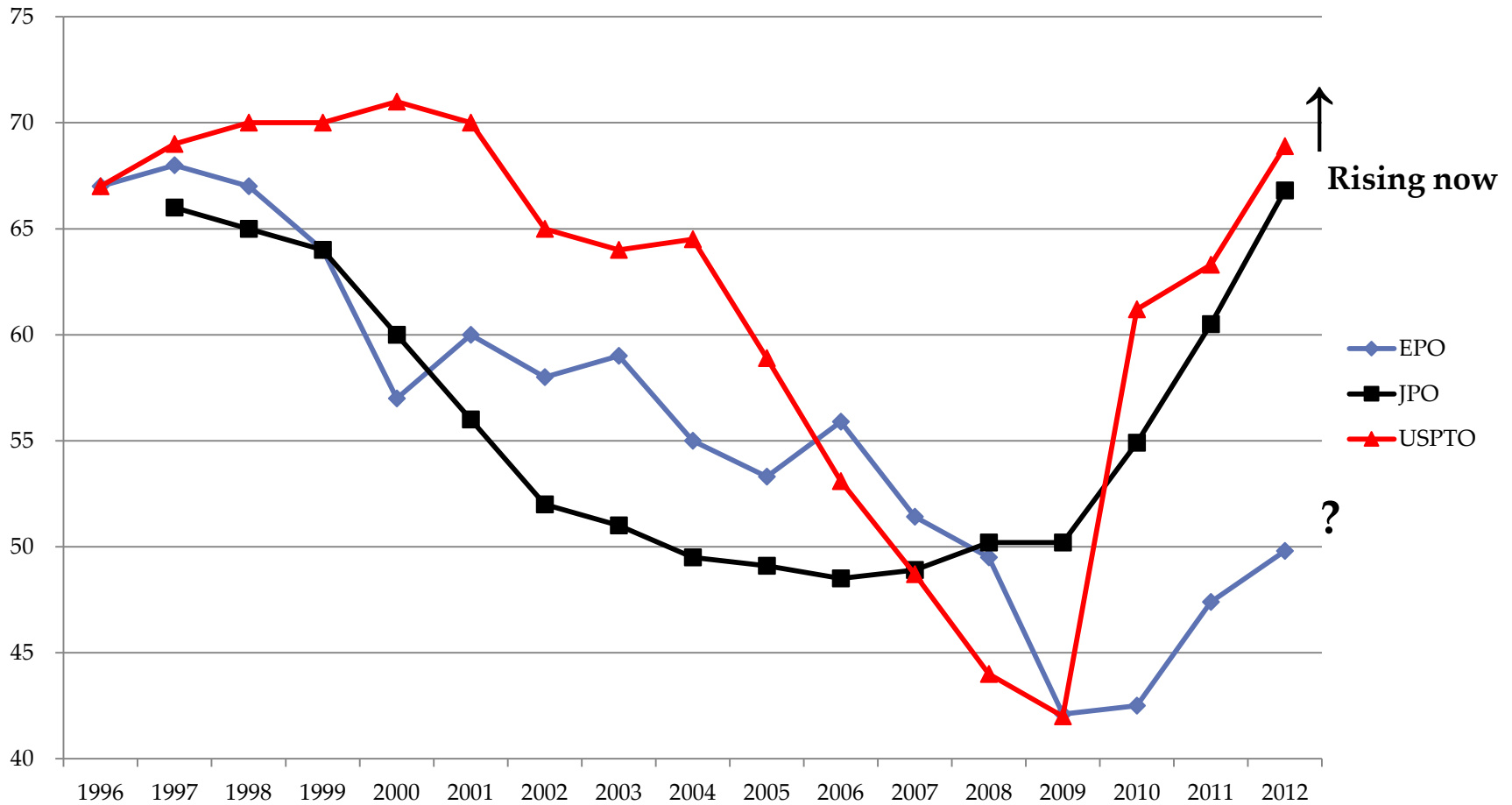


Patent Grant-rate in EPO,USPTO,JPO 2008-2012

Similar rise in USPTO & JPO, not in EPO



Patent Grant-rate in EPO,USPTO,JPO 1996-2012



JPO Exam.Guidelines

Identify Claimed Invention

Identify Cited Invention

Find correspondences &
Differences

Reasons for Denying Inventive
Step

To Combine or Replace is Easy or not?

- ①Relation of technical field
- ②Close Similarity between the two Problems
- ③Commonality of working or function
- ④Implications in the cited Invention

Is there any teaching away ?

NO

YES

More Advantageous
Effects ?

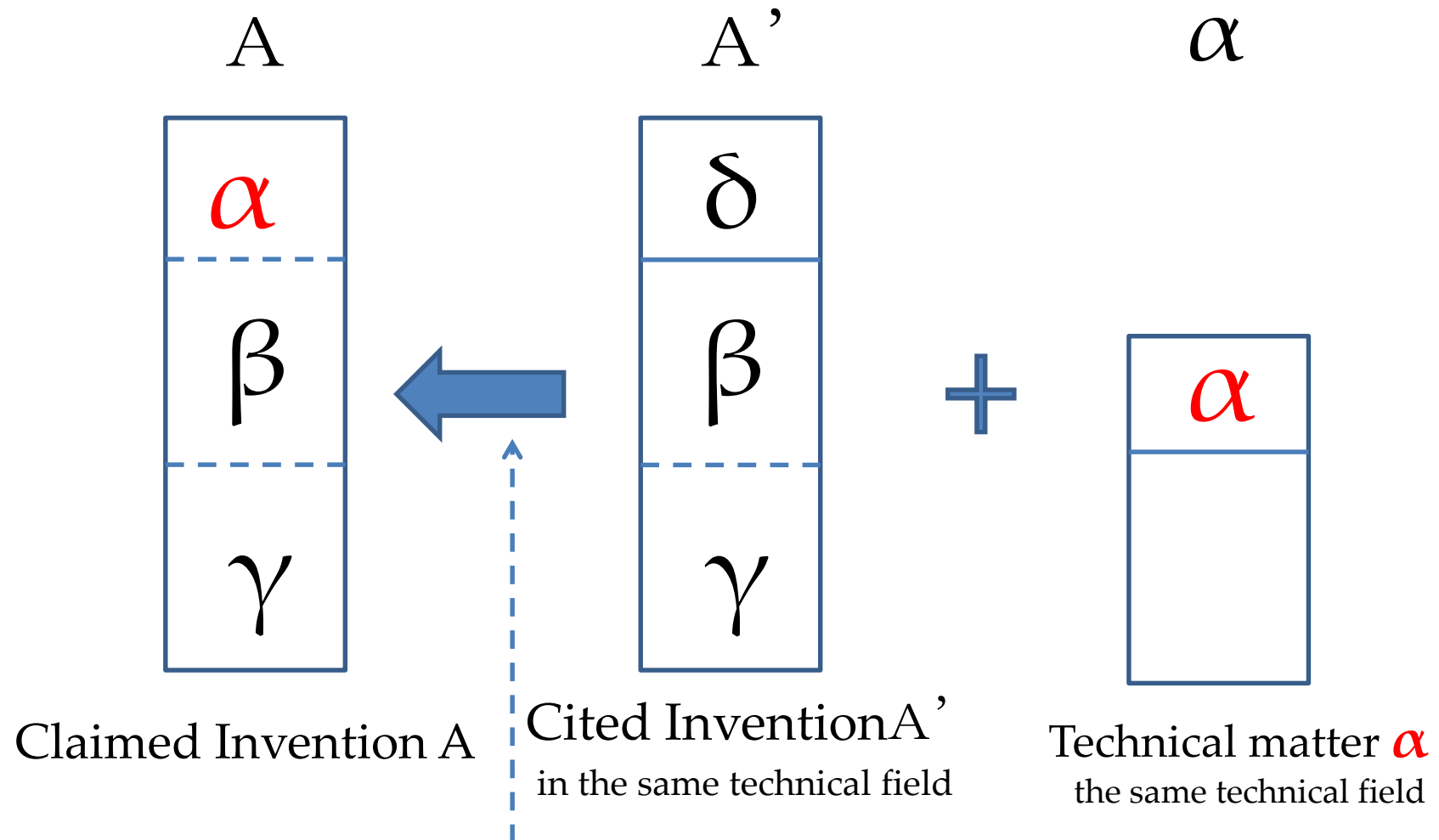
NO

YES

Inventive Step

Non-Inventive Step

The Same Technical Field Doctrine *Disappeared in 2008*



even when there is no suggestion or motive

(1) “KARAOKE Patent” (P3031538) is invalid or not
Decision by Tokyo High Court January 28
2009[2008(GyoKe)10096]

March 17, 1982: Patent application

for ‘Video recording apparatus’ filed by **Toshiba**

November 30, 1990:

1st divisional application filed, 2nd divisional filed in 1996

‘Karaoke patent’ appears at the 2nd divisional

May 21, 1996: JPO rejects the patent application

May 14, 1997: JPO denied Toshiba’s appeal

Reason: Patent subject matter eligibility lacking

Toshiba files suit to cancel JPO’ decision with IP High Court

May 26, 1996: IP High Court affirms patent subject matter eligibility, renders judgment cancelling trial decision

JPO allows 'Karaoke patent' and registers it

Claims thereof are as follows:

“A singing lyric instructing method comprising displaying characters of lyrics on a screen of a display and changing color of the characters to be sung of the lyrics in accordance with progression of an accompaniment”

The Karaoke Patent works hard encouraged by the decision, however

April 23, 2003, JPO affirms Inventive Step and rejects demand for invalidation of 'Karaoke Patent as follows;

“The present invention cannot be easily conceived based on Cited Invention 1 (US 1,516,277; patented in 1924).”

July , 2003: Toshiba demands compensation for 900 million yen (about \$9 million) in damages before the Tokyo District Court.

November 18, 2003:IP High Court renders judgment to cancel trial decision on grounds that the invention in question lacked Inventive Step.

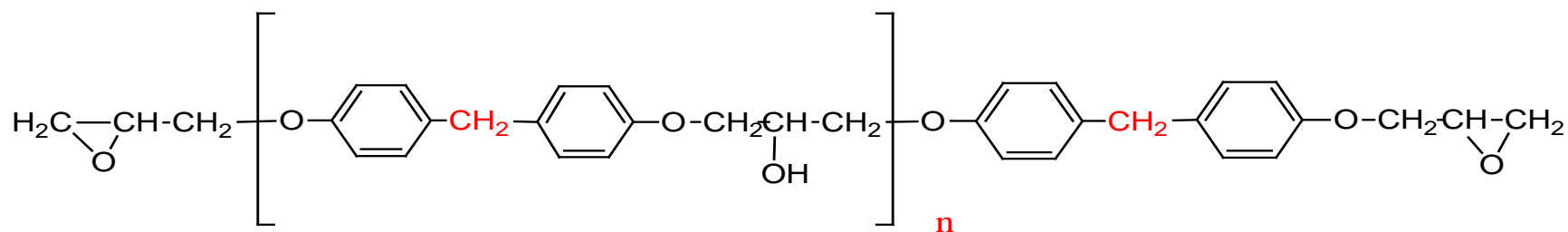
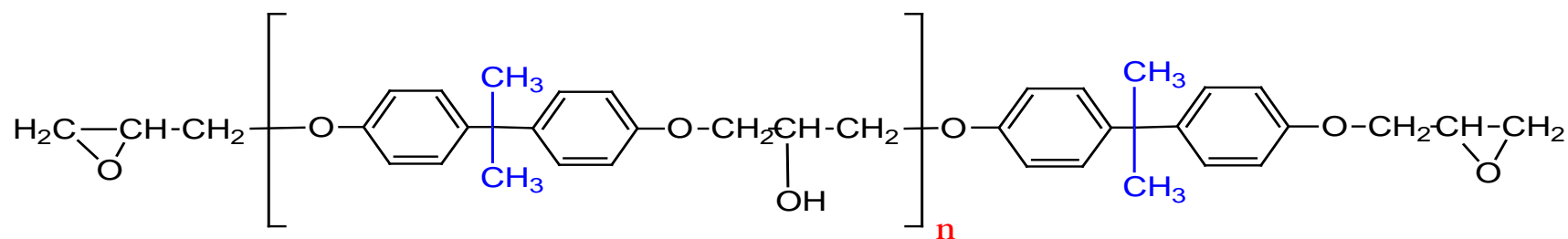
Reason: “Invention can easily display singing part from the well-known art”

(2) “CIRCUIT CONNECTING MEMBER” case
Decision by IP High Court January 28,2009
[2008(GyoKe)10096]

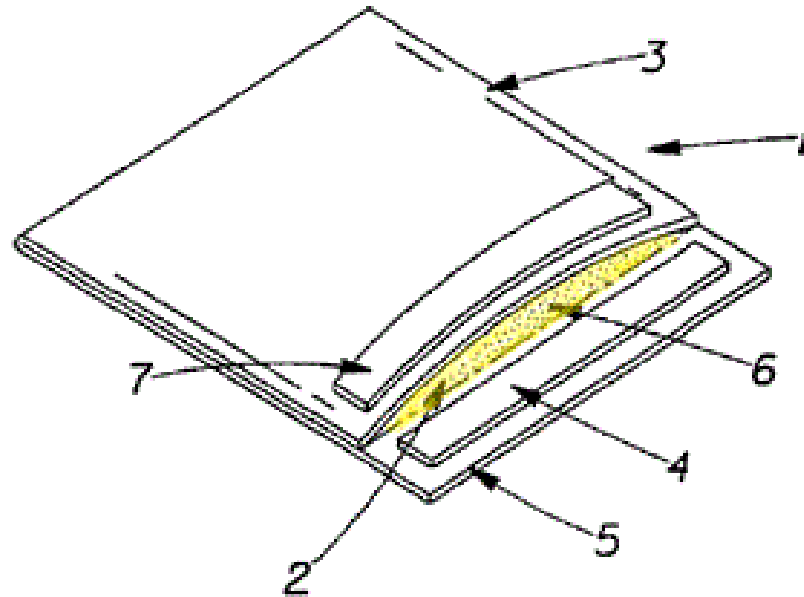
Bisphenol A-type phenoxy(upper) in cited Invention should have been replaced by Bisphenol F-type phenoxy(under) in Claimed Invention.

Differences are found only
between **CH3** and **CH2** and in ‘n’

Bisphenol A-type phenoxy(upper)
 Bisphenol F-type phenoxy(under)



(3)“ODOR-NEUTRALIZING and LIQUID-ABSORBING TRASH BAGS”
Decision by IP High Court September 28, 2010[2008(GyoKe)10096]



1 a flat sheet of flexible plastic

2 an absorbent material

3 The border of the sheet along its lateral edges is free of the absorbent material

4 Strip comprises a layer of contact adhesive as a sealing means on closure flap

5 Closure flap

6 The opening of the bag

7 Contact surface

Important: (a)liquid impervious walls

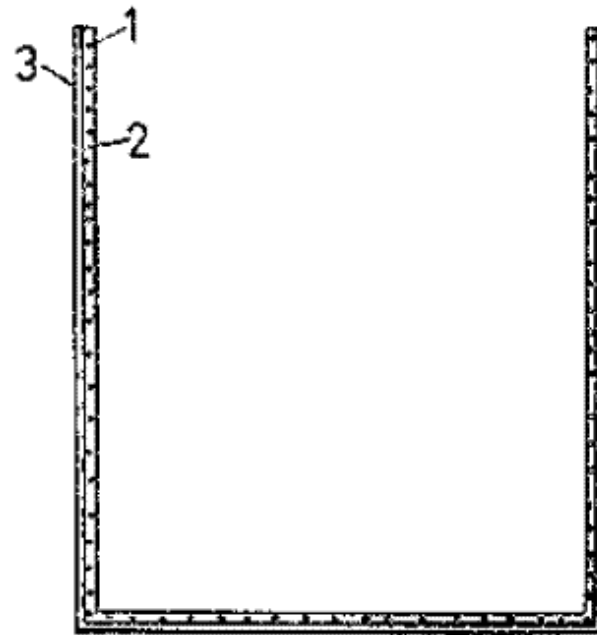
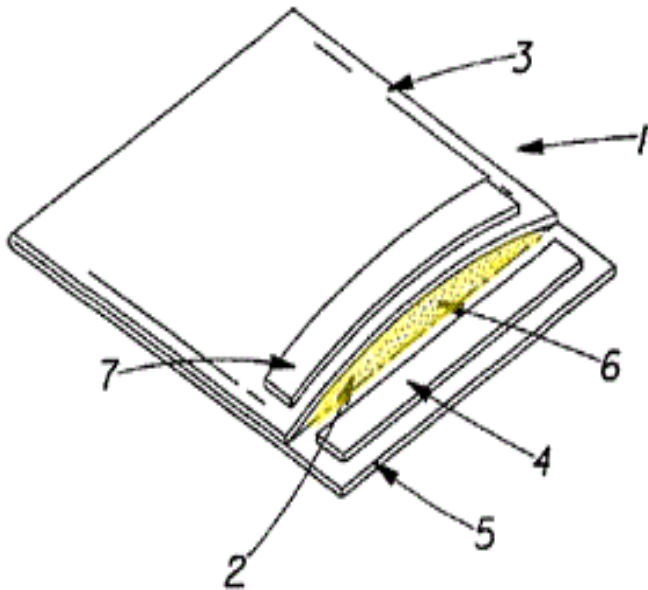
(b)an absorbent material

(c) a liquid pervious liner

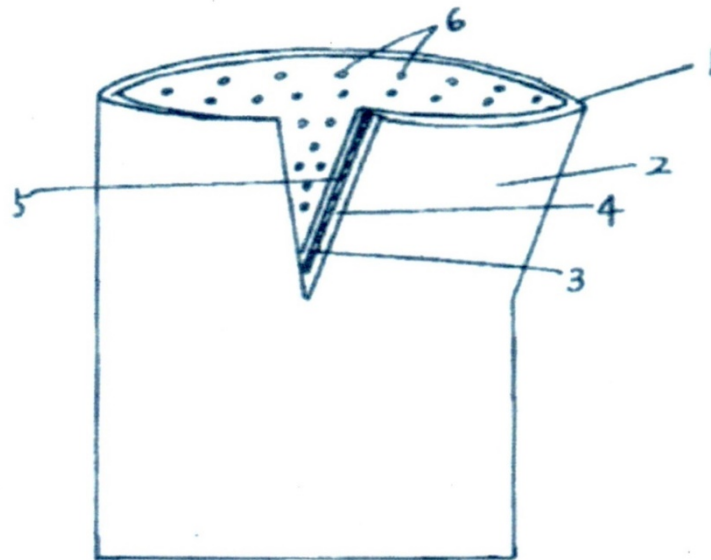
Claimed Invention(left) & cited Invention1(right)

Cited Invention1 is Utility Model (1989-58507)

- 1.trash bags comprises ordor-absorbing
- 2.water absorbing-polymer
- 3.the polyethylene



Well-known matter (Utility Model:1983-101738)
The reference(Invention2) describes an art of arranging
a liquid pervious liner adjacent to an absorber.



The explanation of parts (Utility Model:1983-101738)

part1:container for foods and scraps

2:liquid impervious plastic sheet

3:absorbent material

4-5:liquid pervious liner positioned
adjacent the absorbent material

6:numerous small ventholes in the
inner surface

Claims Before Amendment

Claim1:a container for use in the disposal of food wastes characterized by (a)liquid impervious walls having inner and outer surfaces, (b)an absorbent material having deposited thereon an effective amount of an odor-neutralizing odors emitted by food wastes; where the absorbent material is inside the container.

Claim8:a container for the disposal of food wastes characterized by:

(a) liquid impervious walls defining an opening for receiving the food wastes, the walls having an inner and outer surface;

(b) an absorbent material positioned adjacent the absorbent material.

(c) a liquid pervious liner positioned adjacent the absorbent material.

Claims After Amendment

Claim1:a container for the disposal of food wastes comprising (a) liquid impervious walls defining an opening for receiving the food wastes, the walls having an inner and outer surface

(b) an absorbent material positioned adjacent the inner surface of the liquid impervious walls, characterized by having an effective amount of an odor-neutralizing compound deposited on the absorbent material, and

(c) a liquid pervious liner positioned adjacent the absorbent material.

Claim7-10 deleted

Original Claim and amended Claim in JPO

This Invention used to comprise Claim1-7[(a)Liquid Impervious Walls and (b)Absorbent Materials] and Claim8-10([(a) and (b)] and (c)Liquid Pervious Liner). Claim1-7 based on Cited Invention1(Utility:1989-58507). Claim8-10 based on Cited Invention1 and Invention2(Utility:1983-101737).

It can be said that Cited Invention1 and Cited Invention2 are well-known, or at least, Invention2 is clearly well-known. Many evidences(referemces:utility models) were submitted in the court.

Therefore, Claim1-7 was inevitably abandoned. Claim8(changed into Claim1) comprises Cited Invention1 and Cited Invention2(well-known). Before the amendment, the application was totally rejected in USPTO. And In JPO, even after amendment, the application was refused because of lacking inventiveness. The applicant filed a suit with IP High Court.

Speaking from the perspective of judgment standard or common sense as appeared in KSR case, this invention (after amendment) lacks inventiveness. However, the Court decided “There is no description or suggestion in the specification to adopt “Invention2((c)Liquid Pervious Liner)”. The Court canceled the decision of the JPO.

The Odor-Bag Invention

really has inventive step?

In USPTO

Application was filed in Nov/2003

Application was abandoned (no appeal again USPTO)

in May/2006

USPTO says "This Invention is obvious and unpatentable"

In Japan

Application was filed in Nov/1999

Office Action in Nov/2008→Amendment→refusal &
appeal→rejection→file a suit with IP High Court

IP High Court said in the decision of Sep.28/2011 as follows;

"There is no motivation to arrange (c)liquid permeable liner in
the cited invention 1"



In EPO, why amended Invention survive ?

Application was filed in Nov/1999

In Apr/2002 Amendment was made as result of Communications.

Examiner advised as follows,

“Claim1-7 has no inventiveness, but Claim8 has inventiveness”

In Japanese Court practice;

If there is no suggestion nor problem in cited invention,
fundamentally(with sometimes happened exceptions),
inventiveness exists.

In EPO practice, the problem—solution approach
generally applied.

Establishing the “objective technical problem”to be solved

Objective technical problem may not be what the applicant
presented as“the problem”in his application.

✂PartG-ChapVII-4

What kind of problem did examiners formulate ?

~~One of technical features of this amended Invention is as follows,~~

how to solve “the problem that consumers have accidental and undesirable contact with the absorber which has been almost or completely saturated with liquid trash”

In the specification the description is as follows,

“The liquid pervious liner is compliant, soft feeling, and non-irritating to human skin and allows liquids to readily penetrate through its thickness. By providing the liner, a consumer who places his or her hand into the container in the process of placing food wastes and scraps inside will not have incidental and undesirable contact with the absorbent material which is nearly or completely saturated with liquid wastes.”

※There are small differences in specification JP0[0023], USPTO[0028], EP0[0026].

In the light of the cited Invention¹(though Japanese publication), the above-mentioned problem could be conceived or not? If not, the examiner should have tried to formulate another problem concerning another feature(c)(Liquid Pervious Liner).

As for me, it is not so difficult for house keepers.

My conclusion

Thank you very much for your attention.

The present Invention comprises the two well-known arts.

In the IP High Court practice, the level of inventive step is sometimes(not so often) too low these few years. Those exceptional decisions appear often when the court apply well-known matters to the cited invention.

The EPO examination practice, especially how to formulate the problem, is not clear to me. It is not so difficult to find the problem which really exists in the specification, but it is very difficult to formulate objectively the real but partially virtual problem.