

16 回知的財産翻訳検定<第9回和文英訳>

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標準解答例

Issue: Standard for determining inventive step of claimed invention

Facts:

Japanese patent number 3561899 entitled "Filter for ventilating fans and manufacturing method of the same" was determined invalid through an appeal for patent invalidation at the Japan Patent Office (JPO). The owner of the patent at issue filed an appeal with the Intellectual Property High Court (IPHC) in order to repeal the invalidation decision by the JPO effectively cancelling the decision. The IPHC determined there was due cause for cancelling the decision by the JPO's decision. Hereafter the decision of the court on the JPO's decision will be described by focusing on claim 1 of the invention of the patent.

Court's discussion:

The invention of claim 1 of the patent is a filter for a ventilating fan configured with a metal filter frame and a filter member formed with an unwoven fabric wherein the metal filter frame and the filter member of the unwoven fabric are adhered by a soluble emulsion adhesive agent including a film forming polymer.

The JPO invalidated the invention of claim 1 of the patent because the invention could be easily made based on the invention described in the microfilm of Japanese application for utility model registration No. S58-136320, hereinafter "Invention A" and the description in Japanese patent application as disclosed in publication No. H07-188632 (Reference 2), and the well-known technique described in Japanese patent application as disclosed in publications Nos. H11-129645, S51-48404 and 2000-126523 (References 3-5). The invalidation decision determines that Invention A is

substantially a filter cover for a range hood comprising an unwoven fabric filter attached to a grating part of the filter and the difference between the invention at issue and Invention A lies in that the invention at issue had employed a soluble emulsion adhesive agent including a film forming polymer while Invention A does not use such an adhesive agent. However, it was determined in the decision that the problem to be solved in the patented invention was to enable easy separation of an unwoven fabric filter element from a metal filter frame after expiration of the ventilator filter and disposal was a well-known technical problem and an ordinary person skilled in the art would have easily selected an adhesive with a soluble or swellable component. The rationality behind the decision was that the JPO determined that the problem to be solved in the patent at issue was that during the disposal process, separation of the unwoven fabric filter member from the metal filter frame after expiration of the life of the filter was well-known, reference 2 described an adhesive with soluble and swellable components which was similar to an adhesive as multiple materials were attached to each other, and an ordinary artisan could have been motivated to select the adhesive with a soluble/swellable component. As a result, the JPO concluded that it was not difficult for an ordinary artisan to employ "a soluble emulsion adhesive including a film forming polymer" as the adhesive in Invention A to facilitate separation of the filter member from the filter frame upon disposal.

In this context, the court found that the decision of the JPO was improper because the decision did not provide a rationale for the reason why the configuration of the above difference was easily perceived if a problem to be solved by the invention at issue had been well-known.

Furthermore, the court has found additional references 3-5 do not suggest the above problem in that in ventilator fans with a metal filter frame to which unwoven fabric filter is adhered with an adhesive agent so that while the frame and the filter member are firmly fixed during normal use, the filter

member can be removed from the frame easily after use for easy separation for enabling separate disposal of each material.

Therefore, the court has determined that an ordinary person skilled in the art could not easily arrive at the difference in configuration of the invention at issue from Invention A through applying the inventions of references 2-5 to Invention A.

(671 words)