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Rejection Response Points for Machinery (Structure) Related Patent (Techniques and examples related to Rejection Reason and Response in the Machinery Field)

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1. Introduction

Drawings are needed most of the time for describing patents in the mechanical (structural) field. It is difficult to understand an invention in the mechanical (structural) field without drawings.

In addition, there are difficulties not seen in other technical fields regarding expressing mechanical (structural) field patents using text while referencing drawings in an easy to understand manner. In particular in the case of an invention with characteristics in a three dimensional arrangement, expressing these characteristics using text such that scope is not narrowed, that is easy to understand, and that does not include prior art takes considerable skill.

Describing an initial application specification is important for considering how to handle various reasons for rejection.

A description of how to handle rejections related to mechanical (structural) patents based on examples the author considers will be of use as a reference for handling reasons for rejection is given below. A description of an initial application specification will also be touched on.

2. Specific Examples of How to Handle

2.1 Example of Handling Novelty and Inventive Step Rejection (regulation article 29, paragraph 1 and paragraph 2)

2.1.1 Example where corrections at the time of claim by a judge were rejected but inventive step was recognized and a patent trial decision was made.

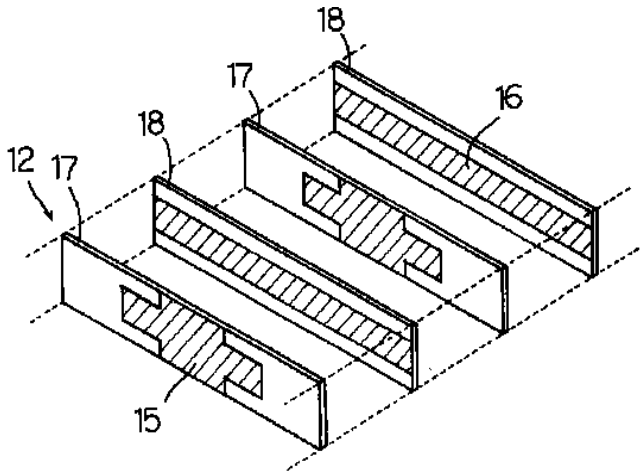
(1) Details for final rejection

In paragraph [0030] of cited literature 1 (Japanese Patent Application H10-340825) it indicates "minimum distance of each ground internal

electrode...thus is connected to ground...reduces residual inductance...becomes feasible", where the aspect of the important item in the corrected claim 1 "suppresses the overall height direction of the part, all parts are inserted between opposing upper and lower circuit boards with the side end surface of the parts overall embedded in the board surface of another circuit board in the height direction" was recognized as suitably designable by a person skilled in the art from the description of cited literature 1.

Note, with regards to the aspect "a first internal electrode and electrically conducting external electrode" and aspect "electrically conducting external electrode to second internal electrode" as described in cited literature 1 and the point of the configuration being switch changed, the invention according to claim 1 of this document after correction could not be recognized to have special meaning previously.」

Drawings for cited literature 1 are shown in Fig. 1 and Fig. 2 and drawings for the present invention are shown in Fig. 3 and Fig. 4. Furthermore, the usage method of the electronic part of the present invention is shown in Fig. 5.



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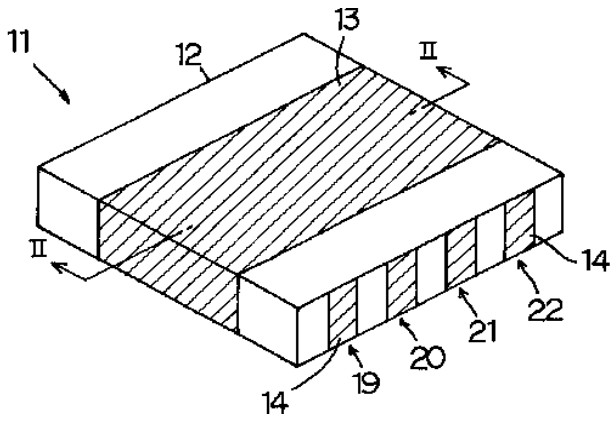

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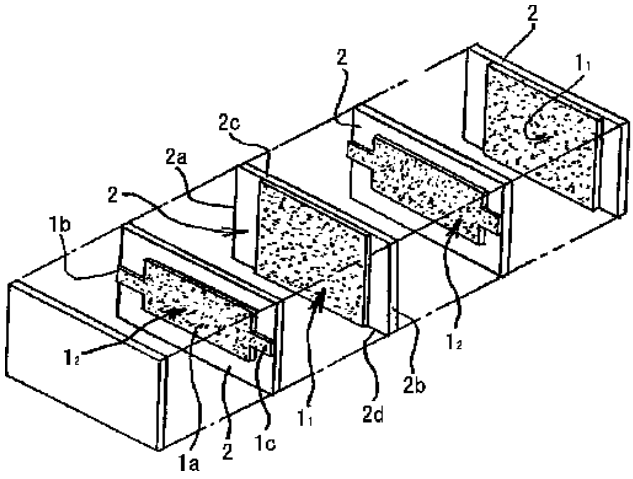


Fig 3

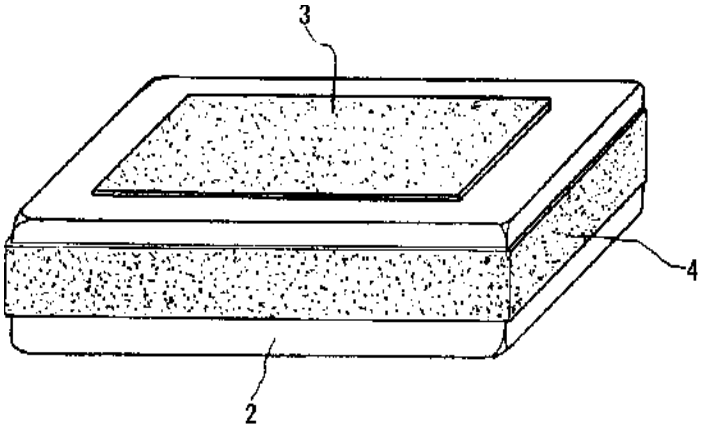


Fig 4

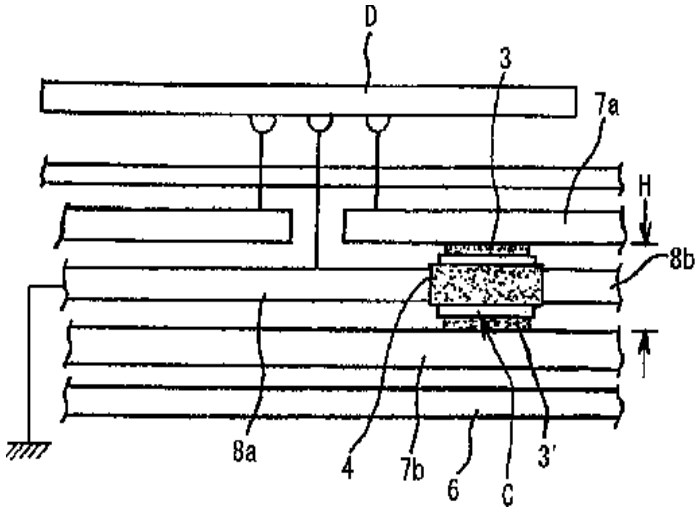


Fig 5

(2) Correction During Trial Application

Claim 1

(A) A three dimensional mounted feedthrough multilayer ceramic capacitor with a multilayer chip body formed of a plurality of alternating laminations of prescribed pattern internal electrodes and rectangular ceramic layers with an external electrode electrically conducting with an internal electrode of this multilayer chip body provided on a prescribed surface of the multilayer chip body,

(B) a multilayer chip body with an interleaved ceramic layer laminated alternately with a first internal electrode that extends across the center excluding the short sides to both long sides of the ceramic layer and a second internal electrode having two leads extend from a principal part positioned on the ceramic layer to each of the short sides,

(C) a pair of first external electrodes electrically conductive at exposed parts of each long side of the ceramic layer with the first internal electrode are respectively provided on opposing upper and lower surfaces of the multilayer chip body and a single second external electrode electrically conductive with the second internal electrode at each lead is provided on the circumference of side end surface of the multilayer chip body.

(D) the width of the connection between the pair of first external electrodes with the first internal electrode has a greater width than the short side of the ceramic layer

(E) the three dimensional mounted feedthrough multilayer ceramic capacitor with the short side of the ceramic layer that forms the multilayer chip body suppresses the overall component body in the height direction, the part overall is inserted between the board surfaces of upper and lower opposing first circuit boards, the end side surface of the overall part being embedded in the height direction in the board surface of a separate second circuit board positioned between the pair of first circuit boards where each of the external electrodes is faced perpendicular to the differing circuit patterns of each circuit board and configured as electrically connected three dimensional mounted feedthrough type.」

The underlined parts were added at the time of trial.

(3) The correction was rejected but the patent still faced a trial decision

At the trial the claimed element (D) in the present invention was judged as "with

regards to the technical items lead to from the overall description of the initial specification and the like, it is not that no new technical items were introduced so it is not within the scope of the initial specification description" and so all of the corrections (underlined parts) from the time of trial were rejected. Note, it was judged that the corrections in claimed element (C) were not new items; however, this was not the judgment for the corrections in claimed element (E).

The technical matter shown in claimed element (D) are elements that were added to the technical elements shown in the drawings shown in Fig. 3 and Fig. 4 of this application in order to emphasize the differences of the internal electrode patterns with cited literature 1 shown in Fig. 1. The examiner judged that the external electrode 13 of cited literature 1 shown in Fig. 2 corresponds to external electrode 4 of the present invention shown in Fig. 4; that external electrodes 19 to 22 of cited literature 1 shown in Fig. 2 correspond to the external electrode 3 of the present invention shown in Fig. 4; and that the repeated pattern of internal electrodes 15 and 16 shown in cited literature 1 shown in Fig. 1 are analogous to the repeated pattern of internal electrodes 11 and 12 of the present invention shown in Fig. 3.

Here, by adding the technical matter shown in claimed element (D) described above, the repeated pattern of internal electrodes 15 and 16 shown in cited literature 1 shown in Fig. 1 and the internal electrodes 11 and 12 of the present invention shown in Fig. 3 attempt was made to clarify that the vertical and horizontal lengths were opposite but the correction itself was rejected.

The correction itself was rejected but in the grounds of the trial, the assertion regarding differences of the present invention and cited literature 1 were recognized and the present invention was patented.

(4) Consideration

In the description of the initial application of the present invention, there was not a direct expression corresponding to the claimed element (D) described above but it is clear when looking at the drawings so it was thought that the correction should be recognized. Even for scopes where corrections are recognized in US patent practice, in Japan patent practice there is a strong tendency to judge corrections based solely on descriptions in drawings as new matters added and reject them.

However, this example shows that even if the correction itself is rejected in the objection to the final rejection, enough emphasis of difference between

documents and the present invention as a reason for judging may enable the patent to be upheld.

With the recent practice of mechanical and structural related patents, there is a trend to more stringent judgments for corrections based solely on drawings. On the other hand, with regards to drawings in cited literature, even if the drawings themselves of the present invention are similar, if the technical idea of the present invention is not disclosed in the text of the specification of the cited literature, inventive step may be recognized and the patent may be upheld.

Note, with regards to mechanical and structural related inventions, even for well known technical matters expressed in the drawings, they need to be expressed in the text of the initial specification application. For example, if there is a description expressing matters shown in drawings such as "horizontal breadth of the internal electrode 11 shown in Fig. 3 is broader than the vertical breadth" in text in the initial application specification, the correction described above would likely have been recognized. However, for this case, as a result of the correction being rejected, the claim was not restricted, the patent upheld, and as a result became a benefit to the applicant.

2.1.2 Example of patent being upheld based on description of difference with cited literature using drawings in a written opinion.

(1) Details for reason for rejection

The basic structure corresponding to the "device" of the present invention, namely the 11, 12-14, 44 respectively corresponding to "cover", "retention means", and "connector" are disclosed as provided in periodical 1 (for example, see Fig. 1 to 12, page 9, lines 34 to 37 and the like).

In the technical field for covers having "at least one engagement part make up a side wall of the container during use and engages with the bottom of a part of the container annularly formed on the outside of the container", is technology that was known prior to the present application (if necessary, see the configuration of lip 80 of periodical 2 Fig. 1 to 3 or the configuration of lock part 25 of Fig. 1, 2).

Furthermore, in preventing full disconnection of the cover from the container more reliably, as described in the well known technique regarding "cover" described in periodical 1 particular difficulty for having "at least one engagement part make up a side wall of the container during use and engages with the bottom of a part of the container annularly formed on the outside of the

container", was not recognized.

Therefore, the invention according to claims 1 to 23 and 25 to 30 could easily be considered by a person skilled in the art from the technology described in periodical 1 and well know techniques.

(2) Rejected Claim

Claim 1

A device for a container comprising a cover engaged so as to enable flipping over and covering an opening of the container,

at least one engagement part that makes up engagement means engaged to the engagement part of the container and preventing disconnection of the cover from the container,

and a plurality of moveable members that make up retention means that conform to positioning around the outer surface of the cover, can be fixed in place to prevent disconnection of the at least one engagement part from a part of the container in a first operation mode, and enable the at least one engagement part to be disconnected from a part of the container in a second operation mode,

wherein, the at least one engagement part makes up a side wall of the container during use and is engaged to the bottom of a part of the container annularly formed on the outside of the container.

(3) Patent Upheld Claim

Claim 1

A device for a container comprising a cover engaged so as to enable flipping over and covering an opening of the container,

at least one engagement part that makes up engagement means engaged to the engagement part of the container and preventing disconnection of the cover from the container,

a plurality of moveable members that make up retention means that conform to positioning around the outer surface of the cover, can be fixed in place to prevent disconnection of the at least one engagement part from a part of the container in a first operation mode, and enable the at least one engagement part to be disconnected from a part of the container in a second operation mode,

and a connector for connecting to the retention means extending from the outer surface of the cover to the outside,

wherein, the at least one engagement part makes up a side wall of the container

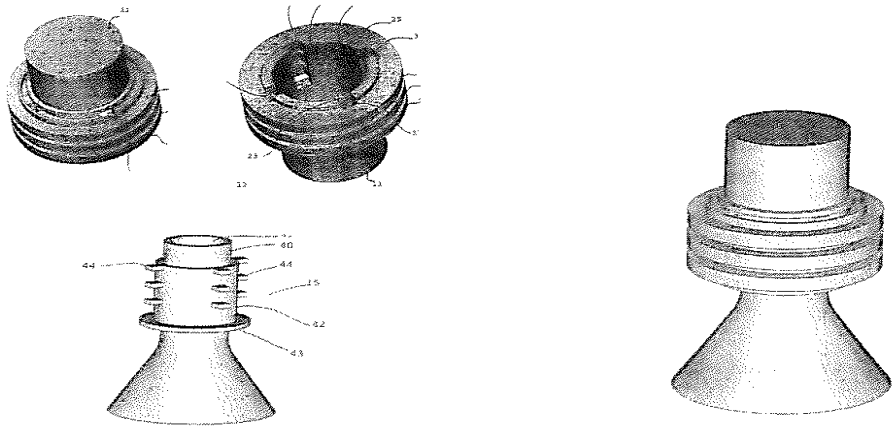
during use and is engaged to the bottom of a part of the container annularly formed on the outside of the container.

Attached Fig. 1

A (Present invention)

(i)　　(i i)

B. (Cited literature 1)



(i)　　(i i)

Fig6

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(4) Consideration

There are a lot of cases where the examiner will make a rejection based simply on drawings being similar. In addition, in the description of the claims at the time of application, there are a lot of cases where a wide scope that includes the scope of cited literature 1 (periodical 1) that is prior art is described.

Therefore, in mechanical and structural related inventions, there are a lot of cases where the claims are corrected so that the content does not include the scope of cited literature 1 (periodical 1) that is prior art shown in the drawing and through emphasizing the specific effect of the present invention unobtainable from the cited literature 1 that is prior art shown in the drawing, the patent is upheld. Furthermore, in an opinion document, for example, as shown in Fig. 6, by attaching a drawing showing the differences with the invention according to the present invention and cited literature 1, it is feasible to suggest that the present invention does have an inventive step with regards to the examiner or appeal examiner.

For this case, the present invention was usable as a freely detachable cover for a normal regular PET bottle while the invention described in cited literature 1 required providing a protrusion on the bottle itself and a particular bottleneck shape and through emphasizing its inability for use on a regular bottle, granting of rights was achieved.

Note, for this case an interview was not held with the examiner; however, with regards to mechanical and structural related inventions, in the case that a sample product of the invention is small, taking a sample of the invention and describing the present invention and its relationship to cited literature to the examiner is beneficial. In the case that the product corresponding to the cited literature is on the market, taking the product corresponding to the cited literature along with a sample of the present invention and describing the differences to the examiner is effective in terms of the patent being upheld. There were examples of where an interview examination was actually held and the patent was upheld.

Furthermore, in the case that a sample of the invention is large, taking a video of the sample of the invention, showing the video to the examiner, and describing the detail of the invention is beneficial. A purpose of the examiner is to contribute to industrial growth through encouragement of inventions through protection and use of inventions (law purpose of patent law article 1), and if the examiner considers the invented product to be superior to other products based

on an interview, the examiner becomes an ally to the applicant and may provide suggestions in order to have the patent upheld.

However, while the patent may be upheld based on corrections made as identified by the examiner, there are cases where the rights were achieved for a scope narrower than the anticipated scope.

In this case, considering a divisional application simultaneous with making corrections as identified by the examiner is effective. In addition, during the process of examination if under conditions where a claim that is too narrow can not be widened through correction (for example during examination appeal), thoroughly develop differentiation with cited literature to achieve rights and simultaneously targeting rights with a wider scope claim through divisional application is beneficial. In actuality, I have experience with just after providing thorough description of differences with cited literature at a final rejection objection trial for a relatively narrow claim and achieving patent being upheld, a divisional application corresponding to a wider claim being patented soon thereafter.

2.1.3 Example of patent being upheld through clarifying purpose through numerical restriction

(1) Details for reason for rejection

Cited literature 1 disclosed "a medical use tube with an auxiliary tube integrated inside a main tube" and other cited literature 2 to 4 disclosed a balloon catheter for vasodilation (PTCA) having an internal pipe inside a catheter pipe (integrated or not is unclear) and adding the technical details shown in cited literature 1 to the balloon catheter shown in cited documents 2 to 4 was taken as self evident and the present invention was rejected.

(2) Patent Upheld Claim

Claim 1

A balloon catheter used for a balloon pumping method inside the aorta comprising a balloon part that is inserted in the aorta that can be expanded and contracted to perform supplementary action of the heart function,
a catheter tube connected to the inside of the balloon part enabling insertion and extraction of pressurized fluid with an internal diameter of 1.5 to 4.0 mm and a thickness of 0.05 to 0.4 mm,
and an internal pipe that communicates with the blood introduction opening

provided in the tip of the balloon part, extends along the axial direction of the balloon part and inside the catheter tube with an internal diameter of 0.1 to 1.0 mm and a thickness of 0.05 to 0.4 mm, wherein
the internal pipe adheres to the inner wall of the catheter.

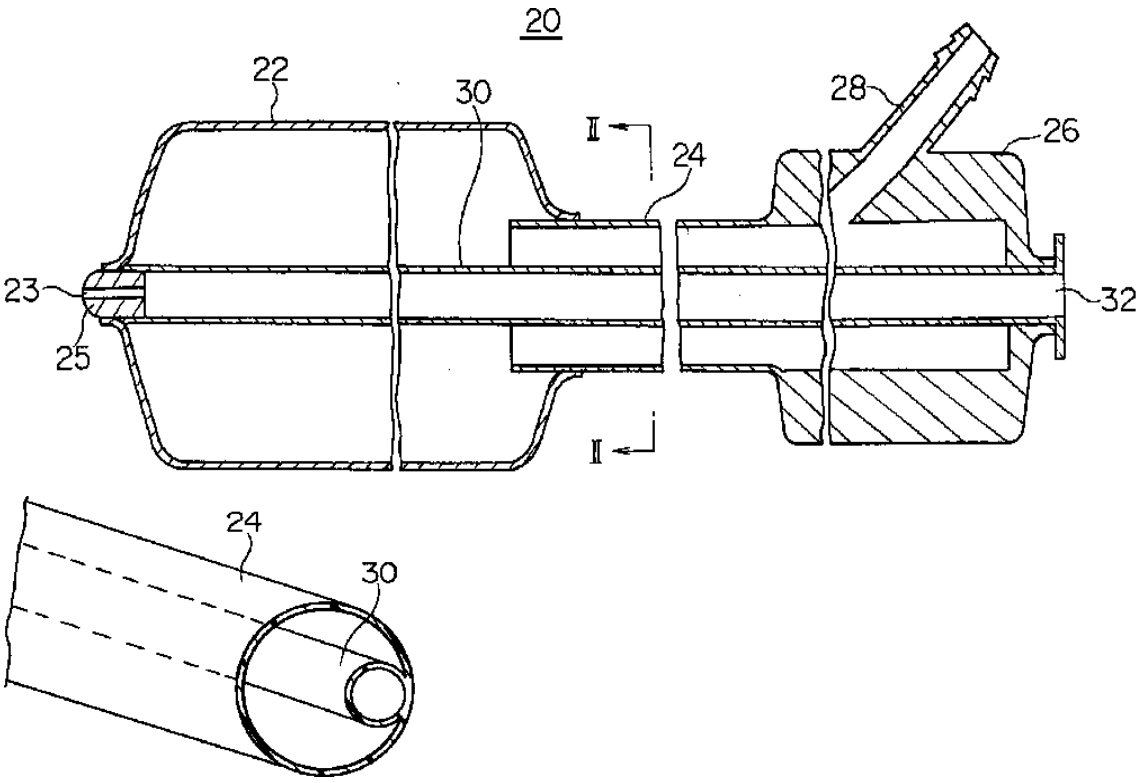


Fig. 7

Table 1

	$T_1 + T_D$
Embodiment 1	248 ± 2 msec
Embodiment 2	244 ± 2 msec
Comparative Example 1	276 ± 3 msec
Comparative Example 2	255 ± 2 msec

(3) Consideration

All of the cited literature 1 to 4 were not balloon catheters for IABP (balloon pumping method in aorta) so a correction adding numerical range was performed to clarify the application of the balloon catheter and exclude balloon catheters for PTCA from the scope. In other words, compared to a balloon catheter for PTCA, the size of a balloon catheter for IABP is large so a correction restricting the size (numerical range) was performed and differentiation with balloon catheters shown in the cited literature was achieved. Furthermore, in an opinion document, as shown in Table 1, it was emphasized that compared to comparative examples 1 and 2 of a balloon catheter without the internal pipe integrated, the embodiments 1 and 2 of the balloon catheter with internal pipe integrated have favorable effects of balloon expansion and contraction response and the patent was upheld.

With mechanical and structural related patents as well, showing of experimental data may lead to recognition of the effect of the patent and to the patent being upheld.

2.2 Example of how to handle regarding invalidation reason (law article 36) of description deficiency

2.2.1 Example related to trial decision and judicial decision of not violating law article 36, paragraph 6 second 2 and paragraph 4

(1) Plaintiff assertion

In the 2009 (rows) 10440 trial decision revocation application case (case where trial judgment indicating patent was not invalid was brought to the intellectual property high court and confirmed that it was not invalid), the plaintiff emphasized that there was no novelty or inventive step and also emphasized the description deficiency shown below.

“In the invention for this case, the intent was for the problem of avoiding seeing an inner layer while deburring that this could be achieved simply by specifying the ratio of the plastic thicknesses of the inner layer and outer layer but this was unreasonable and inexplicable when viewed from a technical common sense perspective.

In other words, in the case of cutting the two respective layers, the inner layer

and outer layer of a hollow window material made of synthetic resin diagonally and heating the cross section and pushing from both sides to weld, a condition for preventing exposure of the inner layer during deburring can not be determined simply by specifying the relative thicknesses of the inner layer and outer layer. This differs greatly with how the ratio of the weld margin ("white" part for welding) set beforehand as the amount that flows as a burr during hollow material welding and window material thickness is taken and depending on how this ratio is taken, the type of relative thickness (ratio) that can be used as a condition for not exposing the inner layer can be achieved (A 17, 18). In other words, it is nothing more than that the lower limit of the thickness ratio is however small setting is feasible and the upper limit is roughly how much recycled plastic can be used while preventing exposure of the inner layer during deburring, it is not that there is an exceptional basis for the numbers themselves.

In this manner, with no consideration for weld margin and simply specifying only the thickness ratio of the inner layer and outer layer plastic layers, the scope of the configuration layers A, B and relative thickness C of the inner and outer layers of the present invention has no meaning regarding the discussion of whether or not the inner layer is exposed."

(2) Court decision

"Based on the configuration requirements of the present invention and disclosure in the detailed description field of the present invention in the specification, if one of the conditions of configuration layers A, B or C are satisfied, it is clear that the problem with layer in question will be thus resolved; therefore, the assertion described above of the plaintiff regarding the configuration requirements of the present invention can not be used.

The plaintiff asserted that depending on how the ratio of thickness of weld margin set beforehand and window material was taken that the ratio of inner layer and outer layer as a condition for not exposing the inner layer during deburring could be achieved in any number of ways so that only specifying the ratio of the thickness of the inner layer and outer layer plastic thickness as in the present invention would not enable preventing seeing the inner layer during deburring; that the present invention was inexplicable when viewed from a technical common sense perspective; that nothing is specified other than the condition described above so that the effect stated in the specification could not be achieved by the present invention and that there was description deficiency in

the specification.

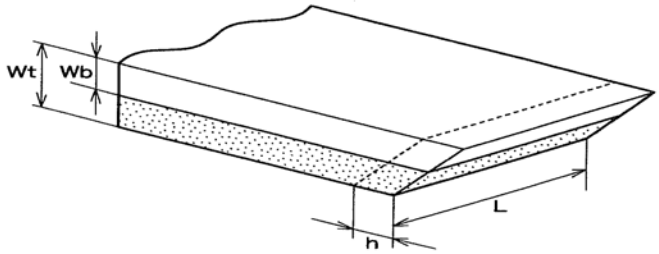
Still, the case of heating and welding two resin based window frames made up of two layers, an inner and outer as in the cited literature or the present invention, setting of the weld margin high lead to improving strength of the weld while increasing likelihood of outflow of the inner layer as a burr and setting weld margin low reduced joint strength based on welding but reduced likelihood of exposure of the inner layer as a burr was technical common sense by a person skilled in the art at the time of the application of the present invention. Furthermore, in addition, in the case of the above, it could also be said that thin configuring of the outer layer increasing likelihood of exposing the inner layer as a burr and thick configuring of the outer layer decreased the likelihood of exposure of the inner layer as a burr was technical common sense to a person skilled in the art at the time of application of the present invention (for the above see A 17, B 1, 3, 4 and 5; in particular B 5 reference drawings 1 to 6).

When premised on the technical common sense of a person skilled in the art, in the case that if a fixed number regarding the ratio of the external layer part relative to the overall thickness as shown by the condition of the present invention according to difference 3 is provided, it can not be said that setting the weld margin to a range where the inner layer would not be exposed by deburring would be in particular difficult to a person skilled in the art. It would be feasible and the condition of the present invention according to difference 3 has a lower limit set with regards to the thickness of the outer layer part so is at all times premised on existence of a fixed weld margin and it is clear that if the weld margin is small that joint strength would not be immediately lost.

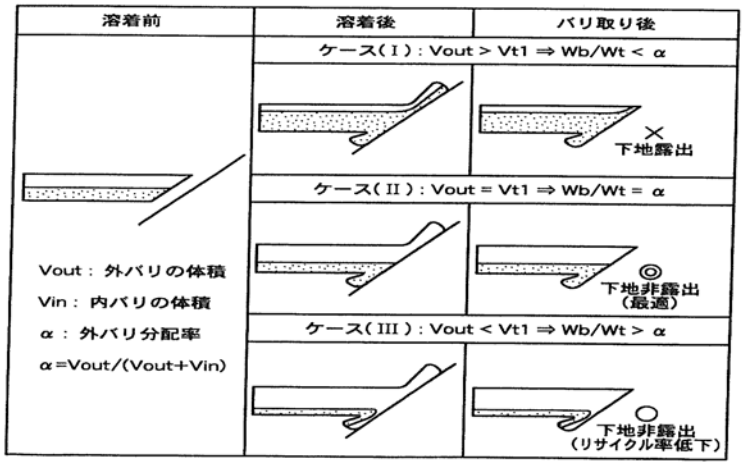
Therefore, with the technical common sense regarding welding, the present invention can be implemented with appropriate consideration to the amount of weld margin by a person skilled in the art, it is understandable from a technical standpoint enabling obtaining the effect described in the specification. Furthermore, the description of the patent claims for the present invention are clear for the present invention (patent law article 36, paragraph 6, section 2) and the description of the invention details in the specification provide a sufficient description that is clear enough for implementation by a person skilled in the art (patent law article 36 paragraph 4 prior to revision based on regulation 24 of 2002) so deficiency of the specification is not recognized and there are no mistakes regarding judgment for this issue.”

Fig8

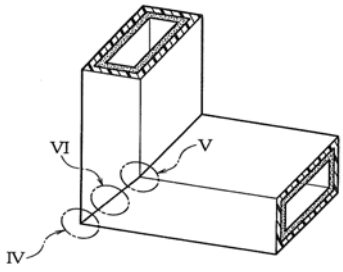
【参考図1】



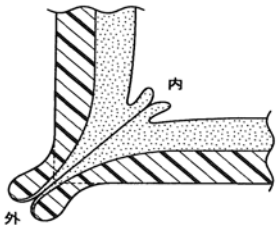
【参考図2】



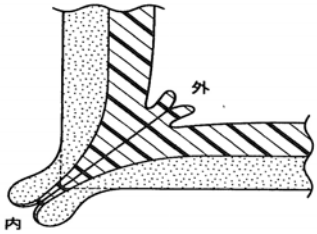
【参考図3】



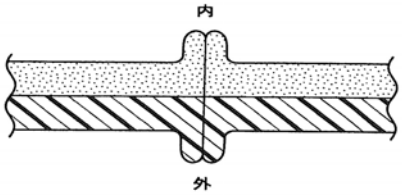
【参考図4】
(乙部分)



【参考図5】
(甲部分)



【参考図6】
(丙部分)



(3) Consideration

The reference drawings 1 to 6 (Fig. 8 that was not in the drawings attached to the initial application specification) submitted by the rights holder (defendant) during the trial process are thought to be beneficial in describing the technical meaning of the present invention to the appeal examiner and to the judge. It would have been good if the details corresponding to these reference drawings 1 to 6 (Fig. 8) had been described in the drawings attached to the initial application specification. However, there was text suggesting the technical items shown in reference drawings 1 to 6 (Fig. 8) in the initial application specification and it is thought that this is why the assertion based on reference drawings 1 to 6 (Fig. 8) was recognized.

With regards to mechanical and structural related inventions, with regards to reasons for rejection, in the case that violation of law article 36, paragraph 6 section 2 and section 4 is identified, use of figures to describe the technical meaning of the present invention in an opinion document so that it is easy to understand is effective.

In addition, in trial decision and judgment, there is a trend towards consideration for the issue of the invention and purpose of the invention in the specification and not just description of the patent claims in interpreting the invention details. With regards to handling relative to reason for rejection, it is important to consider the issue of the invention and purpose of the invention in the specification for rebuttal. In the case of the judgment incident as described above, the text "at least one" noted in the patent claims becomes one of the issues where the plaintiff attacked the expression "at least one" as including prior art that has the same ratio around the whole circumference but in the trial decision and judicial decision, through consideration of the issue of the invention and purpose of the invention in the specification of the invention, based on differentiation of the technical concept of the invention, an inventive step of the invention with respect to cited literature was recognized.

Furthermore, with regards to rebuttal of description deficiency, rebuttal based on quotes of examination standards, trial decision precedents, and judgment precedents is effective.

For example, in the case of a problem that a correction is a new item, rebuttal with quotes from examination standard examples where there was no new item added, such as the solder resist (excluding claim) item judgment (Intellectual Property High Court May 30, 2008 major collegiate decision Heisei (line number)

No. 10563) or the high insulation highly air tight numerical range added correction incident (2009 (line number) 10175) is beneficial.

2.2.2 Law article 36 paragraph 6 section 1 (including law article 39 section 2) violation handling example

(1) Reason for rejection

"A. The invention according to the following claims in this application were deemed to be the same as the invention according to the following application applied for on the same day and the invention according to the following application has been patented and discussions are not feasible so based on stipulations of patent law article 39, paragraph 2, this can not be patented.
B. The description of the patent claims in this application do not satisfy the requirements stipulated in patent law article 36 paragraph 6 section 1.

Note

Reason A

• Claims 3, 10

Remarks:

Japanese Patent Application No. 2007-84990 (hereafter "Application A") was applied for on the same day as the present application and setting was already registered.

Furthermore, there are no differences between the invention according to claim 10 of the present application and the invention according to claim 3 of application A. While the invention according to claim 3 of the present application and the invention according to claim 3 of application A are in different invention categories from an expression standpoint, there are no practical differences in the configuration.

Reason B

• Claims 1, 2, 4-9, 11-14

Remarks:

Regarding the invention according to claims 1, 2, 4-9, 11-14, the "mark is partitioned by mesh" is not specified.

However, the item substantially described in the detailed description of the invention in the specification is accurate detection of the center of gravity position of the mark in the case that the mark is partitioned by mesh and is not a description for other cases.

Therefore, the invention according to claims 1, 2, 4-9, 11-14 is not described in

the detailed description of the invention.」

(2) Response

(2-1) Regarding Rejection Reason of Law Article 39 Paragraph 2

By correcting claims 3 and 10, the assertion that the invention according to claim 3 and 10 was a substantially different invention (invention corresponding to broader term) than the invention according to any of the claims of Japanese Patent Application 2007-84990 was recognized.

(2-2) Regarding Rejection Reason of Law Article 36 Paragraph 6 Section 1

Rebuttal based on examination standard and judicial example quotes was recognized.

The examination standard regarding law article 36, paragraph 6, section 1 is described as follows.

The decision regarding whether the description of patent claims conforms to patent law article 36 paragraph 6 section 1 is performed by comparing and investigating the invention according to the claims and the description of the invention in the detailed description of the invention.

The comparison and investigation is not caught up in simply checking consistency of expression in the invention according to the claims and the description as the invention in the detailed description of the invention but examines the substantial compatibility relationship. If simple expression conformity is understood to be sufficient then this would lead to generation of rights for inventions not substantially publicized and this would be against the meaning of this provision.

The examination of substantial compatibility relationship is performed by investigating whether or not the invention according to the claims exceeds the scope described such that a person skilled in the art is able to recognize how to resolve the issue of the invention in the detailed description of the invention. In the case it is determined that the scope described such that a person skilled in the art can resolve the issue of the invention is exceeded, the invention according to the claims and the description as the invention in the detailed description of the invention can not be said to substantially correspond and this violates patent law article 36 paragraph 6 section 1 specification.

●●●Omission●●●

(Points of concern)

(i) Examination of patent law article 36 paragraph 6 section 1 proceeds through investigating the description in the detailed description of the invention based on what is specified in the claims as the patent by the applicant attempting to receive the patent.

(ii) The claims can be extended or generalized regarding one or a plurality of specific examples described in the detailed description of the invention. The level of extension that does not exceed the scope described in the detailed description of the invention differs depending on the characteristics of each technical industry and the appropriate scope is determined for each case. Keep in mind that this judgment should not be caught up in specific examples and should not be more restrictive than necessary.

(iii) When referring to technical common sense at the time of application, if it is judged that the content disclosed in the detailed description of the invention can not be extended or generalized to the scope of the invention according to the claims, the examiner will explain the reasons it is thought that extension or generalization is not feasible by showing the basis for this judgment.

(iv) If the means for resolving the issue of the invention is not reflected in the claims and as a result it is judged that a patent that exceeds the scope of the description in the detailed description of the invention has been applied for, the examiner will show the issue and resolution means of the invention described in the detailed description of the invention, describe the reasoning, and enable the applicant to understand the direction for correcting to avoid the reason for rejection. Note, in the case that a plurality of issues are described in the detailed description of the invention, means corresponding to at least one of these issues must be reflected in the claims.

Furthermore, the following description is provided as applicant support related to examples 1 to 4 of law article 36 paragraph 6 section 1.

"Loading and executing a specific protocol conversion program is the only specific thing disclosed as data format conversion means in the detailed description of the invention but the issue of the invention is achieved through converting data format so there is no need to restrict to a specific item regarding data format conversion means.

Furthermore, for this application, rebuttal also quoted other judgment examples (2010 (line number) no. 10221, 2009 (line number) no. 10134, 2007 (line number) no. 10403).

In other words, “with regards to whether or not the description in the scope of

patent claims satisfies the requirements described above, the description of scope of patent claims and the description in the detailed description of the invention are compared and investigation and judgment should be performed as to whether the invention described in the patent claims is a scope recognized as enabling a person skilled in the art (a person with general knowledge of the technical industry related to the invention) to resolve the issue of the invention or if description or suggestion is not present, whether the scope is recognized as enabling a person skilled in the art to resolve the issue of the invention in light of technical common sense at the time of the application."

Here, in following the guideline of this judgment, investigation was performed on this patent application and it was asserted that "the description of the invention at least suggests the feasibility of application to a mark that is separated using a method other than mesh".

(3) Consideration

(3-1) Law article 39 rejection is relatively easily resolved based on correction but care should have been taken regarding the original application at the time of the divisional application. In the original application, with substantially the same expression, singularity was achieved for the device claims and the method claims but when the device claims are divided, there is possibility of article 39 paragraph 2 violation.

(3-2) It is thought that care regarding the expression for the description of the Issue the Invention Intends to Resolve is needed to prevent violation of article 36 paragraph 6 section 1. It is better not to include any description other than the purpose of the invention for this item. The reason being if problems with prior art are described, the emphasis of the examiner regarding "should be divided using mesh" may have been validated and assertion that there is no article 36 paragraph 1 section 1 violation may have become more difficult. In the examination standard as the wording "enabling resolution of the issue of the invention" is used, with regards to the relation with this wording, describing the Issue the Invention Intends to Resolve in too narrow a manner in the specification may lead to a requirement of limiting the scope of claims due to violation of article 36 paragraph 6 section 1.

Furthermore, it is better not to narrowly describe the purpose of the invention. This is because if "the center of gravity position for even marks divided by mesh

can be detected" was described in this item, the assertion by the examiner of "should divide using mesh" would be validated which may have made assertion of no violation of article 36 paragraph 1 section 1 difficult.

(3-3) Care should have been taken regarding description in the embodiments and working examples. Description similar to as another embodiment, "the present invention can also be applied to normal marks" should have been added. It was thought that description of well know items was not needed and this was not described. Peace of mind was achieved through description in the item means to resolve issues and the description of other embodiments was insufficient.

2.3 Interaction example regarding rejection of establishment requirements of the present invention (law article 29 paragraph 1 introductory clause)

2.3.1 Reason for rejection

“The invention according to the following claim in this application does not satisfy the requirements specified in the patent law article 29 paragraph 1 introductory clause according to the following points and therefore the patent can not be upheld.

Note

The invention according to claims 1 to 11 is related to a rehabilitation method for tinnitus for providing relief to patients suffering from tinnitus hindrance symptoms and so corresponds to a ’method for treating people’.

Furthermore, the invention according to claim 15 includes a process of receiving data shown in a hearing diagram of a patient suffering from tinnitus from a user online and a process of sending required equalization response data to the user and so corresponds to a "method for diagnosis of people" and ’method for treating people”.

Therefore, the invention according to claims 1-11 and 15 is not an invention that can be used in industry and therefore does not correspond to an invention specified by patent law article 29 paragraph 1 introductory clause.”

2.3.2 Rejected Claim

"Claim 1
A tinnitus rehabilitation method that provides relief to patients suffering from tinnitus hindrance symptoms comprising,
a step of providing an acoustic signal change spectrally based on an algorithm for a prescribed mask designed to change the acoustic signal at selected frequencies,
and upon use, when the patient listens to the spectrally changed acoustic signal, provides superior tinnitus masking."

2.3.3 Claim patented through correction

"Claim 1
An acoustic signal formation method for sending a stimulus to the hearing system of an individual that has tinnitus or hyperacusis using an acoustic signal formation device, comprising
a step of inputting an acoustic signal with peaks and valleys,
a step of generating a prescribed mask algorithm that changes the strength of the acoustic signal for the selected frequency to provide tinnitus intermittent masking based on the hearing ability measurement information of the individual to obtain a required equalization response that is a response that supplies a relatively equal sensation level across all frequencies,
a step of spectrally changing the acoustic signal based on the prescribed mask algorithm, of providing this spectrally changed acoustic signal for tinnitus masking to the individual through substantial weakening of tinnitus heard at peaks by the individual and the acoustic signal is spectrally changed so that the individual perceives the acoustic signal as tinnitus at what were heard as valleys."

2.3.4 Consideration
Rehabilitation method was corrected to "acoustic signal formation method" while in addition, signal conversion details were added and through emphasis that this was a usage method of an acoustic signal formation device and not applicable to a treatment method or diagnostic method, rights were upheld. With "tinnitus rehabilitation method" as-is, it would be judged as not corresponding to an invention specified by patent law article 29 paragraph 1 introductory clause so in addition to correcting the claims, emphasis of inapplicability to treatment

methods or diagnostic methods enabled the patent being upheld.

Furthermore, with regards to the present invention, as shown in Fig. 9, it is thought that "use of natural laws" may have been recognized for the point of signal conversion weakening tinnitus during peaks of the acoustic signal and strengthening tinnitus at the valleys of the signal. With regards to this case, at the time of the second reason for rejection a request was made for correcting "signal formation device" as the subject because "a method with a person as the subject can not be protected". This is somewhat connected to the Bilski incident in the US (CAFC grand bench judgment of October 30, 2008, machinery/conversion test supreme court ruling on June 28, 2010).

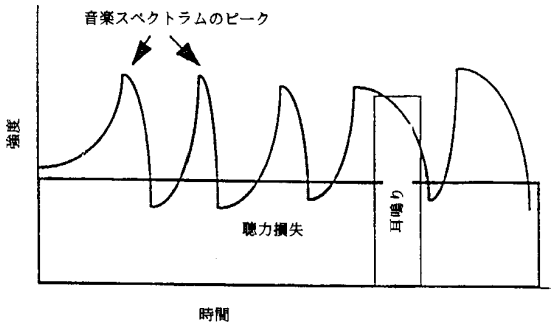


Fig. 9

FIG. 3.

3. Conclusion

With regards to mechanical and structural related inventions, in the case of receipt of a notification of reason for rejection, final rejection, or patent invalidation judgment, I recommend comparing the invention described in the present application drawings and the invention described in the drawings of the cited literature, list the differences and thoroughly investigate whether the differences show up in the scope of patent claims of the present application. With the scope of patent claims at the initial application, from the perspective of desiring to broaden scope of rights, there are cases where a broad scope including prior art of cited literature is used. In this type of case, making corrections to clarify differences with cited literature and thoroughly emphasizing differences with cited literature from a configuration standpoint and differences from an operation effect standpoint in an opinion document is favorable.

However, while performing a correction making sure that the scope of rights does not become too narrow, describe differences between the present

invention and the invention in cited literature in an opinion document or the like. In an infringement lawsuit after patent, with regards to that emphasized in an opinion document, the principle of bandage estoppel is applied where unless there is a logical reason, emphasis of content differing from the opinion document is difficult in an infringement lawsuit and there are cases where rights interpretation is based on the content of the opinion document.

Therefore, in order to achieve rights with a broad state of scope of rights, it is preferable to not perform a correction and to not emphasize the operation effect of the present invention such as in an opinion document; however, in this case it is difficult to get the examiner to uphold the patent. Rights are upheld based on the relationship with the cited literature but care must be taken regarding corrections and opinion documents to prevent the scope of rights from becoming too narrow. Here, an interview with the examiner and support of a divisional application are effective. Interview records with an examiner are kept but they are simple items and it is not that all details discussed with the examiner are described so application of a bandage estoppel based on discussed content will not occur. Furthermore, in the case of rights being upheld with a too narrow scope, investigation of performing a divisional application using a patent claim scope of broad rights scope is favorable.

Updated: August 20, 2014