

Circuit-connecting Material Case
IP High Court
CASE 2008(Ne) 10096(January 28, 2009)

SUMMARY

In determining inventive step (non-obviousness) of an invention, the relevant features of the invention must be evaluated in view of the technical problem to be solved. Inventive step may not be denied just because it is presumed that a person skilled in the art might have endeavored to reach the invention. In order to deny inventive step, some suggestion or the like must be found in a cited reference that would cause a person skilled in the art to endeavor to reach the invention.

FACTS

The plaintiff is the applicant of a patent application A, which relates to circuit-connecting material. Appealing a decision of final rejection of Application A, the applicant amended claim 1. The amended claim 1 relates to circuit-connecting material that includes, as one of the requisite constituent elements of the material, bisphenol F-type phenoxy resin.

The Board of Appeal of the Patent Office (“the Board”) cited Reference 1, which discloses circuit-connecting material that includes, as one of the requisite constituent elements of the material, bisphenol A-type phenoxy resin. The Board also found that the other constituent elements of Reference 1 are substantially identical to those of claim 1.

The Board concluded that it would have been obvious for a person skilled in the art to try to employ bisphenol F-type phenoxy resin instead of bisphenol A-type phenoxy resin for the purpose of improving compatibility and adhesiveness of the circuit-connecting material, and found that the invention recited in the amended claim 1 was obvious. The Board thus refused to enter the amendment of claim 1, and issued a final rejoinder of the application. The plaintiff filed a lawsuit seeking cancellation of the Board’s decision.

ISSUE

Did the Patent Office err in determining that the claimed invention was obvious in view of the cited reference?

HOLDING AND REASONING

(1) To determine objectively whether the invention includes inventive step or not, it is necessary to correctly understand the features of the invention as compared to the cited

references. In order to correctly understand the features of the invention, it is essential to correctly understand the problem to be solved by the invention. Presumption that a person skilled in the art could try to reach the invention is not enough to prove a lack of inventive step. There must be suggestion or the like in a cited reference that would cause a person skilled in the art to endeavor to reach the invention.

(2) In the claimed invention of this case, bisphenol F-type phenoxy resin is used as constituency of the circuit-connecting material in order to improve reliability in connection of the circuit, as well as to improve reparability. On the other hand, cited Reference 1 does not refer to the problems of compatibility and adhesiveness. In addition, there is no evidence that proves that bisphenol F-type phenoxy resin is well-known as being good for improving reliability in connection and for improving the reparability of circuit-connecting material. There are various factors to be considered for choosing and adjusting the constituency of circuit-connecting material, such as heat resistance, insulation, viscosity, and rigidity. Among these factors, suggestion for focusing especially on compatibility or adhesiveness and employing bisphenol F-type phenoxy resin is not found in the cited reference. Furthermore, bisphenol F-type phenoxy resin is inferior in heat-resistance, which makes it difficult to employ it as an element of the circuit-connecting material.

(3) In view of the above factors, the IP High Court concluded that the Board of Appeal erred in determining that the invention was obvious. The decision should be cancelled.