

Date	October 25, 2017	Court	Intellectual Property High Court First Division
Case number	2016 (Gyo-Ke) 10092		
– A case in which, with respect to a patent for an invention titled "dispersion composition, cosmetic preparation for skin care and method for producing dispersion composition," the court maintained the JPO decision that dismissed a request for an invalidation trial, on the grounds that there are no errors in the JPO's conclusion that the patent cannot be invalidated.			

Reference: Article 29, paragraph (2) of the Patent Act

Number of related rights, etc.: Invalidation Trial No. 2015-800026, Patent No. 5046756

Summary of the Judgment

1. The defendant holds a patent right for an invention titled "dispersion composition, cosmetic preparation for skin care and method for producing dispersion composition" (Patent No. 5046756; the "Patent"). In response to a request for an invalidation trial filed by the plaintiff (Invalidation Trial No. 2015-800026) with regard to the inventions stated in Claims 1 to 4 of the Patent (referred to as "Invention 1" or the like respectively and the "Invention" collectively), the JPO made a decision to dismiss this request.

2. The primary cited inventions relating to the major points discussed in this judgment are: Cited Invention 1 (the invention disclosed on the website of Yugen Kaisha Hisamitsu Kobo, which featured a product "f²i Infiltrate Serum Wrinkle Essence" that was put on sale on January 15, 2007; accessed as of June 14, 2007; "Exhibit Ko 1 Webpage"); and Cited Invention 5 (the invention disclosed in a catalogue of "Astaxanthin ver. 1.0 SM" (Oryza Oil & Fat Chemical Co., Ltd.; product specification formulated on May 25, 2006, "Product name: Astaxanthin-LSC1, cosmetics") (Exhibit Ko 5 Document)).

The JPO determined that the Patent cannot be invalidated because the Invention cannot be regarded as one that a person ordinarily skilled in the art could have easily made based on the cited inventions.

3. In this judgment, the court dismissed the plaintiff's claim, holding as summarized below with regard to the determination made by the JPO on whether a person ordinarily skilled in the art could have easily conceived of the Invention by referring to Cited Inventions 1 and 5 as the primary cited inventions, and ruling that there are no errors in the JPO's conclusion that the Invention cannot be regarded as one that a person ordinarily skilled in the art could have easily made based on the cited

inventions.

(1) Determination as to whether it was easy for a person ordinarily skilled in the art to conceive of the Invention based on Cited Invention 1

On Exhibit Ko 1 Webpage, a description that reads "This product has similarity to all ingredients of the following products" was posted, followed by the list of product names containing: "Astalift Essence (Fujifilm)"; "Astalift Lotion (Fujifilm)"; and "Astalift Cream (Fujifilm)." It is found that all these listed products were featured in the news release dated July 10, 2007, and put on sale on September 12, 2007, and that the information on these listed products posted on Exhibit Ko 1 Webpage was prepared based on the information registered on the website "Cosmetic-Info.jp" (information on products available on the market and their publicly disclosed ingredients). These findings demonstrate that the products featured in the news release and put on sale after the filing date of the application for the Patent, June 27, 2007, were posted on Exhibit Ko 1 Webpage, and therefore, the information on all ingredients of "f²i " posted on Exhibit Ko 1 Webpage cannot be found to have been made publicly available through an electric telecommunication line prior to the filing date of the application. Thus, as it turned out, the Invention cannot be regarded as one that a person ordinarily skilled in the art could have easily made based on Cited Invention 1, and hence, there are no errors in the JPO's conclusion that the Patent cannot be invalidated based on Reason for Invalidation 2 alleged by the plaintiff.

(2) Determination as to whether it was easy for a person ordinarily skilled in the art to conceive of the Invention based on Cited Invention 5

The Invention aims to provide a dispersion composition with excellent preservation stability and a cosmetic preparation for skin care using that composition, by mixing a water dispersible matter, which is an O/W emulsion containing a carotenoid-containing oily ingredient and having emulsion particles, with a water-based composition containing ascorbic acid or its derivative, and setting the pH level at 5 to 7.5, so that both the dispersion stability of the carotenoid-containing oily ingredient and the color stability of carotenoid can be maintained in good condition. On the other hand, Cited Invention 5 is not a substance that can be used as a cosmetic product per se but it is an emulsion composition to be used as raw material for a cosmetic product, and hence, it cannot be regarded as a cosmetic preparation for skin care per se.

Accordingly, even though setting the pH level within the range between low acidity and low alkalinity (Exhibits Ko 3-1 to 3-6) is common general technical knowledge in relation to cosmetic preparations for skin care, since what is disclosed in

Exhibit Ko 5 Document is an "emulsion composition" to be used as raw material for a cosmetic product and Cited Invention 5 is not a cosmetic preparation for skin care per se, it must be said that said common general technical knowledge cannot be directly applied to Cited Invention 5. Consequently, it is difficult to find that Cited Invention 5 provides a motivation to adopt the structure of Invention 1 involving Difference 2.

Furthermore, Exhibit Ko 5 Document does not disclose anything about the preservation stability and other properties of a "cosmetic preparation for skin care," nor can it be understood as containing any statement or suggestion that provides a motivation to make Cited Invention 5 into a "cosmetic preparation for skin care" by adding "magnesium ascorbyl phosphate" to it and using only polyglyceryl fatty acid ester as an emulsifier, and then adopt the structure of Invention 1 involving the difference between these inventions, that is, setting the pH level of the cosmetic preparation for skin care thus made at "5.0 to 7.5," which is within the range "between low acidity and low alkalinity." Therefore, even a person ordinarily skilled in the art would need to make a special effort to adopt the structure of Invention 1. In that case, it cannot be found that a person ordinarily skilled in the art could have easily adopted the structure of Invention 1 involving that difference for Cited Invention 5, which is an emulsion composition to be used as raw material for a cosmetic product.

For the reasons given above, it can be concluded that there are no errors in the JPO's determination that said difference cannot be regarded as a matter that a person ordinarily skilled in the art could have easily adopted.

Invention 1 cannot be deemed to be one that a person ordinarily skilled in the art could have easily made based on Cited Invention 5. Therefore, there are no errors in the JPO's determination to the same effect, and Ground for Rescission 2 alleged by the plaintiff is unacceptable.