Patent Right	Date	May 31, 2021	Court	Intellectual Property High Court, Third Division
	Case number	2020 (Gyo-Ke) 10092		
- A case in which the court, in determining whether a person skilled in the art could have easily conceived of the configuration of the Invention relating to a difference, found that the configuration in question could not have been arrived at even if the statement of the claims is interpreted by taking into consideration the statement of the description and if the technical matters described in the secondarily cited reference are applied, and held that the JPO decision, which determined the Invention to lack an inventive step, was erroneous.				

Case type: Rescission of Appeal Decision of Refusal
Result: Granted
References: Article 29, paragraph (2) of the Patent Act
Related rights, etc.: Patent Application No. 2018-539447
Decision of JPO: Appeal against Examiner's Decision of Refusal No. 2019-1287

Summary of the Judgment

1. This case is a lawsuit to seek rescission of the JPO decision to maintain the examiner's decision of refusal that was rendered in an appeal against examiner's decision of refusal with regard to an invention in question (the "Invention") comprised in an invention titled "Microneedle patch and packing material for same."

In the JPO decision in question (the "JPO Decision"), the JPO determined that a person skilled in the art could have easily conceived of the difference between Cited Document 1 (International Publication No. 2011/148994) and the Invention by applying the technical matters described in Cited Document 2 (International Publication No. 2004/108112), and concluded that the Invention lacks an inventive step.

The Plaintiff alleged that the JPO erred in the determination of the difference as a ground for rescission.

2. In this judgment, the court held as follows and rescinded the JPO Decision.

(1) In the configuration of the Invention relating to the difference, the meaning of an "oil gel sheet adhesive to the skin" should be interpreted as a "sheet that adheres to the skin due to the adhesiveness of gelled oil instead of the adhesiveness of an acrylic adhesive, etc." by taking into consideration the statement of the relevant description.

Since the "oil-based gelatinous adhesive preparation" described in Cited Document 2 adheres to the skin due to the adhesiveness of an acrylic adhesive, its technical meaning

differs from that of the "oil gel sheet adhesive to the skin" of the Invention.

Consequently, as the configuration of the Invention relating to the difference cannot be arrived at even by applying the technical matters described in Cited Document 2, there is an error in the determination made in the JPO Decision.

(2) The Defendant (the JPO Commissioner) alleges that, because there is common general technical knowledge that "oil gel" is a generic term for a gel that uses an organic solvent as solvent and there is no statement in the relevant description about the meaning or composition of the "oil gel" of the Invention, the term should be interpreted according to the common general technical knowledge, and that the "oil-based gel" described in Cited Document 2 is included in "oil gel" according to the common general technical knowledge.

Indeed, according to evidence, it is found to be generally accepted to categorize "gel" into three types, namely "hydrogel," "oil gel," and "xerogel," from the viewpoint of the difference in the fluid (solvent). On the other hand, however, there is also a document in the cosmetics field that uses the term "oil gel" to mean an "organic solvent (oil) that has been made solid or semisolid by using a small amount of solidifying agent." Therefore, it cannot be concluded that the term "oil gel" is automatically used in the meaning alleged by the Defendant.

It follows that the technical meaning of the "oil gel" of the Invention is not unambiguously clear from the statement of the claims alone. Thus, the "oil gel sheet" should be interpreted as a "sheet that adheres to the skin due to the adhesiveness of gelled oil instead of the adhesiveness of an acrylic adhesive, etc." as mentioned in (1) above, by taking into consideration the statement on prior art and the statement on the problem to be solved from among the statements in the detailed explanation of the invention in the description.

Consequently, the Defendant's abovementioned allegation is unacceptable.

Judgment rendered on May 31, 2021
2020 (Gyo-Ke) 10092, Case of seeking rescission of the JPO decision
Date of conclusion of oral argument: April 21, 2021

Judgment

Plaintiff: Nissha Co., Ltd.

Defendant: Commissioner of the Japan Patent Office

Main text

1. The decision made by the Japan Patent Office (JPO) on June 18, 2020, concerning the case of Appeal against Examiner's Decision of Refusal No. 2019-1287 shall be rescinded.
2. The Defendant shall bear the court costs.

Facts and reasons

No. 1 Claim

Same as the main text.

No. 2 Outline of the case

1. Outline of procedures at the JPO

(1) The Plaintiff filed an application for an invention titled "Microneedle patch and packing material for same" with the filing date of the international application being February 28, 2018 (country claiming priority: Japan on May 30, 2017), but received the examiner's decision of refusal as of November 9, 2018. Therefore, the Plaintiff requested a trial seeking rescission of this decision made by the JPO (Appeal against Examiner's Decision of Refusal No. 2019-1287) on January 31, 2019, and also amended the scope of the claims and other matters.

(2) The JPO made the decision to maintain the examiner's decision of refusal on June 18, 2020, and a certified copy of the decision was served to the Plaintiff on July 7, 2020. The Plaintiff filed this lawsuit on August 5, 2020.

2. Invention

The invention stated in Claim 2 after the aforementioned amendment (hereinafter referred to as the "Invention") is as stated below.

"A microneedle patch
that has an oil gel sheet on which oil gel containing an oil-soluble component is applied to the support base and which is adhesive to the skin,

a sheet-shaped base that is affixed over the area excluding the periphery of the aforementioned oil gel sheet,
and multiple microneedles formed on the aforementioned sheet-shaped base."
3. Summary of the grounds for the JPO Decision
A summary of the judgment related to issues in this case among the grounds for the JPO Decision is as stated below.
1. Cited Invention, etc.
(1) Cited Document 1 (International Publication No. 2011/148994) states the following invention (hereinafter referred to as the "Cited Invention").
"a device 20 that has an array 1 with micro projections,
which is equipped with a holding means 21 on which an adhesive agent layer 21b is laminated over the entire surface of a support base 21a and which applies an array 1 with microneedles to the skin for a specified duration,
a base 2 that is secured at the center of the aforementioned holding means 21,
and
multiple micro projections 3 that are aligned in a biodimensional manner on the aforementioned base 2.
(2) Cited Document 2 (International Publication No. 2004/108112) states the following technology (hereinafter referred to as the "Cited Technology 2").
"(it is) an oil-based gelatinous adhesive preparation on which a transdermal agent, ceramide, is dissolved and a topical skin adhesive sheet preparation where said oil-based gelatinous adhesive preparation is laminated onto the base material, and an oil-based gelatinous adhesive preparation that has appropriate adhesiveness to the skin but causes no damage to skin corneocytes when removing it and a topical skin adhesive sheet preparation where said oil-based gelatinous adhesive preparation is also laminated onto the base material."
2. Comparison
The Invention and Cited Invention are consistent in the following points:
"A microneedle patch
that has an adhesive sheet on which adhesive materials are applied to the support base and which is adhesive to the skin,
a sheet-shaped base that is affixed over the area excluding the periphery of the aforementioned adhesive sheet,
and multiple microneedles formed on the aforementioned sheet-shaped base."
and they are different regarding the following points.
[Difference]
Concerning an adhesive sheet on which adhesive materials are applied, in the Invention, it

is an oil gel sheet on which an oil gel containing an oil-soluble component is applied; however, in the Cited Invention, it is a holding means 21 on which an adhesive agent layer 21b is laminated and it is not clear whether the adhesive agent layer 21b is an oil gel containing an oil-soluble component.

3. Determination regarding the difference

Cited Document 2 states that an oil-based gelatinous adhesive preparation which contains an oil-soluble component, ceramide, is used as the adhesive of a topical skin adhesive sheet for cosmetic use, in order to avoid damage to skin corneocytes when removing the sheet from the skin while maintaining appropriate adhesiveness to the skin.

Both the Cited Invention and Cited Technology 2 have commonality in that they belong to the technology field of a sheet-shaped device for cosmetic use and have the same issue of controlling damage to skin corneocytes. Therefore, a person skilled in the art could have easily conceived of adopting an oil-based gelatinous adhesive preparation containing ceramide, which is an oil gel containing an oil-soluble component, as stated in Cited Document 2 in lieu of an adhesive agent layer 21b and using a structure related to the aforementioned difference.

In addition, the effects of the Invention are only in the range expected from the effects of the Cited Invention and Cited Technology 2 and cannot be considered as being exceptionally significant.

Consequently, a person skilled in the art could have easily arrived at the Invention based on the Cited Invention and Cited Technology 2.

(omitted)

No. 6 Judgment of this court

1. Concerning the "oil gel sheet which is adhesive to the skin" in the Invention, the issue in this case is the meaning of "an adhesive sheet on which adhesive materials are applied" out of the differences found by the JPO Decision. Therefore, this case is examined with a focus on this point.

(1) The description in question (the "Description") has the following statements.

A. The Invention is related to a microneedle patch that enables the administration of target substances contained in the microneedles by inserting the microneedles into the skin and that has an adhesive sheet on the back of a microneedle sheet where multiple microneedles are formed on a sheet-shaped base in a manner that the microneedle sheet is not formed on the periphery of the adhesive sheet in order to secure the microneedle sheet on the skin, thereby making it possible to secure the microneedle sheet on the skin by an adhesive layer on the periphery of the adhesive sheet ([0001] [0002]).

B. Conventional microneedle patch as disclosed in Unexamined Patent Application Publication No. 2016-189844 (Exhibit Ko 12) has the following problems: [i] cosmetic effects cannot be obtained from the adhesive layer section that is affixed on the skin; and [ii] when it is affixed on the skin onto which a milky lotion, etc. has been applied, adhesive force of the adhesive layer is weakened due to the grease contained in the milky lotion, etc. and it easily comes off.

The Invention aims to provide a microneedle patch [i] that makes it possible to obtain cosmetic effects also from the section affixed on the skin, and [ii] that does not easily come off even if it is affixed on the skin onto which a milky lotion, etc. is applied. As a means to resolve these problems, the Invention has the following major features: an oil gel sheet containing an oil-soluble component, a sheet-shaped base that is formed in the area excluding the periphery of the oil gel sheet, and multiple microneedles formed on the sheet-shaped base ([0004] [0006] [0007] [0017]). By adopting such structure, the Invention can provide a microneedle patch [i] that makes it possible to obtain cosmetic effects since an oil-soluble component penetrates into the skin also from the section affixed on the skin and [ii] that does not easily come off even if it is affixed on the skin onto which a milky lotion, etc. is applied ([0012] [0017]).

C. "An oil gel is a gel containing an oil-soluble component and has good adhesiveness to the skin." [0017]

(2) In [0032] in Exhibit Ko 12, which is indicated as prior art in the Descriptions, acrylic adhesive agents, rubber-based adhesive agents, silicon rubber-based adhesive agents, vinyl ether-based adhesive agents, polyurethane agents, and other items are listed as examples of adhesive agents. However, according to the statement in (1) B. above, these adhesive agents are found to have the problems indicated in [i] and [ii] above which a conventional microneedle patch had, in particular, the problem indicated in [ii] above that adhesive force is weakened due to the grease contained in the milky lotion, etc.

(3) According to the statements in (1) A., B., and (2) above, in cases of using an acrylic adhesive agent, etc. as an adhesive layer of a microneedle patch, there are the following two technical problems: [i] cosmetic effects cannot be obtained from the adhesive layer section and [ii] the patch can easily come off when it is affixed to the skin onto which a milky lotion, etc. is applied; and the technical idea of the Invention (principle to resolve the problem) is found to resolve the aforementioned two technical problems by using an oil gel sheet containing [i] an oil-soluble component that penetrates into the skin and can give cosmetic effects and [ii] oil that can be easily mixed with the grease contained in a milky lotion, etc., as the main component.

In addition, according to the statement in (1) C. above, the "oil gel" as used in the Invention does not have to contain an "adhesive agent" as stated in Exhibit Ko 12, but only needs to have good independent adhesiveness to the skin.

In consideration of these statements comprehensively, in the Invention, the "oil gel sheet"

should be interpreted as "a sheet that adheres to the skin due to the adhesiveness of gelled oil instead of the adhesiveness of an acrylic adhesive agent, etc."

2. "Oil-based gelatinous adhesive preparation" in Cited Technology 2

(1) Cited Document 2 has the following statements.

A. The Invention is related to the adhesive composition and adhesive sheet to be used as a topical skin agent, such as cosmetics and topical skin medicine (page 1, line 4 and after).

B. Concerning the development of topical skin adhesive sheet preparations that have the appropriate balance between skin adhesiveness and detachability, oil-based gelatinous adhesive layer preparations with a cross-linked acrylic adhesive agent layer containing a large amount of oil-based liquid components have been proposed. However, it could hardly be said that these preparations were exceptionally excellent in the solubility of their medicinal ingredients and other agents, although the balance between skin adhesiveness and detachability can be improved (page 2, line 21 and after).

C. Concerning the oil-based gelatinous adhesive preparation in the Invention, a specified amount of acrylic copolymerized polymer, non-ionic surface-active agent, and acrylic polymer in specific compositions are cross-linked by an external cross-linking agent. This resulted in obtaining the adhesive composition and adhesive sheets for topical skin agents that are excellent in the solubility of medicinal ingredients and other agents and that have good skin adhesiveness and detachability (page 4, line 18 and after).

(2) According to the statement in (1) above, it is found that the "oil-based gelatinous" "adhesive sheet preparation" as stated in Cited Technology 2 is a sheet where the solubility of agents is increased while maintaining adhesiveness by adjusting the composition of a "cross-linked acrylic adhesive agent," which is prior art as stated in (1) B. above, and the adhesiveness to the skin solely depends on an acrylic adhesive agent, as is the case with prior art.

3. Appropriateness of the determination of the JPO Decision regarding the difference

As stated in 1. (3) above, in light of the technical meaning of the Invention, the "oil gel" as used in the Invention adheres to the skin not by the adhesiveness of an acrylic adhesive agent, etc., but by the adhesiveness of gelled oil. However, the "oil-based gelatinous adhesive preparation " as stated in Cited Technology 2 adheres to the skin by the adhesiveness of an acrylic adhesive agent as stated in 2. (2) above.

In this way, the "oil-based gelatinous adhesive preparation" as stated in Cited Technology 2 has a different technical meaning than the "oil gel" in the Invention. Therefore, even if Cited Technology 2 is applied to the Cited Invention, a person skilled in the art cannot conceive of the structure of the Invention related to the difference.

Therefore, there is an error in the determination of the JPO Decision concerning whether the invention could have been easily conceived of by a person skilled in the art.

4. Allegation of the Defendant

The Defendant alleges that, because there is common general technical knowledge that "oil gel" is a generic term for a gel that uses an organic solvent as solvent and there is no statement in the Description about the meaning or composition of the "oil gel" of the Invention, the term should be interpreted according to the common general technical knowledge, and that the "oil-based gel" stated in Cited Technology 2 is included in "oil gel" according to the common general technical knowledge.

According to Exhibit Otsu 1 (Japan Patent Office, "Shuchi/Kanyo Gijutsu Shu (Koryo) Dai I bu, Koryo Ippan (Well-known and Conventional Arts (Perfumes) Part I General Perfumes)," published on January 29, 1999), etc., it is found to be generally accepted to categorize "gel" into three types, namely "hydrogel," "oil gel," and "xerogel," from the viewpoint of the difference in the fluid (solvent). In Exhibit Otsu 6 (Eishuku Ken, et al., "Jikkoukan wo Hatsugen suru tame no Skin Care Seizai Sekkei (Skin Care Agent Design to Develop Effectiveness), FRAGRANCE JOURNAL Vol.34-No.1. pp.52.-55 (2006)), etc., there are statements indicating adhesive agents of "oil gel" using acrylic materials as a base agent on the assumption of the aforementioned categorization. However, on the other hand, in Exhibit Ko 7 (Shibata Masashi, "Oil Solidification Technology for Cosmetics," J.Jpn. Soc. Colour Mater., 85 [8] 339-342 (2012)), it is stated at the beginning that "Organic solvent (oil) that has been made solid or semisolid by using a small amount of solidifying agent are generally called oil-based gels.... They are mainly used as base for makeup cosmetics and as base for other wide-ranging products." It is found that the term "oil gel" is generally used with this meaning in the field of cosmetics. Therefore, it cannot be concluded that the term "oil gel" is automatically used in the meaning alleged by the Defendant.

It follows that the technical meaning of the "oil gel" of the Invention is not unambiguously clear from the statement of the claims alone. Thus, the "oil gel sheet" should be interpreted as a "sheet that adheres to the skin due to the adhesiveness of gelled oil instead of the adhesiveness of an acrylic adhesive agent, etc." as mentioned in 1. above, by taking into consideration the statement on prior art and the statement on the problem to be solved from among the statements in the detailed explanation of the invention in the Description.

Consequently, the Defendant's abovementioned allegation is unacceptable.

5. Conclusion

As mentioned above, there is an error in the determination of the JPO Decision and this error affects the conclusion. Therefore, the JPO Decision shall be rescinded.

Intellectual Property High Court, Third Division
Presiding judge: TSURUOKA Toshihiko

Judge: UEDA Takuya

Judge: TSUNO Michinori