

Patent Right	Date	January 14, 2020	Court	Intellectual Property High Court, First Division
	Case number	2019 (Gyo-Ke) 10060		
- A case in which, concerning a patent invention titled "METHOD FOR MANUFACTURING SOAP SCRUB", the court held that the invention conforms to the support requirements and the enablement requirements, and is not easily conceived of based on the cited invention.				

Case type: Rescission of Trial Decision to Maintain

Result: Dismissed

References: Article 29, paragraph (1), item (iii) and paragraph (2), and Article 36, paragraph (4), item (i) and paragraph (6), item (i) of the Patent Act

Related rights, etc.: Patent No. 4473278

Decision of JPO: Invalidation Trial No. 2018-800006

#### Summary of the Judgment

1. The present case is a lawsuit filed by Plaintiff, seeking rescission of the JPO Decision which dismissed the Plaintiff's request for a trial for patent invalidation of the Patent Right for the Defendants' invention titled "METHOD FOR MANUFACTURING SOAP SCRUB".

Plaintiff asserted, as reasons for rescission, that the JPO Decision is erroneous in regards to error in judgment on support requirements, error in judgment on enablement requirements, and error in judgment on inventive step.

2. In the judgment of the present case, the court dismissed the Plaintiff's request by ruling as follows.

- (1) Reason 1 for Rescission (error in judgment on support requirements)

It should be said that a person skilled in the art is able to recognize, based on the descriptions of "Problem to be solved by the invention", "Means for solving the problem", and "Effects of the invention" of the Description, that the problem to be solved by Invention 1 is to manufacture a solid or semi-solid soap scrub which has a high cleansing effect while at the same time having an excellent foam-holding property and yet causing little irritation to the skin, and that the means for solving the problem is to adopt a manufacturing method in which a Shirasu Balloon, which is a hollow sphere made from expanded volcanic ash, is immersed in an alkaline solution containing a surfactant so that the alkaline solution is infiltrated into the hollow interior, and then adding a fatty acid to the alkaline solution, thereby forming soap on the exterior of the aforementioned Shirasu Balloon, in addition to forming soap in the hollow

interior as well, the result being a soap scrub which contains volcanic ash but causes little irritation to the skin and furthermore has a controlled release property and a high cleansing effect as well as an excellent foam-holding property.

As such, Invention 1 is described in the detailed explanation of the invention in the Description to the extent that it can be recognized that the problem to be solved by Invention 1 can be solved based on such description. Accordingly, Invention 1 conforms to the support requirements.

(2) Reason 2 for Rescission (error in judgment on enablement requirements)

It is acknowledged to be described in a clear and sufficient manner that allows for implementation of the method, in the Description, that a manufacturing method in which a Shirasu Balloon, which is a hollow sphere made from expanded volcanic ash, is immersed in an alkaline solution containing a surfactant so that the alkaline solution is infiltrated into the hollow interior, and then adding a fatty acid to the alkaline solution, thereby forming soap on the exterior of the aforementioned Shirasu Balloon, in addition to forming soap in the hollow interior as well. Accordingly, the Description conforms to the enablement requirements.

(3) Reason 3 for Rescission (error in judgment on inventive step based on Cited Invention 1)

Exhibit Ko 3 does not contain any description to the effect that a fatty acid is added to an alkaline solution containing a surfactant, so that even if the Technology of Exhibit Ko 3 is applied to Cited Invention 1, it cannot conceive of Difference 1-2.

Furthermore, even if the well-known process of forming soap by adding a fatty acid to an alkaline solution is applied to Cited Invention 1, it cannot conceive of Difference 1-2.

Since Cited Invention 1 concerns a method for manufacturing a soap scrub, and the method involves preparing a potassium soap, which is a soft soap, followed by mixing Shirasu Micro Balloons therein, there is no reason to adopt Difference 1-2. Even if common general technical knowledge is taken into account, it cannot be said, upon applying the Technology of Exhibit Ko 3 or the Well-Known Art to Cited Invention 1, that it was possible to add a Shirasu Balloon to an alkaline solution containing a surfactant, or to change the timing of such addition to either before or after the addition of a fatty acid as is appropriate.

As such, application of the Technology of Exhibit Ko 3 or the Well-Known Art to Cited Invention 1 cannot easily conceive of the structure pertaining to Difference 1-2.

- (4) Reason 4 for Rescission (error in judgment on inventive step based on Cited Invention 2)

Cited Example 2 does not describe anything to the effect that a soap is formed in the hollow interior of a ceramic granulated body, so that there is no motivation for applying the Technology of Exhibit Ko 3 or the Well-Known Art relating to a method for manufacturing soap to Cited Invention 2.

Even if the Technology of Exhibit Ko 3 or the Well-Known Art is applied to Cited Invention 2, it cannot conceive of Difference 2-2.

Accordingly, application of the Technology of Exhibit Ko 3 or the Well-Known Art to Cited Invention 2 cannot easily conceive of the structure pertaining to Difference 2-2.