Appeal decision

Appeal No. 2012-26151

Switzerland
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The case of appeal against the examiner's decision of refusal Japanese Patent Application No. 2008-244190, entitled "Micropigment Mixture" (the application published on April 23, 2009, Japanese Unexamined Patent Application Publication No. 2009-84572) has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reason

No. 1 History of the procedures

The present application is a new patent application filed on September 24, 2008, which is a part of an application (Japanese Patent Application No. 2003-563509) filed on January 23, 2003 as international filing date (Priority Claim under the Paris Convention: January 31, 2002 at the European Patent Office). A notice of reasons for refusal was issued on May 13, 2011. On November 16, 2011, a written opinion and a written amendment were filed. On August 28, 2012, a decision of refusal was issued. On December 28, 2012, appeals against an examiner's decision of refusal and a written amendment was filed at the same time. Inquiry was then made by the body on June 14, 2013. A response letter was filed on September 18, 2013.

No. 2 Dismissal of amendment dated December 28, 2012

[Conclusion of Decision to Dismiss Amendment]

The amendment dated December 28, 2012 is dismissed.

[Reason]

1. Detail of amendment

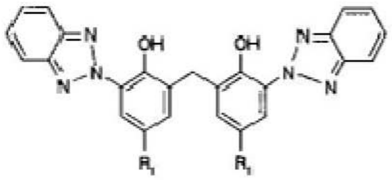
The amendment made by the written amendment dated December 28, 2012 (hereinafter referred to as the "Amendment ") is to amend the description in Claim 1 before the Amendment from:

"[Claim 1]

UV-absorber mixture, comprising:

(a) 1% to 60% by weight of a micronized UV broadband absorber of formula:

[Formula 1]

(i) 

wherein R_1 is C_1-C_{12} alkyl; or phenyl-substituted C_1-C_{12} alkyl; and

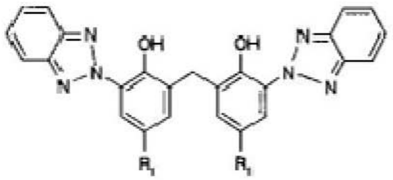
(b) 1% to 60% by weight of an oil-dispersible titanium dioxide coated with metal soaps to impart hydrophobic surface." to

"[Claim 1]

UV-absorber mixture, comprising:

(a) 1% to 60% by weight of a micronised UV broadband absorber of formula:

[Formula 1]

(i) 

wherein R_1 is C_1-C_{12} alkyl; or phenyl-substituted C_1-C_{12} alkyl; and

(b) 1% to 60% by weight of an oil dispersion comprising granular titanium dioxide having an average particle diameter of 10 nm to 150 nm, with a TiO_2 content equivalent to more than 40% by weight of solid content in the dispersion, the oil being selected from a vegetable oil, a fatty acid glyceride, a fatty acid ester, and a fatty acid alcohol." (hereinafter referred to as "Amendment 1)".

2. Purpose of amendment

In the Amendment 1, in the description of "(b)" in Claim 1, "titanium dioxide coated with metal soaps to impart hydrophobic surface" was replaced with "titanium dioxide" by deletion of the description, so that the scope of the claim was broadened to titanium dioxide not "coated with metal soaps", limiting the matter unrelated to coating with metal soaps by the description "the granules having an average particle diameter of 10 nm to 150 nm" and "the oil dispersion having more than 40% by weight of solid content, the oil being selected from a vegetable oil, a fatty acid glyceride, a fatty acid ester, and a fatty acid alcohol". The Amendment 1 in the Amendment therefore does not falls under the term "restriction of the scope of claims" as referred to in Article 17-2 (4) (ii) of the Patent Act before revision by the Act No. 55 of 2006 (hereinafter referred to as "Patent Act before revision in 2006"),

of which the provisions then in force shall remain applicable according to revision supplement Article 3 (1) of the Act No. 55 of 2006.

It is obvious that the Amendment does not correspond to any one of the deletion of claims under provisions of item (i) in the same Article, same paragraph of the same Act, the correction of errors in the description under provisions of item (iii), and the clarification of an ambiguous statement under provisions of item (iv).

3. Conclusion

The Amendment therefore violates the provisions of Article 17-2 (4) of the Patent Act before revision in 2006, and should be dismissed under the provisions of Article 53 (1) of the same Act which is applied mutatis mutandis pursuant to the provisions of Article 159 (1) of the same Act.

No. 3 Regarding the Invention

Since the amendment dated December 28, 2012 was dismissed as described above, the invention according to Claim 1 of the case (hereinafter referred to as "the Invention") is specified by the matters described in Claim 1 according to the scope of claims for patent amended by the written amendment submitted on November 16, 2011.

No. 4 Reasons for refusal of the examiner's decision

The brief reason for refusal in the decision of refusal ("Reasons" "2." in the notice of reasons for refusal on May 13, 2011) is that the invention according to Claims 1 to 9 of the application could be easily made by a person skilled in the art based on the invention described in the cited documents 1 to 5 distributed before the application, and cannot be obtained a patent under the provisions of Article 29 (2).

The cited documents include the following document.

2. Japanese Unexamined Patent Application Publication No. 2001-151657

No. 5 Judgement on the body

The body judges that the Invention should be rejected due to the reasons described in the reasons for refusal described above.

Details are as follows.

1. Publication and described matters in the publication

(1) Publication

1. National Publication of International Patent Application No. 2001-151657 ("Cited document No. 2" in the notice of reasons for refusal)

2. International Publication No. WO 00/02529 (Cited document in the decision of refusal)

(2) Described matters in the publication

A. Regarding Publication 1

In the Publication 1, the following matters are described.

1a: "[Scope of claims]

[Claim 1] A water-in-oil type emulsion for cosmetics or skins comprising:

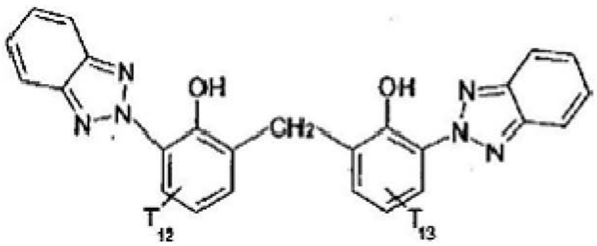
(a) at least one aqueous phase;

(b) at least one fat phase;

(c) at least one photoprotection system capable of blocking UV rays, which includes at least one organic UV blocking agent insoluble in the emulsion in a micronised form with an average particle diameter in the range of 0.01 to 2 μm; and

(d) at least one non-blocking organo modified silicone including an oxyalkylenated group; the said insoluble organic UV blocking agent being different from micronised 2,4,6-tris[p-(2'-ethylhexyl-1'-oxycarbonyl)anilino]-1,3,5-triazine and a compound having the following structure; ···."

1b: "[0031] Examples of the organic UV blocking agent of benzotriazole type of the present invention include a methylenebis(hydroxyphenyl-benzotriazole) derivative having the following structure:



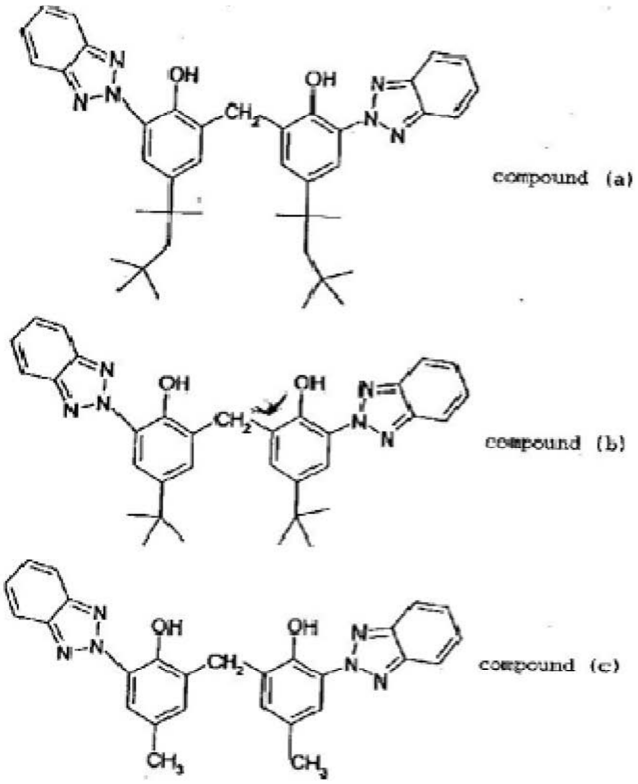
(6)

wherein T_{12} and T_{13} may be the same or may be different, representing a C_1-C_{18} alkyl group which may be substituted with one or a plurality of groups selected from a C_1-C_4 alkyl, a C_5-C_{12} cycloalkyl, and an aryl residue. These compounds are known in themselves and described in U.S. Patents No. 5237071 and No. 5166355, British Patent Application Publication No. 2303549, DE No. 19726184, and

European Patent Application Publication No. 893119 (constituting a part of the present specification).

[0032] In the formula (8), the C_1-C_{18} alkyl group may be in a straight chain or branched chain, and includes, for example, methyl, ethyl, n-propyl, isopropyl, n-butyl, isobutyl, tert-butyl, tert-octyl, n-amyl, n-hexyl, n-heptyl, n-octyl, iso-octyl, n-nonyl, n-decyl, n-undecyl, n-dodecyl, tetradecyl, hexyldecyl and octadecyl; the C_5-C_{12} cycloalkyl includes, for example, cyclopentyl, cyclohexyl, and cyclooctyl; and the aryl group includes, for example, phenyl and benzyl.

[0033] As the compound of formula (8), a compound having the following structure is particularly preferred:



The compound (a) named 2,2'-methylenebis [6-(2H-benzotriazole-2-yl)-4-(1,1,3,3-tetrametylbutyl)phenol] is available from Fairmount Chemical Co. under the product name MIXXIM BB/100 in a purified form, and from Ciba-Geigy under the product name TINOSORB M in a micronised form. The compound (c) named 2,2'-methylenebis[6-(2H-benzotriazole-2-yl)-4-(methyl)phenol] is available from Fairmount Chemical Co. under the product name MIXXIM BB/200."

1c: "[0048] Specific examples are as follows, which exemplify the present invention but do not limit the present invention.

Examples

[Table 1]

W/O emulsion composition	gram
Oxyethylenated polydimethyl/methyl cetyl methyl siloxane (ABIL EM 90D-GOLDSCHMIDT)	2
Phenyltrimethylsiloxy trisiloxane (DOW CORNING 556 COSMETIC grade fluid-DOW CORNING)	3
C_{12}/C_{15} alcohol benzoate (WITOCONOL TN-WTTCO)	8
Methylenebis(tetramethylbutyl hydroxyphenyl benzotriazole) in micronised form, available under product name TINOSORB M Average particle diameter: 150 nm to 200 nm	5
Drometrizole trisiloxane	2
2,4-bis{[4-2-ethylhexyloxy]}-2-hydroxy]phenyl}-6-(4-methoxyphenyl)-1,3,5-triazine	2
Titanium oxide (TITANIUM DIOXIDE MT 100TV TAYCA)	3
Glycerine	5
Magnesium sulfate	0.7
Preservative	Proper quantity
Demineralized water, the amount for the whole to have the amount described at right"	100 g

"

B. Regarding Publication 2

In the Publication 2, the following matters are described. (The translation is based on National Publication of International Patent Application No. 2002-520264, which is a patent family member of the Publication 2).

2a: "The coating on the nano pigment, formed of a hydrophobic hydrocarbon as base, preferably includes a fatty acid or a salt of a fatty acid and a monovalent or a polyvalent metal, ammonium, or an organic metal.

Particularly preferable examples of the nano pigment include a titanium oxide nano

pigment coated with alumina and aluminium stearate under the product name "MICRO TITANIUM OXIDE MT 100T" or "MT-100TV" available from Tayca Corporation, or a rutile-type titanium oxide nano pigment coated with stearic acid available from Ishihara Sangyo Kaisha Ltd., under the product name "TTO-SA". (p.7, l.17 to 25)

2. Invention described in the Publication

In the Publication 1, it is recognized that the invention of the following W/O emulsion composition (hereinafter referred to as "Cited Invention") is described from the description in indication 1c. (Herein, the description in the Table 1 is interpreted as follows.

- In the indication 1c, it is obvious that the "whole" in the description "demineralized water, the amount for the whole to have the amount described at right" and "100 g" means the whole of "W/O emulsion composition", so that the demineralized water content corresponds to "the amount for the whole composition to have an amount of 100 g".

- The description "2,4-bis-{[4-2-ethylhexyloxy]}-2-hydroxy]phenyl}-6-(4-methoxyphenyl)-1,3,5-triazine" (underlined by the body) has two "}" and two "]" for one "{" and one "[", respectively, of which the relations are inconsistent.

Since it is obvious that the second and fourth positions of triazine connect to "{[4-2-ethylhexhlo···phenyl]} described after "bis", it is understood that the underlined "}" was incorrectly described.

Further, it is understood that "[4-2-ethylhexyloxy]}-2-hydroxy]" is described as the functional group connected to "phenyl", and "2-hydroxy" has a hydroxyl group connected to the second position of the phenyl group. Consequently it is understood that "4-2-ethylhexyloxy" includes "2-ethylhexyloxy" group connected to the fourth position. In that case, the "[4-2-ethylhexyloxy]" should be described as "4-[2-ethylhexyloxy]", and it is understood that the underlined "]" was incorrectly described.

Accordingly, the description of the compound is an erroneous description of "2,4-bis-{4-[2-ethylhexyloxy]-2-hydroxyphenyl}-6-(4-methoxyphenyl)-1,3,5-triazine".)

"A W/O emulsion composition including:

2 g of oxyethylenated polydimethyl/methyl cetyl methyl siloxane (ABIL EM 90D-GOLDSCHMIDT) ;

3 g of phenyl trimethyl siloxy trisiloxane (DOWCORNING 556 COSMETIC grade fluid-DOW CORNING);

8 g of C_{12}/C_{15} alcohol benzoate (WITOCONOLTN-WITOCO);

5 g of methylenebis(tetramethylbutyl-hydroxyphenyl-benzotriazole) in micronised form having an average particle diameter of 150 nm to 200 nm, available under the product name TINOSORB M;

2 g of drometrizole trisiloxane;

2 g of 2,4-bis-{4-[2-ethylhexyloxy]-2-hydroxyphenyl}-6-(4-methoxyphenyl)-1,3,5-triazine;

3 g of titanium oxide (TITANIUM DIOXIDE MT 100TV TAYCA;

5 g of glycerine;

0.7 g of magnesium sulfate;

a proper amount of a preservative;

and demineralized water in an amount for the whole composition to have 100 g."

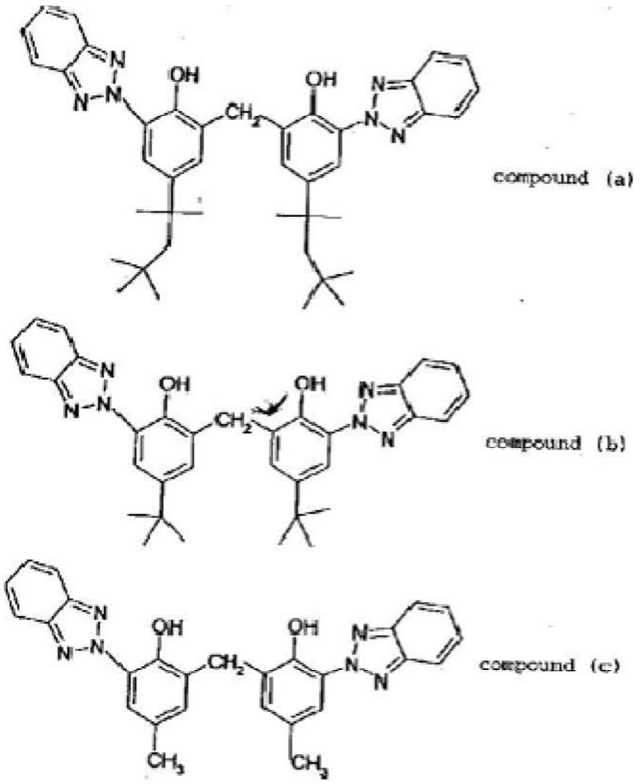
3. Comparison and judgement

(1) Comparison

First, due to the description in the indication 1b

"[0031] Examples of the organic UV blocking agent of benzotriazole type of the present invention include a methylenebis(hydroxyphenyl benzotriazole) derivative having the following structure: ···

[0033] As the compound of formula (8), a compound having the following structure is particularly preferred:



The compound (a) named ··· is available ··· and from Ciba-Geigy under the product name TINOSORB M in a micronised form.", it is recognized that the "methylene bis(tetramethylbutyl-hydroxyphenyl-benzotriazole) in micronised form having an average particle diameter of 150 nm to 200 nm, available under the product name TINOSORB M" in the cited invention has the structure shown in the "compound (a)", and corresponds to the micronised product having the structure shown in [Formula 1] of the Invention.

In a section "Benzotriazole UV absorbers" on page 1050 of "13398 Chemical Products" (published by The Chemical Daily Co., Ltd., in 1998), it is described that "2-2-methylenebis{4-(1,1,3,3-tetramethylbutyl)-6-(2H-benzotriazole-2-yl)-phenol}" having the same structure as the "compound (a)", i.e. the same structure as the "TINOSORB M", has an "effective absorption wavelength" of "270 to 380 nm". This indicates that the compound is a broadband absorber which can absorb both of UV-A and UV-B.

In that case, it is recognized that the "methylene bis(tetramethylbutyl-hydroxyphenyl-benzotriazole) in micronized form having an average particle diameter of 150 nm to 200 nm, available under the product name TINOSORB M" in theCited Invention is a UV broadband absorber.

Accordingly, the "methylene bis(tetramethylbutyl-hydroxyphenyl-benzotriazole) in micronised form having an average particle diameter of 150 nm to 200 nm, available under the product name TINOSORB M" in the Cited Invention corresponds to "a micronized UV broadband absorber of Formula:

[Formula 1]
(The formula is omitted.)
wherein R_1 is C_1-C_{12} alkyl; or phenyl-substituted C_1-C_{12} alkyl" of the Invention.

Further, the "W/O emulsion composition" of the Cited Invention includes "demineralized water" added in an "amount for the whole composition to have an amount of 100 g", having a total weight of 100 g, with "5 g" of the "TINOSORB M" being contained, and therefore corresponds to "1% to 60% by weight of a micronized UV broadband absorber" of the Invention.

Next, "3 g of titanium oxide (TITANIUM DIOXIDE MT 100TV TAYCA)" in the Cited Invention corresponds to the "titanium dioxide" of the Invention. And due to the same reason as described above, it is recognized that "3 g" of the titanium oxide is contained in 100 g of the W/O emulsion compound. Consequently the content also corresponds to "1% to 60% by weight" of the Invention.

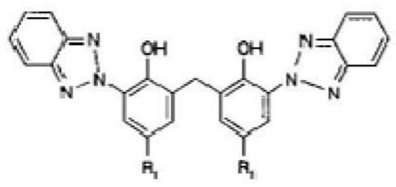
As described above, the "W/O emulsion composition" of the Cited Invention includes the component corresponding to the "UV broadband absorber" of the Invention, and therefore also corresponds to the "UV absorber mixture" of the Invention.

Accordingly, the Invention and the Cited Invention correspond with each other in terms of:

"A UV-absorber mixture comprising:
(a) 1% to 60% by weight of a micronized UV broadband absorber of formula

[Formula 1]

(1)



wherein R_1 is C_1-C_{12} alkyl; or phenyl-substituted C_1-C_{12} alkyl; and
(b) 1% to 60% by weight of titanium oxide.

The Invention and the Cited Invention are different from each other in the following ways.

The different feature: In the Invention, titanium dioxide is specified to be "an oil-dispersible titanium dioxide coated with metal soaps to impart hydrophobic surface", while in the Cited Invention such a specification is not made.

(2) Judgement of the different feature

It is recognized that the "titanium oxide (TITANIUM DIOXIDE MT 100TV TAYCA)" in the Cited Invention is titanium dioxide coated with alumina and aluminium stearate based on the description in the indication 2a of the publication 2 "The particularly preferably nano pigment is a titanium oxide nano pigment coated with alumina and aluminum stearate available from Tayca Corporation under the product name "MICRO TITANIUM DIOXIDE MT100T" or "MT-100TV", or a rutile-type titanium oxide nano pigment coated with stearic acid available from Ishihara Sangyo Kaisha Ltd., under the product name "TTO-SA"

Incidentally, based on the description in paragraph [0013] of the detailed explanation of the Invention, "Oil-dispersible titanium dioxide, in accordance with the present invention, is micronised titanium dioxide, the particles of which exhibit a hydrophobic surface property, and, which for this purpose, are coated with metal soaps like polymethylmethycrylate, isopropyl titanium triisostearate, aluminium stearate, magnesium stearate, aluminium laurate or zinc stearate, methyl hydrogen polysiloxane, oxygenated polysiloxane, glycerine, stearyl alcohol, Steareth-7, Steareth-10, stearic acid, lauric acid, simethicone or dimethicone." (Note in Appeal Decision: It is recognized that "micro-differentiated titanium dioxide" is an erroneous description of "micronised titanium dioxide"), it is recognized that the "oil-dispersible titanium dioxide" means "micronised titanium dioxide" "coated with metal soaps" like "aluminium stearate".

The "titanium oxide (TITANIUM DIOXIDE MT 100TV TAYCA)" in the Cited Invention is, therefore, the "titanium oxide" coated with "aluminium stearate" given as an example of metal soaps in the detailed explanation of the Invention as described above, corresponding to the "oil-dispersible titanium dioxide coated with metal soaps" of the Invention.

As in description in indication 2a in Publication 2, "The coating on the nano

pigment, formed of a hydrophobic hydrocarbon as base, preferably includes a fatty acid or a salt of a fatty acid and a monovalent or polyvalent metal, ammonium, or an organic metal.", it is generally recognized that the coating formed of "salt of fatty acid and a monovalent or polyvalent metal ···" is provided to impart "hydrophobicity". In particular, the "titanium oxide" coated with aluminium stearate in the Cited Invention may be easily employed to "impart a hydrophobic surface".

Further, any exceptional effect thereof is not recognized.

(3) Summary

As described above, the Invention could be easily made by a person skilled in the art based on the Publication 1 which had been distributed before the priority date for the Invention and the well-known arts, and it cannot be obtained a patent under the provisions of Article 29 (2) of the Patent Act.

No. 6 Appellant's allegation

In the written reply of the appellant, a draft amendment A was submitted as follows with the following arguments B and C. (The underlines except for in "A" are added by the body.)

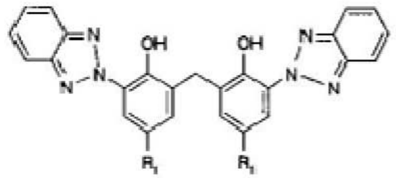
A: "The appellant is prepared to amend Claim 1 of the Invention to the following draft amendment based on the paragraph 13 of the description of the Invention. In the draft amendment to be proposed as follows, the portion changed from the description in the claim in the written amendment submitted on November 16, 2011 (hereinafter referred to as "former claim") is underlined.

"UV-absorber mixture, comprising:

(a) 1% to 60% by weight of a micronised UV broadband absorber of formula:

[Formula 1]

(1)



wherein R_1 is C_l-C_{12} alkyl; or phenyl-substituted C_l-C_{12} alkyl; and

(b) 1% to 60% by weight of an oil dispersible titanium dioxide comprising

micronised titanium dioxide particles coated with metal soaps selected from the group consisting of polymethylmethycrylate, isopropyl titanium triisostearate, aluminium stearate, magnesium stearate, aluminium laurate or zinc stearate, methyl hydrogen polysiloxane, oxygenated polysiloxane, glycerine, stearyl alcohol, Steareth-7, Steareth-10, stearic acid, lauric acid, simethicone and dimethicone, in order to impart a hydrophobic surface."

B: "2) Regarding titanium dioxide (Cited documents 1 to 6, National Publication of International Patent Application No. 2002-520264)

The "oil-dispersible titanium dioxide" of the Invention is not the titanium dioxide coated with the coating agent disclosed in the cited document 2 referred to in the reason 2 for decision of refusal (Article 29 (2) of the Patent Act) on August 28, 2012 (draft date).

The "oil-dispersible titanium dioxide" of the Invention is an oil dispersion dispersed in oil (paragraphs 13 and 96 in the description of the Invention).

On the other hand, the titanium dioxide coated with a coating agent used in the cited documents 1 to 3 in the decision of refusal is implied to be powder, and no description on the oil dispersion dispersed in oil is included therein.

...

In the cited documents 1 to 3 and 6, a titanium oxide nano pigment having amphiphilicity in a "powder" form is specifically described in Examples and the like, and in the cited documents 4 and 5, "titanium dioxide" is specifically described in Examples and the like. The descriptions in the cited documents 1 to 6 and National Publication of International Patent Application No. 2002-520264 do not imply the "oil-dispersible titanium dioxide."

C: "(4) Regarding the effects of the Invention

(4-1) Regarding the comparative experiment in the written opinion dated on November 17, 2011

In the Invention, mixtures of specific micronised organic UV absorbers (a) and oil-dispersible titanium dioxide (b) surprisingly show synergistic effect with respect to the SPF values (paragraph 4 in the description of the Invention).

In Example 3, it is disclosed that the "Oil/water sun care cream having a high SPF" using a mixture of a specific micronised organic UV absorber (a) and oil-dispersible titanium dioxide (b) of the Invention has an SPF value of 19.4 (Table 18 in paragraph 98 in the description of the Invention).

Further, in Example 4, it is disclosed that the "Oil/water sun care cream having a high SPF" using a mixture of a specific micronised organic UV absorber (a) and oil-dispersible titanium dioxide (b) of the Invention has an SPF value of 67.5 (Table 19 in paragraph 100 in the description of the Invention).

As shown in the following Table 1 described on page 12 of the written appeal, the sun care cream using a mixture of a specific micronised organic UV absorber (a) and oil-dispersible titanium dioxide (b) of the Invention exhibits higher SPF value in comparison with an oil/water cream using a specific micronised organic UV absorber (a) alone or with an oil/water cream using oil-dispersible titanium dioxide (b) alone.

[Table 1]

	Active substance	SPF	Standard deviation	UVA ratio	Critical wavelength
Formulation (A) =prior art	Tinosorb M (A1)	4.8	0.5	0.95	387
Formulation (B) =prior art	Tioveil PCM (B1)	6.2	0.6	0.41	368
Formulation (C) according to the Invention	Tinosorb M (C1) Tioveil PCM (C2)	19.1	2.8	0.72	384

It should be noted that the decision of refusal dated on August 28, 2012 recognized that "the results of the comparative experiment is not based on the matters described in the description, etc., originally attached to the application, and therefore cannot be taken into consideration." (Decision of refusal, p.2, lines 20 to 21).

In the results of comparative experiment shown in the Table 1, the SPF value of the formulation (C) according to the Invention is the SPF value in Example 3 of the description of the Invention, which is the same as the SPF value described in the Table 18 in the paragraph 98 of the description of the Invention, and no change is made in the matters described in the description originally attached to the application. The formulation (A) as prior art in the Table 1 is a formulation which includes a specific micronised organic UV absorber (a) and no oil-dispersible titanium dioxide (b). The formulation (B) as prior art is a formulation which includes no specific micronised organic UV absorber (a) and includes oil-dispersible titanium dioxide (b).

These formulations therefore do not satisfy the constituent of the invention.

In the cited documents 1 to 3, compositions including methylenebis(tetramethylbutyl hydroxyphenyl benzotriazole) and titanium oxide (TITANIUM DIOXIDE MT 100TV TAYCA) are described (Table 1 and Table 2 in the cited document 1, Table 1 in the cited document 2, and Table 1 and Table 2 in the cited document 3). In the cited documents 1 to 3, however, no SPF value of the compositions is described, so that the advantageous effect of the Invention cannot be shown in comparison with the art described in the cited documents 1 to 3."

-Regarding draft amendment A

The appellant showed a draft amendment to amend the description described in [claim 1] in the written amendment of proceedings dated on November 16, 2011 from "metal soaps" to "one selected from the group consisting of polymethylmethycrylate, isopropyl titanium triisostearate, aluminium stearate, magnesium stearate, aluminium laurate or zinc stearate, methyl hydrogen polysiloxane, oxygenated polysiloxane, glycerine, stearyl alcohol, Steareth-7, Steareth-10, stearic acid, lauric acid, simethicone and dimethicone".

Although the paragraph [0013] states that the metal soaps are selected from the group consisting of "polymethylmethycrylate, ··· lauric acid, simethicone and dimethicone", polymethylmethycrylate, isopropyl titanium triisostearate, methyl hydrogen polysiloxane, oxygenated polysiloxane, glycerine, stearyl alcohol, Steareth-7, Steareth-10, stearic acid, lauric acid, simethicone and dimethicone are not "metal soaps" from the common general knowledge, so that the "metal soaps" cannot be restricted in a limited way.

Accordingly, even if the amendment of proceedings after the appeal was made according to the draft amendment, the amendment does not correspond to the restriction in a limited way under the provisions of Article 17-2 (4) (ii) before revision in 2006, and even if the amendment corresponds to the restriction in a limited way, the definition and use of terms are unclear, different from the common general knowledge, so that requirement for independent patentability cannot be satisfied. In other words, the amendment is illegal.

-Regarding argument B

Based on the description in paragraphs [0013] and [0096] in the detailed explanation of the Invention, the appellant insists that the "oil-dispersible titanium dioxide" of the Invention is a "hydrophobic" "oil dispersion dispersed in oil", and

different from the "titanium oxide" of the cited invention, which is "amphiphilic" and in "powder form".

As described in No. 5, 3 (2), however, with taking into consideration of the description in paragraph [0013] in the detailed explanation of the Invention, the "oil-dispersible titanium dioxide" is simply described as "coated with metal soaps", and the dispersion into oil is described immediately after the above, separately from the description in [0013]:

"[0014]

The micronised titanium dioxide can be incorporated either in the water phase (water- dispersible) or in the oil phase (oil-dispersible) during the manufacturing of the cosmetic end-formulations." Accordingly the "oil-dispersible titanium dioxide" cannot be understood as "oil dispersion dispersed in oil".

Further, [0096] of the description of the Invention is as follows:

"[0096]

Example 2: Preparation of micronised titanium dioxide:

A method to manufacture an oil dispersion comprises milling in the presence of a particulate grinding medium particulate titanium dioxide in an oil and in the presence of an organic dispersing agent for said TiO_2 in said oil, in which the amount of said TiO_2 is such that the dispersion has a solids content of greater than 40% by weight and continuing said milling for a period of time such that the particulate TiO_2 has an average particle diameter from 10 nm to 150 nm. This method is described in GB-A-2206339A. The oil can be vegetable oils, fatty acid glycerides, fatty acid esters or fatty alcohols." In other words, it is only described that the titanium dioxide in a particulate form is dispersed in oil, and there is no description which allows the term "oil-dispersible titanium oxide" to mean "oil-dispersion dispersed in oil".

Accordingly, the "oil-dispersible titanium dioxide" of the Invention cannot be acknowledged to be the "oil dispersion dispersed in oil", and cannot be acknowledged to be different from the "titanium oxide" of the cited invention in this regard.

As described in No. 5, 3 (2), the difficulty in specifying the treatment of the titanium oxide with metal soaps in the cited invention to be a treatment for "imparting a hydrophobic surface" cannot be acknowledged.

-Regarding argument C

The appellant insists that the combination use of the "UV broadband absorber" "(a)" and the "oil-dispersible titanium dioxide" "(b)" has an effect of synergistically

increasing the SPF value in comparison with the single use, which is unpredictable for a person with skilled art.

The difference feature between the Invention and the cited invention is, however, only whether being "coated with metal soaps" is "for imparting a hydrophobic surface" or not. Since both of the titanium dioxides are coated with metal soaps in the same way, it cannot be acknowledged that the Invention has an exceptional effect in comparison with the cited invention in that respect.

Further, even if the Invention is different from the cited invention in terms of the titanium dioxide as "oil-dispersion dispersed in oil", any exceptional effect of the Invention which is unpredictable for a person with skilled art in comparison with a composition as in the cited invention, different from the Invention only in terms of using titanium dioxide which is not an oil-dispersion, is not described in the detailed explanation of the Invention, and no results of such a comparison experiment is shown.

As a result, it cannot be acknowledged that the Invention has an exceptional effect in comparison with the cited invention.

No. 7 Conclusion

As described above, the appellant should not be granted a patent for the Invention in accordance with the provisions of Article 29 (2) of the Patent Act. This application, therefore, should be rejected without need of examining the other matters.

Therefore, the appeal decision shall be made as described in the conclusion.

November 18, 2013

Chief administrative judge: MATSUURA, Shinji
Administrative judge: KOISHI, Mayumi
Administrative judge: HIBINO, Takaharu