

Trial decision

Invalidation No. 2014-800045

Tokyo, Japan

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The case of trial regarding the invalidation of Japanese Patent No. 4114820, entitled "Detergent Composition" between the parties above has resulted in the following trial decision:

#### Conclusion

The demand for trial of the case is dismissed.

The costs in connection with the trial shall be borne by the demandant.

#### Reason

No. 1 History of the procedures

#### 1 The Patent

Japanese Patent No. 4114820 subjected to the invalidation trial of the case (hereinafter referred to as the "Patent") is entitled "Detergent Composition," and its patent application was filed on July 24, 1996 as Patent Application No. H8-194727 (Priority Date: December 11, 1995, Japanese Patent Application No. H7-321895), and the establishment of patent right was registered on April 25, 2008:

#### 2 History to the first trial decision

The trial for invalidation was demanded by HIROSE, Takami on July 13, 2009 (the case of the invalidation No. 2009-800152, hereinafter referred to as the "first trial"), a request for correction was made on October 5, 2009, and the trial decision was made on March 2, 2010; however, a court decision of revocation of the trial decision (2010 (Gyo-Ke) 10104, rendition of decision on November 10, 2010) was made at the Intellectual Property High Court, the case was proceeded further, and the trial decision that "the correction shall be approved. The demand for trial of the case was groundless" (hereinafter referred to as the "first trial decision") was made on January 31, 2011, the above decision

became final and binding on March 14, 2011, and the binding was registered on April 20, 2011.

### 3 History to the second trial decision

The trial for invalidation was demanded by AKZO NOBEL on August 25, 2011 (the case of the invalidation No. 2011-800147, hereinafter referred to as the "second trial"), the trial decision that "the demand for trial of the case was groundless" (hereinafter referred to as the "second trial decision") was made on April 12, 2012, and after a court decision of dismissal of a claim (2012 (Gyo-Ke) 10177, rendition of decision on February 27, 2013) was made at the Intellectual Property High Court, the above decision became final and binding on March 13, 2013, and the binding was registered on April 4, 2013.

### 4 History of the trial of the case

The invalidation trial of the case was demanded by AKZO NOBEL on March 26, 2014 (the case of the invalidation No. 2014-800045, hereinafter referred to as the "trial of the case"), and then, a written reply was submitted by SHOWA DENKO K.K., which is a demandee, on June 17, 2014 (date of acceptance).

### No. 2 Description of the scope of claims in the specification of the case

The description of the scope of claims in the specification of the Patent after the correction dated October 5, 2009 (hereinafter referred to as the "specification of the case") that was admitted in the first trial is as follows;

"[Claim 1] A detergent composition comprising sodium hydroxide, aspartate diacetate and/or glutamate diacetate, and sodium glycolate, wherein the content of the sodium hydroxide is 0.1 to 40% by weight of the composition.

"[Claim 2] The detergent composition according to claim 1, wherein the content of the sodium hydroxide is 5 to 30% by weight, the content of the aspartate diacetate and/or glutamate diacetate is 1 to 20% by weight, and the content of the sodium glycolate is 0.1 to 0.3 parts by weight with respect to 1 part by weight of the aspartate diacetate and/or glutamate diacetate."

(hereinafter the inventions relating to these claims are referred to as "Invention 1" and "Invention 2" so as to correspond to the claim numbers, and the patents corresponding to the inventions are referred to as "Patent 1" and "Patent 2".)

### No. 3 Outline of the trial of the case

The reasons for invalidation and evidences alleged by the demandant in the trial of the case are as follows;

#### 1 Reasons for invalidation 1 (the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act)

Patents 1 and 2 are in breach of the provisions of Article 29(2) of the Patent Act, and thus fall under Article 123(1) (ii) and should be invalidated.

Evidences A No. 1 to A No. 4 are submitted as the means of proof as described below.

#### NOTES

Evidence A No. 1 "Introductory chelate (the second revised edition)"

Evidence A No. 2 Japanese Unexamined Patent Application Publication No. H7-238299

Evidence A No. 3 Specification of United Kingdom patent application No. 1439518

Evidence A No. 4 Japanese Unexamined Patent Application Publication No. S50-3979

#### 2 Reasons for invalidation 2 (the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act)

Patents 1 and 2 were based on a patent application that does not meet the requirement stipulated in Article 36(6)(i) of the Patent Act, and thus fall under Article 123(1)(iv) and should be invalidated.

#### No. 4 Judgment by the body regarding prohibition of double jeopardy

##### 1 applicable law

(1) Article 167 of the Patent Act stipulates the principle of prohibition of double jeopardy, and the article was revised by Act No. 63 of June 8, 2011, in which the range of the effect of prohibition of double jeopardy, which is the effect of final and binding decision, was revised from "a certain person" to "parties and intervenors" (hereinafter Article 167 of the Patent Act before revision and Article 167 of the Patent Act after revision by Act No. 63 are respectively referred to as "Article 167 before revision" and "Article 167 after revision").

In accordance with supplement Article 2(22) of Act No. 63, the stipulation of Article 167 after revision is applied to the trials based on the same facts and the same evidences as the trials on which the final and binding decision was registered after April 1, 2012 which is the day of enforcement of Act No. 63, and Article 167 before revision is applied to the trials based on the same facts and the same evidences as the trials on which the final and binding decision was registered before the day of enforcement of Act No. 63.

(2) The final and binding effect of the first trial decision (the effect of prohibition of double jeopardy)

Since the binding of the first trial decision was registered on April 20, 2011, the judgment of suitability of Article 167 before revision should be discussed; however, the article stipulates that no one may file a demand for a trial again on the basis of the same facts and evidence.

Thus, while the demandant of the trial of the case (AKZO NOBEL) is different from the demandant of the first trial (HIROSE, Takami), the final and binding effect of the first trial decision is good for any one as described above, so that the difference in demandant does not prevent the application of the stipulation of Article 167.

(3) The final and binding effect of the second trial decision (the effect of prohibition of double jeopardy)

Since the binding of the second trial decision was registered on April 4, 2013 (bound on March 13, 2013), the stipulation of Article 167 after revision should be applied

in relation to the trial of the case, and the final and binding effect thereof is good only for the parties and intervenors; however, the party (demandant) of the trial of the case is AKZO NOBEL, which is the same party as in the second trial.

Therefore, the effect of prohibition of double jeopardy of the second trial decision is also good for the trial of the case.

(4) As described above, both of the effects of prohibition of double jeopardy, which are the effect of the first trial decision and the effect of the second trial decision that have already been bound, are good also for the trial of the case.

## 2 precondition

(1) The gist of Article 167 of the Patent Act (regardless of Article 167 before or Article 167 after revision) is understood to: (i) prevent a plurality of contradictory final and binding decisions that are made based on allegations and proofs relating to the same matter; (ii) prevent abuse of an invalid demand for trial or the like; (iii) prevent complexity corresponding to a proceeding of the trial for invalidation or the like that the right holder will receive; (iv) solve a dispute one time only; and the like; however, in the demand for trial for invalidation, it is reasonable to understand that "the same facts" indicate major facts relating to the same reasons for invalidation, and "the same evidences" indicate substantially same evidences to constitute grounds for the major facts.

(2) Regarding "the same evidences", as long as evidences are grounds for proving the same facts (the same propositions to be proven), it should be understood that different evidences do not immediately mean that they are substantially different (see 2013 (Gyo-Ke) 10226, a request to revoke the trial decision at the Intellectual Property High Court, March 13, 2014).

(3) Therefore, for example, it should not be understood that after a final and binding trial decision regarding invalidation prescribed in the provisions of Article 29(2) of the Patent Act, adding different reasons for invalidation negates the effect of the trial decision. Whether the facts are same or not should be determined on the basis of the major facts relating to each reason for invalidation. Further, according to the latter part in the main paragraph of Article 123(1) of the Patent Act that stipulates; "in the event of two or more claims, a request for a trial for patent invalidation may be filed for each claim," there is an explicit expression for dealing with claims one by one in the Patent Act. Therefore, it is

understood that determination regarding the similarities should be made for each claim (for each patent).

(4) In addition, in a case where the parties are the same as the parties in the final and binding decision, preventing a repeating demand is more stressed than in a case of another demand for trial by another party, and it can't be helped that the similarities between facts and evidences are not strictly determined (see the above-described decision of the Intellectual Property High Court, and also 2013 (Gyo-Ke) 10127, a request to revoke the trial decision at the Intellectual Property High Court, February 5, 2014). And thus in order that the demand for trial is regarded to be a legitimate demand for trial based on new "evidences" as not violating the provisions of Article 167 after revision, it is required that not only the evidences are different from the ones submitted in the former demand for trial for invalidation but also newly submitted evidences are substantially worth proving new facts other than the facts that support the past reasons for invalidation.

(5) Hereinafter, in view of these, reasons for invalidation and evidences relating to the trial of the case will each be discussed below while attention is focused especially on Patent 1.

3 Relationship between the final and binding effect of the first trial decision and the reasons for invalidation 2 (the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act) of the trial of the case

(1) Since the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act have been already alleged in the first trial, the relationship between these reasons for invalidation and the reasons for invalidation 2 (the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act) of the trial of the case will be considered first.

(2) Article 131 (2) of the Patent Act stipulates that the facts (the major facts) on which the invalidation of the patent is based shall be specified in concrete terms, and the relationship of each fact that is required to be proved with the relevant evidence (requiring-proof fact) shall be stated in "the grounds for the request" in the demand for trial for invalidation, so that it is understood to be embodied in the "grounds for the request" in the demands for trial of the first trial and the trial of the case that the first trial and the trial of the case were demanded on the basis on what "facts" and "evidences."

(3) Thus, in view of the "grounds for the request" in the demands for trial of the first trial

and the trial of the case, the following description regarding the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act regarding Patent 1 is recognized.

A The first trial (page 11 in the demand for trial)

"(4-2) Reasons II to invalidate the Patent (deficiency in the description)

....

In addition, the aspartate diacetate and/or the glutamate diacetate, and the sodium glycolate should be present in predetermined concentrations in order that these components may have certain effects (for example, one molecule of these components cannot be considered to have an effect in one liter of the detergent composition). Nevertheless, Claim 1 that lacks such a limitation encompasses the scope to which the effect of the Invention is not provided.

Therefore, the invention for which a patent is sought is not described in the detailed description of the invention, and thus the Patent was made on a patent application that does not meet the requirement stipulated in Article 36(6)(i) of the Patent Act."

B The trial of the case (page 17 in the demand for trial)

"(E) Reasons to invalidate the Patent (deficiency in the description)

The aspartate diacetate and/or the glutamate diacetate, and the sodium glycolate should be present in predetermined concentrations in order that these components may have certain effects (for example, one molecule of these components cannot be considered to have an effect in one liter of the detergent composition). Shown in the examples are only glutamate sodium diacetate having concentrations of 2.5% by weight, 4% by weight, and 5% by weight, and aspartate sodium diacetate having a concentration of 5% by weight. The concentration of the sodium glycolate is 0.06 to 0.3% by weight. Nevertheless, Claim 1, which lacks the limitation of the concentrations, encompasses the scope on which the effect of the Invention is not supported.

...

Therefore, the invention for which a patent is sought is not described in the detailed description of the invention, and thus the Patent was made on a patent application that does



not meet the requirement stipulated in Article 36(6)(i) of the Patent Act, and thus falls under Article 123(1)(iv) and should be invalidated."

(It is to be noted that the underlines are added by the body in order to highlight the differences and similarities between the two.)

(4) In view of the above, the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act in the trial of the case regarding Patent 1 are recognized to have newly added specific component concentrations that are described in the examples of the specification of the case (the component concentrations of which the effect of the invention is supported actually in the specification of the case) to the reasons for invalidation in the first trial; however, it is understood that the two correspond in the following point.

"The aspartate diacetate and/or the glutamate diacetate, and the sodium glycolate should be present in predetermined concentrations in order that these components may have certain effects (for example, one molecule of these components cannot be considered to have an effect in one liter of the detergent composition). Nevertheless, Claim 1, which lacks the limitation of the concentrations, encompasses the scope on which the effect of the Invention is not supported (this is admitted to be synonymous with the "scope to which the effect of the Invention is not provided").

Therefore, the invention for which a patent is sought is not described in the detailed description of the invention, and thus Patent 1 was made on a patent application that does not meet the requirement stipulated in Article 36(6)(i) of the Patent Act."

(5) The above-described corresponding point forms the basis of the reasons for invalidation of the two, and is nothing other than the major facts on which the invalidation of Patent 1 is based.

In addition, the major facts are not to be influenced to be changed only because the specific component concentrations in the examples (the component concentrations of which the effect of the invention is supported actually in the specification of the case) are added to the basis of the reasons for invalidation as described above, and thus the reasons for invalidation of the two relating to Patent 1 can be evaluated to be substantially the same in terms of the fact of being alleged to be the reason for invalidation of Article 36(6)(i) of the Patent Act, and it has to be said that the reason for invalidation is based on the "same facts."

It is to be noted that regarding Patent 1, there is no means of proof for reasons for

invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act other than the specification or the like, and thus there is no matter that corresponds to the "same evidence" prescribed in the principles of prohibition of double jeopardy.

(6) The reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act relating to Patent 1 in the trial of the case is explained as below in the first trial decision (see the articles of "No. 5 Judgment by the body" and "2 reasons for invalidation 2"), and the trial proceedings are already done.

"In the demand for trial page 11 (4-2), the demandant points out, as the reasons for invalidation 2, that

...

B) " the aspartate diacetate and/or the glutamate diacetate, and the sodium glycolate should be present in predetermined concentrations in order that these components may have certain effects (\*snip\*). Nevertheless, Claim 1, which lacks such a limitation, encompasses the scope to which the effect of the Invention is not provided." and alleges that the invention for which a patent is sought is not described in the detailed description of the invention.

...

Next, B) will be discussed. Patent 1 relates to a "detergent composition," and it is obvious that the detergent composition does not include components whose contents are extremely small to have no cleansing effect.

The demandant alleges, in an oral proceedings statement brief, that "judgment criteria as to whether the detergent composition has an effect of a detergent is not described in the specification of the case, so that a person skilled in the art cannot judge in an objective way." ((5) at page 8)

However, Invention 1 is not merely a composition, but is an invention relating to a "detergent composition" with limitation of use, and using the composition as a detergent is prerequisite. It is obvious that by being used as a detergent, the composition has the effect, so that the aspartate diacetate, the glutamate diacetate, and the sodium glycolate should be present therein with concentrations so as to have the effect even if the concentrations are not specified.

Therefore, the demandant's allegation cannot be accepted.

Thus, it cannot be said that Invention 1 encompasses the scope to which the effect of the Invention is not provided.

As described above, it cannot be said that Invention 1 encompasses the scope to which the effect of the Invention is not provided, and is described in the detailed description of the invention. Thus, Patent 1 complies with Article 36(6)(i) of the Patent Act, so that Patent 1 cannot be invalidated by the reasons for invalidation 2 that the demandant alleges."

#### (7) Summary

As discussed above, the trial of the case on the basis of the reasons for invalidation 2 (the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act) regarding Patent 1 was demanded on the basis of the same facts (and the same evidence) as in the first trial (the facts relating to the reasons for invalidation 2) that was already examined in the foregoing trial, and is thus against the effect of prohibition of double jeopardy that is the final and binding effect of the first trial decision, and should not be approved.

4 Relationship between the final and binding effect of the second trial decision and the reasons for invalidation 1 (the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act) of the trial of the case

(1) The major facts in the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act

The major facts in the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act; that is, the major facts on which the invalidation of the patent is based alleged to be in breach of Article 29(2) of the Patent Act, are facts that include common knowledge that is the basis in judging that the "inventions described in the respective items of the preceding paragraph" (hereinafter referred to as the "main cited inventions") are easily conceivable, and also includes other facts such as well-known arts that prove that the "inventions are easily conceivable by a person skilled in the art" based on the main cited inventions.

In order to prove the presence of the reasons for invalidation prescribed in the

article based on the facts, a variety of decision-making processes can be built, through which a conclusion that the inventions could be easily conceived by a person skilled in the art based on the main cited inventions is derived, so that it is possible to give reasons for invalidation that are different from the reasons for invalidation that were judged in the preceding final and binding decision by newly adding specific well-known arts (and the evidences thereof) to the second-time demand for trial for invalidation.

Therefore, in judging whether or not the trial alleging the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act is demanded on the basis of the same facts as the facts in the preceding trial, it should be examined how other well-known arts in addition to the main cited invention are applied to the decision-making processes for a conclusion that the Invention could be easily conceived by a person skilled in the art based on the main cited inventions.

Consequently, the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act regarding the second trial and the trial of the case (the evidences and the major facts (the main cited invention and the like)) will be viewed in detail hereinafter (described below in (2) and (3)), and then the similarities between the facts and the evidence of the two will be examined (described below in (4) and (5)).

(2) The reasons for invalidation in the second trial (the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act)

#### A Outline

Since the reasons for invalidation that the demandant alleges about Patent 1 in the second trial are that "Invention 1 could have been easily invented by a person skilled in the art before the priority date of the application for the Patent based on the invention described in the Evidence A No. 1 and the invention Evidence A No. 2, and the well-known arts described in Evidence A No. 3 to Evidence A No. 6, the Invention 1 cannot obtain a patent in accordance with the provisions of Article 29 (2) of the Patent Act, and therefore Patent 1 should be invalidated under the provisions of Article 123(1)(ii) of the Patent Act."

#### B Evidence

Evidences A No. 1 to Evidence A No. 6 described above that were submitted as the means of proof are as follows;

Evidence A No. 1      Specification of United Kingdom patent application No.  
1439518

Evidence A No. 2      Japanese Unexamined Patent Application Publication No.  
S50-3979

Evidence A No. 3      Japanese Unexamined Patent Application Publication No.  
H7-238299

Evidence A No. 4 to Evidence A No. 6 are omitted.

It is to be noted that both of Evidence A No. 1 and Evidence A No. 2 belong to a patent family based on patent applications in France (No. 7228746 and No. 7242210) claiming priority under the Paris Convention, and the descriptions of the two are remarkably similar.

C The major facts (the main cited invention and the like)

(A) The gist of the reasons for invalidation is summarized in a table in the "outline of (1) the grounds for the request" at page 2 in the written demand for the second trial, which is described as follows;

"Detergents containing aspartate diacetate and/or glutamate diacetate, and sodium glycolate are described in A-1 and A-2. (Evidence A No. 1 and Evidence A No. 2)

It is known that sodium hydroxide is added to a detergent containing a chelating agent that is a tertiary amine derivative. (A-3 to A-6)

No special technical significance about limitations of the sodium hydroxide and its content is found in the specification.

Therefore, the invention of Claim 1 could have been easily invented by a person skilled in the art based on the inventions described in Evidence A No. 1 and Evidence A No. 2, and Evidence A No. 3 to Evidence A No. 6."

(B) It is described more particularly in the article, "(C) Comparison between the invention of Claim 1 of the case (hereinafter referred to as the Invention of the case) and the prior art invention," on pages 20 to 25 in the written demand as follows;

"(C) Comparison between the invention of Claim 1 of the case and the prior art invention"

(C-1) Evidence A No. 1 discloses a metal ion-sealing composition based on a dicarboxylic amino acid that is easily degradable biologically (a).

The ion-sealing composition based on the dicarboxylic amino acid is called OS<sub>1</sub> in Evidence A No. 1, and contains 60% by weight of sodium salt of N, N-dicarboxymethyl-2-amino-pentane diacid, and 12% by weight of sodium glycolate (d). The sodium salt of N, N-dicarboxymethyl-2-amino-pentane diacid is the same substance as the sodium salt of a glutamic acid diacetate in the Invention of the case. ... is described in Evidence A No. 2.

(C-2) It is known that a sodium hydroxide is added to a detergent containing a chelating agent that is a tertiary amine derivative such as chelating agents including a sodium salt ethylenediaminetetraacetate (EDTA) and a sodium salt of nitrilotriacetate (NTA). The sodium salt of a glutamic acid diacetate in the Invention of the case is also a chelating agent that is a tertiary amine derivative.

Japanese Unexamined Patent Application Publication No. H7-238299 (Evidence A No. 3) published before the priority date of the case discloses a composition for cleaning a hard surface that contains an alkali metal hydroxide, a gluconate, and hydroxyethyl iminodiacetate (Claim 1).

...

As described above, it is known that a sodium hydroxide is added to a detergent containing a chelating agent that is a tertiary amine derivative.

In the Invention of the case, the content of the sodium hydroxide is limited to 0.1 to 40% by weight; however, it is not recognized that the limit provides specific effect beyond effect predicted on the basis of the descriptions in the specification.

...

While described above is a case where the tertiary amine is a glutamine acid, a case where the tertiary amine is an asparagine acid is described in Evidence A No. 2 on the second page, the upper-right column, ll. 13 to 15.

Therefore, the invention of Claim 1 of the case could be easily conceivable by a person skilled in the art based on the inventions of Evidence A No. 1 and Evidence A No. 2, and Evidence A No. 3 to Evidence A No. 6, and cannot obtain a patent in accordance with the provisions of Article 29 (2) of the Patent Act, and therefore the patent should be

invalidated under the provisions of Article 123(1)(ii) of the Patent Act."

(C) Further, the demandant alleges, in the written statement for the trial case dated February 6, 2012 on the second page, "6." "I.", that "2. The main cited invention is a composition OS<sub>1</sub> described in Evidence A No. 1 and Evidence A No. 2."

(D) According to the above descriptions, the "inventions described in the respective items of the preceding paragraph", i.e. the "main cited inventions", which are one of the major facts stipulated in Article 29 (2) of the Patent Act relating to the reasons for invalidation, can be said to be an invention relating to a metal ion-sealing composition that is referred to as "OS<sub>1</sub>" described in Evidence A No. 1 (or Evidence A No. 2) in the second trial, which is nothing other than the "cited invention 1b" to be described below that is admitted in the second trial decision.

In addition, it is understood that the fact of the "well-known arts" is proved on the basis of Evidences A No. 3 (to 6) that disclose "adding a sodium hydroxide to a detergent containing a chelating agent that is a tertiary amine derivative." Further, it is understood that the decision-making process on inventive step is based on a premise that the Invention 1 could be easily conceivable by a person skilled in the art based on the main cited invention and the above-described well-known arts.

(E) It can be said that Evidence A No. 1 and Evidence A No. 2 are evidences to prove requiring-proof facts that the above-described "main cited invention" exists, and Evidence A No. 3 (to 6) are evidences to prove requiring-proof facts that the above-described "well-known arts" exist.

It is to be noted that while Evidence A No. 2 discloses the same content as Evidence A No. 1, and thus is not documentary evidence requisite to arrive at the "main cited invention," Evidence A No. 2 is understood to be an evidence especially to prove that the invention could be easily conceivable when the constituent component of the detergent composition according to the Invention 1 is an "aspartate diacetate."

D In the second trial as described above, the second trial decision explains already as follows;

(A) Recognition of the main cited invention

"Thus, it can be said that A-1 describes an invention (hereinafter referred to as the 'cited invention 1b') of

'a metal ion-sealing composition that is non-toxic, non-polluting, and easily

degradable biologically and that contains

60% by weight of trisodium salt of N, N-dicarboxymethyl-2-amino-pentane diacid that is obtained by concurrently adding a solution of monochloroacetic acid and a solution of caustic soda to an aqueous solution of monosodium glutamic acid, by reaction where (a) the alkali is used such that the pH of a reaction medium is maintained at 9.2 to 9.5; (b) the reaction is carried out at temperatures ranging from 70 to 75 degrees C; and (c) the monochloroacetic acid of 2.6 mol per one mol of glutamic acid is used, 12% by weight of sodium glycolate that is an impurity generated by secondary reaction of the reaction, and sodium chloride of a content by which the entire amount becomes 100% by weight." (See the items, "No. 6 Judgment by the body," "2 Regarding Reasons for invalidation 1," "(3) The Invention 1 [3]," and "(3-1) Cited Invention.")

(B) Recognition of the well-known arts

"Each of A-3 to A-6 describes a detergent containing a chelating agent that is a tertiary amine derivative and a sodium hydroxide, so that using a sodium hydroxide in a detergent containing a chelating agent that is a tertiary amine derivative can be said to be well-known art before the priority date of the application for the Patent"

(See the items, "No. 6 Judgment by the body," "2 Regarding Reasons for invalidation 1," "(2) The Invention 1 [2]," "(2.-3) Judgment," and "D Regarding the different feature 3.")

(C) Judgment on inventive step

" ... Even if sodium glycolate is regarded as an impurity generated by secondary reaction as is specified in the cited invention 1b because the Invention 1 does not specify containing sodium glycolate, sodium glycolate is literally contained therein, and even if it cannot be said that containing sodium glycolate is a substantial difference, the Invention 1 cannot be said to have been easily conceived by a person skilled in the art based on the descriptions of A-2 to A-6 described in A-1, which had been distributed before the priority date of the application for the Patent as described below. ...."

(See the items, "No. 6 Judgment by the body," "2 Regarding Reasons for invalidation 1," and "(4) The Invention 1 [4].")

E Further, in the dismissal of a claim (2012 (Gyo-Ke) 10177 that the demandant demanded revocation of the second trial decision, the Intellectual Property High Court held as follows regarding inventive step.



"(3) Judgment on inventive step

A The detergent composition of the Invention 1 consists of three components of sodium hydroxide, aspartate diacetate and/or glutamate diacetate, and sodium glycolate, and the sodium glycolate is one of the major three components. Meanwhile, the metal ion-sealing composition of the cited invention 1b is not only different in constituent components from the detergent composition of the Invention 1 in terms of not containing sodium hydroxide that is one of the major three components of the detergent composition of the Invention 1, but also different therefrom in that sodium glycolate was understood to be an impurity generated by secondary reaction in obtaining a sodium salt of glutamic acid diacetate, and to be a unnecessary component that has no effect of improving sealing capability of the metal ion-sealing composition, in terms of technical significance.

B In addition, the Invention 1 is a detergent composition consisting of three components as major components as described above. According to Table 1 in the specification of the case, the detergent composition of the Invention 1 is recognized to have a cleaning effect the same as that of a conventional detergent containing EDTA, and to have improved cleaning effect by containing sodium glycolate. Meanwhile, the metal ion-sealing composition of the cited invention 1b, which contains glutamate diacetate and sodium glycolate while not containing sodium hydroxide, is more excellent in metal-ion-sealing capability than TPP while being inferior to an EDTA tetrasodium salt according to FIGs. 1 and 2 in the A-1 document.

As described above, it can be said that by the synergetic effect obtained by containing three components of sodium hydroxide, aspartate diacetate and/or glutamate diacetate, and sodium glycolate as major components, the detergent composition of the Invention 1 has a cleaning effect the same as that of a detergent containing EDTA.

C According to the above description, while a detergent composition consisting of three components of sodium hydroxide, aspartate diacetate and/or glutamate diacetate which is amino dicarboxylic acid diacetate, and sodium glycolate as major components has an excellent cleaning effect by the synergetic effect, the A-1 document suggests nothing about this. In addition, A-2 to A-6 suggest nothing about it, either. Thus, a detergent composition's containing the above-described three components as major components and thereby having an effect of improving the cleaning effect is recognized to have an effect that cannot be expected by a person skilled in the art, and thus Invention 1 is not easily

conceivable by a person skilled in the art based on the A-1 document, and A-2 to A-6. ..."

(See the items, "No. 4 Judgment by the court," "2 Misjudgment on inventive step of the Invention 1 regarding the reasons for invalidation 1 (grounds for cancellation 1, 2)," and "(3) Judgment on inventive step.")

(3) Reasons for invalidation 1 in the trial of the case (the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act)

#### A Outline and evidence

The outline of the reasons for invalidation 1 and the submitted evidence in the trial of the case are as described above in "No. 3 Outline of the trial of the case." The evidence is described again by means of comparing the evidence with the evidence submitted in the second trial, which is as described below;

#### NOTES

Evidence A No. 1 "Introductory chelate (the second revised edition)"

(Newly submitted evidence)

Evidence A No. 2 Japanese Unexamined Patent Application Publication No. H7-238299

(Evidence A No. 3 in the second trial)

Evidence A No. 3 Specification of United Kingdom patent application No. 1439518

(Evidence A No. 1 in the second trial)

Evidence A No. 4 Japanese Unexamined Patent Application Publication No. S50-3979

(Evidence A No. 2 in the second trial)

#### B Major facts (the main cited invention and the like)

(A) The gist of the reasons for invalidation is described in the table, "(1) Abstract of the

grounds for the request," on the second page in the written demand of the trial of the case.

"While a 2% or more NaOH aqueous solution to which EDTA is added as a chelating agent is regularly used in cleaning surfaces of metal or glass bottles, there is a known problem in that the solution is low in biodegradability (A-1).

In order to solve this problem, using a complexan type chelating agent, like EDTA, together with 1 to 5% by weight of sodium hydroxide was proposed (A-2).

In order to solve the problem of EDTA's biodegradability, a detergent composition called OS<sub>1</sub> that contains a sodium salt of glutamic acid diacetate and sodium glycolate was disclosed (A-3).

The fields of application of the detergents according to A-1, A-2, and A-3 are glasses and surfaces of metal.

Therefore, the invention of Claim 1 could be easily conceived by a person skilled in the art based on the inventions described in Evidence A No. 1, Evidence A No. 2, and Evidence A No. 3."

(B) Details thereof are explained as follows in the article, "(C) Comparison between the invention of Claim 1 of the case (hereinafter referred to as the Invention of the case) and the prior art invention," on pages 12 to 16 in the written demand of the trial of the case.

"(C) Comparison between the invention of Claim 1 of the case (hereinafter referred to as the Invention of the case) and the prior art invention

(C-1) ...a 2% or more NaOH aqueous solution to which EDTA or NTA is added as a chelating agent is regularly used in cleaning surfaces of glass bottles.

However, ... there is a problem in that EDTA and NTA are not degraded by microorganisms.

(C-2) The invention to solve the problem is described in Evidence A No. 2.

... The invention of Evidence A No. 2 is to provide a composition for cleaning a hard surface that has excellent detergency, is more degraded by microorganisms, and is suitable for cleaning glass products such as glass bottles and metallic products such as tanks and pipes in factories. The invention is a composition for cleaning a hard surface that contains an alkali metal hydroxide, a gluconate, and hydroxyethyl iminodiacetate as active ingredients.

It is preferable to use sodium hydroxide as an alkali metal hydroxide, and it is used in the range of 1 to 5%.

(C-3) ... Evidence A No. 3 discloses a method for manufacturing a chelating agent that is

easily degradable biologically as a chelating agent that is an alternative to EDTA ..., and a metal ion-sealing composition that is easily degradable biologically based on a dicarboxylic amino acid is disclosed in Evidence A No. 3. A 'sodium salt of N, N-dicarboxymethyl-2-amino-pentane diacid' that is a specific example of 'salt of N, N-dicarboxymethyl-2-amino-pentane diacid' in Claim 1 of Evidence A No. 3 is the same substance as the sodium salt of a glutamic acid diacetate in the Invention of the case. ...

While obtained by the reaction described in Claim 1, the salt of N, N-dicarboxymethyl-2-amino-pentane diacid can be used as a metal ion-sealing composition without purifying the reaction solution containing a reaction product. ... Such a metal ion-sealing composition that is not purified is called OS<sub>1</sub>, and contains 60% by weight of sodium salt of N, N-dicarboxymethyl-2-amino-pentane diacid and 12% by weight of sodium glycolate.

...

While, conventionally, a 2% or more NaOH (sodium hydroxide) aqueous solution to which EDTA of a complexan type is added as a chelating agent is regularly used in cleaning surfaces of metal or glass bottles as in Evidence A No. 1 as described above, there is a known problem in that the solution is low in biodegradability, it is proposed in Evidence A No. 2 that 1 to 5% by weight of a sodium hydroxide aqueous solution to which a chelating agent that is of a complexan type as above but excellent in biodegradability is added is used instead in cleaning surfaces of metal or glass bottles, and in such a circumstance, it is easily conceived by a person skilled in the art to use OS<sub>1</sub> containing a chelating agent as a main component that is described in Evidence A No. 3 and of a complexan type as above but excellent in biodegradability together with a 2% or more sodium hydroxide in cleaning surfaces of metal or glass bottles.

...

Evidence A No. 1 is a book for reference taught at the school level entitled 'Introductory chelate chemistry,' and demonstrates common general technical knowledge at the time of 1988.

...

As known from Evidence A No. 1 and Evidence A No. 2, the Invention of the case merely named sodium hydroxide as a typical alkaline substance to bring a complexan type chelating agent under an alkaline condition.

...

While described above is a case where the tertiary amine is a glutamine acid, a case where the tertiary amine is an asparagine acid is described in Evidence A No. 4 on the

second page, the upper-right column, ll. 13 to 15.

Therefore, the invention of Claim 1 of the case could be easily conceivable by a person skilled in the art based on the inventions of Evidence A No. 1 and Evidence A No. 2 and the invention of Evidence A No. 3, or based on the inventions of Evidence A No. 1 and Evidence A No. 2 and the inventions of Evidence A No. 3 and Evidence A No. 4, and cannot obtain a patent in accordance with the provisions of Article 29 (2) of the Patent Act, and therefore the patent should be invalidated under the provisions of Article 123(1)(ii) of the Patent Act."

(C) Accordingly, the "main cited inventions" or the major facts relating to the reasons for invalidation of this trial can be said to be an invention relating to a metal ion-sealing composition that is referred to as "OS<sub>1</sub>" described in Evidence A No. 3 (or Evidence A No. 4), which is understood to be the "main cited invention" in the above-described second trial (the above-described "cited invention 1b").

In addition, the technical matter that is proved as "well-known arts" is understood to be "using a complexan type chelating agent (made of an aminocarboxylic acid derivative) together with sodium hydroxide in the field of a detergent" that is described in Evidence A No. 1 and Evidence A No. 2. As the above-described complexan type chelating agent used together with sodium hydroxide, EDTA and NTA are specifically indicated in Evidence A No. 1, while hydroxyethyl iminodiacetate is specifically indicated in Evidence A No. 2, and these belong to tertiary amine derivatives, and thus the true nature of the well-known arts can be said to be an art of using a chelating agent that is a tertiary amine derivative and sodium hydroxide together, and thus can be understood to be a technical matter that is substantially the same as the well-known arts that "sodium hydroxide is added to a detergent containing a chelate agent that is a tertiary amine derivative" in the above-described second trial.

Further, the "decision-making processes" to derive a conclusion about inventive step are understood to be a decision-making process through which the Invention 1 could be easily conceived by a person skilled in the art based on the main cited inventions under the existence of the above-described well-known arts, and thus it is understood that the decision-making processes to derive a conclusion about inventive step are common to the trial of the case and the above-described second trial.

(D) Evidence A No. 3 and Evidence A No. 4 (which respectively correspond to Evidence A No. 1 and Evidence A No. 2 in the second trial) can be said to be evidences to prove that

the above-described "main cited invention" exists (it is to be noted that the fact that Evidence A No. 4 discloses the same content as Evidence A No. 3 is as already explained above), and Evidence A No. 1 and Evidence A No. 2 can be said to be evidences to prove that the above-described "the well-known arts" exist.

It is to be noted that Evidence A No. 1 is merely a "reference book for students" that indicates the background of the art (technical problem) described in Evidence A No. 2; that is, indicates that some chelating agents belonging to a tertiary amine derivative are inferior in biodegradability (EDTA or the like), and those chelating agents were conventionally used commonly (this is what the demandant agrees with), and thus Evidence A No. 1 is only to reinforce or assist the existence of the "well-known arts" proved by Evidence A No. 2.

#### (4) Judgment as to the "same facts"

Comparing the major facts (the main cited invention and the like) relating to the second trial and the trial of the case described above, it can be said that the two allege inventive step of the Invention 1 based on the main cited invention under the existence of the above-described well-known arts in the detergent that is obtained by "adding a chelate agent that is a tertiary amine derivative and sodium hydroxide" to the invention relating to a metal ion-sealing composition called "OS<sub>1</sub>" (to which the above-described "cited invention 1b" corresponds) that is derived from United Kingdom patent application No. 1439518 (or Japanese Unexamined Patent Application Publication No. S50-3979) as the main cited invention.

Thus, the facts on which the invalidation of Patent 1 is based according to the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act in the trial of the case have been already alleged in the second trial, and can be evaluated to be substantially the same as the facts subjected to the trial as described in "4(2) D" described above, and thus it has to be said that the trial of the case is the demand for trial based on the same facts as the second trial. In addition, even the decision-making processes to derive a conclusion about inventive step are common to the trial of the case and the second trial.

#### (5) Judgment as to the "same evidence"

As to whether or not the trial of the case is based on the same evidence as the second trial, while the two are based on the same evidence to prove that the main cited invention exists, they are based on different evidences to prove that the well-known arts exist as described above.

The well-known arts are said to be a common general technical knowledge, and to be generally known in the art; for example, there are quite a few publicly known documents relating to the well-known arts (i.e., evidences can be submitted easily), or to be known well in the industry or to be known well to such an extent that they are understood without examples (i.e., there is no necessity to indicate evidences).

In order that the demand for trial is regarded to be a legitimate demand for trial based on new "evidences" as not violating the provisions of Article 167 after revision, it is not admitted so only if evidences that are different from the ones submitted in the former demand for trial for invalidation are submitted as a matter of form, but it can be said that the newly submitted evidences need to be substantially worth proving new facts other than the facts that support the past reasons for invalidation as having already been explained in "2 precondition" described above; however, in view of the understanding relating to the significance of the above-described "well-known arts," if there is an evidence to prove the same fact in evaluating similarities of the evidences to prove that the well-known arts exist unless there are special circumstances in spite of the presence or absence, the number, or differences and similarities of the contents of the evidences, or even if evidences do not necessarily have to be submitted, the evidences should not be prevented from being substantially evaluated to satisfy the requirement for the "same evidences" prescribed in Article 167 of the Patent Act.

Now this understanding is applied to the evidences of the trial of the case and the evidences of the second trial. The existence of the "well-known arts" that the two are trying to prove by showing the means of proof relates to the same technical matters as described above, and also a part of the evidences themselves (Evidence A No. 2 in the trial of the case and Evidence A No. 3 in the second trial) is identical to the two, and thus it is adequate to evaluate that the evidences fall under the category of the "same evidence."

In addition, it is not especially necessary to submit evidence different from the ones relating to the well-known arts of the second trial decision when the trial of the case was demanded, because the existence of the "well-known arts" itself is already recognized in the second trial decision; however, if a demand for such a second-time trial for invalidation is permitted, the specific well-known arts that were judged in the trial and also recognized can avoid applicability of the requirement for the "same evidence" stipulated in the principles of prohibition of double jeopardy only if a part of the evidences on which that recognition is based is changed despite the fact that the main cited inventions that constitute the major facts are the same in the former final and binding decision, which means repeatedly demanding trials for invalidation is made possible by changing the evidences one after

another, allowing a demand against the purport of the principles of prohibition of double jeopardy that prevents the above-described repeating demand, and thus, judging in that light, there is no reason not to evaluate that the evidences do not fall under the category of the "same evidence."

Thus, each of the above-described evidences submitted in the trial of the case is not beyond the range of evidence submitted against the judgement proscribing the allegation by the demandant in the second trial decision for the purpose of reiterating the judgement.

As described above in "4(3)B(C),(D)," Evidence A No. 1 submitted as a new evidence in the trial of the case is what the second trial decision tried to prove as to the existence of the specific well-known arts that were already subjected to the trial, or otherwise, Evidence A No. 1 is only to explain at most the background of the art (technical problem) described in Evidence A No. 2 (already submitted as Evidence A No. 3 in the second trial), and thus only to reinforce or assist in proving the existence of the specific "well-known arts." Thus, Evidence A No. 1 can never be substantially evaluated to be evidence worth proving new facts other than the facts that support the past reasons for invalidation, so that the trial of the case is nothing other than being based on the same evidence as the second trial.

In addition, in the case of the trial of the case, the above-described specific "well-known arts" can be regarded as a portion of common general technical knowledge that was used in particularly explaining decision-making processes through which a conclusion that the Invention could be easily conceived by a person skilled in the art based on the main cited inventions is derived in applying the provisions of Article 29(2) of the Patent Act. If so, the fact that the specific "well-known arts" exist is not the major facts prescribed in Article 29(2) of the Patent Act, and as a result thereof, the evidence to prove it would lack a precondition to judge whether or not the evidence is applied to the "same evidence" prescribed in Article 167 of the Patent Act in the first place.

Thus, the judgment whether or not the demand for trial of the case is applied to the requirement for the "same facts" prescribed in Article 167 of the Patent Act does not depend on whether or not the evidence is the same in whole or in part, and even taking this into consideration, the conclusion demonstrated by the body is not changed.

#### (6) Summary

As discussed above, since the reasons for invalidation 1 of the trial of the case (the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act) regarding Patent 1 are based on the same facts and the same evidence as those of the



reasons, which had been examined in the second trial for invalidation, the trial of the case should be said to be demanded against the effect of prohibition of double jeopardy of the second trial decision.

#### No. 5 Summary

As described above, the reasons for invalidation 1 (the reasons for invalidation prescribed in the provisions of Article 29(2) of the Patent Act) and the reasons for invalidation 2 (the reasons for invalidation prescribed in the provisions of Article 36(6)(i) of the Patent Act) regarding Patent 1 had been thoroughly examined in the second trial and in the first trial respectively. Then, the same arguments will be repeated since the trial will be conducted on the basis of the same facts and the same evidence as those in the preceding trials. Therefore the demand for the trial shall be an illegitimate demand for trial made in violation of the principle of prohibition of double jeopardy stipulated in the provisions of Article 167 of the Patent Act. Thus, the demand for trial of the case should be dismissed under the provisions of Article 135 of the Patent Act.

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

Concerning the costs in connection with the trial, the provisions of Article 61 of the Code of Civil Procedure which is applied mutatis mutandis in the provisions of Article 169(2) of the Patent Act shall be applied, and the trial decision shall be made as described in the conclusion.

September 16, 2014

Chief administrative judge: YAMADA, Yasushi

Administrative judge: HIBINO, Takaharu

Administrative judge: SUGANO, Yoshio