

Trial decision

Invalidation No. 2015-800103

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The case of the patent invalidation trial between the above parties on Japanese Patent No. 3277180, entitled "Double Eyelid Forming Tape or String and Method of Manufacturing the Same" has resulted in the following trial decision:

Conclusion

The appeal of the case was groundless.

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

Reason

No. 1 History of the procedures

May 29, 2001: Filing of a patent application (claiming a priority based on an application with the priority date of October 3, 2000)

February 8, 2002: Establishment of registration of the Patent (Japanese Patent No. 3277180)

July 26, 2011: Filing of the request for the invalidation trial (1)(Invalidation No. 2011-800133)

January 16, 2012: Trial decision dismissing the request for the above invalidation trial (1), which became final and binding.

September 14, 2011: Filing of the request for the invalidation trial (2) (Invalidation No. 2011-800174)

March 14, 2012: Trial decision dismissing the request for the above invalidation trial (2), which became final and binding.

February 22, 2013: Filing of the request for the invalidation trial (3) (Invalidation No. 2013-800032)

August 30, 2013: Trial decision dismissing the request for the above invalidation trial (3), which became final and binding.

April 1, 2015: Filing of the request for the invalidation trial of the case

June 19, 2015: Submission of the written reply of the trial case

July 2, 2015: Notification of matters to be examined (1)

August 6, 2015: Submission of an oral proceedings statement brief by the demandee (1)

August 7, 2015: Submission of an oral proceedings statement brief by the demandant (1)

August 10, 2015: Notification of matters to be examined (2)

August 31, 2015: Submission of an oral proceedings statement brief by both parties (2)

September 3, 2015: Oral proceeding

September 17, 2015: Submission of a written statement by the demandant

The evidence will be abbreviated as "Evidence A No. 1" for "demandant's Exhibit No. 1," and the oral proceedings statement brief will be abbreviated as "statement brief."

Articles of the Patent Act may be mentioned in this trial decision without an explicit indication of "Patent Act."

No. 2 The Invention

The invention according to claim 1 of the Patent of the case (hereinafter referred to as "Invention 1") is identified as follows.

"[Claim 1] A double eyelid forming tape comprising a narrow tape member formed of synthetic resin that is stretchable and exhibits resilient elasticity after being stretched, and an adhesive applied on the narrow tape member."

No. 3 The demandant's allegation

1 Summary

The demandant has sought a trial decision to the effect that the patent regarding the invention according to claim 1 of the case is invalidated. The outline of the reasons is as follows.

(1) Reasons for invalidation 1 (Article 29(2))

Since Invention 1 of the case could have been easily made by a person skilled in the art prior to filing of the patent application of the Patent of the case on the basis of the invention described in Evidence A No. 2 (United states Patent No. 4,653,483), the invention of the case is not patentable under the provision of Article 29(2) and therefore the Patent regarding Invention 1 of the case should be invalidated as falling under Article 123(1)(ii).

(2) Reasons for invalidation 2 (Article 36(6)(i))

Since Invention 1 of the case is not the one that is described in the detailed description of the invention, the description of Invention 1 of the case fails to comply with the provision of Article 36(6)(i) and therefore the Patent regarding Invention 1 of the case should be invalidated as falling under Article 123(1)(iv).

(3) Reasons for invalidation 3 (Article 36(6)(ii))

Since Invention 1 of the case is not clear, the description of Invention 1 fails to comply with the provision of Article 36(6)(ii) and therefore the Patent regarding invention 1 of the case should be invalidated as falling under Article 123(1)(iv).

2 Means of proof

The evidence presented by the demandant is as follows.

Evidence A No. 1: Japanese Patent No. 3277180

Evidence A No. 2: United States Patent No. 4,653,483

Evidence A No. 3: An abridged translation of demandant's Exhibit No. 2

Evidence A No. 4: Unabridged Genius English-Japanese Dictionary 2001 published on April 25, 2001, TAISHUKAN Publishing Co., Ltd.

Evidence A No. 5-1: A document titled "3M(TM) Surgical Tapes" (a brochure of 3M), 2003

Evidence A No. 5-2: An abridged translation of Evidence A No. 5-1

Evidence A No. 6: A document titled "Technical Report" created by Noboru KODA, Skin Wound Care Product Technical Department, 3M Health Care, Co., Ltd., January 22, 2015

Evidence A No. 7: A document titled "With regard to the question about our Technical Report" created by Takahiro KASAHARA, head of the Skin Wound Care Product Technical Department, Technical Headquarters, 3M Health Care, Co., Ltd., March 10, 2015

Evidence A No. 8: Encyclopedia of Chemistry, eighth abridged version published on September 20, 1977, Kyoritsu Shuppan Co., Ltd.

Evidence A No. 9: Japanese Supreme Court Decision by Second Petty Bench on March 8, 1991

Evidence A No. 10: Supreme Court Researcher Comments (Civil Law 1991, Pages 28 to 50)

Evidence A No. 11: Tokkyo Hanrei Hyakusen (100 Patent Precedents) (fourth edition) (Bessatsu Jurist No. 209), Pages 124 to 125

Evidence A No. 12: New Commentary on Patent Act (Volume I), April 26, 2011, Seirin Shoin Co., Ltd., Pages 302 and 658

Evidence A No. 13: Intellectual Property High Court Decision on August 31, 2010

Evidence A No. 14: A document titled "Announcement of Change of 3M Health Care's Company Name" created by 3M Japan Co., Ltd., Koichi MIMURA, President and CEO of 3M Health Care, Co., Ltd., April 2015

Evidence A No. 15: A document titled "With regard to the additional question about our Technical Report" created by Takahiro KASAHARA, head of the Skin Wound Care Product Technical Department, Technical Headquarters of 3M Health Care Company, 3M Japan Co., Ltd. created on August 21, 2015

Among the above means of proof, Evidence A Nos. 1 to 8 had been attached to the written demand for trial (which may be hereinafter simply referred to as "the written

demand") whilst the remaining materials are those that were subsequently submitted. Also, with regard to the validity of the means of proof, there is no dispute between the parties (Subsection 1 in the "demandee" section of the record of oral proceeding).

3 Summary of the Allegations

The following is a summary of the allegations by the demandant.

(1) Reasons for invalidation 1 (Article 29(2))

Identification of (the technical matters of) Invention 1 should be made in a literal manner based on its claim language in view of the Judgement by the Supreme Court of Japan (Evidence A No. 9). It is not allowed to identify (the technical matters of) the invention based on limitative interpretation of the claim language.

Evidence A No. 2 describes an invention related to a double-sided adhesive tape strip for application to an upper eyelid to retain a fold in the skin thereof.

In addition, as the material for this double-sided adhesive tape strip, there is used 3M's tape with the product ID of No. 1512-3, whose polyethylene film is coated with a hypoallergenic, synthetic, acrylate based pressure sensitive adhesive applied on each side thereof.

Here, according to the brochure of the United States 3M Health Care (Evidence A No. 5), it is appreciated that, in the context of Evidence A No. 2, 3M's product with the product ID of No. 1512 whose width is three inches (the tape having a polyethylene film on both sides of which the adhesive is applied) is cut and thus the double-sided adhesive tape strip is formed.

Accordingly, Invention 1 differs from the invention of Evidence A No. 2 in the following features.

(The different feature 1)

Invention 1 uses the synthetic resin "which is stretchable and exhibits resilient elasticity after being stretched" whilst the invention of Evidence A No. 2 does not identify such a synthetic resin.

(The different feature 2)

Invention 1 comprises "a narrow tape member with an adhesive applied thereon" whilst the invention of Evidence A No. 2 uses an adhesive tape comprising a polyethylene film (substrate) on both sides of which an adhesive is applied in advance, which is cut into a thin shape, and accordingly the adhesive is not applied on a narrow tape member.

The different feature 1 is first examined.

Evidence A No. 6 shows the test results where the same substrate (polyethylene film) as that of the product ID No. 1512 is used (Evidence A No. 7) and the film is stretched using a load so that it has a predetermined length, and then the load is released. It is appreciated that the polyethylene film, which is the substrate of the product with the product ID of No. 1512, is "stretchable and exhibits resilient elasticity after being stretched."

Hence, the different feature 1 does not constitute a substantial difference.

If it is assumed, *arguendo*, that the different feature 1 is the substantial difference, it would have been easily arrived at by a person skilled in the art by combining (the latter invention with) the publicly worked invention (it has been possible that the fact that the substrate of the double-sided adhesive tape with the product ID No. 1512 is stretchable and exhibits resilient elasticity after being stretched" becomes publicly known).

With regard to the different feature 2, it is merely a design matter that should be defined as appropriate by a person skilled in the art whether a narrow tape member is constructed from a synthetic resin substrate (e.g., polyethylene) on which an adhesive is applied in advance or from a substrate formed into a narrow tape material on which an adhesive is subsequently applied.

(2) Reasons for invalidation 2 (Article 36(6)(i))

The "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" of Invention 1 can be interpreted as encompassing all possible synthetic resins that have the property of being stretchable and the property of being resiliently contracted after being stretched. Meanwhile, the detailed description of the invention only describes "a synthetic resin that is stretchable and has a contractive force causing the tape member to be elastically restored to its original state even in a state where the tape member is stretched and attached to the eyelid (a contractive force to such an extent that the resiliently contracted tape member is made to dig into the eyelid on which it is attached when being pressed against the eyelid and the double eyelid is formed by virtue of the contraction of the tape member itself). "

The "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" encompasses synthetic resins that are not described in the detailed description of the invention, such as a synthetic resin that loses the contractive force for elastic restoration when it is stretched to be placed in a state where it is ready to be attached to the eyelid and a synthetic resin that has the contractive force for elastic restoration but does not have a sufficient contractive force that allows the double eyelid

to be formed by virtue of the contraction of the synthetic resin itself. It is not possible to recognize that the problem addressed by Invention 1 is solved using these synthetic resins.

(3) Reasons for invalidation 3 (Article 36(6)(ii))

In the detailed description of the invention, the conditions such as the method of stretching and the degree of stretching are limited to the statement that "a state where it is stretched and placed to be ready to be attached to the eyelid (a case where it is pressed against the eyelid)."

Meanwhile, the "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" of Invention 1 can encompass every possible synthetic resin that has the property of being resiliently contracted after being stretched regardless of the conditions such as the method of stretching and the degree of stretching, which renders Invention 1 unclear.

Since Invention 1 includes a chronological element that involves the action of "applying," Invention 1 is (an invention that is defined by) a "product-by-process claim" (Evidence A No. 12). However, there are no "circumstances where it was impossible or utterly impractical to directly define the product subject to the invention by means of its structure or characteristics."

Therefore, in view of the frame of reference defined in the Judgement of the Supreme Court of Japan (June 5, 2015), Invention 1 fails to comply with the requirement that "the invention be clear."

No. 4 The demandee's allegation

1 Summary

In response to the demandant's allegations, the demandee seeks a trial decision to the effect that the appeal of this case is groundless.

2 Means of proof

The evidence submitted by the demandee is as follows. With regard to the validity of the evidence, there is no dispute between the parties (Subsection 1 in the "demandant" section of the record of oral proceeding).

Evidence B No. 1: Judgment document of the suit (2012 (Gyo-Ke) No. 10133) against the trial decision of Invalidation No. 2011-800174

Evidence B No. 2: Microfilm of Japanese Utility Model Application No. S61-24573

(Japanese Unexamined Utility Model Application Publication No. S62-136545)

Evidence B No. 3: Trial decision document of Invalidation No. 2013-800032

Evidence B No. 4: Toshiaki IIMURA "On Identification of the Claimed Invention of a Patent Application and Claim Construction" (New Trends of Intellectual Property Law in Professor Eiji Katayama's Sexagenarian Memorial Essays, Pages 35 to 51)

Evidence B No. 5: Yoshiaki AIDA, "On Identification of the Technical Matters of an Invention" (Patent 2011, Vol. 64 No. 2, Pages 89 to 94)

Evidence B No. 6: Examination Guidelines for Patent and Utility Model in Japan

Evidence B No. 7: Japanese Unexamined Patent Application Publication No. H11-318558

Evidence B No. 8: Japanese Utility Model Registration No. 3043151

Evidence B No. 9: Japanese Utility Model Publication No. S51-1986

Evidence B No. 10: Akitoshi HIROE, Masanobu MOTOYOSHI, "Introduction to Physical Properties of Plastics for Molding Process Engineers," Pages 61 to 79 (Nihon Kogyo Shimbun, Ltd.)

Evidence B No. 11: National Publication of International Patent Application No. H8-505593

Evidence B No. 12: "Stretch Shrink Packages" (Training and Education Committee of Federation of Packing Industry Associations of Japan)

Evidence B Nos. 13-1 to 3: Tension Test Results of "Mezaik" in which the Invention is worked (Tokyo Metropolitan Industrial Technology Research Institute)

Evidence B No. 14: A photograph (a copy) of "Mezaik" in which the Invention is worked

Evidence B No. 15-1: A photograph (a copy) of the "Mezaik" in a stretched state and a tape of the sample A

Evidence B No. 15-2: Specification (a copy) of the "Mezaik" and the tape of the sample A

Evidence B Nos. 16-1 and 2: A photograph (a copy) of the "Mezaik" in a state where it is attached to the eyelid

Evidence B Nos. 17-1 to 3: A photograph (a copy) showing the method of attaching the tape of Sample A to an eyelid and its attached state

Evidence B No. 18: Japanese Patent No. 4692943

Evidence B No. 19: Japanese Patent Publication No. H07-45766

Evidence B No. 20: Japanese Patent Publication No. H03-2963

3 Summary of Allegations

The following is a summary of the allegations by the demandee.

(1) Reasons for invalidation 1 (Article 29(2))

Since Invention 1 relates to a "synthetic resin tape" whose usage is limited to the "double eyelid forming tape," the meanings of its terms should be reasonably interpreted in light of the above usage and taking into account the definitions and explanations stated in the Description and illustrated in the drawings as well as the common technical knowledge related thereto.

The demandant alleges that (the technical matters of) the invention should be identified in a literal manner according to the so-called "Lipase Judgment," but such an allegation is not found in the Lipase Judgment itself (Evidence A No. 9) or the Supreme Court researcher's comments (Evidence A No. 10).

The cosmetic tape of Evidence A No. 2 is nothing but a tape by which a fold is formed in a fixed manner by simply bonding the folded skins of the eyelid to each other with the double-sided adhesive tape.

Evidence A No. 2 in no way discloses the feature of Invention 1 of "being stretchable and exhibits resilient elasticity after being stretched;" i.e., "forming a fold of a double eyelid on the eyelid using the resilient elasticity of the tape member after being stretched" and there is no statement therein that would suggest such content.

The elongated strip of Evidence A No. 2 has the varying width with curved or arcuate longitudinal edges so as to readily conform to the three-dimensional contours or shape of the skin forming the upper eyelid, and cosmetic surgery is performed using such a shape. Accordingly, when the above shape is stretched and deformed, then the use of the above shape of the cosmetic tape will have to be abandoned. It is clear that (the invention of) Evidence A No. 2 is intended as one that is not deformed in use by stretching or the like.

Although the demandant alleges that the different feature 2 is identified, it cannot be said that Invention 1 includes a manufacturing procedure, and the allegation by the demandant is constructed based on an erroneous premise.

(2) Reasons for invalidation 2 (Article 36(6)(i))

In light of the statements associated with the function and effects of the double eyelid forming tape in Paragraphs 0008, 0009, and 0032 of the Description as well as the circumstances at the time of filing of the patent application of the case as shown in Evidence B Nos. 7 to 9, it is clear that the "synthetic resin which is stretchable and

exhibits resilient elasticity after being stretched" in Invention 1 refers to the concept that the synthetic resin "exhibits resilient elasticity contributing to formation of a fold of a double eyelid by digging into the eyelid even after being stretched."

It is also clear that the function and effects of Invention 1 are consistent with the problems that Invention 1 addresses as stated in Paragraph 0003 of the Description; i.e., providing a double eyelid forming tape for forming an eyelid with a clear fold in a simple manner; providing a double eyelid forming tape that can form a fold directly on the eyelid so that a natural double eyelid is obtained; and providing a double eyelid forming tape which allows the operation of forming a double eyelid to be safe and easy.

Evidence B No. 10 makes reference to general mechanical properties of synthetic resins (in particular tensile characteristics) and illustrates the basic shapes (types) of tensile stress-distortion (elongation) curves of materials and the characteristics and representative examples of synthetic resins that belong to the specific types of the curves.

When the "stretchable synthetic resin" of Invention 1 is examined in this context, it belongs to the classification D which corresponds to a synthetic resin having a tensile strength (tensile stress at the time of fracture) and tensile elastic modulus (tensile stress/extension) that are relatively small when compared with other synthetic resins but exhibiting a larger elongation (the amount of distortion at the time of fracture) (in other words, a soft and robust synthetic resin). The example of the "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" described in Paragraph 0010 of the Description is also polyethylene.

In view of the above, the "stretchable synthetic resin" of Invention 1 can be interpreted as denoting a predetermined limited range of synthetic resins including "polyethylene."

The descriptions of Invention 1 do not involve a manufacturing method, and, when the descriptions of the Description and the drawings as well as common technical knowledge are taken into account, they only identify the structure by pointing out the state of a substance in the similar manner as in Evidence B Nos. 18 to 20. It is clear that Invention 1 is not one that is identified by a "product-by-process claim."

(3) Reasons for invalidation 3 (Article 36(6)(ii))

Paragraph 0008 of the Description explicitly states that, according to Invention 1, "both ends of the tape member are held and stretched into a resiliently stretched state, and in this state, the portion of the tape member having adhesive is placed and pressed at the position of an eyelid where a user wants to form a fold, and the tape member is

adhered using the adhesive." In view of this fact, it is clear that Invention 1 is one that is stretched by holding both ends of the tape member and thus pulling the tape member, at the time of which the tape member is pressed at the position of the eyelid where the user wants to form the fold (of the double eyelid) in the eyelid, and stretched to a length that is sufficient for allowing the tape member to be attached to the position of the eyelid.

Also, as stated in the above subsection (2), it is clear that the "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" of Invention 1 refers to the concept that the "synthetic resin that exhibits resilient elasticity contributing to formation of a fold of a double eyelid by digging into the eyelid even after being stretched."

No. 5 Judgment by the body regarding reason for invalidation 1 (Article 29(2))

1 Invention of the case

Invention 1 of the case is recognized as identified in the above section No. 2 in view of the descriptions of the Description and the drawings.

2 Evidence A No. 2

With regard to "Cosmetic tape, applicator therefor and method," Evidence A No. 2, which was submitted by the demandant, describes the following matters with reference to the drawings.

(A) Column 1, Lines 11 to 17

"The present invention relates to precut, preshaped adhesive tape strips or members for application to an upper eyelid to retain a fold in the skin thereof, an applicator device for facilitating placement of such an adhesive member on the skin surface of the eyelid, and a method for use of the tape strip nonsurgically taking a tuck in loose skin, such as at the upper eyelid."

(B) Column 2, Lines 46 to 59

"The tape strip member has a backing of hypo-allergenic material and adhesive such as to make the strip very thin, very soft and pliable, strong, tear resistant, easily conformed to body contours, non-irritating, and water resistant. The skin of the upper eyelid is folded down over the adhesive strip and attached to the exposed adhesive on the other side of the adhesive strip; and, the folded skin of the upper eyelid folded back upon itself with its edge along the bottom edge of the adhesive strip to form an artificial super

tarsal fold which is deeper and higher than the natural fold. The application of the tape strip is facilitated by the use of an applicator device which releasably carries the tape strip to the eyelid."

(C) Column 3, Lines 43 to 61

"Turning first to FIG. 5, a simplified drawing through the upper eyelid 10 in conjunction with an eyeball 12 is shown, depicting the desired objective of the present invention; that is, if the natural super tarsal fold in the upper eyelid 10 is replaced by a deeper artificial super tarsal fold, an effective tuck will be taken in the loose skin of the upper eyelid 10. According to the present invention, a very thin strip of double-sided adhesive tape 32 generally less than 1 cm in width and 4 cm in length is attached to the upper eyelid 10 with the bottom edge spaced about 8-12 mm above the ciliary margin 20 and/or the top edge above the fold line of the natural super tarsal fold. The skin above the adhesive strip 32 is then folded down and then back upon itself as shown in FIG. 5 with the bottom edge of the skin aligned along the bottom edge of the tape strip 32. The adhesive strip 32 maintains the deeper and higher artificial super tarsal fold thus formed in the desired position."

(D) Column 5, Lines 39 to 53

"Another example of a strip member 32 suitable for use in the present invention is that made by the Minnesota Mining & Manufacturing Co. (3M) of St. Paul, Minn. under specification No. 1512-3 of August, 1981. In such a 3M tape, the strip material may comprise a backing material of transparent polyethylene film having a thickness of 1.5 mils. The adhesive coating or lamina on each side surface of the backing material may be a hypoallergenic, synthetic, acrylate based pressure sensitive adhesive. The thickness of the backing material and the adhesive lamina on opposite side surfaces thereof may result in a thickness of about 3 mils. The backing material of polyethylene film in the 3M example is generally occlusive and is suitable for use for relatively short periods of time."

(E) Column 5, Lines 54 to 62

"Liner sheet 44 may be a skin bleached two-sided silicone treated polyethylene coated paper of a suitable basis weight. Examples of strip members 32 as described above comprising a backing material and adhesive lamina may be cut into a shape to provide an elongated strip of varying width with curved or arcuate longitudinal edges to readily conform to the three-dimensional contours or shape of the skin forming the upper

eyelid."

(F) Column 6, Lines 18 to 30

"Practice of the method of this invention; namely, attaching one side of an adhesive strip member having adhesive on both sides along one surface of the intended tuck area, folding the skin of the intended tuck area over the adhesive strip, and attaching it to the exposed adhesive on the other side of the adhesive strip, is facilitated by the use of an applicator device as shown in FIGS. 16, 17, and 18. FIG. 16 is similar to FIG. 7 in the illustration of the pulling back of the loose upper eyelid skin 10 by a finger and positioning of the strip member 32 on the eyelid skin surface substantially as shown in FIG. 7. In FIG. 16, the strip member 32 is shown as being applied by an applicator device 70."

Accordingly, it is noted that the following invention (hereinafter referred to as "the invention of Evidence A No. 2") is described in Evidence A No. 2.

"A double eyelid forming tape strip 32 formed by 3M's polyethylene film of specification No. 1512-3 (of August 1981) wherein an adhesive is coated on the curved tape strip 32."

3 Comparison of Invention 1 with the invention of Evidence A No. 2

Invention 1 is compared with the invention of Evidence A No. 2.

The "polyethylene film" of the invention of Evidence A No. 2 corresponds to "synthetic resin" of Invention 1. Likewise, the "tape strip 32" of the former invention corresponds to the "narrow tape member" and "is coated" to "comprising ... applied on" of Invention 1.

Accordingly, the corresponding feature and the different feature are as follows:

Corresponding Feature

"A double eyelid forming tape comprising a narrow tape-like member formed by synthetic resin and an adhesive applied on the tape-like member."

Different Feature

With regard to the synthetic resin, the synthetic resin of Invention 1 is "stretchable and exhibits resilient elasticity after being stretched" whilst the synthetic resin of the invention of Evidence A No. 2 is "3M's polyethylene film of the specification No. 1512-3 (August 1981)".

The demandant "does not overtly dispute" (statement brief (1), section 2(1) on Page 3) in the following point but alleges that it is a different feature as well (the above subsection 3(1) of Section No. 3).

Invention 1 comprises "a narrow tape member with an adhesive applied thereon" whilst the invention of Evidence A No. 2 uses an adhesive tape comprising a polyethylene film (substrate) on both sides of which an adhesive is applied in advance, which is cut into a thin shape, and accordingly the adhesive is not applied on a narrow tape member.

As the body examines the different features, it is noted that the Description of the case includes the following descriptions.

"[0010] [Description of Embodiments] Fig. 1 illustrates an embodiment of a double eyelid forming tape of the present invention. The double eyelid forming tape can be constructed, basically, by applying an adhesive 2 on the front and back surfaces of a resiliently elastic narrow tape member 1."

"[0013] The double eyelid forming tape described above can be manufactured with extreme ease, as illustrated in Fig. 2, by applying an adhesive 12 on the whole area of the front and back surfaces of the resiliently elastic sheet member 11 having a given length in the direction X, forming holding portions 13 having no adhesive property at both ends when viewed in the widthwise direction (direction W), and cutting it along a number of cutting lines L into narrow strips."

In other words, according to the double eyelid forming tape of the Invention of the case, basically, the adhesive 2 is applied on the front and back sides of the narrow tape member 1, which means that the adhesive is applied on each of the narrow tape members (Paragraph 0010), and, the adhesive 12 is applied on the whole area of the front and back surfaces of the sheet member 11 and cut along a number of cutting lines L into narrow strips, so that the double eyelid forming tape described above can be manufactured with extreme ease (Paragraph 0013).

As such, it is interpreted that (the invention configured for) "applying an adhesive on a narrow tape member" of Invention 1 includes both "one that applies an adhesive on a narrow tape member" and "one that applies an adhesive on a sheet member and cut it into narrow strips," and accordingly the allegation by the demandant

that this is a different feature cannot be accepted.

4 Determination

The demandant alleges with regard to the identification of (the technical matters of) Invention 1 that the requirement of "being stretchable and exhibiting resilient elasticity after being stretched" should be made in a literal manner in light of the judgment of the Supreme Court of Japan (Evidence A No. 9) and is not allowed to be interpreted in a limitative manner. This point should be first addressed.

The judgment of the Supreme Court of Japan ruled that the identification of (the technical matters of) the invention should be made, in the absence of any special circumstances, on the basis of the statements of the scope of claims attached to the patent application.

The above ruling should be examined below.

It is common technical knowledge that synthetic resin "which is stretchable and exhibits resilient elasticity after being stretched" may include various synthetic resins including a synthetic resin that cannot be substantially stretched beyond its limit (or more than a certain criterion) or a synthetic resin that can be stretched beyond its limit but does not have enough resilient elasticity for the fold to be formed by virtue of the digging (of the tape member) into the eyelid when (the tape member is) attached to the eyelid (Page 21, (3) A of Evidence B No. 1, Fig. 3.6, and Table 3.2 of Evidence B No. 10).

Invention 1 of the case is a "double eyelid forming tape" as described in claim 1. It is clear that, amongst synthetic resins "which are stretchable and exhibit resilient elasticity after being stretched," "a synthetic resin that cannot be substantially stretched beyond its limit (or more than a certain criterion) and a synthetic resin that can be stretched beyond its limit but does not have enough resilient elasticity for the fold to be formed by virtue of the digging (of the tape member) into the eyelid when (the tape member is) attached to the eyelid" do not contribute to the "double eyelid formation."

Specifically, when the synthetic resin "which is stretchable and exhibits resilient elasticity after being stretched" is interpreted in its literal sense, the synthetic resin may include a synthetic resin that does not contribute to the double eyelid formation. However, claim 1 includes the term "double eyelid forming tape." When these two terms are integrally interpreted, it is reasonable to understand that the synthetic resin "which is stretchable and exhibits resilient elasticity after being stretched" refers to a synthetic resin that contributes to the "double eyelid formation."

Also, the Supreme Court researcher's comments (Evidence A No. 10) to the above judgment of the Supreme Court includes the following statement.

"8 Meaning of "Taking into Consideration"

... (Omitted)...

The judgment of this case is intended to clarify the doctrine that, although it is necessary to scan the statements in the detailed description of the invention and the illustrations of the drawings in order to elucidate the technical content associated with the invention in the process of identification (of the technical scope) of the invention, the constituent features that are only described in the detailed description of the invention or the drawings must not be added beyond what is recited in the scope of claims when the stage is entered where the technical content has already been comprehended and the technical matters constituting (the technical feature of) the invention is now to be determined. In this context, it is allowed only in exceptional cases to take into consideration the statements of the detailed description of the invention.

9 Exceptional Cases

... (Omitted)...

In this manner, depending upon specific cases, what is more important is the specific degree to which it is permitted to ascertain that the special circumstances exist, which means that it is necessary to deliberately assess the range that is covered by the exceptional cases under the doctrine of this ruling.

The recitations in the scope of claims in the field of machinery vary depending upon the individual patent applications, including the names and terms of components and functions, and in many cases the meaning of the scope of claims cannot be fully understood without reading the statements of the detailed description of the invention of the Description and the drawings attached to the patent application, and as a result there are many cases where the statements in the detailed description of the invention are allowed to be taken into consideration and, rather, in not a few cases, the very consideration thereof is unavoidable." (Pages 39 and 40)

So far as this case is concerned, the detailed description of the invention is to be taken into consideration in order to elucidate the technical content regarding the "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" of the "double eyelid forming tape "described in the scope of claims, and this consideration of the detailed description of the invention is made in conformity to the

judgment of the Supreme Court.

Therefore, in this case, it is allowed to take the detailed description of the invention of the Description into consideration.

With regard to the "double eyelid formation," the Description of Invention 1 includes the following descriptions:

"[0008] ... (Omitted)... In order to form a double eyelid with the double eyelid forming tape, both ends of the tape member are held and stretched into a resiliently stretched state, and in this state, the portion of the tape member having adhesive is placed and pressed at the position of an eyelid where a user wants to form a fold, the tape member is adhered using the adhesive, and the holding portions at both ends are released in this state. As a result, the tape member under tension resiliently contracts. Meanwhile, since an eyelid normally projects toward the front at the center thereof along an eyeball with respect to both ends, the resiliently contracted tape member digs into the eyelid on which it is attached and forms a fold of the double eyelid. ...

[0009] In this manner, since the tape member forms a fold for making a double eyelid directly on the eyelid as described above, a natural double eyelid can be formed without puckering up the skin or leaving a print of a film on the eyelid as in the conventional methods. In addition, the double eyelid can be made just by stretching both ends of the tape member, and in this state, pressing it against the position of the eyelid where the user wants to form a fold, thereby forming a clear double eyelid in a simple manner. ...

[0010]

[Description of Embodiments] Fig. 1 illustrates an embodiment of a double eyelid forming tape of the present invention... Although, as the tape members 1 described above, any tape may be employed so long as it stretches when both ends thereof are held and pulled, and contracts resiliently to the original state upon release, it is especially preferable that the tape is formed of a synthetic resin which is stretchable and exhibits resilient elasticity after being stretched such as polyethylene... (Omitted)."

"[0016] Subsequently, a method for forming an eyelid with a fold by the use of the double eyelid forming tape having the construction described above will now be described. Fig. 3 illustrates the tape member 1 formed of synthetic resin being stretchable and exhibiting resilient elasticity even after being stretched, in a state in which the tape member 1 is stretched by holding the holding portions 3 at both ends thereof with the fingertips and stretching the same; in other words, a state where the

tape member 1 is ready to be adhered on the eyelid. In this state, the tape member 1 has a contractive force for resiliently restoring to its original state.

[0017] Then, the user pushes the portion of the tape member 1 where the adhesive 2 is applied against the eyelid 7 where he/she wants to form a fold in a state where the tape member 1 is held on the opposite ends and stretched as illustrated in Fig. 4, adheres the tape member 1 thereon by the adhesive 2, and releases the holding portions 3 at both ends, whereby the tape member 1 under tension resiliently contracts. Since the eyelid normally projects toward the front at the center thereof along the eyeball with respect to both ends, the resiliently contracted tape member 1 digs into the eyelid 7 on which it is attached and forms a fold of a double eyelid. The holding portions 3 on both ends are cut after the fold is formed.

[0018] In this manner, since the tape member 1 forms a fold for making a double eyelid directly on the eyelid 7, a natural double eyelid can be formed without puckering up the skin or leaving a print of the film on the eyelid as in the conventional methods. In addition, since the user has only to simply press the tape member 1 against the position of the eyelid 7 where he/she wants to form a fold in a state where the tape member 1 is held at both ends thereof and stretched in the opposite directions, a clear double eyelid can be formed in a simple manner... (Omitted)."

According to these statements, the Description of Invention 1 describes, with regard to the method of forming a double eyelid by the double eyelid forming tape of Invention 1, that "both ends of the tape member are held and stretched into a resiliently stretched state, and in this state, the portion of the tape member having adhesive is pressed against and adhered to the eyelid, the holding portions at both ends are released in this state, the stretched tape member resiliently contracts and the tape member thus contracted digs into the eyelid on which it is attached, and thus a fold of the double eyelid is formed."

Accordingly, when the Description is taken into consideration, synthetic resin "which is stretchable and exhibits resilient elasticity after being stretched" of Invention 1 refers to the one that contributes to the "double eyelid formation" and should be interpreted as the synthetic resin "by which a fold of a double eyelid is formed on the eyelid using the resilient elasticity of the tape member after being stretched."

Next, "3M's polyethylene film of specification No. 1512-3 (August 1981)" of the invention of Evidence A No. 2 is now examined.

Such a polyethylene film generally has a contractive property after being

stretched (Evidence A Nos. 6, 7, and 15).

Evidence A No. 2 includes the following descriptions:

"According to the present invention, a very thin strip of double-sided adhesive tape 32 generally less than 1 cm in width and 4 cm in length is attached to the upper eyelid 10 with the bottom edge spaced about 8-12 mm above the ciliary margin 20 and/or the top edge above the fold line of the natural super tarsal fold. The skin above the adhesive strip 32 is then folded down and then back upon itself as shown in FIG. 5 with the bottom edge of the skin aligned along the bottom edge of the tape strip 32." (See the above section 2.(C).)

"Examples of strip members 32 as described above may be cut into a shape to provide an elongated strip of varying width with curved or arcuate longitudinal edges to readily conform to the three-dimensional contours or shape of the skin forming the upper eyelid." (See the above section 2.(E).)

"attaching one side of an adhesive strip member having adhesive on both sides along one surface of the intended tuck area, folding the skin of the intended tuck area over the adhesive strip, and attaching it to the exposed adhesive on the other side of the adhesive strip is facilitated by the use of an applicator device as shown in FIGS. 16, 17 and 18." (See the above section 2.(F).)

In view of these statements, the polyethylene film of the invention of Evidence A No. 2 is attached to the skin in its original shape without being stretched and its shape is maintained after adhesion thereto, and in this manner the double eyelid is formed.

It cannot be said that the polyethylene film of the invention of Evidence A No. 2 is a synthetic resin "by which a fold of a double eyelid is formed on the eyelid using the resilient elasticity of the tape member after being stretched" as in the case of the synthetic resin of Invention 1 that is "stretchable and exhibits resilient elasticity after being stretched."

The invention of Evidence A No. 2 and Invention 1 differ from each other in their technical approaches regarding the double eyelid formation. If an attempt is made to stretch the polyethylene film of the invention of Evidence A No. 2, then the "curved or arcuate" shape is lost. Hence, there is no motivation to stretch this polyethylene film.

It is not possible to conclude that this different feature would have been easily

conceived.

As discussed above, the Patent regarding Invention 1 cannot be invalidated for the reason for invalidation 1.

No. 6 Judgment by the body regarding the reason for invalidation 2 (Article 36(6)(i))

1 Premise

It is understood that whether or not the recitations of the scope of claims fulfill the support requirement under Article 36(6)(i) should be determined by comparing the recitations of the scope of claims with the statements of the detailed description of the specification; and then assessing whether or not the claimed invention is the one that is described in the detailed description of the invention, and whether or not the claimed invention can be regarded as falling within the range where a person skilled in the art could have derived the invention on the basis of its recitations, or whether or not the claimed invention can be regarded as falling within the range where a person skilled in the art could have derived it on the basis of the common technical knowledge at the time of filing of the application in the absence of the recitations or suggestions (Intellectual Property High Court 2005(Gyo-Ke) 10042).

There is no dispute between the parties regarding this premise (The subsection 1 of the "Both Parties" section of the record of oral proceeding).

2 Detailed description of the Invention of the Description of the case

The detailed description of the invention of the Description includes the following descriptions.

"[0003]

[Technical Problem] An object of the present invention is to solve the above problem and provide a double eyelid forming tape or string for forming an eyelid with a clear fold in a simple manner without puckering up the skin or leaving the print of a film thereon. Another object of the present invention is to provide a double eyelid forming tape or string that can form a fold directly on the eyelid so that a natural double eyelid is obtained. A further object of the present invention is to provide a double eyelid forming tape or string which allows the operation of forming a double eyelid to be safe and easy. Still another object of the present invention is to provide a method of manufacturing the above double eyelid forming tape very easily."

"[0004]

[Solution to Problem] In order to solve the above problem, a double eyelid forming tape according to the present invention basically includes a resiliently elastic narrow tape member formed by a synthetic resin that is stretchable and exhibits resilient elasticity after being stretched, and an adhesive applied thereon, the synthetic resin being stretchable and exhibiting resilient elasticity after being stretched. The adhesive may be applied on one or both surfaces of the tape member. Also, the double eyelid forming tape may be provided with holding portions at both ends thereof, the surfaces of which have no adhering property, for being held with the fingertips."

"[0008] In order to form a double eyelid with the double eyelid forming tape, both ends of the tape member are held and stretched into a resiliently stretched state, and in this state, the portion of the tape member having adhesive is placed and pressed at the position of an eyelid where a user wants to form a fold, the tape member is adhered using the adhesive, and the holding portions at both ends are released in this state. As a result, the tape member resiliently contracts. Meanwhile, since an eyelid normally projects toward the front at the center thereof along an eyeball with respect to both ends, the resiliently contracted tape member digs into the eyelid on which it is attached and forms a fold of the double eyelid. The unnecessary end portions may be cut afterwards.

[0009] In this manner, since the tape member forms a fold for making a double eyelid directly on the eyelid as described above, a natural double eyelid can be formed without puckering up the skin or leaving a print of a film on the eyelid as in the conventional methods. In addition, the double eyelid can be made just by stretching both ends of the tape member, and in this state, pressing it against the position of the eyelid where the user wants to form a fold, thereby forming a clear double eyelid in a simple manner. Also, in the known methods described above, the user has to use a pusher or the like to form a fold by himself/herself when bonding the eyelid skin or adhering the single-sided adhesive tape or the like on the eyelid. However, the double eyelid forming tape of the present invention forms an eyelid with a fold by its own contractive force, and thus a pusher or the like is not necessary, and formation of double eyelid can be performed safely and easily.

[0010] [Description of Embodiments] Fig. 1 illustrates an embodiment of a double eyelid forming tape of the present invention. The double eyelid forming tape can be constructed, basically, by applying an adhesive 2 on the front and back surfaces of a resiliently elastic narrow tape member 1. Although any tape or tape members 1 described above may be employed so long as it stretches when both ends thereof are

held and pulled, and contracts resiliently to the original state on release, it is especially preferable to form it of a synthetic resin which is stretchable and exhibits resilient elasticity after being stretched such as polyethylene. The tape member 1 is generally formed in a narrow tape of about 1 to 3 mm in width, but the width is not limited to that range, and the shape does not have to be of accurate tape shape. In addition, the adhesive 2 described above may be any type so long as it can be used for the skin."

3 Assessment

The Description of the case describes the configuration and the embodiment of the Invention as mentioned in the above section 2.

It is clear that the "synthetic resins such as polyethylene" having characteristics of this kind falls within a predetermined range of synthetic resins including polyethylene as classified into the classification D of Evidence B No. 10. Within the predetermined range of synthetic resins, for example, "3M's #1522 product" already existed at the time of filing of the application for the Patent of the case as a readily available general-purpose article (Evidence B No. 1, Page 13).

As such, it is recognized that a person skilled in the art would recognize that the problem of Invention 1; i.e., the difficulty in readily forming a clear double eyelid without causing the skin to be irregularly puckered or leaving a print on the skin, can be solved by adopting the feature of Invention 1.

Therefore, the Patent according to Invention 1 of the case complies with the support requirement under Article 36(6)(i).

The demandant alleges that there exists, in the resin indicated under the classification D of Evidence B No. 10, a region that is not subject to Hooke's law where the synthetic resin is autonomously stretched without application of an additional force and the resilient elasticity for restoration after being stretched no longer remains, so that it cannot be said the resin is a "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" (see the demandant's written statement dated September 17, 2015, item "d" in Page 17).

However, even when the demandant is correct in asserting that the region pointed out by the demandant is not subject to Hooke's law, this region is in a sense a region where both elasticity and plasticity exist, where the resin is stretched with a substantially constant force but the resilient elasticity for restoration after being stretched still remains. This fact that the synthetic resin has a region where the resin is

stretched with the substantially constant force but the resilient elasticity for restoration still remains in no way acts as a hindrance to recognizing that the problem of Invention 1 can be solved by the double eyelid forming tape. Moreover, this synthetic resin is possibly more suitable for the double eyelid formation than a material such as rubber that is solely subject to Hooke's law. Accordingly, the allegation by the demandant cannot be accepted.

Further, the demandant alleges that the double eyelid forming tape according to Invention 1 has to be stretched such that it is "longer than the length of the eyelid on which the double eyelid is formed" but the stretching to the extent as alleged by the demandee in the statement brief (2); i.e., the extent that "it can be stretched without difficulty to the length equivalent to that of the eyelid," is insufficient for successfully recognizing that the problem of Invention 1 can be solved at all (see the demandant's written statement dated September 17, 2015, Pages 18 and 19).

In this respect, the demandee simply mentioned at least "equivalent to the length of the eyelid," which does not exclude an embodiment where it is stretched to be "longer than the length of the eyelid." Also, even if the stretching takes place to the extent of being "equivalent to the length of the eyelid," it is not essential that the region where the double eyelid forming tape is adhered be "longer than the length of the eyelid where the double eyelid is formed" and it suffices that it has the necessary length for forming the double eyelid. Accordingly, the allegation by the demandant cannot be accepted.

As discussed above, the Patent regarding Invention 1 cannot be invalidated for the reason for invalidation 2.

No. 7 Judgment by the body regarding the reason for invalidation 3 (Article 36(6)(ii))
1 Stretchable and Contractive Properties

As has been discussed in the above section 4 of No. 5, since the synthetic resin "which is stretchable and exhibits resilient elasticity after being stretched" of Invention 1 should be interpreted as synthetic resin "by which a fold of a double eyelid is formed on the eyelid using the resilient elasticity of the tape member after being stretched," Invention 1 is clear.

The demandant alleges that the "synthetic resin which is stretchable and exhibits resilient elasticity after being stretched" encompasses all types of synthetic resins that have the property of being resiliently contracted after being stretched, and accordingly

Invention 1 is not clear.

However, as mentioned above, it is clear that the synthetic resin of Invention 1 is the one "by which a fold of a double eyelid is formed on the eyelid using the resilient elasticity of the tape member after being stretched" and falls within the predetermined range of synthetic resins including polyethylene as has been discussed in section 3 of No. 6. The allegation by the demandant cannot be accepted.

2 Product-by-Process Claim

The allegation by the demandant that Invention 1 is (recited in the format of) a "product-by-process claim" is finally addressed. With regard to the matter defining the invention; i.e., "applying," in view of the statement regarding the "double eyelid formation" discussed in the above section 4 of No. 5, Invention 1 is capable of forming a double eyelid so long as the "tape member" in use is in the state where the "adhesive" is "applied" thereon. The "action" of "applying" does not have a technical significance in the double eyelid formation.

Therefore, Invention 1 is not one that is claimed by a "product-by-process claim."

3 Summary

As discussed in the foregoing, the Patent regarding Invention 1 cannot be invalidated for the reason for invalidation 3.

No. 8 Closing

In view of the foregoing, the Patent regarding Invention 1 of the case cannot be invalidated based on the reasons as alleged by the demandant and the means of proof submitted by the demandant.

With regard to the costs regarding the trial, it should be borne by the demandant pursuant to Article 61 of the Code of Civil Procedure as applied *mutatis mutandis* under Article 169(2) of the Patent Act.

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

November 4, 2015

Chief administrative judge: NAGAYA, Yojiro
Administrative judge: CHIBA, Shigenari

Administrative judge: WATANABE, Toyohide