Appeal decision

Appeal No. 2017-13374

Appellant L'Oreal

Patent Attorney MURAYAMA, Yasuhiko

Patent Attorney JITSUHIRO, Shinya

The case of appeal against the examiner's decision of refusal for Japanese Patent application No. 2015-188560, titled "METHOD FOR TREATING HAIR USING STEAM" [published on February 12, 2016, Japanese Unexamined Patent Application Publication No. 2016-25937] has resulted in the following appeal decision.

Conclusion

The appeal of the case was groundless.

Reason

1. History of the procedures

The present application is a patent application filed on September 25, 2015, which is a divisional application of Japanese Patent Application No. 2010-85876 filed on April 2, 2010 (priority claim under the Paris Convention: April 3, 2009, France), for which a notice of reason for refusal was issued on August 1, 2016 (dispatched date: August 8, 2016), and a written opinion and a written amendment were submitted on January 10, 2017, and a decision of refusal was issued on April 27, 2017 (dispatched date: May 8, 2017). In response, the appeal against the examiner's decision of refusal was filed on September 8, 2017 together with a written amendment, and a notice of reasons for refusal was issued by the body on August 23, 2018 (dispatched date: August 27, 2018), and a written opinion and a written correction of mistranslation were submitted on November 16, 2018.

2. Claims

An amendment was made to the scope of claims with a written correction on November 16, 2018 as set forth below (Note that the invention according to Claim 1 of the present application is referred to as "the Invention".):

"[Claim 1]

A method of treating hair fibers comprising the following steps of:

applying steam to hair fibers in an amount of 5 g/minute or less; and

shaping the hair fibers at a temperature higher than 90°C,

wherein said step of applying steam and step of shaping are not performed simultaneously on the same parts of hair fibers,

wherein the shaping is carried out for each hair bundle in which hair fibers are to be treated by use of iron after the step of applying steam,

wherein an amount of steam to be used is 1 to 4 g/minute.

[Claim 2]

The method according to Claim 1, wherein the shaping temperature is 90 to 230°C.

[Claim 3]

The method according to Claim 1 or 2, comprising one-time steam application for each bundle of hair to be treated.

[Claim 4]

The method according to any one of Claims 1 to 3, wherein said steam comprises one or a plurality of cosmetic active ingredients.

[Claim 5]

The method according to any one of Claims 1 to 4, wherein the shaping is carried out after the step of applying steam.

[Claim 6]

The method according to any one of Claims 1 to 5, further comprising a step of cosmetic treatment of hair fibers, using a composition comprising one or a plurality of cosmetic active ingredients.

[Claim 7]

The method according to Claim 6, comprising the steps of cosmetic treatment, subsequent application of steam, and the following shaping of hair fibers in this order.

[Claim 8]

The method according to Claim 6, comprising the steps of the application of steam, subsequent shaping of hair fibers, and the following cosmetic treatment in this order.

[Claim 9]

The method according to Claim 6, comprising the steps of the application of steam, subsequent cosmetic treatment, and the following shaping of hair fibers in this order.

[Claim 10]

The method according to Claim 6 or 7, wherein said cosmetic treatment step is selected from a care of hair fibers, washing the fibers, shaping, perm treatment, semiperm treatment or temporary dying, modified perm using a reductant and an optional fixing agent, and alkaline straight perm treatment using sodium hydroxide or guanidine carbonate."

3. Reasons for refusal stated in the examiner's decision

The summary of reason 1 for refusal stated in the examiner's decision for Claim 1 is set forth as below.

"The invention according to Claim 1 of this application was easily conceivable on the basis of the inventions described in Japanese Unexamined Patent Application Publication No. H7-51119 (hereinafter referred to as "Cited Document 1") and National Publication of International Patent Application No. 2005-530583 (hereinafter referred to as "Cited Document 2") that were distributed in Japan or foreign countries before the filing (priority date) by a person skilled in the art who had an ordinary knowledge in the field of art to which the invention belongs, and thus appellant should not be granted a patent under the provision of Article 29(2) of the Patent Act."

4. Cited Document

Cited Document 1 cited in the reasons for refusal stated in the examiner's decision discloses the following matters together with the drawings:

a "This invention relates to a procedure method of perm treatment and iron perm treatment, and to a conditioner used for hair protecting agent." ([0001]),

b "In other words, the procedure method of perm treatment of Claim 1 relating to the invention firstly heats hairs with a steamer simultaneously with the conventional procedure method. A setting temperature of the steamer in this case is in the vicinity of 50°C, and the heating time is preferably about 15 to 20 minutes. This allows matrix in hair cortex to be lost by 10 to 15%. Further, a protein that prevents loss may be dissolved and penetrated in place of matrix in hair cortex by coating on a surface of hair a conditioner containing the protein preventing loss.

Subsequently, a conditioner for protection from a curling iron is coated on a surface of hair, and subjected to heat of a curling iron. The setting temperature of the curling iron in this case is preferably a high temperature of 180°C to 200°C. In such a manner, said protein penetrating into hair cortex is chemically modified by high heat of the curling iron to cause heat coagulation and prevent elution." ([0018] to [0019])

It can be seen from the above description that heating with a steamer is followed by subjecting to iron permanent wave. Thus, the procedures are not simultaneously performed on the same part of hairs.

It can be seen from the above description that heating with a steamer and then subjecting hairs to iron permanent wave are followed by use of a curling iron.

In view of the above description, Cited Document 1 describes the invention of "a procedure method of iron permanent wave procedure on hair by use of a curling iron, comprising the steps of heating hair with a steamer, and
subjecting hairs to iron permanent wave at a high temperature of 180°C to 200°C,
wherein heating with a steamer and subjecting to iron permanent wave procedure are not simultaneously performed on the same part of hairs,
wherein heating with a steamer and subjecting hairs to iron permanent wave are followed by use of a curling iron."
(hereinafter referred to as "Cited Invention".).

Cited Document 2 cited in the reasons for refusal stated in the examiner's decision discloses the following matters together with the drawings:

c "A hair styling device according to Claim 2, wherein about 0.02 to about 4 grams per minute of water is delivered to the hair." ([Claim 3])

d "The use of steam for setting or styling hair is well known and many attempts have been made to provide devices such as hair rollers, curling irons and flat irons with structures to emit steam to improve the results obtained in curling, straightening, and setting hair with the aid of heat." ([0002]),

e "The water that may be delivered by the present invention may comprise from about 0.01 - 2 grams per minute per side of the styling device, which would be equal to from about 0.02 to about 4 grams per minute for the total of 2 sides of the styling device delivering, preferably from about 0.1 to about 1 gram per minute per side, which would be equal to from about 0.2 to about 2 grams per minute for the total of 2 sides of the styling device delivering, more preferably from about 0.15 to about 0.4 grams per minute per side, which would be equal to from about 0.3 to about 0.8 grams per minute for the total of 2 sides of the styling device delivering." ([0056])

5. Comparison

In comparison of the Invention with the Cited Invention, "hairs", "curling iron", and "procedure method" of the Cited Invention correspond to "hair fibers", "iron", and "a method of treating hair fibers" of the Invention.

Heating with a steamer applies steam to hairs. Thus, "heating hairs with a steamer" of the Cited Invention and "applying steam to hair fiber in an amount of 5 g/minute or less" of the Invention are identical in the point of "applying steam to hair fiber".

"Subjecting hairs to iron permanent wave at a high temperature of 180°C to 200°C" of the Cited Invention corresponds to "shaping the hair fiber at a temperature higher than 90°C" of the Invention.

Consequently, "heating hair with a steamer, and subjecting hairs to iron permanent wave at a high temperature of 180°C to 200°C" of the Cited Invention and "comprising the following steps of: applying steam to hair fibers in an amount of 5 g/minute or less; and shaping the hair fibers at a temperature higher than 90°C" of the Invention are identical in the point of " comprising the following steps of: applying steam to hair fibers; and shaping the hair fibers at a temperature higher than 90°C".

"Wherein heating with a steamer and subjecting to iron permanent wave procedure are not simultaneously performed on the same part of hairs" of the Cited Invention corresponds to "wherein said step of applying steam and step of shaping are not performed simultaneously on the same parts of hair fibers" of the Invention.

In the Cited Invention, the procedure on hairs is not performed at one time for the whole hairs, but performed for a part of hairs. Thus, "wherein heating with a steamer and subjecting hairs to iron permanent wave are followed by use of a curling iron" of the Cited Invention corresponds to "wherein the shaping is carried out for each hair bundle in which hair fibers are to be treated by use of an iron after the step of applying steam" of the Invention.

Therefore, the Invention and Cited Invention are identical in the following point,
"A method of treating hair fibers comprising the following steps of:
applying steam to hair fibers; and
shaping the hair fibers at a temperature higher than 90°C,
wherein said step of applying steam and step of shaping are not performed simultaneously on the same parts of hair fibers,
wherein the shaping is carried out for each hair bundle in which hair fibers are to be treated by use of iron after the step of applying steam."

but they are different from each other in the following feature:

[Different Feature]

Regarding steam, the Invention applies steam in an amount of 5 g/minute or less, and an amount of steam to be used is 1 to 4 g/minute, whereas the Cited Invention applies steam, but does not specify an amount of steam per time in use.

6. Judgment

It is a well-known matter to provide hair with steam and shape with a curling iron (see 4.d). Further, the grating of hairs when using a curling iron stems from the exfoliation of cuticles and the decrease in moisture of hairs. Furthermore, it is a well-known matter that the use of a curling iron with hairs remaining wet results in damages on hairs.

Consequently, it is better not to provide hairs with moisture in such an amount that makes hairs get wet but to provide hairs with a proper amount of moisture for the use of curling iron without damage on hairs.

The appellant alleges in the written opinion on November 16, 2018 that "However, in a case where the shaping is performed right after the application of steam to hair fibers (i.e. right after the cease of the application of steam), for example, the application of steam and shaping are sequentially performed, and the application of steam and shaping are not performed simultaneously on a same part of hair fibers. Thus, it corresponds to the embodiment of the Invention. As seen above, according to the method of the Invention, steam is firstly applied to hair fibers to be treated, and shaping is performed in a wet state accordingly. Thus, there is an advantage of no damage on hair fibers due to high heat like a case where heat shaping is directly applied to dried hairs." This allegation is construed such that there is a difference in effects on hair fibers depending on whether the shaping is performed simultaneously with or right after the steam application. Supposing that a same amount of steam is applied to hair fibers, it is hardly believed that there is a difference in wetness of hair fibers in shaping between the case where the application of steam and shaping are simultaneously performed on a same part of hair fibers and the case where the shaping is performed right after the application of steam.

If so, troubles caused during use of a curling iron regardless of whether hairs have rich moisture or poor moisture should be avoided also in the Cited Invention. At the time, an amount of steam for providing a proper moisture should be optimized as necessary. This aims to prevent hair damage during use of a curling iron to adjust an

amount of water to about 0.02 to about 4 g/minute during use of the styling device in Cited Document 2. Thus, it is recognized that it is easily conceivable by a person skilled in the art to adjust steam given to hair to about 0.02 to about 4 g/minute in the Cited Invention as in the case of Cited Document 2. It is recognized that a person skilled in the art could have easily adjusted an amount of steam to 1 to 4 g/minute within a range of about 0.02 to about 4 g/minute at the time.

Further, the function and effect of the Invention also fall within a scope that can be expected by a person skilled in the art from the Cited Invention and the matters described in Cited Document 2.

Therefore, the Invention was easily conceivable by a person skilled in the art on the basis of Cited Invention and matters described in Cited Document 2, and thus the Appellant should not be granted a patent for the invention under the provision of Article 29(2) of the Patent Act.

7. Closing

Therefore, the Invention was easily conceivable by a person skilled in the art on the basis of Cited Invention and matters described in Cited Document 2, and thus the Appellant should not be granted a patent for the invention under the provision of Article 29(2) of the Patent Act.

Consequently, the examiner's decision to the effect that the present application should be rejected should be maintained.

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

April 19, 2019

Chief administrative judge: SASAKI, Yoshie
Administrative judge: HORIKAWA, Ichiro
Administrative judge: NAGAMA, Nozomi