

## Trial Decision

Invalidation 2017-800158

Osaka, Japan  
Demandant                                 BENOA JAPAN CO., LTD.

Osaka, Japan  
Patent Attorney                             TAKAYAMA, Yoshinari

Osaka, Japan  
Attorney                                     FUKE, Megumu

Aichi, Japan  
Demandee                                  MTG CO., LTD.

Gifu, Japan  
Patent Attorney                             KOBAYASHI, Tokuo

The case of trial regarding the invalidation of Japanese Patent No. 5230864, entitled "Roller for Beautiful Skin" between the parties above has resulted in the following trial decision:

### Conclusion

The demand for trial of the case shall be dismissed.

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

### Reason

No. 1 History of the procedures regarding the patent of the case

The application of Patent No. 5230864 of the case (hereinafter, simply referred to as the "the Patent") was filed on December 14, 2007 as Japanese Patent Application No. 2007-324077, and the establishment of the patent right for the inventions according to claims 1 to 7 was registered on March 29, 2013.

Regarding the patent for the inventions according to claims 1 to 7 of the case, a trial for invalidation (Invalidation No. 2016-800085, hereinafter, referred to as "the previous invalidation trial") was demanded by the demandant of the trial for invalidation, Benoa Japan Co., Ltd., on July 21, 2016. Then, the trial decision of "the demand for trial of the case was groundless" was made on April 18, 2017, and this trial decision was made final and binding, and registration thereof was established on May 29, 2017.

No. 2 History of the invalidation trial of the case

The history of the invalidation trial of the case is as follows:

December 25, 2017

Demand for the invalidation trial of the case by the same demandant, Benoa Japan Co., Ltd., as in the previous invalidation trial

(Invalidation 2017-800158)

March 26, 2018	Submission of the written reply of the trial case by the demandee, MTG Co., Ltd (hereinafter, simply referred to as "the written reply")
April 4, 2018	Inquiry to the Demandant
April 24, 2018	Submission of the response letter (1) by the demandant
May 28, 2018	Inquiry to the Demandant
June 27, 2018	Submission of the response letter (2) by the demandant
June 27, 2018	Submission of the written refutation by the demandant

In this trial decision, when a reference part is specified with lines, the number of lines does not include blank lines. In addition, Articles of the Patent Act may be mentioned without an explicit indication of "Patent Act."

### No 3. The patent invention

The inventions according to claims 1 to 7 of the Patent are acknowledged as follows, as described in the scope of claims according to the descriptions of the specification and drawings attached to the application. (Hereinafter, they may be referred to as "Patent Invention 1" and the like; or they may be collectively referred to as "the Patent Invention.")

"[claim 1]

A roller for beautiful skin, comprising:  
a handle;

a pair of rollers formed by a conductor at one end of the handle; and

a solar battery energizing the rollers by generated power;

wherein, the rotary axes of the rollers are each provided at an acute angle to the center line in a long axis direction of the handle; and

the angle formed by the rotary axes of the pair of rollers is obtuse.

[claim 2]

A roller for beautiful skin, comprising:

a pair of rollers formed by a conductor;

a grip part supporting the pair of rollers; and

a solar battery energizing the rollers by generated power;

wherein, the rotary axes of the rollers are each provided at an acute angle to the center line of the grip part; and

the angle formed by the rotary axes of the pair of rollers is obtuse.

[claim 3]

A roller for beautiful skin according to claim 1 or 2, wherein the roller is formed by metal.

[claim 4]

A roller for beautiful skin according to one of claims 1 to 3, wherein the roller is formed by a metal oxide.

[claim 5]

A roller for beautiful skin according to claim 3 or claim 4, wherein one or more kinds of metals are selected as the metal from platinum, titanium, germanium, and stainless steel.

[claim 6]

A roller for beautiful skin according to one of claims 1 to 5, wherein the roller includes a photocatalyst.

[claim 7]

A roller for beautiful skin according to claim 6, wherein the photocatalyst is a titanium oxide."

No. 4 The demandant's allegation

1 Object of the demand

The object of the demand alleged by the demandant is to seek the trial decision that the patent regarding the patent invention shall be invalidated.

2 Means of proof

The means of proof submitted by the demandant are as follows.

Evidence A No. 1: Copy of Japanese Unexamined Patent Application Publication No. 2005-66304 (Hereinafter, an indication that the submitted evidence is a copy of its original document is omitted.)

Evidence A No. 2: Japanese Unexamined Patent Application Publication No. H2-131779

Evidence A No. 3: Japanese Unexamined Patent Application Publication No. H3-92175

Evidence A No. 4: Japanese Unexamined Patent Application Publication No. H4-231957

Evidence A No. 5: Japanese Unexamined Patent Application Publication No. 2004-321814

Evidence A No. 6-1: Korean Design Registration Publication No. 30-0399693

Evidence A No. 6-2: Translation of Korean Design Registration Publication No. 30-0399693

Evidence A No. 7-1: Taiwanese Utility Model Gazette No. M258730

Evidence A No. 7-2: Translation of Taiwanese Utility Model Gazette No. M258730

Evidence A No. 8: Registered Utility Model Gazette No. 3109896

Evidence A No. 9-1: Korean Design Examination Guidelines

Evidence A No. 9-2: Translation of Korean Design Examination Guidelines

3 Gist of statement of the demand

The gist of the statement of the demand is as follows according to the entire import of the demandant's allegation.

(1) Inventions 1 to 5 could have been easily made by a person skilled in the art based on the invention described in Evidence A No. 1, the invention described in Evidence A No. 2 or Evidence A No. 3, and the invention described in any of Evidence A No. 4 to Evidence A No. 7; and thus the demandee should not be granted a patent for the inventions under the provisions of Article 29(2) of the Patent Act and the Patent falls under Article 123(1)(ii) of the Patent Act and should be invalidated.

(2) Inventions 6 and 7 could have been easily made by a person skilled in the art based on the invention described in Evidence A No. 1, the invention described in Evidence A No. 2 or Evidence A No. 3, the invention described in any of Evidence A No. 4 to Evidence A No. 7, and the invention described in Evidence A No. 8; and thus the demandee should not be granted a patent for the inventions under the provisions of

Article 29(2) of the Patent Act and the Patent falls under Article 123(1)(ii) of the Patent Act and should be invalidated.

(3) The trial decision of the previous invalidation trial (hereinafter, it may be referred to as "the previous trial decision") was made based on only one different feature (Different Feature 2), and even if the evidences relating to "one different feature (Different Feature 2)" of the previous trial decision and the evidences in the invalidation trial of the case are the same, the evidences regarding the other different feature (Different Feature 1) in the previous trial decision and the evidences in the invalidation trial of the case are different; and therefore, the demand for the invalidation trial of the case is not based on the same evidences and does not violate Article 167 of the Patent Act. (the written refutation by the demandant, page 2; the written reply by the demandant (2), page 1)

No. 5 The demandee's allegation

1 Gist

Against this, the demandee demands the trial decision that the trial of the case may not be demanded under the provisions of Article 167 of the Patent Act and therefore the demand for trial of the case is groundless, based on the reasons outlined below.

2 Summary of the allegation

The demandee's allegation is summarized as follows:

(1) The reasons for invalidation alleged by the demandant in the invalidation trial of the case is the same as the reasons for invalidation in the previous trial decision in that the appellant should not be granted a patent for the patent inventions 1 to 7 in accordance with the provisions of Article 29(2) of the Patent Act. (around the middle of page 5 in the written reply)

(2) As for the evidences, the easily-conceived properties of Patent Invention 1 and the like based on the invention described in the same "primary cited document" (Japanese Unexamined Patent Application Publication No. 2005-66304) are alleged in both the previous trial decision and the invalidation trial of the case. In addition, for "Different Feature 2" (Note by the body: it corresponds to Different Feature 1-2 in the invalidation trial of the case) which was judged as being not easily conceivable in the previous trial decision, the same evidences as those used in the previous trial decision are used in the invalidation trial of the case.

The evidences (Evidence A No. 2 and Evidence A No. 3) used for Different Feature 1-1 in the invalidation trial of the case were not used in the previous trial decision; however, in the first place, a judgment was not made on Different Feature 1 (Note by the body: it corresponds to Different Feature 1-1 in the trial of the case) in the previous trial decision on the ground that it was judged that Different Feature 2 was not easily conceivable.

If the demandant was aggrieved by the judgment of the previous trial decision, he/she could bring an action for revocation of the trial decision and dispute the validity of the judgment of the trial decision. However, the demandant did not bring an action for revocation of the previous trial decision and the trial decision was made final and

binding. Nevertheless, in the invalidation trial of the case, the demandant alleges again the easily-conceived property based on the same evidences for Different Feature 2 which was judged in the previous trial decision. This brings up again the previous trial decision which was made final and binding, and obviously contravenes the purport of Article 167 of the Patent Act that is to seek to solve a dispute at a time in a trial for patent invalidation, and the invalidation trial of the case was demanded based on the same facts and evidences as those in the previous trial decision. (from around the middle of page 15 to around the lower part of page 17 in the written reply)

## No.6 Judgment by the body regarding prohibition of double jeopardy

### 1. Regarding the purport and interpretation of Article 167 of the Patent Act

Article 167 of the Patent Act provides that when a trial decision of a patent invalidation trial has been made final and binding, the parties concerned or intervenors may not file a request for a trial on the basis of the same facts and evidences. It is understood that the purport of the Article 167 is to exert the effect of prohibition of double jeopardy to the parties concerned and the like so that a dispute can be solved at a time in a trial for patent invalidation in order to prevent a situation where a plurality of different judgments are made for the validity of the patent right that is an exclusive, monopolistic right (Article 68 of the Patent Act) and to prevent a dispute from being brought up again.

The parties concerned and the like in the previous trial for patent invalidation were given an opportunity to present allegations and evidence regarding the existence/nonexistence of reasons for invalidation in the procedure of the trial and, if a suit against the trial decision in the trial for patent invalidation was made, an opportunity to present allegations and evidence regarding the existence/nonexistence of grounds for revocation of the trial decision in the procedures of the suit. Therefore, it is not reasonable to interpret "the same facts and evidences" in a narrow sense in terms of preventing a dispute from being brought up again.

Especially, due to the amendment of the Patent Act by Act No. 63 of 2011, the effects on the third parties in Article 167 of the Patent Act have been abolished and the range of the effect of prohibition of double jeopardy is limited to the parties concerned or intervenors who could be involved in the procedure of the previous trial and could have provided all assertions and proof. Accordingly, it is reasonable to understand the significance of "the same facts and evidences" in Article 167 while putting more emphasis on the purport of solving a dispute at a time. (Refer to the case of Intellectual Property High Court, 2009 (Gyo-Ke) No. 10260.)

### 2 Summary of the reasons of the previous trial decision

The summary of the demandant's allegation and reasons of the trial decision in the previous invalidation trial are as follows:

#### (1) Means of proof of the demandant in the previous invalidation trial

Evidence A No. 1 to Evidence A No. 9 among the means of proof submitted by the demandant in the previous invalidation trial are as follows:

Evidence A No. 1: Japanese Unexamined Patent Application Publication No. 2005-66304

(Hereinafter, it may be referred to as "the previous A-1" or the like in accordance with the notation by the demandee in order to be distinguished from the means of proof in

the invalidation trial of the case. In addition, the means of proof in the invalidation trial of the case may be referred to as "A-1" or the like in accordance with the notation by the demandee.)

Evidence A No. 2: Japanese Unexamined Patent Application Publication No. 2002-65867

Evidence A No. 3: Japanese Unexamined Patent Application Publication No. S60-2207

Evidence A No. 4: Japanese Unexamined Patent Application Publication No. S61-73649

Evidence A No. 5: Japanese Unexamined Patent Application Publication No. H4-231957

Evidence A No. 6: Japanese Unexamined Patent Application Publication No. 2004-321814

Evidence A No. 7-1: Korean Design Registration Publication No. 30-0399693

Evidence A No. 7-2: Translation of Korean Design Registration Publication No. 30-0399693

Evidence A No. 8-1: Taiwanese Utility Model Gazette No. M258730

Evidence A No. 8-2: Translation of Taiwanese Utility Model Gazette No. M258730

Evidence A No. 9: Registered Utility Model Gazette No. 3109896

## (2) Statement of the demand by the demandant in the previous invalidation trial

The statement of the demand by the demandant in the previous invalidation trial is as outlined below (Refer to the section of No. 2 "Allegation by the demandant" in the previous trial decision).

### A Reason for Invalidation 1

The inventions according to claims 1 to 5 of the Patent could have been easily made by a person skilled in the art prior to the filing of the application based on the invention described in the previous A-1, the well-known arts described in the previous A-2 to the previous A-4, and any of the inventions described in the previous A-5, the previous A-6, the previous A-7-1, and the previous A-8-1; and thus, the demandee should not be granted a patent for the inventions under the provisions of Article 29(2) of the Patent Act.

### B Reason for Invalidation 2

The inventions according to claims 6 and 7 of the Patent could have been easily made by a person skilled in the art prior to the filing of the application based on the invention described in the previous A-1, the well-known arts described in the previous A-2 to the previous A-4, any of the inventions described in the previous A-5, the previous A-6, the previous A-7-1, and the previous A-8-1, and the invention described in the previous A-9; and thus, the demandee should not be granted a patent for the inventions under the provisions of Article 29(2) of the Patent Act.

## (3) Summary of the reasons of the previous trial decision

### (3-1) Patent invention 1

#### A Comparison with the primary cited document

In the previous trial decision, the corresponding feature and different features between Patent invention 1 and the invention described in the previous A-1 that was a

primary cited document were recognized as follows (Refer to the section of No. 4, 2 (2) (2-1) "Comparison").

(A) The corresponding features

"A roller applied to skin, comprising:

a handle;

a pair of rollers formed by a conductor at one end of the handle; and

a battery energizing the rollers by generated power."

(B) The different features

<Different Feature 1>

Regarding power with which the roller is energized, it is generated by the "solar battery" in Patent Invention 1; whereas, it is generated by the "dry battery 400" in the invention described in the previous A-1.

<The Different Feature 2>

Regarding a relationship between the pair of rollers and the handle, "the rotary axes of the rollers are each provided at an acute angle to the center line in a long axis direction of the handle; and the angle formed by the rotary shafts of the pair of rollers is obtuse" in Patent Invention 1; whereas, "the horizontal shaft parts 210 as the rotation axes of the rollers 100, 100 are each provided at the right angle to the center line of the grip part 300, and the angle formed by the horizontal shaft parts 210 as rotation axes of the pair of rollers 100, 100 is 180 degrees" in the invention described in the previous A-1.

<Different Feature 3>

A roller applied to skin is the "roller for beautiful skin" in Patent Invention 1; whereas, it is the "massager" in the invention described in the previous A-1.

B Judgment on the different features

In the previous trial decision, it was judged that since it could not be said that there was a motivation to apply the matters described in any of the previous A-5, the previous A-6, the previous A-7-1, and the previous A-8-1 in the invention described in the previous A-1 and also it could be recognized that there was a disincentive in the application, it could not be said that the configuration of the Patent Invention 1 relating to Different Feature 2 could have been easily conceived from the inventions described in the previous A-1 and in the previous A-5, the previous A-6, the previous A-7-1, and the previous A8-1.

In addition, it was judged in the previous trial decision that since Different Feature 2 could not be considered to be easily conceivable, there was no need to examine Different Feature 1 and Different Feature 3 and Patent Invention 1 could not have been easily made by a person skilled in the art based on the inventions described in the evidences submitted by the demandant.

(3-2) Patent Invention 2

In the previous trial decision, it was judged that Patent Invention 2 was different from the invention described in the previous A-1 in terms of Different Feature 1 to Different Feature 3 which were the same as the different features regarding Patent Invention 1.

In addition, it was judged in the previous trial decision that since Different Feature 2 could not be considered to be easily conceived from the invention and the like which were described in the previous A-1, as with the examination for Patent Invention 1, there was no need to examine Different Feature 1 and Different Feature 3 and Patent Invention 2 could not have been easily made by a person skilled in the art based on the invention described in the evidences submitted by the demandant.

### (3-3) Patent Inventions 3 to 5

In the previous trial decision, it was judged that Patent Inventions 3 to 5 included the configurations of Patent Invention 1 or Patent Invention 2 as a part of their configurations and therefore, for a reason similar to that given for Patent Invention 1 or Patent Invention 2, those inventions could not have been easily made by a person skilled in the art.

### (3-4) Patent Inventions 6 and 7 (Reason for invalidation 2)

In the previous trial decision, it was judged that Patent Inventions 6 and 7 included Patent Inventions 1 to 5 as a part of their configurations and therefore, for a reason similar to that given for Patent Invention 1 or the like, those inventions could not have been easily made by a person skilled in the art.

## 3 Judgment by the body

### (1) Regarding Patent Invention 1 and the like

A The demandants (the parties) in both the previous invalidation trial and the invalidation trial of the case are Benoa Japan Co., Ltd., and the similarity between "the parties" is obvious.

In this term, the same also applies to Patent Inventions 2 to 7.

B In the previous trial decision and the invalidation trial of the case, the easily-conceived properties of Patent Invention 1 and the like based on the inventions described in the previous A-1 and A-1 (Japanese Unexamined Patent Application Publication No. 2005-66304), which are the same primary cited document, are alleged.

C In the invalidation trial of the case, the demandant alleged that Patent Invention 1 and the invention described in the A-1 were different in terms of the same Different Features 1 to 3 as with the previous trial decision (For information on the invalidation trial of the case, refer to around the middle of page 31 in the written demand). In addition, the evidences for the easily-conceived properties of Different Feature 2 are entirely the same between the invalidation trial and the previous trial decision, as described below.

<Evidences regarding Different Feature 2 in the previous trial decision>

Previous A-5: Japanese Unexamined Patent Application Publication No. H4-231957

Previous A-6: Japanese Unexamined Patent Application Publication No. 2004-321814

Previous A-7-1: Korean Design Registration Publication No. 30-0399693

Previous A-8-1: Taiwanese Utility Model Gazette No. M258730

<Evidences regarding Different Feature 2 ("Different Feature 1-2" in the written



demand) in the invalidation trial of the case>

A-4: Japanese Unexamined Patent Application Publication No. H4-231957

A-5: Japanese Unexamined Patent Application Publication No. 2004-321814

A-6-1: Korean Design Registration Publication No. 30-0399693

A-7-1: Taiwanese Utility Model Gazette No. M258730

D As pointed out in 2 (3) above, it was judged in the previous final and binding trial decision that Different Feature 2 could not be considered to be easily conceivable from the above evidences (Previous A-5 to Previous A-8-1) and therefore, there was no need to examine Different Feature 1 and Different Feature 3 and Patent Invention 1 could not have been easily made by a person skilled in the part. In addition, even though the demandant could contest against the previous trial decision in a litigation rescinding the trial decision, the demandant did not file a suit and the previous trial decision was made final and binding.

E In the invalidation trial of the case, the easily-conceived properties of Patent Invention 1 and the like based on the same primary cited document as the one in the previous final and binding trial decision are alleged (B above). Also, as for evidences other than the primary cited document, the easily-conceived properties based on A-4 to A-7-1 that are entirely the same as Previous A-5 to Previous A-8-1 as indicated in C above are alleged concerning Different Feature 2 only for which judgment was made in the previous trial decision.

Then, in order to substantially judge the easily-conceived properties in the invalidation trial of the case, the easily-conceived properties of Different Feature 2 based on the same facts and evidences are to be judged again and therefore, it can be said that the same point of dispute is brought up again by the same demandant.

F The evidences supporting the existence of the well-known art relating to Different Feature 1 for which judgment was not made in the previous trial decision were Previous A-2 (Japanese Unexamined Patent Application Publication No. 2002-65867), Previous A-3 (Japanese Unexamined Patent Application Publication No. S60-2207), and Previous A-4 (Japanese Unexamined Patent Application Publication No. S61-73649), which are described above; whereas, in the invalidation trial of the case, the demandant has replaced them with A-2 (Japanese Unexamined Patent Application Publication No. H2-131779) and A-3 (Japanese Unexamined Patent Application Publication No. H3-92175) as the evidences supporting a similar technical matter concerning the similar Different Feature 1 (Different Feature 1-1).

G However, as indicated in "1 Regarding the purport and interpretation of Article 167 of the Patent Act" above, in consideration that it is reasonable to understand the significance of "the same facts and evidences" in Article 167 of the Patent Act while putting more emphasis on the purport of solving a dispute at a time in a trial for patent invalidation, the following is considered: since it was judged in the previous final and binding trial decision that the common Different Feature 2 could not be easily conceived from Previous A-5 to Previous A-8-1 which were evidences common in the previous trial decision and the demand for invalidation trial of the case and also since allegation on Different Feature 2 based on the same facts and evidences as those for the

previous trial decision was made also in the demand for invalidation trial of the case, it is groundless and normally unconceivable that Different Feature 1 apart from Different Feature 2 is newly judged and is made a point of dispute.

Therefore, it should be considered that the understanding that even though the evidences regarding Different Feature 1 for which judgment was not made in the previous trial decision are different, the previous trial decision and the demand for the invalidation trial of the case were made substantially based on "the same facts and evidences" meets the purport of Article 167 of the Patent Act described in 1 above.

H To summarize the above, in the invalidation trial of the case, the same primary cited document as that for the previous final and binding trial decision is presented and part of evidences other than the primary cited document that support the well-known art regarding the different features for which judgment was not made in the previous trial decision have only been replaced with part of evidences that support the technical matter similar thereto; the demandant did not file a suit against the previous trial decision even though he/she could, making the previous trial decision final and binding; and the purport of Article 167 of the Patent Act is taken into consideration. Accordingly, it is reasonable to consider that the demand regarding Patent Invention 1 in the invalidation trial of the case was made by the same demandant based on the same facts and evidences as those for the previous trial decision.

I In addition, even if the replacement of the evidences regarding Different Feature 1 is examined, it was alleged by the demandant in the previous demand that the technical matter of "solar battery is used in making current flow through a living body" was a matter of well-known art and the previous A2 to A4 were presented in order to support that allegation; and also in the demand for the invalidation trial of the case, A2 and A3 were presented for replacement as evidences supporting the technical matter similar thereto. Accordingly, irrespective of the presence or absence of an explicit allegation that those are well-known arts, it can be said that the foregoing A-2 to A-3 are also evidences supporting the well-known arts in the light of the principle of faith and trust (estoppel). On the other hand, finding based on evidences is not required for the well-known arts (The Supreme Court Ruling on 1979 (Gyo-tsu) No. 134). Accordingly, the replacement of the evidences supporting well-known arts regarding Different Feature 1 was made for evidences supporting the well-known arts that did not need the finding and presentation thereof; and therefore, this point does not affect the judgment that the demand for the invalidation trial of the case was made based on the same facts and evidences.

## (2) Regarding the Patent Invention 2

In the previous trial decision, the same Different Feature 2 as the one for Patent Invention 1 was presented and as with the examination for Patent Invention 1, it was judged that Patent Invention 2 could not be easily conceived from the inventions described in the Previous A-1 and the like (2)(3)(3-2) above). Also, in the invalidation trial of the case, the evidences that Different Feature 2 can be easily conceived are entirely the same as the one in the previous trial decision. Therefore, as with the examination in Patent Invention 1, it is reasonable to consider that the demand regarding Patent Invention 2 was also made based on the same facts and evidences as

those in the previous trial decision.

(3) Regarding Patent Inventions 3 to 7

Regarding the easily-conceived properties of Patent Inventions 3 to 7, judgment in the invalidation trial of the case is the same as that in the previous trial decision in terms of assuming that Patent Inventions 1 and 2 are easily conceivable.

Therefore, as with the examination in Patent Inventions 1 and 2, it is reasonable to consider that the demand regarding Patent Inventions 3 to 7 was also made based on the same facts and evidences as those in the previous trial decision.

No. 7 Summary

Accordingly, the demand for trial of the case is an illegitimate demand for trial made in violation of the provisions of Article 167 of the Patent Act and thus 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.

August 8, 2018

Chief administrative judge: TAKAGI, Akira  
Administrative judge: NAGAYA, Yojiro  
Administrative judge: SETO, Kohei