

Appeal decision

Appeal No. 2018-1932

Osaka, Japan
Appellant

MANDOM CORPORATION

Patent Attorney

KATSURADA, Masanori

The case of appeal against the examiner's decision of refusal for Japanese Patent Application No. 2013-155983, titled "ASSESSMENTMETHOD OF SKIN CONDITION" [published on February 5, 2015, Japanese Unexamined Patent Application Publication No. 2015-24044, Number of claims: 6] has resulted in the following appeal decision.

Conclusion

The examiner's decision is revoked.

The Invention of the present application shall be granted a patent.

Reason

No. 1 History of the procedures

The present application was filed on July 26, 2013, a notice of Reasons for rejection was issued on November 25, 2016, an amendment was filed on November 29, 2016, but a final notice of rejection was issued on April 27, 2017, a written opinion was submitted on June 28, 2017, a decision of refusal (hereinafter referred to as "Examiner's decision") was issued on November 10, 2017, and a notice of appeal against the decision of refusal was filed on February 13, 2018. Thereafter, the body issued reasons for refusal on September 20, 2018 (hereinafter referred to as "the reasons for refusal by the body"), and a written opinion and an amendment were submitted on October 5, 2018.

No. 2 Outline of the examiner's decision

The outline of the examiner's decision is as follows.

1 The Detailed Description of the Invention of the present application does not at all define "(excluding medical act)" recited in Claims 1 to 7 of the present application, which makes the scope of the exclusion indefinite. Thus it does not conform to the requirement as provided in Article 36(6)(ii) of the Patent Act.

2 The inventions according to Claims 1 to 7 of the present application were easily conceivable on the basis of Cited Documents A to C by a person who had ordinary knowledge in the art to which the inventions pertain (hereinafter referred to as "a person skilled in the art"). Thus the applicant should not be granted a patent for the inventions under the provision of Article 29(2) of the Patent Act.

List of Cited Documents, etc.

A. Japanese Unexamined Patent Application Publication No. H11-076206

B. Japanese Unexamined Patent Application Publication No. H10-042950 (Document

showing well-known techniques)

C. Japanese Unexamined Patent Application Publication No. 2005-097244 (Document showing well-known techniques)

No. 3 Outline of reasons for refusal of the body

The outline of reasons for refusal by the body is as follows.

1 The claims of this application do not comply with the requirements as provided in Article 36(6)(ii) of the Patent Act, in the following points.

(1) Claims 1, 2, 5, and 6

Regarding "a group of abrasive tools having an abrasive surface in compliance with the predetermined standard" recited in Claim 1 of the present application, "the predetermined standard" cannot be specified. Thus the invention according to Claim 1 and the inventions according to Claims 2, 5, and 6 depending therefrom are indefinite.

(2) Claims 1 to 7

The "(excluding medical act)" of Claims 1 to 7 of the present application is indefinite as to what kind of act is excluded in a skin condition assessment method according to Claims 1 to 7 of the present application.

2 The inventions according to Claims 1, 2, 5, and 6 were easily conceivable on the basis of the following Cited Documents 1 to 3 by a person skilled in the art. Therefore, the Applicant cannot be granted a patent for the inventions under the provision of Article 29(2) of the Patent Act.

List of Cited Documents, etc.

Cited Document 1: Japanese Unexamined Patent Application Publication No. H11-076206 (Cited Document A of the examiner's decision)

Cited Document 2: Japanese Unexamined Patent Application Publication No. H10-042950 (Cited Document B of the examiner's decision)

Cited Document 3: Japanese Unexamined Patent Application Publication No. 2005-097244 (Cited Document C of the examiner's decision)

No. 4 The Invention

The inventions according to Claims 1 to 6 of the present application (hereinafter referred to as "the Present Invention 1" to "the Present Invention 6", respectively) are specified in the following by the matters recited in Claims 1 to 6 of the scope of the claims that have been amended by the amendment on October 5, 2018, and the Present Inventions 1 to 6 are the following inventions:

"[Claim 1]

A skin condition assessment method to assess a skin condition of a subject skin for assessing use effect of skin-care cosmetics depending on a skin condition,

comprising the steps of: selecting a plurality of abrasive tools having different roughness degrees of abrasive surface from each other from a group of abrasive tools having an abrasive surface in compliance with a standard defined by JIS and/or ISO;

preparing a group of samples composed of a plurality of standard samples for skin assessment, which are manufactured by transferring respective abrasive surfaces of the selected abrasive tools onto a polymer;

and touching the plurality of standard samples for skin assessment with a finger while touching the subject skin with a finger, comparing a feeling of the subject skin with a feeling of the plurality of standard samples for skin assessment.

[Claim 2]

The skin condition assessment method of Claim 1, wherein said group of tool for abrasion consists of three kinds of abrasive tools of abrasion paper, abrasion cloth, and abrasion film.

[Claim 3]

The skin condition assessment method of Claim 1 or 2, wherein said standard defined by JIS and/or ISO is JIS R 6010 of JIS, and said tool for abrasion is formed by adhering an abrasive agent on a surface of a substrate, and a particle size of said abrasive agent is in compliance with said JIS R 6010.

[Claim 4]

The skin condition assessment method of Claim 3, wherein said abrasive agent has a particle size of 40 to 15000.

[Claim 5]

The skin condition assessment method of any one of Claims 1 to 4, wherein the polymer is a silicone compound.

[Claim 6]

The skin condition assessment method of any one of Claims 1 to 5, wherein the polymer is a replica agent for skin."

No. 5 Cited Documents, Cited Inventions, and the like

1 Regarding Cited Document 1

(1) Matters described in Cited Document 1

Cited Document 1 cited in the reasons for refusal on September 20, 2018 discloses the following matters together with the drawing:

(Citation 1a) "[0001]

[Field of the Invention] The present invention relates to an apparatus for assessment of a surface condition of a skin, a method of assessing a surface condition of a skin, and a method of selecting cosmetics, to be used for the objective assessment of skin condition of each person for the selection of cosmetics."

(Citation 1a) "[0010] Provided is a method of assessing a surface condition of a skin by preparing a plurality of imitation surfaces for the assessment of a skin surface having a surface profile corresponding to each of surface profiles of different kinds of skins and a plurality of imitations for the assessment of skin elasticity having elasticity corresponding to each of elasticity of different kinds of skins, and frictioning and comparing each of the said imitation surfaces for the assessment of a skin surface and a surface profile of a skin with a finger, and pressing and comparing each of the said imitations for the assessment of skin elasticity and elasticity of a skin with a finger so as to assess a surface condition of the skin."

(Citation 1b) "[0013] The above piece of cloth can be replaced with a silicone resin on which a surface profile of a skin is transferred. In this case, a plurality of different kinds of skin surfaces are preliminarily molded with a molding material such as a silicone resin, and this mold is transferred onto a silicone resin. This is intended for matching the irregularity of silicone resin surface to be used as an imitation surface for the assessment of skin surface with a surface profile of a skin."

(Citation 1c) "[0019]

[Table 1]

'Silky skin': A very smooth skin with a fine texture

'Smooth skin': A smooth skin with improved fine texture

'Smooth dry skin': A somewhat smooth skin and that has slightly irregular texture

'Dried skin': A skin with a cornified layer being peeled and with some irregular texture

'Rough skin': A skin with a cornified layer being peeled to the extent that causes splinters and rough texture"

(Citation 1d) "[0026]

[Example 6] In a case where the above cloth is replaced with a silicone resin on which surface profiles of a plurality of different skins are transferred, a human skin on which a silicone resin is transferred is also selected in compliance with a standard as shown in the above Table 1."

(2) The invention described in Cited Document 1

The above (Citation 1d) describes that "a human skin on which a silicone resin is transferred is also selected in compliance with a standard as shown in the above Table 1." Further, [Table 1] describes the standards of "silky skin", "smooth skin", "smooth dry skin", "dried skin", and "rough skin" together with the selection condition (see the above (Citation 1c)). It deems that this standard of [Table 1] is a predetermined standard. Consequently, "a plurality of different skins" of the above (Citation 1d) are "a plurality of different human skins selected in compliance with the predetermined standard". Thus it deems that "silicone resin" of Cited Document 1 is one "on which surface profiles of a plurality of different human skins selected in compliance with the predetermined standard are transferred".

Therefore, it can be seen from the above (Citation 1a) to (Citation 1d) that Cited Document 1 discloses the following invention (hereinafter referred to as "Cited Invention"):

"For selecting cosmetics,

a method of assessing a surface condition of a skin by preparing a plurality of imitation surfaces for the assessment of a skin surface, each having a surface profile corresponding to each of surface profiles of different kinds of skins for selecting cosmetics, and frictioning and comparing each of the imitation surfaces for the assessment of said skin surface and a surface profile of a skin with a finger so as to assess a surface condition of the skin, further comprising the steps of:

preliminarily molding a plurality of different kinds of skin surfaces with a molding material such as a silicone resin; transferring this mold onto a silicone resin; and

matching the irregularity of a silicone resin surface as an imitation surface for the

assessment of skin surface with a surface profile of the skin ,

wherein the silicone resin on which surface profiles of a plurality of different skins are transferred has transferred a plurality of different human skin surface profiles selected in compliance with the predetermined standard."

2 Regarding Cited Document 2

Cited Document 2 cited in the reasons for refusal on September 20, 2018 discloses the following matters together with the drawing:

"[0035] In producing a foundation for coating cosmetics of the present invention using these materials, it is preferable to provide a surface to be a coating surface for cosmetics with an appropriate irregular texture. Such irregular texture is not particularly limited, but may include, for example, one having a frequency component peak in a range of 1 to 30 (cycle/mm), and a central line average roughness (JIS B 0601-1982) Ra= 1 to 1000 (um) as a preferable one. Further, a mold for the formation of irregular texture is not particularly limited, but may include various ones, for example, a regular pattern like a roughness standard tableau, or sand paper, or an irregular pattern such as a replica of human skin."

"[0039] Example 1 Foundation for coating silicone cosmetics

A polysulfide-based synthetic rubber dental impression material (GC Surflex, manufactured by GC) consisting a rubber base and an accelerator was well kneaded with a spatula on a palette so that a ratio of rubber base to accelerator (weight ratio) might become 2:3. Subsequently, the kneaded product was coated onto a piece of sand paper (#100) and dried naturally. After drying, a dental impression material was peeled from the sand paper and cut into a size of 6*4 cm to manufacture a mold. Further, the mold was adhered to a bottom part of a plastic container so that its irregular surface might be directed upward to prepare a mold container. For 100 weight parts of transparent silicone rubber precursor (KE-108, manufactured by Shinetsu Silicone) and 5 weight parts of a curing catalyst (CAT-108, manufactured by Shinetsu Silicone), 0.5 weight part of the mixture of the components shown in Table 1 was uniformly mixed (Mixture A). Subsequently, the mixture A was casted onto a skin mold container so that a depth might become 0.3 to 1 cm. After leaving this for 24 hours for curing, it was taken out from the mold container to obtain a foundation for coating cosmetics."

3 Regarding Cited Document 3

Cited Document 3 cited in the reasons for refusal on September 20, 2018 discloses the following matters:

"[0182]

Preparation of silicone rubber surface (Siflo)

Silflo silicone rubber material (Flexico Developments, England) was used as adhesion. Silflo replica surface for adhesion test was treated with almost the same surface roughness as a surface roughness of a skin. About 5 ml of Silflo material was squeezed from a storage jar to a piece of wax paper. After the addition of two to three drops of a catalyst material (provided by Silflo), a liquid material might increase its viscosity while stirring with a stainless steel spatula (for about 30 seconds). An abrasion paper of #100-grit

(particle size) was cut out into a square piece of 4 cm* 4 cm, and a tape was attached to a surface so that a surface part of about 2.5 cm* 2.5 cm might be exposed. The viscous material was uniformly expanded on an abrasive paper and dried (for about 10 minutes). After solidification, a solid Silflo replica was separated by peeling from an abrasive paper, and an exposed tape adhesive surface was covered with a new tape. A replica surface is a negative mold of an abrasive paper surface, and thus has irregularity. #100-grit was selected so as to be close to a surface roughness of a skin."

No. 6 Comparison / judgment

1 Regarding Present Invention 1

(1) Comparison

Present Invention 1 and the cited invention are compared as follows.

A "Assessing a surface condition", "skin", and "surface condition of a skin" of the cited invention respectively correspond to "a subject skin " and "skin condition" in Present Invention 1.

B "A plurality of imitation surfaces for the assessment of a skin surface having a surface profile corresponding to each of surface profiles of different kinds of skins" of the cited invention are intended for "frictioning and comparing each of the imitation surfaces for the assessment of said skin surface and a surface profile of a skin with a finger so as to assess a surface condition of the skin", and thus correspond to "a group of samples composed of a plurality of standard samples for the assessment of skin" of Present Invention 1.

C " A plurality of different human skin surface profiles selected in compliance with the predetermined standard" of the Cited Invention and an "abrasive surface" of "a group of abrasive tools having an abrasive surface in compliance with a standard defined by JIS and/or ISO" of Present Invention 1 have in common that they are both "a surface in compliance with a predetermined standard". Further, "a predetermined standard" of the Cited Invention is a standard of "silky skin", "smooth skin", "smooth dry skin", "dried skin", and "rough skin". Thus "human skin surfaces" of these standards are different in surface roughness from each other. Therefore, " a plurality of different human skin surface profiles selected in compliance with the predetermined standard" of the Cited Invention and an "abrasive surface" of "a group of abrasive tools having an abrasive surface in compliance with a standard determined by JIS and/or ISO" of Present Invention 1 have in common that they are "different in surface roughness from each other".

D "Imitation surfaces for the assessment of a skin surface" of the cited invention is obtained by "preliminarily molding a plurality of different kinds of skin surfaces with a molding material such as a silicone resin; transferring each mold onto a silicone resin; and matching the irregularity of silicone resin surface as an imitation surface for the assessment of skin surface with a surface profile of the skin ", and "a silicone resin on which surface profiles of a plurality of different skins are transferred has transferred a plurality of different human skin surface profiles selected in compliance with the predetermined standard".

Consequently, "a plurality of imitation surfaces for the assessment of a skin

surface having a surface profile corresponding to each of surface profiles of different kinds of skins" of the Cited Invention and "a group of samples composed of a plurality of standard samples for the assessment of skin" of Present Invention 1 have in common that they "are manufactured by selecting plural ones having different roughness degrees of a surface from each other from the ones comprising a surface in compliance with a predetermined surface, and transferring respective surfaces of the selected plural ones onto a polymer".

E "Frictioning and comparing a surface profile of a skin and each of said imitation surfaces for a skin surface assessment and a surface profile of a skin with a finger to assess a surface condition of a skin" of the Cited Invention corresponds to "touching the plurality of standard samples for skin assessment with a finger while touching a subject skin with a finger, comparing a feeling of the subject skin with a feeling of the plurality of standard samples for skin assessment so as to assess the skin condition of the subject skin" of Present Invention 1.

F As in the foregoing A to E, there are the following common features and different features between Present Invention 1 and the Cited Invention.

(Common feature)

"A skin condition assessment method to assess a skin condition of a subject skin , comprising the steps of: selecting plural ones having different roughness degrees of a surface from each other from the ones comprising a surface in compliance with a predetermined surface; and preparing a group of samples composed of a plurality of standard samples for skin assessment, which are manufactured by transferring respective surfaces of the selected ones onto a polymer; and touching the plurality of standard samples for skin assessment with a finger while touching a subject skin with a finger, comparing a feeling of the skin under study with a feeling of the plurality of standard samples for skin assessment so as to assess the skin condition of the subject skin ."

(The different features)

(Different Feature 1) A skin condition assessment method is "to assess use effect of skin-care cosmetics depending on a skin condition" in Present Invention 1, whereas the method of the Cited Invention is to "select the cosmetics".

(Different Feature 2) Regarding "a group of samples composed of a plurality of standard samples for the assessment of skin", Present Invention 1 "manufactures it by selecting a plurality of abrasive tools having different roughness degrees of abrasive surface from each other from a group of abrasive tools having an abrasive surface in compliance with a standard determined by JIS and/or ISO, and transferring respective abrasive surfaces of the selected abrasive tools onto a polymer", whereas the Cited Invention "preliminarily molds a plurality of different kinds of skin surfaces with a molding material such as a silicone resin" "selected in compliance with the predetermined standard", "transfers each mold onto a silicone resin", and "matches the irregularity of the silicone resin surface with a surface profile of the skin ", thereby "transferring surface profiles of a plurality of different kinds of human skin".

(2) Judgment on the different features

A consideration is given to the above Different Feature 2 in view of the case. Cited Document 2 and 3 describe transferring an abrasive surface of "tool for abrasion" such as "sand paper" and "abrasive paper" onto a "polymer" such as a silicone resin for imitating a surface profile of a skin; however, the constituent feature of "selecting a plurality of abrasive tools having different roughness degrees of abrasive surface from each other from a group of abrasive tools having an abrasive surface in compliance with a standard defined by JIS and/or ISO; a group of samples composed of a plurality of standard samples for skin assessment, which are manufactured by transferring respective abrasive surfaces of the selected abrasive tools onto a polymer;" of Present Invention 1 according to Different Feature 2 is not described in the above Cited Documents 1 to 3, nor can it be said to have been a matter of well-known art before the priority date of the present application.

Further, "standard defined by JIS and/or ISO" of "abrasive surface" is a standard in polishing an article. Even a person skilled in the art could not have conceived of "assessing" "surface condition of a skin" of a "human" by this standard.

Therefore, it is not deemed that Present Invention 1 was easily conceivable by a person skilled in the art on the basis of the Cited Invention and the technical matters described in Cited Documents 2 and 3, without the judgement of the other different features.

2. Regarding Present Inventions 2 to 6

Present Inventions 2 to 6 also have a same constituent feature as a constituent feature of "selecting a plurality of abrasive tools having different roughness degrees of abrasive surface from each other from a group of abrasive tools having an abrasive surface in compliance with a standard defined by JIS and/or ISO; a group of samples composed of a plurality of standard samples for skin assessment, which are manufactured by transferring respective abrasive surfaces of the selected abrasive tools onto a polymer;" of Present Invention 1. Thus, it is not deemed that even a person skilled in the art could have easily conceived of the inventions on the basis of the Cited Invention and the technical matters of Cited Documents 2 and 3, for a reason similar to that of Present Invention 1.

No. 7 Determination on Examiner's Decision

1 Regarding Article 36(6)(ii) of the Patent Act

In the examiner's decision, the reasons for refusal that the meaning of "(excluding medical act)" of Claims 1 to 7 of the scope of claims amended by an amendment on November 29, 2018 is indefinite has been overcome as a result of deleting the recitation of "(excluding medical act)" and amending that "a skin condition assessment method" of the invention according to Claim 1 of the present application to that "a skin condition assessment method to assess skin condition of skin under study for assessing use effect of skin-care cosmetics on skin condition" in Claims 1 to 6 of the scope of claims to which an amendment was made on October 5, 2018.

2 Article 29(2) of the Patent Act

The amendment made on October 5, 2018 has made Claim 1 after the amendment have a technical matter of "selecting a plurality of abrasive tools having different

roughness degrees of abrasive surface from each other from a group of abrasive tools having an abrasive surface in compliance with a standard defined by JIS and/or ISO; a group of samples composed of a plurality of standard samples for skin assessment, which are manufactured by transferring respective abrasive surfaces of the selected abrasive tools onto a polymer; ". " Selecting a plurality of abrasive tools having different roughness degrees of abrasive surface from each other from a group of abrasive tools having an abrasive surface in compliance with a standard defined by JIS and/or ISO; a group of samples composed of a plurality of standard samples for skin assessment, which are manufactured by transferring respective abrasive surfaces of the selected abrasive tools onto a polymer; " is not described in Cited Documents A to C in the examiner's decision (Cited Documents 1 to 3 in the reason for refusal by the body), nor was it well-known art before the filing of the present application. Thus Present Inventions 1 to 6 were not easily conceivable even by the a person skilled in the art on the basis of Cited Documents A to C in the examiner's decision, as discussed in the above No. 6.

Therefore, the examiner's decision should not be maintained in this respect.

No. 8 Reasons for refusal by the body (Article 36(6)(ii) of the Patent Act)

1 The body could not specify "predetermined standard" with respect to "a group of abrasive tools having an abrasive surface in compliance with the predetermined standard" of Claim 1, and thus issued reasons for refusal that the invention according to Claim 1 is indefinite. In an amendment on October 5, 2018, "predetermined standard" was amended to "standard defined by JIS and/or ISO", which has overcome the reasons for refusal.

2 The body issued the reasons for refusal that the meaning of "(excluding medical act)" of Claims 1 to 7 is indefinite. In Claims 1 to 6 of the scope of claims to which an amendment was made on October 5, 2018, the recitation of "(excluding medical act)" was deleted. In the amendment, "a skin condition assessment method" of the invention according to Claim 1 of the present application was amended to "a skin condition assessment method to assess skin condition of a subject skin for assessing use effect of skin-care cosmetics on skin condition", which as a result has overcome the reasons for refusal.

No. 9 Closing

As described above, the application should not be rejected for the reasons of the examiner's decision and the reasons by the body.

No other reason for refusal was found.

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

November 5, 2018

Chief administrative judge:	ITO, Masaya
Administrative judge:	FUKUSHIMA, Koji
Administrative judge:	MISAKI, Hitoshi