

Advisory Opinion

Advisory opinion No. 2019-600005

Kyoto, Japan

Demandant

CosMED Pharmaceutical Co., Ltd.

Osaka, Japan

Demandee

Wave Corporation Co., Ltd.

The case of advisory opinion on the technical scope of a patent invention for Patent No. 5687170 between the parties above is stated and concluded as follows.

Conclusion

The "microneedle patch storage container" indicated in the drawings and explanatory document of Article A belongs to the technical scope of the invention according to Claim 1 of Japanese Patent No. 5687170.

Reason

No. 1 Object of the demand

The object of the advisory opinion is to demand the advisory opinion that the microneedle patch storage container indicated in the drawings and explanatory document of Article A (hereinafter, referred to as "Article A") belongs to the technical scope of the invention according to Claim 1 of Japanese Patent No. 5687170.

(Note by the body: Although, in the column of object of the demand of a written request for an advisory opinion, it is described that "to demand the advisory opinion that the microneedle patch storage container indicated in the drawings and explanatory document of Article A belongs to the technical scope of the invention according to Japanese Patent No. 5687170." according to the description of the columns of "5 Statement of the request" of the written request for the advisory opinion, it is obvious that the object is "to demand the advisory opinion that the microneedle patch storage container indicated in the drawings and explanatory document of Article A belongs to the technical scope of the invention according to Claim 1 of Japanese Patent No. 5687170."; the above findings have been made based on these points.)

No. 2 History of the procedures and the patent invention

1 History of the procedures

September 22, 2011	Application of Japanese Patent (Japanese Patent Application No. 2011-225328)
Dated July 2, 2014	Notice of reasons for refusal
September 4, 2014	Submission of written opinion and written amendment
January 30, 2015	Registration of establishment
November 2, 2015	Demand for trial for correction (Correction No. 2015-390119)
January 15, 2016	Trial decision of the correction made final and binding
February 5, 2019	Request for the advisory opinion of the case
Dated February 19, 2019	Written amendment instruction
February 27, 2019	Submission of written amendment
Dated March 5, 2019	Delivery notice of a duplicate of the written request for the advisory opinion to the demandee, Wave Corporation Co., Ltd.
Dated March 6, 2019	Transmittal notice of a duplicate of the written amendment to the demandee, Wave Corporation Co., Ltd.

Then, a duplicate of the written request for the advisory opinion and a duplicate of the written amendment were delivered, and although an opportunity was given for filing a written reply within a designated period, there was no response from the demandee.

2 The patent invention

The patent invention relating to the request for the advisory opinion is the invention according to Claim 1 of Japanese Patent No. 5687170 (hereinafter, referred to as "the patent invention"), in view of the description of Trial Decision Gazette of the trial decision of the correction (Correction No. 2015-390119) made final and binding on January 15, 2016, which is approved as the invention described in Claim 1 in the scope of claims. The constituent components are as follows when stated in a manner describing separately for each constituent component (hereinafter, each of them is referred to as such as the "constituent component (A)"), according to the description of the written request for the advisory opinion.

(G) A microneedle patch storage container, having

(A) one or a plurality of bottom surfaces recessed from a peripheral portion,

(B) a side surface connecting the bottom surface and the peripheral portion,

(C) a bottom surface convex portion protruding from the bottom surface, and

- (D) the bottom surface convex portion existing at a position corresponding to a release sheet of a flexible microneedle patch,
- (E) the release sheet part of the flexible microneedle patch being held by the bottom surface convex portion of each bottom surface,
- (F) the bottom surface existing between the peripheral portion and the bottom surface convex portion.

3 Object and effects and the like of the patent invention

It is recognized that the patent invention has an object to make a microneedle patch be "held hygienically and, in addition, in a manner not deteriorating its pharmaceutical benefit during a period from completion of its manufacturing to its use via a distribution process" (paragraph [0009]), a microneedle patch storage container is made to have the above-mentioned constitution, and, by this, it produces an effect that "a microneedle patch is held by the portion of a release sheet, and the microneedle portion does not come into contact with any portion of the container. Even if a microneedle patch is a flexible sheet, it can be held hygienically until the container is opened." (paragraph [0023]).

No. 3 Article A

1 In the written request, 5(4) of (Page 3), for advisory opinion of the case, the following matters are described as "explanation of the drawings of Article A."

"(4) Explanation of the drawings of Article A

As shown in the following explanation, Article A is as follows when stating based on the patent invention.

- (g) A microneedle patch storage container, having
 - (a) one bottom surface (2) recessed from a peripheral portion (1),
 - (b) a side surface (3) connecting the bottom surface (2) and the peripheral portion (1),
 - (c) a bottom surface convex portion (4) protruding from the bottom surface (2), and
 - (d) the bottom surface convex portion (4) existing at a position corresponding to a protection sheet (13) of a flexible microneedle patch (10),
 - (e) a part of the protection sheet (13) of the flexible microneedle patch (10) being held by the bottom surface convex portion (4) of each bottom surface (2),
 - (f) the bottom surface (2) existing between the peripheral portion (1) and the bottom surface convex portion (4).

Explanation of (a)

As shown in the drawings and explanatory document of Article A and Evidence A No. 3, Article A has "one bottom surface (2) recessed from a peripheral portion (1)."

Explanation of (b)

As shown in the drawings and explanatory document of Article A and Evidence A No. 3, Article A has "a side surface (3) connecting the bottom surface (2) and the peripheral portion (1)."

Explanation of (c)

As shown in the drawings and explanatory document of Article A and Evidence A No. 3, Article A has "a bottom surface convex portion (4) protruding from the bottom surface (2)."

Explanation of (d)

As shown in the drawings and explanatory document of Article A and Evidence A No. 3, in Article A, "the bottom surface convex portion (4) exists at a position corresponding to a protection sheet (13) of a flexible microneedle patch (10)." Further, the protection sheet, as described in [How to use] of Evidence A No. 3, "the surrounding white protection sheet is removed," is synonymous with the release sheet attached to the viscous surface in the patent invention (Evidence A No. 1, Paragraph [0009]).

Explanation of (e)

As shown in the drawings and explanatory document of Article A and Evidence A No. 3, in Article A, "a part of the protection sheet (13) of the flexible microneedle patch (10) is held by the bottom surface convex portion (4) of each bottom surface (2)." The protection sheet, the same as (d) above, is the release sheet in the patent invention.

Explanation of (f)

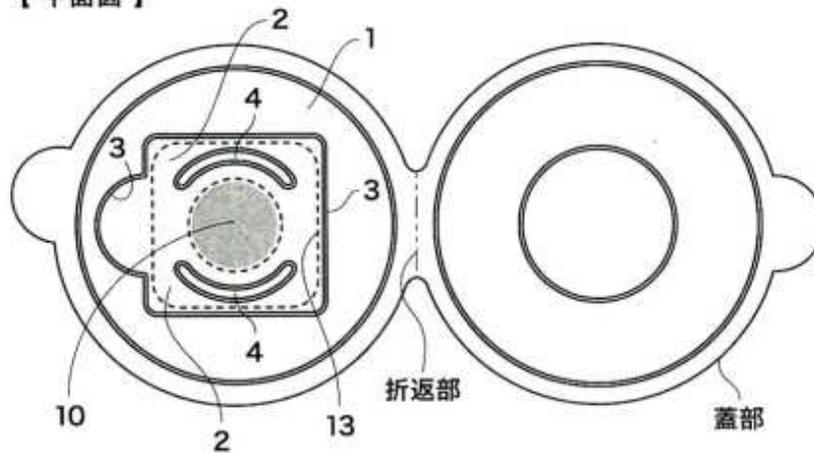
As shown in the drawings and explanatory document of Article A and Evidence A No. 3, in Article A, "the bottom surface (2) exists between the peripheral portion (1) and the bottom surface convex portion (4)."

Explanation of (g)

As shown in the drawings and explanatory document of Article A and Evidence A No. 3, Article A is "a microneedle patch storage container".

2 The drawings and explanatory document of Article A attached to the written request for advisory opinion of the case describe the following matters.

【 平面図 】



- ・二重線は、立体に加工されたケースの側面を表している。
- ・点線は、マイクロニードルパッチが保持される位置を示す。
- ・網かけ部は、保持されたマイクロニードルパッチのマイクロニードルの部分を示す。

イ号図面及び説明書	The drawings and explanatory document of Article A
平面図	Top View
折返部	Folded portion
蓋部	Cover portion

- ・二重線は、立体に加工されたケースの側面を表している。 The double line represents a side surface of a case that has been three-dimensionally machined.
- ・点線は、マイクロニードルパッチが保持される位置を示す。 The dotted line indicates a position where the microneedle patch is held.
- ・網かけ部は、保持されたマイクロニードルパッチのマイクロニードルの部分を示す。 A shaded part indicates a microneedle part of the held microneedle patch.

Further, "(1) Necessity of request for advisory opinion" of "5 Statement of the request" in the written request for advisory opinion describes as follows.

"The patentee (the demandant, CosMED Pharmaceutical) of the patent invention 'microneedle patch storage container' (Evidence A No. 1) relating to the request for the advisory opinion of the case, confirmed that Wave Corporation Co., Ltd (the demandee)

manufactures and sells a Spa Treatment White Micro Patch (Evidence A No. 3: Article A) using the microneedle patch storage container that indicates in the drawings and explanatory document of Article A."

According to this description and No. 1 "Object of the demand" above, it can be said that "the drawings and explanatory document of Article A" indicate Article A of Evidence A No. 3: Spa Treatment White Micro Patch.

3 Packaging of Article A

In the packaging of Spa Treatment White Micro Patch that is Article A submitted as Evidence A No. 3, it is described as follows.

"[How to use]

- * After washing your face and using a lotion, please use after your face is dry.
- * Peel off the surrounding white protection sheet so as not to touch the protruding part in the center of the sheet, and place it on the part of your face that you are worried about and press it lightly over the sheet. (Remainder omitted)

From the description matter, it can be said that Article A has a white protection sheet around the protruding part of the center of the sheet. Also, since the sheet is to be placed on a part of a face and then pressed lightly over the sheet, it is obviously flexible. Further, since the protection sheet can be removed, it is also obvious that it functions as a release sheet.

4 Article A

The following matters can be observed from Article A submitted as Evidence A No. 3. By the way, for the figure numbers, reference is made the figure numbers given by the demandant in the drawings of Article A of "the drawings and explanatory document of Article A" of 1 above.

- (A) Article A is a container and stores a sheet (10).
- (B) Article A has a circular outer edge portion and a first side surface raised from the outer edge portion, an upper surface portion (1) connecting to the first side surface, and one bottom surface portion (2) with a generally square outline, which is recessed from the upper surface portion (1) and has a semi-circular bulge on a part of one side.
- (C) Article A has a second side surface (3) connecting the bottom surface portion (2) and the upper surface portion (1).
- (D) Article A has a pair of opposite arc-shaped first convex portions (4) protruding from the bottom surface portion (2).

(E) The convex portion (4) of Article A exists at a position corresponding to a white protection sheet (13) around a protruding part of the center of the sheet (10).

(F) A part of the white protection sheet (13) around the protruding part of the center of the sheet (10) of Article A is placed on the first convex portion (4) of the bottom surface portion (2).

(G) Between the upper surface portion (1) and the first convex portion (4), the bottom surface portion (2) and a second convex portion that is higher than the bottom surface portion (2) but lower than the first convex portion (4) exists.

5 When 1 to 4 above are summarize, Article A includes the following constitution (hereinafter, referred to as such as the "constitution (a)").

"(g) A container for storing a flexible sheet (10), having

(a) a circular outer edge portion and a first side surface raised from the outer edge portion, an upper surface portion (1) connecting to the first side surface, one bottom surface portion (2) with a generally square outline, which is recessed from the upper surface portion (1) and has a semi-circular bulge on a part of one side,

(b) a second side surface (3) connecting the bottom surface portion (2) and the upper surface portion (1), and

(c) a pair of opposite arc-shaped first convex portions (4) protruding from the bottom surface portion (2),

(d) the convex portion (4) existing at a position corresponding to a white protection sheet (13) around a protruding part of the center of the flexible sheet (10),

(e) a part of the white protection sheet (13) around the protruding part of the center of the flexible sheet (10) being placed on the first convex portion (4) of the bottom surface portion (2),

(f) between the upper surface portion (1) and the first convex portion (4), the bottom surface portion (2) and a second convex portion that is higher than the bottom surface portion (2) but lower than the first convex portion (4) exist."

No. 4 Comparison/Judgment

1 Regarding sufficiency of the constituent components

We will examine whether or not Article A satisfies the constituent components of the patent invention.

(1) Regarding the constituent component (A)

Article A has the constitution (a) that is "a circular outer edge portion and a first side surface raised from the outer edge portion, an upper surface portion (1) connecting

to the first side surface, one bottom surface portion (2) with a generally square outline, which is recessed from the upper surface portion (1) and has a semi-circular bulge on a part of one side."

Then, according to the descriptions Paragraphs [0011], [0031], [0032], FIG. 2, and the like of the specification and other materials of the patent, in the patent invention, although it is understood that "the bottom surface" is a surface on a bottom in a recessed space in which the microneedle patch (10) is tightly stored, and "the peripheral portion" is a part positioned so as to surround the periphery of the microneedle patch (10) supported by the bottom surface convex portion (34) and tightly stored in the recessed space, and positioned higher than the bottom surface (2), in comparison between the constituent component (A) of the patent invention and the constitution (a) of Article A, "an upper surface portion (1)" of Article A, as viewed from its structures, corresponds to "a peripheral portion" of the patent invention, and subsequently, "one bottom surface portion (2)" corresponds to "one or a plurality of bottom surfaces".

In view of the above, the constitution (a) of Article A satisfies the constituent component (A) that is "one or a plurality of bottom surfaces recessed from a peripheral portion" of the patent invention.

(2) Regarding the constituent component (B)

Article A has the constitution (b) that is "a second side surface (3) connecting the bottom surface portion (2) and the upper surface portion (1)."

In comparison between the constituent component (B) of the patent invention and the constitution (b) of Article A, "a second side surface (3)" of Article A connects "an upper surface portion" corresponding to "a peripheral portion" of the patent invention and "a bottom surface portion" corresponding to "a bottom surface" of the patent invention, and as viewed from its structure, corresponds to "a side surface" of the patent invention.

In view of the above, the constitution (b) of Article A satisfies the constituent component (B) that is "a side surface connecting the bottom surface and the peripheral portion" of the patent invention.

(3) Regarding the constituent component (C)

Article A has the constitution (c) "a pair of opposite arc-shaped first convex portions (4) protruding from the bottom surface portion (2)."

In comparison between the constituent component (C) of the patent invention and the constitution (c) of Article A, "a first convex portion (4)" of Article A, as viewed from its structure, corresponds to "a bottom surface convex portion" of the patent invention.

In view of the above, the constitution (c) of Article A satisfies the constituent component (C) that is "a bottom surface convex portion protruding from the bottom surface" of the patent invention.

(4) Regarding the constituent component (D)

Article A has the constitution (d) that is "the convex portion (4) existing at a position corresponding to a white protection sheet (13) around a protruding part of the center of the flexible sheet (10)."

In comparison between the constituent component (D) of the patent invention and the constitution (d) of Article A, "flexible" of Article A, as viewed from its function and operation, corresponds to "flexible" of the patent invention. Also, "a sheet (10)" of Article A, as viewed from its structure and function, corresponds to "a microneedle patch" of the patent invention. Furthermore, "a white protection sheet (13)" of Article A, as described in No. 3-3 above, functions as a release sheet, and thus corresponds to "a release sheet" of the patent invention.

In view of the above, the constitution (d) of Article A satisfies the constituent component (D) that is "the bottom surface convex portion existing at a position corresponding to a release sheet of a flexible microneedle patch" of the patent invention.

(5) Regarding the constituent component (E)

Article A has the constitution (e) that is "a part of the white protection sheet (13) around the protruding part of the center of the flexible sheet (10) being placed on the first convex portion (4) of the bottom surface portion (2)."

In comparison between the constituent component (E) of the patent invention and the constitution (e) of Article A, "a part of the protection sheet (13)" of Article A, as viewed from its structure, corresponds to "the release sheet part" of the patent invention.

Further, since it can be said that "held" of the patent invention, as viewed from the description "when the lid 20 and the storage container 30 are engaged with each other, the microneedle patch is inserted and held by the recess 22, the bottom surface convex portion 34 and the side surface convex portion 35 of the storage container" in [0033] of the specification of the case, includes placing the microneedle patch on the bottom surface convex portion 34 of the storage container, "placed" of Article A, as viewed from its function and operation, corresponds to "held" of the patent invention.

In view of the above, the constitution (e) of Article A satisfies the constituent component (E) that is "the release sheet part of the flexible microneedle patch being held by the bottom surface convex portion of each bottom surface" of the patent invention.

(6) Regarding the constituent component (F)

Article A has the constitution (f) that is "between the upper surface portion (1) and the first convex portion (4), the bottom surface portion (2) and a second convex portion that is higher than the bottom surface portion (2) but lower than the first convex portion (4) exist."

When examining the constitution (f), it can be said that between the upper surface portion (1) and the first convex portion (4), the bottom surface portion (2) always exists, though not necessarily throughout.

Further, "the bottom surface convex portion" of the patent invention holds the microneedle patch, but on the other hand, the second convex portion of Article A is lower than the first convex portion (4) and does not contribute to holding the sheet (10), and thus can be considered to constitute a part of the bottom surface portion (2). Then, it can be said that "the bottom surface portion (2)" and "a second convex portion" of Article A, as viewed from their structures, correspond to "the bottom surface" of the patent invention.

In any case, the constitution (f) of Article A satisfies the constituent component (F) that is "the bottom surface existing between the peripheral portion and the bottom surface convex portion" of the patent invention.

(7) Regarding the constituent component (G)

Article A has the constitution (g) that is "a container for storing a sheet (10)."

In comparison between the constituent component (G) of the patent invention and the constitution (g) of Article A, "storing" of Article A, as viewed from its function and operation, corresponds to "storage" of the patent invention.

In view of the above, the constitution (g) of Article A satisfies the constituent component (G) that is "a microneedle patch storage container" of the patent invention.

2 Summary

As shown in 1 (1) to (7) above, the constitutions (a) to (g) of Article A respectively satisfy the constituent components (A) to (G) of the patent invention, and thus it can be said that Article A belongs to the technical scope of the patent invention.

No. 5 Closing

Accordingly, Article A belongs to the technical scope of the patent invention. Therefore, the advisory opinion shall be made as described in the conclusion.

June 5, 2019

Chief administrative judge: HAYASHI, Shigeki
Administrative judge: ASHIHARA, Yasuhiro
Administrative judge: TAKAGI, Akira