

## Appeal decision

Appeal No. 2019-11786

Appellant	L'Oreal
Patent Attorney	MURAYAMA, Yasuhiko
Patent Attorney	JITSUHIRO, Shinya
Patent Attorney	HORIE, Kentaro

The case of appeal against the examiner's decision of refusal of Japanese Patent Application No. 2017-542331, entitled "Cosmetic Applicator Having Fiber" (International Publication No. WO2016/071486 published on May 12, 2016, National Publication of International Patent Application No. 2018-501044 published on January 18, 2018) has resulted in the following appeal decision.

### Conclusion

The appeal of the case was groundless.

### Reason

#### No. 1 History of the procedures

The present application was filed on November 6, 2015 as an international filing date (Priority Claim received by the foreign receiving office under the Paris Convention on November 6, 2014, France), and a written amendment was submitted on June 12, 2017. Although a written opinion and a written amendment were submitted on November 12, 2018 in response to the notice of reasons for refusal dated August 8, 2018, an examiner's decision of refusal was issued on April 24, 2019, and a demand for appeal against the examiner's decision of refusal was made on September 6, 2019.

#### No. 2 The Invention

The invention according to claims of the present application is recognized as specified by the matters described in Claims 1 to 10 of the scope of claims amended by the written amendment dated on November 12, 2018, and the invention according to Claim 1 (hereinafter, referred to as "the Invention") is as follows.

"An applicator (3) for applying a cosmetic product, comprising:  
a stem (4); and  
an applicator member (5) carried by the stem (4), and having a plurality of fibers (11),  
each fiber (11) having  
    a hollow cylindrical body (13), and  
    at least one longitudinal rib (17; 17a, 17b; 17i, and 17e) attached to the body (13)  
by a base (23) thereof,  
    wherein each fiber (11) is not axially symmetrical in cross section and is  
inscribed in a circle (C) with a diameter of D2, in which a ratio  $D2/D1$  is 1.75 or less,  
D1 being the maximum outside transverse dimension of the body (13), and  
    wherein at least one longitudinal rib (17; 17i) extends into the inside of the body  
(13) and one or more the longitudinal ribs (17;17a, 17b; 17i, and 17e) have a polygonal  
shaped cross section, or at least one longitudinal rib (17;17i) extends into the inside of  
the body (13) or one or more the longitudinal ribs (17;17a, 17b; 17i, and 17e) have a  
polygonal shaped cross section".

#### No. 3 Reasons for refusal stated in the examiner's decision

Of the reasons for refusal stated in the examiner's decision (the examiner's decision of refusal dated April 24, 2019) regarding the Invention (the invention according to Claim 1) (the reasons for refusal noticed on August 8, 2018) relating to inventive step, the summary is as follows.

(Inventive step) The invention according to Claim 1 of the present application could have been easily invented by a person who had ordinary skill in the art belonging to the invention (hereinafter, referred to as "a person skilled in the art") before the priority date, based on the invention described in Cited Document 1 below and the matters described in Cited Document 2, or based on the invention described in Cited Document 3 and the matters described in Cited Document 2, which were distributed or available to public over an electric communication network in Japan or a foreign country before the priority date of the application, and accordingly, the Appellant should not be granted a patent for the Invention under the provisions of Article 29(2) of the Patent Act.

Cited Document 1: United States Patent No. 6237609

Cited Document 2: United States Patent No. 5933908

Cited Document 3: Japanese Unexamined Patent Application Publication No. 2003-

No. 4 Descriptions in the Cited Documents and Cited Invention

1. Cited Document 1

(1) Descriptions in Cited Document 1

Cited Document 1 cited in the reasons for refusal stated in the examiner's decision, which is a publication distributed before the priority date of the present application, describes the following statement together with drawings (the underlines were added by the body, the same fashion shall be applied hereinafter).

A. "FIGS. 1-7 illustrate a mascara container 10 and its mascara brush 12, according to the invention herein. The container 10 has an elongated tubular body 14 which defines a cavity 16 therein for receiving and storing mascara, not shown. The body 14 has a threaded neck 18 in which a wiper 20 is mounted." (Column 3, lines 45 to 50)

B. "The mascara container 10 has a cap 26 which has internal threads 28 adapting the cap for being secured on the threaded neck 18 of the body 14. The threads 28 are conveniently provided on a head 32 of an applicator rod 30, the head 32 being inserted into the cap to mount the applicator rod thereto and provide for attaching the cap to the body 10. The applicator rod 30 and its head 32 may be fabricated of acetal plastic. The distal end 34 of the applicator rod 30 mounts the mascara brush 12.

The brush 12 has a twisted wire core 40 extending from a tip 42 to a shank 44, the shank being inserted into the distal end 34 the applicator rod 30 to mount the brush thereto. The tip 42 and shank 44 lie along the axis of the applicator rod. The twisted wire core 40 secures a plurality of bristles, generally indicated at 46, and the bristles extend generally radially from the twisted wire core 40. With reference to FIG. 4, a single bristle 47 is illustrated, the bristle 47 being a hollow fiber bristle with tri-lobal longitudinal ribs 49 on its exterior surface. The overall diameter of the bristles, subject to manufacturing tolerances, may be 0.005 inches, and the bristles may be made of 6.12 nylon. Such bristles have a desirable tendency to spread when captured in a twisted wire core, but are still considered as extending generally radially from the core." (Column 3, line 59 to Column 4, line 15)

C. "In using the brush 12, the applicator bristles that are closer to the plane P are generally more highly involved in the application process and, because these bristles extend from the convex side of the twisted wire core, they diverge and separate toward their tips. This allows the eyelashes to be received between the applicator bristles 50

for transferring mascara from the bristles 46 to the eyelashes." (Column 4, lines 34 to 41)

D. According to the described matter C, in using the brush 12, the brush 12 can transfer mascara from the bristles 46 to the eyelashes. Further, according to the described matter B, the mascara brush 12 is mounted to the distal end 34 of the applicator rod 30. Therefore, it can be said that a member equipped with the mascara brush 12 and the applicator rod 30 to mount the mascara brush 12 thereto can transfer mascara from the bristles 46 to the eyelashes.

E. According to the described matter B, it can be said that the mascara brush 12 is mounted to the applicator rod 30, and has a plurality of bristles 46 extending generally radially from the twisted wire core 40.

F. According to the described matter B, it can be said that the single bristle 47 of the mascara brush 12 is a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface.

## (2) Cited Invention

Summarizing the described matters A to F of Cited Document 1 and illustrated contents of the drawings, it is recognized that Cited Document 1 describes the following invention (hereinafter, referred to as "the Cited Invention").

"A member equipped with a mascara brush 12 and an applicator rod 30 to mount the mascara brush 12 thereto, which can transfer mascara from bristles 46 to eyelashes, comprising:

the applicator rod 30; and

the mascara brush 12 which is mounted to the applicator rod 30, and has the plurality of bristles 46 extending generally radially from a twisted wire core 40, wherein a single bristle 47 is a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface".

## 2. Cited Document 2

Cited Document 2 cited in the reasons for refusal stated in the examiner's decision, which is a publication distributed before the priority date of the present application, describes the following statement together with drawings.

(1) "The bristle 10 includes a central core 12 having a pair of semi-cylindrical passages 14 and 16 extending the length of the bristle and separated by a central dividing wall 18. In addition, the bristle 10 includes four spokes, or ribs, 20, 22, 24, and 26 projecting radially from the outer surface 27 of said core." (Column 3, lines 22 to 27)

(2) "It is an extremely important feature of this invention that the spokes be equally spaced about the circumference of the bristle, that none of the spokes be in the same plane as the central dividing wall 18, and that the spokes adjacent to, and on opposite sides of the dividing wall 18 be equally spaced from the central axis 28 of said dividing wall. This structural arrangement among the central dividing wall 18 and the spokes provides for a balanced weight distribution around the circumference of the bristle, which assists in maintaining the bristle substantially straight throughout the longitudinal extent thereof; i.e., avoids camber or curl in the longitudinal direction of the bristle 10. This is a very important property of bristles employed in applicator brushes, such as in paintbrushes, toothbrushes, and cosmetic brushes." (Column 3, lines 36 to 49)

(3) "The bristles of this invention have a number of advantages over prior art hollow and honeycomb bristles.

First, the inclusion of the central dividing wall 18, 118, and 218 in the bristles 10, 100 and 200 of this invention renders the bristles more stable than hollow bristles having a single, central passage through them. Second, the provision of the central dividing wall provides an additional surface to be flagged as compared to a bristle with a single central passage, for the purpose of enhancing the evenness of paint application. Third, the inclusion of radiating ribs or spokes in the honeycomb construction also increases the surface available for flagging as compared to a bristle with a single central passage (with or without ribs) or to a honeycomb bristle without ribs.

The aforementioned benefits are achieved in bristles of this invention that tend to remain straight during use; i.e., they do not tend to develop camber or curl, because of the unique and effective weight distribution of the polymer within the bristles." (Column 6, lines 3 to 21)

#### No. 5 Comparison

Hereinafter, the Invention and the Cited Invention are compared.

"mascara" of the Cited Invention corresponds to "a cosmetic product" of the Invention, and it can be said that the matter which "can transfer mascara from bristles 46 to eyelashes" of the Cited Invention is to apply mascara to eyelashes, and thus

corresponds to "applying a cosmetic product" of the Invention. Further, "a member equipped with a mascara brush 12 and an applicator rod 30 to mount the mascara brush 12 thereto" of the Cited Invention is for transferring mascara from bristles 46 to eyelashes, and corresponds to "an applicator (3)" of the Invention. Then, "a member equipped with a mascara brush 12 and an applicator rod 30 to mount the mascara brush 12 thereto, which can transfer mascara from bristles 46 to eyelashes" of the Cited Invention corresponds to "an applicator (3) for applying a cosmetic product" of the Invention.

"An applicator rod 30" of the Cited Invention corresponds to "a stem (4)" of the Invention.

"A mascara brush 12," "a plurality of bristles 46," and "a single bristle 47" of the Cited Invention respectively correspond to "an applicator (5)," " a plurality of fibers (11)," and "each fiber (11)" of the Invention. Considering illustrated contents of FIG. 4 of Cited Document 1 (Note by the body: considering that the number "48" added to FIG. 4 is not referenced in the specification, and that although it is described that "With reference to FIG. 4, a single bristle 47 is illustrated" in the described matter B. of "No. 4 1.(1)" above, the number "47" is not illustrated, the number "48" added to FIG. 4 is recognized as a clerical error of "47"), "a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface" of the Cited Invention is one equipped with longitudinal ribs 49 extending its longitudinal direction on an exterior surface of a hollow cylindrical member, and it can be said that bases of the longitudinal ribs 49 are adhered to the exterior of the hollow cylindrical member, and thus it corresponds to "a hollow cylindrical body (13), and at least one longitudinal rib (17; 17a, 17b; 17i, and 17e) attached to the body (13) by a base (23) thereof" of the Invention. Accordingly, "the mascara brush 12 which is mounted to the applicator rod 30, and has the plurality of bristles 46 extending generally radially from a twisted wire core 40, wherein a single bristle 47 is a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface" of the Cited Invention corresponds to "an applicator member (5) carried by the stem (4), and having a plurality of fibers (11), each fiber (11) having a hollow cylindrical body (13), and at least one longitudinal rib (17; 17a, 17b; 17i, and 17e) attached to the body (13) by a base (23) thereof" of the Invention.

Furthermore, concerning the matter "each fiber (11) is not axially symmetrical in cross section" of the Invention, in Paragraph [0051] of the specification of the present application, it is described that "a cross section of the fiber 11 is not symmetrical around its center, and in the illustrated example, the fiber is an image of itself with a rotation of 120°," and as an example for FIG. 2, one provided with three longitudinal ribs 17 at

intervals of 120° is described. The arrangement of such longitudinal ribs 17 is also included in the matter that "each fiber (11) is not axially symmetrical in cross section" of the Invention, and the matter that "a single bristle 47 is a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface" of the Cited Invention, considering the illustrated contents of FIG. 4 of Cited Document 1, is one provided with three longitudinal ribs 49 at intervals of generally 120° on an exterior surface of a hollow cylindrical member. Therefore, since it can be said that a cross-sectional shape of the single bristle 47 of the Cited Invention, concerning an arrangement place of the longitudinal ribs 49, matches a cross-sectional shape of the fiber (11) in the example of the Invention and is not axially symmetrical, the matter that "a single bristle 47 is a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface" of the Cited Invention and the matter that "each fiber (11) is not axially symmetrical in cross section and is inscribed in a circle (C) with a diameter of D, in which a ratio  $D2/D1$  is 1.75 or less, the  $D1$  being the maximum outside transverse dimension of the body (13)" of the Invention are common in the point that "each fiber is not axially symmetrical in cross section".

Therefore, the Invention and the Cited Invention are common in the point that "An applicator for applying a cosmetic product, comprising:  
a stem; and  
an applicator member carried by the stem, and having a plurality of fibers, each fiber having  
a hollow cylindrical body, and  
at least one longitudinal rib attached to the body by a base thereof,  
wherein each fiber is not axially symmetrical in cross section,"  
and are different in the following points.

[Different Feature 1]

Concerning each fiber, in the Invention, it "is inscribed in a circle with a diameter of  $D2$ , in which a ratio  $D2/D1$  is 1.75 or less,  $D1$  being the maximum outside transverse dimension of the body," whereas, in the Cited Invention, it is not clear if it has such a ratio.

[Different Feature 2]

Concerning the longitudinal ribs, in the Invention, "at least one longitudinal rib extends into the inside of the body and one or more the longitudinal ribs have a

polygonal shaped cross section, or at least one longitudinal rib extends into the inside of the body or one or more the longitudinal ribs have a polygonal shaped cross section," whereas, in the Cited Invention, the longitudinal ribs 49 do not extend into the hollow inside of the hollow fiber bristle, and it cannot be said that the longitudinal ribs 49 have a polygonal shaped cross section.

#### No. 6 Judgment

Hereinafter, the different features are examined.

##### (1) Regarding [Different Feature 1]

Concerning "a single bristle 47" that "is a hollow fiber bristle with trilobal longitudinal ribs 49 on its exterior surface" of the Cited Invention, in the described matter B. of "No. 4 1.(1)" above, it is described that those "have a desirable tendency to spread when captured in a twisted wire core, but are still considered as extending generally radially from the core," and it can be said that it is desirable that the "single bristle 47" extends generally radially from a twisted wire core. Also, "the longitudinal ribs 49" contribute to increase the rigidity of "the single bristle 47" as long as they are ribs, and it can be said that they are provided so that "the single bristle 47" has rigidity for extending generally radially as described above.

Furthermore, since it is an obvious matter that the dimensions of "the longitudinal ribs 49" influence the rigidity of "the single bristle 47," it could have been easily conceived by a person skilled in the art to optimize the dimensions such as height and width of "the longitudinal ribs 49" by considering the rigidity of "the single bristle 47" to be required and coating performance of mascara to eyelashes that is an original function of "the mascara brush 12" and the like.

Then, even examining the matter that "is inscribed in a circle with a diameter D2, in which a ratio  $D2/D1$  is 1.75 or less, the D1 being the maximum outside transverse dimension of the body" of the Invention, if the dimensions (width, etc.) other than the height of the longitudinal rib extending to the outside of the hollow cylindrical body (13), a material of the fiber (11) or the like changes, the rigidity of the fiber (11) changes. The matter "a ratio  $D2/D1$  is 1.75 or less" does not necessarily specify the rigidity of the fiber (11), and it cannot be recognized that this numerical range has a critical significance regarding the applicability of cosmetic products. Further, seeing FIG. 4 of Cited Document 1, one having a ratio  $D2/D1$  of 1.75 or less (about 1.67) is illustrated, and it cannot be acknowledged that the numerical range of "a ratio  $D2/D1$  is 1.75 or less" is a special one different from a general one.

Therefore, as described above, it could have been easily conceived by a person

skilled in the art to optimize the dimensions such as the height of "the longitudinal ribs 49" of the Cited Invention, and at that time, it is not significantly difficult to make the height within the numerical range of "is inscribed in a circle with a diameter D2, in which a ratio  $D2/D1$  is 1.75 or less, D1 being the maximum outside transverse dimension of the body (13)".

(2) Regarding [Different Feature 2]

According to the described matters (1) to (3) of "No. 4 2." above, Cited Document 2 describes a bristle 10 including a central dividing wall 18 extending in the length of the bristle 10 in a central core 12 and including four ribs 20, 22, 24, and 26 projecting radially from the outer surface 27 of the central core 12, and suggests that the bristle is maintained substantially straight throughout the longitudinal extent thereof and camber or curl in the longitudinal direction of the bristle 10 is avoided by providing the central dividing wall 18 and the four ribs 20, 22, 24, and 26.

The Cited Invention and the matters described in Cited Document 2 are both related to a brush for a cosmetic product, and their technical fields are common. Furthermore, according to the described matter B, of "No. 4 1. (1)" above, it is understood that the Cited Invention includes a problem that the single bristle 47 is extended generally radially from a twisted wire core, and to solve the problem, it is provided with the longitudinal ribs 49 on an exterior surface of a hollow fiber bristle configuring the single bristle 47. On the other hand, the matters described in Cited Document 2 maintain the bristle 10 substantially straight throughout the longitudinal extent thereof and solve the problem that camber or curl in the longitudinal direction of the bristle 10 is avoided, and to solve the problem, it is equipped with the central dividing wall 18 extending in the length of the bristle 10 in the central core 12 and the four ribs 20, 22, 24, and 26, so that it can be said that the problems of the two are related, and that the vertical ribs 49 of the Cited Invention and the central dividing wall 18 and the four ribs 20, 22, 24, and 26 have common effects and functions in the point that they apply rigidity to the fiber having a hollow part.

Accordingly, in the Cited Invention, it could have been easily conceived by a person skilled in the art to provide the central dividing wall extending in the longitudinal direction of the hollow fiber bristle in the hollow part of the hollow fiber bristle, in addition to the vertical ribs 49 provided on the exterior surface of the hollow fiber bristle, in order to further improve the problem that the single bristle 47 is extended generally radially from the twisted wire core, with reference to the configurations of the central dividing wall 18 and the four ribs 20, 22, 24, and 26 that

are the matters described in Cited Document 2 and have the common effects and functions with the vertical ribs 49. Further, since the central dividing wall extending in the longitudinal direction of the hollow fiber bristle, provided in the hollow part of the hollow fiber bristle, extends into the inside of the hollow cylindrical body in the hollow fiber bristle and improves the rigidity of the hollow fiber bristle, it can be said to be a longitudinal rib.

Therefore, it could have been easily conceived by a person skilled in the art to apply the matters described in Cited Document 2 to the Cited Invention to adopt "at least one longitudinal rib extends into the inside of the body" among the matters specifying the invention relating to Different Feature 2 of the Invention alternatively specifying "at least one longitudinal rib extends into the inside of the body and one or more the longitudinal ribs have a polygonal shaped cross section," "at least one longitudinal rib extends into the inside of the body," and "one or more the longitudinal ribs have a polygonal shaped cross section".

Further, the effects and functions of the Invention fall within a scope that can be predicted by a person skilled in the art based on Cited Invention and the matters described in Cited Document 2.

## (2) Appellant's allegation

The Appellant, in the reasons for the written demand for appeal amended by the written amendment (formality) submitted on October 17, 2019, alleges that "Examining the Invention 1, the term 'ribs' is used only for those referring to a component 17 projecting out from the exterior surface of a fiber or projecting from the inner surface of a hollow fiber, but please refer to FIGS. 2 to 7 of the application in which different types of 'ribs' are described. In the embodiment of the Invention, none of these ribs are assimilated with an internal wall, and there is no description in the specification that allows such an interpretation of the word 'ribs'. Furthermore, in Paragraph [0026] of the specification of the present application, it is indicated that the rib has a base connected to the body and a free end.

Examining about Cited Document 2, the term 'ribs' is used for referring to those extending radially outward from the exterior surface, which are also called spokes 20, 22, 24, and 26 (for example, see Abstract, FIG. 3, and Column 3, line 29). However, in Cited Document 2 the term 'ribs' is not used for referring to the inner part 18 called the central dividing wall 18.

Therefore, neither the drafter of the specification of the present application nor

the drafter of Cited Document 2 has selected the term 'ribs' for referring to the inner wall. Also, both have selected the term 'ribs' for referring to a projection having a base connected to the body and a free end.

Accordingly, it is impossible to link the central dividing wall 18 of Cited Document 2 to the ribs of the present application. Therefore, the opinions in the previous response will be repeated below." (Page 4, lines 25 to 41 of the written amendment (formality) submitted on October 17, 2019).

However, considering the description, etc. about "ribs L" illustrated in FIG. 3 of the specification of United States Patent Application Publication No. 2014/0159432 indicated at the time of the examiner's decision of refusal, it cannot be said that the term "ribs" is not always used to refer to a projection having a base connected to a body and a free end. Then, the Invention is specified in the longitudinal ribs, only as "attached to the body (13) by a base (23) thereof," and "at least one longitudinal rib (17; 17i) extends into the inside of the body (13) and one or more the longitudinal ribs (17;17a, 17b; 17i, and 17e) have a polygonal shaped cross section, or at least one longitudinal rib (17;17i) extends into the inside of the body (13) or one or more the longitudinal ribs (17;17a, 17b; 17i, and 17e) have a polygonal shaped cross section," and nothing is specified in having a free end, so that it cannot be said that the Appellant's allegation is based on the description of the scope of claims.

Accordingly, the Appellant's allegation cannot be accepted.

#### No. 7 Closing

Therefore, since the Invention (the invention according to Claim 1) could have been easily invented by a person skilled in the art, based on the Cited Invention and the matters described in Cited Document 2, the Appellant should not be granted a patent for the Invention under the provisions of Article 29(2) of the Patent Act.

Then, the present application including such an invention for which the Appellant should not be granted a patent should be rejected without examining inventions relating to other claims of the application.

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

September 18, 2020

Chief administrative judge: SASAKI, Yoshie  
Administrative judge: KAKIZAKI, Hiraki

Administrative judge: YAMAMOTO, Takeharu