

**Sunscreen Composition Case**  
**(Whether post-filing experiments can support the effect of the invention**  
**to assert inventive step)**

**IP High Court**

**Case H21 (Gyoke) No. 10238 (July 15, 2010)**

**FACTS**

The applicant, receiving a final rejection of Japanese Patent Application No.2000-561967 for a composition for sunscreen, filed an appeal (Appeal No.2007-5283).

In the appeal brief, the applicant described results of experiments done after the filing of the application that supported the effect of the invention, and described the effect of the invention to assert inventive step of the invention.

The Japan Patent Office rejected the appeal, ruling that the results of the experiments could not be used to show inventive step and that, even assuming the results could be used, no special effect was found, and therefore the invention lacked inventive step.

The applicant appealed the JPO's decision to the IP High Court.

**ISSUE**

Under what circumstances, if any, can the effect of an invention based on results of experiments performed after the filing of the application be used to assert inventive step?

**HOLDING AND REASONING**

When judging whether the requirements stipulated in Article 29, Paragraph 2 of the Patent Act have been met, barring exceptional circumstances the applicant cannot be allowed to assert inventive step by submitting results of experiments performed by the applicant after filing the patent application where the originally filed specification includes no description of the "effect of the invention", because to allow such proof contravenes the basic premise of the first-to-file patent system, which confers a patent right (exclusive right) in compensation for disclosure of the invention.

Thus, when judging the inventive step of the invention, it is not possible to take into consideration results of experiments performed after the filing as to the "effect of the invention" where, as here in this case, that effect was not clarified in the originally filed specification of the application, because to do so would be unfair to third parties, who have a right to rely on the applicant's disclosure as filed.

However, where there is a description in the originally filed specification to such a degree that a person skilled in the art can recognize or deduce the "effect of the invention", it should be possible to take into consideration the experimental results of experiments performed after the filing that are within the scope of the description. In sum, whether or not results of experiments done after the filing can be taken into consideration should be a matter of equity, judged from the viewpoint of fairness.