

# **Patent Infringement Litigation Case Study (2)**

**- Patent Infringement Under the Doctrine  
of Equivalents in Japan -**

Japan Patent Office

Asia-Pacific Industrial Property Center. JIII

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## I. Patent Infringement Litigation in Japan

### 1. Patent infringement

"Invention" in the Japan Patent Law means the highly advanced creation of technical ideas by which a law of nature is utilized (Article 2(1)).

"Patented invention" in the Japan Patent Law means an invention for which a patent has been granted (Article 2(2)).

"Working" of an invention in the Japan Patent Law means the following acts, (Article 2(3)):

(i) in case of an invention of a product (including program and the like);  
acts of manufacturing, using, assigning, leasing, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease ) of the product;

(ii) in case of an invention of a process;  
acts of using the process;

(iii) in case of an invention of a process of manufacturing a product;  
acts of using, assigning, leasing, importing or offering for assignment or lease (including displaying for the purpose of assignment or lease ) of the product manufactured by the process, in addition to the acts mentioned in the preceding paragraph (ii).

#### 1.1 Acts to be infringement of patent ( "Direct infringement" )

A patent owner has the right to exclude others from making, using, selling or offering to sell the patented invention.

A patentee shall have an exclusive right to commercially work the patented invention.

However, where the patent right is the subject of an exclusive license, this provision shall not apply to the extent that the exclusive licensee exclusively possesses the right to work the patented invention (Article 68).

Commercially working the following acts (commercially working a patented

invention) without authorization shall be an infringement of a patent right :

In case a patented invention is on a product;

- an act of manufacturing, using, selling, offering to sell or importing the "product",

In case a patented invention is on a process;

- an act of using the "process"

In case a patented invention is on a process for manufacturing a product;

- an act of using the " process for manufacturing a product" and
- an act of using, selling, offering to sell or importing the "product" made by the process for manufacturing.

—Presumption of manufacture by the patented process

In case a patented invention is on a process for manufacturing a product, where such a product was not publicly known in Japan prior to the filing of the patent application concerned, any identical product shall be presumed to have been manufactured by that process (Article 104).

## 1.2 Acts deemed to be infringement (“Indirect infringement”)

The following act shall be deemed to be an infringement of a patent right or an exclusive license (Article 101 i,ii,iii,iv):

(i) in case a patented invention is of a "product";

an act of commercially manufacturing, assigning and the like (selling and the like) or importing, or offering for assigning and the like, an article to be used exclusively (only) for the manufacture of the “product”;



(ii) in case a patented invention is of a “product”;

an act of commercially manufacturing, assigning and the like or importing, or offering for assigning and the like, an article (excluding those articles widely and commonly distributed in Japan) to be used for the manufacture of the "product", which is indispensable for accomplishing the object of the patented invention, with the knowledge that the invention is a patented invention and that the article must be used for the working of the invention;

(iii) in case a patented invention is of a "process";

an act of commercially manufacturing, assigning and the like or importing or offering for assignment and the like, an articles to be used exclusively (only) for working the process invention;

(iv) in case a patented invention is of a "process";

an act of commercially manufacturing, assigning and the like or importing, or offering for assigning and the like, an article (excluding those articles widely and commonly distributed in Japan) to be used for working the "processt", which is indispensable for accomplishing the object of the patented invention, with the knowledge that the invention is a patented invention and that the article must be used for the working of the invention;

## 2 Patent infringement litigation

### 2.1 Procedure against patent infringement

#### 2.1.1 Considerations in patent infringement case

##### ① patent owner

A patent owner who finds a patent infringement usually makes considerations concerning “warning” to the alleged infringer, “settlement” with the alleged infringer, and/or “judicial action before the court” (“patent infringement law-suit”).

② defender (alleged infringer)

Any third party who concerns about a patent infringement usually makes considerations concerning “submission of information”(which is able to invalidate the patent), “trial for invalidation of the patent before the Japan Patent Office”, “design around” (to keep away from an infringement), and/or “judicial action before the court” (“law-suit to confirm non-existence of patent infringement”).

2.1.2 Judicial action against patent infringement

The jurisdiction over patent infringement cases has been mainly exercised by the Tokyo District Court and the Osaka District Court as the first instance courts.

And the jurisdiction over appellate cases of patent infringement has been exercised by the Tokyo High Court and the Osaka High Court as the second instance court from the district courts.

Since the amendment of Civil Procedure Code in 2003 (came into effect from April 1, 2004), the Tokyo District Court (for cases in the East area of Japan) and the Osaka District Court (for cases in the West area of Japan) have had exclusive jurisdiction over patent infringement cases, and the Tokyo High Court (the Intellectual Property Special Division) have had exclusive jurisdiction as an appellate court from the Tokyo District Court and the Osaka District Court for patent infringement cases.

The Intellectual Property High Court, established as a special branch of the Tokyo High Court on April 1, 2005, has dealt with intellectual property cases including patent infringement cases as the successor of the Intellectual Property Special Division of the Tokyo High Court.

*Jokoku* Appeal (in case of violation of constitutional provision) or *Jokoku-Juri*

Appeal (in case of violation of the Supreme Court precedents) may be instituted against a decision in the Tokyo High Court (the Intellectual High Court since April 1, 2005) before the Supreme Court as the third and the last instance court.

## 2.2 Remedies against infringement

### 2.2.1 Demands of patent holders

#### (1) Injunction

(a) A patentee or exclusive licensee may require a person who is infringing or is likely to infringe the patent right or exclusive license to discontinue or refrain from such infringement (Article 100(1)).

(b) A patentee or an exclusive licensee who is acting under Article 100(1) may demand the destruction of the articles by which the act of infringement was committed (including the articles manufactured by the act of infringement in the case of a patented invention of a process of manufacture), the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement (Article 100(2)).

#### (2) Compensation for unfair profit

Liability to turn benefit of bona fide person (Civil Code 703)

Liability to turn benefit of mala fide person (Civil Code 704)

#### (3) Compensation for damages

(a) Any person who infringes on the right of others should compensate for the damages (Civil Code 709).

#### (b) Presumption of negligence

A person who has infringed a patent right or exclusive license of another person shall be presumed to have been negligent as far as the act of infringement is concerned (Article 103).

(c) Presumption, etc. of amount of damage (Article 102)

Where a patentee or exclusive licensee claims, from a person who has intentionally or negligently infringed the patent right or exclusive license, compensation for damage caused to him by the infringement, the damage through the infringement may be presumed as follows; (Article 102)

number of infringing product that has been sold

× profit per unit of product that could have been sold by patentee

(revised in 1998, with effect from 1999.01.01)

A patentee or exclusive licensee may claim, from a person who has intentionally or negligently infringed the patent right or exclusive license, an amount of money which he would be entitled to receive for the working of the patented invention, as the amount of damage suffered by him/her (Article 102(3)).

The word " normally" was deleted from " amount of money which he would normally be entitled to receive for the working of the patented invention".

(revised in 1998, with effect from 1999.01.01)

The preceding shall not preclude a claim to damages exceeding the amount referred to therein. In such a case, where there has been neither wilfulness nor gross negligence on the part of the person who has infringed the patent right or the exclusive license, the court may take this into consideration when awarding damages(Article 102(4)).

#### (4) Payment of compensation

When an applicant for a patent has, after the laying open of his patent application, given a warning with a written statement setting forth the contents of the invention claimed in the application, he may claim, against a person who has commercially worked the invention, after the warning but before the registration of the establishment of the patent right, the payment of compensation in a sum of money equivalent to what he would normally be entitled to receive for the working of the invention if the invention were patented. Even in the absence of the warning, the same shall apply to a person who commercially worked the invention before the registration of the establishment of the patent right, knowing that the invention

was claimed in the patent application laid open for public inspection (Article 65(1)). The right to claim the compensation under Article 65(1) may not be exercised until after the establishment of the patent right is registered (Article 65(2)).

The exercise of the right to claim the compensation under Article 65(1) shall not preclude the exercise of the patent right (Article 65(3)).

## 2.2.2 Proof of infringement

### (1) Obligation of defendant for clarifying acts

If a patentee alleges a specific product or process as constituting an infringement, the other party will have to disclose its own acts for denial of the infringement with respect to the alleged product or process unless there is a reasonable ground for refusal (Article 104 bis).

(revised in 1999, with effect from 2000.01.01)

### (2) Document submission order for document as proof

The court in an patent infringement shall have a power to order either party at the request of the other party to submit a document needed for the proof of infringement. However, the party holding such a document may refuse its submission if there is a reasonable ground for refusal (Article 105(1)).

(revised in 1999, with effect from 2000.01.01)

In case where a party ordered to submit a document for the proof of infringement refuses to do so, the court may make the party submit a document needed for judging if there is a reasonable ground for refusal. No one can request the disclosure of the document submitted for the purpose (Article 105(2)). (revised in 1999, with effect from 2000.01.01)

### (3) Appraise for calculation of damages

The court may appoint an appraiser for evaluating any matters necessary for calculation of the damages at the request of either party. The parties have to provide necessary information to the appraiser (Article 105 bis).

(revised in 1999, with effect from 2000.01.01)

#### (4) Award by court

When it is extremely difficult to prove the damages in a litigation where infringement is acknowledged, the court may award reasonable damages on the basis of the hearing and evidences as a whole (Article 105 tert).

(revised in 1999, with effect from 2000.01.01)

### 2.2.3 Non-binding official opinion of the Patent Office

A patentee or an interested third party may seek for a non-binding official opinion of the Patent Office as to the technical scope of a patented invention.

An official opinion is made by three trial examiners (Article 71).

(revised in 1999, with effect from 2000.01.01)

A request for interpretation may be made to the Patent Office with respect to the technical scope of a patented invention (Article 71(1)).

Where such a request is made, the Commissioner of the Patent Office shall designate three trial examiners to give the requested interpretation (Article 71(2)).

Proceedings concerning an interpretation other than those provided for in Article 71(2) shall be prescribed by Cabinet Order (Article 71(3)).

### 2.2.4 Communication between the courts and the Japanese Patent Office

The court (patent infringement court) should inform the Patent Office as to the filling and termination of an infringement suit (Article 168(3)).

The Commissioner of the Patent Office should inform the relevant court of any trial filed concerning the patent involved in the litigation, the decision to the trial, or withdrawal of the trial demand (Article 168(4)).

(revised in 1999, with effect from 2000.01.01)

## 2.3 Practice on patent infringement case

In a patent infringement litigation, it is examined and decided whether the

alleged infringement product or process is within the technical scope of the patented invention.

### 2.3.1 Technical scope of patented invention

The technical scope of a patented invention shall be determined on the basis of the description of the claim(s) in the specification attached to the request (Article 70(1)).

### 2.3.2 Construction of term(s) in the claim

In the case of Article 70(1) (determination of the technical scope of a patented invention), the meaning of a term or terms of the patent claim(s) shall be interpreted in the light of the specification excluding the patent claim(s) and the drawings (Article 70(2)).

In the case of Article 70(1) and (2), no statements of the abstract attached to the request shall be taken into account for such purpose (Article 70(3)).

## 2.4 Examining and judging whether the alleged product or process fall within the technical scope of the patented invention

The alleged product or process is compared with the patented invention element by element.

Then, whether all constituents of the claimed invention are included in the alleged product/process is examined and judged as follows.

- ① Confirmation of the patented invention
- ② Confirmation of the alleged infringement product/process
- ③ Comparison between the constituents (elements) of the patented claimed invention and the elements of the alleged infringement product/process
- ④ Examination and judgement whether the alleged product/process meets each

and every constituent (element) of the claimed invention

If an element claimed is missing in the alleged product/process, or an element claimed is different from that of corresponding element of the alleged product/process, then there is no literal infringement.

## 2.5 Literal infringement

### 2.5.1 Validity of patent

A patent shall be construed as valid in an infringement court.

Under the Japanese Patent Law, a patent is valid until a decision of invalid of a patent in a trial for invalidation is made final and conclusive. Only the Japanese Patent Office can invalidate a patent.

However, in a case that the patent is found as “apparently invalid” in the infringement court, the court could decide that the patent is “unenforceable” by the reason of “abuse of patent right” in the light of equity ( the Judgment of the Supreme Court of Japan, April 11, 2000, Heisei 10 (o) 364, in so-called “Kilby case” ).

Article 104.3 (came into force from April 1, 2005) amended in 2004 has made clear the “unenforceability of an invalid patent” accordance with the Judgment of the Supreme Court.

### 2.5.2 Judgment for fulfillment of the constituents (elements) of the patented claimed invention by the alleged product/process

The comparison between the patented claimed invention and the alleged product or process shall be done by “element by element” .

The meaning of each element of the claim shall be construed in the light of the claimed invention “as a whole”.



### 2.5.3 Significance of claims

The technical scope of a patented invention shall be determined on the basis of the description of the claim(s) in the specification (Article 70(1)).

### 2.5.4 Premise of claim interpretation

A claimed invention has to be disclosed sufficiently in the specification (Article 36(6)1).

A claimed invention has to be clear (Article 36(6)2).

A claimed invention has to be different from prior arts clearly (Article 36(6)1).

Wording in a claim, although it is described broadly, it may be construed to an limited meaning in the light of the description of the specification, prior arts, and the examination prosecution.

### 2.5.5 Relation between the claim(s) and the detail explanation of the invention

The judgment of the Supreme Court on March 8, 1991 (the decision on finding concerning an claimed invention upon filing before grant) has been often referred in a claim interpretation even by an infringement litigation court.

In the case where the technical meaning of the description of a claim can be found clearly only to have one meaning, the claim shall be interpreted solely from the description of the claim.

In the case where the technical meaning of the description of a claim can not be found clearly to have only one meaning, the claim shall be interpreted from the description of the claim with referring to the detailed description of an invention and description of drawings.

The judgment of the Supreme Court on April 28, 1998 also has been often referred in a claim interpretation of patent.

In the Judgment, the Supreme Court stated that the word in a claim should be construed literally as premise, and if the meaning of any word in the claim is unclear, then the word should be construed in the light of the description in the specification, especially the description of the function or the effect relevant to the word.

#### 2.5.6 Referring to the detailed description of the invention

Wording in a claim may be made clear in the light of the detailed description of the invention or the description of the drawings.

A functional claim may be made clear by the detailed description of the invention.

Effects of the invention expressly written in the "effect of invention" may be referred.

#### 2.5.7 Relationship between claim interpretation and prior arts

A claim shall be interpreted such that the prior arts shall not be included in the technical scope of the patent.

#### 2.5.8 Defense by prior arts

- Defense by prior art the same as alleged product/process
- Argument of invalid of patent by prior art

The alleged infringer often may assert as defense that the alleged product/process should be found to be the same as the proven publicly known prior art, the working of which could not infringe the patent, and that the patent should be found to be invalid because of lack of novelty/inventive-step by the prior art.

### 2.5.9 Relationship between claim interpretation and prosecution history

A claim may be interpreted by referring the prosecution history.

### 2.6 Infringement under the doctrine of equivalents

The Judgment of the Supreme Court on February 24, 1998 in so-called “Ball Spline Case” has been often referred in an examination and judgement under the doctrine of equivalents in an infringement litigation court.

In the case where a literal infringement is not found, an application of the doctrine of equivalents shall be examined and judged.

The Supreme Court of Japan stated in the opinion concerning “the Conditions” for applying the doctrine of equivalents in so-called “Ball Spline Case”.

### 2.7 Indirect infringement

Concerning to “only use” (Article 101(i),(iii)), “product used only for working the invention” means that the product “has no other use economically, commercially, or practically in the sense of socially acceptable idea”.

Courts have construed that only a possibility of an abstract or experimental use is not enough to have “other use”.

### 2.8 Other considerations

#### ① Prior use (Article 79)

Where, at the time of filing of a patent application, a person who has made an invention by himself without knowledge of the contents of an invention claimed in the patent application or has learned the invention from a person just referred to,

has been commercially working the invention in Japan or has been making preparations therefor, such person shall have a non-exclusive license on the patent right under the patent application.

Such license shall be limited to the invention which is being worked or for which preparations for working are being made and to the purpose of such working or the preparations therefor (Article 79).

## ② Consideration to the other party's patent (Article 72)

When a patented invention would utilize another person's patented invention filed prior to the filing date of the patent application concerned, the patentee, exclusive licensee or non-exclusive licensee shall not commercially work the patented invention (Article 72 ).

## 3 Criminal penalties

### 3.1 Offense of infringement

Any person who has infringed a patent right or an exclusive license shall be liable to imprisonment with labor not exceeding five years or to a fine not exceeding 5,000,000 yen (Article 196(1)).

The former Article 196(2) (" The prosecution for the offenses under Article 196(1) shall be initiated upon complaint.") was deleted.

(revised in 1998, with effect from 1999.01.01)

### 3.2 Offense of fraud

Any person who has obtained a patent, a registration of an extension of the term of a patent right, a ruling on the opposition to the patent, or a trial decision by means of a fraudulent act shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 3,000,000 yen (Article 197).

### 3.3 Offense of false marking

Any person infringing Section 188 shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 3,000,000 yen (Article 198).

### 3.4 Offense of perjury, etc.

A witness, expert witness or interpreter who, having taken an oath under this Law, has made a false statement or has given a false expert opinion or has interpreted falsely before the Patent Office or a court commissioned thereby shall be liable to imprisonment with labor for a term not less than three months nor more than ten years (Article 199(1)).

Where a person committing the offense in Article 199(1) has made a voluntary confession before the ruling on the opposition to the patent or trial decision concerning the case has become final and conclusive, his sentence may be reduced or suppressed (Article 199(2)).

### 3.5 Offense of divulging secrets

Where any present or former official of the Patent Office has divulged or made surreptitious use of the secrets relating to an invention in a patent application to which he had access in the course of his duties, he shall be liable to imprisonment with labor not exceeding one year or a fine not exceeding 500,000 yen (Article 200).

### 3.6 Dual liability

Where an officer representing a legal entity or a representative, employee or any other servant of a legal entity or of a natural person has committed an act in violation of Article 196(1), 197 or 198, with regard to the business of the legal entity or natural person, the legal entity or the natural person shall, in addition to

the offender, be liable to the fine prescribed in those sections (Article 201).

A corporation must be held liable if an employee from the corporation commits a patent infringement in business. The fines on such a corporation have been raised to 150 million yen or less (Article 201).

(revised in 1998, with effect from 1999.01.01)

## 4 Invalidation Procedure against Patent

### 4.1 Trial for Invalidation of Patent

A trial may be demanded for the invalidation of a patent before the Japan Patent Office (Article 123(1)).

Where a trial decision that a patent is to be invalidated has become final and conclusive, the patent right shall be deemed never to have existed (Article 125) .

### 4.2 Judicial Action against Trial Decision

An action against a trial decision shall come under the exclusive jurisdiction of the Tokyo High Court (the Intellectual Property High Court since April 1, 2005) (Article 178(1)).

An action against a trial decision in a trial for the invalidation of a patent may be instituted only by a party in the trial (Article 178(2)).

An action with regard to the matters on which a trial may be demanded may be instituted only against a trial decision (Article 178(6)).

In an action under Article 178(1), in the case of an action against a trial decision in a trial for the invalidation of a patent, the demandant or the defendant in the

trial shall be the defendant (Article 179).

.  
*Jokoku* Appeal (violation of constitutional provision) and/or *Jokoku-Juri* Appeal (violation of the Supreme Court precedents) may be instituted before the Supreme Court against a decision in the Tokyo High Court (IP High Court) (Civil Procedure Code).

## II. The Doctrine of Equivalents in Patent Infringement Litigation in Japan

### 1. The Japan Supreme Court Judgement concerning the Doctrine of Equivalents

The Judgment of the Supreme Court of Japan ( the Third. Petit Bench ) in the “Ball Spline Case” (Feb.24,1998) (Heisei 6 (o) 1083, of 1994) was the first judicial construction that affirmed application of the Doctrine of Equivalents in a patent infringement litigation in Japan.

#### 1.1 Five Conditions for applying the Doctrine of Equivalents

In the Opinion of the Judgment of the Supreme Court, the Court provided the “Five Conditions” (“Condition 1 ~ 5”) for applying the Doctrine of Equivalents in a patent infringement litigation as follows;

“In a patent infringement litigation, the technical scope of the patented invention must be determined on the basis of the patented claim in the specification (Japan Patent Law Article 70(1)) in order to determine whether the alleged product which is made or process which is used by the other party falls within the technical scope of the patented invention.

If there is any part expressed in the patented claim different from the corresponding one in the alleged product or process, the alleged product or process can not be concluded to fall within the technical scope of the patented invention.

However, even if the patented claim includes any part of the constituent elements different from the corresponding one in the alleged product or process, the alleged product or process should be construed to be equivalent to the constitution expressed in the patented claim thereby to fall within the technical scope of the patented invention, when the following conditions are all satisfied:



**【Condition 1】**

the different part is not the essential part of the patented invention;

**【Condition 2】**

the purpose of the patented invention can be achieved and the same function and result as those of the patented invention can be yielded, even after interchanging the different part by the element in the alleged product or process;

**【Condition 3】**

a person with ordinary-skill in the art to which the patented invention pertains (hereinafter “a person skilled in the art”) would have easily known the interchangeability at the time of making or using the alleged product or process;

**【Condition 4】**

the alleged product or process is not identical to and not obvious from the publicly known prior art at the time of filling the patent application ;

**【Condition 5】**

there is no special circumstance such that the alleged product or process was intentionally excluded from the scope of the patented claim during the prosecution of the patent application. ”

## 1.2 Reasons for applying the Doctrine of Equivalent

The Supreme Court also stated in the opinion the reasons for applying the doctrine of equivalents in a patent infringement litigation as follows:

**【Reasons】**

“(i) It is very difficult to draft claims at the time of filing the application with expecting all manners of infringement in the future. If the other party can easily go

beyond out of the scope of the patented claim by interchanging a part of the constituent elements of the patented claim with the material/ technology which has become clearly known after the filing of the application, and can easily avoid enforcement by the patent right owner such as an injunction, such situation will discourage motivations for inventions in society. And this situation will be against the purpose of the Patent Law to contribute to the development of industries by protecting and encouraging inventions, and also will be against social justice and equity.

(ii) Under such considerations, the substantial value of a patented invention should be extended from the patented claim to the extent that a third party would have readily known as substantially the same technology as the constitution of the patented claim. And the third party should expect such extension of the scope of a patented invention.

(iii) On the other hand, since no one could have obtained a patent right to the technology publicly known or could easily have been conceived from the publicly known prior art by a person skilled in the art at the time of filing (Patent Law Article 29), such technology could not be included in the scope of the patented invention.

(iv) Once the patentee has intentionally excluded the technology from the claim during the prosecution of application, for example, so as to admit that such an alleged product or process would not be included the scope of the patented invention, or once the patentee has taken such an action as to be outwardly understood so, the patentee can not assert contradictorily under the lawful concept of estoppel. ”

## 2 Flow Chart of Examination for Patent Infringement under the Doctrine of Equivalentents

**【Start of Examination】**

confirm the constituent elements of the patent claim

↓

confirm the elements of the alleged product or process

↓

compare the constituent elements of the patent claim with those of the alleged product or process on the element-by-element basis

↓

whether there is *any element expressed in the patent claim* different from one in the alleged product or process

↓

if yes, "**literal infringement**" should not be found,

however,

an alleged product or process that does not literally infringe upon the express terms of the patent claim should nonetheless be found to infringe,

*if there is **equivalence** between the element in the alleged product or process and the different element in the patent claim, and the alleged product or process is **substantially the same** as the patented invention.*

#### 【Examination for applying the Doctrine of Equivalents】

↓

##### 【Examination of Condition 1】

1. whether the change or substitution of the different element in the patent claim relates to *insubstantial difference* in the patented invention

⇒ NO no infringement (even under D.O.E.) (substantial difference can be found)

↓ **YES** (the different element is *insubstantial* one)

##### 【Examination of Condition 2】

2. whether *the purpose* of the patented invention can be achieved and *the same result* as that of the patented invention can be obtained even after the different

element is interchanged by the element in the alleged product or process

⇒ NO no infringement (even under D.O.E.)

↓ YES (“*interchangeability*” can be found)

#### 【Examination of Condition 3】

3. whether a person skilled in the art *would have known* the interchangeability (of the element not contained in the patent with one that was) *at the time of making or using of the alleged product or process*

⇒ NO no infringement (even under D.O.E.)

↓ YES (“*conceivability of the interchange*” can be found)

#### 【Examination of Condition 4】

4. whether the alleged product or process is identical to or obvious from "the publicly known prior art" at the time of filing of the application

⇒ YES no infringement (even under D.O.E.)

(it is within the public domain)

↓ NO (it is "new and non-obvious" to the prior art)

#### 【Examination of Condition 5】

5. whether there are any special circumstances such that the alleged product or process was "intentionally excluded" from the scope of the patent claim during the prosecution of the application

⇒ YES no infringement (even under D.O.E.)

(prosecution history estoppel bars)

↓ NO

"*infringement under the doctrine of equivalents*" should be found.

(all the above conditions are met, then the alleged product or process is equivalent to the claimed invention to fall within the scope of the patented invention)

### 3 Examination for “Conditions” of applying the Doctrine of Equivalents

#### 3.1 “Essential Part” (“Condition 1”):

The Supreme Court presented no clear interpretation of the “essential part” in the “Condition 1” for applying the Doctrine of Equivalents.

The lower courts (district courts and high courts) have provided the interpretation of the “essential part” in patent infringement cases after the Judgment of the Supreme Court.

The Osaka District Court ( Decision on Sept.17, 1998, Case No. Heisei 8 (wa) 8927 of 1996) held the definition of the “essential part” in the “Sustained Release Diclofenac Sodium Pharmaceutical Case (No.1)” as follows.

“The essential part of the patented invention should be interpreted to be a part of the constituent elements of the claimed invention *which yields the specific effect of the patented invention*. In other word, if the part is substituted with other constituent element, then the technical idea of the patented invention would be substantially changed into another one as a whole.”

The Tokyo District Court ( Decision on Jan. 1, 1999, Case No. Heisei 8 (wa) 14828 of 1996) also held the definition of the “essential part” in the “Sustained Release Diclofenac Sodium Pharmaceutical Case (No.2)” as follows.

“The essential part of the patented invention should be interpreted to be a part of the constituent elements of the claimed invention *which founds the specific means for solving the technical problem of the patented invention*. In other word, if the part is substituted with other constituent element, then the technical idea of the patented invention would be substantially changed into another one as a whole.”

#### 3.2 Time of Decision for Equivalents (“Condition 3”)

The Supreme Court stated concerning the Condition 3 that “a person skilled in the art would have known the interchangeability of the constituent element not contained in the patent with one that was *at the time of making or using of the alleged product or process*”, so the time of decision for equivalents is not the time of filing the patent application, but the time when the alleged product or process is made, used, or sold.

The “Condition 3” must be more important if there is any new technology, known after the time of the filling of the patent application but before the time of the infringement, which is found to be equivalent to the different part of the patented invention.

### III Recent Trend in Patent Infringement Litigation in Japan

#### 1. General Situation

The Supreme Court Judgment in “Kilby Case” ,Heisei (o) 364 of 1998 was held on Apr. 11, 2000 , after the Supreme Court Judgment in the Ball Spline Case.

The Supreme Court in “Kilby Case” referred to the “Doctrine of Equity” and confirmed that ‘*a patent infringement court should be able to examine whether the disputed patent is obviously invalid or not*’ even before the time the trial decision before the Japan Patent Office for invalidation of the patent became final.

The “Kilby Case” Supreme Court Judgment also stated that a patent right which would be invalidated by an invalidation trial must not be enforced because of “*abuse of right*”.

Since the Supreme Court judged in the Kilby Case, almost alleged infringers have asserted reasons of invalidity of patent rights in stead of asserting that the “Condition 4” was not fulfilled.

Article 104.3 (as in force since Apr.1, 2005) of Japan Patent Law was enacted as a provision according to the the “Kilby Case” Supreme Court Judgment .

#### 2 Decisions by Lower Courts after the Ball Spline Case Supreme Court Judgment

Most patent owner would assert infringement under the Doctrine of Equivalent as well as literal infringement against an alleged product or process after the “Ball Spline Case” Supreme Court Judgment .

Patent infringement courts, mainly, the Tokyo District Court , the Tokyo High Court (the Intellectual Property High Court science April 1, 2005), the Osaka District Court and the Osaka High Court have found and decided whether the “Condition 1 ~ 5” were fulfilled and whether the alleged product or process

infringed the patent under the Doctrine of Equivalents after examination of whether the alleged product or process infringed literally.

There have been not so many cases in which lower courts found infringement under the Doctrine of Equivalents. And unexpectedly, many patents have been found invalid in patent infringement courts after finding the infringement of the alleged product or process under the Doctrine of Equivalents were found.

## 2.1 Case in which Court Found Infringement under the Doctrine of Equivalents

All Conditions, or Condition 1~5, are necessary to be fulfilled for finding infringement under the Doctrine of Equivalents.

Condition 1~3 are referred to “Positive Conditions” and Condition 4~5 are referred to “Negative Conditions”.

There have be seen few case in which all Condition 1~5 were found to be fulfilled.

## 2.2 Case in which Court did not Find Infringement under the Doctrine of Equivalents

In most cases, patent infringement courts did not find Infringement under the Doctrine of Equivalents, because any of the Conditions were not fulfilled.

Condition 4 and/or Condition 5 (“Negative Conditions”) are those which an alleged infringer would assert as defense to deny fulfilling those Conditions for denying “infringement under the Doctrine of Equivalents”, however, those two Conditions are those which an alleged infringer could also assert as defense even for denying “literal infringement”.

Recently, there have been many cases in which the Condition 5 was found not to be fulfilled because of finding “intentional limitation” during patent obtaining



procedure.

### 2.2.1 Case in which Condition 1 is not fulfilled

If a different part in the constituent elements of the patented invention is found in comparison with an alleged product or process, and if the different part is “essential” one of the patented invention, the alleged product or process is “not substantially the same” as the patented invention, so infringement under the Doctrine of Equivalent should not be recognized.

There have been many cases of this type.

### 2.2.2 Case in which Condition 2 is not fulfilled

The Condition 2 has been referred to “interchangeability” which has been discussed in many infringement cases since several tens of years.

The Condition 2 has been often examined with Condition 1 and/or Condition 3.

It might be said that Condition 1,2 and 3 (“Positive Conditions”) are conditions for finding the fact in which an alleged product/process is “substantially the same” as a patented invention.

### 2.2.3 Case in which Condition 3 is not fulfilled

The Condition 3 has been referred to “conceivability of the interchange” (the criteria of “would have known the interchange”) which has been discussed in many infringement cases since several tens of years as well as the “interchangeability”.

The Condition 3 is often examined with Condition 2 .

There have been some cases in which the Condition 2 was fulfilled but the Condition 3 was not fulfilled. However, there have been no cases in which the Condition 2 was not fulfilled but the Condition 3 was fulfilled.

There were few cases in which only the Condition 3 was not found to be fulfilled

to deny infringement under the Doctrine of Equivalents.

#### 2.2.4 Case in which Condition 4 is not fulfilled

The Supreme Court Judgment of “Ball Spline” Case was rendered on Feb.24, 1998.

As stated in the reason of the judgment, no one could have obtained a patent right to the technology publicly known or could easily have been conceived from the publicly known prior art by a person skilled in the art at the time of filing the patent application.

The reason for the Condition 4 has been asserted as a defense of so-called “ free technology” or “public domain of technology” in a patent infringement litigation even with respect to “literal infringement” (In the past before the Supreme Court Judgment was rendered, it has not been clarified that “the public domain” defense could be expanded to the extent of “obviousness” from the publicly known prior art.).

After the Supreme Court Judgment of Ball Spline Case, the Supreme Court Judgment of Kilby Case was judged on Apr. 11, 2000.

The Kilby Case Supreme Court Judgment stated that a patent right which would be invalidated in an invalidation trial before the Japan Patent Office must not be enforced because of “abuse of right” in the light of “equity”.

Since the Supreme Court judged in the Kilby Case , almost alleged infringers have asserted reasons of invalidation of patent rights in stead of asserting the Condition 4 being not fulfilled.

Article 104-3 (as in force from Apr.1, 2005) of Japan Patent Law was enacted as a provision according to the Supreme Court Judgment in Kilby Case.

#### 2.2.5 Case in which Condition 5 is not fulfilled

The reason as the Condition 5 has been asserted as a defense of so-called

“intentional exclusion” from the scope of patent right or “file wrapper estoppel” in a patent infringement litigation even with respect to literal infringement.

If an applicant limits the scope of a claimed invention, for example, by an amendment according to a reason for refusal of the application, then the applicant can not assert the right beyond the limited scope of the invention.

Recently, it is recognized that infringement courts strictly (against right holders) find “intentional exclusion” from the scope of right during the prosecution procedure or “file wrapper estoppel”, and that amendments or remarks during the procedure to obtain patent rights should be careful not to limit the claims more than necessary.

It is apparent that the claimed invention should be disclosed clearly and broadly enough at the time of filing the patent application with supporting description sufficient for the claimed invention in the specification.

## IV Case Study

1

CASE ALL THE "CONDITION 1~5" WERE FULFILLED AND THE DOCTRINE OF EQUIVALENTS WAS APPLIED TO FIND PATENT INFRINGEMENT

1.1

“Injection Method” Case (method claim)

(Case of seeking Injunction against Patent Infringement)

Patent Number : JP 2108611

(H06-61361 : Examined Patent Application Publication Number)

(1) Patented Invention **【FIG. 1.1-1】** (fig. 8,9,10,11 in H06-61361)

Patented Claim (Claim 1 was at issue. Claim 2 to 5 are omitted below.)

**【Claim 1】**

(A) A method of preparing a solution, emulsion or suspension

(B) in water of one or more sensitive medicaments for one or more subsequent injections using a multi-chamber cylinder ampoule (1) known per se and comprising

a front space (6) containing the sensitive medicament (10) and sealed at its front end by means of a membrane (3) penetrable to an injection needle (17) and delimited at its rear end by a front movable wall (8),

a rear space (7) containing an aqueous phase (11) and delimited at its front end by the front movable wall (8) and delimited at its rear end by a rear movable wall (9),

and

a connecting passage (12) arranged in the wall of the ampoule between the rear and the front spaces,

the rear movable wall (9) being moved forwards and entraining thereby the

aqueous phase (11) and the front, movable wall (8) until this is just opposite the connecting passage (12), so that the aqueous phase (11) upon continued displacement of the rear movable wall (9) will flow past the front movable wall into the front space and dissolve, suspend or emulsify the medicament (10),

(C) characterized in that

*the rear movable wall (9) being moved forwards in the ampoule (1) by the screw mechanism in such a manner that the front end of the ampoule (1) is kept upward almost in the vertical position,*

so that the aqueous phase (11) is made to flow calmly from below and upwards through the medicament (10) avoiding any shaking and admixture of air.

(2) Patent Infringement Litigation

(Case of Seeking Injunction against Patent Infringement)

© Osaka High Court, Decision, Apr. 19, 2001 (Appellate Court Decision)

Case No. Heisei 11 (ne) 2198 (of 2001)

(*Kosō* appealed by the alleged infringer or defendant against the following First Instance Court Decision)

(Original Court Decision)

○ Osaka District Court, Decision, May 27, 1999

Case No. Heisei 8 (wa) 12220 (of 1999)

(2.1) Alleged Product(s);

“The alleged product” was the alleged injection device with the alleged cartridge (dual chamber cylinder ampoule).

The alleged injection device was used to hold the top of the needle slightly upwardly from the horizontal position.

The alleged infringer (appellant-defendant) had made and sold the alleged cartridge.

The alleged infringer (appellant-defendant) also had sold the alleged injection device with the alleged cartridge.

The patent holder (appellee-plaintiff) asserted that the defendant's method carried out by using the defendant's injection device with the defendant's cartridge fell within the scope of the invention's method of the Claim 1 and that the defendant's injection device with the defendant's cartridge infringed the patent of Claim 1 (method) "indirectly" under the Article 101 paragraph 2 of the Japan Patent Law (the paragraph 2 has been transferred to the paragraph 4 after the amendment of Japan Patent Law in 2002.) .

## (2.2) Court Decisions

The Osaka District Court (the first instance court) found that *the defendant's method* carried out by using the defendant's injection device with the defendant's cartridge did not infringe "literally" *the patented method* of the Claim 1, because the defendant's method was carried out in such a manner that the front end of the needle of the injection device was kept *slightly upwardly from the horizontal position*, which was different from the patented method of Claim 1 .

So, the Osaka District Court decided that *the defendant's injection* with the defendant's cartridge did not infringe "literally" the patented method of the Claim 1 even under the Article 101 paragraph 2 of the Japan Patent Law ("indirect infringement" of an alleged product to a process patented claim) .

Then the Osaka District Court examined whether the alleged product (the defendant's injection with the defendant's cartridge) infringed the patented method of the Claim 1 (method) under the Doctrine of Equivalents.

After the examination, the Osaka District Court found that *the defendant's method* carried out by using the defendant's injection device with the defendant's cartridge fell within the scope of *the patented method* of the Claim 1 equivalently and that *the defendant's method* infringed *the patented method* of the Claim 1

under the Doctrine of Equivalents, because the defendant's method (*the front end of the needle of the injection device was kept slightly upwardly from the horizontal position*) was substantially the same as the patented method of the Claim 1 (*the front end of the ampoule is kept upward almost in the vertical position*).

The Osaka District Court examined Five Conditions for applying the Doctrine of Equivalents as follows:

“Condition 1” :

The Osaka District Court found that the different part of the patented method of the Claim 1 (*the front end of the ampoule is kept upward almost in the vertical position*) from the defendant's method (*the front end of the needle of the injection device was kept slightly upwardly from the horizontal position*) was not the essential part of the patented method of the Claim 1.

“Condition 2” :

The Osaka District Court found that the object of the invention (to prepare a solution, emulsion or suspension in water of one or more sensitive medicaments) could be carried out by the alleged method in place of the patented method and that substitution of holding position of an injection device could not affect the effect of the patented invention.

As the result, interchangeability was found.

“Condition 3” :

The Osaka District Court found that a skilled person in the art would have easily known the interchange of the holding position from that of the patented method of the Claim 1 to that of alleged method at the time of making the alleged device.

Because it was apparent that liquid for injection would not spilled out by holding *slightly upward* the front end of the needle of the injection device from the horizontal position in place of holding the front end of the ampoule *upward almost*

*in the vertical position* (the patented method of the Claim 1).

As the result, conceivability of interchange was found.

“Condition 4” :

The Osaka District Court found that there was no evidence showing that the alleged method was identical to a publicly known technology or it was easily thought from a publicly known technology by a skilled person.

“Condition 5” :

The Osaka District Court found that there was no evidence showing that the alleged method was intentionally excluded from the scope of the claimed invention during the prosecution for obtaining the patent.

As the result of the above examination, the Osaka District Court decided the alleged method infringed the patented method of the Claim 1 under the Doctrine of equivalents.

Then the Osaka District Court examined “indirect infringement” of the alleged device. The Osaka District Court found that the alleged device was only able to be used for the alleged method equivalent to the patented method of the Claim 1 and that the alleged device had no use other than that use.

As the result of the above examination, the Osaka District Court decided the alleged device “indirectly infringed” the patented method of the Claim 1 under Article 101 paragraph 2 under the Doctrine of Equivalents.

The Osaka High Court affirmed the decision of the Osaka District Court.

(3) Invalidation Procedure against the Patent :

(Patent Number : JP 2108611)

(3.1) Invalidation Trial (No. 1) and Judicial Action against Trial Decision



- JPO Trial No. Heisei 11-35500 (of 1999) (JPO)  
JPO Trial Decision “the demand for invalidation is not allowed”  
(The decision meant that the patent was not invalid.)
  
- Court Appeal No. Heisei 12 (gyo ke) 355 (of 2000) (Tokyo High Court)  
Court Decision “dismissal of claim (for cancellation of trial decision)”  
(This meant that the patent was maintained to be valid.)

### (3.2) Invalidation Trial (No. 2)

- JPO Trial No. 2001-35279 (JPO)  
Withdrawal of Demand for Invalidation Trial  
(This meant that the patent was maintained to be valid.)

### (4) COMMENT:

This case is the interesting case in which “indirect infringement” was found under “the Doctrine of Equivalent”.

Some practitioner expected that the decision of the Osaka District Court must be totally or partially denied by the second instance court of the Osaka High Court, however the first instance court decision was affirmed by the second instance court.

As explained below (Case 2.1.1, Case 2.3.1), the different findings were shown to the product claim of the patented Claim 5 by the First and the Second Instance Courts.

This patent contains method (process) claims and device (product) claims.

This case includes the examination of “literal infringement” and “infringement under the Doctrine of Equivalent”, and “direct infringement” and “indirect infringement”.

The case taught that claims should be drafted to include product claims and

process claims having different scope of the invention.

## 1.2

“Foreign Matter Separating and Removing Apparatus for Raw Laver” Case  
(Case of Seeking Injunction against Patent Infringement)

Patent Number : JP 2662538

(1) Patented Invention **【FIG. 1.2-1】** (Fig. 1,4 in JP 2662538 )

Patented Claim (Claim 1 and 2 were at issue. Claim 3 and 4 are omitted below.)

### **【Claim 1】**

An apparatus for separating and removing foreign matter from raw laver comprising;

a cylindrical mixing tank 61,

a ring-like casing member 23,24, the outer peripheral edge portion of the casing member being connected with the bottom peripheral edge portion of the tank 61,

a first rotating plate member 51 which is fit to the inner peripheral portion of the ring-like casing member 24 with a slight clearance  $C$ , the first rotating plate member 51 being rotatable around the center of an axis by a drive means, and

a foreign matter drain port 25 at the corner of the bottom of the tank 61.

### **【Claim 2】**

The apparatus according to claim 1, wherein the surface of the first rotating plate member 51 is sloping down from the center of rotation thereof to peripheral portion.

(2) Patent Infringement Litigation:

© Tokyo High Court, Decision, Oct.26, 2000 (Appellate Instance Court)

Case No. Heisei 12 (ne) 2147 (of 2000)

(Original Decision)

- Tokyo District Court, Decision, Mar.23, 2000  
Case No. Heisei 10 (wa) 11453 (of 1998)

(2.1) Alleged Product(s);

The alleged infringer had made and sold the alleged apparatus 1 and 2 for separating and removing foreign matter from raw laver

The Tokyo District Court found the alleged apparatus as follows ;

the alleged apparatus satisfied the constituent element “E” of the claim 1 (“an apparatus for separating and removing foreign matter from raw laver”),

the alleged apparatus satisfied the constituent element “A” of the claim 1 (“a cylindrical mixing tank 61, a ring-like casing member 23,24, the outer peripheral edge portion of the casing member being connected with the bottom peripheral edge portion of the tank 61”),

the alleged apparatus satisfied the constituent element “C” of the claim 1 (“the first rotating plate member 51 being rotatable around the center of an axis by a drive means”), and

the alleged apparatus satisfied the constituent element “D” of the claim 1 (“a foreign matter drain port 25 at the corner of the bottom of the tank 61”).

The Tokyo District Court found that the different part of the patented invention (claim 1,2) from the alleged product is the portion of “a first rotating plate member 51 which is fit” “with a slight clearance *C*” in the constituent element “B” of the claim 1 (“a first rotating plate member 51 which is fit to the inner peripheral portion of the ring-like casing member 24 with a slight clearance *C*”).

(2.2) Court Decisions

The Tokyo District Court (the first instance court) examined all Conditions (Condition 1 to Condition 5) for applying the Doctrine of Equivalents according to “the different part” and the Court found that all Conditions were fulfilled.

As the result of the above examination, the Court concluded that the alleged device infringed the Patented Claim (claim 1 and 2) under the Doctrine of Equivalents.

The Tokyo High Court affirmed the decision of the Osaka District Court.

(3) Invalidation Procedure for the Patent :

(Patent Number : JP 2662538)

(3.1) Invalidation Trial (No. 1) and Judicial Actions against Trial Decision

- JPO Trial No. 2000-35411, 2000-35675 (JPO)

JPO Trial Decision “the demand for invalidation is not allowed”

(The trial decision meant that the patent was not invalid.)

- Court Appeal No. Heisei 13 (gyo ke) 586 (of 2001) (Tokyo High Court)

Court Decision “dismissal of claim (for cancellation of trial decision)”

(The court decision affirmed the trial decision, which meant that the patent was maintained to be valid.)

- *Jokoku* Appeal No. Heisei 15 (gyo tsu) 311 (of 2003) (Supreme Court)

Judgment: “dismissal ”

- ◆ *Jokoku- Juri* Appeal No. Heisei 15 (gyo sa) 166 (of 2003) (Supreme Court)

Decision: “turning down”

(The Supreme Court did not overrule the Tokyo High Court Decision, which

meant that the patent was maintained to be valid.)

(3.2) Invalidation Trial (No. 2)

- JPO Trial No. 2002-35475 (JPO)

Withdrawal of Demand for Invalidation Trial

(The patent was maintained to be valid.)

(3.3) Invalidation Trial (No. 3)

- JPO Trial No. 2003-35052 (JPO)

Withdrawal of Demand for Invalidation Trial

(The patent was maintained to be valid.)

(3.4) Invalidation Trial (No. 4) and Judicial Actions against Trial Decision

- JPO Trial No. 2003-35204 (JPO)

JPO Trial Decision : “the demand for invalidation is not allowed”

(The decision meant that the patent was not invalid.)

- Court Appeal No. Heisei 16 (gyo ke) 51 (of 2004) (Tokyo High Court)

Court Decision : “dismissal of claim (for cancellation of trial decision) “

(The patent was maintained to be valid.)

(3.5.1) Invalidation Trial (No. 5-1) and Judicial Action against Trial Decision

- JPO Trial No. 2003-35247 (against the Claim 1 of the Patent) (JPO)

JPO Trial Decision : “the demand for invalidation is not allowed”

(The patent was maintained to be valid.)

- Court Appeal No. Heisei 16 (gyo ke) 214 (of 2004) (Tokyo High Court)

Court Decision : “cancel the JPO trial decision”

(The Court’s finding was that the JPO trial decision had erroneous concerning finding of inventive step and that the lack of inventive step should be found against the patented invention of the Claim 1.)

(3.5.2) Invalidation Trial (No. 5-2) and Judicial Action against Trial Decision  
(repeated-trial after the cancellation of the former trial decision)

- JPO Trial No. 2003-35247 (against the Claim 1 of the Patent) (JPO)

JPO Repeated-Trial Decision :

“the Claim 1 of the patent is made to be invalid”

( because the lack of inventive step was found in the patented claim.)

(The repeated-trial decision was restrained by the Court decision)

- Court Appeal No. Heisei 17 (gyo ke) 10530 (of 2005) (IP High Court)

Court Decision : “dismissal of claim (for cancellation of the trial decision)”

(The Court affirmed the trial decision to make invalid the Claim 1 of  
the patent.)

(4) COMMENT:

The patent owner won the patent infringement litigation in which the Doctrine of Equivalent of the patent was affirmed to be applied to the alleged device.

However, after the several invalidation trials before the JPO and the judicial actions against the trial decisions before the Tokyo High Court (the Intellectual Property High Court since Apr.1, 2005), the patent right have been found to be invalid because of lack of inventive step.

It is taught that a patent right holder needs to ascertain the validity of the patent before filing a patent infringement law suit.

1.3

“Production Method of Paste made from Starch of Devil’s-Tongue in Muscle Texture State and Production Device therefore” Case

Patent Number : JP1912343

(1) Patented Invention **【FIG. 1.3-1】** (Fig. 1,2,3,4,5 in H06-36727)

Patented Claim (Claim 1 and 2 were at issue.)

**【Claim 1】**

A method of making muscle-texture-state devil's tongue paste members ("*Konjac*" or "*Konnyaku*" which is one of Japanese traditional food) comprising the steps of;

adding a proper amount of water into Konjac flour to make swelled Konjac starch,

blending the swelled Konjac starch with gelling agent to make Konjac paste,

extruding the Konjac paste through a nozzle with a great number of extrusion holes in such a way that gaps among noodle-like extruded paste members are 3 mm or less immediately after the extrusion so that the noodle-like extruded paste members are mutually in contact with each other in a short time before gelatinization without applying any pressure because of swelling of the noodle-like extruded paste members by pressure diminishment immediately after the extrusion, and then

collecting the noodle-like extruded paste members before or at the same time of heat treatment.

**【Claim 2】**

An apparatus for making muscle-texture-state devil's tongue paste members comprising;

an extrusion device having an inclined nozzle with a great number of extrusion holes through which Konjac paste in a hopper is extruded,

wherein;

the nozzle having through holes arranged in parallel the distances among which being 3 mm or less so as to make the gaps among noodle-like extruded paste members 3 mm or less immediately after the extrusion, so that the noodle-like

extruded paste members are mutually in contact with each other in a short time before gelatinization without applying any pressure because of swelling of the noodle-like extruded paste members by pressure diminishment immediately after the extrusion.

(2.1) Patent Infringement Litigation (No. 1)

(Case of Seeking Injunction, Damages and Recover )

(The patented Claim 1 and 2 were at issue.)

◎ Osaka High Court, Decision, May 28, 2004 (Appellate Instance)

Case No. Heisei 14 (ne) 3649 (of 2002)

(Original Decision)

○ Osaka District Court Oct. 29, 2002 (First Instance)

Case No. Heisei 11 (wa) 12586 (of 1999)

(2.1.1) Alleged Product and Alleged Process (No. 1)

The alleged "product (A)" was an apparatus for making alleged "Konjac (A)" paste members including an extrusion device having a "mesh plate" with a great number of extrusion holes connected with connecting holes.

The alleged "process (A)" was a process for making the alleged "Konjac (A)" by using the alleged apparatus (A).

The alleged infringer (X1) had made the alleged apparatus (A) and the alleged "Konjac (A)" by using the alleged apparatus (A).

The another alleged infringer (X2) had sold the alleged product (A) and the alleged "Konjac (A)" made by the product (A).



### (2.1.2) Court Decision (No. 1)

The Osaka District Court examined all of the "Conditions" for applying the DOE, and found that the alleged product (A) and the alleged process (A") met all Conditions 1~5, and the Court concluded that the alleged product (A) infringed the patented invention of the Claim 1 and the alleged process (A") infringed the patented invention of the Claim 2 under the Doctrine of Equivalents.

The Osaka High Court affirmed the decision of the Osaka District Court and dismissed the *kosō*-appeal by the alleged infringer.

### (2.2) Patent Infringement Litigation (No. 2)

(Case of Seeking Injunction and Damages )

(The patented Claim 2 was at issue.)

◎ Osaka High Court, Decision, May 28, 2004 (Second Instance or *kosō*-Appeal)

Case No. Heisei 14 (ne) 1693 (of 2002)

(Original Decision)

○ Osaka District Court Apr. 16, 2002 (First Instance)

Case No. Heisei 12 (wa) 6322 (of 2000)

### (2.2.1) Alleged Product (No. 2)

The alleged "product (B)" was a "mesh plate" with through holes used in an apparatus for making "Konjac" paste members including an extrusion device.

The alleged infringer (Y) had made and sold the "mesh plate" of the alleged product (B).

### (2.2.2) Court Decision (No. 2)

The Osaka District Court and the Osaka High Court found that the alleged mesh plate infringed the Claim 2 of the apparatus "indirectly" under the Doctrine of

Equivalents.

(2.3) Patent Infringement Litigation (No. 3)

(Case of Seeking Injunction and Damages)

(The patented Claim 2 was at issue.)

○ Osaka District Court Mar. 13, 2003

Case No. Heisei 12 (wa) 6570 (of 2000)

(2.3.1) Alleged Product (No. 3)

The alleged "product (C)" was a "mesh plate" with through holes. The alleged mesh plate was found by the Court that it was the same as the "nozzle" of the patented invention and that it was only used in an apparatus for making "Konjac" paste members including an extrusion device. The "mesh plate" or nozzle had a plurality of through holes connected with slits of 0.23 to 0.26 mm width.

The alleged infringer (Z) had made and sold the "mesh plate" of the alleged product (C).

(2.3.2) Court Decision (No. 3)

The Osaka District Court examined if the apparatus for making the muscle-texture-state devil's tongue paste members using the alleged "mesh plate" fell within the technical scope of the patented invention of Claim 2, then the conduct of making or selling the "mesh plate" should be deemed to indirectly infringe the patent (Japan Patent Law Article 101 (i)).

At first, the Osaka District Court found that the alleged "mesh plate" did not literally infringe the patented Claim 2 because of difference between the patent and the alleged product.

Then the Court examined the "Condition 1 ~ 5" for applying DOE.

Finally, the Court found "indirect infringement" under the Doctrine of

Equivalents to the alleged product by the product claim.

### (3) Invalidation Procedure for the Patent :

#### (3.1) Invalidation Trial (No. 1)

- JPO Trial No. 2002-35072 (JPO)

Withdrawal of Demand for Trial

(This meant that the patent was maintained to be valid.)

#### (3.2.1) Invalidation Trial (No. 2-1) and Judicial Actions against Trial Decision

- JPO Trial No. 2002-35294 (JPO)

JPO Trial Decision; “the demand for invalidation of the patented Claim 1 and Claim 2 shall not be allowed”

(The JPO Trial examiners decided that the patent was not invalid.)

- Court Appeal No. Heisei 17 (gyo ke)10060 (of 2005)

(Tokyo High Court →IP High Court)

Court Decision ; “cancel the JPO trial decision” June 30,2005

(The Court’s finding was that the JPO trial decision had erroneous concerning finding of novelty and that the lack of novelty should be found against the patented invention of the Claim 1 and 2 because of the publicly worked invention before the application.)

- ◆ *Jokoku-Juri* Appeal (Supreme Court) against the IP High Court Decision

Decision ; “disallow” Nov. 22, 2005

(The JPO trial decision, in which the demand for invalidation of the patent shall not be allowed, was cancelled conclusively by the courts. The IP High Court’s decision suggested that the patented Claim 1 and 2 should be invalid

because of lack of novelty. )

(3.2.2) Invalidation Trial (No. 2-2)

(JPO repeated-trial after the cancellation of the former JPO trial decision)

- JPO Trial No. 2002-35294 (against the Claim 1 of the Patent) (JPO)  
JPO Re-Trial Decision: Not found yet. (May be pending)  
(The repeated-trial decision must be restrained by the Court decision)

(3.3) Invalidation Trial (No. 3)

- JPO Trial No. 2005-80143 (JPO)  
(pending)

(3.4) Invalidation Trial (No. 4)

- JPO Trial No. 2005-80151 (JPO)  
(pending)

(4) COMMENT:

In this case, the patent owner won the patent infringement law suit in which the Doctrine of Equivalents was affirmed to apply to the alleged device.

It is interesting that the alleged product (mesh plate) was found to infringe the product (apparatus) claim indirectly under the Doctrine of Equivalents.

Also, the patent owner won the invalidation trials before the JPO, in which the demandant asserted that the patented invention was the same as those had been publicly worked before the application of the patent. The JPO trial examiners did not find the lack of novelty concerning the publicly worked fact evidence produced by the demandant.

However, IP High Court (which is the successor to the Tokyo High Court since

Apr.1, 2005, and which had the exclusive jurisdiction for suits against trial/appeal decisions of JPO) found that the patented invention was the same as the publicly worked invention which meant the lack of novelty of the patent, and cancelled the JPO's trial decision.

The Supreme Court overruled the *Jokoku-Juri* appeal by the appellor-demandant and finalized the IP High Court decision, which concluded cancellation of the JPO trial decision. The JPO shall be restrained by the Court decision in the repeated-trial, so that the repeated-trial decision could be expected to invalidate the patent.

It is expected that the patent owner try to correct the claim(s) by “correction trial” before the JPO to maintain the validity of the patent. However, if the scope of the claim is limited by correction, the finding of patent infringement by courts will be changed.

2

CASE ANY ONE OF THE "CONDITIONS 1~5" WAS NOT FULFILLED AND THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS WAS DISAFFIRMED

If *the different part of the patented invention* from the alleged product or process is *not the essential part* of the patented invention (Condition 1),

if the purpose of the patented invention can be achieved and/or the advantageous effect can be yielded after the different part of the patented invention is interchanged to that of alleged product or process (“*interchangeability*”) (Condition 2),

and if a person skilled in the art would have easily known the interchangeability at the time of making, using or selling the alleged product or process (“*conceivability of interchange*”)(Condition 3),

then the alleged product or process is “*substantially the same*” as the patented

invention.

On the contrary, no one could have obtained a patent right to the technology publicly known or could easily have been conceived from the publicly known prior art by a person skilled in the art at the time of filing, so

if the alleged product or process is publicly known or could easily have been conceived from the publicly known prior art by a person skilled in the art at the time of filing, the alleged one could not infringe patents (Condition 4).

In addition, once the patentee has intentionally excluded the technology from the claim during the prosecution of application, the patentee can not assert contradictorily under the lawful concept of “estoppel”, so

if the alleged product or process would be excluded by the applicant from the scope of the patent claim during the patent obtaining procedure, the alleged one could not infringe patents (Condition 5).

In the case in which at least any one of the Condition 1 to 5 is not met, infringement under the Doctrine of Equivalents can not be found.

## 2.1

### CASE THE "CONDITION 1" WAS NOT SATISFIED

("Substantial the Same" test : whether or not "the different part(s) is not the essential part of the patented invention" is examined.)

#### 2.1.1

“Injection Device” Case (product claim)

(Case of seeking Injunction against Patent Infringement)

Patent Number : JP 2108611 (the same patent as 1.1 case)

Patented Invention **【FIG. 2.1.1-1】** (Fig. 5 in JP 2108611)

Patented Claim ( Claim 5 was at issue. Claim 1 to 4 are omitted below.)

**【Claim 5】**

(a)

A device for preparation of an injection solution of substances sensitive to degradation,

(b)

characterized in that the constituents of the injection solution are kept in a container (1)

in which the constituents are separated but can be brought together to be mixed and dissolved through external influence

and which is made as a pipe which is sealed at its front end (2) by means of a penetrable membrane,

contains in a space (6) between the penetrable wall and a front movable wall (8) the solid constituents (10) of the injection solution,

contains in a space (7) between the front movable wall (8) and a rear movable wall (9) the liquid constituents (11) of the injection solution

and is provided in the tubular wall with a connecting passage (12) so arranged that when the rear movable wall (9) is moved forwards together with the liquid (11) and the front movable wall (8), the liquid (11) can stream past the front movable wall (8) and be mixed with the solid constituents (10) to a solution,

(c)

and that the device comprises a holder means (24, 28) in which *the container can be fixed so that the constituents (10, 11) of the injection solution can be brought together and mixed,*

*and which is made of two tubular members (24, 28) which can be screwed together and enclose the container (1)*

so that when the members (24, 28) are screwed together the front end (2) of the container (1) with the penetrable membrane is exposed at the front end (25) of the holder means

and at the rear end of the container (1) the rear tubular wall (9) is moved

forwards together with the liquid (11) and the front movable wall (8) by means of a piston (30) arranged at the rear end (28) of the holder means pressing the rear movable wall (9) of the container (1) forwards so that the liquid (11) can be brought to stream through the connecting passage (12) over to the space (6) of the solid constituents (10) and be mixed with these to a solution.

## (2) Patent Infringement Litigation

◎ Osaka High Court, Decision , Apr. 19, 2001

Case No. Heisei 11 (ne) 2198 (of 2001)

(Original Decision)

○ Osaka District Court, Decision, May 27, 1999

Case No. Heisei 8 (wa) 12220 (of 1999)

### (2.1) Alleged Product(s);

“The alleged product” was the alleged injection device with the alleged cartridge (dual chamber cylinder ampoule).

The alleged product was a type different from a fountain pen type.

The defendant (alleged infringer) had made and sold the alleged cartridge.

The defendant had sold the alleged injection device with the alleged cartridge.

The plaintiff (the patent holder) asserted that the defendant’s product fell within the scope of the product claim of the Claim 5 and that the defendant’s injection device with the defendant’s cartridge literally infringed the patent of Claim 5 .

The plaintiff (the patent holder) also asserted that if there was any different part of the claimed invention from the defendant’s injection device, the defendant’s injection device with the defendant’s cartridge infringed the patent of Claim 5 under the Doctrine of Equivalents.



## (2.2) Court Decisions

The Osaka District Court found that the defendant's injection device with the defendant's cartridge did not infringe literally the patented Claim 5, because the alleged device was not a fountain pen type construction in which two tubular members were able to be screwed together and so the alleged device did not fulfill the constituent features "*the container can be fixed so that the constituents of the injection solution can be brought together and mixed, and which is made of two tubular members which can be screwed together and enclose the container*" in the patented Claim 5.

Then the Osaka District Court examined whether the alleged product (the defendant's injection device with the defendant's cartridge) infringed the patented Claim 5 under the Doctrine of Equivalents.

The Osaka District Court examined at first the first Condition of the five Conditions for applying the Doctrine of Equivalents as follows:

"Condition 1" :

The Osaka District Court found that the different part of the patented Claim 5 ("*the container can be fixed so that the constituents of the injection solution can be brought together and mixed, and which is made of two tubular members which can be screwed together and enclose the container*") from the alleged product was the "essential part" of the patented product of the Claim 5.

As the result, the Osaka District Court concluded that the alleged device did not meet the "Condition 1" and that the alleged device did not infringe the patented Claim 5.

As explained later (Case 2.3.1), the Osaka District Court also examined the Condition 3.)

The Osaka High Court affirmed the decision of the Osaka District Court.

## (3) Invalidation Procedure against the Patent

(the same as said before at 1.1)

(4) COMMENT:

The Claim 5 is limited to a device having a structure of “two tubular members (24, 28) which can be screwed together” (so-called as "fountain pen" type structure).

In this case, the specific structure ("fountain pen" type) was thought to be essential part of the invention of the Claim 5.

2.1.2

“Sustained Release Diclophenac Sodium Pharmaceutical” Case (No.1)

(Case of seeking Injunction and Disposal against Patent Infringement)

Patent Number : JP1571849 (The patent expired on Aug. 10, 2004)

(H01-57090 : Examined Patent Application Publication Number)

(1) Patented Invention

Patented Claim:

**【Claim 1】**

A sustained release diclophenac pharmaceutical consisting of ;

(A) rapid-acting diclophenac sodium, and

(B) slow-acting diclophenac sodium formed by an enteric substance film of

methacrylic-acid methyl methacrylate copolymer at solved pH of 6~7,

methacrylic-acid ethylacrylate copolymer at solved pH of 5, or

*hydroxypropyl-mehtylcellulose-phtalate (HP)* at solved pH of 5~5.5,

wherein the weight ratio of (A) : (B) being 4 : 6 ~ 3 : 7.

(2) Patent Infringement Litigation

○ Osaka District Court, Decision, Sept.17, 1998

Case No. Heisei 8 (wa) 8927 (of 1996)

### (2.1) Alleged Product

The alleged product comprises ;

hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS)

(as a substituent for hydroxypropyl-mehtylcellulose-phtalate (HP) of the patented invention.)

The alleged infringer had made and sold the alleged product.

### (2.2) Court Decision

The Osaka District Court found that the alleged product consisted of “*hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS)*” in place of the “*hydroxypropyl-mehtylcellulose-phtalate (HP)*” in the patented invention and that the different part of the patented invention ”HP” was the essential part of the patented invention.

Then the Osaka District Court decided that the alleged product did not fulfill the Condition 1 for applying the Doctrine of Equivalent, and that the alleged product did not infringe the patented Claim.

As explained below (Case 2.3.2), the Osaka District Court also examined the Condition 3.

### (3) Invalidation Procedure against the Patent

(Not found.)

### (4) COMMENT:

The Osaka District Court provided the interpretation of “essential part” of the patented invention from the side of “constituent element yielding the *effect*” of the invention (as explained above).

### 2.1.3

“Sustained Release Diclofenac Sodium Pharmaceutical” Case (No.2)

(Case of seeking Injunction and Destruction against Patent Infringement)

Patent Number : JP1571849 (The patent expired on Aug. 10, 2004.)

#### (1) Patented Invention

Patented Claim: (as the same as Case 2.1.2 No.1)

#### 【Claim 1】

A sustained release diclofenac pharmaceutical consisting of ;

(A) rapid-acting diclofenac sodium, and

(B) slow-acting diclofenac sodium formed by an enteric substance film of methacrylic-acid methyl methacrylate copolymer at solved pH of 6~7,

methacrylic-acid ethylacrylate copolymer at solved pH of 5, or

*hydroxypropyl-mehtylcellulose-phtalate (HP)* at solved pH of 5~5.5,

wherein the weight ratio of (A) : (B) being 4 : 6 ~ 3 : 7.

#### (2) Patent Infringement Litigation

○ Tokyo District Court, Decision, Jan. 1, 1999

Case No. Heisei 8 (wa) 14828 (of 1996)

##### (2.1) Alleged Product

The alleged product comprises ;

hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS)

(as a substituent for hydroxyl-propyl-mehtyl-cellulose-phtalate (HP) of the patented invention).

## (2.2) Court Decision

In this case, the alleged product was different from that of the " Case 2.1.2".

The Tokyo District Court found that the alleged product containing "*hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS)*" in place of the "*hydroxypropyl-mehtylcellulose-phtalate (HP)*" in the patented invention and that the different part of the patented invention "HP" was the essential part of the patented invention.

Then the Tokyo District Court decided that the alleged product did not fulfill the Condition 1 for applying the Doctrine of Equivalents, and that the alleged product did not infringe the patented Claim.

As explained below (Case 2.5.1), the Tokyo District Court also examined the Condition 5.

(In this case, the Tokyo District Court also examined the Condition 2 of interchangeability of "AS" of alleged product with "HP" of the patented invention. The Court found that "AS" and "HP" had the same operation effect which enables to obtain diclophenac pharmaceutical capable of maintaining effective blood concentration for a certain period of time. The Tokyo District Court found the interchangeability of "AS" with "HP" as the "Condition 2".)

substitution and found that the substitution would have conceived by a person skilled in the art.)

## (3) Invalidation Procedure against the Patent

(Not found)

## (4) COMMENT:

The Tokyo District Court provided the interpretation of "essential part" of the

patented invention in this case from the side of constituent element of the claim “accomplishing the object” of the invention (as described before).

#### 2.1.4

##### "Copper-based Alloy for Electrical Connector"

(Case of Seeking Injunction and Damages against Patent Infringement)

Patent Number: JP2572042

(1) Patented Invention (Claim 1 was at issue.) (Claim 2~12 are omitted.)

##### 【Claim 1】

A copper base alloy for an electrical connector having an improved combination of ultimate tensile strength, electrical conductivity and stress relaxation properties consisting essentially of ;

from 2 to 4.8 % by weight nickel (Ni),

from 0.2 to 1.4 % by weight silicon (Si),

from 0.05 to 0.45 % by weight magnesium (Mg), and

the balanced copper (Cu),

wherein the alloy is in a stabilized condition.

(2) Patent Infringement Litigation

○ Tokyo District Court, Decision, Feb. 25, 2004

Case No. Heisei 14 (wa) 16268 (of 2002)

(2.1) Alleged Product

Alleged product consists of

from 2.0 to 2.8 by weight Ni,

from 0.45 to 0.6 by weight Si,

from 0.4 to 0.55 by weight Zn,

from 0.1 to 0.25 by weight Sn,  
from 0.05 to 0.2 by weight Mg, and  
the balance copper (Cu).

The alleged infringer (defendant) had commercially made and sold the alleged product.

## (2.2) Court Decision

The Tokyo District Court found that the alleged product containing Zn and Sn was different from the patented invention in which Zn and Sn were not contained.

The Court examined the different part and found that the different part of the patented invention (in which 0.05~0.2 % of Mg was solely contained in Cu-Ni-Si base alloy) from the alleged product (in which 0.4~0.55 % of Zn and 0.1~0.25 % of Sn, were contained in addition to 0.05~0.2 % of Mg in Cu-Ni-Si base alloy) was the essential part of the patented invention. So, the Court concluded that the alleged product did not meet the "Condition 1" for applying the DOE and that the alleged product did not infringe the patent.

The Tokyo District Court also examined the Condition 2 (see Case 2.2.2), the Condition 3 (see Case 2.3.4), and the Condition 5 (see Case 2.5.7).

## (3) Invalidation Procedure against the Patent

### (3.1) Invalidation Trial and Judicial Action against Trial Decision

- JPO Trial No. 2002-35501 (JPO)

JPO Trial Decision; "the demand for invalidation shall not be allowed"

(This decision meant that the patent was not invalid.)

- Court Appeal No. Heisei 17 (gyo-ke) 10076 (of 2005) (IP High Court)

(Case of seeking cancellation of the JPO trial decision)

The demand for trial of invalidation of the patent was withdrawn on July 2005, and this invalidation procedure was ended before the court appeal was decided by the IP High Court. As the result, the validity of the patent was maintained.

#### (4) COMMENT

It was obvious that the Zn and Sn contained in the alleged product were essential ingredients and that the alleged product was apparently not substantially the same as the patented invention.

## 2.2

### CASE THE "CONDITION 2" WAS NOT SATISFIED

("Interchangeability" test : whether or not "the purpose of the patented invention can be achieved and/or the advantageous effect can be yielded after the interchange from the different part of the patented invention to that of alleged product or process")

#### 2.2.1

“Optical Depilating Device” Case

(Case for Seeking Injunction and damages against Patent Infringement)

Patent Number: JP1926400

(H06-36768 : Examined Patent Application Publication Number)

(1) Patented Invention **【FIG. 2.2.1-1】** (Fig. 1A in H06-367568)

Patented Claim ; (Claim 1 was at issue.)

**【Claim 1】**

An optical depilating device comprising



two kinds of light emitting sources for emitting red light and blue light,  
a main body with a control circuit for controlling the irradiation intensity and  
the irradiation time of the lights from the light emitting sources,  
an irradiation probe for emitting the lights to the skin,  
a flexible connector for connecting the main body with the irradiation probe, and  
a switching mechanism for alternatively emitting red light and blue light.

(According to the patented invention, the tissue factors of hair in the deep area and  
in the shallow area of derma can be dried by using the probe.)

## (2) Patent Infringement Litigation

◎ Tokyo High Court, Decision, Apr. 25, 2001  
Case No. Heisei 12 (ne) 1266 (of 2000)

(Original Decision)

○ Tokyo District Court, Decision, Jan. 28, 2000  
Case No. Heisei 10 (wa) 16017 (of 1998)

### (2.1) Alleged Product

The alleged device includes a halogen lamp and a xenon lamp with a filter for  
eliminating ultra-violet light in stead of the red and blue light sources of the  
patented invention. The light from the xenon lamp is emitted through an  
irradiation probe to the skin, however, the light from the halogen lamp is emitted  
without using an irradiation probe to the skin.

### (2.2) Court Decision

The Tokyo District Court (first instance court) found that the halogen lamp of  
the alleged device did not contain the means for irradiating red- color light through

the probe and that the *effect* of the halogen lamp of the alleged device was not identical to that of the present invention, and so the halogen lamp of the alleged device was not equivalent to the corresponding one of the present invention.

The Tokyo District Court did not find the interchangeability of the different part and decided that the alleged device did not infringe the patent even under the Doctrine of Equivalents.

The Tokyo High Court (*Koso* appeal court or second instance court) also found that the alleged device did not include the probe for irradiation the lights and that the halogen lamp of the alleged device did not yield the *effect* of the patented invention, and concluded that the interchangeability could not be found.

The Tokyo High Court affirmed the decision of the Tokyo District Court and dismissed the *Koso* appeal by the patent owner.

### (3) Invalidation Procedure against the Patent

Not found.

### (4) COMMENT:

The Courts examined interchangeability of the different part of the patented invention into that of the alleged product from the view of "effect" achieved by those elements.

The Courts did not find the interchangeability by limiting the meaning of the constituent element of the light emitting source or the "probe" according to the description in the specification of the patent.

The Court concluded that the alleged product did not meet the "Condition 2" for applying the DOE and that the alleged product did not infringe the patent.

## 2.2.2

"Copper-based Alloy for Electrical Connector"

(Case of Seeking Injunction and Damages against Patent Infringement)

Patent Number: JP2572042 (See 2.1.4)

(1) Patented Invention

(See 2.1.4)

(2) Patent Infringement Litigation

(See 2.1.4)

(2.1) Alleged Product

(See 2.1.4)

(2.2) Court Decision

The Tokyo District Court found that the alleged product did not yield the advantage *effect* of the patented invention and that the interchangeability of the constituents of the patented invention with those of alleged product was denied.

The Court concluded that the alleged product did not meet the "Condition 2" for applying the DOE and that the alleged product did not infringe the patent.

The Tokyo District Court also examined the Condition 1 (see Case 2.1.4), the Condition 3 (see Case 2.3.4), and the Condition 5 (see Case 2.5.7).

(3) Invalidation Procedure against the Patent

(See 2.1.4)

(4) COMMENT

It is presumed that the different ingredients of Zn and Sn contained in the alleged copper base alloy would have yield the effect different from that of the patented invention.

2.3

CASE THE "CONDITION 3" WAS NOT SATISFIED

("Would Have Easily Known" test or "Conceivability of Interchange" test : whether or not "a person skilled in the art would have easily known the interchangeability at the time of making, using or selling the alleged product or process")

### 2.3.1

"Injection Device" Case (product claim)

(Case of Seeking Injunction against Patent Infringement)

Patent Number : JP 2108611 (See 2.1.1)

#### (1) Patented Invention

Patented Claim; (Claim 5 was at issue.)

(See 2.1.1)

#### (2) Patent Infringement Litigation

◎ Osaka High Court, Decision, Apr. 19, 2001

Case No. Heisei 11 (ne) 2198 (of 2001)

○ Original Decision;

Osaka District Court, Decision, May 27, 1999

Case No. Heisei 8 (wa) 12220 (of 1999)

#### (2.1) Alleged Product

(the same as 2.1.1 case)

#### (2.2) Court Decision

The Osaka District Court examined whether the alleged product (the defendant's injection device with the defendant's cartridge) infringed the patented Claim 5 under the Doctrine of Equivalents.

The Osaka District Court examined the “Condition 3” in the five conditions for applying the Doctrine of Equivalents after examining the “Condition 1” (as explained before in Case 2.1.1).

The Osaka District Court found that there was no evidence showing that a skilled person in the art would have easily conceived the interchange of the different part of the patented Claim 5 (“*the container can be fixed so that the constituents of the injection solution can be brought together and mixed, and which is made of two tubular members which can be screwed together and enclose the container*”) into the construction of the alleged device (which is not a fountain pen type).

As the result examination, the Osaka District Court decided that the alleged device did not infringe the patented Claim 5.

As explained before (Case 2.1.1), the Osaka District Court also examined the “Condition 1”.

The Osaka High Court affirmed the original decision of the Osaka District Court.

### (3) Invalidation Procedure against the Patent

(See 1.1)

### (4) COMMENT

It is not easy to understand the examination for the “Condition 3” or “conceivability of the substitution from the different part of the patented invention to that of the alleged product/process”.

It should be mainly important for examination of “conceivability” to find the publicly known technology at the time of infringement (especially the technology not known at the filing of the patent application but known at the time of infringement).

It has been suggested that the finding of the “conceivability” would be affected from the test of whether the different part is “essential” or not and whether the

different part is "interchangeable" or not.

It is thought that the "Condition 1 to 3" in combination are the criteria for finding whether the alleged or accused product/process is "substantially the same" as the patented invention.

### 2.3.2

Sustained Release Diclophenac Sodium Pharmaceutical Case (No.1)

(Case of Seeking Injunction)

Patent Number : JP1571849 (See 2.1.2)

#### (1) Patented Invention

(See 2.1.2)

#### (2) Patent Infringement Litigation

○ Osaka District Court, Decision, Sept.17, 1998

Case No. Heisei 8 (wa) 8927 (of 1996)

#### (2.1) Alleged Product

The alleged product consisted of;

hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS),

as a substituent for hydroxyl-propyl-mehtyl-cellulose-phtalate (HP) of the patented invention.

#### (2.2) Court Decision

The Osaka District Court found that the alleged product was substituted with "*hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS)*" for "*hydroxypropyl-mehtylcellulose-phtalate (HP)*" of the patented invention.

And the Osaka District Court did not found that, at the time of making and selling the alleged pharmaceutical product, a person skilled in the art would have

easily known the interchangeability of the part of the patented invention HP with that of the alleged device AS.

So, the Osaka District Court decided that the alleged product did not fulfill the “Condition 3” for applying the Doctrine of Equivalents, and that the alleged product did not infringe the patented Claim.

As explained above (Case 2.1.2), the Osaka District Court also examined the “Condition 1”.)

### (3) Invalidation Procedure against the Patent

(See 2.1.2)

### (4) COMMENT

It is not easy to clarify the “Condition 3” separately from the “Condition 1” and “Condition 2” as explained before.

The “Condition 1”, “Condition 2” and “Condition 3” should be totally examined for finding whether the alleged product/process is substantially the same as the patented invention.

### 2.3.3

“Cutting Blade for Shredder” Case (product claim)

(Case of Seeking Injunction and Disposal against Patent Infringement)

Patent Number : JP 2813572

(1) Patented Invention **【FIG. 2.3.3-1】** (Fig. 1 in JP281372)

Patented Claim; (Claim 1 was at issue.)

**【Claim 1】**

A cutting blade 10 for a shredder, which is fixed through a spacer 11 to a shaft 1 rotatably mounted on a casing 4, comprising;

a mount portion 14 set to the shaft 1 and

an edge portion 13 divided into a plurality of edge pieces 13a circumferentially surrounding the mount portion 14 to cover the periphery of the mount portion 14,

the edge pieces 13a being attachable to and detachable from the mount portion 14,

wherein step-like shaped tooth portions 14a projecting on the periphery of the mount 14 are formed so as to be engaged with the edge pieces 13a .

## (2) Patent Infringement Litigation

○ Osaka District Court, Decision, Feb. 22,2000

Case No. Heisei 10 (wa) 12235 (of 1998)

### (2.1) Alleged Product

The alleged blade was found to have a mount member *integrated with a shaft* for a shredder.

It was found that the alleged infringer had made, sold and offered to sell the alleged cutting blades for shredders and the alleged shredders with the alleged cutting blades.

### (2.2) Court Decision

The Osaka District Court mentioned that the “conceivability of interchange ” of the "Condition 3" means that "any" persons skilled in the art would have conceived the interchangeability of the different part of the patented invention with that of the alleged product.

The Osaka District Court found that there was no evidence showing that at the time of beginning of making the alleged product, any persons skilled in the art would have conceived from the publicly known art the alleged product in which the mount member and the shaft was *integrated with each other* and in which only the



cutting blade was made separately from the mount integrated with the shaft.

The Court concluded that the "Condition 3" was not met and that there was no space to apply the D.O.E. against the alleged product.

### (3) Invalidation Procedure against the Patent

#### (3.1) Invalidation Trial (No.1-1) and Judicial Action against Trial Decision

- JPO Trial No. Heisei 11-35020 (of 1999)

JPO Trial Decision;

"the patented claim is made to be invalid"

(because of lack of inventive step)

- Court Appeal against the JPO Trial Decision

No. Heisei 12 (gyo-ke) 204 (of 2000)

Court Decision; "cancel the JPO Trial Decision to invalidate the patent"

(because the correction of the patented claim had been allowed by the JPO in the correction trial after the invalidation trial decision)

#### (3.2) Invalidation Trial (No. 1-2) and Judicial Action against Trial Decision

(repeated-trial after the cancellation of the former invalidation trial decision)

- JPO Trial No. Heisei 11-35020 (of 1999) (the same as the former number) (JPO)

JPO Repeated-Trial Decision

"the patented claim is made to be invalid"

(because of lack of inventive step even after the demanded correction of the claim could be allowed)

- Court Appeal against the JPO Repeated-Trial Decision

No. Heisei 14 (gyo-ke) 273 (of 2002)

Court Decision; " dismissal of claim (for cancellation of the JPO Trial Decision to invalidate the patent)"

■ Supreme Court *Jokoku*-Appeal (to reverse the High Court decision)

☆ After the *Jokoku* appeal was filed before the Japan Supreme Court, the Demand for the Invalidation Trial before the JPO was withdrawn by the demandant of the Invalidation Trial.

(As the result of withdrawn of the demand for the invalidation trial, the JPO Trial Decision to make the patent invalid was not affirmed finally.

And this invalidation procedure was made the end so that the validity of the patent was maintained. )

#### (4) COMMENT

Concerning the "conceivability" of the "Condition 3", it is thought to be important to search and confirm the evidence relevant to publicly known art at the time of infringement (including the art known from before the patent application to the time of infringement, especially the art known from the filling to the infringement).

In this case, the invalidation procedure was finalized by withdrawal of the demand of invalidation trial at the stage the judicial action was to be examined before the Supreme Court.

It is presumed in such a case that the withdrawal of the demand of invalidation trial before the JPO was consented between the patent owner and the alleged infringer to keep the validity of the patent.

#### 2.3.4

"Copper-based Alloy for Electrical Connector"

(Case of Seeking Injunction and Damages against Patent Infringement)

Patent Number: JP2572042 (See 2.1.4)

(1) Patented Invention (See 2.1.4)

(2) Patent Infringement Litigation (See 2.1.4)

(2.1) Alleged Product (See 2.1.4)

(2.2) Court Decision

The Tokyo District Court found that the alleged product did not yield the advantage *effect* of the patented invention.

Then the Tokyo District Court did not find that, at the time of making and selling the alleged alloy, a person skilled in the art would have easily conceived the interchangeability of the constituent elements of the patented invention with those of the alleged alloy.

And, the Tokyo District Court concluded that the alleged product did not fulfill the "Condition 3" for applying the Doctrine of Equivalents, and that the alleged product did not infringe the patented Claim.

The Tokyo District Court also examined the Condition 1 (see Case 2.1.4), the Condition 2 (see Case 2.2.2), and the Condition 5 (see Case 2.5.7).

(3) Invalidation Procedure against the Patent

(See 2.1.4)

(4) COMMENT

The Court simply pointed out the difference of *effect* between the patented invention and the alleged product, and disaffirmed the conceivability of the interchange of the different part.

2.4

CASE THE "CONDITION 4" WAS NOT SATISFIED

("Public Domain" test : whether or not "the alleged product/process is publicly known or is obviously thought by a skilled-person from the publicly known invention")

There have been very few case in which the "Condition 4" was examined as the matter of whether the Doctrine of Equivalent should be applied or not in a patent infringement law suit.

This is because if the alleged product/process has been publicly known or is obviously thought by a skilled-person from the publicly known art, then the patented invention must be invalidated because of lack of novelty or inventive step in most cases.

In the Judgment of the so-called "Kilby Case" (Apr. 11, 2000 : Case No. Heisei 10 (o) 364 of 1998), the Japan Supreme Court confirmed that a patent infringement court should examine and find whether the patent at issue is obviously invalid or not if a defense of invalidity of the patent is presented, even before becoming finalizing the trial decision of invalidation of the patent before the JPO.

After the Judgment of the Supreme Court in the "Kilby Case", almost alleged infringer have asserted the invalidity of the patent at issue instead of asserting the "Condition 4".

Japan Patent Law Article 104-3 was established as an expressed provision along the line of the Judgment of the Supreme Court in the "Kilby Case".

#### 2.4.1

"Switch Valve Tube" Case

(Case of Seeking Injunction and Destruction against Patent Infringement)

Patent Number: JP2859546 (expired on Dec. 4, 2004)

(1) Patented Invention

**【FIG. 2.4.1】** (Fig.2 and 4 in the drawings attached to the patent specification)

Patented Claim (Claim 1 was at issue. Claim 2 is omitted below.)

**【Claim 1】**

A switch valve tube comprising;

a pouring tube part 106 provided with an inflow port 109 and an outflow port 108,

a valve tube part 107 connected with the pouring tube part 106 at the position between the inflow port 109 and the outflow port 108,

a valve element 112 inserted into the valve tube part 107, so that the valve element 112 can be moved along the axis as well as around the axis of the valve tube part 107 so as to be positioned to realize the pouring condition by blocking the connection port between the pouring tube part 106 and the valve tube part 107 or to realize the non-pouring condition by blocking the outflow port 108 of the pouring tube part 106,

and

a moving mechanism for moving the valve element 112,

wherein the moving mechanism comprises;

the first guide groove 113a and the second guide groove 113b formed on the peripheral surface of the valve tube part 107, the first guide groove 113a extending circumferentially around the valve tube part 107, and the second guide groove 113b being connected with the first guide groove 113a and extending along the axis of the valve tube part 107,

a guide rod 114 formed on the outer surface of the valve element 112 in such a manner that the guide rod 114 is able to be projected through the grooves 113a and 113b and moved in the grooves 113a and 113b, and

a head screw rod 117 the axis of which is arranged along the axis of the valve tube part 107, the one end 117a of the screw rod 117 being rotatable to the valve tube part 107, and the other end 117b being screwed to the center portion of the

valve element 112.

(The switching workability from the pouring condition of concrete material to the non-pouring condition and vice versa can be improved by using the valve tube.)

## (2) Patent Infringement Litigation

- Tokyo District Court, Decision, Jan.29,2004  
Case No. Heisei 12 (wa) 16275 (of 2000)

### (2.1) Alleged Product

The alleged infringers (two defendants) had made and sold the alleged switching valve tubes (A) and (B).

The alleged infringers introduced the evidence of a switching valve tube (C) which was sold before the application date of the patent application to prove a publicly known art before the application of the patent.

### (2.2) Court Decision

The Court found that there were some differences between the alleged device (A) , (B) and the publicly known device (c) and that the alleged device (A) and (B) were easily thought from the publicly known device (C) by a person skilled in the art.

The Court examined and concluded that the "Condition 4" for applying D.O.E. could not be fulfilled, and decided that the alleged devices did not infringe the patent.

The Court also found that there was some difference between the patented invention and the publicly known device (c) and that the patented invention could be easily thought from the publicly known device by a person skilled in the art.

The Court concluded that the patent would be invalidated because of lack of

inventive step by the publicly known device (C) and that the patent right could not be enforced because of abuse of right along the line shown in the “Kilby Case” by the Supreme Court.

### (3) Invalidation Procedure against the Patent

Not found.

### (4) COMMENT

When the patent owner asserts that the alleged product/process is the same as the patent invention, the alleged product/process is found to be obvious from the publicly known prior art, then the patented invention will be obvious from the publicly known prior art and the patent will be invalid because of lack of inventive step.

The patent owner should examine the publicly known prior art as well as the alleged product/process before accusing someone of patent infringement.

## 2.5

Cases the "Condition 5" was not met

("Prosecution History" test or "Estoppel" test : whether or not "the alleged product/process has been intentionally excluded from the scope of the patent right during the prosecution")

### 2.5.1

“Sustained Release Diclophenac Sodium Pharmaceutical” Case (No.2)

(Case of Seeking Injunction and Destruction against Patent Infringement)

Patent Number : JP1571849

### (1) Patented Invention

Patented Claim: (See Case 2.1.3)

**【Claim 1】**

A sustained release diclophenac pharmaceutical consisting of

(A) rapid-acting diclophenac sodium, and

(B) slow-acting diclophenac sodium formed by an enteric substance film of methacrylic-acid methyl methacrylate copolymer(MM) at solved pH of 6~7, methacrylic-acid ethylacrylate copolymer (ME)at solved pH of 5, or *hydroxypropyl-mehtylcellulose-phtalate (HP)* at solved pH of 5~5.5,

wherein the weight ratio of (A) :(B) being 4:6 ~ 3:7.

The alleged product was consist of ;

hydroxyl-propyl-mehtylcellulose-acetate-suxinate (AS)

as a substitute for hydroxyl-propyl-mehtyl-cellulose-phtalate (HP).

(2) Patent Infringement Litigation

○ Tokyo District Court, Decision, Jan. 28, 1999

Case No. Heisei 8 (wa) 14828 (of 1996)

(2.1) Alleged Product

(2.2) Court Decision

The Tokyo District Court found that the applicant had limited the MM, ME, and HP as the enteric substance film during the patent application procedure, and that usage of AS was excluded from the scope of patented invention.

So, the Tokyo District Court decided that the alleged product containing “AS” did not fulfill the Condition 5 for applying the Doctrine of Equivalents, and that the alleged product did not infringe the patented Claim.

As explained in the Case 2.1.3, the Tokyo District Court also examined the Condition 1 which was not satisfied in the alleged product.



### (3) Invalidation Procedure against the Patent

(see 2.1.3)

### (4) COMMENT

It should be careful to make an amendment and remarks during prosecution.

## 2.5.2

“Resonant Tag and Deactivator for Use in an Electronic Security System” Case

(Case of Seeking Injunction, Destruction and Damages )

Patent No.JP1677440 (expired on Apr. 23, 2004)

(S61-501947/ WO8504975 : Publication Number)

### (1) Patented Invention **【FIG. 2.5.2-1】** (Fig. 3 in WO8504975)

Patented Claim (Claim 1 was at issue.)

#### **【Claim 1】**

A de-activatable resonant tag (label) comprising:

a planar substrate 14,42,62 of dielectric material;

a tuned circuit on the substrate in a planar circuit configuration and resonant at a frequency for detecting the presence of the resonant tag circuit within a predetermined range,

conductive areas 10,12,22,24, 46,50,66,74, 10a,12a,22a,28a in alignment on respective opposite surface of the substrate to define a capacitor of the tuned circuit,

and

deactivatable portions between the conductive areas, the deactivatable portions being burn out in response to an electromagnetic field at the frequency of sufficient energy for deactivation to destroy the resonant properties of the tuned circuit at the frequency for detection,

wherein the deactivatable portions comprises dielectric portions between some conductive areas to insulate therebetween,

the dielectric portion provides a discharge path along which an *arc discharge* will occur, and

the *arc discharge* will occur in response to an electromagnetic field at the frequency for deactivation, between the conductive areas through the dielectric material, to destroy or change the resonant properties of the tuned circuit at the detection frequency.

## (2) Patent Infringement Litigation

◎ IP High Court, Decision, June 16, 2005

Case No. Heisei 17 (ne) 10052 (of 2005)

(Original Decision)

○ Tokyo District Court, Decision, Apr.28, 2004

Case No. Heisei 14 (wa) 25924 (of 2002)

### (2.1) Alleged Product

Alleged device 1 and 3 were found to have arrangements in which “spark discharge” were occurred.

### (2.2) Court Decision

The Tokyo District Court found that the “arc discharge” in the constituent elements of the patented invention differed from the “spark discharge” in the alleged devices ( device 1 and 3), and that the applicant limited the scope of claim only within the constituent causing “arc discharge” during the patent obtaining procedure.

Then the Tokyo District Court decided that the alleged devices, in which “spark discharge” could be caused, was intentionally excluded from the scope of patent

and that the alleged devices did not infringe the patent even under the Doctrine of Equivalents.

The IP High Court also found that the applicant wrote only the constituent element which causes “arc discharge” in the claim during the prosecution, even though “spark discharge” was also publicly known at the time of filing.

The IP High Court decided that the alleged devices did not infringe the patent under the Doctrine of Equivalents because the Condition 5 was not fulfilled.

### (3) Invalidation Procedure against the Patent

#### (3.1) Invalidation Trial and Judicial Action against Trial Decision

- JPO Trial No. 2002-35105 (JPO)

JPO Trial Decision: “the demand for invalidation shall not be allowed”

(This meant that the patent was not invalid.)

- Court Appeal No. Heisei 15 (gyo ke)73 (of 2003) (Tokyo High Court)

Court Decision: “dismissal of claim (for cancellation of trial decision)”

(This means that the patent is maintained to be valid.)

#### (4) COMMENT

It is taught by examining the Case that patent infringement courts strictly interpret constituent elements of a patent claim even when courts examine whether an alleged product/process may infringe a patent under the Doctrine of Equivalents.

#### 2.5.3

“Manufacture of Morphologically Homogeneous Thiazole Derivative” Case

Patent Number: 2708715

(1) Patented Invention

Patented Claim:

【Claim 1】

*Form "B" of Famotidine* which has an endotherma maximum of melting at 159 °C on the DSC; its characteristic absorption bands in its infrared spectrum are at 3506, 3103 and 777  $\text{cm}^{-1}$ , and its melting point is 159~162 °C .

【Claim 2】

A process of preparing morphologically homogeneous Famotidine (chemical name: N-sulfamoyl-3-(2-guanidino-thiazole-4-yl-methylthio)-propionamide), characterized by dissolving Famotidine of optional morphological composition in water and/or a lower aliphatic alcohol under heating and in the case of the preparation of the form "B", the product is precipitated from its oversaturated solution, which was oversaturated at a temperature lower than 40 °C, and the required product is separated from the obtained suspension of crystals.

(2-1) Patent Infringement Litigation (No.1)

(Case of Seeking Injunction and Destruction against Patent Infringement)

◎ Osaka High Court, Decision, Nov.27, 2004

Case No. Heisei 15 (ne) 514 (of 2003)

(Original Decision)

○ Osaka District Court, Decision, Jan. 30, 2003

Case No. Heisei 14 (wa)3043 (of 2002)

(2-1.1) Alleged Product

The alleged infringer (X) had made, sold, offered to sell the alleged product (L) consisting of a mixture of "Form A Famotidine" with "Form B Famotidine".

## (2-1.2) Court Decision

The Osaka District Court found that the “Famotidine” in the Claim 1, 2 should be construed to limit the material only consisting of “pure Form B Famotidine” in the light of the explanation in the specification and the prosecution history including the remarks in response to the notification of reason for refusal. The court concluded that the alleged product containing “Form A Famotidine” with “Form B Famotidine” was out of the scope of the patented invention.

The Osaka District Court dismissed the demand of the patent owner without examining the application of D.O.E..

The Osaka High Court found that the “Form B Famotidine” in the Claim should be interpreted as “pure Form B Famotidine” containing no “Form A Famotidine”, which was to be the essential part of the patented invention.

Then the Osaka High Court concluded that the alleged product did not meet the Condition 1 for applying the D.O.E..

The Osaka High Court also found that the scope of the invention was intentionally limited within "*Form B Famotidine*" so as to exclude "Form A Famotidine" from the scope of patent by the applicant (patent owner) during the patent obtaining procedure which included the description in the specification and the remarks against the office action..

The Osaka High Court decided that the alleged products containing "Form A Famotidine" did not infringe the patent even under the Doctrine of Equivalents because the “Condition 5” was not fulfilled.

## (2-2) Patent Infringement Litigation (No.2)

(Case of Seeking Injunction and Destruction against Patent Infringement)

© Osaka High Court, Decision; Feb.6, 2004

Case No. Heisei 15 (ne) 2115 (of 2003)

(Original Decision)

○ Osaka District Court, Decision; May 29, 2003

Case No. Heisei 14 (wa)4040 (of 2002)

#### (2-2.1) Alleged Product

The alleged infringers (Y1, Y2) had made, sold, offered to sell the alleged product (M) consisting of a mixture of “Form A Famotidine” with “Form B Famotidine”.

#### (2-2.2) Court Decision

The Osaka District Court found that the “Famotidine” in the Claim 1, 2 should be construed to limit the material only consisting of “pure Form B Famotidine” in the light of the explanation in the specification and the prosecution history including the remarks in response to the notification of reason for refusal. The court concluded that the alleged product containing “Form A Famotidine” with “Form B Famotidine” was out of the scope of the patented invention.

The Osaka District Court dismissed the demand of the patent owner without examining the application of D.O.E..

The Osaka High Court found that the “Form B Famotidine” in the Claim should be interpreted as “pure Form B Famotidine” containing no “Form A Famotidine”, which was to be the essential part of the patented invention.

Then the Osaka High Court concluded that the alleged product did not meet the Condition 1 for applying the D.O.E..

The Osaka High Court also found that the scope of the invention was intentionally limited within “*Form B Famotidine*” so as to exclude “Form A Famotidine” from the scope of patent by the applicant (patent owner) during the

patent obtaining procedure which included the description in the specification and the remarks against the office action..

The Osaka High Court decided that the alleged products containing "Form A Famotidine" did not infringe the patent even under the Doctrine of Equivalents because the "Condition 5" was not fulfilled.

### (2-3) Patent Infringement Litigation (No.3)

(Case of Seeking Injunction and Destruction against Patent Infringement)

◎ Tokyo High Court, Apr.28, 2004

Case No. Heisei 15 (ne) 3034 (of 2003)

(Original Decision)

○ Tokyo District Court, May 7, 2003

Case No. Heisei 14 (wa) 6613 (of 2002)

#### (2-3.1) Alleged Product

The alleged infringers (Z1, Z2) had made, sold, offered to sell the alleged product (N) consisting of a mixture of "Form A Famotidine" with "Form B Famotidine".

In the Cases, the alleged products contained "A type famotidine" as well as "B type famotidine".

#### (2-3.2) Court Decision

The Tokyo District Court found that the "Famotidine" in the Claim should be construed as "pure Form B Famotidine" in the light of the explanation in the specification and the remarks in response to the notification of reason for refusal during prosecution.

The court concluded that the alleged product containing "Form A Famotidine"

with “ Form B Famotidine” was out of the scope of the patented invention.

The Tokyo District Court dismissed the demand of the patent owner without examining the application of D.O.E..

The Tokyo High Court found that the scope of the invention was intentionally limited to "*Form B Famotidine*" so as to exclude "Form A Famotidine" from the scope of patent by the applicant (patent owner) during the patent obtaining procedure including the description in the specification and the remarks against the office action..

The Tokyo High Court decided that the alleged products containing "Form A Famotidine" did not infringe the patent even under the Doctrine of Equivalents because the “Condition 5” was not fulfilled.

### (3) Invalidation Procedure against the Patent

#### (3.1) Invalidation Trial (No. 1) and Judicial Action against Trial Decision

- JPO Trial No. 2002-35349 (JPO)

JPO Trial Decision;

"The correction of the Claim 1 was allowed."

“The demand for invalidation shall not be allowed.”

(The patent was maintained to be valid.)

- Court Appeal No. Heisei 15 (gyo ke)439 (of 2003)

(Tokyo High Court →IP High Court since Apr. 1, 2005)

Court Decision ; Not found.

#### (3.2) Invalidation Trial (No. 2)

- JPO Trial No. 2002-35414 (JPO)

JPO Trial Decision; “the demand for invalidation shall not be allowed”



(The patent was maintained to be valid.)

### (3.3) Invalidation Trial (No. 3)

- JPO Trial No. 2002-35460 (JPO)

JPO Trial Decision; “the demand for invalidation shall not be allowed”

(The patent was maintained to be valid.)

### (4) COMMENT

The patented claim was limited to "*Form B famotidine*" although "Form A famotidine" was also written in the specification of the patent application,

(The applicant obtained another patent related to "Form A famotidine".)

It should be noticed to draft claims with broadest extent within the disclosure of the specification.

#### 2.5.4

“Wire Stretcher of Synthetic Resin Coated Wire” Case

(Case of Seeking Injunction, Destruction, and Damages)

Patent Number: JP3232061

(1) Patented Invention **【FIG. 2.5.4-1】** (Fig. 2 in JP3232061)

Patented Claim (Claim 1 was at issue.)

#### **【Claim 1】**

A wire stretcher including;

a pair of side plates 1a, 1b,

a fitting shaft 2 at the tips of the side plates 1a, 1b, to which a hook 30 is fitted,

a drum 5 rotatably provided at the rear ends of the side plates 1a, 1b, in which a through hole 10 for passing a synthetic resin coated wire is bored,

a ratchet wheel 15 fixed coaxially with the drum 5,

a ratchet 20 meshing with the ratchet wheel 15 to regulate the rotation of the drum 5 only in the direction of taking up the synthetic resin coated wire,

a spring for energizing the ratchet 20 in the direction of meshing with the ratchet wheel 15, and

a releasing device 27 for holding the meshing in the release state, wherein

the center section of the open end of the through hole 10 is provided with an angled edge toward the outside periphery of the drum 5, and

the axis direction of the through hole 10 of the drum 5 at the open end is arranged in the inclined plane 12 along the periphery.

(When the wire is inserted in the through hole 10 and the drum 5 is rotated in the take-up direction, the synthetic resin coated wire can be easily tensed and fixed.)

## (2) Patent Infringement Litigation

○ Tokyo District Court, Decision, Jan.30, 2003

Case No. Heisei 14 (wa) 8839 (of 2002)

### (2.1) Alleged Product

The alleged wire stretcher was provided with the *chamfer plane* (at which the edges were cut off) at the open end of the through hole of a *rectangular member*.

The alleged infringer had made and sold the alleged stretcher.

### (2.2) Court Decision

The Tokyo District Court found that the different part of the patented invention of Claim 1 (“the center section of the open end of the through hole 10 is *provided with an angled edge toward the outside periphery of the drum 5*”) from the alleged stretcher was the essential part of the patented invention according to the

problem-solution explanation in the specification, and the Court concluded that the alleged device did not satisfy the Condition 1. The Court decided that the alleged device did not infringe the patent even under the D.O.E..

The Tokyo District Court also examined the Condition 5.

The Court found that the limitation related to the different part of the patented invention of Claim 1 (“the center section of the open end of the through hole 10 is *provided with an angled edge toward the outside periphery of the drum 5*”) had been introduced into the Claim 1 from the original Claim 2 by the amendment in response to the notification of reason for refusal during the prosecution.

The Court concluded that the limitation of the special structure at the open end of the through hole of the Claim 1 meant intentional exclusion of another type of structure in the light of the amendment and the remarks attached to the amendment, and that the alleged device did not satisfy the Condition 5.

The Court decided that the alleged device did not infringe the patent even under the D.O.E..

### (3) Invalidation Procedure against the Patent

(Not found)

### (4) COMMENT

It should be careful to make an amendment and remarks during prosecution not limit the scope of the invention.

#### 2.5.5

“Method for Preventing Coagulation of Blood in Injector and Pledget Composition”

Case

(Case of Seeking Injunction and Destruction)

Patent Number: JP2977339 (expired on Sept. 10, 2003)

(1) Patented Invention **【FIG. 2.5.5-1】** (Fig. 5 in JP2977339)

**【Claim 1】** (Claim 1 was at issue as the "First Invention".)

A method of measuring the free ion concentration in a blood sample in a syringe to reduce error by using heparin comprising the steps of;

providing a predetermined amount of a heparin salt,

providing a predetermined amount of a water-soluble filler material,

combining the heparin salt and the water-soluble filler material,

making a plurality of pledgets by lyophilizing the mixture of heparin salt and the water-soluble filler material after the mixing step,

placing into a syringe at least one of the pledgets having less than about 15 U.S.P. units of heparin activity per milliliter,

obtaining a blood sample into the syringe,

inputting at least portions of the blood sample from the syringe into a testing apparatus for analyzing the blood sample portions, and

determining the free calcium ion concentration associated with the blood sample portions while reducing error in the determination step due to use of the heparin.

**【Claim 4】** (Claim 4 was at issue as the "Second Invention".)

A blood-coagulation-preventing pledget,

for reducing error in the determination of the free calcium ion concentration in the blood sample, containing

a predetermined amount of heparin salt, and

water-soluble glucose polymer filler having the molecular weight of about 60000 ~ 90000, and

having less than about 15 U.S.P. units of heparin activity per milliliter.

(2) Patent Infringement Litigation

© Tokyo High Court, Decision, Apr.30, 2002

Case No. Heisei 13 (ne) 2296 (of 2001)

(Original Decision)

○ Tokyo District Court, Decision, Mar.26, 2001

Case No. Heisei 11 (wa) 26599 (of 1999)

#### (2.1) Alleged Process/Product

The alleged process did not comprise the steps of “making a plurality of pledgets by lyophilizing the mixture of heparin salt and the water-soluble filler material after the mixing step,(and then) placing into a syringe at least one of the pledgets having less than about 15 U.S.P. units of heparin activity per milliliter” (in this order).

#### (2.2) Court Decision

The Tokyo District Court examined the different part of the invention 1 of “making a plurality of pledgets by lyophilizing the mixture of heparin salt and the water-soluble filler material after the mixing step,(and then) placing into a syringe at least one of the pledgets having less than about 15 U.S.P. units of heparin activity per milliliter” (in this order),different from the alleged process, and concluded that the different part was essential part of the invention and that the applicant intentionally excluded the alleged process from the scope of the invention.

The Tokyo District Court decided that the alleged process did not meet the Condition 1 as well as the Condition 5 and denied patent infringement under D.O.E. to the Claim 1.

Then the Tokyo District Court examined the different part of the patented invention 2 (“ water-soluble filler with molecular weight of 60000 - 90000” ) from the alleged product and concluded that the different part was the “essential part” of the patented invention because the applicant explained the *specific effect*

of the part in the detail explanation in the specification . The Tokyo District Court decided that the alleged product did not infringe the patented invention 2.

The Tokyo High Court found that the scope of the patented invention 1 had been intentionally limited to “the steps in the order” written in the claim because the applicant asserted inventive step by referring the “the steps in the order” in the “remarks” in response to the reason for refusal during the prosecution. Then the Tokyo High Court concluded that the alleged process did not meet the Condition 5 and denied infringement under the Doctrine of Equivalent.

Concerning the patented invention 2, the Tokyo High Court affirmed the decision of the Tokyo District Court without modification.

### (3) Invalidation Procedure against the Patent

(Not found.)

### (4) COMMENT

It should be careful to explain the “object” or the “effect” of the specific constituent element(s) of a claim in the specification in a limited manner.

And it should be also careful during patent-obtaining procedure to assert novelty or inventive step with respect to the specific constituent element(s) of a claim.

#### 2.5.6

##### “Doctor Brade” Case

(Case of Seeking Injunction, Destruction and Damages against Patent Infringement)

Patent Number: JP2128843 (expired on Oct. 12, 2003)

(H08-11877 : Examined Patent Application Publication Number)

(1) Patented Invention **【FIG. 2.5.6-1】** (FIG. 1 in H08-11877)

Patented Claim (Claim 1 was at issue.)

**【Claim 1】**

A doctor blade for controlled application and smoothing of a coating composition on a running paper web, wherein;

the blade comprises a flexible steel strip having a thickness of 0.7 mm or less,

the coating composition comprises a surface coating of a ceramic material having higher wear-resistance than the steel blade,

the ceramic surface coating is thin relative to the steel strip thickness,

the total thickness of the coating composition is *not more than 0.25 mm* at the effective zone, and

the ceramic coating comprises a plurality of ceramic material layers formed in successive steps in a molten state.

(2) Patent Infringement Litigation

◎ Tokyo High Court, Decision, July 18, 2003

Case No. Heisei 14(ne)4193 (of 2002)

(Original Decision)

○ Tokyo District Court, Decision,

Case No. Heisei 13 (wa) 1650 (of 2001)

(2.1) Alleged Product

The Patent owner asserted that the alleged ceramic blade A,B, and C infringed the patent "indirectly" as stipulated in Article 101 (i) of the Japan Patent Law.

The thickness of the ceramic surface coating of the alleged ceramic blades were found to be *far more than 0.25 mm* at the effective zone (at the engaged zone).

(2.2) Court Decision

The Tokyo District Court pointed out that the applicant (patent owner) amended the "total thickness of the wear-resistant coating" from "less than 0.35 mm" to "not more than 0.25 mm" during the prosecution of obtaining the patent, and that whole of the constituent elements in the claimed invention were not met in the alleged products.

The Tokyo District Court concluded that "indirectly infringement" was not found and decided that the demand by the plaintiff (patent holder) was dismissed.

The Tokyo District Court did not examine the application of the D.O.E. because the plaintiff (patent holder) did not assert any infringement under the D.O.E.

The appellant-plaintiff (patent holder) asserted the infringement under the D.O.E. in the appellate instance before the Tokyo High Court.

The Tokyo High Court decided that indirect infringement was not found and affirmed the Tokyo District Court Decision.

Then the Tokyo High Court examined application of the D.O.E, and found that the Claim 1 was amended so as to limit the total thickness of the ceramic coating from less than 0.35 mm at the time of application to "not more than 0.25 mm" with the argument in which the total thickness should be made not more than 0.25 mm.

The Tokyo High Court concluded that the applicant excluded the ceramic coating having the total thickness of *more than 0.25 mm* from the scope of the claimed invention during the prosecution so as to intentionally limit the patent within the scope of "not more than 0.25 mm", and decided that the "Condition 5" for applying the D.O.E. was not fulfilled.

### (3) Invalidation Procedure against the Patent

(Not found.)

### (4) COMMENT

It should be careful to limit a claim with numerals.

It is usually known that when the claim is required to include a numerical



limitation, such a numeral is necessary to ascertain the novelty or inventive step of the invention. Then it is not fair to assert, after the registration, the scope of right beyond such a numerical limitation written in the claim when registered.

#### 2.5.7

"Copper-based Alloy for Electrical Connector"

(Case of Seeking Injunction and Damages against Patent Infringement)

(See 2.1.4, 2.2.2, 2.3.4)

Patent Number: JP2572042

(See 2.1.4)

(1) Patented Invention

(See 2.1.4)

(2) Patent Infringement Litigation

(See 2.1.4)

(2.1) Alleged Product

(See 2.1.4)

(2.2) Court Decision

The Tokyo District Court found that the applicant (patent owner) excluded Sn-containing Cu-Ni-Si alloy from the scope of the invention during the prosecution, and the Court concluded that the alleged product of an alloy containing 0.4~0.55 % of Zn and 0.1~0.25 % of Sn was intentionally excluded from the scope of the patented invention and that the application of the D.O.E. was denied.

The Tokyo District Court also examined the Condition 1 (see Case 2.1.4), the Condition 2 (see Case 2.2.2), and the Condition 3 (see Case 2.3.4).

(3) Invalidation Procedure against the Patent

(See 2.1.4)

#### (4) COMMENT

It is usual to determine that two alloys containing different ingredients (unless inevitable ingredient) are not the same. As decided by the Court, if any ingredient (e.g. Sn) not written in the claim is contained in the alleged product as the ingredient, it should be found that any alloy containing such an ingredient (e.g. Sn) have been excluded from the scope of the patent right.

## REFERENCES:

JPO Homepage

Japan Supreme Court Homepage

EPO Homepage

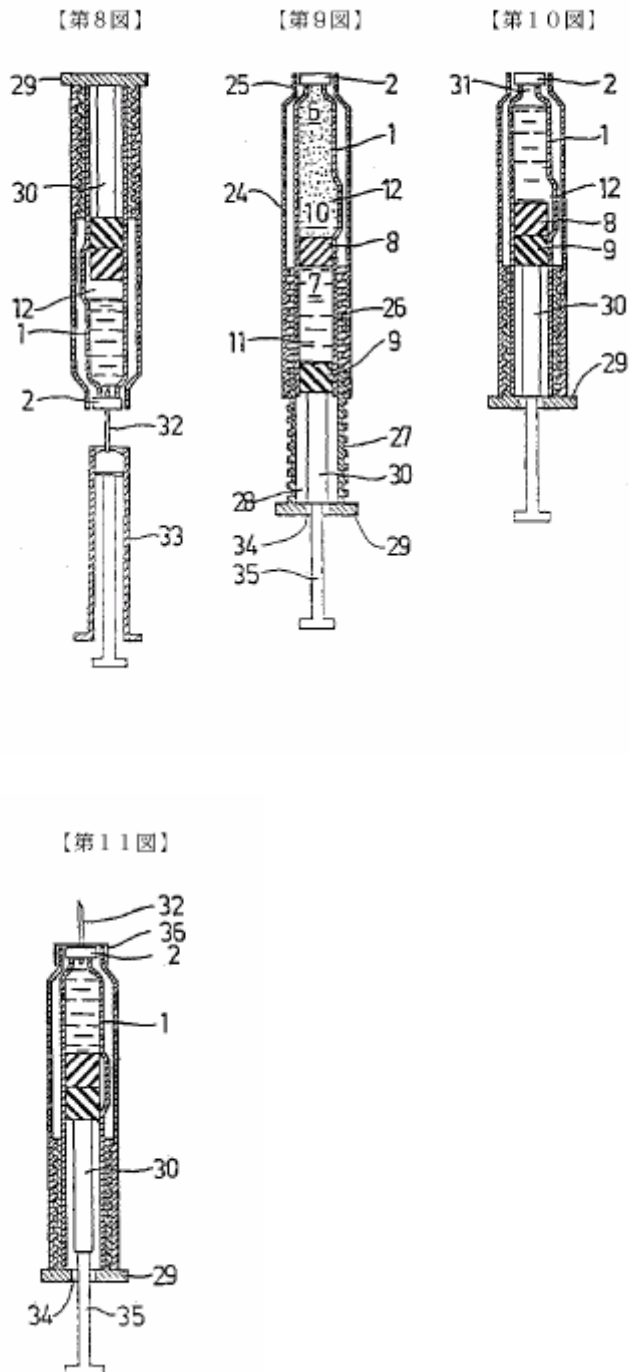
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JIII APIC Homepage

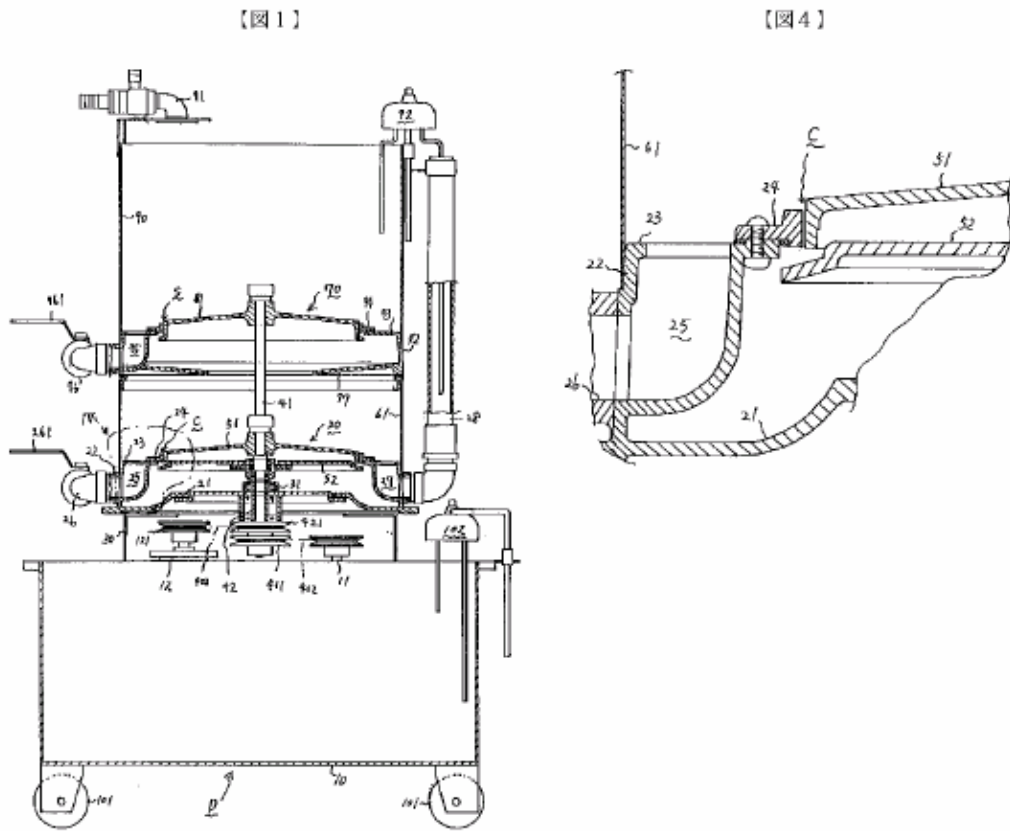
DRAWINGS :

- Fig. 1.1-1 (H06-61361 fig. 8,9,10,11)
- Fig. 1.2-1 (JP2662538 fig.1,4)
- Fig. 1.3-1 (H06-36727 fig. 1,2,3,4,5)
  
- Fig. 2.1.1-1 (H06-61361 fig. 5)
  
- Fig. 2.2.1-1 (H06-36728 fig. 1A)
  
- Fig. 2.3.3-1 (JP2813572 fig.1)
  
- Fig. 2.4.1-1 (JP2859546 fig. 2,4)
  
- Fig. 2.5.2-1 (WO8504975 fig. 3)
- Fig. 2.5.4-1 (JP3232061 fig. 2)
- Fig. 2.5.5-1 (JP2977339 fig. 5)
- Fig. 2.5.6-1 (H08-11877 fig. 1)

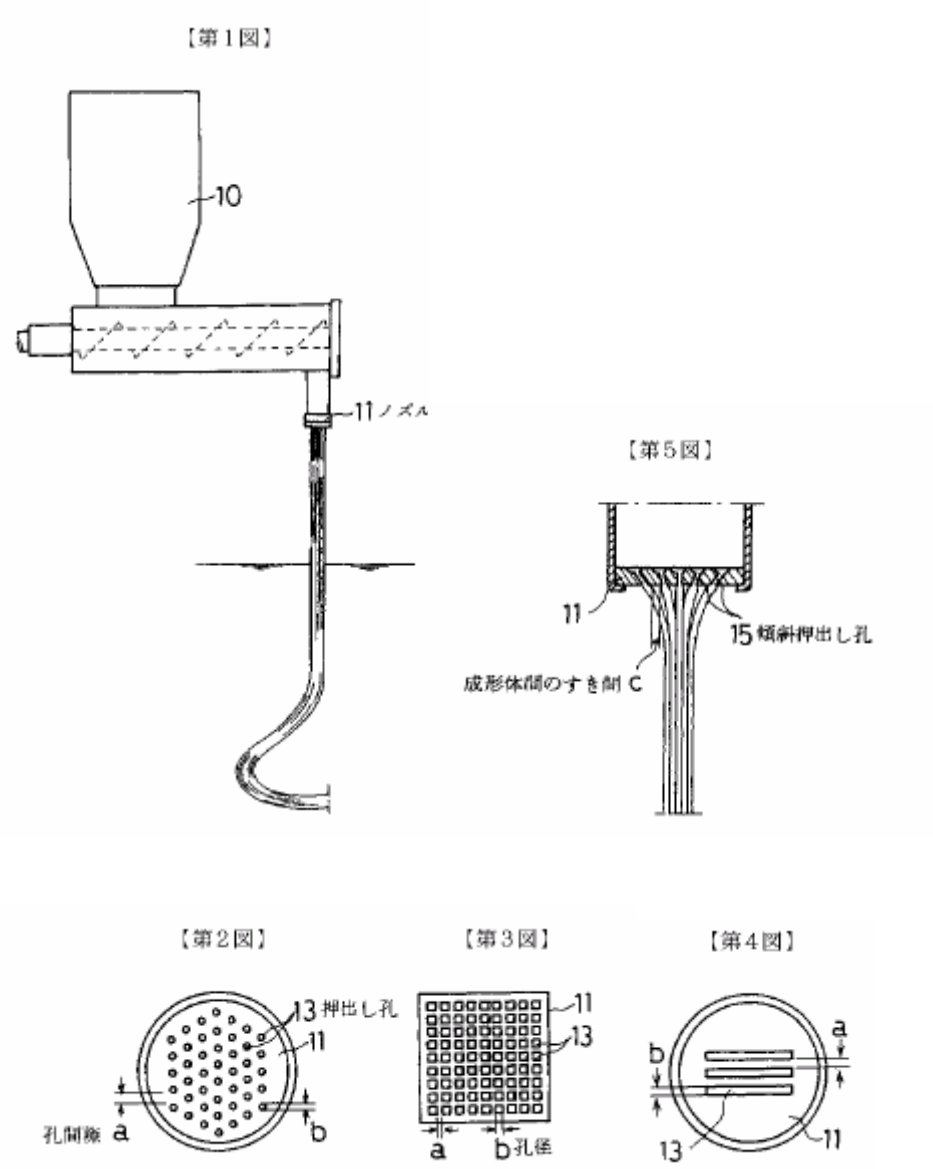
• Fig. 1.1-1 (H06-61361 fig. 8,9,10,11)



• Fig. 1.2-1 (JP2662538 fig.1,4)

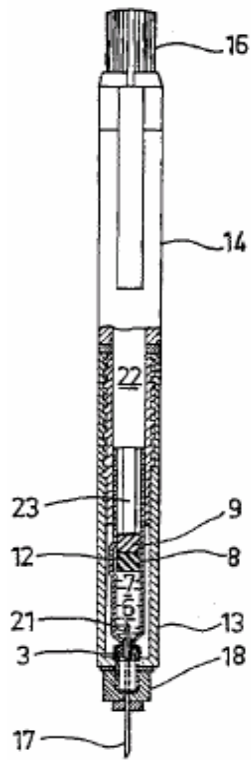


• Fig. 1.3-1 (H06-36727 fig. 1,2,3,4,5)



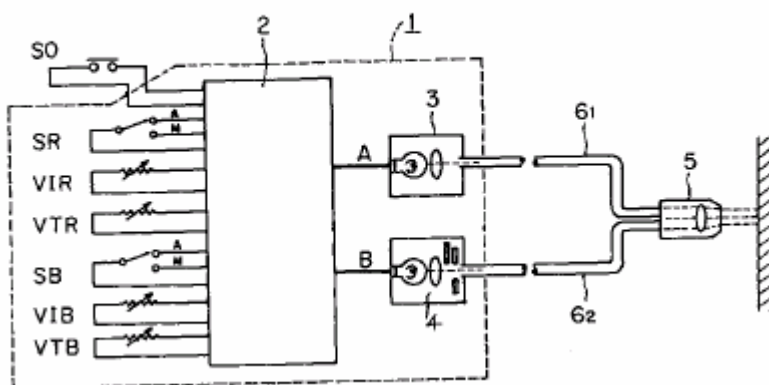
• Fig. 2.1.1-1 (H06-61361 fig. 5)

【第5圖】



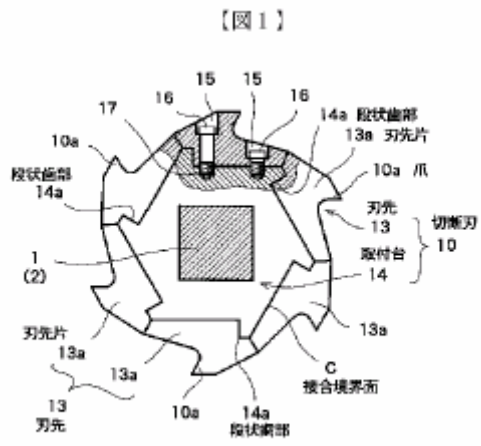
• Fig. 2.2.1-1 (H06-36768 fig. 1A)

【第1A圖】

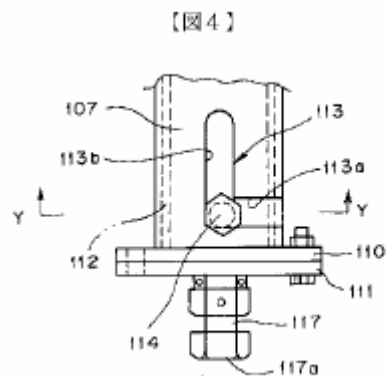
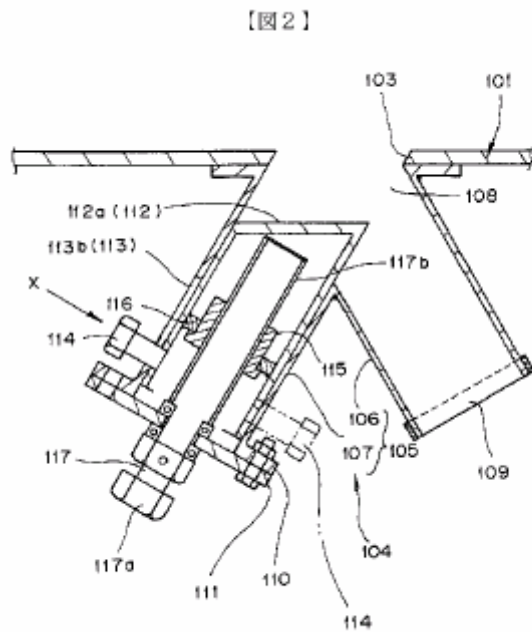




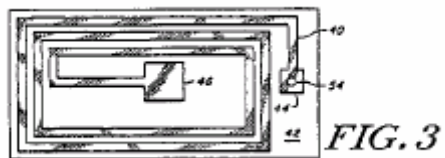
• Fig. 2.3.3-1 (JP2813572 fig.1)



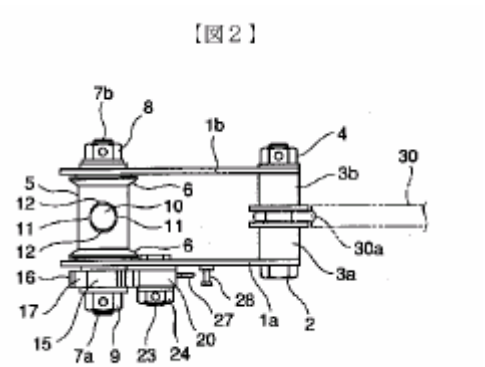
• Fig. 2.4.1-1 (JP2859546 fig. 2,4)



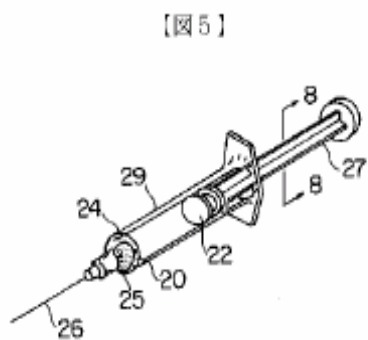
• Fig. 2.5.2-1 (WO8504975 fig. 3)



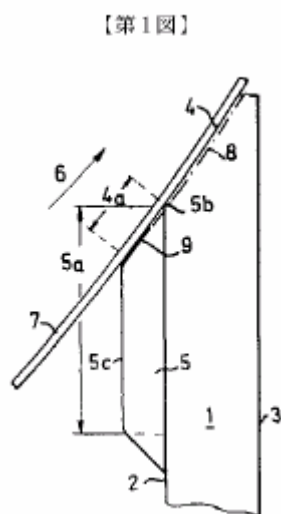
• Fig. 2.5.4-1 (JP3232061 fig. 2)



• Fig. 2.5.5-1 (JP2977339 fig. 5)



• Fig. 2.5.6-1 (H08-11877 fig. 1)



CASE TABLE

(Finding of Condition 1 ~ 5 and Application of D.O.E)

Case No.	Cond. 1	Cond. 2	Cond. 3	Cond. 4	Cond. 5	D.O.E.	Note	PAT. No.
1.1	○	○	○	○	○	【○】		2108611
1.2	○	○	○	○	○	【○】		2662538
1.3	○	○	○	○	○	【○】		1912343
...								...
2.1.1	×	—	×2.3.1	—	—	【×】	cf. 1.1	2108611
2.1.2	×	—	×2.3.2	—	—	【×】		1571849
2.1.3	×	○	—	—	×2.5.1	【×】	cf.2.1.2	1571849
2.1.4	×	×2.2.2	×2.3.4	—	×2.5.7	【×】		2572042
...								...
2.2.1	—	×	—	—	—	【×】		1926400
2.2.2	×2.1.4	×	×2.3.4	—	×2.5.7	【×】		2572042
...								...
2.3.1	×2.1.1	—	×	—	—	【×】	cf. 1.1	2108611
2.3.2	×2.1.2	—	×	—	—	【×】		1571849
2.3.3	—	—	×	—	—	【×】		2813572
2.3.4	×2.1.4	×2.2.2	×	—	×2.5.7	【×】		2572042
...								...
2.4.1	—	—	—	×	—	【×】		2859546
...								...
2.5.1	×2.1.3	○	—	—	×	【×】	cf.2.1.2	1571849
2.5.2	—	—	—	—	×	【×】		1677440
2.5.3	×	—	—	—	×	【×】		2708715
2.5.4	×	—	—	—	×	【×】		3232061
2.5.5	×	—	—	—	×	【×】		2977339
2.5.6	—	—	—	—	×	【×】		2128843
2.5.7	×2.1.4	×2.2.2	×2.3.4	—	×	【×】		2572042