

Summary of the Judgment

I. Main text

1. The defendant shall not manufacture or sell the Defendant's Styluses.
2. The remaining parts of the plaintiff's demand are dismissed with prejudice on the merits.
3. The court costs shall be divided into two equal parts, with the defendant to bear one half and the plaintiff to bear the other half.
4. This judgment may be provisionally enforced as far as paragraph 1 is concerned.

II. Outline of the Case

1. The plaintiff is a holder of the Present Patent for an invention named "Position detector." The defendant manufactures and sells position detectors with the product name "D-Pointer" bearing model code "D-10" (the "Defendant's Position Detector(s)"). The plaintiff asserts that the manufacture and sale of the Defendant's Position Detectors and replaceable styluses (the "Defendant's Stylus(es)") by the defendant constitute indirect infringement of the Present Patent (as set forth in item (i) or (ii), Article 101 of the Patent Act). The plaintiff seeks an injunction pursuant to paragraph (1), Article 100 of the Patent Act to demand that the defendant halt the manufacture and sale of the Defendant's Position Detectors and the Defendant's Styluses.

2. (1) Descriptions of the scope of claims

Claim 1 of the Present Patent is described as follows. The invention claimed in Claim 1 is hereinafter referred to as the "Present Invention."

<Claim 1>

. A position detector comprising:

A. a micro-movable stylus held in a predetermined stable position

in an electrically insulated state; and

a main body including a contact detection circuit connected to the stylus,

5 wherein contact between the stylus and a workpiece is electrically detected as a result of formation of a closed circuit including the contact detection circuit via the workpiece when a contacting portion of the stylus contacts the workpiece, and

B. wherein the contacting portion of the stylus is made of a non-magnetic material containing tungsten carbide and a nickel binder.

10 (2) Fulfillment of the Elements of the Present Invention

Since the Defendant's Position Detector equipped with the standard stainless steel stylus (Form α) fulfills Feature A but does not fulfill "Feature B," the Defendant's Position Detector in Form α does not fall within the technical scope of the Present Invention.

15 On the other hand, the Defendant's Position Detector equipped with the Defendant's Stylus (Form β) falls within the technical scope of the Present Invention since it fulfills all the elements of it.

3. The points at issue in this case are as follows.

20 (1) Whether or not the manufacture and sale of the Defendant's Styluses by the defendant constitute indirect infringement as set forth in item (i), Article 101 of the Patent Act

a) Does the Defendant's Stylus fall under "any product to be used exclusively for the producing of" the Defendant's Position Detector in Form β ?

25 b) Do the manufacture and sale of the Defendant's Styluses fall under "producing, assigning" "any product to be used exclusively for the

producing of the said product”?

(2) Whether or not the manufacture and sale of the Defendant’s Styluses by the defendant constitute indirect infringement as set forth in item (ii), Article 101 of the Patent Act

5 a) Does the Defendant’s Stylus fall under “any product (excluding those widely distributed within Japan) to be used for the producing of” the Defendant’s Position Detector in Form β and a product that is “indispensable for the resolution of the problem” by the Present Invention?

10 b) Do the manufacture and sale of the Defendant’s Styluses fall under an act of “producing, assigning ... any product ... knowing that ... the said product is used for the working of the invention”?

(3) Whether or not the manufacture and sale of the Defendant’s Position Detectors by the defendant constitute indirect infringement as set forth in item (ii), Article 101 of the Patent Act

15 a) Does the Defendant’s Position Detector fall under “any product (excluding those widely distributed within Japan) to be used for the producing of” the Defendant’s Position Detector in Form β and a product that is “indispensable for the resolution of the problem” by the Present Invention?

20 b) Do the manufacture and sale of the Defendant’s Position Detectors fall under an act of “producing, assigning ... any product ... knowing that ... the said product is used for the working of the invention”?

(4) Necessity of injunction against the manufacture and sale

25 III. Summary of the Determinations concerning the Points at Issue

1. Whether or not the manufacture and sale of the Defendant’s Styluses by the

defendant constitute indirect infringement as set forth in item (i), Article 101 of the Patent Act

(1) Item (i), Article 101 of the Patent Act provides, as one of the requirements for establishing indirect infringement, “any product to be used exclusively for the producing of the said product,” which is interpreted as an attempt to expand the scope of infringement of a patent right in such a way as to cover only the acts that are highly likely to induce direct infringement, with a view to ensuring the effect of a patent right within such range that will not unduly enlarge the effect of a patent right. Therefore, in order for the plaintiff to assert that an article at issue falls under “any product to be used exclusively for the producing of the said product” as set forth in item (i), Article 101 of the Patent Act, in a situation where the article is available for use in both forms that is for the working of the patented invention and that is not, the plaintiff must prove that the use of the article in a form not for the working of the patented invention is not an economical, commercial or practical application of that article.

(2) Let us apply the foregoing theory to this case. If a user attaches the Defendant’s Stylus to the Defendant’s Position Detector to make it into the Defendant’s Position Detector in Form β , the user’s act falls under “the producing of” the Defendant’s Position Detector which falls within the technical scope of the Present Invention as an invention of a product.

The Defendant’s Stylus is compatible not only with the Defendant’s Position Detector, but also with the internal contact type position detector manufactured by the defendant, and can be used by attaching it to that type of position detector. The internal contact type position detector equipped with the Defendant’s Stylus does not fall within the technical

scope of the Present Invention, thus the act of using the Defendant's Stylus applied to the internal contact type position detector shall be considered as use in a form not for the working of the Present Invention. In this case, no sufficient evidence is found to determine that the use in such a way is not an economical, commercial or practical application of the Defendant's Stylus. On the contrary, the Defendant's Stylus has excellent abrasion resistance and corrosion resistance, and so, even when it is applied to the internal contact type position detector, an advantage of preventing measurement errors resulting from wear and deformation caused by repeated contact with workpieces can be recognized. Therefore, using the Defendant's Stylus in such a way is an economical, commercial or practical application of it.

Consequently, the Defendant's Stylus does not fall under "any product to be used exclusively for the producing of" the Defendant's Position Detector in Form β . The remaining points asserted as to this issue need not to be determined. In conclusion, the manufacture and sale of the Defendant's Styluses by the defendant do not constitute indirect infringement as set forth in item (i), Article 101 of the Patent Act.

2. Whether or not the manufacture and sale of the Defendant's Styluses by the defendant constitute indirect infringement as set forth in item (ii), Article 101 of the Patent Act

(1) First, attaching the Defendant's Stylus to the Defendant's Position Detector falls under "the producing of" the Defendant's Position Detector in Form β . Unlike versatile products such as screws or nails, it is found that the Defendant's Stylus is a specially designed product compatible exclusively with the position detector manufactured by the defendant.

Therefore, the Defendant's Stylus does not fall under "those widely distributed within Japan." This means that the Defendant's Stylus falls under "any product (excluding those widely distributed within Japan) to be used for the producing of" the Defendant's Position Detector in Form β .

5 Next, the Specification of the Present Patent discloses the following. A conventional position detector had a disadvantage of causing a measurement error in detecting the position of a magnetic workpiece when the stylus is magnetized. In addition, a conventional stylus made of a non-magnetic metal material had a disadvantage that it generally had low
10 hardness, and wear and deformation caused a measurement error. The Present Invention therefore aims at providing position detectors enabling accurate position detection equipped with a stylus which is durable and does not cause a measurement error. As a means for solving this problem, the Present Invention adopts the structure that, in an energized type
15 position detector, a contacting portion of the stylus is made of a non-magnetic material containing tungsten carbide and a nickel binder, by which the Present Invention has the effect of preventing the stylus from being magnetized by opening and closing a contact detection circuit, as well as the effect of preventing deterioration of position detection accuracy
20 due to wear or deformation of the contacting portion and enabling accurate position detection.

 Since the Defendant's Stylus has the same structure as the one described above that is a means to solve the above problem by the Present Invention, it shall be considered to fall under "any product ... to
25 be ... indispensable for the resolution of the problem" by the Present Invention.

As a consequence, the Defendant's Stylus falls under "any product (excluding those widely distributed within Japan) to be used for the producing of" the Defendant's Position Detector in Form β " and a product "indispensable for the resolution of the problem."

5 (2) It is found that on May 1, 2020, the defendant was notified by the plaintiff of the contents of the Present Invention, that the Defendant's Position Detector with the Defendant's Stylus attached falls within the technical scope of the Present Invention and that the manufacture and sale of the Defendant's Styluses constitute infringement of the Plaintiff's
10 Patent Right. The defendant is therefore found to have become aware by that day that the Present Invention is a patented invention and that it is highly probable that the Defendant's Stylus is used for the working of the Present Invention.

In consequence, the manufacture and sale of the Defendant's
15 Styluses by the defendant shall be considered to fall under acts of "producing, assigning ... any product ... knowing that the said product is used for the working of the invention."

(3) Based on the foregoing, the manufacture and sale of the Defendant's Styluses by the defendant shall be considered to constitute indirect
20 infringement as set forth in item (ii), Article 101 of the Patent Act.

3. Whether or not the manufacture and sale of the Defendant's Position Detectors by the defendant constitute indirect infringement as set forth in item (ii), Article 101 of the Patent Act

(1) The plaintiff asserts that, to solve the problem by the Present
25 Invention, both adopting the energized type measurement method of the position detector and making the stylus of a non-magnetic material are

indispensable, then the Defendant's Position Detector is also an article that is "indispensable for the resolution of the problem" by the Present Invention in the composition of the Defendant's Position Detector with the Defendant's Stylus attached (Form β).

5 As stated above, however, the Present Invention aims at providing position detectors enabling accurate position detection equipped with a stylus which is durable and does not cause a measurement error. As a means for solving this problem, the Present Invention adopts "the structure that, in an energized type position detector, a contacting portion of the stylus is made of a non-magnetic material containing tungsten carbide and a nickel binder". On the other hand, the main body of the Defendant's Position Detector is an independent component that differs from the Defendant's Stylus adopting the structure described above. Therefore, the main body shall not be an article "indispensable for the resolution of the problem" by the Present Invention.

10
15 In consequence, the plaintiff's aforementioned assertion is groundless.

(2) Based on the above, the Defendant's Position Detector does not fall under "any product ... to be indispensable for the resolution of the problem" by the Present Invention. The remaining points asserted as to this issue need not to be determined. In conclusion, the manufacture and sale of the Defendant's Position Detectors by the defendant do not constitute indirect infringement as set forth in item (ii), Article 101 of the Patent Act.

4. Necessity of injunction against the manufacture and sale

25 The defendant asserts that, since the Defendant's Stylus has other legal uses than being applied to the Defendant's Position Detector, injunction to

completely prohibit the manufacture and sale of the Defendant's Styluses is excessive, and that there is no need for such injunction.

5 However, the court recognizes the following facts. First, the Defendant's Stylus is sold as a replacement for the stylus attached to the Defendant's Position Detector as standard equipment. Second, while the Defendant's Stylus has other uses than being applied to the Defendant's Position Detector, the Defendant's Stylus is an article indispensable for solving the problem by the Present Invention, and present circumstances show it is highly probable that acts such as assigning the Defendant's Styluses may induce infringement
10 of the Plaintiff's Patent Right. In light of these facts, the necessity of injunction against the manufacture and sale of the Defendant's Styluses shall be recognized for the purpose of stopping and preventing infringement of the Plaintiff's Patent Right.

Therefore, the defendant's aforementioned assertion shall not be admitted.

15 5. Conclusion

Based on all of the foregoing, the plaintiff's claim has a ground and shall be upheld to the extent of seeking the injunction against the manufacture and sale of the Defendant's Styluses. The remaining parts of the plaintiff's claim shall be dismissed as groundless. Therefore, the court renders a judgment as
20 indicated in the main text.