

## Advisory Opinion

Advisory Opinion No. 2015-600015

Tokyo, Japan

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The case of the advisory opinion on the technical scope of a patent invention for Japanese Patent No. 5025709 between the parties above is stated and concluded as follows.

### Conclusion

A soft electric conductor (a thin conductive cushion) shown in a drawing A does not belong to the technical scope of the invention in Japanese Patent No. 5025709.

### Reason

#### No. 1 Gist of the demand

The gist of the request of the advisory opinion is to demand the advisory opinion that the soft electric conductor (the thin conductive cushion, hereinafter referred to as "Article A") shown in the drawing A belongs to the technical scope of the invention in Japanese Patent No. 5025709.

## No. 2 The patent invention

The patent invention relating to the request of the advisory opinion of the case is the invention relating to Claim 1 of Japanese Patent No. 5025709 (hereinafter referred to as a "patent invention"), and, according to descriptions of Japanese Patent No. 5025709 (Evidence A No. 1, hereinafter referred to as "specification"), is acknowledged as described in Claim 1 of the scope of claims for patent. The patent invention relating to the request of the advisory opinion of the case will be separately described as follows, by adding codes to the constituent components of the same.

"A soft electric conductor (A) which is equipped with a rectangular parallelepiped cushion material formed with two parallel surfaces, having elasticity, and with which conductors are respectively contacted, (B) and which electrically connects the conductors contacted on the two surfaces by being compressed so as to bring the two surfaces close to each other, (E) comprising: (C) double-sided adhesive tapes respectively stuck on the two surfaces; (D) and a conductive film which is stuck to cover both of the whole of one surface of the two surfaces and one side surface of side surfaces connecting the two surfaces, and to cover only the one side surface side on the other surface continuously from the one side surface, so as to expose the double-sided adhesive tape, without covering the other side surface side different from the one side surface on the other surface different from the one surface of the two surfaces.

Here, concerning "double-sided adhesive tapes respectively stuck on the two surfaces" of the constituent component (C), according to descriptions "as adhesive layers (the double-sided adhesive tapes 14a and 14b) are in only partial contact with the conductors 16 (both side surfaces 12c and 12d have no adhesive layer)" (Paragraph [0023]) and "the double-sided adhesive tapes 14a and 14b are separated bodies, so that kinds of that can be changed" (the same Paragraph) in the specification, it is understood that the constituent component (C) is "double-sided adhesive tapes respectively stuck only on the two surfaces."

## No. 3 Article A

1. In the advisory opinion request, as "explanations of Article A" (page 4, line 18 to page 5, line 20), the following matters are described. Also, underlines are eliminated.

"Explanations of Article A

Article A 'a soft electric conductor (a conductive cushion)' has a configuration as shown in the attached drawing A. As the drawing A, a drawing attached to the end of Evidence A No. 4 and Evidence A No. 8 mentioned in the 'necessity of the request of the advisory opinion' described above for specifying a product of a demandee is used. In the drawing A, a side view is at a center in a vertical direction, a plane view is at an upper part, a bottom view is at a lower part, and an encircled part in the side view at the center is indicated on a right side as an enlarged view. The configuration of Article A is described as follows, on the basis of the configuration of the patent invention mentioned above (hereinafter, terms indicated in " are terms in the drawing A).

'(E) A soft electric conductor ('a conductive cushion') (A) which is equipped with a rectangular parallelepiped cushion material ('a polyurethane foam') formed with two parallel surfaces (upper and lower surfaces in the side view), having elasticity, and with which conductors are respectively contacted, (B) and which electrically connects the conductors contacted on the two surfaces by being compressed on the two surfaces so as to bring the two surfaces close to each other, (C) wherein adhesive layers of 'conductive cloth tapes' equipped with the adhesive layers are respectively stuck on the two surfaces, instead of double-sided adhesive tapes respectively stuck on the two surfaces; (D1) both of the whole of one surface (the upper surface in the side view) of the two surfaces and one side surface (the right side surface in the side view) of side surfaces connecting the two surfaces are covered by 'the conductive cloth tape' cover; (D2) and only the one side surface (the right side surface) side on the other surface (the lower surface) is covered continuously from the one side surface (the right side surface) without covering the other side surface (the left side surface) different from the one side surface (the right surface) on the other surface (the lower surface in the side view above) different from the one surface (the upper surface) of the two surfaces, and a double-sided adhesive tape ('a double-sided tape') is stuck on a part which is not covered by 'the conductive cloth tape' on the other surface (the lower surface)."

2. In the drawing A, the following matters are described and illustrated.

(1) The title is described as "a thin conductive cushion."

(2) The following list is described as components.

## #1 構成

#2 #3	番号	名 称	素 材
	1	導電性布テープ	ポリエステル/銅+ニッケル/アクリル系粘着剤
	2	発泡体	ポリウレタン
	3	両面テープ	アクリル系粘着剤
	4	セパレータ	PET

## #1 Configuration

### #2 No. Name Material

### #3

1. Conductive cloth tape Polyester/copper + nickel/acrylic adhesive
2. Foam Polyurethane
3. Double-sided tape Acrylic adhesive
4. Separator PET

(3) In the side view and the enlarged view, it is indicated that the upper surface and the lower surface of the foam are parallel with each other.

(4) When viewed from the plane view, the side view, and the bottom view, it is indicated that the foam has a rectangular parallelepiped shape.

(5) In the plane view, it is indicated that the conductive cloth tape covers the whole of the upper surface of the thin conductive cushion.

(6) It is described that the conductive cloth tape is composed of polyester, copper and nickel, and an acrylic adhesive, and in the enlarged view, it is indicated that the conductive cloth tape is stuck to cover the upper surface, the right side surface, and the lower surface of the foam. Also, it is indicated that the double-sided tape is stuck on the lower surface of the foam continuously from an end of the conductive cloth tape.

(7) In the side view, it is indicated that upper and lower ends on the right side surface of the thin conductive cushion are rounded, but on the other hand, upper and lower ends on the left side surface are not rounded. By combining with the enlarged view, it is indicated that the conductive cloth tape does not cover the left side surface of the foam.

(8) In the bottom view, it is indicated that generally a right half of the lower surface of the thin conductive cushion is covered by the conductive cloth tape, and generally a left

half is covered by the double-sided tape.

(9) According to (5) to (8) above, it can be said that the conductive cloth tape is stuck to cover the whole of the upper surface of the foam, the right side surface, and generally the right half of the lower surface.

(10) On the basis of the fact that the whole of the upper surface of the thin conductive cushion is covered by the conductive cloth tape and generally the right half of the lower surface is covered by the conductive cloth tape, and the fact that the foam is polyurethane, it is obvious that the thin conductive cushion is compressed so as to bring the upper and lower surface on which the conductors are in contact, close to each other, thereby electrically connecting the conductors contacted on the upper and lower surfaces.

3. Considering the matters of 1 and 2 above, it is acknowledged that the configuration of Article A is described as follows, according to the patent invention.

"A thin conductive cushion which is equipped with a rectangular parallelepiped foam made from polyurethane, formed with parallel upper and lower surfaces, and on which conductors are respectively contacted; and which electrically connects the conductors contacted on the upper and lower surfaces by being compressed so as to bring the upper and lower surfaces close to each other, comprising: a conductive cloth tape of which one surface is made from an acrylic adhesive, and which is stuck to cover both of the whole of the upper surface of the upper and lower surfaces and a right side surface connecting the upper and lower surfaces, and to cover only the generally right half on the lower surface continuously from the right side surface, without covering a left side surface side different from the right side surface on the lower surface different from the upper surface of the upper and lower surfaces; and a double-sided tape stuck on generally the left half on the lower surface."

#### No. 4 Comparison/judgment

Comparison and determination are made as follows as to whether or not Article A satisfies the constituent components (A) to (E) relating to the patent invention and separately described.

##### 1. Sufficiency of the constituent component (A)

In the comparison between the patent invention and Article A, "parallel upper and lower surfaces" of the latter are "two parallel surfaces" of the former. "A rectangular parallelepiped foam made from polyurethane" of the latter configures the thin conductive cushion, and thus obviously has elasticity. Therefore, it can be said that "the rectangular parallelepiped foam made from polyurethane" of the latter is "a rectangular parallelepiped cushion material having elasticity" of the former.

Therefore, Article A satisfies the constituent component (A) of the patent invention.

## 2. Sufficiency of the constituent components (B) and (E)

In the comparison between the patent invention and Article A, "a thin conductive cushion" of the latter is compressed so as to bring the upper and lower surfaces close to each other, thereby electrically connecting the conductors contacting on the upper and lower surfaces, so that it can be said that "the thin conductive cushion" is "a soft electric conductor" of the former.

Therefore, Article A satisfies the constituent components (B) and (E) of the patent invention.

## 3. Sufficiency of the constituent component (C)

In the comparison between the patent invention and Article A, in the former, the double-sided tapes are respectively stuck only on the two upper and lower surfaces, whereas in the latter, the double-sided tape is stuck on generally the left half of the lower surface, but is not stuck on the upper surface and generally the right half of the lower surface, and on the upper surface and generally the right half of the lower surface, the conductive cloth tape is stuck by an acrylic adhesive. The former and the latter are different.

Therefore, Article A does not satisfy the constituent component (C) of the patent invention.

Furthermore, the demandant also acknowledges that Article A does not satisfy the constituent component (C) of the patent invention in the advisory opinion request (a list of "Technical comparison between the patent invention and Article A" on page 6, and page 7, line 8 from the bottom of the page to page 8, line 1).

## 4. Sufficiency of the constituent component (D)

In the comparison between the patent invention and Article A, "the upper surface of the upper and lower surfaces" of the latter is "one surface of the two surfaces"

of the former, "the right side surface connecting the upper and lower surfaces" of the latter is "one side surface of side surfaces connecting the two surfaces" of the former, "the lower surface" of the latter is "the other surface" of the former, "the left side surface of the latter is " the other side surface" of the former, "generally the left half on the lower surface" of the latter is "the other side surface side different from the one side surface on the other surface" of the former, and "generally the right half on the lower surface" of the latter is "the one side surface side on the other surface" of the former.

Furthermore, the fact that "the conductive cloth tape" "does not cover the left surface side different from the right side surface on the lower surface" and the double-sided tape "is stuck on generally the left half on the lower surface" in the latter refers to the fact that on "the other side surface side different from the one side surface on the other surface," "the double-sided adhesive tape is exposed" in the former.

On the other hand, in the latter, "the conductive cloth tape" "is stuck to" "cover both of the whole of the upper surface of the upper and lower surfaces and the right side surface connecting the upper and lower surfaces," whereas in the former, "the conductive film" "is stuck to" "cover both of the whole of one surface of the two surfaces and one side surface of side surfaces connecting the two surfaces." Therefore, the two correspond at a point that those are stuck to cover both of the whole of one surface of the two surfaces and one side surface of the side surfaces connecting the two surfaces, but in the latter, "the conductive cloth tape" is stuck to cover, whereas in the former, "the conductive film" is stuck to cover.

Furthermore, "the conductive cloth tape stuck to cover only generally the right half on the lower surface continuously from the right side surface" of the latter and "a conductive film stuck to cover only the one side surface side on the other surface continuously from the one side surface" correspond at a point that the two are stuck to cover only the one side surface side on the other surface continuously from the one side surface, but in the latter, "the conductive cloth tape" is stuck to cover, whereas in the former, "the conductive film" is stuck to cover.

Then, "the conductive cloth tape" of the latter and "the conductive film" of the former are examined.

On the basis of the fact that "the conductive cloth tape" of the latter is made from "copper and nickel," one surface of the conductive cloth tape is made from

"copper and nickel," whereas "the conductive film" of the former is made from a conductive thin film as a whole, according to descriptions "a conductive film (a conductive thin film) 16" (Paragraph [0020]) of the specifications.

Then, "copper and nickel" of "the conductive cloth tape" of the latter corresponds to "the conductive film" of the former, so that, to the extent above, there is no difference between the fact that "the conductive cloth tape" of the latter is stuck to cover and the fact that "the conductive film" of the former is stuck to cover.

However, concerning the fact that "the conductive cloth tape" of the latter is stuck to cover "a right side surface connecting the upper and lower surfaces," "the conductive cloth tape" of which "one surface is made from an acrylic adhesive," so that if stuck to cover the right side surface of the foam, "the conductive cloth tape" is adhered to the right side surface of the foam. On the other hand, concerning the fact that "the conductive film" of the former is stuck to cover "one side surface of side surfaces connecting the two surfaces," as described in "No. 2," it is understood that "the double-sided tapes" are respectively stuck only on the two surfaces, so "the conductive film" of the former is not adhered to the one side surface of the cushion material, even if stuck to cover "one side surface of side surfaces connecting the two surfaces."

Then, the fact that "the conductive cloth tape" of the latter is stuck to cover "the right side surface connecting the upper and lower surfaces" differs from the fact that "the conductive film" of the former is stuck to cover "one side surface of side surfaces connecting the two surfaces," in a point that the conductive film is adhered to the one side surface.

Therefore, Article A does not satisfy the constituent component (D) of the patent invention.

## 5. Allegation of equivalence

(1) The demandant alleges "the different features satisfy requirements of a doctrine of equivalents given in 'the case of infinite sliding ball spline bearing' given a decision by the Supreme Court on Feb. 24, 1998, so that Article A properly belongs to the technical scope of the patent invention" (page 8, lines 2-5 of the advisory opinion request).

Then, of the constituent components of the patent invention and the configuration of Article A, we will examine whether or not configurations relating to the different features above (the constituent components (C) and (D)) are equivalent.

The requirements for establishing equivalence given in a court decision 1994 (E)



No. 1083 (rendition of decision on Feb. 24, 1998) at the Supreme Court are as follows.

Even if a part different from a target product exists in the configuration described in the scope of claims for patent, it is understood that the object product and the like satisfying all of the following requirements are equivalent to the configuration described in the scope of claims for patent, so that they belong to the technical scope of the patent invention.

- Requirement 1. Different parts are not essential parts of the patent invention.
- Requirement 2. A purpose of the patent invention can be attained, and the same action effect is taken.
- Requirement 3. A party can easily think of replacing the different parts above during manufacturing of the object product and the like.
- Requirement 4. The object product and the like are not the same as a well-known technology at the time of application or cannot be easily inferred by traders.
- Requirement 5. In an application procedure of the patent invention, there is no special reason such that the object product and the like are intentionally excluded from the scope of claims for patent, and the like.

(2) First, we will examine whether or not, of the requirements for establishing equivalence given by the court decision, "Requirement 5" is satisfied.

In the written opinion (Evidence A No. 5) submitted during the application procedure of the patent invention, the paragraph of "(b) comparison between the invention relating to Claim 1 of the present application and the invention described in the cited document 1 (note for the body : Evidence A No. 9)" (page 2, line 10) describes "in a manufacturing process, the invention described in the cited document 1 has an inner adhesive layer to a conductive material (Claim 2 and Claim 4) or has no inner adhesive layer (Claim 3), so that the invention described in the cited document 1 is quite different from the invention relating to Claim 1 of the present application which is provided with double-sided adhesive tapes on the two surfaces." (page 2, the lowest line to page 3, line 2). According to this description, the demandant alleges that being provided with "double-sided adhesive tapes" differs from "the inner adhesive layer" in the cited document 1.

It is obvious that "the inner adhesive layer" of the cited document 1 is provided on the inner side of "a conductive material" and sticks "the conductive material" to "a core material," so that it can be understood that the demandant made an allegation while intentionally excluding such sticking by "the inner adhesive layer" provided on the inner

side of "the conductive material" from sticking by "the double-sided adhesive tape" of the patent invention.

Then, considering other allegations by the demandant in the written opinion, the demandant alleges "according to the invention relating to Claim 1 of the present application, on the other surface, the double-sided adhesive tape is exposed on the other side surface side, and the one side surface side is covered by the conductive film. By this structure, on the other surface, while carrying out sufficient fixing and positioning on a member required to ensure conduction by the exposed double-sided adhesive tape (for example, a conductor 18, hereinafter, referred as to "a conductive target"), the conduction with the conductive target can be ensured by the conductive film, hence a remarkable effect peculiar to the invention of the present application is taken" (page 2, lines 4 to 9), "in the invention relating to Claim 1 of the present application, on the other surface, the double-sided adhesive tape is exposed without floating on the other side surface side, and when placed on the conductive target, the exposed double-sided adhesive tape is certainly contacted with the conductive target to perform fixing" (page 2, lines 22 to 24), "in the invention relating to Claim 1 of the present application, the double-sided adhesive tape has a structure in which only one side is covered by the conductive film, and there is only one floating part. Therefore, sufficient fixing to the conductive target can be performed by the double-sided adhesive tape" (page 2, lines 33 to 35), and "in the invention relating to Claim 1 of the present application, the other side surface is not provided with the conductive film, and namely opens at one-end, thereby providing compression easiness (a compression property). Furthermore, the double-sided adhesive tapes are not provided on both side surfaces, so that an excellent effect such as sufficient restorability to compression is equipped to make the conductive film tightly contact with the upper and lower conductive targets (followability) and enable stable conduction, is shown" (page 2, lines 42 to 46). The demandant devotedly alleges that the conductive film is not adhered on the side surface by using "the double-sided adhesive tape," thereby taking the effect of the patent invention, and it is not contradictory to the understanding above that the demandant consciously excludes sticking by "the inner adhesive layer" provided on the inner side of "the conductive material."

The demandant mentions that "the double-sided tape" is included in "a fixing adhesive layer 40" of the cited document 1, in the advisory opinion request (page 11, line 18 to page 12, line 13), and it is obviously indicated that the cited document 1 discloses adhesion by "the double-sided adhesive tape" in a notice of reasons for refusal

(Evidence A No. 3), and alleges that descriptions relating to the double-sided adhesive tape in the written opinion are caused by a mistake.

However, "the fixing adhesive layer 40" of the cited document 1 is for adhering the soft electric conductor 30 to the conductor 4, and is described as an adhesive layer distinguished from "an inner adhesive layer 36" for sticking "the conductive material 34" to "the core material 32" in the cited document 1. Furthermore, the above indication of the notice of reasons for refusal is made by the examiner of the original examination, not by the demandant, so that the above allegation that the descriptions relating to the double-sided adhesive tape in the written opinion are caused by a mistake cannot be accepted.

As described above, it can be said that the demandant consciously excludes sticking by "the inner adhesive layer" provided on the inner side of "the conductive material" when sticking "the conductive material" to "the core material."

Therefore, the constituent components of the patent invention and the configuration of Article A do not satisfy "Requirement 5" relating to the requirements for establishing equivalence.

(3) In addition, we will examine whether or not, of the requirements for establishing equivalence given by the court decision, "Requirement 1" is satisfied.

"The double-sided adhesive tapes" of the patent invention are respectively stuck only on the two parallel surfaces of the cushion material (the constituent component (C)), so that "the conductive film" (the constituent component (D)) covering the whole of one surface, one side surface, and only one side surface side on the other surface continuously from the one side surface is stuck only on the whole of the one surface and the one side surface side on the other side. In this regard, the specifications describe "adhesive layers (the double-sided adhesive tapes 14a and 14b) are only partially contacted with the conductors 16 (both side surfaces 12c and 12d have no adhesive layer)" (Paragraph [0023]).

According to this description, it can be said that "the double-sided adhesive tape" of the patent invention is equipped with a function for sticking "the conductive film" to a specified position (surface), and is not adhered on the side surface.

Therefore, "the double-sided adhesive tape" of the patent invention is different from "a conductive cloth tape of which one surface is made from an acrylic adhesive" of Article A, and is equipped with the function above, so that "the double-sided adhesive tape" is an essential part of the patent invention.

Therefore, the constituent components of the patent invention and the configuration of Article A do not satisfy "Requirement 1" relating to the requirements for establishing equivalence.

(4) Hence, as the constituent components of the patent invention and the configuration of Article A do not satisfy, of the requirements for establishing equivalence, "Requirement 1" and "Requirement 5," and thus cannot be said to be equivalent without examining other requirements.

#### 6 Summary

As described above, Article A does not satisfy the constituent components (C) and (D) of the patent invention, and cannot be said to be equivalent, so that it cannot be said that Article A belongs to the technical scope of the patent invention.

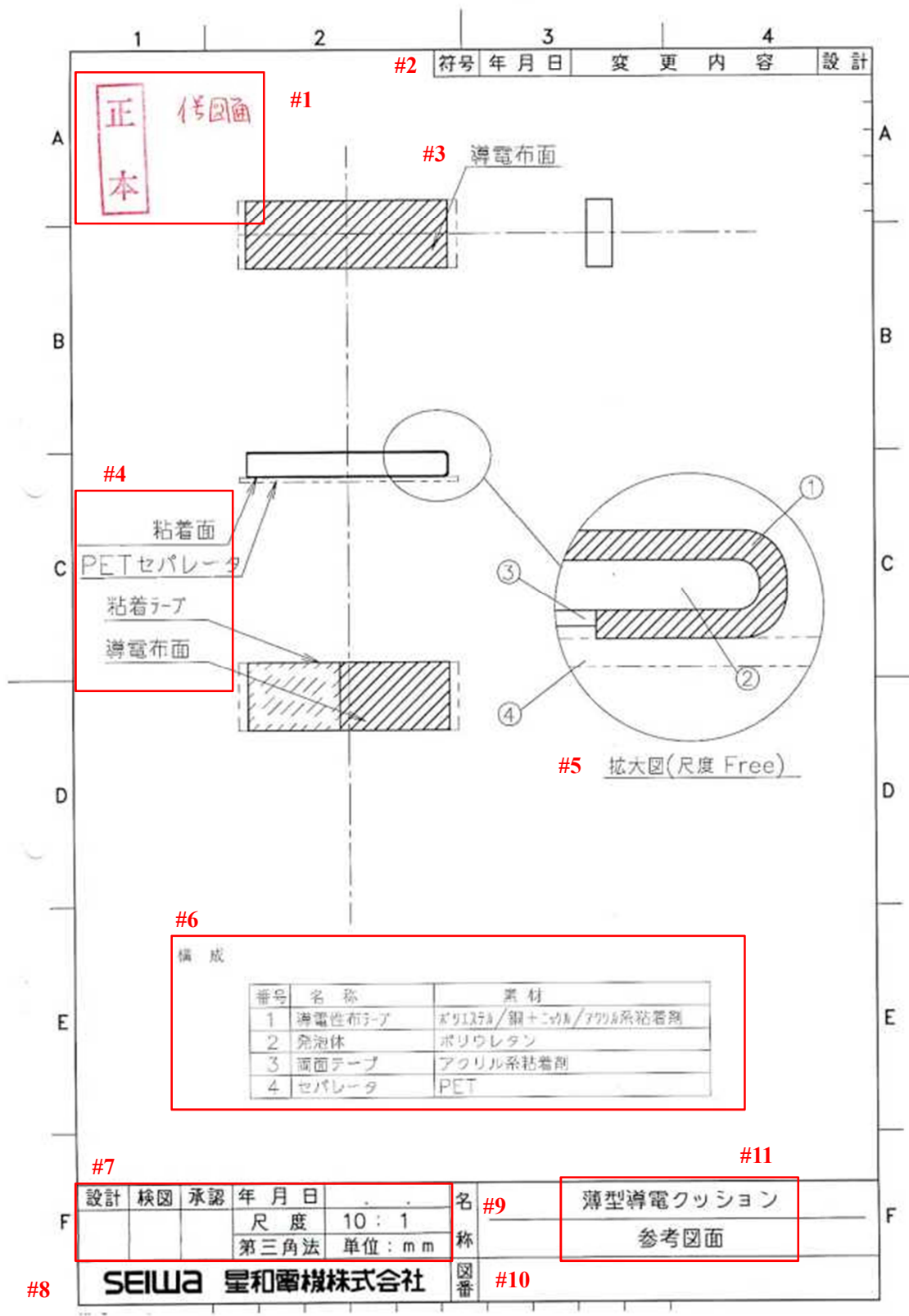
#### No. 5 Conclusion

Therefore, Article A does not belong to the technical scope of the patent invention.

Therefore, the advisory opinion shall be made as described in the conclusion.

August 27, 2015

Chief administrative judge:	MORIKAWA, Mototsugu
Administrative judge:	TOMIOKA, Kazuhito
Administrative judge:	OUCHI, Toshihiko



- #1 Original The Drawings of Article A
- #2 Code Date Contents of change Design
- #3 Conductive cloth surface
- #4 Adhesive surface  
PET separator  
Adhesive tape

- Conductive cloth surface
- #5 Enlarged view (Scale Free)
- #6 Components
- | No. | Name                  | Material                                   |
|-----|-----------------------|--|
| 1   | Conductive cloth tape | Polyester/copper + nickel/acrylic adhesive |
| 2   | Foam                  | Polyurethane                               |
| 3   | Double-sided tape     | Acrylic adhesive                           |
| 4   | Separator             | PET  |
- #7 Design Drawing check Approval Date
- Scale 10:1
- Third angle projection unit : mm
- #8 SEIWA SEIWA ELECTRIC MFG CO. Ltd
- #9 Title
- #10 Number of drawings
- #11 THIN CONDUCTIVE CUSHION
- Reference drawing