

Advisory opinion

Advisory opinion No. 2016-600022

Hyogo, Japan

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The advisory opinion on the technical scope of a patent invention for Japanese Patent No. 3955432 between the parties above is stated and concluded as follows.

Conclusion

The eye wear of structures indicated in Reference Drawing does not fall within the technical scope of the invention in Japanese Patent No. 3955432.

Reason

No. 1 Outline of the case

1 History of the procedures

Japanese Patent No. 3955432 (hereinafter, referred to as the "Patent") was filed on October 2, 2000 as Japanese Patent Application No. 2000-302262, a notice of reasons for refusal (hereinafter, referred to as the "notice of reasons for refusal") was issued on January 25, 2007, a written amendment (hereinafter, referred to as the

"Amendment") was submitted on March 19, 2007, the examiner's decision that the invention should be granted patent was issued on April 10, 2007, and the establishment of patent right was registered on May 11, 2007.

Regarding the Patent, an advisory opinion (Advisory opinion No. 2016-600022) designating the patentee as the demandee was requested from the demandant PULSE CORPORATION, on May 31, 2016, and then, a written reply was submitted from the demandee on August 18, 2016.

The following documents serving as evidence are attached to the written reply.

B1: Japanese Unexamined Patent Application Publication No. 2003-261826

B2: Japanese Unexamined Patent Application Publication No. 1989-295652

2 Object of the demand

The object of the request for the advisory opinion is to demand the advisory opinion that the structure (hereinafter, referred to as "Article A") indicated in Reference Drawing does not fall within the technical scope of the invention of Claim 1 of Patent No. 3955432 (hereinafter, referred to as the "patent invention") indicated in the scope of claims for patent.

No. 2 The patent invention

The patent invention is acknowledged as described in Claim 1 of the scope of claims for patent of the Patent, and constituent components thereof are separately described as follows (hereinafter, referred to as the "constituent component A" and the like).

"(F) An eye wear, comprising:

(A) a pair of lenses; and a pair of frames,

(B) wherein the lenses are mounted in the respective frames,

(C) a pair of connectors consisting solely of magnets is connected to respective inner ends of the frames so as to expose end surfaces of the magnets, and temples are connected to respective outer ends of the frames,

(D) rear ends of the temples are connected by a strap having sufficient hardness and elasticity to retain its shape, and flexibility capable of bending, and

(E) when putting on and taking off of the eye wear is carried out by connecting or releasing the inner ends of the frames, with the pair of the connectors consisting solely of the magnets, the lenses can be accurately positioned in front of the eyes through the

use of the strap with its shape retained, and the eye wear can be hung around a neck when not being worn."

No. 3 Article A

Article A is as described in Appendix "(4) Detailed description of Article A" and "Reference Drawing."

Also, in the description of "(4-2) Configurations of Article A" of "(4) Detailed description of Article A," "sufficient stiffness to retain its shape" of a strap is used for the same meaning as "sufficient hardness to retain its shape," and "a neck (クビ)" around which the eye wear is hung when not being worn, means "a neck (首)." "

Article A will be separately described as follows by making it correspond to constituent components of the patent invention (hereinafter referred to as "configuration a" and the like).

"(f) An eyewear, comprising:

- (a) a pair of lenses (1); and a pair of frames (2),
- (b) wherein the lenses (1) are mounted in the respective frames (2),
- (c) two magnets (3) are connected in recessed portions (2C) provided at respective inner ends (2A) of the frames (2) so as to make end surfaces of the respective magnets (3) lower than end surfaces of the respective inner ends (2A), temples (5) are connected to respective outer ends (2B) of the frames (2),
- (c-2) coating films (4) fill the respective recessed portions (2C), and cover the end surfaces of the respective magnets (3) and the end surfaces of the respective inner ends (2A) of the respective frames (2), surfaces of the coating films (4) are generally flat, the thickness of the coating films (4) is about 1 mm on the end surfaces of the respective magnets (3),
- (d) rear ends of the temples (5) are connected by a strap (6) having sufficient hardness and elasticity to retain its shape, and flexibility capable of bending, and
- (e) when putting on and taking off of the eye wear is carried out by connecting or releasing the inner ends (2A) of the respective frames (2), with the two magnets (3), the lenses (1) can be accurately positioned in front of the eyes through the use of the strap (6) with its shape retained, and the eye wear can be hung around a neck when not being worn."

No. 4 Allegations of the parties

1 The demandant's allegation

(1) The demandant, in "(5-1) the corresponding features of the patent invention and Article A" and "(5-2) the different features of the patent invention and Article A" of the request for advisory opinion, alleges that each configuration of Article A satisfies the constituent components A, B, D, E, and F of the patent invention, and the point "a pair of connectors consisting solely of magnets is connected to respective inner ends of the frames, and temples are connected to respective outer ends of the frames, respectively" of the constituent component C, whereas the configuration c-2 of Article A is provided with coating films, so that the demandant alleges that each configuration of Article A does not satisfy the point "a pair of connectors is connected to respective inner ends of the frame so as to expose end surfaces of the magnets" of the constituent component C of the patent invention.

(2) The demandant, in "(5-3) Interpretation of the different features" of the request for advisory opinion, alleges mainly the following three points, regarding Article A and "a pair of connectors is connected to respective inner ends of the frame so as to expose end surfaces of the magnets" of the constituent component C of the patent invention.

A In Article A, so as to avoid the exposure of the end surfaces of the respective magnets as in the patent invention, the coating films covering the end surfaces of the respective magnets are deliberately provided. The coating films prevent oxidation or corrosion of the end surfaces caused when the end surfaces are scratched due to repeated connection and release. Then, the thickness of the coating films is about 1 mm on the end surfaces of the respective magnets, so as to sufficiently obtain attracting force between the magnets while preventing the oxidation or corrosion of the end surfaces of the respective magnets.

B If coatings are provided on "the magnets" themselves in advance, the coatings are very thin. Furthermore, if the end surfaces of "the magnets" are on the same surface as the end surfaces of the inner ends of the frames, or at positions higher than the end surfaces of the inner ends of the frames, end edges on the end surfaces of "the magnets" easily receive impact from the outside. Therefore, the coatings provided on "the magnets" themselves in advance cannot be expected to have an effect which can be obtained by the coating films of Article A.

C Also, if the coatings are provided on "the magnets" themselves in advance, they are provided on "the magnets" only, and do not cover the end surfaces of the inner ends of the respective frames with the end surfaces of the respective magnets, so that an effect of preventing the slipping-off of the magnets is not provided. Therefore, the coatings provided on "the magnets" themselves in advance of the constituent component C of the patent invention do not fall under the coating films.

(3) The demandant, furthermore in "(6) Explanation that Article A does not fall within the technical scope of the patent invention," alleges the following three points as evidence that Article A is not within the scope of equivalents to the patent invention in view of the doctrine of equivalents.

A First requirement

Although the coating films of Article A do not satisfy the point "a pair of connectors is connected to respective inner ends of the frames so as to expose end surfaces of the magnets" of the constituent component C of the patent invention, the connectors of the patent invention are essential parts of the patent invention.

B Third requirement

It is common sense not to put anything between two magnets when making the magnets stick together, and it cannot be easily conceived by a person skilled in the art that the coating films are provided on the end surfaces of the magnets which is to be exposed in the patent invention.

C Fifth requirement

The demandee submitted an amendment to add the description "a pair of connectors consisting solely of magnets is connected to respective inner ends of the frames so as to expose end surfaces of the magnets" by written amendment for clarifying the different features from the registered utility model gazette No. 3019999, and "the end surfaces of the magnets are covered by any member so as not to expose the end surfaces of the magnets" is a constitution which was consciously excluded by the demandee.

2 The demandee's allegation

The demandee, in the written reply to the request for advisory opinion, alleges the following points and demands the advisory opinion that "Article A ' eye wear ' shown in drawings and descriptions of Article A in the request for advisory opinion falls within the technical scope of Patent No. 3955432."

(1) Regarding the corresponding features and different features of the patent invention and Article A alleged by the demandant, the corresponding features are acknowledged, whereas Article A is provided with the coating films, so that the demandee disputes on the point which does not satisfy "a pair of connectors is connected to respective inner ends of the frames so as to expose end surfaces of the magnets" of the constituent component C of the patent invention.

(2) "The magnets" used for eye wear of the patent invention can easily get rusty as they are, and so as to prevent that, it has been common practice to provide antioxidant coatings on the surfaces of the magnets. Therefore, even if the antioxidant coatings are provided on the surfaces of the magnets, it can be said to satisfy "expose end surfaces of the magnets" of the constituent component C of the patent invention. Even though coating films provided for preventing oxidation on the surfaces of the magnets at the time of manufacturing of Article A are different in forming process from the antioxidant coatings provided on the surfaces of the magnets, they are common in a point provided for preventing oxidation, and satisfy "expose end surfaces of the magnets" in the constituent component C.

(3) Regarding "an effect of preventing the slipping-off of the magnets" alleged by the demandant, in Article A, this is an operation and effect which can be achieved not only by satisfying the constituent components of the patent invention but also by providing additional components, and does not become a reason why Article A does not fall within the technical scope of the patent invention.

(4) Regarding the thickness of the coating films, although it is described as "about 1 mm", the thickness cannot become a reason why Article A does not fall within the technical scope of the patent invention. Also, "about 1 mm" does not clarify significant digits, and includes the thickness of a range of 0.5-1.4 mm, so that it cannot be said that Article A is sufficiently specified.

No. 5 Comparison / Judgment

1 Regarding whether or not each constituent component is satisfied

(1) Regarding whether or not constituent components A, B, D, and F are satisfied

Configurations a, b, d, and f of Article A respectively satisfy the constituent components A, B, D, and F of the patent invention.

(2) Regarding whether or not a part "a pair of connectors consisting solely of magnets" "is attached to respective inner ends of the frames, and temples are connected to respective outer ends of the frames, respectively" of the constituent components E and C is satisfied

"The two magnets (3)" of Article A are attached "in recessed portions (2C) provided at respective inner ends (2A) of the frames (2)," and "connecting or releasing the inner ends (2A) of the respective frames (2), with the two magnets (3)." Therefore, "the two magnets (3)" of Article A correspond to "a pair of connectors consisting solely of magnets" of the patent invention.

Then, "the inner ends (2A) of the frames (2)" of Article A correspond to "inner ends of the frames" of the patent invention. Therefore, the configuration e of Article A satisfies the constituent component E of the patent invention.

Furthermore, "respective outer ends (2B) of the frames (2)" of Article A correspond to "respective outer ends of the frames" of the patent invention. Then, configurations c and c-2 of Article A satisfy "a pair of connectors consisting solely of magnets" "is connected to respective inner ends of the frames, and temples are connected to respective outer ends of the frames, respectively" of the constituent component C of the patent invention.

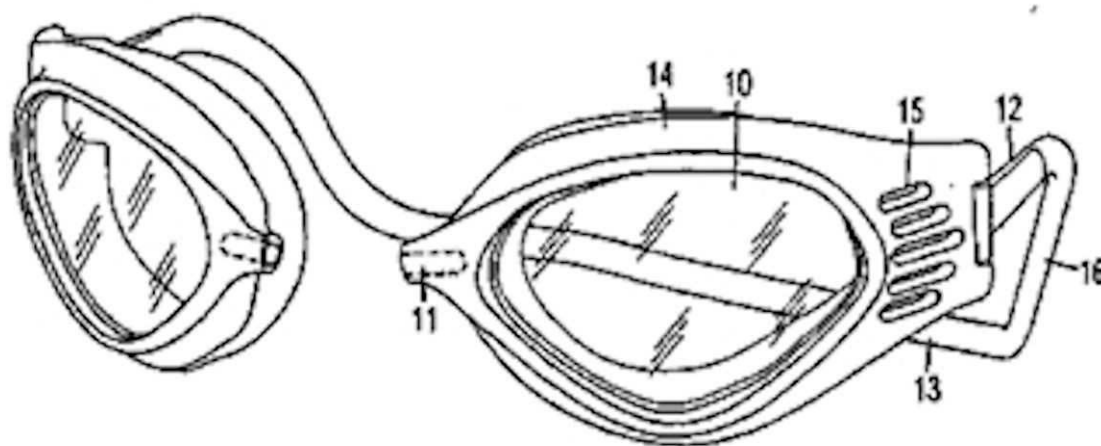
Also, regarding whether or not (1) and (2) above are satisfied, there is no dispute between the parties.

(3) Regarding whether or not a part "so as to expose end surfaces of the magnets" of the constituent component C is satisfied

A Regarding the constituent component C, the patent invention "exposes end surfaces of the magnets," whereas, in Article A, "coating films (4)... cover the end surfaces of the respective magnets (3)... "Then, so as to interpret the meaning of "expose" described in

the scope of claims, considering descriptions in the specification and drawings attached to the application, in the specification, there is no description of a special meaning about "expose," and moreover, there is no description of a term "expose" in the specification (the term was introduced in the scope of claims by the Amendment). However, in Fig. 3 of the Patent, it can be seen that connectors 11 are bare without covering.

[Fig. 3]



Therefore, it is reasonable to understand that "the exposure" of the end surfaces of the magnets means "being revealed without any covering." Also, such an interpretation is consistent with "being revealed, and bared." (Iwanami Shoten, Kojien, 6th edition) which is the general meaning of "exposure."

B In Article A, "two magnets (3)" "are connected in recessed portions (2C) provided at respective inner ends (2A) of the frames (2) so as to make end surfaces of the respective magnets (3) lower than end surfaces of the respective inner ends (2A)," "coating films (4) cover the end surfaces of the respective magnets (3) and the end surfaces of the respective inner ends (2A) of the respective frames (2)."

C Here, in Article A, since "coating films (4)" "fill the respective recessed portions (2C), and cover the end surfaces of the respective magnets (3) and the end surfaces of the respective inner ends (2A) of the respective frames (2)" and "surfaces are generally flat," "the magnets" of Article A are completely covered by "the respective frames (2)" and "the coating films (4)." (This point also can be seen from [Fig. 1 of Article A] and

[Fig. 4 of Article A] of Reference Drawing.) Therefore, although the meaning that end surfaces are "exposed" is understood as the end surfaces being bare without being covered by any other member, in "the magnets" of Article A, the entire end surfaces are covered by "the frames" and "the coating films," so that it cannot be said that "the end surfaces are exposed." Therefore, the configurations c and c-2 of Article A do not satisfy the constituent component C of the patent invention.

D Incidentally, it is well known and commonly practiced by a person skilled in the art that surfaces of magnets are coated with intention to prevent oxidation, and such magnets are sometimes simply called "the magnets" while including the coatings on the surfaces (the coatings are regarded as a part of the magnets). However, "the coating films (4)" in Article A not only cover the end surfaces, but also cover the end surfaces of the inner ends of the respective frames. Therefore, it is reasonable to understand that "the coating films (4)" in Article A are different from the antioxidant coatings which are provided on the surfaces of the magnets at the time of manufacturing of the magnets, so that they cannot be acknowledged as members composing a part of "the magnets."

Hence, even when considering the antioxidant coatings, the configurations c and c-2 of Article A do not satisfy the constituent component C of the patent invention.

E Furthermore, in Article A, "the thickness of the coating films (4) is about 1 mm on the end surfaces of the respective magnets (3)." The object of the coating films is to prevent the oxidation or corrosion of the end surfaces of the magnets caused when the end surfaces are scratched due to repeated connection and release by users, and "the coating films (4)" of Article A are made to have the above-mentioned thickness and structures on the basis of a problem peculiar to Article A. Although "the coating films (4)" of Article A are common with the well-known antioxidant coatings in terms of preventing oxidation, a function fulfilled in Article A is different, so that they cannot be identified as the mere antioxidant coatings which can be regarded as a part of the magnets.

F Therefore, furthermore, considering "the coating films (4)" of Article A, it cannot be said that the configurations c and c-2 of Article A do not satisfy the constituent component C of the patent invention.

G Consequently, the configurations c and c-2 of Article A do not satisfy the part "so as to expose end surfaces of the magnets."

(4) Summary of whether or not each constituent component is satisfied

As mentioned in (3) above, Article A does not satisfy the constituent component C of the patent invention, which is "a pair of connectors consisting solely of magnets is connected to respective inner ends of the frames so as to expose end surfaces of the magnets, and temples are connected to respective outer ends of the frames, respectively."

2 Regarding equivalence

The demandant, in the request for advisory opinion, specifically alleges that since Article A does not satisfy the First, Third, and Fifth requirements of equivalence, it does not fall within the scope of application of the doctrine of equivalents, whereas the demandee, in the written reply to the request for advisory opinion, did not allege and prove anything on the First and Third requirements at all, also did not make any rebuttal statements on the Fifth requirement, about equivalence.

Therefore, it cannot be said that Article A is an equivalent of the patent invention.

3 Regarding the demandee's allegation

(1) The demandee alleges that it has been commonly practiced to provide antioxidant coatings on the surfaces of the magnets, and even if the antioxidant coatings are provided on the surfaces of the magnets, "expose end surfaces of the magnets" of the constituent component C of the patent invention is satisfied, so that even if "the coating films (4)" are provided on the surfaces of the magnets in the manufacturing of Article A, they are also intended to prevent oxidation, and it can be said that "expose end surfaces of the magnets" of the constituent component C is satisfied.

However, it cannot be said that, as mentioned in 1(3) above, the coating films (4) provided for preventing oxidation on the surfaces of the magnets in the manufacturing of Article A configure a part of the magnets, so that it cannot be said that Article A covered by the coating films (4) on the end surfaces of the magnets satisfies "expose end surfaces of the magnets" of the constituent component C.

(2) Furthermore, the demandee alleges that although the thickness of the coating films (4) is described as "about 1 mm," its significant figures are not clear and this expression encompasses the thickness of a range of 0.5-1.4 mm, so that it cannot be said that

Article A is sufficiently specified.

However, the description about Article A is for specifying the configurations of Article A, and is not for specifying the technical scope of the invention like the description of the scope of claims for patent. Therefore, it is reasonable to understand that the description of "about 1 mm" in the configurations of Article A is specified as "about 1 mm" considering a manufacturing error to a design value of "1 mm," and it is not reasonable to understand that it describes a range of significant figures. Therefore, the allegation of the demandee is unreasonable in a presupposition thereof. Furthermore, the demandant, in the written request, alleges that by making the thickness "about 1 mm," while attracting force between the two magnets can be sufficiently obtained, "the oxidation or corrosion of the end surfaces of the respective magnets can be suppressed" by preventing scratches due to repeated connection and release ("(4-3) Effect of Article A"). The configurations of Article A are as mentioned in No. 3 above; even if the thickness is described as "about 1 mm" in the configurations of Article A, it cannot be said that Article A is not sufficiently specified in the determination of whether or not it falls within the technical scope of the patent invention.

4 Summary

Therefore, Article A does not satisfy the constituent component C of the patent invention. It cannot be said that Article A is an equivalent of the patent invention.

No. 6 Closing

As described above, Article A does not fall within the technical scope of the patent invention.

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

October 19, 2016

Chief administrative judge:	HIGUCHI, Nobuhiro
Administrative judge:	TADA, Tatsuya
Administrative judge:	TETSU, Toyoo

Appendix "(4) Detailed description of Article A" and "Reference Drawing"

(4) Detailed description of Article A

(4-1) Reference Drawing

Of Reference Drawing (hereinafter, referred to as "each drawing of Article A," and individual drawings are referred to as "Fig. 1 of Article A" to "Fig. 4 of Article A") attached to the request for advisory opinion, Fig. 1 of Article A is a perspective view while eye wear frames are not connected, Fig. 2 of Article A is a perspective view while the eye wear frames are connected, Fig. 3 of Article A is a cross-sectional view of a connecting part of the eye wear frames while the eye wear frames are not connected, and Fig. 4 of Article A is a view showing a forming process of the connecting part of the eye wear frames in order of (A), (B), and (C).

From Figs. 1, 2, and 3 of Article A, the following configurations of Article A can be seen. Two frames (2) respectively connected with lenses (1) are provided, recessed portions (2C) are provided at inner ends (2A) of the respective frames (2), outer ends (2B) of the respective frames (2) are connected to a strap (6) through temples (5), the respective magnets (3) are provided in the respective recessed portions (2C) so as to make end surfaces of the respective magnets (3) lower than end surfaces of the respective inner ends (2A), releasing or connecting of the inner ends (2A) of the respective frames (2) is carried out with the two magnets (3), coating films (4) which fill the respective recessed portions (2C) and cover the end surfaces of the respective magnets (3) and the end surfaces of the respective inner ends (2A) of the respective frames (2) are provided, and surfaces of the coating films (4) are generally flat, and the thickness of the coating films (4) is about 1 mm on the end surfaces of the respective magnets (3).

From Fig. 4 of Article A, it can be seen that, in the recessed portions (2C) provided at the respective inner ends (2A) of the frames (2), the respective magnets (3) are connected so as to make the end surfaces of the respective magnets (3) lower than the end surfaces of the respective inner ends (2A), then the respective recessed portions (2C) are filled with curable resin (4A), the end surfaces of the respective magnets (3) and the end surfaces of the inner ends (2A) of the respective frames (2) are covered by the curable resin (4A) so as to make the surface of the curable resin (4A) generally flat and make the thickness of the curable resin (4A) become about 1 mm on the end

surfaces of the respective magnets (3), and then, the coating films (4) are formed at a connecting part of the eye wear frames of Article A by hardening the curable resin (4A).

(4-2) Configurations of Article A

Article A will be separately described as follows

"(g) An eye wear comprising:

- (a) a pair of lenses (1); and a pair of frames (2),
- (b) wherein the lenses (1) are mounted in the respective frames (2),
- (c) two magnets (3) are connected in recessed portions (2C) provided on respective inner ends (2A) of the frames (2) so as to make end surfaces of the respective magnets (3) lower than end surfaces of the respective inner ends (2A), temples (5) are connected to respective outer ends (2B) of the frames (2),
- (d) coating films (4) fill the respective recessed portions (2C), and cover the end surfaces of the respective magnets (3) and the end surfaces of the respective inner ends (2A) of the respective frames (2), surfaces of the coating films (4) are generally flat, the thickness of the coating films (4) is about 1 mm on the end surfaces of the respective magnets (3),
- (e) rear ends of the temples (5) are connected by a strap having sufficient stiffness and elasticity to retain its shape and flexibility capable of bending, and
- (f) when putting on and taking off of the eye wear is carried out by connecting or releasing the inner ends (2A) of the respective frames (2), with the two magnets (3), the lenses (1) can be accurately positioned in front of the eyes through the strap (6) with its shape retained, and the eye wear can be hung around a neck when not being worn."

(4-3) Effect of Article A

In Article A, the end surfaces of the respective magnets (3) and the end surfaces of the respective inner ends (2A) are covered by the coating films (4). Therefore, the end surfaces of the respective magnets (3) are protected by the coating films (4), so that scratches due to repeated connection and release of Article A by users are hardly formed on the end surfaces of the respective magnets (3). Consequently, the oxidation or corrosion of the end surfaces of the respective magnets can be suppressed.

Also, in Article A, the thickness of the coating films (4) is about 1 mm on the end surfaces of the respective magnets (3). Therefore, while attracting force between the two magnets can be sufficiently obtained, the oxidation or

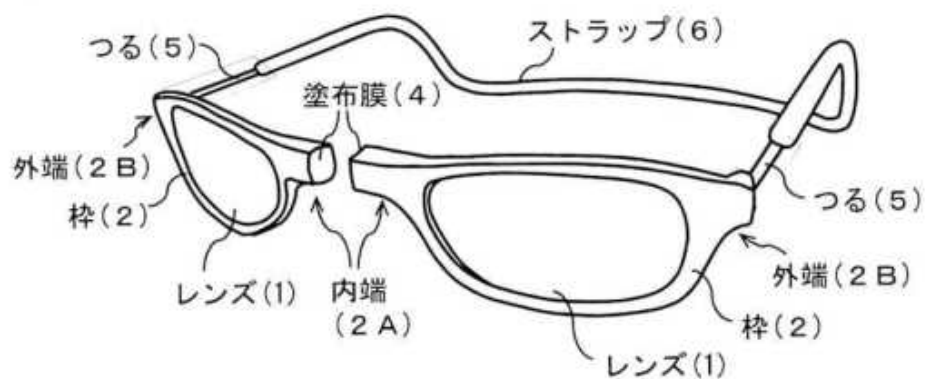
corrosion of the end surfaces of the respective magnets (3) can be suppressed.

Also, in Article A, the connectors (4) are connected so as to make the end surfaces of the respective magnets (3) lower than the end surfaces of the respective inner ends (2A). Therefore, only the parts requiring thickness as the coating films (4) (the parts contacted with the end surfaces of the magnets (3)) can be made thick, and the part which does not require thickness as the coating films (4) (the parts contacted with the end surfaces of the inner ends (2A)) can be made thin. Incidentally, as a result of this, of the coating films (4), only the parts contacted with the end surfaces of the magnets (3) are made thick, and if bulge portions are generated on the surfaces of the coating films (4), there is a probability that the coating films (4) are peeled at the bulge portions. However, in Article A, the surfaces of the coating films (4) are generally flat, so that the coating films (4) are hardly peeled. Therefore, the oxidation or corrosion of the end surfaces of the respective magnets (3) can be suppressed.

Also, in Article A, the end surfaces of the respective magnets (3) and the end surfaces of the inner ends (2A) are covered by the coating films (4), so that the coating films (4) can prevent the respective magnets (3) from slipping off from the recessed portions 2C due to the repeated connection and release of Article A by users. Also, the coating films (4) can prevent the respective magnets from slipping off from the recessed portions 2C, so that, for example, holes communicating to the recessed portions 2C are provided on the respective inner ends (2A), and an adhesive is made to flow into the recessed portions 2C through the holes while the magnets (3) are inserted in the recessed portions 2C, thereby omitting extremely complicated work such as fixing the magnets (3) to the recessed portions 2C.

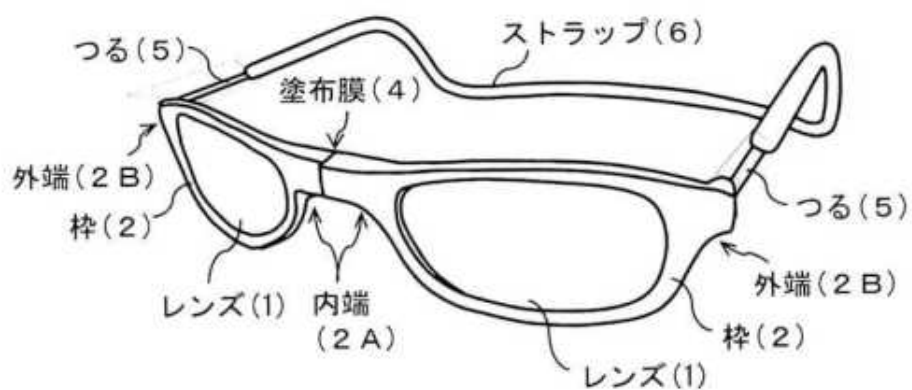
Reference Drawing

[Fig. 1 of Article A]



- つる (5) Temple (5)
外端 (2 B) Outer end (2B)
枠 (2) Frame (2)
レンズ (1) Lens (1)
内端 (2 A) Inner end (2A)
ストラップ (6) Strap (6)

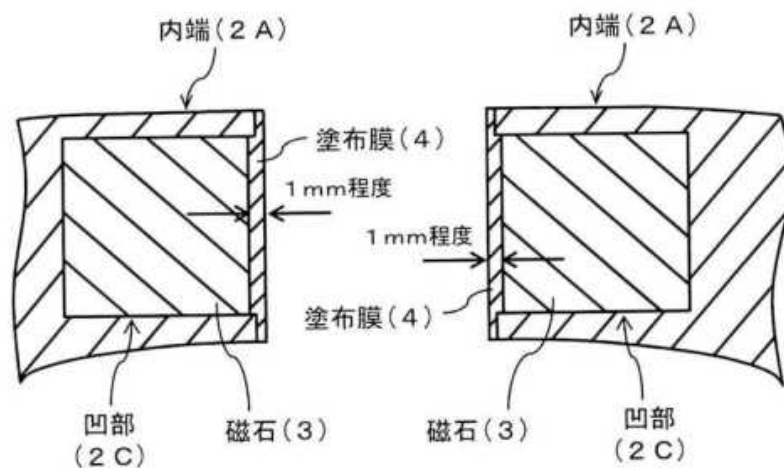
[Fig. 2 of Article A]



- つる (5) Temple (5)
外端 (2 B) Outer end (2B)
枠 (2) Frame (2)

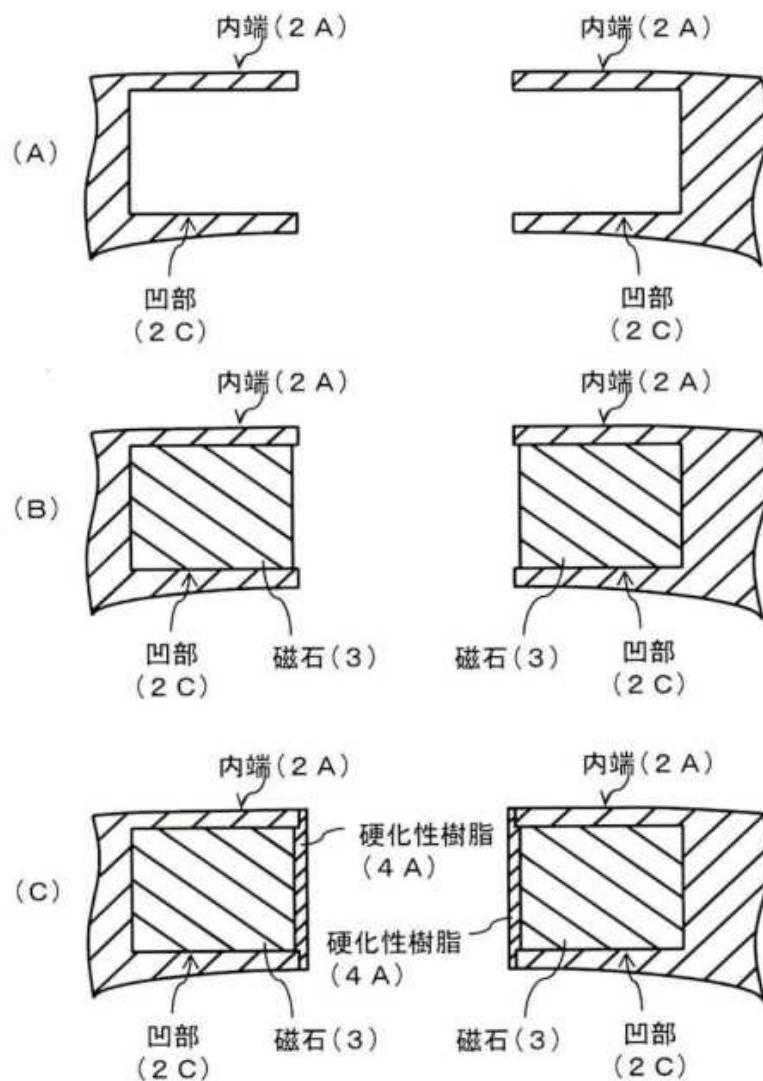
レンズ (1)	Lens (1)
内端 (2 A)	Inner end (2A)
ストラップ (6)	Strap (6)

[Fig. 3 of Article A]



内端 (2 A)	Inner end (2A)
塗布膜 (4)	Coating film (4)
1 mm 程度	about 1 mm
凹部 (2 C)	Recessed portion (2C)
磁石 (3)	Magnet (3)

[Fig. 4 of Article A]



内端 (2 A)	Inner end (2A)
凹部 (2 C)	Recessed portion (2C)
磁石 (3)	Magnet (3)
硬化性樹脂 (4 A)	Curable resin (4A)