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Date of the judgment

2017.03.24
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Case number

2016 (Ju) 1242
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Reporter

Minshu Vol. 71, No. 3
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Title

Judgment on whether or not there are particular circumstances to determine that the structure stated in the scope of patent claims is not equivalent to the structure of another person's products or processes that can be easily conceived at the time of filing a patent application (e.g., a circumstance where another person's products or processes were intentionally excluded from the scope of claims in the course of filing an application) merely because the applicant did not mention the structure for the other person's products or processes in the scope of the patent claims
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Case name

Case demanding an injunction against an act of infringing on a patent right
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Result

Judgment of the Second Petty Bench, dismissed
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Court of the Second Instance

Intellectual Property High Court, Judgment of March 25, 2016
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Summary of the judgment

1. Even in a situation where the scope of patent claims written by a patent applicant did not mention the structure of certain products or processes manufactured or used by another person, which differ in part from the structure stated in the scope of claims, while the applicant was able to easily conceive the structure for the other person's products or processes at the time of filing the application, the mere fact of such omission in the scope of claims cannot imply that the other person's products or processes were intentionally excluded from the scope of the patent claims in the course of filing the application for the patented invention or that there are other particular circumstances justifying denial of equivalence in structure between another person's products or processes and the product or process stated in the scope of the patent claims.

2. In a situation where the scope of patent claims written by a patent applicant did not mention the structure for certain products or processes manufactured or used by another person, which differ in part from the structure stated in the scope of claims, while the applicant was able to easily conceive the structure for the other person's products or processes at the time of filing the application, if it is objectively and visibly clear that the scope of the patent claims did not mention the structure of the other person's products or processes even though the applicant recognized that said structure could substitute for the structure stated in the scope of the patent claims, the court will ascertain that the competing products or processes were intentionally excluded from the scope of the patent claims in the course of filing the application for the patented invention or that there are other particular circumstances for justifying denial of the equivalence in structure between the other person's products or processes and the product or process stated in the scope of the patent claims.

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References

For Paragraphs 1 and 2: Article 70, paragraph (1) of the Patent Act
Chapter IV, Section 2 (Infringement of rights) of the Patent Act
Article 1, paragraph (2) of the Civil Code

Patent Act

Article 70 (1) The technical scope of a patented invention shall be determined based upon the statements in the scope of claims attached to the application.

Civil Code

Article 1 (2) The exercise of rights and performance of duties must be done in good faith.

Main text of the judgment

The final appeal shall be dismissed.

The costs for the final appeal shall be borne by the appellants.

Reasons

Explanations regarding the reasons for the petition for acceptance of the final appeal filed by the Attorney for Appellant SHINBO Katsuyoshi and other (except for the reasons that were eliminated)

1. This lawsuit was initially instituted by the appellee to demand an injunction against the appellants' import and sale, etc. of certain pharmaceutical drugs and to seek an order to discard said drugs. The appellee is a joint owner of the patent right for a process for manufacturing a compound containing maxacalcitol, which is one of the active ingredients in a drug used to treat keratosis. The appellee asserts that the process for manufacturing pharmaceutical drugs covered by the appellants' business for import and sale, etc. is equivalent to the structure stated in the scope of claims for the appellee's above-mentioned patent and therefore falls within the technical scope of the patented invention (cf. a judgment of the Third Petty Bench of February 24, 1998 in Supreme Court 1994 (O) 1083 (hereinafter referred to as the "1998 Judgment"), as shown on page 113 of Minshu Vol. 52, No. 1). The appellants are fighting against the appellee's demand. While the 1998 Judgment explains the particular circumstances justifying denial of equivalence (e.g., a circumstance where certain products or processes manufactured or used by the party adverse to a patent infringement suit (hereinafter referred to as "Competing Products or Processes") were intentionally excluded from the scope of the patent claims in the course of filing a patent application for the patented invention), the appellants argue that there are particular circumstances in relation to the referenced patent and they insist that the manufacturing process for their above mentioned pharmaceutical drugs is not equivalent to the structure stated in the scope of the patent claims in question.

2. The facts lawfully ascertained in the second instance are summarized as follows.

(1) Patent

The appellee is a joint owner of the patent right for an invention named “intermediates for the synthesis of vitamin D and steroid derivatives and process for preparation thereof” (Patent Number 3310301, covering 28 claims; hereinafter referred to as the “Patent”). Claiming priority with regard to the Patent based on the patent application filed in the United States on September 3, 1996, the appellee filed a patent application with the Japan Patent Office on September 3, 1997.

(2) Invention

Claim 13 written in the scope of claims for the Patent (hereinafter referred to as the “Scope of Claims”; the invention pertaining thereto being referred to as the “Invention”) is as described in the Appendix attached hereto (attachment omitted). At the time of filing an application for the Patent, the appellee stated the structure of cis-vitamin D in the Scope of Claims as the starting material, etc. for manufacturing the target compound, without mentioning the structure of trans-vitamin D, which is an isomer of cis-vitamin D.

(3) Appellants’ Process

a) DKSH Japan K.K., as an appellant, is a business operator that imports and sells maxacalcitol, an active pharmaceutical ingredient (API) for a drug used in the treatment of keratosis. Other appellants are distributors of maxacalcitol preparation products. (The process for manufacturing such maxacalcitol APIs is hereinafter referred to as the “Appellants’ Process.”)

b) In comparing the Appellants’ Process with the structure stated in the Scope of Claims, both are different with respect to the starting material, etc. for manufacturing the target compound—trans-vitamin D is used in the former and cis-vitamin D is adopted in the latter. However, the Appellants’ Process satisfies the requirements for the structure stated in the Scope of Claims in all other respects.

The appellants allege as follows: in connection with the parts of the structure stated in the Scope of Claims that are different from the Appellants’ Process, the appellee was supposed to be able to easily conceive the structure adopted in the Appellants’ Process at the time of filing the application for the Patent.

(4) Statements in the patent description

Looking into the description attached to the application filed for the Patent (hereinafter referred to as the “Description”), there is no statement concerning a process for transforming vitamin D from the trans form to the cis form, and nothing in the Description implies that an invention using trans-vitamin D as the starting material, etc. is disclosed. In short, no such inventions are disclosed in the Description.

3. Based on the facts explained above, the court of second instance determined as follows: this court case does not involve any particular circumstances as explained in Paragraph 1; the Appellants' Process is equivalent to the structure stated in the Scope of Claims and falls within the technical scope of the Invention, and thus, the appellee's claim is acceptable. The points for such a determination are as follows.

(1) Although an applicant for a certain patent may be able to easily conceive of the existence of some structures that fall outside the scope of claims at the time of filing a patent application, the applicant may omit statements concerning such structures in the application to be filed. In this event, it cannot be ascertained that there are particular circumstances explained in Paragraph 1 above merely due to such an omission.

(2) Even in the event described in (1) above, the existence of particular circumstances explained in Paragraph 1 above will be ascertained if it is objectively and visibly determined that the applicant recognized that a certain structure that falls outside the scope of the patent claims could substitute for the structure stated in the scope of claims while the former structure differs in part from the latter.

4. The appellants argue that the scope of particular circumstances explained in Paragraph 1 above is interpreted too narrowly in the determination shown by the court of second instance.

5.

(1) The patent system is a system for granting a patent right, which is an exclusive right, to inventors who have publicly disclosed their inventions, thereby protecting the patented inventions for the holders of the relevant patent rights and making known the contents of the patented inventions to third parties, with the aim of encouraging the creation of inventions through promoting their utilization, thereby contributing to the development of industry (cf. Article 1 of the Patent Act). According to Article 70, paragraph (1) of the Patent Act, the technical scope of a patented invention must be defined based on the statements in the scope of claims attached to a patent application. If, however, a party adverse to a patent infringement suit were easily able to evade injunctions or the exercise of other rights by a patentee simply by replacing a certain part of the structure stated in the scope of the patent claims with any other easily conceivable technology that is substantially the same as the structure specified in the patent application, such evasion would go against the purport of the patent system

described above and produce the effect of prejudicing the equitable principle. In light of the foregoing, Competing Products or Processes satisfying given requirements should be considered to be equivalent to the structure stated in the scope of patent claims and fall within the technical scope of the patented invention even when the structure specified by the applicant contains any part that is different from those of the Competing Products or Processes. If some Competing Products or Processes were intentionally excluded from the scope of patent claims in the course of filing the application for the patented invention, or if there are other particular circumstances justifying denial of equivalence, the patentee will not be allowed to insist on the doctrine of equivalents. This is because the doctrine of estoppel does not allow the patentee to subsequently insist on what is inconsistent with his/her previous consent to exclusion of the Competing Products or Processes from the technical scope of the patented invention, or with his/her previous conduct that might visibly be interpreted as such consent (cf. 1998 Judgment).

Therefore, third parties who are aware of the description in a patent application that is publicly disclosed cannot reliably believe that the Competing Products or Processes are excluded from the scope of the patent claims, and it is difficult to ascertain that the applicant has acted in a way to imply consent to such exclusion from the technical scope of the patented invention merely because the applicant omitted to mention the Competing Products or Processes in the scope of patent claims in a situation where the applicant was able to easily conceive the structures adopted in the Competing Products or Processes different in part from the structure stated in the scope of the claims at the time of filing the patent application. In addition, if the patent applicant's failure to describe other easily conceivable structures in the scope of the patent claims automatically and unexceptionally made it impossible for the patentee fighting in a patent infringement lawsuit to insist that the Competing Products or Processes fall within the technical scope of the patented invention on the grounds that they are equivalent to the structure stated in the scope of the patent claims, the expected result would be inequitable for both patent applicants/patentees and third parties. On the part of patent applicants, such interpretation and operation would be the same as forcing them to prepare their applications in a way that exhaustively covers all expected future forms of infringement at the time of filing while they are under pressure to file patent applications as early as possible under the first-to-file rule. On the part of third parties aware of patent descriptions publicly disclosed, they would be able to examine alternative structures equivalent to the structure stated in the scope of claims without the time constraints faced by patent applicants, and third parties could therefore be

able to easily evade injunctions or the exercise of other rights by relevant patentees.

In consequence, even in a situation where the scope of patent claims written by the patent applicant did not mention the structure for Competing Products or Processes different in part from the structure stated in the scope of claims while the applicant was able to easily conceive the structure for such Competing Products or Processes at the time of filing the application, the mere fact of such omission in the scope of the patent claims does not infer that the Competing Products or Processes were intentionally excluded from the scope of patent claims in the course of filing the application for the patented invention or that there are other particular circumstances.

(2) In some of the situations explained in (1) above, however, a patent description written by an applicant may contain a statement to the effect that the patented invention can work even when the structure stated in the scope of claims is replaced with a structure for Competing Products or Processes that are different in part from the structure stated in the scope of claims. In this or any other way, applicants may recognize at the time of filing the patent that the structure for any Competing Products or Processes can substitute for the structure stated in the scope of the patent claims, but intentionally omit statements concerning such Competing Products or Processes in the scope of the patent claim. If the situation explained in the preceding two sentences is objectively and visibly ascertained, third parties aware of the publicly disclosed patent description can understand that Competing Products or Processes are excluded from the scope of the patent claims based on the applicant's intention. This means that the applicant has acted in a way to cause third parties to believe that the Competing Products or Processes do not fall within the technical scope of the patented invention with the applicant's consent. A ruling that the existence of particular circumstances is ascertained in the situation referred to above is consistent with the purpose of the Patent Act, which is to encourage inventions through promoting their protection and utilization, thereby contributing to the development of industry, and such a ruling is reasonable for adequate coordination of interests between patent applicants and third parties.

Therefore, intentional exclusion of Competing Products or Processes from the scope of patent claims in the course of filing an application for a patented invention or the existence of other particular circumstances should be ascertained if the applicant is objectively and visibly determined to have indicated his/her intention of omitting statements concerning Competing Products or Processes in the scope of the patent claims in a situation described below, while recognizing that the structure for the Competing Products or Processes could substitute for the structure stated in the scope

of the patent claims; the applicant knew the existence of such Competing Products that contain certain parts that are different from the parts in the structure stated in the scope of the patent claims; and the applicant was able to easily conceive the structure for such Competing Products or Processes at the time of filing the application in connection with said differences.

In light of the facts explained prior, nothing contained in the appellee's application for the Patent indicates objectively and visibly the appellee's intention of omitting to mention the structure for the Appellants' Process in the Scope of Claims while recognizing that the structure adopted by the appellants, which was different in part from the structure stated in the Scope of Claims, could substitute for said structure.

6. Since the determination shown in the second instance is consistent with the foregoing, the Supreme Court upholds such a determination. The arguments of the final appeal are unacceptable.

Therefore, the justices unanimously render a judgment as stated in the main text.

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Presiding Judge

Justice ONIMARU Kaoru

Justice ONUKI Yoshinobu

Justice YAMAMOTO Tsuneyuki

Justice KANNO Hiroyuki

(This translation is provisional and subject to revision.)