Date	May 31, 2017	Court	Tokyo District Court, 29th Civil Division
Case number	2016 (Wa) 7763		
– A case in which the court examined whether it is necessary to satisfy the requirement that a person ordinarily skilled in the art could have easily conceived of the idea of replacing the structure described in the claims with the structure of the disputed product, etc. as of the time of the production, etc. of the disputed product, etc. (the significance of the third requirement for establishment of equivalence).			

References: None

Numbers of related rights, etc.: Patent No. 5377629

Summary of the Judgment

The disputed product, etc. could be considered to have a structure equivalent to the structure described in the claims and to fall within the technical scope of a patented invention only if a person ordinarily skilled in the art could have easily conceived of the idea of replacing the structure described in the claims with the structure of the disputed product, etc. as of the time of the production, etc. of the disputed product, etc. (the third requirement).

The satisfaction of the third requirement is considered to be necessary for the establishment of equivalence because, from the perspective of the purpose of the Patent Act, the social justice, and the principle of equity, it can be interpreted that the substantial value of a patented invention extends to the practically same technology that any third party could easily conceive of based on the structure described in the claims and that any third party should expect that (the Supreme Court judgment for the Ball Spline Case)

Thus, the phrases used in the third requirement, i.e., "a person ordinarily skilled in the art" "could have easily conceived of the idea as of the time of the production, etc. of the disputed product, etc." should be interpreted, unlike the phrase "a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention" in the public domain included in Article 29, paragraph (2) of the Patent Act or the phrases "a person ordinarily skilled in the art" could have "easily conceived of the disputed product" included in the fourth requirement, to mean that any person ordinarily skilled in the art could have easily conceived of the disputed product as easily as making a product described in the claims, in other words, the disputed product could be considered to be identical to the relevant invention in substance (1991 (Wa) 10687, Judgment of the Tokyo District Court of October 7, 1998, Hanji No. 1657, at 122).

On the other hand, regarding the phrase "easily conceived of" included in the third requirement, the plaintiff alleged that, as long as the words "easily" and "conceived of" are used, the same standard as the one adopted by Article 29, paragraph (2) of the Patent Act should be used for making judgment. However, it should be found that there are no practical grounds to use the same standard for the inventive step requirement, which is a patentability requirement that must be satisfied in order to exclusively use the invention, and for a requirement of the doctrine of equivalents, which determines the extent of the technical scope of the invention disclosed in the claims. As mentioned above, in the case where a technology is easily conceived of based on the structure described in the claims as a technology practically identical to the one described therein, even a third party should expect that the substantial value of the patented invention would extend to such technology. In this case, the requirement for public announcement of the claims can be considered to be satisfied. However, if the substantial value of the patented invention extends even to a structure "that can be easily invented" as specified in Article 29, paragraph (2) of the Patent Act, a third party would not be able to easily understand the technical scope of the patented invention. Consequently, the requirement for public announcement of the claims could not be satisfied. Therefore, the aforementioned allegation of the plaintiff is unacceptable.

Judgment rendered on May 31, 2017; the original was delivered on the same day; court clerk

2016 (Wa) 7763 Case of Seeking Order to Prohibit Manufacturing and Sale based on Patent Right, and other claims

Date of conclusion of oral argument: March 2, 2017

Judgment

Plaintiff: Panduit Corporation

Defendant: HellermannTyton Co., Ltd.

Main text

1. All of the plaintiff's claims shall be dismissed.

2. The plaintiff shall bear the court costs.

3. The additional period for filing an appeal against this judgment shall be specified as 30 days.

Facts and reasons

No. 1 Claims

1. The defendant shall not manufacture or sell the product indicated in Attachment 1, List of Product.

2. The defendant shall not import, export, offer for sale, or display for sale, the product indicated in Attachment 1, List of Product.

3. The defendant shall dispose of the product indicated in Attachment 1, List of Product.

4. The defendant shall pay to the plaintiff 5,100,000 yen and the amount accrued thereon at the rate of 5% per annum for the period from March 26, 2016, to the date of completion of the payment.

No. 2 Outline of the case

1. The plaintiff, who holds a patent right of Patent No. 5377629 for an invention titled "self-laminating rotating cable marker label with breakaway portion" (hereinafter referred to as the "**Patent Right**" and the "**Patent**"; the description and drawings attached to the application for the Patent are hereinafter referred to as the "**Description and Drawings**"), alleged against the defendant that the product indicated in Attachment 1, List of Product (hereinafter referred to as the "**Defendant's Product**") falls within the technical scope of each of the relevant inventions stated in the scope of claims attached to the application of the Patent (hereinafter simply referred to as the "**scope of claims**" in some cases), namely, the invention stated in Claim 1 (hereinafter referred to as "**Invention 1**") and the invention stated in Claim 26 (hereinafter referred to as "**Invention 26**"; Inventions 1 and 26 are hereinafter collectively

referred to as the "**Inventions**"), and therefore, all of the defendant's acts of manufacturing, selling, importing, exporting, offering for sale, and displaying for sale (hereinafter collectively referred to as "**Assignment, etc.**") of the Defendant's Product infringe the Patent Right. Based on this allegation, the plaintiff [i] sought an injunction against the Assignment, etc. of the Defendant's Product under Article 100, paragraph (1) of the Patent Act, [ii] demanded the disposal of the Defendant's Product under paragraph (2) of the same Article, and [iii] claimed payment of 5,100,000 yen as damages based on a right to claim damages for a tort of patent right infringement (the period subject to a claim for damages is from October 4, 2013, to March 9, 2016), with delay damages accrued thereon at the rate of 5% per annum for the period from a day after the tortious act took place, that is, March 26, 2016 (the day following the date of service of the complaint of this case), to the date of completion of the payment.

2. Underlying facts (facts for which the parties have no dispute or facts that can easily be found from the evidence indicated below and the entire import of the oral argument)

(1) Parties

The plaintiff is a US corporation engaging in the business of development, manufacturing, and sale of electrical products and network products (Exhibit Ko 4 and the entire import of the oral argument).

The defendant is a stock company engaging in the business of manufacturing, sale, research and development, import and export, etc. of electrical, electronical and information communication wiring materials.

(2) The Patent Right

The plaintiff holds the Patent Right as specified below (Exhibits Ko 1 and 2).

Patent number: Patent No. 5377629

Date of registration: October 4, 2013

Application number: Patent Application No. 2011-508702

Filing date: May 8, 2009

Publication of Japanese translation of PCT international application: Publication No. 2011-524154

Date of publication: August 25, 2011

International application number: PCT/US2009/043265

International publication number: WO2009/137756

Date of international publication: November 12, 2009

Priority claim number: 61/051,976

Priority date: May 9, 2008 (referred to as the "**First Priority Date**")

Priority country: United States

Priority claim number: 12/437,187

Priority date: May 7, 2009
Priority country: United States
Title of the invention: Self-laminating rotating cable marker label with breakaway portion
Scope of claims: As indicated in [Scope of claims] section in Attachment 2 (patent gazette).
(3) Decomposition of each of the Inventions into constituent features
A. Invention 1 (the invention stated in Claim 1) can be decomposed as follows (hereinafter the constituent features identified through the decomposition are referred to as "**Constituent Feature 1A**" or the like with the combinations of alphabets and numbers assigned thereto).
1A: A self-laminating rotating cable marker label for identifying a cable, comprising a transparent film having a first adhesive area;
1B: said transparent film having an adhesive-free area adjacent said first adhesive area;
1C: said transparent film having a second adhesive area adjacent said adhesive-free area;
1D: said second adhesive area of said transparent film adapted to at least partially overlie said adhesive-free area when said transparent film is wrapped over a cable;
1E: said transparent film having a print-on area on one side of said transparent film;
1F: a perforation extending across said transparent film;
1G: said perforation providing a line of separation of said transparent film;
1H: a self-laminating rotating cable marker label characterized as above.
B. Invention 26 (the invention stated in Claim 26) can be decomposed as follows (hereinafter the constituent features identified through the decomposition are referred to as "**Constituent Feature 26A**" or the like with the combinations of alphabets and numbers assigned thereto).
26A: A plurality of self-laminating rotating cable marker labels adhered in an array on a substrate;
26B: each cable marker label comprising a transparent film having first and second adhesive areas;
26C: a smooth adhesive-free area between said first and second adhesive areas;
26D: a print-on area on said transparent film, said print-on area located between said first and second adhesive areas;
26E: and a perforation in said transparent film, said perforation providing a line of separation of said film, comprising;
26F: each of said first and second adhesive areas removably adhering said adhesive areas of each said film to said substrate;
26G: the adhesive-free area of each said film being free from adhesion to said substrate and forming an opening between said substrate and each of said transparent films, said opening adapted to receive a lifting force to engage a selected transparent film and remove said selected transparent film from said substrate;

26H: a plurality of self-laminating rotating cable marker labels characterized as above.

(4) Defendant's acts

The defendant engages, as a business, in manufacturing and selling the Defendant's Product, and offering and displaying the Defendant's Product for sale.

The Defendant's Product is a self-laminating rotating cable marker label set comprising plural transparent films adhered to the substrate, which has the structure described in Attachment 3, the Defendant's Product Description (Exhibits Ko 3 and 8). The defendant holds a patent right for the structure of the Defendant's Product (Patent No. 5859083; hereinafter the invention covered by this patent is referred to as the "**Defendant's Patented Invention**") (Exhibit Ko 12 and the entire import of the oral argument).

The Defendant's Product fulfills Constituent Features 1C, 1D, 1E, 1H, 26A, and 26H (the defendant does not object to this point).

3. Issues

(1) Whether the Defendant's Product literally falls within the technical scope of Invention 1 (Issue 1)

A. Whether the Defendant's Product fulfills Constituent Feature 1A (Issue 1-1)

B. Whether the Defendant's Product fulfills Constituent Feature 1B (Issue 1-2)

C. Whether the Defendant's Product fulfills Constituent Feature 1F (Issue 1-3)

D. Whether the Defendant's Product fulfills Constituent Feature 1G (Issue 1-4)

(2) Whether the Defendant's Product falls within the technical scope of Invention 1 as its equivalent (Issue 2)

(3) Whether the Defendant's Product literally falls within the technical scope of Invention 26 (Issue 3)

A. Whether the Defendant's Product fulfills Constituent Features 26B, 26C, 26D, and 26F (Issue 3-1)

B. Whether the Defendant's Product fulfills Constituent Feature 26E (Issue 3-2)

C. Whether the Defendant's Product fulfills Constituent Feature 26G (Issue 3-3)

(4) Whether the Defendant's Product falls within the technical scope of Invention 26 as its equivalent (Issue 4)

(5) Whether the defendant engages in importing and exporting of the Defendant's Product (Issue 5)

(6) Damage sustained by the plaintiff, and the amount thereof (Issue 6)

(omitted)

No. 3 Court decision

1. The Inventions

(1) Statements of the scope of claims

The statements of the scope of claims of the Inventions are as shown in (3) of the "Underlying facts" section above.

(2) Statements of the Description and Drawings

The Description and Drawings contain the following statements.

A. Technical field

[0002] "The invention relates to a cable identification label that rotates about the cable to allow the label to be read at any position and, more particularly, to a self-laminating cable marker label with a breakaway portion that allows the label to rotate on the cable after installation, and permits the label to be applied to a terminated cable without disconnecting a previously connected cable."

B. Background art

[0003] "It is important that cables used to make electrical and mechanical connections between control, operating, and other systems be properly labeled to allow cables to be moved, added to such systems, changed, repaired, and/or identified for trouble shooting maintenance."

[0004] "Presently available labels used to mark cables have an adhesive surface and an opposed printable surface, with the cable marker indicia applied to the printable surface. The adhesive side of the label attaches to the outer insulation layer surrounding the cable, such that the label is not rotatable around the cable."

[0005] "Other presently available cable marker labels comprise a hollow cylindrical label with cable identification markings imprinted on the outer surface of the cylindrical label. These labels are capable of rotating when applied over a cable; however, one end of the cable must be disconnected to allow one of these cylindrical labels to be installed over the cable, or the cylindrical label must be applied over the cable prior to installation."

[0007] "Another cable marker presently available comprises a rotatable label strip with a write-on area on the front side of the label strip, and a partial adhesive on the back of the label strip opposite the write-on area. One end of the strip is wrapped around the cable and attaches to the adhesive side. This strip is not capable of adjusting to the size of the cable, nor of providing a protective over-laminate segment to protect the printed-on indicia against smudging or erasure."

C. The problem to be solved by the invention

[0009] "Therefore, there is a need for a cable marker label that is rotatably applied to the cable, can be applied to a terminated cable without disconnecting an end of the cable connection, can be applied over a cable in a matter of seconds, is a one-piece or two-piece construction, provides a clear, protective over-laminate segment covering the print-on area, and is inexpensive to

manufacture."

D. Means to solve the problem

[0010] "A self-laminating cable marker label with a breakaway portion is provided that allows rotation of the label on the cable after installation. This allows the label to be rotated on the cable and be read from any position. The label in one embodiment comprises a strip of transparent film material having a first adhesive area applied over a first portion of one side of the film, a second portion of the film comprising a print-on or pre-printed label area with an adhesive-free smooth undersurface having a low coefficient of friction, and a third clear over-laminate portion of the film having a second adhesive area applied over the third portion on the same side of the film as the first adhesive area. A breakaway perforation is applied to the film at or adjacent the junction between the first adhesive area and the print-on label area. The transparent film material is thin so as not to materially add to the profile of the cable."

[0011] "The film is wrapped around the cable over an approximate four hundred fifty degree distance, with the first adhesive layer engaging and adhering to the cable and also engaging and adhering to a portion of the film as the wrap extends beyond three hundred sixty degrees. The wrapping of the film about the cable continues until the print-on or pre-printed, non-adhesive label portion of the film is wrapped around the cable over an approximate four hundred fifty degree distance. The cable is held against rotation, while a tangent force is applied to the unwrapped portion of the label. The second pre-printed label portion and the third adhesive area of the film break from the first portion of the film along the perforation, such that the first film portion remains adhesively secured to the cable. After separation, the third over-laminate portion is adhesively attached to the upper surface of the label area by continuing to wrap the film around the label, thus providing a protective layer over the print-on area of the rotatable label portion. The pre-printed label portion and the clear over-laminate portion are free to rotate about the outer, non-adhesive surface of the first film portion. Since the outwardly facing surface of the film underlying the pre-printed label portion and the underside of the pre-printed label portion are adhesive free, the pre-printed label portion is able to achieve three hundred sixty degree rotation around the cable."

[0013] "Certain examples of the present invention are illustrated by the accompanying figures. It should be understood that the figures are not necessarily to scale and that details that are not necessary for an understanding of the invention, or that render other details difficult to perceive, may be omitted. It should be understood, of course, that the invention is not necessarily limited to the particular examples illustrated herein."

E. Brief explanation of the drawings

[0014] "FIG. 1 is a cross-sectional view of an embodiment of the rotatable film and label combination strip of an embodiment of the present invention, showing the different portions of

the film and the location of the perforation in the illustrated embodiment.

FIG. 2 is a plan view of the film and label combination strip of the embodiment of the invention illustrated in FIG. 1, showing the location of the first adhesive pressure sensitive area of the film, the second print-on or pre-printed label portion, the third over-laminate portion, and the location of the perforation between the first and second portions of the illustrated embodiment.

FIG. 3 diagrammatically illustrates the steps of wrapping the transparent film and label combination strip of the embodiment of the present invention shown in FIGS. 1 and 2 around a cable, breaking the film along the perforation, applying the over-laminate protective portion of the film over the print-on area of the label, and rotating the label once applied to the cable."

F. Embodiment of the invention

[0015] "Referring to FIGS. 1 and 2, an embodiment of the self-laminating rotating cable marker label of the present invention is illustrated. FIG. 1 shows the combination film and label strip 10 wrapped around a cable 12. Cable 12 is normally surrounded by a cable jacket (not shown). Referring to FIGS. 1 and 2, the combined film and label strip 10 comprises an elongated strip of thin film material 14 made of transparent flexible material such as vinyl, polyolefin, polyester or other suitable material. The film material 14 comprises a first portion or area 16 having an adhesive applied to the underside 18 (not shown). A second portion of strip 14 comprises a print-on or pre-printed label area 20. No adhesive is applied to the underside of printed label area 20, and the underside of strip 14 opposite area 20 has a low friction outer facing surface. In an embodiment, the printed label area 20 is located on a second side of strip 14 opposite the underside 18 of strip 14. A perforation 22 extends through the film strip 14 and across the width of strip 14 adjacent or at the junction of first adhesive area 16 and printed label area 20. Strip 14 also includes a third clear over-laminate portion 24 having a transparent adhesive area 26 applied to the underside, such that third portion 24 provides a clear, transparent over-laminate area, for purposes to be explained."

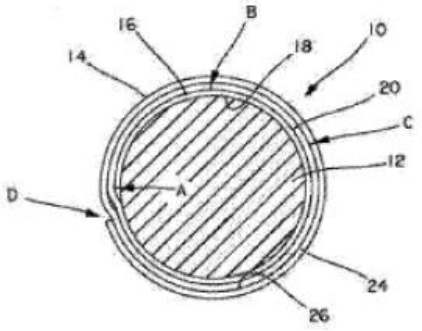


FIG. 1

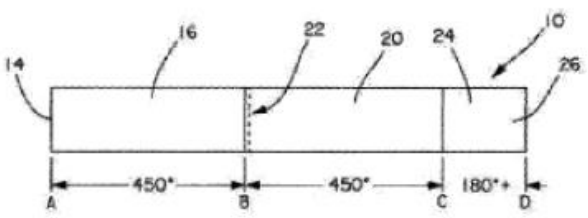


FIG.2

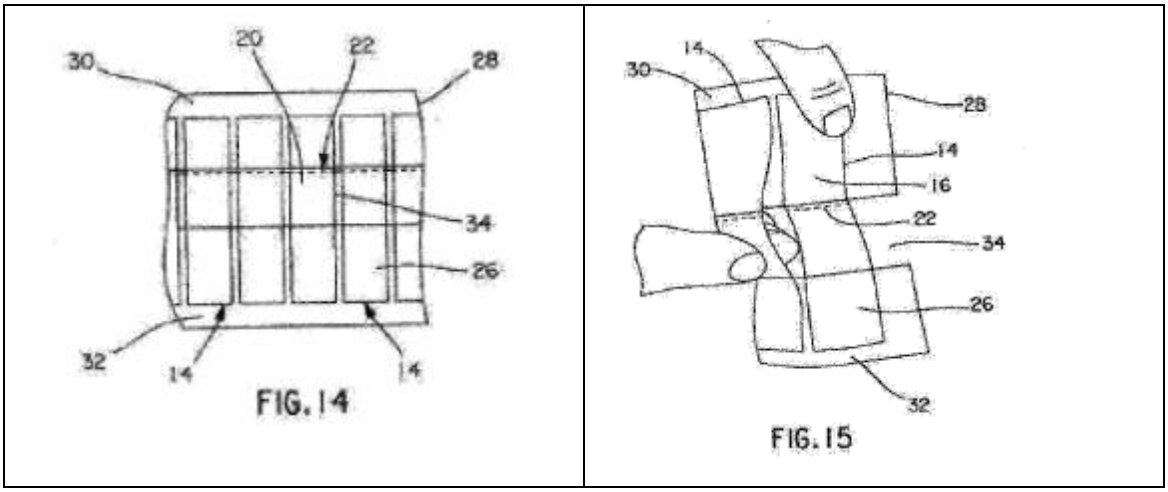
[0016] "Referring to FIG. 2, the forward end of the strip 14 is designated A, the general location of perforation 22 is designated B, and the end of the printed label area 20 is designated C. As

seen in the embodiment of the invention described in FIG. 1, when strip 14 is initially wrapped around cable 12, the adhesive area 16 extending along strip 14 between A and B attaches first adhesive area 16 to cable 12, providing an anchor for further wrapping strip 14 around cable 12. In the illustrated embodiment, first adhesive area 16 of strip 14 is wrapped a distance greater than three hundred sixty degrees around cable 12, for example four hundred fifty degrees as suggested in FIG. 2, such that first adhesive area 16 is attached to cable 12 over a circumferential distance relative to the diameter of the cable 12. In addition, first adhesive area 16 is attached to the strip over ninety degrees in the illustrated embodiment of FIG. 1."

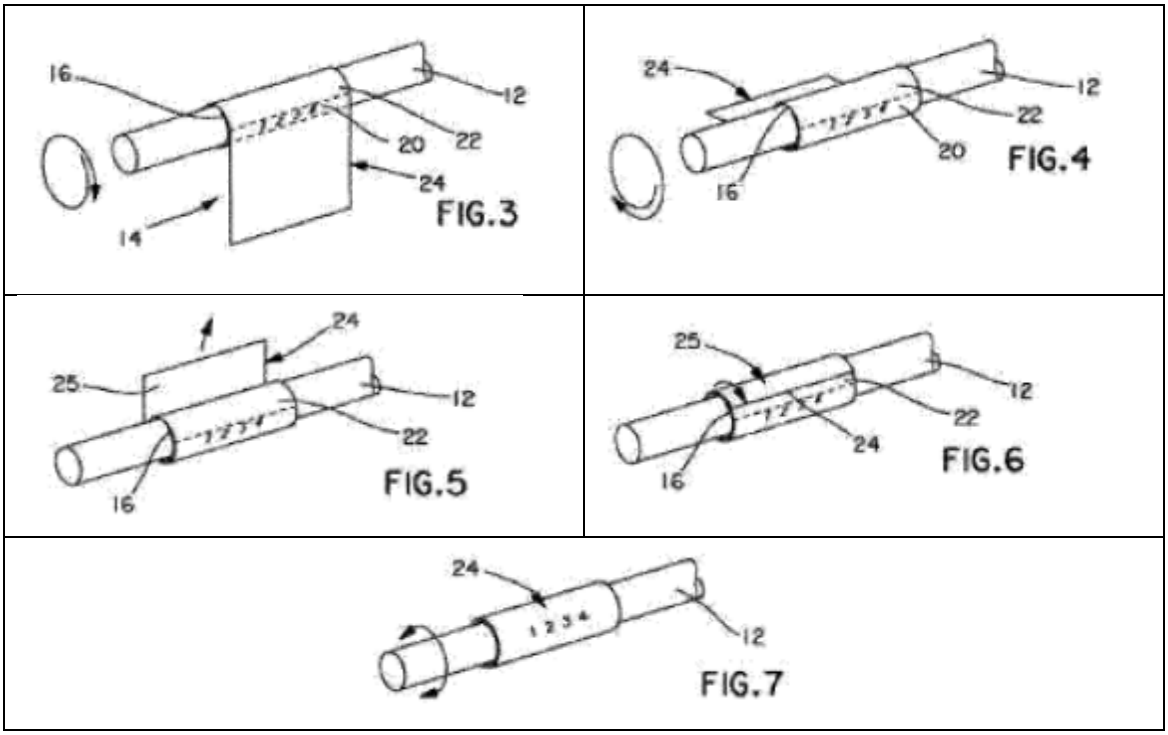
[0017] "In the embodiment illustrated in FIG. 1, when first adhesive area 16 is wrapped a total of four hundred fifty degrees around cable 12, perforation 22 is in the position B shown in FIG. 1, with position B approximately ninety degrees from position A. However, the first adhesive area 16 may be wrapped around cable 12 over other circular distance ranges depending on the diameter of cable 12. The angular wrapping parameters mentioned above are exemplary only, and other circular wrapping distances may be utilized within the scope of the present invention."

[0018] "Referring to FIG. 1, when the strip 10 is applied to cable 12, printed label area 20 extends over the upper surface of first adhesive area 16 of label strip 14, such that printed label area 20 overlies first adhesive area 16 over a distance greater than three hundred sixty degrees. In the embodiment illustrated in FIG. 1, printed label area 20 extends four hundred fifty degrees beyond position B of perforation 22, as designated at position C. Other angular distances may also be suitable. Since the printed label area 20 does not have an adhesive bottom, the printed label area 20 is capable of circumferential rotative movement about the non-adhesive top side of first adhesive area 16 of strip 14 were the perforation 22 broken, as will be explained. The third clear over-laminate portion 24 of strip 14 extends over the printed label area 20 by a distance of one hundred eighty degrees to position D in the illustrated embodiment of FIG. 1; however, other angular distance ranges may be used as a result of varying diameter of cable 12. The over-laminate portion 24 is adhered to the outside of printed label area 20 due to adhesive area 26, and provides a protective transparent cover over the printed label area 20 to prevent smudging of the printed indicia as the installed label is manually rotated to a readable position."

[0019] "The present invention contemplates in one embodiment, that a plurality of strips 14 will be provided to the user in a roll or other suitable form having the strips 14 removably adhered to a substrate 28 in a linear array (FIG. 14). The adhesive segments 16, 26 at both ends of strip 14 removably adhere the strip to the substrate 28, such that each strip 14 may be manually removed from substrate 28 when a label is to be applied to a cable 12, as illustrated in FIG. 15. Each strip 14 on substrate 28 includes perforation 22. In one embodiment, substrate 28 is formed in two parallel portions 30, 32, with an open space 34 beneath the printed label area 20 of the strip 14."



[0020] "FIGS. 3-7 illustrate the unique method of applying the combined film and label strip 10 to a cable 12. First, a single strip of material 14 with a print-on or pre-printed label area 20 is manually removed from portions 30, 32 of substrate 28 (FIG. 15). As shown in FIG. 3, the first adhesive area 16 of strip 14 is tightly wrapped around cable 12 such that adhesive underside 18 anchors first portion 16 to cable 12. First adhesive area 16 is wrapped around cable 12 beyond three hundred sixty degrees, such that a segment of adhesive area 16 overlies and adheres to the upper surface of a previously wrapped segment of adhesive area 16, as shown between positions A and B in FIG. 1."



[0021] "Referring to FIGS. 4 and 5, the wrapping process continues as printed label area 20 is wrapped over the upper, non-adhesive surface of first area 16 of strip 14. In the illustrated embodiment, label area 20 is wrapped over approximately a four hundred fifty degree distance

around cable 12, extending from B to C as viewed in FIGS. 1 and 4. Pressure sensitive area 26 of over-laminate portion 24 of strip 14 is then partially adhesively adhered to a portion of label area 20 over an approximate ninety-degree extent in the illustrated embodiment. The wrapping steps are halted at this point, with the outer segment 25 of third over-laminate portion 24 of strip 14 extending outward from printed label area 20, as seen in FIG. 5. Next, the cable 12 is held against rotation, the label area 20 is grasped and pulled in a direction tangent to cable 12 in the direction of wrapping, applying a torsional force sufficient to separate first adhesive area 16 from printed label area 20 along perforation 22. After perforation 22 is broken, the remaining segment 25 of pressure sensitive over-laminate portion 24 is wrapped over and adhered to the label area 20, as shown in FIG. 6. As the perforation 22 breaks, printed label area 20 is free to rotate in either direction about the smooth outer surface of first adhesive area 16 of film material 14, as depicted in FIG. 7, and due to the smooth underside of printed label area 20 that is in contact with the smooth outer surface of first adhesive area 16 of film 14 over a distance of three hundred sixty degrees or more. In the illustrated embodiment, the smooth underside of printed label area 20 is coated with silicon to provide a low coefficient of friction between printed label area 20 and the non-adhesive upper surface of area 16."

[0046] "The present invention has been described as embodiments for applying a rotatable self-laminating marker label to a cable, where the label can be circumferentially moved around the cable for ease of reading at any orientation. It is to be understood that the label structure and application method disclosed herein can be used to apply identification labels to other devices, such as fluid conduits, axially moveable control wires, tubular static structures, or the like."

[0047] "It should be noted that the above-described illustrated embodiments of the invention are not exhaustive of the form the self-laminating rotating cable marker label in accordance with the invention might take. Rather, the disclosed embodiments serve as exemplary and illustrative embodiments of the invention as presently understood. It is intended that the scope of the invention not be limited by the specification, but be defined by the claims set forth below."

(3) Outline of each of the Inventions

According to the statements of the scope of claims ((1) above) and the statements of the Description and Drawings ((2) above), the outline of each of the Inventions is found as follows.

A. Each of the Inventions relates to a marker label for identifying a cable that is used to make electrical and mechanical connections ([0002] and [0003]).

The conventional cable marker labels have problems such as that: the label cannot rotate around the cable because it is adhered to the cable; in order to apply a label over a cable, the cable must be disconnected or the label must be applied prior to installation of the cable; and the label cannot be adjusted to the size of the cable, nor can it provide an over-laminate segment to protect the print-on area ([0004], [0005], and [0007]).

B. Invention 1 relates to a cable marker label with a structure that fulfills Constituent Features 1A to 1H, or more specifically, a cable marker label comprising a strip having a transparent first adhesive area on one side of a film with an adhesive applied thereon, a print-on area with an adhesive-free smooth undersurface, and a transparent second adhesive area with adhesive applied over the same side of the film as the first adhesive area, with a perforation extending across the strip at or adjacent the junction between the first adhesive area and the print-on label area, and by adopting this structure, it aims to provide a cable marker label with the first adhesive area being adhered to a cable when applying the label to the cable in a manner that the label can be rotatably applied over the cable starting from the adhered point and then the non-adhesive print-on area can be separated from the adhesive-applied first adhesive area by means of a perforation, so that the label is rotatably applied to a terminated cable without disconnecting an end of the cable connection, can be applied over a cable in a matter of seconds, is a one-piece or two-piece construction, provides a clear, protective over-laminate segment covering the print-on area, and is inexpensive to provide ([0009] to [0011], [0015], etc.).

Invention 26 relates to cable marker labels with a structure that fulfills Constituent Features 26A to 26H, or more specifically, cable marker labels each comprising a transparent film having a first adhesive area and a second adhesive area, a print-on area on the transparent film located between the first adhesive area and the second adhesive area, and a perforation in the transparent film that provides a line of separation of the film, with these cable marker labels being adhered in an array on a substrate and an opening being provided between each transparent film and the substrate to lift a selected transparent film, and by adopting this structure, it aims to provide cable marker labels that allow the same mechanism as Invention 1, so that each of the labels is rotatably applied to a terminated cable without disconnecting an end of the cable connection, can be applied over a cable in a matter of seconds, is a one-piece or two-piece construction, provides a clear, protective over-laminate segment covering the print-on area, and is inexpensive to provide ([0009] to [0011], [0014], [0019], etc.).

2. Issue 1 (Whether the Defendant's Product literally falls within the technical scope of Invention 1)

(1) Whether the Defendant's Product fulfills Constituent Feature 1F (Issue 1-3).

A. "Perforation"

(a) Constituent Feature 1F reads "a perforation extending across said transparent film." The term "perforation" is translated into the Japanese term "ミシン目," consisting of the combination of the word "ミシン," which usually means "holes aligning like a dotted line," and the word "目," which usually means a "point where things come into contact or a line created at such point (the meanings of these Japanese words are based on Exhibit Otsu 1 [Kojien, 4th edition]). Accordingly, the Japanese term "ミシン目" can be interpreted as meaning a "line formed with

holes aligning like a dotted line."

(b) On this point, the plaintiff alleges that, according to the statements of the Description and Drawings, the technical meaning of providing a "perforation" (ミシン目) in Invention 1 lies in making it easier to separate things or break a thing into several parts, and therefore, the term "ミシン目" means a "weakening line to make it easier to break a film into several parts or separate one part of a film from the other part," regardless of whether there are holes aligning like a dotted line.

However, paragraph [0011] in the Description states the method of using a cable marker label based on Invention 1 as follows.

> "The film is wrapped around the cable…, with the first adhesive layer engaging and adhering to the cable and also engaging and adhering to a portion of the film as the wrap extends beyond three hundred sixty degrees. The wrapping of the film about the cable continues until the print-on or pre-printed, non-adhesive label portion of the film is wrapped around the cable... The cable is held against rotation, while a tangent force is applied to the unwrapped portion of the label. The second pre-printed label portion and the third adhesive area of the film break from the first portion of the film along the perforation, such that the first film portion remains adhesively secured to the cable. After separation, the third over-laminate portion is adhesively attached to the upper surface of the label area by continuing to wrap the film around the label…" (underlined by the court).

According to the statement above, in the cable marker label based on Invention 1, the first adhesive area is adhered to the cable, and then, while the label is being wrapped around the cable, the label holds the cable at its first adhesive area against the force in the wrapping direction. After that, until the print-on area (the portion referred to as the "second pre-printed label portion" in paragraph [0011]) is wrapped around the cable, the first adhesive area is not separated by a perforation ("ミシン目") from the print-on area and the second adhesive area (the portion referred to as the "third adhesive area" or "third over-laminate portion" in paragraph [0011]), but they are separated along the perforation after the print-on area is wrapped around the cable.

In that case, the technical meaning of providing a perforation ("ミシン目") in Invention 1 can be interpreted as providing a line of separation that has both a "certain degree of holding force" and "ease of separation," in a manner that, in the initial phase of wrapping the label around the cable, the film can hold against the wrapping force so that the first adhesive area is not separated from the print-on area and the second adhesive area, and then after the print-on area is wrapped around the cable, and an additional force is applied in the wrapping direction, the first adhesive area can be separated from the print-on area and the second adhesive area along the perforation.

Thus, a "weakening line to make it easier to break a film into several parts or separate one part of a film from the other part" is insufficient to be recognized as "ミシン目" (a "perforation") in Invention 1, and therefore, the plaintiff's allegation mentioned above cannot be accepted.

B. "Extending across"

(a) Constituent Feature 1F reads a perforation "extending across" the transparent film. The phrase "extending across" is translated into "横断して延在" in Japanese. The word "横断" generally means "crossing or passing transversely or in the east-west direction" (Exhibit Otsu 1 [Kojien, 4th edition]), and the word "延在" generally means "extending and existing." Accordingly, it is natural to consider that the "perforation" in Constituent Feature 1F must extend from one end of the transparent film to the other end, crossing the film. Here, it is uncertain from the statements of the scope of claims alone whether the "perforation" must "extend across" the transparent film in the widthwise or lengthwise direction.

Referring to the Description and Drawings, paragraph [0015] and FIG. 2 state as follows.

"…In an embodiment, the printed label area 20 is located on a second side of strip 14 opposite the underside 18 of strip 14. A perforation 22 extends through the film strip 14 and across the width of strip 14 adjacent or at the junction of first adhesive area 16 and printed label area 20... "(underlined by the court).

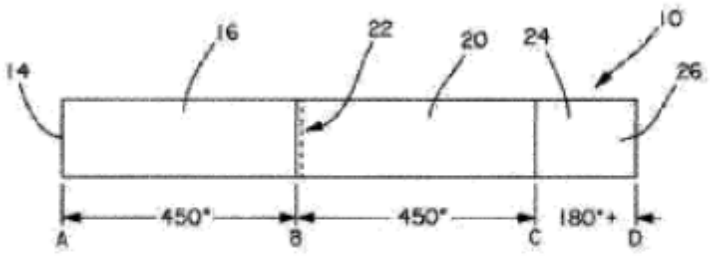


FIG.2

In light of the statement above, the phrase "a perforation extending across said transparent film" in Constituent Features 1F can be interpreted as meaning that a "perforation" must extend from one end of the transparent film to the other end, crossing the film sideways in the widthwise direction.

(b) On this point, the plaintiff alleges that the statements of the scope of claims do not require a perforation to pass transversally in a straight line, or that in light of the technical meaning of the term "perforation," a perforation can be regarded as "crossing" if it extends from one point on the outer edge of the transparent film to another point to allow the separation or break along the line between these points.

With regard to this allegation, even if a "perforation" does not form a straight line but forms

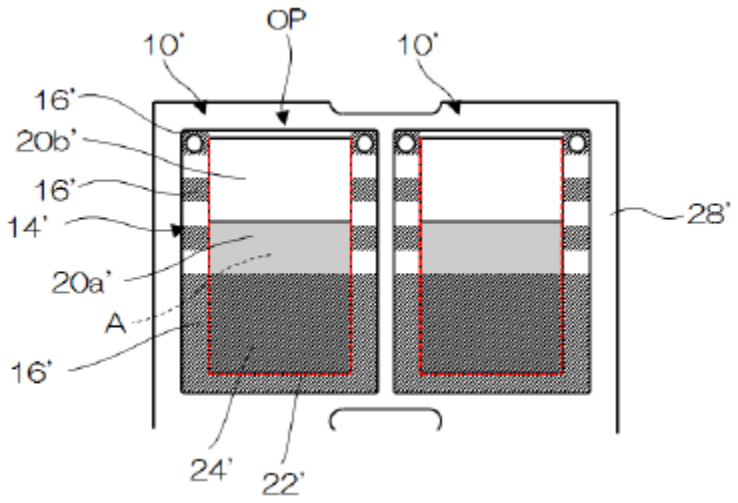
a curved line, for example, as long as it can be regarded as "extending across" the transparent film, it may be justified to consider that such perforation fulfils Constituent Feature 1F.

However, according to the statements of the scope of claims, a perforation must "extend across the transparent film." If a perforation just extends from one point to another point in whatever direction, it cannot be recognized as "extending across" the transparent film. In addition, although the technical scope of a patented invention is generally not limited to the structure of an embodiment disclosed in the detailed explanation of the invention in the description, the Description and Drawings do not disclose any case in which a "perforation" "extending across the transparent film" can solve the problem targeted by Invention 1 except for the embodiment illustrated in FIG.2. Hence, it should inevitably be understood that the structure with a "perforation extending across the transparent film," which a person ordinarily skilled in the art who has accessed the scope of claims and the Descriptions and Drawings would recognize as a structure to solve the problem targeted by Invention 1, would be one with a perforation extending from one end of the transparent film to the other end, crossing the film sideways in the widthwise direction.

Consequently, the plaintiff's allegation mentioned above cannot be accepted.

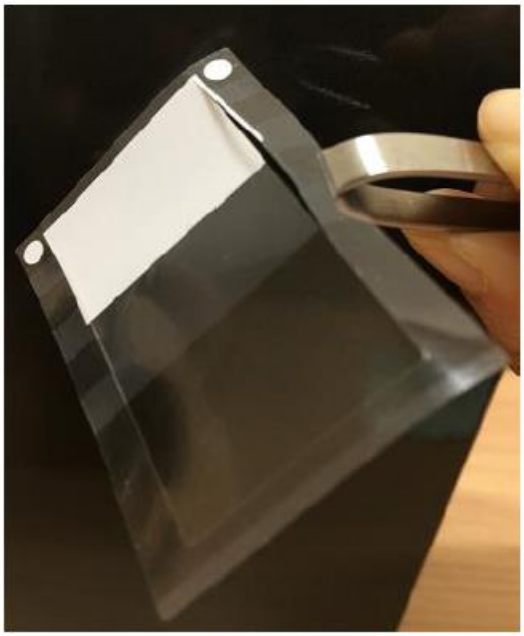
C. Structure of the Defendant's Product

(a) As shown in Attachment 3, the Defendant's Product Description, the Defendant's Product has "a slit 22'" along the red dotted line in the figure below (Figure 1 in Attachment 3, the Defendant's Product Description).



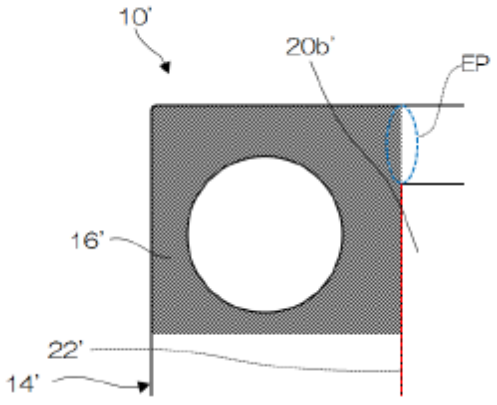
As shown in the photograph below (Photograph 3 in Attachment 3, the Defendant's Product Description), the "slit 22'" causes the film to be broken into several parts just by picking up the label 10' off from the substrate 28' with tweezers, and thus it can be found that the "slit 22'" forms a line along which the film has once been completely broken into several parts and then the parts are barely bonded with an adhesive during the manufacturing process of the

Defendant's Product.



It is obvious that the "slit 22'" as described above cannot be regarded as a "line formed with holes aligning like a dotted line." Such a line along which the parts of the film are barely bonded with an adhesive cannot be deemed to have both a "certain degree of holding force" and "ease of separation," and hence it is not equivalent to a "perforation" in Invention 1.

(b) The plaintiff alleges that even if the "slit 22'" in the Defendant's Product is not equivalent to the "perforation" in Invention 1, the portion consisting of the "slit 22'" and the "end connecting portion EP" (see Figure 2 in Attachment 3, the Defendant's Product Description, below) is equivalent to the "perforation" in Invention 1.



However, it is totally impossible to understand that the portion consisting of the "slit 22'," which forms the shape of a large letter U, and the "end connecting portion EP," which is very short, can be regarded as a "line formed with holes aligning like a dotted line."

Furthermore, even if the portion consisting of the "slit 22"' and the "end connecting portion EP" can be a "perforation," this portion does not extend from one end of the transparent film 14' to the other end, crossing the film sideways in the widthwise direction, and it cannot be regarded as "extending across" the film.

D. Consequently, the Defendant's Product does not fulfil Constituent Feature 1F.

(2) Whether the Defendant's Product fulfills Constituent Feature 1G (Issue 1-4)

Constituent Feature 1G reads "said perforation providing a line of separation of said film." The term "line of separation" is translated into the Japanese term "分断線." From its general meaning (Exhibit Ko 11 [Kojien, 6th edition]), this term can be interpreted as meaning "a line that breaks something organized in a block into several parts."

When the "first adhesive area 16"' is removed after installing the Defendant's Product over the cable, the "end connecting portion EP" is pulled off and the transparent film 14' is cut off. Therefore, the portion consisting of the "slit 22"' and the "end connecting portion EP" may be regarded as a line that cuts off the transparent film 14' but, as mentioned in (1) above, it is not equivalent to the "perforation" in Invention 1.

Consequently, the Defendant's Product does not fulfil Constituent Feature 1G.

(3) Summary on Issue 1

As discussed above, the Defendant's Product does not fulfil, at least, Constituent Features 1F and 1G of Invention 1, and therefore, without needing to consider the issues relating to Constituent Feature 1A (Issue 1-1) and Constituent Feature 1B (Issue 1-2), the Defendant's Product does not fall within the technical scope of Invention 1.

3. Issue 2 (Whether the Defendant's Product falls within the technical scope of Invention 1 as its equivalent)

(1) Five requirements under the doctrine of equivalents

Even if, within the structure stated in the scope of claims, there is a part which is different from a product manufactured, etc. or a process used by the other party to the dispute (hereinafter referred to as a "**product or process in dispute**"), it is reasonable to understand that the product or process in dispute falls within the technical scope of the patented invention as an equivalent to the claimed structure if the following requirements are fulfilled:

[i] said part is not the essential part of the patented invention;

[ii] even if said part is replaced with a part in the product or process in dispute, the purpose of the patented invention can be achieved and the same function and effect can be obtained;

[iii] a person ordinarily skilled in the art to which the invention pertains (hereinafter referred to as a "**person ordinarily skilled in the art**") could have easily conceived of the aforementioned replacement at the time of the manufacturing, etc. of the product or process in dispute;

[iv] the product or process in dispute is neither identical with publicly known art at the time of

the filing of the patent application for the patented invention nor is one which a person ordinarily skilled in the art could have easily presumptively conceived of at the time of said filing; and

[v] there are no particular circumstances, such as that the product or process in dispute was intentionally excluded from the scope of claims in the course of filing a patent application for the patented invention (see 1994 (O) 1083, judgment of the Third Petty Bench of the Supreme Court, February 24, 1998, *Minshu* Vol. 52, No. 1, p. 113 (hereinafter referred to as the "**Supreme Court Judgment on the Ball Spline Bearing Case**"), and 2016 (Ju) 1242, judgment of the Second Petty Bench of the Supreme Court, March 24, 2017, *Saibansho Jiho* No. 1672, p. 3; hereinafter the requirements [i] to [v] are referred to as the "**first requirement**" to the "**fifth requirement**"; it should be noted that since the Patent is accompanied by the priority claim, the factor of "the time of the filing of the patent application" in the fourth requirement is replaced with the First Priority Date).

(2) Differences between Invention 1 and the Defendant's Product

As detailed in 2(1) above, in Invention 1, a "perforation extends across said transparent film" (which means that "a perforation extends from one end of the transparent film to the other end, crossing the film sideways in the widthwise direction," as found and explained in 2(1)B above), whereas in the Defendant's Product, (a) the "slit 22'" forms a line along which the film has once been completely broken into several parts and then the parts are barely bonded with an adhesive, and (b) the portion consisting of the "slit 22'" and the "end connecting portion EP" forms the shape of a large letter U within the transparent film 14'. The Defendant's Product differs from Invention 1 in these two points.

(3) Third requirement under the doctrine of equivalents (easiness of replacement)

A. Meaning of the third requirement under the doctrine of equivalents

In order to prove that the product or process in dispute falls within the technical scope of the patented invention as an equivalent to the structure stated in the scope of claims, a person ordinarily skilled in the art should have been able to easily conceive of the idea of replacing the claimed structure with the structure of the product or process in dispute, at the time of the manufacturing, etc. of the product or process in dispute (third requirement).

The basis for the third requirement is the conception that, from the perspective of the purpose of the Patent Act, social justice, and principle of equity, the substantial value of a patented invention covers the art that a third party can easily conceive of as one that is substantially identical with the structure stated in the scope of claims based on that claimed structure, and that a third party must foresee this (see the Supreme Court Judgment on the Ball Spline Bearing Case).

In that case, the condition that a "person ordinarily skilled in the art" "could have easily

conceived of [the aforementioned replacement] at the time of the manufacturing, etc. of the product or process in dispute" in the third requirement is different from the case where a person ordinarily skilled in the art "would have been able to easily make the invention" based on a publicly known invention, as prescribed in Article 29, paragraph (2) of the Patent Act, or the case where a "person ordinarily skilled in the art" "could have easily presumptively conceived of the product or process in dispute," as referred to in the fourth requirement; it should rather be understood as requiring that any person ordinarily skilled in the art could have conceived of the structure of the product or process in dispute easily as if it were explicitly stated in the scope of claims, or in other words, easily to the extent that such person can recognize it as being substantially identical with the structure stated in the scope of claims (see 1991 (Wa) 10687, judgment of the Tokyo District Court, October 7, 1998, *Hanrei Jiho* No. 1657, p. 122).

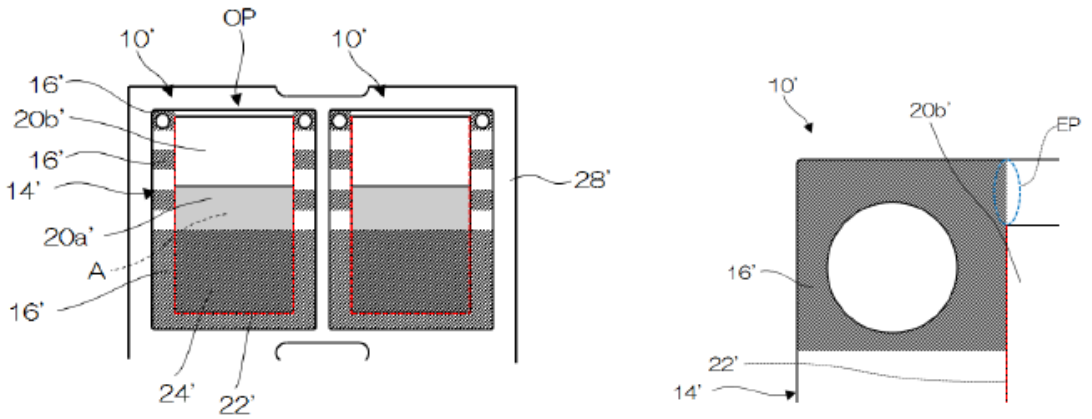
With regard to the condition included in the third requirement, i.e., "[a person ordinarily skilled in the art] could have easily conceived of," the plaintiff alleges that since this condition contains the terms "easily" and "conceive of," whether it is satisfied should be determined according to the same criteria as those applied under Article 29, paragraph (2) of the Patent Act. However, there is no practical reason to consider that the criteria for determining an inventive step, which is an element of patentability required for allowing monopoly on an invention, should be the same as the criteria for determining equivalence, which defines the technical scope of an invention disclosed in the scope of claims. As explained above, if it is possible to conceive of a particular art as one that is substantially identical with the structure stated in the scope of claims based on that claimed structure, even a third party must foresee that the substantial value of the patented invention would cover that art, and this may not be contrary to the publication function that should be performed by a patent claim. However, if the substantial value of a patented invention were to cover not only the structure stated in the scope of claims but also a structure that a person ordinarily skilled in the art "would have been able to easily make" as prescribed in Article 29, paragraph (2) of the Patent Act, a third party would not be able to easily understand the technical scope of the patented invention, causing a situation that is contrary to the publication function that should be performed by a patent claim. Consequently, the plaintiff's allegation mentioned above cannot be accepted.

B. Defendant's Product

As described in (2) above, in Invention 1, a "perforation extends across said transparent film" (which means that "a perforation extends from one end of the transparent film to the other end, crossing the film sideways in the widthwise direction," as found and explained in 2(1)B above), whereas in the Defendant's Product, (a) the "slit 22'" forms a line along which the film has once been completely broken into several parts and then the parts are barely bonded with an adhesive, and (b) the portion consisting of the "slit 22'" and the "end connecting portion EP"

forms the shape of a large letter U within the transparent film 14'. The Defendant's Product differs from Invention 1 in these two points.

Invention 1 provides a rotatable cable marker label by adopting a "perforation" having both a "certain degree of holding force" and "ease of separation" and "extending across the transparent film," so that the label can be wrapped around the cable starting at the first adhesive area and then the print-on area can be separated from the first adhesive area by means of a perforation. In light of the technical meaning of a "perforation," it is obvious that a "certain degree of holding force" of a perforation cannot be obtained just by replacing the perforation with the "slit 22'" by which the film has once been completely broken into several parts. In the case of the Defendant's Product, it is not sufficient to replace the "perforation" with the "slit 22'," but only after the "slit 22'" is bent into a U-shape within the transparent film 14', and then the "end connecting portion EP" is provided at each of its ends and the "first adhesive area 16'" is placed on the outer side of the "end connecting portion EP" and the "slit 22'" in the widthwise direction of the label (as shown below [Figures 1 and 2 in Attachment 3, the Defendant's Product Description]), it is possible to provide a rotatable cable marker label, so that the label can be wrapped around the cable starting at the "first adhesive area 16'" and then the "print-on area 20b'" can be separated from the "first adhesive area 16'."



Even if providing a non-linear, such as a U-shape, line of separation on a label and breaking the label into several parts along the line is well-known art in the technical field relating to labels attached to goods (Exhibits Ko 21 to 30), it can hardly be said that any person ordinarily skilled in the art could have conceived of the structure of the Defendant's Product easily to the extent that such person can recognize as if it were explicitly stated in the scope of claims (the Defendant's Patented Invention was granted a patent through the examination conducted by referring to the invention described in the publication of the Patent as prior art; there is no dispute between the parties regarding the fact that the Defendant's Product is a product that embodies the Defendant's Patented Invention).

The plaintiff alleges that since the structure of the Defendant's Product with the "first adhesive area 16"' being anchored at both corners of the label is included in the technical scope of Invention 1, the motivation to adopt this structure is not necessary. The question here is whether it is easy to conceive of a specific structure that is relevant to the difference between the Defendant's Product and Invention 1 based on the statement of the claim of Invention 1. Since such specific structure is necessarily concerned with the issue of where in the label the "first adhesive area" should be provided, it can hardly be said that a person ordinarily skilled in the art could have recognized the structure of the Defendant's Product as if it were stated in the claim of Invention 1, only on the grounds that the Defendant's Product has a part that could function as the "first adhesive area" in Invention 1 and that providing a U-shaped line of separation is well-known art.

Consequently, the Defendant's Product cannot be found to fulfil the third requirement under the doctrine of equivalents.

(4) Summary on Issue 2

As discussed above, the Defendant's Product does not fulfil, at least, the third requirement under the doctrine of equivalents, and therefore, it cannot be found to fall within the technical scope of Invention 1 as its equivalent.

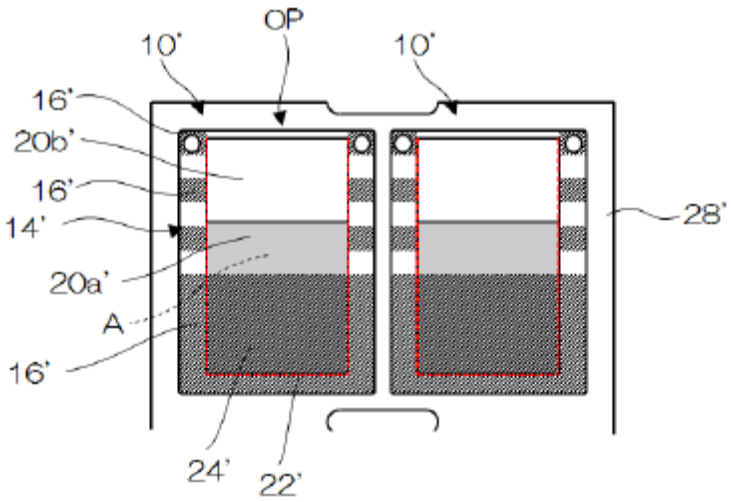
4. Issue 3 (Whether the Defendant's Product literally falls within the technical scope of Invention 26)

(1) Issue 3-1 (Whether the Defendant's Product fulfills Constituent Features 26B, 26C, 26D, and 26F)

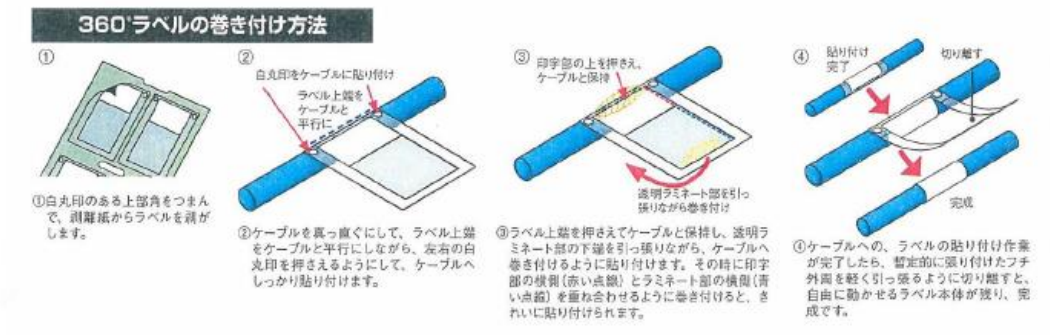
A. "Print-on area located between said first and second adhesive areas"

Constituent Feature 26D reads "[a print-on area on said transparent film,] said print-on area located between said first and second adhesive areas." The phrase "located between" is translated into the Japanese phrase "間に位置する," which means "located at an interval of two things" (Kojien, 6th edition). Accordingly, the "print-on area" in Invention 26 must be located at an interval of the "first adhesive area" and the "second adhesive area."

In the Defendant's Product, the "print-on area 20b"' (indicated as 20b' in the figure below [Figure 1 in Attachment 3, the Defendant's Product Description]) can be regarded as being located at an interval of the "first adhesive areas 16"' (indicated as 16') but can hardly be regarded as being located at an interval of the "first adhesive area 16"' and the "second adhesive area 24'."



The plaintiff alleges that when the label 10' of the Defendant's Product is attached to a cable, the "first adhesive area 16'" is first attached, followed by the "print-on area 20b'" and the "second adhesive area 24'" in this order, and given their respective functions, the "print-on area 20b'" is located between the "first adhesive area 16'" and the "second adhesive area 24'." However, according to evidence (Exhibit Ko 3), the Defendant's Product is used in the manner shown below, and the "first adhesive area 16'" and the "print-on area 20b'" are attached to the cable almost simultaneously. Therefore, it is uncertain whether one can definitely say that the "first adhesive area 16'," the "print-on area 20b'" and the "second adhesive area 24'" are attached to the cable in this order. Even if this point is left aside, it is difficult to consider that one component of a product is "located between two other components" on the basis of the method of using the product although that component cannot be literally described as being "located between" the two other components. Hence, the plaintiff's allegation cannot be accepted.



B. As discussed above, the Defendant's Product does not fulfil, at least, Constituent Feature 26D.

(2) Issue 3-2 (Whether the Defendant's Product fulfills Constituent Feature 26E)

As found and explained in 2(1) above with regard to Invention 1, the term "perforation"

contained in Constituent Feature 26E can be interpreted as meaning a "line formed with holes aligning like a dotted line." Also as found and explained above, neither the "slit 22'" nor the portion consisting of the "slit 22'" and the "end connecting portion EP" in the Defendant's Product is equivalent to the "perforation."

Consequently, the Defendant's Product does not fulfil Constituent Feature 26E.

(3) Summary on Issue 3

As discussed above, the Defendant's Product does not fulfil, at least, Constituent Features 26D and 26E of Invention 26, and therefore, without needing to consider the issues relating to Constituent Features 26B and 26C (the part of Issue 2-1 excluded from discussion) and Constituent Feature 26G (Issue 2-3), the Defendant's Product does not fall within the technical scope of Invention 26.

5. Issue 4 (Whether the Defendant's Product falls within the technical scope of Invention 26 as its equivalent)

As mentioned in 4. above, Invention 26 has a "print-on area located between said first and second adhesive areas" (Constituent Feature 26D) and a "perforation" (Constituent Feature 26E), and the Defendant's Product differs from it at least on the following two points: (a) the "print-on area 20b'" cannot be regarded as being located between the "first adhesive area 16'" and the "second adhesive area 24'"; and (b) neither the "slit 22'" nor the portion consisting of the "slit 22'" and the "end connecting portion EP" in the Defendant's Product is equivalent to the "perforation."

With regard to the former different feature, that is, the "print-on area 20b'" in the Defendant's Product cannot be regarded as being located between the "first adhesive area 16'" and the "second adhesive area 24'," the plaintiff does not allege that this feature fulfils any of the requirements under the doctrine of equivalents.

Furthermore, even when this point is left aside, for the same reasons as those found and explained in 3. above, it can hardly be said that it is possible to recognize the structure of the Defendant's Product regarding the latter different features as if it were stated in the claim of Invention 26, and that structure does not fulfil at least the third requirement under the doctrine of equivalents.

Consequently, the Defendant's Product cannot be found to fall within the technical scope of Invention 26 as its equivalent.

6. Conclusion

As shown above, without needing to examine other issues, all of the plaintiff's claims are groundless, and therefore, the court shall dismiss these claims and render a judgment in the form of the main text.

Tokyo District Court, 29th Civil Division

Presiding judge: SHIMASUE Kazuhide

Judge: AMANO Kenji

Judge SASAMOTO Tetsuro was unable to sign and seal due to a transfer of position.

Presiding judge: SHIMASUE Kazuhide

(Attachment 1)

List of Product

Product name: TABTAG Label 360 degree label
(self-laminating type)
Product number: TAGN71T-4010

End

(Attachment 2) omitted

(Attachment 3)

Defendant's Product Description

1. The Defendant's Product is photographed and illustrated as in Photographs 1 to 3 and Figures 1 and 2.

2. The structure of the Defendant's Product is explained below, in line with the constituent features of Invention 1.

1a: A label 10' is a self-laminating rotating cable marker label for identifying a cable, comprising a transparent film 14' having a first adhesive area 16'.

1b: The transparent film 14' has non-adhesive areas 20a' and 20b', which are at least partially adjacent to the first adhesive area 16'.

1c: The transparent film 14' has a second adhesive area 24', which is at least partially adjacent to the non-adhesive areas 20a' and 20b'.

1d: The second adhesive area 24' of the transparent film 14' at least partially overlies the non-adhesive area 20a' when the transparent film 14' is wrapped over a cable.

1e: The transparent film 14' has a print-on area 20b' on one of its sides.

1f: On the transparent film 14', there is a slit 22' that runs along the red dotted line in Figure 1.

1g: The transparent film 14' is broken along the slit 22'.

1h: The Defendant's Product is a self-laminating rotating cable marker label as characterized above.

3. The structure of the Defendant's Product is explained below, in line with the constituent features of Invention 26.

26a: A plurality of labels 10', which are self-laminating rotating cable marker labels, are adhered in an array on a substrate 28'.

26b: Each label 10' comprises a transparent film 14' having a first adhesive area 16' and a second adhesive area 24'.

26c: The label 10' comprises smooth non-adhesive areas 20a' and 20b'.

26d: The transparent film 14' of the label 10' has a print-on area 20b' thereon. The locations of the first adhesive area 16', the second adhesive area 24', and the print-on area 20b' are as indicated in Figure 1.

26e: A slit 22' that runs along the red dotted line in Figure 1 is provided within the transparent

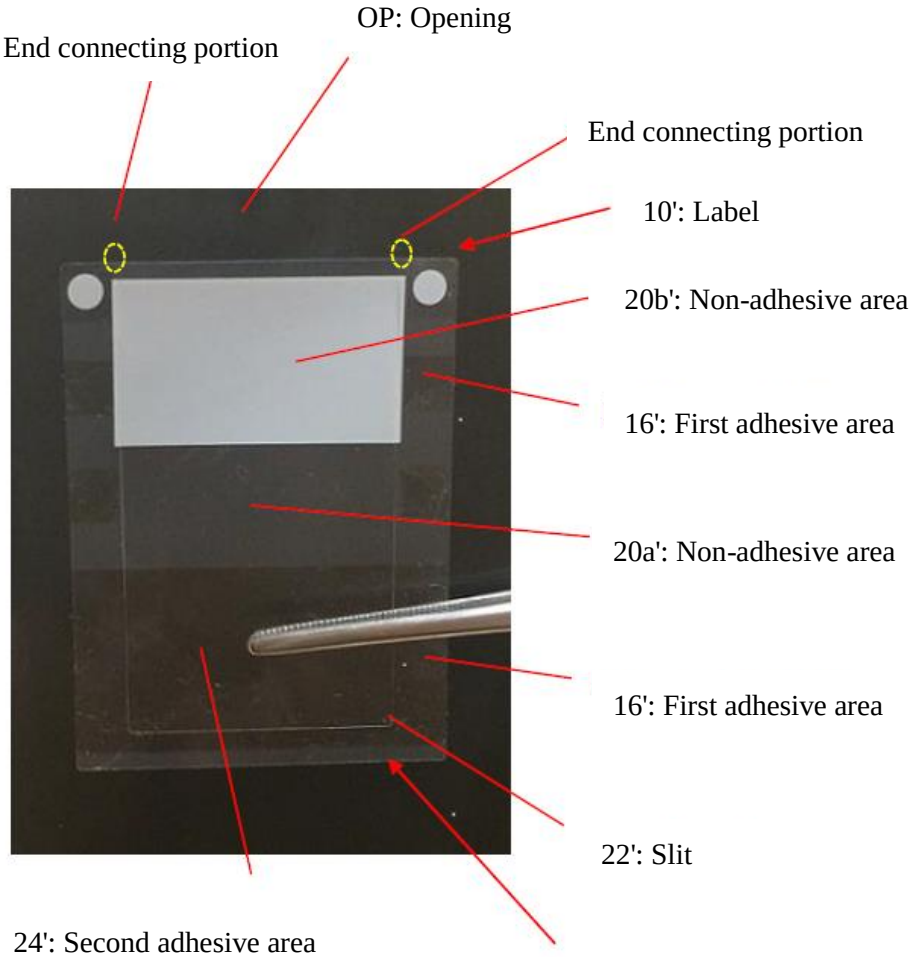
film 14' of the label 10'.

26f: The first adhesive area 16' and the second adhesive area 24' of the transparent film 14' are removably adhered to the substrate 28'.

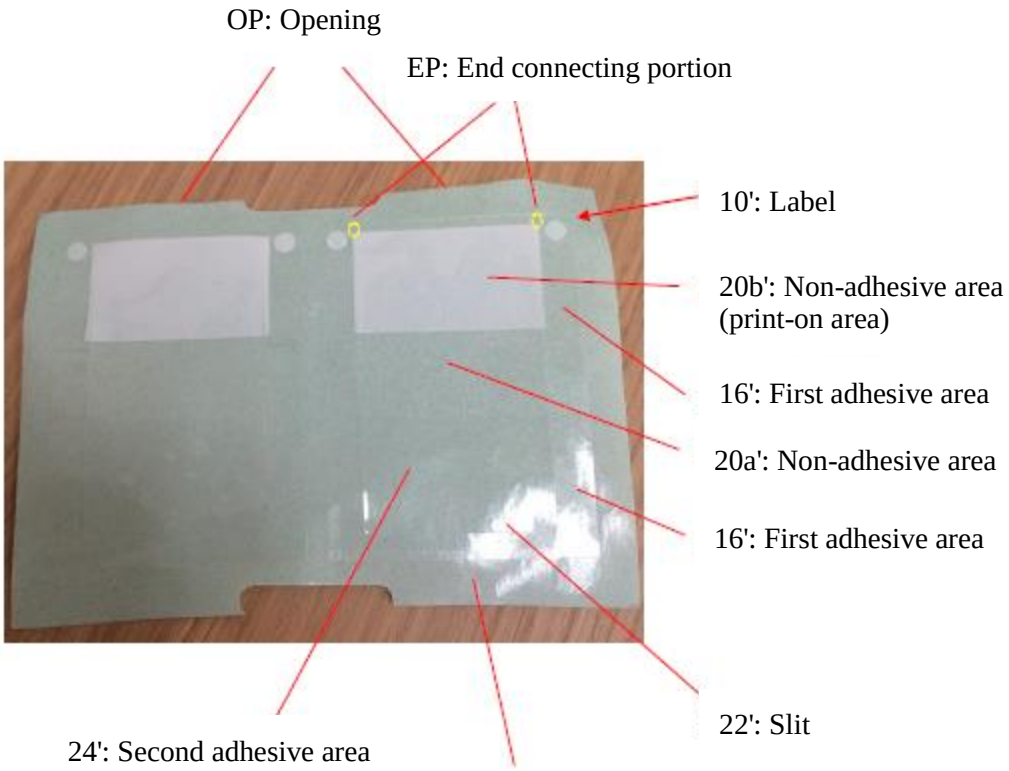
26g: The transparent film 14' is not adhered to the substrate 28' at an opening OP.

26h: The Defendant's Product is a plurality of self-laminating rotating cable marker labels as characterized above.

Photograph 1 (Defendant's Product peeled off from the release paper and held up with tweezers against a black background)



Photograph 2 (Defendant's Product adhered to the release paper)



Photograph 3 (Defendant's Product held against a black background by picking up the first adhesive area 16')

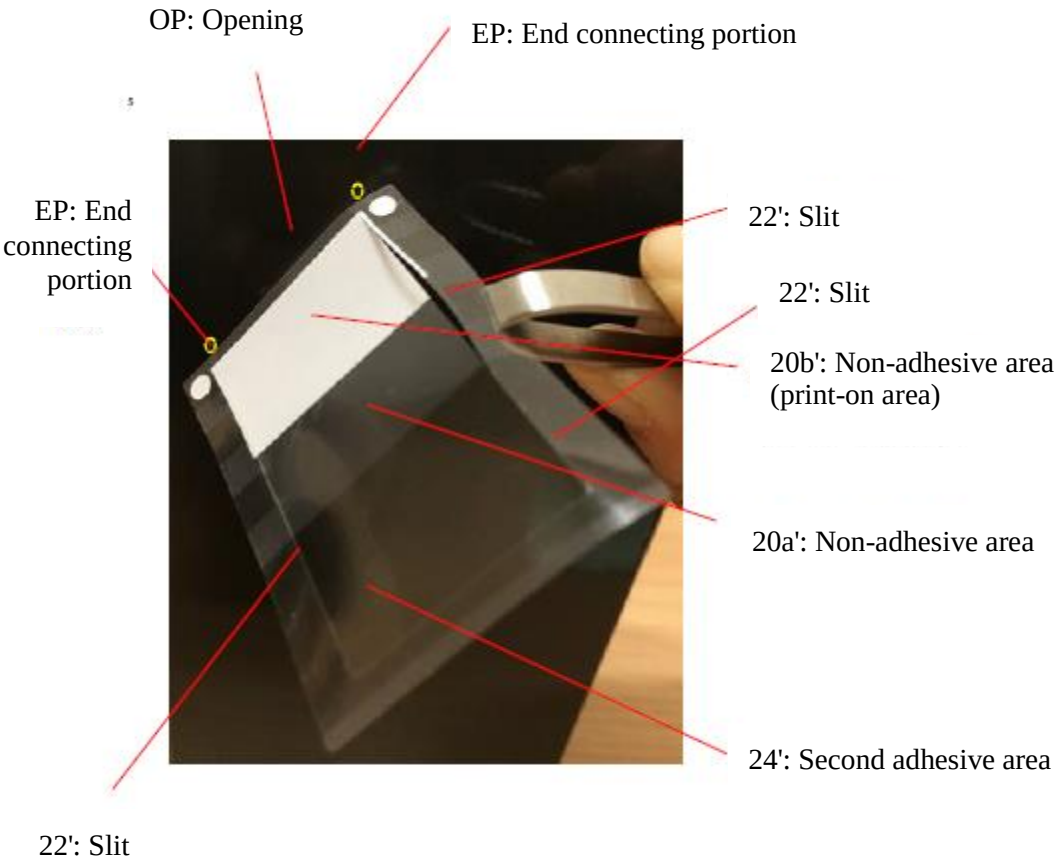
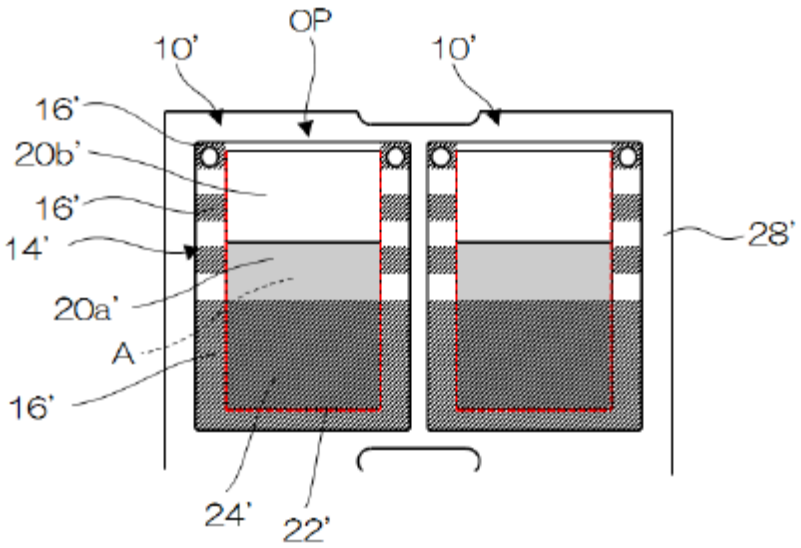


Figure 1



An adhesive is applied to the slashed areas with signs "16'" and "24'" on their sides facing the substrate (28').

Figure 2 (Enlarged view of the area of the Defendant's Product where there is a white circle)