

Date	January 22, 2015	Court	Tokyo District Court, 47th Civil Division
Case number	2012 (Wa) 15621		
– A case in which the court dismissed the plaintiff's claim for an injunction against the production, etc. of Cu-Ni-Si alloys, which was filed based on a patent right for an invention titled "Cu-Ni-Si alloy with excellent strength and bending workability."			

### Summary of the Judgment

The plaintiff, who holds a patent right for an invention titled "Cu-Ni-Si alloy with excellent strength and bending workability" (the "Invention"), alleges that the defendant's production, sale, etc. of Cu-Ni-Si alloys (the "Defendant's Products") constitutes infringement of the plaintiff's patent right. Based on this allegation, the plaintiff filed this action against the defendant to seek an injunction against the production, use, assignment, and offer for assignment of the Defendant's Products.

In this judgment, the court first identified the Defendant's Products based on the model codes of the defendant's two kinds of alloys (Defendant's Alloys 1 and 2). The court then ruled that the plaintiff's method of identifying the Defendant's Products by limiting them to those that fulfill Constituent Feature D of the Invention is legitimate but that in the case based on such identification, whether the Defendant's Products fall under the technical scope of the Invention should be determined in relation to Defendant's Alloys 1 and 2. After that, the court ruled that only one of the samples of Defendant's Alloys 1 and 2, respectively, fulfills Constituent Feature D, which prescribes the local maximum value of X-ray random intensity ratio of alloy but that there are no other samples of Defendant's Alloys 1 and 2 that fulfill Constituent Feature D. Based on this ruling, the court determined that only the aforementioned one sample of Defendant's Alloys 1 and 2, respectively, falls under the technical scope of the Invention. In addition, the court determined that the patent in question is not recognized as one that should be invalidated by a trial for patent invalidation. Furthermore, the court cast aside the defendant's allegation that the defendant has a non-exclusive license based on prior use. However, the court determined that an injunction cannot be granted against the Defendant's Products as identified by the plaintiff, comprehensively taking the following circumstances into account: [i] Out of the samples of Defendant's Alloys 1 and 2, only the aforementioned one sample of Defendant's Alloys 1 and 2, respectively, fulfills Constituent Feature D, and other samples do not fulfill it; in addition, the defendant is not recognized as manufacturing Defendant's Alloys 1 and 2 with the intention of keeping the local maximum value of X-ray random intensity ratio within the scope of Constituent Feature D; therefore, the

defendant is not recognized as being highly probable to manufacture Defendant's Alloys 1 and 2 which fulfill Constituent Feature D; [ii] Granting an injunction against the Defendant's Products is likely to be an excessive injunction because at which part of the Defendant's Products the local maximum value of X-ray random intensity ratio should be measured is unclear; [iii] Granting an injunction against the Defendant's Products will force the defendant to bear a heavy burden, and this lacks equity. Based on this determination, the court ended up dismissing the plaintiff's claim.