Judgment rendered on February 1, 2005, the original received on the same date, Court Clerk

2004 (Wa) 16732 Case of Seeking an Injunction against Infringement of a Patent Right

Date of conclusion of oral argument: November 30, 2004

Judgment

Plaintiff: Matsushita Electric Industrial Co., Ltd.

Representative Director: X

Counsel attorney: OHNO Seiji

Patent attorney as an assistant in court: TANAKA Hisako

Defendant: JustSystems Corporation

Representative Director: Y

Counsel attorney: FUKUSHIMA Eiichi

Same as above: SUGA Hiroshi

Same as above: NAGATA Sanae

Same as above: OMUKAI Naoko

Patent attorney as an assistant in court: KIMURA Mitsuru

Same as above: ISHII Yuichiro

Same as above: AMEMIYA Yasuhito

Main text of the judgment

1. The defendant shall not engage in manufacturing, assigning, etc. (assigning, leasing, or providing through an electric telecommunication line), or offering for assignment, etc. the products specified in attached Product Lists (A) and (B).

2. The defendant shall dispose of the products specified in the preceding paragraph.

3. The defendant shall bear the court costs.

Facts and reasons

No. 1 Claims

The same as those stated in the "Main text of the judgment."

No. 2 Background

1. Facts, etc. undisputed by the parties

(1) Parties concerned

The plaintiff is a stock company engaged in the manufacturing, sale, etc. of video and audio equipment, home electrical appliances, information and communication equipment, etc. as a business.

The defendant is a stock company incorporated for the purpose of the development, sales, etc. of computer systems.

(2) Patent right of the plaintiff

The plaintiff has the following patent right (the "Patent Right"; the invention described in Claim 1 shall be referred to as "Invention 1," the invention described in Claim 2 shall be referred to as "Invention 2," and the invention described in Claim 3 shall be referred to as "Invention 3": the three inventions shall be collectively referred to as the "Inventions"; the description concerning the Invention shall be referred to as the "Description" (Exhibit Ko No. 13-13; please refer to the attached patent gazette)).

Patent No.: 2803236

Title of the Invention: Equipment and method of information processing

Application filing date: October 31, 1989

Application number: Patent Application No. 1989-283583

Publication date: June 20, 1991

Publication Number: Publication of Unexamined Patent Application No. 1991-144719

Registration date: July 17, 1998

Claim 1

An information processing device characterized by having [i] a display means to display on the display screen an icon 1, which triggers the execution of the function which displays the functional description of an icon, and an icon 2, which triggers the execution of the predetermined information processing function, [ii] a selection means to select an icon displayed on the display screen of said display means, and [iii] a control means to display the functional description of said icon 2 on the display screen of said display means in response to the selection of the icon 2 immediately after the selection of an icon 1 by said selection means.

Claim 2

The information processing device described in Claim 1, which is characterized by the process where, if an icon 2 is not selected by said selection means immediately after the selection of an icon 1, said control means would execute the predetermined information processing function of said icon 2.

Claim 3

An information processing method that is designed to control a device equipped with a data input device and a data display device and that is characterized by the process where, on the display screen, which displays an icon 1, which triggers the execution of the function of displaying a functional description, and an icon 2, which triggers the execution of the predetermined information processing function, the

functional description of said icon 2 is displayed in response to the selection of the icon 2 immediately after the selection of the icon 1.

(3) Decomposition into the constituent features

A. Invention 1 may be decomposed into the following constituent features:

1-A. A display means to display on the display screen an icon 1, which triggers the execution of the function of displaying the functional description of an icon, and an icon 2, which triggers the execution of the predetermined information processing function;

1-B. A selection means to select an icon displayed on the display screen of said display means;

1-C. A control means to display the functional description of said icon 2 on the display screen of said display means in response to the selection of the icon 2 immediately after the selection of an icon 1 by said selection means;

1-D. An information processing device characterized by having 1-A. to 1-C. above

B. Invention 2 may be decomposed into the following constituent features:

2-A. The process where, if an icon 2 is not selected by said selection means immediately after the selection of an icon 1, said control means would execute the predetermined information processing function of said icon 2;

2-B.The information processing device described in Claim 1 which is characterized by 2-A. above

C. Invention 3 may be decomposed into the following constituent features:

3-A. An information processing method that is designed to control a device equipped with a data input device and a data display device;

3-B. On the display screen, which displays an icon 1, which triggers the execution of the function of displaying a functional description, and an icon 2, which triggers the execution of the predetermined information processing function;

3-C. The functional description of said icon 2 is displayed in response to the selection of the icon 2 immediately after the selection of an icon 1;

3-D. An information processing method characterized by 3-A. to 3-C. above

(4) Defendant's act

The defendant has been engaged in manufacturing, assigning, etc. (assigning, leasing, or providing through an electric telecommunication line) or offering for assignment, etc., the products stated in attached Product Lists (A) and (B).

Any user who was assigned or otherwise given the defendant's product has installed it in his/her computer and has been using it. On the computer into which the defendant's product has been installed, the help function is carried and displayed as described in attached Product Lists (A) and (B).

2. In this court case, the plaintiff alleged against the defendant that the defendant's act specified in 1.(4) above constitutes infringement of the Patent Right and sought an injunction against the manufacturing, assignment, etc. of the defendant's product and demanded disposal thereof under Article 100 of the Patent Act.

3. Issues

(1) whether the "help mode" button and the "print" button displayed on a computer into which the defendant's product has been installed may be regarded as "icons" mentioned in the constituent features in question

(2) whether the defendant's act constitutes indirect infringement (Article 101, items (ii) and (iv) of the Patent Act)

(3) whether it is obvious that there is a reason for invalidation of the patent in question (the "Patent")

No. 3 Allegations of the parties concerned regarding the issues

1. Issue (1) (the fulfillment of the constituent features)

[Plaintiff's allegation]

Since the "help mode" button and the "print" button displayed on a computer into which the defendant's product has been installed may be regarded as "icon," any computer to which the defendant's product has been installed satisfies all of the constituent features of the Inventions.

(1) Meaning of "icons" in the Inventions

The term "icons" in the Inventions means a "pictures or pictographs displayed on a display screen as representations of various data and processing functions."

Although the defendant argued that the term "icons" means "'draggable' or 'movable' pictures or pictographs placed 'on a desktop' as representations of various data and processing functions in order to carry out commands." However, the information contained in a document (Exhibit Ko No. 15) available as of the time of the filing of an application to obtain the Patent (the "Patent Application") clearly reveals that, at the time of the filing of the Patent Application, any person ordinarily skilled in the art recognized any "pictures or pictographs displayed on a display screen as representations of various data and processing functions" as "icons" regardless of whether those icons were draggable or movable or not and whether they were placed on a desktop or in a window. Therefore, such limited interpretation as mentioned above is unacceptable.

(2) Issue of whether the "help mode" button and the "print" button of the defendant's product may be regarded as "icons"

The icons of "help mode" button and the "print" button of the defendant's product may be regarded as "icons" of the Inventions because the icons of said buttons are

"pictures or pictographs displayed on a display screen as representations of various data and processing functions."

Although the "help mode" button of the defendant's product itself is not movable, if a user clicks the "help mode" button with a mouse, the arrow-shaped cursor transforms into an arrow with a "?" mark. This cursor with a "?" mark is movable. If a user clicks the "print" button with the cursor with a "?" mark, a description of the "print" button will be displayed. Therefore, while the "help mode" button of the defendant's product itself is not movable, it may be regarded as an "icon" that can be placed over another icon. In this sense as well, no one doubts that the defendant's product contains what may be regarded as "icons" of the Inventions.

Furthermore, the "help mode" button and the "print" button of the defendant's product can be moved up and down as a "group of icons" if dragged with a mouse. Thus, it is clear that the "help mode" button and the "print" button of the defendant's product may be regarded as "icons" even if we examine the issue of whether those bottoms may be regarded as "icons" from the perspective of movability as alleged by the defendant.

(3) Defendant's allegation (3)

The defendant alleged that, in order to be recognized as "icons" of the Inventions, it is necessary that icons are used in a modeless environment. However, the plaintiff merely stated that "in a modeless environment as icons" as a premise for its argument concerning the issue of whether the Inventions could have been easily conceived of by any person ordinarily skilled in the art. Therefore, this statement does not limit the scope of the concept of "icons."

[Defendant's allegation]

Since the "help mode" button and the "print" button displayed on a computer into which the defendant's product has been installed may not be regarded as "icons," the computer into which the defendant's product has been installed does not satisfy the constituent features of the Inventions.

(1) Meaning of "icons" of the Inventions

"Icons" are "draggable" or "movable" pictures or pictographs placed "on a desktop" as representations of various data and processing functions that are used to carry out commands.

In other words, although the Description does not contain any statement that directly defines "icons," Figure 2 of the Description was prepared on the premise that "icons" are draggable or movable. Also, around the time of filing the Patent Application, documents (Exhibits Otsu No. 2 to No. 4) were created on the premise that "icons" are draggable or movable.

Furthermore, around the time of the filing of the Patent Application, "icons" mean pictures or pictographs displayed on a desktop as representations of various data and processing functions that are used to carry out commands. Any pictograph that is not directly displayed on the desktop (pictograph, etc. in a window) should be regarded as a mere "mark" or "button" even if it may be regarded as a "pictograph" and should not be considered as an "icon" (Exhibit Ko No. 13-44).

(2) Interpretation that the "help mode" button and the "print" button of the defendant's product may not be regarded as "icons"

As described above, "icons" mean draggable or movable pictures or pictographs displayed on a desktop as representations of various data and processing functions that are used to carry out commands. On the other hand, the "help mode" button and the "print" button of the defendant's product are not only undraggable and unmovable but also placed in a separate window displayed on a desktop. Since it is obvious that said buttons do not exist on a display screen, i.e., desktop, the "help mode" button and the "print" button displayed on a computer into which the defendant's product has been installed may not be regarded as "icons."

(3) It may be interpreted that the plaintiff requires the "icons" of the Inventions to be used in a modeless environment.

2. Issue (2) (indirect infringement)

[Plaintiff's allegation]

(1) Since any computer into which the defendant's product has been installed satisfies the constituent features of the Inventions, the user's act of purchasing the defendant's product and installing it into his/her computer and using said computer constitutes an act of producing a product embodying Inventions 1 and 2 and using the process embodying Invention 3 and therefore constitutes an act of direct infringement.

(2) Since the problem to be solved by the Inventions may be solved by installing the defendant's product into a computer, the defendant's product is essential to solve the problem to be solved by the Inventions. The defendant's product is different from any of the standardized or widely-used products marketed in Japan, such as screws, nails, electric bulbs, transistors, etc., but is a special product made for the purpose of solving the problem by use of the Inventions. Therefore, the defendant's product may not be considered to be a product widely distributed in Japan.

(3) Defendant's allegation

The defendant alleged that, in consideration of the facts that the functions of the defendant's product described in attached Product Lists (A) and (B) are the functions of Microsoft Windows and that its help display program, etc. may be used even when

another application software is being executed, said functions may be considered to be executed regardless of whether the defendant's product has been installed or not. The defendant further alleged that the installation of the defendant's product into a computer has nothing to do with the resolution of the problem to be solved by the Inventions.

However, even if the help display program, etc. are functions of Windows, unless the defendant's product is designed to use such Windows functions, the functions described in attached Product Lists (A) and (B) could not be performed. In other words, the display screen described in said Product Lists itself would not appear on any computer into which the defendant's product has not been installed. The functions described in attached Product Lists (A) and (B) that can be performed on the display screen would become available on a computer only if the defendant's product is installed into the computer.

It should be noted, first of all, that the act of direct infringement disputed in this court case is an act of installing the defendant's product into a computer, in other words, an act of producing a computer that displays the screen described in said attached Product Lists (A) and (B) in which the functions described in said lists can be performed, and is not an act of producing a computer in a general, abstract sense, as alleged by the defendant, that allows the execution of the function described to be "if a user selects the 'help mode' button and then another button, the description of said another button would be displayed."

As mentioned above, since a computer into which the defendant's product has been installed infringes the Patent Right and solves the problem to be solved by the Inventions, the infringement alleged by the plaintiff would not occur if the defendant's product is not installed into a computer. Therefore, the defendant's product may be regarded as essential for resolution of the problem.

(4) The defendant has been aware, at least since the time of the service of a petition for an order of provisional disposition (Exhibit Ko No. 13-1) concerning another case filed by the plaintiff on November 7, 2002, that the Inventions are the defendant's patented inventions and that the defendant's product has been used to work the Inventions.

(5) Therefore, the defendant's act of engaging in manufacturing, assignment, etc., or offering for assignment, etc. of the defendant's product as a business satisfies the requirement specified in Article 101, items (ii) and (iv) of the Patent Act and constitutes indirect infringement of the Patent Right.

[Defendant's allegation]

The defendant's product may not be considered to be "essential for the resolution of the problem by the invention." "A thing that is essential for the resolution of the

problem by an invention" means some goods without which the "problem to be solved by an invention" cannot be solved. The problem to be sold by the Inventions is the "inability to receive a functional description service when a user forgets or does not know a keyword (if the conventional method is adopted)." The function that the plaintiff alleged as the function of the defendant's product is a function of the operating system of Microsoft Windows. The help display program, etc. can be used even when another application software is being executed. Regardless of whether the defendant's product has been installed or not, the function described as "if a user selects the 'help mode' button and then another button, the description of said ‘another button’ would be displayed" can be executed.

Therefore, the installation of the defendant's product has nothing to do with the resolution of the problem, i.e., the "inability to receive a functional description service when a user forgets or does not know a keyword (if the conventional method is adopted)." It cannot be said that the problem to be solved by an invention cannot be solved without using the defendant's product. Thus, since the defendant's product may not be considered to be "essential for the resolution of the problem by an invention," the defendant's act does not constitute indirect infringement.

3. Issue (3) (Abuse of rights)

[Defendant's allegation]

The Inventions could have been easily made by any person ordinarily skilled in the art based on the inventions described in publications, etc. distributed in Japan prior to the filing of the Patent Application and therefore cannot be patented under Article 29, paragraph (2) of the Patent Act. Since there is a clear reason for invalidation of the Patent, any claim made based on the Patent is unacceptable as an abuse of rights.

(1) Invention 1

A. Exhibit Ko No. 13-25

The Patent Gazette No. 1986-281358 (Exhibit Ko No. 13-25; the "cited reference") publicized on December 11, 1986, which preceded the filing of the Patent Application, disclosed that "a functional description display method of a word processor equipped with an input means having character/sign keys, function keys to order some editing processes such as deletion and insertion, and operation instruction keys, as well as a display means to display a document or operational guidance in response to the information input by use of said input means. Said method may be characterized by the process where the pressing of an operation instruction key and a function key in succession will display on said display means a description of the editing processing function selected by said function key."

The cited reference shows the operation instruction key that corresponds to the "icon 1" of Invention 1 and also shows a "function key" that corresponds to an "icon 2." However, the two are the same in terms of the constituent features except for the feature where, while a user displays the "icon 1" and an "icon 2" on a display screen and then displays a description by selecting with a mouse the "icon 2" immediately after the "icon 1" in Invention 1, a user carries out the same task by pressing keys on an actual keyboard in the cited reference.

B. Combination of the cited reference, Exhibit Otsu No. 5 and Exhibit Ko No. 13-27

"JStar Workstation" (Exhibit Otsu No. 5; "Publication 1" issued on April 25, 1986) discloses a technology concerning the relationships between an actual keyboard and the marks displayed on the screen. Said technology allows a user to display pictures or pictographs on a screen as the marks that correspond to the keys on an actual keyboard (such keyboard displayed on a screen shall be referred to as a "virtual keyboard") and to select a key on a virtual keyboard with a mouse instead of pressing said key. Therefore, Publication 1 may be considered to have disclosed that the "pressing of a key on an actual keyboard" may be replaced by the "selection, with a mouse, of a mark that is displayed on a screen in the form other than characters, such as a picture or pictograph."

Furthermore, page 128 of "Nikkei Baito" (Exhibit Ko No. 13-27, "Publication 2" issued in May 1986) discloses that the "operation that can be done by use of an actual keyboard" may be replaced by the "selection, with a mouse, of a mark that is displayed on a screen in the form of a picture or pictograph."

Thus, by combining the cited reference about keys on a keyboard with Publications 1 and 2, any person ordinarily skilled in the art could have easily conceived of the technology that allows a user to display a description by displaying on a screen the "icon 1," which corresponds to the "operation instruction key," and an "icon 2," which corresponds to a "function key," and then "pressing the function key or selecting the icon 2 with a mouse" immediately after "pressing the operation instruction key or selecting an icon 1 with a mouse,"; or, to be more specific, Invention 1, which allows a user to display a description by displaying the "icon 1" and an "icon 2" on the screen and "selecting an icon 2 with a mouse" immediately after "selecting the icon 1 with a mouse."

C. Combination of the cited reference, Exhibit Ko No. 13-26 and Publication 2

Pages 33 and 34 of the "Ichitaro Ver. 4 Katsuyohen" (How to Use Ichitaro Ver. 4) (Exhibit Ko No. 13-26, "Publication 3" issued on April 14, 1989) state that the direct clicking of a mark on a screen constitutes the same operation as the pressing of the corresponding key.

Publication 2 states that a user may input selection information either by clicking on an "icon or button" or pressing a "key."

As of the time of the filing of the Patent Application, Publications 2 and 3 made publicly known the technology that allows a user to either select a key on a keyboard instead of selecting a button on a screen or, vice versa, to select a button on a screen instead of selecting a key on a keyboard. Since an icon and a key are interchangeable, any person ordinarily skilled in the art could have easily conceived of Invention 1, which is about icons on a display screen, by combining the cited reference concerning keys with Publications 2 and 3.

As described above, if a key on a keyboard and a mark displayed on a screen in the form of a picture or pictograph are interchangeable, any person ordinarily skilled in the art could have easily conceived of Invention 1. Furthermore, there is a prior art document concerning the use of a picture or pictograph as a key on a keyboard (Exhibit Ko. No. 13-44). If a keyboard consisting of keys carrying characters is presented as a virtual keyboard of JStar, since the same characters are used in principle (Exhibit Otsu No. 5), the idea of using the same pictures or pictographs could have been even more easily conceived of by any person ordinarily skilled in the art when a keyboard consisting of keys carrying pictures or pictographs is presented as a virtual keyboard.

(2) Invention 2

In the case of Invention 2, the Description has not disclosed anything about whether the effect of the selection of an icon 1 could be canceled by the selection of any icon other than an icon 2. Therefore, Invention 2 may not be considered to have realized "automatic recovery from the mode." Furthermore, the case where an icon 2 is not selected immediately after the selection of an icon 1 may be interpreted as the case where the selection of an icon 2 is the first selection or the case where the selection of an icon 2 occurs immediately after the selection of another icon 2. Since both of these cases had already been disclosed in the cited reference, these could have been easily conceived of by any person ordinarily skilled in the art as of the time of the filing of the Patent Application.

(3) Invention 3

Invention 3 is the invention to make Invention 1, which is an invention of a product, i.e., a data processing device, into an invention of a process, i.e., the data processing method. As mentioned with regard to Invention 1, Invention 3 could have been easily conceived of by any person ordinarily skilled in the art based on the prior arts described in the cited reference, Publication 1, etc.

(4) Plaintiff's allegation (2) (Difference A described below)

A. What the plaintiff pointed out, as Difference A described below, can be summed up to be that the function keys on a virtual keyboard are described in such a way that they are differentiated from "icons."

However, Publication 1 does not refer to the function keys on a virtual keyboard as "icons" probably because it wasn't certain whether said keys were movable or not. If immovable marks fall within the scope of the definition of "icons," the function keys on a virtual keyboard may also be regarded as "icons," which makes it clear that function keys and "icons" are interchangeable.

Therefore, any person ordinarily skilled in the art could have easily conceived of Invention 1 by combining the technologies described in the cited reference, Publication 1, etc.

B. Meanwhile, since the cited reference discloses the case where the operation instruction key and a function key are pressed in an opposite order, any person who exercises an ordinary level of creativity, such as in making changes to the design, could have easily conceived of the idea of creating an icon 1, which is designed to trigger the execution of the function of displaying the functional description of an icon, as the icon to be selected prior to an icon 2.

Moreover, any person ordinarily skilled in the art as of the time of the filing of the Patent Application could have easily conceived of the idea of creating the icon 1, which is designed to trigger the execution of the function of displaying the functional description of an icon, as the icon to be selected prior to an icon 2, because such person must have learned from Exhibit Ko No. 14-1 that, although the modeless conversation system, under which a user first selects an icon (object) and then selects an icon that triggers the execution of its function, is more useful in many cases, the mode type conversation is preferable depending on the function or is inevitable in terms of design.

(5) Plaintiff's allegation (3) (Difference B described below)

The control flow that corresponds to "immediately after" is the same as the key input control flow described in the cited reference in terms of function and effect.

In other words, the Description does not disclose at all what should follow after the selection of any icon other than an icon 2 immediately after the selection of an icon 1. Therefore, any claim made based on the assumption that "any icon other than an icon 2 is selected," which is not disclosed in the Description, should be found unacceptable.

According to Exhibit Ko No. 14-1, it is clear that any person ordinarily skilled in the art as of the time of the filing of the Patent Application could have easily conceived of the process where the function-first type procedure is also applied to icons.

The plaintiff alleged that, since the effect of pressing the operation instruction key

described in the cited reference remains until a functional key is pressed, it is different from Invention 1. However, said control flow is merely one of the embodiments. The cited reference does not describe any cases where the operation instruction key is pressed by mistake. In contrast, in the case of Invention 1, there are no constituent features that require "limitations should be imposed." Also, no limitations are imposed on the case where any "icon other than an icon 2 is selected." Therefore, this includes the technology where a user's act of mistakenly selecting the icon 1 leads to the unwanted display of an operation instruction.

Therefore, it may not be said that it is clear that Invention 1 has created the control flow that is much more convenient than the one described in the cited reference.

[Plaintiff's allegation]

The Inventions involve inventive steps and it may not be said that it is clear that there are reasons for invalidation of the Inventions.

(1) There are at least the following differences between Invention 1 and the cited reference.

A. While the cited reference describes the operation instruction key, it does not describe Constituent Feature 1-A of Invention 1 "an icon 1 designed to trigger the execution of the function of displaying the functional description of an icon."

B. The control flow described in the cited reference that "if said function key is pressed immediately after said operation instruction key" is different from the control flow of Invention 1 described as "in response to the selection of an icon 2 immediately after the selection of an icon 1."

(2) Difference A

A. The defendant alleged that any person ordinarily skilled in the art could have easily conceived of Invention 1 concerning icons on a display screen based on the cited reference concerning keys on a keyboard since Publication 1, etc. discloses that the "operation of a key on an actual keyboard" may be replaced by the "selection, with a mouse, of a mark that is displayed on a screen in the form of a picture or pictograph."

However, pressing of a key is not something that can be simply replaced with the selection of an icon in a comprehensive manner. The idea presented in the cited reference that an operation instruction will be displayed regardless of which key: the operation instruction key or a function key, is pressed first as long as the two keys are pressed in succession was formed only because a keyboard, which has a fixed number of keys in predetermined places, is at issue. In the case of icons, which are highly flexible in terms of their number and positions on a screen, it is necessary to examine various issues different from those related to the keys on a keyboard.

Thus, when we discuss the issue of an inventive step of Invention 1, we need to examine on a case-by-case basis whether any person ordinarily skilled in the art could have easily conceived of the replacement of a key with an icon.

B. Publication 1 (Exhibit Otsu No. 5) describes a JStar's independently developed "virtual keyboard" where a software keyboard corresponding to an actual keyboard was created on a screen. This virtual keyboard was presented in a specialized window display on a screen separately from other windows. The window for specifically presenting the virtual keyboard displays a group of keys that are completely identical with those positioned in the "key area (Fig. 7.2)" of an actual keyboard in the exactly same arrangement.

Fig. 9.33 "special virtual keyboard" of Publication 1 cited by the defendant is a type of the aforementioned virtual keyboard. While the window specifically for a special virtual keyboard displays a group of keys that are completely identical with those positioned in the key area of an actual keyboard in the exactly same arrangement, the keys displayed on the window have pictures.

Therefore, in the entire Publication 1, any key displayed within a window specifically for a virtual keyboard is referred to not as a "mark" but as a "key" and is completely differentiated from an "icon."

In this way, any person who refers to Publication 1, which discloses icons in such a way that has nothing to do with keys on an actual keyboard or a virtual keyboard on a screen, would not conceive of an idea of replacing with an "icon" the operation instruction key described in the cited reference, which does not involve the concept of an icon at all. In other words, even if a key carrying a picture that corresponds to the relevant key on an actual keyboard is displayed on a screen, the key would merely be interpreted as a key on a virtual keyboard and no person would ever come across the idea that the key should be regarded as the "icon 1 designed to trigger the execution of the function of displaying the functional description of an icon" used in Invention 1.

C. Moreover, Publication 2 (Exhibit Ko No. 13-27) states that "use of a keyboard instead of a mouse in order to select a buttonon a screen," which merely suggests that, if an icon is already displayed on a screen, any person who wants to select it may press a certain key on a keyboard instead of clicking it with a mouse. Therefore, any person who refers to Publication 2 would not conceive of the idea of replacing with "icon" the operation instruction key described in the cited reference, which does not involve the concept of an icon displayed on a screen at all.

(3) Difference B

The control flow described in the cited reference that "if said function key is pressed

immediately after said operation instruction key" is a control flow where the pressing of any key other than a function key (key carrying a character, sign, etc.) immediately after the pressing of the operation instruction key would not be accepted. Since the effect of the pressing of the operation instruction key would continue until the pressing of a function key, the subsequent pressing of a function key would display the operation instruction of said function key.

In contrast, the control flow "in response to the selection of an icon 2 immediately after the selection of an icon 1" in Invention 1 means that, after the icon 1 is selected, if an icon 2 is selected, the functional description of the icon 2 would be displayed as long as any icon other than the icon 2 has not been selected.

While the defendant alleged that the Description does not disclose the case where any icon other than an icon 2 is selected, Figure 2 of the Description clearly describes the case where an icon 2 is not immediately selected after the selection of an icon 1. In other words, in the case where "Release" is conducted in Step S4, if an "icon 2 designed to trigger the execution of the predetermined information processing function" does not exist in that position, it would be interpreted that the user has not chosen a subject matter whose functions will be described in Step S5 "Analysis/activation," which would result in the user's coming to the "end" of the flowchart shown in Figure 2 for this time. Subsequently, if the user selects "an icon 2 designed to trigger the execution of the predetermined information processing function," the flowchart would proceed from "Start" to Step S1, where "the window information is acquired," and then to Step S2, which examines whether the icon is "descriptive icon" or not. In this control flow, the answer "No" would be chosen, which would lead to Step S6 "Functional operation," where the information processing function of the icon 2 would be executed.

In sum, if "an icon 2 is selected immediately after the selection of an icon 1," in other words, in the case where "Release" is conducted in Step S4, if "there exists an icon 2 designed to trigger the execution of the predetermined information processing function," the functional description of said icon 2 would be displayed. On the other hand, in the case where any icon other than an icon 2 is selected, in other words, in the case where "Release" is conducted in Step S4, but there is no "icon 2 designed to trigger the execution of the predetermined information processing function," no functional description would be displayed. It is clearly stated that, if an icon 2 is subsequently selected, in other words, if "an icon 2 is not immediately selected after the selection of an icon 1," the information processing function of the icon 2 would be executed.

No. 4 Court decision

1. Issue (1) (Fulfillment of the constituent features)

(1) Meaning of "icons" in the Description

A. While the Description (Exhibit Ko No. 13-13) does not define "icons," the claims contain the statements "an icon 1 designed to trigger the execution of the function of displaying the functional description," "an icon 2 designed to trigger the execution of the predetermined information processing function," and "an icon displayed on the display screen of the display means."

B. The detailed explanation of the invention presented in the Description (Exhibit Ko No. 13-13) contains the same information as contained in the aforementioned claims and the following statements regarding "icons."

(A) "First, in Step S1, Window Information Memory Part 5 is used as a reference in order to ascertain what objects are placed in what positions on the display screen of Display Device 1. In sum, the display position data of icons displayed on Display Device 1 that are designed to give various processing commands is obtained." (Section 4, lines 9 to 14)

(B) "Next, in Step S2, it is determined whether the icon designed to request a functional description has been selected or not. In this step, based on the position of the mouse cursor at the time when a button on Pointing Device 2 was pressed, the type of the icon displayed in that position is identified. If the selected icon is an icon designed to request a functional description, the next step would be Step S3, where the icon designed to request a functional description is moved in tandem with the movement of Pointing Device 2. In Step S4, if a button of Pointing Device 2 is released, the process would proceed to Step S5, where, based on the data about the position of the icon that requests a functional description as of the time when the button was released and also on the data obtained from Window Information Memory Part 5, the type of function whose functional description is requested is identified, and then, the functional description application is activated to present the relevant functional description. In Step S2, if it is determined that an icon is not a functional description icon, the process would proceed to Step S6, where the functional operation represented by the selected icon is executed. Upon completion of said function, the control of the process of the flowchart presented in Figure 2 is completed (lines 14 to 30 of Section 4).

(C) "The structure described the above functions as follows. First, a window opens as shown in Figure 3. At this point in time, screen information, information about the position, size, etc. of the window is recorded. Within that window, multiple rectangular-shaped home menus are displayed. At this time, the functional description application is displayed in the form of an icon marked by a circle. Pointing Device 2 is moved in such a way that an arrow-shaped mouse cursor is placed over the functional

description icon marked by a circle. Then, said icon is dragged by pressing a mouse button until said icon is placed over the object whose functional description needs to be displayed. Then, the mouse button is released. For example, said icon may be moved onto an icon representing a communication function." (lines 31 to 41 of Section 4)

(D) "Figure 5 shows an example of a functional description displayed upon release of a mouse button when the functional description icon marked by a circle is moved onto the scroll bar positioned on a window frame. Figure 6 shows an example where said icon is moved onto the menu message shown in another window." (line 50 of Section 4 to line 5 of Section 5)

(E) "Figure 2 shows the flowchart of the control procedure applicable to the embodiments. Figures 3 and 4 show the embodiments. Figures 5 and 6 show other display examples of the embodiments." (lines 9 to 11 of Section 6)

C. As found in A. above, the Description does not define "icons," which are, according to the information presented in A. above, designed to be displayed on the display screen and to trigger the execution of the information processing function, etc., and, according to the information presented in B.(A) above, designed to give various processing commands.

Meanwhile, as described in B.(D) above, although some examples are shown as to how a functional description is displayed when the functional description icon is moved onto the scroll bar positioned on a window frame or onto the menu message displayed in another window. However, since "menu message" is not something that "gives various processing commands," it may not be regarded as an "icon." Therefore, it cannot be considered as an embodiment of the Inventions. In the Description, as described in B.(E) above, Figures 3 and 4 are shown as the "embodiments." However, Figure 6, which shows the situation where the functional description icon has been moved onto a menu message, is titled as "another display example" and is thus distinguished from the embodiments. Therefore, the situation described in Figure 5 as "another display example," where the functional description icon has been moved onto the scroll bar, may not be regarded as an embodiment of the Inventions. Accordingly, a scroll bar may not be considered to be an "icon."

D. The defendant alleged that Figure 2 of the Description states that "icons" are required to be draggable or movable.

Figure 2 of the Description shows a flowchart of the control procedure of the embodiments. After the acquisition of window information, if the description icon is "yes," the procedures would be described in the order of drag, release, and analysis/activation. The explanation of the details thereof is given as found in B.(B)

above. While the embodiments describe a method where an icon 1 is dragged and released onto an icon 2, any part of the Description other than the section on the embodiments does not mention anything about the draggability and movability of "icons." Furthermore, the claims of the Inventions merely contain a statement that an icon is "selected." In other words, the method of selection is not limited to dragging or moving icons. The claims do not contain any statement that imposes a limitation on said method. Thus, it may not be interpreted that Figure 2 of the Description requires "icons" to be movable.

E. The defendant alleged that "icons" are required to be able to be placed on a desktop.

However, since Figure 3 of the Description requires "icons" to be displayed within a window called "window title," it may not be said that "icons" of the Inventions are required to be able to be placed on a desktop.

F. As described above, according to the Description, "icons" may not be considered to have been defined in any other way as found in C. above. Therefore, the limitations alleged by the defendant may not be considered to have been imposed.

(2) Meaning of "icons" as of the time of the filing of the application

A. Next, we are going to examine the defendant's allegation in consideration of the meaning of "icons" as of the time of the filing of the Patent Application. Documents available as of the time of the filing of the Patent Application (October 31, 1989) describe as follows.

(A) "Gendai yougo no kisochishiki 1989" (Basic knowledge of current terminology) (Exhibit Ko No. 13-56), which was published on January 1, 1989, describes an icon as "a method where a visually-recognizable picture displayed on a display screen is designed to trigger the execution of the process that corresponds to said picture. For example, a user who wants to know the time can select a clock-shaped picture with a mouse."

(B) "Gekkan ASCII (Issue of January 1989) (Monthly ASCII) (Exhibit Ko No. 15), which was published on January 1, 1989, has the following description.

a. It is stated that "This group of icons represent accessible devices and applications. If a user drags this part with a mouse and moves it up and down, he/she can completely hide those icons under the upper or lower side of the window except for the NeXT logo mark displayed at the top."

b. It is stated that "As is the case with Mac, any file to be deleted will be dragged with a mouse onto the black hole."

c. It is stated that "[Directory Browser] menu displays, (omitted) in the form of a hierarchical structure, a list of the files stored in the selected window. A part of the

information is displayed in the following two windows displayed in the form of icons." In this connection, Figure 3 shows a common initial screen where many sets of file names and the corresponding pictures symbolizing them are arranged and shown in a window as "a group of icons in a window selected by the [Directory Browser] menu."

d. It is stated that "In the case of voice mail, a click of an icon for the [voice] command would cause the audio data to be played." In this connection, Figure 4 shows the initial screen of Electronic Mail where the mail window contains a set of the characters "voice" and a picture of lips as well as several sets of other characters and pictures representing them, while the window to send mails also contains several sets of similar combinations.

(C) The "Denshi jouhou tsuushin handobukku" (Electronic information communication handbook) (Exhibit Ko No. 13-57), which was published on March 30, 1988, states that "On a display, the multi-window function displays multiple screens at the same time in order to allow mutual data exchange so that the user can carry out work by visually checking the work flow. Meanwhile, various data and processing functions are represented by 'pictures' (called icons), which may be pointed and selected with a mouse in order to carry out processes."

(D) "Zukai konpyuuta hyakka jiten" (illustrated computer encyclopedia) (Exhibit Ko No. 13-58), which was published on November 20, 1986, states that "icons are pictographs representing functions and files in a visually understandable manner. Some icons are determined by a system from the beginning, while others can be freely determined by each user. However, the use of unstandardized pictographs could make things even more complicated. The standardization of icons only started from 1986. As famous examples of icons, the icons adopted by Xerox workstation "STAR" are described below." As examples of icons, twelve icons are described. All of them are pictures representing the corresponding functions.

(E) The "JStar waaku suteishon" (JStar work station) (Exhibits Ko No. 13-44, No. 14-1, Exhibits Otsu No. 2 and No. 5), which was published on April 25, 1986, states as follows.

a. Regarding the icons adopted by Xerox workstation "STAR" as described in (D) above, it is stated that "The method in which papers, folders, drawers, mailboxes, etc. used in an ordinary office environment are simulated on a screen. The idea of a desktop with such pictographs has been adopted as a basic model. These pictographs designed based on the forms of actual papers, folders, etc. in an easily recognizable manner are called icons. Figure 3.3 shows major icons adopted by JStar. Each pictograph is designed in such a way that users can understand what each pictograph represents at first glance."

While examples of eight types of icons are shown, all of them are represented by pictures. The description contains the term "icon (pictograph)" (Exhibits Ko No. 13-44 and No. 14-1).

b. This publication contains the following statements: "Such icons are displayed on a screen and their positions on the screen can be changed freely in accordance with the user's preference. This means that the desktop exactly simulates the papers and devices on an office desk. This is a desktop approach that has become indispensable for the concept of the work station." "The idea that the items on an actual office desk can be simulated on a screen by displaying icons makes the screen look familiar to users. The purpose of this idea is to improve maneuverability and operability." "There are roughly two types of icons. The first type includes data icons containing substantive content, such as document icons and record file icons. The second type includes icons designed to trigger the execution of certain functions," "In comparison with conventional devices whose user interface is dependent basically on the display of information consisting solely of characters and the pressing of step keys and number keys, the system that uses icons and a mouse has greatly reduced the psychological burdens on users and improved the user interface." (Exhibit Ko No. 13-44)

c. Figure 6.5 shows some examples of desktop displays where icons are placed on a desktop. Figure 6.6 shows some examples of icon designs where five examples are shown for each of the nine functions. Each icon consists of a picture whose design represents its function. (Exhibit Ko No. 13-44)

d. It is stated that "No icon representing an ordinary function cannot be moved or copied onto any other icon. For example, even if a user attempts to copy a printer icon onto the out-box, such attempt would be rejected." (Exhibit Ko No. 14-1)

e. It is stated that "Icons are displayed in different manners depending on their respective states and purposes of use. For example, desktop icons are displayed in large sizes, while they are displayed in small sizes in container windows." (Exhibit Ko No. 14-1)

f. Figure 6.8 shows a picture of a rectangular shape with its upper right corner folded. Regarding this picture, it is stated that "This is a miniature version of a document icon. When an order for moving or copying a document icon is issued, the document icon takes this shape, requesting the user to take necessary actions such as indicating where the icon should be moved or copied to. Similar miniature icons exist for a folder icon, drawer icon, and printer icon." (Exhibit Ko No. 13-44)

g. It is stated that "In the case of graphic processing, lines and rectangles, just like icons and characters, can be selected, moved, copied, modified, or otherwise handled."

(Exhibits Otsu No. 2 and No.5)

B. As found in A. above, according to documents available as of the time of the filing of the Patent Application, it was widely interpreted that icons mean "pictures or pictographs displayed on a display screen as representations of various data or processing functions."

The defendant alleged that, as of the time of the filing of the Patent Application, "icons" were required to be "draggable" and "movable" and placeable "on a desktop." This point will be examined below.

C. Movability

(A) "Gekkan ASCII (Issue of January 1989) (Monthly ASCII) (Exhibit Ko No. 15), a document available as of the time of the filing of the Patent Application, describes that a group of icons can be dragged with a mouse ((2)A.(B)a. above). On the other hand, the same document describes that there are icons representing commands in the mail window and icons in a window for sending mails ((2)A.(B)d. above). There are no statement to the effect that said icons are draggable or movable. Since such icons are clicked in order to trigger the execution of a function within a window, this may be interpreted to have nothing to do with draggability and movability.

Therefore, it may not be said that all of the icons described in the aforementioned document are draggable or movable.

(B) "JStar Workstation" (Exhibit Ko No. 13-44, Exhibits Otsu No. 2 and No. 5), a document available as of the time of the filing of the Patent Application, states, on the premise that icons are movable, that "These icons are displayed on a screen. Their positions may be changed freely in accordance with each user's preference." ((2)A.(E)b. above) and that "Icons can be moved or copied." ((2)A.(E)f. above). Furthermore, it is stated that, in the case of graphic processing, graphic objects, just like icons and characters, can be moved or otherwise handled ((2)A.(E)g. above).

However, after the statement that "Such icons are displayed on a screen and their positions can be changed freely in accordance with each user's preference," it is stated that "This is a desktop approach that has become indispensable for the concept of the workstation." This shows that the aforementioned statements are not about the general theory of icons, but about the positioning of icons within the framework of the desktop approach. Moreover, the statement that "Icons can be moved or copied" is found in Figure 6.8 "Types of cursor shapes and the situation where they are used" in connection with the explanation of how easily-understandable, user-friendly interface can be realized by changing the shape of a cursor depending on the situation and giving a user a visual cue, i.e., a graphic pattern, in order to tell what action should be taken next. If

the user gives an order such as moving or copying a document icon, the cursor would change its shape into a miniature version of the document icon in order to prompt the user to take action such as indicating a position where the document icon should be moved or copied to. Therefore, the statement that "Icons can be moved or copied" should not be interpreted as meaning that icons in general can be moved. Furthermore, the statement that, in the case of graphic processing, graphic objects, just like icons and characters, can be moved or otherwise handled is made in the context that the user interface for graphic processing has been improved. In this statement, icons and characters are mentioned as examples. It may not be interpreted that this statement means that all icons should be movable, just as this may not be interpreted that all characters should be movable.

On the other hand, the same document contains a statement made on the premise that the movement, etc. of some icons is limited ((2)A.(E)d. above).

Thus, the aforementioned document does not provide sufficient grounds for proving that all icons are required to be draggable or movable.

(C) Meanwhile, as is found in (2)A. above, since the document available as of the time of the filing of Patent Application does not contain any clear statement that "icons" are required to be movable, it may not be found that, as of the time of the filing of the Patent Application, it was interpreted that "icons" are required to be draggable or movable.

(D) Based on the information provided by Exhibit Otsu No. 3, the defendant argued that icons are required to be movable.

"Sentan Sofutouea yougo jiten" (Latest software terminology) (Exhibit Otsu No. 3) was published on May 25, 1991 after the filing of the Patent Application. The aforementioned document merely defines icons as "small pictures displayed on a display screen in order to indicate computer resources" and does not mention anything about movability. Also, the aforementioned document states that "The user can select, activate, move, copy, delete, or otherwise handle an icon with a mouse" followed by the statement that "This is called direct manipulation in contrast to character-based command." This shows that the first statement was made in the context that icons can be directly manipulated with a mouse and that "move" is merely a type of such manipulation. It is also stated that "Any user who wants to copy a file is usually only requested to drag said file icon to the directory in which the user wants to make a copy. Any user who wants to delete a file can drag the file onto the icon of trash can. If there is an icon of printer on a screen, any user who wants to print out a file can drag the file onto said icon." Said document introduces a method of dragging an icon to a user who

wants to copy, delete, or print out a file. However, said document should be interpreted to be stating only that some icons are movable and should not be interpreted to be stating that all icons should be draggable or movable.

(E) Based on the information provided by Exhibit Otsu No. 4, the defendant argued that icons are required to be movable.

"Jouho sisutemu handobukku" (Information system handbook) (Exhibit Otsu No. 4) was published on December 5, 1989. The aforementioned document merely defines icons as "Indication of the resources and menu options, etc. available for users in the form of pictographs. One of the means devised to improve the interface between a computer and a user (User interface)" and does not say anything about the issue of movability. Furthermore, while the aforementioned document states that "Any user who wants to print out a document is only required to move the document icon onto the printer icon," this statement describes the difference in the consequence between the case where the user moved the same document icon onto the drawer icon and the case where the user moved the same document icon onto the trash can icon. Such difference was pointed out as a mere example where users would find it convenient if the same operation results in a difference consequence depending on which object an icon is dragged to. Therefore, said statement cannot be interpreted to mean that all icons are required to be draggable or movable.

(F) Also, "Iwanami jouhou kagaku jiten" (Iwanami information science dictionary) (Exhibit Ko No. 13-19), which was published on May 25, 1990 after the filing of the Patent Application, defined an "icon" as a "picture representing a subject matter of processing or the processing itself that is displayed on a screen as an interface between a computer and a human beings." This definition does not say anything about movability. The aforementioned document also states that "Under the window system with advanced functions, a user can complete a task by just handling icons with a mouse. For example, if a user selects a document icon and moves (drags) it onto the printer icon or trash can icon, the user can print out or delete the document." However, this does not necessarily mean that all icons are required to be draggable or movable.

No other documents publicized after the filing of the Patent Application state that "icons" are required to be movable.

(G) As described about, regarding the meaning of "icons," it cannot be said that, before and after the filing of the Patent Application, "icons" have been interpreted to be required to be "draggable" or "movable."

D. Placeability on a desktop

Based on Exhibit Ko No. 13-44, the defendant alleged that, as of the time of the

filing of the Patent Application, "icons" were required to be placeable "on a desktop."

The Description does not specify this point as mentioned in (1)E. above. As found in (2)A.(E)e. above, "JStar workstation," which is a document that was available as of the time of the filing of the Patent Application (Exhibit Ko No. 13-44), was prepared based on the premise that "icons" can exist not only on a desktop but also in a window and that, in some cases, "icons" exist not on a desktop but in a container window. There is no evidence to prove that these "icons" were placeable on a desktop. Furthermore, as found in (2)A.(B)c. above, the same applies to "Gekkan ASCII (Issue of January 1989) (Monthly ASCII) (Exhibit Ko No. 15), which is a document that was available as of the time of the filing of the Patent Application.

As found in (2)A. above, none of the documents available as of the time of the filing of the Patent Application state that "icons" are required to be placeable on a desktop. Even if all of the facts found in (2)A. above are taken into consideration, it may not be recognized that, as of the time of the filing of the Patent Application, "icons" were required to be placeable on a desktop.

On these grounds, it may not be said that, before and after the filing of the Patent Application, it has been interpreted that "icons" are required to be placeable on a desktop.

E. Based on all of the evidence submitted in this case, it may not be found that "icons" used in the Inventions are required to be used in a modeless environment.

(3) Summary

According to (1) and (2) above, the "icons" used in the Inventions are designed to "represent various data and processing functions in the form of pictures and pictographs and to carry out commands." Since this is a sufficient requirement for icons, it should be found that neither the Description nor the understanding of the persons ordinarily skilled in the art as of the time of the filing of the Patent Application provides a basis for imposing any additional requirements such as the draggability and movability of icons or the placeability of icons on a desktop.

(4) Issue of whether the "help mode" button and the "print" button of the defendant's product may be regarded as "icons"

As shown in attached Product Lists (A) and (B), the "help mode" button and the "print" button of the defendant's product are displayed on a display screen as the representations of various data or processing functions in the form of pictures or pictographs. Therefore, the "help mode" button and the "print" button of the defendant's product may be regarded as "icons" of the Inventions.

2. Fulfillment of the constituent features by a computer into which the defendant's

product has been installed

(1) Invention 1

As described above, the "help mode" button and the "print" button of the defendant's product may be regarded as "icons" of the Inventions. Since the "help mode" button is designed to display the functional description of the "print" button, which may be regarded as an "icon," the "help mode" button may be regarded as the "icon 1 designed to trigger the execution of the function of displaying the functional description of an icon." On the other hand, the "print" button is designed to carry out the predetermined function, when clicked. Therefore, the "print" button may be regarded as an "icon 2 designed to trigger the execution of the predetermined information processing function." These icons will be displayed on the screen of a computer into which the defendant's product has been installed.

It is possible to select the "help mode" button or the "print" button of the defendant's product by a click of a mouse. This corresponds to the "selection means to select an icon displayed on the display screen of said display means."

Furthermore, the act of clicking the "help mode" button of the defendant's product with a mouse and then clicking the "print" button may be regarded as the "selection of an icon 2 immediately after the selection of an icon 1." The display of the description of the print "button" on the screen of a computer into which the defendant's product has been installed may be regarded as the "control means to display the functional description of said icon 2 on the display screen of said display means."

It is therefore obvious that any computer into which the defendant's product has been installed may be regarded as an "information processing device."

For this reason, any computer into which the defendant's product has been installed satisfies all of the constituent features 1-A to 1-D of Invention 1.

(2) Invention 2

The case where a user clicks the "help mode" button of the defendant's product with a mouse, conducts another operation, and then clicks the "print" button may be regarded as the case where "an icon 2 is selected not immediately after the selection of an icon 1." In this case, the description of the "print" button would not be displayed. Instead, the predetermined function would be activated. This corresponds to the case where "said control means" "executes the predetermined information processing function of said icon 2." It is clear that any computer into which the defendant's product has been installed may be regarded as an "information processing device."

Therefore, any computer into which the defendant's product has been installed may be considered to satisfy the constituent features 2-A and 2-B of Invention 2.

(3) Invention 3

Any computer into which the defendant's product has been installed is a "device equipped with" a "data input device" such as a keyboard, mouse, etc. and a "data display device," namely, a monitor. Those devices can be controlled through the operation of the computer into which the defendant's product has been installed.

The "help mode" button, which displays the functional description of the "print" button, may be regarded as "an icon 1 designed to execute the function of displaying a functional description," while the "print button" may be regarded as "an icon 2 designed to execute the predetermined information processing function" because the "print button" has the function of activating its predetermined function, when clicked. These buttons are displayed on a computer into which the defendant's product has been installed.

Moreover, it is possible to click with a mouse the "help mode" button and the "print" button of the defendant's product in succession. This procedure corresponds to "the selection of an icon 2 immediately after the selection of an icon 1." The display of the description of the "print" button on a computer into which the defendant's product has been installed in response to the aforementioned successive selection of two buttons may be regarded as "the functional description of said icon 2 will be displayed on a display screen."

Thus, it is clear that the use of a computer into which the defendant's product has been installed may be regarded as an "information processing method."

Therefore, the use of a computer into which the defendant's product has been installed fulfills the constituent features 3-A to 3-D of Invention 3.

(4) As described above, any computer into which the defendant's product has been installed and the use thereof fall within the technical scope of the Inventions.

3. Issue (2) (Indirect infringement)

(1) Article 101 of the Patent Act specifies so-called indirect infringement. Item (ii) of said Article states that, where a patent has been granted for an invention of a product, acts of producing, assigning, etc., importing or offering for assignment, etc. any product (excluding those widely distributed within Japan) that is to be used for the producing of [said product and is indispensable for the resolution of the problem by said invention as a business, knowing that said invention is a patented invention and said product is used for the working of the invention, shall be deemed to constitute infringement of a patent right, etc. Item (iv) of said Article specifies that the same shall apply to the case where a patent is granted for an invention of a process.

(2) As held in 2. above, a computer into which the defendant's product has been

installed and the use thereof fulfill the constituent features of the Inventions. The defendant's product is used for producing a "computer into which the defendant's product has been installed" and is essential for the resolution of the problem to be solved by the Inventions, i.e., "inability to receive a functional description service when a user forgets or does not know a keyword (if the conventional method is adopted)." Meanwhile, it is obvious that the defendant's product has not been "widely distributed in Japan."

(3) The defendant alleged that, since the operating system called Microsoft Windows has the same function as that of the Inventions, the defendant's product is not "essential for the resolution of the problem by the invention." While the purpose of this allegation is not necessarily clear, even if the help display program, etc. of Windows performs, as alleged by the defendant, the function of "displaying the description of another button if said ‘another button’ is selected immediately after the selection of the 'help mode' button," the functions described in attached Product Lists (A) and (B) cannot be executed without using a computer into which the defendant's product has been installed. Therefore, it must be said that the defendant's product may be considered to be indispensable for the resolution of the problem to be solved by the Inventions and that the act of installing the defendant's product constitutes an act of producing goods infringing the Patent Right.

(4) At least since the time of the service of a written petition for an order for provisional disposition filed by the plaintiff on November 7, 2002, the defendant may be found to have been aware of the fact that the Inventions are patented inventions and that the defendant's product is used for the working of the Inventions (Exhibit Ko No. 13-1, the entire import of oral argument).

(5) On these grounds, the defendant's acts described in 2-1.(4) above may be considered to constitute the indirect infringement specified in Article 101, items (ii) and (iv) of the Patent Act.

4. Issue (3) (Abuse of rights)

(1) Technology in the public domain

Based on the evidence, it may be recognized that the following technologies were in the public domain as of the time of the filing of the Patent Application.

A. The cited reference publicized on December 11, 1986 (Publicized patent gazette of Publication of Unexamined Patent Application No. 1986-281358, Exhibit Ko No. 13-25) contains the following statements.

(A) Title of the invention

Method of displaying functional descriptions of a word processor

(B) Scope of claims

"A functional description display method of a word processor equipped with an input means having character/sign keys, function keys designed to order some editing processes such as deletion and insertion, and operation instruction keys as well as a display means to display a document or operational guidance in response to the information input by use of said input means. Said method may be characterized by the process where the pressing of said operation instruction key and said function key in succession will display on said display means the description of the editing processing function identified by said function key."

(C) Effect of the Invention

"Any user who presses the operation instruction ken and a function key of his/her choice in succession could easily check the function of said function key."

B. Publication 1 ("JStar Workstation"; Exhibit Otsu No. 5) published on April 25, 1986 contains the following statements.

(A) "JStar uses (omitted) an independently developed 'virtual keyboard.' This 'virtual keyboard' creates on a screen a software keyboard that corresponds to an actual keyboard. A user operates this keyboard by switching between interpretations and a multiple number of bitmaps made available as data."

(B) "The selection of a key on a virtual keyboard displayed on a screen with a mouse is the same as typing said key."

(C) "A user can open a document and click with a mouse the position into which an alignment box needs to be inserted. Since a special virtual keyboard has a function key to insert an alignment box (corresponding to the key "A" of Figure 9.33), the user can insert an alignment box by pressing said key and inserting the corresponding anchor mark into the text."

C. Publication 2 published in May 1986 ("Nikkei Baito"; Exhibit Ko No. 13-27) states that "It is permitted to use a keyboard instead of a mouse to select a button on a screen. This figure shows that 'Yes' may be selected by 'Y,' 'Enter,' or 'Return' key (omitted)."

D. Publication 3 published on April 14, 1989 ("Ichitaro Ver. 4 Advanced Manual"; Exhibit Ko No. 13-26) states that "The user can directly left-click the 'ESC' mark on a screen instead of pressing the 'ESC' key to produce the same effect."

(2) Inventive step of Invention 1

A. As found in (1)A. above, the cited reference discloses an invention wherein, if a user of a word processor having a function key and the operation instruction key presses the operation instruction key and a function key in succession, the description of the function identified by said function key is displayed (the "cited invention").

Therefore, a comparison between Invention 1 and the cited invention shows the difference between the two. More specifically, Invention 1 is an invention related to icons that are displayed on a display screen and "designed to trigger the execution of the function of displaying the functional description of an icon," whereas the cited invention is an invention related to keys on a keyboard having the operation instruction key, but does not have icons like those mentioned above.

Invention 1 has adopted a completely different concept of "icons," which does not have to correspond to the keys on an actual keyboard in order to have icons play the role that has been played by the keys on the keyboard, whereas the cited invention is related to the keys on an actual keyboard. Regarding the cited invention that is specifically about keys on an actual keyboard and does not even hint of the existence of icons on a display screen, there have been no publications that indicate the possibility of replacing keyboard keys with icons, which are qualitatively different from keyboard keys. Therefore, it may not be said that any person ordinarily skilled in the art could have easily conceived of Invention 1 related to icons based on the cited invention related to keyboard keys.

B. The defendant alleged that, since Publications 1 and 2 have disclosed that "the operation of keys on an actual keyboard" may be replaced by "the selection of marks, with a mouse, displayed on a screen in the form of pictures or pictographs other than characters," any person ordinarily skilled in the art could have easily conceived of Invention 1 related to icons displayed on a display screen by combining the cited reference concerning keyboard keys with Publications 1 and 2.

As found in (1) B. above, Publication 1 has disclosed an invention that allows the user to click, with a mouse, keys on a virtual keyboard displayed on a screen that corresponds to an actual keyboard, instead of typing actual keys, to produce the same effects and to display a special virtual keyboard on a screen and to select and execute a function represented by a keyboard key by clicking, with a mouse, a mark represented in the form of a picture on a virtual keyboard.

However, Publication 1 merely describes a "virtual keyboard" that displays on a screen a software keyboard that corresponds to an actual keyboard. The keys displayed in a window specifically for this virtual keyboard are referred to as "keys" and described as something completely different from "icons." Thus, it may not be said that Publication 1 suggests that keyboard keys may be replaced by icons.

Moreover, as found in (1)C. above, Publication 2 merely states that the selection of the "Yes" button on a screen may be replaced by the selection of the "Y," "Enter," or "Return" key and does not state anything about "icons."

Meanwhile, as of the time of the filing of the Patent Application, there existed documents that assign pictures to the keys on an actual keyboard or a virtual keyboard (Exhibits Otsu No. 5 to No. 9). If these keys are displayed on a screen, they could look similar to icons. However, even if keys carry marks represented by pictures, the keys on an actual keyboard as well as the keys on a virtual keyboard displayed on a screen merely correspond to those of an actual keyboard on a one-to-one basis. Those keys do not go beyond the scope of keys. On the other hand, as a found in 1.(3) above, icons are designed to "carry out commands by representing various data and processing functions in the form of pictures or pictographs on a display screen." "Icons" do not need to correspond to the keys on an actual keyboard. It is possible for icons to freely assume various functions without being subject to the limitations imposed on an actual keyboard in terms of the number and positions of keys. This indicates that there exists a qualitative difference between keys and icons.

On these grounds, it may not be said that any person ordinarily skilled in the art as of the time of the filing of the Patent Application could have easily conceived of Invention 1 by combining the cited invention and the technologies described in Publications 1 and 2.

C. Moreover, the defendant also alleged that Publications 2 and 3 have revealed that icons and keys are interchangeable and that any person ordinarily skilled in the art could have easily conceived of Invention 1, which is related to icons displayed on a display screen, by combining the cited invention related to keys and Publications 2 and 3.

However, as a found in (1)C. above, the technology described in Publication 2 merely allows selection by a key instead of the "Yes" button on a screen. Therefore, Publication 2 is not about "icons." Moreover, as found in (1)D. above, the technology described in Publication 3 merely allows replacement of the function of the "ESC" key with the "ESC" mark displayed on a screen. Thus, Publication 3 is also not about "icons,". Therefore, Publications 2 and 3 may not be considered to have revealed that icons and keys are interchangeable.

On these grounds, it may not be said that any person ordinarily skilled in the art as of the time of the filing of the Patent Application could have easily conceived of Invention 1 by combining the cited invention and the technologies described in Publications 2 and 3.

D. As found in 1.(2)A. above, it may be recognized that the concept of "icons" was publicly known as of the time of the filing of the Patent Application. However, as held in A. and B. above, since keyboard keys are qualitatively different from icons, even if the concept of "icons" itself was publicly known, it may not be recognized that any

person ordinarily skilled in the art as of the time of the filing of the Patent Application could have easily conceived of Invention 1 by combining the cited invention related to keyboard keys with the concept of "icons."

(3) Inventive step of Invention 2

Invention 2 was made based on Invention 1. Therefore, as long as any person ordinarily skilled in the art as of the time of the filing of the Patent Application may not be considered to have easily conceived of Invention 1, any person ordinarily skilled in the art as of the time of the filing of the Patent Application may not be considered to have easily conceived of Invention 2.

(4) Inventive step of Invention 3

Invention 3 represents Invention 1 in the form of an invention of a process. Therefore, as long as any person ordinarily skilled in the art as of the time of the filing of the Patent Application may not be considered to have easily conceived of Invention 1, any person ordinarily skilled in the art as of the time of the filing of the Patent Application may not be considered to have easily conceived Invention 3.

(5) In view of these facts, without examining any other factors, it may not be said that there are clear reasons for invalidation of the Patent.

5. Conclusion

On these grounds, the court found the plaintiff's claims to be well-grounded and acceptable and rendered a judgment in the form of the main text. This court has decided not to make a declaration of provisional execution because it is not appropriate.

Tokyo District Court, 47th Civil Division

Presiding Judge: TAKABE Makiko
Judge: SETO Sayaka
Judge: KUMASHIRO Masato