

Date	March 25, 2016	Court	Intellectual Property High Court, Special Division
Case number	2015 (Ne) 10014		

– A case in which, with regard to a manufacturing process of a preparation, etc., the court upheld a claim for an injunction against the import and sale of the preparation etc. and other claims based on a patent right on the grounds that said process is equivalent to a patented invention.

– A case in which the court ruled as follows: The essential part of a patented invention in the first requirement of the doctrine of equivalents means a characteristic part, which constitutes a unique technical idea that is not seen in prior art, in the statements in the scope of claims of the patented invention, and the essential part should be found based on the statements in the scope of claims and the description, in particular, the comparison with prior art stated in the description and the degree of contribution.

– A case in which the court ruled as follows: The fact that the applicant did not state another structure, which a person ordinarily skilled in the art can easily conceive of as of the filing date as one that is substantially identical with the structure stated in the scope of claims, in the scope of claims only because of the existence of such other structure cannot be considered to fall under the "special circumstances" in the fifth requirement of the doctrine of equivalents; however, if the applicant is objectively and externally recognized as having recognized another structure that is outside the scope of claims as a replacement for a different part in the structure stated in the scope of claims as of the filing date, the applicant's failure to state said other structure in the scope of claims can be considered to fall under the "special circumstances" in the fifth requirement of the doctrine of equivalents.

Reference: Article 100, paragraphs (1) and (2), Article 70, paragraph (1), and Article 29, paragraph (2) of the Patent Act

Number of related rights, etc.: Patent No. 3310301 (the "Patent"), Invalidation Trial No. 2013-800080

Summary of the judgment

1. Background

The appellee (plaintiff in the first instance), who holds the patent right in question (the "Patent Right") for an invention titled "intermediates for the synthesis of vitamin D and steroid derivatives and process for preparation thereof," alleged that the manufacturing process (the "Appellant's Process") of the maxacalcitol preparations, etc. (the "Appellants' Products") imported and sold by the appellants (defendants in the first instance) is equivalent to the invention claimed in Claim 13 of the Patent (the

"Corrected Invention") and that the sale, etc. of the Appellants' Products constitutes infringement of the Patent Right. Based on this allegation, the appellee filed this action against the appellants to seek an injunction against the import, assignment, etc. of the Appellants' Products and disposal thereof.

Briefly speaking, the Corrected Invention is a process for preparing a compound wherein an intermediate is prepared by having the starting material react with a specific reagent and the objective substance is prepared by treating the intermediate with a reducing agent. The Appellant's Process fulfills the constituent features pertaining to the reagent and objective substance of the Corrected Invention (Constituent Features [A], [B-2], [D], and [E]), but does not fulfill the constituent features pertaining to the starting material and intermediate of the Corrected Invention (Constituent Features [B-1], [B-3], and [C]) in that the carbon skeletons of the starting material and the intermediate do not have cis-form vitamin D structures but have trans-form vitamin D structures that are the geometric isomers thereof.

In relation to the doctrine of equivalents, the five requirements for applying the doctrine of equivalents are indicated in the judgment of the Third Petty Bench of the Supreme Court of February 24, 1998, 1994 (O) 1083 ("Ball spline bearing" case). In this case, the parties disputed whether the doctrine of equivalents is established through specific application of the five requirements. In addition, the appellants alleged that the Patent should be invalidated by a trial for patent invalidation.

The court of prior instance recognized that the Appellant's Process is equivalent to the Corrected Invention and determined that the patent for the Corrected Invention is not recognized as one that should be invalidated by a trial for patent invalidation. Based thereon, the court of prior instance upheld all of the appellee's claims. Therefore, dissatisfied with this, the appellants filed an appeal (the "Appeal").

2. Content of this judgment

In this judgment, the court ruled as summarized below, and recognized that the Appellant's Process is equivalent to the Corrected Invention. The court also determined that there is no reason for all of the grounds for invalidation alleged by the appellants. Based thereon, the court upheld the judgment in prior instance and dismissed the Appeal.

(1) Regarding the burden of proving the fulfillment of the five requirements for the doctrine of equivalents

"Regarding the burden of alleging and proving the fulfillment of the first to fifth requirements, it is reasonable to understand as follows, taking into account that the doctrine of equivalents should be applied within the scope of those that are found to be

easily conceived of by a person ordinarily skilled in the art as one that is substantially identical with the statements in the scope of claims beyond the scope of the literal interpretation of said statements: a person who alleges that the subject product, etc. is equivalent to a patented invention should be considered to have the burden of allegation and proof for the first to third requirements, which are the facts required for the subject product, etc. to be recognized as falling within said scope, while a person who denies the application of the doctrine of equivalents in relation to the subject product, etc. has the burden of allegation and proof for the fourth and fifth requirements, which are related to the cases where the application of the doctrine of equivalents should be eliminated, even if the subject product, etc. is within the aforementioned scope."

(2) Regarding the first requirement of the doctrine of equivalents (non-essential part)

The first requirement of the doctrine of equivalents in the Supreme Court judgment on the "Ball spline bearing" case is that even if the structure stated in the scope of claims contains any part that is different from that of the product manufactured, etc. by the other party or the process used thereby, said part is not the essential part of the patented invention.

A. "The substantial value of an invention which the Patent Act intends to protect exists in the disclosure, with a specific structure, to society of a means for solving a technical problem that could not have been solved by prior art, which is based on a unique technical idea that is not seen in prior art. Therefore, the essential part of a patented invention should be understood as the characteristic part which constitutes a unique technical idea that is not seen in prior art in the statements in the scope of claims of the patented invention.

The aforementioned essential part should be found by first understanding the problem to be solved and means for solving the problem of the patented invention ... and its effects ... based on the statements in the scope of claims and the description and then determining the characteristic part that constitutes a unique technical idea that is not seen in prior art in the statements in the scope of claims of the patented invention. That is, taking into account that the substantial value of a patented invention is defined depending on the degree of contribution in comparison with prior art in the relevant technical field, the essential part of a patented invention should be found based on the statements in the scope of claims and the description, in particular, through comparison with prior art stated in the description. [i] If the degree of contribution of the patented invention is considered to be more than that of prior art, the patented invention is found as a generic concept in relation to part of the statements in the scope of claims

.... [ii] If the degree of contribution of the patented invention is evaluated as not much more than prior art, the patented invention is found to have almost the same meaning as stated in the scope of claims.

However, if the statement of the problem, which is described as one that prior art could not solve, in the description is objectively insufficient in light of prior art as of the filing date ..., a characteristic part which constitutes a unique technical idea of the patented invention that is not seen in prior art should be found also in consideration of prior art that is not stated in the description. In such cases, the essential part of the patented invention is closer to the statements in the scope of claims compared to the cases where it is found only based on the statements in the scope of claims and the description, and the scope of application of the doctrine of equivalents is considered to be narrower.

In addition, in determining the fulfillment of the first requirement, that is, whether a difference from the subject product, etc. is a non-essential part, it is not appropriate to first divide the constituent features stated in the scope of claims into essential parts and non-essential parts and then consider that the doctrine of equivalents is not applicable to all of the constituent features that fall under essential parts, but it is necessary to first determine whether the subject product, etc. commonly has the essential part of the patented invention determined as mentioned above and then consider a difference not to be an essential part if the subject product, etc. is recognized as having said essential part. Even if the subject product, etc. has a difference other than the characteristic part that constitutes a unique technical idea that is not seen in prior art, this fact does not become a reason for denying the fulfillment of the first requirement."

B. "The Corrected Invention makes it possible to prepare its objective substance through a new preparation route that is not available in prior art, and its degree of contribution to prior art is large. ... The Corrected Invention made it possible to industrially produce maxacalcitol for the first time. ...

In light of the problem to be solved and means for solving the problem of the Corrected Invention and its effects as mentioned above, the essential part of the Corrected Invention ... is recognized as existing in finding that a side chain having an epoxy group by an ether bond can be introduced through one step by having an alcohol compound at position 20 of a vitamin D structure or steroid ring structure react with an epoxy hydrocarbon compound of Constituent Feature [B-2] which has an eliminating group at its end and in making it possible to introduce a maxacalcitol side chain into an alcohol compound at position 20 of a vitamin D structure or steroid ring structure

through a new route of first going through an intermediate that is a vitamin D structure or steroid ring structure into which a side chain having an epoxy group by an ether bond is introduced through such one step and then opening the ring of the epoxy group of the side chain. ...

The Appellant's Process ... is considered to have the characteristic part that constitutes a unique technical idea that is not seen in prior art in the statements in the scope of claims of the Corrected Invention.

On the other hand, in the Appellant's Process, the point that a vitamin D structure that corresponds to "Z" of the starting material and the intermediate, which is a difference from the Corrected Invention, is not a cis form but a trans form ... is not the essential part of the Corrected Invention.

Therefore, the Appellant's Process is recognized as fulfilling the first requirement of the doctrine of equivalents."

(3) Regarding the second requirement of the doctrine of equivalents (replaceability)

"In ... Starting Material A and Intermediate C in the Appellant's Process, the carbon skeleton that corresponds to Z of the Corrected Invention is a trans-form vitamin D structure, and the Appellant's Process differs from the Corrected Invention in that the carbon skeleton of Z of the starting material ... and intermediate ... in the Corrected Invention is a cis-form vitamin D structure. However, the starting materials and intermediates in both the Appellant's Process and the Corrected Invention have the same function and effect of being able to prepare maxacalcitol by a process of going through an intermediate that is a vitamin D structure into which a side chain having an epoxy group by an ether bond through one step by having an alcohol compound at position 20 of a vitamin D structure react with the same epoxy hydrocarbon compound. It is recognized that the same purpose as that of the Corrected Invention can be achieved and the same function and effect are produced even if the aforementioned starting material and intermediate having a cis-form vitamin D structure in the Corrected Invention are replaced with the aforementioned starting material and intermediate having a trans-form vitamin D structure in the Appellant's Process. ... Therefore, the Appellant's Process is recognized as fulfilling the second requirement of the doctrine of equivalents."

(4) Regarding the third requirement of the doctrine of equivalents (easiness of replacement)

In this judgment, the court determined that the Appellant's Process is one that a person ordinarily skilled in the art could have easily conceived of based on the Corrected Invention as of the time of infringement of the Patent Right and found that

the Appellant's Process fulfills the third requirement of the doctrine of equivalents.

(5) Regarding the fourth requirement of the doctrine of equivalents (whether the subject process can be easily presumptively conceived of)

In this judgment, regarding the fourth requirement of the doctrine of equivalents, the court cited the judgment in prior instance and determined that the Appellant's Process is not recognized as one that can be easily presumptively conceived of.

(6) Regarding the fifth requirement of the doctrine of equivalents (special circumstances)

The fifth requirement of the doctrine of equivalents mentioned in the Supreme Court judgment on the "Ball spline bearing" case is that there are no special circumstances, such as the fact that the subject product, etc. falls under those that are intentionally excluded from the scope of claims in the patent application procedures for the patented invention.

A. "The substantial value of a patented invention extends to the art which a person ordinarily skilled in the art can easily conceive of based on the structure stated in the scope of claims as one that is substantially identical with said structure, and third parties should expect this. Therefore, if the subject product, etc. is identical with a patented invention in the essential part, purpose, and function and effect, and is one that a person ordinarily skilled in the art can easily conceive of based on the patented invention, the subject product, etc. can be in principle considered to be equivalent to the patented invention. However, with regard to a structure which was once approved by the patentee as not falling under the technical scope of the patented invention (for example, in the case where the applicant intentionally excluded it from the scope of claims in the patent application procedures) or for which the patentee has taken action that is externally considered as such approval, the patentee is not permitted to subsequently make an allegation that goes against said approval or action in light of the doctrine of estoppel. Therefore, if there are such special circumstances, the application of the doctrine of equivalents is exceptionally denied (see the aforementioned Supreme Court judgment on the "Ball spline bearing" case).

(A) In this regard, even if there is another structure that is outside the scope of claims, which a person ordinarily skilled in the art can easily conceive of as of the filing date as one that is substantially identical with the structure stated in the scope of claims and the applicant could thus have also easily conceived of said another structure as of the filing date, this fact alone cannot serve as a reason for alleging that the applicant's failure to state said another structure in the scope of claims falls under the "special circumstances" in the fifth requirement of the doctrine of equivalents.

This is because of the following reasons. [i] As mentioned above, the substantial value of a patented invention extends to the art that a person ordinarily skilled in the art can easily conceive of as one that is substantially identical with the structure stated in the scope of claims based on said structure even if it is a structure other than the structure stated in the scope of claims. This principle does not change at all in relation to any art that a person ordinarily skilled in the art can easily conceive of as of the filing date. If it is not at all permitted to allege the doctrine of equivalents only for the reason that a structure could have been easily conceived of by a person ordinarily skilled in the art as of the filing date, the scope to which the substantial value of a patented invention extends will differ from the aforementioned scope. [ii] In addition, taking into account that an applicant should first disclose his/her invention to the public by stating it in the description and then clearly specify the scope of the exclusive right in the scope of claims, the applicant should state the scope of claims in just proportion within the scope of the invention disclosed in the description while fulfilling the requirements, such as the support requirements under Article 36, paragraph (5) of the Patent Act and paragraph (6), item (i) of said Article and the clarity requirements under item (ii) of said paragraph. However, in some cases, it is considered to be harsh to require the applicant to prepare the scope of claims that contains all the expected infringing embodiments and the description supporting such scope of claims within a limited period of time, taking into account the fact that, under the first-to-file system, applicants are generally required to prepare the scope of claims and the description and file applications within a limited period of time. On the other hand, in many cases, a third party who has received the disclosure of an invention as described in the description pertaining to a patent application can easily conceive of one which has the essential part of the patented invention but part of which is not included in the literal interpretation of the scope of claims, based on the statements in the scope of claims and the description, etc., during the duration of the patent. The doctrine of equivalents is applicable because if any third party can easily escape from the exercise of rights by the patentee, including an injunction, through replacement of the non-essential part of the patented invention, incentive to invent in society in general will be diminished, which not only goes against the purpose of the Patent Act, that is, contributing to the development of industry through protection and encouragement of inventions, but also goes against social justice and results in running counter to the principle of equity. In light of the aforementioned situation, etc., even if a person ordinarily skilled in the art could have easily conceived of another structure that is outside the scope of claims as of the filing date, it is not reasonable to exclude

said another structure from the application of the doctrine of equivalents only for the reason of such fact without exception.

(B) However, even in such a case, if the applicant is objectively and externally recognized as having recognized another structure that is outside the scope of claims as a replacement for a different part in the structure stated in the scope of claims as of the filing date (for example, where the applicant can be considered to have stated the invention based on said another structure in the description or where the applicant stated the invention based on another structure that is outside the scope of claims in a paper, etc. which he/she published as of the filing date), the applicant's failure to state said another structure in the scope of claims is considered to fall under the "special circumstances" in the fifth requirement.

The reason therefor is as follows. In the aforementioned cases, it can be understood that the patentee intentionally excluded said another structure from the scope of claims when stating the scope of claims, that is, the patentee approved that said another structure does not fall under the technical scope of the patented invention or took action that is externally understood as such approval, and the trust of a third party who understands as such should be protected. Therefore, the patentee is not permitted to subsequently allege the application of the doctrine of equivalents in relation to the subject product, etc. that is based on said another structure in contradiction to such protection in light of the doctrine of estoppel."

B. In this judgment, the court specifically considered the statements, etc. in the corrected description, which the appellants allege as the "special circumstances" in the fifth requirement, and determined as follows: The corrected description does not include any statement that can be considered to be stating an invention wherein the starting material of the Corrected Invention has a trans-form vitamin D structure, and there is no other evidence sufficient to objectively and externally recognize that the applicant recognized a trans-form vitamin D structure as a replacement for a cis-form vitamin D structure as the starting material of the Corrected Invention as of the filing date of the application for the Patent; therefore, the special circumstances in the fifth requirement of the doctrine of equivalents cannot be recognized.

(6) Regarding the existence or absence of grounds for invalidation of the Corrected Invention

In this judgment, the court determined that all of the grounds for invalidation alleged by the appellants are unacceptable.