| Patent Right | Date | June 28, 2021 | Court | Intellectual Property High Court, Third Division |
|---|---|---|---|---|
| | Case number | 2020 (Ne) 10044 | | |

- An appeal case of a patent infringement lawsuit in which the court, holding that the Defendant's product does not infringe the first-instance Plaintiff's patent due to grounds [i] and [ii] below, reversed the part of the judgment in prior instance, which partially upheld the first-instance Plaintiff's claims, and the court dismissed with prejudice on the merits the first-instance Plaintiff's claims with regard to that part:
[i] the wording of claims should be interpreted based on the technical meaning of the claimed invention, and when interpreted from that viewpoint, the structure of the Defendant's product does not fulfill the wording of the claims of the first-instance Plaintiff's patent; and
[ii] if the wording in question were interpreted broadly to include the structure of the Defendant's product, the first-instance Plaintiff's patent would be invalid due to lack of an inventive step.
- An appeal case of a patent infringement lawsuit in which the court held that it cannot be said that the new allegations made by the first-instance Defendant in the appeal instance are impermissible because they constitute withdrawal of its admission, nor can it be said that these allegations should be dismissed without prejudice because they constitute allegations or evidence presented after the time by when they should have been presented (hereinafter referred to as "belated allegations or evidence").

Case type: Compensation for Damages Caused by Patent Infringement
Result: Partial reversal of the prior instance judgment
References: Article 29, paragraph (2) and Article 70 of the Patent Act
Related rights, etc.: Patent No. 4520670
Judgment of the prior instance: Tokyo District Court, 2017 (Wa) 29228, rendered on January 30, 2020, and a ruling of correction made on March 12, 2020

## Summary of the Judgment

### 1. Background

The first-instance Plaintiff is the patentee of Patent No. 4520670 for an invention titled "Fluid feeding apparatus, fluid feeding method, recording medium, and program" (hereinafter referred to as the "Patent"). The Patent relates to an invention of an apparatus and program that enable settlement of payment by using a "storage medium," such as a prepaid card, at a self-service gas station.

The first-instance Defendant manufactures and sells the Defendant's apparatus, which enables settlement of payment by using a contactless IC card (FeliCa™ card) at a self-service gas station, and the apparatus contains the Defendant's program to have it operate.

The first-instance Plaintiff alleged that the Defendant's apparatus and the Defendant's program fall within the technical scope of the Patent, and sought an injunction and compensation for damages.

The court of prior instance upheld the first-instance Plaintiff's claim for an injunction, and partially upheld its claim for compensation for damages to the extent of the principal of approximately 450 million yen (the amount after the ruling of correction).

Both parties were dissatisfied with the parts of the case they had lost, and filed an appeal.

In this judgment, the court held that the first-instance Plaintiff's claims are groundless due to the grounds stated in 2. and 3. below, and based on the first-instance Defendant's appeal, reversed the part of the judgment in prior instance rendered in favor of the first-instance Plaintiff, and dismissed with prejudice on the merits the first-instance Plaintiff's claims with regard to that part. In addition, with regard to the first-instance Plaintiff's allegation to the effect that the new allegations made by the first-instance Defendant in the appeal instance constituted withdrawal of its admission and also constitute belated allegations or evidence, the court indicated that this allegation cannot be accepted due to the grounds stated in 4. and 5. below.

2. Regarding the arguments that the Defendant's product fulfills the constituent features of the Invention (hereinafter referred to as "arguments on fulfillment")

As an invention is a technical idea which serves as a means for solving a problem, in the process of interpreting the meaning of the wording of claims reciting the structure of an invention, the statements in the description concerning the problem to be solved by the invention and the operation and effect to be provided by the invention should be taken into account, and the meaning should be examined from the viewpoint of what operation and effect would be provided and what problem would be solved by that structure of the invention.

According to the statements in the description in this case, the structure of the invention in this case (hereinafter referred to as the "Invention") is intended for solving the problems that had occurred in prior art that mainly used a magnetic prepaid card. However, when a contactless IC card is used in the Defendant's oil feeding apparatus, the problems that are intended to be solved by the Invention do not originally exist, and

there is also no problem that could be the subject to be solved by means of the Invention. Therefore, a contactless IC card does not constitute the "storage medium" referred to in the Invention.

3. Regarding arguments on invalidity

The arguments on invalidity are examined on a premise that the "storage medium" in the Invention is interpreted as including a contactless IC card.

At the time of filing the application for the Patent, an apparatus that enables settlement of payment by cash at a self-service gas station was publicly known.

It was easy to conceive of replacing payment by cash with payment by a contactless IC card, in light of such facts as that contactless IC cards were often referred to as "electronic money." Moreover, the process to settle payment for the oil fed by using a contactless IC card by means of the structure of the Invention is one that would be naturally adopted if payment by cash is to be replaced with payment by a contactless IC card in the abovementioned publicly known apparatus.

Accordingly, the Invention lacks an inventive step in relation to the abovementioned publicly known apparatus.

4. Regarding withdrawal of an admission

The first-instance Plaintiff alleged that the first-instance Defendant's Allegation on Non-infringement [iv] constitutes withdrawal of its admission that had been established based on its approval or disapproval in its written answer submitted in the prior instance, and is impermissible.

However, whereas the question of whether or not an admission has been established should be examined based on the entirety of the party's answer, the first-instance Defendant, although "approving" that its product fulfills Constituent Feature 1C in its written answer in prior instance, made the following allegations, for example, in the section for its approval or disapproval of the first-instance Plaintiff's allegations on equivalence and the section for the first-instance Defendant's allegations in that written answer: (a) in Constituent Feature 1C of Invention 1, the amount to be debited is set by the system of the setting instrument, whereas in Constituent Feature 1c of the Defendant's oil feeding apparatus, the amount to be debited is designated by the customer; (b) in the Defendant's oil feeding apparatus, the transactions are completed in Constituent Feature 1c; and (c) in Constituent Feature 1F of Invention 1, the amount of payment according to the volume of the oil fed is calculated, and the difference with the debited amount is returned, whereas in Constituent Feature 1f of the Defendant's oil feeding apparatus, the amount of payment for the sale and purchase that arise from returning the volume of oil that could not be fed is calculated. These allegations of the

first-instance Defendant should practically be understood to be asserting that the processes conducted in the Defendant's oil feeding apparatus differ from the processes conducted in Constituent Feature 1C of Invention 1. Thus, it can be said that it is inappropriate for the court of prior instance to have simply treated the fulfillment of Constituent Feature 1C as an issue not disputed between the parties.

According to the above, it cannot be said that the first-instance Defendant's Allegation on Non-infringement [iv] is impermissible because it constitutes withdrawal of its admission.

5. Regarding whether the first-instance Defendant's new allegations in the appeal instance constitute belated allegations or evidence

As the first-instance Defendant's Allegations on Invalidity A, B, and D were presented after the court of prior instance disclosed its interim views concerning the arguments on infringement, they were treated by the court of prior instance as having been presented belatedly. However, as already pointed out in the section concerning the arguments on fulfillment, it must be said that the manner in which the court of prior instance arranged issues concerning fulfillment of Constituent Feature 1C1 (Allegation on Non-infringement [iv]) and fulfillment of Constituent Features 1A, 1C, 1F3, and 1F4 (Allegation on Non-infringement [v]) is defective in that an issue that should have been treated as one disputed between the parties was treated as one involving no such dispute. Given that matters such as whether and when the parties should make allegations on the arguments on invalidity cannot be considered separately from the process through which the parties present allegations and evidence concerning the arguments on fulfillment, in this case where it is considered that the parties should have presented further allegations and evidence concerning the arguments on fulfillment, it is not reasonable to evaluate that the first-instance Defendant's allegations on invalidity were presented belatedly solely based on the fact that they were presented after the court of prior instance disclosed its interim views concerning the arguments on infringement.

In addition, it can be said that, in this instance, the first-instance Defendant presented allegations on invalidity regarding the abovementioned grounds for invalidation immediately after filing the appeal.

According to the above, the abovementioned allegations on invalidity by the first-instance Defendant cannot be evaluated as having been presented belatedly either from the viewpoint of looking at the overall proceedings in the prior instance and this instance or from the viewpoint of focusing only on the proceedings in this instance.

Consequently, none of the allegations on invalidity by the first-instance Defendant should be dismissed without prejudice as a belated allegation or evidence.

Judgment rendered on June 28, 2021
2020(Ne)10044, Appeal case of seeking compensation based on patent infringement
(Court of prior instance: Tokyo District Court, 2017(Wa)29228)
Date of conclusion of oral argument: March 24, 2021

Judgment

Appellant / Appellee: Cosmo Oil Marketing Co., Ltd.
(hereinafter referred to as the "first-instance Plaintiff)

Appellee / Appellant: Comota Co., Ltd.
(hereinafter referred to as the "first-instance Defendant")

Main text

1. Based on the appeal filed by the first-instance Defendant, the part of the judgment in prior instance which is against the first-instance Defendant shall be reversed.
2. All the claims of the first-instance Plaintiff pertaining to the abovementioned part shall be dismissed with prejudice on the merits.
3. The appeal filed by the first-instance Plaintiff shall be dismissed with prejudice on the merits.
4. The first-instance Plaintiff shall bear the court costs in the first and second instances.

Facts and reasons

No. 1 Object of the claim
(The first-instance Plaintiff)
1. The judgment in prior instance shall be modified as follows.
2. The first-instance Defendant shall neither manufacture, nor sell nor offer to sell the product stated in 2. in the Item List attached to this judgment.
3. The first-instance Defendant shall dispose of the product stated in the preceding paragraph.
4. The first-instance Defendant shall neither manufacture, nor use, nor sell, nor offer to sell the program stated in the Program List attached to this judgment nor provide nor offer to provide it through telecommunications line.
5. The first-instance Defendant shall delete the program stated in the preceding

paragraph.
6. The first-instance Defendant shall pay to the first-instance Plaintiff 950,543,000 yen as well as the amount accrued on 100,000,000 yen out of the abovementioned amount at the rate of 5% per annum for the period from October 1, 2015 until the completion of the payment and the amount accrued on 850,543,000 yen out of the same amount at the same rate for the period from September 30, 2018 until the completion of the payment.
(The first-instance Defendant)
1. The part of the judgment in prior instance which is against the first-instance Defendant shall be reversed.
2. All the claims of the first-instance Plaintiff pertaining to the abovementioned reversed part shall be dismissed with prejudice on the merits.
No. 2 Outline of the case, etc. (Abbreviations used in this judgment are as defined in the judgment in prior instance unless otherwise specified.)
1. Outline of the case
(1) The first-instance Plaintiff is the patentee of Patent No. 4520670 (hereinafter referred to as the "Patent") for an invention titled "Fluid feeding apparatus, fluid feeding method, recording medium, and program."

The first-instance Defendant manufactures and sells settling instruments that are incorporated into oil feeding apparatuses (the product stated in 1. in the Item List attached to this judgment), and a program that enables the settlement by electronic money can be stored in the same setting instruments. Most of the same setting instruments are operated at gas stations where oil feeding apparatuses into which the same setting instruments are incorporated are installed in the state where the same program is stored and activated.

The first-instance Plaintiff alleged as follows: An oil feeding apparatus into which the abovementioned setting instrument is incorporated falls within the technical scope of the inventions claimed in Claims 1 to 3 and 8 of the Patent, and the same setting instrument falls under an article whose only use is to produce the same oil feeding apparatus; therefore, the first-instance Defendant's act of manufacturing, selling or otherwise handling the same oil feeding apparatus constitutes the indirect infringement of the patent right in question (the "Patent Right") (Article 101, item (i) of the Patent Act). Based on this allegation, the first-instance Plaintiff demanded that the first-instance Defendant suspend the manufacture, sale, and offer for sale of the same setting instrument and dispose of the same setting instrument under Article 100, paragraphs (1) and (2) of the Patent Act and also demanded that the first-instance Defendant pay

2,811,015,900 yen as compensation for damages (partial claim) and delay damages accrued thereon at the rate of 5% per annum (the first day of the calculation is October 1, 2015 in relation to 100,000,000 yen out of the abovementioned amount and September 30, 2018 in relation to the remaining amount) under Article 709 of the Civil Code.

(2) On January 30, 2020, the court of prior instance rendered the judgment [in prior instance] that upheld the first-instance Plaintiff's claims to the following extent.

"1. The first-instance Defendant shall neither manufacture, nor sell, nor offer to sell the product stated in 2. in the Item List attached to this judgment.

2. The first-instance Defendant shall remove the program stated in the Program List attached to this judgment from the product stated in 2. in the Item List attached to this judgment.

3. The first-instance Defendant shall pay to the first-instance Plaintiff 428,347,890 yen as well as the amount accrued on ●●● out of the abovementioned amount at the rate of 5% per annum for the period from October 1, 2015 until the completion of the payment, the amount accrued on ●●●●●●●●●●●●● out of the same amount at the same rate for the period from September 30, 2018 until the completion of the payment, and the amount accrued on ●●●●●●●●●● out of the same amount at the same rate for the period from June 30, 2019 until the completion of payment."

(3) On March 12, 2020, the court of prior instance rendered a ruling to correct paragraph 3 of the main text of the judgment in prior instance as follows.

"3. The first-instance Defendant shall pay to the first-instance Plaintiff 450,543,000 yen as well as the amount accrued on ●●● out of the abovementioned amount at the rate of 5% per annum for the period from October 1, 2015 until the completion of the payment, the amount accrued on ●●●●●●●●●●●●● out of the same amount at the same rate for the period from September 30, 2018 until the completion of the payment, and the amount accrued on ●●●●●●●●●●●●● out of the same amount at the same rate for the period from June 30, 2019 until the completion of payment."

(4) The first-instance Plaintiff and the first-instance Defendant were dissatisfied with the parts they had lost and filed an appeal, respectively. After filing the appeal, the first-instance Plaintiff arranged its claims as mentioned in No. 1 above in light of the ruling of correction mentioned in (3) above. Of which, arrangement regarding the amount of the principal of the claim for damages was intended to limit the scope covered by the appeal to 500,000,000 yen out of the part of the claim that the judgment in prior instance

(after the correction) dismissed with prejudice on the merits.

2. Basic facts, etc. (1)

The following facts, etc. are not disputed between the parties or are easily found based on evidence stated.

(1) The first-instance Plaintiff engages in the business of selling oils, petrochemical products, etc., maintaining and managing gas stations, and operating and managing computer systems relating to gas stations on a regular basis.

The first-instance Defendant engages in the manufacture, sale, etc. of gas station-related equipment on a regular basis.

(2)A. The first-instance Plaintiff is the co-owner of the Patent Right as described below.

[Patent number]

Patent No. 4520670

[Title of the invention]

Fluid feeding apparatus, fluid feeding method, recording medium, and program

[Filing date]

July 18, 2001

[Registration date]

May 28, 2010

B. Non-party Hitachi Automotive Systems Measurement Kabushiki Kaisha (hereinafter referred to as the "Co-owner"; it was Tokiko Techno Kabushiki Kaisha before the change of indication of the registered holder on May 21, 2015) had held 100% share of the Patent Right. However, 50% share of the Patent Right was transferred (specific succession) to non-party Cosmo Oil Co., Ltd. on February 20, 2014, and the relevant share was transferred (general succession) to the first-instance Plaintiff on November 17, 2015. The Patent Right is now co-owned by the first-instance Plaintiff and the Co-owner.

Incidentally, the Co-owner engages in the development, manufacture, and sale of instrumentation devices and the planning, designing, and construction, etc. of gas stations and eco-service stations on a regular basis.

(3)A. Inventions 1 to 3 and 8 stated in Claims 1 to 3 and 8 in the claims of the Patent Right are segmented into the following constituent features (hereinafter those constituent features are described as "Constituent Feature 1A" or "1A," etc., and 1C1 and 1C2 are sometimes collectively referred to as "1C," and 1F1 to 1F4 are sometimes collectively referred to as "1F").

(Invention 1)

1G: A fluid feeding apparatus characterized in that it has

1A: a storage medium reading and writing means which reads and writes the amount data stored in a storage medium,
1B: a flow volume measurement means which measures the fed volume of said fluid,
1C1: a deposit data processing means which imports the amount not exceeding the amount indicated by the amount data in the storage medium that was read by said storage medium reading and writing means before the start of the feeding of said fluid as deposit data and
1C2: writes the amount obtained by deducting the amount of the relevant deposit data from the amount of said amount data in said storage medium as a new amount data,
1D: a feeding permission means which makes it possible to feed the fluid in a volume corresponding to the amount data in the deposit data that was imported by the relevant deposit data processing means,
1E: a calculation means which calculates a charge to be made based on the flow volume value measured by said flow volume measurement means, and
1F1: a charge settlement means which has said calculation means calculate the amount corresponding to the flow volume value measured by said flow volume measurement means,
1F2: deducts the amount of the relevant calculated charge from the amount of said deposit data,
1F3: adds the amount of the remaining difference data to the amount data in said storage medium, and
1F4: writes the amount data after the relevant addition in said storage medium
(Invention 2)
2B: A fluid feeding apparatus stated in Claim 1 that is characterized in that
2A: said deposit data processing means imports the amount not exceeding the amount indicated by the amount data stored in said storage medium before the start of the feeding of said fluid as deposit data and deducts the amount of the relevant deposit data from the amount data in the relevant storage medium
(Invention 3)
3C: A fluid feeding apparatus stated in Claim 1 or 2 that is characterized in that it has
3A: the first refund means which adds the amount of the deposit data imported by said deposit data processing means before the feeding of said fluid to the amount of the amount data in said storage medium if a refund is ordered before the feeding of said fluid and
3B: the second refund means which deducts the amount corresponding to the flow volume value measured by said flow volume measurement means from the amount of

said deposit data, adds the amount of the remaining difference data to the amount of the amount data in said storage medium, and writes the amount data after the relevant addition in said storage medium if a refund is ordered after the feeding of said fluid

(Invention 8)

8P: A program which is executed in a fluid feeding apparatus that makes it possible to feed the fluid in a volume corresponding to the amount data imported as deposit data, which

8C1: imports the amount not exceeding the amount indicated by the amount data in a storage medium that was read by a storage medium reading and writing means before the start of the feeding of fluid into a computer as deposit data and

8Q: is intended to have the following steps be executed in a sequential order:

8C2: the first step in which the amount obtained by deducting the amount of the relevant deposit data from said amount data is written in said storage medium as a new amount data,

8D: the second step in which it is made possible to feed the fluid in a volume corresponding to the amount data in the deposit data, which were imported in the relevant first step,

8E: the third step in which a charge to be made is calculated based on the flow volume value measured by a flow volume measurement means, and

8F1: the fourth step in which the amount corresponding to the flow volume value measured by said flow volume measurement means is calculated,

8F2: the relevant calculated charge is deducted from the amount of said deposit data,

8F3: the amount of the remaining difference data is added to the amount data in said storage medium, and

8F4: the amount data after the relevant addition is written in said storage medium

B. The structure of Invention 8 is a description of the structure of the oil feeding apparatus of Invention 1 from the perspective of a program that has the oil feeding apparatus execute its operations (symbols, C to F, correspond, respectively).

(4) The first-instance Defendant manufactures and sells setting instruments (an instrument that sets the volume of oil to be fed and method of payment to be made by a customer), which constitute oil feeding apparatuses at gas stations, to gas stations affiliated with EMG Marketing Godo Kaisha, to which the same company supplied gasoline, etc. as an oil wholesaler. Incidentally, the same company was merged by absorption by Tonen General Sekiyu Kaisha in January 2017, and Tonen General Sekiyu Kaisha was merged by absorption by JXTG Nippon Oil & Energy Corporation in April of the same year.

In addition, the first-instance Defendant develops and sells a program that makes it possible to settle fees, etc. which is stored on a setting instrument manufactured and sold by the first-instance Defendant and is executed in an oil feeding apparatus.

(5) Oil feeding apparatuses using a setting instrument manufactured and sold by the first-instance Defendant include those that have the structure mentioned in [i] below and perform operations mentioned in [ii] to [vii] in the case where an electronic money medium using a contactless IC chip (called "FeliCa"; hereinafter the term "electronic money (medium)" as used in this judgment refers to this unless otherwise specified) is used to feed oil and to settle a charge for the feeding. Hereinafter, a program that has an oil feeding apparatus perform such operations is called the "Defendant's Program," a setting instrument on which the Defendant's Program is stored is referred to as the "Defendant's Setting Instrument," and an oil feeding apparatus comprising the Defendant's Setting Instrument is referred to as the "Defendant's Oil Feeding Apparatus." In addition, the operations mentioned in [ii] to [vii] are sometimes referred to as "Specific Operation [ii]," etc.

[i] In general, an oil feeding apparatus consists of an oil feeding machine that feeds oil for a customer, a weighing machine that measures the volume of oil fed and indicates the amount of payment obtained by multiplying the unit price of oil by the volume of oil fed, a setting instrument that sets the volume of oil to be fed and the method of payment to be made by a customer, etc. The Defendant's Oil Feeding Apparatus is an oil feeding apparatus comprising the Defendant's Setting Instrument and a weighing machine (hereinafter the weighing machine constituting the Defendant's Oil Feeding Apparatus is referred to as the "Defendant's Weighing Machine"). The Defendant's Setting Instrument has component structures, including a display and a reader.

[ii] A customer who intends to use an electronic money medium to pay for the oil fed selects the means of payment using electronic money on the display of the Defendant's Setting Instrument. The customer has his/her electronic money medium touch the reader of the Defendant's Setting Instrument in accordance with an instruction indicated on the display of the Defendant's Setting Instrument (incidentally, to be exact, it is only necessary to bring the medium within a few centimeters of the reader as the medium adopts a "contactless" system; therefore, hereinafter the word "hold over" is sometimes used in place of the word "touch"). The Defendant's Setting Instrument reads the balance of the electronic money medium by the first touching motion.

[iii] Buttons stating the volumes of oil to be fed or the amounts to be paid are indicated on the display of the Defendant's Setting Instrument, and a customer can select the volume of oil to be fed or the amount to be paid by pushing one of those buttons. At

this time, a customer cannot select any volume of oil to be fed or amount to be paid, when the payment amounts calculated based on the unit price per unit volume of oil (generic name for gasoline and light oil) (the amounts calculated by multiplying the volumes of oil to be fed by the unit price) exceed the balance of the electronic money medium read in [ii] above. Whether individual volumes of oil to be fed and amounts to be paid are selectable or not are indicated on the display of the Defendant's Setting Instrument.

[iv] After selecting the volume of oil to be fed or the amount to be paid, a customer touches the reader of the Defendant's Setting Instrument with the electronic money medium again. By this second touching motion, the Defendant's Setting Instrument reads the balance of the electronic money medium again (incidentally, the balance could differ due to the use of the electronic money medium after the first touching motion), indicates the balance on the display, deducts the amount of payment corresponding to the volume of oil to be fed or the amount to be paid as selected by the customer from the balance of the electronic money medium, and writes the balance after that deduction in the electronic money medium (underlined by this court; the same applies hereinafter). The amount of payment corresponding to the selected volume of oil to be fed (the unit price multiplied by the volume of oil to be fed as selected by the customer) or the fact that the amount to be paid as selected by the customer was deducted is indicated on the display of the Defendant's Setting Instrument, and the balance of the electronic money medium after the deduction is also indicated thereon.

[v] If a customer conducts the second touching motion mentioned in [iv] above, an instruction to start the feeding of oil is indicated on the display of the Defendant's Setting Instrument, and the feeding of oil in the volume as selected by the customer or the volume of oil corresponding to the amount to be paid as selected by the customer becomes possible. Therefore, the customer becomes able to take the oil feeding nozzle from the Defendant's Weighing Machine and feed oil to his/her vehicle.

During oil feeding, the volume of oil fed is indicated on the display of the Defendant's Weighing Machine, and the indication changes according to the volume of oil fed. In addition, the amount of payment according to the volume of oil fed up to then is indicated on the display of the Defendant's Weighing Machine, together with the change of the volume of oil fed. This amount of payment is the result of multiplying the unit price of oil by the volume of oil actually fed.

[vi] Where a customer finished the feeding of oil before the volume of oil fed reaches the volume of oil to be fed or the volume of oil corresponding to the amount to be paid that they selected in [iv] above, such as the case where they suspended the feeding of

oil and returned the oil feeding nozzle to its original position on the Defendant's Weighing Machine, the same price as the price indicated on the display of the Defendant's Weighing Machine as the amount of payment as mentioned in [v] above is indicated as the amount of purchase on the display of the Defendant's Setting Instrument. At this time, the amount of refund is indicated on the display of the Defendant's Setting Instrument, together with an indication to the effect that the amount corresponding to the volume of oil that was not fed is refunded.

When a customer pushes a button for receiving a refund on the display of the Defendant's Setting Instrument in the state where the abovementioned amount of refund is indicated on the display, an instruction is indicated on the display of the Defendant's Setting Instrument. If a customer touches the reader of the Defendant's Setting Instrument with an electronic money medium in accordance with the instruction (third touch), the Defendant's Setting Instrument adds the amount of refund to the balance of the electronic money medium before the refund and writes the balance in the electronic money medium in such a way that the balance of the electronic money medium is that after the addition. The fact that the amount of refund was charged is indicated on the display of the Defendant's Setting Instrument, and the balance of the electronic money medium after the refund is indicated thereon. This balance after the refund is the amount obtained by adding the amount of refund to the balance of the electronic money medium before the refund.

[vii] Even where a customer touches the reader of the Defendant's Setting Instrument with an electronic money medium (first touch), selects the volume of oil to be fed, and touches the reader of the Defendant's Setting Instrument with the electronic money medium again (second touch) and an instruction to start the feeding of oil is indicated on the display of the Defendant's Setting Instrument, if the customer does not start the feeding of oil thereafter, the same amount as the amount of money to be paid by the second touch motion is indicated on the display of the Defendant's Setting Instrument as the amount of refund, together with an indication to the effect that the paid amount is refunded. During this status, the customer can push a button for receiving the refund on the display of the Defendant's Setting Instrument, and if the customer pushes it, by the same operation as mentioned in [vi] above (third touch, etc.), the amount deducted by the second touch motion is added to the balance of the electronic money medium, and the balance of the electronic money medium is written in the electronic money medium in such a way that the balance is that after the addition of the abovementioned deducted amount.

(6) Card-type FeliCa (Suica card, nanaco card, Edy card, etc.) is a computer with a CPU,

antenna, memory, etc., and it has calculation and communication functions, etc. (Exhibits Otsu 37, 38-1, and 38-2).

Therefore, the underlined operations mentioned in (5) above are shared, in a strict sense, by the Defendant's Oil Feeding Apparatus and a FeliCa card (electronic money medium). For example, in the underlined operation mentioned in [iv] above, the Defendant's Oil Feeding Apparatus sends the amount of payment or the amount corresponding to the volume of oil to be fed to a FeliCa card, and the FeliCa card conducts calculation for deducting the abovementioned amount from the balance of the card and stores the balance after the deduction in the memory. In addition, the FeliCa card sends information, such as the fact that the abovementioned amount was used at a gas station, to the issuer of the card and the operator of the gas station, etc. through a communication network connected to the Defendant's Oil Feeding Apparatus, and thereby enables the settlement, etc. between the issuer of the card and the operator of the gas station.

In this manner, in a strict sense, the Defendant's Oil Feeding Apparatus does not conduct operations of calculations, including deduction from the balance of the card, and writing.

(7)A. The structures and operations of the Defendant's Oil Feeding Apparatus mentioned in (5)[i] to [vi] above are segmented as follows in line with the constituent features of Invention 1 (underlined parts are not necessarily accurate in light of the specification of FeliCa card, as mentioned in (6) above).

1g: An oil feeding apparatus characterized in that it has

1a: a reader which reads and writes the amount data stored in an electronic money medium,

1b: a means for measuring the volume of oil fed which measures the volume of oil, such as gasoline and light oil, that was fed

1c1: a deposit data processing means which imports the amount designated by the customer not exceeding the amount indicated by the amount data in the storage medium that was read by said reader before the start of the feeding of oil as deposit data, and

1c2: writes the amount obtained by deducting the amount of said deposit data from said amount data in said electronic storage medium as a new amount data,

1d: a feeding permission means which makes it possible to feed oil in a volume corresponding to the amount data in the deposit data that was imported by the relevant deposit data processing means,

1e: a calculation means which calculates the amount for refund in the case where a customer finishes the feeding of oil before the volume of oil fed reaches the

abovementioned volume of oil, and

1f: a charge settlement means which has the amount of refund calculated based on abovementioned calculation be written in said electronic money medium in the case mentioned above

B. Out of the findings in A. above, the parties dispute over the method of calculation that is conducted in the calculations stated in 1e and 1f. The first-instance Defendant alleged that the Defendant's Oil Feeding Apparatus directly calculates the amount of payment corresponding to the volume of oil that falls short of the volume of oil based on the amount designated by the customer, that is, the amount of refund, (1e) and writes it in the electronic money medium (1f). On the other hand, the first-instance Plaintiff alleged that the Defendant's Oil Feeding Apparatus conducts calculations similar to Constituent Features 1E and 1F of Invention 1. This court reserves a determination concerning this point.

The first-instance Plaintiff also alleged as follows: [i] regarding the "electronic money medium" in 1a, 1c1, 1c2, and 1f, the first-instance Defendant acknowledged, in prior instance, that the Defendant's Oil Feeding Apparatus uses a "storage media," without specifying the relevant medium as such; therefore, an admission has been established in this regard, and the first-instance Defendant is not permitted to dispute over this point at this stage; [ii] regarding the "amount designated by the customer" in 1c1, the first-instance Defendant also acknowledged the fulfillment of Constituent Feature 1C1 of Invention 1 without such limitation; therefore, an admission has also been established, and the first-instance Defendant is not permitted to dispute over this point at this stage. This court examines the propriety of these allegations again later.

C. It is considered that the Defendant's Oil Feeding Apparatus can comprise the following structure in relation to the operations mentioned in (5)[ii] to [iv] above.

2a: a deposit data processing means incorporates the amount that is less than the amount indicated by the amount of an electronic money medium before the start of the feeding of oil as deposit data and also deducts the amount of the deposit data from the electronic money medium

D. The operation mentioned in (5)[vii] above of the Defendant's Oil Feeding Apparatus can be described as follows in line with the constituent features of Invention 3 as the structure of a "refund means."

3a: A refund means which adds the amount of deposit data incorporated by said deposit data processing means before the feeding of oil to the amount of the amount data in said electronic money medium if an instruction to refund is given before the feeding of oil

(8) Out of the constituent features of the Defendant's Oil Feeding Apparatus described

as mentioned in (7) above, 1b, 1g, 2a, and 3a fulfill Constituent Features 1B, 1G, 2A, and 3A of the Invention, respectively (this point is not disputed between the parties).

On the other hand, regarding other Constituent Features 1a, 1c, 1e, and 1f, the parties dispute over the fulfillment of the constituent features of the Invention (details are described later).

3. Basic facts, etc. (2)

The following facts, etc. are not disputed between the parties or are easily found based on evidence stated.

(1) Regarding Trial No. 145

A. Request for a trial

The first-instance Defendant filed a request for a trial for the invalidation of the Patent with the Japan Patent Office on December 17, 2018, while this case was pending in the court of prior instance (Invalidation Trial No. 2018-800145; hereinafter referred to as "Trial No. 145"). The summary of grounds for invalidation is as follows.

Incidentally, Exhibits Ko in the same trial are described as "Trial Exhibit Ko A1," etc.

[Grounds for invalidation]

Invention 1 does not involve an inventive step in relation to the invention described in Unexamined Patent Application Publication No. 1995-210754 (Exhibit Otsu 14-1 Publication (Trial Exhibit Ko A1); hereinafter referred to as "Trial Exhibit Ko A1 Publication").

B. Advance notice of a trial decision

On February 21, 2020, the Japan Patent Office ruled that the abovementioned allegation of the first-instance Defendant is well-grounded and made an advance notice of a trial decision to invalidate Invention 1.

C. Correction in question

(A) On June 29, 2020, the first-instance Plaintiff filed a request for the correction of the Patent (hereinafter referred to as the "Correction").

(B) The substantial content of the correction of Invention 1 was the correction of the statement of Constituent Feature 1G as stated below, and underlined parts in Constituent Features 1X and 1Y were added.

"1X: A fluid feeding apparatus <u>for feeding fuel at a gas station</u> which has

…

1Y: <u>wherein it is possible to suspend the oil feeding process after amount data in a storage medium is read by said storage medium reading and writing means before the amount not exceeding the amount indicated by said amount data in the storage medium</u>

is imported as deposit data"

The first-instance Plaintiff also corrected Invention 8 to add the structures that have substantially the same content as Constituent Features 1X and 1Y.

(C) The substantial content of the correction of Invention 3 is the addition of Constituent Feature 3Z as stated below.

"3Z: also has a paper money insertion portion"

(D) Incidentally, Claim 3 before the Correction cited Claims 1 and 2. In the Correction, the part citing Claim 2 was made into an independent claim and was moved into a newly added claim, Claim 9. Claim 9 also has structures corresponding to 1X, 1Y, and 3Z as mentioned above.

(E) The Defendant's Oil Feeding Apparatus fulfills Constituent Features 1X and 3Z that were added by the Correction. However, whether the Defendant's Oil Feeding Apparatus fulfills Constituent Feature 1Y is disputed between the parties as described later.

(2) Regarding Trial No. 146

A. Request for a trial

The first-instance Defendant filed a request for a trial for the invalidation of the Patent (Invalidation Trial No. 2018-800146; hereinafter referred to as "Trial No. 146") with the Japan Patent Office on the same date as the date on which the request for a trial for invalidation mentioned in (1) above was filed.

Incidentally, Exhibits Ko in the same trial are sometimes described as "Trial Exhibit Ko B1," etc.

[Ground for Invalidation 1]

Invention 1 does not involve an inventive step in relation to the invention that has been publicly known to be worked in a stand-alone outdoor-installed settlement terminal manufactured by the first-instance Defendant, SF-1000 (Exhibit Otsu 16-1 (Trial Exhibit Ko B1) is a manual for SF-1000 and is hereinafter referred to as "Trial Exhibit Ko B1 Manual"; SF-1000 is hereinafter referred to as "Trial Exhibit Ko B1 Apparatus").

[Ground for Invalidation 2]

Invention 1 does not involve an inventive step in relation to the invention described in Unexamined Patent Application Publication No. 1999-130198 (Exhibit Otsu 16-4 (Trial Exhibit Ko B4)) (Exhibit Otsu 16-4 is referred to as "Exhibit Otsu 3 Publication" below in accordance with the judgment in prior instance as it is the same document as Exhibit Otsu 3).

[Ground for Invalidation 3]

Invention 1 does not involve an inventive step in relation to the invention described in Unexamined Patent Application Publication No. 1992-57794 (Exhibit Otsu 16-21 (Trial Exhibit Ko B21); hereinafter referred to as "Trial Exhibit Ko B21 Publication").
B. Regarding Trial No. 146, neither an advance notice of a trial decision was given, nor a request for correction was filed.
4. Issues (hereinafter the issues are referred to as "Issue 1," etc. in number order)
(1) Whether the Defendant's Oil Feeding Apparatus falls within the technical scope of Invention 1
(2) Whether the Defendant's Setting Instrument falls under a product indirectly infringing the Defendant's Oil Feeding Apparatus
(3) Whether the first-instance Defendant is negligent in relation to infringement
(4) Whether the Patent should be invalidated through a trial for patent invalidation
(5) Whether damages exist and the amount of damages
(6) Scope of products that are subject to a demand for an injunction and a demand for disposal

(omitted)

No. 4 Judgment of this court
1. Technical meaning, etc. of the Invention
(1) Statements in the description in question

The description in question (the "Description") states the following in relation to the problems to be solved by the Invention, means for solving the problems, and effect, etc.

A. Technical field of the invention

The Invention relates to a fluid feeding apparatus and program that are structured to use a prepaid card for the settlement of a charge for fluid. ([0001])

B. Prior art

In the past, in the case where a customer intended to use a fuel feeding system at a self-service gas station for the feeding of oil and pay a charge through a settlement method using a prepaid card, they stopped their vehicle in front of an unoccupied weighing machine and inserted a prepaid card into the card reader and writer (hereinafter referred to as "RW"), and then designated a type of oil to be fed with the oil type selection switch, inserted the oil feeding nozzle for the designated type of oil into the oil feeding opening of their vehicle, and started the feeding of oil; when the feeding of oil ended, the amount of payment corresponding to the volume of oil fed was

deducted from the balance data stored in the prepaid card, and the balance data was written in the prepaid card and the prepaid card was returned to the customer. ([0004])

C. Problems to be solved by the invention

The abovementioned prior art (hereinafter referred to as the "Prior Art") had the following three problems (hereinafter referred to as the "Three Problems"): [i] as the prepaid card cannot be seen from outside after it is inserted into the RW, the customer is likely to forget the fact that the prepaid card is in the RW and leave the gas station while leaving the prepaid card behind; [ii] if the prepaid card is inserted in the RW installed on the weighing machine during the feeding of oil, it is inconvenient because the customer cannot use the prepaid card for other purposes, such as purchasing a drink by inserting the prepaid card into a drink vending machine, etc., during the feeding of oil; [iii] a system structured to start the feeding of oil with part of the inserted prepaid card sticking out of the card insertion slot prevents customers from forgetting their cards after finishing the feeding of oil, but drivers cannot move away from the weighing machine because of the possibility of theft of their prepaid cards as inserted prepaid cards can be pulled out during the feeding of oil. ([0005] to [0007])

D. Means for solving the problems

As means for solving the Three Problems, the Invention adopted a means, etc. whereby the following operations are controlled: before the start of the feeding of fluid, amount (y) not exceeding the amount indicated by the amount data in a storage medium (x) is imported as deposit data, and the amount obtained by deducting amount y of the relevant deposit data from amount data x (x - y) is written as a new amount data; the flow volume corresponding to deposit data y is made available for feeding; and the amount to be charged after the feeding of fluid (z) is determined, the amount of difference between the amount imported as the deposit data y and the abovementioned amount to be charged z (y - z) is added to the amount data in the storage medium (x - y), and the amount data after the relevant addition ((y - z) + (x - y) = (x - z)) is written in the storage medium. ([0009] to [0011] and [0016])

E. Effect of the invention

The adoption of the Invention makes it possible to take out a storage medium during the feeding of fluid. Therefore, the problems mentioned in [i] and [ii] can be solved. In addition, even if a storage medium is kept inserted during the feeding of oil, the amount of damage from the theft of the storage medium can be lowered as the balance of the storage medium is zero or small. Therefore, the problem mentioned in [iii] above can be solved. ([0073] and [0074])

(2) Technical meaning of the application of debit processing before feeding

Incidentally, in the Prior Art, a customer is to insert a prepaid card into the RW before starting the oil feeding operation. However, debiting of payment for oil fed and writing of the balance are conducted between the prepaid card and the RW after the completion of the oil feeding operation (hereinafter referred to as a "debit after feeding"). Then, it could be considered that as a simpler means for solving the Three Problems, it is only necessary to insert a prepaid card into the RW only after the completion of the oil feeding operation. In addition, even if it is necessary to insert a prepaid card into an oil feeding apparatus before the start of the oil feeding operation for the purpose of recognizing amount x indicated by the amount data in the storage medium (hereinafter referred to as "card balance"), if it is necessary to do so only for that purpose, the Three Problems can be simply solved by changing the specifications of an oil feeding apparatus in such a way to enable a customer to take out a prepaid card from the oil feeding apparatus after card balance x is read and to insert it again after the completion of the feeding of oil.

In the Invention, the process of debiting amount y before the start of the feeding of oil (hereinafter referred to as a "debit before feeding") is added despite the existence of these simple means for solving the problems. Moreover, the amount of payment for the oil actually fed z differs from amount y in many cases, and in such case, the process of settling difference between those amounts after the completion of the feeding of oil (hereinafter referred to as "settlement after feeding") is required. Therefore, the number of times of processing, such as that required for rewriting of the amount data in a prepaid card, increases from once to twice, and the entire process becomes more complicated.

The Description states no reason for having adopted a structure, in which the process of "debit before feeding" is added in the Invention, though the adoption of the structure results in the complication of the entire process. However, as long as use at a self-service gas station is supposed, it is reasonable to presumptively recognize that the reason therefor exists in that by the abovementioned simple means it is impossible to eliminate the possibility that a customer will leave the gas station without settling payment after the completion of the feeding of oil (there is the following statement in [0002] and [0003] of Exhibit Otsu 4 (Unexamined Patent Application Publication No. 1999-11594; hereinafter referred to as "Exhibit Otsu 4 Publication"): for cash settlement-based self-service gas stations, an "advance payment system" is preferable to a "deferred payment system" because there is the "possibility that a customer will escape without making payment for the oil fed").

That is, for operators of self-service gas stations designed for many and unspecified

customers, permitting the feeding of oil to customers without receiving any "security" involves the risk of failure to collect payments. It can be said that the Prior Art, in which a prepaid card was kept inserted in the RW during oil feeding operation, intended to avoid the abovementioned risk by keeping the prepaid card, which embodies the value corresponding to the balance, as security. The Invention can be considered to have solved the Three Problems by a new structure wherein deposit data amount y is kept as security in place of keeping an article, a prepaid card, as security, while avoiding the risk of failure to collect payments.

In other words, the Prior Art made it possible to operate a self-service gas station while avoiding the risk of failure to collect payments through the combination of keeping a prepaid card before the start of the feeding of oil (hereinafter referred to as "keeping of a medium") and debiting payment after the completion of the feeding of oil (hereinafter referred to as a "debit after feeding"). On the other hand, the Invention can be considered not only to have made it possible to operate a self-service gas station while avoiding the risk of failure to collect payments but also to have adopted the combination of "debit before feeding" and "settlement after feeding" for the purpose of solving the Three Problems.

2. Regarding the structure, etc. of the Defendant's Oil Feeding Apparatus

According to evidence stated below and the entire import of oral arguments, the following facts are found in relation to the Defendant's Oil Feeding Apparatus.

(1) In general, an oil feeding apparatus comprises an oil feeding machine that feeds oil for a customer, a weighing machine that measures the volume of oil fed and indicates the amount of payment obtained by multiplying the unit price of oil by the volume of oil fed, a setting instrument that sets the volume of oil to be fed and the method of payment to be made by a customer, etc. (entire import of oral arguments)

The Defendant's Oil Feeding Apparatus is an oil feeding apparatus comprising the Defendant's Setting Instrument and the Defendant's Weighing Machine. The Defendant's Setting Instrument has component structures, including a display and a reader.

(2) When a customer uses an electronic money medium to pay for the oil fed and settles a charge on the Defendant's Oil Feeding Apparatus, they conduct operations as stated in No. 2, 2.(5) above.

(3) The Defendant's Program is stored on the Defendant's Setting Instrument and is executed in the Defendant's Oil Feeding Apparatus. This Defendant's Program has the Defendant's Oil Feeding Apparatus conduct the operations mentioned in (2) above in response to operations conducted by a customer.

(4) The Defendant's Weighing Machine and other weighing machines manufactured and sold by the first-instance Defendant are ordinarily set up to "omit" decimals in the final calculation of the amount of a charge for oil fed. In that case, the amount of payment for oil fed indicated on the weighing machine and the amount of purchase indicated on the setting instrument become the same. If the abovementioned setting is changed to "round off decimals to the closest whole number," the amount of payment for oil fed indicated on the weighing machine and the amount of purchase indicated on the setting instrument may differ. (Exhibits Otsu 6 and 7)

The Defendant's Oil Feeding Apparatuses and the Defendant's Programs manufactured and sold by the first-instance Defendant to former EMG-affiliated gas stations do not include those in which the amount of refund differ from the amount obtained by subtracting the amount of purchase (the amount indicated on the Defendant's Weighing Machine as the amount of payment) from the amount of payment (the amount debited from an electronic money medium) in the refund process.

(5) The manual for the Defendant's Oil Feeding Apparatus that is distributed to gas stations at which the Defendant's Oil Feeding Apparatus is installed includes the following statements. (Exhibit Otsu 11)

A. In relation to means for payment by electronic money before feeding, refund in cash (cashing) is basically not permitted.

B. In the handling of electronic money paid before feeding, a customer is to purchase the "right to feed oil" in the amount that they paid by electronic money. If a customer finishes the feeding of oil before the volume of oil fed reaches the volume of oil corresponding to the amount of their payment, the amount of money corresponding to the volume of oil that was not fed is refunded to them as a refund for the oil that was not fed. Specifically, if a customer deposits 5,000 yen by electronic money before feeding, a transaction of the right to feed oil for 5,000 yen is made between the customer and the service station. If the customer's vehicle is filled up by oil for 3,000 yen in the subsequent feeding of oil, the refund process is conducted in a way that the service station purchases oil for the remaining 2,000 yen from the customer.

(6) At former EMG-affiliated gas stations, it has become possible to settle a charge, etc. by using a FeliCa card by filing an application with an oil wholesaler, EMG Marketing, since October 1, 2015. (Exhibit Ko 5)

(7) In order to make it possible to make settlement by an electronic money medium on the Defendant's Setting Instrument, it is necessary to store the Defendant's Program in the Defendant's Setting Instrument and conduct an operation called activation at a gas station where the Defendant's Setting Instrument is installed. The abovementioned

activation roughly comprises the following operations: [i] having an indication about electronic money settlement be displayed on the operation screen of the setting instrument of the oil feeding apparatus, [ii] downloading a file relating to the setting of electronic money, rewriting an oil feeding control program and a program relating to the calculation of the amount of electronic money, and putting a program for payment by using an electronic money medium into an operable state, [iii] putting a contactless credit card reader into a state available also for electronic money media, and [iv] making communication settings, including assignment of an ID to each setting instrument and registration of such IDs with a center that manages and communicates card information, settlement information, etc.

3. Regarding Issue 1 (arguments that the Defendant's Oil Feeding Apparatus fulfills the constituent features of the Invention (hereinafter referred to as "arguments on fulfillment"))

(1) Regarding Allegation on Non-infringement [iv]

A. Whether or not an admission has been established

The first-instance Plaintiff alleged that the first-instance Defendant's Allegation on Non-infringement [iv] constitutes withdrawal of its admission that had been established based on its approval or disapproval in its written answer submitted in the prior instance, and is impermissible.

However, whereas the question of whether or not an admission has been established should be examined based on the entirety of the party's answer, the first-instance Defendant, although "approving" that its product fulfills Constituent Feature 1C in its written answer in prior instance, made the following allegations, for example, in the section for its approval or disapproval of the first-instance Plaintiff's allegations on equivalence and the section for the first-instance Defendant's allegations in that written answer: (a) in Constituent Feature 1C of Invention 1, the amount to be debited is set by the system of the setting instrument, whereas in Constituent Feature 1c of the Defendant's Oil Feeding Apparatus, the amount to be debited is designated by the customer; (b) in the Defendant's Oil Feeding Apparatus, the transactions are completed in Constituent Feature 1c; and (c) in Constituent Feature 1F of Invention 1, the amount of payment according to the amount of the oil fed is calculated, and the difference with the debited amount is returned, whereas in Constituent Feature 1f of the Defendant's Oil Feeding Apparatus, the amount of payment for the sale and purchase that arise from returning the volume of oil that could not be fed is calculated. These allegations of the first-instance Defendant should practically be understood to be asserting that the processes conducted in the Defendant's Oil Feeding Apparatus differ from the processes

conducted in Constituent Feature 1C of Invention 1. Thus, it can be said that it is inappropriate for the court of prior instance to have simply treated the fulfillment of Constituent Feature 1C as an issue not disputed between the parties.

According to the above, it cannot be said that the first-instance Defendant's Allegation on Non-infringement [iv] is impermissible because it constitutes withdrawal of its admission.

B. Regarding the amount to be debited

(A) The specific way of determining the "amount not exceeding the amount indicated by the amount data in the storage medium" that becomes the amount of a "debit before feeding," that is, the "amount not exceeding the card balance," is not specified in Constituent Feature 1C1 of Invention 1. In consideration of the statements in the Description, the amount of debit before feeding is the whole amount of the card balance in Working Example 1 ([0037]), and is the "amount set in advance" (hereinafter referred to as the "preset amount") in Working Example 2 ([0049]).

Regarding the issue of who conducts the latter "setting," the first-instance Plaintiff alleged that a customer also sets the amount in some cases. However, the amount set by a customer is supposed to differ in each case of the feeding of oil and can thus not be considered to be the amount "set in advance". Therefore, the abovementioned allegation cannot be accepted, and the abovementioned amount should be considered to mean the amount preset by the system of a setting instrument (however, if a customer presets the flat-rate amount to be debited separately from individual occasions of the feeding of oil, the amount may fall under the "amount set in advance"; however, "the volume of oil to be fed or the amount to be paid" selected by a customer in specific operations [iii] and [iv] of the Defendant's Oil Feeding Apparatus is just to be designated at the time of an individual occasion of the feeding of oil and differs in each case; therefore, it does not fit the definition mentioned above).

(B) In this manner, the "amount designated by a customer," which is ordinarily supposed to be first conceived of as the subject of "debit before feeding," is not described as a working example, and only the "whole amount of the card balance" or the "amount set in advance," which is set according to the convenience of gas station operators, is described as a working example. This is probably because the amount of "debit before feeding" in Constituent Feature 1C1 has the nature of "security" for payment for the oil to be fed, as pointed out in 1.(2) above. That is, in the step of Constituent Feature 1C of Invention 1, the amount of "debit before feeding" as security is determined without regard to the volume of the oil to be fed, and the settlement process based on the premise that oil was fed is scheduled to be conducted only in the steps of 1D to 1F. The

abovementioned settlement process includes the following steps: actual feeding of oil, calculation of a charge based on the volume of oil fed, deduction of the amount of payment for the oil fed from the amount debited before feeding, and return of the remaining amount. In this manner, the amount of "debit before feeding" itself is determined not as the amount of payment for the oil actually fed but as security for the amount to be paid subsequently for the oil fed. Therefore, when determining the amount of debit before feeding, it is only necessary for gas station operators to set an appropriate amount from the perspective of the need to secure payment for the oil fed and other perspectives, and it is not necessary to reflect customers' intention. Given this perspective, the working examples do not describe a case where a customer determines the amount to be debited before feeding because it is not necessary to do so. Therefore, it is considered that Invention 1 does not assume a structure wherein a customer determines the amount of "debit before feeding."

On the other hand, in the Defendant's Oil Feeding Apparatus, the "amount not exceeding the amount indicated by the amount data in the electronic money medium" that is the amount of "debit before feeding" is the amount to be paid corresponding to the volume of oil to be fed that a customer designates before using the Defendant's Oil Feeding Apparatus. This is because it is first necessary for a customer to purchase the "right to feed oil" by paying a certain amount in the procedure of settlement by electronic money before feeding that is used in the Defendant's Oil Feeding Apparatus, as mentioned in 2.(5) above. Therefore, the amount debited in Constituent Feature 1c1 of the Defendant's Oil Feeding Apparatus is not security but payment for oil to be fed itself, and it is thus never determined without regard to the customer's intention.

In this manner, the amount debited before feeding has entirely different meanings between Invention 1 and the Defendant's Oil Feeding Apparatus, and in a reflection of that difference, in the Defendant's Oil Feeding Apparatus, the amount debited before feeding is to be determined by a customer, which is not assumed in Constituent Feature 1C1 of Invention 1. Therefore, Constituent Feature 1c1 of the Defendant's Oil Feeding Apparatus does not fulfill Constituent Feature 1C1 of Invention 1.

Incidentally, the first-instance Plaintiff alleged that working examples in which the amount of deposit data imported is the amount to be paid for oil to be fed as set by a customer ("The amount to be paid for oil to be fed that you set is deposited" in (B) in [Fig. 9] and "Deposited amount/3,000 yen" in (C) therein) are also disclosed in [0061] to [0068] and [Fig. 9] in the Description, etc. However, it is difficult to determine, based on the indications in [Fig. 9], that the indications indicate that the amount designated by the customer is "deposited." Taking into account that paragraphs [0061] to [0068]

are parts explaining Working Examples 1 and 2 and that [Fig. 9] is cited as part of that explanation, it is rather far reasonable to consider that the indications in the abovementioned [Fig. 9] assume and explain the cases where the whole amount of the balance of the medium or the preset amount is debited as in Working Examples 1 and 2, instead of assuming the case where a customer designates the amount to be paid for oil to be fed. Therefore, the first-instance Plaintiff's allegation cannot be accepted.

(2) Regarding Allegation on Non-infringement [v]

A. Whether an admission has been established and whether the first-instance Defendant's new allegations in the appeal instance constitute belated allegations or evidence

The first-instance Plaintiff alleged that Allegation on Non-infringement [v] is impermissible because it constitutes withdrawal of its admission that had been established based on its approval or disapproval in its written answer submitted in the prior instance and is also a belated allegation.

Certainly, in the approval or disapproval of Constituent Feature 1A, etc. in its written answer in prior instance, the first-instance Defendant did not clearly dispute the point that the electronic money medium in the Defendant's Oil Feeding Apparatus falls under the "storage medium" in the Invention. However, the first-instance Defendant had alleged that the Defendant's Oil Feeding Apparatus is not the one that embodied the technical idea of the Invention. Therefore, it can be said that the Allegation on Non-infringement [v] makes this allegation from the perspective of difference in the settlement means used (prepaid card and contactless IC card). Consequently, as long as the first-instance Defendant has not expressed approval or disapproval in order to simply approve the overall arguments on fulfillment, it cannot be said that the first-instance Defendant withdrew its admission and made a new allegation, and it is also not reasonable to handle this allegation as a belated allegation.

Therefore, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

B. Whether a contactless IC card falls under a "storage medium"

As the specific circumstances of the "storage medium" in the Invention, the Description discloses an "electronic money card with built-in IC memory for storing the amount data" ([0070]) and a "storage medium in a form other than a card, for example, disc-shaped, tape-shaped, and plate-shaped medium" ([0071]), in addition to a magnetic prepaid card ([0033]). In this manner, the "storage medium" in the Invention is not necessarily limited to a magnetic prepaid card.

However, in light of the fact that the technical meaning of the Invention is as

mentioned in 1. above, unless a storage medium used is one for which settlement through combination of "keeping of a medium" and "debit after feeding" can be assumed, the Three Problems never occur and it thus does not mean that the effect of solving the problems by the structure of the Invention was produced. Therefore, a storage medium for which settlement through the abovementioned combination cannot be assumed does not fall under the "storage medium" in the Invention.

When examining this case from such perspective, as the electronic money medium used in the Defendant's Oil Feeding Apparatus is a contactless IC card, it can be said that in terms of its nature, the card is basically expected to be constantly held by a customer in making settlement, etc. therewith, while only momentarily being held over the RW as needed. Therefore, when developing an oil feeding apparatus for a self-service gas station compatible with electronic money media, a structure wherein the oil feeding apparatus "keeps" an electronic money medium as an article is hardly assumed. Therefore, it is impossible for a person skilled in the art who intends to develop an oil feeding apparatus compatible with electronic money media to adopt the Prior Art as long as the "keeping of a medium" is the essential structure of the Prior Art.

Consequently, the electronic money medium used in the Defendant's Oil Feeding Apparatus does not have the Three Problems that are to be solved by the Invention, and is also not subject to the means for solving the problems of the Invention. Therefore, it should be considered not to fall under the "storage medium" stated in the Invention. The Defendant's Oil Feeding Apparatus for which electronic money media can be used is just an oil feeding apparatus for cash settlement, which adopts a settlement procedure created by changing a basic settlement procedure, wherein a customer hands a certain amount of cash they have to service staff or puts it in the money slot of the oil feeding apparatus, for the feeding of oil within that amount, and receives the balance (change) if any (this procedure is introduced in [0002] of Exhibit Otsu 4 Publication as prior art, and it thus can be considered to have been well-known art) according to the nature of electronic money media. Therefore, it should be considered as an art established independent of the technical idea of the Invention. The first-instance Defendant's Allegation on Non-infringement [v] is considered to allege this point in the form that the electronic money medium in the Defendant's Oil Feeding Apparatus is not included in the "storage medium" in the Invention, and is thus well-grounded.

C. Regarding the first-instance Plaintiff's allegations

(A) The first-instance Plaintiff alleged that it is only necessary that the "storage medium" in the Invention is a "storage medium" suitable for the operations of Constituent Features 1C and 1F.

However, as an invention is a technical idea which serves as a means for solving a problem, in the process of interpreting the meaning of the wording of claims reciting the structure of an invention, the statements in the description concerning the problem to be solved by the invention and the operation and effect to be provided by the invention should be taken into account, and the meaning should be examined from the viewpoint of what operation and effect would be provided and what problem would be solved by that structure of the invention. Nevertheless, the abovementioned first-instance Plaintiff's allegation only concerns the form of the wording without examining the wording from such perspective and is thus unreasonable.

Therefore, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(B) The first-instance Plaintiff alleged that [0070] in the Description contains a statement citing an "electronic money card with built-in IC memory for storing the amount data" as an example of the "storage medium" and that a contactless IC card is also included in such card.

However, the abovementioned statement only indicates that the storage element of a card could be an IC memory instead of a magnetic material in response to statements in [0033], including the statement that "prepaid card 71 comprises a magnetic card," and is not a statement indicating that the card operates without contact. Moreover, in the abovementioned statement, the IC memory is "to store the amount data," and the statement neither discloses nor suggests that the IC memory has calculation and communication functions like a contactless IC card. Therefore, it cannot be said that a contactless IC card falls under the "storage medium" in the Invention based on the abovementioned statement.

Therefore, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(C) The first-instance Plaintiff alleged as follows: it is well-known that a contactless IC card can be used while being put in a ticketing machine, and the Description indicates that a storage medium that is not continuously placed in the setting instrument can also be used; therefore, it cannot be said that a contactless IC card does not fall under the "storage medium" in the Invention.

However, just as the basic facts stated above, when using an electronic money medium in the Defendant's Oil Feeding Apparatus, the electronic money medium (contactless IC card) is only held over the RW and is not "continuously placed" in the apparatus. Although contactless IC cards in general can be used in the form as alleged by the first-instance Plaintiff, in the Defendant's Oil Feeding Apparatus, a contactless

IC card is used as an "electronic money medium" without being based on such form of use. Therefore, the technical meaning of the "electronic money medium" in the Defendant's Oil Feeding Apparatus differs from that of the "storage medium" in the Invention.

Therefore, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(3) Summary of the arguments on fulfillment

According to the above, the first-instance Defendant's Allegations on Non-infringement [iv] and [v] are well-grounded. Therefore, the Defendant's Oil Feeding Apparatus and the Defendant's Program do not infringe the Patent without the need to determine whether other allegations on non-infringement is established.

4. Regarding Issue 4 (arguments on invalidity)

For confirmation, arguments on invalidity are examined on the assumption that the amount of "debit before feeding" in Invention 1 also include the amount designated by a customer (see 3.(1)B.(B) above) and that a contactless IC card is also included in the "storage media" in the Patent (see 3.(2)B. above).

Incidentally, in this case, it is only necessary to examine the arguments on invalidity in relation to Inventions 1 and 3 (those after the Correction). This is as instructed at the beginning of No. 3, 4. above.

(1) Regarding whether the first-instance Defendant's new allegations in the appeal instance constitute belated allegations or evidence

As the first-instance Defendant's Allegations on Invalidity A, B, and D were presented after the court of prior instance disclosed its interim views concerning the arguments on infringement, they were treated by the court of prior instance as having been presented belatedly. However, as already pointed out in the section concerning the arguments on fulfillment, it must be said that the manner in which the court of prior instance arranged issues concerning fulfillment of Constituent Feature 1C1 (Allegation on Non-infringement [iv]) and fulfillment of Constituent Features 1A, 1C, 1F3, and 1F4 (Allegation on Non-infringement [v]) is defective in that an issue that should have been treated as one disputed between the parties was treated as one involving no such dispute. Given that matters such as whether and when the parties should make allegations on the arguments on invalidity cannot be considered separately from the process through which the parties present allegations and evidence concerning the arguments on fulfillment, in this case where it is considered that the parties should have presented further allegations and evidence concerning the arguments on fulfillment, it is not reasonable to evaluate that the first-instance Defendant's allegations on invalidity were

presented belatedly solely based on the fact that they were presented after the court of prior instance disclosed its interim views concerning the arguments on infringement.

In addition, it can be said that, in this instance, the first-instance Defendant presented allegations on invalidity regarding the abovementioned grounds for invalidation immediately after filing the appeal.

According to the above, the abovementioned allegations on invalidity by the first-instance Defendant cannot be evaluated as having been presented belatedly either from the viewpoint of looking at the overall proceedings in the prior instance and this instance or from the viewpoint of focusing only on the proceedings in this instance.

Consequently, none of the allegations on invalidity by the first-instance Defendant should be dismissed without prejudice as a belated allegation or evidence.

(2) Regarding whether the Correction conforms to the requirements for correction

As the first-instance Defendant made a counter-defense of correction based on the Correction in relation to all the arguments on invalidity, for convenience, this court first clarifies that the Correction conforms to the requirements for correction as mentioned below, and then examines the arguments on invalidity on the premise of the Corrected Invention.

A. Regarding Constituent Feature 1X

The addition of Constituent Feature 1X is a correction to limit "fluid feeding" before the correction to "oil feeding," and the parties do not dispute that it conforms to the requirements for correction.

B. Regarding Constituent Feature 1Y

Constituent Feature 1Y is a structure that makes it possible to suspend the oil feeding process after the card balance is read before the amount not exceeding the card balance is debited.

The first-instance Defendant alleged as follows: the Invention is to solve the problems in making and settling payment for the oil fed, and it is naturally premised that a user actually feeds oil; on the other hand, added Constituent Feature 1Y is a structure that is originally based on the premise that oil is not fed, and it thus provides new operation and effect that are completely unrelated to the purpose of Invention 1.

However, as the oil feeding process is supposed to be suspended at a self-service gas station before the feeding of oil is started based on a user's intention, it cannot be said that the situation where oil is not fed is against the natural premise of Invention 1. Moreover, as the operation and effect provided by Constituent Feature 1Y are not clear from the statements in the Description corresponding to Constituent Feature 1Y, it cannot be said that Constituent Feature 1Y provides new operation and effect that are

completely unrelated to the purpose of Invention 1 before the correction.

Consequently, the addition of Constituent Feature 1Y neither substantially enlarges nor alters the claims in comparison to the claims before the correction.

C. Regarding Constituent Feature 3Z

Constituent Feature 3Z is a structure that additionally has the paper money insertion portion to make it possible to handle paper money (cash).

The first-instance Defendant alleged as follows: the Invention is an invention that is naturally premised on payment by using a prepaid card, etc., and the addition of a structure that makes it possible to make payment by using cash, etc. causes the exertion of new operation and effect that are completely unrelated to the operation and effect of the Invention as stated in the Description; therefore, the addition substantially enlarges and alters the claims.

However, as the Description discloses a specific embodiment with the paper money insertion portion ([0024], [0026], [0031], [Fig. 2], and [Fig. 3]), it cannot be said that payment by using cash, etc. is completely unrelated to the Invention. In addition, it cannot be said that the fact that cash can be used in addition to a prepaid card provides new operation and effect that are completely unrelated to the purpose of the Invention.

Therefore, the addition of Constituent Feature 3Z neither substantially enlarges nor alters the claims in comparison to the claims before the correction.

(3) Regarding the first-instance Defendant's Allegation on Invalidity B

A. Regarding Trial Exhibit Ko B1 Apparatus as the primary cited invention

(A) The public relations magazine published by the first-instance Defendant on April 30, 2000 (Exhibit Otsu 16-19) carries an article to the effect that a "stand-alone settlement terminal SF-1000" is actually operating at self-service gas stations. According to photographs and explanatory text in that article, the operation manual published on March 1, 2001 (Exhibit Otsu 16-18) is recognized as a manual for the same model as that described in the abovementioned public relations magazine. Then, the same manual and Trial Exhibit Ko B1 Manual (Exhibit Otsu 16-1) were published on the same date, and they differ only in that the display is "LED" or "LCD" and do not differ in the operational procedures described, the operations of the terminal that are presumptively recognized from those procedures, and the content of the programs. Therefore, the structure of Trial Exhibit Ko B1 Apparatus (SF-1000) that had been publicly known to be worked on the filing date in question can be found based on Trial Exhibit Ko B1 Manual (excerpt from the manual is indicated in an attachment to this judgement).

(B) In this regard, the first-instance Plaintiff alleged that the structure (Trial Exhibit Ko

B1 Invention) of Trial Exhibit Ko B1 Apparatus as of 2000 (Exhibit Otsu 16-19) cannot be found based on Trial Exhibit Ko B1 Manual that was published in 2001 (Exhibit Otsu 16-1) as the operation manual for a product cannot be published after the release of the product. However, it is not impossible that an operational manual is prepared at a later date due to republication, revision, etc. Therefore, it should be said that it is not precluded from using Trial Exhibit Ko B1 Manual as evidence to find an invention that had been publicly known to be worked at least as of March 1, 2001, on which the manual was prepared (this date is before the filing date of the Patent). Consequently, the abovementioned allegation is unreasonable.

B. The result of comparison between the structure in which Invention 1 (before the Correction) is applied to an electronic money medium (contactless IC card) and the structure in which cash is used on Trial Exhibit Ko B1 Apparatus (cited invention) is as indicated in the following table (for the latter, numbers in parentheses indicate the relevant pages of Trial Exhibit Ko B1 Manual, and matters without parentheses are those that are naturally recognized presumptively based on the general knowledge).

| Invention 1 | Cited invention | |
|---|---|---|
| 1A: an RW which reads and writes the amount data stored in an electronic money medium, | 1a: for customers who can count the amount of money in their wallets and put cash in and out from their wallets | |
| 1B: a flow volume measurement means which measures the volume of fluid fed, | 1b: has a weighing instrument [7] | Common feature |
| 1C1: a deposit data processing means which imports amount y not exceeding the balance of the electronic money medium read by said RW before the start of the feeding of said fluid as deposit data and | 1c1: accepts and takes in paper money for amount y not exceeding amount of cash x that a customer has from the paper money insertion slot of the apparatus before the start of the feeding of oil [1-5], | |
| 1C2: writes the amount obtained by deducting amount y of the relevant deposit data from said balance x in the | 1c2: the amount obtained by deducting the abovementioned amount y that was taken into the apparatus from amount x | |

| | | |
|---|---|---|
| electronic money medium as a new amount data, | that the customer had before putting paper money in the apparatus (x - y) remains in the customer's wallet | |
| 1D: a feeding permission means which makes it possible to feed the fluid in a volume corresponding to amount y of the abovementioned deposit data that was imported by the relevant deposit data processing means, | 1d: it becomes possible for the customer to feed oil corresponding to amount y of the paper money that was taken into the abovementioned apparatus [1-6] | Common feature |
| 1E: a calculation means which calculates a charge to be made based on the flow volume value measured by said flow volume measurement means, and | 1e: has the function to calculate the amount of payment for the oil fed based on the flow volume value measured by the weighing machine | Common feature |
| 1F1: a charge settlement means which has said calculation means calculate amount z corresponding to the flow volume value measured by said flow volume measurement means, | 1f1: calculates amount z corresponding to the flow volume value measured by the weighing machine by the abovementioned calculation function [1-7] | Common feature |
| 1F2: deducts the relevant calculated charge z from the amount of said deposit data y, | 1f2: deducts amount z from amount y that was taken into the apparatus [1-7], | Common feature |
| 1F3: adds the amount of the remaining difference data (y – z) to the amount data (x – y) in said electronic money medium, and | 1f3: change (y - z) is emitted from the paper money slot and the coil return [4] [1-7], and the customer puts the change in his/her wallet containing the amount (x - y) | |
| 1F4: writes the amount data | 1f4: the amount of cash that | |

| | | |
|---|---|---|
| after the relevant addition (x - z) in said electronic money medium | the customer has becomes (x - z) | |
| 1G: A fluid feeding apparatus characterized in that it has | 1g: An oil feeding apparatus | Common feature |

C. Whether a person skilled in the art could have easily conceived of differences

The structures of Invention 1 which are not determined to be common features in the table above constitute differences.

However, all of those structures are those that an oil feeding apparatus for a self-service gas station naturally come to have when replacing payment by cash in Trial Exhibit Ko B1 Apparatus with payment by an electronic money medium. That is, the abovementioned differences can be summed up in the following two points: in Invention 1, the apparatus has an RW; the amount data of electronic money is electronically rewritten by the RW. However, all of those structures are outcomes that inevitably arise as a result of having monetary value embodied in a tangible object, currency, in the case of cash being embodied in an intangible object, electronic information.

Moreover, replacement of payment by cash with payment by an electronic money medium can be easily conceived of from the word "money" in the term "electronic money." For example, the following matters are stated in Exhibit Otsu 16-12 (Electronic Commerce Promotion Council of Japan, "Interim Report on the Study of Standard Settlement Model Relating to Mobile EC," issued in March 2001): a contactless IC card is used as "electronic money"; and a mobile phone with built-in FeliCa can serve as an "electronic wallet." These statements provide motivation for the replacement of payment by cash with payment by electronic money medium.

Based on the above, it can be said that it was merely the result of the exercise of ordinary creativity and was easy for a person skilled in the art to conceive of the structures of Invention 1 pertaining to the abovementioned differences.

D. Regarding the first-instance Plaintiff's allegations concerning whether a person skilled in the art could have easily conceived of Invention 1

(A) The first-instance Plaintiff alleged as follows: if the cited invention is found based on a structure in the case where cash is put in Trial Exhibit Ko B1 Apparatus, its structure becomes totally different from that of Invention 1 in which a storage medium, such as a prepaid card, is used, and the Three Problems cannot occur.

However, if a contactless IC card is used as the "storage medium" in Invention 1, the Three Problems also cannot occur in Invention 1 in the first place, as instructed in 3.(2) above. Nevertheless, in terms of the fulfillment of the constituent features, the

first-instance Plaintiff alleged that the "storage medium" in Invention 1 includes a contactless IC card that is not premised on the solution of the Three Problems. However, in response to the allegation on invalidity based on the art in which the storage medium in the cited invention is replaced with a contactless IC card, the first-instance Plaintiff alleged that the allegation on invalidity cannot be established as the Three Problems are not solved. These allegations made by the first-instance Plaintiff must be considered to constitute self-contradiction.

Therefore, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(B) The first-instance Plaintiff argued that the first-instance Defendant alleges the lack of an inventive step in the Invention by arguing that the Invention can be reached through the combination of two easy steps.

However, as instructed in C. above, if payment by cash in Trial Exhibit Ko B1 Apparatus is changed to payment by an electronic money medium, the apparatus naturally comes to have the structures of Invention 1 indicated in the table in B. above, and it is not necessary for a person skilled in the art to "conceive of" those structures.

Therefore, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(C) The first-instance Plaintiff alleged that Invention 1 does not fall under the "systematization of service or a method for doing business performed by humans," which can be easily conceived of by a person skilled in the art according to the Japan Patent Office's Examination Guidelines. However, as mentioned in C. above, the grounds for the allegation that a person skilled in the art could have easily conceived of Invention 1 are that a person skilled in the art could have easily conceived of replacing payment by cash with payment by an electronic money medium and that if a person skilled in the art conceives of this point, they naturally arrive at the structures of Invention 1 pertaining to the differences (this is a natural outcome and does not require the process of conception), and whether Invention 1 falls under the "systematization of service or a method for doing business performed by humans" is not questioned. Therefore, the first-instance Plaintiff's allegation does not affect the abovementioned determination.

E. Regarding involvement of an inventive step in the Corrected Invention

(A) Regarding Constituent Feature 1X

As Trial Exhibit Ko B1 Apparatus is an oil feeding apparatus, Constituent Feature 1X does not constitute a difference.

(B) Regarding Constituent Feature 1Y

As long as an oil feeding apparatus for a self-service gas station is an automatic vending machine for the general public, it is considered to fall within the general knowledge to make it possible for customers to suspend operation at any stage and not to require customers to bear a special burden in the case of suspension of operation. Neither specific structure for suspending the oil feeding process before the card balance is read nor the technical meaning thereof is clear in the Corrected Invention.

Therefore, it should be said that a person skilled in the art could have easily conceived of adding such structure to the cited invention based on a method that falls within the general knowledge.

(C) Regarding Constituent Feature 3Z

Trial Exhibit Ko B1 Manual itself also discloses the idea of making it possible to settle payment by cash on an oil feeding apparatus by providing a paper money insertion slot on the apparatus in addition to a card insertion slot, and the idea of making it possible to respond to multiple settlement means on an automatic vending machine is well-known art (Exhibit Otsu 3 Publication, etc.). Moreover, Constituent Feature 3Z only specifies that the apparatus has a paper money insertion slot, and the Description does not disclose processing procedures, etc. when using a prepaid card and cash in combination. Therefore, a special technical meaning that differs from that of the abovementioned well-known art is not clear.

Consequently, it should be said that a person skilled in the art could have easily conceived of the addition of such structure based on well-known art.

(D) According to the above, the constituent features added by the Correction do not provide a basis for the involvement of an inventive step.

F. According to the above, Allegation on Invalidity B is well-grounded.

(4) Regarding Allegation on Invalidity A

A. Comparison between Invention 1 and Trial Exhibit Ko A1 Invention

The result of comparison between Invention 1 and Trial Exhibit Ko A1 Invention is as indicated in the table below. Incidentally, as the working example described in Trial Exhibit Ko A1 Publication is an example relating to a gas supply unit, Trial Exhibit Ko A1 Invention is described based on that example in the table below.

| Invention 1 | Trial Exhibit Ko A1 Invention | |
|---|---|---|
| 1A: a storage medium reading and writing means which reads and writes the amount data stored in a storage medium, | 1a: its meter side control unit 10 has a portion that "receives the prepaid amount stored in contactless prepaid card 1 by | Common feature |

| | | |
|---|---|---|
| | meter side radio receiving portion 8 and transmits the balance to prepaid card 1 via meter side radio transmitting portion 11," | |
| 1B: a flow volume measurement means which measures the volume of fluid fed, | 1b: wherein it has flow volume detection device 15, | Common feature |
| 1C1: a deposit data processing means which imports amount y not exceeding the amount indicated by amount data x in the storage medium that was read by said storage medium reading and writing means before the start of the feeding of said fluid as deposit data, wherein deposit data y may be designated by a customer, and | 1c: wherein the full amount x of the prepaid amount received by said meter side radio receiving portion 8 is stocked in ROM 9 on the meter side (in this state, a user can use gas at any time by opening the gas cock), and by running fixed amount depositing circuit 18, it is possible to leave only amount y to be deposited as designed by a user (customer) in the meter and return the remaining amount (x – y) to prepaid card 1, | Common feature |
| 1C2: writes the amount obtained by deducting the amount of the relevant deposit data from the amount of said amount data (x - y) in said storage medium as a new amount data, | | |
| 1D: makes it possible to feed the fluid in a volume corresponding to the amount data in the deposit data that was imported by the relevant deposit data processing means, | 1d: wherein it has a means for calculating the upper limit of the volume of gas to be used corresponding to amount y stocked in ROM 9 on the meter side, and | Common feature |
| 1E: a calculation means which calculates a charge to be made | | Difference 1 |

| | | |
|---|---|---|
| based on the flow volume value measured by said flow volume measurement means, and | | |
| 1F1: a charge settlement means which has said calculation means calculate the amount corresponding to the flow volume value measured by said flow volume measurement means, | 1f: wherein if there is the remaining amount after settlement of a charge based on the volume used up to then, the remaining amount is stocked and can be refunded to prepaid card 1 | Difference 2 |
| 1F2: deducts the relevant calculated charge from the amount of said deposit data, | | |
| 1F3: adds the amount of the remaining difference data to the amount data in said storage medium, and | | |
| 1F4: writes the amount data after the relevant addition in said storage medium | | |
| 1G: A fluid feeding apparatus characterized in that it has | A contactless prepaid card-based gas meter characterized in that | |

B. Regarding Difference 1

(A) Content of Difference 1

It is unclear whether flow volume detection device 15 in Trial Exhibit Ko A1 Invention has the "calculation means" in Constituent Feature 1E of Invention 1.

(B) Whether a person skilled in the art could have easily conceived of Difference 1

Trial Exhibit Ko A1 Publication contains the following statement: "… volume of gas corresponding to the deposited amount is calculated, and when this volume becomes zero, shutoff device 16 is shut off. Further, the supply of gas can be stopped by the user's intention during the supply of gas. In this case, the charge for gas used up to then is settled" [0019]. In light of this statement, it can be said that it is also suggested that Trial Exhibit Ko A1 Invention has a means for calculating a charge based on the flow

volume of fluid. In addition, it is obvious that an oil feeding apparatus for feeding fuel at an automated gas station is supposed to naturally have a means for calculating a charge based on the volume of oil fed.

Therefore, Difference 1 is not a substantial difference, or even if it is a difference, it can be said that a person skilled in the art could have easily conceived of adopting Constituent Feature 1E pertaining to Difference 1 in Invention 1, which is a fluid feeding apparatus for feeding fuel at a gas station.

C. Regarding Difference 2

(A) Content of Difference 2

The inventions have commonality only in terms of a "charge settlement means which has the calculation means calculate the amount based on the volume used up to then, deducts the amount of the relevant calculated charge from the amount of said deposit data, and refunds the amount of the remaining difference data to said storage medium." However, in Trial Exhibit Ko A1 Invention, [i] the charge settlement means "has the calculation means calculate the amount based on the volume used up to then," but it is unclear whether it "has said calculation means calculate the amount corresponding to the flow volume value measured by a flow volume measurement means" like Invention 1. [ii] It is also unclear whether the process of "refund to a storage medium" in Trial Exhibit Ko A1 Invention includes the process of "addition to the amount data in the storage medium" and the process of "writing of the amount data after the relevant addition in said storage medium."

(B) Whether a person skilled in the art could have easily conceived of Difference 2

a. Regarding the point mentioned in [i] above

It is obvious to a person skilled in the art that the "volume used up to then" is detected by "flow volume detection device 15" in Trial Exhibit Ko A1 Invention. Moreover, it is easy for a person skilled in the art to structure an oil feeding apparatus so that it has a means for calculating a charge based on the volume of oil fed (B. above).

Therefore, a person skilled in the art could have easily conceived of the structure of Invention 1 pertaining to the point mentioned in a. above.

b. Regarding the point mentioned in [ii] above

In Trial Exhibit Ko A1 Invention, in Constituent Feature 1c, by running fixed amount depositing circuit 18, it is possible to leave only the amount to be deposited in the meter and return the remaining amount to prepaid card 1. Therefore, it can be said that Trial Exhibit Ko A1 itself suggests the following: if intending to further return the remaining amount to prepaid card 1, to which the remaining amount was returned by fixed amount depositing circuit 18, through the refund in Constituent Feature 1f, that

process is to be conducted by a method of further addition to the amount data of the remaining amount returned to prepaid card 1 by fixed amount depositing circuit 18, and the amount adding the remaining amount arising from the refund is to be written as the balance of prepaid card 1. In general, it is extremely natural to adopt a structure wherein the amount of refund is added to the amount data in a storage medium and the amount data after the relevant addition is written in said storage medium in order to make a refund in the amount data of the remaining amount after a transaction in the storage medium (incidentally, on page 32 of the "advance notice of a trial decision" (Exhibit Otsu 47) in Trial No. 145, multiple patent documents are cited and the court finds that it is a well-known art).

Therefore, a person skilled in the art who came across Trial Exhibit Ko A1 Invention could have easily considered the structure of Invention 1 pertaining to Difference 2 as a matter required to identify the invention in light of the abovementioned well-known art only by exercising ordinary creativity.

D. Regarding involvement of an inventive step in the Corrected Invention

(A) Regarding Constituent Feature 1X

Constituent Feature 1X to the effect that a fluid feeding apparatus is "for feeding fuel at a gas station" is added in Corrected Invention 1. On the other hand, Trial Exhibit Ko A1 Invention is not specified as such. Therefore, this point constitutes a difference.

However, the essential feature of the Invention exists in the settlement procedure at a self-service gas station and does not exist in the flow volume measurement means (meter) itself. With regard to Constituent Feature 1X of Corrected Invention 1, the application of the contactless prepaid card-based meter in Trial Exhibit Ko A1 Invention to a "fluid feeding apparatus for feeding fuel at a gas station" has commonality in terms of a settlement procedure used for a meter that feeds fluid in return for a value. In addition, Trial Exhibit Ko A1 Publication includes a statement to the effect that the invention can also be used for a water meter. On the other hand, in [0069] in the Description, it is stated that the invention is also applicable to fluid other than fuel, such as drinking water. Therefore, it can be said that the technical fields of those inventions are related to each other. Consequently, it can be said that a person skilled in the art could have easily conceived of obtaining Constituent Feature 1X of Corrected Invention 1 by applying Trial Exhibit Ko A1 Invention to fuel oil, not limiting the usage of Trial Exhibit Ko A1 Invention to the usage indicated as an example in Trial Exhibit Ko A1 Publication.

(B) Regarding Constituent Features 1Y and 3Z

A person skilled in the art could have easily conceived of the structures of Corrected

Invention 1 pertaining to Constituent Features 1Y and 3Z, as instructed in (3)E. above in relation to Allegation on Invalidity B.

E. Regarding the first-instance Plaintiff's allegations

(A) The first-instance Plaintiff alleged that Invention 1 and Trial Exhibit Ko A1 Invention differ in the technical field. However, this allegation cannot be accepted as mentioned in D. above.

(B) The first-instance Plaintiff first alleged that Constituent Feature 1C of Invention 1 and Constituent Feature 1c of Trial Exhibit Ko A1 Invention are different from each other, and then alleged as follows: in Trial Exhibit Ko A1 Invention, in terms of the characteristics of the invention as a feeding apparatus for water, gas, etc. in cottage areas, a customer, in principle, deposits the full amount, and the adoption of a structure wherein "by running fixed amount depositing circuit 18, it is possible to leave only the amount to be deposited in the meter and return the remaining amount to prepaid card 1" is merely an additional matter; there is a disincentive to change the design of such Trial Exhibit Ko A1 Invention and adopt the structure of Invention 1 wherein only part of the balance of a card is imported, and there is also no motivation to do so; in addition, even if a person skilled in the art can conceive of importing part of the balance of a card, there is a disincentive to change Trial Exhibit Ko A1 Invention to adopt the structure of Invention 1 and there is also no motivation to do so as Trial Exhibit Ko A1 Invention has already realized the same effect by the "fixed amount depositing circuit."

However, the basic operations of Constituent Feature 1C of Invention 1 and Constituent Feature 1c of Trial Exhibit Ko A1 Invention are designed to recognize amount x stored in a prepaid card, transfer amount y in the stored amount to the feeding apparatus, and write the remaining amount (x – y) in the prepaid card, and these operations are common to those constituent features. In addition, there is no sign that a special device for conducting such operations is used in Invention 1, and Invention 1 is considered to achieve such operations by general means. Therefore, it is not found that those constituent features are substantially different from each other.

Consequently, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(C) Regarding Constituent Features 1X and 1Y, the first-instance Plaintiff also alleged that there is a disincentive or no motivation. However, both of those constituent features are nothing more than a method that falls within the general knowledge or the application of well-known art. Therefore, no special motivation is required, and no disincentive exists. Therefore, the first-instance Plaintiff's allegation cannot be accepted.

(D) The first-instance Plaintiff alleged that there is a disincentive to add Constituent

Feature 3Z that is designed for the combined use of paper money to Trial Exhibit Ko A1 Invention, which is designed to solve the problem of inconvenience arising from the use of coins (cash).

However, the fact that a prepaid card is a settlement means that has been developed to eliminate the inconvenience of settlement by cash is not exclusively related to Trial Exhibit Ko A1 Invention. However, cash is still the most versatile settlement means today. Therefore, the fact that many automatic vending machines compatible with prepaid cards are also designed to be compatible with cash falls within the general knowledge. In addition, Constituent Feature 3Z of Corrected Invention 3 merely states that the fluid feeding apparatus has a paper money insertion portion, and does not specify how settlement by using paper money is made and how that settlement by using paper money is related to the entire settlement procedure of the Corrected Invention by using a "storage medium" (card). Therefore, it is impossible to find that settlement by using paper money has a special technical meaning. In that case, provision of a paper money insertion slot on Trial Exhibit Ko A1 Invention based on a general method is also nothing more than a mere matter of design variation. Therefore, motivation is not required to do so, nor there is disincentive to do so.

Consequently, the abovementioned first-instance Plaintiff's allegation cannot be accepted.

(E) Incidentally, as mentioned at the beginning of this section, this examination of the arguments on invalidity is based on the premise that the Defendant's feeding apparatus also fulfills the constituent features of Invention 1 as Invention 1 also includes the cases where a customer designates the amount of debit before feeding. Therefore, the following argument cannot be established: in Trial Exhibit Ko A1 Invention, a customer designates the amount of debit before feeding, while Invention 1 does not include such designation method; therefore, this point constitutes a difference, and this difference cannot be overcome.

(5) Summary concerning the arguments on invalidity

According to the above, the first-instance Defendant's Allegations on Invalidity B and A are well-grounded. Therefore, without the need to determine whether other allegations on invalidity are established, the Patent should be invalidated through a trial for patent invalidation even after the Correction.

5. Conclusion

Accordingly, the first-instance Plaintiff's claims are groundless and should be dismissed with prejudice on the merits. The judgment in prior instance that partially upheld the first-instance Plaintiff's claims is unreasonable. Therefore, based on the

appeal filed by the first-instance Defendant, the part of the judgment in prior instance which is against the first-instance Defendant is reversed, and all of the first-instance Plaintiff's claims pertaining to the same part is dismissed with prejudice on the merits. The appeal filed by the first-instance Plaintiff has no grounds and therefore is dismissed with prejudice on the merits. The judgment is rendered as indicated in the main text.

Intellectual Property High Court, Third Division
Judge: UEDA Takuya
Judge: TSUNO Michinori
Presiding Judge TSURUOKA Toshihiko is unable to sign and seal this document due to his retirement.
Judge: UEDA Takuya

Attachment

Item List

1. Product name: Setting instrument "POS 21"

2. Product name: Setting instrument "POS 21" (one in which the program stated in the Program List attached to this judgment is stored)

Attachment

Program List

(The principal claim is made based on the structure not including the underlined parts, and the alternative claim is made based on the structure including the underlined parts.)

A program having constituent features a to f and y stated below, which is executed on an oil feeding apparatus comprising a setting instrument. However, it includes a program that has the process of instructing an electronic money medium and a third-party organization, in place of the setting instrument, to deduct or add the designated amount when writing the amount data in the electronic money medium.

a: A program which is executed on an oil feeding apparatus that makes it possible to feed oil in a volume corresponding to the amount data imported as deposit data,

y: which is a program for making it possible to suspend the oil feeding process after the amount data in a storage medium is read by a reader before the amount not exceeding the amount indicated by the amount data in said electronic money medium is imported as deposit data,

f. by executing the following steps in a sequential order:

b: the first step in which the amount not exceeding the amount indicated by the amount data in an electronic money medium that was read by the reader before the start of the feeding of oil is imported in the oil feeding apparatus as deposit data and the amount obtained by deducting the amount of the relevant deposit data from the amount of said amount data in said electronic money medium as a new amount data,

c: the second step in which it is made possible to feed oil in a volume corresponding to the amount data in the deposit data that was imported in said first step,

d: the third step in which the volume of oil fed measured by a means for measuring the volume of oil that was fed from the volume of oil corresponding to the amount data in the deposit data and a charge to be added is calculated based on the amount of money corresponding to the remaining volume of oil to be fed, and

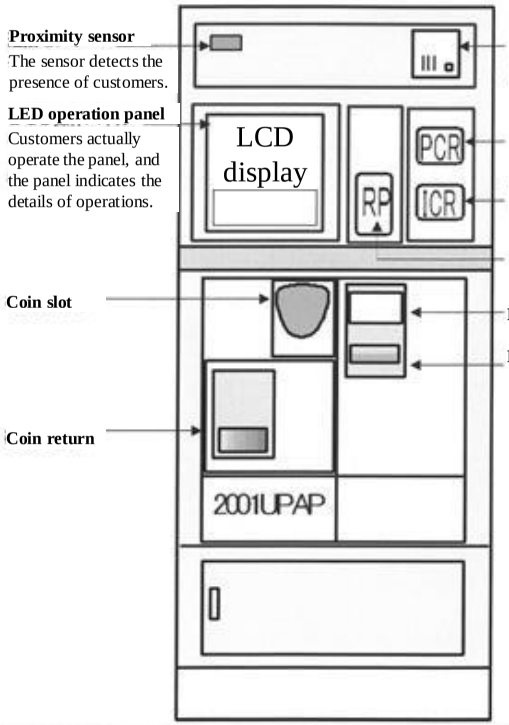
e1: the fourth step in which the amount of money corresponding to said remaining volume of oil to be fed is calculated,

e2: the relevant calculated amount is added to the amount data in said electronic money medium, and

e3: the amount data after the relevant addition is written in said electronic money medium

## Part names and functions

This manual explains the operations of outdoor terminals such as the following.




**Proximity sensor**
The sensor detects the presence of customers.

**LED operation panel**
Customers actually operate the panel, and the panel indicates the details of operations.

**Intercom**
This is an intercom for calling staff.

**Prepaid card insertion slot**

**Card insertion slot**
Customers insert a card, such as a member card and credit card, in this slot.

**Receipt ejection slot**

**Coin slot**

**Paper money insertion slot**

**Paper money return slot**

**Coin return**

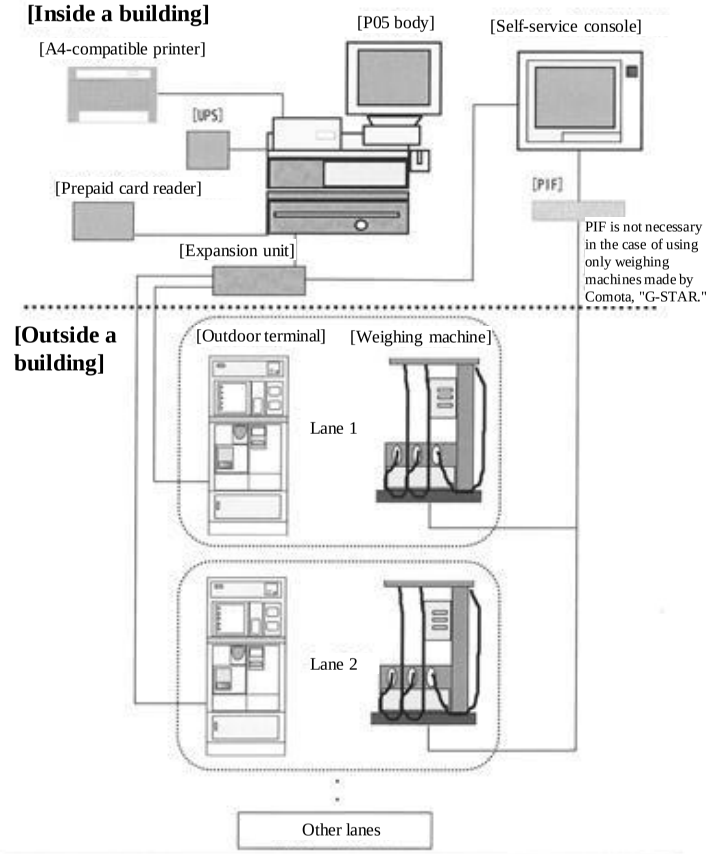
### Handling of cards

Depending on the specifications, some types of outdoor terminals do not have the "prepaid card insertion slot" or the "card insertion slot." Please note that this manual describes an outdoor terminal with both slots as an example.



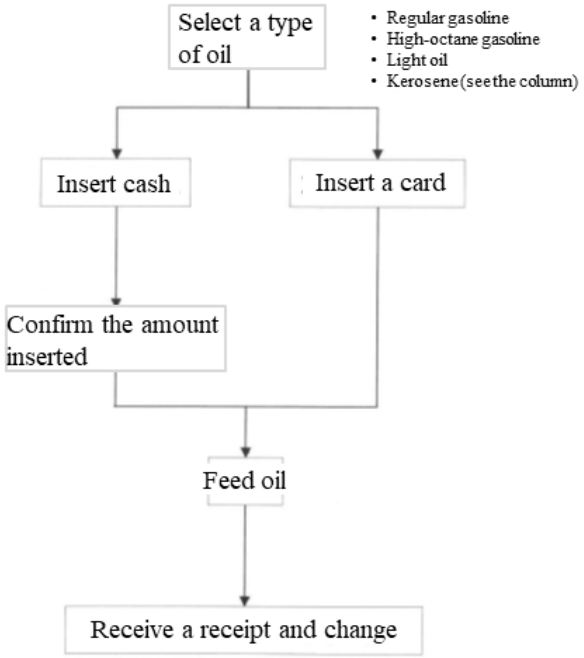
## Diagram of connection between an outdoor terminal and peripherals

An example of connection between an outdoor terminal and peripherals is indicated below. Incidentally, connection differs for each customer, so the following connection is not always applicable. For details, please make inquiries with the business offices of Comota Co., Ltd.



# 1. Flow of the oil feeding operation

The flow of the oil feeding operation conducted by a customer is roughly as follows.




**Selection of a type of oil**

Depending on individual customers' specifications, there are terminals that allow a selection of a type of oil from the options of high-octane gasoline, regular gasoline, and light oil, and terminals designed to feed only kerosene. Please note that terminals designed to feed only kerosene do not have the function to allow a selection of a type of oil.



# 2. Oil feeding process

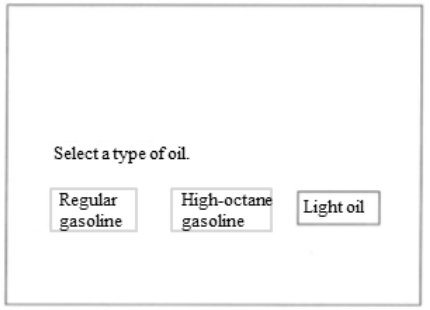
Oil feeding process is explained by method of payment.

## 2-1 Cash

The operation procedure for payment by cash is explained.

### 1. Select the type of oil you want.

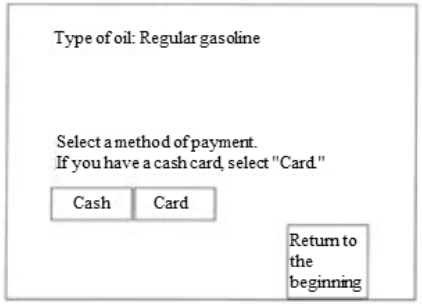
"Hello. Select a type of oil."




If the terminal is only for feeding kerosene, it is not necessary to select a type of oil. In such case, refer to step 2 and subsequent steps in the operation procedure.

## 2. Push the Cash button.

"Select a method of payment."




If you want to change the type of oil, push the Return to the beginning button and restart the procedure from step 1.

### Insertion of paper money

Two or more paper money bills can be inserted in the slot at the same time. (up to about 20 bills)
If a paper money bill cannot be read, it is ejected. So, insert it in the slot again.
In the case of inserting two or more paper money bills in the slot, please make sure that a receipt or other paper is not stuck between the bills because it will cause a paper jam.

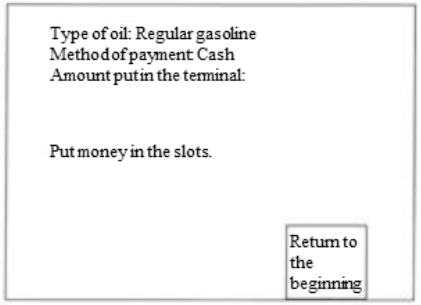
### Insertion of a cash member card

A cash member card can be used on an outdoor terminal having a card insertion slot.
If you have a cash member card, first select Card and then insert your cash member card. Please put money in the slots after hearing an audio guidance instructing you to put cash in the slots.



## 3. Put money in the slots.

"Put money in the slots."

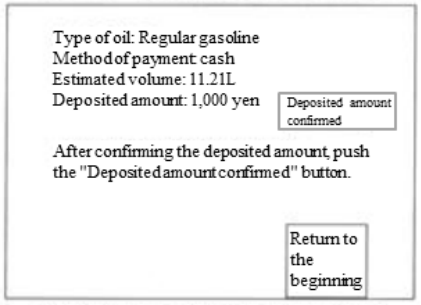





If you want to change the method of payment or amount or type of oil, push the Return to the beginning button and restart the procedure from step 1.

## 4. Push the Deposited amount confirmed button.

"If that's all right, push the 'Deposited amount confirmed' button."

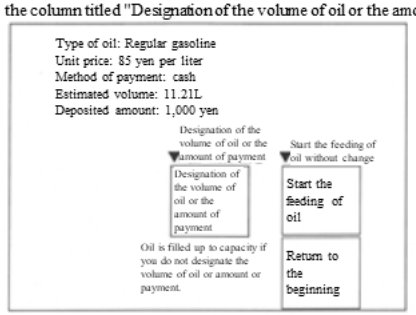



If you want to change the method of payment, amount or type of oil, push the Return to the beginning button and restart the procedure from step 1.

## 5. If you want to start the feeding of oil without change, push the Start the feeding of oil button.

"If that's all right, push the 'Start the feeding of oil' button."

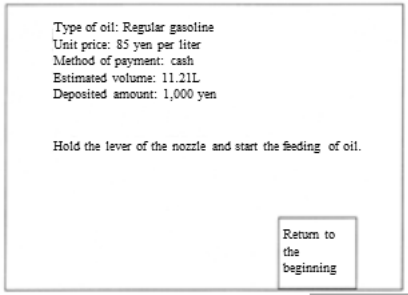
If you want to designate the volume of oil or the amount of payment, refer to the column titled "Designation of the volume of oil or the amount of payment."




If you want to change the method of payment, amount or type of oil, push the Return to the beginning button and restart the procedure from step 1.

## 6. Start the feeding of oil.

"Start the feeding of oil."




In order to suspend the feeding of oil, push the Return to the beginning button. Then, the procedure will return to step 1.



## 7. Return the nozzle and receive your change and receipt.

"Receive your change and receipt.
Thank you."