Date	June 23, 2011	Court	Intellectual Property High Court, Fourth Division
Case number	2010 (Ne) 10089		

A case in which the court ruled that:

– A product to be used "exclusively" for the use of the process as set forth in Article 101, item (iv) of the Patent Act must be such product that does not have any other economic, commercial or practical usage.

– Even where a product to be used for the use of the process pertaining to the patented invention can also be used without working the patented invention, the product still falls within the category of a "product to be used exclusively for the use of the process" set forth in Article 101, item (iv) of the Patent Act, as long as the product may be used in the form in which only the function that does not involve the working of the patented invention is continuously used and the function that involves the working of the patented invention is not used at all, but such form of use is not recognized as an economic, commercial or practical form of using the product.

– Even where the accused apparatus was delivered in the form that did not involve the working of the patented invention, that is, where it was delivered with a nozzle that cannot move downward 1mm or lower, in light of the facts that it is not impossible to change the position of the stopper or to remove the stopper or replace the nozzle with another one, and that it is more practically beneficial to have the nozzle move down further, the accused apparatus is deemed to fall within the category of a "product to be used exclusively for the use of the process" set forth in Article 101, item (iv) of the Patent Act.

References:

Article 100, Article 101, item (iv), and Article 102, paragraph (2) of the Patent Act

In this case, the appellant alleged that the appellee manufactured and sold, etc. Accused Apparatuses 1 to 3, and thereby infringed the appellant's patent right for the invention entitled "process of forming rolled food and apparatus thereof" (claiming infringement under the doctrine of equivalents with respect to Accused Apparatus 2), and accordingly, the appellant (i) sought an injunction to stop the manufacturing and sale, etc. of the accused apparatuses and demanded destruction thereof, and (ii) sought payment of 36 million yen as damages in tort, with delay damages accrued thereon.

The judgment in prior instance found that the nozzle, which is incorporated in the accused process and the accused apparatuses, does not correspond to the push-in part adopted in the patented invention and therefore it is regarded as failing to meet the constituent requirements of the patented invention, and that with respect to Accused

Apparatus 2, infringement is not established even under the doctrine of equivalents. Dissatisfied with this, the appellant appealed to the higher court.

The Intellectual Property High Court found that the accused apparatuses respectively met the constituent requirements of the patented invention (with respect to Accused Apparatus 2, infringement is established under the doctrine of equivalents), and thereby infringe the appellant's patent right, and rendered a ruling to modify the judgment in prior instance and upheld the appellant's claim for injunction and destruction as well as part of its claim for damages up to 17.66 million yen. In rendering this ruling, the court held as follows.

"Under Article 101, item (iv) of the Patent Act, an act of producing, assigning, etc. a product which is itself used for working the process pertaining to the patented invention is deemed to constitute infringement of the patent right. Said item limits the scope of acts to be deemed to constitute infringement of a patent right to such acts as producing, assigning, etc. 'any product to be used exclusively for the use of the said process,' because there is a substantially high probability that a product with such nature will induce infringement when it is produced or assigned, etc., so the enforceability of the patent right should be ensured within an extent that does not result in unduly broadening the scope of the effect of the patent right. In light of such purpose of the provisions of said item, it is appropriate to construe that a product to be used 'exclusively' for the use of the process must be such product that does not have any other economic, commercial or practical usage.

As mentioned above, Accused Apparatus 1 is a product that uses the process pertaining to Patented Invention 1. The appellee alleged that this apparatus was delivered with a nozzle that cannot move downward 1mm or lower. This allegation can be understood in favor of the appellee to the effect that Accused Apparatus 1 does not always involve the working of Patented Invention 1.

However, in light of the abovementioned purpose of Article 101, item (iv) of the Patent Act, even where a product to be used for the use of the process pertaining to the patented invention can also be used without working the patented invention, there is still a substantially high probability that the product will induce infringement when it is produced, sold, etc., as long as the product may be used in the form in which only the function that does not involve the working of the patented invention is continuously used and the function that involves the working of the patented invention is not used at all, but such form of use is not recognized as an economic, commercial or practical form of using the product. Therefore, only in such case, the product should

be deemed to be a ‘product to be used exclusively for the use of the process.’ In Accused Apparatus 1, it is not impossible to change the position of the stopper, or to remove the stopper or replace the nozzle with another one, and as mentioned above, it is more practically beneficial to have the nozzle move down further. Consequently, even if Accused Apparatus 1 was delivered with a nozzle that cannot move downward 1mm or lower, a form of using Accused Apparatus 1 in which only the function that does not involve the working of Patented Invention 1 is continuously used and the function that involves the working of Patented Invention 1 is not used at all—for example, by providing a stopper so as to prevent the nozzle from moving down to form a dip, and making it physically impossible to change the position of the stopper or to remove the stopper or replace the nozzle with another one—cannot be regarded as an economic, commercial or practical form of using Accused Apparatus 1. Therefore, Accused Apparatus 1 is deemed to fall within the category of a ‘product to be used exclusively for the use of the process.’”

Judgment rendered on June 23, 2011, the original of the judgment was received by the court clerk on the same day

2010 (Ne) 10089, Appeal Case of Seeking Injunction Against Infringement of Patent Right, etc.

Court of prior instance: Tokyo District Court 2009 (Wa) 1201

Date of conclusion of oral argument: June 9, 2011

Judgment

Appellant: KOBIRD, Co., Ltd.

Appellee: Rheon Automatic Machinery, co., ltd.

Main text

1. The judgment in prior instance shall be modified as follows.
   (1) The appellee shall not manufacture, sell, offer for sale or export the apparatuses stated in the Lists of the Defendant's Apparatus 1 through 3 contained in Attachments 1 through 3.
   (2) The appellee shall dispose of the abovementioned apparatuses.
   (3) The appellee shall pay to the appellant 17,669,218 yen and money accrued thereon at the rate of 5% per annum for the period from February 17, 2010 until the date of completion of the payment.
   (4) The other claims made by the appellant shall be dismissed.
2. The court costs shall be divided into three portions for both the first and second instances, one-third of which shall be borne by the appellant while the remaining two-third shall be borne by the appellee.
3. This judgment may be provisionally executed as far as paragraph 1.(3) of the main text is concerned.

Facts and reasons

No. 1 Objects of the appeal

1. The judgment in prior instance shall be revoked.

2. Same as those stated in 1.(1) and (2) of the main text.

3. The appellee shall pay to the appellant 36,000,000 yen and money accrued thereon at the rate of 5% per annum for the period from February 17, 2010 until the date of completion of the payment.

4. The court costs shall be borne by the appellee for both the first and second instances.

5. A declaration of provisional execution with respect to paragraph 3.

No. 2 Outline of the case (in principle, the abbreviations used in the judgment in prior instance will be used)

1. In this case, the appellant alleged that the appellee's act of manufacturing, selling and offering for sale the defendant's apparatuses (meaning the apparatuses stated in the Lists of the Defendant's Apparatus 1 through 3 contained in Attachments 1 through 3; the same shall apply hereinafter) shall be deemed to infringe Patent Right 1 with respect to Claim 1 of Patent No. 4210779 granted to the appellant for an invention titled "method for wrapping and forming food and apparatus therefor" (Article 101, item (iv) of the Patent Act) and further infringes Patent Right 2 with respect to Claim 2 of the abovementioned patent (with respect to Defendant's Apparatus 2, the appellant alleged infringement under the doctrine of equivalents). Based on these allegations, the appellant claimed: [i] an injunction against the manufacture and sale, etc. of the defendant's apparatuses and disposal thereof based on the patent rights in question ("Patent Rights"); and [ii] payment of 36,000,000 yen and delay damages accrued thereon at the rate of 5% per annum as provided by the Civil Code for the period from February 17, 2010 (the day immediately following the date on which the petition for amendment of claims was served) until the date of completion of the payment as compensation for damages based on tort.

In the judgment in prior instance, the court dismissed all of the appellant's claims by holding as follows: since the "nozzle member" used in the method for wrapping and forming food using the Defendant's Apparatuses ("Defendant's Process") and in the Defendant's Apparatuses is not equivalent to the "pushing member" of the inventions in question ("Inventions"), it does not fulfill the constituent features; moreover, infringement under the doctrine of equivalents cannot also be found with respect to the Defendant's Apparatus 2. Dissatisfied with this, the appellant filed an appeal and added infringement under the doctrine of equivalents with respect to the "pushing member," as a secondary claim, to its claims in this instance.

2. Facts on which the decision is premised

The facts on which the decision on the appellant's claims is premised are as stated in section 1 of part No. 2 in the facts and reasons of the judgment in prior instance (line 19 of page 2 to line 4 of page 7 in the judgment in prior instance) and thus these parts shall be cited.

3. Issues of the case

(1) Whether or not Patent Right 1 has been indirectly infringed

(2) Whether or not Patent Right 2 has been infringed

(3) Whether or not the Inventions lack an inventive step

(4) Amount of damages

No. 3 Allegations of the parties

(omitted)

No. 4 Court decision

1. Regarding the Inventions

(1) Constituent features of Invention 1

The constituent features of Invention 1 can be decomposed as follows.

1A: A sheet-like pastry material is supplied on the receiving member in a state where a shutter consisting of multiple shutter pieces that is arranged above the receiving member is opened;

1B: The position of the pastry material is adjusted to fit in a predetermined position by operating the shutter pieces in a closing direction and reducing the opening area;

1C: The pastry material is retained on the receiving member by lowering the pressing member together with the pushing member and pushing the pressing member against the edge part of the pastry material;

1D: The pastry material is supported by a supporting member while being formed into a bowl-like shape by further lowering the pushing member and thrusting it into the opening part of the receiving member and thereby pushing the central part of the pastry material into the opening part;

1E: The inner material is arranged on the pastry material by supplying the inner material through the pushing member;

1F: The peripheral part of the pastry material is gathered and sealed to wrap the inner material by operating the shutter to close in a state where the pastry material is supported by the supporting member;

1G: A formed article is conveyed by lowering the supporting member;

1H: A method to wrap and form food characterized by the features mentioned in 1A through 1H above.

(2) Constituent features of Invention 2

The constituent features of Invention 2 can be decomposed as follows.

2A: A receiving member in which an opening part is formed in the central part and on which a sheet-like pastry material is placed;

2B: A shutter which is arranged above the receiving member and equipped with multiple shutter pieces;

2C: A shutter driving means wherein the position of the pastry material is adjusted to fit in a predetermined position by operating the shutter pieces in a closing direction and reducing the opening area while gathering the peripheral part of the pastry material to wrap the inner material by operating the shutter to close;

2D: A pastry material forming means wherein the pastry material is formed into a bowl-like shape by lowering the pushing member and thrusting it into the opening part of the receiving member and pushing the central part of the pastry material into the opening part while supplying the inner material inside the pastry material through the pushing member;

2E: A retention means established in a pastry material forming means wherein the pastry material is retained on the receiving member by pushing the pressing member against the edge part of the pastry material;
2F: A supporting means arranged on the lower side of the receiving member wherein the pastry material formed into a bowl-like shape is supported by lifting the supporting member and the formed article is conveyed by lowering the supporting member;
2G: An apparatus to wrap and form food characterized by comprising the abovementioned features.
(3) Statements in the description in question
A. According to the statements in the description in question ("Description"), the Inventions are related to a method for wrapping and forming food wherein an inner material such as bean paste and cooked meat and vegetables can be securely wrapped and formed by a pastry material such as bread dough or steamed bun dough, and an apparatus for wrapping and forming food using the abovementioned method ([0001]).

In the prior art, the pastry material shaped like a cylinder is continuously formed on the exterior of the inner material shaped like a rod and then formed and cut by being squeezed by the opening and closing action of the shutter mechanism. However, there were disadvantages such that when a fermentable dough such as bread dough was used as the pastry material, excessive pressure and twist will be applied to the dough at the time of forming it into a cylinder shape, and thus the dough does not rise in a sufficient manner after the process of forming and cutting, thereby resulting in a hard food with inelastic pastry material ([0002]).

A method to form food from a sheet-like pastry material instead of forming the pastry in a cylinder shape has been suggested. However, in the case of carrying out the formation from a sheet-like pastry material, foodstuffs like bread dough have flexibility and thus, in many cases, the shape of the pastry material became un-uniform and each sheet of pastry material had an oval shape with slight differences. In addition, it is likely to be difficult to seal the pastry material since the abovementioned foodstuffs are so sticky that they may be displaced during transportation and unable to be arranged in the position for formation in an accurate manner ([0003] and [0004]). When the dough pieces are made larger in order to avoid such a situation, the volume of the dough pieces will increase and thus, when the sealing gate is closed, the dough pieces are likely to protrude to the upper side of the sealing gate. In addition, even if the protrusion of the pastry materials is prevented by a plug, this will result in an increased process of arranging the plug in a female die and the complicated process of moving the female die on which the pastry material is placed. Furthermore, the overall apparatus will grow in size due to the necessity to arrange a number of female dies, resulting in the complication of the mechanism of the apparatus ([0004]).

As such, the Inventions were created by taking into consideration the abovementioned disadvantages in prior methods for forming food. They aim to provide a method to wrap and form food wherein the inner material can be surely wrapped with the pastry material and formed at the time of sealing even if there are variations in the shape or displacement of the pastry material and a wrapping and forming apparatus having a simple structure ([0005]).

B. The Inventions adopt the technical matters stated in Claim 1 or 2 for the purpose mentioned above and produce the following effects.

(A) If the opening area of the shutter is reduced by operating the shutter pieces of the shutter in a closing direction, the pastry material can be set to fit the reduced opening state and the position of the pastry materials can be adjusted to fit in a predetermined position. This enables a more secure forming treatment by adjusting in advance the shape-variation and displacement of the pastry materials ([0008]).

(B) Since the edge part of the pastry material will be retained by the pressing member when the pastry material is to be formed into a bowl-like shape, even if the pastry material is a foodstuff with elasticity such as bread dough, it can be formed into a bowl-like shape by rolling out the periphery of the edge part of the pastry material. As a result, even if there are slight variations in the shape and size of the pastry material or any displacement thereof, the pastry material can be surely formed into a bowl-like shape. At the time of such formation, if it is designed to support the pastry material by a supporting member, the pastry material can be prevented from extending to the lower side beyond necessity ([0009]).

(C) Since the inner material is supplied through the pushing member, the pastry material can be prevented from shrinking in connection with the rise of the pushing member while the formation of the shape of the pastry material and supply of the inner material can be carried out in an efficient manner in a short time. At this time, as the pastry material is supported by the supporting member, the pastry material can be prevented from extending beyond necessity by discharge of the inner material and the inner material can be arranged inside the pastry material without fail ([0010]).

(D) Since the pastry material is supplied on the receiving member established on the lower side of the shutter, the pastry material can be placed in a more stable manner and be securely pressed and retained by the receiving member and pressing member of the retention means. Moreover, by thrusting the pushing member into the opening part of the receiving member, the pastry material can be formed into a bowl-like shape by using the opening part of the receiving member ([0011]).

(E) Since the pastry material is supplied on the receiving member established on the lower side of the shutter, the position of the pastry material on the receiving member can be adjusted by the closing operation of the shutter and thereby considerably simplify the structure of the apparatus

([0012]).

(F) The Inventions produce an excellent effect in that, by operating in a closing direction the shutter pieces of the shutter that seals the pastry material and reducing the opening area, at the time when the pastry material is supplied, the pastry material can be set to fit the reduced opening state and its position can be adjusted so as to fit in the predetermined position. Especially, the Inventions produce a special effect in achieving the objective by a shutter used for sealing without separately establishing an auxiliary shutter as mentioned in the "First reference example" ([0013] to [0036], [Drawing 1] to [Drawing 24], [0056] and [0066]).

2. Whether or not Defendant's Process 1 indirectly infringes Patent Right 1

(1) Fulfillment of Constituent Features 1A, 1F and 1G

There are no disputes between the parties regarding the fact that Defendant's Process 1 fulfills Constituent Features 1A, 1F and 1G.

(2) Fulfillment of Constituent Feature 1B

A. Constituent Feature 1B states that "the position of the pastry material is adjusted to fit in a predetermined position by operating the shutter pieces in a closing direction and reducing the opening area." There are no disputes between the parties to the extent that Defendant's Process 1 has the structure to "adjust the position of the dough to fit into a predetermined position that is approximately concentric and covers the opening part […] by operating the shutter pieces in a closing direction and reducing the opening area" (as described in structure 1b alleged by the appellant and structure 1(b) alleged by the appellee). In addition, the "predetermined position that is approximately concentric and covers the opening part" of Defendant's Process 1 is equivalent to the "predetermined position" of Invention 1 while the "dough" of Defendant's Process 1 is equivalent to the "pastry material" of Invention 1. Thus, the abovementioned structure of Defendant's Process 1 fulfills Constituent Feature 1B.

B. In the judgment in prior instance, the court determined that Defendant's Process 1 fulfills Constituent Feature 1B and the appellee has stated not to dispute such determination in this instance.

(3) Fulfillment of Constituent Feature 1C

A. Interpretation of the constituent feature of "lowering the pressing member together with the pushing member"

Constituent Feature 1C states that "the pastry material is retained on the receiving member by lowering the pressing member together with the pushing member and pushing the pressing member against the edge part of the pastry material." With respect to the part of "lowering the pressing member together with the pushing member," the appellant alleges that this part includes the case where the lowering of the pushing member starts prior to the completion of the lowering of the pressing member in addition to the case where the pushing member and pressing

member are simultaneously lowered, while the appellee alleges that said part does not include the case where only the pressing member will be lowered.

According to the ordinary interpretation of the term "together with," it is natural to interpret that the pushing member and pressing member are lowered together. However, Constituent Feature 1C mainly describes the role of the pressing member by stating that the pressing member will be lowered and pushed against the edge part of the pastry material, thereby retaining the pastry material on the receiving member. Constituent Feature 1D, which is stated immediately after Constituent Feature 1C, states that the pushing member will be further lowered. In addition, the Description contains no statements of the technical significance of lowering the pushing member and pressing member together. In light of these facts, it is appropriate to construe that the element of "lowering the pressing member together with the pushing member" of Constituent Feature 1C represents the fact that both the pushing member and pressing member are lowered and includes not only the case where both members are simultaneously lowered but also the case where the lowering of the pressing member starts prior to the completion of the lowering of the pushing member.

B. Structure of Defendant's Process 1

There are no disputes between the parties to the extent that Defendant's Process 1 has the structure of "lowering the dough pressing member […] and pushing the dough pressing member against the edge part of the dough, thereby retaining the dough on the placement member" (as described in structure 1c alleged by the appellant and structure 1(c) alleged by the appellee).

The appellee alleges that Defendant's Process 1 has the structure of "lowering the dough pressing member alone and pushing the dough pressing member against the edge part of the dough, thereby retaining the dough on the placement member" and that the dough pressing member is not simultaneously lowered with the nozzle member. However, in Defendant's Apparatus 1, the nozzle member is lowered in addition to the dough pressing member, and it has a structure wherein the nozzle member and dough pressing member are set to be separately lifted and lowered and are individually operated (Exhibits Otsu 5-3 and 8-2), thereby independently controlling the lifting and lowering operation. In light of the fact that the process time will be shorter and the production efficiency can be improved if the nozzle member and dough pressing member are controlled to be lowered simultaneously or to start the lowering of the nozzle member prior to the completion of the lowering of the dough pressing member, it is possible to control Defendant's Apparatus 1 so as to simultaneously lift the nozzle member and dough pressing member or to start the lowering of the nozzle member prior to the completion of the lowering of the dough pressing member.

C. Fulfillment

The "dough pressing member" of Defendant's Process 1 is equivalent to the "pressing

member" of Invention 1 while the "placement member" of Defendant's Process 1 is equivalent to the "receiving member" of Invention 1. Thus, Defendant's Process 1 fulfills the element of "lowering the pressing member and pushing the pressing member against the edge part of the pastry material, thereby retaining the pastry material on the receiving member" of Constituent Feature 1C. As held in (5) below, the "nozzle member" of Defendant's Process 1 is equivalent to the "pushing member" of Invention 1. Thus, in Defendant's Process 1, the nozzle member is lowered in addition to the dough pressing member and it is possible to control both members to be lowered simultaneously or to start the lowering of the nozzle member prior to the completion of the lowering of the dough pressing member. Therefore, Defendant's Process 1 also fulfills the element of "lowering […] together with the pushing member" of Constituent Feature 1C.

Accordingly, Defendant's Process 1 fulfills Constituent Feature 1C of Invention 1.

(4) Fulfillment of Constituent Feature 1D

A. Interpretation of the constituent feature of "formed into a bowl-like shape"

(A) Constituent Feature 1D states that "the pastry material is supported by a supporting member while being formed into a bowl-like shape by further lowering the pushing member and thrusting it into the opening part of the receiving member and thereby pushing the central part of the pastry material into the opening part." According to this statement, the pastry material is formed into a bowl-like shape by lowering the pushing member and pushing the pastry material into the opening part. Yet, the specific mode of "bowl-like shape" has not been limited in a more specific manner in the scope of claims.

The appellant alleges as follows with respect to the constituent feature of "formed into a bowl-like shape": as long as neither the scope of claims nor the detailed explanation of the invention contains any definition of the term "bowl-like shape," there are no statements limiting the pastry material to be those with elasticity; thus, there are no grounds for limiting the structure to be those "deeply thrusting the pushing member into the pastry material and forming the pastry material into a bowl-like shape while rolling out the periphery of the edge part of the pastry material"; accordingly, the abovementioned element means to push in and transform the dough to the extent possible to normally carry out the subsequent processes of supplying the inner material and sealing. In contrast, the appellee alleges that the "bowl-like shape" does not include such a slight dent in the pastry material as that with which the pushing member comes into contact.

(B) While the Description contains no definition on the term "bowl-like shape," it contains drawings showing a substantially u-shaped dent as an explanation for forming the pastry material into a bowl-like shape (Drawings 10(c), 19, 22, 28, 35, 42 and 51). These shapes are in line with the ordinary usage of the term "bowl," which has a certain depth.

(C) As stated in 1. above, the Description contains a statement on the function and effect

produced by the Inventions as a result of adopting the technical matters stated in the scope of claims. According to such statement, in Invention 1, since there is a risk of "the pastry material to be rolled out to the lower side beyond necessity" due to thrusting the pushing member deeply into the opening part to a certain degree ([0009]) as well as a risk of "the pastry material being rolled out beyond necessity due to the discharge of the inner material" ([0010]), the pastry material is supported by the supporting material to avoid such risks. If the pushing member is only lowered to a level to come into contact with the dent, the pastry material will not be rolled out to the lower side beyond necessity except due to the discharge of the inner material. Thus, it can be found that, in Invention 1, the pushing member is expected to be thrust into the opening part to a certain depth. Similarly, because the pushing member is thrust into the opening part to a certain depth, there is a risk of "the pastry material shrinking in connection with the rise of the pushing member" and thus, in Invention 1, the inner material is supplied through the pushing member to avoid such risks ([0010]). As described above, the pushing member of Invention 1 is recognized to be thrust into the opening part to a certain depth in order to support the pastry material by the supporting member and to supply the inner material.

(D) In addition, in light of the statements in the Description, it can be recognized that the inner material is arranged after the pastry material is formed into a bowl-like shape by thrusting the pushing member into the opening part of the receiving member to a certain depth. More specifically, in Invention 1, the pastry material is formed into a "bowl-like shape" by thrusting the pushing member into the pastry material to a certain depth and the inner material is arranged inside the part formed into a bowl-like shape.

As described above, in light of the function and effect of Invention 1, it should be said that the "pushing member" in Invention 1 is not expected to be stopped at a state wherein its lower end part is in contact with the dent formed in the central part of the pastry material or, at best, to be stopped at a state wherein its lower end is in contact with the pastry material and the pastry material is slightly dented in line with the shape of the lower end but instead is expected to form the pastry material into a bowl-like shape by being thrust into the opening part of the receiving member to a certain depth. In addition, even if there is a prominent effect in the case where the pastry material is a "foodstuff with elasticity," the Description contains no special statements focusing on the types of the pastry material and inner material, and thus it can be found that, in Invention 1, the pastry material is formed into a "bowl-like shape" in line with the shape of the tip of the pushing member by lowering the pushing member regardless of the type of the pastry material or inner material.

(E) As the technical terms of patents, Exhibit Ko 21 uses the term, "a dent shaped like a flat bowl," and calls the shape of the dent shown in Drawing 5 "a dent shaped like a flat bowl." Similarly, Exhibit Ko 22 states that a plate shaped concave portion is "made by being squeezed

and processed into a bowl-like shape" in the technology for sealed battery equipped with a sealing plate as an explosion-proof mechanism. As described above, the shape shown in Drawing 5 of Exhibit Ko 21 and the shape of the plate-shaped concaved portion of Exhibit Ko 22 are sometimes called "bowl-like shape," so, in other words, it can be found that the term "bowl-like shape" is used regardless of the depth of the dent.

(F) Based on the abovementioned findings, the significance of "forming the pastry material into a bowl-like shape" by the pushing member in Invention 1 should be found in forming the pastry material in a "bowl-like shape" in line with the shape of the tip of the pushing member by lowering the pushing member to a certain depth and thereby realizing the arrangement of the inner material and sealing regardless of the characteristics of the pastry material. In addition, in light of the fact that the degree of the "bowl-like shape" is not limited in the scope of claims and that the term "bowl-like shape" is used regardless of the depth of the dent as a technical term for patents, the degree of "bowl-like shape" is not required to be "a depth subequal to the height of the formed article" as found in the judgment in prior instance but rather it is sufficient if the arrangement of the inner material and sealing can be realized thereafter; the depth is not in question.

B. Structure of Defendant's Process 1

(A) The appellant alleges that in Defendant's Process 1, "the nozzle member is lowered while maintaining a state where the dent generated in the dough is supported by the supporting conveyer, and then stopped at a state where the lower end part of the nozzle member is in contact with the dent formed in the central part of the dough"; it has a structure wherein the lower surface of the nozzle member can only protrude at a maximum 1mm from the lower surface of the placement member.

According to the time chart diagram and the instructions of Defendant's Apparatus 1 (Exhibits Otsu 9-1 and 9-2), videos for operation explanation thereof (Exhibit Otsu 10) and pictures (Exhibits Otsu 11-1 to 11-15) as well as the written explanation leaflet provided by the appellee's personnel with respect to the background to the development (Exhibit Otsu 13), it can be actually found that Defendant's Process 1 is structured as follows: instead of forming the dough into a bowl-like shape by thrusting the nozzle member deeply into the dough, the nozzle member is lowered to bring its lower end part into contact with the dough and then stopped in a state where the dough is dented in line with the shape of its lower end part and then the dough is expanded by supplying the inner material through the nozzle member and lowering the nozzle member while supporting the bottom part of the dough by the supporting conveyer, in addition to using the discharge pressure of the inner material.

Yet, the shape of the dent alleged by the appellee has transformed from the state shown in Drawing 6B to that shown in Drawing 7B in the List of the Defendant's Apparatus (Defendant's

Allegation) 1 contained in Attachment 3-1 of the judgment in prior instance by the lowering of the nozzle member and the shape shown in Drawing 7B can be found to be a shallow bowl-like shape.

(B) Meanwhile, after acquiring Defendant's Apparatus 1 and confirming the structure thereof, the appellant implemented a fact experiment to wrap the inner material by the dough and seal it by adjusting the lifting and lowering position of the nozzle member by entrusting the experiment to a notary on February 23, 2011 and then submitted a notarized instrument of the fact experiment stating the results thereof (Exhibit Ko 26). According to such instrument, the following facts can be found: [i] the nozzle member of Defendant's Apparatus 1 can be lowered to a depth of 7mm from the lower surface of the opening part of the placement member to the lower surface of the base and can be thrust into the opening part to such depth; and [ii] the nozzle member can be easily removed from the supporting frame body and can be replaced with a longer one and thereby the depth to which the nozzle member is thrust can be extended to 15mm.

When the tip of the nozzle member is lowered for only 1mm from the lower surface of the placement member, dough with ordinary thickness can be formed almost normally while hard dough cannot be formed well, since the inner material will leak at the time of the sealing operation. In contrast, when the nozzle member is lowered to a position of 10mm from the lower surface of the placement member, both dough with ordinary thickness and thick dough can be formed almost normally; when forming is to be carried out by combining various types of dough and inner material, secure handling can be made by making the lowering position deeper (Exhibits Ko 16, 17 and 23).

Based on this fact, it is presumed that when using Defendant's Process 1, if the tip of the nozzle member is lowered and brought into contact with the dough, a dent in line with the shape of the tip of the nozzle member will be formed in the central part of the dough, and the dough can be formed and the inner material can be sealed by the dough by the adjustment of the supporting conveyer (lowering speed), lifting and lowering operation of the nozzle member and dough pressing member (the level of pressing the dough) and discharge pressure of the inner material according to the combination of various types of dough materials and inner materials. Moreover, by deepening the lowering position of the nozzle member of Defendant's Process 1 to 7mm instead of 1mm, its practical value can be improved.

(C) The appellee alleges that the allegations and proof based on Exhibit Ko 26 are allegations and evidence advanced out of time. However, Exhibit Ko 26 is a notarized instrument of the fact experiment conducted by obtaining Defendant's Apparatus 1 and has been submitted as evidence to support the appellant's previous allegations. In addition, it has been submitted at the beginning of the appeal instance during which the appellant can make counterarguments and

submit rebuttal evidence and thus it cannot be found to have been advanced out of time.

Moreover, the appellee alleges that the apparatus used in the fact experiment conducted by the appellant and shown in Exhibit Ko 26 is a remodel of Defendant's Apparatus 1 wherein the nozzle member is fixed so as to prevent it from being lowered for more than 1mm. However, there is not enough evidence to find that, when the appellant asked a notary to conduct the fact experiment, it remodeled Defendant's Apparatus 1 to at least set the lowering position of the nozzle member to 7mm. Even if, as alleged by the appellee, the nozzle member was fixed to prevent it from being lowered for more than 1mm at the time of manufacture and sale of the apparatuses by the appellee, it is possible to change the position of the stopper or to remove it or change out the nozzle member. Moreover, it is also more practical to lower the nozzle member deeper, and thus, this point of issue will be determined in relation to determining whether or not indirect infringement can be found below.

(D) As such, it can be found that, in Defendant's Process 1, the lower end of the nozzle member can be thrust into the opening part of the placement member to a depth of 7 to 15mm from the lower surface by lowering the nozzle member, thereby pushing the central part of the dough into the opening part and forming a dent in line with the shape of the tip of the nozzle member on the dough while supporting the dough by the placement member.

C. Fulfillment

As stated above, Invention 1 is an invention wherein "the pastry material is formed into a bowl-like shape by further lowering the pushing member and thrusting it into the opening part of the receiving member and pushing the central part of the pastry material into the opening part;" the pastry material is formed into a bowl-like shape by thrusting the pushing member into the opening part of the receiving member to a certain depth. In contrast, Defendant's Process 1 can be used to bring the lower end part of the nozzle member into contact with the dough and form a dent in the dough in line with the shape of its lower end part. However, it can also be used as follows: by lowering the nozzle member, its lower end can be thrust into the opening part of the placement member to a depth of 7 to 15mm from the lower surface, thereby pushing the central part of the dough into the opening part and forming a dent in line with the shape of the tip of the nozzle member on the dough while supporting the dough by the placement member. In addition, in light of the fact that a dent can be regarded as the "bowl-like shape" of Constituent Feature 1D regardless of its depth, the dent formed in the central part of the dough by thrusting the lower end of the nozzle member into the opening part of the placement member to a depth of 7 to 15 mm from the lower surface can also be called a "bowl-like shape."

Moreover, the "supporting conveyer" used in Defendant's Process 1 is equivalent to the "supporting member" of Invention 1 and they both support the pastry material (dough).

Therefore, Defendant's Process 1 fulfills Constituent Feature 1D.

(5) Fulfillment of Constituent Feature 1E

A. Interpretation of the constituent feature

Constituent Feature 1E states that "the inner material is arranged on the pastry material by supplying the inner material through the pushing member." The Description contains a statement that since the inner material is supplied through a pushing member, the pastry material can be prevented from shrinking in connection with the rise of the pushing member while the formation of the shape of the pastry material and supply of the inner material can be carried out in an efficient manner in a short time ([0010]). Thus, it can be said that the abovementioned function and effect are stated base on the assumption that the pastry material will be formed into a "bowl-like shape" by thrusting the pushing member into the pastry material to a certain depth and then the inner material will be arranged inside the part formed like a bowl-like shape by lifting the pushing member. Yet, methods other than the abovementioned arrangement have not been excluded and no special limitation on the method of arrangement has been contained in the statements of the scope of claims. Therefore, regarding Invention 1, if the pastry material is formed into a "bowl-like shape" by thrusting the pushing member into the pastry material to a certain depth (Constituent Feature 1D) and the inner material is arranged on the pastry material by supplying the inner material from the pushing member, it can be found that Constituent Feature 1E is fulfilled.

B. Structure of Defendant's Process 1

There are no disputes between the parties to the extent that in Defendant's Process 1, "the inner material is arranged on the dough […] by supplying the inner material through a nozzle member" (as described in structure 1e alleged by the appellant and structure 1(e) alleged by the appellee). In addition, as stated in (4) above, Defendant's Process 1 has the following structure: the lower end of the nozzle member can be thrust into the opening part of the placement member to a depth of 7 to 15mm from the lower surface by lowering the nozzle member, thereby pushing the central part of the dough into the opening part and forming a dent in line with the shape of the tip of the nozzle member while further expanding the dough by supporting the dough by the placement member, supplying the inner material through the nozzle member and lowering the supporting conveyer that supports the bottom part, in addition to discharging the inner material.

C. Fulfillment

As stated above, there is no difference between Invention 1 and Defendant's Process 1, since in the former process, the inner material is arranged inside the bowl-like shape part formed on the pastry material through a pushing member, while in the latter process, the inner material is arranged on the dough by supplying the inner material to the dent of the dough through a nozzle member. Thus, the "nozzle member" of Defendant's Process 1 is equivalent to the "pushing

member" of Invention 1 and Defendant's Process 1 fulfills Constituent Feature 1E of Invention 1.

The extension of the pastry material caused by discharging the inner material is also expected to occur in Invention 1 ([0010]) and thus the step of expanding the dough by discharging the inner material in Defendant's Process 1 does not affect the determination on the fulfillment of Constituent Feature 1E.

(6) Whether or not indirect infringement can be found.

A. As found above, Defendant's Process 1 fulfills all of the constituent features of Invention 1.

B. Regarding Article 101, item (iv) of the Patent Act

Under Article 101, item (iv) of the Patent Act, the act of producing and assigning, etc. a product in which the patented invention of a process is worked by using the product itself is deemed to be an infringement of a patent right. Said item limited the scope of acts which shall be deemed to infringe the patent right to the act of producing and assigning, etc. "product to be used exclusively for the use of the process" for the purpose of securing the effectiveness of the patent right within a scope which will not result in unjust expansion thereof for reasons such as, in the case of a product with such characteristics, an act of infringement is highly likely to be induced when such product is to be produced or assigned, etc. Based on such standpoint, it is appropriate to construe that a product to be used "exclusively" for the use of the process requires the product to have no other economical, commercial or practical usage.

As stated above, Defendant's Apparatus 1 is a product which uses the process covered by Invention 1. Thus, the appellee's allegation mentioned above that Defendant's Apparatus 1 was delivered in a state where the nozzle member cannot be lowered for more than 1mm can be construed to be based on the idea that there are cases where Invention 1 is not worked in Defendant's Apparatus 1.

However, according to the abovementioned purpose of said item, even in the case where a product to be used for the process of a patented invention can be used without working the patented invention, it should be said that the act of infringement is still highly likely to be induced by the act of manufacturing and selling, etc. the product unless the mode of using the product without using the function for working the patented invention while continuously using only the function that does not work the patented invention is found as an economical, commercial or practical mode of use of the product. Thus, in such case, it is still appropriate to construe that the product is a "product to be used exclusively for the use of the process." As stated above, in Defendant's Apparatus 1, it is possible to change the position of the stopper, remove the stopper or change out the nozzle member and it is also more practical to lower the nozzle member deeper. As such, even if the appellee delivered Defendant's Apparatus 1 in a state where the nozzle member cannot be lower for more than 1mm, the mode of using

Defendant's Apparatus 1 without using the function for working Invention 1 while continuously using only the function that does not work Invention 1 (e.g. the act of establishing a stopper to prevent the nozzle member from being lowered to avoid any formation of dent, changing the position of such stopper, removing the stopper or changing out the nozzle member is physically impossible) cannot be found to be an economical, commercial or practical mode of use of Defendant's Apparatus 1. Accordingly, Defendant's Apparatus 1 should be found to fall under the "product to be used exclusively for the use of the process."

(7) Summary

As found above, the act of manufacturing, selling or offering for sale Defendant's Apparatus 1 shall be deemed to infringe Patent Right 1.

3. Whether or not Defendant's Process 2 indirectly infringes Patent Right 1

(1) Fulfillment of Constituent Feature 1A

A. Interpretation of the constituent feature of "above the receiving member"

Constituent Feature 1A of Invention 1 states that "a sheet-like pastry material is supplied on the receiving member in a state where a shutter consisting of multiple shutter pieces that is arranged above the receiving member is opened." The appellee alleges that the phrase "above the receiving member" means that there is no space or intervening member between the receiving member and the shutter, or, in other words, a shutter consisting of multiple shutter pieces is directly arranged on the receiving member. In addition, in the working example in the Description, a drawing in which a shutter is directly arranged on the receiving member is stated (Drawing 40).

However, normally, the term "above" simply refers to the "upper side" regardless of whether the relevant member is arranged with direct contact with or with space from the other member. Thus, even if a drawing showing such state is contained in the working example, the term should not be construed by limiting to a state where the relevant member is directly arranged on the other member. Moreover, in Constituent Feature 1A, the shutter is required to be arranged above the receiving member at the stage of "supplying the pastry material," and thus it cannot be construed that the shutter is required to be directly arranged on the receiving member to avoid any space or intervening member in between.

B. Structure of Defendant's Process 2

There are no disputes between the parties to the extent that, in Defendant's Process 2, "the sheet-like dough is supplied on the placement member […] in a state where a shutter consisting of six shutter pieces […] is arranged above the placement member" (as described in structure 1a' alleged by the appellant and structure 1(a)' alleged by the appellee).

C. Fulfillment

Even if the shutter pieces are arranged in an upper side position separated from the receiving

member, such state will be included in the scope of "above" mentioned in Constituent Feature 1A and thus Defendant's Process 2 fulfills Constituent Feature 1A.

(2) Fulfillment of Constituent Feature 1B

A. Structure of Defendant's Process 2

Based on either the appellant's allegation or appellee's allegation, the structure of Defendant's Process 2 that corresponds to Constituent Feature 1B is identical with that of Defendant's Process 1 (as described in structure 1b and 1b' alleged by the appellant and structure 1(b) and 1(b)' alleged by the appellee).

B. Fulfillment

Accordingly, as with the case of Defendant's Process 1 mentioned in 2. above, the abovementioned structure of Defendant's Process 2 fulfills Constituent Feature 1B.

(3) Fulfillment of Constituent Feature 1C

A. Structure of Defendant's Process 2

There are no disputes between the parties to the extent that Defendant's Process 2 is structured to "retain the dough on the placement member by lifting shutter pieces, placement member […] and pushing the dough pressing member against the edge part of the dough" (as described in structure 1c' alleged by the appellant and structure 1(c)' alleged by the appellee). As such, Defendant's Process 2 and Invention 1 are different in that while the shutter pieces and placement member are brought close to the nozzle member and dough pressing member by being lifted without lowering the pushing member in the former process, the nozzle member and dough pressing member are brought close to the shutter pieces and placement member by being lowered in the latter process.

B. Requirements for finding infringement under the doctrine of equivalents

Even if part of the structures stated in the scope of claims for Invention 1 is different from Defendant's Process 2, it is appropriate to construe that Defendant's Process 2 falls within the technical scope of Invention 1 for having a structure equivalent to that stated in Claim 1 as long as there are no special circumstances as follows: [i] the abovementioned part is not an essential part of the Inventions; [ii] even if the abovementioned part is replaced with an equivalent part of Defendant's Process 2, the objective of Invention 1 can be achieved and the same function and effect can be produced; [iii] a person ordinarily skilled in the art to which the Inventions pertain can easily arrive at making the abovementioned replacement at the time of using Defendant's Process 2; [iv] Defendant's Process 2 is not identical with a publicly known art at the time of filing of a patent application for Invention 1 or could not have been easily inferred by a person ordinarily skilled in the art at the abovementioned time of filing of the patent application; and [v] Defendant's Process 2 is equivalent to what was intentionally excluded from the scope of claims in the procedures for the patent application filed for Invention 1 (1994 (O) 1083,

Judgment of the Third Petty Bench of the Supreme Court of February 24, 1998, Minshu Vol. 52, No. 1 at 113).

C. Regarding requirement [i] for finding infringement under the doctrine of equivalents

Based on the statements in the Description mentioned in 1. above, the characteristic features of Invention 1 can be found in the following points: [i] the step of adjusting the position of the pastry material which is strongly related to and important for the subsequent steps of forming the pastry material into a bowl-like shape and sealing it is implemented by using the shutter for sealing, which is equipped in advance; and [ii] the abovementioned important step is achieved by a simple structure without establishing other means.

In Invention 1, while it is important for the shutter pieces and placement member and the nozzle member and dough pressing member to mutually come close, there is no technical significance in deciding which side is to be lifted. Thus, the following difference between Invention 1 and Defendant's Process 2 is not an essential part of Invention 1: while the nozzle member and dough pressing member are brought close to the shutter pieces and placement member by being lowered in the former process, the shutter pieces and placement member are brought close to the nozzle member and dough pressing member by being lifted in the latter process.

D. Regarding requirement [ii] for finding infringement under the doctrine of equivalents

Defendant's Process 2, wherein the shutter pieces and placement member are brought close to the nozzle member and dough pressing member by being lifted without lowering the pressing member instead of bringing the nozzle member and dough pressing member close to the shutter pieces and placement member by lowering them, can produce the same function and effect as that of Invention 1, i.e., [i] to adjust the position of the pastry material to fit in a predetermined position and modify in advance the variations in the shape of the pastry material and position gap to ensure a more stable formation process ([0008] and [0013]); [ii] to securely press and hold the pastry material by placing it in a more stable manner ([0011]); and [iii] to substantially simplify the structure of the apparatus ([0012]).

Constituent Features 1C and 1D of Invention 1 can be achieved if the pressing member can retain the pastry material on the receiving member and the pushing member can be thrust into the opening part of the receiving member to a certain depth to supply the inner material.

As such, even if the structure of bringing the nozzle member and dough pressing member close to the shutter pieces and placement member by lowering them is replaced with the structure of bringing the shutter pieces and placement member close to the nozzle member and dough pressing member by lifting them, the same objective can be achieved and the same function and effect can be produced.

E. Regarding requirement [iii] for finding infringement under the doctrine of equivalents

The difference in the abovementioned structure between Invention 1 and Defendant's Process 1 is simply the difference of lowering the upper side members or lifting the lower side members in relation to the operation of bringing the nozzle member and dough pressing member close to the dough on the placement member. Thus, a person ordinarily skilled in the art could have easily arrived at the abovementioned structure of Defendant's Process 2.

F. Regarding requirements [iv] and [v] for finding infringement under the doctrine of equivalents

In the case where the requirements [i] through [iii] mentioned above are found, unless the requirements [iv] and [v] are found, infringement under the doctrine of equivalents will be found. The appellee has made no allegations nor showed proof of the fact that Defendant's Process 2 does not satisfy requirements [iv] and [v].

G. Summary

As found above, Defendant's Process 2 is equivalent to the structure of Constituent Feature 1C of Invention 1.

(4) Fulfillment of Constituent Feature 1D

A. Interpretation of the constituent feature of "further lowering"

Constituent Feature 1D states that "the pastry material is supported by a supporting member while forming the pastry material into a bowl-like shape by further lowering the pushing member and thrusting it into the opening part of the receiving member and thereby pushing the central part of the pastry material into the opening part." It prescribes that the pastry material will be formed into a bowl-like shape by lowering the pushing member and pushing the pastry material into the opening part, following Constituent Feature 1C. While Constituent Feature 1C mainly specifies the functions and roles of the pressing member based on the premise that both the pushing member and pressing member will be lowered, Constituent Feature 1D mainly specifies the functions and roles of the pushing member. Based on such fact, it should be construed that the step of "further lowering" contained in Constituent Feature 1D includes the case where the pushing member will be lowered together with the pressing member in addition to the case of further lowering the pushing member alone in addition to such step contained in Constituent Feature 1C. In addition, Constituent Feature 1D can be construed to have specified that the position at which the lowered pushing member will finally arrive is a position lower than the receiving member. This point can be found to be the technical significance of Constituent Feature 1D.

B. Structure of Defendant's Process 2

In Defendant's Process 2, the nozzle member and dough pressing member are integrated (Exhibits Otsu 23 and 24). As stated in (3) above, while the nozzle member and dough pressing member are brought close to the shutter pieces and placement member by being lowered in

Invention 1, the shutter pieces and placement member are brought close to the integrated nozzle member and dough pressing member by being lifted and the lower end of the nozzle member is relatively moved to a position lower than the placement member to be thrust into the dough to a degree to at least change the shape of the dent formed in the central part of the dough as shown in Drawings 6B and 7B contained in the List of the Defendant's Apparatus (Defendant's Allegations) 2 contained in attachment 3-2 of the judgment in prior instance.

C. Fulfillment

As such, the nozzle member will not be lowered in Defendant's Process 2. But, as with the case stated in (3) above, while the nozzle member and dough pressing member are brought close to the shutter pieces and placement member by being lowered in Invention 1, the shutter pieces and placement member are brought close to the integrated nozzle member and dough pressing member by being lifted in Defendant's Process 2. Thus, Defendant's Process 2 is found equivalent to Invention 1 in that point. Moreover, the step of changing the shape of the dough by relatively moving the lower end of the nozzle member to a position lower than the placement member and thrusting it into the dent formed in the central part of the dough is the same step used in Defendant's Process 1 mentioned in 2. above. Thus, even if the dough is expanded while supplying the inner material through a nozzle member, it can be said that Defendant's Process 2 also fulfills Constituent Feature 1D.

(5) Fulfillment of Constituent Feature 1E

There are no disputes between the parties to the extent that, in Defendant's Process 2, "the inner material is arranged on the dough […] by supplying the inner material through a nozzle member" (as described in structure 1e' alleged by the appellant and structure 1(e)' alleged by the appellee).

As such, as with the case of Defendant's Process 1 mentioned in 2. above, Defendant's Process 2 fulfills Constituent Feature 1E and the step of expanding the dough by discharging the inner material does not affect the determination on the fulfillment of the constituent feature.

(6) Fulfillment of Constituent Features 1F and 1G

There are no disputes between the parties regarding the fact that Defendant's Process 2 fulfills Constituent Features 1F and 1G.

(7) Whether or not indirect infringement can be found.

A. As found above, Defendant's Process 2 falls within the technical scope of Invention 1 as an equivalent thereof.

B. Regarding Article 101, item (iv) of the Patent Act

As with the case stated in 2. above, Defendant's Apparatus 2 is "a product to be used exclusively for the use of the process" of Invention 1.

(8) Summary

As found above, the act of manufacturing, selling and offering for sale Defendant's Apparatus 2 shall be deemed to infringe Patent Right 1

4. Whether or not Defendant's Process 3 indirectly infringes Patent Right 1

(1) Fulfillment of Constituent Feature 1A

A. Structure of Defendant's Process 3

Based on either the appellant's allegation or the appellee's allegation, the structure of Defendant's Process 3 that corresponds to Constituent Feature 1A is identical with that of Defendant's Process 2 (as described in structure 2a' and 2a alleged by the appellant and structure 2(a)' and 2(a)" alleged by the appellee).

B. Fulfillment

Accordingly, as with the case of Defendant's Process 2 stated in 3. above, Defendant's Process 3 fulfills Constituent Feature 1A.

(2) Fulfillment of Constituent Feature 1B

While the appellant alleges that Defendant's Process 3 and Defendant's Process 1 are the same, the appellee alleges as described in structure 1(b)" alleged by the appellee. Structure 1(b)" alleged by the appellee is identical with structure 1(b) alleged by the appellee with respect to Defendant's Process 1 except for the structure of "supporting the dent generated in the dough by a supporting conveyer." Even if Defendant's Process 3 has the structure as alleged by the appellee, it fulfills Constituent Feature 1B as with the case of Defendant's Process 1 stated in 2. above.

(3) Fulfillment of Constituent Feature 1C

There are no disputes between the parties to the extent that Defendant's Process 3 contains the step of "retaining the dough on the placement member by lowering the nozzle member and dough pressing member and pushing the dough pressing member against the edge part of the dough" (as described in structure 1c alleged by the appellant and structure 1(c)" alleged by the appellee). Thus, Defendant's Process 3 fulfills Constituent Feature 1C.

(4) Fulfillment of Constituent Feature 1D

The appellee alleges that Defendant's Process 3 does not have the step of further lowering the pushing member. While the nozzle member and dough pressing member are integrated in Defendant's Process 3 (Exhibits Otsu 23 and 25), Constituent Feature 1D includes the step of lowering the nozzle member integrated with dough pressing member, as stated in 3. above.

The appellee alleges that Defendant's Process 3 has the following structures as with the case of Defendant's Processes 1 and 2: [i] the "nozzle member" is stopped in a state where its lower end part is in contact with the dent formed in the central part of the dough (structure 1(c)" alleged by the appellee); [ii] the dough is expanded and formed into a bowl-like shape by supplying the inner material through the nozzle member (structure 1(e)" alleged by the

appellee); and [iii] the dough is expanded and formed into a bowl-like shape by the discharge pressure of the inner material instead of forming the dough into a bowl-like shape by thrusting the nozzle member into the dough and arranging the inner material inside the pastry material formed into a bowl-like shape. However, the same determination made for Defendant's Process 1 as stated in 2. above shall apply to this point and thus Defendant's Process 3 also fulfills Constituent Feature 1D.

(5) Fulfillment of Constituent Feature 1E

There are no disputes between the parties to the extent that Defendant's Process 3 has the step of "arranging the inner material on the dough […] by supplying the inner material through the nozzle member" (as described in structure 1e alleged by the appellant and structure 1(e)" alleged by the appellee).

As such, as with the case of Defendant's Process 1 as stated in 2. above, Defendant's Process 3 fulfills Constituent Feature 1E and the step of expanding the dough by discharging the inner material does not affect the determination on the fulfillment of Constituent Feature 1E.

(6) Fulfillment of Constituent Features 1F and 1G

There are no disputes between the parties regarding the fact that Defendant's Process 3 fulfills Constituent Features 1F and 1G.

(7) Whether or not indirect infringement can be found.

A. Accordingly, Defendant's Process 3 fulfills all of the constituent features of Invention 1.

B. Regarding Article 101, item (iv) of the Patent Act

As with the case stated in 2. above, Defendant's Apparatus 3 is "a product to be used exclusively for the use of the process" of Invention 1.

(8) Summary

As found above, the act of manufacturing, selling and offering for sale Defendant's Apparatus 3 shall be deemed to infringe Patent Right 1.

5. Whether or not Defendant's Apparatus 1 infringes Patent Right 2

(1) Fulfillment of Constituent Features 2A and 2B

There are no disputes between the parties regarding the fact that Defendant's Apparatus 1 fulfills Constituent Features 2A and 2B.

(2) Fulfillment of Constituent Feature 2C

A. Constituent Feature 2C is "a shutter driving means wherein the position of the pastry material is adjusted to fit in a predetermined position by operating the shutter pieces in a closing direction and reducing the opening area while gathering the peripheral part of the pastry material to wrap the inner material by operating the shutter to close" and is the same as Constituent Features 1B and 1F of Invention 1.

There are no disputes between the parties to the extent that Defendant's Apparatus 1 has the

structure of having "a shutter activation shaft that seals the peripheral edge of the dough by wrapping and gathering the inner material by operating the shutter to close while reducing the opening area by operating the shutter pieces in a closing direction […] and adjusting the position of the dough to fit in a predetermined position that is approximately concentric and covers the opening part" (as described in structure 2c alleged by the appellant and structure 2(c) alleged by the appellee). In addition, as with the case of Constituent Feature 1B, the structure of "a predetermined position that is approximately concentric and covers the opening part" is equivalent to the "predetermined position" of Constituent Feature 2C.

Thus, Defendant's Apparatus 1 fulfills Constituent Feature 2C.

B. The appellee alleges that the phrase "adjusting the position" means to adjust the position of the receiving member on a plane surface (two dimensional adjustment of position) and the structure of Defendant's Apparatus 1 is different from this. However, the structure of "denting the central part of the dough to a slightly lower side from the opening part of the placement member by compressing the peripheral edge of the dough by shutter pieces and by the weight of the central part of the dough" is an additional structure and does not affect the determination on the fulfillment of Constituent Feature 2C. In addition, the appellee has stated that it will not dispute in this instance with respect to Constituent Feature 1B, which has the same structure as that of Constituent Feature 2C, and there are no disputes regarding the fulfillment of Constituent Feature 1F as stated in 2. above.

(3) Fulfillment of Constituent Feature 2D

A. Interpretation of the constituent feature of "formed into a bowl-like shape"

Constituent Feature 2D is "a pastry material forming means wherein the pastry material is formed into a bowl-like shape by lowering the pushing member and thrusting it into the opening part of the receiving member and pushing the central part of the pastry material into the opening part while supplying the inner material inside the pastry material through the pushing member."

In Constituent Feature 2D, the significance of having the pastry material "formed into a bowl-like shape" by a pushing member lies in enabling the pastry material to be formed into a "bowl-like shape" in line with the shape of the tip of the pushing member by lowering the pushing member to a certain depth regardless of the characteristics of the pastry material, as with the case of Constituent Feature 1D of Invention 1. In addition, since there are no special limitations on the method of arranging the inner material, the pushing member will be thrust into the pastry material to a certain depth, the pastry material will be formed into a "bowl-like shape" and the inner material will be arranged inside the part formed into a bowl-like shape, as with the case of Constituent Feature 1E.

The appellee alleges that the "pushing member" established in the pastry material forming means refers to a member which forms the pastry material into a bowl-like shape by being

lowered together with the "pressing member," being thrust into the opening part of the receiving member, and pushing the central part of the pastry material into the opening part. However, there are no statements in the scope of claims of Invention 2 that both the pushing member and pressing member will be lowered.

B. Structure of Defendant's Apparatus 1

As stated in 2.(4) and (5) above, Defendant's Apparatus 1 can be used as follows: [i] by lowering the nozzle member, its lower end part will be brought into contact with the dough and form a dent in the dough in line with the shape of its lower end part; and [ii] the lower end of the nozzle member can be thrust into the opening part of the placement member to a depth of 7 to 15mm from the lower surface by lowering the nozzle member, thereby forming a dent in the central part of the dough while supporting the dough by the placement member. In addition, the inner material is supplied on the dent of the dough through the nozzle member and thereby the inner material is arranged on the dough.

C. Fulfillment

The "nozzle member" used in Defendant's Apparatus 1 is equivalent to the "pushing member" used in Invention2, and the fact that the dent formed by Defendant's Apparatus 1 is a "bowl-like shape" is the same as in the case mentioned in 2. above, which means the nozzle member constitutes the "pastry material forming means." Thus, Defendant's Apparatus 1 fulfills Constituent Feature 2D.

(4) Fulfillment of Constituent Feature 2E

A. Interpretation of the constituent feature

Constituent Feature 2E is "a retention means established in a pastry material forming means wherein the pastry material is retained on the receiving member by pushing the pressing member against the edge part of the pastry material." As with the case of Constituent Feature 2D, it is not required for both the pushing member and pressing member to be lowered in Constituent Feature 2E. In addition, the retention means is established in the pastry material forming means of Constituent Feature 2D.

B. Structure of Defendant's Apparatus 1

There are no disputes between the parties to the extent that Defendant's Apparatus 1 "retains the dough on the placement member by pushing the dough pressing member against the edge part of the dough" (as described in structure 2e alleged by the appellant and structure 2(e) alleged by the appellee).

C. Fulfillment

As with the case of Invention 1 stated in 2. above, the "dough pressing member" of Defendant's Apparatus 1 is equivalent to the "pressing member" of Invention 2 while the "placement member" of Defendant's Apparatus 1 is equivalent to the "receiving member" of

Invention 2, and the dough pressing member constitutes the "retention means." Even if the dough pressing means and the nozzle member can be lifted and lowered separately as alleged by the appellee, the dough pressing means is established in the nozzle member as shown in the drawings contained in the List of the Defendant's Apparatus (Defendant's Allegation) 1 contained in the attachment 3-1 of the judgment in prior instance. Thus, Defendant's Apparatus 1 fulfills Constituent Feature 2E.

(5) Fulfillment of Constituent Feature 2F

Constituent Feature 2F is "a supporting means arranged on the lower side of the receiving member wherein the pastry material formed into a bowl-like shape is supported by lifting the supporting member and the formed article is conveyed by lowering the supporting member." There are no disputes between the parties to the extent that Defendant's Apparatus 1 is a "a supporting means comprising a supporting conveyer and the lifting and lowering mechanism thereof which is arranged on the lower side of the placement member and supports the dough with a dent by lifting the supporting conveyer […] and conveys the formed article by lowering the supporting conveyer" (as described in structure 2f alleged by the appellant and structure 2(f) alleged by the appellee). In addition, as with the case mentioned in 2. above, the "supporting conveyer" of Defendant's Apparatus 1 is equivalent to the "supporting member" of Invention 2 while the step of forming the "dent" in Defendant's Apparatus 1 is equivalent to step of forming the pastry material into a "bowl-like shape" in Invention 2.

Thus, Defendant's Apparatus 1 fulfills Constituent Feature 2F.

(6) Whether or not infringement can be found

As found above, Defendant's Apparatus 1 fulfills all of the constituent features of Invention 2 and falls within the technical scope thereof.

6. Whether or not Defendant's Apparatus 2 infringes Patent Right 2

(1) Fulfillment of Constituent Feature 2A

A. Interpretation of the "receiving member" of the constituent feature

Constituent Feature 2A is "a receiving member in which an opening part is formed in the central part and on which a sheet-like pastry material is placed." In relation to this, the appellee alleges that the "receiving member" of Invention 2 does not show a lifting and lowering operation. However, the scope of claims contains no statements on whether or not the receiving member will be lifted or lowered, and there are no reasons to limit it to those that do not show a lifting and lowering operation.

B. Structure of Defendant's Apparatus 2

There are no disputes between the parties to the extent that Defendant's Apparatus 2 has the structure of "a placement member wherein an opening part is formed in the central part and on which the substantially disk shape dough is placed" (as described in structure 2a' alleged by the

appellant and structure 2(a)' alleged by the appellee).

C. Fulfillment

Even if the placement member of Defendant's Apparatus 2 has a lifting and lowering mechanism, it still fulfills Constituent Feature 2A.

(2) Fulfillment of Constituent Feature 2B

A. Interpretation of the term "above" contained in the constituent feature

Constituent Feature 2B is "a shutter which is arranged above the receiving member and equipped with multiple shutter pieces." In relation to this, the appellee alleges that the term "above" means that there is no space or intervening member between the receiving member and the shutter." However, normally, the term "above" simply refers to the "upper side" regardless of whether or not the relevant member is directly arranged or arranged with space with respect to another member and cannot be interpreted to be limited to the state where the relevant member is directly arranged on the other member, as with the case of Constituent Feature 1A.

B. Structure of Defendant's Apparatus 2

There are no disputes between the parties to the extent that Defendant's Apparatus 2 has the structure of "a shutter which is arranged above the placement member and equipped with six shutter pieces […]" (as described in structure 2b' alleged by the appellant and structure 2(b)' alleged by the appellee).

C. Fulfillment

Even if the shutter pieces are arranged in an upper side position separated from the receiving member in Defendant's Apparatus 2, such position will be included in the scope of the term "above" used in Constituent Feature 2B and thus Defendant's Apparatus 2 fulfills Constituent Feature 2B.

(3) Fulfillment of Constituent Feature 2C

As with the case of Defendant's Apparatus 1 stated in 5. above, Defendant's Apparatus 2 fulfills Constituent Feature 2C.

(4) Fulfillment of Constituent Feature 2D

A. Interpretation of the constituent feature

As with the case mentioned in 5. above, the following facts are found: [i] Constituent Feature 2D is "a pastry material forming means wherein the pastry material is formed into a bowl-like shape by lowering the pushing member and thrusting it into the opening part of the receiving member and pushing the central part of the pastry material into the opening part while supplying the inner material inside the pastry material through the pushing member"; [ii] the significance of "forming the pastry material into a bowl-like shape" by the pushing member is to form the pastry material into a "bowl-like shape" in line with the shape of the tip of the pushing member by lowering the pushing member to a certain depth regardless of the characteristics of

the pastry material; and [iii] since there are no special limitations on the method to arrange the inner material, the inner material will be arranged inside the part formed into a bowl-like shape by thrusting the pushing member into the pastry material to a certain depth and forming the pastry material into a "bowl-like shape."

B. Structure of Defendant's Apparatus 2

There are no disputes between the parties to the extent that Defendant's Apparatus 2 has the structure of "supplying the inner material inside the dough through the nozzle member […] by lifting the shutter pieces, placement member […]" (as stated in structure 2d' alleged by the appellant and structure 2(d)' alleged by the appellee).

As such, Defendant's Apparatus 2 and Invention 2 differ in that while the nozzle member and dough pressing member are brought close to the shutter pieces and placement member by being lowered in the latter apparatus, the shutter pieces and placement member are brought close to the nozzle member and dough pressing member by being lifted without lowering the pushing member in the former apparatus.

C. Whether or not infringement under the doctrine of equivalents can be found

As with the case stated in 3. above, Defendant's Apparatus 2 is equivalent to Constituent Feature 2D of Invention 2 and falls within the technical scope thereof.

(5) Fulfillment of Constituent Feature 2E

There are no disputes between the parties to the extent that Constituent Feature 2E is "a retention means established in a pastry material forming means wherein the pastry material is retained on the receiving member by pushing the pressing member against the edge part of the pastry material" and Defendant's Apparatus 2 is "a retention means that […] retains the dough on the placement member by pushing the dough pressing member […] against the edge part of the dough" (as described in structure 2e' alleged by the appellant and structure 2(e)' alleged by the appellee). In addition, based on the appellee's appellation, the nozzle member and dough pressing member are integrally established in Defendant's Apparatus 2 (structure 2(e)' alleged by the appellee).

Thus, Defendant's Apparatus 2 fulfills Constituent Feature 2E.

(6) Fulfillment of Constituent Feature 2F

A. Structure of Defendant's Apparatus 2

Based on either the appellant's allegation or the appellee's allegation, the structure of Defendant's Apparatus 2 that corresponds to Constituent Feature 2F is identical with that of Defendant's Apparatus 1 (as described in structures 2f and 2f' alleged by the appellant and structures 2(f) and 2(f)' alleged by the appellee).

B. Fulfillment

Thus, as with the case of Defendant's Apparatus 1 stated in 5. above, Defendant's Apparatus

2 fulfills Constituent Feature 2F.

(7) Whether or not infringement can be found

As found above, Defendant's Apparatus 2 falls within the technical scope of Invention 2 as an equivalent thereof.

7. Whether or not Defendant's Apparatus 3 infringes Patent Right 2

(1) Fulfillment of Constituent Feature 2A

A. Structure of Defendant's Apparatus 3

Based on either the appellant's allegation or the appellee's allegation, the structure of Defendant's Apparatus 3 that corresponds to Constituent Feature 2A is identical with that of Defendant's Apparatus 2 (as described in structure 2a' and 2a alleged by the appellant and structures 2(a)' and 2(a)" alleged by the appellee).

B. Fulfillment

Thus, as with the case of Defendant's Apparatus 2 stated in 6. above, Defendant's Apparatus 3 fulfills Constituent Feature 2A.

(2) Fulfillment of Constituent Feature 2B

A. Structure of Defendant's Apparatus 3

There are no disputes between the parties to the extent that Defendant's Apparatus 3 has the structure of "a shutter which is arranged above the placement member and equipped with six shutter pieces […]" (as described in structure 2b alleged by the appellant and structure 2(b)" alleged by the appellee).

B. Fulfillment

Even if the shutter pieces are arranged in an upper side position separated from the receiving member in Defendant's Apparatus 3, it would be included in the scope of the term "above" used in Constituent Feature 2B and thus Defendant's Apparatus 3 fulfills Constituent Feature 2B.

(3) Fulfillment of Constituent Feature 2C

As with the case of Defendant's Apparatus 1 stated in 5. above, Defendant's Apparatus 3 fulfills Constituent Feature 2C.

(4) Fulfillment of Constituent Feature 2D

A. Structure of Defendant's Apparatus 3

Based on either the appellant's allegation or the appellee's allegation, the structure of Defendant's Apparatus 3 that corresponds to Constituent Feature 2D is identical with that of Defendant's Apparatus 1 (as stated in structure 2d alleged by the appellant and structures 2(d) and 2(d)" alleged by the appellee).

B. Fulfillment

Thus, as with the case of Defendant's Apparatus 1 stated in 5. above, Defendant's Apparatus 3 fulfills Constituent Feature 2D.

(5) Fulfillment of Constituent Feature 2E

There are no disputes between the parties to the extent that Constituent Feature 2E is "a retention means established in a pastry material forming means wherein the pastry material is retained on the receiving member by pushing the pressing member against the edge part of the pastry material" and that Defendant's Apparatus 3 is "a retention means that […] retains the dough on the placement member by pushing the dough pressing member […] against the edge part of the dough" (as described in structure 2e alleged by the appellant and structure 2(e)" alleged by the appellee). In addition, based on the appellee's allegation, the nozzle member and dough pressing member are integrally established in Defendant's Apparatus 3 (structure 2(e)" alleged by the appellee).

Thus, Defendant's Apparatus 3 fulfills Constituent Feature 2E.

(6) Fulfillment of Constituent Feature 2F

There are no disputes between the parties to the extent that Constituent Feature 2F is "a supporting means arranged on the lower side of the receiving member wherein the pastry material formed into a bowl-like shape is supported by lifting the supporting member and the formed article is conveyed by lowering the supporting member" and that Defendant's Apparatus 3 is "a supporting means comprising a supporting conveyer and the lifting and lowering mechanism thereof which [...] supports the dough [...] with the supporting conveyer […] and conveys the formed article by lowering the supporting conveyer" (as stated in structure 2f alleged by the appellant and structure 2(f)" alleged by the appellee). Even based on the appellee's allegation, it is obvious from the drawing contained in the List of the Defendant's Apparatus (Defendant's Allegation) 3 contained in Attachment 3-3 of the judgment in prior instance that the supporting conveyer is arranged on the lower side of the placement member in Defendant's Apparatus 3.

The supporting conveyer of Defendant's Apparatus 3 is equivalent to the "supporting means" of Invention 2 while the placement member of Defendant's Apparatus 3 is equivalent to the "receiving member" of Invention 2 and thus, Defendant's Apparatus 3 fulfills Constituent Feature 2F.

(7) Whether or not infringement can be found

As found above, Defendant's Apparatus 3 fulfills all of the constituent features of Invention 2 and falls within the technical scope thereof.

8. Regarding the defense of patent invalidity

(1) The appellee alleges that the patent in question ("Patent") should be invalidated in a trial for patent invalidation.

(2) The appellee filed a request for a trial for patent invalidation with respect to Inventions 1 and 2 based on the same reasons used in this action, but the JPO rendered a trial decision to dismiss

the request. The appellee filed an action seeking rescission of the JPO decision (Intellectual Property High Court 2010 (Gyo-Ke) 10058), but this court rendered a judgment to dismiss the appellee's claims and the judgment became final and binding on January 11, 2011.

(3) Accordingly, the Patent cannot be invalidated in a trial for patent invalidation based on the reasons alleged by the appellee, and thus the defense alleging the invalidity of the Patent is found unreasonable without the need for making determinations on other points.

9. Regarding damages

(1) There are no disputes between the parties regarding the fact that the appellee sold Defendant's Apparatus 2 to Chubu Foods Co., Ltd. and Defendant's Apparatus 3 to Yamazaki Baking Co., Ltd. In addition, the appellee alleges that the sales value and amount of sales profit of Defendant's Apparatus 2 are 55,762,560 yen and 10,873,699 yen (profit rate: 19.5%), respectively, while the sales value and amount of sales profit of Defendant's Apparatus 3 are 70,056,900 yen and 6,795,519 yen (profit rate: 9.7%), respectively. The appellant has acknowledged such amounts and the appellee has not alleged other costs to be deducted.

(2) Thus, the amount of damages sustained by the appellant based on Article 102, paragraph (2) of the Patent Act is found to be a total of 17,669,218 yen (sum of 10,873,699 yen and 6,795,519 yen).

10. Conclusion

As found above, the appellant's claims made in this action are well-grounded to the extent of seeking an injunction against the manufacture, sale, offer for sale and export of Defendant's Apparatuses 1 through 3 based on Article 100, paragraph (1) of the Patent Act (with respect to the export, an injunction against the act of working the invention covered by Patent Right 2), disposal of said apparatuses based on paragraph (2) of said Article and compensation for damages in an amount of 17,669,218 yen based on Article 709 of the Civil Code. Thus, the judgment should be modified in the form of the main text.

Intellectual Property High Court 4th Division,

Presiding Judge: TAKIZAWA Takaomi

Judge: TAKABE Makiko

Judge: INOUE Yasuhito

(Attachments are omitted)