

Patent Right	Date	June 17, 2020	Court	Intellectual Property High Court, Second Division
	Case number	2019 (Ne) 10066		
- A case in which, in the patent infringement lawsuit of the invention titled "INFORMATION MANAGEMENT METHOD, INFORMATION MANAGING DEVICE, AND INFORMATION MANAGEMENT PROGRAM", the judgment in prior instance was reversed by holding that the invention is identical to the cited invention, and no novelty is found, and the claim by Plaintiff of the first court was dismissed.				

Case type: Patent Infringement Lawsuit and the like

Result: Reversal of prior instance judgment, Dismissed

References: Article 29, paragraph (1) of the Patent Act

Related rights, etc.: Patent No. 5075201

Judgment of the prior instance: Tokyo District Court, 2016 (Wa) 16912

#### Summary of the Judgment

1. This case is a case in which Plaintiff of the first court having the present patent right pertaining to Patent No. 5075201 of the invention titled "INFORMATION MANAGEMENT METHOD, INFORMATION MANAGING DEVICE, AND INFORMATION MANAGEMENT PROGRAM" made a claim for injunction of transfer of Defendant's program and the like to Defendant of the first court on the ground of Article 100, paragraph (1) of the Patent Act and demanded payment of the compensation for damage and delay damages at the rate of 5% per annum as prescribed by the Civil Code from the date subsequent to the tort on the ground of Article 709 of the Civil Code from Defendant of the first court by asserting that Defendant of the first court provides customers with services using Defendant's program belonging to the technical scope of the invention (present invention) according to Claim 7 of the Scope of Claims thereof and infringes the present patent right.

The judgment in prior instance affirmed the injunction of the transfer of Defendant's program and the like and the claim for a part of the compensation for damage on the ground of Article 709 of the Civil Code among the claims by Plaintiff of the first court and dismissed the remaining claims and thus, Plaintiff of the first court and Defendant of the first court instituted respective lawsuits.

The defense of invalidity of lack of novelty on the ground of the invention described in the Exhibit Otsu 14 (description of the U.S. Patent Publication No. 2005-0251445) (hereinafter, referred to as the "Exhibit Otsu 14 invention") was

dismissed since it was allegation and evidence presented belatedly in the court of prior instance, but Defendant of the first court does not assert that it is the allegation and evidence presented belatedly on the defense of invalidity of lack of novelty with the Exhibit Otsu 14 invention as the main cited document in this court.

2. Defense of invalidity of lack of novelty on the ground of the Exhibit Otsu 14 invention

(1) The present invention is an advertising method utilizing a web page on the Internet and is an invention according to a Pay per Call method in which a telephone number associated with each advertiser is posted with advertisement information on the web page of an advertising site, and when a user who sees it and makes a phone call to the advertiser, an advertisement fee is charged on the ground of establishment of the call. The present invention is addressed to solve the problem of the exhaustion of the telephone number resources when different telephone numbers are to be posted for each of a large number of advertising sites and commodities so as to grasp to which advertising site the user made a call, and enables reuse of identification information and to promote effective use and prevention of exhaustion of resources of the identification information by dynamically assigning the identification information indicating the telephone number and by finishing the offering thereof with elapse of a certain period of time or a certain number of accesses.

(2) The Exhibit Otsu 14 invention is also an invention pertaining to the Pay per Call method which is the same as the present invention, and the following processing is executed in response to a search request made by an end user in a search engine of a requested partner.

(a) The search engine of the requested partner having received the search request transmits the search request to the system;

(b) The system assigns a telephone number to be the "unique telephone number" in the telephone numbers in a pool of unassigned telephone numbers to an advertisement of a specific advertiser associated with a keyword in the search request and automatically inserts it in the advertisement in the "just-in-time method" and transmits the advertisement in which the assigned "unique telephone number" is inserted to the search engine of the requested partner;

(c) The search engine of the requested partner displays the "advertisement in

which the unique telephone number was inserted" transmitted from the system in a search result in response to the search request;

- (d) The system records that the advertisement of the specific advertiser was displayed with the specific unique telephone number on a specific web site (a web site of a certain search engine) at some time;
  - (e) In the system, if a "certain period of time has elapsed since" the "unique telephone number" "was displayed", it is returned to the "pool of the telephone numbers" for "reuse", and if "there is no call inducing an inquiry", the "dynamically assigned telephone number" is associated with "the advertisement for a "certain period of time since" this "unique telephone number" "was displayed".
- (3) Constituent feature [vi] of the present invention ("a function of executing a step of changing a state where the identification method can be sent out toward the web page to a state where sending-out is not possible when a certain period of time has elapsed since the identification information was sent out toward the web server or when the number of times that the web server was accessed has reached a reference")
- A. With regard to the start point of the "certain period of time", it is a point of time when "the identification information was sent out toward the web server" in the present invention, while in the Exhibit Otsu 14 invention, it is a "point of time when the telephone number was displayed on a computer or the like of the user".

However, the Description of the Exhibit Otsu 14 invention has description which can be so understood that the term "display" is not limited to the meaning that the information is shown only on a screen of a user terminal or the like but also includes presentation by the system (advertising company) of information of the advertisement to which the telephone number was assigned to the web site of the requested partner. Moreover, the search engine of the requested partner of the Exhibit Otsu 14 invention is "for displaying the 'advertisement in which the unique telephone number was inserted' transmitted from the system in the search result in response to the search request", and as in constituent features (b) and (c), since the presentation of the information to the web site of the search engine of the requested partner or the like is performed by transmission by the system of the "advertisement in which the unique telephone number was inserted" to the requested partner, it can be

understood that the "display" referred to in the Exhibit Otsu 14 invention also includes the meaning that the system sends out the "advertisement in which the unique telephone number was inserted" to be presented on the web site of the requested partner.

According to the above, it is reasonable to admit that the phrase "since it was displayed" in the Exhibit Otsu 14 invention includes the point of time when the telephone number was "sent out" toward the search engine of the requested partner and thus, there is no different feature in this point between the present invention and the Exhibit Otsu 14 invention.

- B. In the present invention, "the information management server is in the 'state capable of sending-out' the identification information toward the advertising server while a 'certain period of time' is elapsing, while the Exhibit Otsu 14 invention does not have explicit description on that point.

However, the Exhibit Otsu 14 invention is understood to be inevitably based on the fact that the number of managed telephone numbers should be decreased by assigning and displaying the same telephone number as the telephone number assigned in a search by a first customer again to a search by a second customer on the web site of the same search engine and thus, it is so understood to indicate that, when the telephone number in the pool is to be assigned to the advertisement in the "just-in-time method" to the search request from the end user to the search engine of the requested partner, the telephone number within a predetermined period of time since the advertisement was displayed is assigned again to the "advertisement" as the "unique telephone number", and the advertisement in which the "telephone number within the predetermined period of time" was inserted is transmitted to the search engine of the requested partner in the case of the same requested partner or the same context.

Then, the point that the "state capable of sending-out" remains until the "certain period of time" is finished and the "state where sending-out is not possible" is brought about in the present invention is the common feature with the Exhibit Otsu 14 invention.

- C. According to the above, the Exhibit Otsu 14 invention includes constituent feature [vi] of the present invention.
- (4) Since the Exhibit Otsu 14 invention includes the other constituent features of the present invention, the present invention is identical to the Exhibit Otsu 14 invention. Therefore, the patent according to the present invention should

be invalidated pursuant to Article 123, paragraph (1), item (ii) of the Patent Act (violation of Article 29, paragraph (1), item (iii) of the same Act), and exercise of right by Plaintiff of the first court on the ground of the present patent right shall not be affirmed.