Patent Right	Date	June 24, 2020	Court	Intellectual Property High Court, Fourth Division
	Case number	2019 (Ne) 10015		
- A case in which with regard to the significance of a "fermented product" stated in the scope of claims of an invention related to the fermented product and a foodstuff, etc. containing the fermented product, taking the description attached to the written application and common general technical knowledge into consideration, it was construed that a fermented product produced from a raw material for fermentation, which requires a high cost and another nutrient for fermentation, does not fall under the fermented product of the invention. - A case in which it was determined that satisfaction of the first requirement of the doctrine of equivalence was not acknowledged.				

Case type: Injunction

Result: Appeal dismissed

References: Article 70, paragraphs (1) and (2), and Article 100, paragraphs (1) and (2) of the Patent Act

Related rights, etc.: Patent No. 5946489

Judgment of the prior instance: Tokyo District Court 2017 (Wa) 35663

Summary of the Judgment

1. Outline of the case

The present case is one in which the Appellant, who has a patent right concerning the present patent (Patent No. 5946489) on an invention titled "EQUOL-CONTAINING FERMENTED SOYBEAN HYPOCOTYL PRODUCT, AND METHOD FOR PRODUCTION THEREOF", asserted that the production and sale, etc. of the Appellee's (Defendant's) product by the Appellee constitutes an infringement of the present patent right, and thus demanded that the Appellee be enjoined from the production and transfer, etc. of the Appellee's (Defendant's) product under Article 100, paragraph (1) of the Patent Act, and that the Appellee's (Defendant's) product be disposed of under Article 100, paragraph (2) of the Patent Act.

The court of the prior instance dismissed these demands by the Appellant (Plaintiff) on the grounds that since the Appellee's (Defendant's) product is a fermented product of a soybean hypocotyl extract and not a fermented product of a soybean hypocotyl itself, the Appellee's (Defendant's) product does not satisfy the constituent features of the "fermented soybean hypocotyl product" of the invention according to Claims 1 and 3 in the Scope of Claims of the present patent, and therefore, without going so far as to determine other issues, none of the Appellant's

demands are founded.

2. Summary of this judgment

This judgment dismissed the Appellant's appeal on the grounds that it was determined that the Appellee's (Defendant's) product does not fall under the "fermented soybean hypocotyl product" of each of the present inventions and does not satisfy the first requirement of the doctrine of equivalence, and thus, it cannot be acknowledged that the Appellee's (Defendant's) product falls within the technical scope of each of the present inventions, and therefore, without going so far as to determine other issues, the Appellant's demands are unfounded, as follows.

(1) Whether or not constituent feature is satisfied

In the scope of claims of each of the present inventions, there is neither a statement defining a "fermented soybean hypocotyl product" nor a statement limiting a "soybean hypocotyl", which is a raw material for fermentation, to a specific component. On the other hand, the present description clearly distinguishes between the "soybean hypocotyl extract" and the "soybean hypocotyl" as a raw material for fermentation for producing the "fermented soybean hypocotyl product", and discloses that the "soybean hypocotyl extract" is not suitable as a raw material for fermentation, because the "soybean hypocotyl extract" requires a high cost and another nutrient for fermentation by equol-producing bacteria. In light of these facts, it is reasonable to construe that the fermented product produced from such "soybean hypocotyl extract" as a raw material for fermentation does not fall under the "fermented soybean hypocotyl product" of each of the present inventions.

However, the present description does not disclose a component of the "soybean hypocotyl extract" which is not suitable as a raw material for fermentation, and the content of isoflavone, etc.

In this regard, an extraction process of isoflavone-containing components from a soybean hypocotyl is generally carried out as an extraction by using a solvent such as water, alcohol (ethanol, etc.), or water-containing alcohol. It can be acknowledged that it was common general technical knowledge at the time of the priority date of the present patent that, in order to obtain a "soybean hypocotyl extract" containing a high concentration of isoflavone from a soybean hypocotyl, it is necessary to carry out a purification process such as a concentration operation, etc. by using a synthetic adsorption resin, in addition to such an extraction process.

Further, it is obvious that a "soybean hypocotyl extract", which contains a high concentration of isoflavone, requires a high cost and another nutrient for fermentation by equol-producing bacteria. Thus, it is reasonable to acknowledge that a fermented

product produced from such a "soybean hypocotyl extract" as a raw material for fermentation does not fall under the "fermented soybean hypocotyl product" of each of the present inventions.

Considering this with regard to the Appellee's (Defendant's) product, "EQ-5" used in the Appellee's (Defendant's) product is a fermented product which is obtained by adding seed bacteria to a raw material isoflavone extracted from a soybean hypocotyl and then fermenting it, and 90% or more of the raw material isoflavone is isoflavone of daidzeins, genisteins, and glyciteins. Thus, it is clear that the raw material isoflavone falls under the "soybean hypocotyl extract" which contains a high concentration of isoflavone.

Then, "EQ-5" falls under the fermented product produced from the "soybean hypocotyl extract" as a raw material for fermentation, which requires a high cost and another nutrient for fermentation. Therefore, it can be acknowledged that "EQ-5" does not fall under the "fermented soybean hypocotyl product" of each of the present inventions.

(2) Doctrine of equivalence

It can be acknowledged that the essential part of each of the present inventions is not to use a "soybean hypocotyl extract", which requires another nutrient for fermentation by equol-producing bacteria, as a raw material for fermentation, but to select a soybean hypocotyl, which has been disposed of at the time of soybean food processing, as a raw material for fermentation, and to ferment the soybean hypocotyl by using equol-producing microorganisms, thereby to obtain an equol-containing fermented soybean hypocotyl product in which equol is produced with high efficiency.

In this regard, "EQ-5" used in the Appellee's (Defendant's) product is a fermented product produced from the "soybean hypocotyl extract", which requires a high cost and another nutrient for fermentation by equol-producing bacteria, as a raw material for fermentation. Thus, it cannot be acknowledged that the Appellee's (Defendant's) product has the essential part of each of the present inventions.

Then, it cannot be deemed that the part of the difference in configuration between each of the present inventions and the Appellee's (Defendant's) product is not the essential part of each of the present inventions. Therefore, the first requirement of the doctrine of equivalence is not satisfied.