

Date	June 6, 2013	Court	Intellectual Property High Court, Fourth Division
Case number	2012 (Ne) 10094		
<p>– A case in which, with regard to the plaintiff's claims for an injunction against infringement, etc. based on a patent right for inventions titled "anti-theft connector for a computer and other equipment," the court ruled that the subject products cannot be considered to fall within the technical scope of said inventions as equivalents thereto.</p>			

References: Article 70 of the Patent Act

Numbers of related rights, etc.: Patent No. 3559501

### Summary of the Judgment

1. The appellant, who holds a patent right (hereinafter referred to as the "Patent Right") for inventions titled "anti-theft connector for a computer and other equipment" (hereinafter referred to as the "Inventions"), alleged that the appellee's act of importing and selling the products stated in Product Lists 1 to 3 attached to the judgment in prior instance (the "Defendant's Products") constitutes infringement of the Patent Right. Based on this allegation, the appellant filed this action against the appellee to seek an injunction against selling, etc. of the Defendant's Products and disposal thereof as well as payment of 22,780,000 yen as compensation for damages with delay damages accrued thereon.

In the judgment in prior instance, the court ruled that the Defendant's Products cannot be considered to fall within the technical scope of the Inventions, and dismissed all the appellant's claims. Dissatisfied with the judgment in prior instance, the appellant filed an appeal and also added an allegation that the Defendant's Products are equivalents to the Inventions.

2. In this judgment, the court held as summarized below, and ruled that the Defendant's Products cannot be recognized as falling within the technical scope of the Inventions as equivalents thereto because they do not satisfy at least the first and third requirements of the doctrine of equivalents and that there is no reason for all the appellant's claims. Based on this ruling, the court dismissed the appeal.

(1) Regarding the first requirement (non-essential part)

The essential part of a patented invention in relation to the first requirement of the doctrine of equivalents refers to a distinctive part of a technical idea that provides a basis for a means for solving a problem peculiar to the patented invention in the structure of the patented invention stated in the scope of claims, that is, a part, the replacement of which with another structure will cause the technical idea as a whole to be evaluated as being different from the technical idea of the patented invention.

The Inventions should be considered to have the distinctive part of the technical idea which provides a basis for the means for solving the problem peculiar thereto, that is, the essential part, in that they have made it possible to easily attach the anti-theft connector with one hand by adopting a structure wherein the main plate and the auxiliary plate are engaged with each other in a relatively slidable manner and are held in an inseparable manner by sliding the auxiliary plate forward in the direction of insertion into the slit, that is, in the direction of the protrusion of or along the shape of the insertion piece. On the other hand, the Defendant's Products are not those wherein the auxiliary member engages with the main plate in a slidable manner by sliding forward in the direction of insertion into the slit, that is, in the direction of the protrusion of or along the shape of the insertion piece, but are those that adopt a structure wherein the auxiliary member engages with the main plate so that it is slidable in the direction of rotation centering on one pivotal connection point. The aforementioned difference should be considered to be one that concerns the essential part of the patented inventions in question.

Therefore, the first requirement, "being a non-essential part," cannot be recognized as being satisfied with regard to the Defendant's Products.

(2) Regarding the third requirement (easiness of replacement)

The appellant alleges that a person ordinarily skilled in the art could have easily arrived at the structure of the Defendant's Products wherein the main plate and the auxiliary plate are pivotally connected to each other with one pin and slide in the direction of move in a circular path based on the statements in the claims of the Patent Right or the description pertaining to the Inventions (hereinafter referred to as the "Description"). The appellant cites the arts and other matters stated in the pieces of documentary evidence as evidence that conforms to said allegation.

However, all the arts and other matters disclosed in the aforementioned pieces of documentary evidence differ from the Inventions, which are related to the technical field of anti-theft connectors, in terms of the technical field and technical problem. In addition, all the arts and other matters disclosed in the aforementioned pieces of documentary evidence, which the appellant cites as bases for alleging that said arts are conventional, differ from the Inventions in terms of the problem to be solved of the inventions, the purpose of the inventions, the means for solving the problem, basic structure, form of use, etc. The Description neither discloses nor suggests any motivation to adopt said conventional arts, and the aforementioned pieces of documentary evidence neither disclose nor suggest anything concerning the technical problem of the Inventions. Therefore, there is no motivation to adopt the structure of

the Defendant's Products by applying said arts and other matters to the Inventions. There is no sufficient evidence to recognize that a person ordinarily skilled in the art could have easily arrived at the structure of the Defendant's Products as of the time of selling, etc. of the Defendant's Products.

Consequently, the third requirement, being easily replaceable, cannot be recognized as being satisfied.

Judgment rendered on June 6, 2013; the original was received on the same day; court clerk  
2012 (Ne) 10094 Appeal Case of Seeking an Injunction against Patent Right Infringement, etc.  
Court of prior instance: Osaka District Court, 2011 (Wa) 10341  
Date of conclusion of oral argument: May 23, 2013

### Judgment

Appellant: Yugen Kaisha KYT

Appellee: Sanwa Supply Inc.

### Main Text

This appeal shall be dismissed.

The appellant shall bear the cost of the appeal.

### Facts and reasons

#### No. 1 Objects of the appeal

1. The judgment in prior instance shall be revoked.
2. The appellee shall not sell, import, or offer for sale the products stated in Product Lists 1 to 3 attached to the judgment in prior instance.
3. The appellee shall dispose of the products set forth in the preceding paragraph.
4. The appellee shall pay to the appellant 22,780,000 yen and the amount accrued thereon at the rate of 5% per annum for the period from August 25, 2011 to the date of completion of the payment.
5. The appellee shall bear the court costs for both the first and second instances.
6. Declaration of provisional execution

#### No. 2 Outline of the case

The abbreviations used in this judgment follow those used in the judgment in prior instance unless otherwise specified below.

1. The appellant, who holds the patent right in question (the "Patent Right"; Patent No. 3559501) for an invention titled "anti-theft connector for a computer and other equipment," alleges that the appellee's act of importing and selling the products stated in Product Lists 1 to 3 attached to the judgment in prior instance (the "Defendant's Products") as a business constitutes infringement of the Patent Right. Based on this allegation, the appellant filed this action against the appellee to seek an injunction against selling, etc. of the Defendant's Products and payment of 22,780,000 yen as compensation for damages with delay damages accrued thereon at the rate of 5% per annum as prescribed in the Civil Code for the period from August 25, 2011, which is the day following the date of service of the complaint, to the date of completion of the payment.

In the judgment in prior instance, the court ruled that the Defendant's Products cannot be considered to fall under the technical scope of the invention pertaining to the Patent Right, and dismissed all the appellant's claims. Dissatisfied with the judgment in prior instance, the appellant filed this appeal to seek a judgment as stated in the objects of the appeal.

(omitted)

No. 4 Court decision

This court also determines that all the appellant's claims in this action should be dismissed as there is no ground therefor.

(omitted)

"Furthermore, the following is stated in Constituent Feature D of Patented Invention 1: 'the auxiliary plate ... a slide board that is engaged with the main plate in a manner that it is slidable in the direction of the positioning of the protruded insertion piece of said main plate (note in the judgment: a protruded piece positioned at the tip of the base board that constitutes the main plate: Constituent Feature C) and ... when said slide board is slid in the direction of the protrusion of the insertion piece.' The following is also stated in Constituent Feature J of Patented Invention 2: 'the auxiliary plate ... a slide board that is engaged with the main plate in a manner that it is slidable in the direction of the protrusion of the insertion piece of said main plate and ... when said slide board is slid in the direction of the protrusion of the insertion piece.' Therefore, the "direction of insertion into the slit" and the "direction of the protrusion of the insertion piece" are recognized as the same. In addition, as the insertion piece is inserted into the slit in the "direction of the protrusion" thereof, the direction of insertion into the slit is regulated by the shape of the insertion piece."

(omitted)

"In this regard, the appellant alleges as follows: The patented inventions in question (the "Patented Inventions") achieve the solution of the aforementioned problem by having the main plate and the auxiliary plate always engaged with each other and held in an inseparable manner so that the rotation stopper piece can slide at least in the range where it overlaps with the insertion piece; the core of the technical idea exists in this point; therefore, it is sufficient to question whether or not the main plate and the auxiliary plate 'are relatively slidable in the direction of insertion into the slit' only within the range 'where the insertion piece and the

rotation stopper piece overlap with each other,' and it is not at all necessary for the Patented Inventions to have a structure wherein the main plate and the auxiliary plate 'are relatively slidable in the direction of insertion into the slit' in other situations as well; consequently, the judgment in prior instance that conflicts with this is erroneous.

Considering this allegation, the technical matter of attaching the connector while preventing the rotation thereof within the slit by having the auxiliary plate move (slide) back and forth on the main plate and having the insertion piece of the main plate and the rotation stopper piece of the auxiliary plate overlap with each other is stated in paragraph [0002][Conventional art] in the description in question (the "Description") as mentioned in 1.(3)A. above. In addition, it is also recognized that said technical matter is disclosed as a technical matter by Exhibit Otsu 15 (U.S. Patent No. 6038891; date of patent issuance: March 21, 2000). Therefore, said technical matter was publicly known art as of the time of the filing of the application for the Patented Inventions. As mentioned in 1.(3)A. above, the Patented Inventions achieve the solution of the problem of difficulty in attaching the connector by having the main plate and the auxiliary plate always engaged with each other and held in an inseparable manner so that a person can easily attach the connector while preventing the rotation thereof within the slit by having the main plate and the auxiliary plate slide and having the insertion piece of the main plate and the rotation stopper piece of the auxiliary plate overlap with each other. In the claims in the scope of claims for the Patented Inventions, there is neither a statement that limits the range where the main plate and the auxiliary plate are slidable to the range where the 'insertion piece' of the main plate and the 'rotation stopper piece' of the auxiliary plate 'overlap with each other' nor is there a statement suggesting such. Moreover, a figure showing the state where the auxiliary plate is moved back to a maximum extent along the shape of the insertion piece of the main plate (Figure 4(a)) and a figure showing the state where the auxiliary plate is moved forward to a maximum extent (Figure 4(b)) are presented in Figure 4 of a working example in the Description. In said figures, the insertion piece and the rotation stopper piece remain overlapped with each other. However, there is neither a statement that the main plate and the auxiliary plate are slidable within the range where the insertion piece and the rotation stopper piece remain overlapped with each other nor is there a technical explanation suggesting such in the detailed explanation of the invention. In that case, the aforementioned allegation of the appellant that it is sufficient to question the existence of a structure wherein the main plate and the auxiliary plate 'are relatively slidable in the direction of insertion into the slit' only within the range 'where the insertion piece and the rotation stopper piece overlap with each other' is an allegation of a technical structure that is not disclosed in the Description and is not based on the Description in that sense. Consequently, there is no reason therefor."

(omitted)

"Even on the premise of the plaintiff's allegation mentioned in (2) above, the functional and abstract statements, 'engaged with each other in a manner that they are ... slidable' and 'held in an inseparable manner,' in the claim of the Patented Inventions, 'engaged with each other in a manner that they are relatively slidable in the direction of insertion into the slit and the plates are held in an inseparable manner,' cannot be considered to be those that make clear the specific structures of the engaging means and the holding means that are necessary to achieve the purpose and effect of the Patented Inventions. In the case where the structure of the invention is stated by functional and abstract expressions in the scope of claims in this manner, if it is construed that the technical scope of the invention includes all the structures that can achieve the relevant function or the relevant function and effect of the invention, structures that belong to technical ideas that are not disclosed in the description can also be included in the technical scope of the invention. This will cause the expansion of the technical scope of the patent beyond the scope which a person ordinarily skilled in the art can understand from the statements in the scope of claims and in the description, which goes against the purpose of the patent system, i.e. granting a patent right in return for the disclosure of an invention. Therefore, if the scope of claims is stated by expressions as mentioned above, it is impossible to make clear the technical scope of the invention by those statements alone, and the technical scope of the invention should be ascertained in consideration of the statements in the detailed explanation of the invention in the description, in addition to the aforementioned statements, based on the technical ideas indicated in the specific structure disclosed therein. However, this does not limit the technical scope of the invention to the specific working examples stated in the description, but should be construed to include structures which are not stated as working examples but can be worked by a person who has ordinary knowledge in the technical field of the invention (a person ordinarily skilled in the art) based on the content of the statements concerning the invention disclosed in the description.

Looking at this in relation to this case, the only structure disclosed in the Description in relation to the claim, 'engaged with each other in a manner that they are ... slidable,' is a structure wherein the plates mutually linearly move (slide) back and forth in the direction of the insertion of the insertion piece into the slit (or the direction of the protrusion of the insertion piece) both in terms of conventional art and working examples. In addition, the only structure disclosed in the Description in relation to the claim, 'engaged with each other in a manner that they are ... slidable' and 'held in an inseparable manner,' is a structure wherein a long hole that extends in the sliding direction is opened on one plate, a pin is fixed on another plate, and the pin is fit in said long hole in a slidable manner. No other structures are specifically disclosed,

and there is also no expression that specifically suggests them. Therefore, it is reasonable to interpret the claim of the Patented Inventions, 'engaged with each other in a manner that they are ... slidable' and 'held in an inseparable manner,' by limiting it to the structures disclosed in the Description and those that a person ordinarily skilled in the art can work based on the statements in the detailed explanation of the invention in the Description, as mentioned above.

On the other hand, as mentioned in (1)C. above, the structure of the Defendant's Products corresponding to the claim, 'engaged with each other in a manner that they are ... slidable' and 'held in an inseparable manner,' is a structure wherein one end of the main plate and that of the auxiliary member are pivotally connected to each other with a pin and the main plate and the auxiliary member are slidable in the direction of move in a circular path centering on said pin. It is obvious that this structure differs from the structure disclosed in the Description, and this structure totally differs from the structure disclosed in the detailed explanation of the invention in the Description which ensures that the main plate and the auxiliary plate are 'engaged with each other in a manner that they are ... slidable' and are 'held in an inseparable manner' in terms of the configuration. Therefore, this structure cannot be considered to be a structure which a person ordinarily skilled in the art can easily work based on the statements in the detailed explanation of the invention in the Description.

In this regard, the appellant alleges as follows: A structure wherein multiple members are pivotally connected to each other with a pin, etc., 'engaged with each other in a slidable manner' and 'held in an inseparable manner,' based on the fact that the members draw a nearly straight orbit at a point distant from the pivotal connection point in the range with a small rotation angle if they are rotated centering on the pivotal connection point, is conventional art that is widely used irrespective of the technical field; in light of this conventional art, the structure of the Defendant's Products is disclosed in the Description to the extent that a person ordinarily skilled in the art can easily work it. As pieces of documentary evidence that conform with said allegation, the appellant cites Exhibits Ko 14 to 18, 20, 22 to 29, Exhibits Ko 30-1 and 30-2, Exhibits Ko 34 to 39, 43, and 44.

However, all the arts and other matters disclosed in the aforementioned pieces of documentary evidence differ from the Patented Inventions, which are related to the technical field of anti-theft connectors, in terms of the technical field and technical problem. In addition, even if the art of pivotally connecting multiple members with a pin and having them 'engaged with each other in a slidable manner' and 'held in an inseparable manner' is conventional art that is widely used irrespective of the technical field, all the arts, etc. disclosed in the aforementioned pieces of documentary evidence, which the appellant cites as bases for alleging that said art is conventional, differ from the Patented Inventions in terms of the problem to be solved of the invention, the purpose of the invention, the means for solving the problem, basic



structure, form of use, etc. The Description neither discloses nor suggests any motivation to adopt said conventional art, and the aforementioned pieces of documentary evidence neither disclose nor suggest anything concerning the technical problem of the Patented Inventions. Therefore, it should be said that there is no motivation to adopt the structure of the Defendant's Products by applying said art to the Patented Inventions.

(omitted)

"4. Summary regarding Issue 1 (whether or not the Defendant's Products fall under the technical scope of Patented Invention 1)

On these grounds, the Defendant's Products do not literally satisfy at least Constituent Features B, D, and E of Patented Invention 1, and therefore, a literal infringement is not established.

5. Regarding Issue 2 (whether or not the Defendant's Products fall under the technical scope of Patented Invention 2)

The Defendant's Products do not literally satisfy at least Constituent Features H, J, and K of Patented Invention 2 for the same reason as mentioned in 1. to 4. above, and therefore, a literal infringement is not established.

6. Regarding Issue 3 (whether or not the Defendant's Products fall under the technical scope of Patented Invention 5)

As mentioned in 4. and 5. above, the Defendant's Products do not literally infringe Patented Inventions 1 and 2. In addition, Patented Invention 5 is stated in a dependent claim of the claims concerning Patented Inventions 1 and 2. Therefore, a literal infringement is also not established in relation to Patented Invention 5.

7. Regarding infringement under the doctrine of equivalents

(1) The appellee alleges that there is no room for applying the doctrine of equivalents as long as it was determined that the Defendant's Products do not literally fall under the technical scope of the Patented Inventions which are expressed by functional claims.

However, the doctrine of equivalents is an idea based on finding an infringement by deeming the Defendant's Products to be exceptionally evaluated as equivalent to the invention stated in the scope of claims if they fulfill certain requirements, even if they literally have a structure that differs from that of the invention stated in the scope of claims. This logic does not change depending on whether the claims are functionally stated. Therefore, there is no reason for naturally denying the application of the doctrine of equivalents for the reason of denial of literal infringement only in relation to functional claims. Consequently, the aforementioned allegation of the appellee is unacceptable.

(2) Regarding the first requirement (being a non-essential part)

The essential part of a patented invention in relation to the first requirement for the application of the doctrine of equivalents refers to a distinctive part of a technical idea that provides a basis for a means for solving a problem peculiar to the patented invention in the structure of the patented invention stated in the scope of claims, that is, a part, the replacement of which with another structure will cause the technical idea as a whole to be evaluated as being different from the technical idea of the patented invention.

According to the statements in the scope of claims of the Patented Inventions (Claims 1, 2, and 5) and the Description, a connector comprising a latch with a hooking part formed at its tip and an oval-shaped cover that engages with said latch in a removable manner has conventionally existed as a connector to be connected to a slit opened on a notebook computer body casing. However, in conventional art, 'If a person inserts the hook part of the latch into the slit and then lets go of the latch, the latch sometimes suspends from the slit or drops from the slit, which makes it impossible to attach the cover. Therefore, it was necessary to insert a cover with one hand while holding the latch with another hand. However, as both the latch and the cover are small and the slit is formed on the side part close to the lower surface of a notebook computer, it was difficult to attach the connector with both hands. There was thus the problem of poor workability' (paragraph [0003] in the Description. For this reason, the Patented Inventions are intended to "provide an anti-theft cable connector for a notebook computer and other equipment which can be easily attached with one hand (paragraph [0005] in the Description). The Patented Inventions are also recognized as inventions that produce the function and effect of 'enabling a person to attach a connector to a slit only by grasping the connector with one hand, inserting the retaining piece of the main plate into the slit and turning it at a 90-degree angle, and pushing the rotation stopper piece of the auxiliary plate into the slit so that it overlaps with the insertion piece while keeping the retaining piece as it is' (paragraph [0007] in the Description) by adopting a structure wherein the main plate and the auxiliary plate are engaged with each other in a relatively slidable manner and are held in an inseparable manner by sliding the auxiliary plate forward in the direction of insertion into the slit, that is, in the direction of the protrusion of or along the shape of the insertion piece (structure pertaining to Constituent Features B, D, and E) as a means for solving the aforementioned problem.

In light of the aforementioned problem, purpose, structure, function and effect, etc. of the Patented Inventions, the Patented Inventions should be considered to have the distinctive part of the technical idea which provides a basis for the means for solving the problem peculiar thereto, that is, the essential part, in that they have made it possible to easily attach the anti-theft connector with one hand by adopting a structure wherein the main plate and the auxiliary plate are engaged with each other in a relatively slidable manner and are held in an inseparable

manner by sliding the auxiliary plate forward in the direction of insertion into the slit, that is, in the direction of the protrusion of or along the shape of the insertion piece.

On the other hand, the Defendant's Products are not those wherein the auxiliary member engages with the main plate in a slidable manner by sliding forward in the direction of insertion into the slit, that is, in the direction of the protrusion of or along the shape of the insertion piece, but are those that adopt a structure wherein the auxiliary member engages with the main plate so that it is slidable in the direction of rotation centering on one pivotal connection point. The aforementioned difference should be considered to be one that concerns the essential part of the Patented Inventions.

Therefore, the first requirement, 'being a non-essential part' cannot be recognized as being satisfied with regard to the Defendant's Products.

(3) Regarding the third requirement (being easily replaceable)

The appellant alleges as follows: A person ordinarily skilled in the art could have easily conceived of the structure of the Defendant's Products wherein the main plate and the auxiliary plate are pivotally connected to each other with one pin and slide in the direction of move in a circular path based on the claims of the Patent Rights or the statements in the Description at the time of the filing of the application in question, let alone at the time of importing and selling the Defendant's Products, taking into account that [i] both [a] a structure wherein two members are pivotally connected to each other with a pin and are moved in a circular path and [b] the fact that it is inevitable to make the outer circumference of a protrusion to be inserted be arc-shaped in the case of inserting a protrusion into a hole, the size of which is prescribed in advance, from the direction of rotation, are conventional arts that are widely used irrespective of the technical field and that [ii] reduction of the number of parts is an obvious problem irrespective of the technical field and a person ordinarily skilled in the art should naturally consider reducing the number of spring pins from two to one from the perspective of reducing the number of parts. As pieces of evidence that conform to said allegation, the appellant cites Exhibits Ko 14 to 18, 20, 22 to 29, Exhibits Ko 30-1 and 30-2, Exhibits Ko 34 to 39, 43, and 44.

However, all the arts and other matters disclosed in the aforementioned pieces of documentary evidence differ from the Patented Inventions, which are related to the technical field of anti-theft connectors, in terms of the technical field and technical problem. In addition, even if a structure wherein two members are pivotally connected to each other with a pin and are moved in a circular path and the fact that it is inevitable to make the outer circumference of a protrusion to be inserted be arc-shaped in the case of inserting a protrusion into a hole, the size of which is prescribed in advance, from the direction of rotation are conventional arts that are widely used irrespective of the technical field, all the arts, etc. disclosed in the aforementioned pieces of documentary evidence, which the appellant cites as bases for alleging that said arts are

conventional, differ from the Patented Inventions in terms of the problem to be solved of the invention, the purpose of the invention, the means for solving the problem, basic structure, form of use, etc. The Description neither discloses nor suggests any motivation to adopt said conventional arts, and the aforementioned pieces of documentary evidence neither disclose nor suggest anything concerning the technical problem of the Patented Inventions. Therefore, there is no motivation to adopt the structure of the Defendant's Products by applying said arts, etc. to the Patented Inventions. In the end, it is not recognized that a person ordinarily skilled in the art can work the Defendant's Products based on the statements in the detailed explanation of the invention in the Description, as mentioned above. There is not sufficient evidence to find that a person ordinarily skilled in the art could have easily conceived of the structure of the Defendant's Products as of the time of selling, etc. of the Defendant's Products.

Moreover, even if it is an obvious problem to reduce the number of parts irrespective of the technical field, this alone does not lead to the conclusion that a person ordinarily skilled in the art can easily conceive of the structure of the Defendant's Products based on the Patented Inventions.

Consequently, the third requirement, being easily replaceable, cannot be recognized as being satisfied.

#### (4) Summary

On these grounds, the Defendant's Products do not satisfy at least the first and third requirements for the application of the doctrine of equivalents. Therefore, the Defendant's Products cannot be recognized as falling under the technical scope of the Patented Inventions as equivalents thereto.

#### 8. Conclusion

Consequently, this appeal shall be dismissed without the need for making determinations on other issues because there is no reason for all the appellant's claims in this action, the judgment in prior instance is reasonable, and there is no reason for this appeal. Accordingly, the judgment shall be rendered in the form of the main text."

Intellectual Property High Court, Fourth Division

Presiding judge: DOI Akio

Judge: TANAKA Yoshiki

Judge: ARAI Akimitsu