国際知財司法シンポジウム
Judicial Symposium on Intellectual Property / Tokyo 2020

知的財産高等裁判所

Intellectual Property High Court of Japan

パネリスト　The panelists

OTAKA Ichiro	Chief Judge, IP High Court
KUMAGAI Daisuke	Judge, IP High Court
SAGARA Yuriko	Attorney at Law, Nakamura & Partners

Colin Birss	Justice, High Court of England and Wales, Chancery Division (in charge of the Patents Court)

Klaus Bacher	Presiding Judge, Federal Court of Justice (Bundesgerichtshof)

Paul T. Meiklejohn	Partner, Dorsey & Whitney LLP

Moderators	**SHIROYAMA Yasufumi**	Attorney at Law, Anderson Mori & Tomotsune
	TAKAHASHI Aya	Judge, IP High Court

模擬事例について　The Mock Case

結論 Conclusion	 日本 Japan	 アメリカ US	 イギリス UK	 ドイツ Germany
文言侵害 **Literal infringement**	✘ 否定 Denied	✘ 否定 Denied	✘ 否定 Denied	✘ 否定 Denied
均等侵害 **Doctrine of equivalents**	✔ 肯定 Affirmed	✔ 肯定 Affirmed	✔ 肯定 Affirmed	✔ 肯定 Affirmed
訴訟の結果 **Outcome of the case**	✔ 勝訴 Plaintiff Wins	✔ 勝訴 Plaintiff Wins	✔ 勝訴 Plaintiff Wins	✔ 勝訴 Plaintiff Wins

模擬事例　Mock Case

従来技術　Conventional Art

【図３】FIG.3

【図３】FIG.3

課題：

金属製外殻部材に用いられる金属材料によっては，接着剤のみでFRP製外殻部材を金属製外殻部材に接合すると十分な接合強度が得られず，ゴルフクラブヘッドとしての耐久性を確保することが困難であった。（【0003】）

目的：

中空ゴルフクラブヘッドにおいて，金属製外殻部材に用いられる金属材料によらず，金属製外殻部材とFRP製外殻部材との接合強度を高めることを可能にする。（【0004】）

Problem:

Depending on the metallic material used for the metallic outer shell member, there was difficulty in achieving sufficient bonding strength, thus it was not possible to ensure durability as a golf club head, when only adhesive material alone was used to bond the FRP outer shell member to the metallic outer shell member. (See [0003])

Objective:

To provide a hollow golf club head capable of enhancing the bonding strength of a metallic outer shell member and an FRP outer shell member, regardless of the kind of the metallic material used in the metallic outer shell member. (See [0004])

模擬事例　Mock Case
特許請求の範囲　Claim

A 中空構造を有し，金属製外殻部材と繊維強化プラスチック（FRP）製外殻部材をそれぞれの接合部で互いに結合することによって形成されるヘッド本体を有する中空ゴルフクラブヘッドであって，

B 複数の貫通穴が前記金属製外殻部材の接合部に設けられ，

C 前記複数の貫通穴を通されて前記金属製外殻部材の内面と外面を交互に通り，その形状が維持されたFRP製糸部材を，接着剤と共に，前記金属製外殻部材と前記FRP製外殻部材との間に介在させることによって，

D 前記金属製外殻部材の接合部が，前記FRP製外殻部材の接合部に接着されており，

E 前記FRP製外殻部材及び前記FRP製糸部材のマトリックスは，エポキシ樹脂を含有する

F ことを特徴とする中空ゴルフクラブヘッド。

F A hollow golf club head, comprising

A a head body having a hollow structure and formed by coupling together a metallic outer shell member and a fiber reinforced plastic (FRP) outer shell member at their respective bonding portions, wherein;

B a plurality of through-holes are provided in the bonding portion of the metallic outer shell member;

D the bonding portion of the metallic outer shell member is bonded to the bonding portion of the FRP outer shell member

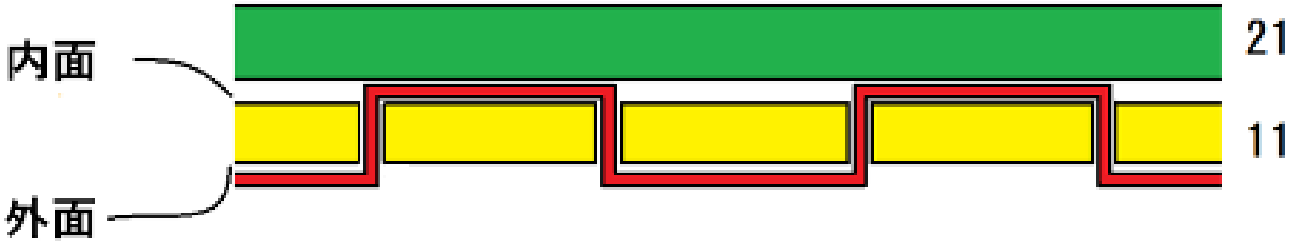
C by interposing an FRP thread member along with adhesive material between the metallic outer shell member and the FRP outer shell member, the FRP thread member maintaining a shape of passing through the plurality of the through-holes and running alternately on inner and outer surfaces of the metallic outer shell member; and

E each matrix of the FRP outer shell member and the FRP thread member contains epoxy resin.

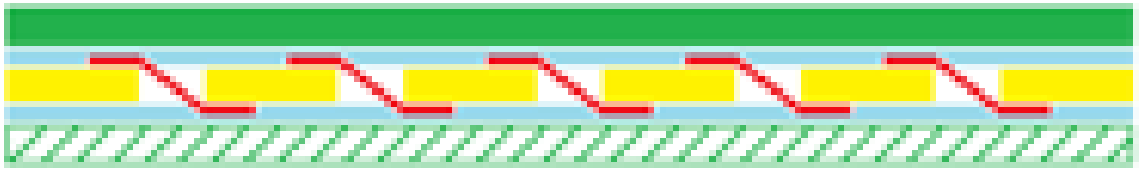
模擬事例　Mock Case
被告製品　Defendant's Product

明細書の実施例　Embodiment in the Specification

【図２】FIG.2



被告製品　Defendant’s Product



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模擬事例　Mock Case
被告製品　Defendant's Product

明細書の実施例　Embodiment in the Specification

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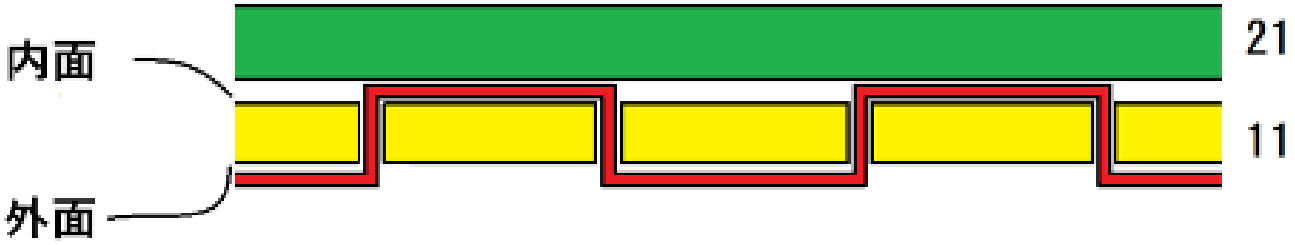
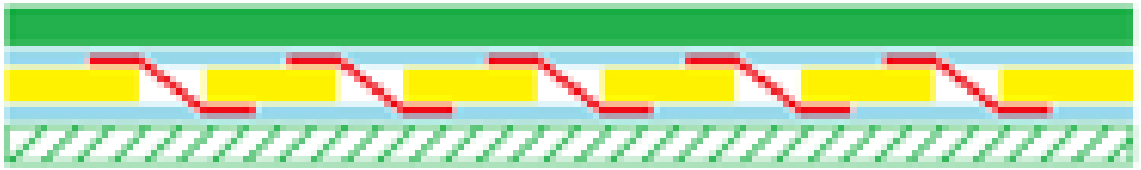


被告製品　Defendant’s Product



日本　JAPAN

均等の5要件　5 Requirements of DOE

第１要件　本質的部分

第２要件　置換可能性

第３要件　置換容易性

第４要件　公知技術の除外

第５要件　意識的除外

Requirement #1

Replacement not being an essential part

Requirement #2

The purpose of the invention achieved, an identical function and effect obtained

Requirement #3

Would be easily come up with by a PSA at the time of the production of the accused product

Requirement #4

Not identical to a prior art nor easily conceived of by a PSA at the time of the patent application

Requirement #5

Not excluded intentionally from the scope of the claim in the patent application process

ドイツ　Germany

均等の要件　Requirements of DOE

１　同一の効果	1 Same effect
２　自明性	2 Obviousness
３　技術的思想に基づく解決手段の同等性 当業者が変更手段を想到する際の考慮が，特許クレームが保護する技術的思想の実質的意味をなお志向したもので，それゆえに，当該変更手段が技術的効果の達成のための同等に有効な方法であると認識できるかどうか。	3 Orientation to the claim Are the considerations to be made by the skilled person in order to arrive at the deviating means still oriented to the essential meaning of the technical teaching protected by the patent claim, so that the deviating means can be recognized as an equally valid way of achieving the technical effect?

模擬事例　Mock Case
明細書の開示 Specification

明細書の記載

【００１５】

なお，金属製外殻部材１１の接合部１１a及びFRP製外殻部材２１の接合部２１aの大きさ，形状等に応じて，金属製外殻部材１１とFRP製外殻部材２１の接合強度をより高めるために，金属製外殻部材１１に複数本の糸部材２２を配して接着させてもよい。

Specification

[0015]Depending on the size, shape or other factors of the bonding portion 11a of the metallic outer shell member 11 and the bonding portion 21a of the FRP outer shell member 21, a plurality of thread members 22 may be arranged on the metallic outer shell member 11 for bonding so as to further enhance the bonding strength of the metallic outer shell member 11 and the FRP outer shell member 21.

被告の主張

「複数本の糸部材を配して接着」する構成を認識しながら，敢えて，「前記複数の貫通穴を通されて前記金属製外殻部材の内面と外面を交互に通」る構成に限定

The argument of the defendant

The applicant limits the structure to the structure of “having a thread member pass through the plurality of the through-holes and run alternately on inner and outer surfaces of the metallic outer shell member”, while recognizing the structure that “a plurality of thread members may be arranged for bonding”

イギリス　United Kingdom

均等の要件　Requirements of DOE

Actavis質問

第１質問　（はい）

実質的に同じ結果を，実質的に同じ方法で達成するか。

第２質問　（はい）

優先日の当業者における自明性

第３質問　（いいえ）

特許権者がクレームの文理的な意味に厳格に従うことを発明の必須な要件とする意図であったと結論付けるか。

Actavis Questions

1st Question　"yes"

Substantially the same result in substantially the same way

2nd Question　"yes"

Obviousness to the PSA at the priority date

3rd Question　"no"

Would such a reader have concluded that the patentee intended strict compliance with the literal meaning of the relevant claim(s) was an essential requirement of the invention?

アメリカ　United States

均等の要件　Requirements of DOE

対象製品等が特許発明の各クレームと同一又は均等な要素を含むかを，次のようなテストを用いて検討する。

A. FWRテスト

　機能・方法・結果の同一性

B. 非本質的差異のテスト

　差異部分が非本質的か

C. 置換容易性

Essential inquiry:

　Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?

A. Function, way, result test

B. Insubstantial differences test

C. Known Interchangeability

アメリカ　United States

抗弁等　Defenses or Bars

- ●先行技術の抗弁
- ●公衆への提供
- ●出願経過禁反言
- ●Vitiation（無効化）の法理

- ●Prior Art Defense
- ●Dedication to the Public
- ●Prosecution History Estoppel
- ●Claim Vitiation Doctrine

模擬事例　Mock Case
出願経過　Prosecution History

拒絶理由通知：明確性要件違反

補正

　前記複数の貫通穴を通されて前記金属製外殻部材の内面と外面を交互に通り，その形状が維持されたFRP製糸部材

Reason for refusal: Lack of clarity

Amendment

... an FRP thread member maintaining a shape of passing through the plurality of the through-holes and running alternately on inner and outer surfaces of the metallic outer shell member; and

被告の主張

「複数の貫通穴を通され」る態様のうち、「金属製外殻部材の内面と外面を交互に通」る構成に限定

The argument of the defendant

The structure of “having a thread member pass through the plurality of the through-holes” is limited to the structure of “running alternately on inner and outer surfaces of the metallic outer shell member”

模擬事例　Mock Case
明細書の開示 Specification

明細書の記載

【００１５】

なお，金属製外殻部材１１の接合部１１a及びFRP製外殻部材２１の接合部２１aの大きさ，形状等に応じて，金属製外殻部材１１とFRP製外殻部材２１の接合強度をより高めるために，金属製外殻部材１１に複数本の糸部材２２を配して接着させてもよい。

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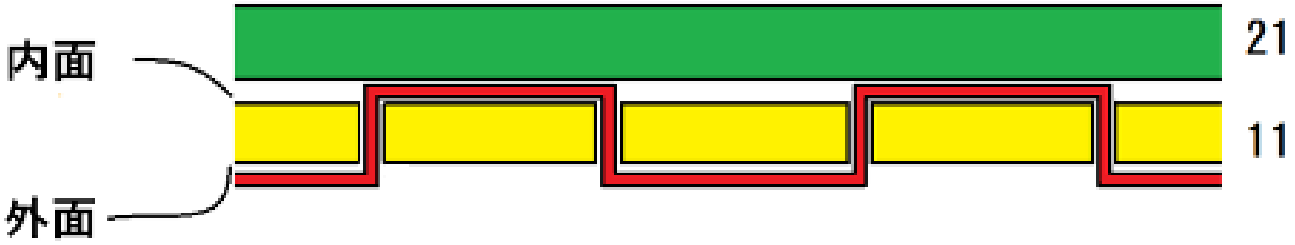
The argument of the defendant

The applicant limits the structure to the structure of “having a thread member pass through the plurality of the through-holes and run alternately on inner and outer surfaces of the metallic outer shell member”, while recognizing the structure that “a plurality of thread members may be arranged for bonding”

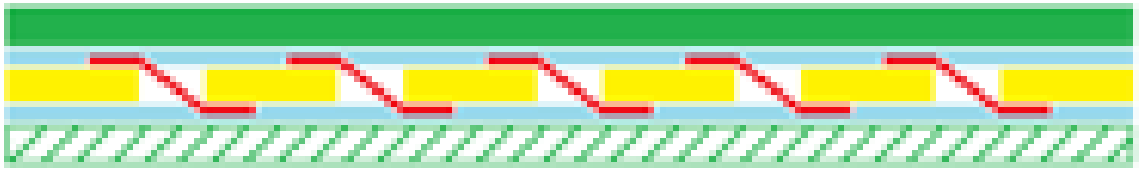
模擬事例　Mock Case
被告製品　Defendant's Product

明細書の実施例　Embodiment in the Specification

【図２】FIG.2



被告製品　Defendant’s Product



仮想事例　Hypothetical Case

出願経過　Prosecution History

拒絶理由：

　明確性要件違反→新規性欠如

補正：

　被告製品の構成を除外

Reason for refusal:

　Lack of clarity→Lack of novelty

Amendment:

　Excludes Defendant's Product

Q　新規性ないし進歩性欠如を理由とする拒絶理由通知に対して，被告製品を除外する補正がされたとしたら，被告による侵害を認める結論になるか？

Q.　If the amendment excluded Defendant's Product in accordance with the officer's finding that the original claim lacks novelty, would you conclude that the Defendant's Product infringes the patent?

仮想事例　Hypothetical Case

明細書の開示　Specification

被告製品　Defendant's Product

Q　模擬事例において，明細書に次の図面のような構成が開示されている場合，被告による侵害を認める結論になるか？

Q. If the specification in the Mock Case includes an embodiment drawn below, would you conclude that the Defendant's Product infringes the patent?

仮想事例　Hypothetical Case

「同一の」作用効果　“Same” effect or result

Q　模擬事例において，

１　被告製品における接合強度が，本件発明における接合強度より相当に低い場合

２　被告製品における接合強度が，本件発明における接合強度よりも低いものの，本件発明の従来技術よりも相当に高い場合

Q. How would you conclude

1 if the bonding strength of the Defendant’s Product is much weaker than that of the Invention

2 if the bonding strength of the Defendant’s Product is weaker than that of the Invention, but much stronger than the bonding strength of a golf club described in Background Art([0003])