

# Doctrine of Equivalents

- Intellectual Property High Court
- Grand Panel Judgement
- March 25<sup>th</sup> ,2016 (2015(Ne)10014)
- AIPLA Meeting
  - April 20<sup>th</sup>,2016
  - Chief Judge , IP High Court
  - Ryuichi Shitara

2015(Ne)10014 , Intellectual Property High Court  
 [First instance:2013(Wa)4040,Tokyo District Court]

● The Corrected Invention (Claim 13) in case of preparing maxacalcitol

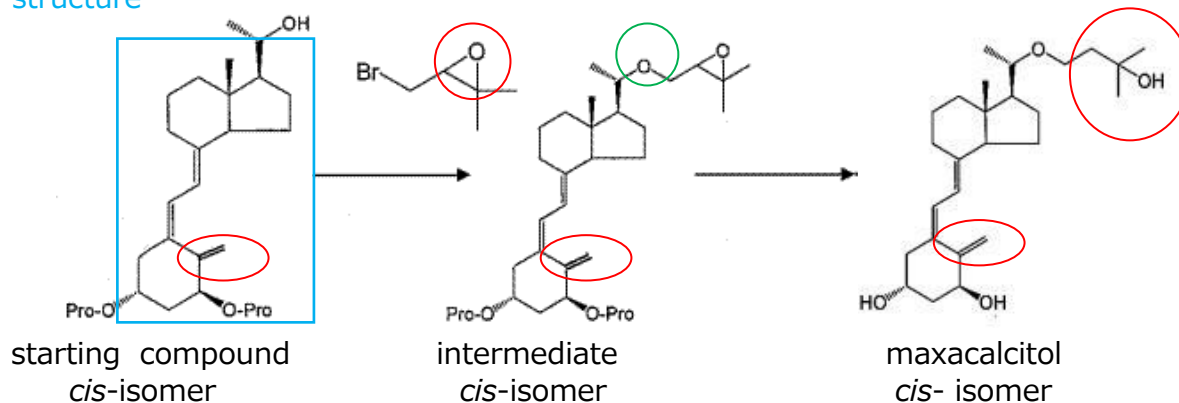
※Pro = protecting group

vitamin D  
 structure

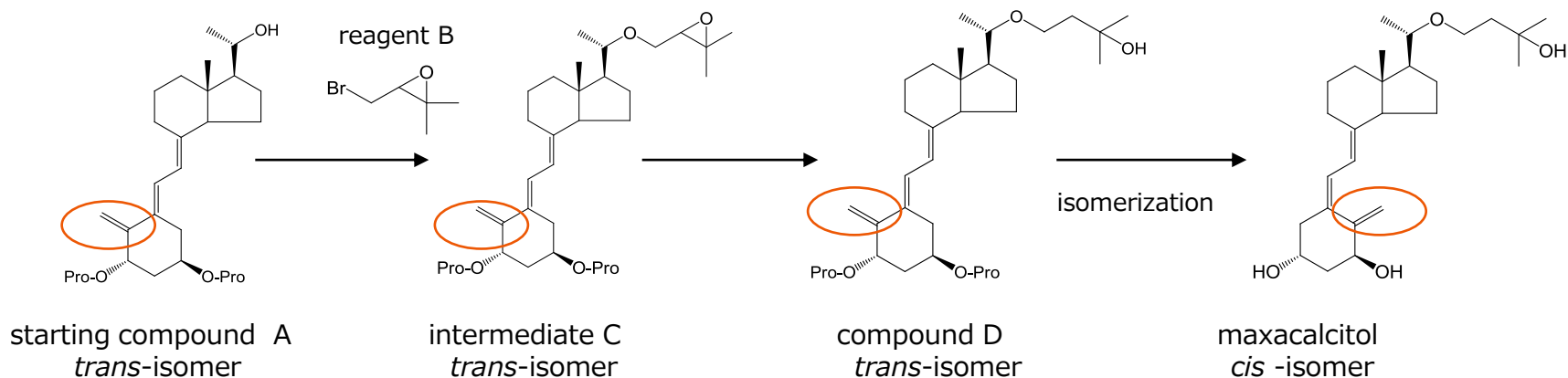
epoxy group

ether bond

opening of epoxy ring



● The Appellants' Method



# Supreme Court Judgment ( Feb. 24<sup>th</sup>, 1998. ” *Ball Spline case*” )

- Even if there is a part in elements of a patent claim, which is literally different from the accused products or process (“products”),
- ① if this part is not **the essential part** of the patented invention ;
- ② if the purpose of the patented invention can be achieved and identical function and effect can be obtained by replacing this part with a part in the accused products;
- ③ if a person ordinarily skilled in the art could easily come up with the idea of such replacement at the time of the production of the accused products;
- ④ if the products are not identical to the technology in the public domain at the time of the application of the patented invention or could not be easily conceived by this person at that time;
- ⑤ if there were **no special circumstances** such as the fact that those products had been intentionally excluded from the scope of the patent claim in the patent application process;
- such products should be regarded as **equivalent** with the elements of the patent claim and fall within the scope of the technological scope of the patented invention.

# Grand Panel Judgment (*Maxacalcitol* case)

- Conclusion ;The accused process is equivalent to the patented invention. Approved the injunction order by the Tokyo District Court
- Decided;
- 1. **The burden of proof** of the Five Equivalent Requirements.
- 2. First Requirement;
- **What is the “essential part”** of the patented invention, and **how should it be decided?**
- 3. Fifth Requirement;
- **Apart from prosecution history estoppels**, what could be considered as “special circumstances”?

# Grand Panel Judgment

## 1. Burden of proof of Equivalent Requirements

- **First to Third** Equivalent Requirements; **the patentee**
  
- **Fourth and Fifth** Equivalent Requirements; **the accused person**

# Grand Panel Judgment

## 2. The essential part of the patented invention (“First Requirement”)

- “The essential part” of the patented invention should be the distinctive part of a patent claim, which constitutes the innovative and unique technical idea of the patented invention.
- The said essential part should be decided by understanding the problem solution method and effects of the patented invention based on description of specification and patent claims.

# Grand Panel Judgment

## 2. The essential part of the patented invention (“First Requirement”)

- Since **substantial value of a patented invention** shall be decided by the degree of its **contribution to technology development**,
- **the “essential part”** of a patented invention should be decided by comparing with the **prior art described in a specification** (or other documents in some cases), and,
- i) if **the degree of contribution** of a patented invention is evaluated to **be large, meanings of a part of elements** described in a patent claim shall be recognized as a **superordinate concept**,
- ii) **if not**, meanings of elements described in patent claims shall be recognized approximately **the same as the description of a patent claim** (almost no DOE).

# Grand Panel Judgment

## 2. The essential part of the patented invention (“First Requirement”)

- When determining whether the elements different from the accused products is a non-essential part of a patent claim or not,
- a person should **not classify each elements of a patent claim into essential elements and non-essential elements** and decide that there are no equivalents to such essential elements,
- but should **determine whether the accused products have the essential part of the patented invention** or not.



# Grand Panel Judgment

## 2. The essential part of the patented invention in this Case(“First Requirement”)

- Maxacalcitol has become possible to be produced industrially only with the patented invention.
- The patented Invention makes it possible to produce Maxacalcitol by a brand new process which is not found in the prior art, therefore, the degree of the contribution of the patented invention is evaluated to be large. ...
- The essential part of the patented invention is the following new process;
- ①By reacting 20-position alcohol compound of Vitamin D structure and epoxy hydrocarbon compound, side chain with epoxy group can be attached to Vitamin D structure, and the intermediate epoxy compound obtained through such one process,
- ②Processing the intermediate compound to open the epoxy group of such side chain, to get Maxacalcitol.

## Grand Panel Judgment

2.The essential part of the patented invention(“First Requirement”)

- The accused process has the essential part of the patented invention.
- Cis*-form or *trans*-form of Vitamin D structure is not the essential part of the patented invention.

# “*Ball Spline Case*” (Supreme Court Judgment)

## 3. Special Circumstances

### (“Fifth Requirement”=“Estoppel”)

- “if the patent holder **had once acknowledged** some technology **not to belong to** the technical scope of the patent claim,  
or in relation to which he/she **had behaved as if** he/she had **objectively acknowledged so**,  
e.g., **by intentionally excluding such technology from the scope** of patent claim in the patent application process,  
the patent holder is not entitled to claim otherwise afterwards,  
since this is against the **doctrine of estoppel**.
- Therefore, when there is **such special circumstances**, equivalent will be denied.”

# Grand Panel Judgment

## 3.Special Circumstances • • A)

(“Fifth Requirement”=“Estoppel”)

- A) Even if **equivalents** (a construction outside the literal meaning of a claim but is equivalent to an element of the claim) could be easily conceived of by a person ordinarily skilled in the art at the time of application, and the applicant did not draft the scope of the patent claim to include such another construction, it shall not be enough to deem “**special circumstances**” required in the Fifth Requirement.

# Grand Panel Judgment

## 3.Special Circumstances; Reasons of A)

- An applicant must **describe an invention in the specification to disclose it** to the public and draft the scope of **patent claims** in order to **clearly specify the scope of the exclusive right**. Therefore the scope of patent **claims should not be too broad, and should be supported by** the specification.
- However, under the **first-to-file system**, an applicant has to prepare the scope of patent claims and the specifications in **a limited time**, therefore, it may **be too strict**, in some cases, to **require applicants** to prepare the scope of patent claims to **include any and all foreseeable future infringing products** and the specifications which supports such claims.
- In opposition, **a third party**, who **touches** the disclosure of invention by **the specifications** of the patent application, may often **easily come up with ideas of such equivalents**, which have the essential parts of the patented invention and at the same time which is not literally included in the scope of patented claims.

# Grand Panel Judgment

## 3.Special Circumstances; Reasons of A)

- If the accused products, a part of which is substituted by alternatives in the non-essential elements of patented invention, **might easily escape** from the exercise of right by a patent holder, such result would be against the **purpose of the Patent Law**, i.e. **encouragement of inventions by promoting their protection so as to contribute to the development of industry.**

# Grand Panel Judgment

## 3.Special Circumstances • • B)

(“Fifth Requirement”=“Estoppel”)

- B) If the applicant had objectively/apparently behaved as if he/she had **acknowledged some other construction outside the literal scope of the patent claim to be an alternative to an element of the patent claim,**
- **e.g.,** when an applicant **describes the invention with such other construction in the specification,** or
- when the applicant **describes invention with such other construction in a research paper, etc.** which was **published around the time of the application,**
- then it is **deemed to constitute “special circumstances”** required in Fifth Requirement that the applicant did not draft the scope of patent claims to include such other construction.

# Grand Panel Judgment

## 3.Special Circumstances

(“Fifth Requirement”=“Estoppel”)

- In this case **Court denied the existence of special circumstances**, because there is no description in the specification (or in other research papers) of such invention with *trans*-form Vitamin D structure as an alternative starting compound for the patented invention.



- Thank you for listening!