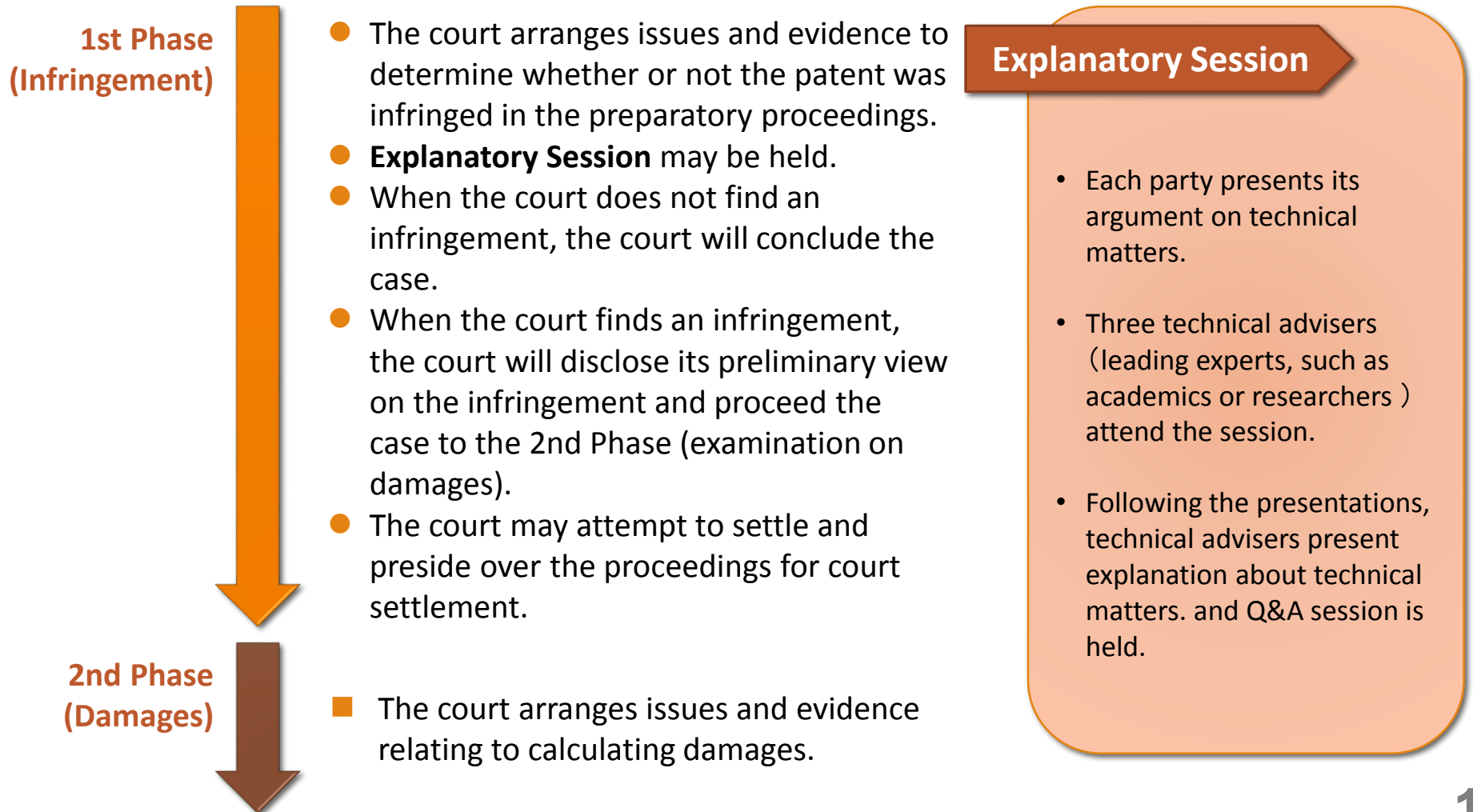


# Proceedings of Patent Infringement Suit (Two-Phase Proceedings System)



# Fulfillment of the Technical Scope of Invention

- Rules for claim construction

- *“The technical scope of a patented invention shall be determined based upon the statements in the scope of claims attached to the application.” (Patent Act § 70 I )*
- *“[T]he meaning of each term used in the scope of claims shall be interpreted in consideration of the statements in the description and drawings attached to the application.” (Patent Act § 70 II)*
- File Wrapper Estoppel or Prosecution History Estoppel may be considered.

- Basic steps for determination of literal infringement

- (1) The claim is divided into technical elements (constituent features) .
- (2) The features of the alleged infringing product/method are also divided as well.
- (3) Each constituent feature of the patented invention is compared with the corresponding feature of the alleged infringing product/method.

- Doctrine of Equivalents (DOE) (Supreme Court, Feb. 24th,1998, “Ball spline bearing” case)

## OVERVIEW OF THE JAPANESE LEGAL SYSTEM

# Comparison between Invention and D method

- The Patented Invention is divided into 6 technical elements (constituent features), and each feature is compared with the corresponding feature of D method as follows.

Patented Invention		D method	
A	Control method for <b><u>car navigation system</u></b> that displays a map on a display screen, the method comprising steps of:	a	A control method for <b><u>car navigation system comprising a server and a terminal</u></b> that displays a map on a screen of D terminal, which includes:
B	reading, from <b><u>first memory means</u></b> in which facility data comprising display data indicative of a plurality of service facilities and coordinate data indicative of existing positions of the service facilities have previously been stored, the display data to display the plurality of service facilities on the display screen;	b	holding D spot data including D name data indicative of a plurality of spots and D play the plurality of spots corresponding to the D name data on the screen; position data indicative of existing positions of the spots in <b><u>D server</u></b> of the car navigation system in order to display the plurality of spots corresponding to the designated the D name data on the screen;
C	designating one of the plurality of service facilities displayed on the display screen in accordance with an operation;	c	receiving an instruction to register one of the plurality of spots displayed on the screen as a "memo position";

# Comparison between Invention and D method

Patented Invention		D method	
D	reading coordinate data corresponding to the designated one service facility from the <u>first memory means</u> ;	d	obtaining D position data corresponding to the designated spot from <u>D server</u> to be registered according to the instruction;
E	storing the read coordinate data as user registered data in <u>second memory means</u> ;	e	storing the D position data as D memo data in <u>D server</u> ;
F	displaying a position indicated by the coordinate data read from the <u>second memory means</u> by superimposing a predetermined pattern on to the map when the map is displayed on the display screen.	f	superimposing an icon on the map indicated by the D position data of D memo data read from <u>D server</u> when the map is displayed on the screen.

## Proceedings of the 2nd Date for Oral Argument

### **Procedures Conducted on This Date**

#### **Statement of the Outcome of the Preparatory Proceedings**

= The court and the parties confirm the issues in dispute.

#### **Explanatory Session**

= Each party presents its argument on technical matters.

# SCENE1: The Second Date for Oral Argument

## Statement of the Outcome of the Preparatory Proceedings

- **The court and both parties:**

- No dispute regarding the description of D method.

- **Issues in dispute**

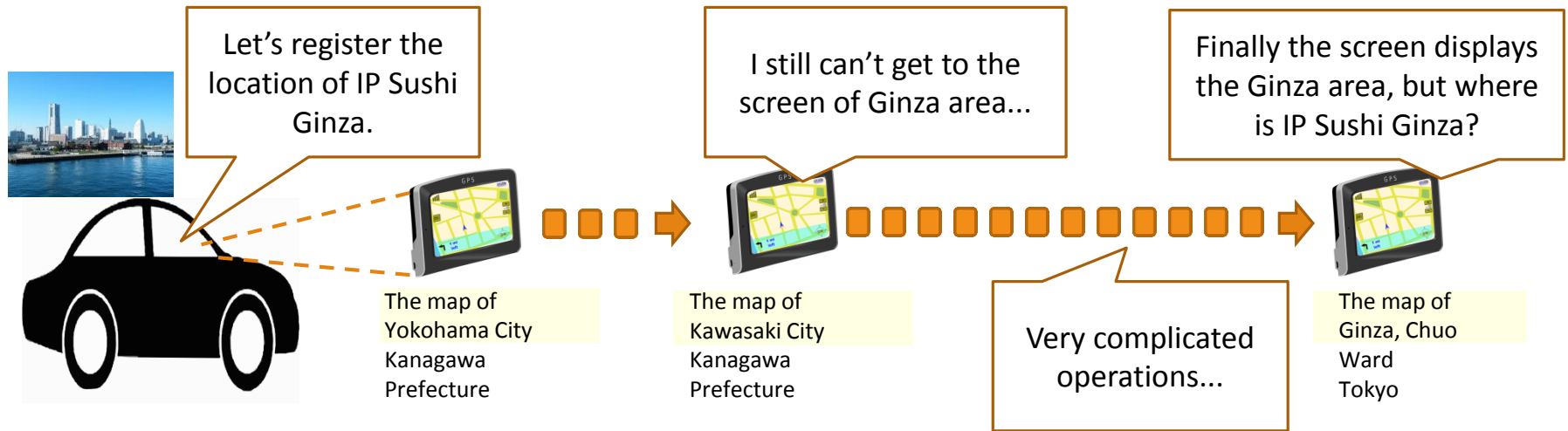
1. Whether or not the system of D method satisfies “car navigation system”
2. Whether or not D server satisfies “first memory means”
3. Whether or not D method comprises “second memory means”

- **Plaintiff:** No allegation of infringement under DOE

- **Defendant :** No allegation of the defense of patent invalidity

# 1. Technical Significance of the Invention (Plaintiff's Allegations)

**Conventional Art [0003][0004]**: the user needs to display a position to be registered on the map, therefore the user needs to accurately know a location of the position previously, and complicated operations are needed for displaying the location on the screen.



**Objective of the Invention (the Problem to be Solved) [0005]**: To provide a car navigation system control method which allows the user to register a user registration without performing complicated operations for displaying service facilities on the map.

# 1. Technical Significance of the Invention (Plaintiff's Allegations)

## Mode of Operation of the Invention [0007]:

“the display data indicative of a plurality of service facilities and the position coordinate data indicative of the existing positions of the service facilities are previously stored **in the first memory means**. By designating one of the plurality of service facilities ... by the operation, **the coordinate data corresponding to the designated one service facility is read out from the first memory means and the user position is registered into the second memory means**. ... **the coordinate data which is stored as user registered data is read out** and the position indicated on the map by the coordinate data **is superimposed onto the map by a predetermined pattern** and can be displayed on the screen.”

## Effect of the Invention [0020]:

“...**by merely designating one of the plurality of service facilities** displayed ... **in accordance with an operator input, the coordinate data corresponding to the designated one service facility is read out from the first memory means and stored in the second memory means as user registered data**. Each user, therefore, can register the user position by a simple operation, even if each user does not know accurate locations of service facilities...”

## The Example Cited in the Specification [0008]-[0018]:

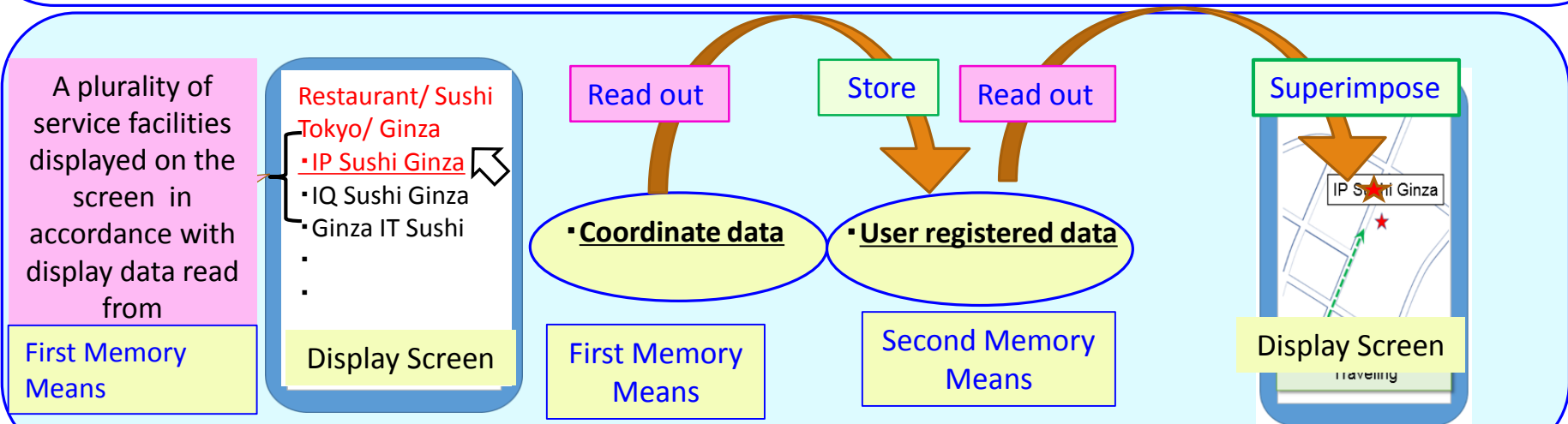
The example is merely “an embodiment” of “a preferred car navigation system” for the invention.



# 1. Technical Significance of the Invention (Plaintiff's Allegations)

## Technical significance of the invention :

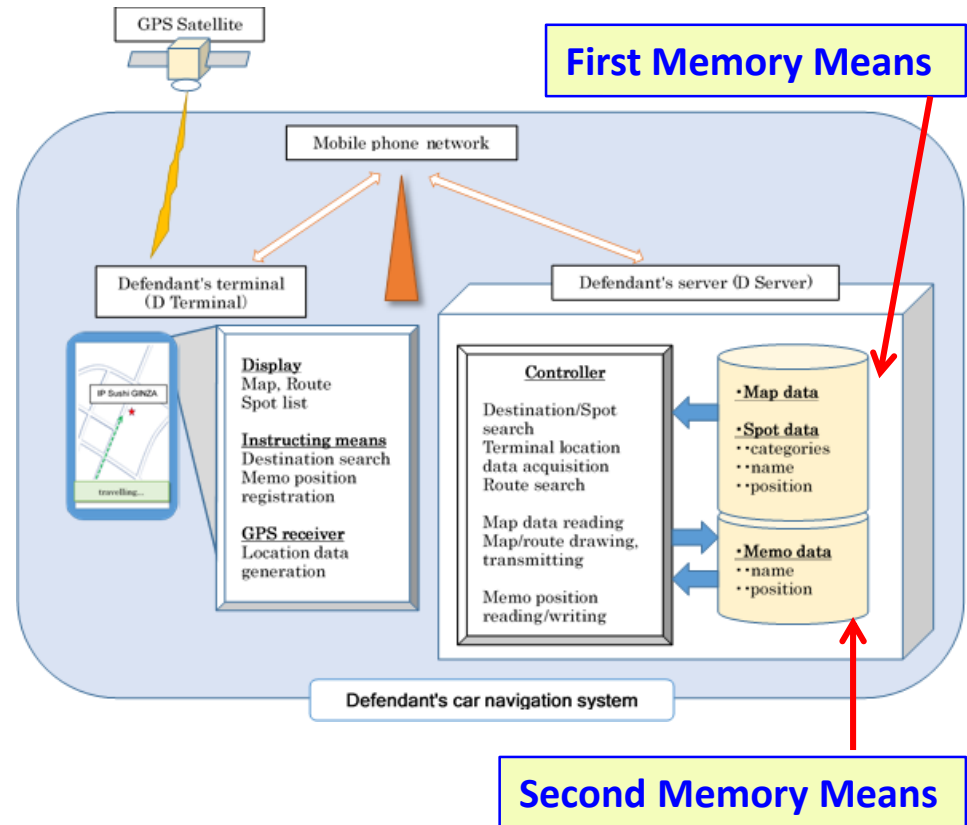
- (1)READING: Among the plurality of service facilities displayed on the display screen in accordance with display data read out from the first memory means, reading coordinate data from the first memory means corresponding to one service facility designated by the user (**Elements B, C and D**),
- (2)STORING: Storing the read coordinate data as user registered data in the second memory means (**Element E**),
- (3) SUPERIMPOSING: As the map is displayed on the display screen, reading the coordinate data from the second memory means, and superimposing a predetermined pattern (★) on to the map to display a position indicated by the coordinate data (**Element F**)



## 2. Fulfillment of Element A (Plaintiff's Allegations)

- (1) The “system” in the invention is not limited to a system where all the features are incorporated as one component. The demonstration of a system which has all the features installed in a vehicle in the specification is merely an embodiment.
- (2) D method satisfies the “car navigation system” of the invention, as D server and D terminal communicate with each other via a network so as to display data received from D server on the screen of D terminal.

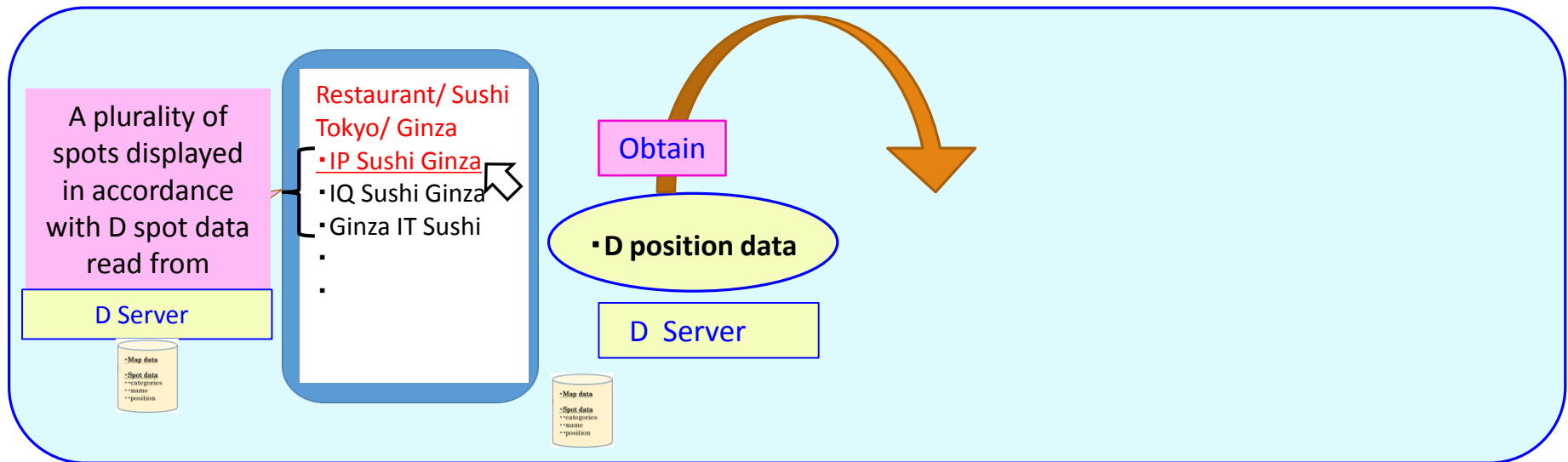
- **Prosecution history :** The Written Opinion does not limit the scope of the Invention to the navigation system installed in a vehicle. It only explains a car navigation system in comparison with a navigation system for a pedestrian (Cited Invention 1).



D method can fulfill the technical significance of the invention when D server carries each of the memory means and communicates with D terminal via a network.

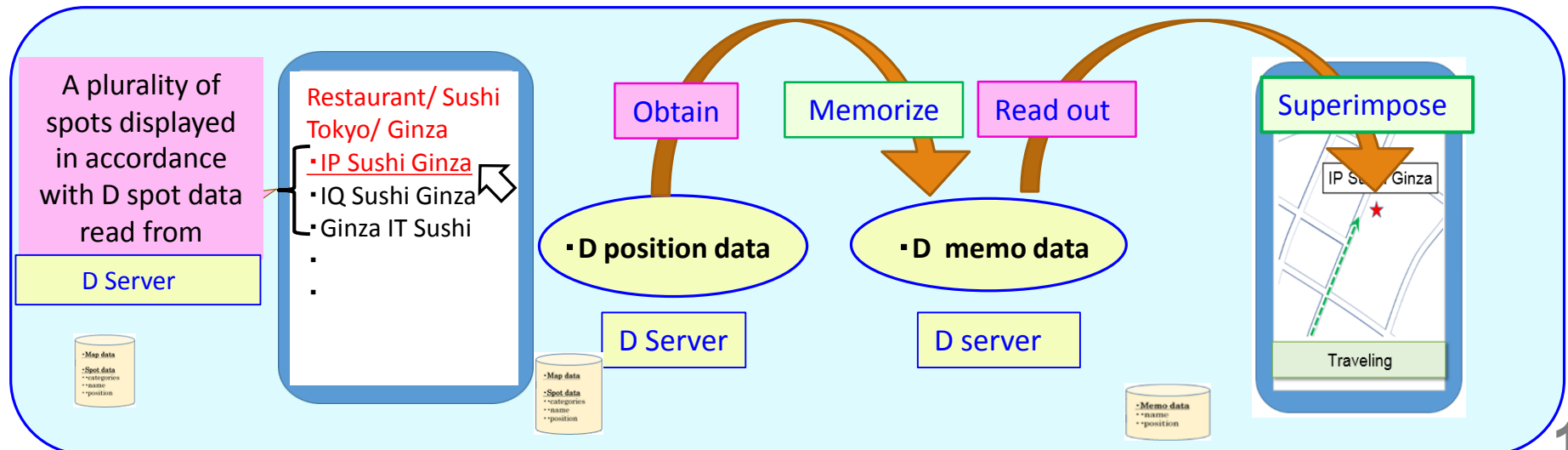
### 3. Fulfillment of Elements B and D (Plaintiff's Allegations)

- (1) "First memory means" in the invention does not specify memory medium, and is not limited to a CD-ROM in the embodiment.
- (2) In D method, 1) D server stores "D spot data (= "D name data" + "D position data") to display a list of names of spots on the screen by using "D name data", and 2) D method obtains "D position data" corresponding to the designated spot.
- (3) Therefore, D method satisfies the Elements B and D.



## 4. Fulfillment of Elements E and F (Plaintiff's Allegations)

- (1) In D method, 1) "D position data" obtained from D server are to be stored in "D server" as "D memo data", and 2) D method reads out "D memo data" from "D server" to display the position on a map indicated by the position data by superimposing an icon on the map.
- (2) "First memory means" and "second memory means" in the invention only need to be media to fulfill the respective function defined by the claim.
- (3) "D spot data" and "D memo data" are stored separately in D server, and D server fulfills both functions required in "first memory means" and "second memory means".
- (4) Therefore, D method satisfies Elements E and F.

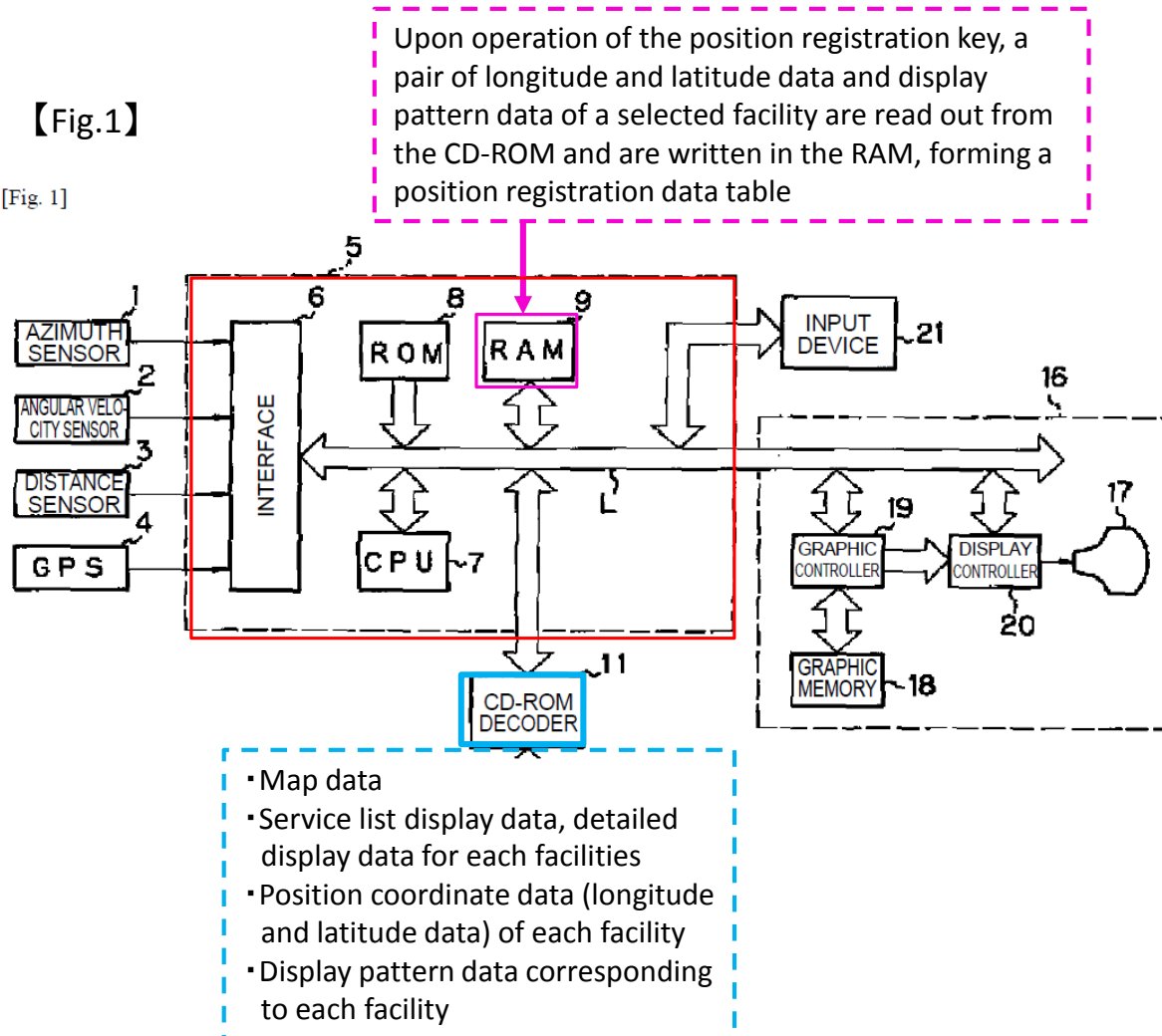


## (Defendant's Allegations)

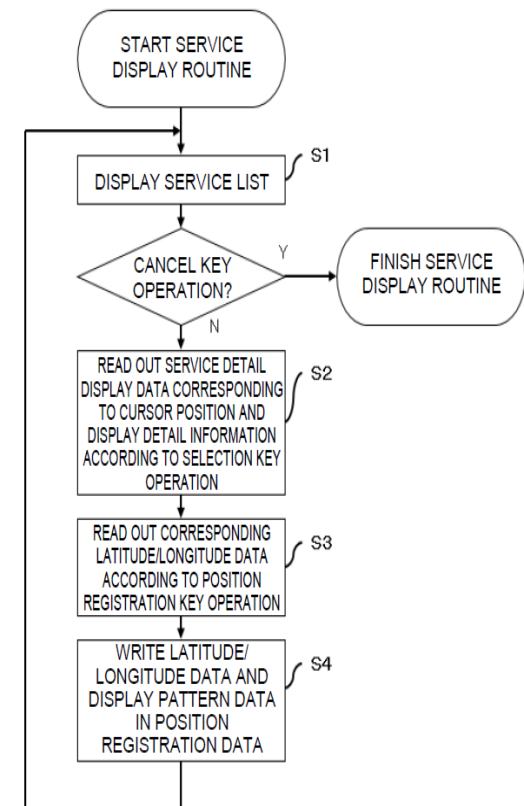
### 1. Disclosure in the Specification

【Fig.1】

[Fig. 1]

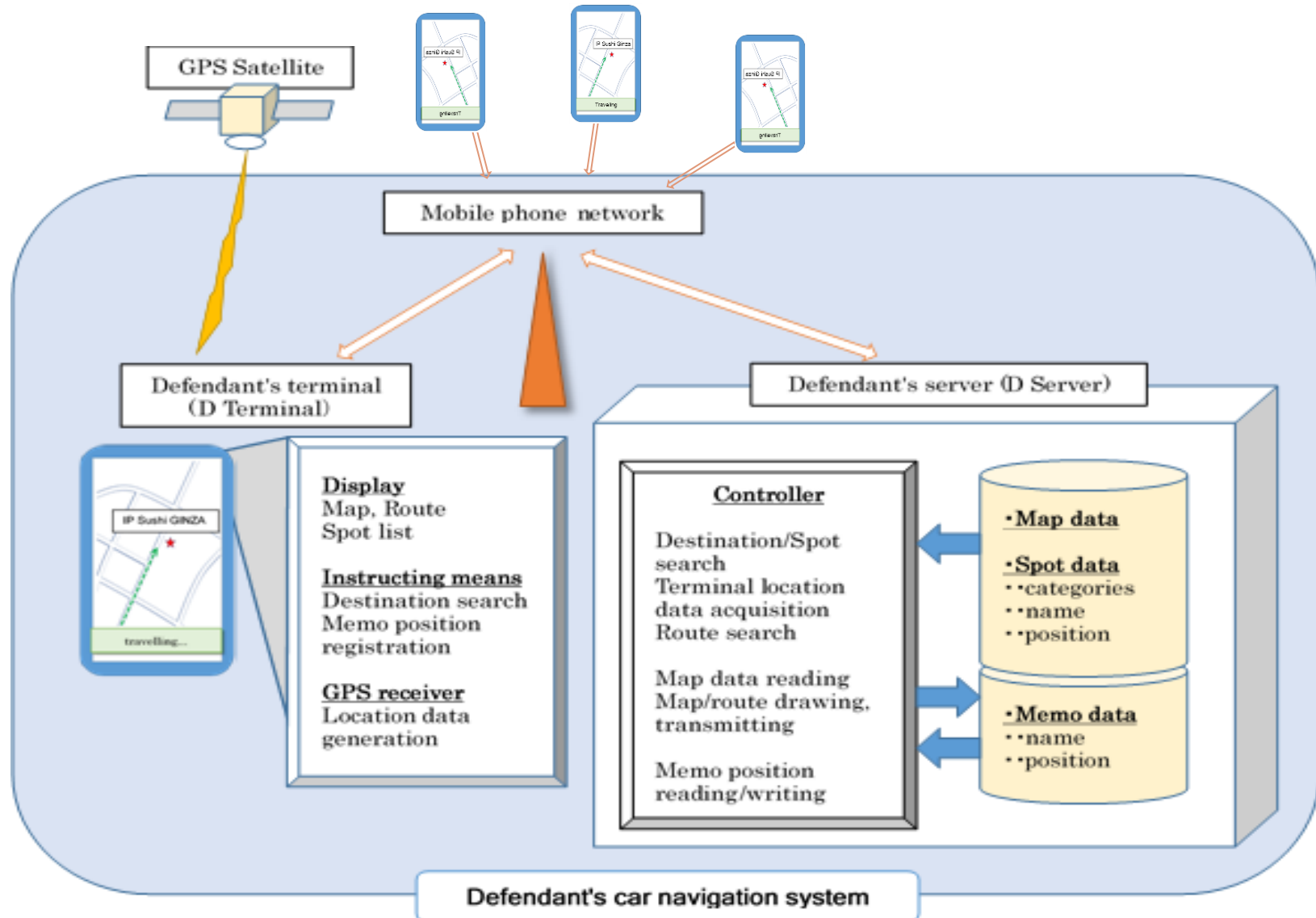


【Fig.4】



## (Defendant's Allegations)

### 2. D Method



## (Defendant's Allegations)

### 3. Claim construction

#### (1) Method for controlling car navigation system” (A)

##### • Specification

- The car navigation system is a single equipment comprising plural elements (GPS sensor, system controller, memories and the like), the elements being connected by bass lines (Fig. 1)
- Large volume data, such as map data and service facilities data, are stored in a CD-ROM [0010]
- When a user selects a facility, the position coordinate (a pair of longitude and latitude data) and the display pattern data for the selected facility are read out from CD-ROM and are written in RAM, in the position registration data table. [0015] [Fig.3]
- The CPU determines whether the location of the selected service facility is within the area currently displayed on the display, and if yes, goes on to display the display pattern (facility mark) on the map being displayed. [0017][Fig.4]

- **Opinion submitted during prosecution** : By providing the second memory means using RAM backed up by power supply from a large capacity car-battery, the registration data can be continuously stored, resulting in improved convenience for users. Such an effect can only be obtained because the navigation system is installed in a vehicle with a large capacity car-battery.

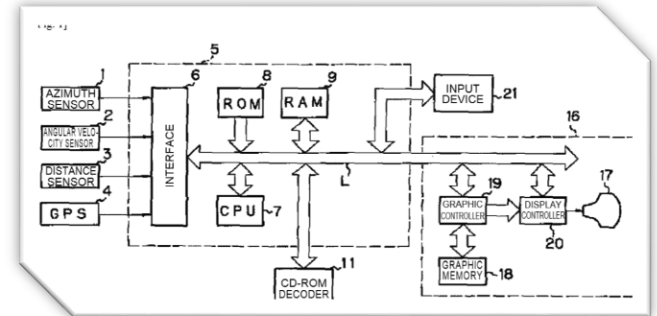
→ "Navigation System" of the Patent is a single equipment that can be installed in a car. As such, the “control method” comprises features unique to such a single appliance.

## (Defendant's Allegations)

### 3. Claim Construction

#### (2) First Memory Means (B,D)

- The claim: Description by an abstract word “memory means”
- Detailed description :
  - The only example of “first memory means” disclosed in the specification is CD-ROM connected to other elements by bass lines [Fig. 1] [0010]
  - By storing the facility data in a CD-ROM, which is an inexpensive memory medium, and by storing user position registering data in a rewritable RAM, improved convenience and cost reduction can both be achieved. [0015]
- No disclosure other than the above



➡ “first memory means” refers to a memory medium such as CD-ROM, incorporated in a single equipment.

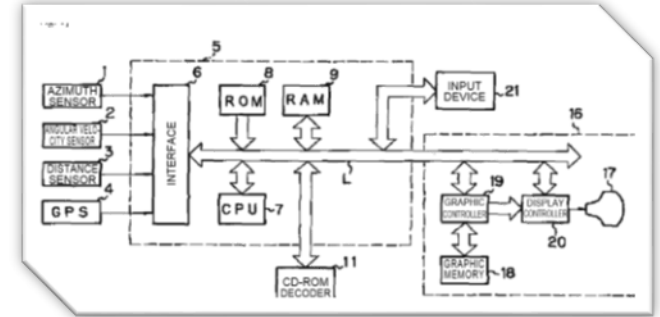


## (Defendant's Allegations)

### 3. Claim Construction

(3) “Second Memory Means”(E,F)

- Wording of the claim :
  - The claim language distinguishes two memory media, each storing different type of data.
- Detailed description in the specification :
  - All that are described are two different memory media, i.e. CD-ROM (“first memory means”) and RAM ( “second memory means” ) [0009]
  - “By storing . . . facility data in a CD-ROM, which is an inexpensive memory medium, and storing user position data in rewritable RAM, improved convenience and cost reduction can both be [0015]
  - No disclosure other than the above descriptions



➡ “second memory means” refers to a memory medium distinguished from the memory medium as “first memory means”.

(Defendant's Allegations)

## 4. Comparison

**D method is not within the scope of the claim**

**(1) “method for controlling a car navigation system” (A) ? ➡No**

- D’s car navigation system is characterized in that the data is transmitted by wireless network transmission between the user terminal and the remote server.
- D’s system, unlike the system disclosed in the specification, is not a single equipment which can be installed in a vehicle. As such, D method differs technically from the control method of the Invention.

**(2) “first memory means” (B,D) ? ➡No**

- D server (a remote server) is not a portable storage means (such as CD-ROM) in a single equipment, which can be installed in a vehicle.

**(3) “second memory means” (E,F) ? ➡No**

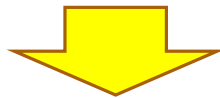
- Two distinct memory media do not exist. D memo data and D spot data are both stored in a single server.

## Q&A Session

- **Why did P submit the Written Opinion?**
- **Why does the specification disclose two separate storage media in the embodiment?**
- **What was the state of art in storage media at the time of filing?**
- **What are the differences between D system and a system with all components installed as a whole in a vehicle?**
- **What was the common general technical knowledge for the structure of a car navigation system at the time of filing?**
- **Why does the specification have not described a system that connects a terminal and a server by network?**
- **Does the D method have the effect of the Invention?**

## Final Step of the Phase for Examination on Infringement

The court discloses its preliminary view on infringement and attempts to arrange a settlement.



The court terminates the attempt of settlement, and proceeds the case to the 2<sup>nd</sup> Phase (examination on damages).