

# Doctrine of Equivalents in Japan

(2017.4.26 AIPLA)



Presiding Judge

IP High Court of Japan

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## Overview

1. Supreme Court Judgment (Feb. 24th, 1998. “Ball spline bearing” case)
2. Maxacalcitol case
3. Intellectual Property High Court Grand Panel Judgment (Mar. 25<sup>th</sup>, 2016. “Maxacalcitol” Grand Panel case)
4. Supreme Court Judgment (Mar. 24th, 2017. “Maxacalcitol” case)



1. Supreme Court Judgment (Feb. 24th, 1998. “Ball spline bearing” case)



## Ball spline bearing case

Even if there is a part in elements of a patent claim, which is literally different from the accused products or processes (“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 an identical function and effect can be obtained by replacing this part with a part in the products;



## Ball spline bearing case

- 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 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;



## Ball spline bearing case

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.



## 2. Maxacalcitol case



## outline

- The appellee (plaintiff in the first instance) holds the patent right in question for an invention of manufacturing process of compound containing maxacalcitol.
- Appellants (defendants in the first instance) has imported and sold the maxacalcitol preparations.



## The Corrected Invention (Claim 13)

A process for manufacturing a compound

starting material (**cis-form** vitamin D structures)



reagent

intermediate (**cis-form** vitamin D structures)



reducing agent

objective substance



# The Appellants' Process

## The Appellants' Process

starting material (**trans-form** vitamin D structures)

reagent

intermediate (**trans-form** vitamin D structures)

reducing agent

objective substance



### 3. Intellectual Property High Court Grand Panel Judgment (March 25th ,2016. “Maxacalcitol” Grand Panel case)

The court of first and second instance  
upheld all of the appellee's claims.



# IP High Court Grand Panel Judgment

1. The burden of proof of the Five Equivalent Requirements.
2. First Requirement; What is the “essential part” of the patented invention, and in what case will it be recognized?
3. Fifth Requirement; In light of the doctrine of estoppel, what kind of facts can serve as a reason for recognizing the special circumstances?



## 3-1 Burden of proof of Equivalent Requirements

- ▶ Equivalent Requirements ①~③  
the Patentee
- ▶ Equivalent Requirements ④~⑤  
the alleged infringer



## 3-2 The essential part of the patented invention

- “The essential part” of the patented invention should be the distinctive part of a patent claim, which constitutes the unique technical idea of the patented invention.
- The said essential part should be found by understanding the problem to be solved, means for solving the problem, and effects of the patented invention based on description of specification and patent claims.



- When determining whether the elements different from the accused products is a non-essential part of a patent claim or not,
  - it is not appropriate to divide each element of a patent claim into essential elements and nonessential elements, then consider equivalents based on such essential elements,
  - but should determine whether the accused products have the essential part of the patented invention or not.



## 3-3 Special Circumstances ("Fifth Requirement")

Even if the applicant could have been easily conceived of another structure that is outside the scope of claims as of the filing date and did not state said another structure in the scope of claims, it shall not be enough to deem "special circumstances" required in the Fifth Requirement.



If the applicant had objectively and externally recognized as if he/she had acknowledged another structure outside the literal scope of the patent claim to be an alternative to an element of the patent claim,

- when an applicant describes the invention with such another structure in the specification, or



- when the applicant describes invention with such another structure in a research paper, etc. which was published at the time of the application, the applicant's failure to state said another structure in the scope of claims is considered to fall under the "special circumstances" in the fifth requirement.



## 4. Supreme Court Judgment(Mar. 24th,2017. “Maxacalcitol” case)

“The final appeal is dismissed.”



## Issue: Special Circumstances ("Fifth Requirement")

If "Special Circumstances" is recognized,  
the structure of the subject products



not equivalent

the structure as described in the scope of the patent  
claims.

"Special Circumstances" such as the subject products had  
been intentionally excluded from the scope of the patent  
claims.



## Scene in question

### The Fact

The applicant, as of the filing date,  
could have easily conceived of another structure of  
subject products (=trans-form vitamin D structures)  
and  
did not state said another structure in the scope of  
claims.



## Scene in question

- (1) Whether it can be said that special circumstances exist based on this Fact alone?
- (2) If this Fact alone cannot serve as a reason, in what cases can you say there are special circumstances?



## 4-1 Whether it can be said that special circumstances exist based on this Fact alone?

The Fact cannot serve as a reason for recognizing the “special circumstances” .



## (reason)

- This Fact alone did not generate trust that Subject products were excluded from the scope of the claims for third party to receive disclosure of the specification pertaining to the patent application.
- If it is not at all permitted to allege that the Subject products are within the technical scope of the patent invention only because the applicant did not state another structure in the scope of claims which have been easily conceived of, that is not reasonable.



- The applicant is required to prepare the scope of claims that contains all the expected infringing embodiments under the first-to-file system.
- Third party can easily evade exercise of rights of patent holder because he can prepare without such time constraint.



## 4-2 In what cases can you say there are special circumstances?

In that case, if the applicant is objectively and externally recognized as having recognized another structure of Subject products replaces the structure as described in the scope of the patent claims

and

indicated the applicant deliberately had not described another structure in the scope of the patent claims,

it can serve as a reason for recognizing the special circumstances.



e.g. The applicant stated in the specification etc. that it could replace the structure as described in the scope of the patent claims with the structure of Subject products.



## (reason)

- Third party who receives disclosure of the specification acknowledged the Subject products were excluded from the scope of the patent claim based on such description.
- It conduces to the purpose of the Patent Act and also adjusts interests appropriately between the applicant and the third party.



# Thank you for your attention.

Presiding Judge

IP High Court of Japan



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