

A teal-colored map of Japan is positioned in the background, showing the four main islands: Hokkaido, Honshu, Shikoku, and Kyushu. The map is semi-transparent, allowing the text to be overlaid on it.

# Claim Construction and Doctrine of Equivalents in Japan

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# Outline

- I. Claim Construction
- II. Doctrine of Equivalents: The Supreme Court judgment on “Ball Spline Bearing” case (1998)
- III. 5<sup>th</sup> Requirement: The Supreme Court judgment on “Maxacalcitol” case (2017)
- IV. 1<sup>st</sup> Requirement: IP High Court Grand Panel judgment on “Maxacalcitol” case (2016)
- V. Case Study

# I Claim Construction

# 1. The reference for claim construction

1. “The technical scope of a patented invention shall be determined based upon **the statements in the scope of claims** attached to the application.” ( § 70 I )
2. “[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.” ( § 70 II )
3. **Dictionary definition**
4. **File wrapper estoppel** or **Prosecution history estoppel** (general principle of civil litigation )

# File Wrapper Estoppel

- i) When the patentee has explicitly acknowledged certain structure does not fall within the scope of claims by intentionally excluding the structure from the scope of claims;
- ii) When the patentee has made amendments to exclude certain invention in response to the notice of reasons for refusal or the decision of refusal;
- iii) When the patentee has made written remarks or oral statements to limit the scope of claims, and the patent was granted accordingly;
- iv) When the patentee is making an allegation which contradicts to the prior allegations in previous invalidation trial.

## 2. Consideration of Publicly Known Art

In the 20th Century Japan... limited the scope of claim by excluding publicly known art from the patented invention

- $A+B+C=A1+B+C$       ( $A2+B+C$ =Publicly Known Art)



After the Supreme Court judgment on “Kilby” case in 2000 and subsequent revision of the Patent Act in 2004... literally construed

- $A+B+C=A+B+C \Rightarrow$  (patent invalidation)  $\Rightarrow$  correction to restrict the scope of the claim to  $A1+B+C$ .

### 3. Technical Meaning

- A claim must be construed according to its literal meaning even when the structure of defendant's product is found to have the same function as patented invention considering the statements in the specification.
- If the defendant's product is beyond the scope of literal meaning of the claim, infringement under DOE shall be considered.

II Doctrine of Equivalents :  
Supreme Court Judgment (Feb.  
24th, 1998. “Ball spline bearing”  
case)

# Five Requirements of DOE

- Even if there is a part in elements of a patent claim, which is literally different from products and processes (“product”),
  - ① this part is **not the essential part** of the patented invention (non-essential part);
  - ② the purpose of the patented invention can be achieved by replacing this part with a part in the product and an **identical function and effect** can be obtained (interchangeability);
  - ③ a person having ordinarily skilled in the art could **easily come up with** the idea of such replacement at the time of the production of the product (conceivability of interchange);

④ the product is not identical to the technology in the **public domain** at the time of the patent application of the patented invention or could not have been easily conceived at that time by the person (public domain);

⑤ there were **no special circumstances** such as the fact that the product had been **intentionally excluded** from the scope of the patent claim in the patent application process (no special circumstances);

the product should be regarded as equivalent with the elements of the patent claim and fall within the scope of the technical scope of the patented invention.

# Burden of proof on the fulfillment of the five requirements for DOE

- Requirements ①~③  
⇒ The patentee
- Requirements ④~⑤  
⇒ The alleged infringer

JAPAN	GERMANY
1 Non-essential part	
2 Interchangeability	Same effects : the variant solves the problem underlying the invention with means that have objectively the same technical effects
3 Conceivability of the interchange	Obviousness: a person having ordinary skill in the art could easily come up with the variant having objectively the same effects
4 Public domain	(Prior art defense )
5 No special circumstances	Claim orientation: a person having ordinary skill in the art was able to find the variant by considerations oriented to the technical teaching of the claim as a variant having the same technical effects

# III 5<sup>th</sup> Requirement (Special Circumstances)

“[T]here is no special circumstances such as the fact that the product had been intentionally excluded from the scope of the patent claim in the application process”

# (The basis for this requirement)

- If the patentee had once acknowledged that the product does not belong to the technical scope of claim, or
- If he had behaved as if he had objectively acknowledged so by intentionally excluding the technology from the scope of claim in the patent application process,



the patentee is not entitled to claim otherwise afterwards

▪ against the doctrine of estoppel

# 1. Amendment and Correction

- An invention which was excluded from the scope of claims by amendment or correction to restrict the scope.
- An invention which the patentee acknowledged as not falling within the technical scope of claims in documents submitted in application process or trial process.

## 2. Equivalent materials and arts that already existed at the filing date

Competing theories:

- It cannot be considered as a special circumstance for not including into the scope of claims the structure which was easily conceived of, because it is a mere omission.

or

- It should be considered as a special circumstance because the applicant intentionally omitted the structure from the scope of claims while a person having ordinary skill in the art could have easily conceived of the structure at the time of filing, or amended the scope of claims to include the structure during the application process.

# Maxacalcitol case

## The Invention (Claim)

- starting material (cis-form vitamin D structures)
- ↓ reagent
- intermediate (cis-form vitamin D structures)
- ↓ reducing agent
- objective substance

## The Appellants' Process

- starting material (trans-form vitamin D structures)
- ↓ reagent
- intermediate (trans-form vitamin D structures)
- ↓ reducing agent
- objective substance

# Scene in question

- The applicant did not mention the structure for defendant's product in the scope of claims while the applicant could have easily conceived of such structure as of the filing date.



- (1) Can be said that special circumstances exist based on this fact alone?
- (2) If not, in what particular cases can it be said there are special circumstances?

# (1) Can it be said that special circumstances exist based on this fact alone?

- This fact alone does not infer there is a special circumstance to deny the application of DOE.

(reasons)

- A mere fact that the applicant omitted the defendant's product from the scope of claims when the applicant could have easily conceived of such structures at the time of filing does not cause third parties who receive the disclosure of the specification to believe that the defendant's product was excluded from the scope of the claims.
- If it is forbidden to allege that the defendant's product falls within the technical scope of the patent invention on the grounds of DOE only because the applicant did not state other easily conceivable structures in the scope of claims, the expected result would be inequitable.

(2) In what cases can it be said there are special circumstances?

- If the applicant is objectively and visibly determined to have indicated his intention of omitting statements concerning defendant's product from the scope of claims even though the applicant recognized such structure could substitute for the structure stated in the scope of claims, it can serve as a ground for recognizing the special circumstances.

(reasons)

- The applicant has acted in a way to cause third parties to believe that the defendant's product does not fall within the technical scope of the patented invention with the applicant's consent.
- The above ruling is reasonable for consistency with the purpose of the Patent Act, which is to encourage inventions through promoting their protection and utilization, thereby contributing to the development of industry, as well as for adequately coordinating interests between patent applicants and third parties.

### 3. Japanese Supreme Court rulings in comparison with rulings of German Federal Court of Justice

The ruling of the "Maxacalcitol" case is similar to the ruling of the "Occlusion Device" case in Germany.

- "clamping, soldering, brazing, welding" were disclosed in the description, but only "clamping" was mentioned in the claim.  
...special circumstance to indicate intentional exclusion.

There is no general consensus in Japan on a case like "Pemetrexed" case in Germany, where only a generic concept "antifolate" was written in the specification.

Competing opinions in Japan:

- There is no intentional exclusion because the patentee is not considered to have acknowledged the structures of defendant's product do not belong to the technical scope of claims.

or

- Limiting the scope of claims to Pemetrexed Disodium while writing generic concept "antifolate" in the specification implies intentional exclusion when it is obvious to the person having ordinary skill in the art that "antifolate" includes both Pemetrexed Disodium and Pemetrexed Dipotassium.

# IV 1st Requirement: “essential part” of the patented invention

- [E]ven if the structure stated in the scope of claims contains any part that is different from that of the product manufactured, etc. by the other party or the process used thereby, said part is not the essential part of the patented invention.

# V Case Study

**Issue: whether the defendant product falls within the technical scope of the claimed invention in Japan?**

- Literal infringement?
- Infringement under DOE?

# 1 Literal infringement

Question: How to interpret the “**radial blind bore**” of claim 1?

Considerations:

- A) The term “blind” in claim 1 indicates a non-through hole.
- B) A non-through hole is preferable considering the function of the adapter member disclosed in paragraph 0048.
- C) “Stepped bore” and “through-hole” are used separately .
- D) Dictionary definition.

Conclusion:

“Blind bore” of claim 1 means a non-through. **The defendant product does not constitute **literal** infringement of the claimed invention.**

## 2 Infringement under DOE

**Question:** Whether the adapter member with the “stepped bore” of defendant’s product is equivalent to the adapter member in claim 1.

### **Considerations:**

- A) The 1<sup>st</sup> through 3<sup>rd</sup> requirements appear to be fulfilled.
- B) No information for the 4<sup>th</sup> requirement.
- C) The 5<sup>th</sup> requirement is satisfied as there is no “intentional exclusion.”
  - Claim 5 and para [0036] describe the bore types for the "reception bore," not for the adapter member.
  - These descriptions do not indicate that the patentee had recognized a stepped bore as a replacement for the blind bore of the adapter member.

### **Conclusion:**

If the 4<sup>th</sup> requirements is fulfilled, DOE would be applied

**Alternative 1:** Para [0012] describes that various bore types were known in the state of the art, such as **stepped bores**, through-hole bores or **blind bores**.

**Considerations:**

A), B) are quoted from the main case.

C) Para [0012] does not mention that these bores are for the adapter member.

- **No intentional exclusion:** it is uncertain as to whether the patentee recognized a stepped bore as a replacement for the claimed invention indeed (“opinion 1”).
- **Intentional exclusion:** it is obvious for the person skilled in the art that the stepped bore is applicable to the adapter member (“opinion2”).

**Conclusion:**

If the opinion 1 is taken , DOE is **applied** so long as the 4<sup>th</sup> requirement is fulfilled. If the opinion 2 is taken, the application of DOE is **denied**.

**Alternative 2:** Para [0049] explains that various bores types are available for the adapter member, such as **stepped bores**, through-hole bores or **blind bores**.

**Considerations:**

A), B) are quoted from the main case.

C) The 5<sup>th</sup> requirement is not satisfied as it is a typical case for **intentional exclusion**.

It is objectively and visibly recognized that the patentee intentionally omitted the adapter having the stepped bore while recognizing the stepped bore as a replacement for the blind bore of the adapter member at the time of filing the patent.

**Conclusion:**

The application of DOE is **denied**.

**Alternative 3:** In the published patent application, Claim 1 claims that the adapter member has an approximately cylindrical base body in which a **radial blind bore** or a **stepped bore** is formed for insertion on a gudgeon.

**Considerations:**

A) is quoted from the main case.

B) The 5<sup>th</sup> requirement may not be satisfied.

- The description of the prior art alone does not infer the existence of "special circumstance."
- Depending on the patentee's action taken against the prior art during the patent prosecution, "intentional exclusion" may be recognized.

**Conclusion:**

DOE would not be applied for not fulfilling the 5th requirement.

**Alternative 4**: In the published patent application, the description mentions as bore types for the adapter member **stepped bores**, through-hole bores or **blind bores**.

**Considerations:**

A) Is quoted from the main case.

B) is quoted from alternative 3.

**Conclusion:**

DOE would not be applied for not fulfilling the 5th requirement.

# Summary

	Main	Alternative 1	Alternative 2	Alternative 3	Alternative 4
First Requirement	✓	✓	✓	✓	✓
Second Requirement	✓	✓	✓	✓	✓
Third Requirement	✓	✓	✓	✓	✓
Fourth Requirement	?	?	?	?	?
Fifth Requirement	✓	✓ or X	X	(X)	(X)

Thank you for your attention.



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