
Articles

The Supreme Court Decision Regarding the Requirements for the Infringement under the Doctrine of Equivalents

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Case in question

Decision of the Second Petty Bench of the Supreme Court of March 24, 2017, 2016 (Ju) 1242, Case demanding an injunction against an act of infringing on a patent right

Appellant of the final appeal: DKSH Japan K.K., Iwaki Seiyaku Co., Ltd., Takata Pharmaceutical Co., Ltd., and Pola Pharma Inc.

Appellee of the final appeal: Chugai Pharmaceutical Co., Ltd.

Development of the court proceedings

Appeal instance: Decision of the Intellectual Property High Court of March 25, 2016, 2015 (Ne) 10014

First instance: Decision of the Tokyo District Court of December 24, 2014, 2013 (Wa) 4040

1. Introduction

In the past, there have been various discussions and interpretations concerning the doctrine of equivalents in Japan. The Supreme Court rendered a decision that explicitly recognized the possibility of establishing infringement under the doctrine of equivalents and specifically indicated the requirements for doing so (Ball Spline Bearing Case Decision) on February 24, 1998, which resulted in a tentative solution. However, the five requirements for the establishment of equivalence indicated by the Supreme Court are not necessarily clear. In particular, there are conflicting theories regarding the interpretations of the first and fifth requirements, and the interpretations and applications thereof have not been necessarily unified in the lower courts.

The decision in question (the “Decision”) was rendered against such backdrop. It is a Supreme Court decision in respect of a patent infringement action concerning a process for the synthesis of vitamin D and its derivatives that can be used as a medicine. In the Decision, the court made a determination supporting the Tokyo District Court decision in the first instance, and the Intellectual Property High Court Grand Panel decision in the appeal instance, both of which found infringement under the doctrine of equivalents.

The case in question also attracts attention in the sense of having found infringement under the doctrine of equivalents for the first time in the field of medicine, an area where there have been few such cases. It also attracts tremendous interest in that the Intellectual Property High Court handled the case as a Grand Panel case, presented methods to determine the first and fifth requirements for establishing equivalence in detail as a general theory, and presented a general theory for determining the fifth requirement. That is, the case in question was not chosen to be examined at the Grand Panel of the Intellectual Property High Court and the Supreme Court in order to verify the propriety of the conclusion of the Tokyo District Court in the first instance, but rather to indicate a uniform standard for interpreting the requirements for the establishment of equivalence looking toward future practice.

Therefore, this article first briefly introduces the trends of the Supreme Court decisions on patent infringement cases in Japan, then explains the conventional trends concerning the doctrine of equivalents and the outline of the Deci-

sion, and lastly examines the effect of the Decision on future practice. Incidentally, as the Decision made a determination only concerning the fifth requirement, and as a whole did not significantly change the rule set forth in the Intellectual Property High Court Grand Panel decision in the appeal instance (hereinafter referred to as the “Grand Panel Decision”), it is considered important to examine the content of the Grand Panel Decision when considering future practice. This article also refers to the Grand Panel Decision to some extent, but for detailed commentary thereon, please also refer to the author’s article titled “*Intellectual Property High Court Grand Panel Decision Regarding the Requirements for the Establishment of Infringement under the Doctrine of Equivalents*” in the January 2017 issue of this journal.

2. Background of the Decision

2-1. Trends in Supreme Court decisions concerning patent infringement cases

As the three-court system (district court, high court, and Supreme Court) has now been adopted for civil actions in Japan,¹ the Supreme Court serves in principle as the court of last resort. Therefore, the accumulation of important past court decisions concerning patent infringement consists mainly of Supreme Court decisions. Needless to say, all courts other than the Supreme Court, including the Grand Panel² of the Intellectual Property High Court, which served as the appeal court for this case, are lower courts. It goes without saying that a Supreme Court decision overrides the lower courts if the Supreme Court makes a determination on the same issue. How-

ever, under the new Code of Civil Procedure that became effective on January 1, 1998, a violation of law or regulation that affects the conclusion has ceased to serve as a reason for filing a final appeal, and whether to accept a final appeal for such a reason is left to the Supreme Court’s discretion. Thereby, cases covering important points at issue under the Patent Act on which the Supreme Court makes a substantial determination have been dramatically restricted.

In fact, under the new Code of Civil Procedure, it is not uncommon to file a final appeal or a petition for acceptance of final appeal with the Intellectual Property High Court, which is an appeal court, but it is very rare for the Supreme Court to actually examine the appeals. Therefore, for patent cases, an appeal to the Intellectual Property High Court is actually positioned as the *de facto* final instance and, in particular, decisions rendered at the Grand Panel of the Intellectual Property High Court have exceptionally high value as precedents and have significant impact on intellectual property practice thereafter (however, as mentioned later, there are cases in which such decisions are reversed or modified by the Supreme Court).

In this regard, since the establishment of the Intellectual Property High Court on April 1, 2005, there have been only two Supreme Court decisions in which the Supreme Court made a determination concerning important points peculiar to patent infringement in response to a final appeal or a petition for acceptance of final appeal of an Intellectual Property High Court decision: (1) the decision of the First Petty Bench of the Supreme Court of November 8, 2007 concerning exhaustion theory (2006 (Ju)

826; “Canon Ink Tank Case”), and (2) the decision of the Second Petty Bench of the Supreme Court of June 5, 2015 over the interpretation of the scope of rights for product-by-process claims (Case No. 2012 (Ju) 1204; the “Pravastatin Sodium Case”). For both of these cases, the Grand Panel of the Intellectual Property High Court served as the court of appeal in the same manner as the case in question.

In the Canon Ink Tank Case, the Intellectual Property High Court Grand Panel advocated a detailed theory concerning the situations in which a defense of exhaustion may be accepted and the distribution of the burden of proof in such cases. However, because a determination modifying said theory was made in a Supreme Court decision (though the Supreme Court upheld the ultimate conclusion), the importance of said Grand Panel decision was significantly reduced.

In the Pravastatin Sodium Case, the Intellectual Property High Court Grand Panel decision attracted a lot of attention because the court advocated a new theory whereby product-by-process claims are classified as “true” product-by-process claims or “untrue” product-by-process claims based on the advisability or difficulty of identifying the product without being based on the process, and the scope of rights is interpreted differently based on this classification. However, in the Supreme Court decision of the same case, rendered on June 5, 2015, the court indicated that the advisability or difficulty of identifying the product without being based on the process should be taken into account in relation to the clarity requirement, while fundamentally being based on the product identity theory, and completely denied the theory adopted in the

aforementioned Grand Panel decision. The court, thereby, reversed the decision in the prior instance. Thus, the standard adopted in this Supreme Court decision is now the standard for patent practice, and the aforementioned Grand Panel decision has come to have almost no significance in terms of practice.

In this manner, the Supreme Court sometimes significantly modifies a determination made by the Grand Panel of the Intellectual Property High Court. However, in the Decision, the Supreme Court did not modify the relevant determination to the extent that it did in the aforementioned two cases, because said determination was originally made within the framework of the five requirements for infringement under the doctrine of equivalents that were indicated by the Supreme Court. More specifically, regarding the fifth requirement, the Supreme Court indicated a different determination standard from that in the Grand Panel Decision, though it basically takes the same stance as the Grand Panel Decision. Therefore, the rule of the Grand Panel Decision was modified by the Supreme Court to the extent it conflicts with the Supreme Court decision. On the other hand, regarding determinations concerning other requirements, in particular, the first requirement for which the Grand Panel indicated a detailed determination standard, the Supreme Court provided no new determination. Therefore, it is reasonable to surmise that the Supreme Court had no specific objection, and that the rule indicated in the Grand Panel Decision is expected to become a standard for future practice.

2-2. Infringement under the doctrine of equivalents in Japan and standards for determination

Article 70, paragraph (1) of the Patent Act provides that “*the technical scope of a patented invention must be defined based on the statements in the scope of claims attached to a patent application.*” There is no clear legal basis for the establishment of a doctrine of equivalents. Therefore, in the past some have taken the view that the doctrine of equivalents should not be recognized in any case, but it has also been a commonly accepted view that recognizing the doctrine of equivalents does not conflict with the aforementioned provisions of the Patent Act. In fact, there are many lower court decisions in which the court found infringement by recognizing the doctrine of equivalents on the premise that infringement could be established thereunder. However, a variety of determination standards were used in such cases.

Under these circumstances, in the Supreme Court decision dated February 24, 1998 (Ball Spline Bearing Case Decision), the Supreme Court explicitly recognized the doctrine of equivalents and clearly indicated determination standards therefor as follows:³

[E]ven if, within the structure stated in the scope of claims, there is a part which is different from a product manufactured, etc., or a process used by the other party (hereinafter referred to as a “competing product or process”), it is reasonable to understand that the competing product or process falls under the technical scope of the patented invention as an equivalent to the structure stated in the scope of

claims if the following requirements are fulfilled:

[i] said part is not the essential part of the patented invention;

[ii] even if said part is replaced with a part in the competing product or process, the purpose of the patented invention can be achieved and the same function and effect can be obtained;

[iii] a person ordinarily skilled in the art to which the invention pertains (a person ordinarily skilled in the art) could have easily conceived of the aforementioned replacement at the time of the manufacturing, etc., of the competing product or process;

[iv] the competing product or process is neither identical with publicly known art at the time of the filing of the patent application for the patented invention nor is one which a person ordinarily skilled in the art could have easily presumptively conceived of at the time of said filing based on such publicly known art; and

[v] there are no particular circumstances, such as a circumstance where the competing product or process falls under those that were intentionally excluded from the scope of claims in the course of filing a patent application for the patented invention.

As the Supreme Court of Japan often shows a negative attitude toward adopting a theory that is not explicitly grounded in law, it was also very innovative in that sense that the Supreme Court explicitly recognized the doctrine of equivalents and indicated all of the requirements for equivalence in the case in question. The Supreme Court’s recognition of the doctrine of equivalents and

clear indication of determination standards therefor, in such manner, led its decision to become the standard in subsequent patent practice. Since then, lower courts have come to determine equivalence based on these five requirements. In this manner, the Ball Spline Bearing Case Decision caused the debate over the doctrine of equivalents to reach a tentative resolution. However, as mentioned in the next chapter, there were some issues concerning the interpretation of the requirements for equivalence, and it could hardly be said that lower courts were putting the requirements into practice in a unified way.

2-3. Trends and problems in court decisions after the Ball Spline Bearing Case Decision

As mentioned above, lower courts have come to determine equivalence based on the aforementioned five requirements since the Ball Spline Bearing Case Decision, and one lower court rendered a decision holding that the patentee has the burden of allegation and proof for the first to third requirements while the defendant has the burden of allegation and proof for the fourth and fifth requirements.⁴ There has been almost no dispute on this point in practice.

Regarding the first through third requirements to be alleged and proven by the patentee, their fulfillment is usually determined in this order, so if the first requirement is not fulfilled, and, consequently, infringement under the doctrine of equivalents is not established, fulfillment of the other requirements is often not determined. Moreover, in about 70% of the court decisions that denied infringement under the doctrine of equivalents, the court determined that the first

requirement had not been fulfilled. On the other hand, there are no cases in which the court has determined that the second or third requirement was not fulfilled after the first requirement was fulfilled.

Thus, the first requirement plays a very important role in the practice of making a determination of infringement under the doctrine of equivalents, despite the fact that it is a less common requirement in other countries. Therefore, there is no doubt that the first requirement is a major cause of the particular nature of determinations concerning equivalence in Japan.⁵ The background of these developments is that in conventional court precedents and practice, establishment of infringement under the doctrine of equivalents has been determined mainly based on the aforementioned second and third requirements, i.e., identity of function and effect or replaceability, and obviousness or ease of replacement.⁶ That is, the Ball Spline Bearing Case Decision can be evaluated as not only having indicated the requirements for the establishment of infringement under the doctrine of equivalents, but also as having substantially changed the major factor considered in the requirements, and having significantly converted conventional practice to this standard. In addition, as the first requirement concerns the question of whether a difference between the invention and a competing product is the “*essential part of the patented invention*,” an abstract requirement that seems to assume the answer in advance, the conclusion can significantly differ depending on the interpretation of the “*essential part*.” However, the determination standard therefor has not been necessarily unified among lower court decisions since the

Ball Spline Bearing Case Decision; therefore, the first requirement has been frequently used as a shortcut to deny infringement under the doctrine of equivalents.

In contrast, the fourth and fifth requirements are matters that are examined only in response to the defendant's arguments, as mentioned above, and fulfillment of these requirements is determined separately from the first to third requirements only if it has been alleged by the defendant. Therefore, there are many cases in which the court first determines the non-fulfillment of the fourth or fifth requirement and does not make any determination concerning the first to third requirements. In this manner, the first to third requirements and the fourth and fifth requirements are independent of each other. However, the relationship between the first requirement and the fourth requirement sometimes becomes an issue when taking into account publicly known art. In so doing, the court often considers the relationship not in terms of the fourth requirement, which clearly specifies publicly known art, but in relation to the consideration of publicly known art in finding the essential part for the first requirement.^{7,8} Moreover, regarding the relationship between the first requirement and the fifth requirement, there are many cases in which an issue that should have originally been discussed as an issue of estoppel in the fifth requirement is determined as an issue concerning the "essential part" in the first requirement, and equivalence is thereby denied, such as cases in which the applicant's allegation or amendment becomes an issue in the prosecution history, or in which a numerical limitation that is hardly distinctive becomes an issue.

In this manner, the first requirement has been used for convenience as a requirement including elements that should first be determined through other requirements, but this practice carries a risk of expanded application of the first requirement to a scope so wide that there would originally have been no need to restrict the application of the doctrine of equivalents. Therefore, it is considered very important to clarify the standard for the interpretation of the "essential part" in the first requirement and restrict the scope of the first requirement so as not to restrict unjustly the situations where the doctrine of equivalents is applicable, and enhance legal stability by securing objectivity in establishing infringement under the doctrine of equivalents.⁹

Furthermore, regarding the fifth requirement, which is the second most commonly used as a ground for denying infringement under the doctrine of equivalents after the first requirement, it is not necessarily clear what action taken by the patentee causes the case to fall under the "particular circumstances." This point has been an issue peculiar to the fifth requirement. That is, as the fifth requirement is specified as "*such as a circumstance where ... falls under those that were intentionally excluded from the scope of claims in the course of filing a patent application*," it is typically applied in the cases where an amendment is made to exclude an embodiment including the competing product in response to a rejection for lack of novelty or inventive step during prosecution, as well as cases where a party alleges that competing product is not encompassed in the scope of the claims. There is no dispute in practice over the point that the fifth requirement matters in such cases. How-

ever, the phrase “*in the course of filing a patent application*” does not necessarily specify only office actions after filing, so there has been a dispute over whether the fifth requirement is applicable when the embodiment of a relevant invention is stated in the description as of the filing date, but is not encompassed in the scope of claims, or where the embodiment of the competing product was not described despite the fact that it would have been easy to include based on common general technical knowledge as of the filing date.¹⁰

It is considered to be very meaningful in increasing the predictability of the establishment of infringement under the doctrine of equivalents in future practice that, under the circumstances mentioned above, the Intellectual Property High Court clearly indicated methods for determination of the first and fifth requirements, which have an especially significant influence on practice, in the form of the Grand Panel Decision, and that the Supreme Court also modified the rule of the Grand Panel Decision concerning the fifth requirement by indicating a new method of determination.

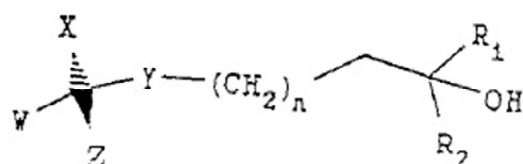
3. Explanation of the Decision

3-1. Outline of the case

The appellee of the final appeal (the “Appellee”) (plaintiff in the first instance) holds the patent right in question for an invention titled “*Intermediates for the Synthesis of Vitamin D and Steroid Derivatives and Process for Preparation Thereof*.” The appellant of the final appeal (the “Appellant”) (patent holder and defendant in the first instance) alleged that the process for the preparation of maxacalcitol preparations, etc.,

imported and sold by the appellant was equivalent to the invention of claim 13, and that the sale of these products constituted infringement. Based on this allegation, the Appellant filed this case to demand an injunction prohibiting import, assignment, etc., of the Appellant’s products and disposal thereof. The structure of the invention in question is as follows (segmentation of the invention into constituent features is as described in the text of the Grand Panel Decision of the Intellectual Property High Court):

[A-1] A process for preparing a compound having the following structure:



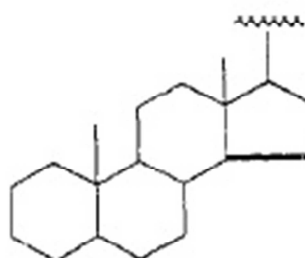
[A-2] (in the formula, n is 1;

[A-3] R₁ and R₂ are methyl;

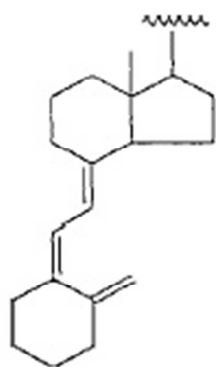
[A-4] each of W and X is independently hydrogen or methyl;

[A-5] Y is O; and

[A-6] Z is a steroid ring structure of the formula:



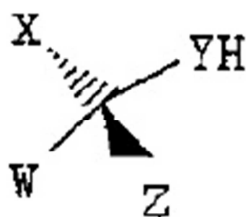
or a vitamin D structure of the formula:



wherein each of the structures of Z may optionally have one or more protected or unprotected substituents and/or one or more protective groups, and wherein any ring of the structure of Z may optionally have one or more unsaturated bonds);

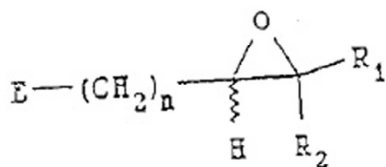
[E] which comprises:

[B-1] [a] the step of reacting a compound having the following structure:

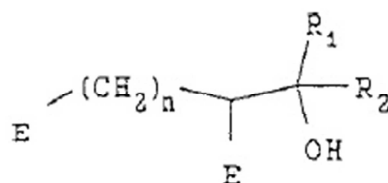


(in the formula, W, X, Y and Z are as defined above)

[B-2] in the presence of a base, with a compound having the following structure:

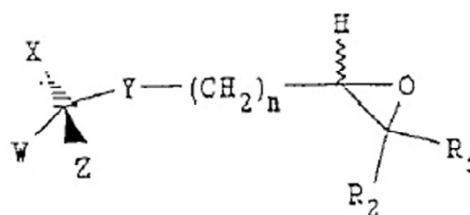


or



(in the formula, n, R₁, and R₂ are as defined above, and E is an eliminating group)

[B-3] to produce an epoxide compound having the following structure:



[C] [b] the step of treating the epoxide compound with a reducing agent to produce the compound; and

[D] [c] the step of recovering the compound so produced.

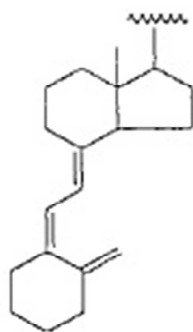
The corrected invention is outlined as a process for preparing a compound wherein the objective substance is produced by reacting the starting material with a specific reagent to prepare an intermediate and by treating the intermediate with a reducing agent. The Appellant's process fulfills the constituent features of the corrected invention concerning the reagent and objective substance (Constituent Features [A], [B-2], [B-3], and [E], and [C]) in that the carbon skeletons of the starting material and intermediate do not have a cis-form vitamin D structure, but have a trans-form

vitamin D structure, which is a geometric isomer of said cis-form vitamin D structure.

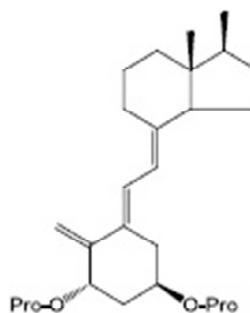
More specifically, as mentioned below, the Appellant's process does not fulfill Constituent Feature [B-1] of the corrected invention in that the carbon skeleton of Starting Material A in Step I is not a "*cis-form vitamin D structure*"

(cis (5Z) secosteroid structure) which has two protected substituents among "Z" of Constituent Feature [A-6] cited in Constituent Feature [B-1] of the corrected invention but is a trans-form vitamin D structure, which is a geometric isomer of said cis-form vitamin D structure.

(Vitamin D structure of Z in the Corrected Invention)

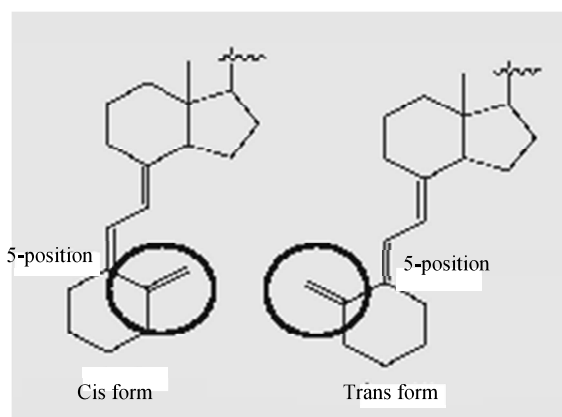


(Carbon skeleton of Starting Material A for the Process of the Appellant)



(Z may have one or more protected substituents.)

In addition, the Process of the Appellant does not fulfill Constituent Features [B-3] and [C] of the corrected invention in that the carbon skeleton of Intermediate C in Steps I and II is not a cis-form vitamin D structure but a trans-form vitamin D structure, as mentioned below.



Consequently, the establishment of infringement under the doctrine of equivalents became an issue in this case because the process of the Appellant did not literally fulfill the structure of the corrected invention, but used a trans form not literally *specified as Constituent Feature [A-6]*. The parties disputed the establishment of equivalence through specific application of the five requirements that were indicated in the aforementioned Ball Spline Bearing Case Decision. The court of first instance and the court of appeal instance had recognized that the process of the Appellant was equivalent to the corrected invention and upheld the claims, leading the Appellant to file its final appeal against these decisions, disputing not only the doctrine of equivalents, but also the invalidity of the patent (the invalidity of the patent is omitted from this article because it is not subject to the Supreme Court's determination). However, the Supreme Court only made a determination on the fifth requirement. Since establishing infringement under the doctrine of equivalents requires fulfillment of the other requirements as well, including the first requirement, the Supreme Court is considered to have had no special objection to the other requirements for equivalence, including the first requirement which is based on the general theory.

3-2. Content of the Decision

As mentioned above, in the Decision, the Supreme Court made a determination only concerning the fifth requirement. More specifically, the Supreme Court's determination is related to the following parts of the holding in the Grand Panel Decision:

“(1) Although an applicant for a certain patent may be able to easily conceive of the existence of some structures that fall outside the scope of claims at the time of filing a patent application, the applicant may omit statements concerning such structures in the application to be filed. In this event, it cannot be ascertained that there are particular circumstances explained in Paragraph 1 above merely due to such an omission.”

“(2) Even in the event described in (1) above, the existence of particular circumstances explained in Paragraph 1 above will be ascertained if it is objectively and visibly determined that the applicant recognized that a certain structure that falls outside the scope of the patent claims could substitute for the structure stated in the scope of claims while the former structure differs in part from the latter.”

In this regard, in the Decision, the Supreme Court first organized the Appellant's allegations as follows:

“The appellants argue that the scope of particular circumstances explained in Paragraph 1 above is interpreted too narrowly in the determination shown by the court of second instance.” The Supreme Court then

gave the following reasoning and concluded as follows: *“Since the determination shown in the second instance is consistent with the foregoing, the Supreme Court upholds such a determination.”*

“5. (1) The patent system is a system for granting a patent right, which is an exclusive right, to inventors who have publicly disclosed their inventions, thereby protecting the patented inventions for the holders of the relevant patent rights and making known the contents of the patented inventions to third parties, with the aim of encouraging the creation of inventions through promoting their utilization, thereby contributing to the development of industry (cf. Article 1 of the Patent Act). According to Article 70, paragraph (1) of the Patent Act, the technical scope of a patented invention must be defined based on the statements in the scope of claims attached to a patent application. If, however, a party adverse to a patent infringement suit were easily able to evade injunctions or the exercise of other rights by a patentee simply by replacing a certain part of the structure stated in the scope of the patent claims with any other easily conceivable technology that is substantially the same as the structure specified in the patent application, such evasion would go against the purport of the patent system described above and produce the effect of prejudicing the equitable principle. In light of the foregoing, Competing Products or Processes satisfying given requirements should be considered to be equivalent to the structure stated in the scope of patent claims and fall within the technical scope of the patented invention even

when the structure specified by the applicant contains any part that is different from those of the Competing Products or Processes. If some Competing Products or Processes were intentionally excluded from the scope of patent claims in the course of filing the application for the patented invention, or if there are other particular circumstances justifying denial of equivalence, the patentee will not be allowed to insist on the doctrine of equivalents. This is because the doctrine of estoppel does not allow the patentee to subsequently insist on what is inconsistent with his/her previous consent to exclusion of the Competing Products or Processes from the technical scope of the patented invention, or with his/her previous conduct that might visibly be interpreted as such consent (cf. 1998 Judgment).

Therefore, third parties who are aware of the description in a patent application that is publicly disclosed cannot reliably believe that the Competing Products or Processes are excluded from the scope of the patent claims, and it is difficult to ascertain that the applicant has acted in a way to imply consent to such exclusion from the technical scope of the patented invention merely because the applicant omitted to mention the Competing Products or Processes in the scope of patent claims in a situation where the applicant was able to easily conceive the structures adopted in the Competing Products or Processes different in part from the structure stated in the scope of the claims at the time of filing the patent application. In addition, if the patent applicant's failure to describe other easily conceivable struc-

tures in the scope of the patent claims automatically and unexceptionally made it impossible for the patentee fighting in a patent infringement lawsuit to insist that the Competing Products or Processes fall within the technical scope of the patented invention on the grounds that they are equivalent to the structure stated in the scope of the patent claims, the expected result would be inequitable for both patent applicants/patentees and third parties. On the part of patent applicants, such interpretation and operation would be the same as forcing them to prepare their applications in a way that exhaustively covers all expected future forms of infringement at the time of filing while they are under pressure to file patent applications as early as possible under the first-to-file rule. On the part of third parties aware of patent descriptions publicly disclosed, they would be able to examine alternative structures equivalent to the structure stated in the scope of claims without the time constraints faced by patent applicants, and third parties could therefore be able to easily evade injunctions or the exercise of other rights by relevant patentees.

In consequence, even in a situation where the scope of patent claims written by the patent applicant did not mention the structure for Competing Products or Processes different in part from the structure stated in the scope of claims while the applicant was able to easily conceive the structure for such Competing Products or Processes at the time of filing the application, the mere fact of such omission in the scope of the patent claims does not infer that the Competing Products or Processes

were intentionally excluded from the scope of patent claims in the course of filing the application for the patented invention or that there are other particular circumstances.”

“(2) In some of the situations explained in (1) above, however, a patent description written by an applicant may contain a statement to the effect that the patented invention can work even when the structure stated in the scope of claims is replaced with a structure for Competing Products or Processes that are different in part from the structure stated in the scope of claims. In this or any other way, applicants may recognize at the time of filing the patent that the structure for any Competing Products or Processes can substitute for the structure stated in the scope of the patent claims, but intentionally omit statements concerning such Competing Products or Processes in the scope of the patent claim. If the situation explained in the preceding two sentences is objectively and visibly ascertained, third parties aware of the publicly disclosed patent description can understand that Competing Products or Processes are excluded from the scope of the patent claims based on the applicant’s intention. This means that the applicant has acted in a way to cause third parties to believe that the Competing Products or Processes do not fall within the technical scope of the patented invention with the applicant’s consent. A ruling that the existence of particular circumstances is ascertained in the situation referred to above is consistent 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, and such a ruling is reasonable for adequate coordination of interests between patent applicants and third parties.

Therefore, intentional exclusion of Competing Products or Processes from the scope of patent claims in the course of filing an application for a patented invention or the existence of other particular circumstances should be ascertained if the applicant is objectively and visibly determined to have indicated his/her intention of omitting statements concerning Competing Products or Processes in the scope of the patent claims in a situation described below, while recognizing that the structure for the Competing Products or Processes could substitute for the structure stated in the scope of the patent claims; the applicant knew the existence of such Competing Products that contain certain parts that are different from the parts in the structure stated in the scope of the patent claims; and the applicant was able to easily conceive the structure for such Competing Products or Processes at the time of filing the application in connection with said differences.

In light of the facts explained prior, nothing contained in the appellee's application for the Patent indicates objectively and visibly the appellee's intention of omitting to mention the structure for the Appellants' Process in the Scope of Claims while recognizing that the structure adopted by the appellants, which was different in part from the structure stated in the Scope of Claims, could substitute for said structure."

(emphasis in original.)

3-3. Commentary on the Decision

3-3-1. Regarding part (1) of the Decision

As indicated in section 2-2 above, the fifth requirement for showing infringement under the doctrine of equivalents is stated as "[I]f . . . there are no particular circumstances, such as a circumstance where competing products or processes fall under those that were intentionally excluded from the scope of claims in the course of filing a patent application for the patented invention." In part (1) of the Decision above, the Court provided a general principle for the method of determining the existence of such "particular circumstances."

In this regard, the Supreme Court held as follows in the Decision: Even when the patent claims did not mention a structure for competing products or processes partially different from the structure stated in the scope of claims, but the applicant was able to easily conceive the structure for such competing products or processes at the time of filing the application, the mere fact of such omission does not imply that there are "particular circumstances," such as a circumstance wherein the competing products or processes fall under those intentionally excluded from the scope of claims during prosecution. This rule has the same effect as the following determination in the aforementioned Grand Panel Decision: "Although an applicant for a certain patent may be able to easily conceive of the existence of some structures that fall outside the scope of claims at the time of filing a patent application, the applicant may omit statements concerning such structures in the application to be filed. In this event, it cannot be ascertained that there are particular circumstances

explained in Paragraph 1 above merely due to such an omission.”

Similarly, the following view was stated in the research law clerk’s explanation in the Ball Spline Bearing Case Decision: The fact that the applicant chose neither to include a structure in the scope of claims as of the filing date, nor to include it the scope of claims through amendment, though he/she could easily have done so, falls under particular circumstances, such as intentional exclusion, and can be a circumstance that prevents the establishment of equivalence.¹¹ In addition, the “*prosecution history estoppel*” requirement, which is a requirement for the doctrine of equivalents in the United States corresponding to the fifth requirement in Japan, has the effect of limiting rights so as not to extend to subjects excluded through amendment in the course of prosecution.¹² However, Judge Rader of the CAFC advocated the view that such subjects should be limited to those that a person ordinarily skilled in the art could predict.¹³ Therefore, there has been a dispute over the question of whether even a circumstance in which an unclaimed equivalent is in use as of the filing date falls under the “*particular circumstances*” of the fifth requirement. How this point is actually interpreted and implemented in lower court decisions after the Ball Spline Bearing Case Decision has attracted attention.

However, as long as the fifth requirement originally specifies “*special circumstances such as the fact that the products had been intentionally excluded from the scope of claims,*” it is considered reasonable to think that a failure to state another material due to mere negligence, etc., is not sufficient to fulfill the fifth requirement, and that an active intention

of choosing not to include such material in the scope of claims is required. If so, the mere existence of another material that produces the same effect as of the filing date is not sufficient to suggest the intention to actively exclude such material. Therefore, it is literally unreasonable to say that the other material was “*intentionally*” excluded, and it also seems difficult to say that the applicant took an action that might be interpreted as such. Moreover, if protection is not granted unless an applicant states all the other materials in the scope of claims, irrespective of whether he/she had recognized said other materials as substitute materials as of the filing date, it will force the applicant to bear an excessive burden contrary to the purpose of the Patent Act (contributing to the development of industry through promoting the protection and utilization of inventions). The following holding in the Ball Spline Bearing Case Decision is probably also based on an idea to the same effect:

“[I]t is extremely difficult to state the scope of claims in the description in expectation of all forms of future infringement at the time of filing a patent application, and if the other party were easily able to evade injunctions or the exercise of other rights by a patentee simply by replacing a certain part of the structure stated in the scope of claims with a substance, technology, etc., that had become clear after the filing of the patent application, it will greatly reduce the incentive for inventions in the society in general, which is not only against the purpose of Patent Act, i.e., contributing to the development of industry through protection

and encouragement of inventions, but also goes against social justice and results in running counter to the principle of fairness.”

Furthermore, as long as the easiness of replacement at the time of infringement is specified in the third requirement for equivalence, if non-easiness of replacement as of the filing date is set as a requirement in the fifth requirement, infringement under the doctrine of equivalents will never be established unless the technical level concerning easiness of conceiving of the replacement changes during a brief period between the filing date and the time of infringement (the scope of equivalence will not extend to those other than “later equivalents”), and it will become very rare to find infringement under the doctrine of equivalents (actually, in the Grand Panel Decision, the court also found the easiness of replacement based on the filing date in its determination concerning the third requirement, and easiness of conceiving of the replacement as of the filing date is fulfilled in the case). As mentioned in 2-2. above, taking into account the background that the theory of the doctrine of equivalents has originally been discussed mainly in relation to the second and third requirements, that is, identity or replaceability of function and effect and obviousness or easiness of replacement, it seems to be excessive to completely exclude equivalents other than later equivalents, which have subsequently become replaceable or easy to replace, based on the fifth requirement.

On these bases, it is reasonable to surmise that the mere failure of an applicant to recite a structure in the claims that is outside the scope of the claims, despite

the fact that he/she could have easily conceived of said other structure as of the filing date, does not fall under the “*particular circumstances*” specified in the fifth requirement. The Decision is reasonable, as it gives a result to the same effect. In actuality, the court has basically made determinations to the same effect as this in past decisions,¹⁴ and there is no case in which the court has explicitly recognized ease of conception at the time of filing as a basis for satisfaction of the fifth requirement.¹⁵ Therefore, said holding can be considered as conforming to the stance of lower court decisions after the Ball Spline Bearing Case Decision, and does not bring about a major change from past practice. However, it is meaningful that this point was made clear in a Supreme Court decision.

3-3-2 Regarding part (2) of the Decision

In the Decision, the court indicated the following determination standard: On the premise that mere ease of replacement, as of the filing date, does not fall under the “*particular circumstances*” mentioned above, if the applicant is determined to have objectively and clearly indicated his/her intention to omit statements concerning the structure for competing products or processes from the scope of claims, while recognizing that the structure for the competing products or processes could substitute for the structure stated in the scope of claims, the existence of particular circumstances is ascertained, such as whether the competing products or processes fall under those intentionally excluded from the scope of claims in the course of prosecution. As a specific example, the court cited the circumstance in which the description

contains a statement to the effect that the patented invention can work even when the structure stated in the scope of claims is replaced with a structure for competing products or processes.

In this regard, the Grand Panel Decision made the following determination concerning what falls under “*particular circumstances*”:

“[I]f it is objectively and clearly determined that the applicant recognized that a certain structure that falls outside the scope of the patent claims could substitute for the structure stated in the scope of claims while the former structure differs in part from the latter.” The court cited the following cases as specific examples: “*where the applicant can be considered to have stated the invention based on said another structure in the description . . . ;*” and “*where the applicant stated the invention based on another structure that is outside the scope of claims in a paper, etc. which he/she published as of the filing date.*”

That is, in the Grand Panel Decision, the court requires that the applicant be objectively and clearly determined to “*have recognized*” the structure as one that may be substituted by another structure. On the other hand, in the Supreme Court decision, the court required that the applicant “*indicated his/her intention of omitting statements ... in the scope of claims while recognizing [this]...*” The Supreme Court decision can be considered to be setting a higher bar for falling under “*particular circumstances.*” This relates to the case in which the applicant has forgotten to state another structure while recognizing that the

structure substitutes for said other structure, that is, the way to handle “*omission of statements*” at the time of preparing a description. This is an important issue that can serve as a guideline for preparation of a description and application practice in the future.

In this regard, an applicant or patentee is not considered to have committed a significant error in failing (omitting) to state an embodiment identical to the patented invention as a technical idea, but of equivalent or lower efficiency in terms of the purpose of the invention. The doctrine of equivalents is considered as a theory that is intended for protecting embodiments identical to a patented invention in terms of their purpose, function, and effect; replaceable by the patented invention; and for which such replacement is easy if such embodiments do not literally fulfill constituent features due to their equivalent or lower efficiency. Therefore, it is considered unreasonable to consider the “*particular circumstances*” for denying the establishment of equivalence, if the first to third requirements are fulfilled, while expanding their application to the case of “*omission of statements.*”

Moreover, as mentioned above, as long as the fifth requirement is originally specified as “*particular circumstances, such as a circumstance where competing products or processes fall under those that were intentionally excluded from the scope of claims,*” it is considered reasonable to infer that failure to state another material due to mere negligence is insufficient to fulfill the fifth requirement, and that an active intention to choose not to include such material in the scope of claims is required. Consequently, in faithful accordance with the phrase “*intention-*

ally excluded,” it seems reasonable to infer that mere recognition of another material is not sufficient, and that the applicant must also have “*indicated his/her intention of omitting statements ... in the scope of claims while recognizing [this].*”

Incidentally, the legal basis for the fifth requirement for infringement under the doctrine of equivalents is considered to lie in the doctrine of estoppel derived from Article 1, paragraph (2) of the Civil Code.¹⁶ In line with this doctrine of estoppel, it is hard to say that the allegations of the patentee (applicant), as of the filing date and at the time of exercising rights, conflict with each other only because he/she failed to state another material while recognizing it due to negligence, etc. It seems to be reasonable to infer that the applicant’s “*having indicated his/her intention of omitting statements ... in the scope of claims while recognizing [this]*” is also necessary in order to say that allegations conflict with each other in the light of the doctrine of estoppel, as held by the Supreme Court.

On these bases, the determination of the Supreme Court is more reasonable than that of the Grand Panel as it indicated the requirement for existence of “*particular circumstances,*” that is, “*having indicated his/her intention of omitting statements ... in the scope of claims... while recognizing [this].*” It is reasonable to consider that the determination standard indicated in the Grand Panel Decision was modified by the Decision to that extent. Therefore, it is necessary to consider which specific cases fall under this requirement and are recognized as involving “*particular circumstances.*”

In this regard, in the Decision, the court specifically indicates, as an example case where the applicant “*has indi-*

cated his/her intention of omitting statements ... in the scope of the claims while recognizing” a circumstance where “*a description, etc., contains a statement to the effect that the patented invention can work even when the structure stated in the scope of claims is replaced with a structure for competing products or processes.*” It is not necessarily clear to what the word “etc.,” in “*description, etc.*” specifically refers, but those that are mainly assumed here are considered to be documents that are closely related to the relevant application in the same manner as a description, such as a written opinion or a written amendment prepared in response to a notice of reasons for refusal. In this regard, when an applicant states another material in a description but chooses not to include it in the scope of claims, or an applicant limits a structure for the purpose of avoiding a reason for refusal, these circumstances are considered sufficient to determine that the applicant chose not to state another material while recognizing this fact. It is not considered necessary to relieve an applicant or a right holder of its burden in the case where it has “*omitted to state*” another material in the scope of claims while stating it in the description. In such cases, it is necessary to protect the expectation of third parties that said other material is excluded from the scope of rights.

Incidentally, in past lower court practice, there have been court decisions that held that a statement in a description can serve as a ground for finding the existence of particular circumstances.¹⁷ However, it is rather rare to take into account statements in a description themselves, in relation to a determination concerning the fifth requirement, as they are matters that have often been determined in relation to

the first requirement. Statements during the intermediate stage, such as those in a written opinion or a written amendment, have typically been used as grounds for falling under “*particular circumstances.*” This is probably because the fifth requirement is specified as “*those that were intentionally excluded from the scope of claims in the course of filing a patent application.*” However, as statements in a description can also be considered as part of the course of filing a patent application, it seems to be little unreasonable to consider statements in a description as grounds for determining the fulfillment of the fifth requirement.

On these bases, there seems to be no special problem in that a circumstance where “*a description, etc. contains a statement to the effect that the patented invention can work even when the structure stated in the scope of claims is replaced with a structure for competing products or processes*” falls under “*particular circumstances.*” However, as the court states this circumstance just as an example in the Decision, there can be other circumstances that fall under “*particular circumstances.*” Therefore, it is considered below whether or not the circumstances that were stated as examples of the case where “*if it is objectively and visibly determined that the applicant recognized that a certain structure that falls outside the scope of the patent claims could substitute for the structure stated in the scope of claims while the former structure differs in part from the latter*” in the Grand Panel Decision can be considered to fall under “*particular circumstances*” in the light of the standard of the Decision.

First of all, regarding the case “*where the applicant can be considered*

to have stated the invention based on said another structure in the description,” many such cases are considered to fall under a circumstance where “*a description, etc., contains a statement to the effect that the patented invention can work even when the structure stated in the scope of claims is replaced with a structure for competing products or processes*” as mentioned in the Decision. Therefore, such a case is considered to fall under “*particular circumstances.*” In a circumstance where a description contains a statement to the effect that the patented invention *cannot* work when the structure stated in the scope of claims is replaced with a structure for competing products or processes (for example, where a text example using another relevant material is used as a comparative example and whether a working example is changed into a comparative example along with an amendment), it is reasonable to think that said other structure is an embodiment of a technical idea that differs from that of the relevant patent. The first and second requirements are not fulfilled, and neither is the fifth requirement. Therefore, most of the circumstances “*where the applicant can be considered to have stated the invention based on said another structure in the description*” fall under “*particular circumstances*” in line with the determination standard of the Decision, and infringement under the doctrine of equivalents will be denied.

On the other hand, a circumstance “*where the applicant stated the invention based on another structure that is outside the scope of claims in a paper, etc. which he/she published as of the filing date*” can serve as a ground for finding that the applicant recognizes the invention based on said other structure, but it very rarely

serves a direct ground for the applicant's "*having indicated his/her intention of omitting statements ... in the scope of the patent claims ... while recognizing [this]*" as mentioned in the Decision. Unlike application documents, academic papers are not intended to demand granting of an exclusive right in return for publication of an invention but are intended to inform the world of new discoveries or inventions. Therefore, their nature significantly differs from that of application documents. Consequently, there seems to be little chance that the purpose of the statement of the scope of claims for a patent application can be understood from statements in an academic paper, and it is questionable whether it is reasonable to interpret the effective scope of a patent right in consideration of documents that so differ in nature. Moreover, there are cases where various research groups within one applicant entity conduct separate research projects without mutual communication (e.g., large companies and national university corporations). Therefore, it is also questionable whether it is appropriate to use papers, etc., as bases for determining the existence of "particular circumstances" merely because the applicant is the same.

On these bases, the mere fact that statements in "*a paper, etc. which the applicant published as of the filing date*" serves as a ground for violation of the novelty or involvement of an inventive step requirement of the invention, and in particular, the fact that they serve as a ground for denying the fulfillment of the fourth requirement, will never justify finding the existence of "*particular circumstances*" in the light of the purpose of the Decision. That is, if there are such

circumstances, the court is expected to determine whether the applicant can be evaluated as "*having indicated his/her intention of omitting statements ... in the scope of the patent claims ... while recognizing [this]*" in comprehensive consideration of statements in a description and statements, etc., in written opinions as intermediate responses in line with specific cases on an individual and specific basis.

It is expected that other circumstances that fall under circumstances where the applicant is determined to "*have indicated his/her intention of omitting statements ... in the scope of the claims ... while recognizing that the structure for the competing products or processes could substitute for the structure stated in the scope of claims*" will be made clear through an accumulation of future court decisions.

4. Influence of the Decision on practice and points to note for future practice

As mentioned above, the Decision is meaningful for indicating the determination standard for the fulfillment of the fifth requirement of the doctrine of equivalents, for indicating a stricter standard for establishing "*particular circumstances*" than the standard indicated in the Grand Panel Decision, and for interpreting the cases in which infringement under the doctrine of equivalents is not established due to the fifth requirement in a limited manner. The content of the Decision can be considered friendly to rights holders and those who engage in patent application practice.

At the time when the Grand Panel Decision was rendered, it attracted

tremendous interest because it was the first indication that a circumstance “*where the applicant stated the invention based on another structure that is outside the scope of claims in a paper, etc., which he/she published as of the filing date*” could serve as grounds for the existence of “*particular circumstances*.” However, as the Decision set forth a new standard on this point, the existence of “*particular circumstances*” is not determined solely on this basis, and whether the applicant can be considered to have “*indicated his/her intention of omitting statements ... in the scope of the patent claims ... while recognizing [this]*” is based on a comprehensive consideration of statements in a description and in written opinions as intermediate responses on an individual and specific basis. Moreover, statements in “*a paper, etc., which the applicant published as of the filing date*” can serve as grounds for invalidation of the relevant patent or can serve as grounds for denying the fulfillment of the fourth requirement. Therefore, careful consideration of application strategy will be required in relation to content of papers and the time of their publication in the future.

Incidentally, details are saved for the author’s article titled “*Intellectual Property High Court Grand Panel Decision Regarding the Requirements for the Establishment of Infringement under the Doctrine of Equivalents*” in the January 2017 issue of this journal. However, it is necessary to consider the content of the Grand Panel Decision to consider its effect on future practice. That is, in the Grand Panel Decision, the court clearly indicated that it stands on the technical idea identity theory in relation to the first requirement and also interpreted elements

to be considered for the first requirement in a limited manner. However, the Decision mentioned nothing about these determinations in the Grand Panel Decision. Therefore, the determination standard indicated in the Grand Panel Decision is expected to become firmly fixed as a practical standard in relation to the first requirement. As a result, there will be fewer decisions in which the court finds no equivalence by excessively expanding the first requirement, as was the case for lower court decisions immediately after the Supreme Court decision on the Ball Spline Bearing Case.

On the other hand, in the Grand Panel Decision, the court moved in the direction of expanding the scope of the fifth requirement toward denying infringement under the doctrine of equivalents, in comparison to the view adopted in past practice. However, as mentioned above, said determination standard was modified by the Decision in the direction of further limiting the cases that fall under “*particular circumstances*” of the fifth requirement, thereby facilitating establishment of infringement under the doctrine of equivalents.

Thus, looking at the decision as a whole, it does not significantly change the idea of current court decisions and practice, but is considered to have set forth a standard which moves in the direction of facilitating establishment of infringement under the doctrine of equivalents. The cases in which infringement under the doctrine of equivalents is established may increase in the future.

There has been no court decision in Japan finding infringement under the doctrine of equivalents in relation to an invention including a limitation by numerical values for a competing product

that is outside the scope of the numerical values of the invention. One reason for this is that infringement under the doctrine of equivalents has been denied based on the first requirement in most cases. However, there will be an increasing number of cases in which establishment of the doctrine of equivalents is determined based on the fifth requirement. In this regard, as an act of placing a limitation by numerical values itself can also be seen as an act of intentional exclusion in a description after considering other ranges of numerical values, it still seems to be difficult to obtain a finding of infringement under the doctrine of equivalents. However, there may be cases in which the court determines, in line with the purpose of the Decision, that infringement under the doctrine of equivalents is established.

Considering points to note in the light of the decision on the case in question, firstly, from the standpoint of rights holders, there is still a high bar to establishing infringement under the doctrine of equivalents in Japan, and rights holders are, needless to say, required to state the scope of claims and a description with ingenuity so that they can allege literal infringement. For that purpose, it is important to consider carefully which parts do not exist in the conventional art by comparing the conventional art to the invention, and state the parts that are the same the conventional art as abstractly as possible, or as generically as possible (needless to say, it is also necessary to leave room for restricting such parts to more specific concepts through amendments in preparation for receipt of a reason for refusal). In doing so, as fulfillment of the fifth requirement is highly likely to be denied in relation to materials

stated in a publication of an unexamined application for the relevant rights holder's application or a previously published paper, it is especially necessary to state such materials without omission. However, in contrast, where a rights holder states such materials only in a description and not in the scope of claims (in particular, where he/she makes negative statements in relation to such materials or numerical ranges), fulfillment of the fifth requirement is highly likely to be denied. Therefore, this point requires attention.

In addition, it is important to enrich statements in a description in order to make it easier for infringement under the doctrine of equivalents to be found. In particular, where a problem that could not have been solved by conventional art is not sufficiently stated, conventional art that is not stated in a description is also taken into account, and fulfillment of the first requirement tends to be denied, in contrast to cases in which conventional art is found based only on statements in a description. This point requires attention. Furthermore, it is a natural precondition for recognizing the fulfillment of the first requirement that technical ideas or the function and effect of a patent can be understood from statements in the patent description. Therefore, it is also important to enrich these statements.

From the standpoint of third parties, it is necessary to pay more attention than ever to infringement under the doctrine of equivalents. As there have been few decisions finding infringement under the doctrine of equivalents in Japan in the past, it is common for a third party to put all his/her efforts toward avoiding literal infringement and to give insufficient consideration to establishing infringement

under the doctrine of equivalents after removing relevant constituent features. In addition, it is difficult to make a determination concerning the first requirement based on the technical idea identity theory because it is necessary to take into account not only statements in a description, but also the relationship with competing products. Therefore, a determination thereon at the court seems to be less predictable in many cases. Where there is no decisive factor for the non-fulfillment of the first requirement due to such circumstances, it might be effective to consider the prosecution history, statements in a description, and statements in the past publications of unexamined applications and papers of the same applicant to seek materials that can be used for alleging the non-fulfillment of the fourth or fifth requirements. However, according to the Decision, the court is highly likely to determine that a mere statement of another structure that can substitute for the structure of a relevant invention in a paper of the same applicant does not fall under the “*particular circumstances*” of the fifth requirement. Therefore, more careful determination is required.

The decision on the case in question is considered to have a significant meaning in that it indicated unified determination standards for the first and fifth requirements, which are especially important in making a determination concerning infringement under the doctrine of equivalents. However, as there are still many aspects of the specific interpretation of these standards that are unclear, further clarification through accumulation of future court decisions is awaited.

(Notes)

- ¹ For a general civil case for which the jurisdictional amount is 1.4 million yen or less, the summary court serves as the court of first instance, the district court serves as the court of appeal instance, and the high court serves as the court of final appeal instance. However, the Tokyo District Court and the Osaka District Court have exclusive jurisdiction over the first instance of a patent infringement case, irrespective of the jurisdictional amount, the Intellectual Property High Court serves as the court of appeal instance, and the Supreme Court serves as the court of final appeal instance.
- ² Regarding the history and positioning of the Grand Panel of the Intellectual Property High Court, see the author’s article titled “*Intellectual Property High Court Grand Panel Decision Regarding the Requirements for the Establishment of Infringement under the Doctrine of Equivalents*” in the January 2017 issue of this journal.
- ³ However, in said Supreme Court decision, the court denied the establishment of infringement under the doctrine of equivalents on the grounds of non-fulfillment of the fourth requirement and thereby reversed the decision in prior instance that had found infringement under the doctrine of equivalents. Therefore, in Japan, there has been no case in which the Supreme Court found infringement under the doctrine of equivalents. Incidentally, when said decision was rendered, a defense set forth in Article 104-3 of the Patent Act (a defense of patent invalidity) had not yet been provided by law, and it was a major method used to interpret the scope of rights in a limited way based on a “*defense of publicly known art*” if the scope of claims included publicly known art. At present, such issues are often determined not within the framework of the requirements for equivalence, but in terms of a defense of patent invalidity. There are few cases in which infringement under the doctrine of equivalents is denied on the grounds of non-fulfillment of the fourth requirement.
- ⁴ This was first held in the decision of the Tokyo District Court of October 7, 1998, Hanji, No. 1657, at 122 (Load Device System Case), and similar determinations have been made in subsequent court decisions.
- ⁵ In this regard, Iimura and Shitara, ed., *Chitekizaisan kanren soshō* (Intellectual property-related suits) states as follows: “*The reason for requiring the first requirement is*

that if the second and third requirements alone are considered as the requirements, the scope in which equivalence is established becomes excessively broad in relation to the point that the standard time for the determination of easiness of replacement was defined as the time of infringement. However, infringement under the doctrine of equivalents is often denied based on the first requirement probably because the first requirement functions as a 'restriction' on the expansion of infringement under the doctrine of equivalents."

⁶ Regarding practice before the Ball Spline Bearing Case Decision, the following is stated in Yoshifuji, *Tokkyohō gaisetsu [dai 13 pan]* (Overview on the Patent Act (13th edition)): "If art in which some of the constituent features of a patented invention are replaced with other elements (art expressed by a product or a process) is identical with the patented invention in terms of purposes as well as functions and effects (functions) (identity of functions and effects or identity of functions) and the patented invention can be replaced with said art (replaceability) and a person ordinarily skilled in the art as of the filing date can naturally conceive of such replacement itself based on the statements of the structure of the patented invention (obviousness (easiness) of replacement), said art is equivalent to the patented invention"; "The definition of equivalence indicated in court decisions and theories (commonly accepted theories) up until the present is almost the same as this."

⁷ In this regard, Iimura, "Tokkyoken no kintōshingai no seihi ni kansuru 2,3 no ronten" (Several issues regarding establishment of infringement of a patent right under the doctrine of equivalents), *Patent*, vol. 67, no. 3 (2014) states as follows: "Looking at actual practice, since the Supreme Court rendered a decision on the Ball Spline Bearing Case, it has been rare that the court makes a determination concerning the fourth requirement in a case concerning equivalence, and there has been no court precedent in which the fourth requirement affected the conclusion. The reason therefor is as follows. The exclusion of publicly known art, etc. (fourth requirement) and non-essential part (first requirement) have commonality in that they are the requirements that focus on comparison between publicly known art as of the filing of a patent application and the patented invention. However, as the first requirement has been

conventionally applied in an expanded manner in practice beyond the purpose of its establishment as a requirement in the Supreme Court decision on the Ball Spline Bearing Case, there is no room left for denying equivalence through application of the fourth requirement."

⁸ Regarding this reason, Tamura, "Saibanrei ni miru kintōron no honshitsutekibubun no ninteihōhō" (Methods of finding an essential part under the doctrine of equivalents that are seen in court decisions), *Kurēmu kaishaku wo meguru shomondai (kenkyūhōkoku dai 23 gō)* (Problems in claim interpretation (research report No. 23)) (Central Research Institute of Intellectual Property of the Japan Patent Attorneys Association, December, 2008), 13 states as follows: "The court prefers to take into account publicly known art not in relation to the fourth requirement but in relation to the first requirement for the following reasons: If publicly known art is taken into account in relation to the fourth requirement, it is necessary to examine whether the relevant claim fulfills the novelty and non-easiness of presumption requirements in comparison with the publicly known art on the assumption that the allegedly infringing product is claimed in the claim, and there is a hurdle that equivalence can be denied for the reason of existence of the publicly known art only if the fulfilment of said requirements is denied. However, in relation to the first requirement, publicly known art can be flexibly taken into account without such hurdle. However, such flexibility cuts both ways in terms of predictability, and it may restrict equivalence to the extent that is originally unnecessary."

⁹ In this regard, the following is stated in Otomo, *Bessatsu jurisuto tokkyohanrei hyakusen VIII [dai 4 han]* (Jurist separate volume: 100 selected patent precedents VIII [4th edition]), 141, which was written as a commentary on the aforementioned interlocutory decision on the Hollow Golf Club Head Case, in which the parties disputed the establishment of infringement under the doctrine of equivalents at the Intellectual Property High Court: "Also taking into account the fact that there is a difference in the interpretation of the first requirement in the decision in prior instance and that in the decision in this case, the first requirement is considered to function as a requirement that is convenient for judges, which can be determined in any way depending on the anticipated conclusion of the court. Thereby,

the second and third requirements become relatively less important, and the desirable way of determination concerning equivalence will be called into question.”

- ¹⁰ For example, the court held as follows in the decision of the Intellectual Property High Court of September 26, 2012, *Hanji*, No. 2072, at 106 (Medical Visible Image Generation Process Case): “*If the applicant chooses to state a specific structure alone in the scope of claims though another candidate structure is disclosed in the description and the applicant can easily state said other structure, application of the doctrine of equivalents to said other structure does not fulfill the fifth requirement for the doctrine of equivalents, and it should be considered to be impermissible to do so.*” This court decision is also cited in the case in question as support for the appellant’s allegation.

- ¹¹ Mimura, *Saikōsaibansho hanrei kaisetsu (minji hen) heisei jū nendo (jō)* (Explanation on Supreme Court precedents (civil cases) fiscal 1998 (1)), 148 states as follows: “*If the applicant chose neither to include a structure in the scope of claims as of the filing date nor to include it in the scope of claims through amendment in the application process though a person ordinarily skilled in the art can easily conceive of doing so, the applicant is considered to have intentionally excluded the structure from the scope of claims in the course of filing a patent application or have taken action that is visibly interpreted as such in relation to requirement (5) (particular circumstances, such as intentional exclusion) cited in the Decision, and such case is often considered to be the cases where there is a circumstance that prevents the establishment of equivalence.*”

- ¹² In Katsufumi Izumi, “*Beikoku ni okeru kintōron—Festo jiken wo chūshin ni*” (Doctrine of equivalents in the United States—focusing on the Festo case), *Patent*, vol. 55, no. 22 (2002), the author states as follows: “*The fifth requirement in the Ball Spline Bearing Case is approximate to the ‘prosecution history estoppel’ in the United States. However, the inclusion of the word ‘intentionally’ indicates that the applicable scope of said requirement is narrow. This requirement may be applicable only to subject matters which are actually recognized through amendment and waived in the course of filing an application.*”

- ¹³ Taijiro Takase, “21. Application of the Doctrines Limiting the Doctrine of Equivalents

and Claim Drafting Concerning U.S. Patents—Foreseeability and Importance of Claim Limitations in Limiting the Range of Equivalents,” *IIP Bulletin* 2006 states as follows: “*In the United States, there is a Supreme Court opinion that claim drafters ‘may be expected to draft claims encompassing readily known equivalents.’ There is also a CAFC en banc opinion that ‘When one of ordinary skill in the relevant art would foresee coverage of an invention, a patent drafter has an obligation to claim (all of) those foreseeable limits.’ In Japan as well, there is an opinion that ‘the prior art exerting the same effect, which exists as of the filing date, must be examined in relation to passive requirements. The two countries are considered to be of one accord in terms of the anticipated orientation.’*”

- ¹⁴ For example, in the decision of the Intellectual Property High Court of September 15, 2006 (2005 (Ne) 10047), available on the Supreme Court’s website (Chair Massage Machine Case), the court held as follows: “*It should be considered that, in order to say that the structure pertaining to a product for which patent infringement is alleged was intentionally excluded from the scope of claims in the course of filing a patent application, it is necessary for the patentee to have admitted in the course of filing the application that the structure pertaining to said product is not included in the scope of claims, or have taken an action by which he/she can be visibly evaluated as having clearly recognized the structure pertaining to said product and having excluded it from the scope of claims, such as excluding said structure from the scope of claims through amendment or correction. The mere fact that the applicant did not include the structure pertaining to said product in the scope of claims despite the fact that he/she could have easily conceived of it in light of publicly known art, etc. as of the filing date should not be considered sufficient to say that the applicant intentionally excluded the structure pertaining to said product from the scope of claims.*” The court clearly indicated that the mere existence of an unclaimed equivalent as of the filing date does not fall under the “particular circumstances” in the fifth requirement.

- ¹⁵ In the aforementioned Medical Visible Image Generation Process Case, the court held as follows: “*If the applicant chose to state only a specific structure in the scope of claims despite*

the fact that he/she could easily state another structure, application of the doctrine of equivalents to said other structure does not fulfill the fifth requirement for the doctrine of equivalents, and it should thus be considered to be impermissible.” However, in this case, the court found that a candidate for another structure was disclosed in the description. Therefore, it is not reasonable to regard the decision on this case as stating a general theory recognizing the ease of conceiving of another structure at the time of filing as a ground for the fifth requirement.

¹⁶ In this regard, in the Ball Spline Bearing Case Decision, the court also held that “*This is*

because the doctrine of estoppel does not allow a patentee to subsequently insist on what is inconsistent with his/her previous consent to exclusion of competing products or processes from the technical scope of the patented invention, such as the applicant’s intentionally excluding the competing products or processes from the scope of claims in the course of filing a patent application, or with his/her previous conduct that might visibly be interpreted as such consent.” The court has made clear that the ground for the fifth requirement is based on the doctrine of estoppel.

¹⁷ See the aforementioned Medical Visible Image Generation Process Case.