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## Recent Japanese cases on Doctrine of Equivalents

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20th Annual Intellectual Property Law &  
Policy  
Conference  
Fordham University School of Law  
April 12-13, 2012

# Japanese IP High Court Started Applying DOE Positively

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- Golf Club Head Case (6/29/2009)

IP High Court (Presiding Judge Imura; Judge Nakadaira; Judge Ueda) overturned Tokyo District Court's decision and found infringement based on DOE.

- **Manhole Cover Case (3/28/2011)**

IP High Court (Presiding Judge Nakano; Judge Shoji; Judge Yaguchi) overturned Osaka District Court's decision and found infringement based on DOE.

- **Folding Method of Foods Case (6/23/2011)**

IP High Court (Presiding Judge Takizawa, Judge Takabe; Judge Inoue) overturned Tokyo District Court's decision and found infringement based on DOE.

# Five Requirements of DOE in Supreme Court's Decision of 2/24/1998

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## (1) Non-Essential Part

The part of the claim as different from the structure of the accused product or process (“accused embodiment”) is not an essential part of the patented invention.

## (2) Interchangeability

The accused embodiment, even with the existence of the different part, achieves the same purpose and produces the same meritorious effect as those of the patented invention.

### (3) Obviousness of Interchangeability

Above interchangeability in the second requirement was obvious for a person of ordinary skill in the art at the time of manufacturing the accused embodiment.

### (4) Accused Embodiment Not Falling Within Public Domain

The accused embodiment is not the same as, or not obvious from, the prior art at the time of filing of the patent application.

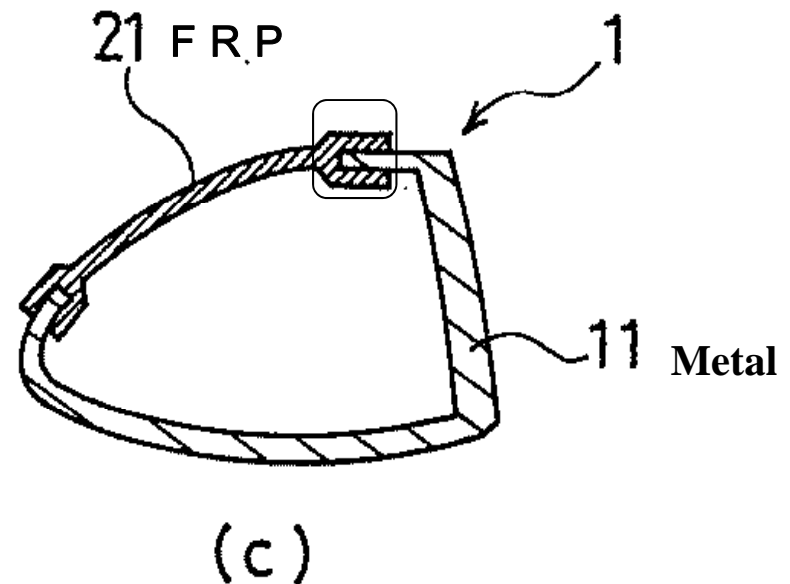
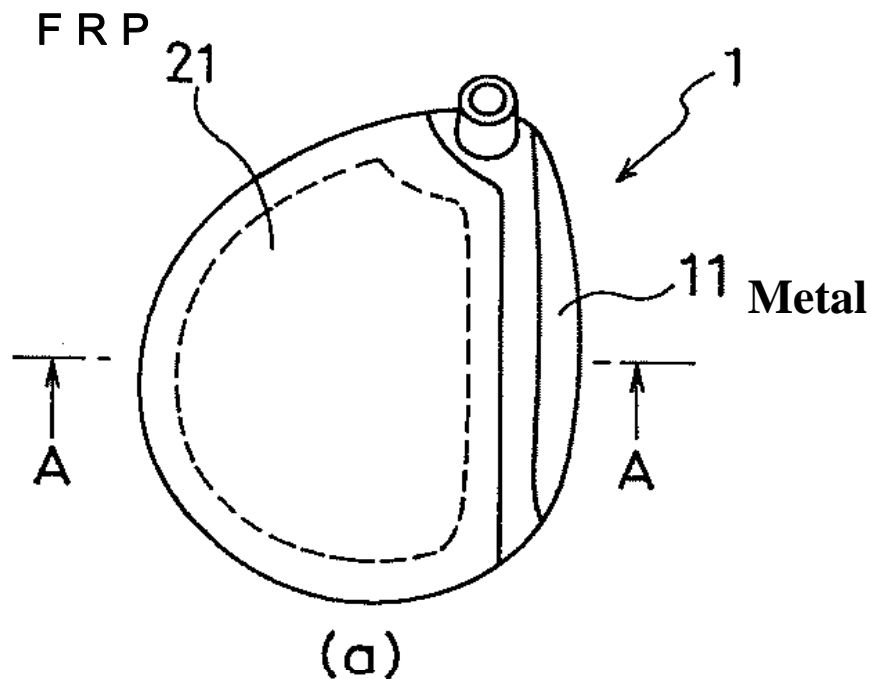
### (5) No Special Circumstances

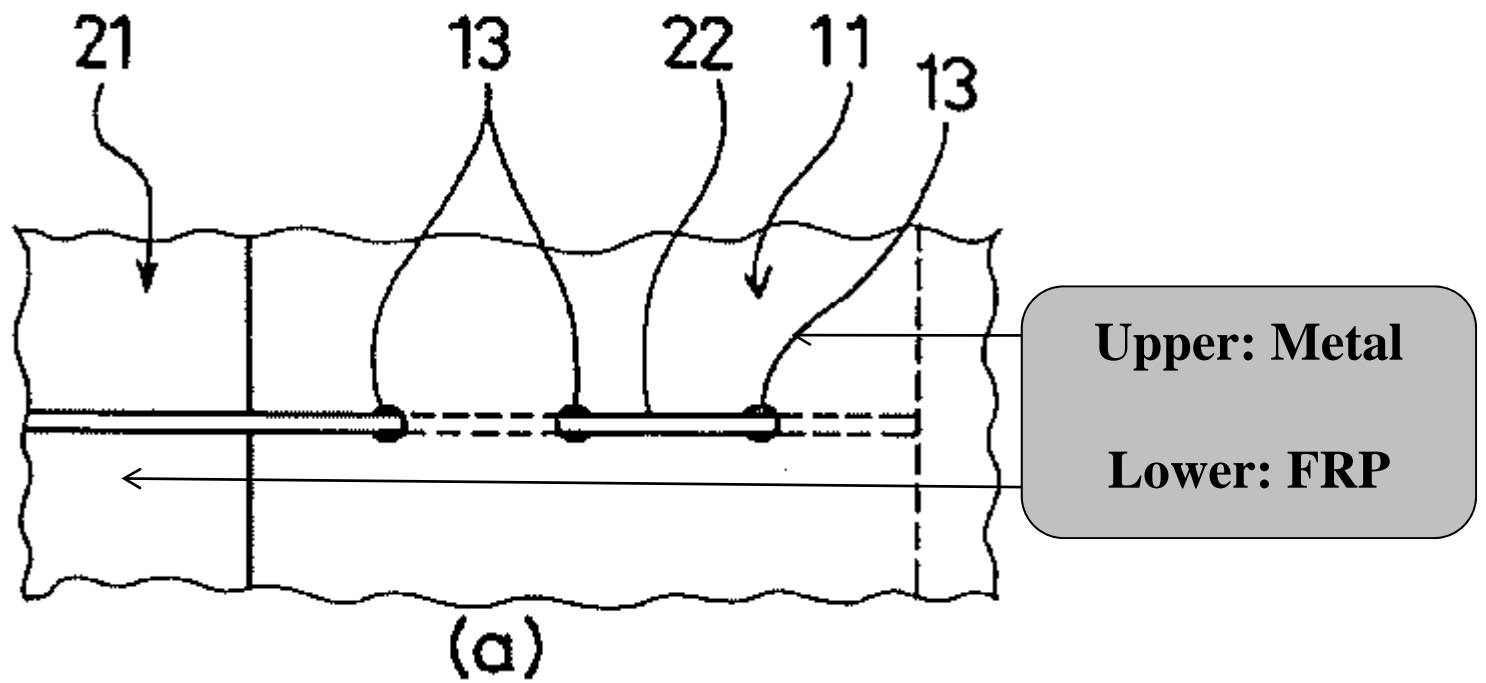
There are no special circumstances to deny the infringement, such as intended exclusion of the accused embodiment from the scope of the claim in the prosecution history, etc.

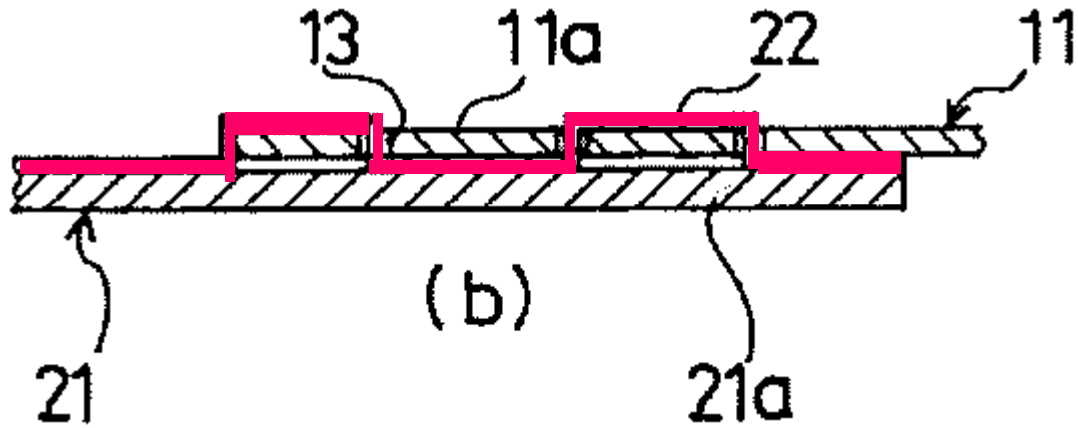
# Golf Club Head Case (IP High Court Decisions of 6/29/2009 and 5/27/2010)

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## ■ invention



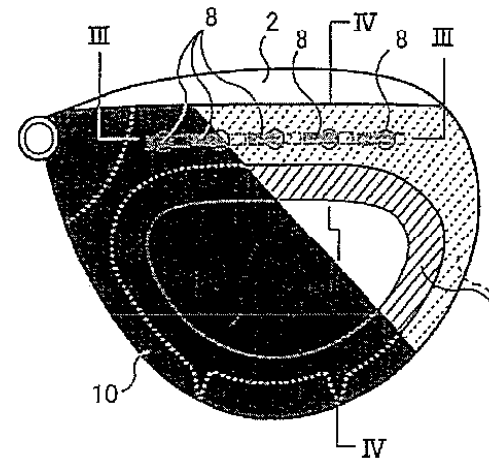
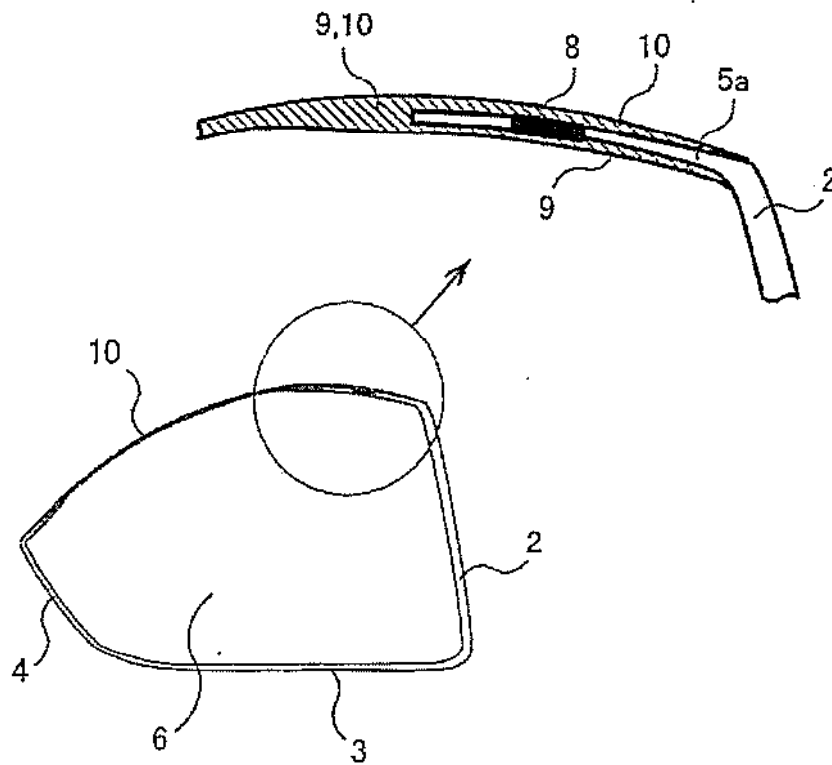




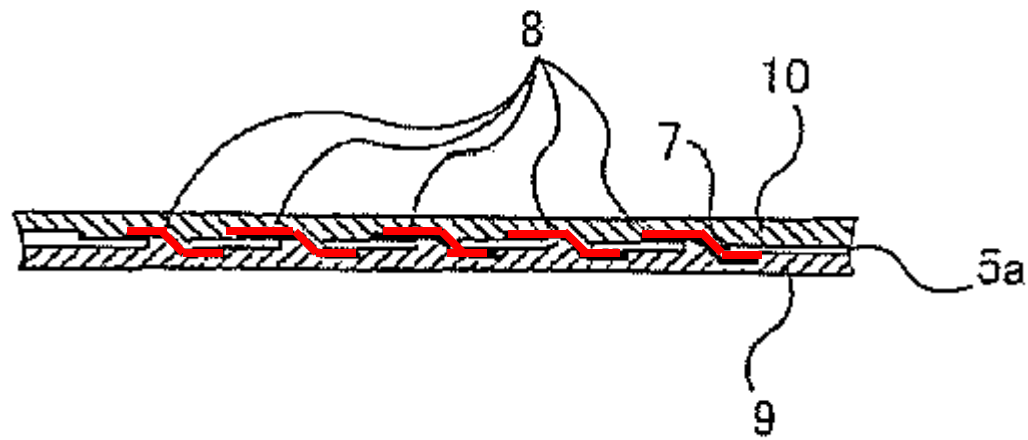


# Defendant's product

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第3图 (III-III断面图)

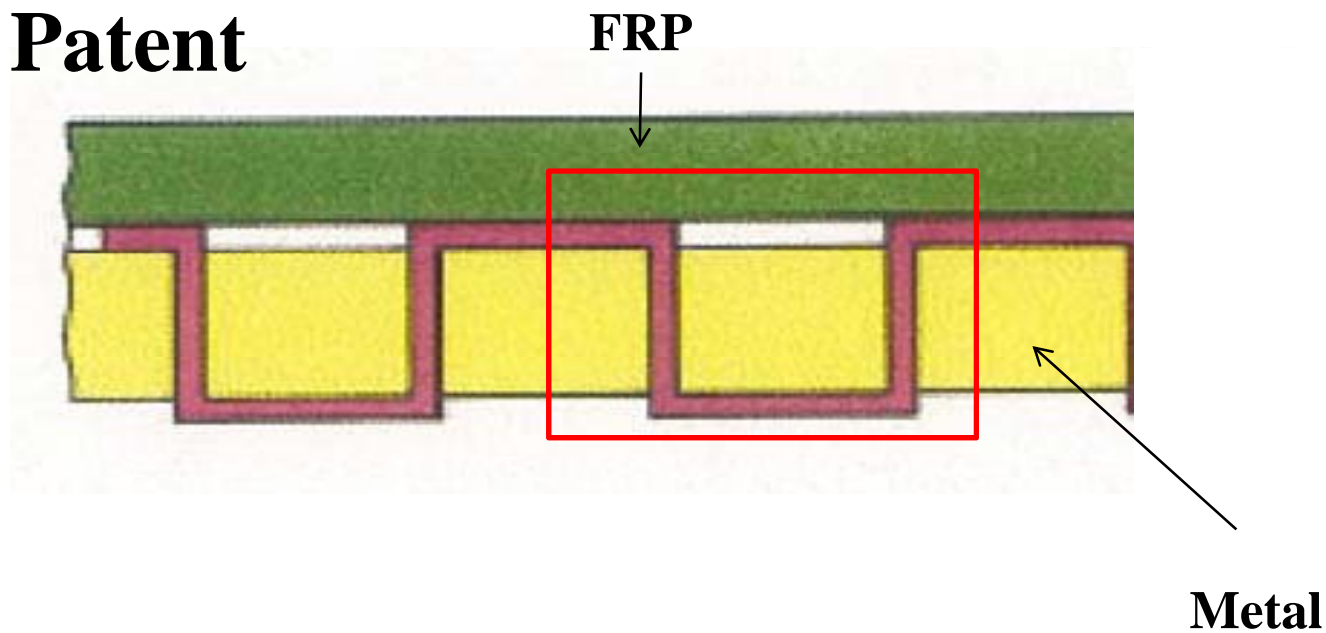


# Claim Language

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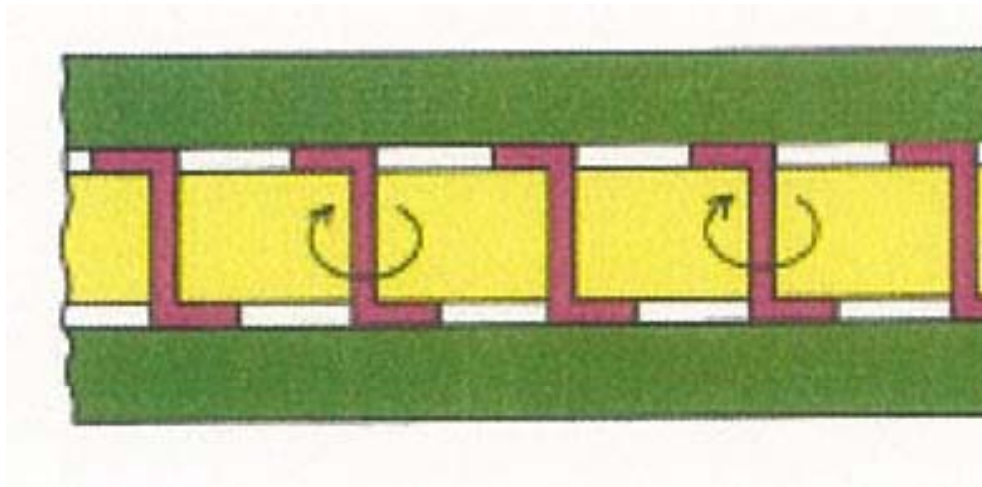
“Sewing Material”

**Patent**



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## Alleged Infringing Product



# Golf Club Head Case

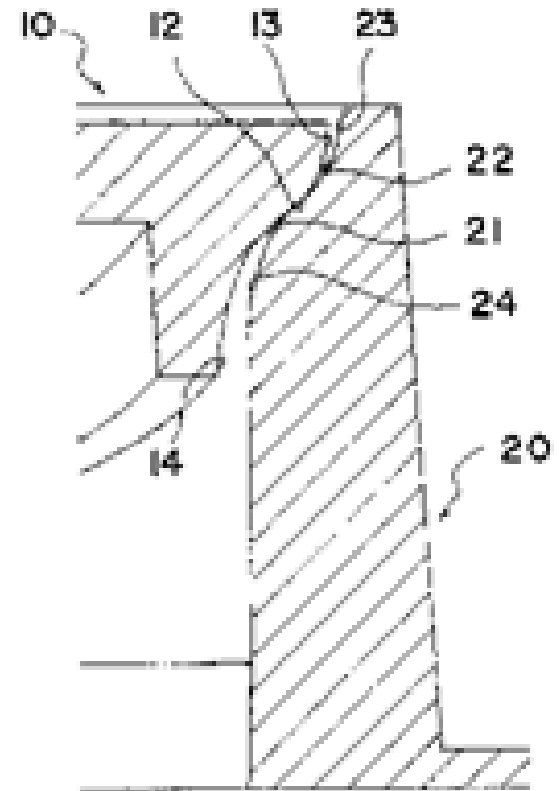
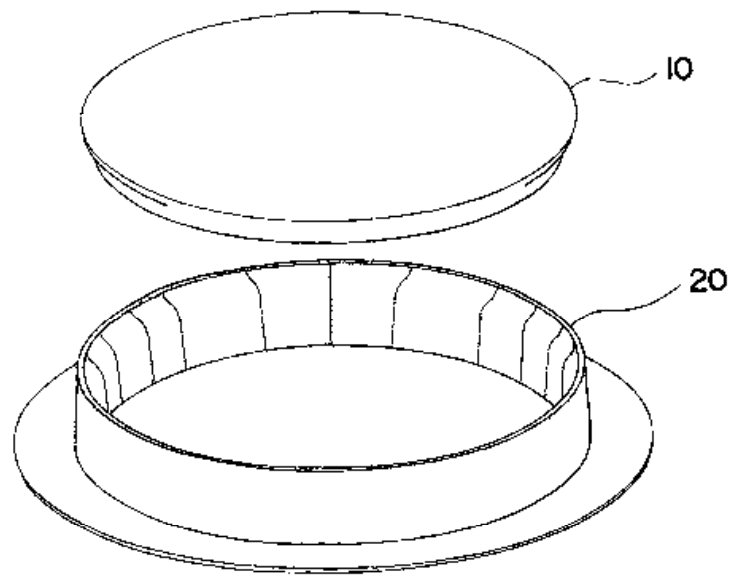
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- Is “Sewing Material” an essential part of invention?

Tokyo District Court; Yes → Denied DOE

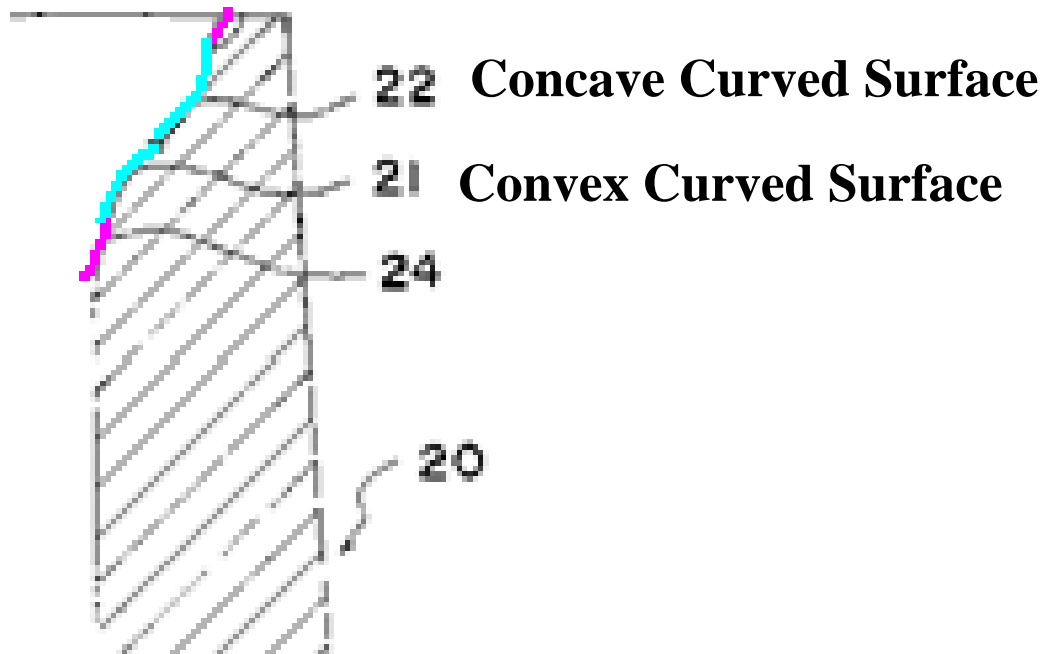
IP High Court; No → Applied DOE

# Manhole Cover Case

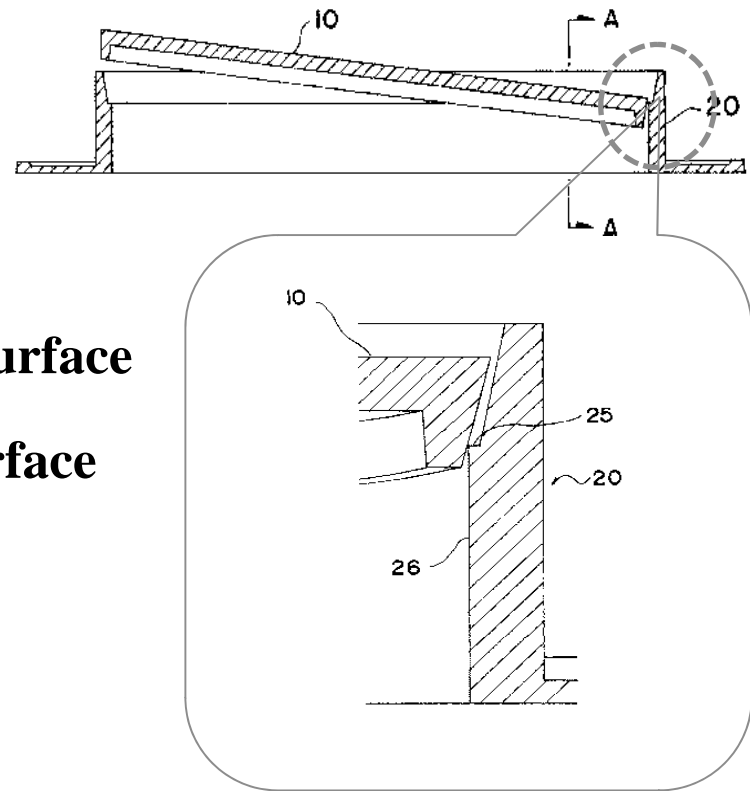


# Manhole Cover Case

## Invention



## Prior Art



## Cover

## Frame

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**Patent**

**curved convex surface**

**+**

**curved concave surface**

**curved concave surface**

**+**

**curved convex surface**

**Defendant's  
Product**

**curved convex surface**

**+**

**curved concave surface**

**curved concave surface**

**+**

**convex surface**  
**(Not curved)**



# Court's Decision

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- Tokyo District Court found that alleged infringing product does not satisfy curved surface requirement, which is an essential part of invention. Thus, denied DOE.
- IP High Court overturned District Court's decision and found infringement based upon DOE. In frame, concaved surface is enough, and thus, curved concaved surface is not essential part of invention.

# Trend of Patent Protection in Japan

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- Former Chief Judge Tsukahara of IP High Court (“Renaissance of DOE in IP High Court “ JIPA Journal, Vol 61, No.12, 2011)

The 1<sup>st</sup> requirement (non-essential part) should be interpreted as meaning the technical concept of the invention rather than as meaning certain part of claim language.

The past trend of frequently rejecting DOE using 1<sup>st</sup> requirement is wrong.

Parties should not refrain from arguing DOE in the infringement action.

# Thank you!

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