

Doctrine of Equivalents in Japan

In Japan, the doctrine of equivalents permits a court to rule that an Intellectual Property Right (IPR) has been infringed if certain conditions (described in detail below) are satisfied, even when the accused product or process has an aspect(s) which is different from the claimed invention. The doctrine of equivalents is based on the concept that patent protection (although not specifically limited to patents) should also apply when a product or a process is substantially identical to that of a patented invention.

In 1998, the Japan Supreme Court ruled that the following 5 conditions must be satisfied in order to assert the doctrine of equivalents.

1) The different part of the product in question is not an essential part of the patented invention;

2) The product in question may achieve the objective of the patented invention and has identical function and effect;

3) A person skilled in the art may easily arrive at an idea to replace the different part at the time of manufacturing of the product in question;

4) The product in question is not identical with publicly known prior art nor is it easily conceivable by a person skilled in the art at the time of filing of the relevant application; and

5) There are no special circumstances for the product in question to be deliberately removed from the claims of the subject patented invention during prosecution. Note that, this condition corresponds to file wrapper estoppel in US courts.

A. Two Cases Pertaining to the Doctrine of Equivalents in Japan

1. Ball Spline Bearing H6(O)No. 1083 (February 24, 1998)

The District Court ruled that parts (components) in the patent claims did not coincide with those in the products produced and sold by an alleged infringer, but judged that the products were within the technological scope of the patented invention based on the ease at which a person skilled in the art could have conceived of replacing the different part(s).

Eventually, based on prior art documents submitted by the patentee, the Japan Supreme Court ruled that the alleged infringer's product could

be obtained by a person skilled in the art even without knowledge of the patent in question. Based on the prior art documents, it was deemed that the technology used by the alleged infringer was already in the public domain, and thus, would not fall within the scope of the patent. This same reasoning was also used by the Supreme Court to invalidate the original patent.

The Ball Spline Bearing case was essentially the first case to spur the development of the five conditions for asserting the Doctrine of Equivalents in Japanese IPR infringement cases and invalidation cases. However, in the years that followed, there were few cases in which the court would deem that the five conditions of the Doctrine of Equivalents were satisfied and could be used to show that infringement had occurred. More than 70% of all infringement cases initiated failed to satisfy the First condition.

2. Maxacalcitol 2015 (Ne)No.10014 (March 25, 2017)

In the first infringement case in the pharmaceutical or life sciences industry to successfully invoke the Doctrine of Equivalents in Japan, Chugai Pharmaceuticals claimed that DKSH Japan had infringed on the Chugai patent (3310301) which relates to a method for manufacturing maxacalcitol. The Chugai patent used the cis-form isomer of a starting material to synthesize the cis-form of maxacalcitol, whereas DKSH Japan used the trans-form isomer of the same starting material to manufacture the trans-form of maxacalcitol. The Chugai patent did not specifically refer to the possibility of using the trans-form isomer of the starting material to manufacture the desired product.

The Tokyo District Court and the Grand Panel of the Japan IP High Court ruled that DKSH Japan infringed on the Chugai patent, stating that the differences in the cis-form and the trans-form were not an essential part and thus, the method employed by DKSH Japan satisfied the First condition of the Doctrine of Equivalents.

Essentially, the IP High Court stated that the extent to which the patented invention makes a contribution over the prior art allows for the technical concept of the invention to be viewed in more generic and broader sense which would make it easier to prove that infringement has occurred. If the difference between the patented invention and the alleged infringing item is deemed to be insignificant or subordinate, the First condition is satisfied. The lack of a "significant"

technological contribution over the prior art would force a narrow interpretation of the claims, which generally makes it more difficult to prove that infringement has occurred.

The Supreme Court approved this judgment by the lower courts and added that with respect to the Fifth condition, unless the patentee intentionally did not include the feature, which is the focus as to whether infringement occurred, in the claims, no special circumstances exist, regardless of whether the feature could have been easily conceived of by a person skilled in the art on the filing date of the original patent application.

As the Chugai patent does not mention the trans-form isomer, it was not deemed that this isomer was intentionally excluded from the claims, and thus, there were no grounds which would qualify as the "special circumstance" of the Fifth condition.

B. Strategy

The application should be written so as to avoid the possibility that the problems to be solved by the invention and/or the technical contribution provided by the invention might be deemed to be insignificant relative to the prior art. Failing to do so runs the risk that additional prior art might be used to narrow the scope of the claims of the application. Patent applications that greatly expand upon the prior art or are deemed to be ground-breaking may have a broader scope.

The prior art should be carefully examined to see whether the application is merely a slight modification or substitution which could easily be viewed under the doctrine of equivalents as infringing on an existing patent with broad coverage.