

Hollow Golf Club Head Case
Intellectual Property High Court
Heisei 19 (NE) 10006 Interim Decision (Heisei 21.6.29)
Final Decision (Heisei 22.5.27)

This High Court decision has drawn attention because, for the first time since the Supreme Court's "Ball Spline" decision of October 24, 1988, it was expressly recognized that a patent can be infringed under the doctrine of equivalents.

BACKGROUND

In an interim decision, based on whether the elements of the appellant's patented invention read upon those of the accused product, and whether or not infringement under the doctrine of equivalents and lack of inventive step existed, the court found that the elements of the appellant's patented invention did not read upon those of the accused product, thereby denying literal infringement. However, the accused product was found to have an element equivalent to a corresponding element of the appellant's patented invention, thus belonging to the same field of technology as that of the appellant's patented invention. Further, the appellant's patented invention was ruled not invalid, because the appellant's patented invention was not found to lack inventive step. In this sense, infringement under the doctrine of equivalents was found. In a final decision, the court made a judgment on some of the critical facts regarding the compensation claimed as well as the amount of the compensation to be paid to the plaintiff.

FACTS

X (plaintiff) is a patentee of "Hollow Golf Club Head," patent No. 3725481. The "accused product" marketed by the appellee Y was found to belong to the same field of technology as that of the appellant's patented invention, thus possibly incurring liability for damages if infringing.

ISSUE

- (1) Whether or not the elements of the appellant's patented invention read upon those of the accused product.
- (2) Whether or not infringement under the doctrine of equivalents is found.

DISPOSITION IN THE LOWER COURT

The judgment in the lower court (Tokyo District Court) failed to comprehend that an element (d) of the accused product (appellee's product) had an element equivalent to a corresponding element of the plaintiff's patented invention, even though the elements of the plaintiff's patented invention did not read upon those of the accused product. The court ruled that the accused product did not belong to the same field of technology as that of the plaintiff's patented invention, and dismissed the plaintiff's (appellant) claim (Tokyo District Court Heisei 19 (wa) No. 28614).

HOLDING AND REASONING

According to the interim decision, the accused product was found to belong to the same field of technology of the appellant's patented invention described in claim 1. Further, the court ruled that the appellant's patented invention should not be considered as invalid due to the result of a trial for patent invalidation.

(Issue 1) Literal Infringement

The definition of the term "stitching member" in element (d) of the claimed invention differs from the common definition thereof, which refers to "a member used to bond a plurality of target objects via penetration through all of them." Therefore, it is not reasonable to determine the definition of the term "stitching member" in this case based on the common definition of a stitching member. Namely, the "stitching member" in this case refers to "a member that passes through a plurality of (i.e., two or more) through-holes of the metallic outer shell member and bonds to the fiber reinforced plastic outer shell member at two portions, at least." Namely, the "stitching member" in element (d) does not read upon that of the accused product. Thus, literal infringement is denied.

(Issue 2) Infringement under the doctrine of equivalents

However, the "small zonal splinter consisting of carbon fiber 8" in element (d) of the accused product is equivalent to the "stitching member made of fiber reinforced plastic" (FRP) in the appellant's patented invention. The reasons for that are as follows:

(1) Replaceability

The "stitching member made of fiber reinforced plastic" in element (d) of the appellant's patented invention shares common characteristics with "small zonal splinter consisting of carbon fiber 8" in the accused product, in terms of purpose as well as operation and effect. Therefore, replaceability is found.

(2) Ease of replacement at the time of alleged infringement

It is considered that such replacement could be easily conceived by persons skilled in the art at the time of manufacture of the accused product. Therefore, replacement was possible.

(3) Non-essentiality

It cannot be comprehended that the "stitching member" is the core as well as characteristic part of the technical idea which constitutes the basis of the technical means for solving the problem unique to the appellant's patented invention. Therefore, according to the appellant's patented invention, the fact that the member threaded through the through-holes is a stitching member should not be regarded as an essential part of the invention.

(4) Non-obviousness at the time of filing the patent application

Even according to all the evidence of the present case, it is considered that the accused product is not identical to the known technology at the time the appellant applied for a patent, and would not have been easily conceived by persons skilled in

the art based on such known technology at the time of the application.

(5) No file-wrapper estoppel

According to the arguments and amendments filed during the application process of the appellant's patented invention, the appellant did not intentionally remove, during the application process, the configuration in which the "stitching member" of the appellant's patented invention is replaced by a member that is threaded through a through-hole and bonds to the upper and lower FRP outer shell members of the metallic outer shell member.

(6) Equivalence

The elements of the accused product are considered as equivalent to those of the appellant's patented invention. Thus, the accused product belongs in the same field of technology as that of the appellant's patented invention.

Conclusion

As stated above, although element (d) in the appellant's patented invention does not literally read upon that of the accused product, the accused product does belong to the same field of technology as that of the appellant's patented invention since the elements thereof are equivalent to those of the appellant's patented invention. Further, the appellant's patented invention does not lack inventive step, whereby the appellant's patented invention is not invalid.