

Ball Spline Bearing Case
The doctrine of equivalents
Supreme Court
Case H6(O)No.1083 (February 24, 1998)

The Japanese Supreme Court set forth the requirements/guidelines for applying the doctrine of equivalents ("Five Requirements for Application of the Doctrine of Equivalents"), which are now used in lower courts.

FACTS

The present case involves a claim of damage by the appellee against the appellant for the infringement of a patent. Relevant facts are as follows.

1. The appellee holds a patent on an invention called 'Infinite Sliding Spline Shaft Bearing' (Patent No.999139).
2. The appellant has produced and marketed products.
3. The first instance court found that elements of components in the scope of patented claim in the specification do not coincide with the accused products, but nevertheless, ruled that the accused products fall within the technological scope of the Invention, there is a possibility of replacement and easiness of replacement between the Invention and the accused products.
4. The judgment of the first instance court should be reversed, and remanded to the first instance court for further review.

ISSUE

Is the doctrine of equivalents admissible in Japan? If Yes, what are the requirements/guidelines for applying the doctrine of equivalents?

COURT DECISION

The court rendered a decision to admit the doctrine of equivalents in Japan and outlined five requirements for applying the doctrine. The decision of the court are as follows.

“Even if there exists an element which differs from the accused product in the elements recited in the claims, the accused product is considered to fall within the technical scope of the patented invention if the following five requirements are fulfilled:

- Requirement 1: the element is not an essential part of the patented invention;
- Requirement 2: even if the element is replaced in the accused product, the object of the patented invention can be attained with the same meritorious effect;
- Requirement 3: a person skilled in the art could have easily conceived the replacement of the element at the time the product was made;
- Requirement 4: the accused product is not identical to publicly known technology at the time of filing, and the skilled person could not have easily conceived the product from publicly known technology at the time of filing; and
- Requirement 5: there are no particular circumstances, for example, to exclude the product from the claims in the prosecution of the application.”