

Amendment to narrow scope of claim in process of prosecution and application of doctrine of equivalents (international trend in court cases and overview of Japanese court cases)

Japanese court cases have established the following five requirements to determine patent infringement under the doctrine of equivalents (cf. Ball Spline Bearing Case, Supreme Court Judgment on February 24, 1998, and Maxacalcitol Case, Supreme Court Judgment on March 24, 2017).

- (1) An element of a patented invention that represents a difference from the alleged infringer's product is not an essential part of the patented invention (non-essential element).
- (2) The purpose, functions and effect of the patented invention can be achieved by replacing the different feature with that of the defendant's product (a possibility for replacement and the identicalness of functions and effect).
- (3) It was easily conceivable to substitute the different feature for that of the defendant's product at the time of the manufacturing of the defendant's product (ease of substitution)
- (4) The defendant's product, at the time of filing of the patented invention, was not identical to publicly known art or was not easily foreseeable based on publicly known art.
- (5) There are no special circumstances, such as that the defendant's product was intentionally excluded from the claim of the patented invention in the course of its prosecution.

It was conventional for Japanese courts to deny the application of the fifth requirement based on a doctrine called "file wrapper estoppel" and deny infringement under the doctrine of equivalents with respect to a constitutional element added by amendment in the course of prosecution in response to a notice of ground for rejection due to a lack of novelty or inventive step.

Meanwhile, the Tokyo District Court handed down two judgments in which it determined the fifth requirement to be satisfied and acknowledged infringement under the doctrine of equivalents with

respect to a constituent feature added by amendment in response to a notice of ground for rejection due to a lack of inventive step. The following provides an analysis of these cases in comparison with developments in the U.S., Germany and the U.K.

**Tokyo District Court, 2017 (Wa) 18184, Osteotomy Spreader Case**

The court acknowledged infringement under the doctrine of equivalents by the satisfaction of the fifth requirement as follows: "The written opinion does not contain any statement implying that Plaintiff was aware of the issue of whether the engagement part is constituted as a part of the swing member or a member separate from the swing member. Thus, the statement in the written opinion does not serve as a basis to conclude that Plaintiff intentionally excluded from the scope of claims the configuration of the engagement portion which is separate from the swing member, at the time of adding constituent feature E by way of the amendment submitted together with the written opinion."

**Tokyo District Court, 2016(Wa) 25436, Process for Producing L-glutamic Acid Case**

The court confirmed the existence of infringement under the doctrine of equivalents by the satisfaction of the fifth requirement as follows: "it was not easily possible for Plaintiff, which is the applicant, to specify a specific configuration using a mutant-type yggB gene derived from *Corynebacterium callunae*, which could solve the problem to be solved by Invention 2, and state it in the claims in a form that would satisfy the support requirement and other description requirements at the time of the filing of the application for Invention 2. Therefore, no special circumstances can be found."

It is specifically noteworthy that the time to determine whether the configuration could be foreseen was the time of filing of the application. Although the reason is not explained in the text of judgment, if this determination is to be made with reference to the time of amendment, in other words, supposing that it was easily possible for the applicant to state the configuration in the claims in a form that satisfies the support requirement and other description

requirements at the time of the amendment, it would be too strict for an applicant as the amendment is only possible within the scope of the initial description filed at the time of application.

Determining the issue of whether the equivalent was foreseeable with reference to the time of filing of the application agrees with the decision which the Supreme Court of the U.S. handed down in May 2002, the Festo case. The court, while acknowledging that a "flexible bar" approach is applied, presented the following three possible grounds for rebutting the prosecution history estoppel: (i) the equivalent was unforeseeable at the time of the application; (ii) the rationale underlying the amendment bears but a tangential relation to the equivalent; or (iii) there is some other reason suggesting that the patentee could not reasonably be expected to have described the equivalent in the description. (However, the Court of Appeal for the Federal Circuit subsequently handed down many decisions determining this foreseeability with reference to the time of amendment; namely, many subsequent CAFC decisions had provided a basis for the criterion that "this foreseeability with reference to the time of amendment" **is** different from the abovementioned Festo case decision.) (Yasuyuki Echi, "Prosecution history estoppel and the doctrine of equivalent material at the time of filing date, and the doctrine of equivalents" *Japan Industrial Property Law Academy Journal* (2015))

This dominant approach to acknowledge infringement under the doctrine of equivalents for constituent elements added by way of amendment in response to an office action on the ground of lack of inventive step, presupposing that the "flexible bar" approach is applied, was also affirmed by the Supreme Courts of the U.K. and Germany in the Eli Lilly cases that were disputed before the courts of several countries immediately before the abovementioned two Japanese court cases. The authors expected that Japanese courts might follow this approach, which the courts actually did.

**The Eli Lilly cases in the U.S., U.K and Germany: All courts acknowledged infringement under the doctrine of equivalents with respect to a narrowed claim after amendment**

**• U.K. Supreme Court Judgment [2017] UKSC48 (v. Actavis), the first U.K. Supreme Court decision confirming infringement under the doctrine of equivalents**

⇒The court ruled that the amendment in question narrowing the claims in the process of the European patent application was made only for the purpose of complying with the requirements for amendment, i.e., avoiding the rejection on the ground of a new matter which was an inadmissible intermediate generalisation.

**• German Federal Court of Justice [2016] X ZR 29/15 (v. Actavis)**

The court ruled that infringement under the doctrine of equivalents is denied if the amendment was made to narrow the subject matter in relation to prior arts; however, such infringement is not excluded if the amendment was necessary to address formality requirements (e.g., new matter requirement or clarity requirement), as such amendment was not based on a voluntary choice of the patentee.

**• U.S. CAFC [2019.8.9] (Eli Lilly and Company v. Hospira, Inc.)**

⇒An applicant who amended the claim to narrow its scope in order to address substantial issues of patentability in the course of prosecution is barred by prosecution history estoppel. An applicant who made such amendment is presumed to have waived all equivalents that may exist between the initial claim and the amended claim. A patentee can rebut this assumption by proving that the amendment bears no more than a tangential relation to the equivalent in question.

Last of all, I would like to introduce the judgment of the Japanese Supreme Court dated March 24, 2017, the Maxacalcitol Case, which is an important court case discussing the fifth requirement of doctrine of equivalents. It should be noted that this decision relates to a disclosure-dedication doctrine, not the file wrapper estoppel

mentioned above. In general terms, the disclosure-dedication doctrine is a rule that bars a patentee from claiming the doctrine of equivalents, as the patentee is deemed to have dedicated to the public any subject matter disclosed but not claimed in the description.

The Supreme Court held as follows: "With respect to any elements of configuration stated in the claim that differ from those of the defendant's product, when an applicant, at the time of filing the application, omitted from its claim the configuration of the defendant's product even where it could be easily conceived of, and if the applicant can be considered to have expressed its intention to omit the configuration from the claim while recognizing that the configuration can objectively and visibly replace the configuration stated in the claim, a specific circumstance can be found, such as that the defendant's product was intentionally excluded from the claim in the course of prosecution of the patented invention."

That being said, there are few or no cases in Japan, including the Maxacalcitol Case, in which the court applied the disclosure-dedication doctrine to deny the application of the fifth requirement of the doctrine of equivalents. This is a general theory suggested by the Supreme Court decision, but there may be some risk for allegedly infringing parties to rely on it.

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