

Sato's Kiri-Mochi (Rice Cake) Case
IP High Court
Case No. H23 (ne)10002
September 7, 2011 (Interlocutory Judgment)

FACTS

Against appellee (defendant in the first instance), appellant (plaintiff in the first instance) demanded, based on its patent right, (i) injunction against manufacture and transfer, etc. of defendant's product (rice cake), (ii) disposal of the defendant's products and manufacturing equipment, etc. and (iii) damages.

Claim description of appellant's patent describes that slits are formed "not on the upper face nor bottom face" but on the side face of the rice cake (Claimed Element B), while the defendant's product formed slits on the upper, bottom and side faces.

The first instance (Tokyo District Court) interpreted Claimed Element B to be that no slits are formed on the "bottom face or upper face" and slits are formed on the side face only, and that the defendant's product did not satisfy Claimed Element B.

This interlocutory judgment of the IP High Court admitted that the defendant's product satisfied Claimed Element B. Then the Final Court Decision of the IP High Court (IP High Court H23(ne)10002, March 22, 2012) allowed the claims (i) (ii) and (iii) 800million yen damages.

ISSUE

Whether the defendant's product satisfies Claimed Element B.

HOLDING

In view of (i) literal interpretation of the claim description including a construction thereof as a whole, (ii) detailed description of a specification and (iii) prosecution history, it can be interpreted that description of "not on the upper face nor bottom face" of "slits are formed not on the upper face nor bottom face but on the side face" is a description just to qualify the side face, and not a description to exclude a construction that slits are formed on the "bottom face or upper face" of a rice cake. The defendant's product satisfies Claimed Element B based.

Regarding (i):

Based on the claim description, after the description of “not on the upper face nor bottom face”, a description of “but on the side face” follows with no comma thereafter. In view of such sentence construction, it can be interpreted that “not on the upper face nor bottom face” qualifies “the side face.”

Regarding (ii):

Based on the detailed description of invention, the invention at issue has an effect of maintaining aesthetic sense and uniformly baking a rice cake by forming slits on the side of a rice cake. There is no description that such effect will not be found if slits are formed on the side face together with bottom face or upper face.

Regarding (iii):

During the application procedure, Plaintiff stated, by submitting an amendment, that the invention has slits not on bottom face or upper face but on side face only. However, the examiner pointed out that the amendment added a new matter. In response, Plaintiff again submitted an amendment, and retracted the above statement too.

There is no reason that Plaintiff’s statement regarding the meaning of the claim description in its retracted Amendment has binding power. Rather, through the whole application procedure, Plaintiff stated that the invention accepts the presence or absence of the slits on the upper face or bottom face of a rice cake.