

Magnetic Medium Reader Case
Tokyo District Court
Case H8 (Wa) 22124, Judgment on December 22, 1996 (H8)

Summary authored by Takeo NASU

FACTS

A plaintiff was an owner of the utility model right, No. 1802476. The plaintiff sued a defendant, alleging that the production and the distribution of their products infringed the plaintiff's utility model right.

The claims of the registered utility model may be divided into elements A to G. The defendant did not challenge that their product met the elements A to D and G. There were disputes about whether the alleged products meet the elements E and F which were specified by their functions.

A. A magnetic reader ...

E. configured to, between said magnetic head and said holding plate,

F. (a) when said magnetic head is located in the declination position, inhibits the rotation of said magnetic head,

(b) when said magnetic head is located in the position of sliding contact, allows said magnetic head to freely rotate.

ISSUE

Whether or not a technical scope of a utility mode (patent) claim specified by a function and by an abstract expression, covers all configurations which may achieve the said function or technical effects.

HOLDING

When a technical scope of a utility mode (patent) claim is specified by a function and by an abstract expression, it cannot be clarified only by the recitations, so that the specification must be reviewed as well as the claim recitations, and the claim scope must be determined based on the technical idea disclosed by specific configurations therein.

However, the claim scope shall not be limited to embodiments described in the specification. A configuration, which is not described as an embodiment in the

specification, is also included in the technical scope if the specification enables a person skilled in the art to make it.

The claim scope would cover a technical idea which is not disclosed in the specification if any configuration achieving the function or the technical effect is interpreted to be included, which would result in a protection beyond the scope that the applicant made. This is against the philosophical construct of the utility model in which an exclusive privilege based on a utility model right is granted to the inventor in return for the disclosure thereof to the public.

Reviewing the present case, in connection with the means for inhibiting the rotation of element F, the specification only discloses a configuration wherein both of a holding plate and a magnetic head holder comprises a plate inhibiting a rotation, and that wherein one of a holding plate and a magnetic head holder comprises a plate prohibiting rotation with an engagement portion, and a pin is fixed on the other. There is no other specific disclosure, embodiment, or suggestions for them. Therefore, the means for inhibiting the rotation of the present utility model should be interpreted to be limited to the configurations which a person skilled in the art can make based on the disclosure of the specification.

On the other hand, it is apparent that the means for inhibiting the rotation of the alleged products is different from the configuration disclosed in the specification. Furthermore, the configuration of the alleged products is different from the technical idea disclosed in the specification, and a skilled person cannot make the alleged products based on the specification.

As a conclusion, the alleged products do not meet the element F, so that it is not covered by the claim scope.

Note of Summary Author: Even though this case is for a utility model, a patent claim is interpreted in a similar fashion because the utility model right was granted through a substantive examination.

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Original document (Japanese):

Hanrei Jiho, vol. 1674, pp. 152; Hanrei Times, vol. 991, pp. 230

English Translation:

N/A