

JAPAN

Patent infringement when a product changes after manufacturing

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Some chemical products alter with the passing of time. When a product does not fall within the scope of claims at the time of manufacturing but falls within the scope of the claims after the passing of time after manufacturing, is it correct to conclude that such a product falls within the technical scope of a patented invention?

Summary of the case

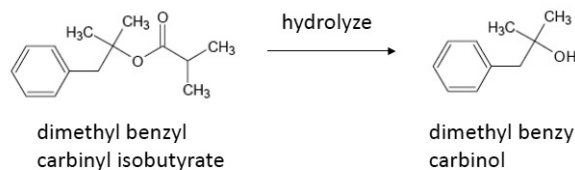
The plaintiff Kao has patent rights related to an aromatic liquid bleaching composition including sodium hypochlorite as an active ingredient, which is characterised by including one, two or more kinds of a lot of fragrances which are stated in the claims. Dimethyl benzyl carbinol is included in these fragrances.

Kao claimed against the defendant Johnson Products, seeking a payment of approximately ¥567,000,000 (USD 5 million) as damages and asserting that Johnson's manufacturing and selling of a household fungi-removing composition (Kabikira as a brand name) infringes Kao's patent rights.

At least some of the dimethyl benzyl carbinyl isobutylate included in the Kabikira manufactured by Johnson changes into dimethyl benzyl carbinol with the passing of time after manufacturing. Johnson asserted that Kabikira did not satisfy the claim elements of the patented invention because at the time of manufacturing Kabikira did not include dimethyl benzyl carbinol. Rather this was merely generated by alteration with lapse of time after manufacturing.

Judgment of November 4 1999, Tokyo District Court

The Tokyo District Court (Presiding



Judge Mimura) granted Kao's claim and ordered Johnson to pay ¥272,300,000 as damages, holding as follows.

The patented invention is a product invention of an aromatic liquid bleaching composition whose manufacturing method is not limited. Therefore, it would fall within the technical scope of a patented invention, not only when a claimed fragrance is added at the time of manufacturing but also when a different fragrance is added which can generate the claimed fragrance up until the time of use after manufacturing.

According to the evidence, dimethyl benzyl carbinyl isobutylate has been decomposed in an aromatic liquid bleaching composition including surfactants and sodium hypochlorite as active ingredient, and dimethyl benzyl carbinol is generated. According to Kao's experiments regarding the alteration with lapse of time, under the condition of static preservation at 20 degrees centigrade, the amount of dimethyl benzyl carbinol was nearly equal to the amount of dimethyl benzyl carbinyl isobutylate in 30 days. According to Johnson's experiments, approximately one third of the amount of dimethyl benzyl carbinyl isobutylate had been altered into dimethyl benzyl carbinol in 28 days from the beginning of the experiments.

Kabikira is household fungi-removing composition, and a period of 28 days or 30 days is not very long compared with the normal period for distributing Kabikira to consumers through the distribution process of products after manufacturing. In addition, for a household fungi-removing composition, it is rare to use up the content of the container at one time but it is usual to use the content prepared at home each time cleaning occurs over a certain period. Thus, a large amount of dimethyl benzyl carbinyl isobutylate in Kabikira would alter into dimethyl benzyl carbinol before con-

sumers begin to use the product.

Therefore Johnson's manufacturing of Kabikira corresponds to the practising of the patented invention because Kabikira inevitably includes dimethyl benzyl carbinol which is stated in the claim element and is generated by the alteration with lapse of time after manufacturing, even though Kabikira does not include any fragrances in the claim element at the time of manufacturing.

Practical tips

This judgment held that when an accused product does not fall within the scope of claims at the time of manufacturing but falls within the scope of claims by lapse of time after manufacturing, such a product falls within the technical scope of a patented invention. This is because the court put value on the following points. About half of the products according to Kao and about one third of the products according to Johnson had altered into the patented products before consumers obtained the products after manufacturing. A large amount of products had altered into the patented products before consumers actually began to use the products and the altering of dimethyl benzyl carbinyl isobutylate into dimethyl benzyl carbinol could be anticipated by skilled persons based on common general technical knowledge such as the hydrolysis of an ester under the alkaline condition. Therefore, the following criteria should be considered to judge whether the products altering with lapse of time infringe patent rights: whether the alteration with lapse of time occurs before consumers obtain or use the products; the ratio of the altered products if the alteration with lapse of time occurs; the condition which causes the alteration with lapse of time; whether skilled persons can anticipate the occurrence of the alteration with lapse of time and so on.