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PAC Case
Tokyo Intellectual Property High Court
Case No. H23 (Ne) 10031
January 31, 2012

(Plaintiff-appellants: Nakata
 Yasuda Seisakusho)
(Defendant-appellees: Carbo-tec
 Carbo-tec Hida
 Yamashita Mokuzai
 Seiki)

FACTS

This is an appeal from the Tokyo District Court, seeking money damages and injunctive relief.

Plaintiff-appellants Nakata and Yasuda Seisakusho jointly own Japanese Patent No. 3364065 issued October 25, 2012 (“the ‘065 patent”) for an invention titled “Carbonization Method”.

The invention involves a method of manufacturing powdered activated carbon or powdered activated charcoal (PAC).

Nakata and Yasuda Seisakusho brought suit in Tokyo District Court, seeking an injunction on the manufacture and marketing of the products in question based on Article 100(1) and (2) of the Patent Law for infringement of the ‘065 patent and seeking money damages based on unfair competition (Civil Code, Article 709 of the Civil Code and Article 102(2) of the Patent Law.

Specifically, the plaintiff-appellants sued Carbo-tec for indirect infringement of the ‘065 patent by manufacturing and marketing a carbonization device that can only be used with the patented method as well as direct infringement of the ‘065 patent by manufacturing and marketing PAC using the patented method. Nakata and Yasuda Seisakusho also sued Carbo-tec Hida for infringement, charging they marketed charcoal products marketed by Carbo-

tec knowing that these products infringed; they also sued Yamashita Mokuzai for marketing to Seiki the products marketed by Carbo-tec Hida knowing that these products infringed the patent.

The Tokyo District Court found that Carbo-tec's ceramic charcoal production method, involving coating wood chips with bentonite, did not retard oxidation and turn the combustible wood chips into charcoal, and thus the defendant's method of manufacturing did not belong to the same technical field as that of the patented invention.

Nakata and Yasuda Seisakusho appealed, seeking to have the district court's decision overturned.

ISSUE

Whether results of experiments conducted with samples obtained under conditions very different from those of an accused method can be used to prove infringement of a claimed invention.

HOLDING AND REASONING

The invention according to the '065 patent has the following elements:

A combustible material or a material containing a combustible material,

B coating the combustible material by mixing it with an inorganic binder containing bentonite,

C feeding the combustible material into a cylindrical oven open to the air through an intake at one end of the oven and conveying it to a discharge at the other end of the oven, and igniting the material from the direction opposite the conveyance direction to dry the material at the intake side, and

D the inorganic coating retards oxidation of the combustible material as it burns, to carbonize the material at the discharge side.

Elements A and C are not in dispute.

As to elements B and D, the Plaintiff-appellants argue that, based on the results of experiments performed by Associate Professor A and the Nagano Prefecture General Industrial Technology Center, there is enough coating of the combustible material in the defendants' method to retard oxidation and achieve carbonization, and that it can be confirmed that enough of the surface of the material is not coated to allow combustion of the gas component.

We disagree. The defendants' method involves spraying with water and

mixing 50 kg of bentonite per cubic meter of wood chips using a mixer for 5 minutes, and then drying and igniting the mixture in an open rotating kiln to achieve carbonization. Associate Professor A took approximately 10 ml of wood chips having a typical length of 3-10 mm, placed them in a beaker, added 0.50 kg of bentonite, sprayed them with a mister and mixed them uniformly, took a sample still wet therefrom, checked the surface using an optical microscope, placed the sample in a Petri dish, dried it at 95°C for 24 hours, and then checked the surface with an optical microscope or a scanning electron microscope (SEM). These conditions are very different from those under which the defendant's method is conducted. Moreover, the method of observation is inadequate to identify the surface properties of the material in view of the very small size of the bentonite particles (from 0.005 to 0.2 μm). Associate Professor A claims to have taken wood chips mixed with bentonite and heated them under ambient air at a rate that increased by 50°C per minute up to a maximum of 800°C for 10 minutes, leaving a black charcoal residue, whereas heating wood chips unmixed with bentonite under the same conditions produced only ashes. But there is no photo attached to the Professor's opinion, and we cannot tell what sort of residue remained, whether charcoal or ash.

The results of experiments performed by the Nagano Prefecture General Industrial Technology Center are merely observations of a small portion of a sample produced under conditions very different from those of the defendants' method, and are inadequate to identify the surface properties of the material in view of the bentonite particle size described above.

Appeal denied; costs to be borne by the Plaintiff-appellants.