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Ningbo Dongfang General Movement Plant v. Jiangyin Jinling Hardware Products Co., Ltd.

Citation: The Supreme People's Court's Judgment No. Minsantizi 1/ 2001

Date of judgment: March 6, 2002

Procedural History

Ningbo Dongfang General Movement Plant (GMP) sued Jiangyin Jinling Hardware Products Co., Ltd. (Jinling) in Nanjing City Intermediate People's Court for infringement of its patent (ZL92102458.4). The court of first instance ruled that Jinling did not infringe said patent. The GMP appealed to the Jiangsu Province Higher People's Court, which upheld the former judgment. The GMP requested the Supreme People's Court for retrial of the case.

Issue

1. Whether a clearly defined claim could be restrictively interpreted on the basis of the specific embodiment presented in the description in claim construction?
2. Whether the doctrine of equivalents could be applied to the determination of two features of an allegedly infringing product, which had function and effect substantially the same as, but slightly inferior to, a feature of a patent claim, as an equivalent feature as a whole?

Facts

This case involved the patent for the invention of “bonding method of a sound board for a mechanical musical instrument and the equipment for the same”, which was aimed at reducing processing cost and improving the quality of sound teeth of the sound board. The products of Jinling were also apparatus for making mechanical musical instruments. The difference therebetween was

that the processing part, a metal blind plate, in the patented apparatus was clamped on a guide plate while the metal blind plate in the allegedly infringing equipment was fixed on a workpiece base plate; besides, in the allegedly infringing equipment, there was a shockproof limit plate, which was installed together with a tower-shaped cutting knife set and did not move in and out along with the metal blind plate.

The claims of said invention patent contained two independent claims, wherein the essential technical features, different from the allegedly infringing product, were respectively the third technical feature of claim 1: the metal blind plate fixing device was a guide plate with comb slits, a thick and wearable block plate with the comb slits functioned as guide slots being parallel to each other, evenly distributed and equal in width; and the third technical feature of claim 9: the metal blind plate was accurately positioned and clamped on the guide plate. The description of said patent further explained the processing method: “the blind plate receives cut-in processing of the rotating blade not in a cantilever hanging manner” in the portion of embodiments.

The first-instance court held that Jinling’s apparatus for making sound board did not have a guide plate device thereon; hence it lacked the claimed essential technical feature, and did not constitute an infringement.

The second-instance court held that:

1. The patent description had already expressly excluded the feature that the blind plate was not fixed on the guide plate, rather, it received cut-in processing of the rotating blade in a cantilever hanging manner from the claims, and therefore the allegedly infringing product did not fall into the extent of protection; and

2. The limit device of the allegedly infringing product lacked the essential technical feature that the guide plate of the patented technology could fix the blind plate, which changed its position in the apparatus and the combination relations between it and other components, thereby causing the cutting method different and resulting in difference thereof in intended use, function and effect; hence the limit device of the allegedly infringing product and the guide plate of the patented technology were not substitutes of equivalent technology.

The GMP argued in the request for retrial that:

1. The method, “the blind plate receives cut-in processing of the rotating blade not in a cantilever hanging manner”, stated in the description did not mean that such method was excluded from the claims, it only further described the best mode of carrying out the patented technology; and
2. If the limit plate and the workpiece base plate of the allegedly infringing product were combined together, the purpose, function and effect thereof were completely the same as the guide plate of the patented technology, so the doctrine of equivalents could apply.

Rule of Law

Article 56, paragraph one of the Patent Law *The extent of protection of the patent right for invention or utility model shall be determined by the terms of the claims; and the description and the appended drawings may be used to interpret the claims.*

Reasoning

1. Firstly, the substantive content of the claims should be taken as the standard in construction of the claims of a patent under Article 56, paragraph one, of the Patent Law. As long as the claims described the technical solution of the invention clearly, the claims should not be interpreted restrictively with specific embodiments described in the description. The claims of the patent of the GMP had already clearly defined the extent of protection sought; hence the claims should not be further defined based on the description.

Secondly, the embodiments in the description were the best mode of carrying out the patented technology, not the whole content of the patented technology, so could not be used to determine the extent of protection sought. If a patent included embodiments of the invention or examples of function or effect of the invention, the claims should not be construed as being limited to these embodiments or examples. This was a generally accepted principle. Although the description of the patent of the GMP presented such content as “since the blind plate is not in a cantilever shape during processing”, said content was stated in the embodiments of the description, and was not put in the independent claim. Therefore, the claimed subject matter should not be defined with the features that appeared in the embodiments. It was groundless to limit the extent of the independent

claim with the additional feature in the embodiments in the description to exclude the feature, “the blind plate receives cut-in processing of the rotating blade in a cantilever hanging manner”, of the allegedly infringing product and method from the extent of protection of the patent on the ground that said infringing product did not include said additional feature.

Therefore, the Jinling’s assertion that the mode of carrying out the invention that “the blind plate is fixed on the clamping device in a cantilever hanging manner” was excluded from the patent claims was not tenable. The claims should be construed by the terms of the claims, and the technical feature “the blind plate is fixed on the clamping device in a cantilever hanging manner”, which was not presented therein should not be taken into consideration.

2. Under Article 56, paragraph one, of the Patent Law and Article 17 of Several Provisions of the Supreme People’s Court on Issues Relating to Application of Law to the Trial of Case of Patent Disputes, the extent of protection determined with the essential technical features clearly presented in the claims, also including the extent as determined with features equivalent to said essential technical features, should be taken as the standard in the claims construction. Equivalent features referred to those features that used substantially the same means, performed substantially the same function, and achieved substantially the same effect as the presented technical features and that could be conceived by those of ordinary skill in the art without any undue burden.

The allegedly infringing product and the patented product were identical in operating principle and method. The main working faces of the two important parts, the guide plate and shockproof limit plate, were similar in structure and shape. The different technical features thereof could be acquired without any undue burden on the part of those of ordinary skill having the professional mechanical knowledge. Therefore, they were substantially the same in technical means.

The guide plate in the patent could be used not only to guide direction, but also to fix the blind plate. The shockproof limit plate and the workpiece base plate in the allegedly infringing product as a whole also performed the functions of guiding direction and fixing the blind plate, so the functions thereof were substantially the same as that of the guide plate in the patent. The practice that one technical feature, “guide plate”, of the allegedly infringing product was split into two

technical features respectively realizing two functions was one of common circumstances of substitution for equivalents.

The allegedly infringing product did not fix the workpiece on the shockproof limit plate, which was not conducive to reducing vibration and improving the quality, but this did not mean that the shockproof limit plate in the allegedly infringing product did not have any shockproof effect or the shockproof effect was different at all. In fact, the shockproof limit plate in the allegedly infringing product could not only resist shock, but also limit position, improving the quality of the sound piece and reducing the damage of the grinding wheel piece. This was substantially identical with the technical effect the patented product was intended to achieve. When comparing between the effect of the allegedly infringing product and that of the patent, we should not emphasize that they should be identical. It was ok as long as they were substantially the same. Good or bad effect of the patent and that of the allegedly infringing product and method would not affect judgment of infringement of the patent. The effect of the allegedly infringing product slightly inferior to that of the patent was a circumstance of a degraded implementation, which was also one of the manifestations of substitution for equivalents.

Therefore, the two technical features, the shockproof limit plate and workpiece base plate in the allegedly infringing product, as a whole, were the equivalents of the guide plate in the patent claim, which used substantially the same means, realized substantially the same function and achieved substantially the same effect.

Holding

1. The claims of the patent had clearly defined the extent of protection and could not be further defined according to the description.
2. The two technical features, the shockproof limit plate and the workpiece base plate in the allegedly infringing product, as a whole, were equivalent to the guide plate in the patent claim, which used substantially the same means, realized substantially the same function and achieved substantially the same effect. The allegedly infringing product should be established as infringement by equivalents.