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Dalian Renda New Wall Building Materials Plant v. Dalian Xinyi Building Materials Co., Ltd.,

Citation: The Supreme People's Court's Civil Judgment No. Minsantizi 1/2005

Date of judgment: August 22, 2005

Procedural history

The Dalian Renda New Wall Building Materials Plant (Renda) sued the Daliang Xinyi Building Materials Co., Ltd. (Xinyi) for infringement of its utility model patent (ZL98231113.3) in the Dalian Intermediate People's Court. In the first-instance judgment was found the infringement by equivalents. The Liaoning Higher People's Court affirmed the judgment. Xinyi requested the Supreme People's Court for trial of the case.

Issue

1. Whether it was allowable, under the doctrine of redundant designation, to find a missing technical feature in the allegedly infringing product as a non-essential technical feature of the claims?
2. Whether it was allowable, under the doctrine of equivalents, to find the difference in the number of the same components in the allegedly infringing product and the claims of the patent in suit as equivalent features?

Facts

Claim 1 of the patent in suit went like this:

A thin concrete barrel member, comprising a barrel pipe and barrel bottom, wherein said barrel

pipe and barrel bottom were respectively made of a stack of at least two layers of glass-fiber cloth.

Compared with that of the patent in suit, the barrel bottom of the Xinyi's allegedly infringing product did not contain the glass-fiber cloth, and the barrel pipe contained only one-layer of it.

The first-instance court held that the technical solution the barrel bottom containing the glass-fiber layer played only a minor role and could be disregarded. While the allegedly infringing product was different from the claim of the patent in suit in the number of layers of the glass-fiber cloth, they were of substantially the same technical solution as a whole; hence Xinyi's product constituted an infringement under the doctrine of equivalents.

The second-instance court affirmed the first-instance judgment, holding that the allegedly infringing product was identical with the claim of the patent in suit in technical conception, and their difference in the number of glass-fiber layers was merely a change in the number thereof, without producing any substantial change or variation.

Xinyi argued, in its appeal to the Supreme People's Court, that:

1. The doctrine of redundant designation was not applicable since the structure of the barrel bottom was an important, distinctive technical feature; and
2. The doctrine of equivalents only applies to individual technical features, not the whole technical solution.

Renda responded that:

1. Unlike at the barrel pipe, addition of glass-fiber layer at the barrel bottom would not improve the tensile strength. For this reason, the barrel bottom structure was not an essential technical feature, and thus was disregardable; and
2. The difference in the number of the layers was not a substantial difference. With the technical

means, function and effect being substantially the same, the doctrine of equivalents was applicable.

Rule of law

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

Rule 20 of the Implementing Regulations of the Patent Law *The claims shall include the technical features of the invention or utility model, and define clearly and concisely the subject matter for which protection is sought.*

Rule 21 thereof *The claims shall include independent claims, and may also contain dependent claims. The independent claim shall outline the technical solution of an invention or utility model and include the essential technical features necessary for the resolution of its technical problem.*

Reasoning

1. Under the explicit provisions of Rules 20 and 21 of the Implementing Regulations of the Patent Law, the claims should define clearly and concisely the subject matter for which protection is sought, and the independent claim should include the technical features necessary for resolving the intended technical problem. All the technical features a patentee puts in the independent claim are essential technical features, and none of them should be disregarded. Instead, they should be compared with the technical features of the accused product. It is usually not advisable to apply the so-called doctrine of redundant designation.

Under Article 56, paragraph one, of the Patent Law, the extent of protection of a patent for an invention or a utility model shall be determined by the terms of the claims. The claims function to inform the public of what acts would infringe the patent. Only by giving a full and sufficient respect for all the technical features in the claims would it be made possible for the public not to be faced with unpredictable changes made in the claims, so as to ensure the certainty of the legal right, and fundamentally guarantee the normal operation of the patent system and realize the value

of the patent.

For these reasons, Renda's assertion that the barrel bottom wall-layer structure was not an essential technical feature was not tenable. Instead, the feature of the barrel bottom having at least two layers of glass-fiber cloth was an essential technical feature, and must be taken into account in the claim construction.

2. Under Article 56, paragraph one, of the Patent Law, the extent of protection of a patent for an invention or a utility model shall be determined by the terms of the claims. The description and the drawings may be used to interpret the claims. Since the phrase "at least two layers" was used in the claims of the patent in suit in enumerating the glass-fiber layers and it is also clearly stated in the description that the layers of the glass-fiber cloth may be at least two, the claim should not be construed beyond its explicit definition.

The difference in the number of layers of the glass-fiber cloth should not be merely taken as a quantitative difference. The layers played a different role in terms of physio-mechanics. Specifically, they produced a different compressive strength, inner cavity capacity and weight of floors. The barrel pipe part containing "at least two layers of glass-fiber cloth" will achieve a better technical effect than that containing only "one layer" in terms of improved compressive strength, reduced floor weight and increased inner caving capacity. Therefore, they are by no means "substantially the same" in terms of technical solution, function and result.

Holding

1. The technical feature of the barrel bottom having glass-fiber cloth is an essential technical feature, and must be take into account in the claim construction. That is, the doctrine of redundant designation should not apply.

2. "One layer of glass-fiber cloth" in the accused product is not identical with, nor equivalent to the feature of "at least two layers" in the claim of the patent in suit.