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≪１級課題 -知財法務実務-≫

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（３）文中に引用されている他の判決等の文献の記載（In re Thorpe, 777 F.2d 695, 697 (Fed. Cir. 1985)等）は、訳出せずに英語のまま日本語翻訳文中に残してかまいません。

以下問題文→
DISCUSSION
Product-by-Process

***** START ***** Kamstrup argues that the Board erred in construing“cast in one piece” as a product-by-process claim element. A product-by-process claim is one in which a product is claimed, at least in part, by the “process by which it is made.” In re Thorpe, 777 F.2d 695, 697 (Fed. Cir. 1985).

Product-by-process claims “enable an applicant to claim an otherwise

patentable product that resists definition by other than the process by which it is made." Id. "In determining validity of a product-by-process claim, the focus is on the product and not the process of making it. That is because of the . . . long-standing rule that an old product is not patentable even if it is made by a new process." Greenliant Sys., 692 F.3d at 1268 (citations omitted).
***** END *****

"As we recognized in Amgen, if the process by which a product is made imparts 'structural and functional differences' distinguishing the claimed product from the prior art, then those differences 'are relevant as evidence of no anticipation' although they 'are not explicitly part of the claim.'" Id. (quoting Amgen Inc. v. F. Hoffman-La Roche Ltd, 580 F.3d 1340, 1365–67 (Fed. Cir. 2009)). The specification, the prosecution history, and any extrinsic evidence may enlighten whether structural and functional differences exist. Amgen, 580 F.3d at 1365–67; Purdue Pharma L.P. v. Epic Pharma, LLC, 811 F.3d 1345, 1353–54 (Fed. Cir. 2016).

For example, in Amgen, we determined that a district court correctly granted JMOL that a prior art reference did not anticipate a product-by-process claim. 580 F.3d at 1365–67. The claim was directed to a chemical compound "purified from mammalian cells grown in culture." Id. The prior art, however, was a similar chemical compound but purified from urine. Id.

We held that the district court correctly found no anticipation because the evidence showed that the chemical compound "purified from mammalian cells grown in culture" had different structural and functional differences from the prior art. Id. at 1367. The district court correctly considered that "the specification and prosecution history of the [] patent . . . refer to studies indicating that [the claimed chemical compound] had a higher molecular weight and different charge than [the prior art] due to differences in carbohydrate composition." Id. The district court also properly considered an expert declaration in the prosecution history and trial expert testimony that similarly evidenced the structural and functional differences between the claimed product and prior art. Id.; see also Purdue Pharma, 811 F.3d at 1353–54 (finding that the district court did not err in disregarding a

product-by-process limitation for an obviousness determination where the specification and the patentee's expert testimony evidenced that the process "imparts no structural or functional differences in the [claimed product] as compared to the prior art products"); Greenliant Sys., 692 F.3d at 1271 ("[The patentee's] arguments clearly and unmistakably represented to the examiner and the Board that [the process] . . . imparted the distinct structural characteristics upon [the patentee's] claimed [product].").

***** START ***** Turning to this case, the first question is whether the Board correctly determined that "cast in one piece" is a product-by-process claim element. Here, the claim language confirms that it is. See Amgen, 580 F.3d at 1367 ("[B]y its plain terms, claim 1 of the [] patent claims a product with a [process] limitation."). The claim describes "a monolithic polymer structure being cast in one piece." '957 patent at 6:40–42. On its face, the claim element claims a process because it describes the structure "being" cast in a particular way. See Greenliant Sys., 692 F.3d at 1264–65 (product-by-process claim elements recited a product "being formed" a certain way).

Kamstrup argues that "[t]he mere mention of a process in a claim limitation does not automatically convert that limitation into a process limitation." Appellant's Br. 31. While that may be true, Kamstrup does not explain why we should disregard the fact that the claims recite a process here. Nor does Kamstrup point to disclosure in the specification that describes structure for the term. Instead, Kamstrup relies on disclosure discussing the fabrication process for the device—further support that this is a product- by-process claim element. Id. at 21–23 (quoting '957 patent at 2:6–15) (emphasis added) (The "flow meter . . . can be fabricated with a reduced number of steps compared to existing meters, since only a single step is used to form the monolithic polymer structure . . . . [A] flow meter housing which has a straight flow section separated from a cavity in a manner where a part of the wall of the flow section is part of the inside of the cavity [] can . . . be cast in a single step . . . ."). We therefore conclude that the Board did not err in finding that "cast in one piece" is a product-by-process claim element.

***** END *****

The second question is whether the product-by-process claim element imparts patentable weight to the claims. Greenliant Sys., 692 F.3d at 1268. We conclude that it does not.

Kamstrup argues that the Board erred in finding that there are no functional or structural differences between polymer structures cast in a single mold versus multiple molds. Appellant's Br. 32–34. Kamstrup states that "various structures . . . cannot be cast in a single mold using conventional die cast injection molding technologies." Id. at 34 (emphasis added); Reply 24–26.

First, even if true, Kamstrup has not identified functional and structural differences between a structure "cast in one piece" and a structure manufactured using another method. Rather, the argument is merely that the claim element describes a manufacturing method with some inherent restrictions. Further, Kamstrup has not identified disclosure in the specification or prosecution history or extrinsic evidence evidencing structural and functional differences.

Second, the alleged structural and functional difference that Kamstrup identifies is detached from the claims. The claims state that the structure should be "cast in one piece," not cast in one mold. '957 patent at 6:40–42 (emphasis added). The Board correctly found that the written description "focuses on reducing the number of steps required to fabricate the flow meter housing, not on casting in a single mold." Axioma, 2021 WL 1235790, at *7 (citing '957 patent at 1:55–57, 2:6–9). While certain figures of the written description, namely Figures 5A and 5B, depict a single mold, the Board correctly found that those embodiments are narrower than the claims—which do not require use of a single mold—and correctly declined to import narrower limitations from the specification to the claims. Id. Substantial evidence also supports the Board's finding that the extrinsic evidence does not exclusively show that "cast in one piece" means "cast in one mold." Id. at *8.

Consequently, we hold that because Kamstrup fails to show that the process claimed imparts "structural and functional differences" distinguished from the prior art, it is not entitled patentable weight.

Greenliant Sys., 692 F.3d at 1268.

【翻訳不要／参考】該当ＵＳ特許のクレーム１

1. An ultrasonic flow meter housing comprising:

a monolithic polymer structure being cast in one piece, the monolithic structure includes a flow tube and a cavity separated from the flow tube, wherein the flow tube defines a through-going straight flow section arranged for passage of a fluid between an inlet and an outlet, wherein a part of a wall of the flow section is part of an inside surface of the cavity, so that the flow section and the cavity has a shared wall area; and wherein the cavity is arranged for housing

at least one ultrasonic transducer, at the shared wall area; and

a measurement circuit operationally connected to the at least one ultrasonic transducer so as to allow measurement of a flow rate of the fluid.

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