

Judgments of Tokyo District Court, 47th Civil Division

Date of the Judgment: 2005.2.25

Case Number: 2004(Wa)No.11487

Title(Case):

Concerning an action to bring a lawsuit over a patent infringement, a case wherein a claim for damages was dismissed by reason that the action to bring a lawsuit was unlawful.

Summary of the Judgment:

The defendant of the counterclaim is a patent owner of a “Contents-linking service device that first reduces the quantity of web-based data contents and then transfers them via linkage over the internet.” The plaintiff of the counterclaim offers rate reduction services for packet telecommunication called “PocketPacket” on an Internet website <http://pocketpacket.jp/>.

The defendant of the counterclaim, against the plaintiff of the counterclaim, alleged that the service was being provided using (an) item(s) specified on a list of items and that the use of this (these) item(s) infringed a patent right, and claimed, according to the patent, an injunction to restrain the use of the item and requested a payment of 33 million yen as compensation for damages (the original claim). In response, the plaintiff of the counterclaim brought a counterclaim against the defendant of the counterclaim for a payment of 20 million yen in torts claiming that the action of bringing forth the original claim was unlawful. The defendant of the counterclaim abandoned the original claims, so only the counterclaim remained in this case.

The judgment held that the the only way an action made against the opposite party could be called unlawful was if it was proven that the actions lacked justice significantly in the context of the intent and purpose of the judicial system, and if, as the rights or legal relationships alleged by the pursuer in the action lacked the factual and/or legal grounds, said person was aware of the situation or could easily come to know of the situation as an ordinary person but in spite of this ventured to bring about the action. With this, each cause of action alleged by the plaintiff of the counterclaim was judged accordingly.

First, regarding the assertion that the specified item(s) of the plaintiff of the counterclaim was (were) not identified, the judgment held that “in a lawsuit of a claim for an injunction based on a patent right, the allegation that specifies the product or the method by which the opposite party’ s infringing actions was committed in order to decide the objective scope of the res judicata of a judgment by specifying the subject

of appeal or the subject-matter as the subject of claiming an injunction and in order to specify the subject of the enforcement, and is also needed in order to determine the feasibility of the patent infringement by comparing whether the product or the method are within the technical scope of the patented invention. Therefore, a person who brings a claim for an injunction based on a patent right should specify the subject of appeal or the subject-matter and the subject of the enforcement, and should specify and allege the product or the method that produce the opposite party's infringing actions to the extent that the feasibility of the patent infringement can be decided. In addition, when this is seen in the view of the opposite party's defense action in a lawsuit, it is required that the product or the method being targeted is specified concretely to the degree that it can be distinguishable from others based upon social convention."

Because the subject of claiming an injunction in the original claim was distinguishable from others based upon social convention, and because what product or method this subject indicated could be easily understood by at least the plaintiff of the counterclaim, the judgment decided that it was not discerned through the claims that specified the item of the plaintiff of the counterclaim by the defendant of the counterclaim or that proved the existence of the item were not satisfied.

Next, concerning the claim that the original claim was brought about in spite of no satisfaction of constituent features, the judgment held that "when declaring a patent litigation lawsuit, a patent owner should investigate whether the product or the method that are alleged to be the source of an infringing action are within the technical scope of a patented invention, and then he should bring the claim. However, though it may be judged that the product or the method that are alleged to cause an infringing action are not within a technical scope of a patented invention, and that, as a result, they do not infringe the patent right, or though the patent owner may abandon the claim himself, one of the above facts does not necessarily make the execution of actions correspond to malfeasance against the opposite party." In this case, because it was not proven that the defendant of the counterclaim who was the patent owner ventured to bring about an action while knowing that his claim that the product or the method made a infringing action lacked the factual and/or legal grounds, or that he easily came to know of that situation as an ordinary person, the judgment held that the execution of actions did not correspond to malfeasance.

Moreover, with respect to the claim that the defendant had filed a false statement, the judgment held "because parties should prosecute a civil action faithfully according to good faith, filing false evidence violates the above responsibility. When false evidence that lacks the justice significantly in the context of the intent and purpose of the judicial system is made voluntarily, and when an action is brought on the grounds of the evidence, the institution of the action can be evaluated as illegal one. However, when the content of the statement by the party or the party's employee consequently

includes the description which is different from an objective fact, only the one fact does not make the institution of actions correspond to malfeasance.” The judgment dismissed the action of the defendant of the counterclaim.

In relation to the claim that the patent right was invalid, the judgment held that “in the patent infringement litigation, though it may be judged that the claim of a patent owner is consequently impermissible because it is clear and convincing that the patent contains a reason of an invalidity, that single fact does not make the institution of actions correspond to malfeasance against the opposite party.” Because it was not proven that the defendant of the counterclaim who was the patent owner ventured to bring an action although he knew that the patent contained a reason of invalidity, or although he easily became to know that situation for an ordinary person, the judgment held that the institution of actions did not correspond to malfeasance. Additionally, when trial decision for correction became irrevocable after the institution of actions, it should be discussed whether the patent owner ventured to bring an action although he knew that it was clear and convincing that the patented invention after the correction still contained a reason of invalidity, or although he easily became to know that situation for an ordinary person. Regarding, the patented invention after the correction, because the Patent Office decided the decision of maintenance of the patent for the reason that the patent invention could not be easily made on the basis of an invention described in a publication and so on, it was not clear and convincing that the patented invention after the correction contained a reason of invalidity.

As mentioned above, because it was apparent that there was no place to decide that the original claim by the defendant of the counterclaim lacked justice significantly, at least in the context of the intent and purpose of the judicial system, it is physically impermissible that the institution was malfeasance; on these grounds, the judgment dismissed the claim made by the plaintiff of the counterclaim.

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