

Judgments of Tokyo District Court, 47th Civil Division

Date of the Judgment: 2006.10.24

Case Number: 2006 (Wa)No. 17644

Title (Case):

A case wherein the court found a drawing of a machine uncopyrightable

Summary of the Judgment:

The plaintiff was the owner of a patent (disputed patent) for an invention named “Electric discharge sintering device.” Before this lawsuit was filed by the plaintiff, the defendant filed patent opposition against the aforementioned patented invention and had the disputed patent revoked. In response, asserting against the defendant that the aforementioned patent opposition constituted a tort, the plaintiff filed a lawsuit twice in order to demand 100,000 yen as a partial payment of the damages. The court made the final decision to dismiss the plaintiff’s claim (previous lawsuit). The plaintiff prepared a drawing of the electric discharge plasma sintering device. The defendant also prepared a similar drawing and produced said device. In this lawsuit, the plaintiff made the following claims against the defendant: (1) the primary claim for 100,000 yen as a partial payment of compensation for the damage of 1.5 billion yen on the allegation that the aforementioned patent opposition constituted a tort because it may be regarded as the abusive exercise of right and (2) the secondary claim for 100,000 yen as a partial payment of compensation for the damage of 100 million yen based on the allegation that the defendant infringed the plaintiff’s copyright.

The court found that the plaintiff’s primary claim was made in this lawsuit on the same grounds that the plaintiff had given to make a claim for damages in the previous lawsuit. In this lawsuit, the plaintiff demanded the remaining part of the damages on those grounds. The court therefore concluded that the plaintiff was merely repeating the claim refused in the previous lawsuit in substance. Thus, the court dismissed the plaintiff’s claim by holding that the plaintiff’s act of claiming damages based on the allegation that the defendant’s act of filing the patent opposition constituted a tort was against the principle of faith and therefore impermissible.

In the meantime, with regard to the secondary claim, the court presented its interpretation that tentative joinder would be permitted only if two or more claims made in a lawsuit are logically incompatible with each other and that the tentative joinder of claims that are logically compatible with each other may be permitted only in the case of concurrent rights of action seeking the same benefits or a formative effect. The court found that, while the plaintiff’s primary claim and the secondary claim were logically compatible claims, they may not be regarded as concurrent rights of action seeking the same benefits but may be regarded to lack relationships under substantive law. Based on this finding, the court concluded that the type of joinder in this case should be regarded as simple joinder and judged that such a joinder was impermissible since it did not meet the conditions for joinder in view of the fact that the plaintiff stated that it had no intention of changing the type of joinder in this lawsuit despite the recommendation of the court.

The court further stated that, since the drawing of the electric discharge plasma sintering device that the plaintiff alleged that the defendant had infringed was a drawing of a machine, the

defendant had little choice in terms of the form of expression due to the nature of drawing. The court therefore concluded that it was inevitable for the defendant to adopt a similar form of expression to prepare a drawing of the same machine. Based on these grounds, the court judged that the act of producing a machine based on the disputed drawing did not constitute an act of reproduction under the Copyright Act (Article 2, para.1, item 15 of Copyright Act) by holding that the disputed drawing was uncopyrightable due to insufficient grounds for recognizing creative expression in the drawing (Article 2, para.1, item 1 of said Act).

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