

Date	January 19, 2012	Court	Osaka District Court, 26th Civil Division
Case number	2010 (Wa) 5655 (Case A) 2011 (Wa) 1443 (Case B)		
– A case wherein the court found that a free license was granted with respect to an invention titled "apparatus and method for measurement of rock deformation."			

In this case, the plaintiffs (a former university assistant professor and a company to which said person serves as the advisor) alleged against the defendant that the defendant's product infringes the plaintiffs' patent right and claimed return for unjust enrichment in an amount of 27,400,000 yen in total (Case A) and the plaintiff company in question (the "Plaintiff Company") claimed against the defendant payment of 1,134,000 yen as the amount of the technical license fee based on the technical license agreement (principal action). Meanwhile, the defendant alleged that it paid a license fee to the Plaintiff Company although the defendant did not work the art covered by the patent licensing agreement and claimed return for unjust enrichment in an amount of 795,795 yen in total (counterclaim; "Case B").

In this judgment, the court dismissed all of the claims made by the plaintiffs in Case A and those made by Plaintiff Company in Case B as a principal claim, while partially upholding the claims made in Case B as a counterclaim.

The major issue of Case A is [i] whether or not the plaintiffs granted to the defendant a free license for the patent in question in Case A, while the major issues in Case B are [ii] the contents of the agreement entered into between the plaintiffs and the defendant and [iii] establishment of payment of non-obligation.

With respect to Issue [i], the court took into consideration the fact that the defendant manufactured the defendant's product at the request of the Plaintiff P1 and under the instructions and supervision thereof and sold such product to the Plaintiff P1's place of work at that time and found that the plaintiffs granted a free license to the defendant to work the patent in question in Case A.

With respect to Issue [ii], the court found that the agreement entered into between the plaintiffs and the defendant is a patent licensing agreement as alleged by the defendant instead of a technical license agreement as alleged by the Plaintiff Company, based on the contents of the agreement. With respect to Issue [iii], the court found establishment of payment of non-obligation for part of the payments made by the defendant.