

Date	December 17, 2014	Court	Intellectual Property High Court, Second Division
Case number	2013 (Ne) 10025		
– A case in which the court partially accepted the appellant's claim for payment of damages made based on a patent right for the invention titled "metal shelf and metal wagon" by modifying the judgment in prior instance in which the court of prior instance examined the appellant's claim for payment of damages and dismissed the appellant's claim by holding that said patent right shall be invalidated on the grounds of the lack of an inventive step.			

References: Article 70, Article 102, paragraph (2), Article 104-3, and Article 29, paragraph (2) of the Patent Act and Article 719 of the Civil Code

Number of related IP rights, etc.: Patent No. 4473095, Publication of Unexamined Utility Model Application No. 1987-85140, Publication of Unexamined Patent Application No. 2000-60656, US Patent Description No. 4351246, Publication of Examined Utility Model Application No. 1981-27793, Publication of Unexamined Utility Model Application No. 1984-20014, Publication of Examined Utility Model Application No. 1966-2774

Summary of Judgment

In this lawsuit, the appellant, who holds a patent right (the "Patent Right") for an invention titled "metal shelf and metal wagon" (the "Invention"), alleged that the appellees' act of manufacturing, selling, or otherwise handling the appellees' products constitutes infringement of the Patent Right and demanded payment of damages for the act of tort.

In the judgment in prior instance (Judgment of the Osaka District Court of 2011 (Wa) 11104 dated February 28, 2013), the Osaka District Court held that any person ordinarily skilled in the art could have easily conceived of the Invention based on the invention presented in Publication of Unexamined Utility Model Application No. 1987-85140, and accepted the appellees' patent invalidity defense raised under Article 104-3 of the Patent Act, and thereby dismissed the appellant's claim.

In this judgment, however, the Intellectual Property High Court dismissed all of the patent invalidity defense raised under Article 104-3 of the Patent Act by holding that any person ordinarily skilled in the art could not have easily conceived of the Invention based on the inventions presented in Publication of Unexamined Utility Model Application No. 1987-85140, Publication of Unexamined Utility Model Application No. 1984-20014, and Publication of Examined Utility Model Application No. 1966-2774.

Then, the court recognized that the appellees' liability for joint tort in consideration

of the facts that Appellee X was able to manufacture the appellees' products based on the trust that Appellee Y, which has strong sales capabilities, would certainly purchase all of the appellees' products and that Appellee Y was able to ensure the supply of goods by exclusively purchasing the products manufactured by Appellee X.

Regarding the calculation of the amount of damage specified in Article 102, paragraph (2) of the Patent Act, based on the marginal profit theory, the court recognized the customer-appeal effect produced by the Invention and the incapability of any other metal wagon to serve as a substitute or competing product. On the other hand, the court permits a partial reduction of the presumed amount of damage on the grounds of the solidification of the appellees' customer base due to the sales method of the appellees' products and the strong sales capabilities of Appellee Y.