Approach to Innovation on IP-related Litigation in Japan

Masaki SUGIURA Judge of Intellectual Property High Court of Japan

Overview

- 1. Matters brought by Innovation
- Measures (1)
 against Technical Difficulties
- Measures (2)
 against Difficult Legal Issues
- 4. Others

Matters brought by Innovation (1) Technological innovation, especially in ICT field recently, may bring –

1. Technical Difficulties;

The issue in dispute is often related to a complex, highly specialized technical matter.

Necessity to introduce and use expert knowledge of technology

Matters brought by Innovation (2) Technological innovation, especially in ICT field, may bring –

2. Difficult Legal Issues;

The issue in dispute is often unprecedented and influential about contract, infringement, validity of IP right, etc.

Necessity to make a decision taking various factors into account carefully

Measures(1)

- against Technical Difficulties (1)
- Judicial Research Officials (1)
 - 1. Full-time court official
 - 2. No statutory term in general
 - 3. Salary paid for full-time official
 - 4. Not expected to be questioned
 - 5. Carry out research on necessary matters as ordered by the court and report the research result.
 - 6. The research results may not be adopted as evidence.

Measures (1) - against Technical Difficulties (2) • Judicial Research Officials (2)



Office of Judicial Research Officials

Technical Briefing by Judicial Research Official



Measures (1) - against Technical Difficulties (3)

Technical Advisors (1)

- 1. Part-time court official
- 2. Two years
- 3. Allowance paid for each case
- 4. Not expected to be questioned
- 5. Provide easy-to-understand explanations on scientific matters as the court's advisor.
- 6. The explanation may not be adopted as evidence.

Measures (1) - against Technical Difficulties (4)

Technical Advisors (2)



Part time court members (more than 200): university professors etc *All belonging to 3 courts: IP High Court, Tokyo District Court, Osaka District Court



Measures (1) - against Technical Difficulties (5) Technical Advisors (3)



Practical case-study seminars for technical advisors

July 22 2016

Measures (1) - against Technical Difficulties (6)

Explanatory Sessions (1)



- Attorney for the Plaintiff
- 2 Technical Advisor
- **3** Judge
- **4** Judicial Research Official
- **5** Attorney for the Defendant



Measures (2) - against Difficult Legal issues (1)

- Grand Panel (1)
 - In principle, IP High Court handles cases through a panel of 3 judges.
 - Under some requirements stipulated by law, IP High Court may handle a case through a panel of 5 judges called 'Grand Panel'.

Measures (2) - against Difficult Legal issues (2) • Grand Panel (2)

- Appeal against an action relating to a patent, etc., which is under the exclusive jurisdiction of the Tokyo High Court
- Suit filed against an appeal/trial decision made by JPO with regard to a patent or utility model

Measures (2) - against Difficult Legal issues (3) • Grand Panel (3)

- To control proceedings with greater care for -
 - cases which require especially highly specialized, technical knowledge
 - cases the outcome of which would give great impact on business activities and the industrial economy

Measures (2) - against Difficult Legal issues (4) • Grand Panel (4)



Measures (2) - against Difficult Legal issues (5) • Grand Panel (5)

 The four presiding judges from each of the four ordinary divisions are usually taken on as members of the panel in principle.

 This system allows the IP High Court to maintain the consistency of its legal interpretation.

Measures (2) - against Difficult Legal issues (6) An attempt to ask a large number of people interested in issues like Amicus Curiae

- > 'Whether there is any restriction on practice of rights to seek an injunction or damages based on a patent that is essential to the standard set by a standard setting organization when so-called (F)RAND declaration is made.'(from the website of Morrison & Foerster LLP)
- > Both parties advertised it and submitted 58 opinions(39 persons and 18 organizations/companies from 8 countries) as $\frac{\text{documentary evidences.}}{_{July 22 2016}}$

Others

Dissemination of Information
International Harmonization

- Participation in international conferences
- Study groups with a global perspective
- Website <u>http://www.ip.courts.go.jp/eng/index.html</u>
 - IP judgments are translated into English. -see <u>http://www.ip.courts.go.jp/eng/hanrei/index.html</u>

Thank you!