

Patent Right	Date	August 20, 2020	Court	Tokyo District Court, 47th Civil Division
	Case number	2019 (Wa) 3141		
- A case in which the court dismissed the Plaintiff's claims against the Defendants for an injunction, disposal of the allegedly infringing product, and compensation for damages, which were filed based on the alleged infringement of the patent right for an invention titled "Cleaning device for imaging device with interchangeable lens and cleaning method for imaging device with interchangeable lens."				

### Summary of the Judgment

In this case, the Plaintiff, which owns a patent right jointly with Defendant 1 based on a patent for an invention titled "Cleaning device for imaging device with interchangeable lens and cleaning method for imaging device with interchangeable lens" (the "Patent Right" and the "Patent"), alleges as follows. The Plaintiff concluded a business collaboration agreement with Defendant 1 (the "Business Collaboration Agreement"), and the Defendants have manufactured and sold pieces of a product using the invention covered by the Patent Right (the "Defendants' Product"). The Defendants' act of manufacturing and selling the Defendants' Product on or after the day following the expiration date of the license under the Business Collaboration Agreement, on the part of Defendant 1, constitutes breach of the special provisions of that agreement (the "contract" referred to in the phrase "unless otherwise agreed upon in a contract" in Article 73, paragraph (2) of the Patent Act), and the same act of manufacturing and selling, on the part of Defendant 2, constitutes infringement of the Plaintiff's co-ownership interest in the Patent Right. Based on these allegations, the Plaintiff demands the Defendants to stop manufacturing and selling the Defendants' Product, dispose of the Defendants' Product, and compensate for damages, and also demands Defendant 1 to pay the unpaid license fee under that Business Collaboration Agreement and perform the procedure to register the transfer of the whole of Defendant 1's co-ownership share in the Patent Right.

In this judgment, the court pointed out as follows. The patent application regarding the Patent was filed by Defendant 1 as the sole applicant, designating the Plaintiff as the inventor, and after that, the Business Collaboration Agreement was concluded between them, with the special provisions that the Patent Right shall belong to the Plaintiff even though the applicant was Defendant 1. The special provisions do not literally reject an interpretation that besides the Plaintiff, Defendant 1 is entitled to the

Patent Right. In fact, the Plaintiff was additionally mentioned as another applicant within the validity period of that agreement (one year; not automatically extended), the establishment of the Patent Right was registered under the names of both Defendant 1 and the Plaintiff, and they ultimately came to co-own the Patent Right. The court also indicated that it is unnatural and unreasonable to consider that Defendant 1 concluded an agreement under which Defendant 1, despite its spending of a considerable amount of capital and labor in the commercial development of the Defendants' Product, would be unable to manufacture and sell the Defendants' Product without the Plaintiff's consent after the expiration of the validity period of the agreement. Accordingly, the court found, as a natural premise of the Business Collaboration Agreement, that Defendant 1 would use the Patent Right as long as it holds a co-ownership interest in it. The court interpreted the Business Collaboration Agreement as meaning that Defendant 1, which makes sales by actually manufacturing and selling the Defendants' Product, comprehensively agreed to decide on matters including its payment to the Plaintiff, which is another co-owner of the Patent Right, and explained that this agreement has terminated upon the expiration of the validity period of the Business Collaboration Agreement. In conclusion, the court dismissed all of the Plaintiff's claims against the Defendants.