

Date	March 14, 2017	Court	Intellectual Property High Court, Fourth Division
Case number	2016 (Ne) 10100		
<p>– A case in which the court found that, even if there are reasons for invalidation of a patent, the exercise of rights by the patentee would not be restricted under Article 104-3, paragraph (1) of the Patent Act, in the case where [i] a request for correction (or a request for a trial for correction) has been legally made (if such request cannot be made because the patentee's right to request correction or request a trial for correction is restricted, a declaration has been made to the effect that such request for correction (or a request for a trial for correction) will be made when it becomes possible), [ii] the grounds for invalidation ceased to exist thanks to the aforementioned correction, and [iii] the product in question falls within the scope of claims after the correction.</p>			

References: Article 104-3, paragraph (1) of the Patent Act

Numbers of related rights, etc.: Patent No. 5641623, Patent No. 5641624, and Patent No. 5641625

Summary of the Judgment

The appellant, who holds a patent right for an invention titled "electric fishing reel," alleged that the appellee's act of selling or otherwise handling the appellee's product constitutes infringement of Patent Rights 1 to 3. The appellant demanded against the appellee [i] an injunction against the appellee's act of manufacturing, assigning, or otherwise handling the appellee's product and disposal thereof under Article 100 of the Patent Act, and [ii] the payment of damages based on the right to demand damages for an act of tort.

In the judgment in prior instance, the court dismissed all of the appellant's claims by holding that Patents 1 to 3 should be invalidated by a trial for invalidation of the patents. Dissatisfied with the judgment, the appellant filed this appeal.

In this judgment, the court held as follows in summary regarding the counterclaim made based on corrections and found that, while the appellee's product falls within the technical scope of the inventions in question, since it can be still considered to be reasonable to invalidate Patents 1 to 3 by a trial for invalidation of the patents even after the corrections, the appellant shall not exercise Patent Rights 1 to 3 against the appellee. On these grounds, the court dismissed this appeal.

(1) Counterclaim made based on corrections

Even if there are reasons for invalidation of a patent, the exercise of rights by the patentee would not be restricted under Article 104-3, paragraph (1) of the Patent Act, in the case where [i] a request for correction (or a request for a trial for correction) has

been legally made (if such request cannot be made because the patentee's right to request correction or request a trial for correction is restricted, a declaration is made to the effect that such request for correction (or a request for a trial for correction) will be made when it becomes possible), [ii] the grounds for invalidation ceased to exist thanks to the aforementioned correction, and [iii] the product in question falls within the scope of claims after the correction.

(2) Whether the grounds for invalidation ceased to exist or not

In consideration of the related facts, a determination should be made as to whether or not the grounds for invalidation based on Invention Otsu 18, i.e. the lack of an inventive step, ceased to exist thanks to the corrections, in other words, whether any person ordinarily skilled in the art could have easily made the corrected inventions based on Invention Otsu 18.

... As mentioned above, it can be found that any person ordinarily skilled in the art could have easily made the corrected inventions based on Invention Otsu 18 and that the grounds for invalidation of the inventions (the lack of an inventive step based on Invention Otsu 18) did not cease to exist even after the corrections.

(3) ... Therefore, the appellant shall not exercise Patent Rights 1 to 3 against the appellee (Article 104-3, paragraph (1) of the Patent Act).