

# Panel Discussion

知的財産紛争解決の国際比較

IP Dispute Resolution at  
Various Jurisdictions

JSIP2023  
COURT PART

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# Process of IP Infringement Cases

## **Presentations**

**1 Chief Judge HONDA from JAPAN**

**2 High Court Judge LEE and Mr.HAN from KOREA**

**3 Justice VARMA from INDIA**

# Process of IP Infringement Cases

## Discussion (Q&A)

*(it might be omitted)*

### Korea

- (1) Revision of the jurisdiction
- (2) ECFS

### India

- (3) Interim order

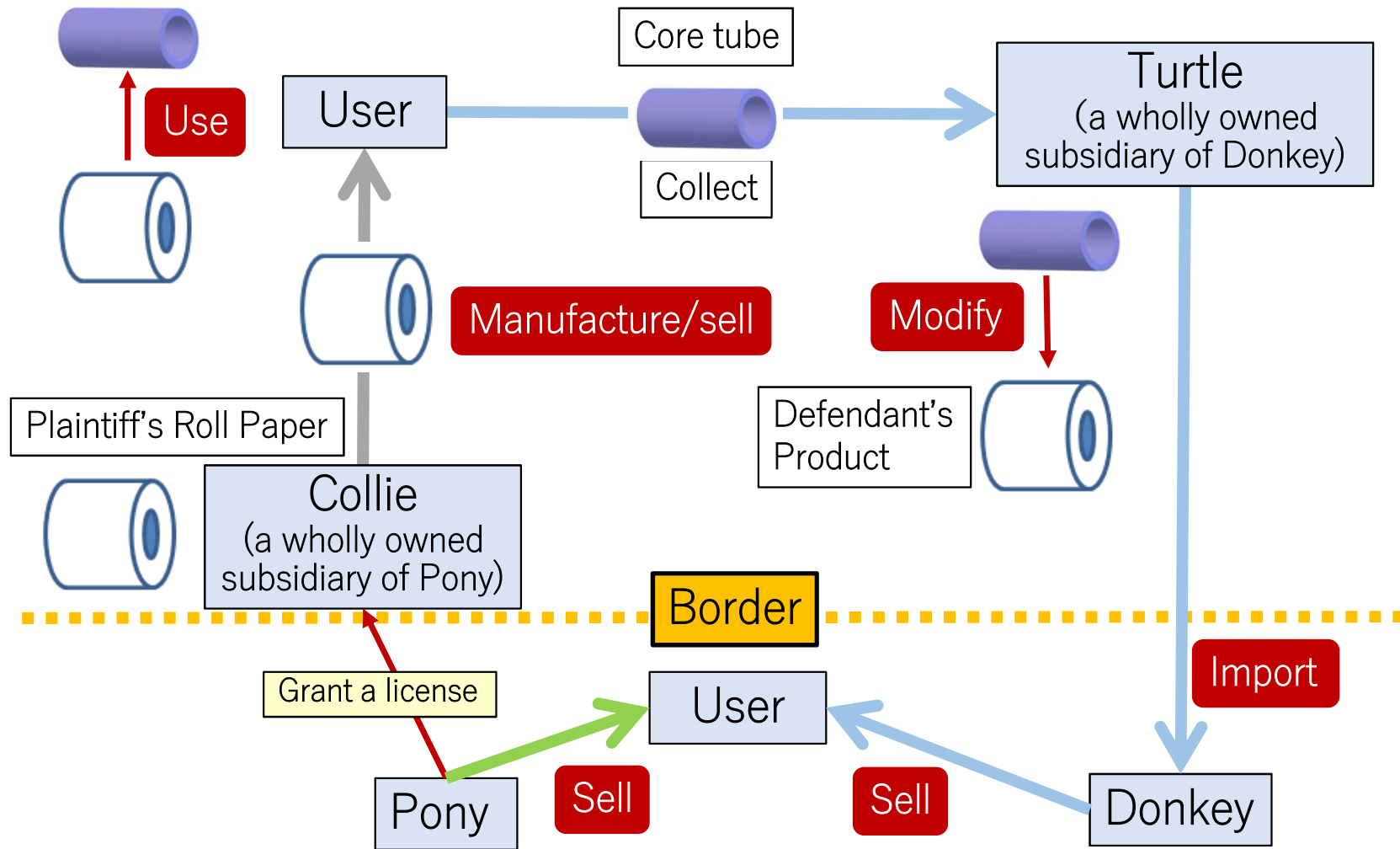
# Mock Trial

Foreign Country

Country B  
(Corresponding Patent Right)

Country A  
(Patent Right)

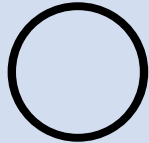
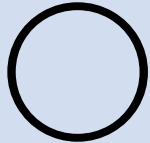
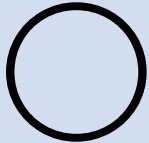
Domestic



# Judgment

Japan	Korea	India
 <b>Affirmed</b> 認容	 <b>Affirmed</b> 認容	 <b>Dismissed</b> 棄却
International Exhaustion virtually YES [ implied license ]  <b>New Product</b> <b>(Impermissible)</b>	International Exhaustion YES  <b>New Product</b> <b>(Impermissible)</b>	International Exhaustion YES [ Patent Act 107A(b) ]  <b>Refurbishment</b> <b>(Permissible)</b>

# International exhaustion/implied license

Japan	Korea	India
 with a few exceptions		
NO STATUTES  BBS Parallel Import Case Supreme Court, 1995(O)1988 July 1, 1997	NO STATUTES  Seoul District Court (Eastern Branch), 81GaHap466, July 30, 1981	Patent Act 107A(b)  (Cf. Trademark Case ) Delhi High Court, Kapil Wadhwa v. Samsung Electronics Ltd 2012 SCC Online Del 5172

# International Exhaustion –Japan–

- No statutes 明文規定なし
- Supreme Court Case (BBS Case) 最高裁判決

## BBS Case (July 1, 1997)

*If the patent holder or the licensee assigned the patented products in Japan, the patent right on the products has achieved its goal and has been exhausted, because (1) smooth circulation of patented goods must not be harmed and (2) the patent holder can obtain the profit at the time of first sale.*

国内消尽は認められる。特許製品の自由な流通を確保する必要があるし、特許権者は最初の販売時に利益を得ることができる。

*However, this does not apply in the same way in cases where a patent holder in Japan assigned the patented good outside Japan.*

しかし、国際消尽については同列に論じることができない。



# International Exhaustion –Japan–

## BBS Case(Cont.)

(About International exhaustion 国際消尽について)

*If a patent holder in Japan or an equivalent person assigns a patented product outside Japan to another person, the patent holder, **unless there is an agreement with the assignee excluding Japan from the areas of sale or use of the said product, may not seek an injunction in Japan concerning the patented product on the basis of the patent right against the person who acquired the product from the assignee, except in cases where the above agreement has been made and is explicitly indicated on the product.***

我が国の特許権者又はこれと同視し得る者が国外において特許製品を譲渡した場合においては、特許権者は、譲受人に対しては、当該製品について販売先ないし使用地域から我が国を除外する旨を譲受人との間で合意した場合を除き、譲受人から特許製品を譲り受けた第三者及びその後の転得者に対しては、譲受人との間で右の旨を合意した上特許製品にこれを明確に表示した場合を除いて、当該製品について我が国において特許権を行使することは許されないものと解するのが相当である。

# International Exhaustion –Korea-

- No statutes 明文規定なし
- Seoul District Court (Eastern Branch) Decision,  
81 *GaHap*466, July 30, 1981 ソウル地方法院東部支部判決

*Although patent rights in each county are independent from each other, and individual acts of working a patent are also separate from each other, the patent rights were already exhausted when the patentee manufactured the product on his/her own and lawfully exported it overseas. How the product is distributed or consumed thereafter is merely a process where the product is allocated to the actual consumers from the patentee's manufacture and sale and does not involve the patentee.*

各国の特許権は別個のもので、特許の実施行為もそれぞれ別個のものであるが、特許権者が自ら製品を製造し、適法に輸出した時点で、特許権は消尽している。製品がどのように流通・消費されるかは、特許権者による製造販売後に、実際の消費者に製品が届くまでの過程に過ぎず、特許権者が関与するものではない。

# International Exhaustion –India-

## •Patent Act

*107A Certain acts not to be considered as infringement. -For the purposes of this Act,-*

**(b) importation of patented products by any person from a person who is duly authorised under the law to produce and sell or distribute the product, shall not be considered as a infringement of patent rights.**

特許製品を製造・販売又は頒布することを法律上許可された者から、特許製品を輸入することは、特許権の侵害とはみなされない。

# International Exhaustion –India-

## Ground for patent exhaustion

As noticed by the US Supreme Court in *Impression Products* and the Australian High Court in *Calidad*, the principle of exhaustion of patent rights draws sustenance principally from the law of personal property and that the owner of a chattel has absolute right of disposal and use.

米国最高裁Impression Products事件判決やオーストラリア最高裁Calidad事件判決が指摘するように、特許権の消尽の原則は、主として、動産の所有者が処分・使用する絶対的権利を有するという動産法上の原則に由来する。

# Repair-Replace/Produce (Permissible repair and impermissible reconstruction)

Japan	Korea	India
<p style="text-align: center;"><b>NEW PRODUCT</b> (impermissible)</p>	<p style="text-align: center;"><b>NEW PRODUCT</b> (impermissible)</p>	<p style="text-align: center;"><b>Refurbishm ent</b> (permissible)</p>
<p>Ink Cartridge Case 最高裁判決Nov. 8, 2007</p>	<p>Cf. Fuji Film single-use camera case (Trademark Case) 大法院判決April 11, 2003</p>	<p>The principle of 'permissible repair' and 'impermissible reconstruction' established by the US court and BGH</p>

# Repair-Replace/Produce –Japan–

- Supreme Court Case (Ink Cartridge Case) 最高裁判決

## Ink Cartridge Case(Nov. 8, 2007)

If the patented product, assigned in Japan by the patent holder or the licensee who was licensed by the patent holder, has been modified or its components replaced, and as a result, it can be regarded as a novel production of the patented product which is not identical to the first patented product, the patent holder is entitled to exercise the patent right over this patented product.

我が国の特許権者等が国外において譲渡した特許製品につき加工や部材の交換がされ、それにより当該特許製品と同一性を欠く特許製品が新たに製造されたものと認められるときは、特許権者は、その特許製品について、我が国において特許権を行使することが許されるというべきである。

# Repair-Replace/Produce –Japan–

## Ink Cartridge Case(Cont.)

Whether the product can be regarded as a novel production of this patented product or not should be determined by taking into consideration

- (1) the characteristics of the patented product (the function of the product, structure and materials, application, usable life, mode of use)
- (2) the content of the patented invention
- (3) the manner of modification and the exchange of components, and
- (4) the circumstances involving the transaction (the state of the Patented Product at the time of modification, the content and extent of the modification, the usable life of the replaced components, the technical function and the economic value of the component within the Patented Product).

新たな製造に当たるかどうかについては、以下を考慮すべき

- (1)特許製品の属性（製品の機能、構造及び材質、用途、耐用期間、使用態様）
- (2)特許発明の内容
- (3)加工及び部材の交換の態様（加工等がされた際の特許製品の状態、加工の内容及び程度、交換された部材の耐用期間、部材の特許製品中における技術的機能及び経済的価値）
- (4)取引の実情

# Repair-Replace/Produce –Japan–

## • **Ruling (mock trial)** → **New Product**

- (1) The Plaintiff's Roll Paper does not expect users to remove the core tube and wind it with a new packaging sheet by themselves. The Plaintiff's Roll Paper loses its utility as a patented product once the packaging sheet is fully consumed.
- (2) The economic value of the Plaintiff's Roll Paper is primarily attributed to the packaging sheet portion. Producing the Defendant's product can be regarded as restoration of the material value of the Invention.

(1) 原告ロールペーパーは、利用者が自ら芯管を取り外し、分包用シートを巻き直すことを予定していない。原告ロールペーパーは分包用シートを消費し尽くした後、価値を失う。

(2) 原告ロールペーパーの経済的価値は、主として分包用シートにある。被告製品の製造は、本件発明の実質的な価値を再び実現するもの。



# Repair/Produce –Korea–

## Cf. Trademark Case

Supreme Court Decision, 2002Do3445, April 11, 2003

(Fuji Film single-use camera case)

**If the product is processed or repaired to a degree that damages the identicalness with the original product, it amounts to production and thus, should be deemed to infringe upon the trademark owner's rights.** Whether the product is processed or repaired to a degree that damages the identicalness with the original product and amounts to production should be judged upon overall consideration of the objective nature and use form of the product, legislative purpose of the Trademark Act, functions of the trademark, etc.

製品が、元の製品との同一性が失われる程度に加工又は修理された場合は、生産に該当し、商標権者の権利を侵害するというべきである。元の製品との同一性が失われる程度に加工又は修理がされ、生産に当たるといえるか否かは、製品の客観的性質及び使用形態、商標法の立法趣旨、商標の機能等を総合的に考慮して判断すべきである。

# Repair/Produce –Korea-

## • Ruling (mock trial)

Whether a patented product has been processed or modified to the extent that the identity of the original product is lost, and therefore, the act of producing has taken place shall be decided based on a comprehensive assessment of the description of the patented invention, the objective nature of the product, and the use form, legislative purpose of the Patent Act, etc.

特許製品が、元の製品との同一性が失われる程度に加工又は変更され、これにより、生産行為が行われたといえるか否かは、特許の発明に係る明細書の記載、製品の客観的性質及び使用形態、特許法の立法趣旨等を総合評価して決定される。

# Repair/Produce –Korea-

## • Ruling (mock trial/ Cont.) → New Product

Plaintiff's patented product is exclusively used in Plaintiff's packaging device, and the packaging sheet part makes up a distinctive portion of the composition of Plaintiff's roll paper. In addition, the Plaintiff's patented product loses its utility after it is used up. Therefore, it is reasonable to conclude that replacing the packaging sheet to the plaintiff's core tube cannot be regarded as replacing a consumable component under normal use, but rather as replacing the component that constitutes an essential portion of the invention.

原告の特許製品は、専ら原告の分包装置に使用されるものであり、分包用シート部分は、原告のロールペーパーの構成中の特徴的な部分を成している。加えて、原告特許製品は、使い切るとその効用を失う。したがって、原告芯管についての分包用シートの交換は、通常の使用における消耗部品の交換とはいえず、むしろ発明の本質的部分を構成する部品の交換であると解するのが相当である。

# Repair/Produce –India–

Limitation of the doctrine of exhaustion:

- (1) The purchaser cannot ‘make’ the patented product or replicate the invention, under the guise of exhaustion.
- (2) Express negative covenant or stipulation imposed by the patentee with respect to the product.

消尽の例外

- (1) 特許製品の購入者が、特許製品を製造・複製する場合
- (2) 特許権者が明示的に消尽を否定する特約を課した場合

# Repair/Produce –India–

The Court, in light of the aforesaid decisions (\*), **holds that the issue of repair and making would be best considered by applying the principles of ‘permissible repair’ and ‘impermissible reconstruction’.**

裁判所は、前記判決(\*)に照らし、修理と生産の点につき、「許される修理」と「許されない再生産」の原則を適用するのが相当

*(\*) House of Lords decision in United Wire Ltd v. Screen Repair Services (2000)*

*United Kingdom Supreme Court decision in Schutz v. Werit, [2013] UKSC 16*

*the Australian High Court decision in Calidad Pty Ltd. & Ors v. Seiko Epson Corporation & Anr, [2020] HCA 41*

# Repair/Produce –India–

The said tests have been formulated by Courts in the United States and the BGH while considering this aspect.

**As per this principle, only a true reconstruction or reproduction would amount to a ‘making’ of the product.**

Wide meaning is sought to be ascribed to the term ‘repair’, in so far as alterations, which improve the usefulness of the product are concerned. Those would fall within the safe harbour of repair. Further, mere replacement of a constituent part would not constitute ‘making’.

The situation can be different, however, if this part in fact embodies essential elements of the inventive concept.

米国・ドイツの裁判所により確立されたテストでは、真の再構築・複製のみが「生産」に当たる。

製品の有用性を向上させる改造は、修理に含まれよう。単なる部品の交換は「生産」に当たらない。

しかし、交換部品に、発明の本質的要素が化体している場合は異なる（生産に当たる。）。

# Repair/Produce –India–

## • **Ruling (mock trial) → refurbishment**

- (1) there is no inventive element claimed on the packaging sheet of the roll paper.
- (2) The core tube has very little utility once the packaging sheet is used up or finished. The Defendant has merely taken steps to extend the useful life of the core tube.
- (3) Winding of the packaging sheet around the core tube does not entail replication of any core or essential element of the invention.

(1) 分包用シートに本件の発明的な要素はない。

(2) 芯管は分包用シートを消費し尽くした後は、実用性を失う。被告は、芯管の使用期間を延長したにすぎない。

(3) 芯管に分包用シートを巻き付けることは、発明の重要な・本質的な部分の複製を意味しない。

# Repair/Produce

## Factors to be considered

Japan	Korea	India
(1) the characteristics of the patented product (2) the content of the patented invention (3) the manner of modification and the exchange of components, and (4) the circumstances involving the transaction + $\alpha$	(1) The description of the patented invention (2) the objective nature of the product (3) the use form (4) legislative purpose of the Patent Act + $\alpha$	(1) Nature of the invention (2) What was done by the Defendants (House of Lords in <i>United Wire</i> ) (1) the extent to which the technical effects of the invention are reflected by the replaced parts (BGH in <i>Impeller Flow Meter</i> , US Supreme Court in <i>Schutz</i> )
(1) 特許製品の属性 (2) 特許発明の内容 (3) 加工及び部材の交換の態様 (4) 取引の実情 等	(1) 特許発明に係る明細書の記載 (2) 製品の客観的性質 (3) 製品の使用形態 (4) 特許法の立法趣旨 等	(1) 特許発明の性質 (2) 被告の行為  (1) 交換された部品に、発明の技術的効果が反映される程度 24



International exhaustion

## **Discussion between Attorneys**

# Wrap up

Japan	Korea	India
 <b>Affirmed</b> 認容	 <b>Affirmed</b> 認容	 <b>Dismissed</b> 棄却
International Exhaustion virtually YES [ implied license ]	International Exhaustion YES	International Exhaustion YES [ Patent Act 107A(b) ]
<b>New Product</b> (Impermissible)	<b>New Product</b> (Impermissible)	<b>Refurbishment</b> (Permissible)

# Panel Discussion

## IP Dispute Resolution at Various Jurisdictions

# END

Thank you for your attention