

# IV Management of Proceedings for Patent-related Cases

## 1 Suits against Infringement of a Patent

In principle, the procedure of suits against infringement of a patent (“patent infringement suits”) is carried out in accordance with the Code of Civil Procedure. Also, the Patent Act has various special provisions related to the Code of Civil Procedure.

### Proceedings Model (Two-Phase Proceedings System)



The intellectual property divisions of the Tokyo District Court and the Osaka District Court respectively have prepared the Guidelines for Proceedings for Patent Infringement Suits. When a patent infringement suit is filed with either of these courts, the proceedings will be managed in accordance with these Guidelines. Both courts have adopted the two-phase proceedings system, where the court first conducts proceedings on whether the patent has been infringed or not (phase for examination on infringement) and, if the court finds, based on the result of the proceedings, that infringement has actually occurred, second-phase proceedings will be conducted on the amount of damage (phase for examination on damages). In some cases where a court finds that infringement has actually occurred and starts proceedings in the phase for examination on damages, the court may attempt to arrange a settlement and designate the date of settlement. The English translation of the Guidelines of both courts are publicized on the website of the Intellectual Property High Court.

### Patent Invalidity Defense (Double Track with JPO Invalidation Trial Procedure)

In accordance with the provisions concerning the restriction on exercise of rights by the patentee (Article 104-3 of the Patent Act), it is possible to dispute the validity of a patent in a patent infringement suit (patent invalidity defense). Since the validity of a patent may also be disputed in a trial for patent invalidation at the JPO, there are two ways to dispute the validity of a patent, i.e., patent invalidity defense in a patent infringement suit and the trial procedure for patent invalidation at the JPO (so-called “Double Track”).

### Calculation of the Amount of Damage (Provision of the Presumption of the Amount of Damage)

The calculation of the amount of damage sustained by infringement of the patent right is governed by Article 102 of the Patent Act, which provides for the presumption of the amount of damage. Under this Article, patentee, etc. may claim any of the following [i], [ii],[iii] as the amount of damage:

[i] The sum of the following (a) and (b):

(a) the amount obtained by multiplying the profit per unit of the articles which would have been sold by the patentee, etc. if there had been no act of infringement, by a portion not exceeding the quantity proportionate to the ability of the patentee, etc. to work the patented invention (“quantity proportionate to ability to work”) out of the quantity of the infringing articles assigned by the infringer (“assigned quantity”) (if there are circumstances due to which the patentee, etc. would have been unable to sell the quantity of articles equivalent to all or part of quantity proportionate to ability to work, the quantity relevant to such circumstances (“specified quantity”) shall be deducted);

(b) the amount of money to be received for the working of the patented invention according to specified quantity or the portion exceeding the quantity proportionate to ability to work out of the assigned quantity; (paragraph (1) of said Article)

[ii] the amount of profit earned by the infringer from the act of infringement (paragraph (2) of said Article); or

[iii] the amount of money the patentee, etc. would have been entitled to receive for the working of the patented invention (paragraph (3) of said Article).

# IV 特許関係事件の審理運営

## 1 特許権に関する侵害訴訟

特許権に関する侵害訴訟（特許権侵害訴訟）の手続は、基本的に民事訴訟法に則って行われますが、特許法には、民事訴訟法の各種の特則が設けられています。

### 審理モデル (2段階審理方式)

審理要領



(東京地裁)



(大阪地裁)

東京地方裁判所と大阪地方裁判所の知的財産権部は、それぞれ特許権侵害訴訟の審理要領を作成しています。これらの裁判所での特許権侵害訴訟は、この審理要領をモデルとして、審理運営がされています。いずれの裁判所においても、まず特許権の侵害が生じているかどうかの審理（侵害論）を行い、審理の結果、侵害との心証を得た場合に、損害額の審理（損害論）に入るという、2段階審理方式を採用しています。裁判所は、侵害との心証を得て損害論の審理に入る際に、和解を勧告して、和解期日を指定することもあります。

それぞれの裁判所の審理要領は裁判所のウェブサイトにおいて公開しています。

### 特許無効の抗弁 (無効審判手続との ダブルトラック)

特許権者等の権利行使の制限の規定（特許法104条の3）により、特許権侵害訴訟において特許の有効性を争うことができます（特許無効の抗弁）。特許の有効性は、特許庁における特許無効審判でも争うことができますので、特許権侵害訴訟での特許無効の抗弁と、特許庁における審判手続という2つのルート（いわゆるダブルトラック）で、特許の有効性について争えることとなっています。

### 損害額の算定 (損害の額の推定等 の規定)

特許権侵害による損害額の算定については、損害の額の推定等の規定（特許法102条）が設けられています。同条によれば、特許権者等は、①④侵害の行為がなければ特許権者等が販売することができた物の単位数量当たりの利益の額に、侵害者の侵害品の譲渡数量のうち当該特許権者等の実施能力に応じた数量を超えない部分（その全部又は一部に相当する数量を当該特許権者等が販売することができないとする事情があるときは、当該事情に相当する数量を控除した数量）を乗じて得た額と、⑤譲渡数量から上記④の数量を除いた数量に応じた特許発明の実施に対し受けるべき金銭の額に相当する額の合計額（同条1項）、②侵害者が侵害の行為により受けた利益の額（同条2項）、③特許発明の実施に対し受けるべき金銭の額（同条3項）を、損害の額とすることができるとされています。

## Court Settlement

Some patent infringement cases are solved through court settlement. In large part of those cases, settlements are reached to the patent holders' advantage, including cases where a large amount of damages are claimed. In Japan, court settlement is widely recognized as an efficient and speedy way to reach an appropriate resolution.

## Obligation to Clarify Specific Circumstances

If a patentee, etc. alleges that his/her patent has been infringed by a product or process, and if the adverse party denies the specific conditions of the product or process that the patentee, etc. has claimed as the one that composed an act of infringement, the adverse party must clarify the specific conditions of his/her act (Article 104-2 of the Patent Act).

## Order to Submit Documents

The court may order either party to submit documents that are needed to prove the infringement or to calculate damages incurred by the infringement, except when the party possessing the documents has a legitimate reason for refusing to submit them (Article 105 of said Act).

## Confidentiality Protective Order

A confidentiality protective order is also available as a procedure for protecting the trade secrets stated in briefs or evidence (Article 105-4, etc. of said Act).

## Proceedings of Investigation

The court may also appoint one or more impartial technical experts as inspectors if there are reasonable grounds to suspect the infringement of the patent right, etc. and there seems to be no alternative means to obtain evidence. Those inspectors who are authorized to enter into the factory or other premises of the other party (alleged infringer) and conduct an investigation that is needed to prove the infringement submit a report to the court (Article 105-2, etc. of said Act).

This system was introduced by the amendment to the Patent Act in 2019 (Act No.3 of 2019) as a new procedure for gathering evidence.

## Proceedings for Seeking Opinions from Third Parties

Under the proceedings for seeking opinions from third parties in patent infringement litigation (Article 105-2-11 of the Patent Act), when finding it necessary upon the petition of a party, the court may seek from the general public submission of written opinions on the application of the Patent Act and other necessary matters concerning the case, while specifying the period of the call for opinions, and the parties may use such written opinions as evidence.

This system enables the court to gather opinions from the general public (third parties) to obtain reference materials helpful for making appropriate decisions. It was introduced by the amendment to the Patent Act in 2021 (Act No. 42 of 2021). After its introduction, the Intellectual Property High Court called for third-party opinions for the case pending before the Intellectual Property High Court, 2022 (Ne) 10046 ("Comment Distribution System" case), etc.

## 裁判上の和解

特許権侵害訴訟の中には、裁判上の和解で解決されるものもあります。和解で解決された事件のかなりの部分は、特許権者に有利な方向での合意がされており、請求額の非常に大きな訴訟で和解が成立したものもあります。我が国では、和解は、適切な解決を得るための効率的で迅速な手段と考えられています。

## 具体的態様の明示義務

相手方は、特許権者等が侵害の行為を組成したものと主張する物又は方法の具体的態様を否認するときには、自己の行為の具体的態様を明らかにすることが求められます（特許法104条の2）。

## 書類提出命令

裁判所は、書類の所持者においてその提出を拒むことについて正当な理由がある場合を除いて、当事者に対し、侵害行為の立証や損害の計算に必要な書類の提出を命ずることができます（特許法105条）。

## 秘密保持命令

準備書面や証拠に記載されている営業秘密を保護するための手続として秘密保持命令（同法105条の4等）の制度が設けられています。

## 査証制度

特許権等を侵害したと疑うに足りる相当な理由があり、証拠収集の代替手段がないと見込まれるような場合、中立な技術専門家等を査証人として選任し、相手方である被疑侵害者の工場等に立ち入り、特許権の侵害立証に必要な調査を行わせ、裁判所に報告書を提出させる制度（特許法105条の2等）です。この制度は、新たな証拠収集手続として、令和元年の特許法改正（令和元年法律第3号）によって設けられました。

## 第三者意見募集制度

特許権侵害訴訟において、裁判所が、当事者の申立てにより、必要があると認めるときに、広く一般に対し、当該事件に関する特許法の適用その他の必要な事項について、相当の期間を定めて、意見を記載した書面の提出を求め、当事者が提出された書面を証拠として活用できる制度（特許法105条の2の11）です。この制度は、裁判所が、適正な判断を示すための資料を得るために、広く一般の第三者から意見を集めることを可能としたもので、令和3年の特許法改正（令和3年法律第42号）によって設けられました。制度の導入後、知財高裁令和4年（ネ）第10046号事件（コメント配信システム事件）ほかにおいて、第三者意見募集を実施しました。

## 2 Suits against Appeal/Trial Decisions made by the JPO on a Patent

### Suits against appeal/trial decisions made by JPO

Any administrative disposition conducted by an administrative agency is subject to scrutiny by judicial powers. Therefore, the legality of any decision, etc. made by the JPO, which is an administrative agency, is subject to review by the courts. In the case of an ex parte case, such as a trial against examiner's decision of refusal, the JPO Commissioner will become the defendant, while, in the case of an inter partes case, such as a trial for patent invalidation, either the demandant or the demandee of the trial will serve as the defendant (Article 179 of the Patent Act).

### Proceedings Model

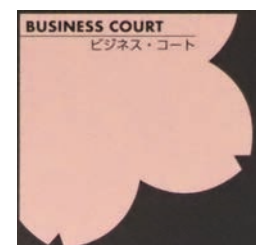
The Intellectual Property High Court has prepared the guidelines for proceedings of suits against appeal/trial decisions made by the JPO. The English translation of the guidelines are publicized on the website of the Intellectual Property High Court. In principle, the proceedings for suits against appeal/trial decisions made by the JPO will be managed in accordance with these guidelines. In a suit against appeal/trial decision made by the JPO, the plaintiff is required to submit a brief prior to the first date for preparatory proceedings and required to present, in the brief, all of the reasons for seeking rescission of the JPO decision. In response, the defendant is required to submit a brief that states all of its counterarguments to the plaintiff's arguments. The English translation of the guidelines are publicized on the website of the Intellectual Property High Court.

Guidelines for Proceedings



### Judgment of Rescission

If the court finds that a JPO decision, etc. erred, the court will hand down a judgment to rescind it. If this judgment is finalized, the procedure will be resumed at the JPO. For example, in the case of a suit against appeal/trial decision made by the JPO in a trial against the examiner's decision of refusal, even if the court finds the JPO decision to uphold the examiner's decision to be erroneous, the court would only rescind the JPO decision and would not have the authority to make a decision to grant a patent.



Guide plates with cherry blossom motifs  
(案内板の桜のモチーフ)



## 2 特許権に関する審決取消訴訟

### 審決取消訴訟

行政庁の行った行政処分は司法権による審査に服します。行政庁である特許庁がした審決等についても、裁判所がその適法性を審査します。拒絶査定不服審判を始めとする査定系の事件においては特許庁長官が、特許無効審判を始めとする当事者系の事件においては審判の請求人又は被請求人が、それぞれ被告となります（特許法179条）。

### 審理モデル

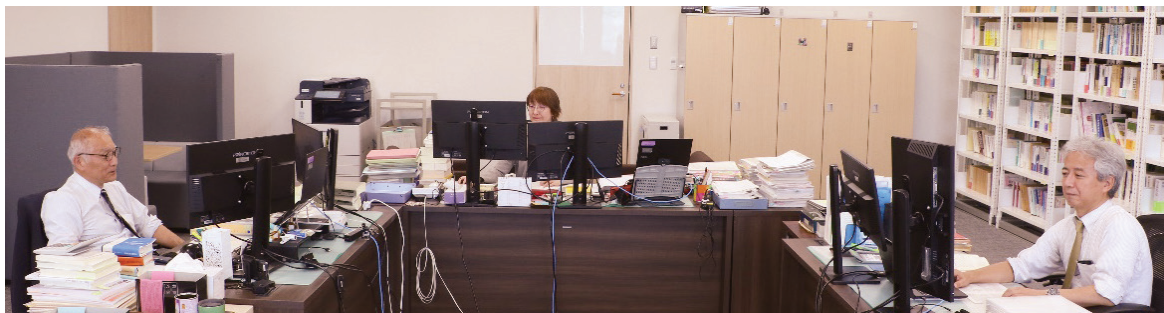
審理要領



知的財産高等裁判所は、審決取消訴訟の審理要領を作成して、基本的にこの審理要領に沿って審理運営されています。審決取消訴訟では、第1回の弁論準備手続期日より前に原告の準備書面の提出が要求され、この準備書面で審決の取消事由の主張を全て記載することが要求されています。その後に被告から提出される準備書面には、原告の主張に対する反論や被告の主張を全て記載することが要求されます。審理要領は知的財産高等裁判所ウェブサイト等において公開しています。

### 取消判決

裁判所が、審決等に違法があると判断した場合、これらを取り消す旨の判決をします。この判決が確定した場合には、特許庁での手続が再開されることになります。例えば、拒絶査定不服審判の審決取消訴訟の場合、裁判所において審決が違法であると判断したとしても、裁判所は審決を取り消すのみで、特許査定をする権限はありません。



Judges' Chamber (裁判官室)



Work in chamber using multiple monitors  
(複数モニターを活用した執務)



Web conference using IT booth  
(ITブースを活用したウェブ会議)