



# **IP Litigations in Japan: Recent Trends and Future Perspectives**

**29 January 2016**

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Supreme Court of Japan**

# Basic Information on Japan

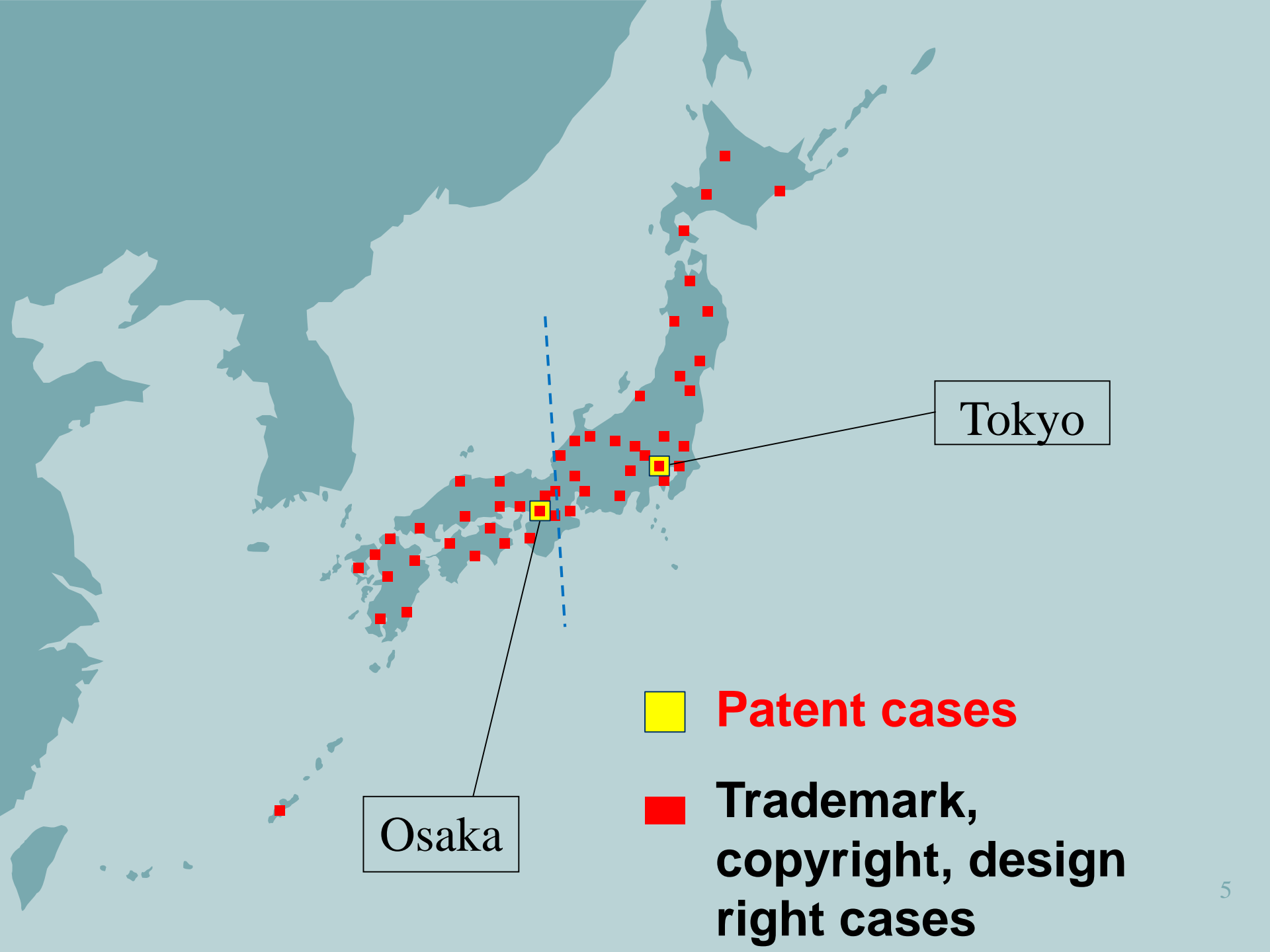
- Population: around **120 million**
- GDP : around **4~5 trillion USD**
- Patent
  - Application (2014) : **325,989**
  - Request for examination (2014): **245,535**
- Modern legal/judicial system was established around **the end of 19<sup>th</sup> century** (after the end of Samurai era)
  - ➔ Categorized as **continental law (civil law)**, but also affected by common law

# Courts in Japan (General)

- **47 prefectures**, each of which has **1** district court as **1<sup>st</sup> instance** (Hokkaido has 4)  
→ **50** district courts
- **8** high courts as **2<sup>nd</sup> instance**
- **Supreme Court** as **final instance** in Tokyo

# Special Jurisdiction rule on IP litigations (1<sup>st</sup> instance)

- **Exclusive jurisdiction over patent cases**
  - ➔ **Tokyo District Court and/or Osaka District Court ONLY have jurisdiction.**
- **Non-exclusive jurisdiction over trademark, copyright, design right cases**
  - ➔ **Tokyo District Court and/or Osaka District Court have jurisdiction but (a)other district(s) court may also have jurisdiction depending on the location of dispute.**



Tokyo

Osaka

 **Patent cases**

 **Trademark,  
copyright, design  
right cases**

# IP divisions in Tokyo/Osaka District Court



TOKYO 4 IP divisions

OSAKA 2 IP divisions

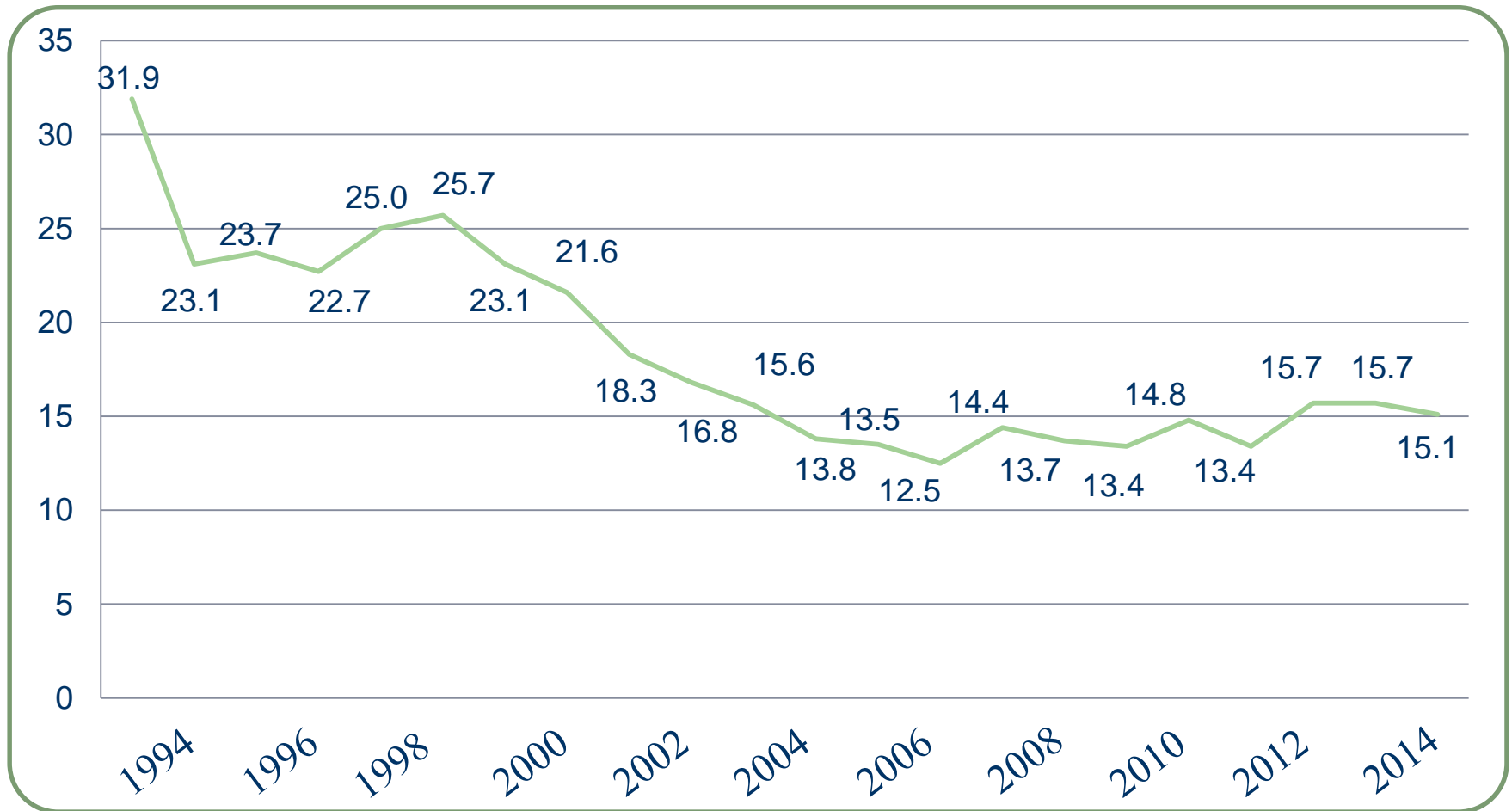
Each “division” has at least 3 judges (sharing 1 room)

→ All IP cases in Tokyo/Osaka District Court are heard by a panel of 3 judges of IP division, not a single judge

# Judges' chamber



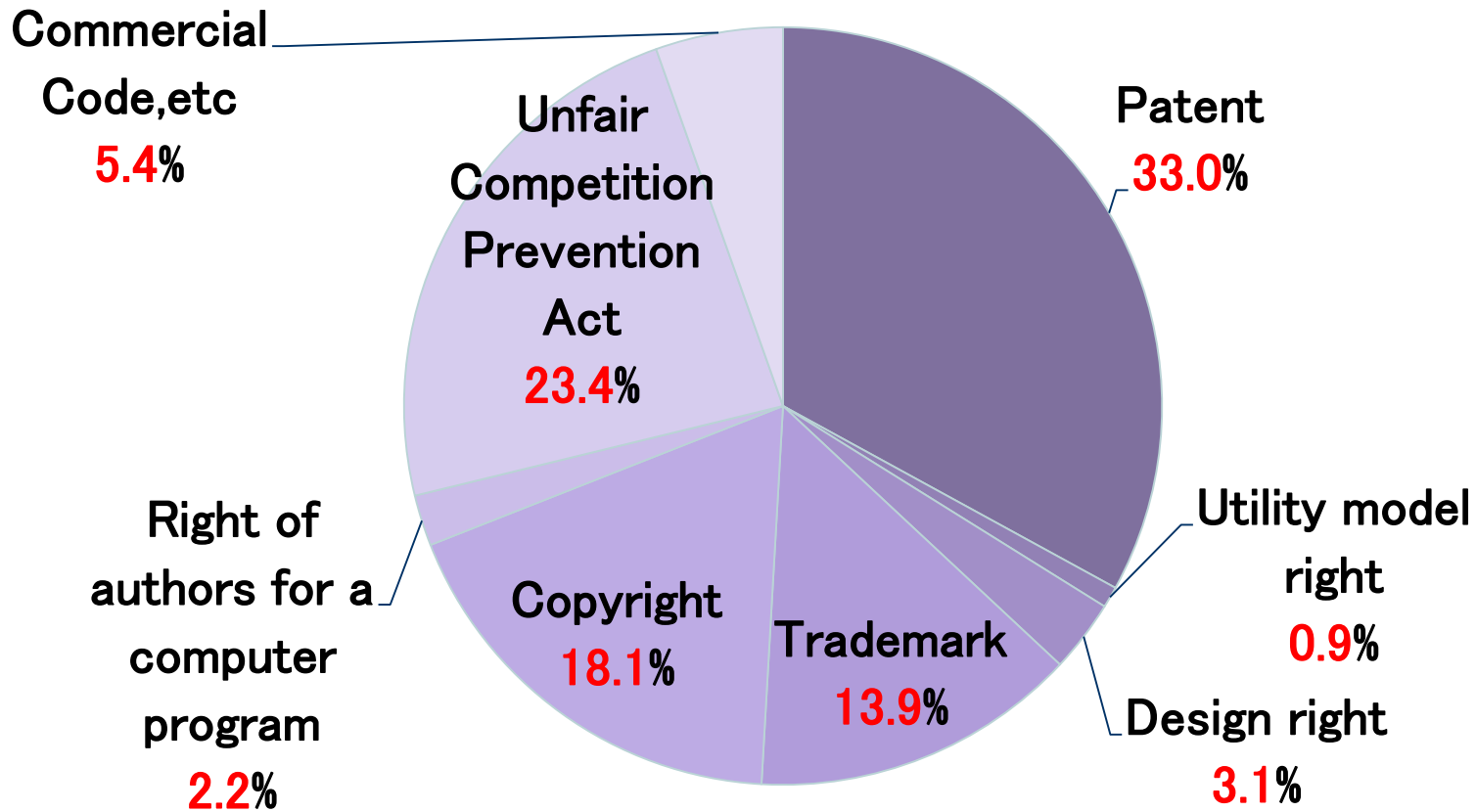
# Average Time Intervals From Commencement to Disposition at First Instance (months)



- Judges play an active role in **case management** under our **docket system** in Japan.
- Generally recognized Strength: **predictability** of judgment, cost and speed <sup>8</sup>



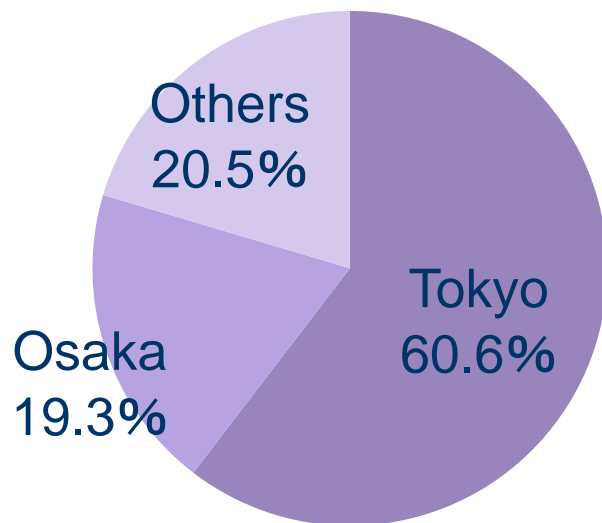
# Types of IP litigations in 1<sup>st</sup> instance (2014): 552 cases



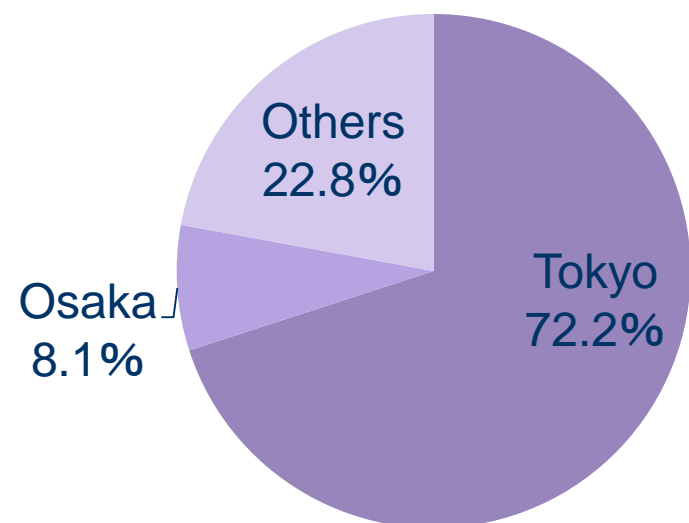
# Which district court handles IP case? (2012-2014)

- Majority are in Tokyo/Osaka District Courts even under non-exclusive jurisdiction

## Trademark



## Copyright



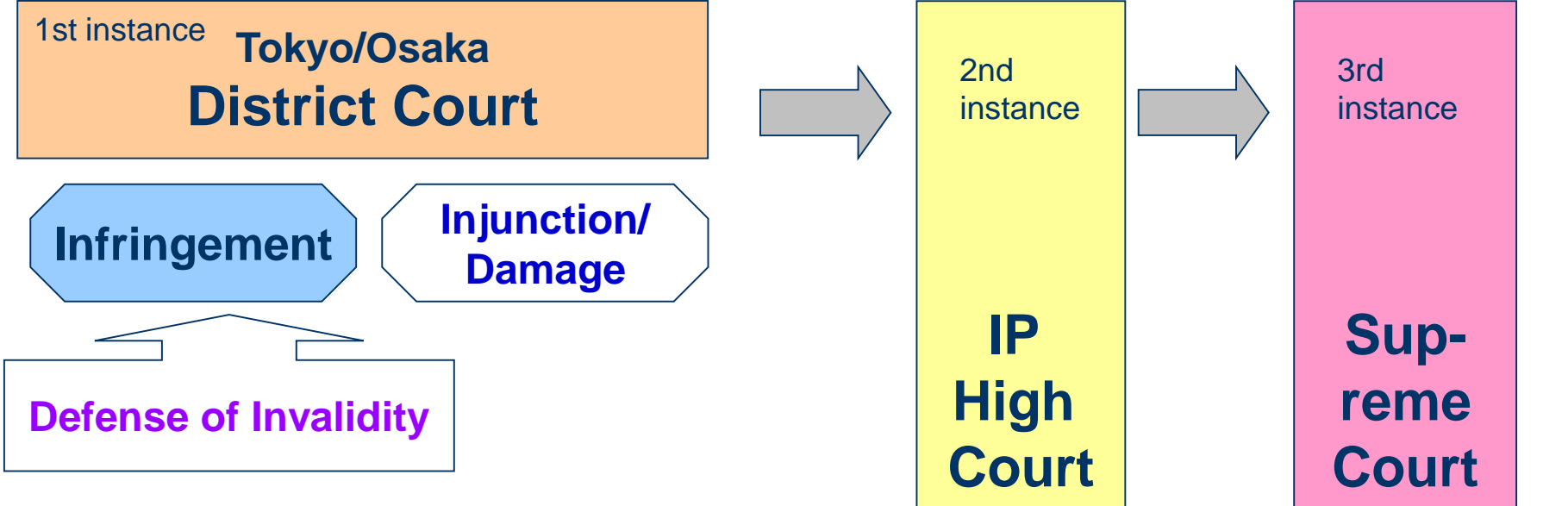
# Intellectual Property High Court (Established in April 2005)

**TOKYO** 4 divisions

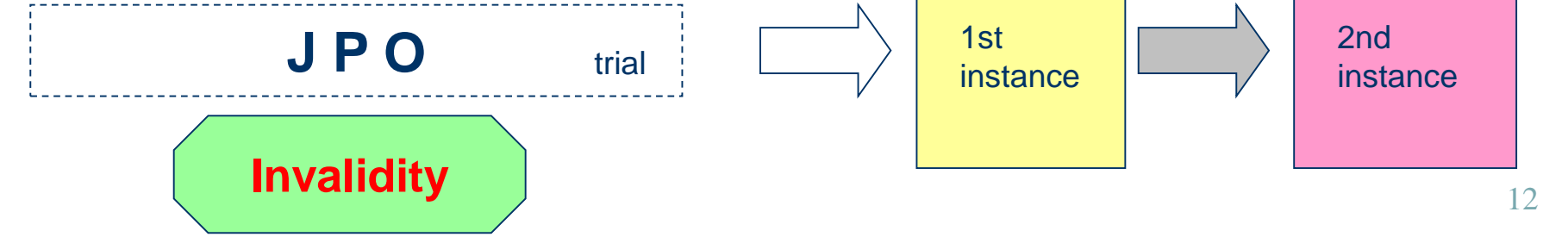
- 1-1) Appeals of all patent cases (Tokyo/Osaka District Court)
- 1-2) Appeals of all types of IP cases from Tokyo District Court and its neighbouring district courts
- 2) Litigations against appeal/trial decisions made by JPO (mainly patent validity)

# Procedures for Patent Infringement Disputes

## Infringement procedure



## Invalidity procedure



# Defense of Invalidity in Infringement Litigation

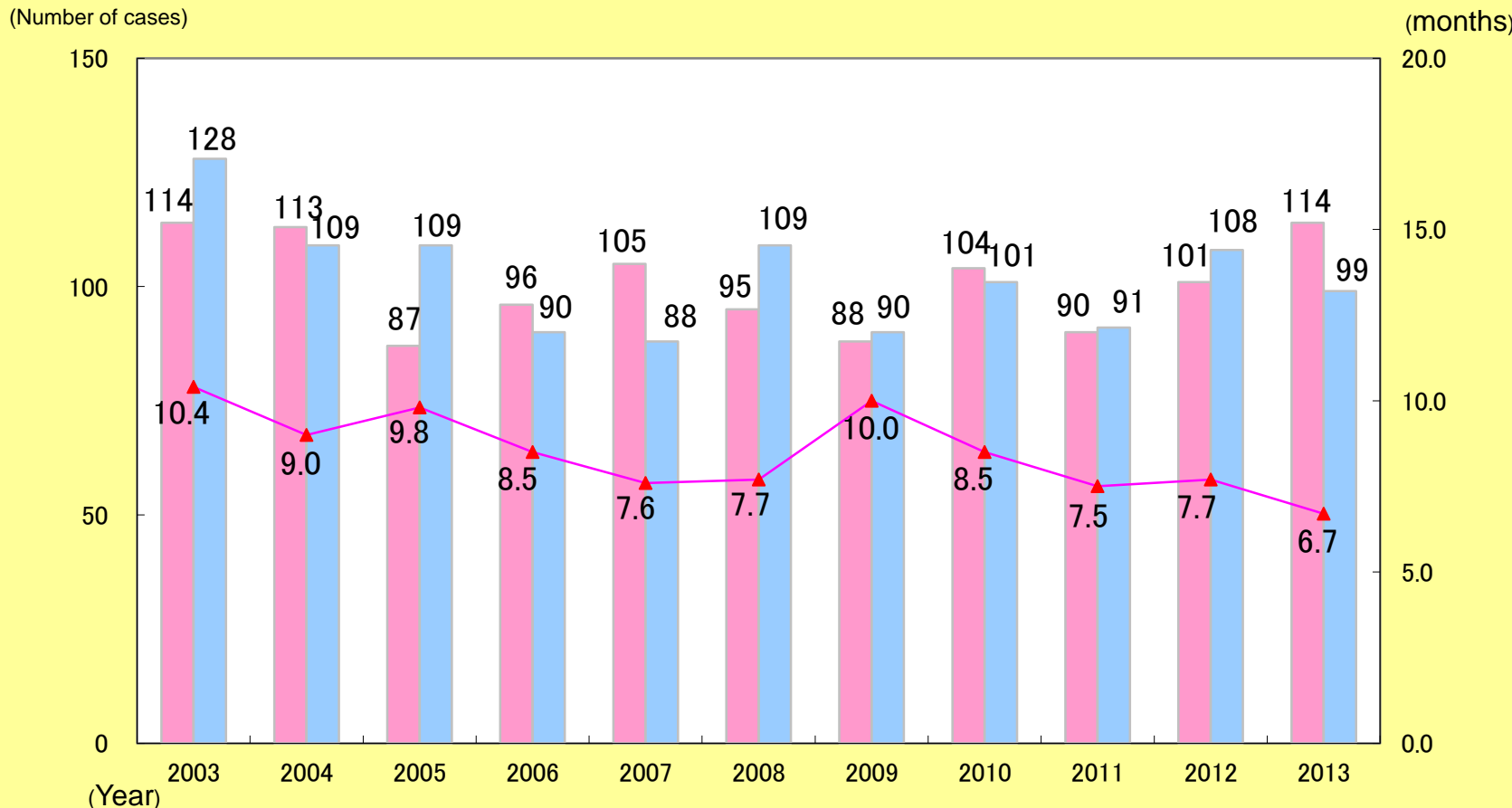
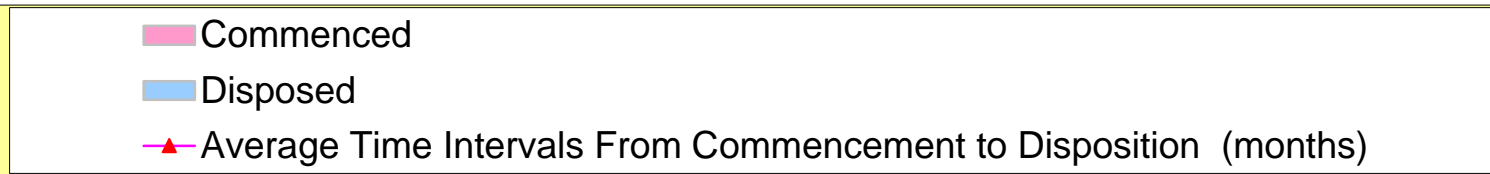
## Article 104 - 3 (1) of the Patent Act

Amendment of Patent Act in 2004  
(Effective from April 1, 2005)

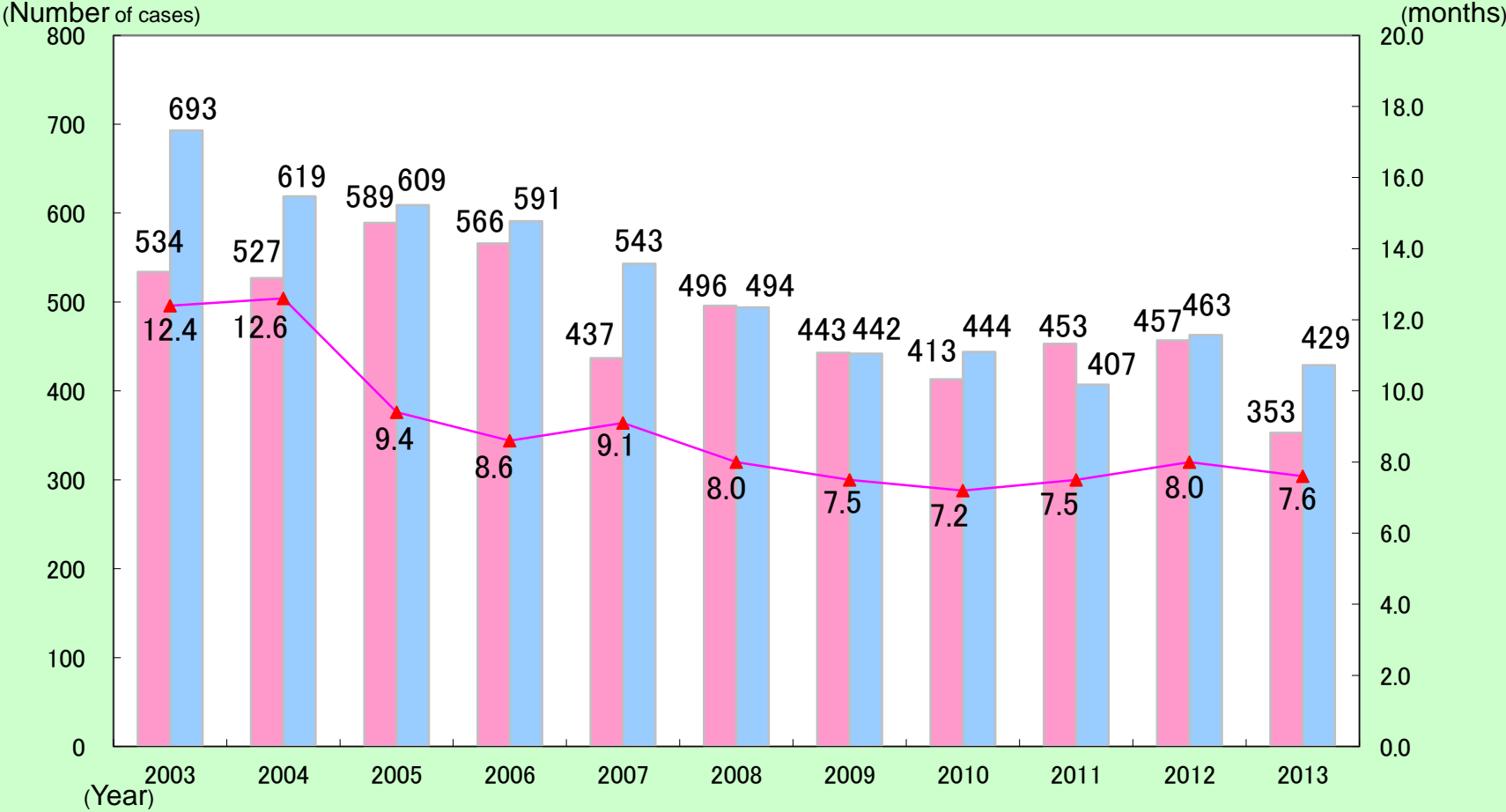
**“ Where, in litigation concerning the infringement of a patent right, the said patent is recognized as one that should be invalidated by an invalidation trial , the rights of the patentee may not be exercised against the adverse party.”**

# Number of IP Appeal Cases, and Average Time Intervals From Commencement to Disposition (IP High Court)

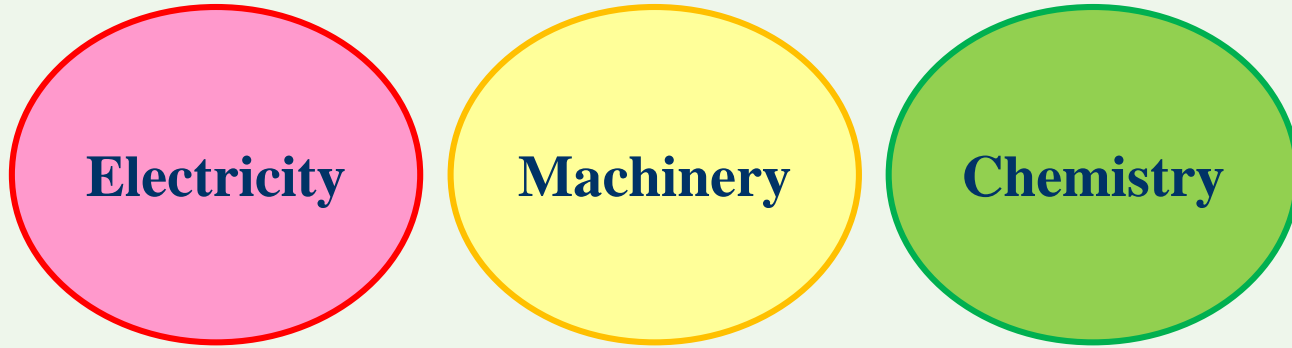
\* ~ March 31 2005 Tokyo High Court



# Number of Suit Against Appeal/Trial Decision made by JPO, and Average Time Intervals From Commencement to Disposition (IP High Court) \* ~March 31 2005 Tokyo High Court



# Judicial Research Officials



**Full-time court officers  
with specialized knowledge in science/technology**



**Assigned to IP High Court (11)  
Tokyo District Court (7)  
Osaka District Court (3)**



**Engaged in all Patent litigations  
to support judges in technological issues**

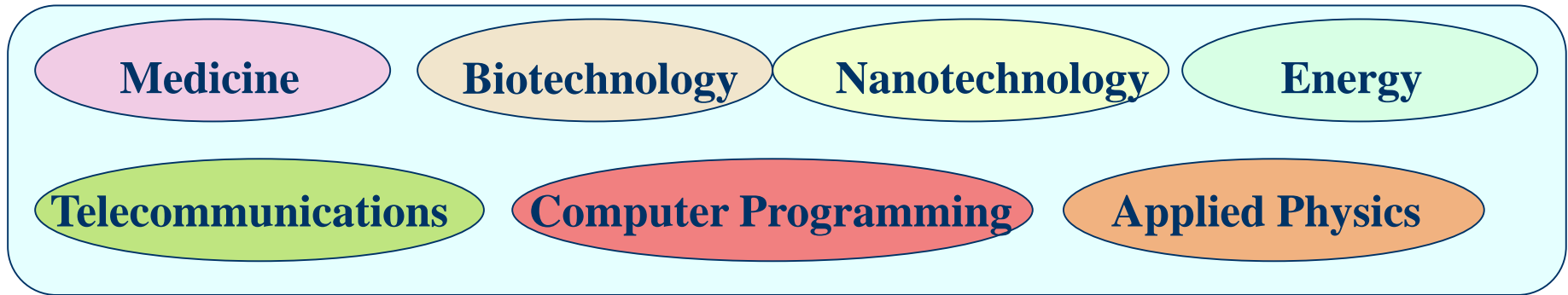
\* The function seems similar to that of **assessors** in Singapore



# Office of Judicial Research Officials



# Technical Advisors



**Part time court members (more than 200): university professors etc**

\*All belonging to 3 courts: IP High Court, Tokyo District Court, Osaka District Court



**Designated for a case which contains highly difficult technological issues.**

# Explanatory sessions

## Presentation by both parties (attorneys)

Alleged infringing product

Videogram

Presentation software

Frank discussion



Questions by judge,  
Judicial Research Official,  
Technical Advisor

Response by parties  
and attorneys

Deepening the understanding  
on technological matters etc

# How to evaluate IP litigation system?

- Quality of judgments, efficiency of procedure (IP Hub Master Plan 5.2 in Singapore)
- Winning rate for patentees?

\* Does it correspond with the value of **fairness**?

\* Does the rate in **judgments only** have a **statistical significance**?

In Japan, judges play a role for **settlement**, disclosing their view on liability issues after hearing.

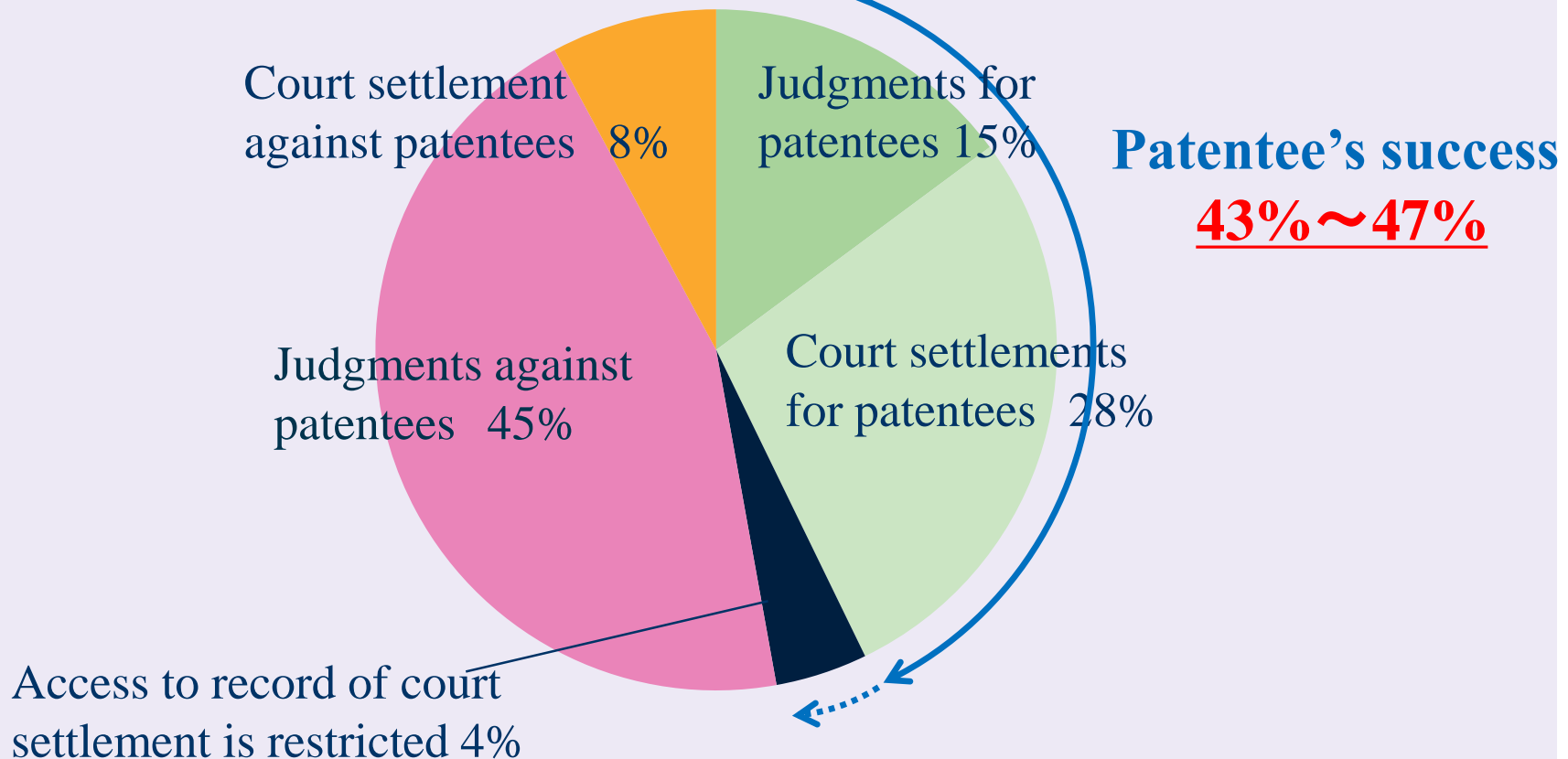
➡ Many cases **for patentees** end by **court settlement** (having the **same legal effect as judgments**).

Focus on statistics on **judgments only** is **misleading**.

# Rate of patentee's success in patent infringement litigations

\*Research by Institute of Intellectual Property (2015)

## Judgments & Court Settlements (2011-2013)



# For further development of IP litigations and rules in Japan

- **Academics** will play significant role.
- **All IP judgments** in SC, IPHC, and IP divisions of Tokyo/Osaka DCs are on the **website (no registration, no charge)**.
  - ➔ Analyzed, discussed and criticized by **scholars** (incl. seminar, conference, etc)
  - ➔ **Development cycle** between judges/legal practitioners and scholars
- Discussion on strengthening document production procedure is under way (typically for cases of process claim).

# International Activities

- **IP judgments** are translated into **English** on **IP High Court website**.
- **Sharing** our IP judgments internationally  
**Development cycle** in international field
- **“IP judgments listed by topic”** on the web

# “IP judgments listed by topic” in IP High Court website

[http://www.ip.courts.go.jp/eng/hanrei/judgments\\_list/index.html](http://www.ip.courts.go.jp/eng/hanrei/judgments_list/index.html)

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## Intellectual Property High Court

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## IP Judgments listed by topic

This webpage provides full/extract translations of selected IP Judgments listed by topic.  
This webpage will be updated as new translations of selected cases are prepared.

- [1 Patent](#)
- [2 Trademark Right](#)
- [3 Design Right](#)
- [4 Copyright](#)
- [5 Unfair Competition Prevention Act](#)
- [6 Commercial Code.etc.](#)

- 1 Patent
  - (1) Patentability/ Validity of the Patent

[\(a\) Eligibility](#)

[\(b\) Novelty/ Inventive Step](#)

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International Symposium: Toward the Future of the Judicial System for Intellectual Property ~Commemorating the 10<sup>th</sup> Anniversary of IP High Court ~ (Tokyo, 20 April 2015)

# Cooperation in Asia

- “The Project on **IP Rights Protection** and Legal Consistency for Improving Business Environment in Indonesia”
  - \* **Long-term Experts** are dispatched from Japan.
  - \* The judiciary in Japan cooperates on the project.
- Japan also can learn through the project.
  - ➔ **Mutually beneficial** (Not one way)
    - Harmonization** of IP rules through this **cycle**
- IP, mutual **gateway to judicial systems as a whole**



**IP High Court's Judge's participation  
in IP Seminar in Indonesia (December 2014)**

# Useful website (English)

- **IP High Court**

<http://www.ip.courts.go.jp/eng/index.html>

- \* **Guidebook of IP High Court**

[http://www.ip.courts.go.jp/eng/documents/thesis/141006\\_setuguusiryo/index.html](http://www.ip.courts.go.jp/eng/documents/thesis/141006_setuguusiryo/index.html)

- \* **IP judgments listed by topic**

[http://www.ip.courts.go.jp/eng/hanrei/judgments\\_list/index.html](http://www.ip.courts.go.jp/eng/hanrei/judgments_list/index.html)

- **Japanese Law Translation**

<http://www.japaneselawtranslation.go.jp/?re=02>

- **Japan Patent Office**

<https://www.jpo.go.jp/>