

Session1: Basics of IP rights  
International Workshop on “Intellectual Property,  
Commercial and Emerging Laws”  
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# Judicial System in Japan (IP-related case)

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Judge, IP High Court of Japan

	India	Japan
<b>GDP</b> (Nominal/PPP) 2015 trillion of U.S. \$	2.07 8.00	4.12 4.84
<b>Patent App.</b> 2015 thousand	45	318
<b>Specialized Court for IP</b>	Commercial Courts etc. (2015-)	IP High Court (2005-)

# Contents

- Statute
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# Statute

## Continental Law

- Patent Act (Utility Model Act)
- Copyright Act
- Trademark Act
- Design Act
- Unfair Competition Prevention Act
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# Statute

Intellectual  
Creation

Patent

Copyright

Design

Unfair Competition  
Prevention

Commercial  
Reputation

Trademark

Unfair Competition  
Prevention

Registration needed at the JPO

Trade secret

Passing Off

# Obtain Patent Right

Registration (JPO) \*2015

## ➤ Examine

Fulfillment Requirements

(Novelty, Inventive Step, Enablement, Clarity, ...)

9.5month(until first action)

71.5% Granted

## ➤ Trial against examiner's decision of refusal

12.5month

76.5% Granted

4372 Cases Not Accepted

# Obtain Patent Right

Registration (IP High Court) \* 2015

## ➤ Ex-parte Appeals

Suits against appeal decisions made by the JPO

Applicant vs. JPO Commissioner, 73 Cases

8.7 months(incl. Inter-parte Trials)

27% Cancellation of appeal decisions

## ➤ Jurisdiction

Exclusive Jurisdiction of the IP High Court

# Right of Patentee

## Work

- Exclusive right to work the patented invention as a business  
Working : Producing, Using, Assigning, etc.
- Scope is determined based upon the statements in the scope of claims



# Right of Patentee

## Patent Infringement Suits

### ➤ Special provisions in Patent Act

#### Substance

Seek Injunction as well as Compensation

Presumption of Amount of Damage

Presumption of Negligence

#### Procedure

Order to produce documents

Protective order to protect trade secrets

Expert opinion for calculation of damages

# Right of Patentee

## Patent Infringement Suits

### ➤ Jurisdiction

#### First Instance

Exclusive Jurisdiction of Tokyo and Osaka  
District Court (Specialized Division)

#### Second Instance

Exclusive Jurisdiction of IP High Court

# Right of Patentee

## Patent Infringement Suits

### ➤ Procedure

Two-phase proceedings system

Stage for examination on infringement

Stage for examination on damages

The court may attempt to arrange a Settlement

# Right of Patentee

## Patent Infringement Suits

### ➤ Claim construction

Whether **the products** fall within the technical scope of patented invention ?

### ➤ Doctrine of Equivalent

If there is **a part** different from **the products** in the construction as indicated in the scope of the patented claims


⇒ Not infringement in principle    ⇒ However

# Right of Patentee

## Patent Infringement Suits

### ➤ Doctrine of Equivalent (cont.)

However, if

- a) **this part** is not essential part
- b) replacing **this part**, identical function and effect
- c) easily come up with the idea of such replacement
- d) **the products** are not identical to the technology in the public domain at the time...
- e) no special circumstances, like **the products** had been intentionally excluded from the scope of the patent claim 

# Right of Patentee

## Patent Infringement Suits

### ➤ Doctrine of Equivalent (cont.)

⇒ **the products** fall within the scope of the technical scope of the patented invention  
("Ball spline bearing" case. Feb 24, 1998 Supreme Ct.)

"Maxacalcitol" Grand Panel case. Mar. 25, 2016 IP HC made these 5 requirements clear.

In detail, please go to the HP of the IP High Court



[http://www.ip.courts.go.jp/eng/hanrei/g\\_panel/index.html](http://www.ip.courts.go.jp/eng/hanrei/g_panel/index.html)

# Right of Patentee

## Patent Infringement Suits

\*2014-2015 First Instance

### ➤ Result (total 202 Cases)

Judgement 125 Cases(61%)

(28 Cases in favor of Patentee)

Settlement 77 Cases(39%)

(61 Cases include Injunction  
and/or Compensation clause)

# Right of Patentee

## IP related Civil Cases

- Number of Cases \*2015 All District Court/Fist Instance  
533 Cases Commenced
  - 28.9% Patent
  - 22.9% Unfair Competition Protection
  - 20.1% Trademark
  - 19.7% Copyright
- Time Intervals \* 2015
  - 14.2months (All District Courts)
  - 7.6months (All High Courts)



# Alleged Infringer's Defense

Registration (JPO) \*2015

➤ Trial for patent invalidation

227 Demands(only an interested  
person may file)

6.8 month(incl. correction etc.)

22% Accepted(Invalid incl. partially)

78% Not Accepted(Valid)

# Alleged Infringer's Defense

Registration (IP High Court) \* 2015

## ➤ Inter-parte Trials

Suits against trial decisions made by the JPO

Mostly, Alleged Infringer vs. Patentee, vice versa

116 Cases

8.7 months(incl. Ex-parte Appeals)

37% Cancellation of Trial Decisions

## ➤ Jurisdiction

Exclusive Jurisdiction of the IP High Court

# Alleged Infringer's Defense

## Patent Infringement Suits

### ➤ Defense of Invalidity

Where the said patent is recognized one that should be invalidated, the rights of patentee may not be exercised. (Japan adopted the so-called Double Track System)

71% of the patent infringement suits, validity of patents are rebutted.

# IP High Court

Established on April 1, 2005

Awareness in Japan that it is necessary to revitalize the Japanese economy by promoting the creation, protection and use of IP at a national level

# IP High Court

## Constitution

- 4 Divisions
- 17 Judges(as of today)

Career system

Not required any technical background

# IP High Court

## Jurisdiction

- IP-related civil appeal cases

Technology-related actions(Patent etc.)

Exclusive Jurisdiction of IP High Court

Non-tech-related actions(Copyright, Trademark etc.)

Each High Court

- Suits against decisions made by the JPO

Exclusive Jurisdiction of IP High Court

# IP High Court

## Use of Expert Knowledge

### ➤ Judicial Research Officials

11 Full-time court staff members

Former JPO trial examiner, Patent Attorney

### ➤ Technical Advisors

200 Part-time national public officers

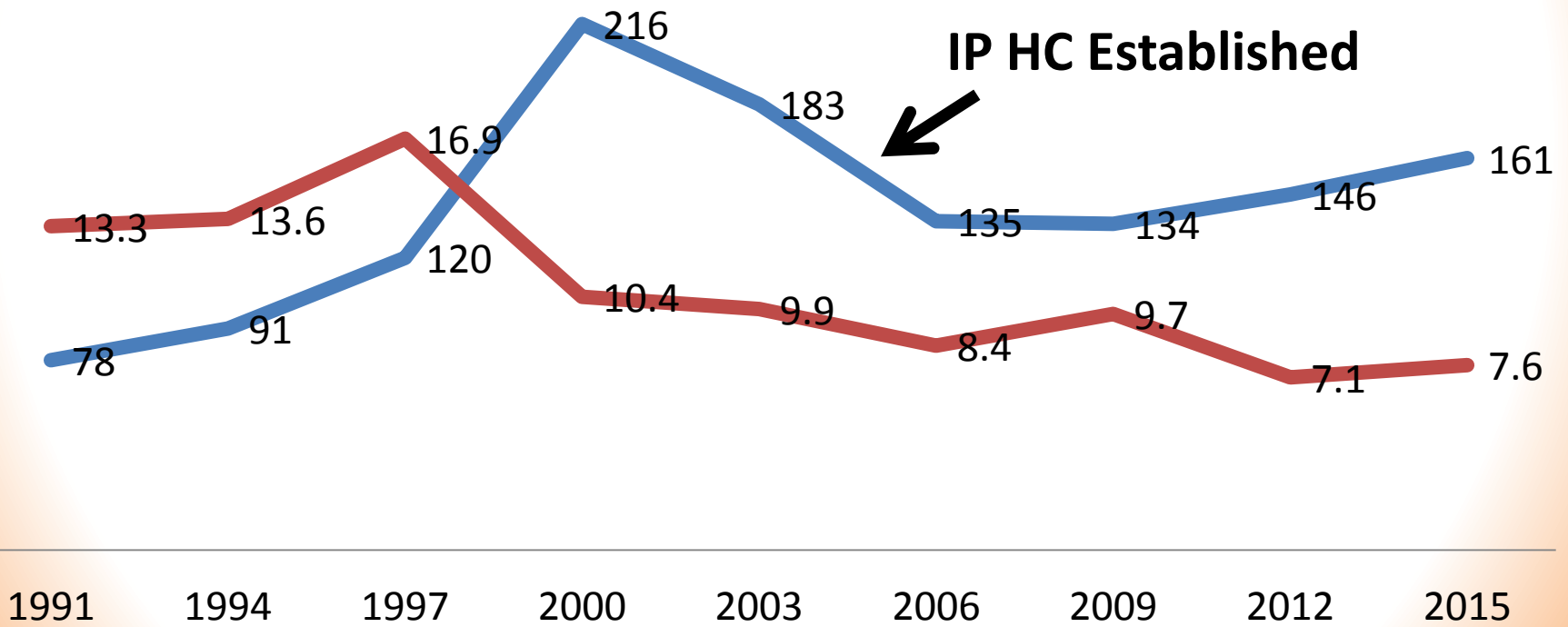
Designated ad-hoc

University professors, Researchers etc.

# IP High Court

## IP-related civil appeal cases (All High Courts)

— Commenced — Intervals(months)



More cases, Prompt Solutions



# IP High Court

## International Info Dissemination

### ➤ Website

IP High Court provides some contents in foreign languages.

Especially important IP judgements are listed by topic on the webpage “IP Judgements listed by topic”

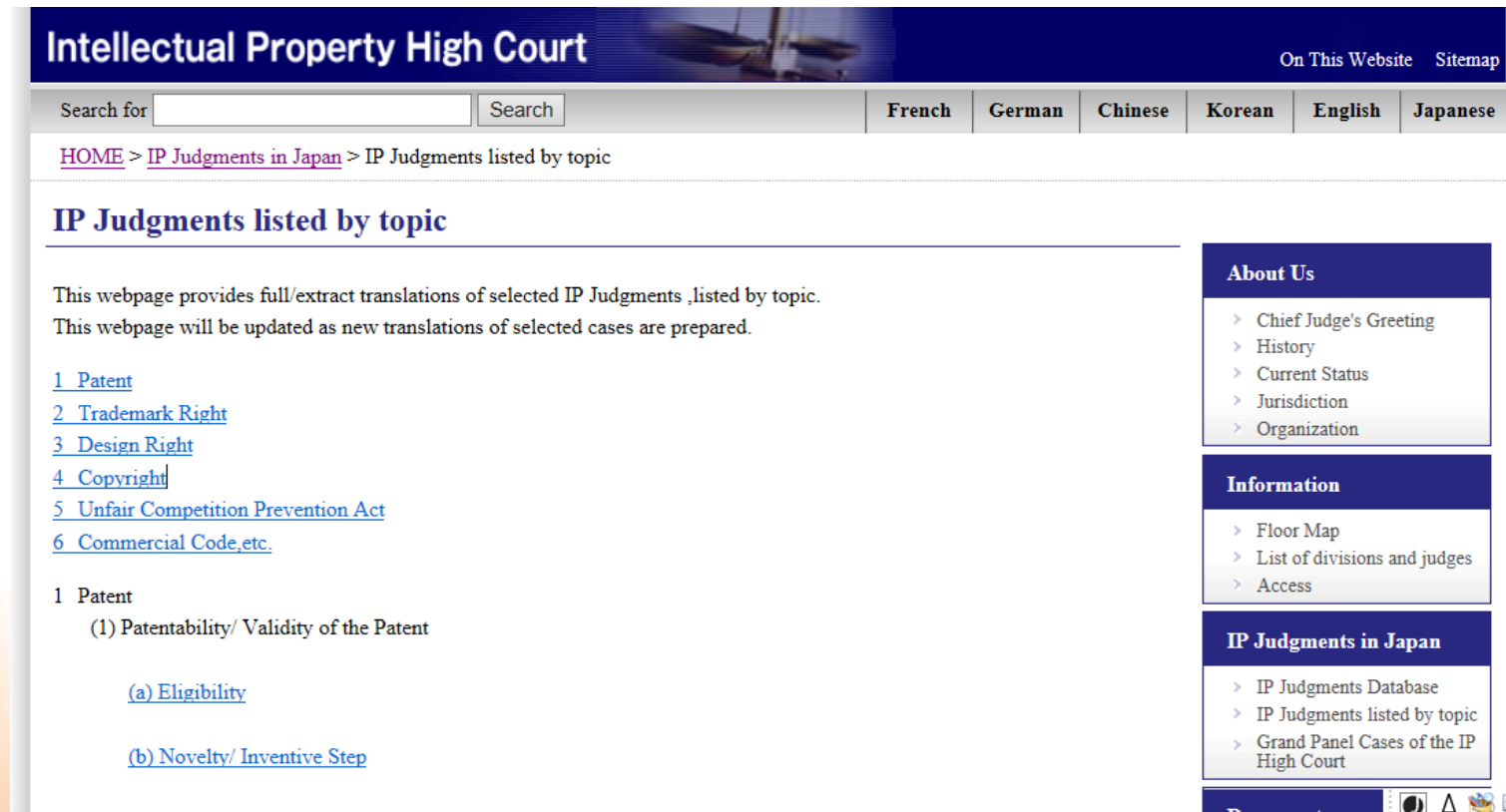


[http://www.ip.courts.go.jp/eng/hanrei/judgments\\_list/index.html](http://www.ip.courts.go.jp/eng/hanrei/judgments_list/index.html)

# IP High Court

## International Info Dissemination

### ➤ Website (cont.)



**Intellectual Property High Court** On This Website Sitemap

Search for   [French](#) [German](#) [Chinese](#) [Korean](#) [English](#) [Japanese](#)

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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](#)

#### About Us


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#### Information

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#### IP Judgments in Japan

- > IP Judgments Database
- > IP Judgments listed by topic
- > Grand Panel Cases of the IP High Court

Documents 

# IP High Court

International Info Dissemination

## ➤ Judicial Symposium on IP 2017

IP High Court organizes an Int'l Symposium.  
From 30 Oct. to 1 Nov. 2017 in Tokyo.

Thank you