IV Management of Proceedings for Patent-related Cases

This chapter outlines the management of proceedings for suits against infringement of a patent and suits against appeal/trial decisions made by the JPO on a patent, which are two of the major IP-related cases.

1 Suits against Infringement of a Patent

(1) A suit against infringement of a patent ("patent infringement suit") is a civil suit to seek an injunction against an act of infringement of a patent or to claim for damages. Patent infringement suits at the first instance are, in principle, under the exclusive jurisdiction of the Tokyo District Court or the Osaka District Court. Any appeal related to such suits will be under the jurisdiction of the Intellectual Property High Court (please refer to Chapter III).

(2) 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. The English translation of these guidelines are publicized on the website of the Intellectual Property High Court (https://www.ip.courts.go.jp/eng/Guidelines_for_Proceedings/index.html, please refer to Chapter VII 5). 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.

(3) It was controversial as to whether it is possible to dispute the validity of a patent in a patent infringement suit. In the "Kilby case" (decided on April 11, 2000), the Supreme Court held that it is an abuse of a right to file a claim based on a patent for which a reason for invalidation clearly exists even though the patent has not been rescinded through a JPO trial procedure. The subsequent addition of Article 104-3 to the Patent Act provided statutory grounds for disputing the validity of a patent in a patent infringement suit. The validity of a patent may be disputed in the course of the JPO trial procedure as well. Therefore, the validity of a patent may be disputed by raising a patent invalidity defense in a patent infringement suit and/or following the JPO invalidation trial procedure.

Ⅳ 特許関係事件の審理運営

この章では，知的財産権関係事件の代表例である，特許権に関する侵害訴訟と審決取消訴訟について，その審理運営を概観します。

1 特許権に関する侵害訴訟

(1) 特許権に関する侵害訴訟（特許権侵害訴訟）は，特許権侵害を理由として侵害行為の差止めや損害賠償などを求める民事訴訟です。特許権侵害訴訟は，原則として，第一審を東京地方裁判所又は大阪地方裁判所が管轄し，控訴審を知的財産高等裁判所が管轄します（Ⅲ参照）。

(2) 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おります。これらはいずれも次のウェブサイトにおいて公開しております（東京地裁審理要領：https://www.courts.go.jp/tokyo/saiban/singairon/index.html，大阪地裁審理要領：https://www.courts.go.jp/osaka/saiban/tetuzuki_ip/index.html，https://www.ip.courts.go.jp/eng/Guidelines_for_Proceedings/index.html）。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などに，和解を勧告して，和解期日を指定することもあります。

(3) 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るかについては議論がありましたが，キルビー事件最高裁判決（最判平成12年4月11日）は，無効理由の存在することの明らかな特許権に基づく請求は，特許庁における審判手続でその特許が無効とされていなくても，権利の濫用であると判示しました。その後，特許法104条の3が設けられ，特許権侵害訴訟において特許の有効性を争えることは法文上の根拠を持つに至りました。特許の有効性は特許庁における審判手続でも争うことができますので，特許の有効性は，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つのルートで争えることとなっています。

(4) 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).

(5) In principle, the procedure of 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. For example, 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). Furthermore, 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). Additionally, 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 and there seems to be no alternative means to obtain evidence. Those inspectors who are authorized to enter into the alleged infringer's factory or other premises and conduct an investigation that is needed to prove the infringement submit a report to the court (Article 105-2, etc. of said Act). Moreover, a confidentiality protective order is also available as a procedure for protecting the trade secrets stated in briefs or evidence (Article 105-4. of said Act).

(6) 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.

(4) 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，①ⓐ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，ⓑ譲渡数量から上記ⓐ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。

(5) 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。例えば，相手方は，特許権者等が侵害の行為を組成したものとして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）。また，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（同法105条），特許権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，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こと（同法105条の2等）ができます。さらには，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）の制度も設けられています。

(6) 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。日本では，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。

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

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. A suit against appeal/trial decision made by the JPO is under the jurisdiction of the Intellectual Property High Court as a court in charge of the first instance (please refer to Chapter III). 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).

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 (https://www.ip.courts.go.jp/eng/Guidelines_for_Proceedings/index.html, please refer to Chapter VII 5). 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.

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.

Office of Court Clerks (書記官室)

Registry/Secretariat Office (訟廷事務室・事務局)

2 特許権に関する審決取消訴訟

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。このような審決取消訴訟は，知的財産高等裁判所が第一審裁判所として管轄を有しています（Ⅲ参照）。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）。

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知的財産高等裁判所ウェブサイト等において公開しており（日本語版：https://www.ip.courts.go.jp/tetuduki/form/index.html，英訳版：https://www.ip.courts.go.jp/eng/Guidelines_for_Proceedings/index.html），審決取消訴訟は，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求められ，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。

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）