

**THE CONSISTENCY BETWEEN A JUDGEMENT
REGARDING A DEFENSE OF INVALIDITY IN A PATENT
INFRINGEMENT LAWSUIT AND A DECISION OF A
INVALIDATION TRIAL IN JAPAN PATENT OFFICE**

April 21,2017

Chief Judge Misao Shimizu

Intellectual Property High Court





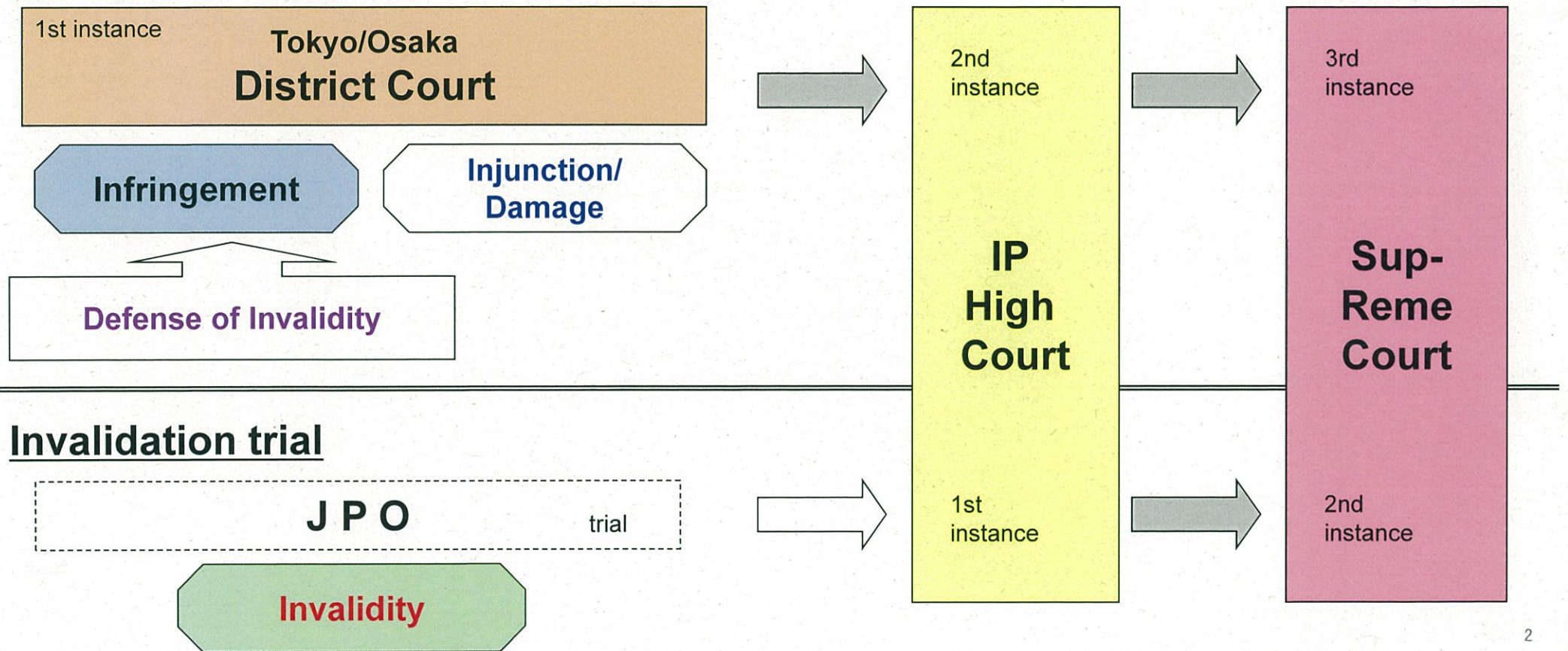
THE CUSTOMARY PRACTICES IN PATENT LITIGATIONS OF JAPAN

The presiding judge of a district court in Japan often asks a defendant at the beginning of oral argument in a patent infringement lawsuit.

”Does the defendant have the plan to raise a defense of invalidity or file a request for an invalidation trial to Japan Patent Office? “

DUAL SYSTEM IN PATENT LITIGATION

Infringement lawsuit





THE CUSTOMARY PRACTICES IN PATENT LITIGATIONS OF JAPAN

If the defendant answers “Yes”,
the presiding judge also requests the defendant to put this plan
into action as soon as possible.

The judge does not recommend a defendant to raise a defense of
invalidity, but just try to take the defendant’s plan into
consideration.

Let me clarify two reasons why the judge makes such a request.



FIRST REASON

If a defendant immediately files a request for an invalidation trial,
a district court can make a judgment after examining a decision of Japan Patent Office.



FIRST REASON

Average time intervals from commencement to disposition of patent infringement lawsuits at district courts are about 15 months.

On the other hand, average time intervals from commencement to disposition of patent invalidation trials of Japan Patent Office are about 8 months.

Therefore, a decision of Japan Patent Office will be made earlier than a judgment of a district court, if an invalidation trial starts around the same time as a patent infringement lawsuit commences.



FIRST REASON

In this case, a district court can examine a decision of Japan Patent Office and then make a judgement, which reaches the same conclusion or sometimes a different conclusion because a decision of Japan Patent Office of course does not have the binding effect to judges.

A judge rarely suspends a proceeding of a patent infringement lawsuit at a district court, so both a lawsuit and a invalidation trial are proceeding at the same time.



SECOND REASON

Even if a decision of Japan Patent Office would be behind a judgement of a district court, a decision of Japan Patent Office will be delivered soon after.

Thus, the same panel of IP High Court can handle both a suit against a decision of Japan Patent Office and an appeal against a judgement of a district court.



SECOND REASON

IP High Court adopts the customary practice that both cases should be allocated to the same panel whether or not a decision of invalidation trial of Japan Patent Office is consistent with a judgment of a district court.

As a result, the allocated panel can coherently solve the same legal issue, regarding invalidity of the same patent in both cases.



THE CHARACTERISTIC OF PATENT LITIGATIONS IN JAPAN

“Consistency” is a highly valued principle in Japan, so IP High Court will continue our efforts to fulfill this principle in patent litigations of Japan.

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- Thank you all very much!