


Finding Facts in Patent Infringement Cases



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Makiko Takabe

Chief Judge, Intellectual Property High Court

Topic

- I. Assertion and proof in patent infringement litigation
- II. Proof of infringement and special provisions established by the Patent Act of Japan
- III. Introduction of reformed inspection system

I Assertion and proof in patent infringement litigation

1. “plaintiff has a patent right ”
2. “defendant practices patented invention”
3. “infringement cause damage and how much it is”

1 “plaintiff has a patent right ”

- the patent registration or the like.

2 “defendant practices patented invention”

- = product which defendant manufactures and sells (or process by which defendant uses) are found to fall within the technical scope of the patented invention.
- manuals, photos and analysis reports of defendant’s products

3 "infringement cause damage and how much it is"

- sales records or profit statements etc. of defendant

II Proof of infringement and special provisions established by the Patent Act of Japan

1. Obligation to clarify the specific features (of infringement)
2. Order to produce documents
3. Presentation of an object for inspection
4. Introduction of reformed inspection system (further revision)

1 Obligation to clarify the specific features (of infringement) (§ 104-2 of the Patent Act)

- defendant shall clarify the specific features of its act

2 Order to produce documents (§ 105 of the Patent Act)

- (I) If documents are “required to prove infringement”,
- (II) not so far as there exist “reasonable grounds”



the court may order defendant to produce documents.

- the plaintiff asserts and proves (I)
- the defendant asserts and proves (II)

2-1 " necessity to prove infringement "

- the level of necessity to interrogate the document ▪ ▪ ▪ probative value of the document as evidence, the existence of alternative evidence
- the judicial interests for finding truth and/or facilitating procedures
- reasonable doubt of infringement

2-2 “reasonable grounds”

comparing and balancing

- "the disadvantage the document holder suffers by disclosing documents"
- "the disadvantage the petitioner suffers by not disclosing documents"

2-3 revised Patent Act enforced in July 2019①

the court can only use the in-camera procedure to decide the existence of the reasonable grounds

↓ revised Patent Act

even when the court decides “whether the document is needed or not to prove the infringement or to calculate the damage”, the court can use the in-camera procedure

2-3 revised Patent Act enforced in July 2019②

the judicial research officials were able to participate in the procedure for deciding whether the document folder should produce the document or not.

↓ revised Patent Act

the technical advisors also participate in the in-camera procedure if the court finds it necessary and with the consent of the parties

3 Presentation of an object for inspection(§ 105 (4) of the Patent Act).

- The provision concerning court order to produce documents shall apply to the procedures on presentation of an object for inspection (similar amendment will be enforced in July 2019).
- Even if the opponent declines the cooperation with the inspection or declines the presentation of an object for inspection in spite of its obligation, execution of them without consent is not appropriate.

4 Introduction of reformed inspection system (further revision)

- The court, upon the petition of a party, may order the neutral and fair expert to collect necessary evidence at the opponent's factory etc. and then write a report, under certain conditions.

III Introduction of reformed inspection system

1. Requirements for ordering newly adopted inspection
2. Collection of evidence
3. Report

1 Requirements for ordering newly adopted inspection

1. “necessity” ▪ ▪ ▪ the object is necessary to prove the infringement.
2. “probability” ▪ ▪ ▪ the probability of patent right infringement by the opposite party.
3. “non-alternativeness” ▪ ▪ ▪ the petitioner can not collect evidence by other means enough to recognize facts to be proved.
4. “appropriateness” ▪ ▪ ▪ the necessary time or burden which the opposite party suffers for the inspection.

2 Collection of evidence

- The court designates the neutral and fair third party who enforces this procedure
lawyers, patent attorneys, researchers
- Experts enter the opponent's properties and collect materials by examining the documents and goods
- Experts summarize the results in the report.

3 Report

- the report is not necessary to prove infringement \Rightarrow the portion relating to trade secrets will not be disclosed.
- the report is necessary to prove infringement \Rightarrow the court will compare and balance the necessity of proving infringement with the necessity of protecting trade secret.
 - < trade secret · · · will not be disclosed.
 - > trade secret · · · will be disclosed.

thank you for your attention



MAKIKO TAKABE
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