JAUIP Summer IP Seminar

Fundamentals of Patent Dispute Resolution in Japan and the United States

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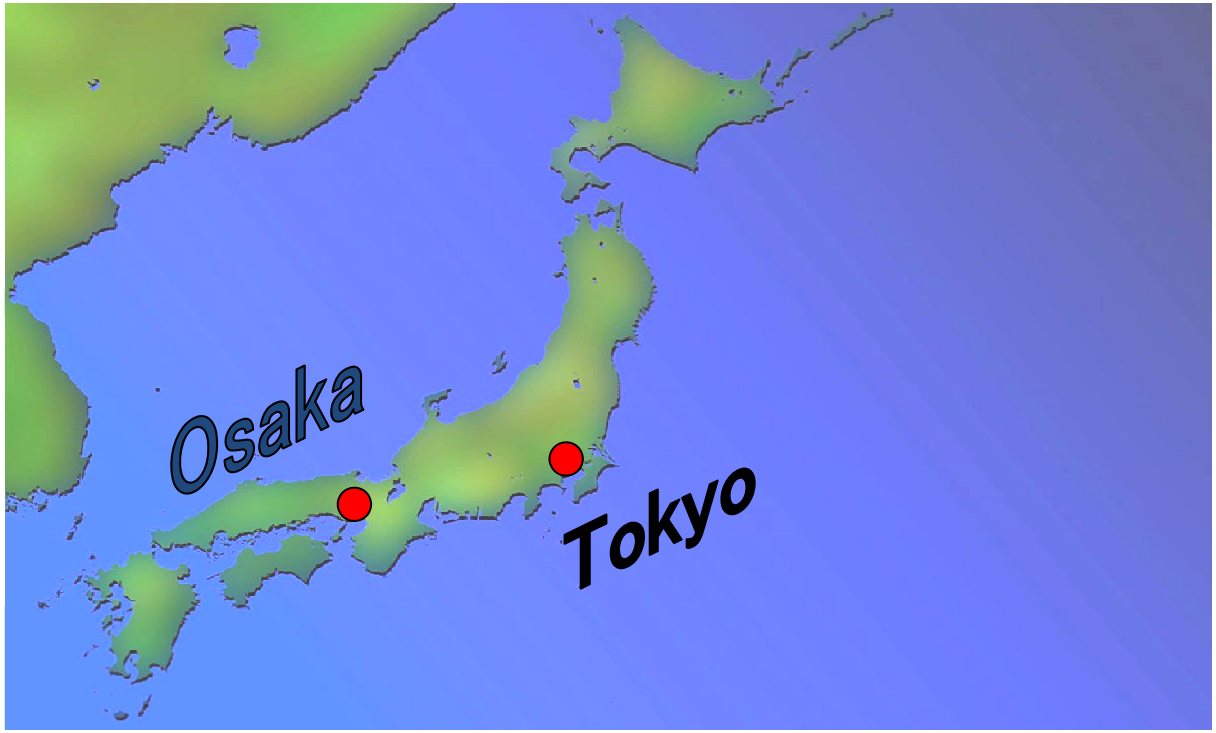
Overview of Patent Litigation in Japan

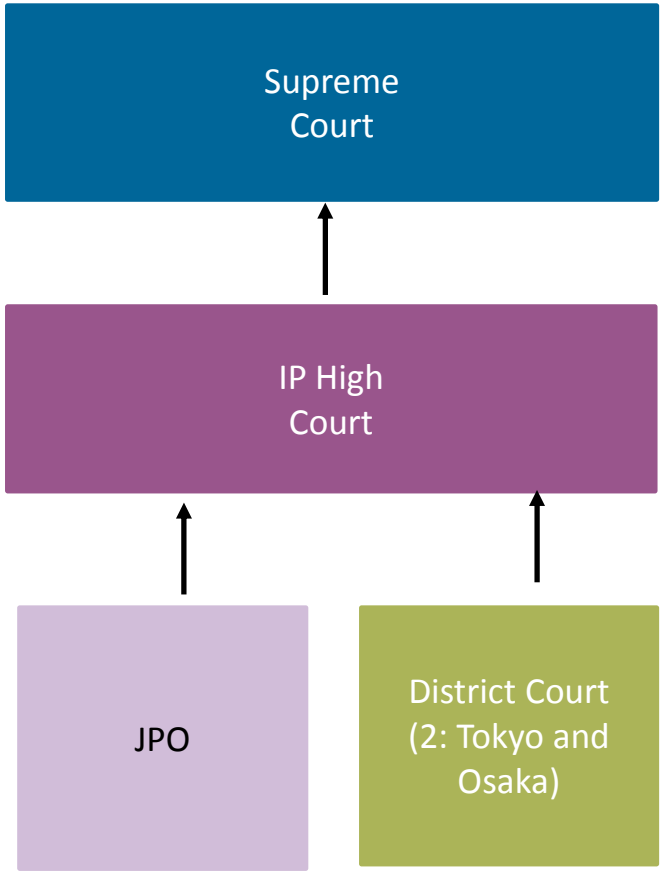
Trial courts

Tokyo & Osaka District Courts



Overview of Patent Litigation in Japan

Appeal from district courts and JPO is to IP High Court



Overview of Patent Litigation in Japan

- Unified

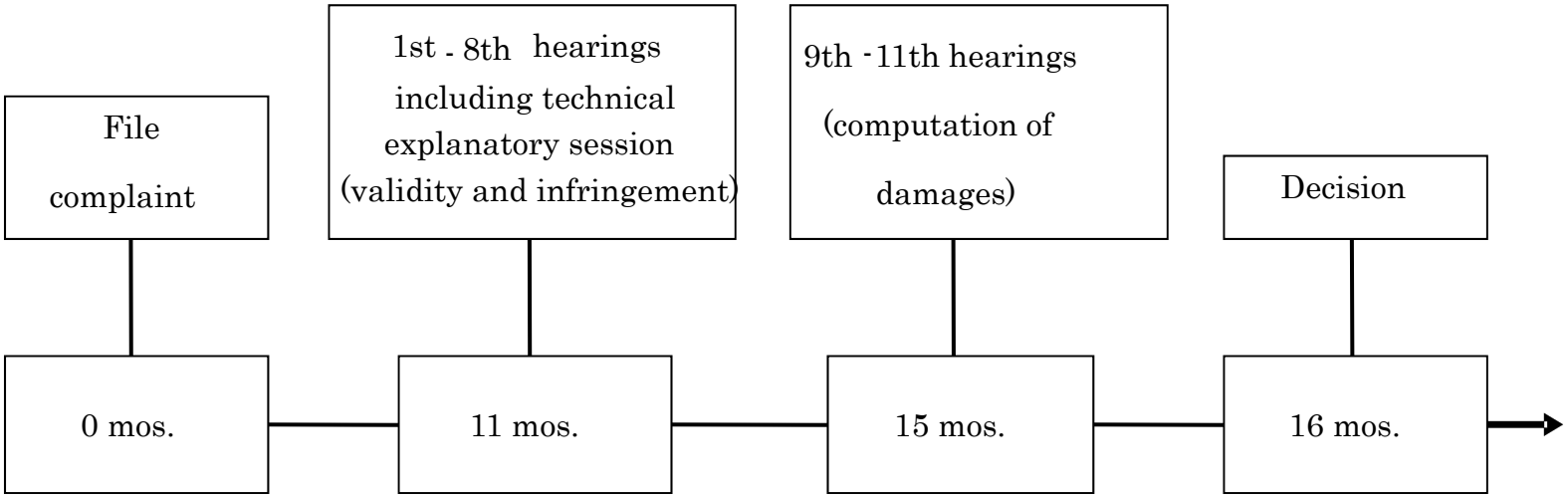
  Infringement and validity issues are heard in the same forum
- No jury trial
- Specialized IP court/judges

  - Tokyo & Osaka District Courts have specialized divisions for intellectual property rights
  - Staffed with technical experts

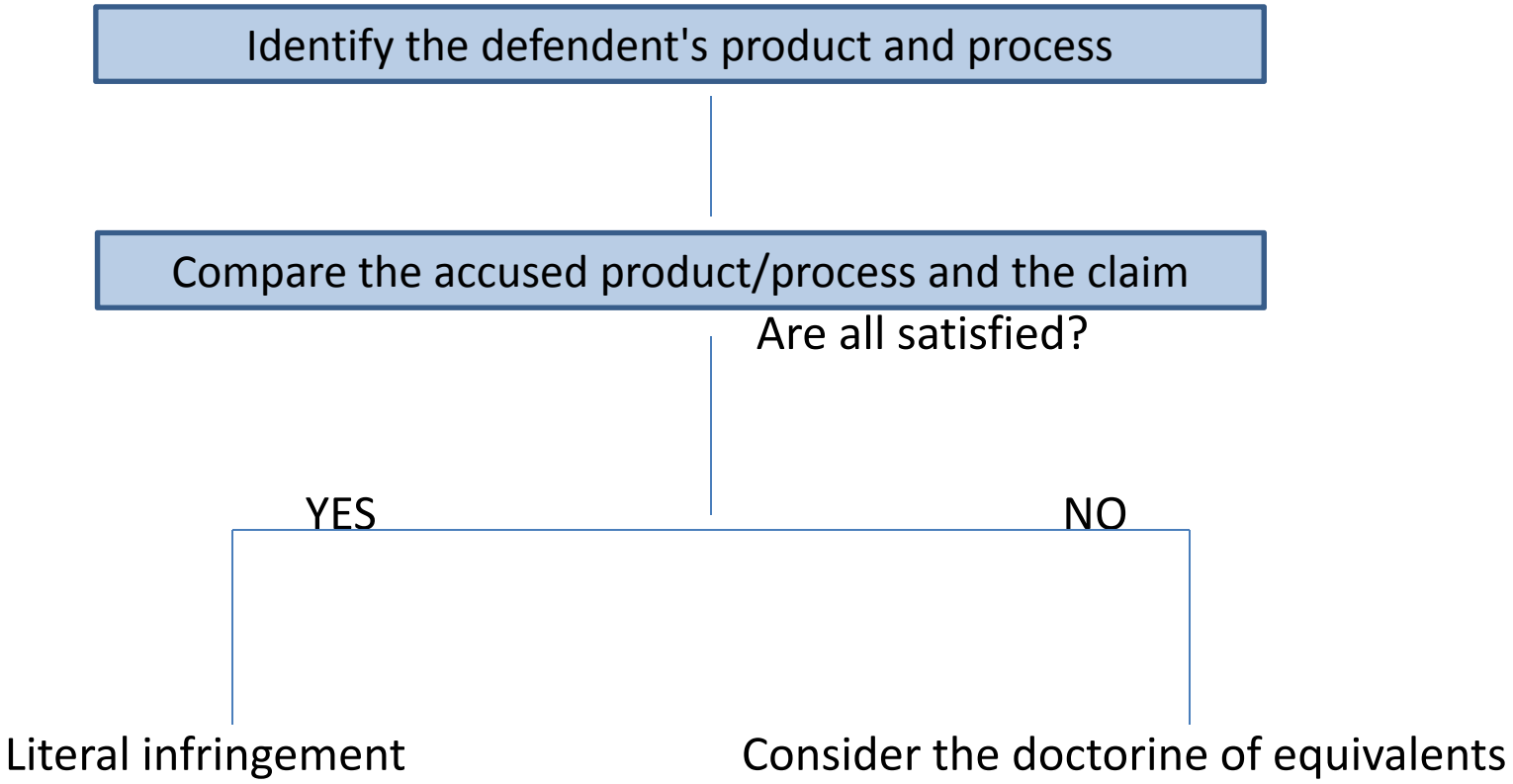
Overview of Patent Litigation in Japan

- No thorough discovery procedures
- Technical explanatory session
- Settlement
- Fairly speedy (district courts: approx. 14 months; IP High Court: approx. 8 months
- Injunction

Sample Timeline of Patent Litigation in Japan
(1st Instance)



Infringement Analysis



Claim Interpretation

- **Claim Language**
- **Description in the Specifications**
- **Prosecution history**

  Bound by prosecution history, such as amendments to claims and patent applicant's written argument

✓ Construe the meaning of a term of claim(s) in a way not including the **prior art**

Literal Infringement

The composition (characteristics) of the accused product/process contains every element of claim

Infringement Under Doctrine of Equivalents

A theory that the defendant products are deemed equivalent to the constitution stated in the claim(s), therefore, falls under the technical scope of a patented invention, even if there is a part that is different from the Defendant’s products within the constitution in the claim(s).

Ball Spline Bearing Case

Supreme Court Judgment of Feb. 24, 1998 (Ball Spline Bearing Case)

"Even if there is a part that is different from the subject products within the constitution stated in the scope of claim(s),

(1) if this part is not the essential part of the patented invention,

(2) the purpose of the patented invention can be achieved by replacing this part with a part of the accused products,

(3) such replacement could have easily been conceived by a person with average knowledge in the area of technology (a person skilled in the art) at the time of the manufacturing of the said product,

(4) if the products are not identical to the technology in the public domain at the time of the patent application of the patented invention or could not have been easily conceived by this person at that time, and

(5) if there were no special circumstances such as the fact that those products had been intentionally excluded from the scope of the patent claim in the patent application process,

such products should be regarded as identical in construction as indicated in the scope of the patent claim and fall within the scope of the technological scope of the patented invention."

5 Requirements for Equivalency

1. Non-essentiality
2. Same operational advantage
3. Interchangeability（at the time of infringement)
4. Not easily conceivable (at the time of the patent application)
5. Prosecution history estoppel

- Patentee bears the burden of proof regarding 1, 2, and 3.
- Accused infringer bears the burden of proof regarding 4 and 5.

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