

# Patent Infringement Litigation Case Study (3)

— Unenforciability of Patent Right  
in Patent Infringement law Suit in Japan —

Japan Patent Office  
Asia-Pacific Industrial Property Center, JIII

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## 1. Patent Invalidation Procedure against Patent Right in Japan

It has been interpreted that a patent shall be construed as valid in an infringement court. Under the Japan Patent Act, a patent is valid until a trial decision of invalidation of a patent by an invalidation trial of the Japan Patent Office is made final and conclusive. Only the Japan Patent Office can invalidate a patent.

However, “an apparent reason for invalidation” is found in the patent by a patent infringement court in a patent infringement law suit, the court should decide that the patent is “unenforceable” by the reason of “abuse of patent right” in the light of equity ( the Judgment of the Supreme Court of Japan, Third Petty Bench, April 11, 2000, Heisei 10 (o) 364, in so-called “Kilby case” ).

Patent Act Article 104.3 (came into force from April 1, 2005) has made clear the “unenforceability of an invalid patent” in accordance with this Judgment of the Supreme Court.

Since the Supreme Court’s Judgment in the Kilby Case, almost alleged infringers have asserted reasons of invalidity of patent rights on the ground of abuse of right.

Since Japan Patent Act Article 104.3 came into force on Apr. 1, 2005, alleged infringers have asserted unenforceability of patent rights because of lack of patentability on the ground of the Article 104.3(1).

Many alleged infringers have filed demands for trial of invalidation of patent right before the Japan Patent Office independently or in parallel with assertion of reason for invalidation in the patent infringement court. In many cases, an appealed patent infringement civil law suit and an administrative law suit concerning the same patent for seeking cancellation of a trial decision have been pending at the same time in the IP High Court.

A patent holder who is attacked by a reason for invalidation has often file a demand for a trial of correction (or file a demand for correction in an invalidation trial) as defense. (If a correction of the patented claim is allowed by the JPO in a trial for correction after an invalidation trial decision to invalidate the patent, the invalidation trial decision must be cancelled. Because the reason for invalidation of the patent must be removed after the correction of the patented claim.)

Trial decisions of invalidation trial are “The patent shall be invalidated.” or “The demand for invalidation of the patent shall not be accepted.”

Trial decisions of correction trial are “The correction shall be allowed.” or “The correction shall not be allowed.”

An administrative Law Suit against the Trial Decision of the Trial Board of the Japan Patent Office should be examined exclusively before the Tokyo High Court (before March 31, 2005 ) then before the IP High Court (after April 1, 2005) under the provisions of the Japan Civil Procedure Act.

The decisions of the High Court are “The claim for cancellation of the trial decision shall be dismissed.” (This means that the trial decision shall be maintained.) or “The trial decision shall be cancelled.”

When the trial decision is cancelled in the High Court, the trial board of the JPO has to re-examine the case and to make another trial decision.

## 2. Supreme Court Judgment in Kilby Case

Supreme Court Judgment the Third Petty Bench

April 11, 2000 Case No. Heisei 10 (o) 364 (of 1998)

The Supreme Court referred to the “Doctrine of Equity” in a civil procedure and confirmed that a patent infringement court should be able to examine whether there is any obvious reason for invalidation of the disputed patent or not even before an invalidation trial decision by the Japan Patent Office to invalidate the disputed patent becomes final and conclusive.

And the Supreme Court concluded that if any obvious reason for invalidation of the patent is found after the examination by a patent infringement court, the patent holder can not exercise the patent right and that a claim for injunction, damages, and others based on the patent right must not be allowed on the ground of abuse of right.

After the Supreme Court Judgment in Kilby Case, in patent infringement courts, a lot of patent rights have been sentenced to be unenforceable as the patents are considered to be invalidated in invalidation trial.



### 3. Patent Act Article 104-3

The Patent Act Article 104.3 (amended in 2004 in accordance with the Judgment of the Supreme Court in Kilby Case) has come into force from April 1, 2005, and has made clear the “unenforceability of an invalid patent” in a patent infringement case.

#### Patent Act Article 104-3 (104 ter)

##### Paragraph 1:

In a patent infringement lawsuit relating patent right or exclusive license (note: “Senyo-Jisshiken” under Article 77), the patent holder or the exclusive licensee shall not exercise the patent right to the other party, when the patent is considered to be invalidated in a patent invalidation trial.

##### Paragraph 2:

With respect to the means of attack or defense under the preceding paragraph, the court may, upon motion or ex officio, render a ruling of dismissal, if the submission involving such measures is considered to have been made for the purpose of causing unreasonable delay in the trial.

### 4. Patent Infringement Civil Law Suit in Japan

#### Before March 31, 2004:

##### ○The First Instance Court (District Court)

A patent infringement case could be examined before any one of district courts (50) as the first instance court.

Most of patent infringement cases were brought before the Tokyo District Court or the Osaka District Court.

##### ◎The Second Instance Court (Appellate court) (High Court)

The losing party (the alleged infringer or the patent holder) could appeal (so-called

“Koso-appeal”) against the original or first instance court decision before the second instance court.

A patent infringement appealed cases was examined before any one of high courts (8) having the jurisdiction over the first instance district court.

Most of patent infringement appealed cases were examined before the Tokyo High Court or the Osaka High Court.

From April 1, 2004 to March 31, 2005

(Since the amendment of Civil Procedure Code in 2003, effect from April 1, 2004)

(The jurisdiction for patent infringement law suits has been revised.)

○The First Instance Court (District Court)

The Tokyo District Court (for patent infringement law suits in the Eastern area of Japan) and the Osaka District Court (for patent infringement law suits in the Western area of Japan) have had exclusive jurisdiction over patent infringement cases.

◎The Second Instance Court (Appellate court) (High Court)

The Tokyo High Court (the Intellectual Property Special Division of the Tokyo High Court ) have had exclusive jurisdiction as the Appellate Court from the Tokyo District Court and the Osaka District Court for patent infringement cases.

Since April 1, 2005

(The Intellectual Property High Court has established as the special branch of the Tokyo High Court on April 1, 2005 to deal with intellectual property cases including patent infringement cases as the successor of the Intellectual Property Special Division of the Tokyo High Court.)

○The First Instance Court (District Court)

(exclusive jurisdiction over patent infringement cases)

The Tokyo District Court (for the Eastern area of Japan) or

The Osaka District Court (for the Western area of Japan)

◎The Second Instance Court (Appellate court) (High Court)

(exclusive jurisdiction over patent infringement appealed cases)

The Intellectual Property High Court (The IP High Court)

■ The third and the last Instance Court (The Supreme Court)

The appeal (“Jokoku Appeal” and/or “Jokoku-Juri Appeal”) may be instituted against a decision in the Tokyo High Court (before March 31, 2005) or the Intellectual Property High Court (since April 1, 2005) before the Supreme Court as the third and the last instance court.

“Jokoku Appeal” : in case of violation of constitutional provision

“Jokoku-Juri Appeal” : in case of violation of the Supreme Court precedents

## 5. CASE STUDY

Forty one patent infringement cases in which appellate court decisions are found are selected from April 11, 2000 (The Supreme Court Judgment in “Kilby Case” was held on the day) to October 30, 2006. They are arranged as follows in each case.

No.XX Case of Seeking .....

Patent Number : XXXXXXXX

Patent Infringement Law Suit : (arranged in reverse sequence)

◎Appellate Court Decision : (The Second Instance Court Decision)

(IP High Court , Tokyo High Court, Osaka High Court)

○Original Court Decision : (The First Instance Court Decision)

(Tokyo District Court, Osaka District Court)

Invalidation Procedure against the Patent : (arranged in sequence)

(Invalidation Trial and Judicial Action against the Trial Decision)

◇ JPO Trial Decision

(trial decision by the trial board of the Japan Patent Office)

□ Judicial Court Appeal against the JPO Trial Decision

(Administrative Law Suit concerning JPO Trial Decision)

(IP High Court , Tokyo High Court)

COMMENT :

☆Articles concerning “Reason for invalidation of patent

(See Patent Act Art. 123)

Lack of novelty;

Patent Act Art. 29, Para. 1, Item 1

Patent Act Art. 29, Para. 1, Item 2

Patent Act Art. 29, Para. 1, Item 3

Lack of inventive step;

Patent Act Art. 29, Para. 2

Lack of description requirement;

Patent Act Art. 36, Para. 6, Item 1 (Lack of supporting description)

Patent Act Art. 36, Para. 6, Item 2 (Lack of clearness)

(Prior to the revision in 1994, Patent Act Art. 36, Para. 6, Item 1 corresponded to Patent Act Art. 36, Para. 5 Item 1 and Patent Act Art. 36, Para. 6, Item 2 corresponded to Patent Act Art. 36, Para. 5 Item 2)

Another reason:

Patent Act Art. 123, Para. 1, Item 6 not the inventor, not the successor

**No.01 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 3294820**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Oct. 30, 2006, IP High Court ; Case No. Heisei 18 (ne)10034 (of 2006 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated, because lack of inventive step is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

Feb. 28, 2006, Tokyo District Court ; Case No. Heisei 17 (wa) 4581 (of 2005)

“The claim of the patent holder shall be dismissed.”

“The patent is to be invalidated, because lack of inventive step is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision Feb. 3, 2006 Invalidation Trial No. 2005-80002 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : Oct. 30, 2006 Heisei 18 (gyo ke) 10098 (of 2006)

“The claim for cancellation of the trial decision shall be dismissed.

(This meant that the patent shall be invalidated.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for cancellation of the JPO trial decision at the same day.

**No.02 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2978025**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Oct. 30, 2006, IP High Court ; Case No. Heisei 18 (ne)10030 (of 2006 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated, because lack of inventive step is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

Feb. 28, 2006, Tokyo District Court ; Case No. Heisei 16(wa)20601 (of 2004)

“The claim of the patent holder shall be dismissed.”

“The patent is to be invalidated, because lack of inventive step is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision(1) May 21, 2001 Invalidation Trial No. 2000-35169 (JPO)

“The demand for invalidation of the patent is not allowed” (P.A. 29(2))

(The decision meant that the patent was to be maintained as valid.)

◇ JPO Trial Decision(2) Feb. 3, 2006 Invalidation Trial No. 2004-80241 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision (2)

IP High Court Decision : Oct. 30, 2006 Heisei 18 (gyo ke) 10096 (of 2006)

“The claim for cancellation of the trial decision is dismissed.”

(This meant that the patent shall be invalidated.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for the JPO trial decision at the same day.

### **No.03 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2599945**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Oct. 4, 2006, IP High Court ; Case No. Heisei 17 (ne)10111 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated, because lack of inventive step is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

August 30, 2005, Tokyo District Court ; Case No. Heisei 16 (wa) 9540 (of 2004)

“The claim of the patent holder shall be dismissed.”

“The patent is to be invalidated, because a reason for invalidation is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent and the Defense :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision April 26 2005 Invalidation Trial No. 2004-80073 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : Oct. 4, 2006 Heisei 17 (gyo ke) 493 (of 2005)

“The claim for cancellation of the trial decision is dismissed.”

(This meant that the patent shall be invalidated.)

(Correction Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision March 1, 2006 Correction Trial No. 2005-39138 (JPO)

“The correction shall not be allowed.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : Oct. 4, 2006 Heisei 18 (gyo ke) 130 (of 2006)

“The claim for cancellation of the trial decision is dismissed.”

(This meant that the correction of the patent shall not be allowed.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for canceling the JPO trial decision at the same day.

The court expected that the patent must be lack of inventive step even after the correction of the patent.

#### **No.04 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 3121727 (Patent 5) et al.**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Sept. 25, 2006, IP High Court ; Case No. Heisei 17 (ne) 10047 (of 2005 )

“The part of the original decision shall be changed.”

(The appellate court admit the part of the claim on the base of the Patent 5.)



(The Patent 5 is valid. The Patent 1~4 are made invalid conclusively.)

○ Original Court Decision :

March 26, 2003, Tokyo District Court ; Case No. Heisei 13(wa)3485 (of 2001)

“The alleged product shall not be made by the accused party.”

(The original court admit the claim of the patent holder.)

(The Patent is found to be valid. )

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision(1) July 2, 2002 Invalidation Trial No. 2001-35537 (JPO)

“The demand for invalidation of the patent is not allowed” (P.A. 29 )

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (1)

Tokyo High Court Decision : Sept. 29, 2003 Heisei 14 (gyo ke)386 (of 2002)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be maintained to be valid.)

◇ JPO Trial Decision(2) April 14, 2003 Invalidation Trial No. 2002-35436 (JPO)

“The demand for invalidation of the patent is not allowed” (P.A. 29 (2))

(The decision meant that the patent was to be maintained as valid.)

◇ JPO Trial Decision(3) Oct. 8, 2004 Invalidation Trial No. 2004-80055 (JPO)

“The demand for invalidation of the patent is not allowed” (P.A. 29 (2))

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (3)

IP High Court Decision : Dec. 1, 2005 Heisei 17 (gyo ke)339 (of 2005)

“The claim for cancellation of the trial decision is dismissed.”

(This meant that the patent shall be maintained to be valid.)

COMMENT:

The Patent 5 (3121727) has been maintained to be valid.

The Patent 1-4 at issue have been invalidated conclusively.

**No.05 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2882962**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

June 26, 2006, IP High Court ; Case No. Heisei 18 (ne)10018 (of 2006 )  
“The appeal shall be dismissed.” (The original court decision is affirmed.)  
“The patent is to be invalidated because of lack of inventive step.”  
(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

January 30, 2006, Tokyo District Court ; Case No. Heisei 16 (wa)12180 (of 2006)  
“The claim of the patent holder shall be dismissed.”  
“The patent is to be invalidated because of lack of inventive step.”  
(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision July 28, 2005 Invalidation Trial No. 2004-80125 (JPO)  
“The patent shall be invalidated.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : April 24, 2006 Heisei 17 (gyo ke)10672 (of 2005)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent shall be invalidated.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for cancellation of the JPO trial decision .

**No.06 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2139927**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

May 31, 2006, Osaka High Court ; Case No. Heisei 16 (ne)3586 (of 2005 )  
“The appeal shall be dismissed.” (The original court decision is affirmed.)  
“The patent is to be invalidated, because lack of inventive step is found.”  
(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

Oct. 21, 2004, Osaka District Court ; Case No. Heisei 13 (wa) 9403 (of 2001)  
“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para 2)

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision Feb. 12, 2004 Invalidation Trial No. 2003-35311 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 1, Item 3)

COMMENT:

JPO Invalidation Trial Decision was that the patent shall be invalidated on the ground of lack of novelty.

The first instance patent infringement court (Osaka District Court) found that the patent is to be invalidated by the reason of lack of inventive step and concluded that exercising the patent right is deemed to be abuse of right in accordance with the Court Precedent of “Kilby case”.

The second instance or appellate patent infringement court (Osaka High Court) affirmed the decision of the original court of the Osaka District Court by applying the newly enforced article of Patent Act Art. 104.3, Para. 1.

#### **No.07 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 3125141**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

March 30, 2006, IP High Court ; Case No. Heisei 17 (ne)10109 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated because of lack of inventive step.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

July 29, 2005, Tokyo District Court ; Case No. Heisei 16 (wa)14019 (of 2004)

“The claim of the patent holder shall be dismissed.”

“The patent is to be invalidated because of lack of inventive step.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

(Correction Trial )

◇ JPO Correction Trial Decision Dec. 16, 2005 Correction Trial No. 2005-39178

(JPO)

“The correction shall be allowed.”

COMMENT:

The correction was allowed, however, the invalidity of patent was found in the infringement court.

**No.08 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 1851891**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

March 27, 2006, IP High Court ; Case No. Heisei 17 (ne)10005 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated because of lack of inventive step.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

July 30, 2003, Tokyo District Court ; Case No. Heisei 14 (wa)2473 (of 2002)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision(1) June 27, 2003 Invalidation Trial No. 2002-35248 (JPO)

“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (1)

IP High Court Decision : July 21, 2004 Heisei 15 (gyo ke)331 (of 2003)

“The trial decision shall be cancelled.”

(This meant that the court found errors in the conclusion of the trial decision .)

◇ JPO Second Trial Decision(1) Sept. 7, 2005 (No. 2002-35248)

“The demand for invalidation of the patent is not allowed” (P.A. 29 (2))

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Second Trial Decision (1)

IP High Court Decision : March 27, 2006 Heisei 17 (gyo ke)10707 (of 2005)

“The second trial decision shall be cancelled.”

(This meant that the court found errors in the conclusion of the trial decision .)

◇ JPO Third Invalidation Trial (No. 2002-35436) (pending)

#### COMMENT :

The first and second instance patent infringement courts (Tokyo District Court and IP High Court) found the reason for invalidation of the patent because of lack of inventive step in the patent infringement case.

The IP High Court cancelled the first invalidation trial decision and the second invalidation trial decision (repeated-trial decision after the cancellation of the former invalidation trial decision) in which the JPO trial board concluded the patent is to be valid.

A plurality of demand for correction trial have been filed.

The patent was expired on March 27, 2006.

#### **No.09** Case of Seeking Injunction and Damages against Patent Infringement

**Patent Number : JP 3433195**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

January 30, 2006, IP High Court ; Case No. Heisei 17 (ne)10080 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated, because lack of novelty is found.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 1, Item 3)

○ Original Court Decision :

March 25, 2005, Tokyo District Court ; Case No. Heisei 16 (wa)16483 (of 2004)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of novelty is found.”

(Court precedent ; Patent Act Art. 29, Para 1, Item 3)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision June 4, 2005 Invalidation Trial No. 2004-80192 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 1, Item 3)

- Judicial Court Appeal against the JPO Trial Decision  
 IP High Court Decision : January 30, 2006 Heisei 17 (gyo ke)10547 (of 2005)  
 “The claim for cancellation of the trial decision shall be dismissed.”  
 (This meant that the patent shall be invalidated.)
- Jokoku Appeal (Supreme Court) was dismissed on June 1, 2006.
- Jokoku- Juri Appeal (Supreme Court) was turned down on June 1, 2006.  
 (The Supreme Court did not overruled the IP High Court Decision, which meant that the patent was made invalid conclusively.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for canceling the JPO trial decision at the same day.

**No. 10 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 3136129**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :  
 January 25, 2006, IP High Court, Case No. Heisei 17 (ne)10004 (of 2005 )  
 “The lost part of the appellor party in the original decision shall be revoked.”  
 (This decision meant that the claim of the patent holder was to be dismissed.)  
 “The patent is to be invalidated, because lack of novelty is found.”  
 (Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 1, Item 3)
- Original Court Decision :  
 April 14, 2003, Tokyo District Court, Case No. Heisei 14 (wa)9503 (of 2002 )  
 “Importing and selling the alleged product shall be banned.  
 (The claim of the patent holder is to be admitted partly.)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

- ◇ JPO Trial Decision March 30, 2005  
 Invalidation Trial No. 2002-35399, 2003-35449 (JPO)  
 “The patent shall be invalidated.” (Patent Act Art. 29, Para 1, Item 3)
- Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : January 25, 2006 Heisei 17 (gyo ke)10572 (of 2005)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for canceling the JPO trial decision at the same day.

**No.11 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2905776**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Nov. 29, 2005, IP High Court ; Case No. Heisei 17 (ne)10024 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated because of lack of inventive step.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

Feb. 17, 2005, Tokyo District Court ; Case No. Heisei 15 (wa)16706 (of 2003)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision Nov. 4, 2004 Invalidation Trial No. 2003-35521 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : Nov. 29, 2005 Heisei 17 (gyo ke)10115 (of 2005)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

COMMENT:

The same court (IP High Court) found that the patent shall be invalidated because of

lack of inventive step both in the appealed case of patent infringement law suit and in the case seeking for canceling the JPO trial decision at the same day.

**No. 12 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 3446095**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Oct. 26, 2005, IP High Court; Case No. Heisei 17 (ne)10096 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated because of lack of inventive step.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)

○ Original Court Decision :

June 17, 2005, Tokyo District Court; Case No. Heisei 16(wa)4339 (of 2004 )

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para 2)

Invalidation Procedure against the Patent :

(Invalidation Trial )

◇ JPO Invalidation Trial No. 2006-80128 (JPO)

(now pending)

COMMENT:

Invalidity of the patent was found in the infringement court.

**No. 13 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2803236**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Sept. 30, 2005 IP High Court; Case No. Heisei 17 (ne)10040 (of 2005 )

“The original decision is to be quashed to dismiss the patent holder’s claim.”

“The patent is to be invalidated because of lack of inventive step.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2)



○ Original Court Decision :

Feb. 1, 2005, Tokyo District Court; Case No. Heisei 16 (wa)16732 (of 2004)

“Making and selling the alleged product shall be banned.”

“Reason for invalidation of the patent is not found”

(The claim of the patent holder was admitted at the first instance court.)

COMMENT:

A demand for invalidation trial against the patent can not be found.

The invalidity of the patent because of lack of inventive step has been found in the stage of the appellate court (IP High Court) by using a newly submitted evidence of a document published in a foreign country.

The Patent Act Art. 104.3 was applied for the first time in the case.

#### **No. 14** Case of Seeking Injunction and Damages against Patent Infringement

**Patent Number : JP 3303165**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Aug. 30, 2005, IP High Court ; Case No. Heisei 17 (ne)10069 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is to be invalidated because lack of inventive step is found and the patent is to be invalidated because the patent was granted to the person who was not the inventor and had not succeeded to the right to obtain a patent.”

(Patent Act Art. 104.3, Para. 1 ; Patent Act Art. 29, Para 2, Art. 123, Para. 1, Item 6)

○ Original Court Decision :

March 10, 2005, Tokyo District Court ; Case No. Heisei 16(wa)11289 (of 2004 )

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found and another reason for invalidation that the patent was granted to the person who was not the inventor and had not succeeded to the right to obtain a patent is found.”

(Court precedent ; Patent Act Art. 29, Para 2, Art. 123, Para. 1, Item 6)

COMMENT:

An invalidation trial against the patent can not be found.

A trial for correction of the patent was filed but the correction was not admitted.

**No. 15 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 3367651**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

April 28, 2005, IP High Court, Case No. Heisei 17 (ne)10050 (of 2005 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is not infringed by the alleged product.”

(The second instance court supported the first instance court’s decision conclusively.)

○ Original Court Decision :

April 23, 2004, Tokyo District Court, Case No. Heisei 15(wa)9215 (of 2003)

“The claim of the patent holder shall be dismissed.”

“The patent is not infringed by the alleged product.”

“The prior users right of the alleged party is found.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

COMMENT:

An invalidation trial against the patent can not be found.

**No. 16 Case of Seeking Injunction against Patent Infringement**

**Patent Number : JP 2965229**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

January 27, 2005, IP High Court, Case No. Heisei 16 (ne)1664 (of 2004 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is not infringed by the alleged product.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of clearness.”

(The second instance court supported the first instance court’s decision conclusively.)

○ Original Court Decision :

Feb. 20, 2004, Tokyo District Court, Case No. Heisei 14(wa)25696 (of 2002)

“The claim of the patent holder shall be dismissed.”

“The patent is not infringed by the alleged product.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of description requirement.”

(Court precedent ; Patent Act Art. 36, Para. 5, Item 2)

Invalidation Procedure against the Patent :

(Invalidation Trial)

◇ JPO Trial Decision January 21, 2005 Invalidation Trial No. 2003-35286 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 36, Para. 5, Item 1,2 )

COMMENT:

The trial decision for invalidation of the patent has been affirmed.

**No. 17 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 2965229**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

January 27, 2005, IP High Court, Case No. Heisei 16 (ne)1589 (of 2004 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The patent is not infringed by the alleged product.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of description requirement.”

(The second instance court supported the first instance court’s decision .)

(Court precedent ; Patent Act Art. 36, Para. 5, Item 2)

○ Original Court Decision :

Feb. 20, 2004, Tokyo District Court, Case No. Heisei 14(wa)25697 (of 2002)

“The claim of the patent holder shall be dismissed.”

“The patent is not infringed by the alleged product.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of clearness.”

(Court precedent ; Patent Act Art. 36, Para. 5, Item 2)

COMMENT:

This case is related to the same patent as the said case No.16.

The patent has been expired on May 23, 2005.

**No. 18** Case of Seeking injunction and damages against Patent Infringement

Patent Number : JP 3105507

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

January 27, 2005, Osaka High Court, Case No. Heisei 16 (ne)281 (of 2004 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step.”

(Court precedent ; Patent Act Art. 29, Para. 2)

○ Original Court Decision :

Dec. 18, 2003, Osaka District Court, Case No. Heisei 14(wa)7600 (of 2002)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step.”

(Court precedent ; Patent Act Art. 29, Para. 2)

COMMENT:

An invalidation trial against the patent can not be found.

A trial for correction of the patent was filed but the correction was not admitted.

**No. 19** Case of Seeking Confirming No Infringement

Patent Number : JP 1875901

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

January 25, 2005, IP High Court, Case No. Heisei 16 (ne)1563 (of 2004 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“A reason for invalidation of the patent can not be found.”

○ Original Court Decision :

Feb. 26, 2004, Tokyo District Court, Case No. Heisei 15(wa)15702 (of 2003)

“The claim of the plaintiff shall be dismissed.”

“A reason for invalidation of the patent can not be found.”

COMMENT:

An invalidation trial against the patent can not be found.

**No. 20 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 2561429**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Sept. 30, 2004 Tokyo High Court ; Case No. Heisei 16 (ne)1367 (of 2004)

“The original decision shall be changed partly.”

(The appellate court admit the patent holder’s claim.)

“Apparent reason for invalidation of the patent 1 is not found”

○ Original Court Decision :

Feb. 20, 2004, Tokyo District Court ; Case No. Heisei 14 (wa)12858 (of 2002)

“ ” (admit the patent holder’s claim)

“Apparent reason for invalidation of the patent 1 is not found”

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision(1) Feb. 17, 1999 Invalidation Trial No. Hei10-35148 (of 1998)

“The demand for invalidation of the patent is not allowed” (P.A. 29(1)(iii), 29(2) )

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (1)

Tokyo High Court Decision : Heisei 11 (gyo ke)77 (of 1999)

“The law suit shall be dismissed.”

(This meant that the patent shall be maintained to be valid.)

◇ JPO Trial Decision(2) Dec. 25, 1999 Invalidation Trial No. Hei11-35186 (of 1999)

“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (2)

Tokyo High Court Decision : April 4, 2001 Heisei 12 (gyo ke)35 (of 2000)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent was to be maintained as valid.)

◇ JPO Trial Decision(3) Nov. 11, 2002 Invalidation Trial No. 2002-35210

“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (3)

Tokyo High Court Decision : May 12, 2004 Heisei 14 (gyo ke)604 (of 2002)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent was to be maintained as valid.)

- Jokoku- Juri Appeal (Supreme Court) against the Tokyo High Court Decision (3) was turned down on Oct. 7, 2004.

(The Supreme Court did not overruled the IP High Court Decision, which meant that the patent was maintained as valid.)

COMMENT:

A reason for invalidation of the patent could not found both in the infringement court and in the invalidation trials.

**No. 21 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 2561429**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :

Sept. 30, 2004 Tokyo High Court Case No. Heisei 16 (ne)1436 (of 2004)

“The original decision shall be changed partly.”

“An apparent reason for invalidation of the patent is not found”

(The patent holder’s claim was admitted.)

- Original Court Decision :

Feb. 20, 2004, Tokyo District Court, Case No. Heisei 14 (wa)12867 (of 2002)

“The patent holder’s claim for seeking damages shall be admitted.”

“An apparent reason for invalidation is not found”

(The patent holder’s claim was admitted.)

COMMENT:

A reason for invalidation of the patent could not found both in the infringement court and in the invalidation trials.

The patent of the case No. 21 is the same as the case No. 20.

**No. 22 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2583808**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :

July 21, 2004, IP High Court ; Case No. Heisei 15 (ne)2130 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

○ Original Court Decision :

March 14, 2003, Tokyo District Court, Case No. Heisei 14(wa)11630 (of 2002)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision Oct. 8, 2003 Invalidation Trial No. 2002-35404 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para 2)

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : July 21, 2004 Heisei 15 (gyo ke)486 (of 2003)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

◇ The demand for invalidation trial was withdrawn on August 2, 2004.

COMMENT:

The demand for invalidation trial was withdrawn before the IP High Court Decision (which affirmed the trial decision to invalidate the patent) was made final and conclusive so that the patent was maintained to be valid.

It is presumed in such a case that the withdrawal of the demand for invalidation trial before the JPO was consented between the patent holder and the alleged infringer to keep the validity of the patent.

**No. 23 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2840061**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

May 31, 2004, Tokyo High Court, Case No. Heisei 15 (ne)1118 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

○ Original Court Decision :

January 30, 2003, Tokyo District Court, Case No. Heisei 13(wa)26513 (of 2001)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision March 25, 2003 Invalidation Trial No. 2002-35331 (JPO)

“The patent shall be invalidated.”

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : May 31, 2004 Heisei 15 (gyo ke)175 (of 2003)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

(Correction Trial)

◇ JPO Trial Decision Sept. 25, 2003 Correction Trial No. 2003-39109 (JPO)

“The correction of the patent shall not be allowed.”

□ Judicial Court Appeal against the JPO Trial Decision

IP High Court Decision : May 31, 2004 Heisei 15 (gyo ke)489 (of 2003)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the correction of the patent shall not be allowed.)

COMMENT:

The validity of the patent were denied in the infringement court, in the administrative court for cancellation of the invalidation trial decision and in the administrative court for cancellation of the correction trial decision.

**No. 24 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 1912343**

Patent Infringement Law Suit : (arranged in reverse sequence)



◎ Appellate Court Decision :

May 28, 2004 Osaka High Court Case No. Heisei 14 (ne)3649 (of 2002)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

(The patent holder’s claim was admitted.)

○ Original Court Decision :

Oct. 29, 2002, Osaka District Court, Case No. Heisei 11 (wa)12586 (of 1999)

“The patent holder’s claim for seeking injunction and damages shall be admitted.”

“An apparent reason for invalidation is not found”

(The patent holder’s claim was admitted.)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision (1-1) Feb. 9, 2004 Invalidation Trial No. 2000-35294 (JPO)

“The demand for invalidation of the patent shall not be accepted.”

□ Judicial Court Appeal against the JPO Trial Decision (1-1)

IP High Court Decision : June 30, 2005 Heisei 17 (gyo ke)10060 (of 2005)

“The trial decision shall be cancelled.”

(This meant that the patent shall be invalidated. The Court found the publicly worked invention before the application of the patent and found that the lack of novelty should be found against the patent which caused the reason for invalidation of the patent.)

■ Jokoku- Juri Appeal (Supreme Court) against the Tokyo High Court Decision (3) was turned down on Nov. 22, 2005.

(The JPO trial decision (1-1) was cancelled by the judicial examination finally and conclusively, and the JPO trial board should re-examine the case.)

◇ JPO Trial Decision (1-2) January 18, 2006 No. 2002-35294 (re-examination)

“The patent shall be invalidated because of lack of novelty.”

(Patent Act Art. 29 Para 1 Item 1)

(The repeated trial decision must be restrained by the court decision.)

□ Judicial Court Appeal against the JPO Trial Decision (1-2)

IP High Court Decision : Oct. 25, 2006 Heisei 18 (gyo ke)10059 (of 2006)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

COMMENT:

In the infringement law suit, the Osaka District Court as the first instance court examined all of the Conditions for applying the Doctrine of Equivalents (The D.O.E was affirmed by the Judgment of the Supreme Court of Japan the third bench in the “Ball Spline Case” on February 24, 1998. See “Patent Infringement Litigation Case Study (2) –Patent Infringement Under the Doctrine of Equivalents in Japan –) and found that the alleged product and the alleged process met all five Conditions for D.O.E. and found infringement under the D.O.E..

The Osaka High Court as the appellate court affirmed the decision of the first instance court. So the patent holder won in the infringement law suit at the time.

However, the patent was found to be invalidated in the administrative law suit against the JPO trial decision before the IP High Court.

#### **No. 25 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 1912343**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

May 28, 2004 Osaka High Court Case No. Heisei 14 (ne)1693 (of 2002)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

(The patent holder’s claim was admitted.)

“An apparent reason for invalidation because of lack of novelty is not found.”

○ Original Court Decision :

April 16, 2002, Osaka District Court, Case No. Heisei 12 (wa)6322 (of 2000)

“The patent holder’s claim for seeking injunction and damages shall be admitted.”

(The patent holder’s claim was admitted.)

(The alleged party did not appeal an apparent reason for invalidation.)

COMMENT:

A reason for invalidation of the patent could not found.

The patent of the case No. 25 is the same as the case No. 24.

#### **No. 26 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 1539074**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

May 31, 2004, Tokyo High Court, Case No. Heisei 15 (ne)2376 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

○ Original Court Decision :

March 27, 2003, Tokyo District Court, Case No. Heisei 13(wa)23830 (of 2001)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

COMMENT:

The patent has been expired.

#### **No. 27 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2956956**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

March 17, 2004, Osaka High Court, Case No. Heisei 15 (ne)3488 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

○ Original Court Decision :

Oct. 9, 2003, Osaka District Court, Case No. Heisei 14(wa)7456 (of 2002)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision July 1, 2003 Invalidation Trial No. 2002-35531 (JPO)

“The patent shall be invalidated.” (Patent Act Art. 29, Para. 2)

- Judicial Court Appeal against the JPO Trial Decision  
Tokyo High Court Decision : Feb. 27, 2004 Heisei 15 (gyo ke)339 (of 2003)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent shall be invalidated.)
- Jokoku Appeal (Supreme Court) was dismissed on Sept. 16, 2004.
- Jokoku- Juri Appeal (Supreme Court) was turned down on Sept. 16, 2004.  
(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the patent was made invalid finally and conclusively.)

COMMENT:

The invalidity of the patent has been confirmed both in the patent infringement court and in the administrative court against the JPO trial decision.

**No. 28 Case of Seeking Injunction against Patent Infringement**

**Patent Number : JP 2621842**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :  
Feb. 27, 2004 Tokyo High Court Case No. Heisei 15 (ne)1223 (of 2003)  
“The original decision shall be reversed.”  
“The demand of the patent holder for banning selling the alleged product shall be admitted.”  
“An apparent reason for invalidation of the patent is not found”  
(The patent holder’s claim was admitted. The high court concluded that the patent holder can demand for injunction even though an exclusive license is registered. )
- Original Court Decision :  
Feb. 6, 2003, Tokyo District Court, Case No. Heisei 13 (wa)21278 (of 2001)  
“The claim of the patent holder shall be dismissed.”  
(The patent holder’s claim for seeking injunction was not admitted because the plaintiff was not the right holder of exclusive license but the patent holder.”

Invalidation Procedure against the Patent :

(Invalidation Trial)

- ◇ JPO Trial Decision January 8, 2004 Invalidation Trial No. 2003-35245 (JPO)  
“The demand for invalidation of the patent shall not be accepted.”  
(Patent Act Art. 29, Para. 1, Item 3, Para. 2)

COMMENT:

The main issue of the infringement law suit was not the validity of the patent.

The validity of the patent was maintained both in the infringement court and in the invalidation trial.

The case is the precedent in which even though an exclusive license is registered, the patent holder can demand for injunction against the infringer.

**No. 29 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2056106**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Feb. 27, 2004, Tokyo High Court, Case No. Heisei 15 (ne) 2732 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

○ Original Court Decision :

April 17, 2003, Tokyo District Court, Case No. Heisei 14(wa)14010 (of 2002)

“The claim of the patent holder shall be dismissed.”

“The alleged product does not infringe the patent.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision (1-1) June 4, 2003 Invalidation Trial No. 2002-35198 (JPO)

“The demand for invalidation of the patent shall not be accepted.”

(Patent Act Art. 29, Para. 2, Art. 36)

□ Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : Feb. 27, 2004 Heisei 15 (gyo ke)278 (of 2003)

“The trial decision shall be cancelled.”

(This meant that the patent shall be invalidated.)

■ Jokoku Appeal (Supreme Court) was dismissed on Sept. 10, 2004.

- Jokoku- Juri Appeal (Supreme Court) was turned down on Sept. 10, 2004.  
(The Supreme Court affirmed the Tokyo High Court Decision which cancelled the trial decision. Therefore the trial board of the JPO must examine the case again.)
- ◇ JPO Trial Decision (1-2) Nov. 26, 2004 (No. 2002-35198 )  
“The patent shall be invalidated.”  
(Patent Act Art. 29, Para. 2)  
(The trial decision has been made final and conclusive.)
- ◇ JPO Trial Decision (2-1) June 4, 2003 Invalidation Trial No. 2002-35238 (JPO)  
“The demand for invalidation of the patent shall not be accepted.”  
(Patent Act Art. 29, Para. 2, Art. 36)
- Judicial Court Appeal against the JPO Trial Decision  
Tokyo High Court Decision : Feb. 27, 2004 Heisei 15 (gyo ke)294 (of 2003)  
“The trial decision shall be cancelled.”  
(This meant that the patent shall be invalidated.)
- Jokoku Appeal (Supreme Court) was dismissed on Sept. 10, 2004.
- Jokoku- Juri Appeal (Supreme Court) was turned down on Sept. 10, 2004.  
(The Supreme Court affirmed the Tokyo High Court Decision which cancelled the trial decision. Therefore the trial board of the JPO must examine the case again.)
- ◇ JPO Trial Decision (2-2) Nov. 26, 2004 (No. 2002-35238 )  
“The patent shall be invalidated.”  
(Patent Act Art. 29, Para. 2)  
(The trial decision has been made final and conclusive.)

COMMENT:

The same court (Tokyo High Court) found that the patent shall be invalidated because of lack of inventive step both in the appealed case of patent infringement law suit and in the case of the administrative law suit of seeking cancellation of the JPO trial decision at the same day.

**No. 30 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 2127180**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Feb. 26, 2004, Tokyo High Court ; Case No. Heisei 15 (ne) 5689 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of novelty is found.”

(Court precedent ; Patent Act Art. 29, Para. 1, Item 1 and 3)

○ Original Court Decision :

Oct. 23, 2003, Tokyo District Court ; Case No. Heisei 15(wa)3010, & 11198 (of 2003)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of novelty is found.”

(Court precedent ; Patent Act Art. 29, Para. 1, Item 1 and 3)

Invalidation Procedure against the Patent :

(Invalidation Trial)

◇JPO Invalidation Trial No. 2000-35157 (JPO)

COMMENT:

The demand for invalidation of the patent was withdrawn.

**No. 31 Case of Seeking Declarative Decision of Confirming No Infringement against the Patent**

**Patent Number : JP 2503045**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

January 22, 2004, Tokyo High Court ; Case No. Heisei 15 (ne) 3366 (of 2003 )

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“The right to demand injunction can not be found.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation by lack of novelty is found.”

(Court precedent ; Patent Act Art. 29, Para. 1, Item 1)

○ Original Court Decision :

May 28, 2003, Tokyo District Court ; Case No. Heisei 13(wa)24667 (of 2001)

“The right to demand injunction can not be found.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for

invalidation by lack of novelty is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

JPO Trial Decision Feb. 13, 2003 Invalidation Trial No. 2002-35163 (JPO)

“The patent shall be invalidated because of lack of novelty.”

(Patent Act Art. 29, Para. 1 Item 1)

Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : January 22, 2004 Heisei 15 (gyo ke)96 (of 2003)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

■ Jokoku- Juri Appeal (Supreme Court) was turned down on June 6, 2004.

(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the patent was made invalid finally and conclusively.)

COMMENT:

The same court (Tokyo High Court) found that the patent shall be invalidated because of lack of novelty both in the appealed case of patent infringement law suit and in the case seeking for cancellation of the JPO trial decision .

### **No. 32 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 1491321**

Patent Infringement Law Suit : (arranged in reverse sequence)

Appellate Court Decision :

March 27, 2003, Osaka High Court, Case No. Heisei 14 (ne) 2331 (of 2002)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation under the Patent Act Art. 29-2 is found.”

(Court precedent ; Patent Act Art. 29-2)

Original Court Decision :

July 4, 2002, Osaka District Court ; Case No. Heisei 13(wa)8906 (of 2001)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation under the Patent Act Art. 29-2 is found.”



(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision April 10, 2002 Invalidation Trial No. 2001-35506 (JPO)

“The patent shall be invalidated under the Patent Act Art. 29-2.”

(Patent Act Art. 29-2)

□ Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : Nov. 21, 2002 Heisei 14 (gyo ke)227 (of 2002)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

■ Jokoku Appeal (Supreme Court) was dismissed on March 25, 2003.

(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the patent was made invalid finally and conclusively.)

COMMENT:

It was found both in the patent infringement civil law suit and in the administrative law suit against the JPO trial decision that the patent should be invalidated under the Patent Act Art. 29-2 because the patented invention was described in the published description of the former filed patent application.

### **No. 33 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 1491321**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

March 27, 2003, Osaka High Court, Case No. Heisei 14 (ne) 2330 (of 2002)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation under the Patent Act Art. 29-2 is found.”

(Court precedent ; Patent Act Art. 29-2)

○ Original Court Decision :

July 4, 2002, Osaka District Court ; Case No. Heisei 13(wa)8214 (of 2001)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation under the Patent Act Art. 29-2 is found.”

(Court precedent ; Patent Act Art. 29, Para. 2)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision(1) April 10, 2002 Invalidation Trial No. 2001-35506 (JPO)

“The patent shall be invalidated under the Patent Act Art. 29-2.”

(Patent Act Art. 29-2)

□ Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : Nov. 21, 2002 Heisei 14 (gyo ke)227 (of 2002)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

■ Jokoku Appeal (Supreme Court) was dismissed on March 25, 2003.

(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the patent was made invalid finally and conclusively.)

◇ JPO Trial Decision(2) May 13, 2002 Invalidation Trial No. 2002-35011 (JPO)

“The patent shall be invalidated under the Patent Act Art. 29-2.”

(Patent Act Art. 29-2)

□ Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : Nov. 21, 2002 Heisei 14 (gyo ke)227 (of 2002)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

■ Jokoku Appeal (Supreme Court) was dismissed on March 25, 2003.

(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the patent was made invalid finally and conclusively.)

COMMENT:

The patent of this case is the same as that of the Case No.32.

It was found both in the patent infringement civil law suit and in the administrative law suit against the JPO trial decision that the patent should be invalidated under the Patent Act Art. 29-2 because the patented invention was described in the published description of the former filed patent application.

**No. 34 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 2613766 (Patent No.1)**

**Patent Number : JP 2627886 (Patent No.2)**

**Patent Number : JP 2799499 (Patent No.3)**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Feb. 27, 2003, Tokyo High Court ; Case No. Heisei 12 (ne) 4200 (of 2000)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“For the Patent No.1, exercising of the patent right is to be abuse of right, because an apparent reason for lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29-2)

“For the Patent No.2, no infringement is found.”

“For the Patent No.3, the invalidation of the patent has been affirmed finally and conclusively.”

○ Original Court Decision :

July 4, 2002, Tokyo District Court ; Case No. Heisei 11(wa)1346 (of 1999)

“The claim of the patent holder shall be dismissed.”

“For the Patent No.1, no infringement is found.”

“For the Patent No.2, no infringement is found.”

“For the Patent No.3, no infringement is found.”

Invalidation Procedure against the Patent No. 3 :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision August 24, 2000 Invalidation Trial No. Hei.11-35581 (1999)

“The Patent No. 3 shall be invalidated because of lack of inventive step.”

(Patent Act Art. 29(2))

□ Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : June 13, 2002 Heisei 12 (gyo ke)393 (of 2000)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

■ Jokoku- Juri Appeal (Supreme Court) was turned down on Oct. 24, 2002.

(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the Patent No. 3 was made invalid finally and conclusively.)

Invalidation Procedure against the Patent No. 1 :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision August 24, 2000 Invalidation Trial No. Hei.11-35415 (1999)

“The Patent No. 1 shall be invalidated because of lack of inventive step.”

(Patent Act Art. 29(2))

- Judicial Court Appeal against the JPO Trial Decision  
Tokyo High Court Decision : Sept. 12, 2002 Heisei 12 (gyo ke)392 (of 2000)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent shall be invalidated.)
- Jokoku- Juri Appeal (Supreme Court) was turned down on January 30, 2003.  
(The Supreme Court did not overruled the Tokyo High Court Decision, which meant that the Patent No. 1 was made invalid finally and conclusively.)

Invalidation Procedure against the Patent No. 2 :

(Invalidation Trial)

- ◇ JPO Trial Decision January 11, 2001 Invalidation Trial No. Hei.11-35512 (1999)  
“The demand for invalidation of the Patent No. 2 shall not be accepted.”  
(This meant that the Patent No. 2 was maintained to be valid.)

COMMENT :

The Patent No. 1 and the Patent No. 3 have been invalidated finally and conclusively.  
The Patent No. 2 has been maintained to be valid, however no infringement was found in each infringement case.

### **No. 35 Case of Seeking Damages against Patent Infringement**

**Patent Number : JP 2567807 (Patent No.1)**

**Patent Number : JP 2838511 (Patent No.2)**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :  
Feb. 27, 2003, Osaka High Court ; Case No. Heisei 14 (ne) 2776 (of 2002)  
“The appeal shall be dismissed.” (The original court decision is affirmed.)  
“For the Patent No.1 and No.2, exercising of the patent right is to be abuse of right, because an apparent reason for invalidation is found.”  
(Court precedent )
- Original Court Decision :  
August 27, 2002, Osaka District Court ; Case No. Heisei 13(wa)831, & 6097 (of 2001)  
“The claim of the patent holder shall be dismissed.”  
“Exercising of the patent rights (No. 1 and No. 2) are to be abuse of right, because apparent reasons for invalidation of lack of novelty, lack of inventive step ,and lack

of requirement for divisional application under the Patent Act are found.”  
(Court precedent ; Patent Act Art. 29(1)(iii), 29(2), 44)

#### Invalidation Procedure against the Patent No. 1:

(Invalidation Trial and Judicial Action against Trial Decision)

- ◇ JPO Trial Decision (1) Sept. 14, 2001 Invalidation Trial No. 2000-35598 (JPO)  
“The demand for invalidation of the patent shall not be accepted.”  
(Patent Act Art. 29, Para. 2)
- Judicial Court Appeal against the JPO Trial Decision (1)  
Tokyo High Court Decision : Heisei 13 (gyo ke)452 (of 2001)  
“The law suit shall be dismissed.”  
(This meant that the patent was to be maintained to be valid.)
- ◇ JPO Trial Decision (2) Feb. 3, 2003 Invalidation Trial No. 2002-35244 (JPO)  
“The Patent No. 1 shall be invalidated because of lack of novelty.”  
(Patent Act Art. 29(1)(iii))
- Judicial Court Appeal against the JPO Trial Decision  
Tokyo High Court Decision : Sept. 3, 2003 Heisei 15 (gyo ke) 65 (of 2003)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent shall be invalidated.)
- Jokoku Appeal (Supreme Court) was dismissed on Feb. 26, 2004.
- Jokoku- Juri Appeal (Supreme Court) was turned down on Feb. 26, 2004.  
(The Supreme Court did not overruled the Tokyo High Court Decision to affirm the JPO trial decision. Therefore the Patent No. 1 was invalidated finally and conclusively .)

#### Invalidation Procedure against the Patent No. 2:

(Invalidation Trial and Judicial Action against Trial Decision)

- ◇ JPO Trial Decision (1) Sept. 14, 2001 Invalidation Trial No. 2000-35604 (JPO)  
“The demand for invalidation of the patent shall not be accepted.”  
(Patent Act Art. 29, Para. 2)
- Judicial Court Appeal against the JPO Trial Decision (1)  
Tokyo High Court Decision : Heisei 13 (gyo ke)456 (of 2001)  
“The law suit shall be dismissed.”  
(This meant that the patent was to be maintained to be valid.)
- ◇ JPO Trial Decision (2) Feb. 3, 2003 Invalidation Trial No. 2002-35245 (JPO)

“The Patent No. 2 shall be invalidated because of lack of novelty.”

(Patent Act Art. 29(1)(iii))

- Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : Sept. 3, 2003 Heisei 15 (gyo ke) 66 (of 2003)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

- Jokoku Appeal (Supreme Court) was dismissed on Feb. 26, 2004.

- Jokoku- Juri Appeal (Supreme Court) was turned down on Feb. 26, 2004.

(The Supreme Court did not overruled the Tokyo High Court Decision to affirm the JPO trial decision. Therefore the Patent No. 2 was invalidated finally and conclusively .)

#### COMMENT:

The infringement court denied the validity of the patents.

The patents were invalidated after several times of invalidation trials.

### **No. 36 Case of Seeking Injunction against Patent Infringement**

**Patent Number : JP 2769925**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :

Nov. 22, 2002 Osaka High Court ; Case No. Heisei 13 (ne) 3840 (of 2001)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

(The appellate court also admit the patent holder’s claim.)

“Apparent reason for invalidation of the patent is not found”

- Original Court Decision :

Oct. 30, 2001, Osaka District Court ; Case No. Heisei 12 (wa)7221 (of 2000)

“The alleged product shall not be imported and sold.”

(The first instance court admit the patent holder’s claim)

“Apparent reason for invalidation of the patent is not found”

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

- ◇ JPO Trial Decision June 8, 2002 Invalidation Trial No. 2000-35453 (JPO)

“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )

(The decision meant that the patent was to be maintained as valid.)

- Judicial Court Appeal against the JPO Trial Decision  
Tokyo High Court Decision : Heisei 14 (gyo ke)329 (of 2002)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent shall be maintained to be valid .)

COMMENT :

The assertion of invalid of the patent was denied both in the infringement court and in the administrative court to cancel the JPO trial decision.

**No. 37 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2619728**

Patent Infringement Law Suit : (arranged in reverse sequence)

- ◎ Appellate Court Decision :  
Oct. 31, 2002 Tokyo High Court ; Case No. Heisei 13 (ne) 4146 (of 2001)  
“The appeal shall be dismissed.” (The original court decision is affirmed.)  
(The appellate court also admit the patent holder’s claim.)  
“Apparent reason for invalidation of the patent is not found”  
(Patent Act Art. 29-2, 29(1), 29(2) )
- Original Court Decision :  
July 17, 2001, Tokyo District Court ; Case No. Heisei 11 (wa)23013 (of 1999)  
“The alleged product shall not be made, used and sold.”  
(The first instance court admit the patent holder’s claim)  
“Apparent reason for invalidation of the patent is not found”

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

- ◇ JPO Trial Decision(1) April 6, 2000 Invalidation Trial No. Hei11-35263 (of 1999)  
“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )  
(The decision meant that the patent was to be maintained as valid.)
- Judicial Court Appeal against the JPO Trial Decision (1)  
Tokyo High Court Decision : Heisei 12 (gyo ke)149 (of 2000)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent shall be maintained to be valid.)
- Jokoku Appeal (Supreme Court) was dismissed on July 13, 2001.
- Jokoku- Juri Appeal (Supreme Court) was turned down on July 13, 2001.

(The Supreme Court did not overruled the Tokyo High Court Decision to affirm the JPO trial decision. Therefore the Patent was maintained to be valid.)

- ◇ JPO Trial Decision(2) July 3, 2000 Invalidation Trial No. Hei11-35526 (of 1999)  
“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )  
(The decision meant that the patent was to be maintained as valid.)

- Judicial Court Appeal against the JPO Trial Decision (2)  
Tokyo High Court Decision : Feb. 22, 2001 Heisei 12 (gyo ke)280 (of 2000)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent was to be maintained as valid.)

■ Jokoku Appeal (Supreme Court) was dismissed on July 13, 2001.

- Jokoku- Juri Appeal (Supreme Court) was turned down on July 13, 2001.  
(The Supreme Court did not overruled the Tokyo High Court Decision to affirm the JPO trial decision. Therefore the Patent was maintained to be valid.)

- ◇ JPO Trial Decision(3) March 14, 2001 Invalidation Trial No. 2000-35092  
“The demand for invalidation of the patent is not allowed” (P.A. 29(2) )  
(The decision meant that the patent was to be maintained as valid.)

- Judicial Court Appeal against the JPO Trial Decision (3)  
Tokyo High Court Decision : June 28, 2004 Heisei 13 (gyo ke)147 (of 2001)  
“The claim for cancellation of the trial decision shall be dismissed.”  
(This meant that the patent was to be maintained as valid.)

■ Jokoku Appeal (Supreme Court) was dismissed on Nov. 11, 2004.

- Jokoku- Juri Appeal (Supreme Court) was turned down on Nov. 11, 2004.  
(The Supreme Court did not overruled the Tokyo High Court Decision and the JPO trial decision was affirmed. Therefore the Patent was maintained to be valid.)

- ◇ JPO Trial Decision(4) Feb. 7, 2004 Invalidation Trial No. 2002-35464  
“The demand for invalidation of the patent is not allowed” (P.A. 29(2), 29-2 )  
(The decision meant that the patent was to be maintained as valid.)

- Judicial Court Appeal against the JPO Trial Decision (4)  
Tokyo High Court Decision : Feb. 17, 2005 Heisei 16 (gyo ke)83 (of 2004)  
“The trial decision (4) shall be cancelled.”  
(This meant that the court denied the trial decision in which a reason for invalidation of the patent could not be found.)

■ Jokoku- Juri Appeal (Supreme Court) was turned down on April 18, 2006.



(The Supreme Court did not overrule the Tokyo High Court Decision, so the JPO trial decision was cancelled finally and conclusively. Therefore the JPO Trial Board shall examine this invalidation trial again.)

- ◇ JPO Invalidation Trial (4) No. 2002-35464  
(now pending)

COMMENT:

The patent was maintained to be valid through several times of invalidation trials and infringement law suits, however, at last the trial decision in which the demand for invalidation of the patent is not accepted was cancelled by the IP High Court.

The IP High Court decision suggested a reason for invalidation against the patent.

**No. 38 Case of Seeking Injunction and Damages against Patent Infringement**

**Patent Number : JP 2128996**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Feb. 28, 2002, Tokyo High Court, Case No. Heisei 13 (ne) 943 (of 2001)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation under the Patent Act Art. 123(1)(vi) is found.”

(Court precedent ; Patent Act Art. 123(1)(vi))

(The second instance court also found that the patent holder was not the inventor of this invention nor the legal successor of this invention.)

(The second instance court did not express the assessment of the issue concerning the prior user’s right.)

○ Original Court Decision :

January 30, 2001, Tokyo District Court ; Case No. Heisei 11(wa)9226 (of 1999)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation under the Patent Act Art. 123(1)(vi) is found.”

(Court precedent ; Patent Act Art. 123(1)(vi))

(The first instance court found that there was an apparent reason for invalidation of the patent because the patent holder was not the inventor of this invention nor the legal successor of this invention. And also the first instance court found that the alleged infringer did not infringe the patent because the alleged infringer had the

prior user's right .)

COMMENT:

The patent right has been expired. No invalidation trial was found.

**No. 39** Case of Seeking Injunction and Damages against Patent Infringement

Patent Number : JP 2871458

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

Feb. 27, 2002 Tokyo High Court ; Case No. Heisei 13 (ne) 3684 (of 2001)

“The appeal shall be dismissed.”

(The original court decision is affirmed as the result by another reason.)

(The appellate court did not admit the patent holder's claim because the court did not find infringement. The appellate court did not find the apparent reason for invalidation of the patent. ) (Patent Act Art. 29(2) )

○ Original Court Decision :

June 19, 2001, Tokyo District Court ; Case No. Heisei 12 (wa)13799 (of 2000)

“The claim of the patent holder shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for invalidation because of lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29(2))

COMMENT:

The appellate court (Tokyo High Court) denied a reason for invalidation against the patent, The Court dismissed the demand of the patent holder because of no infringement.

No invalidation trial was found.

**No. 40** Case of Seeking Injunction and Damages against Patent Infringement

Patent Number : JP 1730090

◎ Appellate Court Decision :

Oct. 25, 2001 Tokyo High Court ; Case No. Heisei 12 (ne) 3411 (of 2000)

“The appeal shall be dismissed.”

“Exercising of the patent right is to be abuse of right, because an apparent reason for

invalidation because of lack of inventive step is found.”

(Court precedent ; Patent Act Art. 29(2))

○ Original Court Decision :

May 30, 2000, Tokyo District Court ; Case No. Heisei 10 (wa)17311 (of 1998)

“The claim of the patent holder shall be dismissed.”

“No infringement against the patent is found.”

(The first instance court did not express assessment of reason for invalidation of the patent.)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision Dec. 3, 2001 Invalidation Trial No. 2001-35163 (JPO)

“The patent shall be invalidated under the Patent Act Art. 126(3).”

(Patent Act Art. 126(3))

□ Judicial Court Appeal against the JPO Trial Decision

Tokyo High Court Decision : Feb. 20, 2003 Heisei 13 (gyo ke)589 (of 2001)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

COMMENT:

The finding of the reason for invalidation of the patent in the infringement court’s decision was before the trial decision for invalidation.

The appellate court affirmed the original court decision by using another reason as the conclusion ( “The claim for cancellation of the trial decision shall be dismissed.”) was not in error.

The appellate court did not admit the patent holder’s claim because the court found the apparent reason for invalidation of the patent.

#### **No. 41 Case of Seeking Injunction against Patent Infringement**

**Patent Number : JP 2615314**

Patent Infringement Law Suit : (arranged in reverse sequence)

◎ Appellate Court Decision :

July 12, 2001 Osaka High Court ; Case No. Heisei 12 (ne) 1016 (of 2000)

“The appeal shall be dismissed.” (The original court decision is affirmed.)

(The appellate court also admit the patent holder’s claim.)

(The court did not find an apparent reason for invalidation of the patent because of

lack of description requirement.) (Patent Act Art. 36 )

○ Original Court Decision :

Feb. 24, 2000, Osaka District Court ; Case No. Heisei 9 (wa)9063 (of 1999)

“The alleged products shall not be made and sold.”

(The first instance court admit the patent holder’s claim)

Invalidation Procedure against the Patent :

(Invalidation Trial and Judicial Action against Trial Decision)

◇ JPO Trial Decision(1) January 6, 1999 Invalidation Trial No. Hei.9-13660 (of 1997)

“The demand for invalidation of the patent is not accepted.” (P.A. 29(2) )

(The decision meant that the patent was to be maintained as valid.)

□ Judicial Court Appeal against the JPO Trial Decision (1)

Tokyo High Court Decision : April 10, 2001 Heisei 11 (gyo ke)21 (of 1999)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be maintained to be valid.)

■ Jokoku- Juri Appeal (Supreme Court) was turned down on Oct. 12, 2001.

(The Supreme Court did not overruled the Tokyo High Court Decision to affirm the JPO trial decision. Therefore the Patent was maintained to be valid.)

◇ JPO Trial Decision (2) April 2, 2002

Invalidation Trial No. 2000-35448 (JPO)

Invalidation Trial No. 2000-35501 (JPO)

(The two trial examinations were combined.)

“The patent shall be invalidated because of lack of inventive step.”

(Patent Act Art. 29(2))

□ Judicial Court Appeal against the JPO Trial Decision (2)

Tokyo High Court Decision : Sept. 4, 2003 Heisei 14 (gyo ke)184 (of 2002)

“The claim for cancellation of the trial decision shall be dismissed.”

(This meant that the patent shall be invalidated.)

■ Jokoku- Juri Appeal (Supreme Court) was turned down on Feb. 26, 2004.

(The Supreme Court did not overruled the Tokyo High Court Decision to affirm the JPO trial decision. Therefore the Patent was invalidated finally and conclusively.)

COMMENT:

The patent has been invalidated finally and conclusively after several invalidation trials.

Patent infringement law suits as follows concerning the same patent have been found.  
The patent holder lost each case.

January 31, 2002 Osaka District Court ; Case No. Heisei 12 (wa)7510 (of 2000)  
Dec. 12, 2002 Tokyo District Court ; Case No. Heisei 11 (wa)6665 (of 1999)  
Case No. Heisei 13 (wa)23635 (of 2001)  
Dec. 12, 2002 Tokyo District Court ; Case No. Heisei 9 (wa)24064 (of 1997)  
Case No. Heisei 11 (wa)19166 (of 1999)

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