

Oral Proceedings at the JPO and Infringement Proceedings

Toshio UCHIDA
Patent & Trademark Attorney

HARAKENZO
WORLD PATENT & TRADEMARK

口頭審理（特許庁） 及び 侵害訴訟

弁理士 内田俊生

特許業務法人 原謙三国際特許事務所

Oral Proceedings at the JPO

口頭審理(特許庁)

How to Proceed in Trial Examination Procedure

<Basic Proceedings>

◆ Oral Proceedings

- Trial for invalidation of a patent
- Trial for invalidation of the registration of extension of the duration of a patent

◆ Documentary Proceedings

- Trial against examiner's decision of refusal
- Trial for correction

審判における審理の方式

<原則>

◆ 口頭審理

- 無効審判
- 延長登録無効審判

◆ 書面審理

- 拒絶査定不服審判
- 訂正審判

Legal Basis of Oral Proceedings

Patent Act Art.145

(1) A trial for patent invalidation or a trial for invalidation of the registration of extension of the duration of a patent shall be conducted by oral proceedings; provided, however, that the chief trial examiner may, upon a motion by a party or intervenor in the case, or ex officio decide to conduct the trial by documentary proceedings.

(2) Trials, excluding those as provided in the preceding paragraph, shall be conducted by documentary proceedings; provided, however, that the chief trial examiner may, upon a motion by the party or ex officio, decide to conduct the trial by oral proceedings.

口頭審理の法的根拠

特許法145条

1 特許無効審判及び延長登録無効審判は、口頭審理による。ただし、審判長は、当事者若しくは参加人の申立てにより又は職権で、書面審理によるものとすることができる。

2 前項に規定する審判以外の審判は、書面審理による。ただし、審判長は、当事者の申立てにより又は職権で、口頭審理によるものとするすることができる。

Legal Basis of Oral Proceedings (cont.)

(3) Where a trial is conducted by oral proceedings under paragraph (1) or the proviso to the preceding paragraph, the chief trial examiner shall designate the date and place thereof and summon the parties and the intervenor on the designated date.

(4) Article 94 (Summon on the designated date) of the Code of Civil Procedure shall apply mutatis mutandis to a summon on the designated date as provided in the preceding paragraph.

(5) The oral proceedings under paragraph (1) or the proviso to paragraph (2) shall be conducted in public; provided, however, that this shall not apply where public order or morality is liable to be injured thereby.

口頭審理の法的根拠(続き)

3 審判長は、第一項又は前項ただし書の規定により口頭審理による審判をするときは、その期日及び場所を定め、当事者及び参加人に対し、期日の呼出しを行わなければならない。

4 民事訴訟法第94条(期日の呼出し)の規定は、前項の期日の呼出しに準用する。

5 第一項又は第二項ただし書の規定による口頭審理は、公開して行う。ただし、公の秩序又は善良の風俗を害するおそれがあるときは、この限りでない

Advantages of Each Proceeding

◆ Oral Proceedings

Since the board and the parties concerned orally communicate with each other, it is possible to, for example, accurately understand and define issues over which the parties have allegations opposed to each other. As such, even in a case where many issues are intertwined in a complicated manner or in a case where a party makes an unclear allegation, it is possible to accurately conduct a trial examination instead of repeated communications in writing.

◆ Documentary Proceedings

It is possible to (i) describe in detail allegations in writing and (ii) precisely describe even highly technical matters in writing.

各審理方式の利点

◆ 口頭審理

合議体と当事者が口頭でやり取りをすることで、双方の主張が対立する争点の的確な把握や整理等ができるので、多くの争点が複雑にからみあった事案や当事者の主張が不明瞭な事案でも、複数回の書面のやり取りをすることなく的確に審理できる。

◆ 書面審理

自己の主張を詳細に書面に記載することができ、高度に技術的な事項も正確に書面で表現できる。

Purpose of Oral Proceedings

- ◆ Clarify issues, accurately understand issues
- ◆ Understand the state of the art in the technical field concerned
- ◆ Point out inappropriateness in allegation, instruct for a further allegation/verification (ex officio direction)

口頭審理の目的

- ◆ 争点整理, 争点の的確な把握
- ◆ 当該技術分野における技術水準の理解
- ◆ 主張における不備の指摘, 更なる主張・立証の指示(職権による指揮)

Features of Oral Proceedings at Trial Examination

Oral proceedings at a trial examination are different from oral proceedings in a litigation.

- ◆ Any trial examination is based on the principle of proceeding by ex officio. A trial examiner actively requests, if necessary for the trial examination, clarification even of a matter which is not disputed by any party.
- ◆ Allegations in writing are also legal. It is therefore unnecessary, in oral proceedings, to repeatedly make the same allegation that has already been filed in writing.
- ◆ Any trial examination is based on the ex officio principle. No recognition is made of binding force of confession or of the system of "fictitious" (constructive) confession.

審判における口頭審理の特徴

審判における口頭審理は、訴訟における口頭審理(口頭弁論手続)とは異なる。

- ◆ 審判は職権主義をとるので、当事者が争わない事項であっても、審理に必要な場合には、審判官が積極的に当事者に釈明を求める。
- ◆ 書面による主張も法的に有効なので、書面で提出した主張を口頭審理の場で改めて主張する必要はない。
- ◆ 審判は職権主義をとるので、自白の拘束力は認められず、擬制自白の制度もない。

Cases in Which Oral Proceedings Are Highly Necessary

- ◆ Case in which infringement litigation is pending
- ◆ Case in which many allegations are made or case in which grounds for allegations are unclearly
- ◆ Case in which many pieces of evidence are submitted, and which is thus complicated and not sufficiently clarified
- ◆ Case in which technical understanding is difficult and it is therefore better to be provided with an explanation of, for example, the patented invention and/or evidence
- ◆ Case in which both parties allege on different planes
- ◆ Case which involves examination of evidence (examination of a witness, verification)

口頭審理を行う必要性の高い事件

- ◆ 侵害訴訟が継続している事件
- ◆ 主張が多い事件, 主張についての根拠が不明確な事件
- ◆ 証拠が多数提出されており, 複雑で整理が十分になされていない事件
- ◆ 特許発明, 証拠などの説明を受けた方がよい, 技術的理解が困難な事件
- ◆ 当事者双方の主張がかみ合っていない事件
- ◆ 証拠調べ(証人尋問, 検証)を伴う事件

Preparation of Oral Proceedings

◆ JPO

- Fix the date and place for the oral proceedings
- Notify in advance of the matter(s) to be examined on the date of oral proceedings (**Notice of matters to be examined**)

◆ Parties

- Consider the matter(s) to be alleged on the date of oral proceedings
- Submit the matter(s) to be alleged on the date of oral proceedings (**Oral proceedings statement brief**)

口頭審理の準備

◆ 特許庁

- 期日・場所の指定
- 口頭審理期日に審理を予定する事項の通知(**審理事項通知書**)

◆ 当事者

- 口頭審理期日に主張すべき事項の検討
- 同事項を記載した書面の提出(**口頭審理陳述要領書**)

Notice of Matters to Be Examined

- ◆ Purpose
 - Board, in order to smoothly conduct a productive trial examination, notifies each party in advance of the matter(s) to be examined on the date of oral proceedings. The Board thus prompts each party to make preparations such as preparation of an oral proceedings statement brief on the basis of the matter(s) to be examined.
- ◆ Matters to be described
 - Describe the preliminary opinion of the Board and ask an opinion to the preliminary opinion
 - Specifically point out the matter(s) that the party regards as an issue(s) and the matter(s) that the Board regards as point(s) at issue, and prompt the party to make a full allegation/proof for the above matter(s)
 - Point out unclear point(s) in a written submission by the party and ask clarification
 - Ask technical explanation related to the patented invention at issue, its background etc.

審理事項通知書

- ◆ 目的
 - 充実した審理を円滑に実施するために、合議体が、口頭審理期日に審理を予定する事項をあらかじめ当事者に通知し、それを踏まえた口頭審理陳述要領書の作成等の準備を促す。
- ◆ 記載事項
 - 合議体の暫定的な見解を記載し、意見を求める。
 - 当事者が争点としている事項及び合議体が論点と考える事項を具体的に指摘し、それらに対する当事者の主張・立証が尽くされるようにする。
 - 当事者が提出した書面における明瞭でない点を指摘し、釈明を求める。
 - 本件特許発明及びその背景等の技術説明を促す。

Oral Proceedings Statement Brief

◆ Purpose

To efficiently carry out oral proceedings by (i) ensuring allegations of each party and hearing thereof without fail on the date of oral proceedings and (ii) allowing for a refined logical construction in the allegations

◆ Matters to Be Described (for a case of the demandant)

- Supplement of grounds for the request
- Counterarguments against the requester's allegations
- Grounds or evidence for withdrawal
- Summary of all the allegations
- Clarification requested in the notice of matters to be examined at trial examination

口頭審理陳述要領書

◆ 目的

口頭審理期日に当事者の陳述とその聴取を脱落なく確実に
行い、さらに、陳述における精緻な理論構成を可能とし、口頭審
理を効率よく行う。

◆ 記載項目(請求人の場合)

- 請求の理由の補足
- 被請求人の主張に対する反論
- 撤回する理由、証拠
- これまでの全主張の要約
- 審理事項通知書で求められている釈明

How Oral Proceedings Proceeds

- ◆ Basically open to the public to secure fairness of the trial examination (closed to the public if public order and morality may be damaged)
- ◆ Trial Examination
 - Statements by both parties (for example, statements of the purpose and reason for a request or statement of the purpose and reason for a reply, an allegation of a point to be emphasized, clarification of an issue, and/or an explanation of the technique and its background technique)
 - Interrogation as to question and/or unclear point in allegations of the parties
 - Examination of evidence (examination of a witness, verification)
 - ➔ Clarify issues between the parties and advise to withdraw unnecessary allegations
 - Notification of reasons for invalidation, reasons for refusal to correction request, announcement of, for example, conclusion of trial examination
- ◆ Preparation of trial record (describing, for example, a summary of the trial examination)

口頭審理の進行

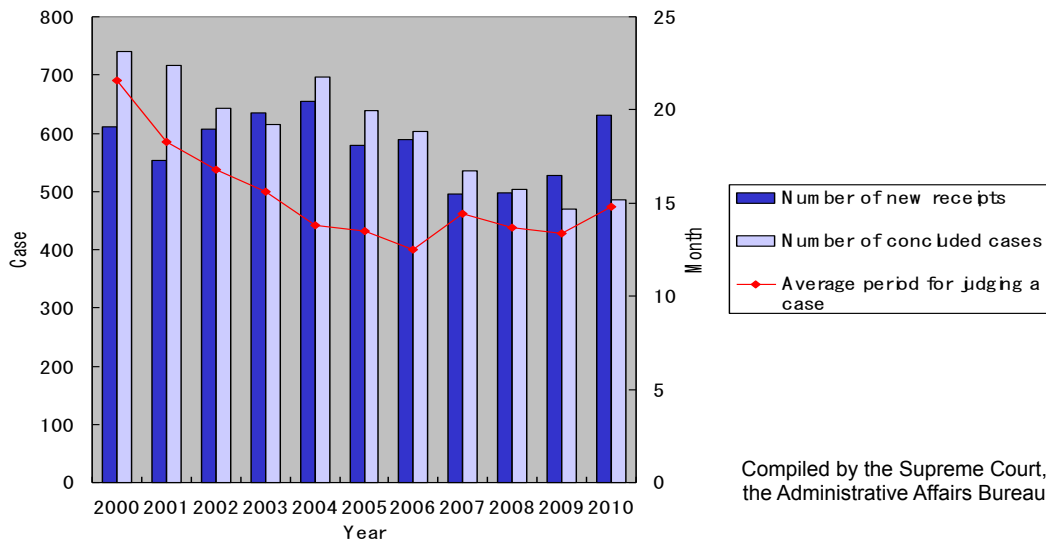
- ◆ 審判の公平性を担保するため、原則公開(公序良俗を害するおそれがあるときは非公開)
- ◆ 審理
 - 両当事者による陳述(請求の趣旨及び理由、又は、答弁の趣旨及び理由についての陳述, 強調したい点の主張, 争点についての釈明, 本件技術・背景技術の説明など)
 - 当事者の主張の疑問点・不明瞭な点についての審尋
 - 証拠調べ(証人尋問, 検証)
 - ➔ 両当事者の争点の整理, 必要でない主張の取下げ勧告
 - 無効理由通知, 訂正拒絶理由通知, 審理終結等の告知
- ◆ 調書の作成(審理の要旨等を記載)

Infringement Proceedings

侵害訴訟

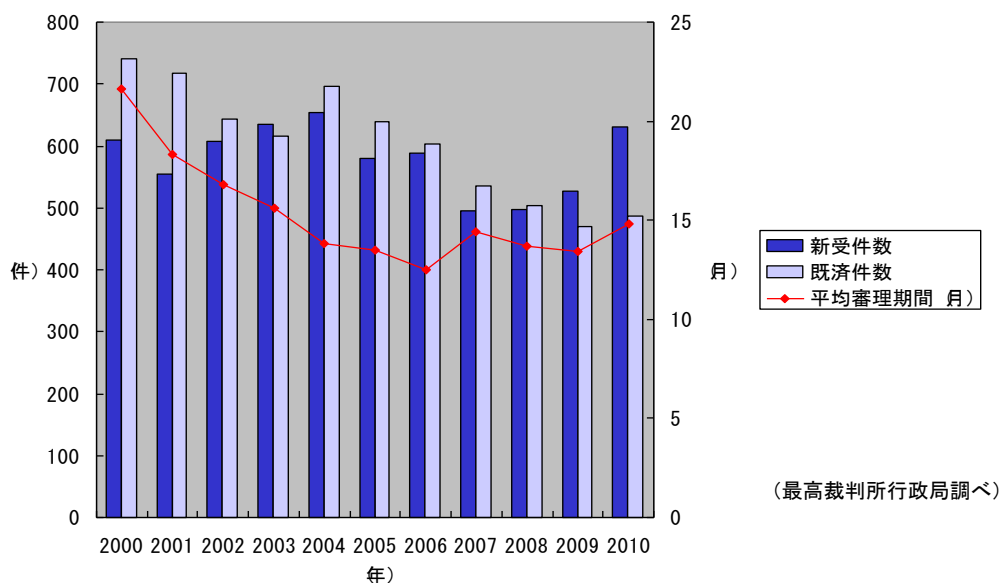
Statistics

Statistics of civil cases related to intellectual property rights
(first instances at all district courts)



統計

知的財産権関係民事事件統計 (全国地裁第一審)



Features of Intellectual Property Right Infringement Proceedings

- ◆ Statutory exclusive jurisdiction (Code of Civil Procedure Art.6)
- ◆ Statutory right of claim to injunction (Patent Act Art. 100)
 - Patent Act Art.100(1)
A patentee or exclusive licensee may demand a person who infringes or is likely infringe the patent right or exclusive license to stop or prevent such infringement.
- ◆ Statutory defense of invalidation of right (Patent Act Art.104-3)

知的財産権侵害訴訟の特徴

- ◆ 専属管轄が法定化されていること(民事訴訟法6条)
- ◆ 差止請求権が法定化されていること(特許法100条)
 - 特許法100条1項
特許権者又は専用実施権者は、自己の特許権又は専用実施権を侵害する者又は侵害するおそれがある者に対し、その侵害の停止又は予防を請求することができる。
- ◆ 権利の無効の抗弁が法定化されていること(特許法104条の3)

Jurisdiction

◆ Basic Principle

- The court that has jurisdiction over the location of the general venue (generally his/her domicile) of the defendant (Code of Civil Procedure Art.4)
- The courts may be selected, that have jurisdiction over the place of performance of the obligation, the place where the tort was committed, etc. (Code of Civil Procedure Art.5)

◆ Exception: action relating to a patent right, etc. (Code of Civil Procedure Art.6)

- Target
patent right, utility model right, right of layout-designs of integrated circuits, author's right (only over a computer program)
- Competent Court
Exclusive jurisdiction of [the Tokyo District Court](#) and [the Osaka District Court](#)
The Tokyo High Court ([the Intellectual Property High Court](#)) has exclusive jurisdiction over appeal trials

裁判管轄

◆ 原則

- 被告の普通裁判籍(通常は住所)の所在地を管轄する裁判所(民事訴訟法4条)
- 義務履行地, 不法行為があった地等を管轄する裁判所も選ぶことができる(民事訴訟法5条)

◆ 特例: 特許権等に関する訴え(民事訴訟法6条)

- 対象
特許権, 実用新案権, 回路配置利用権, 著作者の権利(プログラムの著作物のみ)
- 管轄裁判所
[東京地方裁判所](#), [大阪地方裁判所](#)の専属管轄
控訴審は, [東京高等裁判所\(知的財産高等裁判所\)](#)の専属管轄

Right of Claim Based on Patent Right

- ◆ Right of claim to injunction (Patent Act Art.100)
- ◆ Right of claim to compensation for damages (Civil Code Art.709)
- ◆ Right of claim to unjust enrichment (Civil Code Art. 703)
- ◆ Right of claim to restore business reputation (Patent Act Art.106)

特許権に基づく請求権

- ◆ 差止請求権(特許法100条)
- ◆ 損害賠償請求権(民法709条)
- ◆ 不当利得返還請求権(民法703条)
- ◆ 信用回復措置請求権(特許法106条)

Mode of Patent Infringement (1)

- ◆ Direct infringement (Patent Act Art. 68)
- ◆ Indirect infringement (Patent Act Art. 101)
- ◆ Cases in which no patent right infringement is found
 - Case of working of the patented invention for experimental or research purposes (Patent Act Art.69(1))
 - Case of working based on a license (Patent Act Arts.78 and 79, etc.)
 - Case involving products or acts for which the effect of a patent right is limited (Patent Act Arts.69(2), 69(3) 68-2, and 175, etc.)
 - Case for which is applied so-called exhaustion of right

特許権侵害の態様(1)

- ◆ 直接侵害(特許法68条)
- ◆ 間接侵害(特許法101条)
- ◆ 特許権侵害にならない場合
 - 試験又は研究のために実施する場合(特許法69条1項)
 - 実施権を有する場合(特許法78条, 79条等)
 - 特許権の効力が制限される物又は行為に該当する場合(特許法69条2項・3項, 68条の2, 175条等)
 - いわゆる用尽説が適用される場合

Mode of Patent Infringement (2)

- ◆ Literal infringement
- ◆ Infringement under the doctrine of equivalents

Five requirements for equivalents (Ball Spline case, Supreme Court decision <Supreme Court, February 24, 1998, decision given by the Third Petty Bench>)

- (1) Non-essential element
- (2) Capability of replacement
- (3) Obviousness of replacement
- (4) Identity to known art or ease of guess from known art
- (5) Intentional exclusion

特許権侵害の態様(2)

- ◆ 文言侵害
- ◆ 均等侵害

均等の5要件(ボールスプライン事件最高裁判決(最高裁平成10年2月24日第三小法廷判決))

- (1) 非本質的部分
- (2) 置換可能性
- (3) 置換容易性
- (4) 公知技術との同一性又は容易推考性
- (5) 意識的除外

Defense of Invalidation of Right

◆ Ground Provision

Patent Act Art.104-3

(1) Where, in litigation concerning the infringement of a patent right or an exclusive license, the said patent is recognized as one that should be invalidated by a trial for patent invalidation, the rights of the patentee or exclusive licensee may not be exercised against the adverse party.

(2) Where the court considers that the materials used for an allegation or defense under the preceding paragraph are submitted for the purpose of unreasonably delaying the proceedings, the court may, upon a motion or ex officio, render a ruling to the effect that the allegation or the defense is to be dismissed.

◆ Features

- For all grounds for invalidation
- No need for a trial examination for patent invalidation to be actually requested

無効の抗弁

◆ 根拠規定

特許法104条の3

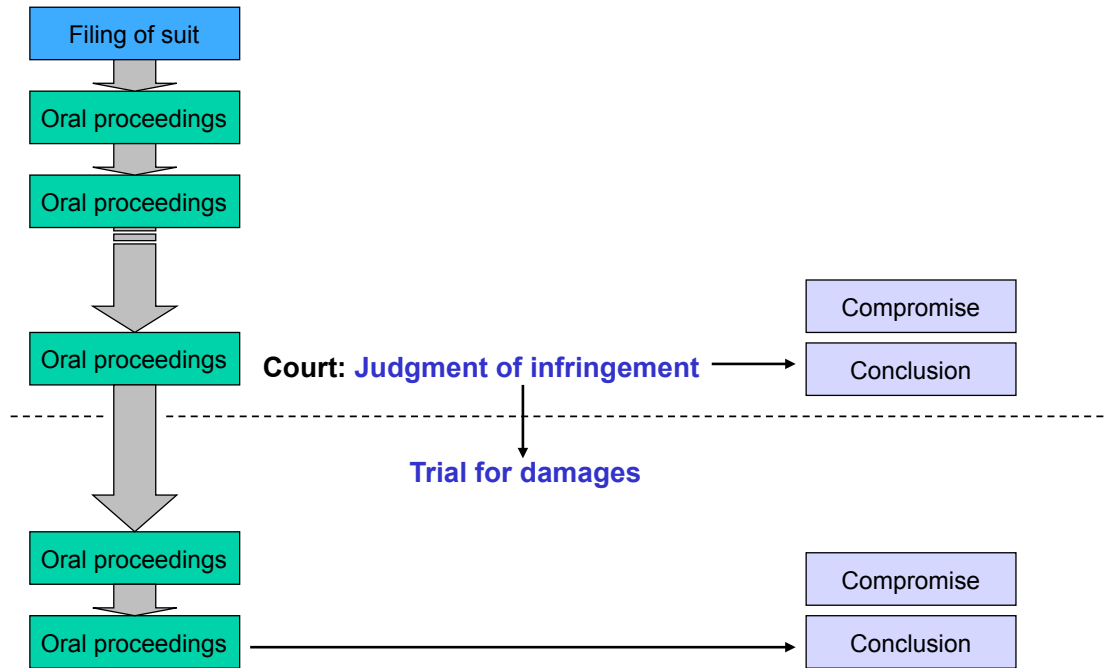
1 特許権又は専用実施権の侵害に係る訴訟において、当該特許が特許無効審判により無効にされるべきものと認められるときは、特許権者又は専用実施権者は、相手方に対しその権利を行使することができない。

2 前項の規定による攻撃又は防御の方法については、これが審理を不当に遅延させることを目的として提出されたものと認められるときは、裁判所は、申立てにより又は職権で、却下の決定をすることができる。

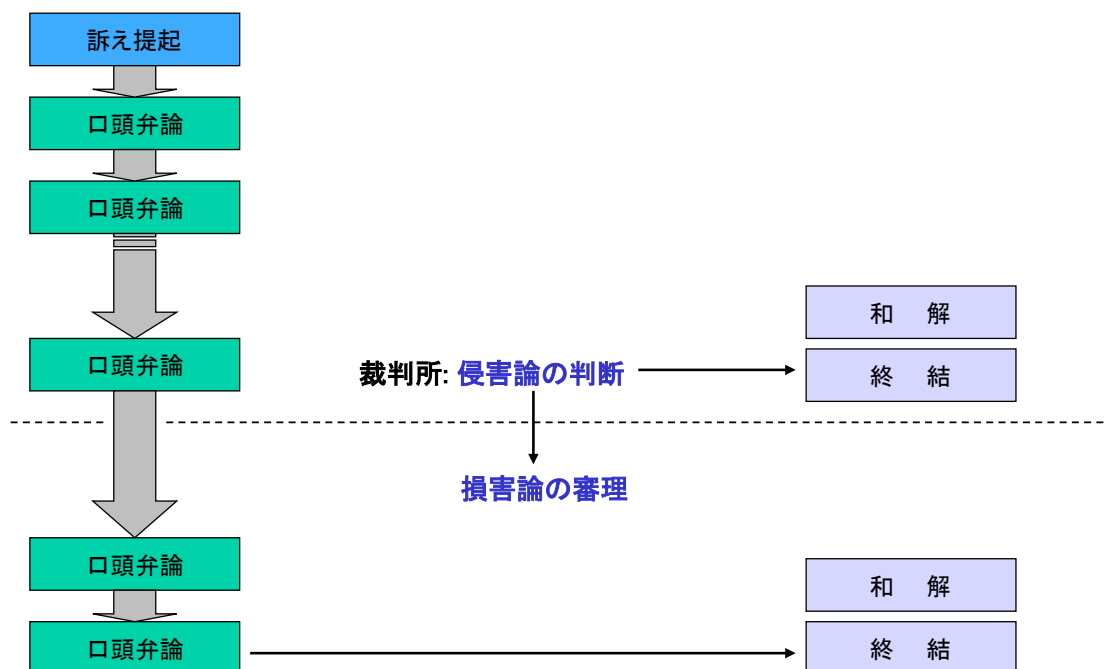
◆ 特徴

- 全ての無効理由が対象
- 現実に無効審判が請求されている必要はない

How Patent Right Infringement Proceedings Are Conducted



特許権侵害訴訟の流れ



Features of Trial for Infringement

- ◆ Identify article/process at issue
Identification based on, for example, a product number/model number
- ◆ Obligation to clarify the specific conditions (Patent Act Art.104-2)
In a case where the defendant disputes the specific embodiment of an article/process that the plaintiff claims, the defendant shall clarify the specific embodiment of his/her act unless there are reasonable grounds for not doing so.
- ◆ Support system for supporting judges in view of technology etc.

侵害論に関する審理の特徴

- ◆ 対象物件・対象方法の特定
製品番号・型番などによる特定
- ◆ 具体的態様の明示義務(特許法104条の2)
原告が主張する対象物件・方法の具体的態様を被告が争うときは、相当の理由がない限り自己の行為の具体的態様を明らかにする明示義務を負う。
- ◆ 裁判官に対する技術等に関するサポート体制

Support System for Judges

- ◆ Technical Adviser (Code of Civil Procedure Arts.92-2 through 92-7)
 - In a litigation, such as an intellectual property right litigation, in which specialized/technical matters are at issue, an expert (technical adviser), serving as a fair and neutral adviser who has ample knowledge of the specialized field, provides the judges and the parties with the specialized technology at issue in the case, in a procedure of clarifying issues.
 - Part-time court staff
 - Appoint a university (or college) professor, a researcher belonging to a public organization/corporation, or a patent attorney
 - Over 200 technical advisers in the field of intellectual property

裁判官のサポート体制

- ◆ 専門委員(民事訴訟法92条の2ないし92条の7)
 - 知的財産権訴訟など、専門的・技術的な事項が争点となる訴訟において、その専門分野の豊富な知識を有している専門家(専門委員)が、争点整理等の手続に際し、裁判官や当事者に対して、公平・中立なアドバイザーの立場から、その事件において争点となっている専門的技術について説明を行う。
 - 非常勤の裁判所職員
 - 大学教授、公的機関・企業に属する研究者、弁理士等から任命
 - 総数は200名を超える(知的財産権分野)

Support System for Judges (cont.)

- ◆ Judicial research official (the Court Law Art.57, the Code of Civil Procedure Arts.92-8 and 92-9)
 - A judicial research official involved in an intellectual property litigation has expertise in technology, and carries out, as ordered by a judge, search necessary for a trial and judicial trial related to a patent or a utility model.
 - Full-time court staff
 - A total of 21 judicial research officials in the Intellectual Property High Court, the Tokyo District Court and the Osaka District Court

裁判官のサポート体制(続き)

- ◆ 裁判所調査官(裁判所法57条, 民事訴訟法92条の8ないし92条の9)
 - 知的財産権訴訟に関与する裁判所調査官は, 技術についての専門的知識を有しており, 裁判官の命を受けて, 特許, 実用新案等に関する事件の審理及び裁判に関して必要な調査を行う。
 - 常勤の裁判所職員
 - 合計21名(知的財産高等裁判所, 東京地方裁判所及び大阪地方裁判所)

Thank you for your attention.

HARAKENZO
WORLD PATENT & TRADEMARK

御清聴ありがとうございました。

特許業務法人 原謙三国際特許事務所