

## Concerning the Reform of the Judicial System for Intellectual Property Rights\*

The First Subcommittee,  
The Second Patent Committee

### (Abstract)

The Council Concerning the Reform of the Judicial System summed up its opinions on the guidelines for the reform concerning the overall judicial system in Japan to the final written opinion and presented it to the cabinet in June 12, 2001.

Based on the written opinion, we reviewed how the judicial system for intellectual property rights should be reformed. As a result, we specifically summed up the opinions as the Ad Hoc Committee of the Japan Intellectual Property Association concerning the various matters such as establishment of procedures for collecting evidences, etc. before filing a judicial action, the patent court, exploitation of experts, improvement of ADR (Alternative Dispute Resolution), burden of the attorneys' fees by the losing party, and consolidation of judgement of patent validity.

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### 1. Introduction

The final written opinion on how the future judicial system in Japan should be (hereinafter referred to as the "the written opinion") was presented to the cabinet from the Council Concerning the Reform of the Judicial System in June 12, 2001.<sup>1</sup> In presenting the written opinion, Prime Minister Koizumi seemed to have stated, "We will place the reform of the judicial system in the national strategy, respect it as much as possible and exert best effort to achieve it".

The Council Concerning the Reform of the Judicial System is an advisory body that was established under the cabinet on July 27, 1999 with the aim of achieving the judicial system that is easier to be exploited by the people. Indeed through 63 times of meeting, the contents of the written opinion were decided. The outline of the written opinion is as follows.<sup>2</sup>

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\* "CHIZAI KANRI" (Intellectual Property Management) Vol.52, No.4, pp.449-463 (2002)

## [The Outline of the Written Opinion]

- Make the number of successful candidates of the National Bar Examination be 3,000 per year, three times as many as the current number in 2010.  
Expand the population of legal professionals to the size of 50,000 by 2018.
- Open law schools in 2004.  
Conduct a New National Bar Examination based on the contents of education at the law schools after 2005.
- Establish a “system of a person in charge of a criminal trial” under which general people can directly join criminal trials.
- Shorten the period for trial just about to half in which witnesses shall be examined.
- Enhance the comprehensive dealing with an action of intellectual property right infringement.
- Establish an advisory body that reflects the people’s intention to the procedure for assigning the judges.
- Development of the suitable criminal defense system for the suspects/accused.
- Exploitation of the adjacent legal professions (judicial scriveners, patent attorneys and certified tax accountants), etc.
- Develop a powerful promotion system in the cabinet. Particular attentions to necessary financial measures.

The reform of the judicial system, as a matter of course, relates to the comprehensive judicial system. The focal point in the written opinion rather seems to lie in the establishment of law schools that ensure the increase in the number of legal professions, and introduction of a system of a person in charge of a criminal trial that ensures the people’s participation in the serious criminal trials. However, concerning the action of intellectual property right infringement that is a kind of forms of civil actions, it has been ranked as one of the most important tasks and has been seen eye-to-eye on. As a result, various opinions have been included in the written opinion such that the section, “Enhancement of comprehensive dealing with cases relating to the intellectual property rights”, has particularly been established.

The Japan Intellectual Property Association that is the largest user’s association of the intellectual property system in Japan (hereinafter referred to as JIPA) has, from the start, paid attention to the movement of this council, and has serially worked upon all quarters directly or indirectly at a favorable opportunity in order to make the intention of the users’ side reflect to this council and the written opinion. The effort might succeed and result in that around 70 % of the requirements of JIPA seem to have been included in the written opinion.

This time, based on the written opinion, this subcommittee made a study on the directional movement concerning how the judicial system, etc. relevant to the intellectual property rights should specifically be developed in the future.

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## 2. Reform of the Judicial System for Intellectual Property Rights

Under the written opinion, we wrote down as new proposals as possible bellow, complying with the “Proposals to the Written Opinion of

the Council Concerning the Reform of the Judicial System”<sup>3</sup> that were presented to the related organs from JIPA dated on November 12, 2001. In the said proposals of JIPA, eight matters have primarily been described. However, among these matters, we have not been concerned at all here with the dealing of trade secret in the orders for presenting document texts, the matter on the

power of attorney for an action to a patent attorney, the matter of making ADR stand in for some affairs of the Department of Appeal of the Japan Patent Office (hereinafter referred to as JPO), and reconsideration of the provision under which a non-attorney-at-law is prohibited to deal with legal affairs.

## 2.1 Establishment of Procedures for Collecting Evidences, etc. Before Filing a Judicial Action

[Proposals Relevant to Procedures for Collecting Evidences, etc. Before Filing a Judicial Action]

Concerning before filing an action of intellectual property right infringement, it should be enabled to collect some information at least relevant to the allegedly infringing product/process.

- It is desirable that the courts get involved in the procedures for collecting information in question in some forms.
- Regarding available information, it is desirable that correspondence between the allegedly infringing product/process and the matter specified by the invention of patented claims of the right holder is valued without interpretation of claims in a manner such as sameness, and differentiation or obscurity, and that the result has no binding force.
- In permitting collection of the information in question, filing an action after a certain period and payment of the reasonable deposit should, as a rule, be required.
- The data relevant to infringement of those obtained, as a result of collecting the information in question, should be available as evidences via the in-camera procedure after filing of an action.

### 2.1.1 Actual States and Issues

The written opinion states that “The method for the person concerned to collect evidences in an early stage should be expanded including the period prior to filing an action.----- We should consider that in case that the person concerned notifies the other party of advance notice of filing an action, the new measure including the system under which the person concerned can exploit the method for collecting particular evidences and introduce it”. In order to prove infringement, the allegedly infringing product/process shall be specified. However, there is sometimes such a case that any evidence for specifying it is unevenly distributed among the side of suspects. And, it seems to become a fetter for the side of a right holder to determine whether or not an action shall be filed. Furthermore, in such a circumstance, it is feared that the appeal/trial examination of the action may be delayed, even if the right holder files an action.

The procedure for collecting evidences in Japan has mainly been established for the pur-

pose of collecting evidences after filing an action. For example, motion for orders for presenting document texts is a procedure to be taken after filing an action. In addition, the Enquiry System of the Party Concerned that was established in the Amended Code of Civil Procedure in 1998 (Section 163 of the Code of Civil Procedure) was drawn upon the interrogatory in the discovery in the U.S. Under this system, the party concerned can inquire, fixing a length of time, the other party to answer in writing about the matters which seem to be possessed by the other party among those required in order to prepare for allegation or proof. However, the time for enquiry is absolutely limited to during the pendency of an action, and any enquiry is permitted only after filing an action. Furthermore, since, even if the other party acts against the duty of enquiry, particular sanctions are not imposed to it, it is short of effectiveness.

As just described, since, concerning the procedure for collecting evidences before filing an action, any particular effective procedure has currently not existed in Japan, the actual status

seems that the party concerned might be compelled to exploit the preservation of evidences before filing an action for the purpose of collecting evidences.

As the written opinion states, we agree to look into the method for collecting evidences before filing an action for the purpose of practicing accelerated appeal/trial examinations. However, although the necessity is large, serious problems such as handling the trade secret, etc. seem to be involved.

### 2.1.2 Proposals

Based on the stated outline, we would like to make proposals relating to the method for collecting evidences, etc. prior to filing an action in Japan as follows.

(1) In the past Patent Committee of JIPA, it was proposed that the enforceable system of preservation of evidences prior to filing an action should be prescribed in the Patent Law as close to the French System.<sup>4</sup> Furthermore, as prerequisite for it, the prima facie proof of infringement, payment of the deposit, and filing an action within the short time after preservation of evidences were cited. In addition, adjusting the French system a little to the Japanese way, some kinds of ingenuity were exercised such that the other party should be given a notice of preserving evidences a several weeks before, and that if in response it acted satisfactory prima facie proof of non-infringement, the preservation of evidences should be ceased.

Incorporating the proposal of the past Patent Committee of JIPA into one of our ideas, we made the following plan.

At first, on the assumption, since the other party has not yet become the actual party concerned before filing an action, more care seems to be taken in handling the trade secret, than after filing an action. Therefore, the enforceable evidence collecting system like the system of seizure in France might be rough on the other party and be hard to be fitted under existing law in Japan. On the other hand, in order to enable the substantial procedure, some enforceable system is desirable. In this case, if the procedure results in the exchange only between the parties concerned, it is predicted that the compelling power may decline. Furthermore, it is rough on

the other party in question to impose sanctions only for the reason that the other party does not conform to the requirements of the right holder that is merely a private individual. In addition, there seems to be a limit to establish the process for collecting evidences under which we can clearly specify the allegedly infringing product/process before filing an action, due to the problems such as the trade secret, etc. Consequently, we would like to propose establishing the system under which we can collect some kind of information on the allegedly infringing product/process as the court get involved in some way. Because we think that by taking procedures through the judiciary, we can secure the effectiveness of the procedure, and that we might eliminate the mal-distribution of evidences in some degree, even if we can not run into evidences available soon after filing an action and if we can obtain the information on the allegedly infringing product/process more than up to now. However, on the occasion when the judiciary gets involved in, if the compulsory enforcement power is too strong, the burden on the other party (particularly the burden on business enterprises) will increase like in the discovery in the U.S. Also, we should prevent the scope of the duty of disclosure from escalating boundlessly into a chain reaction like in the U.S. and in the U.K. We should also pay attention to the existing law under which the privilege of confidential nature of attorneys at law and patent attorneys like in the U.S. has not been approved enough.

(2) Based on the stated problems, we would like to make, for example, the following proposals as the specific procedure for collecting information prior to filing an action in which the court being involved.

On the occasion when the court accepts the application of the right holder and judges it as appropriate, it enables for the court related persons that can understand the art in question or the JPO related persons at the request thereof (hereinafter referred to as "technical investigation officers") to come to see the allegedly infringing product/process owned by the other and take compulsorily a survey on it. And, they fully examine the correspondence between the allegedly infringing product/process and the invention specified matters of the patented claims of

the right holder, and express the results like as identical, different or unclear with respect to each invention specified matter.

In this case, technical investigation officers in question express those only based on the relation of literal inclusion in the patented claims, without interpreting the technical scope of the patented invention which could be comprehended from the patents claims in question.

Herewith, although the right holder can not clearly specify the allegedly infringing product/process, he/she can obtain the simple information on presence or absence of the allegedly infringing product/process that can be included literary in his/her own patented claims. On the other hand, concerning the trade secret of the other party concerned, since technical investigation officers in question merely provide the information of whether or not the allegedly infringing product/process is literary included in the patented claims that are publicized, he/she does not seem to be damaged by the information in question. In addition, in the information in question, the other party concerned might on the contrary be able to complain about non-infringement, and as the case may be, the right holder might become passive against the complaint of infringement. This can result in reaching the accelerated dispute settlement.

In addition, since the result in question is the mere information, we should not approve any dissatisfaction with the decision of investigation in question such as immediate appeal or the like. And as a rule, we should not provide the party concerned with any opportunity to complain (argue) against the result in question. Furthermore, we think that we should store the data such as documents which technical investigation officers collected, pictures which they took for themselves or the like in order to evaluate the allegedly infringing product/process, in the court, and should exploit the particular data relevant to the infringement after filing an action as evidences through the in-camera procedure.

(3) In the mean time, in case that we employ this system as it is, it will become advantageous to the right holder, and the other party that has not yet become the actual party concerned is predicted to be forced to bear the considerable degree of burden.

Consequently, on the prerequisite of such

a motion, just like the enough prima facie proof as well as, for example, the system in France and proposals in the past Patent Committee of JIPA, we should, as a rule, oblige the right holder to file an infringement litigation within a certain period from the day on which the result in question was obtained and to pay its reasonable deposit certified by the court depending on each case. Also, in case of non-infringement as a result of a judicial trial, we think that the liability without fault shall be approved to the other party concerned. Consequently, we think that this result in preventing the abuse of applications in question as much as possible.

## 2.2 Issues on the Patent Court

[Opinions on the Patent Court]

- 1) It is desirable to enable entrusting the professional processing systems of both Tokyo District Court and Osaka District Court with the action case relevant to the intellectual property rights in general.
- 2) Concerning the action of the intellectual property right, it is desirable to integrate all the Appeal Courts to Tokyo High Court as the only Appeal Court of Patents, etc.

### 2.2.1 Actual States and Issues

At present, also in an infringement litigation relevant to the intellectual property such as a patent right, etc., jurisdiction of the first trial lies in each district court as the rule of the general civil action. However, under the recent Amended Code of Civil Procedure, jurisdiction of law suit relevant to the patent right, etc. has been established (Section 6 of the Code of Civil Procedure). Herewith, the extensive jurisdiction concerning the "law suits relevant to a patent right, utility model rights, the rights of layout-designs of integrated circuits or the rights of the authorship about the computer program copyrights" has come to be approved. That is to say, in case that the district courts under, or locating in the east of, the jurisdiction of Nagoya High Court own jurisdiction, persons have come to be able to file an action with Tokyo District Court. On the other hand, in case that the district courts under, or locating in the west of, the jurisdiction

of Osaka High Court own jurisdiction, persons have come to be able to file an action with Osaka District Court. Appeal examinations are under jurisdiction of each High Court. Also, the action against appeal/trial decisions, etc. made by the JPO is under exclusive jurisdiction of Tokyo High Court (Section 178(2) of the Patent Law).

Meanwhile, in Tokyo District Court and Osaka District Court, the specialized divisions have now been established (4 divisions in both courts. 20 judges and 10 investigation officers as of 2001), and judges who are familiar with these kinds of cases have been deployed. Furthermore, in Tokyo High Court that has been competent to an appeal against appeal/trial decisions, etc. made by the JPO three expert divisions (12 judges and 9 investigation officers) in charge of the intellectual property rights have been established.

At present, more than 80 % of the patent related actions and 70 % of cases in all the intellectual property actions have been concentrated in both District Courts in Tokyo and Osaka. The average period of appeal/trial examinations relevant to intellectual property-related cases has approximately shorten by average 5 months, compared with the other district courts in 2000 (14.9 months in Tokyo District Court, 14.7 months in Osaka District Court, and 19.8 months in the other district courts). In these points of view, we can say that both District Courts have substantially played a role close to that of the patent court.<sup>5</sup> However, although both District Courts have substantially played a role of the patent court, the period of appeal/trial examinations has extended for a long time, compared with that of foreign countries. Therefore, we think that additional shortening of the period of appeal/trial examinations will be required.

Also, concerning actions relevant to design rights and trademark rights, since the stated extensive jurisdiction has not been approved, those are under each district court as a rule.

Accordingly, there might be a case that a person cannot go through an appeal/trial examination by the judge that is familiar with the intellectual property-related action.

## 2.2.2 Proposals

(1) The written opinion states that "In order to make the expert divisions in both District Courts in Tokyo and Osaka substantially operate as the "patent courts", the expert processing system shall be reinforced all the more by throwing judges whose expertise is intensified or investigation officers of the courts who are technical specialists in a concentrated manner, introducing the Ad Hoc Committee System, and establishing jurisdiction belonging exclusively to both District Courts, concerning action cases of patents and utility models". We agree with the ideas in the stated written opinion. In order to secure additional acceleration, accuracy and uniformity of appeal/trial examinations, we should position both District Courts in Tokyo and Osaka as the substantial Patent Courts and make an effort to improve their specialization.

However, if the infringement litigation of a patent right, etc. exclusively falls under jurisdiction of both Districts Courts in Tokyo and Osaka, there might be a case that local small and medium sized enterprises may suffer from disadvantages from the view of user-friendliness. Therefore, although it will be anyway in future and we might accept anyhow that the appeal examination will concentrate to Tokyo District Court and Osaka District Court, even the existing system seems to be appropriate under which a party concerned can select either Tokyo District Court or Osaka District Court whose specialization is high depending on judgment thereof, to appear before the judge for the time being.

In addition, concerning appeal examinations, from the respects of security of specialization and uniformity of judicial precedents, etc., we think it desirable to assume for example, Tokyo High Court as the only Appeal Court of Patents, etc. Also, in proceeding exclusive jurisdiction of Tokyo District Court and Osaka District Court and integration into Tokyo High Court relevant to appeal examinations, we also think it necessary to consider the ways of human affairs of intellectual property-related judges which are different from those of other judges.

(2) As stated above, actions for some intellectual property rights such as patents and utility models, etc. are approved to be filed with

Tokyo District Court and Osaka District Court.

However, since knowledge may sometimes be required for not only patents and utility models but also intellectual property rights other than those alike from the experience in our busi-

nesses, we think that similar handling shall also be required for actions concerning intellectual property rights in general including design rights and trademark rights, etc.

## 2.3 Exploitation of Experts

[Opinions on Exploitation of Experts]

[Introduction of Expert Advisor System]

Concerning an infringement litigation of the intellectual property rights, the Expert Advisor System shall be established.

- Concerning whether or not selection of expert advisors is required in the individual action, they should be selected if at least one or the other party concerned requires them or if the court judges them to be required.
- As a rule, expert advisors shall be those who were agreed between both parties concerned. However, if both parties concerned cannot agree, they shall be those who are selected by the court.
- In case that expert advisors are selected by the court, examiners and appeal examiners of the JPO are desirable to be assigned as the first candidates from the view point of neutrality, feasibility and source of supply, etc.
- We should secure the opportunity for the party concerned to be able to argue against opinions of expert advisors, etc.

[Improvement of the Expert Testimony System]

We should establish so-called technical expert witness system under which the party concerned is obliged to explain in concert.

- The technical expert witness in question is desirable to be able to join in-camera examinations.

### 2.3.1 Introduction of Expert Advisor System

#### 2.3.1.1 The Current Status of the Person Who Assists a Judge

At present, each system of a court investigation officer, a judicial committee of a summary court, an expert witness, an arbitration board member, and a senior counselor as persons who play roles of assisting judges with professional knowledge has been established.

An investigation officer of a family court conducts an interview with a person concerned of conflict or a boy who committed delinquency, and investigates the fact relevance. And depending on the necessity, he/she conducts psychological test or counseling.

In an action relevant to the intellectual property rights, investigation officers (in District Courts in Tokyo and Osaka, and High Courts in

Tokyo and Osaka) and expert witnesses play such roles as stated above. As for such investigation officers, Tokyo High Court employed them in 1949 for the first time. At present, in order to assist judges to understand technical terms and technical contents of specifications, technical levels at the time of filing applications, and technical contents of the allegedly infringing product/process relevant to patents, utility models, computer programs and rights of layout-design/topographies of integrated circuits, nineteen examiners and appeal examiners of the JPO in total seem to have been dispatched to Tokyo High Court, Tokyo District Court, Osaka High Court and Osaka District Court that have the Expert Divisions of the Intellectual Property Rights on and after April 1999 (nine to Tokyo High Court, seven to Tokyo District Court, seven to Tokyo District Court, and three each to Osaka High Court and Osaka District Court,

respectively).<sup>6</sup>

An expert witness assists a judge through reporting his/her judgment gained from applying his/her professional knowledge, or his/her professional knowledge itself about particular data pointed out by a judge.

In addition, we have not found any country that owns the system similar to the expert advisors system as proposed in the written opinion as of the moment. Instead, in Korea and the Netherlands as in Japan, officers as persons assisting judges in professional knowledge are dispatched to courts from the Intellectual Property Office. Furthermore, major parts of judges of the Federal Patent Court are dispatched from the Intellectual Property Office in Germany.<sup>7</sup>

### 2.3.1.2 Issues on Investigation Officers System

As for issues on investigation officers system, we think that we could cite following matters.

1) Since the results of investigation conducted by investigation officers are not the action data but internal data, the contents that were reported to judges are not opened to the public. Therefore, it is not exactly known even to the party concerned how the impression of judges was affected, and we can hardly say that the transparency of appeal/trial examination is guaranteed enough.

2) These investigation officers are not always experts in all the technical fields relevant to conflicts of intellectual properties, and particularly, we can hardly say that they can provide judges with appropriate instructions in conflicts in the advanced and complicated technical fields.

3) Furthermore, since investigation officers from the JPO are dispatched only to the courts in Tokyo and Osaka, the courts in other districts should request for dispatching investigation officers of Tokyo District Court or Osaka District Court.

However, since the complex procedure for request thereof is needed, the current state is that this system is hardly said to be exploited enough.<sup>8</sup>

The expert witness system can also be exploited in the stated case 2), however, there are such limitations, that an expert witness is not permitted to voluntarily decide any matters on witness testimony and to report his/her judgment

obtained by applying his/her professional knowledge except for the data presented by judges, etc. In addition, it is said to be hard that we have him/her taken charge of witness testimony. Also, it might take long time in witness testimony work and it is one of the causes for delay in an action.

### 2.3.1.3 Proposals Relevant to the Expert Advisor System

(1) The written opinion states, "We should study the system under which non-legal experts in various kinds of professional fields get involved in all or parts of trials as expert advisors to support judges (support for keeping points in dispute in order; taking charge of or assisting to conciliation; investigation and statement of opinions relevant to issues which require professional knowledge; and involvement in examining evidences) -----, and study the way of introducing it".

The stated opinions refer not only to an intellectual property action but also to an action in general that requires professional support such as labor dispute and medical malpractice suits.

However, we basically agree with experts' involvement in trial procedures in such a form in the intellectual property action. However, since introduction of the expert advisor system is based on the premise that expert advisors themselves have enough knowledge on technology in question, we think it essential to promote thoroughness of recognition thereof through technical arguments between expert advisors in question and parties concerned. Accordingly, it is required to secure opportunities in which both parties concerned can adequately debate and contradict about opinions of expert advisors which relate to intermediate and final decisions of judges. Also, the data prepared by expert advisors shall be opened to the public.

In addition, securement of opportunities for contradiction shall be provided to witness testimony and opinions, etc. of all the persons such as expert witnesses, etc. whose technical support is requested from the courts, as far as it provides some effects on decisions of judges.

### (2) Selection of Expert Advisor

Concerning matters of whether or not ex-



pert advisors shall be selected in an individual action, if selection of expert advisors is requested at least from one or the party concerned since the method of conflict settlement in civil actions shall basically be decided by the parties concerned, or if the court decides that expert advisors are required for the purpose of precisely understanding technology and promoting accelerated ending, regardless of possibility of requirement from the parties concerned, they shall be selected.

As a rule, expert advisors are desirable to be agreed by both parties concerned, however, if both parties concerned cannot agree, people who are selected by the court shall accede to expert advisors depending on each case.

A list of expert advisors that is required in this regard is desirable to be prepared by the JPO or the like in commission of the court. The court

shall assign appropriate expert advisors from the list.

Also, since technical assistance is not limited only to the trial court, it shall also be introduced in the appeal court.

Regarding the number of persons, one or more seems to be acceptable. Plural numbers of persons seem to be hard from issues of the supply source of expert advisors.

### (3) Supply Source of Expert Advisor

As stated above, we think that expert advisors are desirable to be agreed by both parties concerned. However, if both parties concerned can not agree, problems of whom we should select as expert advisors and of where we should obtain supply source will exist.

Table1 Comparison of Supply Sources Proposed of Expert Advisor

	Neutrality	Specialization	Feasibility
Examiners/Appeal Examiners	1	2	1
Patent Attorneys (Attorneys at Law)	2	2	1.5
Researchers of Public Organizations	2	1	2
In-company Researchers	3	1	3

\* The fewer figures are, the better the results are. And, each figure depends on our subjectivity.

As this is shown in Table 1, examiners/appeal examiners of the JPO seem first of all to be desirable from the view point of neutrality, although they have problems which they overlap with investigation officers.

However, in an action relevant to complicated and advanced technology, there seems to be a case where researchers of universities and other public institutes are desired in terms of specialization. Depending on each case, selection of two persons in total, one examiner/appeal examiner of the JPO, and one researcher of universities and other public institutes might be possible.

In addition, if a researcher of universities and other public institutes become an expert advisor, we think that we should consider awarding an honor such as commendation, etc. in compliance with the number of times he/she consecutively occupied an expert advisor, in order to have him/her accepted it with ease.

### (4) The Scope in Which an Expert Advisor Is Involved.

Concerning the scope in which an expert advisor is involved, it is desirable to involve him/her widely not only in the procedure for keeping points in dispute in order at the stage of pretrial procedure explanation of difficult technology, preparation of investigation data and examination of evidences but also in the statement of opinions as a witness or questions to a witness during a trial in order to proceed accelerated ending of the action.

### (5) Stage Where an Expert Advisor Is Involved Except For Trials.

In such a stage, in order to secure the transparency of appeal/trial examination, we should establish the opportunity in which both parties concerned could basically attend to contradict the statement of opinions of expert advisors. In addition, since the transparency of appeal/trial examination should be secured, as is

the case with the investigation data, we should at least make these data available for inspection to both parties concerned, and establish the opportunity for them to contradict. And if possible, those are desirable to be opened to the public. In addition, not only the parties concerned state opinions and explain when they are merely requested to do so from judges, but also we should not prevent them from stating their opinions and technical explanations to judges at their own initiative such that, for example, they offer the necessary witness testimony to judges for the purpose of accelerated ending of an action.

#### (6) Refusal/Exclusion of an Expert Advisor

For the sake of the justice of a trial, the provision of refusal/exclusion of an expert advisor shall be established.

#### (7) Others

1) It is desirable that we should take measures for expert advisors not to be affected by the mass media such that limitations on media coverage is established during a trial.

2) In an action against appeal/trial decision of the appeal against examiner's decision of rejection, since a defendant is the Commissioner of the JPO, it does not seem to be desirable that an examiner/appeal examiner will become an expert advisor. Supposing we tentatively select, should we select other person?

### 2.3.2 Improvement of the Witness Testimony System

#### 2.3.2.1 Actual States and Issues of the Witness Testimony System

The witness testimony in the Code of Civil Procedure means examination of evidences for which judges make expert witnesses report the principle of experience and other professional knowledge or opinions belonging to the particular academic background, in order to supplement their ability to make decisions. The way of evidence thereof is an expert witness.

The witness testimony system is prescribed in the Code of Civil Procedure (Section 212-218) and the Regulation of Civil Procedure (Section 129-133) concerning offer and procedures, etc. As for the witness testimony, an ex-

pert witness reports about matters of the witness testimony that was decided by the court. Selection of an expert witness is entrusted to the court, and an expert witness can observe an appeal/trial examination.

An expert witness is approved not only to have a right to request a permission for questions to the chief justice, and a right to ask a direct question to a witness and the party in question, but also to collect the materials of witness testimony using all kinds of methods, after amendment of the Code of Civil Procedure. For example, one of the judicial precedents, that might be a little old, held it legitimate for the expert witness who was ordered for preparing a measured drawing of forestlands in dispute to have prepared an expert evidence, exploiting the drawing as the material that he/she obtained off the action procedures.<sup>9</sup>

However, it is not prescribed that a party in question shall assume a duty to cooperate in explanation to an expert witness. Also, since an expert witness can not get involved in the in-camera procedure, he/she can not sometimes obtain enough expert evidence.

Consequently, since there was a difficulty in legally advising the document text that was presented to prove the amount of damage caused by infringement of a patent right, etc. and that required professional knowledge of accounting/finance, the accounting expert witness system, in particular, was established by amendment of the Patent Law in 1999 (Section 105(2)). Also, another new system was established by amendment of the Patent Law in 1999, under which, if the witness testimony relevant to the technical scope of the patented invention is required from the court to the Commissioner of the JPO, an appeal examiner of the JPO conducts a witness testimony (Section 71(2)).

Under the accounting expert witness system, the court assigns a certified public accountant in a neutral position as an expert witness in order to make him/her carry out a computation, etc. of the amount of damage, and it makes the party in question assume a duty to cooperate in explanation to the accounting expert witness. However, a penal regulation, etc. against breach of a duty to cooperate in explanation has not been prescribed, in particular.

### 2.3.2.2 Establishment of the System of Technical Expert Witness

On the stage of proving the amount of damage caused by the infringement of a patent right, etc., the particular witness testimony system named the Accounting Expert Witness System was established as stated above. Furthermore, so to speak, the entrusting system of technical expert witness was established, under which an appeal examiner of the JPO could appraise, concerning the technical scope of the patented invention.

However, in order to appraise advise technical issues in fact which are not expressed in the patent specification, the stated entrust system of technical witness testimony seems to have some limits. For example, in the Case "Shrimp-Process Food",<sup>10</sup> Judgment on July 15, 1998, at Tokyo District Court, after the meaning of the term, "the half-cooked and denatured condition" in the scope of the patented claims was interpreted in consideration of the specification, whether or not the defendant product was in the half-cooked and denatured condition as interpreted was determined by the witness testimony.

However, in carrying out the witness testimony, since most of the materials of expert testimony showing whether or not the defendant product was placed in such a condition were unevenly distributed to the side of a defendant, it seems to have become a barrier at one time. As just described, if the allegedly infringing product/process is clear on the surface, the entrusting system of technical expert witness seems to function. However, if the allegedly infringing product/process is not clear on the surface and the materials of witness testimony were unevenly distributed to the side of a defendant, it seems that it might not function well.

In addition, even if the documents which is required for the proof of infringement are presented under the Section 105 of the Patent Law, it may be hard to decipher without cooperation of the other party in such a case that abbreviations or symbols available only to intra-company are described in the documents, etc. which were presented.

Consequently, it seems to be desirable to establish, as it were, the technical expert witness system under which a technical expert witness

such as an appeal examiner of the JPO or a patent attorney who is in a neutral position can appraise in the form of getting further into the entrusting system of technical expert witness prescribed in Section 71 (2) of the Patent Law under a duty to cooperate in explanation or the parties in question, like an accounting expert witness relevant to the amount of damage.

In addition, since in most of the cases, the data that require for the witness testimony is closely related to the trade secret, such system seems to be desirable that the technical expert witness concerned can join an in-camera appeal/trial examination.

## 2.4 Improvement of ADR

[Proposals on ADR]

- 1) It is desirable that we could make the arbitration proceedings to the "two-appeal/trial examination system" under the contract agreement between the parties concerned in order to increase the rate of utilization of the arbitration system as ADR.
- 2) It is desirable that we give the elasticity to the arbitration proceedings and results of the decision thereof.

### 2.4.1 Arbitration System and Its Issues

(1) The methods of settlement by the third party other than the parties concerned in dispute are divided broadly into the one by which the third party recommends compromise (mediation) or submits settlement proposals (conciliation) after hearing opposed arguments of the parties concerned, and the one by which the third party makes judgments binding on the parties concerned and can force them to accept the contents thereof (arbitration, trial).

Arbitration is the system that is authorized by the law (prescribed in Chapter 8, Arbitration Proceedings of the Legislation relating to Public Notification Proceedings and Arbitration Proceedings) under which the parties concerned make the third party, a private individual, judge disputes, accept the judgment thereof ("arbitration agreement"), and settle the dispute in accordance with the agreement thereof.

Conciliation is absolutely harmonization

of differing interests between the parties concerned, and is carried out aiming at the greatest common interest with economy of both parties. On the contrary, arbitration makes finding, judgment and declaration of rights and obligations, as it were, to make it clear which one is right or wrong. Differences between both sides lie in this point.

Concerning decision of which is right, one of the problems of the arbitration system seems that it might be concerned about culminating everything by one judgment.

In addition, concerning the JP domain name, the system has recently been established under which ADR rules whether registration of domain names in question shall be transferred to the person making an appeal or whether it shall be revoked (JP domain name dispute-settlement procedures). This system merely relates to domain name disputes. Under this system, it is prescribed that if a dispute arises, the party concerned firstly can ask for a certain ruling of ADR, and take an action against decision with the court in case of dissatisfaction, based on the contract in filing an application of a JP domain name.

(2) In the existing legislation relating to the arbitration system (Section 800, Chapter 8, Arbitration Proceedings of the Legislation relating to Public Notification Proceedings and Arbitration Proceedings), it is prescribed that "The decision of arbitration has the same effect as that of the judgement of the court that was settled between the parties concerned", and the effect of the decision of arbitration has been prescribed as absolute.

However, it seems that this absolute effect may be one of the factors to make the design of institutional arrangements be fixed.

Consequently, in order to disseminate ADR, we think that we should consider about the effect of the decision of arbitration.

(3) Whether or not a person files an action with the court could be decided after he/she considers the past court decisions analyzing the states of oneself and the others, and looks deeply at the possibility for the judgment advantageous to oneself to be given. It is common that this predictability of a settlement is based on "court decisions" or "judicial precedents". Also, since

we indeed have this "court decisions", etc., it can be said that legal stability of many judgments is secured.

On the other hand, in ADR, there is nothing equivalent to this "court decisions". This conflicts with the merit of nondisclosure that is one of the great characteristics of ADR.

So far as this merit of nondisclosure is maintained for many years to come, decisions of ADR will not be disclosed. Or, even if abstract case examples are disclosed as compromise, ADR will become disadvantageous by all means in comparison with judgments concerning the stated predictability of a settlement and legal stability.

#### 2.4.2 Proposals for ADR

(1) If we inquire into ADR in consideration of "commercial arbitration", we agree, in general, with the ideas which were stated in the written opinion, and we expect the accelerated and effective measure such as grant of the effect of interruption of limitation. In addition, we would like to further propose from the position of users of ADR as follows.

(2) The Current States of ADR and Directional Movement of Amendment of the System in the Future

The rate of utilization of ADR in Japan is lower than in Europe and the U.S.

For example, if we compare with the system that may fairly be said to have the formation as one "industry", like A.A.A. (The American Arbitration Association)<sup>11</sup> in the U.S., we can not deny feeling that our system is behind theirs. The fact is that it is very uncertain whether or not the Japanese version of ADR may be utilized as the dominant method for settling disputes between the parties concerned in the international contracts with the Asia which seem to rapidly increase in parallel with the enhancement of the economic activities in the Asia in the future. We do not think that we could utilize it as to be comparable to A.A.A. that almost necessarily appears on the contract between Japan and the U.S.

We can say that it is even urgent business as a nation to grow up the Japanese version of ADR to make the form as one "industry" like A.A.A. in the U.S., if we bring further economic

globalization, particularly new globalization focusing on the Asia into view.

In order to grow it up, it is necessary to enhance the rate of utilization thereof, above all else. However, although we recognize the necessity of growing it up, the fact is that we can not take the next step due to unavailability thereof, if we consider it as the position of users.

The greatest factor that obstructs the advancement of the rate of utilization seems to consist in the "first instance system" in the arbitration system. This "first instance system" may be troubled, compared with the "third instance system" in judgments under which the opportunities to study and settle the issues three times are assured. Therefore, users may hesitate to select it. Consequently, it is desirable to take measures for easing the "first instance system" in a certain form.

### (3) Consideration to the "Second Instance System"

It seems that uncertainty over the "first instance system" may, in brief, result from being impossible to reverse it, if there is any "decision that is felt undue". As the measure for easing this, we can recall the "second instance system" in arbitration proceedings. In other words, if the party concerned has dissatisfaction with the first arbitration decision, we plan to prepare the tandem arbitration proceedings in arbitration agreement itself.

We think that there is no problem in agreeing with another appeal/trial examination corresponding to the upper instance against the first instance, from the principle of the freedom of contract. It is said that such arbitration is conducted in the field of commodity transaction in the U.K.<sup>12</sup>

### (4) Absolute Effects of Arbitration Decision

We described before that the effects of arbitration decision were looked upon as absolute on the law. If we amend this to such a prescription leaving a room for selection that "it may be looked upon as having the same effects as those of judgment of the court in accordance with the contract", it seems that the rate of utilization may increase. If the parties concerned are prepared for accepting an arbitration decision of the third party as the conclusion, we might as well

look upon it as "it has the same effects as those of judgment of the court in accordance with the contract". Also, if we would like to look upon it as a tentative important opinion, we might as well not advocate the effects thereof in accordance with the contract.

However, we wonder if such a contract like this would be possible under the existing law?

Even in the existing law (Section 8, Chapter 8, Arbitration Proceedings of the Legislation relating to Public Notification Proceedings and Arbitration Proceedings), an "appeal of revocation of an arbitration decision" has been approved. However, in other words, we can not approve such a contract that has not been advocated in each paragraph of the paragraph 1 through 6 of section 8, under which "if one or the other of the parties concerned has an objection after an arbitration decision was conducted, the arbitration decision does not have any effect of Section 800, and he/she can appeal to the court above".

We think that the legal easing will be required in this point.

### (5) Possibility of Hybrid ADR In the U.S.

Recently, particularly in the U.S., considering the parties concerned who want to settle by moderate conciliation if possible, so called Hybrid ADR as one modification of conciliation has been proposed. For example, according to this proposal, if the parties concerned try conciliation first but can not reach any settlement, they once move to the arbitration decision to accept the presentation of final decision of the arbiter concerned and try conciliation once again. And, even so, if the conciliation is not realized, the arbitration decision that makes it clear whether it is right or wrong will be declared.

We think it as a unique method that combines the conciliation system and arbitration system.

### (6) The System Planning of the High Degree of Freedom and Free Selection Thereof

Concerning ADR, particularly in Europe and the U.S. which are advanced countries of ADR, the free system planning seems to have been prepared and under free selection, to have been engaged in settling problems in collabora-

tion with the judgment system.

Also in Japan, there should be various alternatives for a dispute settlement. Under the principle of freedom of contract, it seems to be one of the key points for the development of ADR that we can provide lots of alternatives of ADR in line with the primary purport and that the parties concerned can take them in by working out contract matters like the stated Hybrid ADR in order to positively exploit them.

## 2.5 Handling of Burden of the Attorneys' Fees By the Losing Party

[Burden of the Attorneys' Fees By the Losing Party]

At least in an infringement litigation of intellectual property rights, such system should be established that makes the plaintiff bear parts of the attorney's fees of the side of the defendant, even if the side of the defendant wins the case as well as the plaintiff does.

The written opinion states that "From the standpoint of availability of actions through establishing the fairness of burden of the costs for the benefit of the party concerned who could not help avoiding the action since he/she could not recoup the attorneys' reward even in case of winning the case, we should introduce the system that makes the losing party bear parts of the attorneys' rewards which are included in action costs".

We basically agree with the stated proposal.

Recently, if the plaintiff right holder wins the case in the infringement action of an intellectual property right, it seems that such a case has increased that, in addition to the damages caused by the original lost profit, the attorneys' fees are acknowledged as the positive damage, and the parts thereof are approved as the amount of damages.

Since this trend will also not change under the tidal stream of the pro-patent in the future, and it is coming close to the approval of the more adequate damages, we think that it is advancing toward the right direction.

On the other hand, if the defendant wins the case, it seems that the attorneys' costs spent

in the action in question have not been approved at all in the same action. However, if the defendant that won the case files an action separately, requesting the positive damage concerning the attorneys' costs in question and it is approved, they could be refunded. However, since such a new action like this is too troublesome and is also uncertain about possibility of approval thereof, the actual state is that such an action does not seem to be filed in general. Under such circumstances, the fairness between the parties concerned is lacking. In addition, even if the defendant wins the case, the attorneys' costs, etc. which are anything but low values may unnecessarily be forfeited, and not negligible pains seem to stay behind such that the persons in charge of business routines may be imposed useless workloads. Depending on how things go, only pains may stay behind.

Even though it is unreasonable, if the right holder files an action, the other party should deal with this against its will, and usually select the attorneys, etc. for that purpose. Then, the attorneys' costs, etc. should of course arise, and in many cases, they should not be negligible.

Counterpoising these matters, etc., the other party seems not infrequently to head for a compromise, if it has a warning from the right holder. This unavoidably results in making a breeding ground of the right holder who unfairly exercises the right like making bad use of expensive attorneys' costs, and it turns out just as the right holder like this wants.

Consequently, at least in an infringement litigation of an intellectual property right, we think that we should establish the system under which we approve the very parts of the attorneys' costs, etc. of the side of the defendant, for example, as a positive damage and make the plaintiff right holder bear them as damages, even if the defendant wins the case.

And, we think that the more unfair the appeal is, the higher we should raise the approved amount in question, and the more we should acknowledge the intangible damage.

## 2.6 Consolidation of Judgment of Patent Validity

[Proposals on Judgment of Patent Validity]

- 1) As a rule, judgment of patent validity made by the court shall be enabled. And, if there is a new provision that should enable it enough, for example, a ground for nullity in patents, we should establish the prescription to the effect that exercise of the right based on the patent in question shall not be allowed.
- 2) In order to realize the consolidation of the judgment of patent validity concerning right and wrong of a patent registration, it is desirable that we should establish the system under which the system of the patent trial for invalidation of the JPO is extinguished and an appeal/trial examination is conducted at the court from the first, if the human infrastructure of technical judges is prepared in the future.

### 2.6.1 Issues on Kilby Patent Decision of the Supreme Court

In the appeal hearing of the declaratory judgment of non-existence of debt relevant to the so-called Kilby Patent, the Supreme Court held that “----the court should be understood to be able to decide whether or not it is clear that the ground for nullity exists in patents----, if it is clear that the ground for nullity exists in patents in question, the injunction based on the patent right and the request for compensation for damage correspond to the abuse of the rights and are not allowed---, so long as there is no particular case”.<sup>13</sup> Thereby, it changed the previous court judgement relevant to the distribution of rights between the JPO and the court under which, if the defendant of an infringement litigation disputed the invalidation of patents, he/she entrusted the decision of validity or invalidation of the patent right to the appeal/trial decision of the trial for invalidation of the JPO, and concerning the patent right approved to be valid as the result, the court decided whether or not the implemented products of the defendant existed within the technical scope of the patent in question. As the reason for that, the Supreme Court has cited the action economy and the concept of the equity.

And this decision of the Supreme Court showed that the decision relevant to the validity or invalidation of a patent which was regarded as to be enabled only through the procedure for invalidation trials before the JPO was also enabled in the infringement litigation of a patent right, and the appeal/trial examination for the civil declaratory judgment of non-existence of debt based on the patent right. Consequently, it is significant in the matter that decision of restriction of the effect of a patent right, which was only approved in the past by a certain method such as the plea, etc. of the publicly-known technology, has become possible even if the court decides that the patent is clearly invalid.

However, getting the decision of the Supreme Court, the state of affairs has brought about, in which the theory of abuse of rights to be only exceptionally approved by nature has frequently been utilized in the subsequent trial by a lower court, and this does not seem to be desirable.

### 2.6.2 Directional Movement of the Immediate Reform of the System

The system reform of the decision of the patent validity is not in particularly described in the written opposition in question. However, in order to proceed with the action proceedings for patents, etc. more effectively, considering the stated Supreme Court Decision of the Kilby Patent, we would like to approve in general, the defense of the patent invalidation (or the matter having the same effect as this) by the defendant including lack of inventive steps, etc. and as a rule, to make it possible for the court to decide at the same time in a patent infringement litigation, etc. And furthermore, if the allegation of the cause for a patent invalidation and the reason thereof are presented from the defendant, we would like to make it possible for the plaintiff to submit (tentative) amended claims in which the allegedly infringing product/process is still included in order to avoid them.

We should systematically realize this, and take legislative measures under which all the allegations of invalidation would enable without requesting the side of the defendant for any trial for invalidation in the civil actions. In details, we should prescribe the rule under which, if the cause for invalidation exists in a patent, the ex-

ercise of the right based on the patent in question shall not be allowed. On the other hand, as the re-pleading of the defendant, on the assumption that there still exists a patent infringement by the defendant products, we should prescribe at the same time that the de facto amendment of a patent shall be enabled as a defensive method in order to avoid the cause for invalidation.

### 2.6.3 Directional Movement of the Future Reform of the System

(1) In case that invalidation of a patent is decided without going through the procedure for the trial for invalidation such as the stated proposal in a civil action against a patent infringement, the problem is that the description of the register of the JPO is not changed, since any judgment does not have the general effect to the public, even if the facts such as the decision of a patent invalidation and decision of approval of amendment about which the registry shall be changed come into existence in the appeal/trial examination.

In addition, it originally does not seem to be capable that the administrative authority deals with the matter such as a patent invalidation about which the interest of the parties concerned is directly opposed. Consequently, since the number of technical judges (technical successful candidates of the National Law Examination) is anticipated to increase in the future depending on the movement of law schools, on the assumption that it will increase and the human infrastructure will be enough improved, we have thought the following ideas under which we extinguish the existing trial system for a patent invalidation of the JPO, and alternatively, the court examines and judges the first instance of the confirmation of invalidation. In doing so, it seems that the decision of a patent validity comes to be truly consolidated.

1) The trial for invalidation of the JPO has entrusted the first instance with the procedure for the appeal/trial examination of the JPO as the special provision of the Administrative Case Litigation Law. Sending back this to the first principle, if the defendant conducts the allegation of a patent invalidation in a civil action against a patent infringement, we would amend to make the first instance of the patent registrability fall

under the jurisdiction of Tokyo District Court instead of the trial for invalidation and also to make the Commissioner of the JPO who decided the validity of the patent be a defendant.

Furthermore, we would amend to combine the administrative case litigation in question of a patent invalidation and the civil action in question against a patent infringement.

If doing so, we could at least avoid the state of affairs such as overlapping of the appeal/trial examinations, and if the judgment based on the decision of a patent invalidation becomes final and conclusive, not only non-existence of debt against the patent right in question may become final and conclusive but also the registration of the patent in question may be deleted from the patent register.

However, in this case, we should pay attention to the matters that the jurisdiction of trials will be restricted to Tokyo District Court and that the infringing suspect and the Commissioner of the JPO will automatically be forced to become codefendants.

2) Aside from this, on the assumption that the defendant satisfies a certain requirement in an infringement litigation of a patent, we could make such a plan that we would give the opportunity to join the action to the Commissioner of the JPO who decided the patent in question to be valid by the procedure like a litigation announcement and that afterwards, if the judgment based on the ground of the invalidation of the patent in question becomes final and conclusive, the Commissioner of the JPO would register the fact in question in addition on the register in accordance with the definitive judgement.

From the view point of the simplification of the action proceedings, it seems that the latter plan in which a certain general effect to the public could be obtained by a certain action proceedings may be more desirable than the former one that combines the multiple appeal/trial examinations.

(2) As the issue in case of filing a declaratory judgment of invalidation with the court, the eligibility for the plaintiff could be cited. If the plaintiff can merely have interest so far, it is



feared that the eligibility for the plaintiff might not be approved, since the interest of the appeal might be looked upon as insufficient. So, it will become hard to prophylactically invalidate a patent.

Concerning this matter, we have a problem that, if we merely reduce the level of the eligibility for the plaintiff, it is feared to be conducive to the vexatious actions. We wonder if we can correspond to the requirement for prophylactically invalidating a patent by applying the existing opposition system of the JPO or a little amended system thereof. For example, we could consider extending the term of opposition a little more.

In case that the parties concerned are directly opposed to each other and that the plaintiff would like thoroughly to invalidate the patent, we think that it can not be helped that the eligibility for the plaintiff becomes severe in some degree.

In addition, if an infringement litigation is filed, there will, as a matter of course, exist the eligibility for the plaintiff.

#### 2.6.4 The Independent Amended Appeals and Trials System and the Opposition System

(1) Under the existing law, since we can demand a trial for correction without limitation of the substantial number of times (except for the opposition and the demand for correction during the pendency of the trial for invalidation), it is feared that we might incur useless exchanges between the JPO and the court. In addition, if the substantial correction of the claims becomes possible in the justice of an infringement litigation, it also occurs to us that the independent trial for correction might not be required any more.

However, if the doubt about interpretation of claims arises between the parties concerned, the dispute might be settled depending on a trial for correction. In addition, since the right holder would like to correct the clerical errors before something happens, we are reluctant to abolish a completely independent trial for correction from the standpoint of the disclosing function to the third party.

Therefore, we assume that we make it legally possible just as under the existing law for the right holder to correct the clerical errors or

non-distinctive descriptions. However, concerning limitation of claims, how about making it legally possible to demand the correction of limitation if only the right holder showed the grounds for the prior arts?

It seems that the former falls under so-called correction in the U.S., and the latter falls under so-called ex-parte re-examination system of the U.S.

Then, although there is no limitation in the number of corrections, we can think that the demand for correction trial would considerably be put restraints. Therefore, it seems that we can considerably prevent exchanges between the JPO and the court.

(2) The opposition system seems to have the aims at which the JPO being given a tentative validity also provides the people in general with the opportunity for expressing opinions about the rights and wrongs of the final patent decision and brings the people to the agreement in a certain sense with the grant of the patent right that is a monopolistic and exclusive private right constraining the people in general as well as it intends to secure the opportunity for correcting errors in judgment of examiners as many as possible.

Consequently, since the purport of the opposition system is different from that of a trial for invalidation and that of a civil action against a patent infringement which are the procedures between the private parties concerned, we do not think that the improvement will not greatly be required.

### 3. Conclusion

In the written opinion recently presented by the Council Concerning the Reform of the Judicial System, the unconventional and epoch-making directional movement has been shown from the standpoint of expertise of an infringement litigation of intellectual property rights. Not only from the standpoint of the era of pro-patent but also from that of the promotion of exploitation of intellectual property rights, the directional movement has been shown. From each sector of society, it has been valued as "It is so wonderful that it will leave its name in the history of the reform of the judicial law in

Japan”, “The powerful decision aiming at the drastic reform of judicial law has been shown”, “It has shown the great directional movement on how the judicial system of Japan should be” and etc.

At the end of the written opinion, it has been described, “More important matter than anything is to adequately think of opinions and consciousness of users of the judicial system and to reflect it in the reform and improvement of the system”.

We feel the passion with which committee members want to make the reform into the open-minded one directing its attention to the people, instead of the closed one.

Taking advantage of such a purport, we wish that the contents of the written opinion would not be rendered ineffectual in the subsequent reform of the judicial system, particularly in the infringement litigation system of intellectual property rights.

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#### Notes:

- <sup>1</sup> At the Web site of the Council Concerning the Reform of the Judicial System, URL: <http://www.kantei.go.jp/jp/sihouseido/report-dex.htm>
- <sup>2</sup> Morning Paper of “Nihon Keizai Shinbun” of June 13, 2001
- <sup>3</sup> Takafumi Sawai, “Proposals to the Written Opinion of the Council Concerning the Reform of the Judicial System” in Intellectual Property Management, Vol.51, No.12, p.1941 (2001)

Property Association, “How the Discovery System in Japan should be”, in Intellectual Property Management, Vol.48, No.12, p.1907 (1998)

- <sup>5</sup> Makoto Teizuka, “Activities of the Court against Intellectual Property Litigations” Tokugikon, No.220, Issue of December 3, 2001, pp.23-31 (2001)
- <sup>6</sup> At the Web site of the Patent Office, URL: [http://www.jpo.go.jp/tousi/7s2\\_37.htm](http://www.jpo.go.jp/tousi/7s2_37.htm)
- <sup>7</sup> Under the joint editorship of Naoki Koizumi and Institute of Intellectual Property, “Validity of a Patent and an Action of infringement” published by the Business and Industry Investigation Committee, p.387
- <sup>8</sup> Yoshio Ishii, “Investigation Officer's Work”, Tokugikon, No.220, Issue of December 3, 2001, pp.32-41 (2001)
- <sup>9</sup> The Judgment of the Supreme Court of December 28, 1956, Civil Case Law Reports of the Supreme Court, Volume 10, No.12 Issue, p.1639; Koichi Miki, “Expansion of the information collecting proceedings of the party concerned in an action of patent right infringement” in Jurist, No.1162, pp.55-61
- <sup>10</sup> The Court Judgment of Tokyo District Court on July 15, 1998, Hanrei Jiho, No.1668, p137
- <sup>11</sup> Fumi Yamada, “The Actual State of ADR in the U.S.(The Second Volume), NBL, No.720, p.71 (2001.9.1)
- <sup>12</sup> Editing by Kaoru Matsuura and Yoshimitsu Aoyama, “Issues in Question of Today's Arbitration Law”, Yuhikaku, p.349
- <sup>13</sup> The Court Judgment of the Supreme Court on April 11, 2000, Civil Case Law Reports of the Supreme Court, Vol.54, No.4, p1368

(Date manuscript received: February 7, 2002)

<sup>4</sup> The Patent Committee of Japan Intellectual