INTRODUCTION OF ARTICLES

Recent Decisions Involving Invalidity/Abuse of Rights Practice

—Study of invalidity defense in Japanese courts after Supreme Court decision on Kirby patent —

The Third Subcommittee,
The First Patent Committee

The purpose of this article is to analyze and review the general tendency concerning the invalidity of patents by extracting the infringement cases concerning patents and utility models that relate to "invalidity" issue in any manner from the civil actions and procedures for which any decision was made during the period from May 1, 2000 to April 24, 2002. This article further examines those extracted cases focusing on how the Patent Office and the courts made decisions on the validity issue in respect of the rights held as "obviously invalid" in the course of examination, trial, administrative action or civil action. The followings are the facts we revealed in the course of our study of the cases as described above, and then our proposals retrievable from the facts we found:

- By analyzing the decisions made on the conflict concerning the invalidity issue on the basis of each right, it was revealed that one-thirds of those rights were invalidated by those decisions. We found no substantial difference between the decisions of the Patent Office and those of the courts at the level of the invalidation trials. Therefore, it seems that the difference of the decisions on validity issue are caused by the difference of the quality of the evidence submitted at the examination level and those submitted at the invalidation trial level, in other words, the difference between the examination procedure that mainly focuses on patent or utility model publication documents and the invalidation trial procedure that also takes account of the public knowledge and public use (i.e. the plea on the ground of "obviously invalid" right).

- The right holder, Patent Office and the courts should acknowledge the fact as specified above, and the right holder should, prior to the exercising of its right, confirm the validity of such right by itself, while the Patent Office and the courts should actively exchange information which they have notwithstanding their legally independent positions as an administration agency and as a judicial institution, respectively. Further, the Patent Office should accumulate as data the sources of evidence submitted at the litigation, under which the inventive step was the material issue, so that such data can be exploited in the course of examination procedure in the future.

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