

from the patenting of non-substitutable upstream technology, pointing out that smooth utilization of upstream technology patents is desired so that such patents will not hinder industrial progress including the development of pharmaceutical products and enhancement of public welfare, which could be achieved as a result of research activities. Also, in order to solve these problems, study was conducted on taking various practicable measures under the current patent system as well as establishing, through reform of the current system or creation of a new system, an enforceable system that is acceptable from the perspective of balancing with rights.

This study indicates the necessity to build a system in which basic research will not be disturbed by patenting, while taking into consideration recent changes in the subject matters of inventions.

[This article appeared on pp. 1307-1315 of “*CHIZAI KANRI*” (Intellectual Property Management), Vol. 54, No. 9 (2004).]

Cross-Border Patent Enforcement Against Infringement over the Internet

The Third Subcommittee,
The Second Patent Committee

An act on the Internet has its particularity in the fact that its effect arises in places different from the place where the act was conducted. However, patents will become substantively valueless if borders based on the “principle of territoriality” exist in the patent system and it is possible to escape patent infringement by simply setting up a server overseas. For example, in the case of methods of services, the effect of a Japanese patent should be extended to patent infringement over the Internet even if a server is installed outside Japan or a terminal of a service provider is outside Japan, so long as a customer’s terminal exists within Japan. However, there is the constraint requiring that the act conducted by a server or a terminal be described as a constituent feature in the claims. Therefore, it is necessary to proactively consider cross-border patent enforcement, which would enable applying Japanese patents even to cases where not all of the constituent features in the claims are satisfied in Japan.

This report summarizes the idea of cross-border patent enforcement in Japan, the United States and Europe, respectively. In addition, this report examines claims that can be set up against a third party when a server is installed overseas, in terms of Japan, the United States and Europe, in light of the idea of cross-border patent enforcement in each country, thereby showing guidelines for patent practitioners who prepare specifications. Lastly, this report also considers the ideal method of cross-border patent enforcement in Japan.

[This article appeared on pp. 1441-1451 of “*CHIZAI KANRI*” (Intellectual Property Management), Vol. 54, No. 10 (2004).]