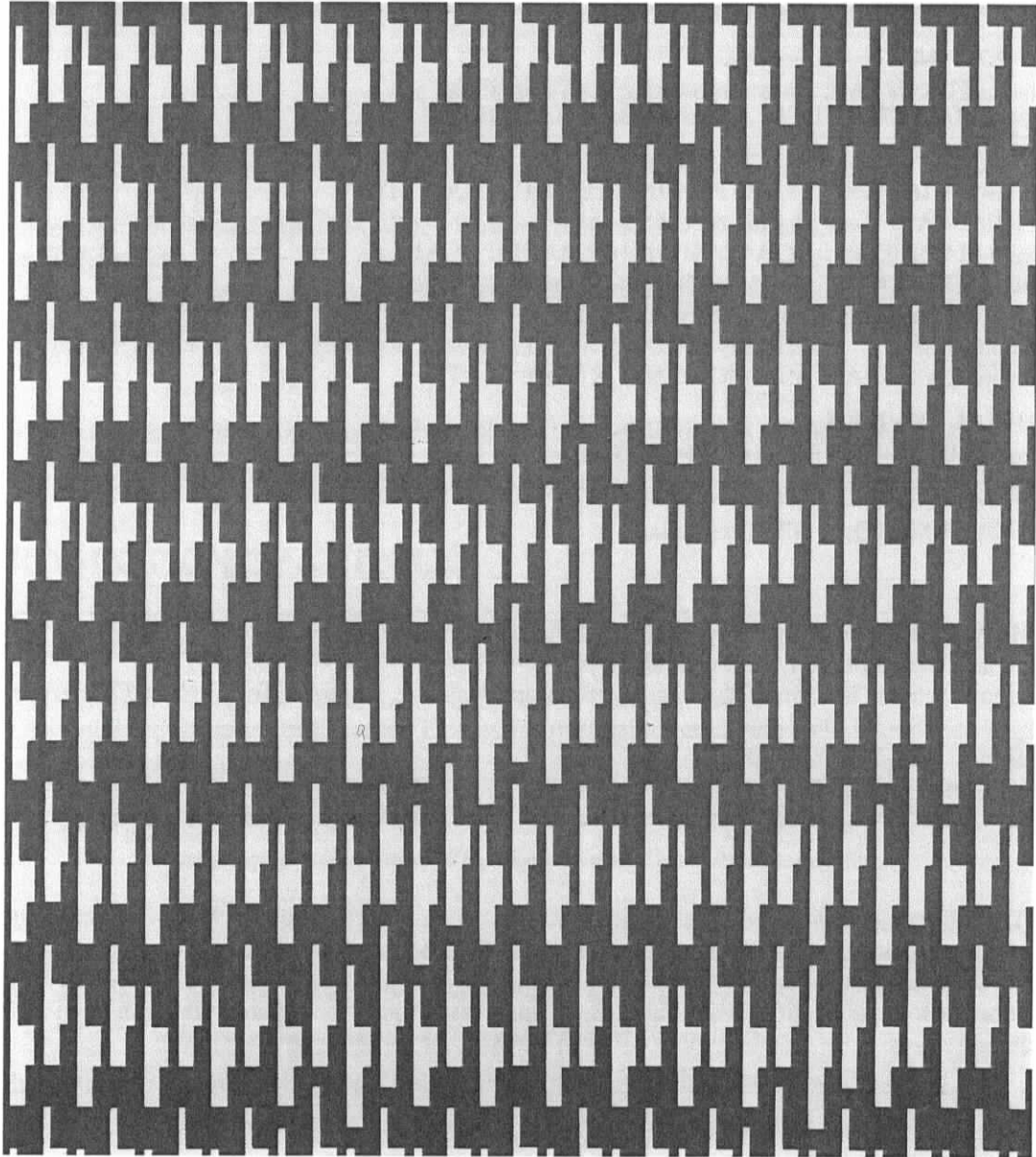


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Study on the Doctrine of Abuse of Right On the Ground of Invalidity of Patent*

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(Abstract)

In the past, the authority to judge validity of patents has been believed to belong, exclusively, to the Patent Office, and courts hearing infringement cases never challenged such judgments of patent jurisdiction. However, after the Supreme Court's decision of April 11, 2000 in the case of Fujitsu vs. Texas Instruments (Case No. (O)-364, 1998), there has been a surge in the movement of the courts adopting more forward-looking attitude for judging the validity of patents in infringement lawsuits. In this paper, the author first explains, from the standpoints of the Japanese Constitution and the Administrative Law, a traditional framework based on the law system that the Patent Office has an exclusive authority to judge the validity of patent, then, discusses the legal position of the Supreme Court's decision. Based on cases after the Supreme Court's decision, the author reviews the scope of the requirement: "it must be evident that there exists a reason for invalidity in a patent" (hereinafter referred to as "evident existence of invalidity") for the doctrine of abuse of right to be applicable, which is believed to be a requirement most important in this coursing patent litigation practice.

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1. Backgrounds of the Japanese Law System Why the Validity of Patents Was Not Considered by Courts in Infringement Lawsuits

While a court has an authority to take a substantial part in determining the validity of a

patent in an action of annulment of the trial decision (administrative suit), it may not judge the validity of a patent in a patent infringement trial (civil suit). Why?

With this regard, we may develop a discussion from the standpoints of the Japanese Constitution and the Administrative Law.

As known, the principle of "Separation of Three Powers" offers a division of the governmental power into three parts, Judiciary, Legislative and Executive. The basic idea underlying this principle is to have them check each other, thereby to maintain the power balance in order to prevent the concentration of the powers, and in turn, to protect the liberty of the citizens. It includes the following aspects; (1) having the powers mutually isolated; and (2) having the powers check each other.

In a case of an action of annulment of a trial decision, the aspect "(2) having the powers check each other" is emphasized. That is, by allowing the Judiciary to ultimately determine the legitimacy of an administrative disposition (in this case, a patent proceeding) of the Executive, the Patent Office as one agency of the Ex-

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ective is checked.

The capability of the Judiciary to ultimately determine the legitimacy of actions taken by any of the governmental powers including the agencies of the Executive is the principle derived from the following two Japanese constitutional provisions.

The Constitution of Japan, Article 76, Paragraph 1

The whole judicial power is vested in a Supreme Court and in such lower courts as are established by law.

The Constitution of Japan, Article 76, Paragraph 2

...nor shall any organ or agency of the Executive be given final judicial power.

These two provisions lead a conclusion that, although any agency of the Executive has jurisdiction (in the case of patent, it may make decisions to grant patents, decisions in trials, and decisions of rejection), any of those decisions made by the agency of the Executive shall never be a final decision (Article 76, paragraph 2), and such final decisions may only be made by the Judiciary which consists of the Supreme Court and the lower courts.

An action of annulment of a trial decision, in deed, is an action that follows the idea derived from this concept, and such an action is exactly where the Judiciary comes in to judge the legitimacy of the decision of the Patent Office. As long as the annulment of trial decisions have such a nature, the consistency of the principle of "Separation of Three Powers" and the concept of Article 76 of the Constitution of Japan cannot be maintained unless jurisdiction to a given extent is permitted to the courts in the dispute over Patent Office's decision on patent validity.

On the other hand, in patent infringement lawsuits, the other aspect of the "Separation of Three Powers" principle, "(1) having the powers isolated from each other" is emphasized. This is because a patent infringement lawsuit is a dispute that arises between private entities (enterprises). In the light of legal stability, it is desirable to simply examine the existence or non-existence of a certain right claimed by the plaintiff under the legal state formed by a decision of an office of the Executive. To explain this in

relation with a patent infringement lawsuit, it is obviously more desirable in terms of legal stability for a patent infringement trial to be proceeded to find the existence or non-existence of a claimed right contested in the trial (subject matter) such as a right to require injunction or a right to claim compensation for damages by arguing whether or not the accused product falls within the technical scope, or the existence of the plea based on prior internal use etc. under the legal state, which assumes that there exists the patent right as determined through the grant of the patent by the office of the Executive. If the patent right itself, which exists as the precondition for the infringement trial, is invalidated through the patent infringement trial, which is a civil suit, such decision would be deemed as an undue interference by the Judiciary against the decision of the office of the Executive, and it is considered to be undesirable in the light of the "Separation of Three Powers" principle.

This idea in patent infringement lawsuits is called "tentative validity". More particularly, the tentative validity is a kind of administrative disposition which has a binding force unless an authorized government agency officially cancels it. As long as the disposition for the patent is an administrative disposition of the Executive, it has the tentative validity. Unless an authorized government office, the Patent Office in this case, officially cancels the disposition through a proceeding called a trial for invalidity, the disposition still works in the infringement lawsuit in principle and continues to have the power to bind.

The reason why the argument of patent validity had never been permitted in patent infringement suits before is because Japanese Patent Office (JPO)'s decision has the tentative validity. Its decision to grant a patent is a kind of administrative dispositions so that the decision should have the tentative validity. To override the tentative validity requires to file a request for a formal procedure (in the case of a patent, trial for invalidity of the patent) to JPO.

However, an important exception for the tentative validity had been long established in the Administrative Law which has seldom been applied to patent infringement lawsuit before following Supreme Court decision. That is, "where there is a serious and evident defect in an

administrative disposition, any citizen may claim for invalidity of the disposition in a normal civil action without formal proceedings.”¹⁾ That means, the tentative validity can be denied under a given condition, that is “the existence of a serious and evident defect.” From the perspective of the Administrative Law, any decision to grant a patent or any trial thereof is one form of administrative dispositions. When “a serious and clear defect” exists in the content of the disposition, one doesn’t need to require to file a request for a trial for invalidity of the patent. One should have claim for the invalidity of the administrative disposition (grant of the patent or trial thereof) during the course of a patent infringement proceeding

2. Interpretation of the Decision by The Third Petty Bench of The Supreme Court on April 11, 2000

According to the above understanding based on the Administrative Law, the Supreme Court decision on April 11, 2000 (Case No. (wo)-364, 1998) is positioned as an instance. The decision was made under the presumption that the patent is invalid in the civil proceeding, acknowledging “a serious and evident defect” in the patent. Following is a replication of the essential part of the decision.

Therefore, it should be proper to construe that the court which examines a case of infringement of a patent right may judge on whether or not it is evident that there exists a reason for invalidity, before the PTO’s trial decision of invalidity of the patent becomes final and conclusive. When it is clear that there exists a reason for invalidity in the patent as a result of court’s examination, it is reasonable to construe that demand for injunction and compensatory damages, etc. based on the patent right should not be permitted by reason of the abuse of rights, unless there is any special circumstance. This interpretation does not contradict the purpose of the patent system. The precedents rendered by the Daishinin (Former Supreme Court), including the Daishinin’s decisions under Case No. Meiji-36 (Re) No. 2662 on September 15, 1903, recorded in the Criminal Cases Decision Report Vol. 10, page

1679, and of Taisho-5 (O) No. 1033 on April 23, 1917 recorded in the Civil Cases Decision Report Vol. 23, page 654, having views different from the aforementioned view of this court, shall be altered to the extent that interferes with the foregoing.

To sum up, the conclusion of the Supreme Court may be summarized in the following two points.

- (1) evident existence of a reason for invalidity in a patent may be judged whether an evident reason for invalidity in a patent exists or not may be judged even before the JPO’s trial decision for invalidity of the patent becomes final and conclusive.
- (2) According to the above point (1), when it is evident that there exists a reason for invalidity in the patent, the demand for injunction or compensatory damages etc. based on the patent right is, in principle, not permitted by reason of the abuse of rights.

The point (1) is only saying that the court examining a patent infringement case can judge “whether or not it is evident that there exists a reason for invalidity in the patent”, in other words, “whether or not there exists a serious and evident defect.” It is merely a matter of course in the light of the Administrative Law.

Similarly, for the point (2), it is only an application of the prior understanding of the Administrative Law, saying that decision may be made in a civil lawsuit under a presumption that the patent is invalid when there exists “a serious and evident defect” in the patent disposition. However, hitherto, as for a plea to argue the existence of a reason for invalidity in a patent, any other jurisprudential theory such as a plea based on public domain technology or the doctrine of embodiments limitation etc. has normally been used, thus, this decision has a certain academic significance in that it adopted the doctrine of abuse of right as the ground for the decision.

It should especially be noted that, the decision of the Supreme Court is consistent with the Administrative Law. The new requirement “evident existence of invalidity” which may strike those who are engaged in the patent practice as an unexpected requirement shall rather be considered well balanced and readily acceptable since it is consistent with the Administrative Law.

3. Case Study on the Doctrine of Abuse of Right

The Supreme Court, however, did not give a clear definition of the requirement of "evident existence of invalidity". On what condition, can we say, "it is evident that there exists a reason for invalidity in a patent"? Is it distinguished by the provision applied to decide invalidity? Although these points are quite important in litigation practice, at present, we have no choice but only to wait for more cases to be accumulated. However, after the above decision was made, many of the decisions by lower courts had led dismissal of appeal by the reasons of abuse of rights, finding the requirement of "evident existence of invalidity" being met.

In this paper, the author intends to clarify the scope of the requirement, "evident existence of invalidity", by reviewing the decisions given by the lower courts after the Supreme Court decision.

3.1 Cases before the Supreme Court Decision

There are several decisions made by lower courts prior to the aforementioned Supreme Court decision, which applied the doctrine of abuse of right as stating such cases fulfill the requirement of "evident existence of invalidity". Following two are the representative examples.

- (1) Osaka District Court Decision; September 2, 1999

(Case No. (WA)-4216, 1996)

The S-6000 type, which is an article exploiting the subject invention, had already been manufactured and sold by the plaintiff prior to at least the claimed priority date, July 4, 1981, thus it is found that the content of the subject invention had been in a state that it could easily have been known to a person with ordinary skill in the art. ... (Omitted)...

Therefore, the subject invention is found to have been publicly practiced by the plaintiff prior to the claimed priority date, July 4, 1981, and it is clear that the invention could not be patented under the provisions of Patent Law Section 29(1)(ii) and Section 43(2)(i) and the first clause of Paris Convention Article 4(B). It

is also clear that the subject patent shall be invalidated through proceedings for invalidity of the patent under the provision of Patent Law Section 123(1)(ii). Therefore, the plaintiff's demand for injunction of the accused article and for compensation of damages by the defendant, Miura, under the subject patent right shall be deemed as abuse of the right.

- (2) Tokyo District Court; February 29, 2000
(Case No. (wa)-7356, 1996)

It is proper to construe that there exists a reason for invalidity in the subject utility model registration since the subject device shall be deemed as a publicly known in Japan prior to the filing date of the application of the subject utility model registration by the reason that the same specification had been offered to Toppan Printing Co., Ltd.

As clear from Fact 5, which is not disputed, the subject specification is the one prepared by simply attaching the figures as issued by the plaintiff to the defendant, thus it is proper to understand that the plaintiff had known that the constitution of an apparatus in the other case might have been disclosed by Toppan Printing. Therefore, it is proper to interpret that the plaintiff had filed the application of the subject utility model registration, knowing that the subject device had already been publicly known in Japan prior to the application as a result of the very action of the plaintiff itself, and now is enforcing the utility model right.

As stated above, from the fact that there exists a reason for invalidity in the subject utility model and recognition that the plaintiff had known the reason since such the reason was a result from the very action of the plaintiff itself, the demand for injunction and compensatory damages under the subject utility model right shall not be permitted by the reason of abuse of the right.

As clear from the above, in either of the lower court decisions given prior to the Supreme Court decision referred that publicly practiced through sales and assignment meant "evident reason for invalidity". The only one exception is the original decision (Tokyo High Court: Case No. (ne)-3790, 1994) of the subject Supreme Court's decision. This is presumably because, when making a judgement based on the fact of

“publicly practiced prior to an application”, the judgement does not require a high degree of patent practice expertise such as comparison with the scope of claims etc. The fact findings, such as “when it was being sold” lead the conclusion. The procedure of the evidence examination and fact finding is substantially the same as regular civil lawsuits, where judges can make a definite judgement on the “evident existence of invalidity”.

3.2 Trend after the Supreme Court Decision

The decisions made after the aforementioned Supreme Court decision are summarized in Table 1. Hereinafter, the points of the decisions are discussed with reference to some extractions from the decisions (i) or (iii) listed in the table. (The underlines are the ones provided by the author.)

Table 1

Date of Decision	Court	Provision Applied	Summary of Decision	Case No.	Ref. #
7/14/2000	Tokyo District	29(1)(ii)	Found the fact of public working due to the fact of assignment prior to patent application	(WA)23184 1996	
8/31/2000	Tokyo District	—	Arguments by concerned parties only: Judgment not made	(WA)16782 1996	
8/31/2000	Tokyo District	—	Arguments by concerned parties only: Judgment not made	(WA)7865 1998	
9/5/2000	Osaka District	29(1)(ii)	<ul style="list-style-type: none"> • Found the fact of public working due to the fact of assignment prior to the application • Found no duty of secrecy merely from the reason that the parties were engaged in business transactions 	(WA)1064 2000	
9/19/2000	Tokyo District	—	Arguments by concerned parties only: Judgment not made	(WA)15083 1998	
9/19/2000	Osaka District	29(1)(ii)		(WA)4084 1997	
9/26/2000	Osaka District	—	Arguments by concerned parties only: Judgment not made	(WA)5189 1996	
9/27/2000	Tokyo District	29(2)	<ul style="list-style-type: none"> • Found that the two different points were readily conceivable by combining the descriptions of two prior art technical documents (same technical field) 	(WA)25701 1998	(i)
10/24/2000	Osaka District	29(2) ex-36(4)	<ul style="list-style-type: none"> • Claims do not include the description of features indispensable for the constitution of the invention • The deficiency may not be resolved even if correction is made • The subject invention is the one which excludes a certain constituent feature of the cited invention, thus, even if there is no description on the exclusion of such a constituent feature from that cited invention, the subject invention is deemed identical to the cited invention 	(WA)12109 1996	(ii)
11/28/2000	Tokyo District	29(2)	<ul style="list-style-type: none"> • Found that the subject invention having three different points was readily conceivable by combining four cited documents • The co-pending trial decision of the dismissal for invalidity has been cancelled 	(WA)25294 1998	(iii)

- (i) Tokyo District Court; September 27, 2000 (29 Civil Department; Case No. (wa)-25701, 1998)

In 38-2 of Defendant Evidence 7 [an article entitled "Kochi-shi Kanda-ponpujo Zousei-koji ni Tomonau Daishindo Soirusemento Renzokuheki Koho (Deep Soil Cement Continuous Wall Method in Kanda Pump Facility Construction in Kochi City)" in "Kisokoh, April" (pp.36-43, April 1981)], all the claimed elements of the subject invention, except for the following two, are explicitly described. That is, the above document does not necessarily describe, explicitly, two points: (1) from Constituent Feature D of the subject invention, "before the wall constructing material hardens, a hole is excavated for the placement of the next pile in a manner that the next pile partially overlaps with the current pile at a given angle including 0 degree relative to the current pile by the rotation of the boring machine. At the same time the wall construction material is poured", the feature that it is achieved by "rotatably configuring the parallel arrangement of augers" (the interpretation of which is later described); and (2) from Constituent Feature C of the subject invention, "While keep mixing the wall construction material by maintaining the ejection of the hardening solution and rotation of the boring machine, the boring machine is retracted in the upward direction from the pile", the feature that it is performed by "maintaining" the ejection of the hardening solution and the rotation.

However, Proof B: 38-9 "Tyuretsu-Shiki Chika Renzokuheki Koho (Column Type Underground Continuous Wall Method)" (Authored by Kazutoshi Kajiwara: Kashima Shuppankai; January 31, 1983) describes a method in which the corner sections of the site is constructed by providing a given angle (90°) including 0° through combining the parallel rotational movements of augers resulted from the rotation of the base machine (it corresponds to the rotation of the boring machine in the subject invention) and the rotation of the rotary leader (Fig. 6, 55) (it is evident that the "rotation of the rotary leader" described therein represents the "parallel rotational movements of the augers"). It is clearly indicated that this is achieved through rotationally moving the parallel arrangement of the augers. Furthermore, the same evidence

describes "... further, the triaxial cone is retracted in the upward direction at a predetermined retraction rate (normally, 1.5m/min) while maintaining the ejection of the cement solution...", and "the amount being mixed and ejected at the time of retraction was adjusted to approximately 90L/min to pore in the total amount intended. The relationship between the boring cycle of one element and the amount pored is shown in Fig. 6.89." The above description indicates that it employs the technical means in which "after the wall construction material is pored into the pile, the boring machine is retracted in the upward direction from the pile while mixing the wall construction material by maintaining the ejection of the cement solution (hardening agent) and rotation of the boring machine" (it is technically obvious that the rotation is maintained).

In the light of each of the above descriptions, the subject invention may be deemed to be easily conceived by a person with ordinary skill in the art based on the above proofs, thus, it is clear that there exists a reason for invalidity in the subject invention under Patent Law Section 29(2).

This decision mainly referred Proof B7 38-2 [an article entitled "Kochi-shi Kanda-ponpujo Zousei-koji ni Tomonau Daishindo Soirusemento Renzokuheki Koho" (Deep Soil Cement Continuous Wall Method in Kanda Pump Facility Construction in Kochi City) in "Kisokoh, April" (pp.36-43, April 1981)], and it found the above points (1) and (2) as differences, and these two points are shown in the other evidence, Proof B 38-9, "Tyuretsu-Shiki Chika Renzokuheki Koho" (Column Type Underground Continuous Wall Method) (Authored by Kazutoshi Kajiwara: Kashima Shuppankai; January 31, 1983). The decision held that the subject invention is to be easily invented by a person with ordinary skill in the art since all the claimed elements are described in the materials pertinent to the same technical field and they could have been readily combined.

While this decision still leaves much to be desired as it failed to discuss on the difficulty of logic to reach the combination which is adopted by the Patent Office, in general, it matches with the criteria of inventive step used in the Patent Office, so that we may say that this instance had

the "evident existence of a reason for invalidity".

- (ii) Osaka District Court; October 24, 2000
(Case No. (WA)-12109, 1996)

Under the old Patent Law Section 36(4) (requirement for description of features indispensable for the constitution of the invention), in order for the invention pertinent to Right 1 to be deemed as an invention which resolves the above technical problems and provides the above effects, it is understood that the description of "the feature for preventing yeast from losing its fermentation power through reaction with water before a kneading process starts" must be included in the scope of claim. The detailed description of the invention in the specification written for Subject Patent 1 is found to include the description of such a feature, as it explains, "to prevent yeast from losing its fermentation power through reaction with water before kneading starts, (1) yeast, bread ingredients and warm water are introduced in this sequence into a bread baking container, (2) warm water, bread ingredients and yeast are introduced in this sequence into a bread baking container, or (3) a mixture of bread ingredients and yeast, and warm water are introduced in this sequence into a bread baking container." On the other hand Claims 1 and 2 merely describe the introduction of bread ingredients, yeast and water into a single bread baking container, and neither claim includes description of any means to prevent yeast from losing its fermentation power through reaction with water before the kneading process starts. Therefore, the description of either claim 1 or 2 of Subject Patent 1 does not include the description of only features indispensable for the constitution of the invention, thus it is found to be violating the provision of former Patent Law Section 36(4).

Former Patent Law Section 29-2 is applicable, not only when the subject invention is identical to any invention or device described in the claim of a prior patent or utility model application, but also when it is identical to any invention or device which is merely described in elsewhere of the specification or indicated in figures of the prior application. In the latter case, the determination on what sort of invention (device) is described in the specification or figures of the prior application as an independ-

ently-organized invention (device), should substantially be discussed from the viewpoint of a person having ordinary skill in the art."

(Omitted)

"When Invention 1(1) and Device 2 of a prior application, and Invention 1(2) and Device 3 of a prior application are compared respectively, besides the difference in wording, there found one difference in that, while Inventions 1(1) and 1(2) include claim element of "not comprising means to detect the temperature of the ingredients introduced in the ingredient container", Devices 2 and 3 of the prior applications do not exactly include such a feature. However, in the light of the technical significance of Devices 2 and 3 of the prior applications previously mentioned, it is proper to construe that these devices are ones which may either include or exclude the "means for detecting the temperature of the ingredients introduced into the ingredient container". Therefore, even if the presence of the feature, "not comprising means to detect the temperature of the ingredients introduced into the ingredient container", is accounted, it shall be construed that Invention 1(1) is included in Device 2, and Invention 1(2) is included in Device 3, of a prior application respectively.

One may view that there would be a unique technical significance in the subject invention since the particular provision of the limitation such as the one in Inventions 1(1) and 1(2) would simplify the structure as the ingredient-temperature-detecting means is not provided. However, this is an obvious effect and may be considered as an effect already contemplated in Devices 2 and 3 which cover those embodiments comprising no ingredient-temperature-detecting means. Also, no other effect can be expected from the above limitation, thus, the above limitation shall be deemed to have no particular technical significance.

Even under the presumption that the correction requested by the amendment on August 19, 1996 is legitimate, Invention 1(1) and Device 2, and Invention 1(2) and Device 3 shall have to be deemed as identical, respectively.

In view of the foregoing, it is proper to construe that there evidently exists a reason for invalidity in the patent pertinent to Right 1, for both Inventions 1(1) and 1(2) under the provisions of old Patent Law Section 123(1)(i) and

Section 29-2."

This decision has a substantial significance in that it concluded "there evidently exists a reason for invalidity" based on "lack of description of features indispensable for the constitution of the invention in the scope of claim (ex-Section 36(4))", which is extremely technical in terms of patent practice. The decision pointed out that, although the sequence (above sequences (1) through (3)) is extremely important in order to achieve the effect of the invention, the claim only prescribes on "introducing bread ingredients, yeast and water into a single bread baking container", and such description lacking sequential element does not specify the feature for preventing the possibility of "yeast to lose its fermentation power by reacting with water before a kneading process starts" (meaning that the effect of the invention cannot be achieved). This is relatively a clear-cut logic. However, this is probably the first instance where a court decision has ever ventured this far with regard to the claiming practice.

Further noticeable point in this decision is that, the judgement was discussed the possibility of amendment, and recognized the incapability of such an amendment to resolve the deficiency even after the judgement was made. No matter what corrections are made, they would never be able to meet the requirement for such an amendment. Considering that it was a legal judgement, and is not a matter governed by adversary system. The judgement with regard to "evident existence of invalidity" is probably possible. However, we may say that this instance is one that substantially intruded into the premises of the patent practice.

With regard to the judgment under Section 29-2, it recognized the difference that the subject invention included the negative feature of "not comprising means to detect the temperature of the ingredients introduced into the ingredient container" while Devices 2 and 3 do not include any explicit description of such a feature. It also concluded that it is proper to construe these Devices 2 and 3 as ones that may either include or exclude the "means to detect the temperature of the ingredients introduced into the ingredient container" in the light of the technical significance of Devices 2 and 3, thus the subject invention is included in the devices

of the prior applications. The author believes that this decision is probably the first instance, which recognized abuse of the right on the ground under Section 29-2.

(iii) Tokyo District Court; November 28, 2000
(46 Civil Department: Case No. (wa)-25294, 1998)

With regard to this instance, a claim pertinent to the subject invention is referenced in explaining the point of the decision in order to avoid causing unnecessary complexity by citing the decision.

- A. A scaffolding laid or suspended between horizontal supporting members such as beams to allow workers to walk or do various works thereon;
- B. said scaffolding comprising a main scaffolding structure and a sub scaffolding structure which is attached to one end or each end of said main scaffolding structure in a retractable and extendable manner;
- C. said main scaffolding structure including a hollow frame body constituted by a top wall, a bottom wall, an inner trunk body and an outer trunk body, an opening being provided in the inner side of said frame body which extends in the longitudinal direction;
- D. said sub scaffolding structure being held inside of, and along said frame body of said main scaffolding structure in a manner that its length can be adjusted, said sub scaffolding structure including a frame longer than the vertical dimension of said opening;
- E. (1) to the inner side of said frame body of said main scaffolding structure, (2) a platform having its top surface sloped at one end is provided in the horizontal direction;
- F. (1) to the inner side of said frame body of said sub scaffolding structure, a platform which is extendable through said opening in a horizontal direction is provided;
- G. (3) foldable handrails being provided to said frame bodies of said main and sub scaffolding structures in the longitudinal direction or along the shorter sides on the upper side of the platform;
- H. said scaffolding being extendable and retractable.

Table 2
Difference Between The Invention and The UK Patent

Difference	Subject Invention	Cited Reference UK Spec.	Other Cited Reference
(1)	There exist part of Feature E and Feature F, "to the inner side of the frame body of the main scaffolding structure, a platform is provided horizontally", and "to the inner side of the frame body of the sub scaffolding structure, a platform which is extendable through the opening is provided in the horizontal direction"	There is no description	<ul style="list-style-type: none"> • It is suggested by the description of the UK spec. • It is disclosed in Proof A8 and A9 within Proof B3
(2)	There exist part of Feature E, "a platform having its top surface sloped at one end"	Different in that it is described, "the top surface of a horizontal member provided on one end between the frames of the main scaffolding structure is sloped"	<ul style="list-style-type: none"> • It is described in Proof A7 within Proof B3
(3)	There exist Feature G, "foldable hand-rails being provided to said frame bodies of said main and sub scaffolding structures in the longitudinal direction or along the shorter sides on the upper side of the platform"	There is no description	<ul style="list-style-type: none"> • It is described in Proof A6 within Proof B3

The differences in the above claim from the UK patent specification that was mainly cited are listed in Table 2. Following is the summary thereof.

That is, as an essence of this decision, it first acknowledged three different points between the disclosure of UK patent specification (the main cited document) and the subject invention, and as for the first difference, the decision acknowledged the fact that the trial decision of the dismissal of invalidity had been reversed as a result of a suit against that trial decision, and as shown in Table 2, by citing the descriptions of 5 documents against the three differences, the decision held that these differences could have been easily conceived respectively, and for the combination of these claimed elements, the court found "no reason to believe that it had been difficult for a person having ordinary skill in the art to combine the claimed elements of the subject inventions 1 and 2", and the decision concluded that the grant of the subject patent had been a violation of the provision of Sec-

tion 29(2), concluding it evident that there exists a reason for invalidity.

Not only that this decision totally lacks the reasoning why "it had been easy to combine those cited documents", but also developed an unusual style of logic, "the three points that differ from the main cited document could have been easily conceived by combining the total of four prior art documents", which perhaps would never occur in the present practice of the Patent Office, therefore it is believed that such the decision, in terms of the style, would not match the judgment criteria for inventive steps adopted by the Patent Office. The impact of this decision over the practice of judgment on inventive steps by the Patent Office is unknown.

However, as it is significant in this decision, it has become more obvious that the courts started assuming the forward-looking attitude for judging patentability in infringement lawsuits. Evidently, the handling of lawsuits will hereinafter require more consideration over this point.

4. Requirement of "Evident Existence of Invalidity"

In view of the trend of the above cases and points in the individual decisions, the requirement, "evident existence of invalidity", may be summarized as follows.

- (1) Before the Supreme Court decision was given, dominant instances were those finding the existence of a reason for invalidity based on the fact that a subject article had been publicly practiced prior to the application of a patent. It is presumably because the certification process of the fact of "publicly practiced" is similar to the certification process of evidence in a normal litigation procedure, thus judges can write their decisions with confidence.
- (2) The tendency of decisions in those cases after the Supreme Court decision is obviously different. Unprecedented reasons for invalidity, such as those requiring a high degree of patent practice expertise are adopted on the basis of the provisions of Sections 29(2), 29-2 and 36(4), showing more active, forward-looking attitude of courts examining infringement cases for judging patentability.

As a conclusion, with regard to those courts examining infringement cases, judgment on the validity of patents and the requirement, "evident existence of invalidity", the following can be said:

- (1) A court examining an infringement case shall judge the patentability in principle. For example, the attitude of courts examining infringement cases dominant 10 years ago had been as follows. (The underline is the one provided by the author.)
"The argument by the defendant alleged as a ground for abuse of right is, in short, that the subject patent can be invalid since the subject invention lacks novelty or inventive steps because of high probability. However, the validity of a patent is an issue that shall be disputed through a trial for invalidity in Patent Office, and even if the subject patent is, in deed, the one that shall

be invalidated, the court shall have to handle the subject patent as being valid, until such a trial for invalidity of the subject patent is demanded and the decision for invalidity of the subject patent becomes final and conclusive. The court shall merely order the suspension of the proceedings, if it is deemed necessary, until the trial decision has become final and conclusive (Japanese Patent law Section 168(2)). As the above, in the proceedings of a trial for injunction under a patent right, the validity or invalidity of the patent shall not be considered, thus, in the light of this point, the argument by the defendant asserting the invalidity of the subject patent shall be deemed as a plea based on no ground." (Case No. (wa)-25294, 1998; (iii) in Table 1)

However, as previously mentioned, such the attitude has become the one in the past. We may see that the attitude of those courts examining infringement cases has switched to judge more actively on patentability.

- (2) Unlike the precedents, there now is an actual benefit in arguing, whatever the reason is, invalidity of a patent of the court. Before the Supreme Court decision was given, the reasons that were worth arguing in a court examining an infringement case were significantly limited. The reasons were mainly consisting of the fact of "public practice". When reviewing those decisions given after the Supreme Court decision however, the courts acknowledged those highly technical and specialized reasons for invalidity based on the provisions of Section 29-2 as well as ex-Sections 36(4) and 29(2). Thus we may say that now, there substantially is no reason for invalidity that would not be judged by courts.
- (3) In the light of the aforementioned tentative validity (expertise of administrative dispositions), it is still highly probable in the actual operation. The judgement on the validity of a patent is left to a trial for invalidation by Patent Office as before from the ground that "it is not evident that there exists a reason for invalidity" when the pat-

ent is highly technical.

However, as mentioned in the earlier part of this discussion from the standpoint of the Constitution and Administrative Law, it is clear that the authority to judge the validity of an administrative disposition by the Executive involving such expertise belongs, in principle, exclusively to an agency of the Executive. The author believes that this fundamental principle shall not be altered.

In reviewing instances of the cases, those instances that acknowledged the doctrine of abuse of right from the reasons that involve a high degree of patent practice expertise pertain to the arts are not highly technological. In consideration with the harmonization between the administrative law system and the actual operation in lawsuits, the author presumes that, in those cases involving extremely high technologies such as those pertinent to the fields of semiconductor, computer science, chemistry, and biotechnology etc. Future judgments on the validity of patents would be made mainly through trials for invalidity in the Patent Office as before, and those courts examining infringement cases would strain themselves from making such judgments.

Footnote:

- 1) The tentative validity is given to an act by the Executive, and even if there is a defect therein, it is not deemed to invalid immediately, until an authorized government agency formally cancels it. This is because, since the judgment on the existence

of such a defect requires technical determination to a certain degree, if the individual citizens had the right to disregard such the act as they determine the act as being invalid at their own discretion, the effectiveness of the Executive can be damaged as the individual judgments by the citizens can be different from one person to another. Accordingly, the current law provides that the judgments on the existence or non-existence of such defects are to be made uniformly by a special agency through a careful procedure, and until such the special agency formally cancels it, any concerned parties shall have to comply with the act by the Executive, thus to stabilize the order of administration. When the ground of the tentative validity is considered in this way, if an act by the Executive violates an important requirement associated with the essence of the system, and if it is clear that such observation is objectively, and unquestionably correct, there would be no problem in leaving the judgment on the existence of the defect to ordinary individuals without waiting for the special government agency to make its decision. Thus, when there is a serious defect in an act of the Executive, and such the defect can be easily recognized at once by ordinary people, it is considered that the act may be exceptionally viewed as invalid, and finding of such may be left to normal litigation proceedings. [Naohiko Harada, "*Gyosei-Ho Yoron* (Essentials of the Administrative Law)" 3rd Edition, p.154; 1994: *Gakuyo Shobo*]

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