

Table of Contents

Preface	V
Authors.....	XIX
Abbreviations	XXI
Selected Bibliography	XXIII

Part 1

Survey

I. The European Patent litigation system	1
1. National patent enforcement	1
a) Forum shopping.....	1
b) Overview of the German judicial system for patent infringement procedure.....	2
aa) Court system.	2
bb) Procedure	2
cc) The dual system.....	3
dd) Time to trial.....	4
ee) Likelihood of success	4
ff) Final remedies in case of infringement	4
(1) Injunctions.....	4
(2) Damages and account of profits.....	5
(3) Removal and destruction.	5
(4) Costs.....	5
c) Utility Model Proceedings	6
2. Cross-border enforcement and “torpedo actions”	8
3. The Unitary Patent system	9
a) Status of reforms.....	9
b) Prosecution of Unitary Patents.....	10
c) Court system	10
d) Enforcement of Unitary Patents.....	11
e) Transitional Period for European Patents (EPs)	12
f) Judges and Attorneys	12
II. The Japanese patent litigation system	13
1. Overview of Japanese judicial system for patent infringement procedure	13
a) “Double track” system and concentration of jurisdiction for patent disputes	13
b) Number of patent litigations in Japan – Statistics	15
2. Overview of Japanese court procedure for patent infringement cases.....	16
a) Litigation fee and attorney’s reward.....	16
b) Complaint.....	16
c) Course of proceedings	17
d) Judgements	18
e) Appeals	18
III. The US patent litigation system	20
1. The Leahy-Smith America Invents Acts (AIA)	20

Part 2

Matter of Infringement

I. Germany	25
1. Scope of protection.....	25
a) Literal and non-literal infringement.....	25
b) Doctrine of equivalents.....	26

aa) Requirements of equivalents.....	26
bb) "Formstein Defense".....	27
c) Basic principles for the determination of the scope of protection.....	28
aa) The wording of claims.....	28
bb) Description, drawings and Prior Art.....	28
cc) The person skilled in the art is relevant for claim interpretation.....	29
dd) File history.....	29
ee) The effect of emphasizing particular features of a patent claim in the description.....	30
ff) The extent of protection of a patent claim containing numerical data and ranges.....	30
gg) Time of equivalence determination.....	31
hh) Doctrine of renunciation.....	31
2. Direct patent infringement.....	32
a) Product patents.....	32
aa) Manufacturing.....	32
bb) Offering.....	33
cc) Putting on the market.....	33
dd) Using.....	33
ee) Importing.....	33
ff) Possessing.....	33
b) Process patents.....	33
aa) Working and usage procedures.....	33
bb) Manufacturing process.....	33
c) Product by process patents.....	34
3. Indirect patent infringement.....	34
a) General principles.....	34
b) Material requirements.....	35
aa) Offer/Delivery of means in Germany.....	35
bb) Essential element of the invention.....	35
cc) Objective aptitude for direct infringement.....	36
dd) Customer's designation for infringing application.....	36
ee) Offerer's/supplier's intention.....	37
ff) Double reference to German territory.....	37
II. Japan.....	38
1. Scope of protection of the patent in action.....	38
a) Literal scope of claim.....	38
aa) Description and drawings.....	38
bb) Prior art.....	39
cc) Prosecution history.....	39
(1) Prosecution history as a means for interpretation.....	39
(2) Prosecution history as a reason for estoppel.....	40
b) Doctrine of equivalents.....	40
aa) "Ball Spline" judgement.....	40
bb) Requirement No. 1 – replacement of unessential element.....	41
cc) Requirement No. 2 – identical function and effect despite replacement.....	44
dd) Requirement No. 3 – obviousness of replacement at the time of infringing.....	44
ee) Requirement No. 4 – objection of free technology.....	44
ff) Requirement No. 5 – objection of intentional exclusion.....	44
gg) Patented inventions containing numerical ranges.....	46
2. Direct infringement.....	46
3. Indirect infringement.....	49
a) Old types of provisions against indirect infringements.....	49
b) New types of provisions against indirect infringements.....	50
c) Indirect infringement in the practice.....	51

III. USA	52
1. Scope of Protection	52
a) The Wording of the Claims	52
b) Claim Interpretation	52
2. Direct Patent Infringement	53
a) Requirements of Equivalents	53
b) Time of Equivalents Determination	54
c) Equivalency and the Prior Art	54
d) Equivalency and File History Estoppel	54
3. Indirect Patent Infringement—Active Inducement	55
a) Active Inducement	55
b) Contributory Infringement	55
c) Infringement through the Supply of Components From United States For Combinations Made Abroad	56
d) Infringement By Sale, Offer for Sale, Use or Importation of a Product Made Outside the United States by a Patented Process	56
4. Types of Patents	57
a) Product Patents	57
b) Process Patents	57
c) Product by Process Patent	57

Part 3

Claims of the Patent Holder and Objections of the Infringer

I. Legal basis for claims	59
1. Germany	59
a) Injunctive relief	59
aa) Criticism on the principle of “automatic” injunctions	59
bb) Proportionality reservation for injunctions in case of patent infringement	60
cc) Motives of the legislator	60
dd) Future Practice	61
b) Rendering account	61
c) Obligation to pay damages	62
aa) Claims	62
bb) Damages proceedings	62
cc) Fault	62
dd) Calculation of damages	63
(1) Patentee’s lost profits	63
(2) Infringer’s profits	63
(3) Reasonable royalties	64
(4) Relations between the calculation methods and punitive damages	64
d) Disclosure of the source of origin and of purchasers	64
e) Destruction	65
f) Removal and recall of infringing goods	65
g) Costs	65
2. Japan	66
a) Claim for injunction	66
aa) Patent holder	66
bb) Licensee	66
cc) Restriction of claim for injunction	67
b) Claim for compensation for damages	67
aa) Overview	67
(1) Legal basis of claim for compensation of damages caused by infringement	67
(2) Claimant for compensation for damages	67
(3) Judicial practice for claiming the compensation for damages	68
(4) Prerequisites for claiming the compensation of damages	68
bb) Calculation of damages	68
(1) Patent holder’s lost profits	69
(2) Patent holder’s profits estimated from the quantity of infringer’s products	69

(3) Patent infringer's profits.....	71
(4) Licence analogy	72
(5) Relations between these alternatives for calculation of damages.....	72
c) Claim for compensation for the use of an opened invention before grant of patent	74
d) Other claims.....	74
aa) Procedural claims for submission of documents	74
bb) Claim for measures preventing further infringement.....	74
cc) Claim for costs.....	75
3. USA.....	75
a) Injunctive Relief	75
b) Accounting and Monetary Relief	76
c) Obligation to Pay Damages	78
d) Disclosure of the Source of Origin and of Purchasers.....	78
e) Destruction of Infringing Goods.....	79
f) Removal of Infringing Goods	79
g) Costs.....	80
h) Award of Attorney's Fees.....	80
II. Objections in patent litigation.....	82
1. Germany	82
a) License agreement, compulsory license, anti-trust defence	82
aa) License agreement	82
bb) Compulsory license.....	82
cc) FRAND defence.....	84
b) Revocation action and the dual system	85
c) Prior use right.....	86
d) Test privilege.....	88
aa) Research privilege.....	88
(1) Legal provision	88
(2) Research on the subject matter.....	88
(3) Economic purposes of research	89
(4) Abuse of privilege	89
(5) Research tools	89
(6) Outsourced research.....	89
(7) Third party support.....	89
bb) Bolar exemption	90
e) Statute of limitation.....	90
f) Laches	91
g) Exhaustion.....	91
h) Grace periods	92
2. Japan	92
a) License	92
aa) License agreement	92
bb) Non-exclusive licenses granted by the Commissioner of the Patent Office etc.	93
cc) Legal licenses	93
(1) Types of legal licenses.....	93
(2) Legal license based upon a prior use.....	94
b) Validity of invention	95
aa) Change of dual system – <i>Kilby</i> patent case.....	95
bb) Countermeasure of patent holders – correction	97
cc) Delay of procedure and the amendment of the Japanese Patent Act 2011.....	98
c) Restrictions of patent rights	99
aa) Expiration of patent rights.....	99
bb) Private uses	102
cc) Experimental purposes.....	102
dd) Restriction of exercise patent right against passing vessels or aircrafts	103
ee) Medical treatments.....	103
ff) Exhaustion of patent right	104

gg) Parallel import	105
hh) Abuse of patent rights.....	106
ii) FRAND.....	106
d) Statute of limitation.....	106
3. USA.....	107
a) Defenses – In General.....	107
aa) Written Description Requirement.....	107
bb) Enablement.....	108
cc) Inventorship.....	108
dd) Inequitable Conduct.....	108
b) Anti-Trust Defense.....	109
c) Licenses	110
d) Invalidation, (Prior Art) and Parallel Patent Office Proceedings.....	111
aa) Section 101 and Anticipation and Section 102 Statutory Bars	111
bb) Anticipation and Other Section 102 Statutory Bars.....	112
cc) Obviousness (35 U.S.C. § 103) and Person of Ordinary Skill	114
dd) Level of Ordinary Skill	117
ee) Scope and Content of the Prior Art	117
ff) Challenges Outside the United States Court System	117
e) The Key AIA procedures are:	118
aa) Supplemental Examination	118
bb) IPR.....	119
cc) Post Grant Review (PGR)	120
dd) Contested Business Methods (CBM) Proceeding.....	120
ee) Prior Use Rights	120
ff) Experimental Use	120
gg) Statute of Limitation.....	121
hh) Laches.....	121
ii) Equitable Estoppel.....	122
jj) Prosecution Laches.....	122
kk) Unclean Hands	122

Part 4 Fact Finding

I. Germany	125
1. Test-purchase.....	125
2. Product analysis and private expertises.....	125
3. Inspection claim.....	126
4. Seizure by customs authorities	127
5. Information claim.....	127
6. Investigation by public prosecutors.....	128
7. Professional confidentiality obligations	128
II. Japan	129
1. Test purchase	129
2. Product analyses and private expertises	129
3. Procedural measures for collecting information about infringement.....	130
a) Preservation of evidence.....	130
aa) Prerequisites and proceeding for preservation of evidences	130
bb) Preservation of documents.....	130
b) Disposition of collection of evidence before filing an action	131
4. Seizure by customs authorities	131
5. Investigation by public prosecutors.....	132
III. USA	133
1. Pre-Filing Investigation (FRCP Rule 11).....	133
2. Product Analysis	133
3. Pre-Filing Discovery.....	134

4. Seizure by Custom Authorities.....	134
5. Government Participation In The Proceedings.....	135

Part 5 Pre-procedural Measures

I. Pre-procedural measures of the patent holder.....	137
1. Germany	137
a) Warning letter due to patent infringement	137
aa) Practical and judicial meaning.....	137
bb) Unauthorized warning	138
cc) Use-by-periods.....	138
b) Preliminary injunctions.....	138
aa) A survey of summary proceedings in patent law	138
bb) Procedural principles in PI proceedings.....	139
(1) Competence of patent chambers.....	139
(2) Two instances	139
(3) Arms equality.....	139
cc) Requirements.....	140
(1) Infringement	140
(2) Validity of the patent of disposal.....	140
(3) Urgency	141
(4) Proportionality.....	142
dd) Enforcement and remedies	142
(1) Opposition	142
(2) Constitutional interim order	142
(3) Request to bring main action.....	142
(4) Final Statement.....	143
(5) Request to cancel the PI.....	143
(6) Judgement and Appeal	143
ee) Damages	143
2. Japan	143
a) Warning	143
b) Preliminary injunction.....	144
aa) Preliminary injunction as a provisional remedy.....	145
bb) Characters of a preliminary injunction	145
cc) Material prerequisites for an order of a preliminary injunction.....	146
dd) Procedure	146
(1) Jurisdiction	146
(2) Petition	147
(3) Relation of a preliminary injunction with an ordinary injunction	147
(4) Hearing.....	148
(5) Proof with prima facie evidences	148
ee) Decision and objection.....	149
(1) Dismissal of a petition and immediate appeal	149
(2) Issue of an order for a preliminary injunction, objection and appeal.....	150
ff) Revocation of a preliminary injunction	151
3. USA	151
a) Warning Letter	151
b) Injunctive Relief	152
II. Pre-Procedural measures of the alleged infringer.....	154
1. Germany	154
a) Negative declaratory action and counter-warning.....	154
b) Protective letter	154
aa) Background.....	154
bb) Rationale.....	154
cc) Electronic Register.....	155
dd) Practical Issues.....	155

c) Application for issuing injunctive relief due to unauthorized patent marking.....	156
d) ANTI-SUIT-INJUNCTIONS	156
aa) Anit-suit-injunction in multi-national patent litigation.....	156
bb) Admissibility of ASIs under German law?.....	157
cc) Anti-ASIs as defensive strategy.....	157
dd) Basis of claims.....	157
ee) Legal interest	157
ff) Jurisdiction.....	158
gg) Outlook.....	158
e) Anti-Divisional-Game-Injunctions	158
2. Japan	159
a) Counter warning	159
aa) Counter warning based on a patent	159
bb) Counter warning based on an unfair competition.....	159
b) Protective letter	161
c) Declaratory judgement	161
3. USA	162
a) Counter-Warning/Protective Letter.....	162
b) Opinions of Counsel	163
c) Declaratory Judgment Proceedings.....	163
d) Request for Injunctive Relief Due to Unauthorized Claim of Patent Rights.....	164

Part 6 Infringement Proceedings

I. Germany	165
1. Jurisdiction and courts	165
2. Parties and participants to the proceedings.....	165
a) The parties.....	165
b) Standing to litigate.....	165
aa) The registered Patent holder	165
bb) Several patent owners.....	166
cc) Exclusive licensee	167
dd) Non-exclusive licensee	167
c) The defendant's standing to be sued.....	168
aa) Alleged infringers	168
bb) Two or more infringers	168
cc) Managing directors.....	169
d) Attorneys of record	169
e) Experts.....	169
aa) Court experts.....	169
bb) Party-appointed expert	170
f) Third party intervention	170
3. Procedure.....	171
a) Filing the complaint	171
b) Reply to a complaint.....	172
c) Oral hearing.....	172
d) Judgement, appeal and provisional execution.....	172
e) Procedural guidelines of the court.....	173
II. Japan	175
1. Jurisdiction	175
a) International jurisdiction and governing law.....	175
aa) Injunction claim	175
bb) Claims for compensation of damages	176
b) National jurisdiction	178
aa) Jurisdiction for the first instance	178
bb) Jurisdiction for the second instance.....	178
cc) Jurisdiction for the final instance.....	178

2. Parties to the proceeding	179
a) Courts	179
b) Parties	179
aa) Plaintiffs	179
(1) Existence of an effective patent right	179
(2) Transfer of patent rights	180
(3) Registered exclusive licensee	180
bb) Defendants	181
cc) Representatives of civil procedure	182
dd) Experts	182
(1) Expert witnesses	182
(2) Judicial research officials for technical matters	183
(3) Technical advisors	183
(4) Inspectors	183
ee) Third parties	184
3. Procedural steps	184
a) Filing a complaint by a plaintiff	184
b) Service of a complaint to the defendant	185
c) Answer of the defendant to a complaint	186
d) Begin of oral proceeding	186
e) Preparatory proceeding	186
aa) Preparatory proceeding for recognising infringement	187
bb) Preparatory proceeding for calculation of damages	187
f) Conclusion of oral proceeding	187
g) Judgement	188
aa) Judgement recognising infringement	188
bb) Judgement denying infringement	188
h) Appeal to the Japanese Intellectual Property High Court	188
i) Final appeal to the Japanese Supreme Court	189
III. USA	191
1. Jurisdiction	191
2. Parties to the Proceedings	192
a) Court	192
b) Necessary and Permissible Parties	192
c) Rights of Action	193
d) Adding of Additional Parties	193
e) Representatives	193
f) Experts	194
g) Third Party Participation	194
3. Procedure	195
a) Filing of the Complaint	195
b) Answer to the Complaint	195
c) Proceedings Leading to the Decision of the Court	196
d) Motion Practice and Oral Hearings	197
e) Trial, Judgment and Appeal	198

Part 7 Procedural Principles

I. Germany	199
1. The dual system	199
a) Separation of infringement and nullity proceedings	199
b) Reform discussions	199
c) “One Track” system for Utility Models	200
2. The principle of party control	201
a) Substantive motions	201
aa) Subject-matter of the motions	201
bb) The principle of the binding nature of the application	202

b) Commencement and termination of the proceedings.....	202
aa) Bringing a suit.....	202
bb) Withdrawal of action.....	202
cc) Acceptance.....	203
dd) Settlement.....	203
c) Changes in the factual and legal situations	203
aa) Change of party	203
bb) Invalidation or restriction of the patent-in-suit.....	204
3. Adversarial system	206
4. Investigative principle and judicial information obligation	206
5. The legal judge	207
6. Right to be heard and “arms equality”	208
7. Oral presentation, publicity and secrecy	208
8. Burden of demonstration and burden of proof.....	209
a) Extent of the burden of demonstration and proof	209
b) Exemption of certain facts from the burden of proof.....	210
c) Shifting of the burden of proof.....	211
d) Taking of evidence and means of evidence	212
9. The principle of concentration	213
10. Liability of the losing party to pay the costs	213
a) Cost risk	213
b) Value of the matter in dispute.....	214
11. The Principle of Territoriality.....	215
a) Basic principles.....	215
b) Production of parts in Germany but assembly abroad.....	216
c) Completion of a process by third parties abroad.....	216
d) Offers from and to a foreign country	217
e) Exhibitions on a fair.....	217
f) Internet offers	217
g) Transit of infringing goods.....	218
h) Participation Abroad.....	218
II. Japan	220
1. “Double Track” system.....	220
a) Separation system before the judgement in 2000.....	220
b) Introduction of “Double Track” system by the judgement in 2000	220
c) Contradiction between courts’ judgements and the JPO’s decisions.....	221
d) Invalidation of patent after the final and binding judgement.....	221
e) Discussion to reform the “Double Track” system.....	221
2. Principle of party disposition.....	222
a) Substantive motions	222
aa) Specification of claims.....	222
(1) Discretion of a patent holder to specify the claims	222
(2) Initiative of an alleged infringer	223
(3) Specification of the objects of claim.....	223
bb) Specification of parties	224
b) Party’s discretion for ending the procedure	224
aa) Withdrawal of action.....	224
(1) Prerequisites of withdrawal of action.....	224
(2) Effect of withdrawal of action	225
(3) Practical meaning of withdrawal of action	225
bb) Waiver of claim	225
cc) Acknowledgment of claim	226
dd) Amicable settlement within a judicial procedure	226
3. Principle of party presentation	227
a) Responsibilities of parties to state facts and to submit proofs.....	227
b) Exceptions to the principle of party presentation.....	227
aa) Interpretation and application of laws	227
bb) Procedural requirements for filing an action.....	228

cc) Progress of proceedings	228
dd) Subsidiary authority of courts to collect evidences	229
4. Judicial information obligation	229
5. Legal judges	230
6. Principles of orality and publicity	231
a) Principles of orality and publicity for civil procedures	231
b) Exceptions in the practice of patent infringement cases	231
aa) Suitableness for preparatory proceedings	231
bb) Limitation of opening records containing trade secrets to the public	232
cc) Protective order	232
(1) Prerequisites for protective order	233
(2) Legal results from protective order	233
dd) Suspension of opening the examination of parties to the public	234
7. Burden of demonstration and burden of proof	234
a) Burden of demonstration	234
b) Burden of proof	235
aa) Burden of proof for literal infringement	235
bb) Burden of proof for equivalent infringement	235
cc) Burden of proof for compensation of damages	235
c) Procedural measures easing the burden of proof related to infringement	236
aa) Obligation of an alleged infringer to present the exploiting forms	236
bb) Presumption of exploiting patented process from identification of products	236
cc) Order to submit documents related to infringement	236
dd) Order to submit a subject matter of observation	237
ee) Inspection after filing a patent infringement law suit	237
d) Procedural measures easing the burden of proof related to calculation damage	238
aa) Order to submit documents related to damages	238
bb) Presumption of the amount of damages	239
cc) Determination of damages for portion beyond rights-holder's production/sales capacity	239
dd) Obligation of infringer to explain the facts for the calculation of damages	239
ee) Recognition of reasonable amount of damages	240
8. Maxim of concentration of examination of witnesses and parties	240
9. Liability of the losing party to pay the costs	240
III. USA	242
1. All Matters Before the Court	242
a) Substantive Motions	242
b) Procedural Motions	242
2. Adversarial System	243
3. Discovery	243
4. The Court and the Judge and Their Roles	244
5. The Jury and Their Role	244
6. Public Trials and Right to be Heard	245
7. Publicity	246
8. Burden of Proof	246
a) Preponderance of the Evidence	246
b) Clear and Convincing	246
c) Taking of Evidence and Means of Evidence	247
aa) Pre-Trial Discovery Testimony	247
bb) Evidence Outside The United States	247
cc) Evidence At Trial	248
9. Costs	249

Part 8
Comparative aspects of law and practice

I. Territoriality	251
II. Courts	252
III. Jury and Judges	252
IV. Evidence and burden of demonstration and proof	252
1. Pretrial discovery	252
2. Depositions	253
3. Experts	254
4. Inspections	255
V. Claim construction	255
VI. Direct and Indirect infringement	255
VII. Validity objection	256
VIII. Compulsory Licensing	257
IX. Experimental use and Bolar exemption	257
X. Injunctions	257
XI. Preliminary Injunctions	258
XII. Anti-Suit-Injunctions	259
XIII. Damages	259
XIV. Costs	259
Index	261