

Class No.6: Invention and Law

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* Significance of leaning on Invention and Law

1 “Invention and Law”—Legal Protection of Invention

*Two routes regarding the legal protection of invention

(i) Legal protection by obtaining a patent right through applying for one

(ii) Legal protection as a trade secret (by concealing the know-how) without patent application

(1) Legal protection covered in the Patent Law

(2) Protection as a trade secret under the Unfair Competition Prevention Law

(Incidentally, as for a computer program, there is another protection under the Copyright Law.)

2 Intellectual Property and Intellectual Property Law

Incorporeal thing (information) –intellectual property (invention, literary work, trademark) –intellectual property rights (patent right, copyright, trademark rights) –Intellectual Property Law
Corporeal thing –proprietary rights –civil law

Incorporeal thing (information) –non-exclusivity
Corporeal thing –exclusivity

Intellectual Property Law = a law for intellectual property rights
+ Unfair Competition Prevention Law

3 Legal Protection under Patent Law

(1) Requisites for patent

Inventiveness (Art. 2, para.1) –use of natural laws –software, business method, related to living thing

Industrial application potency (Art. 29, Chapeau of para. 1) – medical practice

Newness (Art.29, para.1), progressivity (Art. 29, para.2), (first to file: Art.39) –first-to-file system (except the U.S.) ↔ first-to-invent system (U.S.)

Requisites for recording (procedural) (Art.36)

(2) Procedural aspect and organizational aspect

▪ Procedural aspect

(administration and administrative litigation routes –as to a patent right's birth, change, termination) application – examination –decision- action for nullity of the decision (civil suit route regarding a patent right) (patent right) infringement suit

▪ Judicial machinery of the state

Japan Patent Office (examination, decision (quasi-judicial)) and a law court (action for nullity of the decision, infringement suit)

*Various kinds of mixture

Mixture of public law with private

Mixture of administration with judiciary

Mixture of substance with procedure

(3) About patent right

▪ Birth of a patent right (patent evaluation + establishment registration), termination (confirmation of judgment on invalidity, etc.)

▪ Validity of a patent right

- Infringement of a patent right –infringement of wording (claim) and doctrine of equivalents
- Relief of infringement of a patent right - the right to request injunction, a claim for damages –these relief proceedings being a patent-infringement lawsuit (punishment –charge of patent infringement –criminal suit)
- About invalidity of a patent –Art. 123 and Art. 104-3 –biggest disputed point in the Patent Law

4 Regarding Employee Invention (Art. 35, the Patent Law)

- Employee invention and a reasonable compensation
- Dry patent-infringement lawsuit (· action for nullity of the decision) and a wet lawsuit of a claim for reasonable compensation

5 Protection as Trade Secret under Unfair Competition Prevention Law

- Unfairly competitive deed (Art.2, para.1, items 4-9) regarding a trade secret (Art. 2, para.6)
- Right to request injunction and a claim for damages
- However, there is a risk that, if somebody else (a parallel inventor) files for a patent, the right goes to the patent applicant (a first-to-file system). Nonetheless, by fulfilling the requisite said in Art.79 of the Patent Law, the original party is able to obtain the right of prior use (an ordinary license to use a patented invention) and continue the implementation. ■