REQUESTS OR OPINIONS

Request for Enhancement of Correspondence to Intellectual Property Litigations*

Japan Intellectual Property Association (JIPA)

On March 5, 2002, we, Japan Intellectual Property Association (JIPA) have sent the following request letter to Civil/Personnel Litigation Law Committee, Legislative Council, the Ministry of Justice of Japan.

1. Expert Commissioner

1.1 Necessity of Expert Commissioner in Patent Infringement Litigation

(1) Basically, where a case require expertise, it is thought to be necessary in the viewpoint of securing expertise in a patent (or the like) infringement litigation to provide the Expert Commissioner System, mentioned in the recommendation of the Justice System Reform Council, so as to have an expert involved in the proceedings and organized the point at issue or evidence etc.

(2) It is true that there is an opinion pointing out the defect of current judicial system such as the difficulty of maintaining the neutrality of the experts in the case of a medical mistake litigation etc. At least in patent (or the like) infringement litigations, defendant and plaintiff usually have the same background and things are different from those cases always taking a monolithic form such as a medical mistake litigation between a victim and a doctor who have different backgrounds. Accordingly, we believe that an expert commissioner keeps his/her neutrality relatively easier in an infringement litigation of a patent etc. So that it is possible to directly reflect the advantages of providing supports of expertise to the court that the Justice System Reform Council's written recommendation originally intended. For the both parties in the litigation, too, it is extremely beneficial since the expert's support would help avoiding the court to make technical mistakes, so that, at least from this point of view, there is no reason to make an objection against the introduction of the expert commissioner system in those litigations of patent (or the like) infringement.

1.2 The Scope of the Right of Expert Commissioners and the Securement of Equitability

(1) Where specialized knowledge and experiences are required such as litigation of a patent (or the like) infringement, an expert commissioner shall organize the points at issue and evidence, and, in other proceedings, assist the judges.

(2) An expert commissioner shall be able to directly question witnesses and concerned parties.

(3) An expert commissioner shall be able to state an oral or written opinion within a set period

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of time upon the request of the court. Furthermore, the concerned parties shall be granted a chance to make a counterargument against that opinion.

(4) An expert commissioner shall, upon the court's request, be able to state an oral or written opinion outside the set period of time.

* Since the expert commissioner system is introduced on the precondition that the expert commissioner himself has sufficient knowledge of the technology at issue. It is essential for the expert commissioner and concerned parties to share the recognition through technical discussions, thus they have to secure the opportunity to discuss/argue with the expert commissioner's opinions. On the other hand, an expert commissioner may involve in the decision making with the judges as their assistant (in a case where the concerned parties cannot make direct refutation against the expert commissioner's opinion since the opinion has the value equivalent to the judges), but in such a case also, explanation and discussion shall be thoroughly made by the both parties before the expert commissioner to an extent that the both parties can come to believe that the expert commissioner sufficiently understood the technical problems at issue and views of the both parties before a certain level of conviction is formed.

(5) The expulsion and challenge procedure against expert commissioners shall comply with those for judges. Based on the nature of expert commissioner's position, significant lack of knowledge and understanding of subject matters shall serve as a reason for the challenge.

1.3 Merger between the Securement of Neutrality of Expert Commissioners and the Examiner System

(1) As for the source of Expert Commissioners in those infringement litigations of patents etc., examiners of the Patent Office are thought to be suitable from the viewpoint of securement of neutrality. Also, when appointing an expert commissioner, his or her position shall be guaranteed as an official of the court.

(2) Furthermore, in an infringement litigation of a patent etc., examiner system has been used in the courts, so that by making these examiners constitute expert commissioners (or by clarifying the examiner system so as to be able to grant examiners the right and obligation equivalent to those given to expert commissioners, and use this system as an organization alternative to the expert commissioner system), various measures shall be implemented for smooth operation of intellectual property litigations with regard to the source of expert commissioners and securement of their neutrality through the adoption of the expert commissioner system. It is therefore believed that the practical discrepancy within this area can be minimized.

2. Expert Testimony

2.1 Handling of the Expert Testimony

(1) With regard to expert witnesses, unlike the one-question-on-answer system that has been practiced to date, an expert witness shall be given a chance to explain the evaluation of the problems at issue based on his/her expertise knowledge. Through this explanation, the judges may be able to correctly understand the opinion of the expert witness with regard to the subject technology, and concerned parties may be able to assess the understanding of the expert witness of the subject technology.

(2) When a concerned party has doubts in the expert testimony, the party shall be given a chance to question and direct discussion with the expert witness in order to improve the technical accuracy of

the testimony result.

(3) When a concerned party has doubt in the expert testimony which is expressed outside the court, the party shall be given a chance to ask the expert witness further evaluation or direct discussion with him/her.

2.2 Additional Note: Support of Experts by Concerned Parties

(1) As the background why we pursue the chance for concerned parties to refute against experts' opinions in Chapters 1 and 2 of the present written request, there is a recognition that the knowledge and understanding of the technology at issue in any litigation that experts have are generally not as much as what the concerned parties have. Accordingly, it is believed that even an expert needs some sort of assistance, even though the extent of which may vary, to obtain knowledge that is necessary and sufficient to make decision on the point at issue. To this end, it is desirable for the both parties concerned to guide the expert to a common understanding with regard to the subject technologies. It should be appreciated that, to grant concerned parties to refute against the opinion of an expert is to promote an effect that the expert is guided to the accurate technical presumption which serves as the basis of the both parties.

3. Exclusive Jurisdiction of Tokyo/Osaka District Court and Tokyo High Court

(1) In order to secure the speed and accuracy of trials, the exclusive jurisdiction of Tokyo and Osaka District Courts should be stipulated. [Although there will be a problem of access to the Courts, the public interest of the ability to make right judgments based on expertise shall put ahead of accessibility issue.]

(2) From the viewpoint of securement of expertise and coherency of case studies in the cases of appeals, the Tokyo High Court shall take a role of the appeal court of the cases of patents etc. Especially, unified function of infringement cases relevant to patents etc. should be granted to the High Court in the same manner as Court of Appeals for the Federal Circuit of the US.

(3) Litigations pertinent to Copyright, Trademark, Design and Unfair Competition Prevention Laws, requiring expertise, should come under the jurisdiction of Tokyo District Court or Osaka District Court in order to secure the speed and accuracy of the proceedings, as well as those litigations relevant to the right of holders of copyright, patent right, utility model right, layout-designs of integrated circuits or program works.