

AWARD WINNER 2022

IP Litigation Resolution Law Firm of the Year

The Award Reason;

Hino Law and Patent Office won an IP High Court Judgment in Japan based on an epoch-making calculation system for damages to be compensated, that would lead following IP litigation cases.

An IP owner infringed its right has to further overcome the difficult hurdle of calculating its damages to be compensated after infringement has been proved in IP litigation.

Hino Law and Patent Office won IP litigation succeeding in calculating the damages to be compensated with two unrelated presumptive provisions.

(1) At first, it requested submission order for financial and tax documents based on Civil Procedure Law, and proved infringer's profits under the provision of the said Law.

(2) Next, it succeeded in proving the damage to be compensated based on the profits under the presumption provision of Unfair Competition Prohibition Law, in the following case;

March 30, 2021, Judgment Sentenced.
Intellectual Property High Court
Case Number: 2019 (Heisei 31) (ne) No. 10008
Appellant (Plaintiff) Kitazato Corporation
vs.
Appellee (Defendant): Reprolife Co., Ltd.

The translation of the Judgment is attached here.

This method in the above judgment would be a leading case for calculating the damages to be compensated in IP cases.

References:

Document Submission Order

Article 7(1) Unfair Competition Prevention Law

In litigation involving the infringement of business interests through unfair competition, the court may, on the motion of a party, order the other party to produce any documents necessary for proving the act of infringement or calculating the amount of loss or damage caused by the act of infringement; provided, however, that this does not apply if the holder of the documents has reasonable grounds for refusing to produce them.

Article 105 Paragraph (1) Patent Law

In litigation involving the infringement of a patent or the violation of an exclusive license, the court, at the motion of a party, may order a party to submit documents that are needed to prove the infringement or to calculate the damages caused by the infringement; provided, however, that this does not apply if the person in possession of the document has a legitimate reason for refusing to submit them.

These provisions prescribe that IP owner can request the court order the other party to submit documents necessary to calculate the losses or damages caused by an infringement.

The Result of Not Obeying Document Submission Order

Article 224 Paragraph (1) Civil Litigation Procedure Law

If a party does not comply with an order to submit a document, the court may find the adverse party's allegations concerning the details of said document to be true.

This provision prescribes that if the party requested to submit documents does not obey the court order, the court may admit requesting party's allegation.

Presumption Provisions of the Damages to be Compensated

Article 5 Paragraph (2) Unfair Competition Prevention Law

If a person whose business interests have been infringed on through unfair competition makes a claim for compensation for loss or damage from another person that intentionally or negligently infringed on those business interests, and that other person has made a profit through the act of infringement, the amount of that profit is presumed to be the amount of loss or damage that the person whose business interests were infringed on has suffered.

Article 102 Paragraph (2) Patent Law

If a patentee or exclusive licensee claims compensation for damages that the patentee or licensee personally incurs due to infringement, against a person that, intentionally or due to negligence, infringes the patent or violates the exclusive license, and the infringer has made a profit from the infringement, the amount of that profit is presumed to be the value of damages incurred by the patentee or exclusive licensee.

These provisions prescribe that infringer's profit is presumed to be the damages to be compensated.

受賞理由

知的財産高等裁判所において画期的な損害賠償額算定方法を採用した判決を勝ち取り、同種事例の紛争解決を主導したこと

知的財産を巡る訴訟では、権利侵害が立証された後にも、損害賠償額の算定という困難なハードルを越えなければなりません。

日野法律特許事務所は、文書提出命令を用いて侵害者の利益額算定に成功し、さらに、この利益額から損害賠償額を推定するという2段階の算定を経て、高額の損害賠償を勝ち取りました。

この手法は、広く知的財産の損害賠償事例を主導する裁判における成功例と言え、知財訴訟の損害額算定のリーディング・ケースです。

知的財産高等裁判所令和3年3月30日判決

平成31年(ネ)第10008号

不正競争防止法に基づく差止・損害賠償請求控訴事件

参照条文：

文書提出命令根拠規定

不正競争防止法第7条第1項

「裁判所は、不正競争による営業上の利益の侵害に係る訴訟においては、当事者の申立てにより、当事者に対し、当該侵害行為について立証するため、又は当該侵害の行為による損害の計算をするため必要な書類の提出を命ずることができる。」

特許法第105条1項

「裁判所は、特許権又は専用実施権の侵害に係る訴訟においては、当事者の申立てにより、当事者に対し、当該侵害行為について立証するため、又は当該侵害の行為による損害の計算をするため必要な書類の提出を命ずることができる。ただし、その書類の所持者においてその提出を拒むことについて正当な理由があるときは、この限りでない。」

文書提出命令不履行の効果

民事訴訟法第224条第1項

「当事者が文書提出命令に従わないときは、裁判所は、当該文書の記載に関する相手方の主張を真実と認めることができる。」

損賠賠償額推定規定

不正競争防止法第5条第2項

「不正競争によって営業上の利益を侵害された者が故意又は過失により自己の営業上の利益を侵害した者に対しその侵害により自己が受けた損害の賠償を請求する場合において、その者がその侵害の行為により利益を受けているときは、その利益の額は、その営業上の利益を侵害された者が受けた損害の額と推定する。」

特許法第102条2項

「特許権者又は専用実施権者が故意又は過失により自己の特許権又は専用実施権を侵害した者に対しその侵害により自己が受けた損害の賠償を請求する場合において、その者がその侵害の行為により利益を受けているときは、その利益の額は、特許権者又は専用実施権者が受けた損害の額と推定する。」

以上