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※以下に解答を設置問題順に記入してください。

## 1. INTRODUCTION

The present brief is a summary of a decision of the Intellectual Property High Court (hereinafter referred to as "IPHC") ruled in an appeal hearing of a patent infringement case appealed thereto from the District Court of Tokyo.

### A. Facts of the Case

Canon Inc., the right holder of Japanese patent No.3278410, manufactures ink cartridge (hereinafter referred to as "Canon product") as claimed in claim 1 of the aforesaid patent in accordance with a manufacturing method claimed in claim 10 of said patent and offers the same for sale.

Recycle Assist Co.,Ltd (hereinafter referred to as "RA") is engaged in a business of importing ink cartridges (hereinafter referred to as "RA products") that are obtained by refilling ink in the Canon products which have once been emptied by being under use. The used ink cartridges had been sold by either Canon or its licensees in Japan or in other countries.

Canon sought injunction on the import and sale of the RA products and destruction of said products in possession of RA.

### B. Assertions by the Involved Parties

RA insisted that Canon's patent rights based on said patent have "exhausted" with respect to the RA products manufactured from the Canon products that had been sold in Japan or elsewhere, and as such Canon should not be allowed to exercise its patent rights over RA products.

In response to this, Canon insisted that it would be unjust not to be allowed of exercising its patent rights over the RA products, for the conduct of RA refilling ink in the used Canon products is deemed as using the manufacturing method described in

claim 10 of said patent and manufacturing goods that fall within the technical scope of claim 1.

## 2. DECISION BY IPHC AND GROUNDS THEREFOR

### A. Doctrine of Exhaustion in Regards to Invention of a Product

In cases where the patent holder or its licensee of a patent (for an invention of a product) assign the patented product in Japan, the patent rights therefor are deemed exhausted for accomplishing their purpose. Hence, the patent holder shall no longer be allowed to exercise its patent rights in seeking execution of injunction over the conduct such as use, assigning or leasing of the aforesaid patented goods.

However, in cases where one or more of the below conditions are met, the patent rights shall not be exhausted and as such the patent holder is guaranteed of executing its patent rights.

(i) The patented product is reused or recycled exceeding its ordinary product life (first condition).

(ii) The third party has entirely or in part replaced or reconstructed the essential element(s) in the patented product (second condition).

### B. Application of Doctrine of Exhaustion in This Case

In the present case, the first condition was rendered not having been met.

The Canon product was able to serve again as an ink tank with ink refilled therein, for no physical change nor reconstruction in the elements of the Canon product took place except for that the originally filled ink had been consumed. Thus, IPHC rendered Canon product had not exceeded its ordinary product life at the time when the originally filled ink had been consumed.

On the other hand, the second condition was rendered having been met.

The aim of the invention claimed in claim 1 is to solve the problem which arose in the conventional ink cartridges. The problem at issue here is, as also were in the case of the conventional ink cartridges, to realize stable ink supply and at the same time prevent ink leakage upon opening the ink cartridge.

In order to achieve the above aim, the invention of claim 1 comprises two essential structural features: H and K. The features H and K become lost at some point after ink had been used up and the ink cartridge had been removed from the printer.

When RA cleanses the inside of the ink cartridge of the used Canon product and injects ink therein over a predetermined level, the aforesaid features H and K are restored in the RA product.

Hence, the second condition is thereby met, and the patent right with respect to claim 1 was rendered as not having been exhausted.