

A court case where a patentee's request for on-site inspection was rejected

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[Introduction]

In a patent infringement case before the Tokyo District Court, the patentee filed a request for conducting on-site inspection. The Court rejected this request because the Court found the patent invalid and therefore on-site inspection was not necessary (the Tokyo District Court's judgment of March 30, 2021 (Case No. [2019 \(wa\) 30991](#) (in Japanese))).

[Background]

The Chemours Company FC Limited Liability Company (the "Plaintiff") is the patentee of a Japanese registered patent No. 5,701,205 (the "Patent"). The Patent claims a composition which is used for refrigerants and so forth, and comprises several chemical substances with numerical ranges. AGC K.K. (the "Defendant") manufactures and sells the product "AMOLEA 1234yf" (the "Alleged Infringing Product") to the Plaintiff and other third parties.

The Plaintiff filed with the Tokyo District Court a lawsuit against the Defendant claiming that the Alleged Infringing Products fall within the technical scope of the invention of the Patent and the manufacture and sale of the Alleged Infringing Products constitutes patent infringement. The Defendant argued non-infringement of the Patent as well as invalidity of the Patent.

During the court proceeding, the Plaintiff filed a request for on-site inspection indicating amounts of claimed chemical substances contained in the Alleged Infringing Products which were sold to parties other than the Plaintiff were facts to be proven.

The Court dismissed the Plaintiff's claims, finding that the Patent should be invalidated due to adding new matter during prosecution.

As with the request for on-site inspection filed by the Plaintiff, the Court rejected this request stating that the Patent should be invalidated and cannot be enforced against the Defendant, thus, it is not necessary for the Court to judge the above facts to be proven nor to examine evidence to be obtained by on-site inspection requested by the Plaintiff (no necessity of on-site inspection).

[Comments]

The system of on-site inspection ("*sasho*") was newly introduced by the revision of the Patent Act in 2019 (Articles 105-2 ~ 105-2-10 of the Patent Act). Among court cases which are open to the public, this court case appears to be the first one where the court examined a patentee's request for on-site inspection. In this court case, the request for on-site inspection was rejected because the Patent should be invalidated and thus cannot be enforced, which means one of the requirements for on-site inspection was not satisfied: the necessity of collecting evidence to assess patent infringement must be found (Article 105-2(1) of the Patent Act). Although there are still some uncertainties about on-site inspection, this court case can be of reference when considering filing a request for on-site inspection.

For reference, this case was appealed by the Plaintiff to the IP High Court, but was dismissed (the IP High Court's judgment of November 11, 2021 (Case No. [2021 \(ne\) 10043](#) (in

Japanese))). There is nothing about on-site inspection in the judgment of the IP High Court, which makes it appear that the IP High Court has decided nothing about on-site inspection.

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