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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. About the decision

The following are a summary of a (remarkable) appeal decision made by the Intellectual Property High Court (hereinafter “IP High Court”) on a patent infringement case appealed by the Tokyo District Court to the IP High Court.

### A. Facts

Canon Incorporated (hereinafter “Canon”), the patentee of Japanese Patent No. 3278410, have been manufacturing and selling ink cartridges as recited in claim 1 of the above-referenced patent (hereinafter “Canon product”). The Canon product is manufactured according to the manufacturing method as recited in claim 10 of the patent.

Recycle Assist Co., Ltd. (hereinafter “Recycle Assist”) have been importing ink cartridges completed by refilling a used Canon product with ink (hereinafter “Recycle Assist Product”). The used ink cartridge was originally sold in Japan or overseas by Canon or its licensee.

Canon requested suspension of import and sale of the Recycle Assist Product as well as disposal of remaining Recycle Assist products held by Recycle Assist.

### B. Allegations of the opposing parties

Recycle Assist asserted that, regarding the Recycle Assist product made from the Canon product sold in Japan or the Canon product sold overseas, the patent right of Canon had “exhausted” and Canon should not be permitted to enforce the patent right on its product.

In opposition to the Recycle Assist’s allegation, Canon asserted that Recycle Assist fills a used Canon product with ink, which means that Recycle Assist

manufactured the product covered by the technical scope of claim 1 of the above-referenced patent, according to the manufacturing method as recited in claim 10 of the patent, and therefore, it was unreasonable that Canon was not permitted to enforce the patent right on the Recycle Assist product.

## 2. Decision of the IP High Court and Grounds of the Decision

### A. Doctrine of patent exhaustion for invention of product

In the case where a patentee of a patent (for an invention of a product) or its licensee transfers the patented product in Japan, the patent right is exhausted as the patentee is rewarded by the patent right. Accordingly, the patentee is no more permitted to enforce its patent right by requesting suspension of an act such as use, transfer or rent of the patented product.

In the case, however, where any of the following conditions is satisfied, the patent right is not exhausted and the patentee is permitted to enforce its right:

(i) the patented product is reused or recycled after its ordinary reasonable product lifetime (Condition 1); and

(ii) a third party replaces or reconstructs the whole or a part of the essential part(s) of the patented product (Condition 2).

### B. Application of exhaustion doctrine to the present case

It was held that the present case did not satisfy Condition 1.

The parts of the Canon product were not physically changed or reconstructed except that ink had been consumed. Therefore, the Canon product could be recycled as an ink cartridge by refilling the cartridge with ink. The IP High Court accordingly decided that, at the time when the ink having originally filling the cartridge was consumed, the Canon product had not reached the ordinary reasonable product lifetime.

It was, however, held that the present case satisfied Condition 2.

An object of the invention recited in claim 1 is to solve a problem in the conventional ink cartridges. Specifically, the object is to prevent leakage of ink when the ink cartridge is opened, while achieving the effect of stably supplying ink, which is the same as that of the conventional ink cartridge.

In order to achieve this object, the invention claimed in claim 1 has two essential structural features H and K. These features H and K will be lost some time

after the ink cartridge whose ink has been used is removed from the printer.

At the time when Recycle Assist cleans the inside of the ink cartridge, namely the used Canon product, and fills the cartridge with ink to a level exceeding a certain level indicated in the cartridge, these features H and K are restored into the Recycle Assist product.

It was accordingly held that Condition 2 was satisfied and the patent right for the invention claimed in claim 1 had not been exhausted.