

第 8 回知的財産翻訳検定試験<第 5 回和文英訳>1 級／知財法務実務
【標準解答】

I. INTRODUCTION

This is a summary of a landmark patent infringement case from the Intellectual Property High Court (hereinafter "IPHC"), on appeal from the Tokyo District Court.

A. Facts

Canon, the holder of Patent No. 3278410, manufactures and sells the ink tanks described in Claim 1 of the Patent (hereinafter "Canon products") using the manufacturing process described in Claim 10 of the Patent.

Recycle Assist Co., Ltd. (hereinafter "Recycle Assist") is engaged in importing and selling certain ink tanks by refilling used Canon products with ink (hereinafter "Recycle Assist products"), which are sold in Japan or overseas by Canon or its licensee.

Canon seeks to prevent Recycle Assist from importing and selling Recycle Assist products and to force it to dispose of the products it has.

B. The Parties' Arguments

Recycle Assist argues that Canon should not be allowed to assert the Patent against Recycle Assist products, claiming "exhaustion" of the Patent with respect to Recycle Assist products made from Canon products sold in Japan and with respect to Recycle Assist products made from Canon products sold overseas.

In response, Canon argues that Canon should not be prevented from exercising the Patent against Recycle Assist products because Recycle Assist refills the used Canon products with ink and therefore manufactures products that fall within the technical scope of Claim 1 using the manufacturing process described in Claim 10.

II. Holding and Reasoning of the Court

A. The Doctrine of Patent Exhaustion for a Product Invention

Where the holder of a patent (product invention) or patent licensee has assigned the patented product in Japan, the patent, having fulfilled its purpose,

has been exhausted, and the patent holder is no longer allowed to assert the Patent to seek injunctive relief against acts such as using, assigning, or leasing the patented product.

However, the patent is not exhausted and the patent holder is allowed to assert the Patent when one of the following conditions is met:

- (i) the patented product is reused or recycled after it has reached the end of its ordinary service life as a product (First condition); or
- (ii) a third party has made modifications to or replaced, in whole or in part, the essential components of the patented product (Second condition).

B. Application of the Doctrine to this case

In this case, the First condition has not been met.

No physical change or modification has been made to the components of the Canon products other than use of the filled ink, and the Canon products can be reused as ink containers by refilling them with ink. Therefore, the Court finds that the Canon products have not reached the end of their ordinary service life when the initial ink has been used up.

However, the Second condition is met in this case.

The purpose of the invention of Claim 1 is to solve the conventional problem of ink tanks, that is, ink leakage at the time the ink cartridge is unsealed, while at the same time providing the same effect as that of conventional ink tanks, which is stable ink supply.

In order to fulfill the above mentioned purpose, the invention of Claim 1 contains two essential constituent features, H and K, which are lost after a certain period of time has passed after the ink is used up and the ink tank is taken out of the printer.

When Recycle Assist produces products by cleaning the interiors of the ink tanks of used Canon products and injecting ink into them beyond a certain level, the Recycle Assist products restore Features H and K of Claim 1.

Therefore, the Second condition is met and there is no exhaustion of the Patent for Claim 1.