

# 11 The Roles of the Research Judges of the Japanese Supreme Court in the Intellectual Property Cases<sup>(\*)</sup>

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*Today, the intellectual property cannot be utilized properly to encourage the growth of the Japanese economy. It is because the intellectual property has not yet been appropriately protected. Though the attempt to protect the intellectual property has been succeeded once by the harmonization of the intellectual property laws under TRIPS Agreement, it seems that the intellectual property still needs more protection.*

*The harmonization of the law enforcement is expected to be the next step for the protection of the intellectual property. It is well accepted that the Research Judges of the Japanese Supreme Court can play their effective roles in the intellectual property cases to strengthen the intellectual property protection. Nevertheless, it remains a question whether or not their roles will result to the harmonization of the law enforcement in the intellectual property cases. To prove this doubt, the responsibilities of the Research Judges have been scrutinized with the tasks discovered in the current situation of the intellectual property and the jurisdiction of the intellectual property cases in Japan. It is likely that the Research Judges can play their roles to harmonize the law enforcement in the intellectual property cases. To reach this goal, however, some suggestions have been provided.*

## I Introduction

The intellectual property nowadays plays a significant role in the global economy. However, there are a lot of conflicts concerning the intellectual property as well. One of them is the infringements of the intellectual property. It has to be agreed that, according to the high technology of equipment and the low morality of mankind, infringements have been more complex and worldwide.

There have been several attempted to harmonize the intellectual property laws. Although there is the Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods (TRIPS), it comes to the fact that the intellectual property cannot be properly protected by just having the appropriate laws. There must be the appropriate enforcement of the said laws too.

The Japan Intellectual Property Strategy was introduced under the policy of 'the intellectual property – based nation'. This is the crucial step for Japan in using the intellectual property to encourage her economic growth. However, there seem to be some problems in doing so. The inappropriate protection of the intellectual property has been regarded as the obstruction for

the growth of Japanese economy.

The aim of this research is to examine whether or not the Research Judges of the Japanese Supreme Court can play their roles in harmonizing the law enforcement to protect the intellectual property. It bases on the idea that the harmonization of the law enforcement in the intellectual property cases will be the next step to strengthen the protection for the intellectual property. Therefore, the roles of the Research Judges of the Japanese Supreme Court in the intellectual property cases will be discussed. To fulfill this research, the current situation of the intellectual property and the jurisdiction of the intellectual property cases in Japan will also be scrutinized. Consequently, the result will indicate some fruitful suggestions.

## II The Current Situation of the Intellectual Property in Japan

### 1 The intellectual property in Japan

The Japan Intellectual Property Strategy seems to be a guideline for the country to move towards the successful future. It primarily concentrates upon the creation, protection and exploitation of the intellectual property.

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All types of the intellectual property have been included under this policy. Although the words ‘the industrial property’ and ‘the intellectual property’ have been used in Japan, the four types of the industrial property, i.e. patent, utility model, design, and trade mark are defined as the types of intellectual property.

## **2 The current situation of the intellectual property in Japan**

The current situation of the intellectual property in Japan can be accessed through the Intellectual Property Strategic Program 2009. A lot of measures have been flourished and several measures under the Strategy can be regarded as successful.

Arguably, the Japan Intellectual Property Strategy was introduced by following the ‘pro-patent’ policy of the United States of America. However, it may have to accept that the other type of intellectual property, the so-called ‘Soft Power’,<sup>1</sup> has been gradually important in the industrial areas. Also, there seem to be some problems in the area of the protection of the intellectual property. One problem is the infringements of the intellectual property, both domestic and international areas. The other problem is the situation of patent’s instability. The Japanese Government has worried on the instability and unpredictability of the patent, since the Supreme Court judgment of the ‘kilby’ case.<sup>2</sup>

## **3 Some suggestions: a view from the current situation of intellectual property in Thailand**

The word ‘the intellectual property’ has been used to represent all types of the intellectual property in Thailand. Generally, most of the intellectual property laws in Thailand are *sui generis*.<sup>3</sup>

In Japan, the industrial property is dealt with by the Japan Patent Office (JPO), the Ministry of Economy, Trade and Industry. However, the copyright, the other type of the intellectual property is dealt with by the Agency for Cultural Affairs, the Ministry of Education, Culture, Sports, Science and Technology. It is different from the situation in Thailand where all of the above rights are dealt with by the Department of Intellectual Property (DIP), the Ministry of Commerce.

It is convenient for the Thai Government to run her policy upon the intellectual property issues through this Department. The DIP can

serve as a coordinator in dealing with the other organs, both domestic and international areas, for the intellectual property matters. In contrast, there are several organs concerning with the Japan Intellectual Property Strategy. The Strategy Headquarters has declared that it will perform the overall coordination if the implementation of the measure has been delayed because of the connection of more than one Ministry or agency.<sup>4</sup>

Recently, Thailand has noticed the effect of the ‘pro-patent’ policy. Many patents have been granted during these decades and the patentees have exercised their rights by prohibiting the importation of goods related to their patents or asking for compensations. Civil and criminal cases have been litigated in the courts. These situations may involve with the questions of the invalidity of patent *per se*.

There is no controversial in Thailand related to the ‘double track’ system. According to the Patent Act B.E.2522 (1979), the patent, granted by the DIP, can be revoked on the basis of invalidity by the court’s judgment. Although Thailand is a dual judiciary system, the litigations related to the decisions of the authorities in the patent or trade mark registrations have not been regarded as the administrative cases.

## **III The Jurisdiction of the Intellectual Property cases in Japan**

### **1 The jurisdiction of the intellectual property cases in Japan**

In the Japanese court system, Summary Courts and Family Courts hardly deal with the intellectual property cases. There are three types of courts that usually deal with the intellectual property cases, namely: District Courts; High Courts and the Supreme Court.

#### **(1) District Courts**

In the Japan Intellectual Property Strategy, Japan has put forward the proposal to concentrate jurisdiction for the civil intellectual property cases to the Tokyo District Court and the Osaka District Court. The Code of Civil Procedure was amended in 2003 to introduce specific jurisdiction for these cases. One is exclusive jurisdiction for the certain types of intellectual property. The other is optional jurisdiction for the other types of intellectual property.

The above law provides that the cases related to patent right, utility model right, circuit layout utilization right and author’s right as to the

program work must fall under the jurisdiction of either the Tokyo District Court or the Osaka District Court.<sup>5</sup> However, the civil cases related to design right, trade mark right, author's rights (excluding the author's right as to the program work), publication right, neighboring right, plant breeder's right and cases pertaining to infringements of business interests by unfair competition may be brought either to the Tokyo District Court or the Osaka District Court, or other District Courts which normally have the jurisdiction upon the said cases.<sup>6</sup>

The criminal litigation for the intellectual property case is also available in Japan. The ordinary jurisdiction provided for in the Code of Criminal Procedure will be applied to the intellectual property case.

## **(2) High Courts**

There are eight High courts in Japan, located in the cities in different parts of the country. They have their own territorial jurisdiction over their areas. Furthermore, there are six branches throughout the country, and the Intellectual Property High Court as the special branch of the Tokyo High Court.

## **(3) The Intellectual Property High Court**

The Intellectual Property High Court adjudicates the civil intellectual property cases which have been appealed from District Courts. A quorum of five judges in the Intellectual Property High Court may conduct the case. Furthermore, it will adjudicate the actions against appeal/trial decisions made by the JPO. Its judgments can be appealed to the Supreme Court.

There is no specific jurisdiction for the criminal intellectual property cases appealed from all District Courts. Therefore, the normal jurisdiction under the Code of Criminal Procedure will be applied.

## **(4) The Supreme Court**

The Supreme Court is the highest court in Japan. A quorum of the Justices is either the Grand Bench or the Petty Bench. In practice, a case, if permitted to appeal, will be assigned to the Petty Bench at the beginning. If the case involves a constitutional issue, except when there is a precedent upon the same issue, it will be transferred to the Grand Bench.

## **2 Some comments: a comparison to the litigations of the intellectual property cases in Thailand**

In Thailand, there are two Courts dealing with the intellectual property cases, namely the Central Intellectual Property and International Trade Court (CIP&ITC) and the Supreme Court. Since the other Regional IP&IT Court has not yet been established, the CIP&ITC, nowadays, has the jurisdiction all over the country.

The CIP&ITC deals with both civil and criminal cases related to the intellectual property. In each case, two professional judges and an associate judge will form as a quorum.<sup>7</sup> Furthermore, there are legal officers in assisting the judges to adjudicate the cases. The judge can also appoint an expert to give his or her opinion on the intellectual property case.

In Thailand, the defense of the invalidity of patent has been raised frequently in the criminal cases. Therefore, the judges have to consider the issue of the invalidity of patent in these criminal cases as well. The plaintiffs have to prove whether or not such patents are eligible to be protected by law.

In Japan, if the civil intellectual property cases have not been litigated in the Tokyo District Court or the Osaka District Court, the ordinary jurisdiction provided for in the Code of Civil Procedure will be enforced. It means that the said cases will be litigated in District Courts all over the country. Consequently, the appeals for these cases will go to the other High Courts which have the ordinary jurisdiction under the Code of Civil Procedure over the cases. The jurisdiction for the criminal intellectual property cases is as similar as the other criminal cases in Japan.

## **IV The Roles of the Research Judges of the Japanese Supreme Court in the Intellectual Property Cases**

### **1 A Research Judge of the Japanese Supreme Court**

The title of 'the Research Judge' is not an ordinary position of a Japanese judge.<sup>8</sup> It is a position for a court official, the so-called 'judicial research official' (*Chosakan*). Seemingly, a judge can be assigned to this position because there is no explicit qualification for the judicial research official. Furthermore, the clause that the Supreme

Court may assign a judge to a judicial research official was added as the original Supplementary Provisions (3) of the Court Act since 1949.

### **(1) Qualification**

A Research Judge of the Supreme Court will be assigned from the judges in the inferior courts, due to their skill and experience. Some Research Judges being in charge with the civil matters are selected because of their knowledge and experience in the intellectual property laws. They will deal with the intellectual property cases in the Supreme Court.

### **(2) Further training**

As the intellectual property laws are selective subjects in the universities, the judges may have never had the knowledge related to these laws before. The Legal Training and Research Institute (LTRI) will provide several programs to support the assistant judges and the judges to be able to handle their work properly. The judges can choose to attend the training for the intellectual property cases as their Specialized-Field Workshop. The assistant judges and the judges will have a chance to experience the intellectual property practices from the certain places such as private companies.

### **(3) Responsibilities**

The responsibilities of the Research Judges are to assist all the Justices of the Supreme Court in dealing with the cases. There are two methods in doing the research by the Research Judges. One is the specific instruction method. The other is the prior research method.<sup>9</sup> The former method is the responsibility of the Research Judges to conduct the research as ordered by the Justice. The latter method is the way of doing a research without the specific order by the Justice.

### **(4) The differences between the Research Judges of the Supreme Court and the Judicial Research Officials of the Inferior Courts**

There are two differences between the positions of the Supreme Court and the inferior courts. One is the persons who are appointed and the other is the responsibilities. The Supreme Court takes an advantage from the Supplementary Provisions (3) to assign the inferior courts' judges to work as the Research Judges. For the intellectual property issue, most of the judicial research officials in the Intellectual Property High Court, the Tokyo District Court and the

Osaka District Court have been appointed from the examiners of the JPO.

In the Supreme Court, the intellectual property cases will be assigned to the Research Judges who are in charge with the intellectual property cases, while the judicial research officials in the Intellectual Property High Court and the Intellectual Property Divisions in the Tokyo District Court and the Osaka District Court will be appointed and handle the intellectual property cases exclusively, due to their expertise. The judicial research officials of the inferior courts will support the judges mostly in the technical aspects of the cases.

## **2 The roles of the Research Judges in the intellectual property cases**

The problems of the instability of the patent and the jurisdiction of the so-called 'non technological cases' will be picked as the tasks to examine the roles of the Research Judges. Generally, it may be assumed that the Research Judges can play their roles effectively and even to harmonize the law enforcement in the intellectual property cases. For instance, the Research Judges usually work on the precedent basis. The intellectual property cases will be handled in the similar way as the previous cases. The inferior courts will be virtually bound by the legal matters decided directly by the Supreme Court. As a result, though there are a few intellectual property cases in the Supreme Court, the Research Judges can still play their roles in harmonizing the law enforcement among the judicial courts themselves.

If there is no precedent on the said issue, the Research Judges have to do the comparative researches. By this practice, the Japanese intellectual property laws may be interpreted in the similar way to the decisions in the other countries. It can be regarded as the way to harmonize the law enforcement in the international level.

The Research Judge may give his or her opinion according to the way on which the intellectual property cases should be carried. To do it efficiently, the Research Judges have to develop their own skill and knowledge upon the intellectual property practices. In this case, the harmonization of the law enforcement in the international level may be occurred.

The Research Judge may be able to assist the Justices in drafting their judgments. It is expected that the judgment should be accurate, correct and

easy to understand, especially on the legal aspect of the controversial issue. This will be a direct communication from the judiciary to the other organization.

The Japanese Government has been worried by the situation that the patent invalidation can be stated in two different ways. This situation relates to the confidence on the judgments. Seemingly, there are two approaches concerning this issue. The first approach is the judicial knowledge upon the intellectual property laws. This connects to the 'generalist/specialist' dichotomy. The intellectual property laws are the specific ones and they contain some special elements, separately from the civil laws. Therefore, some Research Judges who gain their experience in the intellectual property issues are selected to work in the Supreme Court. This will help the society to confide upon the Supreme Court's judgments.

The second approach is about the judicial knowledge upon the technical issue. It relates to the concept of the 'two cultures'.<sup>10</sup> This concept is regarded as the matter of the different perspectives between the persons in the areas of literature and science. It is well applied in the patent situation too. By the support of the LTRI, the Research Judges will possess more information in technology during this time. If the Research Judges know the way how the technician thinks, before applying the laws to the issue, the Supreme Court's judgments will be well accepted and reliable.

The task related to the so-called 'non technological cases' is considered at this stage. Unlike the 'technological cases', the 'non technological cases' will be adjudicated in District Courts all over the countries. Subsequently, the cases will be appealed to High Courts, due to the ordinary jurisdiction. There is a strong potential that similar cases in different courts, or even in the same court, may be judged in the different ways. Fortunately, these cases may be finally appealed to the Supreme Court. Then, the Research Judges can play their roles to unify the legal solutions of these cases. If there is a mistake in the judgment of the inferior court, the Research Judge can submit his or her opinion on the case to the Justice. Consequently, the legal issue in this case will be corrected to follow the precedent. There are also other channels to harmonize the law enforcement even when the appeals are limited on the permission of the Supreme Court, according to the Code of Civil Procedure Articles 318 and 337.

### 3 Some remarks: an experience as the Research Justice of the Thai Supreme Court

The research judge system has been used in the Thai judicial system. At present, there are the Research Justices and the Research Judges working in the Supreme Court, the Court of Appeals and the Regional Courts of Appeals respectively. The Research Justices of the Supreme Court are selected from the Presiding Judges or the Judges of the Court of Appeals and the Regional Courts of Appeals.

The Research Justices will handle the cases after the judgments have already been drafted. The main duty is the proof-reading. Furthermore, the legal precedent will be reviewed. The researches may be required to support or against the drafts. The Research Justices can also play the additional roles to strengthen the law enforcement in the intellectual property cases.

The 'generalist/specialist' dichotomy will be considered. In some countries, the judges known well in the intellectual property issues may be required to handle the said cases. That is a reason why the Justices and the Research Justices having knowledge and experience in the intellectual property laws have been selected to work for the Division of the Intellectual Property and International Trade in the Thai Supreme Court. For the Japanese Supreme Court, therefore, the 'generalist' should be deliberately defined. If the 'generalist in the legal principles' is preference, the Research Judges may have to possess the knowledge of the intellectual property laws too. This qualification may be added for the judges in the inferior courts who are assigned to work in the Japanese Supreme Court.

## V Conclusion and Suggestions

Japan has played a leading role in the world of innovation for a long time. It may be a time that Japan will play a leading role for the protection of the intellectual property. Facing the crucial problem in protecting the intellectual property, Japan has to find the suitable way to solve her problem.

The progress of the human resources, according to the hard working of the LTRI, has been fabulous. It is likely that the Research Judges of the Japanese Supreme Court can play their roles to harmonize the law enforcement in the intellectual property cases.

To reach this goal, however, some important issues should be reminded. The judgment of the court of justice is not merely for the settlement between the parties. The judgment always reflects the social norm. Additionally, the judgment may sometimes be used to indicate an appropriate way for the society. Therefore, the judgment, especially of the Supreme Court, must be rational and accurate. Making a balance between the rights of the intellectual property owners and the public interests is always the tough task for the judiciary. The subtle role, rather than the active role, may be eligible.

Secondly, when the foreign laws or opinions have been applied to the society, it should be ensured that the said laws or ideas are suitable to the society. One practice may be suitable for one society, but not to the other societies. As a result, it may be better to learn from the other countries, not to duplicate them.

Finally, the recent experience should be studied carefully. The intellectual property laws were once harmonized by the TRIPS Agreement. Today, the intellectual property has not yet been appropriately protected as expected. Harmonization is a beautiful word that the whole sectors should join with harmony. Therefore, harmonization does not mean that one sector must learn and upgrade its law enforcement to the same criteria of the other sector. It means that every sector should sincerely participate and listen to each other. If the communication can do fairly from all sectors, the ideal harmonization of the law enforcement for the intellectual property may be occurred. Subsequently, the intellectual property will be efficiently protected.

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cases related to the above rights which normally fall under the jurisdiction of District Courts which located within the jurisdiction of the Tokyo High Court, the Nagoya High Court, the Sendai High Court and the Sapporo High Court must fall under the jurisdiction of the Tokyo District Court. If the said cases generally go to the District Courts which located within the jurisdiction of the Osaka High Court, the Hiroshima High Court, the Fukuoka High Court and the Takamatsu High Court, they must fall under the jurisdiction of the Osaka District Court.

<sup>6</sup> The cases related to these types of intellectual property are called the non technological cases.

<sup>7</sup> An associate judge is a lay person who is an expert in the intellectual property field.

<sup>8</sup> This research intends to use the title of the Research Judges of the Supreme Court to indicate the differences between the ones who work in the Supreme Court and the others who work in the inferior courts.

<sup>9</sup> See Hiroharu Kitagawa, Saiko Saibansho Chosakan Seido ni Tsute [Judicial Research Official System of the Supreme Court] in *Konnichi no Saiko Saibansho [Supreme Court of Today]* (Nippon Hyoron Sha, 1998)

<sup>10</sup> See C.P. Snow, *The Two Cultures*, 12<sup>th</sup> ed (Cambridge: Cambridge University Press, 2009)

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<sup>1</sup> According to the Secretariat of the Intellectual Property Strategy Headquarters, the 'Soft Power' refers to comics, animation program, movies, games, and other contents as well as food, fashion, designs, etc. See Secretariat of the Intellectual Property Strategy Headquarters, "The Basic Principles of the Third-Term Intellectual Property Strategy and the Intellectual Property Strategic Program 2009" (2009) 34:6 AIPPI Journal 347. at 349.

<sup>2</sup> Judgment of the Supreme Court, the Third Bench. Dated 2000/4/11. Case Number 1998(O) No.364.

<sup>3</sup> Trade name, on the other hand, is protected by the Civil and Commercial Code Section 18 and the Penal Code Sections 271 to 275.

<sup>4</sup> See the Basic concepts of the Intellectual Property Strategic Program 2009.

<sup>5</sup> The cases related to these types of intellectual property are called the technological cases. The said jurisdiction is divided by the jurisdiction of the courts which normally have the jurisdiction on these cases. The civil