

Patent Litigation in Germany, Japan and the United States

Pitz / Kawada / Schwab

Second Edition 2022
ISBN 978-3-406-77884-1
C.H.BECK

schnell und portofrei erhältlich bei
beck-shop.de

Die Online-Fachbuchhandlung beck-shop.de steht für Kompetenz aus Tradition. Sie gründet auf über 250 Jahre juristische Fachbuch-Erfahrung durch die Verlage C.H.BECK und Franz Vahlen.

beck-shop.de hält Fachinformationen in allen gängigen Medienformaten bereit: über 12 Millionen Bücher, eBooks, Loseblattwerke, Zeitschriften, DVDs, Online-Datenbanken und Seminare. Besonders geschätzt wird beck-shop.de für sein

umfassendes Spezialsortiment im Bereich Recht, Steuern und Wirtschaft mit rund 700.000 lieferbaren Fachbuchtiteln.

Pitz/Kawada/Schwab

Patent Litigation in Germany, Japan and the United States

The logo for beck-shop.de features the text 'beck-shop.de' in a bold, lowercase, sans-serif font. Above the 'i' in 'shop' are three small, solid orange circles. Below the main text, the words 'DIE FACHBUCHHANDLUNG' are written in a smaller, uppercase, sans-serif font.

beck-shop.de
DIE FACHBUCHHANDLUNG

beck-shop.de
DIE FACHBUCHHANDLUNG

Patent Litigation in Germany, Japan and the United States

A Practitioner's Guide

by

Johann Pitz

Atsushi Kawada

Jeffrey A. Schwab

beck-shop.de
DIE FACHBUCHHANDLUNG

Second Edition

2022



Published by

Verlag C.H.Beck oHG, Wilhelmstraße 9, 80801 München, Germany,
email: bestellung@beck.de

Co-published by

Hart Publishing, Kemp House, Chawley Park, Cumnor Hill, Oxford, OX2 9PH, United Kingdom,
online at: www.hartpub.co.uk

and

Nomos Verlagsgesellschaft mbH & Co. KG, Waldseestraße 3–5, 76530 Baden-Baden, Germany,
email: nomos@nomos.de

Published in North America by Hart Publishing

An Imprint of Bloomsbury Publishing 1385 Broadway, New York, NY 10018, USA

Suggested citation:

Pitz/Kawada/Schwab, *Patent Litigation in Germany, Japan and the US*, 2nd ed. 2022,
Part [#] mn. [#]

beck-shop.de
DIE FACHBUCHHANDLUNG
www.beck.de

ISBN 978 3 406 77884 1 (C.H.BECK)
ISBN 978 1 5099 6086 6 (HART)
ISBN 978 3 8487 8362 5 (NOMOS)

© 2022 Verlag C.H.Beck oHG
Wilhelmstr. 9, 80801 München
Printed in Germany by
Beltz Grafische Betriebe GmbH
Am Fliegerhorst 8, 99947 Bad Langensalza
Typeset by
Reemers Publishing Services GmbH, Krefeld
Cover: Druckerei C.H.Beck Nördlingen



chbeck.de/nachhaltig

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted, in any form or by any means, without the prior permission of Verlag C.H.Beck, or as expressly permitted by law under the terms agreed with the appropriate reprographic rights organisation.

Enquiries concerning reproduction which may not be covered by the above should be addressed to C.H.Beck at the address above.

Preface

Patent systems in leading industrial nations like Germany, Japan and the United States have an important impact on research development and product commercialization.

The elaboration and further refinement of efficient patent litigation proceedings in these jurisdictions is of utmost importance in order to guarantee powerful enforcement of patent rights.

Practitioners with a multinational focus on patent disputes will have to be aware about the specific legal conditions in the various countries.

The book provides a comparative overview on patent law and patent litigation proceedings in Germany, Japan and the United States. The systematic presentation of the legal systems including comprehensive references reveals differences and similarities.

Munich, October 2021

Johann Pitz

The logo for Beck's Shop.de features the text "beck-shop.de" in a large, bold, orange sans-serif font. Above the "i" in "shop" are three small orange circles of varying sizes, arranged in a slight arc. Below the main text, the words "DIE FACHBUCHHANDLUNG" are written in a smaller, all-caps, orange sans-serif font.

beck-shop.de
DIE FACHBUCHHANDLUNG

beck-shop.de
DIE FACHBUCHHANDLUNG

Table of Contents

Preface	V
Authors.....	XIX
Abbreviations.....	XXI
Selected Bibliography.....	XXIII

Part 1 Survey

I. The European Patent litigation system	1
1. National patent enforcement	1
a) Forum shopping.....	1
b) Overview of the German judicial system for patent infringement procedure.....	2
aa) Court system.	2
bb) Procedure	2
cc) The dual system.....	3
dd) Time to trial.....	4
ee) Likelihood of success	4
ff) Final remedies in case of infringement	4
(1) Injunctions.....	4
(2) Damages and account of profits.....	5
(3) Removal and destruction.	5
(4) Costs.....	5
c) Utility Model Proceedings	6
2. Cross-border enforcement and “torpedo actions”	8
3. The Unitary Patent system.....	9
a) Status of reforms.....	9
b) Prosecution of Unitary Patents.....	10
c) Court system.....	10
d) Enforcement of Unitary Patents.....	11
e) Transitional Period for European Patents (EPs)	12
f) Judges and Attorneys	12
II. The Japanese patent litigation system	13
1. Overview of Japanese judicial system for patent infringement procedure.....	13
a) “Double track” system and concentration of jurisdiction for patent disputes	13
b) Number of patent litigations in Japan – Statistics	15
2. Overview of Japanese court procedure for patent infringement cases	16
a) Litigation fee and attorney’s reward.....	16
b) Complaint.....	16
c) Course of proceedings	17
d) Judgements	18
e) Appeals.....	18
III. The US patent litigation system	20
1. The Leahy-Smith America Invents Acts (AIA)	20

Part 2 Matter of Infringement

I. Germany	25
1. Scope of protection.....	25
a) Literal and non-literal infringement.....	25
b) Doctrine of equivalents.....	26

Table of Contents

aa) Requirements of equivalents.....	26
bb) “Formstein Defense”.....	27
c) Basic principles for the determination of the scope of protection.....	28
aa) The wording of claims.....	28
bb) Description, drawings and Prior Art.....	28
cc) The person skilled in the art is relevant for claim interpretation.....	29
dd) File history.....	29
ee) The effect of emphasizing particular features of a patent claim in the description.....	30
ff) The extent of protection of a patent claim containing numerical data and ranges.....	30
gg) Time of equivalence determination.....	31
hh) Doctrine of renunciation.....	31
2. Direct patent infringement.....	32
a) Product patents.....	32
aa) Manufacturing.....	32
bb) Offering.....	33
cc) Putting on the market.....	33
dd) Using.....	33
ee) Importing.....	33
ff) Possessing.....	33
b) Process patents.....	33
aa) Working and usage procedures.....	33
bb) Manufacturing process.....	33
c) Product by process patents.....	34
3. Indirect patent infringement.....	34
a) General principles.....	34
b) Material requirements.....	35
aa) Offer/Delivery of means in Germany.....	35
bb) Essential element of the invention.....	35
cc) Objective aptitude for direct infringement.....	36
dd) Customer’s designation for infringing application.....	36
ee) Offerer’s/supplier’s intention.....	37
ff) Double reference to German territory.....	37
II. Japan.....	38
1. Scope of protection of the patent in action.....	38
a) Literal scope of claim.....	38
aa) Description and drawings.....	38
bb) Prior art.....	39
cc) Prosecution history.....	39
(1) Prosecution history as a means for interpretation.....	39
(2) Prosecution history as a reason for estoppel.....	40
b) Doctrine of equivalents.....	40
aa) “Ball Spline” judgement.....	40
bb) Requirement No. 1 – replacement of unessential element.....	41
cc) Requirement No. 2 – identical function and effect despite replacement.....	44
dd) Requirement No. 3 – obviousness of replacement at the time of infringing.....	44
ee) Requirement No. 4 – objection of free technology.....	44
ff) Requirement No. 5 – objection of intentional exclusion.....	44
gg) Patented inventions containing numerical ranges.....	46
2. Direct infringement.....	46
3. Indirect infringement.....	49
a) Old types of provisions against indirect infringements.....	49
b) New types of provisions against indirect infringements.....	50
c) Indirect infringement in the practice.....	51

Table of Contents

III. USA	52
1. Scope of Protection.....	52
a) The Wording of the Claims	52
b) Claim Interpretation	52
2. Direct Patent Infringement.....	53
a) Requirements of Equivalents.....	53
b) Time of Equivalents Determination	54
c) Equivalency and the Prior Art.....	54
d) Equivalency and File History Estoppel.....	54
3. Indirect Patent Infringement—Active Inducement	55
a) Active Inducement	55
b) Contributory Infringement.....	55
c) Infringement through the Supply of Components From United States For Combinations Made Abroad.....	56
d) Infringement By Sale, Offer for Sale, Use or Importation of a Product Made Outside the United States by a Patented Process.....	56
4. Types of Patents.....	57
a) Product Patents	57
b) Process Patents.....	57
c) Product by Process Patent	57

Part 3

Claims of the Patent Holder and Objections of the Infringer

I. Legal basis for claims.....	59
1. Germany	59
a) Injunctive relief.....	59
aa) Criticism on the principle of “automatic” injunctions.....	59
bb) Proportionality reservation for injunctions in case of patent infringement.....	60
cc) Motives of the legislator	60
dd) Future Practice	61
b) Rendering account.....	61
c) Obligation to pay damages	62
aa) Claims	62
bb) Damages proceedings.....	62
cc) Fault.....	62
dd) Calculation of damages.....	63
(1) Patentee’s lost profits	63
(2) Infringer’s profits	63
(3) Reasonable royalties	64
(4) Relations between the calculation methods and punitive damages	64
d) Disclosure of the source of origin and of purchasers.....	64
e) Destruction	65
f) Removal and recall of infringing goods.....	65
g) Costs.....	65
2. Japan	66
a) Claim for injunction.....	66
aa) Patent holder	66
bb) Licensee.....	66
cc) Restriction of claim for injunction.....	67
b) Claim for compensation for damages	67
aa) Overview.....	67
(1) Legal basis of claim for compensation of damages caused by infringement	67
(2) Claimant for compensation for damages	67
(3) Judicial practice for claiming the compensation for damages.....	68
(4) Prerequisites for claiming the compensation of damages	68
bb) Calculation of damages.....	68
(1) Patent holder’s lost profits.....	69
(2) Patent holder’s profits estimated from the quantity of infringer’s products	69

Table of Contents

(3) Patent infringer's profits.....	71
(4) Licence analogy	72
(5) Relations between these alternatives for calculation of damages.....	72
c) Claim for compensation for the use of an opened invention before grant of patent	74
d) Other claims.....	74
aa) Procedural claims for submission of documents.....	74
bb) Claim for measures preventing further infringement.....	74
cc) Claim for costs.....	75
3. USA.....	75
a) Injunctive Relief	75
b) Accounting and Monetary Relief.....	76
c) Obligation to Pay Damages.....	78
d) Disclosure of the Source of Origin and of Purchasers.....	78
e) Destruction of Infringing Goods.....	79
f) Removal of Infringing Goods	79
g) Costs.....	80
h) Award of Attorney's Fees.....	80
II. Objections in patent litigation.....	82
1. Germany	82
a) License agreement, compulsory license, anti-trust defence	82
aa) License agreement.....	82
bb) Compulsory license.....	82
cc) FRAND defence.....	84
b) Revocation action and the dual system	85
c) Prior use right.....	86
d) Test privilege.....	88
aa) Research privilege.....	88
(1) Legal provision	88
(2) Research on the subject matter.....	88
(3) Economic purposes of research.....	89
(4) Abuse of privilege	89
(5) Research tools.....	89
(6) Outsourced research.....	89
(7) Third party support.....	89
bb) Bolar exemption	90
e) Statute of limitation.....	90
f) Laches	91
g) Exhaustion	91
h) Grace periods.....	92
2. Japan	92
a) License	92
aa) License agreement	92
bb) Non-exclusive licenses granted by the Commissioner of the Patent Office etc.	93
cc) Legal licenses	93
(1) Types of legal licenses.....	93
(2) Legal license based upon a prior use.....	94
b) Validity of invention	95
aa) Change of dual system – <i>Kilby</i> patent case.....	95
bb) Countermeasure of patent holders – correction.....	97
cc) Delay of procedure and the amendment of the Japanese Patent Act 2011.....	98
c) Restrictions of patent rights	99
aa) Expiration of patent rights.....	99
bb) Private uses	102
cc) Experimental purposes.....	102
dd) Restriction of exercise patent right against passing vessels or aircrafts	103
ee) Medical treatments.....	103
ff) Exhaustion of patent right	104

Table of Contents

gg) Parallel import	105
hh) Abuse of patent rights	106
ii) FRAND	106
d) Statute of limitation	106
3. USA	107
a) Defenses – In General	107
aa) Written Description Requirement	107
bb) Enablement	108
cc) Inventorship	108
dd) Inequitable Conduct	108
b) Anti-Trust Defense	109
c) Licenses	110
d) Invalidation, (Prior Art) and Parallel Patent Office Proceedings	111
aa) Section 101 and Anticipation and Section 102 Statutory Bars	111
bb) Anticipation and Other Section 102 Statutory Bars	112
cc) Obviousness (35 U.S.C. § 103) and Person of Ordinary Skill	114
dd) Level of Ordinary Skill	117
ee) Scope and Content of the Prior Art	117
ff) Challenges Outside the United States Court System	117
e) The Key AIA procedures are:	118
aa) Supplemental Examination	118
bb) IPR	119
cc) Post Grant Review (PGR)	120
dd) Contested Business Methods (CBM) Proceeding	120
ee) Prior Use Rights	120
ff) Experimental Use	120
gg) Statute of Limitation	121
hh) Laches	121
ii) Equitable Estoppel	122
jj) Prosecution Laches	122
kk) Unclean Hands	122
Part 4 Fact Finding	
I. Germany	125
1. Test-purchase	125
2. Product analysis and private expertises	125
3. Inspection claim	126
4. Seizure by customs authorities	127
5. Information claim	127
6. Investigation by public prosecutors	128
7. Professional confidentiality obligations	128
II. Japan	129
1. Test purchase	129
2. Product analyses and private expertises	129
3. Procedural measures for collecting information about infringement	130
a) Preservation of evidence	130
aa) Prerequisites and proceeding for preservation of evidences	130
bb) Preservation of documents	130
b) Disposition of collection of evidence before filing an action	131
4. Seizure by customs authorities	131
5. Investigation by public prosecutors	132
III. USA	133
1. Pre-Filing Investigation (FRCP Rule 11)	133
2. Product Analysis	133
3. Pre-Filing Discovery	134

Table of Contents

4. Seizure by Custom Authorities.....	134
5. Government Participation In The Proceedings.....	135

Part 5 Pre-procedural Measures

I. Pre-procedural measures of the patent holder.....	137
1. Germany.....	137
a) Warning letter due to patent infringement.....	137
aa) Practical and judicial meaning.....	137
bb) Unauthorized warning.....	138
cc) Use-by-periods.....	138
b) Preliminary injunctions.....	138
aa) A survey of summary proceedings in patent law.....	138
bb) Procedural principles in PI proceedings.....	139
(1) Competence of patent chambers.....	139
(2) Two instances.....	139
(3) Arms equality.....	139
cc) Requirements.....	140
(1) Infringement.....	140
(2) Validity of the patent of disposal.....	140
(3) Urgency.....	141
(4) Proportionality.....	142
dd) Enforcement and remedies.....	142
(1) Opposition.....	142
(2) Constitutional interim order.....	142
(3) Request to bring main action.....	142
(4) Final Statement.....	143
(5) Request to cancel the PI.....	143
(6) Judgement and Appeal.....	143
ee) Damages.....	143
2. Japan.....	143
a) Warning.....	143
b) Preliminary injunction.....	144
aa) Preliminary injunction as a provisional remedy.....	145
bb) Characters of a preliminary injunction.....	145
cc) Material prerequisites for an order of a preliminary injunction.....	146
dd) Procedure.....	146
(1) Jurisdiction.....	146
(2) Petition.....	147
(3) Relation of a preliminary injunction with an ordinary injunction.....	147
(4) Hearing.....	148
(5) Proof with prima facie evidences.....	148
ee) Decision and objection.....	149
(1) Dismissal of a petition and immediate appeal.....	149
(2) Issue of an order for a preliminary injunction, objection and appeal.....	150
ff) Revocation of a preliminary injunction.....	151
3. USA.....	151
a) Warning Letter.....	151
b) Injunctive Relief.....	152
II. Pre-Procedural measures of the alleged infringer.....	154
1. Germany.....	154
a) Negative declaratory action and counter-warning.....	154
b) Protective letter.....	154
aa) Background.....	154
bb) Rationale.....	154
cc) Electronic Register.....	155
dd) Practical Issues.....	155

Table of Contents

c) Application for issuing injunctive relief due to unauthorized patent marking.....	156
d) ANTI-SUIT-INJUNCTIONS	156
aa) Anit-suit-injunction in multi-national patent litigation.....	156
bb) Admissibility of ASIs under German law?	157
cc) Anti-ASIs as defensive strategy.....	157
dd) Basis of claims.....	157
ee) Legal interest	157
ff) Jurisdiction.....	158
gg) Outlook.....	158
e) Anti-Divisional-Game-Injunctions	158
2. Japan	159
a) Counter warning.....	159
aa) Counter warning based on a patent	159
bb) Counter warning based on an unfair competition	159
b) Protective letter	161
c) Declaratory judgement	161
3. USA	162
a) Counter-Warning/Protective Letter.....	162
b) Opinions of Counsel	163
c) Declaratory Judgment Proceedings.....	163
d) Request for Injunctive Relief Due to Unauthorized Claim of Patent Rights.....	164

Part 6 Infringement Proceedings

I. Germany	165
1. Jurisdiction and courts	165
2. Parties and participants to the proceedings.....	165
a) The parties.....	165
b) Standing to litigate.....	165
aa) The registered Patent holder.....	165
bb) Several patent owners.....	166
cc) Exclusive licensee	167
dd) Non-exclusive licensee	167
c) The defendant's standing to be sued.....	168
aa) Alleged infringers	168
bb) Two or more infringers	168
cc) Managing directors.....	169
d) Attorneys of record	169
e) Experts.....	169
aa) Court experts.....	169
bb) Party-appointed expert	170
f) Third party intervention	170
3. Procedure.....	171
a) Filing the complaint	171
b) Reply to a complaint.....	172
c) Oral hearing	172
d) Judgement, appeal and provisional execution.....	172
e) Procedural guidelines of the court.....	173
II. Japan	175
1. Jurisdiction	175
a) International jurisdiction and governing law.....	175
aa) Injunction claim	175
bb) Claims for compensation of damages	176
b) National jurisdiction	178
aa) Jurisdiction for the first instance.....	178
bb) Jurisdiction for the second instance.....	178
cc) Jurisdiction for the final instance	178

Table of Contents

2. Parties to the proceeding	179
a) Courts	179
b) Parties	179
aa) Plaintiffs.....	179
(1) Existence of an effective patent right	179
(2) Transfer of patent rights	180
(3) Registered exclusive licensee	180
bb) Defendants	181
cc) Representatives of civil procedure.....	182
dd) Experts	182
(1) Expert witnesses	182
(2) Judicial research officials for technical matters.....	183
(3) Technical advisors	183
(4) Inspectors.....	183
ee) Third parties.....	184
3. Procedural steps	184
a) Filing a complaint by a plaintiff.....	184
b) Service of a complaint to the defendant.....	185
c) Answer of the defendant to a complaint.....	186
d) Begin of oral proceeding	186
e) Preparatory proceeding	186
aa) Preparatory proceeding for recognising infringement.....	187
bb) Preparatory proceeding for calculation of damages.....	187
f) Conclusion of oral proceeding.....	187
g) Judgement.....	188
aa) Judgement recognising infringement.....	188
bb) Judgement denying infringement.....	188
h) Appeal to the Japanese Intellectual Property High Court.....	188
i) Final appeal to the Japanese Supreme Court	189
III. USA	191
1. Jurisdiction	191
2. Parties to the Proceedings.....	192
a) Court.....	192
b) Necessary and Permissible Parties.....	192
c) Rights of Action	193
d) Adding of Additional Parties	193
e) Representatives	193
f) Experts.....	194
g) Third Party Participation	194
3. Procedure	195
a) Filing of the Complaint	195
b) Answer to the Complaint.....	195
c) Proceedings Leading to the Decision of the Court.....	196
d) Motion Practice and Oral Hearings	197
e) Trial, Judgment and Appeal	198

Part 7 Procedural Principles

I. Germany	199
1. The dual system	199
a) Separation of infringement and nullity proceedings	199
b) Reform discussions.....	199
c) “One Track” system for Utility Models.....	200
2. The principle of party control	201
a) Substantive motions.....	201
aa) Subject-matter of the motions.....	201
bb) The principle of the binding nature of the application.....	202

Table of Contents

b) Commencement and termination of the proceedings.....	202
aa) Bringing a suit.....	202
bb) Withdrawal of action.....	202
cc) Acceptance.....	203
dd) Settlement.....	203
c) Changes in the factual and legal situations	203
aa) Change of party	203
bb) Invalidation or restriction of the patent-in-suit.....	204
3. Adversarial system.....	206
4. Investigative principle and judicial information obligation	206
5. The legal judge	207
6. Right to be heard and “arms equality”	208
7. Oral presentation, publicity and secrecy	208
8. Burden of demonstration and burden of proof.....	209
a) Extent of the burden of demonstration and proof	209
b) Exemption of certain facts from the burden of proof.....	210
c) Shifting of the burden of proof.....	211
d) Taking of evidence and means of evidence	212
9. The principle of concentration.....	213
10. Liability of the losing party to pay the costs	213
a) Cost risk.....	213
b) Value of the matter in dispute.....	214
11. The Principle of Territoriality.....	215
a) Basic principles.....	215
b) Production of parts in Germany but assembly abroad.....	216
c) Completion of a process by third parties abroad.....	216
d) Offers from and to a foreign country	217
e) Exhibitions on a fair.....	217
f) Internet offers	217
g) Transit of infringing goods.....	218
h) Participation Abroad.....	218
II. Japan	220
1. “Double Track” system.....	220
a) Separation system before the judgement in 2000.....	220
b) Introduction of “Double Track” system by the judgement in 2000	220
c) Contradiction between courts’ judgements and the JPO’s decisions.....	221
d) Invalidation of patent after the final and binding judgement.....	221
e) Discussion to reform the “Double Track” system.....	221
2. Principle of party disposition.....	222
a) Substantive motions	222
aa) Specification of claims.....	222
(1) Discretion of a patent holder to specify the claims	222
(2) Initiative of an alleged infringer	223
(3) Specification of the objects of claim.....	223
bb) Specification of parties	224
b) Party’s discretion for ending the procedure	224
aa) Withdrawal of action.....	224
(1) Prerequisites of withdrawal of action.....	224
(2) Effect of withdrawal of action.....	225
(3) Practical meaning of withdrawal of action	225
bb) Waiver of claim	225
cc) Acknowledgment of claim	226
dd) Amicable settlement within a judicial procedure	226
3. Principle of party presentation	227
a) Responsibilities of parties to state facts and to submit proofs.....	227
b) Exceptions to the principle of party presentation.....	227
aa) Interpretation and application of laws	227
bb) Procedural requirements for filing an action.....	228

Table of Contents

cc) Progress of proceedings	228
dd) Subsidiary authority of courts to collect evidences	229
4. Judicial information obligation.....	229
5. Legal judges.....	230
6. Principles of orality and publicity.....	231
a) Principles of orality and publicity for civil procedures.....	231
b) Exceptions in the practice of patent infringement cases	231
aa) Suitableness for preparatory proceedings.....	231
bb) Limitation of opening records containing trade secrets to the public.....	232
cc) Protective order	232
(1) Prerequisites for protective order.....	233
(2) Legal results from protective order.....	233
dd) Suspension of opening the examination of parties to the public.....	234
7. Burden of demonstration and burden of proof.....	234
a) Burden of demonstration.....	234
b) Burden of proof.....	235
aa) Burden of proof for literal infringement.....	235
bb) Burden of proof for equivalent infringement.....	235
cc) Burden of proof for compensation of damages	235
c) Procedural measures easing the burden of proof related to infringement.....	236
aa) Obligation of an alleged infringer to present the exploiting forms.....	236
bb) Presumption of exploiting patented process from identification of products	236
cc) Order to submit documents related to infringement	236
dd) Order to submit a subject matter of observation	237
ee) Inspection after filing a patent infringement law suit	237
d) Procedural measures easing the burden of proof related to calculation damage	238
aa) Order to submit documents related to damages.....	238
bb) Presumption of the amount of damages.....	239
cc) Determination of damages for portion beyond rights-holder's production/sales capacity	239
dd) Obligation of infringer to explain the facts for the calculation of damages.....	239
ee) Recognition of reasonable amount of damages.....	240
8. Maxim of concentration of examination of witnesses and parties.....	240
9. Liability of the losing party to pay the costs.....	240
III. USA	242
1. All Matters Before the Court	242
a) Substantive Motions.....	242
b) Procedural Motions.....	242
2. Adversarial System	243
3. Discovery	243
4. The Court and the Judge and Their Roles.....	244
5. The Jury and Their Role.....	244
6. Public Trials and Right to be Heard	245
7. Publicity	246
8. Burden of Proof.....	246
a) Preponderance of the Evidence	246
b) Clear and Convincing.....	246
c) Taking of Evidence and Means of Evidence	247
aa) Pre-Trial Discovery Testimony	247
bb) Evidence Outside The United States	247
cc) Evidence At Trial	248
9. Costs.....	249

Table of Contents

Part 8
Comparative aspects of law and practice

I. Territoriality	251
II. Courts	252
III. Jury and Judges	252
IV. Evidence and burden of demonstration and proof	252
1. Pretrial discovery.....	252
2. Depositions.....	253
3. Experts.....	254
4. Inspections.....	255
V. Claim construction	255
VI. Direct and Indirect infringement	255
VII. Validity objection	256
VIII. Compulsory Licensing	257
IX. Experimental use and Bolar exemption	257
X. Injunctions	257
XI. Preliminary Injunctions	258
XII. Anti-Suit-Injunctions	259
XIII. Damages	259
XIV. Costs	259
Index	261


beck-shop.de
DIE FACHBUCHHANDLUNG

beck-shop.de
DIE FACHBUCHHANDLUNG

Authors

Dr Johann Pitz, attorney at law and patent litigator, Vossius and Partner, Munich

Atsushi Kawada, attorney at law and patent attorney, Tokyo

Jeffrey A. Schwab, patent attorney who specializes in IP litigation, licensing, ADR, and advertising law, New York

The logo for beck-shop.de features the text 'beck-shop.de' in a bold, lowercase, sans-serif font. Above the 'i' in 'shop' are three small, solid orange circles of varying sizes, arranged in a slight arc. Below the main text, the words 'DIE FACHBUCHHANDLUNG' are written in a smaller, all-caps, sans-serif font.

beck-shop.de
DIE FACHBUCHHANDLUNG

beck-shop.de
DIE FACHBUCHHANDLUNG

Abbreviations

AIA	American Invention Act
AIPLA	American Intellectual Property Law Association
ALJ	(U.S.) administrative law judge
Art	Article
BGB	<i>Bürgerliches Gesetzbuch</i> (German Civil Code)
BGH	<i>Bundesgerichtshof</i> (German Federal Supreme Court)
CAFC	(U.S.) Court of Appeal of the Federal Circuit
CBM	(U.S.) Contested Business Methods
cf.	confer (see)
CJEU	Court of Justice of the European Union
DOJ	(U.S.) Department of Justice
ECJ	European Court of Justice
EP	European Patent
EPC	European Patent Convention
EPO	European Patent Office
et seq./seqq.	et sequentia
EU	European Union
F.	(U.S.) Federal Reporter
FCJ	Federal Court of Justice (BGH)
F.R.D.	(U.S.) Federal Rules Decisions
FDA	(U.S.) Food and Drug Administration
Fed. Cir.	(U.S.) Federal Circuit
ff.	and the following
FITF	“First Inventor To File”
FPC	(German) Federal Patent Court
FRAND	fair, reasonable and non-discriminating
FRCP	(U.S.) Federal Rules of Civil Procedure
FRE	(U.S.) Federal Rules of Evidence
FTC	(U.S.) Federal Trade Commission
FTI	“First To Invent”
GATT	General Agreement on Tariffs and Trade
GG	<i>Grundgesetz</i> (German Constitution)
GKG	<i>Gerichtskostengesetz</i> (German Court Fees Act)
GPTO	German Patent and Trademark Office
GRUR	<i>Gewerblicher Rechtsschutz und Urheberrecht</i> (German journal on IP and copyright law)
GRUR Int	<i>Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil</i> (German journal on IP and copyright law – international)
GRUR-RR	<i>Gewerblicher Rechtsschutz und Urheberrecht – Rechtsprechungsreport</i> (German journal on IP and copyright law – case reporter)
GVG	<i>Gerichtsverfassungsgesetz</i> (German Judicature Act)
id.	idem (the same)
IIC	International Review of Intellectual Property and Competition Law
INPIT	Japanese National Centre for Industrial Property Information and Training
InstGE	<i>Entscheidungen der Instanzengerichte zum Recht des geistigen Eigentums</i> (German reporter on IP cases)
IPR	(U.S.) Inter Partes Review
ITC	International Trade Commission
L. Ed.	(U.S.) Supreme Court Reports, Lawyers’ Edition
LG	<i>Landgericht</i> (German court of first instance)
MPEP	(US) Manual of Patent Examining Procedures

Abbreviations

N.D. Cal.	Northern District of California
No.	number
NPE	non-practicing entities
OJ	Official Journal
PAO	<i>Patentanwaltsordnung</i> (German Patent Attorney Code)
PatG	<i>Patentgesetz</i> (German Patent Act)
PGR	(US) Post Grant Review
pp.	pages
PTAB	(US) Patent Trial and Appeal Board
PTO	(US) Patent and Trademark Office
RAND	Reasonable And Non-Discriminatory
RG	<i>Reformgesetz</i> (German Reform Act)
RVG	<i>Rechtsanwaltsvergütungsgesetz</i> (German Lawyers' Fees Act)
S. Ct.	(U.S.) Supreme Court Reporters
S.D.N.Y.	(U.S.) District Court, Southern District of New York
SEP	standard essential patent
SSO	(U.S.) Standard Setting Organizations
Sup. Ct.	Supreme Court of the United States
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
U.S.C.	United States Supreme Court
U.S.C.A.	United States Code Annotated
U.S.S.C.	Supreme Court of the United States
UP	Unitary Patent
UPC	Unified Patent Court
UPCA	Unified Patent Court Agreement
v.	versus
Vol.	Volume
ZPO	<i>Zivilprozessordnung</i> (German Code of Civil Procedure)


beck-shop.de
DIE FACHBUCHHANDLUNG

Selected Bibliography

Germany

Books

- Benkard* Patentgesetz, 11th Ed. 2015; cited: Benkard/*author*, PatG
Busse Patentgesetz, 9th Ed. 2020; cited: Busse/*author*
Fitzner/Lutz/Bodewig Patentrechtskommentar, 4th Ed. 2012; cited: Fitzner/Lutz/Bodewig/*author*
Kraßer/Ann Patentrecht (Patent Law), 7th Ed. 2016
Kühnen Handbuch der Patentverletzung, 13th Ed. 2020
Kühnen Patent Litigation Proceedings in Germany, 7th Ed. 2015
Mellulis Handbuch des Wettbewerbsprozesses, 3rd Ed. 2000
Pitz Patentverletzungsverfahren, 2nd Ed. 2010
Schramm Der Patentverletzungsprozess, 7th Ed. 2013
Schulte Patengesetz mit EPU (German Patent Act), 10th Ed. 2017; cited: Schulte/*Author*

Articles

- Brinks/Fritze* Einstweilige Verfügungen in Patentverletzungssachen in den USA und Deutschland, GRUR Int 1987, 133
Heath Patent Litigation J. Japan and Germany: An introduction, J. Japan. L special issue No. 3 (2011), 13
Klopschinski Der Patentverletzungsprozess in Japan und Deutschland, GRUR Int. 2010, 309
Meier-Beck The interaction between infringement and invalidation decisions in German patent disputes, J. Japan. L. Special Issue No. 3 (2011), 63
Maxeiner Der Sachverständige in Patentrechtsstreitigkeiten in den USA und Deutschland, GRUR Int 1991, 85
Ohly “Patentrolle” oder: Der patentrechtliche Unterlassungsanspruch unter Verhältnismäßigkeitsvorbehalt? – Aktuelle Entwicklung im United States-Patentrecht und ihre Bedeutung für das deutsche und europäische Patentsystem, GRUR Int 2008, 787
Rauh Mittelbare Patentverletzung in Deutschland, Japan und den United States, GRUR Int 2010, 459
Rahn Patent Infringement Proceedings in Japan and Germany: Similarities and Differences, J. Japan. L Special Issue No. 3 (2011), 29
Schönknecht Beweisbeschaffung in den United States zur Verwendung in deutschen Verfahren, GRUR Int 2011, 1000

Japan

Books

- Abe/Ikubo/Katayama* Japanese Patent Litigation, 2nd Ed. 2012
Hansen/Schüssler-Langeheine (eds) Patent Practice in Japan and Europe, Liber Amicorum for Guntram Rahn, 2011
Hinkelmann Gewerblicher Rechtsschutz in Japan, 2nd Ed., 2008
Kawaguchi The Essentials of Japanese Patent Law: Cases and Practice, 1st Ed. 2006

Articles

- Heath* Patent Litigation in Japan and Germany: An introduction, J. Japan. L special issue No. 3 (2011), 13
Heath Erlangung und Durchsetzung von Patentrechten in Japan, GRUR Int 1998, 555
Kimijima Das Patentnichtigkeitsverfahren in Japan, GRUR Int 1996, 986

Selected Bibliography

- Klopschinski* Der Patentverletzungsprozess in Japan und Deutschland, GRUR Int. 2010, 309
- Rahn* Patentstrategien japanischer Unternehmen, GRUR Int 1994, 377
- Rahn* Neuere Entwicklungen bei Patentverletzungsklagen in Japan, Mitt. 2001, 199
- Rahn* Patent Infringement Proceedings in Japan and Germany: Similarities and Differences, J. Japan. L special issue No. 3 (2011), 29
- Rauh* Mittelbare Patentverletzung in Deutschland, Japan und den USA, GRUR Int 2010, 459
- Someno* Grundlagen und Probleme des japanischen Patentrechts, GRUR Int 1994, 371

USA

Books

John R. Thomas, Martin

J. Adelman & Randall J.

Rader

Cases and Materials on Patent Law (St. Paul, Minn.: West 3rd Ed. 2009)

John R. Thomas & Roger

E. Schechter

Principles of Patent Law (St. Paul, Minn.: Thomson/West 2004)

Articles

Bergen-Babinecz/

Hinrichs/Jung/Kolb

Zum Schutzbereich von US-Patenten: Festo und eine deutsche Sicht, GRUR Int 2003, 487

Bodewig

Erschöpfung der gewerblichen Schutzrechte und des Urheberrechts in den USA, GRUR Int 2000, 597

Bodewig

Nichtangriffspflichten des Veräußerers im US-amerikanischen Patentrecht, GRUR Int 2004, 918

Brinks/Fritze

Einstweilige Verfügungen in Patentverletzungssachen in den USA und Deutschland, GRUR Int 1987, 133

Calvetti/Hughes

Mittelbare Verletzung und Anstiftung zur Verletzung im US-Patentrecht, GRUR Int 1993, 833

Calvetti/Venturino

Zur Gültigkeit von Patenten in den USA: Mitteilungspflichten im Patenterteilungsverfahren und im Verletzungsprozess, GRUR Int 1988, 815

The Federal Circuit

Bar Association

Model Patent Jury Instructions, <http://www.fedcirbar.org>

Henry

Pretrial Discovery in USA: Exterritorialer Einfluss auf Durchsetzung und Benutzung von gewerblichen Schutzrechten, GRUR Int 1983, 82

Hufnagel

Ausweitung des Versuchsprivilegs in Europa und den USA – Verschiebung der Grenzen zwischen Patentschutz und Versuchsfreiheit bei Arzneimitteln, PharmR 2006, 209

Koch

Reform des Patentrechts in den USA – Ein Überblick über die Vorschläge zur Revision und Modernisierung des Patentgesetzes, GRUR Int 1975, 103

Maxeiner

Der Sachverständige in Patentrechtsstreitigkeiten in den USA und Deutschland, GRUR Int 1991, 85

Mehler

Das Prosecution History Estoppel im US-Patentrecht, GRUR Int 2006, 278

Münsterer

Fallstricke und andere Besonderheiten der US-Patentpraxis aus deutscher Sicht, MittdtPatA 2010, 332

Müller-Stoy

Grundzüge des U.S.-amerikanischen Patentverletzungsverfahrens, GRUR Int 2005, 558

Ohly

“Patenttrolle” oder: Der patentrechtliche Unterlassungsanspruch unter Verhältnismäßigkeitsvorbehalt? – Aktuelle Entwicklung im US-Patentrecht und ihre Bedeutung für das deutsche und europäische Patentsystem, GRUR Int 2008, 787

Selected Bibliography

- Pakuscher* Das neue zentrale Berufungsgericht in den USA – ein Schritt in die europäische Richtung – Dem alten und neuen Chef-Richter Howard T. Markey, GRUR Int 1983, 71
- Pfeiffer* Hätte Columbus gewusst, was aus seiner “discovery” wird – das “discovery”-Verfahren im amerikanischen Patentverletzungsprozess, GRUR Int 1999, 598
- Rauh* Mittelbare Patentverletzung in Deutschland, Japan und den USA, GRUR Int 2010, 459
- Reitboeck* Das rechtliche Umfeld für (und gegen) nicht operative Patentinhaber in den USA – Ein Überblick über wichtige Entwicklungen der letzten Jahre, GRUR Int 2013, 419
- Ruess* Der U.S. Court of Appeals for the Federal Circuit und seine Bedeutung im U.S.-Gerichtssystem unter besonderer Berücksichtigung des U.S. Supreme Court, GRUR Int 2011, 1
- Schönknecht* Beweisbeschaffung in den USA zur Verwendung in deutschen Verfahren, GRUR Int 2011, 1000
- Wehr* Die Rechtskraftwirkung von Entscheidungen über die Nichtigkeit von Patenten in den USA – die Entscheidung in *Blonder-Tongue* und ihre Auswirkungen, GRUR Int 1973, 131


beck-shop.de
DIE FACHBUCHHANDLUNG

beck-shop.de
DIE FACHBUCHHANDLUNG