

**Kilby Case**  
**Existence of ground for invalidation and “abuse of right” defense**  
**Supreme Court**  
**Case H10 (O) No. 364 (April 11, 2000)**

*A case where an enforcement based on a patent right obviously involving a ground for invalidation was determined to be an abuse of right*

**FACTS**

In this case, the plaintiff sought confirmation of nonexistence of the defendant's right to claim damages from patent infringement since the defendant alleged that production and distribution of semi-conductor devices by the plaintiff infringed the defendant's patent right.

The facts are as follows.

1. The defendant owns a patent entitled “Semi-conductor device” (Patent No.320,275).
2. The subject patent matured from a second divisional application based on a first divisional application from the original application disclosing the original invention.
3. The Decision of Rejection became final and conclusive in the original application for the reason that the original invention could have been made easily by the known, original inventions.
4. The present invention is substantially identical with the original invention.
5. The plaintiff was producing and distributing the accused infringing semi-conductor devices as a business.

**ISSUE**

Can a court which examines a patent infringement suit decide whether or not the patent obviously includes a ground for invalidation before a trial decision for invalidation to the patent becomes final and conclusive? Can injunction, damages or the like based on a patent right be claimed in a patent infringement suit when the court finds that the patent obviously includes a ground for invalidation.

**COURT DECISION**

1. Decision

Any patent right is legally effective and is not invalidated publicly until a trial decision for invalidation becomes final and conclusive.

However, it is not appropriate to interpret that claiming injunction, damages or the like based on a patent right is permissible even in a case where the patent should be invalidated by a final and conclusive trial decision for invalidation if a trial for invalidation is demanded because of obvious existence of a ground for invalidation in the patent. Therefore, it should be interpreted that a court which examines a patent infringement suit can decide whether or not the patent obviously includes a ground for invalidation even before a trial decision for invalidation to the patent become conclusive, and when the trial examination results in a finding that the patent obviously includes a ground for invalidation, it is appropriate to interpret that claiming injunction, damages or the like based on the patent right is not permissible because such an action constitutes an abuse of right so long as a particular circumstance is not recognized. The interpretation as described above is not contrary to the purpose of the patent system.

2. The present case

In the present case, the application should be rejected under the Patent Law art.39(1) because the original application does not lose the status of a prior application even though the Decision of Rejection to the original application became final and conclusive. In addition, the present patent has been granted against Art.29(2) because the present invention is substantially identical with the original invention of the original application to which Decision of Rejection had become final and conclusive for the reason that the original invention could have been made easily on the basis of the known inventions. Therefore, the present patent is surely predicted to be invalidated because it is obvious that the present patent includes a ground for invalidation under art.123(1)(ii) and a particular circumstance like a demand for trial for correction is not recognized.

Therefore, claiming damages based on the present patent right constitutes an abuse of right and is not granted because the present patent obviously includes a ground for invalidation and a particular circumstance is not recognized.

### **NOTES**

By the law revision in 2004 after the above-mentioned judgment, Art.104-3(1) was added, which stipulates as follows:

“A patentee cannot enforce its patent right to an opposite party when it is recognized that the patent should be invalidated by a trial for invalidation in a patent infringement suit”.

That is, a defense of restriction on enforcement under art.104-3 is written as a rule instead of an “abuse of right” defense. This Article does not require obviousness in existence of ground for invalidation, which differs from the above-mentioned case.