

DIFFERENT PROCEDURE, LANGUAGE LEADS TO DIFFERENT RESULTS

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The Mock Trial was a fascinating cultural and legal experience in which we are grateful to have had the opportunity to participate. When asked for our impression of the proceedings, one thing immediately came to mind: In order to ensure that justice is being done, Japan and the United States have adopted legal procedures that are very different from one another. It is therefore not surprising that in some instances the application of these systems will lead to different results. The particular case that was used for the Mock Trial was excellent for demonstrating these differences.

Observing the Japanese trial in the morning, it is evident that the Japanese process is very methodical, analytical and detail oriented. Each issue in the case was examined by the panel of Tokyo District Court Judges sequentially and in detail with argument from the parties exhausted before moving on to the next issue. The methodical resolution of each issue results in an outcome that is “fair and correct” because the process is applied consistently to everyone and necessarily and inexorably leads to a decision that is by definition correct because it is the result of a fair and reasoned process. In the Japanese Mock Trial, after examining each of the other issues, the court concluded that the act of making the heparin outside of the syringe and then placing it into the syringe was an essential part of the invention. Once that decision was made, the outcome was determined. There could be no infringement either literally or by equivalents.

The US trial appears quite different. At the trial, US trial lawyers focus directly on convincing the jury as to what is the overall “fair” result, consistent with the legal instructions that the judge will give the jurors. All issues may not be addressed in detail. Some may not be addressed at all. Because the jurors may lack technical training, the technology at issue is likely to be described in general terms, and the jury is expected to understand it more by analogy to everyday, known things rather than as a scientist or technical expert would understand the technology. Instead, great attention is devoted to the big picture or “telling the story” so that the jury gets a direct sense of the “fair” outcome.

In addition to focusing on the big picture, a U.S. trial lawyer must also give the jury a way, consistent with the judge’s anticipated instructions on the law and the meaning of the claim terms, to reach the result that the trial lawyer hopefully has convinced the jury is the “fair” outcome. In the US case at the Mock Trial, the jury was convinced that the main idea of plaintiff – freeze-drying a solution of water soluble filler and heparin so that a reproducible, uniformly distributed and readily manufacturable unit dose of heparin could be applied to a blood sample – was taken by defendant so that

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the “right” or “fair” result would be to require defendant to pay the plaintiff for plaintiff’s essential contribution. The path that was given to the jurors so that they could find in favor of plaintiff was to make them understand that they were free to find that the differences between the plaintiff’s patent and the defendant’s product or process were “insubstantial” (i.e. “equivalent”) which would allow them to reach the result that they wanted to reach – even if those differences took defendant’s product or process outside the literal scope of plaintiff’s patent.

Thus, the “fairness” issue is approached more indirectly in the Japanese procedure. By consistently following a fair procedure, the result must be fair, or at least very likely will be. In contrast, the American procedure addresses the “fairness” issue more directly. The reasoning in the American system is that, if an advocate in an adversary system is capable of convincing 12 jurors to unanimously conclude that a given outcome is fair or right (and consistent with the judge’s instructions on the law and meaning of the claims), then it must be fair, or at least very likely will be.

The differences in the two approaches can be viewed as somewhat of a necessary or obvious consequence of the different characteristics of the persons chosen to be the triers of fact in the two systems. In the US system, lay people, usually with no legal or technical background, are the triers of fact. Therefore, detailed presentation of complex issues may bore or frustrate rather than convince. In contrast, the Japanese judges who try the case are experienced jurists and often have technical backgrounds or the ability to understand technical matters. As such they are much more likely not only to be open to detailed factual and legal argument, but to actually require argument at that level of sophistication to be convinced.

Looking at the two systems from the point of view of the “trial” only, however, may give an exaggerated view of the differences between them. While a Japanese trial occurs over several sessions spread out over several months, a US trial usually occurs in one continuous block of time at the end of the case. However, many months are spent preparing the groundwork for a U.S. trial, and during that time, many of the complex and detailed arguments that appear to be missing from a US trial are made to the Judge and the results incorporated into the structure of the trial. For example, the US Judges usually conduct a hearing – often well before the trial – on the proper construction of the patent claims (Markman Hearing). That hearing is usually marked by several days of complex technical testimony and complex legal and technical argument which results in a claim construction that is incorporated into the instructions to the jury as to what exactly it is that they need to find in order to find infringement. Similarly, many of the issues that the Japanese court dealt with during the opening stages of the trial are disposed of in the US by motions to the court made prior to the trial – and those issues are then excluded from the trial, for example by a summary judgment motion.

Moreover, the US attorney’s ability to focus the trial on big picture, “fairness” issues is also constrained by the fact that the verdict will have to withstand the scrutiny of a Federal Circuit appeal if there is an appeal from the trial court’s decision. Thus, attorneys must confine their arguments about what is fair to the framework of legal principles enunciated by the Federal Circuit. The Federal Circuit Justices are experienced jurists with a very deep and nuanced understanding of the principles of patent law and with backgrounds that allow them to broadly and deeply understand the technology at issue in the case. Therefore, much of the discipline present in the Japanese system that seems to be lacking from the US trial is actually supplied by the preliminary work of the District

Court Judge leading up to the trial and, if necessary, by the Federal Circuit Justices on appeal after the trial.

An additional observation is the extent to which language differences can play a crucial role in the case outcome. In the original patent application at issue in the Mock Trial, which was filed in the US, the claim required that the pledget be “placed in” the syringe. This term is broad in meaning and can encompass the act of placing the pledget within the syringe as well as taking it from the outside of the syringe and putting it into the syringe. The Japanese patent application translated “placed in” with the Japanese term “ireru” which translates in English roughly as “*inserted* in” or “placed *into*”, a slightly narrower term that apparently encompasses only those situations where the pledget is taken from outside the syringe and put inside.

Since the defendant in this case actually manufactured the pledget in place in the syringe, it is clear that the defendant’s activities could not fall literally within the terms of the Japanese patent, but could be understood to fall literally within the terms of the US patent. Indeed the jurors in the U.S. Mock Trial reported that they were split evenly, six to six, on the question of whether defendant literally infringed the US patent. In the Japanese case, no serious attempt was even made to argue literal infringement. Plaintiff conceded there was no literal infringement in its complaint. This difference in the closeness of the product or process to the literal terms of the patent undoubtedly was a strong factor – if only psychologically – in the different conclusions reached by the Japanese panel of judges and the jurors on the issue of infringement under the doctrine of equivalents. Put another way, the difference between defendant’s process and plaintiff’s patent certainly seems much less substantial when a good faith argument can be made that, notwithstanding the differences, the defendant’s process still falls within the literal claims of the patent. It is therefore helpful to be able to put on a credible literal infringement case, even if one intends ultimately to rely on infringement by doctrine of equivalents.

Because patent cases are, at their core, about language and the nuanced meanings of words and combinations of words in the patent claims, the litigation of the same invention and the same product in different nations using different languages inherently risks different results because translations are not likely to be perfectly equivalent. Whether the translation issue arises during the patent prosecution process or during litigation, even slightly different meanings can have a profound effect on the outcome. The Mock Trial amply illustrated this principal and the importance of devoting appropriate resources to make sure that part of the invention is not “lost in translation.”