

THE COMPARATIVE MOOT COURT WITH US AND JAPANESE PATENT LAW

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This excellent moot court comparison disclosed several important differences between US and Japanese procedure for adjudication of patent disputes. Of course, the most striking difference is the US reliance on juries to decide even the most technical factual issues in a patent trial. The US jury system makes the role of the trial judge very different from the role of the trial judges in the Japanese system.

In somewhat simple terms, the jury system requires the trial judge in the US to differentiate between factual issues and legal issues. In each case, the jury decides the factual issues; the judge decides the legal issues. The predominant legal issue under US patent law is the interpretation of the claims. Before the actual trial with the jury, the US trial judge will generally hold a hearing to ascertain the meaning of the claims. After hearing testimony from experts and after examining the patent documents with the assistance of trial counsel, the US judge will issue an order defining any contested terms in the patent. In the mock trial proceeding, the attorneys often referred to the judge's claim construction order. These comments showed that the trial judge had already resolved substantial legal issues about the meaning of the claims.

Often the judge's claim construction order will resolve the fundamental questions of infringement and validity and enable the court to reach a final judgment without further proceedings. In the mock trial, however, the claim construction alone did not resolve the infringement issue because infringement under the doctrine of equivalents is a factual question. Thus, under the US trial system, the jury resolves any material disputes over infringement by equivalents.

When presiding over a jury trial, the role of the trial judge places special emphasis on preserving fairness to ensure that the jury receives a proper understanding of the evidence. Thus, the trial judge often rules on objections to preserve fairness. If an attorney perceives that the other party is posing misleading questions or presenting irrelevant evidence or otherwise abusing the trial process, that attorney can object. The judge then rules on those objections to keep the process fair. The judge faces a particular challenge to make those rulings without influencing the jury. The jury must not detect that the judge is favoring one party or one version of the evidence. Thus, the judge must rule on the objections without suggesting that one party or another is correct on the factual issues that the jury must decide. For this reason as well, the judge will refrain from commenting on evidence or asking questions that tend to show any partiality to one party or the other.

The US process is often called the adversary system. This designation means that each party

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has the duty to prove their version of the facts to the jury. The court does not have any duty to present evidence or to help the parties with this duty. Thus, the counsel for each party has a significant responsibility to present sufficient evidence to prove each element of their case. If a party presents no evidence on a crucial legal point, the judge could rule as a matter of law that the jury need not make a finding because no evidence was presented on a necessary legal requirement. Because trial attorneys carry a great responsibility, they are generally highly trained and proficient lawyers. Although each attorney has a distinct personality and style, trial attorneys have generally prepared over many years to master trial procedures and techniques.

As mentioned above, the interpretation of law is the judge's duty. In any trial, the judge instructs the jury about the law that governs its decision. The jury takes an oath to follow these legal instructions. The jury instruction includes the judge's interpretation of the terms in the patent and the standards governing the jury's decision.

Observations about the Japanese System

As a judge, I, of course found the Japanese system a different, but very excellent, way to resolve patent disputes. I observed that the Japanese civil procedure seemed to be a mixture of both adversarial and inquisitorial models, no doubt based on the rich Japanese historical and cultural background. Without the burdens of a jury system, Japanese judges are free to decide both factual and legal issues. Thus the distinction between law and fact - an important part of US jurisprudence - is not as important in Japan. In fact, I understand that the Japanese high court reviews factual issues de novo. Thus, these categories probably have their greatest meaning when the Japanese Supreme Court reviews legal issues only from the high court.

I observed that the Japanese judge also has the duty to preserve due process in the litigation procedure. Without the presence of lay jurors, however, the Japanese judge may preserve proper process more informally. Thus, the Japanese trial resembles a US trial without a jury. In other words, when a US judge presides without a jury, the process is similar to the inquisitorial aspect of Japanese litigation.

In sum, I was impressed with the professionalism and skill of the Japanese jurists. I was impressed that a litigant could get a fair trial and an excellent result under either the Japanese or US litigation systems. Technical issues, of course, pose a particular challenge to any system of dispute resolution. Both systems profit from guidance from expert witnesses who understand the technology.

I am also very pleased to know that the Japan is moving towards creation of a new IP High Court even I am writing these passing observations. This new court will develop expertise in applying and administering Japanese intellectual property law. I look forward to cooperating with and learning from this new court as IP courts all over the world strive to improve the administration of justice.