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Title: From Düsseldorf to Tokyo and beyond? Reviewing the reluctant reception of the German Inspection Claim into Japanese Patent Enforcement Procedure

Abstract

Patentees need to demonstrate infringement by showing that all elements of a patented claim are embodied in the claimed product or process. For product claims, the patentee can usually establish the factual background by procuring and analyzing the disputed product. At the same time, process claim infringement evidence collection can be a lot harder to conduct.

German patent law traditionally relied on a civil law inspection claim that gave – at least in theory – patentees the option to inspect a possibly-infringing process. The inspection claim was made a lot more available following the introduction of the so-called “Düsseldorf procedure” that was spearheaded by the Regional Court of Düsseldorf and its then-presiding judge Thomas Kühnen from 2005, and later codified in Section 140c of the German Patent Act, providing for a multi-step procedure that enables patentees to conduct an effective inspection of the allegedly infringing process while maintaining confidentiality interests of the defendant.

Japanese patent enforcement and evidence collection procedure underwent a fairly significant revision in 2004 that aimed to strengthen the position of patentees. Relying on the cooperation of both parties to the dispute, the reform fell short of introducing an enforceable inspection claim. In 2019, after more than a decade of discussions and deliberations, the Japanese government finally decided to propose a new inspection claim that forces the alleged infringer to allow an inspection, drawing heavily on the procedure originally developed by the Düsseldorf court. This paper will critically evaluate the established practice in Germany and the new inspection claim in Japan, which may or may not be a model for evidence collection in other jurisdictions in Asia.