On December 16, 2003, a jury sitting in Tokyo, Japan, decided a patent infringement case between Central Medical Incorporated and Hoshino Medical Equipment Co., Ltd. Witnesses testified; attorneys argued; the Judge ruled; and the jury reached a decision. While everyone played their part in the courtroom, in the end, there was no appeal, no damage awards, and no injunction threats. The reason? This trial occurred not for the benefit of the parties, but for the benefit of the Japanese spectators.

The Tokyo District Court and Waseda University hosted a U.S. mock trial to demonstrate United States patent litigation practices and to highlight some of the differences between patent infringement trials in Japan and those in the United States. Judge Rader from the U.S. Court of Appeals for the Federal Circuit presided at the mock trial, and attorneys tried the case based on the facts from an actual patent case in Japan.

It was believed to be the first time an event like this was held in Japan. As participants, we enjoyed the experience of demonstrating a U.S. patent infringement trial to the Japanese audience, and trust we contributed to a better understanding of Japanese and United States litigation practices.

We represented the accused patent infringer, Hoshino Medical. Because the entire trial was limited to two hours - an extremely short time to present a trial - we focused on the parts of a trial that best demonstrate the differences between the Japanese and U.S. legal systems. Looking back at those differences, the testimony of live factual witnesses, different approaches to the doctrine of equivalents, and the presence of a jury stand out.

I. PRETRIAL

Our biggest challenge was to complete the mock trial in two hours. Typically, a U.S. patent infringement trial lasts days, weeks, or even months. To meet the time requirement, Judge Radar limited the number of witnesses to one per party, and the parties narrowed the issues for trial. Both the plaintiff and the defendant stipulated to issues the parties would not stipulate to in a real trial.

Also, pretrial motions and jury selection were kept short. In a U.S. trial, it is not unusual to
take a whole day to complete the pretrial motions and jury selection.

II. WITNESS TESTIMONY

From the end of the opening statements to the beginning of the closing arguments, a U.S. trial centers on the witnesses. One by one, witnesses take the stand, testify, and endure cross-examination. In a normal trial, each side presents several factual and expert witness, and in a large case, there can be more than ten witnesses from each party. Because of the limited time, however, Central Medical and Hoshino each presented only one expert witness, even though a real trial might see several expert witnesses for each side.

Factual witnesses explain their side of the story, and experts offer opinions. A patent holder almost always calls an inventor, when available, as one of the factual witnesses in a U.S. patent infringement case. The inventor typically explains how the invention was made and describes the effort to complete the invention. On the other hand, an accused infringer often calls its own scientist or engineer who has developed the accused product or method as a factual witness. The jury decides whom to believe.

The jury often does not hear everything and does not get the full story. The rules of evidence and the rules of civil procedure impose limits on what testimony the jury will hear, and the Judge enforces those limits. These issues are often addressed at the pretrial stage out of the hearing of the jury.

In a patent infringement case, the experts are often the most important witnesses. The patent holder's expert testifies to infringement, while the accused infringer's expert testifies to noninfringement and patent invalidity. Because such testimony directly conflicts, the jury has to decide which expert to believe.

Under the rules of civil procedure, each expert must prepare a written report giving the expert’s opinions and the basis for them. Acting as gatekeeper, the Judge must decide if the jury can hear the expert’s opinion. Generally, an expert can express an opinion based upon methodologies accepted in the scientific community that are considered reliable. In addition, experts cannot testify beyond the scope of their reports. To demonstrate these limitations in the mock trial, the defendants objected to the plaintiff's expert report as not relying on accepted methodologies, and the plaintiff objected to the testimony of the defendant's expert as beyond the scope of his expert report.

Also, during pretrial discovery, parties depose many of the factual and expert witnesses to establish the witnesses' testimony at trial. The depositions of trial witnesses reduce the chance of surprise during the trial.

III. INFRINGEMENT

United States patent law recognizes both literal infringement and infringement under the doctrine of equivalents. On December 16, 2003, Central Medical argued for literal infringement and, alternatively, for infringement under the doctrine of equivalents. For literal infringement, the accused device or method must have each and every element of the claim, and a finding of literal infringement often depends on the interpretation of the claim.

Following the U.S. Supreme Court’s Markman decision, the judge must interpret the claim
and instruct the jury on the proper claim scope. U.S. district court judges often hold claim interpretation hearings called Markman hearings and issue detailed claim interpretation orders. There is no jury at these hearings. Such a hearing and orders can be as important or more important than the actual trial because the claim interpretation often determines literal infringement. In many instances, cases end or settle after the Markman hearing.

For the mock trial, we considered holding a claim interpretation hearing because such a hearing is an important part of U.S. patent infringement litigation. However, we abandoned the claim interpretation hearing because of the limited time and our desire to show a jury trial. Instead of holding a Markman hearing, a contested proceeding, both parties agreed to a claim interpretation order. To narrow the issues even further for a two-hour jury trial, the parties agreed to a stipulation.

IV. INVALIDITY

During the mock trial, we limited our arguments to the infringement issues and did not argue patent invalidity due to the time constraints. In a typical U.S. infringement trial, however, invalidity arguments are important parts of the trial, and an accused infringer will almost always raise an invalidity defense. Invalidity issues will often prevent a patent holder from asserting an overly broad claim scope.

V. THE JURY SYSTEM

The presence of a jury marks the most obvious, and perhaps the most important, difference between civil litigation in the United States and civil litigation in most of the rest of the world. The jury is an important part of the U.S. legal system. From the beginning, we structured the mock trial to demonstrate the workings and importance of the jury. Thus, while the judge decided questions of evidence, admissibility, and claim construction, the jury compared the accused method to the claim and considered the doctrine of equivalents.

At the beginning of the trial, Judge Rader selected a jury panel from the audience. This method simulated a normal jury selection, because in the United States, we select juries from the general population. Instead of looking for people with expertise in the subject matter of the litigation or knowledge of the litigation, judges and attorneys look for unbiased jury members.

Although we presented the mock trial to many Japanese professionals, counsel for both sides addressed the case to the jurors in the court. The outcome of the case will be determined by the jury based on what they perceive to be the case. For the mock trial, the jury had an extremely short time to deliberate. In a real trial, a jury takes hours and even days to reach a verdict.

VI. CONCLUSION

During the preparation and throughout the trial, our goal was to demonstrate a U.S. patent infringement trial in a limited time. While many stages in a patent infringement trial were eliminated or abbreviated, we believe the mock trial conveyed to the audience a general sense of a U.S. patent infringement trial.