

Date	January 25, 2017	Court	Intellectual Property High Court, Third Division
Case number	2015 (Gyo-Ke) 10230		
– A case in which the court clarified who shall bear the burden of allegation and proof with regard to a usurped application, presented determination criteria, and thereby made a determination based on said criteria.			

References: Article 123, paragraph (1), item (vi) of the Patent Act prior to amendment by Act No. 63 of 2011

Numbers of related rights, etc.: Patent No. 4958194, Invalidation Trial No. 2014-800187

### Summary of the Judgment

#### 1. Background, etc.

In this case, the plaintiff sought rescission of a JPO decision that dismissed a request for a trial for invalidation of a patent (the "Patent") for the invention made by the defendant titled "method for manufacturing jet nozzle pipe and jet nozzle pipe manufactured using same" (Claims 1 to 3). Claims 1 and 2 of the Patent are about different inventions pertaining to "method for manufacturing jet nozzle pipe," while Claim 3 is about an invention pertaining to "jet nozzle pipe manufactured using the method specified in Claim 1 or 2."

In the trial for invalidation of the Patent, regarding the inventions specified in Claims 1 to 3 (the "Inventions"), the plaintiff alleged that the inventor thereof is not the defendant but the plaintiff and that there are grounds of a usurped application for requesting a trial for invalidation of the Inventions (Article 123, paragraph (1), item (vi) of the Patent Act prior to amendment by Act No. 63 of 2011). However, the JPO made a decision to dismiss the request by holding that the Inventions can be considered to have been made by the defendant and that the Patent was not granted for a usurped application.

The court rescinded the JPO decision on the grounds of an error in its determination that the defendant is the inventor of the Inventions.

#### 2. Outline of this judgment

In this judgment, the court presented its interpretation that, in a trial for patent invalidation requested on the grounds of a usurped application, it is the patentee that bears the burden of allegation and proof with regard to the fact that "the patent application was filed by the inventor of the invention for which a patent was sought or by a person to whom the right to obtain a patent was assigned from the inventor." The court also presented determination criteria by holding that, even if such interpretation is

adopted, it would not mean that the patentee of an invention who faces such trial is always required to present independent, specific, concrete, and detailed allegation and proof with regard to how the invention was made. Furthermore, the court held that the required breadth and depth of the patentee's allegation and proof should be determined based on the nature of the specific grounds to allege that the patent was granted based on a usurped application and also based on the breadth and depth of the allegation and proof of the person who requested a trial for invalidation, and also that, if the person who requested a trial for invalidation fails to provide any specific grounds to allege that the patent was granted based on a usurped application and also fails to provide any evidence for such allegation, the patentee is merely required to provide relatively simple allegation and proof. Whereas, if the person who requested a trial for invalidation provides specific grounds to allege that the patent was granted based on a usurped application and also provides evidence for such allegation, the patentee cannot be considered to have fulfilled the burden of allegation and proof unless the patentee provides allegation and proof that outweigh the allegation and proof provided by the former.

Furthermore, in this judgment, the court held that, before making a determination as to whether the grounds for rescission exist in this case based on the aforementioned determination criteria (an error in the JPO's determination concerning the inventor), it is necessary to examine the breadth and depth of the allegation made by the plaintiff, who alleged that the patent was granted based on a usurped application, based on the premise that the defendant, who is the patentee, bears the burden of allegation and proof with regard to the alleged fact that it is the defendant that made the Inventions, in order to provide possible grounds for such suspicion (in other words, the grounds to prove that it is not the defendant but the plaintiff that made the Inventions). It is also necessary to examine whether the plaintiff provided evidence to prove such allegation. The court subsequently examined and determined whether the defendant provided allegation and proof that outweigh the plaintiff's allegation and proof so that the defendant can be recognized as the inventor.

Consequently, in this judgment, the court examined the plaintiff's allegation and proof and found that, as far as the invention pertaining to the method specified in Claim 1 (Invention 1) is concerned, the plaintiff provided specific allegation to the effect that the plaintiff is the inventor of Invention 1 (in other words, specific grounds for suspecting usurpation) and also provided evidence such as email and relevant parties' statements to prove the allegation. However, the court found that, as far as the invention pertaining to the method specified in Claim 2 (Invention 2) is concerned, the plaintiff

failed to make any specific allegation to the effect that the plaintiff is the inventor of Invention 2 and also failed to provide evidence to prove such allegation.

Furthermore, regarding the defendant's allegation and proof, the court held, in this judgment, that there is only insufficient evidence to prove the defendant's allegation concerning Invention 1 and that the defendant cannot be considered to have provided allegation and proof that outweigh the plaintiff's allegation and proof with regard to the alleged fact that the inventor of Invention 1 is not the plaintiff but the defendant. On the other hand, regarding Invention 2, the court held that, unlike Invention 1, it would suffice for the defendant to provide relatively simple allegation and proof of the inventorship of the defendant. The court found that, although the only evidence that can contribute to proving the defendant's allegation is the statements given by relevant parties on the side of the defendant, since the content of those statements is specific and does not contain any information that contradicts other evidence, the court cannot find any grounds to actively question the reliability of the statements and can consider those statements as legitimate evidence to prove the defendant's allegation. For this reason, the court concluded that the defendant provided allegation and proof that is sufficient enough to fulfill the aforementioned requirements.

Moreover, in this judgment, the court examined Invention 3 and held that, in view of the facts that the defendant cannot be considered to have provided sufficient allegation and proof to the effect that the defendant is the inventor of the method of Invention 1 and that Invention 3 is an invention made of a jet nozzle manufactured by using the method of Invention 1 and a jet nozzle manufactured by using the method of Invention 2, the defendant cannot be considered to have provided sufficient allegation and proof to the effect that the defendant is the inventor of Invention 3 as a whole.

Thus, the court found that, as far as Invention 2 is concerned, the defendant can be considered to be the inventor, while, as far as Inventions 1 and 3 are concerned, the defendant cannot be considered to be the inventor. On these grounds, the court rescinded a part of the JPO decision that pertains to Claims 1 and 3 of the Patent.