

Date	November 19, 2009	Court	Intellectual Property High Court, Fourth Division
Case number	2009 (Gyo-Ke) 10148		
<p>With regard to a request for trial concerning the right to obtain a patent which is jointly owned, even when the attorney, who is mandated respectively by all of the joint owners to perform this task, has submitted a written request for trial which seemingly indicates that it is made on behalf of only part of the joint owners, unless there are special circumstances where the attorney had no option but to perform such an unreasonable act, it is appropriate to presume that the request for trial has been made on behalf of all of the joint owners.</p>			

References:

Articles 132 and 133 of the Patent Act

1. X1 and X2 filed a patent application claiming an invention entitled "lithium secondary battery and manufacturing method of lithium secondary battery," which was refused by the examiner of the Japan Patent Office (JPO). Patent Attorney K, who represents both X1 and X2, made a request for a trial against the examiner's decision of refusal, with a written request for trial in which only X1 was stated as the demandant of trial and X2 was not stated. In this lawsuit, X1 and X2 seek rescission of the JPO trial decision that dismissed this request for trial.

2. The court found that X2 had standing to sue, and upheld the claim of X1 and X2, holding as follows.

(1) When an attorney, who represents all of the joint owners of the right to obtain a patent, makes a request for a trial on behalf of all of them, needless to say, the attorney should state, in the demandant column of the written request, the names of all of the joint owners as the parties. On the other hand, where a request for a trial has been made by an attorney who represents all of the joint owners of the right to obtain a patent, whether or not the trial has been "jointly requested" by all of the joint owners should not be determined merely by referring to the statement in the demandant column of the written request, but should be determined comprehensively by inquiring into the entire import of the written request in a reasonable manner and taking into consideration other matters such as the circumstances that the JPO could have known in relation to the patent application.

With regard to a request that, as a legal requirement, needs to be made by all of the joint owners, such as a request for a trial concerning the right to obtain a patent which is jointly owned, if an attorney, who is mandated respectively by all of the joint owners to perform this task, makes a request for trial only on behalf of part of those joint

owners, while omitting to do so on behalf of the other joint owners, such conduct would undermine the interest of all of the joint owners, and this is as if the attorney him/herself created a procedural defect in the request for trial and resulted in making the decision of refusal final and binding. Reasonably thinking, it is unimaginable for the attorney to do such a thing. Assuming so, unless there are special circumstances where the attorney has no choice but to perform such an unreasonable act, even when a request for trial seemingly indicates that it is made on behalf of only part of the joint owners, it is appropriate to presume that the request for trial is in fact made on behalf of all of the joint owners.

(2) Given the facts of the case, the JPO could have known that Patent Attorney K had the right of representation in making a request for trial on behalf of both X1 and X2. Accordingly, in this case where there are no such special circumstances where the attorney had no option but to perform such an unreasonable act, although the statement in the written request for trial does not clearly indicate that the request is made on behalf of X2 as well, it is presumed to have been made on behalf of both X1 and X2, and the request for trial made by the attorney should be construed to be legally effective for both principals, X1 and X2. The JPO decision that dismissed the request for trial is illegal in that the chief trial examiner did not order an amendment to be made for the written request for trial but immediately dismissed the request for trial.