

**Judgments of Tokyo District Court, 47th Civil Division**

**Date of the Judgment: 2005.9.13**

**Case Number: 2004(Wa)No.14321**

**Title (Case):**

A case wherein the court determined that the person stated as an inventor in the patent gazette cannot be deemed to be an inventor as defined by Article 35 of the Patent Act

**Summary of the Judgment:**

In this case, the plaintiff, who was the head of the pharmaceutical research division and the pharmaceutical research laboratory of the defendant, a pharmaceutical company, seeks from the defendant one billion yen as part of the remuneration for the employee's invention entitled "film-coated dividable tablet," for which a patent right has been granted. In the patent gazette of the patent right, the name of the plaintiff's subordinate, A, as well as the plaintiff's name are stated as the names of the inventors.

The defendant, in accordance with its rules of employment and standards of compensation for employees' inventions, paid the plaintiff compensation for the invention, namely, 5,000 yen as compensation for patent filing and 10,000 yen as compensation for patent registration.

The court, holding that based on the definition of an "invention," i.e. "highly advanced creation of technical ideas by which a law of nature is utilized" (Article 2(1) of the Patent Act), a true inventor (joint inventor) must have been actually involved in the creation of the technical ideas for the invention, determined that the following cannot be deemed to have been actually involved in the creation of technical ideas and therefore should be excluded from the scope of joint inventors: (i) a person who has merely provided general management for the inventor (mere manager), e.g. merely given the inventor general research themes without a specific concept, general guidance in the course of the creation of the invention, or abstract advice for the solution of the problem; (ii) a person who has merely followed the inventor's instructions or assisted the inventor (mere assistant), e.g. merely compiled data, prepared documents, or conducted experiments; (iii) a person who has merely supported the inventor in completing the invention (mere supporter), e.g. provided the inventor with funds or allowed the inventor to use equipment.

The court further held as follows. The present invention relates to a film-coated dividable tablet that can be divided easily and evenly, which is designed to prevent problems that may occur in the film coating process such as twinning, core erosion, and edge chipping. At the time of the creation of the present invention, dividable tablets did exist, e.g. Parlodel tablets produced by a Swiss corporation and Cardenalín tablets

produced by the defendant, but film-coated dividable tablets had not yet been put into practical use. The present invention has embodied a direction in which the problems with film-coated dividable tablets mentioned above will be able to be resolved through repeated experiments.

Based on the facts found, in June 1993, A started to explore a shape of Norvasc tablet and promoted the development thereof based on the shape of the Cardenalín tablet that had already been completely developed, by preparing a development plan and conducting experiments and tests by him/herself, and finally embodied the direction for the solutions to the problems. On the other hand, there is no evidence to prove that the plaintiff conceived the shape of the tablets, nor is there any objective evidence to prove that the plaintiff conducted experiments by him/herself or gave A instructions on the details of experiments. As a matter of fact, the plaintiff did not even observe the conducting of important experiments.

As described above, A made the greatest technical contribution to the creation of the technical ideas for the present invention, whereas the plaintiff cannot be deemed to have formed a specific concept for the present invention but should be deemed to have merely provided general management by giving general guidance in the course of the creation of the invention. Consequently, the plaintiff cannot be deemed to have been actually involved, beyond the bounds of general management, in the creation of the technical ideas to the extent that he/she deserves to be recognized as an inventor, and therefore cannot be regarded as a true joint inventor of the present invention. Based on this conclusion, the court hereby dismissed the plaintiff's claim.

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