

Judgments of Intellectual Property High Court, Third Division

Date of the Judgment: 2006.1.19

Case Number: 2005 (Gyo-Ke) No.10193

Title (Case):

A case wherein the court judged that the JPO was correct in deciding that the patent in dispute was obtained by misappropriation and should therefore be invalidated under Article 123, para1, item 6 of the Patent Act

Reference: Article 123, para1, item 6 of the Patent Act

Summary of the Judgment:

The plaintiff is the owner of the patent on an invention named, "Spray planting materials and spray planting method." Having received the defendant's request for invalidation of the plaintiff's patent, the JPO made a decision that the patent should be invalidated under Article 123, para1, item 6 of the Patent Act. Dissatisfied with this decision, X instituted this lawsuit in order to seek revocation of that decision.

The court judged that the JPO was correct in making the decision to invalidate the patent. Regarding the distribution of the burden of proof in the JPO invalidation procedure commenced on the grounds that the patent in dispute was obtained by a misappropriated application, the court held as follows:

The Patent Act allows only the inventor or the successor thereto to obtain a patent by specifying that, "any person who has made an invention ... may obtain a patent" in Article 29, para.1, and that although "the right to obtain a patent may be transferred" (in Article 33, para.1), "the succession to the right to obtain a patent before the filing of the patent application shall not be effective against third persons unless the successor in title files the patent application" in Article 34(1). Under such "inventor-based" patent system, all patent applicants need to bear the burden for going forward with the evidence to prove that he is qualified for filing a patent application. This necessity is obvious from the fact that Article 36, para.1, item 2 of the Patent Law requires each applicant to state in the application form "the name and the address or location of the inventor" and that an applicant is required under Article 5, para.2 of the Ordinance for Enforcement of the Patent Act to submit a certificate of transfer or any other written document that certifies the succession if so requested by the JPO.

Article 123, para.1 of the Patent Act lists the cases where a request may be filed for the JPO's invalidation procedure. Item 6 of the said act specifies that such procedure may be requested "where the patent has been granted on a patent application filed by a person who is not the inventor and has not succeeded to the right to obtain a patent for the invention concerned." In view of the fact that the Patent Act has adopted such inventor-based system as mentioned above, if the JPO's invalidation procedure is

requested for a patent under Article 123, para.1, item 6 of the said act, the patentee (patent applicant or the successor) must bear the burden for going forward with the evidence to prove that the patent application was filed by the inventor of the invention or by any person who has succeeded to the right to obtain a patent on the invention from the inventor.

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