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judgedate

2017.07.10

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caseid

2016(Ju)632

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reporter

Minshu Vol. 71 No. 6

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casetitle

Judgment on whether or not a patentee, despite his failure to assert a re-defense of correction before the close of the oral argument at the trial court, is permitted to contest the trial court's ruling on the grounds that a trial decision requiring a correction of the scope of claims as referred to in Article 104-4, item (iii) of the Patent Act subsequently became final and binding.

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casename

Case seeking injunction of patent right infringement

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caseresult

Judgment of the Second Petty bench, dismissed

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court_second

Intellectual Property High Court, Judgment of December 16, 2015

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summary_judge

Unless there were convincingly compelling, and exceptional, circumstances that prevented him from asserting a re-defense of correction, a patentee who failed to assert a re-defense of correction (i.e., a re-defense based on the grounds that the correction will resolve the cause of invalidation asserted in the defense of invalidation submitted under Article 104-3, paragraph (1) of the Patent Act) before the close of the oral argument at the trial court is not permitted to contest the trial court's ruling on the grounds that a trial decision requiring a correction of the scope of claims as referred to in Article 104-4, item (iii) of the same act subsequently became final and binding, in light of the intent of the provisions of Articles 104-3 and 104-4 of the same act since permitting this would unreasonably delay a resolution of the dispute involving patent right infringement.

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references

Articles 104-3, 104-4, 126 and 134-2 of the Patent Act, and Article 338, paragraph (1),

item (viii) of the Code of Civil Procedure

Patent Act

Article 104-3 (1) Where, in litigation concerning the infringement of a patent right or an exclusive license, the said patent or the registration of extension of the duration of the said patent right is recognized as one that should be invalidated by a trial for patent invalidation or for invalidation of a registration of extension, respectively, the rights of the patentee or exclusive licensee may not be exercised against the adverse party.

(2) Where the court considers that the materials used for an allegation or defense under the preceding paragraph are submitted for the purpose of unreasonably delaying the proceedings, the court may, upon a motion or ex officio, render a ruling to the effect that the allegation or the defense is to be dismissed.

(3) The provisions of Article 123, paragraph (2) shall not preclude persons other than those who are eligible to demand a trial for patent invalidation with regard to the invention under the patent from submitting materials for an allegation or defense under paragraph (1).

Article 104-4 If any of the following decisions or trial decisions become final and binding after the final judgment in litigation claiming infringement of a patent right or an exclusive license or claiming payment of compensation as referred to in Article 65, paragraph (1) or Article 184-10, paragraph (1) has become final and binding, the parties to such litigation may not assert that such decision or trial decision became final and binding in any action for retrial against such final judgment (including any action whose purpose is to claim damages from a creditor in a case of provisional

seizure order whose merits is the above action and any action whose purpose is to claim damages and return of unjust enrichment from a creditor in a case of provisional disposition order whose merits is the above action):

(i) a decision or trial decision to the effect that the relevant patent should be revoked or invalidated, respectively;

(ii) a trial decision to the effect that the registration of extension of the duration of the said patent right should be invalidated; or

(iii) a decision or trial decision to the effect that the description, scope of claims or drawings attached to the application for the said patent should be corrected and which is specified by Cabinet Order.

Article 126 (1) The patentee may file a request for a trial for correction with regard to the correction of the description, scope of claims or drawings attached to the application; provided, however, that such correction shall be limited to the following:

(i) restriction of the scope of claims;

(ii) correction of errors in the description or incorrect translations;

(iii) clarification of an ambiguous statement; and

(iv) modification of a statement in a claim referring to a statement in another claim to one that does not refer to the said statement in such another claim.

(2) A request for a trial for correction may not be filed from the time the relevant opposition to the patent or the relevant trial for patent invalidation has become pending before the Patent Office to the time the decision or trial decision (or the decisions or trial decisions on all of the relevant claims if an opposition or request was filed with regard to any of the claims covered by the patent) has become final and binding.

(3) Where the patentee intends to correct the scope of claims attached to the application containing two or more claims, the patentee may file a request under paragraph (1) with regard to any of the claims. In such a case, if such claims contain series of claims, such a request shall be made with regard to any of the series of claims.

(4) Where the patentee intends to correct the description or drawings attached to the application and to make a request under paragraph (1) with regard to any of the claims, the patentee shall make a request with regard to all claims relevant to the correction of the said description or drawings (or all series of claims containing the claims relevant to the correction of the said description or drawings, if the patentee makes a request under paragraph (1) with regard to any of the series of claims pursuant to the second sentence of the preceding paragraph).

(5) The correction of the description, scope of claims or drawings under paragraph (1) above shall remain within the scope of the matters disclosed in the description, scope of claims, or drawings attached to the application (in the case of correction for the purposes provided in item (ii) of the proviso to paragraph (1), the description, scope of claims and drawings originally attached to the application (in the case of a patent with regard to a foreign language written application, foreign language documents)).

(6) The correction of the description, scope of claims or drawings under paragraph (1) shall not substantially enlarge or alter the scope of claims.

(7) In the case of correction for any of the purposes as provided in item (i) or (ii) of the proviso to paragraph (1), an invention constituted by the matters described in the corrected scope of claims must be one which could have been patented independently at the time of filing of the patent application.

(8) A request for a trial for correction may be filed even after the lapse of the patent right; provided, however, that this shall not apply after the patent has been revoked by

a decision to revoke the patent or has been invalidated in a trial for patent invalidation.

Article 134-2 (1) The demandee in a trial for patent invalidation may file a request for a correction of the description, scope of claims or drawing(s) attached to the application only within the time limit designated in accordance with paragraph (1) or (2) of the preceding Article, the following Article, Article 153, paragraph (2) or Article 164-2, paragraph (2); provided, however, that such correction shall be limited to the following purposes:

(i) restriction of the scope of claims;

(ii) correction of errors in the description or of incorrect translations;

(iii) clarification of an ambiguous statement; and

(iv) modification of a statement in a claim referring to a statement in another claim to one that does not refer to the said statement in such another claim.

(2) Where the patentee intends to correct the scope of claims attached to the application containing two or more claims, the patentee may file a request under paragraph (1) with regard to any of the claims; provided, however, that where a trial for patent invalidation is demanded with regard to any of the claims, a request for correction shall be made with regard to any of such claims.

(3) In the case of the preceding paragraph, if the relevant claims contain series of claims, such requests shall be made with regard to such respective series of claims.

(4) Upon receipt thereof, the chief trial examiner shall serve to the demandant a copy of the written request for correction as well as the corrected description, scope of claims or drawings attached to the request under paragraph (1).

(5) The trial examiner may examine grounds that have not been pleaded by any of the

parties to or interveners in the case in determining whether the request for correction under paragraph (1) is not for any of the purposes provided in the items of the proviso to the said paragraph, or does not conform to the provisions of paragraphs (5) to (7) of Article 126 that shall be applied mutatis mutandis upon reading the specified terms in accordance with paragraph (9). In such a case, where the request for correction on the above grounds is not approved of, the chief trial examiner shall notify the parties to and the interveners in the case of the results of the proceedings and shall give them an opportunity to state their opinions, designating an adequate time limit.

(6) Where a request for correction under paragraph (1) is made, if another request for correction has been previously made in the said trial, such previous request shall be deemed to have been withdrawn.

(7) A request for correction under paragraph (1) may be withdrawn only during the period when amendment under Article 17-5, paragraph (2) is allowed to be made to the corrected description, scope of claims or drawings attached to the written request for correction under paragraph (1). In such a case, if a request for correction under paragraph (1) has been made with regard to any of the claims or any of the series of claims pursuant to paragraph (2) or (3), respectively, the request shall be withdrawn with regard to all of the relevant claims.

(8) If a request for patent invalidation is withdrawn with regard to any of the claims covered by the patent pursuant to Article 155, paragraph (3), any request for correction under paragraph (1) shall be deemed to have been withdrawn with respect to the relevant claims. If all claims subject to a trial case of patent invalidation are withdrawn, any request for correction under the said paragraph shall be deemed to have been withdrawn with respect to all claims.

(9) Articles 126, paragraphs (4) to (8), Articles 127 and 128, Article 131, paragraphs (1),

(3) and (4), Article 131-2, paragraph (1), Article 132, paragraphs (3) and (4), and Article 133, paragraphs (1), (3) and (4) shall apply mutatis mutandis to the case of paragraph (1). In this case, the term "item (i) or (ii) of the proviso to paragraph (1)" in Article 126, paragraph (7) shall be deemed to be replaced with "item (i) or (ii) of the proviso to paragraph (1) pertaining to a claim or claims for which a request for a trial for patent invalidation is not filed."

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maintext

The final appeal shall be dismissed.

The costs of the final appeal shall be borne by the appellant.

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reason

Reasons for the petition for acceptance of final appeal filed by the counsels for the appeal, SAMEJIMA Masahiro, KOTANI Taizo and YAMAMOTO Mayuko

1. An outline of the facts related to the case which duly became final and binding in the judgment of prior instance and the circumstances leading up to this case as shown in relevant records are as described below:

(1) Patent right

The appellant is the patentee of the patent covering the invention whose title is "Sheet cutter" (Patent No. 5374419, containing one claim; hereinafter this patent is referred to as the "Patent" and the patent right with respect to the Patent as the "Patent Right").

(2) Circumstances during the first instance

In December 2013, the appellant filed against the appellee, who sold the tools listed in the list of items shown in the exhibit to the judgment of first instance, the present action seeking injunction of such sale and claiming damages and other relief based on the Patent Right.

The appellee asserted a defense under Article 104-3, paragraph (1) of the Patent Act (hereinafter referred to as the "defense of invalidation") on the grounds that the reason for invalidation listed in Article 123, paragraph (1), item (i) or (iv) exists with regard to the Patent. In October 2014, however, the court of first instance rendered a judgment which rejected the appellee's defense of invalidation on the above grounds and accepted part of the appellant's claims.

(3) Circumstances during the prior instance

The appellee appealed against the judgment of first instance and, in the statement of reasons for appeal dated December 26, 2014, asserted a new defense of invalidation on the grounds that the Patent had been obtained in violation of Article 29, paragraph (1), item (iii) or paragraph (2) of the Patent Act and that the reason for invalidation listed in Article 123, paragraph (1), item (ii) of the same act thus exists with regard to the Patent (hereinafter the defense based on these grounds is referred to as the "Defense of Invalidation").

After a total of four dates for preparatory proceedings, the court of prior instance closed the oral argument on the first date for oral argument in November 2015. The appellant did not, before the close of the oral argument at the court of prior instance, assert a re-defense against the Defense of Invalidation on the grounds that a correction will resolve the reason for invalidation on which the defense of invalidation was based (hereinafter referred to as the "re-defense of correction").

On December 16, 2015, the court of prior instance rendered a judgment which accepted

the Defense of Invalidation, revoked such part of the judgment of first instance as against the appellee, and rejected all of the appellant's claims, on the grounds that the Patent was obtained in violation of Article 29, paragraph (1), item (iii) of the Patent Act.

(4) Circumstances after the delivery of the judgment of prior instance

The appellant filed a final appeal and a petition for acceptance of final appeal and, on January 6, 2016, requested a trial for correction to correct the scope of claims covered by the Patent (Correction Case No. 2016-390002). In October the same year, the Patent Office made a trial decision to the effect that such correction should be made (hereinafter referred to as the "Trial Decision for Correction"). The Trial Decision for Correction became final and binding around then.

(5) Circumstances, etc. during the trial for patent invalidation

During the pendency of the present case at the court of first instance, the appellee requested a trial for patent invalidation on the grounds of the existence of the reason for invalidation described in (2) above with regard to the Patent (Invalidation Case No. 2014-800004). In July 2014, the Patent Office made a trial decision that the request was unacceptable (hereinafter referred to as the "Other Trial Decision"). In August the same year, the appellee filed an action for revocation of trial decision seeking a revocation of the Other Trial Decision. On December 16, 2015, however, the Intellectual Property High Court rendered a judgment which rejected the appellee's claims. The judgment became final and binding by January 6, 2016.

As described above, at the time when the Defense of Invalidation was asserted at the court of prior instance, the action for revocation of trial decision was already pending against the Other Trial Decision, which did not subsequently become final and binding until January 6, 2016. For these reasons, the appellant was prevented, before the close

of the oral argument at the court of prior instance, from filing a request for a trial for correction or a request for correction in the trial for patent invalidation in order to make corrections intended to resolve the reason for invalidation on which the Defense of Invalidation was based (Article 126, paragraph (2) and Article 134-2, paragraph (1) of the Patent Act).

2. The appellant argues that the ground for retrial listed in Article 338, paragraph (1), item (viii) exists since the administrative disposition based on which the judgment of prior instance was made has been modified by a subsequent administrative disposition as a result of the Trial Decision for Correction having become final and binding during the pendency of the present case at the final appellate court and the scope of claims covered by the Patent having been restricted, and that the judgment of prior instance thus contains a violation of law that obviously affects the judgment.

3. (1) In a patent infringement suit, the adverse party may assert a defense of invalidation, whereas the patentee may assert a re-defense of correction. It is understood that the intention of Article 104-3, paragraph (1) of the Patent Act, which allows a defense of invalidation to be asserted without waiting for a trial decision for invalidation rendered in patent invalidation trial proceedings to become final and binding, is to resolve any dispute involving patent right infringement as promptly as possible within the proceedings of a patent infringement suit. It is then understood that the intention of paragraph (2) of the same article, which authorizes the court to dismiss a defense of invalidation if the court considers that the defense is asserted for the purpose of unreasonably delaying the proceedings, is to prevent the occurrence of delays in the proceedings caused by hearing and judging on the defense of invalidation. These understandings should be the same for a re-defense of correction (see Supreme Court, 2006 (Ju) 1772, Judgment of the First Petty bench of April 24, 2008, Minshu Vol.

62, No. 5, p. 1262).

In addition, the intention of Article 104-4 of the Patent Act, which, if a trial decision to the effect that the scope of claims should be corrected, among others, as listed in item (iii) of the same article (hereinafter simply referred to as a "trial decision for correction, etc.") becomes final and binding after the final judgment on a patent infringement suit has become final and binding, precludes the parties to the patent infringement suit from asserting the fact that the trial decision for correction, etc. became final and binding in any action for retrial against such final judgment, is to ensure that any dispute involving patent right infringement is resolved at one time based on the fact that, as described above, a re-defense of correction is allowed to be asserted against a defense of invalidation in a patent infringement suit.

Even if the final judgment on a patent infringement suit has not become final and binding, if the patentee, despite his failure to assert a re-defense of correction before the close of the oral argument at the trial court, is permitted to contest the trial court's ruling on the grounds that a trial decision for correction, etc. subsequently became final and binding, this would have the same effect as permitting the hearing and judgment made at the trial court to be repeated all over again, as is the case with permitting the parties to a patent infringement suit to assert, in an action for retrial against the final judgment on their patent infringement suit, that a trial decision for correction, etc. became final and binding.

It should then be considered that, unless there were convincingly compelling, and exceptional, circumstances that prevented him from asserting a re-defense of correction, a patentee who failed to assert a re-defense of correction before the close of the oral argument at the trial court is not permitted to contest the trial court's ruling on the grounds that a trial decision for correction, etc. subsequently became final and

binding, in light of the intent of the provisions of Articles 104-3 and 104-4 of the Patent Act since permitting this would unreasonably delay a resolution of the dispute involving patent right infringement.

(2) Let us apply the above discussion to this case. According to the facts related to the case described above, the appellant did not, before the close of the oral argument at the court of prior instance, assert a defense of correction against the Defense of Invalidation asserted at the court of prior instance. Up to the close of the oral argument at the court of prior instance, the appellant had been prevented by law from filing a request for a trial for correction or a request for correction in order to make corrections intended to resolve the reason for invalidation on which the Defense of Invalidation was based. However, under the circumstances described in 1.(5) above, such as that the Other Trial Decision had not become final and binding because an action for revocation of trial decision, which involved reasons for invalidation other than the reason for invalidation on which the Defense of Invalidation was based and which was newly asserted at the court of prior instance, was already pending against the Other Trial Decision, it should be considered that it was not necessary for the appellant to have actually filed these requests in order to assert a re-defense of correction against the Defense of Invalidation. It thus cannot be considered that these circumstances prevented the appellant from asserting a re-defense of correction against the Defense of Invalidation at the court of prior instance. No other convincingly compelling, and exceptional, circumstances are found that would have prevented the appellant from asserting a re-defense of correction.

4. For the above reasons, the judgment of prior instance does not contain the violation of law asserted by the appellant, and the appellant's reasons for the petition are unacceptable. Accordingly, the Court unanimously decides as set forth in the main

text.

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presiding

Justice YAMAMOTO Tsuneyuki

Justice ONUKI Yoshinobu

Justice ONIMARU Kaoru

Justice KANNO Hiroyuki

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note_other

(This translation is provisional and subject to revision.)