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Date of the judgement

1976.03.10

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Case Number

1967(Gyo-Tsu)28

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Reporter

Minshu Vol. 30, No. 2, at 79

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Title

Judgment upon the permissibility of asserting a cause for invalidating a patent in relation to publicly-known facts which were not put for appeal/trial examination and judgment in an appeal to the determination for invalidation of a patent in a lawsuit for revocation of an appeal/trial decision

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Case name

Action for revocation of an appeal to the determination

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Result

Judgment of the Grand Bench, ruling the argument to be groundless

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Court of the Second Instance

Tokyo High Court, Judgment of December 13, 1966

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Summary of the judgement

It is not permissible to assert a cause for invalidating a patent in relation to publicly-known facts that were not put for appeal/trial examination and judgment in an appeal to the determination for

invalidation of a patent in a lawsuit for revocation of an appeal to the determination.

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References

Article 1 of the Old Patent Law (Law No. 96 of 1921)

A person who works out a novel industrial invention is entitled to be granted a patent in connection with the said invention.

Article 4 of the said law

In order that there be novelty in the meaning of this law, an invention must not fall under any of the following cases:

1. The thing publicly-known or publicly used in the country before the application

2. The thing described in a publication circulated in the country before the application to the extent that it is easy to implement

Article 57, Paragraph 1, Item 1, Item 2, Item 3

Any patent that falls under any of the following cases must be invalidated through an examination :

1. Where the patent was granted in contravention of the provisions set forth in Article 1 to Article 3, Article 8, or Article 32;

2. Where the patent was granted to a person who was not a successor entitled to the patent right or a person who infringed the right to the granting of a patent;

3. Where a specification or drawings related to the invention protected under a patent falls short of the description necessary to implement the said invention or contains unnecessary descriptions that make the implementation thereof impossible or difficult.

Article 86 of the said law

An action for an examination must be brought by submitting a written motion for the examination.

A written motion must contain a stated case and reasons.

Article 117 of the said law

Whenever a finalized examination decision regarding a patent or the validity of permission under Article 53... is kept on the registry, no one can bring an action to seek the same appeal/trial based on the same facts and the same evidence.

Article 128-5 of the Old Patent Law (Law No. 96 of 1921)
The court must revoke an appeal/trial decision or decision if it finds an action brought to be grounded.
In the case of the preceding paragraph, appeal examiners in charge of the appeal to the determination must conduct further examination to reach the determination or decision.
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Main text of the judgement

Point 5 in the Statement of Reasons for a Jokoku -Appeal is hereby ruled to be groundless.
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Reasons

Regarding point 5 in the Statement of Reasons for a Jokoku -Appeal presented by Attorney Iwao Niinaga:
The essence of the Statement of Reasons for an Appeal is as follows: regarding the facts asserted by the appellants before the Patent Office and the court below, the original judgment that does not show judgment in this respect on the ground that the said facts were not put for examination and judgment before the Patent Office is illegal, representing a misapplication of the law and goes against the Supreme Court precedent (the Judgment of the Second Petty Bench upon the said agency Case 1951 (O) No. 745 rendered on October 16, 1953, Saibanshu-Minji No. 10, at 189).
According to the old Patent Law (Law No. 96 of 1921; hereinafter referred to as "the law") applicable to this case, it is stipulated that the stake-holder who claims that there is a cause for invalidating a particular patent may seek an appeal to the determination for invalidation of the relevant patent (Article 84), that with regard to a determination reached in the said appeal to the determination or the result of examination of the relevant application, the party subject to such decision or examination may seek an appeal to the determination (Article 109), and on the other hand, that a lawsuit regarding a matter which can be addressed by seeking an examination or appeal to the determination can be instituted only as a lawsuit against an determination of the appeal reached in the appeal to the determination (Article 128-2, Paragraph 4), AND, that a lawsuit against an determination of the appeal reached in an appeal to the determination shall fall under the exclusive jurisdiction of the Tokyo High Court (Paragraph 1 of the said article). Furthermore, it is stipulated that when there are found to be grounds for an action entered in the said lawsuit, the court is to revoke the relevant the determination, and once the said revocation is effected, the appeal to the determination in charge of the relevant appeal to the determination are required to conduct an examination and reach a decision (Article 128-5). In these respects, it

is recognized that in the case where an administrative disposition, namely, a decision to grant a patent or a decision of refusal through examination was wrongly effected, the law calls for the completed procedures for the examination and appeal to the determination (in the case of an examination, only the appeal to the examination) presided over by appeal examiners with expertise and experience in any case to be used as the procedures for redressing such disposition, unlike the case with general administrative dispositions, while prescribing that a lawsuit for revocation may be instituted, not against a decision to grant a patent or a decision of refusal through examination as the original disposition, but against a determination reached in the appeal to the determination, and in the said lawsuit, the law limits the point at issue to nothing but the legality or illegality of the said determination while allowing the propriety of a patent granted or an application rejected through examination to be indirectly challenged only from the perspective of whether a determination reached in the appeal to the determination is proper or not.

Next, in reference to the procedures for the appeal to the determination or examination set forth by the law, concerning an action seeking an appeal/trial to invalidate a particular patent, it is stipulated that a specified form of written motion for an examination describing a stated case and reasons shall be filed (Article 86), that concerning the written motion filed, a duplicate thereof shall be served on the respondent to give an opportunity to file a written statement of defense (Article 88, paragraph 1), that in an appeal, reasons other than ones stated in the written motion may be also examined, but in such case, the parties should be given opportunities to state their cases with regard to such reasons (Article 103), while the law lays down procedures similar to civil proceedings, including exclusion, challenge of appeal examiner(s) involved in the appeal/trial (Article 91 to Article 96), an open oral examination system (Article 97), participation of stake-holders (Article 98, 99), examination of evidence (Article 100) and so on, and prescribes that these provisions shall be applied mutatis mutandis to the appeal. In this respect, it is clear that as far as an appeal/trial for invalidation of a patent is concerned, the law requires the cause for invalidating the patent contested therein to be specified and clarified for the parties, and as far as the procedures for the examination are concerned, the law employs such structured procedures that the said specified cause for invalidating the relevant patent is contested in offense and defense, AND the appeal examiners examine and judge nothing but this point at issue; it is understood that Article 117 of the law providing that "whenever a finalized appeal/trial decision regarding a patent or the validity of permission under Article 53 is kept on the registry, no one can bring an action to seek the same appeal/trial based on the same facts and the same evidence," because along with the said structured procedures, it intends to give a finalized appeal/trial decision the effect of non bis in idem in a practical sense with regard to

matters actually judged therein. In addition, the reason why the law prescribes that a lawsuit for revocation of a determination reached in an examination shall fall under the exclusive jurisdiction of the Tokyo High Court while allowing for one less instance in fact-finding proceedings, must rest on the grounds that with regard to the existence/non-existence of the relevant cause of invalidation, thorough examination was completed with the participation of the parties during the examination and the examination for appeal proceedings.

It should be construed as the purport of the law that in referring to the structure and nature of an opposition system and appeal/trial proceedings concerning patent-related decisions set forth by the law as described above, in the case of a lawsuit for revocation of a determination reached in an appeal to the determination for invalidation of a patent where the judgment thereof is contested in terms of illegality, the issue that was actually contested in the relevant appeal/trial proceedings and related to a specific cause for invalidation examined and judged should be exclusively the subject matter for the appeal/trial examination while other causes for invalidation cannot be asserted as reasons for contending the illegality of the relevant appeal/trial decision in the said lawsuit and brought before the court for judgment.

Then, referring to the specification of the cause for invalidation as described above, each item of Article 57, Paragraph 1 of the law enumerates the cause of invalidation of a patent in abstract terms, but each cause enumerated thereunder is different in nature and substance as the cause of invalidation of a patent, so it is appropriate to deem each of the causes as an independent and separate cause of invalidation; furthermore, as to item 1 of the said paragraph of the said article, each ground of violation of the provisions enumerated therein is different in nature and substance, again, it is appropriate to construe that each ground of violation of the provisions should involve a different cause of invalidation. However, whether or not it is sufficient to specify the cause of invalidation in abstract terms solely relying on the above-described items and/or cases in violation of the provisions should be carefully determined, in view of the mechanism of the law governing the patent system, especially with consideration to the purport of Article 117 of the law, which requires the effect and scope of non bis in idem in connection with a finalized appeal/trial decision to be limited by baring the same facts and evidence therefrom.

In our opinion, the fundamental element of patentability are to fall under "a novel industrial invention" set forth in Article 1 of the law, and in deciding whether a patent is granted or not, or whether a granted patent is invalid or not, is a matter of the most frequent controversy, after all, whether the requirement under the said article is met or not, particularly, whether the relevant

invention is "novel" or not. Article 4 of the law defines the "novelty" of an invention described above as not falling under "the thing publicly-known or publicly used in the country before the application" or "the thing described in a publication circulated in the country before the application to the extent that it is easy to implement." In other words, it is stipulated that whether or not a particular invention falls under "being novel" defined in the law (hereinafter referred to as "novelty") should always be considered and judged in comparison with "the thing publicly-known or publicly used" or the thing that has appeared in publicly-known publications (hereinafter referred to as "publicly-known fact") of the time. However, such publicly-known facts exist over a wide spectrum so that it is extremely difficult to grasp all publicly-known facts to be compared in connection with the invention at issue, but also even if there exist publicly-known facts with such bearing, because technical features embodied therein are of wide variety, it is necessary to examine the invention at issue in one-to-one comparison with each of these publicly-known facts for judgment in terms of novelty. It is understood that the law sets forth the systems and procedures in relation to the above-described uniquely structured examination, appeal/trial for invalidation, and appeal to the determination because it takes into account such difficulty and specialty inherent in judging a particular invention in terms of its novelty. It can be understood that the purport of the said provisions of Article 117 of the law reflects the necessity of judging a particular invention to be novel or not in comparison to practical technical details embodied in specific publicly-known facts cited as evidence on a one-by-one basis. Accordingly, as it requires that the cause of invalidation be a definitely specified one and for example, it should be recognized that a claim for invalidation by comparison to a specific publicly-known fact and a claim for invalidation by comparison to other publicly-known facts constitute different causes, even if both equally address the novelty of an invention.

For the above reasons, in a lawsuit for revocation of a determination, any cause for invalidation by comparison to publicly-known facts that were not examined and judged in the course of the appeal to the determination cannot be cited as a reason for contending the relevant decision to be illegal or upholding it as legal. The former precedents of this court that are contrary to this opinion (the Judgment of the Third Petty Bench upon Case 1958 (O) No. 567 rendered on December 20, 1960, Minshu Vol. 14, No. 14, at 3103; the Judgment of the First Petty Bench upon Case 1964 (Gyo-Tsu) No. 62 rendered on April 4, 1968, Minshu Vol. 22, No. 4, at 816) should be changed. Further, the same holds true for the specification of the reason for a decision of refusal as the specification of the cause of invalidation (see Article 72 of the law with regard to notice on reasons for refusal and Article 113, Paragraph 1 of the law with regard to application mutatis mutandis thereof in Kokoku appeals/trials). Hence, regarding a lawsuit for

revocation of an appeal/trial decision reached in a Kokoku appeal/trial against the decision of refusal, it should be held true that specific, concrete reasons for refusal which were not judged in the said appeal/trial decision cannot be asserted in a lawsuit. Therefore, the Judgment of the Second Petty Bench upon Case 1951 (O) No. 745 rendered on October 16, 1953, Saibanshu-Minji No. 10, at 189 should be changed as well.

When this case is considered from the above viewpoint, it is found that some of the facts that the Appellant argues are illegal in the Statement of Reasons for a Jokoku-Appeal because the court below failed to examine and judge the said facts are concerned with an article/item different from the article/item enumerating the cause of invalidation that was examined and judged in the said appeal/trial decision, and the rest are concerned with a violation of Article 1 of the law, but as the Appellant contends over publicly-known facts different from the publicly-known fact that the said appeal/trial decision determined to be the cause of invalidation, we uphold as proper the court below ruling that with regard to the propriety of the said appeal/trial decision, the claim based on these facts, that is, different causes of invalidation from the ones examined and judged therein must not be taken into account, we sustain that the original judgment is free from illegality opposed to the argument, and thus the Appellant's case cannot be accepted.

Therefore, the judiciary opinion is unanimously formed and the judgment rendered as the main text.

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Presiding judge

Justice MURAKAMI Tomokazu

Justice FUJIBAYASHI Ekizo

Justice OKAHARA Masao

Justice SHIMODA Takezo

Justice KISHI Seiichi

Justice AMANO Buichi

Justice SAKAMOTO Yoshikatsu

Justice KISHIGAMI Yasuo

Justice ERIKUCHI Kiyoo

Justice OHTSUKA Kiichiro

Justice TAKATSUJI Masami

Justice YOSHIDA Yutaka

Justice DANDO Shigemitsu
Justice MOTOBAYASHI Yuzuru
Justice HATTORI Takaaki

(This translation is provisional and subject to revision.)