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Date of the judgement

1995.03.07

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Case Number

1994(Gyo-Tsu)83

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Reporter

Minshu Vol. 49, No. 3 at 944

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Title

Judgment concerning an action for revocation of a trial decision to be filed by co-owners of a right to obtain a utility model registration, and an inherently mandatory joint action

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Case name

Case to seek revocation of the trial decision

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Result

Judgment of the Third Petty Bench, quashed and decided by the Supreme Court

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Court of the Second Instance

Tokyo High Court, Judgment of January 27, 1994

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Summary of the judgement

In cases where co-owners of a right to obtain a utility model registration jointly filed a request for a trial against an examiner's decision of refusal, but received a trial decision not to accept the request, an action for revocation of the trial decision to be filed by said co-owners is an inherently mandatory joint action.

References

Article 62 of the Code of Civil Procedure, Article 41 and Article 47 of the Utility Model Act (prior to the revision by Act No. 26 of 1993), Article 132, paragraph (3) of the Patent Act

Article 62 of the Code of Civil Procedure

- (1) Where the subject matter of the suit should be determined only in a single form for all co-parties, procedural acts performed by one of them shall become effective only in the interest of all of them.
- (2) Procedural acts performed against one of the co-parties by the opponent shall become effective against all of them.
- (3) If there are any grounds for discontinuing action or suspending court proceedings with regard to one of the co-parties, the discontinuance or suspension shall become effective against all of them.

Article 41 of the Utility Model Act (prior to the revision by Act No. 26 of 1993)

The provisions of Article 125, Article 127, Article 128, and Articles 130 to 170 (effect of trial decision, request for trial, trial examiner, trial procedure, relationship with litigation, and costs of trial) of the Patent Act shall apply mutatis mutandis to trials.

Article 47 of the Utility Model Act (prior to the revision by Act No. 26 of 1993)

- (1) The Tokyo High Court shall have exclusive jurisdiction over any action against a trial decision, action against a ruling of dismissal under the provision of Article 53, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 159, paragraph (1) of said Act that is applied mutatis mutandis pursuant to Article 41 [of this Act] or pursuant to Article 174, paragraph (1) of the Patent Act as applied mutatis mutandis pursuant to Article 45 [of this Act], or action against a ruling to dismiss a written request for a trial or a retrial.
- (2) Article 178, paragraphs (2) to (6) (statute of limitations for filing an action, etc.) and Articles 179 to 182 (appropriate party as defendant, notice of institution of action, revocation of the trial decision or ruling, and delivery of original copy of judgment) of the Patent Act shall apply mutatis mutandis to actions under the preceding paragraph.

Article 132, paragraph (3) of the Patent Act

- (3) Where a request for a trial is filed by a co-owner or co-owners of a patent right or a right to obtain a patent, with regard to the right under co-ownership, all of the said co-owners shall

jointly file the request.

Main text of the judgement

The judgment in prior instance is quashed.

This action filed by the appellee of final appeal is dismissed without prejudice.

The appellee of final appeal shall bear the total court cost.

Reasons

Concerning the reasons for final appeal argued by the appeal counsels, MASUI Kazuo, IIMURA Toshiaki, KAWAMURA Yoshiteru, IMAI Hiroaki, OGURI Shohei, YOSHINO Hideo, NAKAMURA Tomoyuki, and SEKIGUCHI Hiroshi

I. According to the facts legally determined by the court of prior instance, the appellee of final appeal owned, jointly with Limited Company X, a right to obtain a utility model registration for the device entitled "magnetic therapy apparatus," and filed jointly with said company an application for a utility model registration regarding this device, but they received an examiner's decision of refusal. Then, the appellee filed a request for trial against this decision jointly with said company, but they received a trial decision not to accept the request. The appellee alone filed this action to seek revocation of said trial decision.

The court of prior instance, finding this action filed by the appellee alone to be lawful, made a determination on the merits and revoked said trial decision.

II. However, we cannot affirm the determination of the court of prior instance mentioned above, on the following grounds.

In cases where co-owners of a right to obtain a utility model registration received an examiner's decision to refuse their application for a utility model registration filed for the purpose of the right under co-ownership, and therefore they jointly filed a request for trial against this decision but received a trial decision not to accept the request, an action for revocation of the trial decision to be filed by said co-owners should be regarded as what is called an inherently mandatory joint action, which must be filed jointly by all co-owners (See 1977 (Gyo-Tsu) No. 28, judgment of the Second Petty Bench of the Supreme Court of January 18, 1980, Saibanshu Minji No. 129, at 43). This is because, to determine in such action whether or not the trial decision is illegal, is to decide whether or not the single right owned by all co-owners validly exists, and therefore the question of whether or not to revoke the trial decision must be determined in a single form. We should say that this is also intended under the Utility Model Act,

which provides that where a request for a trial is filed by a co-owner or co-owners of a right to obtain a utility model registration, with regard to the right under co-ownership, all of the said co-owners shall jointly file the request (Article 132, paragraph (3) of the Patent Act as applied mutatis mutandis pursuant to Article 41 of the Utility Model Act).

In consequence, the determination of the court of prior instance that found this action to be lawful is illegal for its erroneous construction and application of laws and regulations, and such illegality apparently affects the conclusion of the judgment in prior instance. The appeal counsels' arguments are well-grounded, and the judgment in prior instance should inevitably be quashed. In light of our reasoning shown above, this action filed by the appellee should be dismissed as unlawful without prejudice.

Therefore, according to Article 7 of the Administrative Case Litigation Act, and Article 408, Article 96, and Article 89 of the Code of Civil Procedure, the judgment has been rendered in the form of the main text by the unanimous consent of the Justices.

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Presiding judge

Justice SONOBE Itsuo

Justice KABE Tsuneo

Justice ONO Masao

Justice CHIKUSA Hideo

Justice OZAKI Yukinobu

(This translation is provisional and subject to revision.)

(* Translated by Judicial Research Foundation)