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Date of the judgement

2008.04.24

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Case Number

2006(Ju)1772

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Reporter

Minshu Vol. 62, No. 5

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Title

Judgment concerning a case where the court determined that, where the court of second instance rendered a judgment to dismiss the claim for damages, etc. for infringement of a patent right by adopting an allegation of invalidity under Article 104-3, paragraph (1) of the Patent Act, and then a trial decision to allow a correction for the purpose of restricting the scope of claims became final and binding, it is impermissible in light of the purpose of the provision of Article 104-3 of the Patent Act to challenge the determination of the court of second instance by arguing that there exist the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure because said trial decision became final and binding

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Case name

Case to seek an injunction against the manufacture and sale based on a patent right, etc.

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Result

Judgment of the First Petty Bench, dismissed

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Court of the Second Instance

Osaka High Court, Judgment of May 31, 2006

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Summary of the judgement

Where, with regard to X's claim against Y for damages for infringement of a patent right, the court of second instance rendered a judgment to dismiss the claim by adopting Y's allegation of invalidity under Article 104-3, paragraph (1) of the Patent Act, and then a trial decision to allow a correction for the purpose of restricting the scope of claims pertaining to said patent right became final and binding, if X challenges the determination of the court of second instance by arguing that there exist the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure because said trial decision became final and binding, given the facts shown in (1) and (2) below, such behavior of X is regarded as causing an unreasonable delay in solving the dispute and therefore impermissible in light of the purpose of the provision of Article 104-3 of the Patent Act:

(1) Considering that the judgment of first instance dismissed X's claim for damages by adopting Y's allegation of invalidity, X should have advanced, at an early stage at least in the proceedings in the second instance, an allegation to deny or overturn Y's allegation of invalidity;

(2) The trial decision in question was made in response to the request for a trial for correction filed by X after the conclusion of oral argument in the second instance. In view of the content of the trial decision and the fact that X filed requests for trial for correction twice and withdrew both requests while the proceedings in the second instance continued for more than one year, no reason can be found to justify X's failure to advance, prior to the conclusion of oral argument in the second instance, a counter-allegation relating to the request for a trial for correction that was filed after the conclusion of oral argument, in order to deny or overturn Y's allegation of invalidity.

(There is an opinion.)

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References

Article 104-3 and Article 126 of the Patent Act, Article 338, paragraph (1), item (viii) of the Code of Civil Procedure

Article 104-3 of the Patent Act

(Restriction on exercise of rights of patentee, etc.)

(1) Where, in litigation concerning the infringement of a patent right or an exclusive license, said patent is recognized as one that should be invalidated by a trial for patent invalidation, 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.

Article 126 of the Patent Act
(Trial for correction)
(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 or incorrect translations; and
(iii) clarification of an ambiguous statement.
(2) A request for a trial for correction may not be filed from the time the relevant trial for patent invalidation has become pending before the Patent Office to the time the trial decision has become final and binding; provided, however, that this shall not apply to a request for a trial for correction filed within 90 days from the day an action against the trial decision in the trial for patent invalidation is instituted (in the case of the judgment rescinding the trial decision under Article 181(1) or a ruling rescinding the trial decision under Article 181(2) concerning the case, the period after the judgment or the ruling has become final and binding shall be excluded).
(3) 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 written application in foreign language, the document in foreign language)].
(4) The correction of the description, scope of claims or drawings under paragraph (1) shall not substantially enlarged or alter the scope of claims.
(5) 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.
(6) 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 invalidated in a trial for patent invalidation.

Article 338, paragraph (1), item (viii) of the Code of Civil Procedure

(Grounds for retrial)

(1) Where any of the following grounds exist, an appeal may be entered by filing an action for retrial against a final judgment that has become final and binding; provided, however, that this shall not apply where a party, when filing the appeal to the court of second instance or final appeal, alleged such grounds or did not allege them while being aware of them:

(viii) The judgment or other judicial decision on a civil or criminal case or administrative disposition, based on which the judgment pertaining to the appeal was made, has been modified by a subsequent judicial decision or administrative disposition.

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Main text of the judgement

The final appeal is dismissed.

The appellant of final appeal shall bear the cost of the final appeal.

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Reasons

Concerning Reasons V-2 and VI for the petition for acceptance of final appeal argued by the appeal counsels KONDO Tsuyoshi and KAWAZOE Kei and the assistant in court HONJO Takeo, as stated in the written statement of reasons for the petition for acceptance of final appeal dated September 11, 2006

1. The outline of the facts legally determined by the court of prior instance and the history of this case found from the records are as follows.

(1) Patent right in question

The appellant of final appeal holds a patent for the invention entitled "Device for working knife" (Patent No. 2139927; hereinafter referred to as the "Patent").The patent application that matured into the Patent was filed on April 21, 1993, and the establishment of a patent right based on the Patent was registered on January 22, 1999 (hereinafter referred to as the "Patent Right").

(2) Acts committed by the appellees of final appeal

Appellee Y1 manufactures and sells automatic blade bending systems (Product No. ABS303 and ABS302FA; hereinafter referred to as the "Products"), and Appellee Y2 purchases the Products from Appellee Y1 and sells them.

(3) Proceedings before the court of first instance

On September 10, 2001, the appellant, based on the Patent Right, filed this suit against the appellees to seek an injunction against the manufacture and sale of the Products and seek damages.

In the beginning, the appellant alleged that the Products fell within the technical scope of the invention defined by Claim 1 out of the claims stated in the description attached to the patent application (hereinafter referred to as the "Description") (this invention shall hereinafter be referred to as "Invention 1"). In response, the appellees alleged, on the second date for oral argument (December 7, 2001), that there were apparent grounds for invalidation of the patent pertaining to Invention 1 and the appellant's claims for an injunction and damages based on the Patent Right constitute an abuse of right. Appellee Y1 filed a request for a trial for invalidation of said patent by the written request for a trial dated July 25, 2003. The trial examiner made a trial decision on January 30, 2004, to the effect that the patent pertaining to Invention 1 should be invalidated.

The appellant, only on the 18th date for oral argument (February 6, 2004), additionally alleged that the Products also fell within the technical scope of the invention defined by the part of Claim 5 stated in the Description which quotes Claim 1 (this invention shall hereinafter be referred to as "Invention 5"). In response, the appellees alleged that said additional allegation made by the appellant should be dismissed as an allegation advanced outside the appropriate time, and also alleged, on the 19th date for oral argument (March 15, 2004), that there were also apparent grounds for invalidation of the patent pertaining to Invention 5.

The court of first instance, on October 21, 2004, rendered a judgment to dismiss the appellant's claims for an injunction and damages, without determining whether or not the Products fall within the technical scopes of Invention 1 and/or Invention 5, but holding that it is obvious that there exist the grounds for invalidation set forth in Article 123, paragraph (1), item (i) of the Patent Act (prior to the revision by Act No. 26 of 1993; the same shall apply hereinafter) with regard to the patent pertaining to Invention 1 and the patent pertaining to Invention 5, and that the claims for an injunction and damages based on the Patent Right constitute an abuse of right and therefore are impermissible (See 1998 (O) No. 364, judgment of the Third Petty Bench of the Supreme Court of April 11, 2000, Minshu Vol. 54, No. 4, at 1368).

(4) Proceedings before the court of prior instance

On November 2, 2004, the appellant filed an appeal against the judgment of first instance, and then by the written request for a trial dated January 21, 2005, filed a request for a trial for correction for the purpose of restricting the scope of claims with regard to Claim 5 (Correction Case No. 2005-39011).

The appellees, on the first date for oral argument (February 1, 2005), alleged that there were apparent grounds for invalidation of the patent pertaining to Invention 1 and the patent pertaining to Invention 5. Upon the enforcement of the Act for Partial Revision to the Court Act, etc. (Act No. 120 of 2004) as of April 1, 2005, the provision of Article 104-3 of the Patent Act became applicable to this case, and therefore the appellees' allegation, on and after said date,

was treated as an allegation made under the provision of paragraph (1) of said Article.
On April 11, 2005, the appellant withdrew the aforementioned request for a trial for correction, and by the written request for a trial dated the same date, filed the second request for a trial for correction with regard to Claim 5 (Correction Case No. 2005-39061).
Since the trial decision to invalidate the patent pertaining to Invention 1 mentioned in (3) above became final and binding, the appellant, on the third date for oral argument (May 31, 2005), revoked its allegation that the Products fall within the technical scope of Invention 1. As a result, the patent pertaining to Invention 5 became the only subject to be examined in this suit.
With regard to Correction Case No. 2005-39061, the trial examiner made a trial decision on November 25, 2005, to the effect that the request for a trial for correction cannot be filed. On December 22, 2005, the appellant withdrew the request for a trial.
The court of prior instance concluded oral argument on January 20, 2006. The appellant, by the written request for a trial dated April 18, 2006, filed the third request for a trial for correction (Correction Case No. 2006-39057).
The court of prior instance rendered a judgment on May 31, 2006, to the effect that the appellant's claims for an injunction and damages should be dismissed. The judgment of prior instance, without determining whether or not the Products fell within the technical scope of Invention 5, held as follows: The patent pertaining to Invention 5 should be invalidated by way of a trial for patent invalidation because it was granted in violation of Article 29, paragraph (2) of the Patent Act and it is obvious that there exist the grounds for invalidation set forth in Article 123, paragraph (1), item (i) of said Act; consequently, the appellant may not exercise the Patent Right against the appellees (Article 104-3, paragraph (1) of the Patent Act).
(5) Developments following the rendition of the judgment of prior instance
On June 16, 2006, the appellant filed a final appeal and petition for acceptance of final appeal. On June 26, the appellant withdrew the request for a trial for correction mentioned in (4) above (Correction Case No. 2006-39057), and by the written request for a trial dated the same date, filed the fourth request for a trial for correction (Correction Case No. 2006-39109).
On July 7, 2006, the appellant withdrew the request for a trial for correction mentioned above, and by the written request for a trial dated the same date, filed the fifth request for a trial for correction for the purpose of restricting the scope of claims and clarifying an ambiguous statement with regard to Claim 5 (Correction Case No. 2006-39113; hereinafter referred to as the "Request for a Trial for Correction"). Having examined the case, the trial examiner made a trial decision on August 29, 2006, to the effect that the Description should be corrected as requested, and this trial decision became final and binding around that date (this trial decision shall hereinafter be referred to as the "Trial Decision for Correction").
The Trial Decision for Correction allows a correction of the part of Claim 5 which quotes Claim

1 as indicated in Attachment 1, into the claim as indicated in Attachment 2 (this correction shall hereinafter be referred to as the "Correction"). The Correction constitutes restriction of the scope of claims.

2. The appeal counsels and the assistant in court argue that given the fact of the case that within the period for submission of a written statement of reasons for the petition for acceptance of final appeal of this case, the Trial Decision for Correction became final and binding and the scope of claims was restricted with regard to Claim 5, the grounds for retrial prescribed in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure can be found by deeming that the administrative disposition that is the basis for the judgment of prior instance has been modified by a subsequent administrative disposition, and in consequence, the judgment of prior instance contains a violation of laws and regulations that apparently affects the judgment (Article 325, paragraph (2) of the Code of Civil Procedure).

3(1) We therefore examine the point argued by the appeal counsels and the assistant in court. The court of prior instance, having determined, based on the statement of the scope of claims prior to the Correction, that the patent pertaining to Invention 5 should be invalidated on the grounds of violation of Article 29, paragraph (2) of the Patent Act, upheld the appellees' allegation under Article 104-3, paragraph (1) of said Act and dismissed the appellant's claims for an injunction and damages. Upon making the judgment of prior instance, the court did not specifically examine whether or not there exist the grounds for invalidation of the Patent based on the scope of claims after the Correction. Since the Trial Decision for Correction became final and binding, the examiner's decision to grant the Patent shall be deemed to have been made based on the scope of claims after the Correction from the beginning (Article 128 of the Patent Act). In view of the fact that, as explained above, the Correction was made to restrict the scope of claims, we cannot deny the possibility that the aforementioned grounds for invalidation have been overcome by the Correction. If the grounds for invalidation have been overcome and the Products can be recognized as falling within the technical scope of the patented invention based on the scope of claims after the Correction, we may uphold the appellant's claims for an injunction and damages. In such case, we should say that there is room to find the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure.
(2) However, even if the grounds for retrial exist at all, for the reasons shown below, we should say that the appellant, by challenging the determination of the court of prior instance because the Trial Decision for Correction became final and binding, causes an unreasonable delay in solving the dispute between the appellant and the appellees over the infringement of the Patent Right, and such behavior of the appellant is impermissible in light of the purport of the

provision of Article 104-3 of the Patent Act.

(a) Under the provision of Article 104-3, paragraph (1) of the Patent Act, the fact that, in litigation concerning the infringement of a patent right (hereinafter referred to a "patent infringement suit"), the patent is recognized as one that should be invalidated by a trial for patent invalidation, shall be regarded as the grounds for restricting the exercise of the patent right. This means that an allegation that the patent is invalid (hereinafter referred to as an "allegation of invalidity") may be advanced without waiting for a trial decision finding invalidity of the patent to be made final and binding through the trial procedure for patent invalidation. This provision can be construed to aim to solve disputes on infringement of patent rights within the procedures for patent infringement suits to the greatest possible extent, thereby achieving prompt solution to such disputes. Paragraph (2) of said Article provides that when the court considers that the allegation and evidence under paragraph (1) of said Article are advanced for the purpose of unreasonably delaying the proceedings, the court may dismiss such allegation and evidence. It can be construed that the purpose of this provision is to prevent a delay in court proceedings that would occur when the court conducts examination and determination on an allegation of invalidity. In light of such purport of the provision of paragraph (2) of said Article, we should say that the court may dismiss not only an allegation of invalidity itself but also an allegation advanced to deny or overturn an allegation of invalidity (hereinafter referred to as a "counter-allegation"), and even where a counter-allegation is advanced against an allegation of invalidity presented on the grounds of a correction made for the purpose of restricting the scope of claims, such counter-allegation would be dismissed if it is found to have been advanced for the purpose of unreasonably delaying the proceedings.

(b) According to the outline of facts shown in 1 above, the following facts are obvious: [1] The appellees advanced an allegation of invalidity of the patent pertaining to Invention 5 in the first instance of this case, and the judgment of first instance rendered on October 21, 2004, although it was prior to the enforcement of Act No. 120 of 2004 that introduced the provision of Article 104-3 to the Patent Act, adopted the allegation of invalidity and dismissed the appellant's claims for an injunction and damages, in accordance with the aforementioned judgment of the Third Petty Bench of the Supreme Court of April 11, 2000; [2] The appellant filed an appeal against the judgment of first instance on November 2, 2004, and filed a request for a trial for correction for the purpose of restricting the scope of claims with regard to Claim 5 on January 21, 2005, but then withdrew it on April 11, 2005 and filed the second request for a trial for correction with regard to Claim 5 on the same day; [3] In response to the second request for a trial for correction, a trial decision was made on November 25, 2005, to the effect the request cannot be filed, and the appellant withdrew said request on December 22, 2005; [4] The court of prior instance concluded oral argument on January 20, 2006, and the appellant filed the third request for a trial

for correction on April 18, 2006; [5] the court of prior instance dismissed the appellant's appeal on May 31, 2006, for the same reason as that attached to the judgment of first instance, adopting the appellees' allegation of invalidity; [6] The appellant filed a final appeal and petition for acceptance of final appeal on June 16, 2006, and then withdrew the third request for a trial for correction and filed the fourth request for a trial for correction, and subsequently further withdrew the fourth request for a trial for correction and filed the fifth request for a trial for correction, which is disputed in this suit.

(c) Under the circumstances as explained above, the appellant could have advanced a counter-allegation against the appellees' allegation of invalidity in the first instance, and in light of the purport of the provision of Article 104-3 of the Patent Act, it should be construed that at least in the proceedings in the prior instance after the judgment of first instance adopted the appellees' allegation of invalidity, the appellant should have advanced a counter-allegation at an early stage, including one that is on the grounds of a correction made for the purpose of restricting the scope of claims. In view of the content of the Trial Decision for Correction and the fact that the appellant filed requests for a trial for correction twice and withdrew both requests while the proceedings in the prior instance continued for more than one year, we can find no reason to justify the appellant's failure to advance, prior to the conclusion of oral argument in the prior instance, a counter-allegation relating to the Request for a Trial for Correction. Consequently, if the appellant challenges the determination of the court of prior instance by arguing that the Trial Decision for Correction became final and binding, such behavior is equal to advancing a counter-allegation, which should have been advanced during or at an early stage in the proceedings in the prior instance, after the judgment of prior instance was rendered, and in this respect, it should be deemed to cause an unreasonable delay in solving the dispute between the appellant and the appellees over the infringement of the Patent Right. In light of the purport of the provision of Article 104-3 of the Patent Act, such behavior can never be permitted.

4. For the reasons stated above, the judgment of prior instance does not contain such illegality as argued by the appeal counsels and the assistant in court, and we cannot adopt their argument. Therefore, the judgment has been rendered in the form of the main text by the unanimous consent of the Justices. There is an opinion by Justice IZUMI Tokuji.

The opinion by Justice IZUMI Tokuji is as follows.

I am in agreement with the conclusion of the majority opinion that the final appeal should be dismissed, but have different reasons for the conclusion. In my opinion, even where the Trial Decision for Correction became final and binding and the scope of claims was restricted, and

because of this, the examiner's decision to grant the Patent is deemed to have been made based on the restricted scope of claims from the beginning, such change cannot be regarded as constituting the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure, and therefore in the judgment of prior instance, I cannot find any violation of laws or regulations that apparently affects the judgment.

1. In general, when the defendant in a patent infringement suit who is sued for infringing the plaintiff's patent right raises a defense of restriction on the exercise of rights under Article 104-3, paragraph (1) of the Patent Act, arguing that the plaintiff may not exercise the patent right because the patent is recognized as one that should be invalidated by a trial for patent invalidation, the plaintiff can reject the defense of restriction on the exercise of rights by alleging and proving that [1] the part of the scope of claim for which the grounds for invalidation alleged by the defendant can be found (hereinafter referred to as the "invalid part") can be eliminated by filing a request for a trial for correction to restrict the scope of claims, and [2] the defendant's products would fall within the technical scope of the invention based on the restricted scope of claims. If the invalid part can be eliminated by filing a request for a trial for correction, the case does not fall under the case set forth in Article 104-3, paragraph (1) of the Patent Act, "Where the said patent is recognized as one that should be invalidated by a trial for patent invalidation." (1998 (O) No. 364, judgment of the Third Petty Bench of the Supreme Court of April 11, 2000, Minshu Vol. 54, No. 4, at 1368 also found that the claim for damages based on a patent right constitutes an abuse of right and therefore is impermissible "because no special circumstances can be found, such as that a request for a trial for correction has been filed".) When the defendant intends to establish a defense of restriction on the exercise of rights, it is not required that a trial for patent invalidation has already been requested, but it is sufficient to allege and prove that the patent in question would be invalidated if a trial for patent invalidation is requested. Similarly, when the plaintiff intends to avoid the establishment of such defense, it is not required that a trial for correction has already been requested, not is it required that a trial decision for correction has already become final and binding; it is sufficient to allege and prove that the invalid part could be eliminated if a trial for correction is requested at all and that the defendant's products would fall within the technical scope of the invention based on the restricted scope of claims. In other words, by alleging and proving that the invalid part could be eliminated if a trial for correction is requested at all, the plaintiff can assert, as a defense, the same legal effect as one that would be brought about when a trial decision for correction actually becomes final and binding. The plaintiff, in reality, can file a request for a trial for correction before the conclusion of oral argument in the trial court proceedings, and as far as the request is well-grounded, the plaintiff can usually obtain a final and binding trial decision for correction. In such case, in order to avoid the establishment of the defendant's defense of

restriction on the exercise of rights, the plaintiff is not required to go so far as to actually file a request for a trial for correction and obtain a final and binding trial decision for correction in advance.

The possibilities that the invalid part could be eliminated if a trial for correction is requested at all and that the defendant's products would fall within the technical scope of the invention based on the restricted scope of claims---these are the factors for determining whether or not the defendant's defense of restriction on the exercise of rights can be established. The facts that can be the basis for these possibilities had already existed before the conclusion of oral argument in the trial court proceedings, and the plaintiff could have alleged and proven them at any time during the period by that time. The plaintiff should complete such allegation and proof to reject the defense of restriction on the exercise of rights before the conclusion of oral argument in the trial court proceedings, and after the trial court has acknowledged the establishment of the defense of restriction on the exercise of rights based on its free determination on the state of the suit depending on the level of the allegation and proof by each party, even if the plaintiff, after the conclusion of oral argument in the trial court proceedings, has filed a request for a trial for correction and the trial decision for correction has become final and binding, the plaintiff cannot assert illegality in the determination of the trial court by arguing that the trial decision for correction has become final and binding, because the plaintiff could have asserted, before the conclusion of oral argument in the trial court proceedings, the legal effect that may be brought about by the trial decision for correction (see 1980 (O) No. 589, judgment of the First Petty Bench of the Supreme Court of October 23, 1980, Minshu Vol. 34, No. 5, at 747; 1979 (O) No. 110, judgment of the Third Petty Bench of the Supreme Court of March 30, 1982, Minshu Vol. 36, No. 3, at 501).

Article 338, paragraph (1), item (viii) of the Code of Civil Procedure provides for the case where "the administrative disposition, based on which the judgment [pertaining to the appeal was made], has been modified by a subsequent administrative disposition," as one of the grounds for retrial. The trial court makes a determination with regard to whether or not the defense of restriction on the exercise of rights under the provision of Article 104-3, paragraph (1) of the Patent Act can be established, not by regarding the examiner's decision to grant a patent initially made as a given condition, but by also considering whether or not a request for a trial for correction should be accepted when it is filed, or in other words, by taking into consideration the possible legal effect that would be brought about by a trial decision for correction. Therefore, even where a trial decision for correction later becomes final and binding, this cannot be deemed to constitute a modification to the administrative disposition based on which the trial court's determination was made. Even if the plaintiff did not allege, before the conclusion of oral argument in the trial court proceedings, that a request for a trial for correction

should be accepted if it is filed, and therefore the trial court failed to make a determination on this point, the plaintiff is not allowed to advance such allegation at a later stage, and therefore the plaintiff may not allege that the grounds for retrial exist because the trial decision for correction has become final and binding.

Furthermore, in order to allege that the grounds for retrial exist because the trial decision for correction has become final and binding after the conclusion of oral argument in the trial court proceedings and therefore the judgment of prior instance should be revoked, it must be shown that as a result of the final and binding trial decision for correction, the judgment of prior instance now contains a violation of laws and regulations that apparently affect the judgment. However, even after the trial decision for correction has become final and binding, this fact does not mean that there is an error in the judgment of prior instance that acknowledged the establishment of the defense of restriction on the exercise of rights, until the plaintiff alleges and proves that the defendant's products fall within the technical scope of the invention based on the restricted scope of claims. Similarly, even after the trial decision for correction has become final and binding, the defendant may allege and prove that the patent, even based on the restricted scope of claims, should be invalidated by a trial for patent invalidation, and if the defendant has successfully alleged and proven such invalidity, it does not mean that there is an error in the judgment of prior instance that acknowledged the establishment of the defense of restriction on the exercise of rights. In short, the existence of a violation of laws and regulations in the judgment of prior instance cannot be shown until the plaintiff and the defendant complete their allegation and proof in this manner, whereas the final appellate court, which is in charge of reviewing question of law, is not authorized to examine such allegation and proof of the plaintiff and defendant. Therefore, since it cannot be alleged that the judgment of prior instance contains a violation of laws and regulations that apparently affects the judgment even when the scope of claims has been restricted by the final and binding trial decision for correction, it cannot be said, also in this respect, that the grounds for retrial exist because the trial decision for correction has become final and binding.

2. Consequently, in this case, it cannot be said that the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure exist just because the Trial Decision for Correction became final and binding after the conclusion of oral argument in the prior instance, and therefore it cannot be said that the judgment of prior instance contains a violation of laws and regulations that apparently affects the judgment.

3. In a patent infringement suit, if the trial court has upheld the patentee's claim, this means that the court has found infringement on the premise that the patent right be valid and effective.

Therefore, if a trial decision for correction has been made after the conclusion of oral argument in the trial court proceedings and the examiner's decision to grant the patent has been modified, this falls under the case set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure, "the administrative disposition, based on which the judgment [pertaining to the appeal was made], has been modified by a subsequent administrative disposition." However, in this case, although it is a patent infringement suit, the court of prior instance accepted the defense of restriction on the exercise of rights and dismissed the patentee's claim, and in view of this, this case should be distinguished from such cases where the court upholds the patentee's claim.

4. In 2002 (Gyo-Hi) No. 200, judgment of the Second Petty Bench of the Supreme Court of October 31, 2003, Saibanshu Minji No. 211, at 325, the patentee filed an action to seek revocation of the examiner's decision to cancel the patent, received a judgment of the trial court that dismissed the patentee's claim, and therefore filed a request for a trial for correction after the conclusion of oral argument in the trial court proceedings, and then the trial decision for correction became final and binding while the action was pending before the final appellate court. The examiner's decision to cancel the patent is a decision to indicate that the patent right has never existed erga omnes or in relation to everyone. Said judgment of the Second Petty Bench of the Supreme Court stated that if a trial decision for correction allowing the restriction of the scope of claims of the patent has become final and binding while the action concerning the patent is pending before the final appellate court, the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure can be found for the judgment of prior instance by deeming that the administrative disposition based on which the judgment of prior instance was made has been modified by a subsequent administrative disposition. Said judgment of the Second Petty Bench of the Supreme Court determined that since the subject of examination is the examiner's decision to grant a patent that was revoked by the subsequent examiner's decision to cancel the patent, the fact that the examiner's decision to grant a patent, which is the subject of examination, has been modified by a trial decision for correction, constitutes the grounds for retrial set forth in Article 338, paragraph (1), item (viii) of the Code of Civil Procedure. However, the purpose of a patent infringement suit is not to examine the patent right itself so as to establish or extinguish the effect of the patent right erga omnes or in relation to everyone, and in this respect, it is different in nature from a suit to seek revocation of the examiner's decision to cancel the patent. Therefore, the holdings in said judgment of the Second Petty Bench of the Supreme Court cannot be applied to a patent infringement suit where the trial court has accepted the defense of restriction on the exercise of rights and dismissed the patentee's claim.

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Presiding judge

Justice SAIGUCHI Chiharu

Justice YOKOO Kazuko

Justice KAINAKA Tatsuo

Justice IZUMI Tokuji

Justice WAKUI Norio

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Attachment 1

1. A knife working device equipped with a bending working shape inputting means for inputting a geometric bending working shape of a long and thin knife, and an arithmetic means for calculating bending data based on said geometric bending working shape input by way of said bending working shape inputting means, wherein;

a characteristic data inputting means for inputting characteristic data concerning said bending working for a knife is provided, and said arithmetic means calculates bending data based on the geometric bending working shape input by way of said bending working shape inputting means and said characteristic data input by way of said characteristic data inputting means.

(2-4 omitted)

5. A knife working device relating to Claim 1 or Claim 2 wherein the total length of a knife to be worked is calculated by taking into consideration the stretch of the central axis of the bend in said bending working shape input by way of said bending working shape inputting means.

(Attachment 2)

A knife working device for working a long and thin knife into a desired bending working shape through the process in which the knife is supported with a pair of fixed dies, and every time the knife is given plastic deformation and bent by pressing the sides of the knife with movable dies that move between the fixed dies, the knife is fed forward by a small amount and then given plastic deformation by pressing the sides of the knife with the movable dies, and by repeating such bending processing by the bend of the knife multiple times, a single circular arc is formed; which is equipped with:

[1] A bending working shape inputting means for inputting a geometric bending working shape of a knife which consists of a polygon, [2] an arithmetic means for calculating, based on said geometric bending working shape input by way of said bending working shape inputting means, the amount of feeding of the knife, the amount of move of the dies, and the bending data consisting of the number of bending operations in bending processing, and [3] a characteristic

data inputting means for inputting characteristic data concerning said bending working for a knife; wherein:

Said arithmetic means calculates, based on the geometric bending working shape input by way of said bending working shape inputting means and said characteristic data input by way of said characteristic data inputting means, the cutting data for the total length of the knife, said bending data, and said number of bending operations in bending processing of the knife, and by taking into consideration the stretch of the central axis of said bend of said bending working shape of the knife, and deforming said geometric bending working shape of the knife which consists of a polygon under the rule that the difference in the cutting data between each side of the polygon and the circular arc that internally or externally touches the respective sides is within an allowable margin of error, a bending working shape is determined so that the number of operations will be an integral number, and said bending data is calculated for working the knife into the determined bending working shape.

(This translation is provisional and subject to revision.)