Date	March 28, 2013	Court	Intellectual Property High Court, Fourth Division
Case number	2012 (Gyo-Ke) 10280		

– A case in which the court held that the findings and determinations made in the trial decision were not erroneous by finding that, in light of the circumstances such as the technical field to which the inventions in question belong and their features, and the level of knowledge on the technical field of the inventions in question held by the plaintiff's employee X and the defendant's employee Y, as well as the relationship between the plaintiff and the defendant, the plaintiff/employee X cannot be deemed to be the inventor or joint inventor of the inventions in question.

References: Article 123, paragraph (1), item (vi) and Article 38 of the Patent Act

In this case, the plaintiff sought rescission of the trial decision which dismissed the request for a trial to invalidate the patent for an invention made by the employees of the defendant, titled "Dynamic management system, receiver, and dynamic management method" (such trial decision shall hereinafter be referred to as the "Trial Decision").

The Trial Decision held that the patent for the invention stated in claim 1 (hereinafter referred to as "Invention 1") was not granted for a patent application which was filed by a person who is not the inventor of the invention or who does not succeed to the right to receive a patent for such invention and was not granted in violation of the provision of Article 38 of the Patent Act, by finding as follows: (i) the invention stated in the file attached to the email sent from the plaintiff's employee X to the defendant's employee Y (hereinafter the file and invention shall be referred to as the "Attached File" and "Invention Ko No. 5," respectively) cannot be regarded as having been conceived of by employee X; and (ii) even if employee X conceived of the invention stated in the Attached File and presented it to employee Y, employee X cannot be regarded as being one of the inventors of Invention 1.

In response to this, the plaintiff sought rescission of the Trial Decision by arguing that the Trial Decision erred in finding and determining that employee X is not the inventor or joint inventor of the inventions in question (the inventions stated in claim 1 to 7: hereinafter collectively referred to as "Inventions").

This judgment dismissed the plaintiff's claims by holding as follows.

The findings made in the Trial Decision with respect to Invention Ko No. 5 are not erroneous since there are differences between the Inventions and Invention Ko No. 5 with respect to the output direction of the trigger ID output by the transmitter and the fact of whether or not the trigger ID output by the transmitter activates a tag or is a

trigger signal, and thus the Inventions cannot be deemed to have been stated in the Attached File. Then, regardless of whether or not employee X conceived of the contents stated in the Attached File, employee X cannot be considered to be the inventor or joint inventor of the Inventions.

The Trial Decision also did not err in finding that, in light of the circumstances such as the technical field to which the Inventions belong and their features, and the level of knowledge on the technical field of the Inventions held by the employee X and the employee Y, as well as the relationship between the plaintiff and the defendant, the employee X cannot be regarded as the inventor or joint inventor of Invention 1. Moreover, the same can be said for the inventions stated in claims 2 to 5 that cite claim 1 and the inventions stated in claims 6 and 7 that claimed the constituent feature of Invention 1 in the form of the receiver and method, respectively (hereinafter the relevant inventions stated in the relevant claims shall be referred to as "Invention 2" and the like).

In this case, the plaintiff argues that the burden to make allegations and show proof that employee Y is the inventor lies on the defendant, who is the patentee, and that the plaintiff has fully alleged and proved the details of the specific circumstances that suggest the occurrence of a misappropriated application.

It is true that the burden to allege and prove that "the patent application has been filed by the inventor of the invention covered by the patent him/herself or the person who succeeded to the right to receive a patent from the inventor" should be construed as lying on the patentee in form, in a trial for invalidation of a patent requested on the grounds of a misappropriated application or violation of joint application. Yet, the fact that "the applicant is the inventor or a person who has succeeded to the right to receive a patent from the inventor" should be presumed from the fact that the patent application was filed earlier unless there is any rebuttal evidence.

In this case, employee Y can be found to have substantially known the invention stated in Exhibit Ko No. 6, which is a technical idea equivalent to Inventions 1, 6, and 7, at least by November 14, 2003, i.e. the day on which employee Y prepared the email replying to X’s email. Accordingly, since the defendant filed a patent application prior to the plaintiff after gaining knowledge on the technical idea equivalent to Inventions 1, 6, and 7, the defendant should be presumed to be the inventor or a person who has succeeded to the right to receive a patent from the inventor, unless there is any rebuttal evidence.

The plaintiff alleges that the Inventions were obvious for a person skilled in the art since such person could embody the Inventions only if he/she could conceive of the

idea of having a trigger signal contain IDs and thus, employee X who conceived of the idea of having a trigger signal contain IDs is the inventor or one of the joint inventors of the Invention.

However, since an invention means "the highly advanced creation of technical ideas utilizing the laws of nature" (Article 2, paragraph (1) of the Patent Act), it would be necessary for a person to actually take part in the act of creation of the technical idea of the invention in order to be regarded as the true inventor or one of the joint inventors.

In this regard, the Attached File cannot be found to have contained statements indicating or suggesting that the "ID information contained in each trigger" to be sent to the receiver is equivalent to a "trigger signal," which is a signal to the "TAG" (ID tag). Thus, the Attached File cannot be considered to have stated the idea of "having a trigger signal contain IDs." Therefore, the abovementioned allegation of the plaintiff lacks the prerequisite and is groundless.