

Date	March 13, 2013	Court	Intellectual Property High Court, Third Division
Case number	2012 (Gyo-Ke) 10059		
<p>– A case in which the court maintained the determination of the trial decision rendered by the Japan Patent Office (JPO) which held that the patent in question could not be invalidated for violation of the provision of Article 38 of the Patent Act (joint application) by finding that the plaintiff could not be deemed to be a joint inventor of Inventions 1 through 6.</p>			

References:

Article 38 and Article 123, paragraph (1), item (ii) of the Patent Act

This judgment found that there were no errors in the trial decision rendered by the Japan Patent Office (JPO) which did not recognize the plaintiff to be a joint inventor of Inventions 1 through 6 by holding as follows.

1. Since Article 38 of the Patent Act is provided on the basis that the right to obtain a patent is jointly owned, in cases where a trial for invalidation of a patent is to be requested for reasons such as that a patent was granted in violation of the provision of said Article, it is appropriate to construe that the demandant of the trial bears the burden to make allegations and show proof with respect to the fact that "the right to obtain a patent is jointly owned." On the other hand, if the patentee were to bear the burden to make allegations and show proof that "the right to obtain a patent is not jointly owned," this would force the patentee to show proof for a negative fact that there is no other joint owner of its patent, and is thus unreasonable. Moreover, it is also appropriate to adopt the abovementioned construction in distributing the burden to make allegations and show proof in litigation seeking the rescission of a JPO decision rendered in a trial for invalidation of a patent which was requested on the basis of violation of Article 38 of the Patent Act. Thus, it should be construed that the demandant of the trial shall bear the burden to make allegations and show proof that the "right to obtain a patent is jointly owned," i.e. he/she is a joint inventor.

2. The plaintiff alleges that he/she conceived of the idea in question while talking with the defendant as a fact to lay the basis for the plaintiff's involvement in the completion of the characteristic portions of Inventions 1 through 3, and this allegation conforms with the statement made by the plaintiff in the examination of the plaintiff him/herself. However, the plaintiff's statement is not consistent, having changed in some important points from the contents stated in his/her written statement which was prepared prior to such examination, and thus cannot be easily trusted. Moreover, even if the plaintiff was involved in making the Inventions as alleged by him/herself, the

degree of involvement does not exceed the level of a simple idea, and thus this does not serve as a basis to find that the plaintiff was actually involved in the completion of the characteristic portions of Inventions 1 through 3.

Furthermore, although the plaintiff alleges that he/she was engaged in the planning and research and development of products as a fact to lay the basis for the plaintiff's involvement in the completion of the characteristic portions of Inventions 4 through 6, the details of such acts are nothing but an act to decide on the concrete specification of the products related to the invention after the completion of the invention. Thus, such allegation cannot serve as a basis to find that the plaintiff was actually involved in the completion of the characteristic portions of Inventions 4 through 6.

Based on the abovementioned findings, the plaintiff cannot be found to be the joint inventor of Inventions 1 through 6.