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| Patent Right | Date | May 26, 2022 | Court | Intellectual Property High Court, First Division |
| | Case number | 2020 (Ne) 10069 | | |
| - A case in which Appellant argued that it received from Appellee's Representative, etc., by way of assignment, a share in the right to be granted a patent for the Inventions, and made a claim for transfer registration procedures with regard to Appellant's share in the Patent Right, and the court ruled that Appellant's Representative, etc. cannot be acknowledged as joint inventors of the Inventions and that the above claim cannot be approved. | | | | |

Case type: Claim for Patent Right Transfer Registration Procedure pursuant to Article 74, paragraph (1) of the Patent Act

Result: Appeal dismissed

References: Article 74, paragraph (1) of the Patent Act

Related rights, etc.: Patent No. 5892637

Judgment of the prior instance: Tokyo District Court 2018 (Wa) 22338

Summary of the Judgment

1 In the present case, Appellant argued that the inventions for the Patent (Inventions) as registered under Appellee's name with the title, "Wrap net and its manufacturing method," were jointly invented by Appellant's Representative, etc. and Appellee's Representative, and that Appellant received from Appellee's Representative, etc., by way of assignment, a share in the right to be granted a patent for the Inventions, thereby demanding, pursuant to Article 74, paragraph (1) of the Patent Act, that Appellee take transfer registration procedures with regard to 1/2 of the Patent Right as Appellant's share.

The court of prior instance ruled that Appellant's Representative, etc. cannot be acknowledged as joint inventors of the Inventions, and dismissed Appellant's claim.

2 In the judgment of the present case, the court dismissed the Appeal by holding as outlined below regarding whether or not Appellant's Representative, etc. fall under inventors of the Inventions.

(1) Article 2, paragraph (1) of the Patent Act provides that an "invention" is "the highly advanced creation of technical ideas utilizing the laws of nature." Article 70, paragraph (1) of the same Act provides that "the technical scope of a patented invention must be determined based upon the statements in the claims attached to the written application." According to these provisions, it is reasonable to understand that, in order to be called an "inventor" of a patented invention, a person must have conceived the technical ideas (the technical problem and the means for solving the problem) for the patented invention, as embodied in the description of the scope of

claims, or must have been creatively involved in the embodiment of such ideas.

(2) (a) In order to address the problems found in conventional wrap nets, the technical ideas of Invention 1 addressed the issue of providing wrap nets which, even when, upon removing the wrap nets from roll bales, residues of the wrap nets are mixed into a feed or fermentation feedstock, cause little effect on livestock or cause no trouble with the fermentation equipment, while at the same time maintaining the advantages of wrapping that uses wrap nets as they are effective for transportation and storage. In order to solve the said issue, Invention 1 consists of a knitted fabric having a structure in which warps and wefts are both cellulosic fibers, with the warps forming a multiple number of independent chain stitches extending in the length direction of the knitted fabric, and the wefts forming the knitted fabric by joining the loops of the independent chain stitches with the loops of other independent chain stitches. Invention 1 is such that, even if livestock eat some wrap nets together with the feed, the wrap nets are made of same ingredients as hay and straw, so that they are digested inside the bodies of livestock without affecting the livestock. In addition, even if some wrap nets are mixed into fermentation feedstock and enter the fermentation equipment, they are decomposed like hay and straw, creating fermentation feedstock for bioethanol. Furthermore, the wrap nets can be used without being removed from roll bales, but instead kept on roll bales and the entirety being shredded along with roll bales to be turned into feeds for livestock, or used as fermentation feedstock, and it is acknowledged that the success of Invention 1 lies in the achievement of the foregoing.

Regarding this point, considering that Appellee contacted a company, which is a non-party to the litigation (Non-Party Company), in September 2013 to inform such party that cotton yarns are 100% cellulosic and that they are safe because they will be broken down by the degrading enzymes in the stomach even when eaten by cows, it is acknowledged that Appellee had already conceived, by September if not earlier, ideas about the effect that wrap nets can be used, without being removed from roll bales, by being shredded along with roll bales and the entirety being turned into feeds for livestock, or being used as fermentation feedstock. As for the very prototypes of wrap nets that use cotton yarns for warps and wefts, considering that they had been created by the time at which the time Non-Party Company evaluated the prototypes of wrap nets on May 31 of the same year, it is acknowledged that the technical ideas of Invention 1, including the aforementioned effect, were completed by September of the same year, if not earlier.

(b) There is no sufficient evidence to acknowledge that Appellant's Representative,

etc. conceived the technical ideas of Invention 1. Also, while Appellant created, between May 2013 and September of the same year, prototypes of wrap nets by using multiple types of cotton yarns, which were provided by Appellee, as warps and wefts, the cotton yarns that were used for the above prototypes were selected by Appellee and provided to Appellant, and the knitting structure of the above prototypes was commonly used, and Appellant used a raschel knitting machine, which Appellant had owned from earlier, to knit the fabric. In light of these circumstances, it cannot be acknowledged that Appellant was creatively involved in the making of the above prototypes for the embodiment of technical ideas of Invention 1.

Accordingly, it cannot be acknowledged that Appellant's Representative, etc. are inventors of Invention 1.

(3) (a) The technical ideas of Invention 11 address the problem that, in a wrap net consisting of a knitted fabric that uses cellulosic fibers and the like for warps and wefts, if warps are made stronger than wefts, the warps thicken, which means that the length of a wrap net that can be rolled into a single roll will be short. To solve this issue, a technical feature was adopted in which in the manufacturing method of wrap nets, when a wrap net is rolled up by rollers of the roll-up mechanism, the rollers are made to move back-and-forth with certain amplitude in the direction of the rotating shaft, thereby allowing the above wrap net, which is long, to be rolled into a single roll. It is acknowledged that the success of Invention 11 lies in the achievement of the foregoing.

Next, it is acknowledged that the above technical ideas were already embodied in the technical ideas of the invention pertaining to the earlier Application 2, which provides the basis for the priority claim for the application of the Patent. As such, it is acknowledged that Invention 11 was completed by July 22, 2013, which is when the earlier Application 2 was filed, if not earlier.

(b) There is no sufficient evidence to acknowledge that Appellant's Representative, etc. conceived the idea of applying traversing technique to the manufacturing of wrap nets and suggested it to Appellee's Representative or that Appellant provided Appellee with information about the traversing method, which Appellant claims to have implemented. As such, it cannot be acknowledged that Appellant's Representative, etc. conceived the idea of the technical feature of Invention 11 in which rollers are made to move back-and-forth with certain amplitude in the direction of the rotating shaft.

In addition, Appellant had never shown to Appellee the operating conditions of Appellant's raschel knitting machine until around January 2014, and it cannot be

acknowledged that as of 2013, Appellant was creating prototypes for wrap nets by employing the method of traversing rollers. Accordingly, it cannot be acknowledged that Appellant's Representative, etc. were creatively involved in the embodiment of technical ideas of Invention 11.

Therefore, the court cannot acknowledge that Appellant's Representative, etc. are inventors of Invention 11.