

Patent	Date	September 18, 2018	Court	Intellectual Property High Court, Second Division
Right	Case number	2018(Mu)10003		
<p>- In the case where a correction-upholding JPO decision has become final and binding after the final judgment of a patent infringement lawsuit in which the patentee lost has become final and binding on the grounds that the suspected infringing item did not belong to the technical scope of the patent invention, allegation by the retrial plaintiff who is a patentee that the final and binding correction upholding decision as grounds for the retrial is not allowed in view of the purpose of each provision in Article 104-4 and Article 126, paragraph(1), proviso, and the same Article, paragraph(6) of the Patent Act.</p>				

Case type: Request for Retrial

Result: Dismissed

References: Article 338, paragraph(1), item(viii) of the Code of Civil Procedure, Article 104-4, Article 126, paragraphs(1), (6) of the Patent Act

Number of related rights, etc.: Intellectual Property High Court, 2015(Ne)10040, Patent No. 4044598

Summary of the Judgment

1 This case is a case in which the retrial plaintiff alleged that there were grounds for retrial under Article 338, paragraph(1), item(viii) of the Code of Civil Procedure and demanded rescission of the judgment of the prior instance which was the final judgment of the patent infringement lawsuit.

The judgment of the prior instance (Intellectual Property High Court, 2015(Ne)10040, Judgment of August 6, 2015) dismissed the appeal to the judgment in the prior instance which dismissed the demand by the retrial plaintiff on the ground that the product by the retrial defendant did not belong to the technical scope of the corrected invention.

After the judgment of the prior instance became final and binding, the retrial plaintiff made a request for correction trial, and the JPO decision upholding correction of this case became final and binding.

The retrial plaintiff alleged that, since the decision to grant a patent related to the patent right (Patent No. 4044598) which was an administrative measure on which the judgment of the prior instance was grounded was changed by the JPO decision upholding correction which was a subsequent administrative measure, there were grounds for retrial under Article 338, paragraph(1), item(viii) of the Code of Civil Procedure.

2 This court decision was determined as follows, and the request for retrial was dismissed.

(1) The Patent Act provides that correction by request for correction trial is allowed only for the purpose of a predetermined matter including restriction of the scope of claims (Article 126, paragraph(1), proviso of the Patent Act), and moreover, it provides that "the scope of claims should not be substantially expanded or changed" (the same Article, paragraph(6)). This is intended to protect trust by general third parties in the description of the scope of claims, since the correction has a retroactive effect and an effect in rem, and if an invention not included in the scope of claims before correction is included in the scope of claims after the correction, there is a concern that it would inflict an unexpected loss to a third party, and the provision in Article 126, paragraph(6) of the Act is interpreted as a provision with the meaning to secure that such situation would not occur. As described above, since the Patent Act guarantees that the suspected infringing item not belonging to the technical scope of the patent invention before correction does not belong to the technical scope of the patent invention after the correction, allegation in the retrial that the suspected infringing item belongs to the technical scope of the patent invention after the correction by the patentee's obtaining the JPO decision upholding correction after the judgment which dismissed the request on the grounds that the suspected infringing item did not belong to the technical scope of the patent invention is not expected at all in the Patent Act. Moreover, since the retrial plaintiff had an opportunity and a function to allege and verify the technical scope of the invention (the present invention and the present corrected invention) according to the patent on which the judgment of the prior instance was grounded in the base case, if the judgment of the prior instance can be overturned for a reason not expected at all by the Patent Act that the present JPO decision upholding correction has become final and binding after the judgment of the prior instance became final and binding, it brings up a dispute again and is not appropriate from a viewpoint of dispute solving functions and legal stability of patent infringement lawsuits and is not in line with the purpose of the provision in Article 104-4 of the Patent Act. The retrial plaintiff made a request for a correction trial and obtained the JPO decision upholding the correction (primary correction) during pending of the base case, and the circumstances that the retrial plaintiff could not obtain the JPO decision upholding the correction during pending of the base case is not found, either.

By considering these circumstances, the allegation by the retrial plaintiff that the JPO decision upholding correction has become final and binding, as the grounds for retrial should not be allowed in view of the purpose of each provision in Article 104-4,

Article 126, paragraph(1), proviso, and paragraph(6) of the Patent Act.

(2) According to the aforementioned (1), since the retrial plaintiff cannot allege that the JPO decision upholding correction has become final and binding, the allegation that there were grounds for retrial under Article 338, paragraph(1), item(viii) of the Code of Civil Procedure on the ground that the decision to grant a patent related to the patent right which was an administrative measure on which the judgment of the prior instance was grounded was changed by the JPO decision upholding correction which was a subsequent administrative measure does not have a premise or a reason.