

Patent Right	Date	November 24, 2023	Court	Tokyo District Court, 46th Civil Division
	Case number	2021 (Wa) 9575		
<p>- A case in which the Plaintiff, who worked as an employee in the sales position of the Defendant, filed an action after retirement to: principally claim the return of unjust enrichment, etc. by alleging that the Defendant gained unjust enrichment because, although the invention made by the Plaintiff is not an employee invention, the Defendant assumed it to be an employee invention and obtained a patent for the invention; and alternatively claim payment of reasonable consideration by alleging that, if that invention is an employee invention, the Plaintiff should have received payment of reasonable consideration but has not yet received it.</p>				

Summary of the Judgment

The Plaintiff, a former employee of the Defendant, while working in the sales position, made an invention relating to a probe device, and prepared a report according to the internal rules in which the Plaintiff stated their intention to assign to the Defendant their right to be granted intellectual property rights for the invention and submitted this report to the Defendant. Then, the Defendant filed a patent application for the invention stated in this report and registered the establishment of the patent right concerning the patent for an invention titled "Probe device" (the "Patent Right" and the "Patent"). In this case, the Plaintiff principally claimed the return of the money gained by the Defendant, alleging that the Defendant gained unjust enrichment because, although the invention stated in the report is not an employee invention, the Defendant filed a patent application and obtained a patent for the invention relevant to the Patent by assuming that the invention stated in the report was an employee invention and considering that the Defendant succeeded to the right to be granted a patent; and also requested the registration of the transfer of the Plaintiff's share in the patent right by exercising the right to demand removal of obstruction, alleging that the Defendant's succession to the right to be granted a patent is null and void. The Plaintiff alternatively claimed payment of reasonable consideration for the invention stated in the report, alleging that, if it is an employee invention, the Plaintiff should have received payment of reasonable consideration but has not yet received it.

The issues of the case are as follows: (1) regarding the principal claims, [i] whether the Plaintiff's request for the registration of the transfer of their share in the Patent Right is acceptable, [ii] whether the inventions described in Claims 1 and 2 of the Patent

(hereinafter the invention described in Claim 1 is referred to as "Invention 1" and the invention described in Claim 2 is referred to as "Invention 2"; these inventions are collectively referred to as the "Inventions") are not employee inventions, and the Defendant has not duly succeeded to the right to be granted a patent for these inventions, and [iii] whether the Defendant has worked the Inventions, and the amount of profit gained by the Defendant from working the Inventions; and (2) regarding the alternative claim, [iv] whether the Defendant has worked the Inventions, and the amount of "reasonable consideration", and [v] whether the Defendant's obligation to pay reasonable consideration has been extinguished by prescription. In this judgment, the court dismissed all of these claims.

Regarding the principal claims mentioned in (1), the court found, first on Issue [ii], that: the Plaintiff discovered problems with the Defendant's products by hearing requests from customers and conducting study by themselves while engaging in work for the Defendant, studied a method to solve these problems, and made the Inventions that would be able to solve the problems; and in light of the Plaintiff's position, job type and job content as found by the court, the Plaintiff was supposed and expected to discover problems with the Defendant's products and study and propose a method to improve the products. Based on these findings, the court determined that the Inventions are employee inventions and concluded that none of the principal claims can be upheld.

Regarding the alternative claim mentioned in (2), the Plaintiff argued that: the Defendant's products in which specific software is implemented have the structures of other inventions of the Defendant; however, these other inventions are inventions of improvement of the Inventions, and therefore, the manufacturing, sale, etc. of the Defendant's products constitute the working of the Inventions. However, the court determined that the Defendant worked neither of the Inventions.