

Patent	Date	August 27, 2024	Court	Intellectual Property High Court, Third Division
	Case number	2024 (Gyo-Ke) 10016		

- In connection with the trial decision in question (the "JPO Decision") that dismissed without prejudice a request for retrial against a trial decision on an appeal against the examiner's decision of refusal (the "Initial JPO Decision"), the court rescinded the JPO Decision, holding that its determination to the effect that the request for retrial is unlawful and not amendable is erroneous, based on the findings that, although the Initial JPO Decision was not final and binding at the time of filing the request for retrial, it had become final and binding at the time of the rendition of the JPO Decision, and consequently the defect that the Initial JPO Decision was not final and binding at the time of filing the retrial has been remedied upon the rendition of the JPO Decision, and that this defect does not serve as a basis for dismissing without prejudice the request for retrial.

(Case type) Rescission of Trial Decision of Dismissal

(Result) Granted

(References) Article 171, paragraph (1), Article 174, paragraph (2) and Article 135 of the Patent Act

(Decision of JPO) Retrial No. 2023-950004

Summary of Judgment

1. The Plaintiff received a decision of refusal of its patent application, and filed an appeal against the examiner's decision of refusal. On September 21, 2023, the Japan Patent Office (JPO) rendered a decision to dismiss the request for this trial (the "Initial JPO Decision"), and the certified copy was served upon the Plaintiff on October 14, 2023.

On November 9, 2023, the Plaintiff filed a request for retrial against the Initial JPO Decision (hereinafter referred to as the "Request for Retrial"); however, the JPO rendered the JPO Decision to dismiss without prejudice the Request for Retrial on January 23, 2024.

This case relates to an action in which the Plaintiff sought the rescission of the JPO Decision to dismiss without prejudice the Request for Retrial.

2. With respect to a request for retrial against a trial decision on an appeal against the examiner's decision of refusal, Article 171, paragraph (1) of the Patent Act provides that a party to or an intervenor in a trial may file a request for a retrial against a final

and binding trial decision. In addition, Article 135 of the Patent Act as applied *mutatis mutandis* pursuant to Article 174, paragraph (2) of the same Act provides that a request for retrial against a final and binding appeal against the examiner's decision of refusal that is unlawful and not amendable may be dismissed without prejudice by a decision on the trial.

In the JPO Decision, the JPO dismissed the Request for Retrial, holding that it should be dismissed without prejudice under Article 135 of the Patent Act as applied *mutatis mutandis* pursuant to Article 174, paragraph (2) of the same Act, as the Initial JPO Decision was not final and binding on the day of filing the Request for Trial and therefore the Request for Trial is not the one filed against a final and binding trial decision, and that this request violates Article 171, paragraph (1) of the Patent Act and its defect is not amendable.

3. In this judgment, the court rescinded the Initial JPO Decision based on the following reasons.

(1) It is found that the Initial JPO Decision became final and binding upon the elapse of 30 days from October 14, 2023, when the certified copy of the Initial JPO Decision was served upon the Plaintiff, namely, as of November 13, 2023, without the filing of an action seeking the rescission of the Initial JPO Decision by the Plaintiff.

It was on November 9, 2023 when the Plaintiff filed the Request for Retrial, so the Initial JPO Decision had not become final and binding on that day. That being said, the Initial JPO Decision had already become final and binding at the time of rendition of the JPO Decision (on January 23, 2024). Consequently, although the Request for Retrial contained a defect that the Initial JPO Decision was not final and binding at the time of its filing, such defect should be considered to have been remedied since the Initial JPO Decision had become final and binding at the time of rendition of the JPO Decision. Therefore, it is reasonable to understand that this defect does not serve as a basis for dismissing without prejudice the Request for Retrial.

(2) In addition, in the written request for the Request for Retrial, it is found that the Plaintiff alleged the grounds for retrial referred to in Article 338, paragraph (1) of the Code of Civil Procedure as applied *mutatis mutandis* pursuant to Article 171, paragraph (2) of the Patent Act. Therefore, apart from the issue of acceptability of these grounds to retrial, no illegality or lack of allegation of grounds for retrial is found in the Request for Retrial.

Further, the court finds no other unlawful and non-amendable points regarding the Request for Retrial.

(3) Based on the above, the court finds that the Request for Retrial is not an unlawful

and non-amendable request. Therefore, the determination of the JPO Decision that the Request for Retrial is an unlawful and non-amendable request is erroneous.

4. The Plaintiff raised the following two claims in the objects of claims of this action, in addition to a claim requesting the rescission of the JPO Decision, namely, a claim to the effect that "Patent Application No. 2019-139228 concerning an invention titled 'Non-dried tea paste' should be granted a patent" and a claim to the effect that "as the trial decision dated January 23, 2024 was not subjected to a reexamination before trial by a collegial body, a reexamination before trial shall be conducted." In this judgment, the court made an interpretation of the nature of the actions pertaining to these two claims, and dismissed them without prejudice as being unlawful.

Judgment rendered on August 27, 2024

2024 (Gyo-Ke) 10016

Case of seeking rescission of the JPO decision

Date of conclusion of oral argument: June 20, 2024

Judgment

Plaintiff: X

Defendant: Commissioner of the Japan Patent Office

Main Text

1. This action shall be dismissed without prejudice, with respect to the part requesting that the court require the Defendant, the Commissioner of the Japan Patent Office (JPO), to issue an examiner's decision to grant a patent for Patent Application No. 2019-139228 or to effect the registration of its establishment, and to refer the retrial procedures to reexamination by the examiner before trial.
2. The trial decision concerning Retrial No. 2023-950004 rendered by the JPO on January 23, 2024 shall be rescinded.
3. Court costs shall be divided into three parts and the Plaintiff shall bear two parts thereof and the Defendant shall bear the rest, respectively.

Facts and Reasons

No. 1 Objects of claims

1. Patent Application No. 2019-139228 for an invention titled "Non-dried tea paste" should be granted a patent.
2. Same as Paragraph 2 of the main text.
3. As the trial decision dated January 23, 2024 was not subjected to reexamination before trial by a collegial body, reexamination before trial shall be conducted.

No. 2 Background

1. Outline of procedures at the JPO

- (1) On June 24, 2019, the Plaintiff filed a patent application for an invention titled "Non-dried tea paste" (Patent Application No. 2019-139228; the number of claims: 2; hereinafter referred to as the "Application") (Exhibit Ko 4-1).
- (2) Receiving a notice of grounds for refusal dated December 15, 2021, the Plaintiff submitted a written opinion on January 31, 2022, but received a decision of refusal on May 6, 2022 (Exhibits Ko 4-3 through 4-5).
- (3) On May 31, 2022, the Plaintiff filed an appeal against the examiner's decision of

refusal (Appeal against Examiner's Decision of Refusal No. 2022-9649), and submitted a written amendment to amend the patent description to the JPO (Exhibits Ko 4-6 and 4-7).

(4) On September 21, 2023, the JPO rendered a trial decision to the effect that "the request for the trial is groundless" (hereinafter referred to as the "Initial JPO Decision"), and the certified copy thereof was served upon the Plaintiff on October 14, 2023 (Exhibit Ko 3 and Exhibit Otsu 1).

(5) The Plaintiff filed a request for retrial against the Initial JPO Decision on November 9, 2023 (Retrial No. 2023-950004; hereinafter referred to as the "Request for Retrial") (Exhibit Ko 4-8).

(6) On January 23, 2024, the JPO rendered a trial decision on the Request for Retrial to the effect that "the request for retrial shall be dismissed without prejudice" (hereinafter referred to as the "JPO Decision"), and the certified copy thereof was served upon the Plaintiff on February 9, 2024 (Exhibit Otsu 2).

(7) On February 21, 2024, the Plaintiff instituted this action to seek the rescission of the JPO Decision.

2. Statement of the patent claims

The statement of the patent claims concerning the Application is as follows (hereinafter, the inventions stated in Claims 1 and 2 of the Application are collectively referred to as the "Inventions") (Exhibits Ko 3 and 4-1).

[Claim 1]

Non-dried tea paste

[Claim 2]

Non-dried, frozen tea

3. Summary of the reason for the JPO Decision

The reason for the JPO Decision, in summary, is that the Request for Retrial should be dismissed without prejudice under Article 135 of the Patent Act as applied *mutatis mutandis* pursuant to Article 174, paragraph (2) of the same Act, as the Initial JPO Decision was not final and binding on the day of filing the Request for Trial and therefore the Request for Trial is not the one filed against a final and binding trial decision, and that this request violates Article 171, paragraph (1) of the same Act and its defect is not amendable.

No. 4 Judgment of this court

1. Ground for rescission of the JPO Decision (Paragraph 2 of the Objects of claims)

(1) The law provides that a party to or an intervenor in a trial may file a request for a

retrial against a final and binding trial decision (Article 171, paragraph (1) of the Patent Act). In addition, a request for retrial against a final and binding appeal against the examiner's decision of refusal that is unlawful and not amendable may be dismissed without prejudice by a decision on the trial (Article 135 of the Patent Act as applied *mutatis mutandis* pursuant to Article 174, paragraph (2) of the same Act). Therefore, this court will examine whether the Request for Retrial is unlawful and not amendable.

A. It is found that the Initial JPO Decision became final and binding upon the elapse of 30 days from October 14, 2023, when the certified copy of the Initial JPO Decision was served upon the Plaintiff, namely, as of November 13, 2023, without the filing of an action seeking the rescission of the Initial JPO Decision by the Plaintiff.

It was on November 9, 2023 when the Plaintiff filed the Request for Retrial, so the Initial JPO Decision had not become final and binding on that day. That being said, the Initial JPO Decision had already become final and binding when the JPO Decision was rendered in response to the Request for Retrial (on January 23, 2024) (No. 2, 1.(6) above). Consequently, although the Request for Retrial contained a defect in that the Initial JPO Decision was not final and binding at the time of its filing, such defect should be considered to have been remedied because the Initial JPO Decision had become final and binding at the time of the rendition of the JPO Decision. Therefore, it is reasonable to understand that this defect does not serve as a basis for dismissing without prejudice the Request for Retrial.

B. In addition, in the written request for the Request for Retrial (Exhibit Ko 4-8), it is found that the Plaintiff alleged the grounds for retrial referred to in Article 338, paragraph (1) of the Code of Civil Procedure as applied *mutatis mutandis* pursuant to Article 171, paragraph (2) of the Patent Act. Therefore, apart from the issue of acceptability of these grounds, no illegality or lack of allegation of grounds for retrial is found in the Request for Retrial.

Further, the court finds no other unlawful and non-amendable points regarding the Request for Retrial.

C. Based on the above, the court finds that the Request for Retrial is not an unlawful and non-amendable request.

(2) Then, the determination of the JPO Decision that the Request for Retrial is an unlawful and non-amendable request is erroneous, and the grounds for rescission as alleged by the Plaintiff are well-founded.

2. Actions concerning Paragraphs 1 and 3 of the Objects of claims

(1) Paragraph 1 of the Objects of claims, which is stated in No. 1, 1. above, is understood as a *mandamus* action requesting that the court require the Defendant to

issue a decision to grant a patent for the Application or to effect the registration of its establishment.

However, if the court finds a claim in an action instituted against a trial decision to be well-founded, it must rescind the decision on the trial (Article 181, paragraph (1) of the Patent Act). Further, once the court's decision rescinding a decision on a trial has become final and binding, the administrative judges must carry out further proceedings and issue a decision on a trial (paragraph (2) of the same Article). Thus, in the action against a trial decision, the court cannot render a judgment ordering that the JPO issue a decision to grant patent or effect the registration of establishment of patent disputed in the trial decision. Therefore, the action concerning Paragraph 1 of the Objects of claims is found to be unlawful and therefore should be dismissed without prejudice.

(2) Paragraph 3 of the Objects of claims, which is stated in No. 1, 3. above, is understood as a mandamus action requesting that the court require the Defendant to conduct a reexamination by the examiner before trial after the judgment rescinding the JPO Decision became final and binding.

However, as mentioned above, if the court finds a claim in an action against a trial decision to be well-founded, it must rescind the decision on the trial (Article 181, paragraph (1) of the Patent Act), and the Patent Act has no provisions that provide the basis for the court to issue a mandamus order in an action against a trial decision that requires specific formalities of examination in trial proceedings after a judgment rescinding the trial decision becomes final and binding.

In addition, with respect to administration litigations in general, whereas a mandamus action is an action seeking an order from the court requiring an administrative authority to make a specific disposition or decision where the administrative authority fails to do so in spite of its obligations (Article 3, paragraph (6) of the Administrative Case Litigation Act), a reexamination by the examiner before trial in trial proceedings obviously does not fall under a "disposition or decision."

Therefore, an action pertaining to Paragraph 3 of the Objects of claims is unlawful and should be dismissed without prejudice.

Meanwhile, even supposing that Paragraphs 1 and 3 of the Objects of claims, which take the form of a mandamus action, substantially pertain to an action seeking a declaratory judgment confirming an obligation to grant a patent for the Application or register the establishment of a patent in the case of Paragraph 1, or an action seeking a declaratory judgment confirming an obligation to refer the retrial procedures to a reexamination by the examiner before trial in the case of Paragraph 3, the court is not allowed, in light of the Patent Act, to render such declaratory judgment. Therefore, even

on this supposition, the conclusion that the actions pertaining to Paragraphs 1 and 3 of the Objects of claims are unlawful is not affected.

3. Conclusion

Based on the above, the grounds for rescission as alleged by the Plaintiff are well-founded, so the JPO Decision should be rescinded; consequently, the claim pertaining to Paragraph 2 of the Objects of claims is found to be well-founded.

On the other hand, the actions pertaining to Paragraphs 1 and 3 of the Objects of claims are unlawful and should be dismissed without prejudice.

Therefore, the court renders a judgment as stated in the main text.

Intellectual Property High Court, Third Division

Presiding judge: NAKADAIRA Ken

Judge: IMAI Hiroaki

Judge: MIZUNO Masanori