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| Patent<br>Right  | Date           | February 29, 2024 | Court | Tokyo District Court, 40th<br>Civil Division |
|  | Case<br>number | 2023 (Gyo-U) 5004 |       |  |
| - A case in which the court determined that the circumstances in question do not fall under "having legitimate grounds" as set forth in Article 112-2, paragraph (1) of the Former Patent Act. |                |                   |       |  |

### Summary of the Judgment

Concerning procedures to pay patent fees and extra patent fees for fiscal year 2023 for Patent No. 6127102 (hereinafter the patent shall be referred to as the "Patent" and the patent right related to the Patent as the "Patent Right") as submitted as of March 22, 2022, the Commissioner of the Japan Patent Office determined, as of December 1, 2022, that it cannot be found that there are legitimate grounds for failing to complete the procedures within the pre-determined period and the circumstances in question do not fall under the requirements set forth in Article 112-2, paragraph (1) of the Patent Act (the Patent Act prior to the amendment by Act No 42 of 2021; hereinafter referred to as the "Former Patent Act"), and the Commissioner dismissed said procedures based on the main clause of Article 18-2, paragraph (1) of the Former Patent Act (hereinafter referred to as the "Dismissal").

This is a case in which the Plaintiff alleged that the Dismissal is illegal and demanded the revocation of the Dismissal.

In this judgment, the court determined, as summarized below, that it cannot be objectively considered that the patent attorney, who was in charge of filing the application for the Patent and payment and management of the patent fees (hereinafter referred to as the "Patent Attorney") was not able to pay the patent fees, etc. within the late payment period although having paid reasonable attention.

It is reasonable to construe that the phrase "having legitimate grounds" as set forth in Article 112-2, paragraph (1) of the Former Patent Act refers to cases where it was objectively impossible for a patentee (including its agent) to pay patent fees, etc. within the late payment period although they paid reasonable attention.

Applying the aforementioned understanding to this case, it is found that the Patent Attorney paid to the Japan Patent Office the trademark registration fees, patent fees, etc. during the late payment period from April 15, 2021 to October 14, 2021, and submitted written amendments and other necessary documents. It is also found that, even after the late payment period, the Patent Attorney paid the trademark registration fees and patent

fees, etc., submitted the application examination request form and trademark right transfer registration application form, and filed applications for patents.

In consideration of these circumstances, the Patent Attorney paid the patent fees and registration fees for other cases during the late payment period related to the Patent Fees, and objective circumstances to explain the failure to pay the Patent Fees alone could not be found.

Consequently, it is reasonable to find that the Dismissal is legitimate and the Plaintiff's claim is groundless.

Based on the above, the court dismissed the Plaintiff's claim.