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Date of the judgement

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1992.04.28

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Case Number

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1988(Gyo-Tsu)10

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Reporter

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Minshu Vol. 46, No. 4

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Title

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Judgment concerning allegation and proof in an action for the revocation of the second JPO decision in cases where a judgment to revoke the initial JPO decision invalidating a patent was rendered on the grounds that a person ordinarily skilled in the art cannot be considered to have been able to easily make the invention based on a specific cited document

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Case name

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Case to seek revocation of a trial decision

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Result

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Judgment of the Third Petty Bench, quashed and decided by the Supreme Court

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Court of the Second Instance

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Tokyo High Court, Judgment of October 8, 1987

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Summary of the judgement

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1. In cases where a judgment to revoke a JPO decision invalidating a patent was rendered on the grounds that a person ordinarily skilled in the art cannot be considered to have been able to easily

make the invention based on a specific cited document, and the JPO issued another decision, subject to the binding force of said judgment, to the effect that a person ordinarily skilled in the art cannot be considered to have been able to easily make the invention based on the same cited document, in an action for the revocation of the second JPO decision, the submission of any allegation or proof arguing that a person ordinarily skilled in the art would have been able to easily make the invention based on the same cited document should not be allowed.

2. In cases where a judgment to revoke a JPO decision invalidating a patent was rendered on the grounds that a person ordinarily skilled in the art cannot be considered to have been able to easily make the invention based on a specific cited document, even when, in the second trial procedure, a party alleged that a person ordinarily skilled in the art would have been able to easily make the invention based on other cited documents, etc. in addition to said specific cited document, if the party did not mean to allege that a person ordinarily skilled in the art would have been able to easily make the invention based on these additional cited documents, etc. alone, or to allege that a person ordinarily skilled in the art would have been able to easily make the invention based on the additional cited documents, etc. in combination with said specific cited document that had been examined in the previous action, the second JPO decision to the effect that a person ordinarily skilled in the art cannot be considered to have been able to easily make the invention based on said specific cited document and the additional cited documents, etc. should be held to have been issued subject to the binding force of the judgment of revocation, and cannot be held to be illegal in an action to seek revocation of the second JPO decision.

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References

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Article 29, paragraph (2), Article 123 and Article 181 of the Patent Act, Article 33 of the Administrative Case Litigation Act

Patent Act

Article 29

(2) Where, prior to the filing of the patent application, a person ordinarily skilled in the art of the invention would have been able to easily make the invention based on an invention prescribed in any of the items of the preceding paragraph, a patent shall not be granted for such an invention notwithstanding the preceding paragraph.

Article 123

(1) Where a patent falls under any of the following, a request for a trial may be filed. In the event of two or more claims, a request for a trial for patent invalidation may be filed for each claim.

(i) where the patent has been granted in violation of Articles 25, 29, 29-2, 32, 38 or 39(1) to 39(4);

(ii) where the patent has been granted in violation of a treaty;
(iii) where the patent has been granted on a patent application not complying with the requirements as provided in Article 36(4) or 36(5) (excluding 36(6)(iii)) and 36(6);
(iv) where the patent has been granted on a patent application filed by a person who is not the inventor and has not succeeded to the right to obtain a patent for the said invention;
(v) where, after the grant of a patent, the patentee has become unable to hold a patent right under Article 25, or the patent has become in violation of a treaty.
(2) A request for a trial of the preceding paragragh may be filed even after the lapse of the patent right.
(3) Where a request for a trial under Article 123(1) has been filed, the chief trial examiner shall notify the exclusive licensee of the patent right and other persons who have any registered rights relating to the patent.
Article 181
(1) Where the court finds for the plaintiff in an action instituted under Article 178(1), it shall rescind the trial decision or ruling.
(2) When the court's decision rescinding a trial decision or ruling of the preceding paragragh or the court's ruling rescinding a trial decision under paragraph (2) has become final and binding, the trial examiners shall carry out further proceedings and render a trial decision or ruling.
Administrative Case Litigation Act
Article 33
(1) A judgment to revoke an original administrative disposition or administrative disposition on appeal shall be binding on the administrative agency that has made the original administrative disposition or administrative disposition on appeal and any other relevant administrative agency with regard to the case.
(2) When a judgment is made to revoke an original administrative disposition that has dismissed an application with or without prejudice or to revoke an administrative disposition on appeal that has dismissed a request for administrative review with or without prejudice, the administrative agency that has made the original administrative disposition or administrative disposition on appeal shall, according to the purport of the judgment, make another original administrative disposition on the application or another administrative disposition on appeal on the request for administrative review.
(3) The provision of the preceding paragraph shall apply mutatis mutandis where an original administrative disposition made based on an application or an administrative disposition on appeal upholding a request for administrative review is revoked by a judgment by reason of an illegal procedural defect.
(4) The provision of paragraph (1) shall apply mutatis mutandis to an order of stay of execution.
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Main text of the Judgment

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The judgment in prior instance is quashed.

The claim filed by the appellee of final appeal is dismissed.

The appellee of final appeal shall bear the total court cost, and the supporting interveners for the appellee of final appeal shall bear the court cost incurred from their intervention.

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Reasons

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Concerning Reason I for final appeal argued by the appeal counsel

I. The outline of the facts determined by the court of prior instance and the developments of this action are as follows.

1. The appellant of final appeal is a patentee for Patent No. 759004 (patent application filed on May 19, 1962; title of the invention: "fast-rotating barrel polishing method"; hereinafter this invention is referred to as the "Invention" and this patent is referred to as the "Patent"). The Invention relates to a fast-rotating barrel polishing method wherein multiple barrels for which the inside is formed in a regular polygonal (hexagonal or octagonal) prism shape are arranged at equal intervals at the symmetrical positions on the rotation trajectory centered on the main axis so that the longitudinal axis of each barrel or barrel case will be parallel to the main axis. Also, said barrels are driven to rotate on the main axis in a manner such that all points on the barrels move in the same direction: the barrels do not rotate on their own axes against the space, and at a high speed sufficient to apply effective centrifugal force to the objects put into the barrels (the mixture of the work and abrasive powder; hereinafter referred to as the "mass"), thereby applying the centrifugal effect to the mass, while at the same time, having only the upper portion of the mass that has exposure to the empty space within the barrel circulated and fluidized, while rubbing the entire amount of work evenly and incessantly without causing tumbling and keeping the free pieces of work floating within the fluidized portion in contact with the abrasive power, so as to perform surface polishing.

2. [1] On October 7, 1975, the appellee filed a request for a trial for invalidation of the Patent. In response, on April 16, 1979, the JPO trial examiner issued a decision to invalidate the Patent, on the grounds that a person ordinarily skilled in the art to which the Invention belongs (hereinafter simply referred to as a "person ordinarily skilled in the art") would have been able to easily make the Invention, prior to the filing of the patent application (this decision is hereinafter referred to as the "previous JPO decision"). The appellant filed an action for the revocation of the previous JPO decision. On June 23, 1983, the Tokyo High Court rendered a judgment to revoke the previous JPO decision, on the grounds that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, and this judgment

(hereinafter referred to as the "previous judgment") became final and binding. [2] The JPO trial examiner further examined the case of the previous JPO decision pursuant to Article 181, paragraph (2) of the Patent Act, and issued the decision in question (hereinafter referred to as the "JPO Decision") to dismiss the appellee's request for a trial on February 15, 1985, on the grounds that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application.

The appellee files this action for the revocation of the JPO Decision, alleging illegality of the JPO's findings and determination to the effect that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on any one of the patent descriptions made publicly available prior to the filing of the patent application regarding the Invention, namely, the first cited document (the description of US Patent No. 1491601), the second cited document (the description of US Patent No. 2561037), and the third cited document (the description of US Patent No. 3013365).

3. Among the reasons for the previous judgment that revoked the previous JPO decision, the reasons concerning the abovementioned cited documents are as follows. [1] The invention described in the second cited document relates to the rotating polishing operation using barrels for which the inside is formed in a regular tetragonal prism shape. [2] According to the description in question, the rotating barrel polishing method using barrels for which the inside is formed in a regular tetragonal prism shape differs from the rotating barrel polishing method using barrels for which the inside is formed in a regular hexagonal or octagonal prism shape in terms of the behavior of the mass, and the former method is by far inferior to the latter method in terms of the function and effect such as the roughness of the polished surface, and therefore the former method cannot be said to be identical to the polishing method in the Invention. [3] The invention described in the third cited document cannot be described as substantially constituting the rotating barrel polishing operation that is intended in the Invention. [4] Given these facts, the previous JPO decision, in which the JPO invalidated the Patent on the grounds that a person ordinarily skilled in the art would have been able to easily make the Invention, prior to the filing of the patent application, based on the second cited document or the third cited document, is illegal due to errors in identifying the technical matters of the cited inventions and erroneous findings in terms of the differences and common features between the Invention and the cited inventions.

In the JPO Decision, following the abovementioned reasons for the previous judgment, the JPO determined that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on the second cited document or the third cited document. With regard to the invention described in the first cited document, which was additionally cited through the second trial procedure, the JPO determined that said invention does not relate to the fast-rotating barrel polishing operation designed to perform surface polishing

by having only the upper portion of the mass circulated and fluidized and rubbing the work without causing tumbling, and that therefore a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on the first cited document.

II. Based on the facts determined as shown above, the court of prior instance found and determined as follows, and revoked the JPO Decision, on the grounds that the JPO Decision is illegal for determining that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application.

1. The invention described in the second cited document and the Invention have the same structure, except that the inside of the barrels of the former is formed in a regular tetragonal prism shape, whereas the inside of the barrels of the latter is formed in a regular hexagonal or octagonal prism shape. The second cited invention states that, "the present invention is described in the form of a special example, and a person ordinarily skilled in the art to which this invention belongs would be able to practice the invention easily in other forms, by modifying this example in various ways."

2. [1] Although the invention described in the first cited document does not involve the idea of rotating the barrels by centrifugal force, it relates to a kind of rotating barrel polishing operation, and its example discloses casings (barrels) in a regular hexagonal prism shape. [2] The third cited document relates to a rotating barrel polishing method wherein the barrels do not rotate in the same manner as the barrels in the Invention, which rotate on the main axis while not rotating on their own axes, or in short, they do not rotate like the cabins of a Ferris wheel. However, the third cited document states that, "although it is preferable to use cylindrical drums (barrels) with a circular section, drums (barrels) with various types of polygonal sections may be selected." [3] In connection with the barrel polishing method using barrels that rotate on their own axes, barrels in a hexagonal or octagonal prism shape were well-known and commonly used.

3. In the fast-rotating barrel polishing method wherein centrifugal force is applied to barrels to make them rotate like the cabins of a Ferris wheel, the behavior of the mass within the barrel is not determined only by the shape of the inside of the barrel. Rather, according to Exhibit Ko No. 12 submitted by the appellee in the prior instance ("Report of Observation of the High-speed Filming Experiment of Centrifugal Barrel Polishing," prepared by E, Company D) and Exhibits Ko No. 14-1 to No. 14-3 (experimental result reports, prepared by Director G, Experiment Station F, Nagano Prefecture), in comparison of barrels in a regular tetragonal prism shape and those in a regular hexagonal or octagonal prism shape, no particular difference can be found in terms of the flow of the entire mass, nor can any particularly noticeable difference be found in terms of the amount of work polished or the roughness of the polished surface.

4. The fast-rotating barrel polishing method in the Invention differs, in terms of the behavior of the mass within the barrels, from the barrel polishing method using barrels that rotate on their own axes,

or from other types of rotating barrel polishing methods wherein the barrels rotate without centrifugal force, as adopted in the invention described in the first cited document, or wherein the barrels do not rotate like the cabins of a Ferris wheel, as adopted in the invention described in the third cited document. However, the invention described in the second cited document has the same structure as that of the Invention except for the shape of the barrels, and there is no particular difference between them in terms of the behavior of the mass, the amount of the work polished, or the roughness of the polished surface. No particular inventive faculty would be required to conceive of the idea of adopting barrels in a hexagonal or octagonal prism shape, which were well-known and commonly used for the barrel polishing operation using barrels that rotate on their own axes, in place of barrels in a regular tetragonal prism shape used in the invention described in the second cited document, based on the implications given by the first to third cited documents. Even where a difference is found between the Invention and the invention described in the second cited document in terms of the function and effect, the abovementioned idea is nothing more than an idea that could have naturally been reached by replacing the barrels used in the invention described in the second cited document with barrels in a hexagonal or octagonal prism shape based on the matters implied in the first to third cited documents.

Consequently, a person ordinarily skilled in the art would have been able to easily make the Invention, prior to the filing of the patent application.

5. In an action for the revocation of the second JPO decision, if a party submits evidence to support the facts concerning the points on which the JPO made findings and determination in its second decision that was not examined or explained by the JPO in its findings and determination and that goes against said findings and determination, the court should be allowed to make findings of fact based on such evidence and hold the JPO's findings and determination in its second decision to be illegal. The doctrine of binding force of a court judgment to revoke an administrative disposition does not prohibit the court from doing so.

In this case, it is supported by the abovementioned evidence, which was submitted by the appellee in the prior instance in the action for the revocation of the second JPO decision, that there is no substantial difference between the invention described in the second cited document and the Invention in terms of the behavior of the mass in the barrel, the amount of the work polished, and the roughness of the polished surface. What is more, since this point was not specifically examined or explained in the JPO's findings and determination in the JPO Decision, it should be said that nothing prohibits the court in this action from finding errors in the JPO's findings and determination in the JPO Decision on this point.

III. However, we cannot affirm the findings and determination by the court of prior instance mentioned above, on the following grounds.

1. In an action for the revocation of a JPO decision issued in response to a request for a trial for

patent invalidation, when a judgment to revoke the JPO decision is rendered and becomes final and binding, the JPO trial examiner is to further examine the case of said JPO decision as provided in Article 181, paragraph (2) of the Patent Act, and issue another decision. Since an action for the revocation of a JPO decision is governed by the Administrative Case Litigation Act, the JPO's second examination and decision are bound by said judgment of revocation pursuant to the provisions of Article 33, paragraph (1) of said Act. As this binding force is effective on the findings of fact and legal determination required for drawing the main text of a judgment, the JPO trial examiner must not be allowed to make findings or determination that conflict with the court's findings and determination in the judgment of revocation. Therefore, in the second trial procedure, the JPO trial examiner should not permit a party to repeat the same argument that the party had made in the previous trial procedure, alleging that there are errors in the court's findings and determination presented in the reasons for the judgment of revocation, which are bound by the judgment, or to submit new proof to support such argument. A second decision of the JPO trial examiner is legal to the extent that it was issued subject to the binding force of the judgment of revocation, and needless to say, that decision cannot be judged to be illegal in the second action for the revocation of the JPO decision.

Thus, as long as the JPO trial examiner is bound by the judgment of revocation, including the reasons for its main text, if, in an action for the revocation of the second JPO decision, any party concerned condemns the second JPO decision issued subject to such binding force as being illegal, this is nothing other than condemning the court's determination in the final and binding judgment of revocation itself as being illegal, and such condemnation cannot be the grounds for illegality (revocation) of the second JPO decision (the issue of whether or not the court's findings and determination presented in the reasons for the judgment of revocation, which are bound by the judgment, are not in themselves the subject of examination in the action for the revocation of the second JPO decision, and hence it is utterly meaningless for a party to, in the course of conducing proceedings, repeat the same argument that the party had made in the previous trial procedure, alleging that there are errors in the court's findings and determination presented in the reasons for the judgment, which are bound by the judgment, or to submit new proof to support such argument).

2. Considering, in concrete terms and based on the explanation given above, an action for the revocation of a JPO decision issued in response to a request for a trial for patent invalidation, the following is clear: when the court found errors in the JPO's findings and determination and rendered a judgment to revoke the JPO decision, on the grounds that a person ordinarily skilled in the art cannot be considered to have been able to easily make the invention, prior to the filing of the patent application, based on a specific cited document, and such judgment became final and binding, the second trial procedure would be bound by said judgment, and as a result, the JPO trial examiner must not be allowed to make findings or determination to the effect that a person ordinarily skilled in

the art would have been able to easily make the invention, prior to the filing of the patent application, based on the same cited document; and therefore, in an action for the revocation of the second JPO decision, a party should not be permitted to argue that there are errors in the JPO's findings and determination in its second decision issued subject to the binding force of the judgment of revocation (that is, argue that a person ordinarily skilled in the art would have been able to easily make the invention, prior to the filing of the patent application, based on the same cited document) and submit new proof to support such argument, and even when a party behaves in this manner, the court must not be allowed to admit such new proof to find illegality in the second JPO decision issued subject to the binding force of the judgment of revocation.

3. This reasoning can be applied in this case as follows. [1] The previous judgment found and determined that: the Invention and the invention described in the second cited document differ from each other in terms of the behavior of the mass due to the difference in the structure of the barrels and they also significantly differ from each other in terms of the function and effect due to the difference in the behavior of the mass, and therefore the polishing methods in these inventions cannot be deemed to be identical to each other; it is indisputable that it is not easy to replace the structure of the barrels used in the invention described in the second cited document with the structure of the barrels used in the Invention; and the polishing method in the invention described in the third cited document differs from that in the Invention. On these grounds, the court concluded that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on the second cited document or the third cited document, and revoked the previous JPO decision. [2] In the JPO Decision issued after the previous judgment became final and binding, the JPO, subject to the binding force of the previous judgment, determined that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on the second cited document or the third cited document.

In the second trial procedure, the JPO trial examiner, subject to the binding force of the judgment of revocation, must not be allowed to find facts that were not found in the previous judgment and make a different determination as to whether or not a person ordinarily skilled in the art would have been able to easily make the Invention, prior to the filing of the patent application, based on the same cited document for which the court made findings and determination in the previous judgment (the second cited document or the third cited document), and hence, the JPO Decision should be held to be legal to the extent that it was issued subject to the binding force of the judgment of revocation.

However, the court of prior instance admitted Exhibit Ko No. 12 and Exhibits Ko No. 14-1 to No. 14-3, which were submitted by the appellee in the prior instance, and held that based on these exhibits, no particular difference can be found between the Invention and the invention described in the second cited document in terms of the flow of the entire mass despite the difference in the

structure of barrels, nor can any particularly noticeable difference be found between them in terms of the function and effect, and further determined that a person ordinarily skilled in the art would have been able to easily conceive of the idea of replacing the shape of the barrels used in the invention described in the second cited document with the shape of the barrels used in the Invention, by reference to the first to third cited documents as well as the well-known, commonly used means.

As explained above, in an action for the revocation of the JPO Decision issued subject to the binding force of the previous judgment, a party should not be permitted to submit any allegation or proof to deny the court's findings and determination in the previous judgment to the effect that the invention described in the specific cited document (the second cited document) significantly differs from the Invention in terms of the behavior of the mass and the function and effect, and therefore that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on said cited document. However, the court of prior instance, in its judgment, allowed such unallowable allegation and proof and adopted them, and as a result, it made findings and determination to the effect that there is no particular difference between the Invention and the invention described in the second cited document in terms of the behavior of the mass or the function and effect, and that therefore a person ordinarily skilled in the art would have been able to easily make the Invention, prior to the filing of the patent application, based on the second cited document, which are different from the court's findings and determination in the previous judgment, which are bound by the previous judgment. Thus, it is clear that the judgment in prior instance is illegal due to errors in the interpretation and application of the laws and regulations concerning the binding force of a judgment of revocation. In its fact-finding and determination process, the court of prior instance examined the third cited document, as well as the first cited document and the well-known, commonly used means, which had not been examined in the previous judgment. However, (although the court of prior instance took these references into account when making findings and determination as to whether or not it is easy to replace the shape of the barrels used in the invention described in the second cited document with the shape of the barrels used in the Invention, after making findings and determination to the effect that there is no particular difference between the Invention and the invention described in the second cited document in terms of the behavior of the mass or the function and effect), the court of prior instance did not examine these references as matters that can serve as independent grounds for invalidation in the process of finding and determining whether or not a person ordinarily skilled in the art would have been able to easily make the Invention, prior to the filing of the patent application, nor as matters that do not merely corroborate the second cited document but can also serve as grounds for invalidation in combination with it. Rather, the court of prior instance made findings and determination as to whether the Invention involves an inventive step mainly in reference to the second cited document. Therefore, even where the first cited document and the well-known,

commonly used means were taken into account in making determination, the judgment in prior instance remains illegal as mentioned above, and such illegality apparently affects the conclusion of the judgment in prior instance. The appeal counsel's arguments are well-grounded in that they allege illegality on this point, and without needing to make determination on other reasons for final appeal, the judgment in prior instance should inevitably be quashed.

IV. The appellee seeks revocation of the JPO Decision, alleging illegality of the JPO's findings and determination to the effect that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on any of the first to third cited documents. As stated above, the JPO's findings and determination in the JPO Decision to the effect that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on the second cited document or the third cited document were made subject to the binding force of the previous judgment and therefore they are legal. Also as stated in the judgment in prior instance, the first cited document and the well-known, commonly used means cannot be regarded as matters that can serve as independent grounds for invalidation, nor as matters that do not merely corroborate the second cited document but can also serve as grounds for invalidation in combination with it. Hence, the JPO's findings and determination in the JPO Decision to the effect that a person ordinarily skilled in the art cannot be considered to have been able to easily make the Invention, prior to the filing of the patent application, based on the first cited document are also legal. According to the explanation given above, the JPO Decision that dismissed the appellee's request for a trial for patent invalidation is legal, and the appellee's claim for the revocation of said decision is obviously groundless, and therefore should be dismissed.

Therefore, according to Article 7 of the Administrative Case Litigation Act, and Articles 408, 96, 94, 89 and 93 of the Code of Civil Procedure, the judgment has been rendered in the form of the main text by the unanimous consent of the Justices. There is a concurring opinion by Justice SONOBE Itsuo.

The concurring opinion by Justice SONOBE Itsuo is as follows.

I am in agreement with the court opinion for the part concerning the determination on the appeal counsel's arguments, but I have a different view regarding the interpretation of Article 33, paragraph (1) of the Administrative Case Litigation Act, on which said determination is premised, and therefore I will give some comments on this point.

It is clear from the provisions of Article 178 and Article 181, paragraph (1) of the Patent Act that an action may be filed with the court to seek revocation of a JPO decision issued on what is generally referred to as an inter-partes invalidation trial. However, the relevant clauses of the Patent Act and the Administrative Case Litigation Act do not seem to provide clear and consistent operational rules that match the type of litigation of such action for revocation. An action against a JPO decision on an

inter-partes invalidation trial case may be filed by a party, intervener, etc. (Article 178, paragraph (2) of the Patent Act), against the demandant or the demandee of the trial, depending on the case (the proviso to Article 179 of said Act). Thus, an action for the revocation of a JPO decision on an inter-partes trial case differs from a typical action for the revocation of an administrative disposition (Article 3, paragraph (2) of the Administrative Case Litigation Act) in that it is a type of action in which the administrative agency (e.g. the JPO trial examiner, the JPO Commissioner) does not stand as defendant. It also differs in nature from what is generally referred to as a formal public law-related action (the first part of Article 4 of said Act) in that it is not related to an administrative disposition that confirms or creates a legal relationship between the plaintiff and the defendant. In this connection, there is a view that since an action for the revocation of a JPO decision on an inter-partes trial case is in substance an appeal against the exercise of public authority by the administrative agency (the JPO trial examiner or the JPO Commissioner), it is appropriate to apply the provisions of the Administrative Case Litigation Act concerning an action for the revocation of an administrative disposition (Chapter II, Section 1 of said Act) to said action. To the contrary, with regard to the legal basis for an action for the revocation of a JPO decision on an inter-partes trial case, I consider it desirable to apply mutatis mutandis the provisions of the Administrative Case Litigation Act concerning a public law-related action (Chapter III of said Act), or, from the legislative perspective, to introduce new provisions concerning a special type of public law-related action in the Patent Act, including explicitly stipulating the matter that is disputed in this case. However, from the perspective of legal interpretation, the same issue as the one disputed in this case arises even when the provisions concerning a public law-related action are applied mutatis mutandis (Article 41, paragraph (1) of the Administrative Case Litigation Act). Therefore, I will review this issue as a general issue arising from the relationship between the provisions concerning an action for the revocation of an administrative disposition, and an action for the revocation of a JPO decision on an inter-partes trial case.

With regard to how a final and binding judgment to revoke the initial JPO decision affects a decision to be issued by the JPO trial examiner in the second trial procedure, the rule in the conventional practice is that a judgment to revoke the initial JPO decision is binding on the JPO trial examiner in handling the same case, in accordance with the provisions of Article 33, paragraph (1) of the Administrative Case Litigation Act. In my view, the binding force of a judgment of revocation of an administrative disposition as provided in this clause is a special power given under said clause in order to secure the effectiveness of a judgment of revocation, making it obligatory not only for the administrative agency which is a party to the case but also any other relevant administrative agencies to respect the content of the judgment that found the disposition to be illegal, and to act in line with the essence of the judgment when handling the same case (see paragraph (2) of said Article). Meanwhile, in an action for the revocation of a JPO decision on an inter-partes trial case, there is no

such administrative agency which is a party to the case, nor can the JPO trial examiner be deemed to be such other relevant administrative agency as referred to in said clause, and therefore it should be construed that the provisions of Article 33 of said Act cannot be applied as they are. Nevertheless, in view of the fact that an action for the revocation of a JPO decision on an inter-partes trial case is treated as a special type of action for the revocation of an administrative disposition under the Patent Act, I consider that Article 33, paragraph (1) of the Administrative Case Litigation Act should be applied mutatis mutandis to an action for the revocation of a JPO decision on an inter-partes trial case, for the same purpose as applying Article 33, paragraph (1) of said Act mutatis mutandis to a public law-related action pursuant to Article 41 of said Act, and that the JPO trial examiner, who serves as the administrative agency which is in effect a party to the case, should issue a decision in line with the essence of the judgment on the previous action.

Thus far, I agree with the view adopted in the conventional practice and the court opinion in this judgment. However, taking a step further, I dissent from the court opinion to the effect that when an action is filed against the second JPO decision, the court, in the process of making examination and determination, should necessarily hold the second JPO decision to be legal to the extent that it was issued in line with the essence of the judgment on the action for the revocation of the initial JPO decision, and must not be allowed to hold it to be illegal. As explained above, Article 33 of the Administrative Case Litigation Act is interpreted as only stipulating, from the policy perspective of securing the effectiveness of a judgment of revocation of an administrative disposition, that the administrative agency associated with the administrative disposition in question should follow the essence of the judgment, but not stipulating that a judgment on an action for the revocation of the initial JPO decision is necessarily binding on the examination and determination by the court where an action for the revocation of the second JPO decision is pending.

For an ordinary type of action for the revocation of an administrative disposition, it may be exceptional that an action is filed against the second administrative disposition, bringing about the same issue as the one disputed in this case. However, an action for the revocation of a JPO decision has a unique nature in that a JPO decision is issued through the trial procedure for patent invalidation, which is different from the procedure of an ordinary type of disposition issued by an administrative agency. In light of this, as well as the summary of the judgment of the Grand Bench of the Supreme Court rendered on March 10, 1976 (Minshu Vol. 30, No. 2, at 79), one cannot deny the possibility that both parties may submit new allegations and proof in the second trial procedure and may further repeat the procedure depending on the case, resulting in the endless repetition of invalidation trials and actions for the revocation of JPO decisions. As an action for the revocation of a JPO decision has such nature, I consider that, from the viewpoint of attaching importance to the fact that said action is by nature more like a public law-related action, interpretation should be made while taking into account the meaning of Article 33, paragraph (1) of the Administrative Case Litigation Act in

relation to the court in charge of the subsequent action in the case where this clause is applied mutatis mutandis to a public law-related action. In other words, in light of the legal objective underlying said clause, i.e. giving due consideration to public interest or ensuring speedy and effective implementation of litigation proceedings, the court, in repeated actions following an action for the revocation of the initial JPO decision, should try to find the JPO's code of conduct, which may have been followed by the JPO when issuing its decisions, from the findings and determination presented by courts in the reasons for the previous final and binding judgments, and examine and determine the legality of the JPO decisions in connection with such code of conduct. This may be an appropriate approach of handling these actions in accord with the purport of the administrative case litigation system.

From the viewpoint explained above, I find the JPO's findings and determination in the JPO Decision to be legal, on the grounds indicated in III-3. in the court opinion.

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Presiding judge

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Justice KABE Tsuneo

Justice SAKAUE Toshio

Justice TEIKA Katsumi

Justice SONOBE Itsuo

Justice SATO Shoichiro

(This translation is provisional and subject to revision.)