==========

Date of the judgement

1999.03.09

==========

Case Number

1995(Gyo-Tsu)204

==========

Reporter

Minshu Vol. 53, No. 3, at 303

==========

Title

Judgment upon the necessity of revoking the relevant patent office decision on invalidation in the case where a patent office decision on amendment intended to reduce the scope of claims pertaining to the relevant patent became final pending court proceedings taken for revocation of the said patent office decision on invalidation under the Patent Law before revision in accordance with Law No. 26 of 1993

==========

Case name

Revocation of a patent office decision

==========

Result

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

==========

Court of the Second Instance

Tokyo High Court, Judgment of August 3, 1995

==========

Summary of the judgement

In the case where a patent office decision on amendment intended to reduce the scope of claims

pertaining to the relevant patent became final pending court proceedings taken for revocation of a patent office decision on invalidation under the Patent Law before revision in accordance with Law No. 26 of 1993, the said patent office decision on invalidation should be revoked.

==========

References

Article 123 of the Patent Law (before revision in accordance with Law No. 26 of 1993)

If a patent granted falls under any of the following cases, a determination to invalidate the said patent may be sought; in such a case, a request for a determination may be filed for each claim when it involves more than one claim:

1) where the patent was granted in contravention of the provisions set forth in Article 25, Article 29, Article 29-2, Article 32, Article 38, or Article 39, Paragraph 1 to Paragraph 4;

2) where the patent was granted in contravention of a treaty;

3) where the patent was granted upon an application filed for a patent which does not satisfy the requirements set forth in Article 36, Paragraph 4 or Paragraph 5 (excluding item 3), and Paragraph 6;

4) where the patent was granted upon an application filed by a person who is not the inventor and has not been assigned the right to the granting of a patent protecting the invention;

5) where, after the patent was granted, the patentee turns out to be a person who is not entitled to hold a patent according to the provisions of Article 25, or the patent comes into conflict with a treaty.

2. A determination under the preceding paragraph may be sought even after the patent right has been invalidated.

3. The examiner-in-chief shall, when a request for a determination under Paragraph 1 is filed, notify the exclusive licensee and others entitled to rights registered in connection with the patent to that effect.

Article 126 of the said law (before revision in accordance with Law No. 26 of 1993)

1. The patentee may file a request for a determination with regard to amendments to a specification or drawings attached to an application, provided the purpose of the requested amendment falls under any of the following cases:

(1) To reduce the scope of the claim(s)

(2) To correct errors in the description

(3) To explain descriptions that are found not to be clear

2. Amendments to a specification or drawings under the preceding paragraph cannot be intended to expand or change the scope of the claim(s) substantially.

3. In the case of Paragraph 1, Item 1, the invention comprising matters described in the amended scope of the claim(s) must be patentable independently as such at the time that the application is filed.
4. A determination under Paragraph 1 may be sought even after the invalidation of a patent right. However, it is not always the case once the relevant patent is ruled invalid in a determination under Article 123, Paragraph 1.

Article 178 of the said law (before revision in accordance with the Law No. 26 of 1993)
1. An appeal against a patent office decision or a determination on rejection pursuant to the provisions of Article 53, Paragraph 1 as applied mutatis mutandis in Article 159, Paragraph 1 (including the mutatis mutandis application thereof in Article 174, Paragraph 1), or against a decision rejecting a request for a determination or a retrial shall come under the exclusive jurisdiction of the Tokyo High Court.
2. An appeal under the preceding paragraph may be filed only by the party concerned, the participants or examiner(s) concerned, or those who applied for participation but whose application was turned down.
3. Any appeal under Paragraph 1 may not be filed after a lapse of thirty days from the date of the service of a certified copy of a patent office decision or a decision.
4. The period of time under the preceding paragraph shall be regarded as invariable.
5. The examiner-in-chief may set forth ex officio an additional period of time with regard to the invariable period of time stipulated in the preceding paragraph for the benefit of those who are located in remote places or areas that are inconveniently situated with regard to transportation facilities.
6. Regarding matters on which a court hearing can be sought, an appeal against decisions other than patent office decisions may not be filed.

==========

Main text of the judgement

The original judgment is hereby quashed.
The decision rendered by the Patent Office on July 25, 1991 upon determination Case No. 11222 of 1986 is hereby revoked.
The total litigation costs incurred shall be borne by the Appellee.

==========

Reasons

Regarding point 2 in the Statement of Reasons for the Jokoku -Appeal presented by Attorney

SAKAI Naomi, Attorney SAKAI Kei:

I. The facts established by law by the court of Original Instance are outlined as follows:
1. The Appellant is a patentee entitled to Patent No. 1293128 for an invention named "a process for manufacturing large-diameter square steel pipes" (hereinafter referred to as "the said invention"). The Appellee filed a request for a determination to invalidate a patent pertaining to the said invention (hereinafter referred to as "the said patent") at the Patent Office on May 26, 1986, and through examination of the case received and marked Determination Case No. 11222 of 1986, a determination holding the said patent invalid (hereinafter referred to as "the said determination on invalidation") was reached on July 25, 1991. The Appellant filed the law suit in question to seek the revocation of the said determination on invalidation on September 24 of the same year. The Appellant filed a request for a determination with regard to amendment to descriptions of the scope of the claims in a specification attached to an application filed pertaining to the said invention (hereinafter referred to as "the said specification") and so forth on December 17 of the same year, and through examination of the case received and marked Determination Case No. 24195 of 1991, a decision to make the said amendment thereto was reached and became final on October 28, 1993 earlier than the completion of oral arguments in the said law suit before the court of original instance (hereinafter referred to as the "said decision on amendment").
2. The scope of claims described in the said specification is as follows: "as a process for manufacturing large-diameter square steel pipes, the process for manufacturing large-diameter square steel pipes characteristic of conveying a single steel sheet in a lengthwise direction to machine open edges on both sides at first, bending the portions corresponding to the four corners of a square steel pipe one by one, forming in a shape similar to a square steel pipe with an aperture between the open edges of minimum dimensions capable of die-casting, then, with the use of a multi-cylinder forming roll, forming into the shape of a square steel pipe, which is in turn conveyed and temporarily welded, and then welding the interior and exterior surfaces of the open edges by way of mechanical welding, then passed through a distortion-removing roll to achieve a distortion-free finish."
3. The said decision on invalidation is reached on the grounds that it is easy for the said manufacturer to arrive at the said invention by deriving from the prior art cited in the said decision on invalidation.
4. Pursuant to the said decision on amendment, the scope of claims described in the said specification was amended to: "as a process for manufacturing large-diameter square steel pipes, the process for manufacturing large-diameter square steel pipes characteristic of conveying a single steel plate in a lengthwise direction to machine open edges on both sides at first, bending

the portions corresponding to the four corners of a square steel pipe one by one, forming in a shape similar to a square steel pipe with an aperture between the open edges of minimum dimensions capable of die-casting, then passing the above-mentioned nearly square steel pipe through a multi-cylinder forming roll to form into the shape of a square steel pipe and conveying and temporarily welding the abutting sides of the open edges in turn, next, welding the interior and exterior surfaces of the open edges by way of mechanical welding, then passing through a distortion-removing roll to achieve a distortion-free finish."

II. In this case, the Appellant seeks the revocation of the said decision on invalidation, while the court of original instance arrived at the following determination in the context of the above-mentioned facts and dismissed the appeal made by the Appellant:

1. With the said decision on amendment becoming final, the descriptions in the said specification were amended, and it is taken as such that filing an application, examination for granting a patent and the like were conducted based on the said amended specification, retroactive to the time of filing of the application; this leads to the ruling that the said decision on invalidation which determined the content of the said invention based on the said specification before amended erred in its determination.

2. In an appeal against a decision (hereinafter referred to as "proceedings for revocation of a patent office decision"), for the decision at issue to be held illegal, it must be determined that an error in determination in the process of the examination affects the conclusion arrived at in the examination, and even though pending lawsuit taken for revocation of a decision to the effect of invalidating a patent (hereinafter referred to as "a decision on invalidation") a decision to the effect of amending descriptions in a specification pertaining to the relevant patent (hereinafter referred to as "a decision on amendment") becomes final, if a comparison of the invention based on the said amended specification with prior art cited in such a decision on invalidation leads to the same conclusion as arrived at in such decision on invalidation for reasons to the same effect, such error in determination by such patent office decision on invalidation does not affect the conclusion reached therein, and we have no reason to hold illegal and revoke such decision on invalidation.

3. The said decision on invalidation should not be revoked, because it is easy for the said manufacturer to derive the composition of the invention based on the said amended specification from the prior art cited in the said decision on invalidation and for this reason, the said invention is held to be not patentable, whereas an error in determining the content of the invention in the patent office decision on invalidation does not affect the conclusion of the said decision on invalidation.

III. However, point 2 and point 3 in the said determination at the court of original instance cannot be affirmed on the following ground:

1. According to the precedent relied on by this Court (Judgment of the Grand Bench upon Case 1967 (Gyo-Tsu) No. 28 rendered on March 10, 1976, Minshu Vol. 30, No. 2, at 79), in lawsuit taken for revocation of a decision, causes for invalidation in comparison with the known facts which were not examined for determination in the course of the examination cannot be cited as reasons for holding the decision in question illegal, or otherwise, proper by law. Once the scope of claims described in a specification have been reduced pursuant to a decision on amendment, now new requirements are imposed on the scope of claims as reduced, in usual cases, without referring to not only known facts compared with the invention based on a specification before amended, but also other facts for comparison, it is not possible to determine whether the said invention is patentable or not. Based on the interpretation that such examination for determination cannot be conducted primarily by the competent court to which lawsuit taken for revocation of a decision belong without following the procedures for an examination at the Patent Office, we maintain that whether or not the relevant invention based on the specification as amended is patentable should be re-examined for determination according to the procedures for an examination at the Patent Office after the patent office decision on invalidation reached with regard to the relevant patent right is revoked.

As the case may be, however, the invention based on the specification as amended should be held invalid because of the same known facts as those compared in the decision on invalidation, grounded in the original judgment in this Case; for a decision on amendment to be justified in this Case, it requires that pursuant to Article 126, Paragraph 3 of the Patent Law before revision in accordance with Law No. 26 of 1993 (hereinafter referred to as "the old law") the invention comprising matters described in the scope of claims as amended must be patentable independently as such at the time the application is filed, and if the invention based on the specification as amended is to be held invalid because of the same known facts as those compared in the patent office decision on invalidation, it follows that the decision on amendment is against the said requirement, and in such a case, the old law can be construed to intend that such amendment is to be invalidated upon pronouncement of a decision on invalidation of such amendment (Article 129) while maintaining the validity of the decision on invalidation already reached with regard to the relevant patent right (under the current law, Article 123, Paragraph 1, Item 8 provides that a decision on amendment reached in contravention of Article 126, Paragraph 4 is regarded as the justifiable cause for invalidating the relevant patent, and in such case, it is intended that for this reason, the decision on amendment at issue is to be invalidated upon pronouncement of a new decision on invalidation of the

relevant patent).

2. Hence, we hold it appropriate to construe that when a decision on amendment intended to reduce the scope of claims pertaining to the relevant patent becomes final, pending lawsuit taken for revocation of the decision on invalidation, the said decision on invalidation should be revoked.

In considering this case in this context, the portion amended from "a single steel sheet" to "a single steel plate" in the aforementioned amendment of the scope of claims described in the said specification is regarded as a reduction in the scope of claims; therefore, the said decision on invalidation should be revoked.

IV. On the grounds mentioned above, we sustain that the original judgment dismissing this appeal in its opinion different hereinfrom is illegal, giving a misinterpretation of laws and ordinances, and such illegality obviously affects the conclusion of the original judgment. We find that the argument presented by the Appellant is well-grounded, while the original judgment should be quashed without making a judiciary determination of the rest of the reasons for the Jokoku-appeal. According to the facts established by law under the court of original instance, the appeal seeking the revocation of the decision in this case should be affirmed.

Therefore, the judiciary opinion is unanimously formed and the judgment rendered as the main text.

==========

Presiding judge

Justice MOTOHARA Toshifumi

Justice SONOBE Itsuo

Justice CHIKUSA Hideo

Justice OZAKI Yukinobu

Justice KANATANI Toshihiro

(This translation is provisional and subject to revision.)