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judgedate

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2000.01.27

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caseid

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1995 (Gyo-Tsu) 105

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reporter

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Minshu Vol. 54, No. 1

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casetitle

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Judgment concerning what would become of a request for an invalidation trial (Request A) in the case where a final and binding decision rendered by the Japan Patent Office (JPO) to dismiss the claim in another request for an invalidation trial (Request B) filed with regard to the same patent on the basis of the same facts and evidence is registered after the filing of Request A

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casename

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Case to seek revocation of a trial decision

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caseresult

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Judgment of the First Petty Bench, dismissed

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court\_second

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Tokyo High Court, Judgment of February 8, 1995

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summary\_judge

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A request for an invalidation trial (Request A) would not become unlawful even if a final

and binding decision rendered by the Japan Patent Office (JPO) to dismiss the claim in another request for an invalidation trial (Request B) filed with regard to the same patent on the basis of the same facts and evidence is registered after the filing of Request A.

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references

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Article 167 of the Patent Act

Patent Act

Article 167

When a final and binding trial decision in a trial referred to in Article 123, paragraph (1) or Article 125-2, paragraph (1) has been registered, no one may file a request for a trial on the basis of the same facts and evidence.

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maintext

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The final appeal is dismissed.

The appellant of final appeal shall bear the cost of the final appeal.

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reason

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Concerning Reason I for final appeal argued by the appeal counsel

I. The circumstances that led up to this action are as follows.

The appellees of final appeal and Company D, which is not a party to the case, respectively filed requests for trials for invalidation of a patent granted for an invention titled "lead chromate pigment and manufacturing method thereof" based on which the appellant of final appeal held a patent right (Patent No. 952065), and during the trial proceedings jointly conducted, they alleged the same facts and produced the same evidence. Since the Japan Patent Office (JPO) rendered a decision to dismiss the claims in both requests for trials, the appellees filed this action to seek revocation of the JPO decision, whereas Company D did not file an action to seek revocation of the JPO decision, and as a result, the JPO decision became final and binding in relation to Company D.

II. Article 167 of the Patent Act provides that when a final and binding trial decision rendered by the JPO in response to a request for a trial for invalidation of a patent

(hereinafter referred to as a "request for an invalidation trial") has been registered, no one may file a request for an invalidation trial on the basis of the same facts and evidence. What is meant by this provision is that if a JPO decision to dismiss the claim in a request for an invalidation trial filed with regard to a particular patent (hereinafter referred to as a "decision of dismissal") has become final and binding and such decision has been registered, no one is allowed to file another request for an invalidation trial, after said registration, on the basis of the same facts and evidence. Said provision should not be interpreted as having meaning beyond that, that is, meaning that if a final and binding decision of dismissal is registered, any request for an invalidation trial already pending before the JPO at the time of the registration would become unlawful. Consequently, it is appropriate to construe that a request for an invalidation trial (Request A) would not become unlawful even if a final and binding decision rendered by the JPO to dismiss the claim in another request for an invalidation trial (Request B) filed on the basis of the same facts and evidence as those cited in Request A is registered after the filing of Request A. The grounds for this view are as follows.

The law does not prohibit more than one person from filing a request for an invalidation trial with regard to the same patent. Any person who has interest in invalidating a patent may at any time file a request for an invalidation trial regarding the patent, and such interest in invalidating a patent is an inalienable interest vested in each person who files an invalidation trial. However, in the case where a decision of dismissal rendered by the JPO in response to a request for an invalidation trial regarding a particular patent has become final and binding and such decision has been registered, if another request for an invalidation trial is allowed to be filed repeatedly on the basis of the same facts and evidence as those cited in the previous request, this would undermine the stability of the patent right and would go against the purpose of the Patent Act, i.e. protection and use of inventions. From this viewpoint, Article 167 of the Patent Act aims to ensure balance between the inalienable interest of a person who files a request for an invalidation trial and the interest residing in the stability of the patent right, and restricts the right of an interested person to file a request for an invalidation trial only on the conditions prescribed in said Article. Therefore, the provision of said Article should not be interpreted by broadening the scope of cases where it applies, but it is appropriate to interpret its text literally.

If the provision of said Article is interpreted as meaning that if a final and binding decision of dismissal is registered, any request for an invalidation trial filed on the basis of the same effects and evidence that is already pending before the JPO at the time of the registration would become unlawful, such interpretation would lead to the

consequence that when more than one request for an invalidation trial is pending before the JPO, and if any of the persons who filed the requests does not appeal against a decision to dismiss his/her request, the procedures conducted so far by the other persons who filed the requests for their own interests would become meaningless and these persons would no longer be able to enjoy the interests. This is unreasonable.

According to this view, when more than one request for an invalidation trial has been filed simultaneously with regard to the same patent on the basis of the same facts and evidence, there could be a case where the JPO renders a decision of dismissal in one of the trial cases while rendering a decision to invalidate the patent (hereinafter referred to as a "decision of invalidation") in another trial case, and both decisions become final and binding. However, when the decision of invalidation becomes final and binding, the patent right is deemed to have never existed (Article 125 of the Patent Act). Therefore, even if the decision of dismissal has already become final and binding separately from the decision of invalidation, the patent would lose its effect, and there would be no confusion in the legal status caused by the inconsistency or conflict between the JPO decisions. The same applies in the case where the JPO renders a decision of dismissal and decision of invalidation in response to requests for invalidation trials on the basis of different facts or evidence and both decisions become final and binding. The same also applies in the case where the JPO renders decisions of dismissal in response to all of the requests for invalidation trials filed with regard to the same patent on the basis of the same facts and evidence, and the JPO decisions become final and binding in relation to some of the persons who filed the requests, whereas other persons file actions for revocation of the relevant JPO decisions and receive court judgments upholding their claims and decisions of invalidation by the JPO.

The precedent of the Former Supreme Court (1919 (O) No. 811, judgment of the Former Supreme Court of March 19, 1920, Minroku No. 26, at 371) that is contrary to this view should be modified.

III. In the present case, when the appellees filed requests for invalidation trials, the final and binding decision rendered by the JPO in response to Company D's request for an invalidation trial filed on the basis of the same facts and evidence cited in the appellees' requests had not yet been registered. We can affirm the conclusion of the court of prior instance that determined the appellees' requests for invalidation trials to be lawful. The appeal counsel's arguments cannot be accepted.

Concerning other reasons for final appeal argued by the appeal counsel and the reasons for final appeal argued by the appeal counsel

The findings and determination by the court of prior instance with regard to the points

argued by the appeal counsel can be affirmed as justifiable for the conclusion in light of the evidence cited in the judgment in prior instance. The appeal counsel's arguments attack the admission of evidence or finding of fact, which comes under the exclusive jurisdiction of the court of prior instance, and criticize the judgment in prior instance based on their own dogmatic view or allege illegality in the judgment in prior instance based on matters that do not affect the conclusion of the judgment. None of their arguments can be accepted.

Therefore, the judgment has been rendered in the form of the main text by the unanimous consent of the Justices.

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presiding

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Justice FUJII Masao

Justice ONO Motoo

Justice ENDO Mitsuo

Justice IJIMA Kazutomo

Justice ODE Takao

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note\_other

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(This translation is provisional and subject to revision.)