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Date of the judgement

2002.03.25

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Case Number

2001(Gyo-Hi)154

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Reporter

Minshu Vol.56, No.3, at 574

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Title

Judgment upon the case concerning permissibility of one of the joint holders of a patent to initiate an action on his own to have a decision of the Patent Office which annulled the patent to be revoked

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Case name

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claim for the revocation of the decision of the patent office to annul a patent

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Result

Judgment of the Second Petty Bench, quashed and remanded by the Supreme Court

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Court of the Second Instance

Tokyo High Court, Judgment of March 12, 2001

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Summary of the judgement

A joint holder of a patent is entitled on his own to initiate an action to have a decision of the Patent Office revoked, if a decision was made to annul the patent on the basis of a patent objection.

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References

Article 252 of the Civil Code, Article 40 of the Code of Civil Procedure, Article 73, 113, 114, 132, 178 of the Patent Law

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Main text of the judgement

The judgment of the original instance court shall be quashed and the case shall be remanded to the Tokyo High Court

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Reasons

On the grounds of the application for certiorari of representatives of the jokoku appellant, SK, YK, and YN:

1.The outline of the facts lawfully established by the original instance court is as follows:
The jokoku appellant and C Communication Equipment Co. (hereinafter, 'the Company') are joint holders of a patent on an invention called 'pachinko equipment' (patent registration February 19, 1999, Patent No.2888528. Hereinafter, 'the Patent').
A and B filed an objection to the patent on November 5 and 10, 1999 respectively.
The Patent Office, on the above objection, rendered a decision to revoke the Patent concerning item 1 of the patent claim on October 25, 2000.

2. In the present action, although the jokoku appellant is entitled on his own to seek revocation of the above decision, the original instance court dismissed the claim on the following grounds.
An action for the revocation of the decision to revoke a patent which is held jointly, based upon a patent objection (hereinafter, 'the Decision of Revocation') has to be decided uniformly since it is aimed at determining the right of the joint holders of the same right, and therefore, this action should be regarded as an inherently mandatory joint action. The Patent Law provides that it will become impossible for the patent as a whole to be acquired or to subsist, if one of the joint holders of the right to apply for patent registration or the patent itself loses the interest in acquiring or holding the right (Art.132, para.3 of the Patent Law). Therefore, it is not unreasonable to acknowledge the same regarding an action for revocation of the Decision of Revocation.
It is assumed that a copy of the decision has been sent to the Company at the same time as a

copy was sent to the jokoku appellant, but the Company did not initiate an action, and the period for taking an action had expired. Therefore, the present action which has been initiated by the jokoku appellant alone is not lawful.

3. However, the above ruling of the original instance court is not justifiable. The reasons are as follows:

In cases where the right to apply for patent registration is jointly held, each holder is required to apply jointly with the others for patent registration (Article 38 of the Patent Law), and when they initiate a proceeding in relation to the right to apply for patent registration, they are required to do it jointly (Art.132, para.3 of the Patent Law). This is intended to require the conformity of the will of all joint rightholders for the patent on the same right jointly held by them. In contrast, once the patent has been registered, a joint holder of the patent may use the patent without the consent of other joint rightholders, although such consent is required for the assignment of the share in the patent or the creation of an exclusive right to use the patent etc. (Article 73 of the Patent Law).

If a decision was made to revoke the patent which had been registered, once the period for an action has expired without an action having been made against this decision, the patent is deemed not to have existed from the beginning, and the right to work the registered patent is extinguished retrospectively (Art.114, para.3 of the Patent Law). Therefore, it is appropriate to understand that if a decision was made to revoke a registered patent which was jointly held, each joint patent holder is entitled to initiate an action to revoke the Decision for Revocation of the patent on his own as an act of preservation to prevent the extinction of the patent (Supreme Court, 2001 (Gyo-hi) No.142, Judgment of the Supreme Court, the Second Petty Bench, February 22, 2002, Saibansho-jiho, 1310-5). 'When a joint holder of the patent initiates a proceeding in relation to the jointly held patent' as provided in Article 132, para.3 of the Patent Law presupposes the adjudication on the complaint against the refusal to register the extension of the period of subsistence of the patent (Article 67-3, para.1, Article 121 of the Patent Law) or the adjudication for correction (Article 126, ibid.), and should not be understood to mean that if a patent is jointly held, in general, all joint holders of the patent should always act jointly.

Even if one of the joint holders of the patent is allowed to initiate an action to revoke the Decision of Revocation, this is not against the requirement of uniform determination of the rights. If all joint holders of the patent jointly initiate an action, or separately initiate an action to revoke the decision, these actions are quasi-mandatory joint actions and thus will be consolidated, and the requirement of uniform determination will be met.

4. Thus, there is an evident breach of law which affects the judgment in the judgment of the original instance court which found the present action to be unlawful. Incidentally, judgments

such as the Supreme Court 1960 (o) No.684, judgment of the Supreme Court, the First Petty Bench, August 31, 1961, Minshu 15-7-2040, Supreme Court, 1977 (Gyo-tsu) No.28, judgment of the Supreme Court, the Second Petty Bench, January 18, 1980, Saibanshu, civil cases, 129-43, and the Supreme Court, 1994 (Gyo-tsu) No.83, Judgment of the Supreme Court, the Third Petty Bench, March 7, 1995, Minshu 49-3-944 are different from the present case and are not appropriate to be cited. Therefore, the judgment of the original instance court shall be quashed, and in order to have the case considered on its merits, the case shall be remanded to the original instance court.

Thus, the justices unanimously rule as the main text of judgment.

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Presiding judge

Justice KAJITANI Gen

Justice KAWAI Shinichi

Justice FUKUDA Hiroshi

Justice KITAGAWA Hiroharu

Justice KAMEYAMA Tsugio

(*Translated by Sir Ernest Satow Chair of Japanese Law, University of London)