

Patent Right	Date	April 24, 2025	Court	Intellectual Property High Court, Fourth Division
	Case number	2024 (Ne) 10029		
<div>- A case in which the court determined that the plaintiff's claims for declaratory judgments on the rights to be granted patents based on PCT applications lacks the interest in seeking immediate determination.</div> <div>- A case in which the court denied that an invention is an employee invention made by a former employee and dismissed the claim for a declaratory judgment on the right to be granted patents.</div>				

Case type: Claims for declaratory judgments on the right to be granted patents

Conclusion: Partial reversal of the prior instance judgment

References: Article 2, paragraph (1) and Article 35 of the Patent Act

Related rights, etc.: PCT/JP2021/024976, Patent Application No. 2021-010922, PCT/JP2021/025702, and PCT/JP2020/021738

Court of prior instance: Tokyo District Court, 2022 (Wa) 70139 [Case 1]; Tokyo District Court, 2023 (Wa) 70009 [Case 2]

Summary of the Judgment

1. The First-instance Plaintiff argued that Inventions 1-1 through 1-3 are employee inventions that were made by First-instance Defendant Y1 while First-instance Defendant Y1 was employed by the First-instance Plaintiff as the representative director and president, and that Invention 2 is an employee invention made by First-instance Defendant Y3 while the First-instance Defendant Y3 was employed by the First-instance Plaintiff. The First-instance Plaintiff sought [i] in relation to First-instance Defendant Y1, who filed an international application based on the Patent Cooperation Treaty ("PCT application") for Invention 1-1, the court's declaratory judgment that the First-instance Plaintiff has the right to be granted patents for the invention; [ii] in relation to First-instance Defendant Y2, who filed a patent application in Japan for Invention 1-2 and filed a PCT application for Invention 1-3, the court's declaratory judgment that the First-instance Plaintiff has the right to be granted patents for said inventions; and [iii] in relation to Y3, who filed a PCT application for Invention 2, for the court's declaratory judgment that the First-instance Plaintiff has the right to be granted patents for said invention. The claims concerning the inventions related to PCT applications are to seek declaratory judgments that the First-instance Plaintiff has the right to be granted patents in states designated by the PCT applications (all contracting

states of the Patent Cooperation Treaty). Concerning Inventions 1-1, 1-3, and 2, transfer procedures in Japan were not conducted in the designated state and all of them were deemed to be withdrawn.

The court of prior instance determined that any lawsuit related to claims concerning inventions for which PCT applications were filed (Claims 1-1, 1-3, and 2) has no interest in seeking declaratory judgments and the court of prior instance dismissed them and upheld the claim related to Invention 1-2 for which a patent application was filed in Japan (Claim 1-2).

Dissatisfied with the respective parts against the First-instance Plaintiff and First-instance Defendant Y2 in the judgment in prior instance, they filed appeals respectively. Subsequently, the First-instance Plaintiff made additional changes to the claims to seek declaratory judgments that the First-instance Plaintiff has the right to be granted European patents for Inventions 1-1, 1-3, and 2 as an alternative claim.

The court upheld the conclusion of the judgment in prior instance concerning the appeals related to Claims 1-1, 1-3, and 2; however, concerning Claim 1-2, rescinded the judgment in prior instance and dismissed the claim of the First-instance Plaintiff.

2. Claim for seeking declaratory judgments on the rights to be granted patents related to PCT applications

The First-instance Plaintiff stated that, after obtaining declaratory judgments on the rights to be granted patents in this lawsuit, the First-instance Plaintiff would select the states and regions where the First-instance Plaintiff actually desired to obtain patents from among the contracting states of the Patent Cooperation Treaty. However, in light of the territoriality principle, it is construed that how the right to be granted patents is treated in foreign states and what effect it has are determined by the laws of the state where the patents are registered based on the right to be granted said patents. Concerning the invention, even at this moment where no new application has been filed in any state for said invention, transfer procedures have not been conducted in Japan, and no specific plan of the procedures thereof has been clarified, it cannot be found that the dispute has matured to the extent of rendering declaratory judgments that the First-instance Plaintiff has the right to be granted patents for said inventions.

The alternative claims that the First-instance Plaintiff added (claims for declaratory judgments that the First-instance Plaintiff has the rights to be granted European patents for inventions related to the PCT applications) in this instance significantly delay judicial proceedings, and therefore, are not allowed.

3. Characteristics as an employee invention for Invention 1-3 (Invention 1-2 for which the content is the same as Invention 1-3)

In order for a person to be regarded as an investor, the person needs to be actually involved in the act of creation of the technical ideas in the invention, in particular, to be actually involved in completing the characteristic part of the invention related to the means of solving a conventional technical problem.

The characteristic part of Invention 1-3 is the following: concerning a vascular plug comprised of a pusher wire and a mesh-shaped unit embolizing an aneurysm in a blood vessel to prevent rupture of the aneurysm, there was the problem that multiple vascular plugs in different sizes must be prepared and there was a risk of damaging the aneurysm by sudden expansion of the mesh-shaped unit; therefore, a configuration where the tip of a stent is pushed out from the tip of a catheter and expands while curling outwards when it is not stored is adopted; this configuration is highly flexible to adjust to the size of the aneurysm and it does not damage the aneurysm in the bifurcation area.

First-instance Defendant Y1 graduated from a department of humanities at a university, worked for a financial institution, and then founded the First-instance Plaintiff Company jointly with First-instance Defendant Y1's elder brother who is a doctor of science; however, First-instance Defendant Y1 has no clinical knowledge. On the other hand, Professor A, who was a collaborator, has broad clinical experience and Professor A's study note has a clear statement on the problem of Invention 1-3 and a means of solving it. Therefore, it is reasonable to find that it is Professor A who was actually involved in the completion of the characteristic part of Invention 1-3.

Judgment rendered on April 24, 2025

2024 (Ne) 10029 Appeal case of seeking declaratory judgments on the rights to be granted patents

(Court of prior instance: Tokyo District Court, 2022 (Wa) 70139 [Case 1]; Tokyo District Court, 2023 (Wa) 70009 [Case 2])

Date of conclusion of oral argument: March 18, 2025

Judgment

Appellant and Appellee (the Plaintiff in Case 1 and Case 2)

Biomedical Solutions Inc. (hereinafter referred to as the "First-instance Plaintiff")

Appellee (the Defendant in Case 1)

Y1 (hereinafter referred to as "First-instance Defendant Y1")

Appellee and Appellant (the Defendant in Case 1)

Kabushiki Kaisha SG-1 Medical (hereinafter referred to as "First-instance Defendant Company"; First-instance Defendant Y1 and the First-instance Defendant Company are collectively referred to as the "First-instance Defendants")

Appellee (the Defendant in Case 2)

Y2 (hereinafter referred to as "First-instance Defendant Y2")

Main text

1. The appeal by the First-instance Plaintiff shall be dismissed.
2. Based on the appeal by the First-instance Defendant Company, Paragraph 1 in the main text of the judgment in prior instance shall be rescinded.
3. Concerning the part related to the rescission in the preceding paragraph, the claims of the First-instance Plaintiff shall be dismissed.
4. The court costs for both the first and second instance between the First-instance Plaintiff and the First-instance Defendant Company shall be borne by the First-instance Plaintiff. The court costs for the appeal between the First-instance Plaintiff and First-instance Defendant Y1 and First-instance Defendant Y2 shall be borne by the First-instance Plaintiff.

Facts and reasons

(Abbreviations are subject to those used in the judgment in prior instance unless otherwise newly specified in this judgment.)

No. 1 Judgment sought by the parties

1. Object of the appeal of the First-instance Plaintiff

(1) The part of the judgment in prior instance which is against the First-instance Plaintiff shall be rescinded.

(2) (Principal claims)

A. A declaratory judgment that the First-instance Plaintiff has the right to be granted patents for Invention 1-1 between the First-instance Plaintiff and First-instance Defendant Y1 (Claim 1-1)

B. A declaratory judgment that the First-instance Plaintiff has the right to be granted patents for Invention 1-3 between the First-instance Plaintiff and the First-instance Defendant Company (Claim 1-3)

C. A declaratory judgment that the First-instance Plaintiff has the right to be granted the patent for Invention 2 between the First-instance Plaintiff and First-instance Defendant Y2 (Claim 2)

(3) (Alternative claims that are added in this instance. As stated below, any change to the claim is not allowed.)

A. A declaratory judgment that the First-instance Plaintiff has the right to be granted European patents for Invention 1-1 between the First-instance Plaintiff and First-instance Defendant Y1 (Claim 1' -1)

B. A declaratory judgment that the First-instance Plaintiff has the right to be granted European patents for Invention 1-3 between the First-instance Plaintiff and the First-instance Defendant Company (Claim 1' -3)

C. A declaratory judgment that the First-instance Plaintiff has the right to be granted European patents for Invention 2 between the First-instance Plaintiff and First-instance Defendant Y2 (Claim 2')

2. Object of the appeal of the First-instance Defendant Company

Same as Paragraphs 1 and 2 of the main text.

No. 2 Outline of the case

1. Summary of the case

First-instance Defendant Y1 is a person who was in the position of representative director of the First-instance Plaintiff from May 1, 2013 to September 15, 2021 and was in the position of director of the First-instance Plaintiff from September 16, 2021 to March 3, 2022. First-instance Defendant Y2 is a person who was an employee of the First-instance Plaintiff.

In this case, the First-instance Plaintiff alleged that the inventions stated in 1-1 through 1-3 in the Attachment "List of Inventions" attached to the judgment in prior instance ("Inventions 1") are employee inventions made by First-instance Defendant Y1 and the invention stated in 2 in said Attachment ("Invention 2") is an employee

invention made by First-instance Defendant Y2 while they were working at the First-instance Plaintiff. Based on this allegation, the First-instance Plaintiff requested, in relation to First-instance Defendant Y1, who filed an international application based on the Patent Cooperation Treaty (hereinafter referred to as "PCT application") for Invention 1-1, the court's declaratory judgment that the First-instance Plaintiff has the right to be granted patents for these inventions. The First-instance Plaintiff also requested, in relation to the First-instance Defendant Company, which acquired the right to be granted patents for Invention 1-2 from First-instance Defendant Y1 and filed a patent application in Japan, and also filed a PCT application for Invention 1-3, the court's declaratory judgment that the First-instance Plaintiff has the right to be granted patents for these inventions. In addition, the First-instance Plaintiff also requested, in relation to First-instance Defendant Y2, who filed a PCT application for Invention 2, for the court's declaratory judgment that the First-instance Plaintiff has the right to be granted a patent for said invention. The claims concerning the inventions related to PCT applications are to seek a declaratory judgment that the First-instance Plaintiff has the right to be granted patents in states designated by the PCT applications (all contracting states of the Patent Cooperation Treaty).

The court of prior instance determined that any lawsuit related to claims concerning inventions for which PCT applications were filed (Claims 1-1, 1-3, and 2) has no interest in seeking declaratory judgments and the court of prior instance dismissed them and upheld the claim related to Invention 1-2 for which a patent application was filed in Japan (Claim 1-2).

Dissatisfied with the respective parts against the First-instance Plaintiff and the First-instance Defendant Company, they filed appeals respectively. Subsequently, the First-instance Plaintiff made additional changes to the claims to seek declaratory judgments that the First-instance Plaintiff has the right to be granted European patents for Inventions 1-1, 1-3, and 2 as alternative claims.

2. Basic facts

The basic facts (facts that are not disputed by the parties or that can be easily found based on listed evidence or the entire import of oral arguments) are as stated in No. 2, 2. (1) through (4) in "Facts and reasons" section in the judgment in prior instance (page 3 through page 6) and the provisions of the relevant treaties are as stated in No. 2, 3. in "Facts and reasons" section in the judgment in prior instance (page 7 and after). Therefore, they are cited herein.

3. Issues

(1) Existence of the interest in filing a legal action (common to Claims 1-1, 1-3, 2, 1'-

1, 1'-3, and 2'; Issue 1)

(2) Characteristics as an employee invention for Invention 1-1 (Issue 2)

(3) Characteristics as an employee invention for Invention 1-2 and Invention 1-3 (Issue 3)

Concerning Invention 1-3, a PCT application was filed with the patent application in Japan for Invention 1-2 as the base application for a priority claim. Although Inventions 1-2 and 1-3 are different in their content to the extent of the Correction, concerning the characteristics as an employee invention for Invention 1-2, both parties agreed to follow the determination on the characteristics as an employee invention for Invention 1-3. Invention 1-3 consists of multiple claims. Both parties agreed to determine the characteristics as an employee invention for Invention 1-3 as a whole based only on Patent Claim 1. For this reason, the details of the issues on characteristics as an employee invention for Invention 1-2 are the same as those related to Patent Claim 1 of Invention 1-3.

(4) Concerning the right to be granted patents related to Inventions 1, whether the First-instance Plaintiff implemented the procedures for succession and acquisition (Issue 4; additional argument by the First-instance Defendants in this instance)

(5) Concerning the right of the First-instance Plaintiff to be granted patents related to Inventions 1-2 and 1-3, whether the defense of a lack of perfection or loss of right are established (Issue 5; additional argument by the First-instance Defendant Company in this instance)

No. 4 Judgment of this court

1. Issue 1 (Existence of the interest in filing a legal action)

(1) Principal claim for PCT applications (Claims 1-1, 1-3, and 2)

As stated in No. 3, 1. (Supplementary argument of the First-instance Plaintiff), (3), (5) A. above, the First-instance Plaintiff seeks a declaratory judgment that the First-instance Plaintiff has the right to be granted patents in all contracting states of the Patent Cooperation Treaty concerning Inventions 1-1, 1-3, and 2.

The First-instance Plaintiff stated that, after obtaining declaratory judgments on the rights to be granted patents in this lawsuit, the First-instance Plaintiff would select the states and regions where the First-instance Plaintiff actually desires to obtain patents from among the contracting states of the Patent Cooperation Treaty, which totaled 158 states at the end of the oral arguments in this instance (the First-instance Plaintiff argued that there were 157 contracting states; however, the Oriental Republic of Uruguay joined the Patent Cooperation Treaty as of January 7, 2025), and seeks procedures for

filing a new application or for recovering the rights (the First-instance Plaintiff has not clearly stated when and in which state the First-instance Plaintiff planned to obtain patents.).

However, in light of the territoriality principle regarding patents, it is construed that how the right to be granted patents is treated in foreign states and what effect it has are determined by the laws of the state where the patents are registered based on the right to be granted said patents. Concerning the invention, even at this moment where no new application has been filed in any state, transfer procedures have not been conducted in Japan, and no specific plan of the procedures thereof has been clarified, it cannot be found that the dispute has matured to the extent of rendering declaratory judgments that the First-instance Plaintiff has the right to be granted patents for said inventions. In this regard, the First-instance Plaintiff argued that the governing laws are Japanese laws for Claims 1-1, 1-3, and 2 and that even if the argument of the First-instance Plaintiff regarding the governing law is not accepted, it is sufficient if the court applies the appropriate governing laws. However, the court cannot find and judge them since the parties have not made concrete arguments nor have presented any evidence about the details of the relevant laws and regulations in as many as 158 contracting states of the Patent Cooperation Treaty and about whether the First-instance Plaintiff has the right to be granted patents based on them. The argument by the First-instance Plaintiff is groundless.

In addition, the argument by the First-instance Plaintiff regarding the interest in seeking declaratory judgments on the aforementioned claims does not have an impact on the aforementioned determination.

(2) Alternative claims regarding PCT applications (Claims 1'-1, 1'-3, and 2')

The First-instance Plaintiff added claims to seek declaratory judgments that the First-instance Plaintiff has the right to be granted European patents as alternative claims in this instance, concerning the PCT applications for which the First-instance Plaintiff sought declaratory judgments in the court of prior instance. The First-instance Plaintiff argued that the right to be granted European patents was an issue as a typical example concerning the interest in filing a legal action in the court of prior instance and for which both parties fully presented allegations and evidence.

However, the claim of seeking a declaratory judgment that the First-instance Plaintiff has the right to be granted patents in all contracting states of the Patent Cooperation Treaty and the claim of seeking a declaratory judgment that the First-instance Plaintiff has the rights to be granted European patents are totally different in the scope where the First-instance Defendants make rebuttals (in order to argue and

prove the absence of the interest in filing a legal action regarding the former claim, it is not required to argue and prove the same interest regarding the latter claim). In addition, the First-instance Defendants argued in the judgment in prior instance that the right to be granted European patents and "the right to be granted patents related to the PCT applications" were different (No. 3, 1 (Defendants' argument) (2) of the judgment in prior instance); and, it is totally impossible to say that both parties fully presented allegations and evidence in the judgment in prior instance.

If so, it is considered to take a considerably longer period to examine the alternative claims added by the First-instance Plaintiff in this instance, and therefore, the change to the claims by the First-instance Plaintiff mentioned above is found to significantly delay judicial proceedings.

(3) Conclusion

Based on the above, the legal action related to the principal claims for the PCT applications lacks the interest in seeking immediate determination, and therefore, lacks the interest in seeking declaratory judgments.

In addition, the change to the claims to add alternative claims that the First-instance Plaintiff made in this instance falls under the proviso to Article 143, paragraph (1) of the Code of Civil Procedure, and therefore, it is not allowed pursuant to paragraph (4) of said Article.

2. Issue 3 (Characteristics as an employee invention for Inventions 1-2 and 1-3)

According to 1. above, judgment on merits is only required for Claim 1-2. Based on the results of clarification of issues in the court of prior instance, the characteristics as an employee invention for Invention 1-2 were determined to be subject to the characteristics as an employee invention for Invention 1-3 that has identical content to Invention 1-2. Therefore, the characteristics as an employee invention for Invention 1-3 are examined below.

(1) Details of Invention 1-3 (Exhibit Ko 7)

A. Scope of patent claims

[Patent Claim 1]

A vascular plug for embolizing an aneurysm formed in a blood vessel, comprising;
a pusher wire, and
an expanding unit that is connected to the distal side of the aforementioned pusher wire and is implanted in the aneurysm;
wherein the expanding unit reduces its diameter to become an appropriately cylindrical form when it is placed in a catheter and it curls outward from the tip side when it is not placed in a catheter.

B. Statements in the Description, etc.

The Description, etc. contain the statements as stated in No. 4, 2. (1) of the judgment in prior instance (page 25 and after). According to the statements, it is found that the Description, etc. disclose the following.

(A) Technical field

Invention 1-3 is related to a vascular plug and a treatment device equipped with the vascular plug ([0001]).

(B) Background of the invention

In order to prevent the rupture of an aneurysm formed in the blood vessel of a patient, there is a treatment of embolizing an aneurysm with the vascular plug. A vascular plug comprised of a pusher wire and a mesh-shaped unit is proposed ([0002]).

(C) Problem to be solved by the invention

If the size of the mesh-shaped unit when it is expanded does not match the size of the aneurysm, it is difficult to embolize the aneurysm appropriately and other problems arise. Therefore, operations before treatment become troublesome, such as it being necessary to prepare multiple vessel plugs in different sizes and then select an appropriate size for the aneurysm.

In addition, as shown in FIG. 6A, the existing vascular plug sends the tip of a catheter 103 into an aneurysm in the bifurcation area AN; a pusher wire 105 is operated in this state; and a mesh-shaped unit 104 that has been stored in the catheter 3 is pushed from the tip side. However, when more than half of the mesh-shaped unit 104 is pushed out, the remaining mesh-shaped unit 104 is taken out from the catheter 103 due to the extensive force of the mesh-shaped unit that has been pushed out first. As shown in FIG. 6B, subsequently the mesh-shaped unit 104 suddenly pops out, makes the aneurysm in the bifurcation area AN more fragile, and may break through in some cases. Therefore, there was the problem that careful operation is required and this increases the difficulty level of the surgery.

For this reason, Invention 1-3 adopted the configuration stated in Patent Claim 1 aiming to provide a vascular plug and treatment device which are highly flexible to adjust to the size of the aneurysm and which control the sudden expansion of the expanding unit ([0004] through [0007]).

(D) [Effects of the invention]

According to Invention 1-3, it can provide a vascular plug and treatment device which are highly flexible to adjust to the size of the aneurysm and which control the sudden expansion of the expanding unit ([0017]).

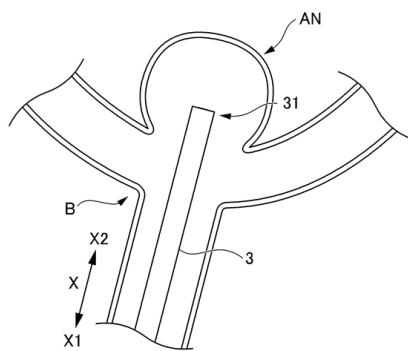
(E) Configuration for embodiments

As shown in FIG. 3A, the tip 31 of the catheter 3 (treatment device 1) is guided close to blood vessel bifurcation area B and the tip 31 is further sent into the aneurysm in the bifurcation area AN ([0034]).

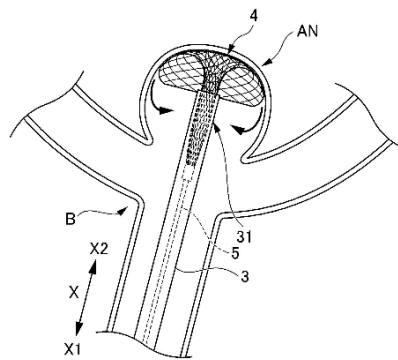
Next, in a state where the proximal side (X1 side) of the catheter 3 is gripped, a pusher wire 5 is operated to push a stent 4 to the distal side (X2 side). As a result, as shown in FIG. 3B, the tip 41 of the stent 4 that is stored in the catheter 3 is pushed from the tip 31 of the catheter 3 and extends while curling outwards. When the stent 4 is additionally pushed towards the distal side by operating the pusher wire 5, as shown in FIG. 3C, the tip 41 of the stent 4 additionally extends while curling outwards. As a result, the stent 4 expands while changing its shape to conform to the size of the aneurysm in the bifurcation area AN, and, eventually, it becomes substantially spherical in a way that conforms to the size of the aneurysm in the bifurcation area AN. Even if the stent 4 is kept pushing to the distal side, the stent 4 does not protrude from the tip 31 of the catheter 3 more than the specified length ([0035]).

Finally, as shown in FIG. 3D, the pusher wire 5 and the stent 4 are separated and then, the catheter 3 and the pusher wire 5 are collected from inside the living body ([0036]).

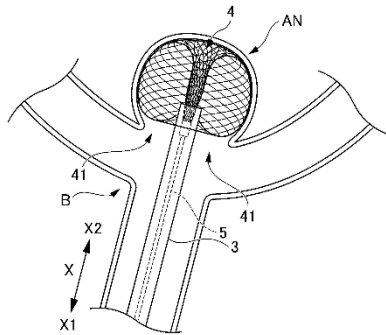
[FIG. 3A]



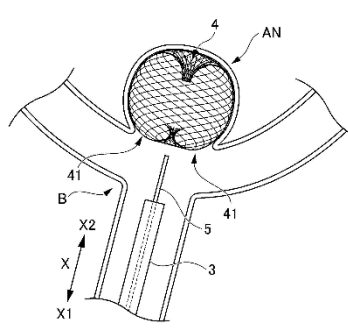
[FIG. 3B]



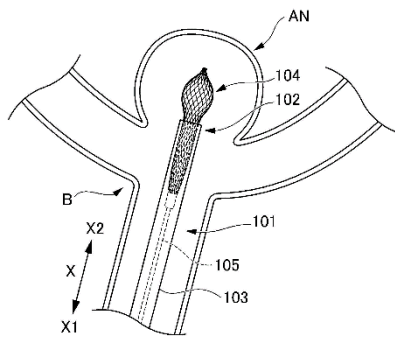
[FIG. 3C]



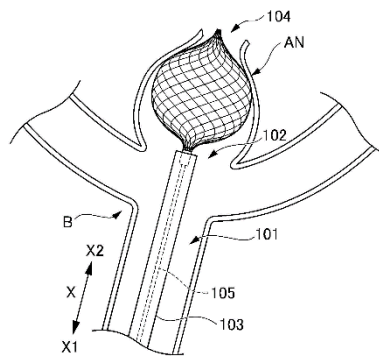
[FIG. 3D]



[FIG. 6A]



[FIG. 6B]



(2) Career and study field of Professor A (Exhibits Otsu 19, 45, and 46)

After obtaining a physician's license in Japan, Professor A went to the U.S.A., obtained a physician's license in the state of California, and is now a professor of the Department of Neurosurgery and the Department of Radiology at the Ronald Reagan UCLA Medical Center of the University of California, Los Angeles.

Professor A has used WEB (Woven EndoBridge: a bag-shaped embolization device for brain aneurysm treatment) by MicroVention, Inc. in the U.S.A. in clinical practice since around 2020; however, Professor A has recognized that there is a risk of penetration of the aneurysm with WEB when it is expanded.

Professor A concluded a medical advisory contract agreement with the First-instance Plaintiff in 2018 and 2019 (Exhibits Ko 55 and 56); however, there are no specific statements concerning the ownership of intellectual property rights.

(3) Career of First-instance Defendant Y1 (Exhibits Otsu 10 and 47)

After graduating from the Faculty of Environment and Information Studies of Keio University, First-instance Defendant Y1 worked at a bank, and founded a company, the First-instance Plaintiff, with his brother Z (completed the Graduate School of Science and Technology, Keio University; doctor of science), and became the representative

director of the company. Both Y1 and Z are nephews of the manager of a leading patent attorney's office.

Externally, it is Z, who was the Director and Head of the Research and Development Department, that gives explanations of concrete technical matters (Exhibits Ko 39, 41, etc.). In addition, the drawings and specifications of stents (Exhibits Ko 44, etc.) were also created under the name of Z.

(4) Statements in the study notes of Professor A (Exhibit Otsu 49) (as stated in the Attachment)

A. In the memorandum dated November 30, 2020 on the right of page 20 and the left of page 21 of Exhibit Ko 49, there are the following statements: concerning prior art, if WEB is expanded in an aneurysm in a blood vessel, it is hard when pushing it out and it may cause an injury; in order to deal with this problem, a mesh-shaped WEB was invented; and on the left of page 21, a drawing where the mesh-shaped unit is expanded while curling outwards from the tip of a catheter is stated.

B. In the memorandum dated December 5, 2020 on the right of page 21 of Exhibit Otsu 49, it is stated that the technology invented by Professor A is less sharp and has size capacity and that Professor A had meetings with First-instance Defendant Y1 via Skype.

C. The study notes in Exhibit Ko 49 are in a bound notebook (not a loose-leaf notebook), stated in chronological order, and there are no circumstances that raise doubts about its authenticity.

(5) Inventor of Inventions 1-3

A. An invention means a highly advanced creation of technical ideas using the laws of nature (Article 2, paragraph (1) of the Patent Act). In order for a person to be regarded as an inventor, the person needs to be actually involved in the act of creation of technical ideas in the invention, in other words, to be actually involved in the act of creation of technical ideas, in particular, to be actually involved in completing the characteristic part of the invention related to the means of solving a conventional technical problem.

B. Based on (1) above, the characteristic part of Invention 1-3 is the following: concerning a vascular plug comprised of a pusher wire and a mesh-shaped unit embolizing an aneurysm in a blood vessel to prevent rupture of the aneurysm, there was the problem that multiple vascular plugs in different sizes must be prepared and there was a risk of damaging the aneurysm by sudden expansion of the mesh-shaped unit; therefore, a configuration where the tip of a stent is pushed out from the tip of a catheter and expands while curling outwards when it is not stored was adopted; thanks to this configuration, the stent changes its shape to conform to the size of the aneurysm in a bifurcation area and is highly flexible to adjust to the size of the aneurysm and the stent

does not protrude from the tip of the catheter more than the specified length; and therefore, it does not damage the aneurysm in the bifurcation area due to sudden expansion.

On the right of page 20 of Exhibit Otsu 49, there is a statement about an injury in an aneurysm in the bifurcation area of a blood vessel due to a hard tip of WEB that is pushed out from a catheter, and a WEB with a sharp tip which is the same as [FIG. 6B] in the Description is shown. The possibility of injury to the aneurysm in the bifurcation area from among problems to be solved by Invention 1-3 is thus stated. Next, on the left of page 21, Patent Claim 1 of Invention 1-3 where the tip of WEB is pushed out from the tip of the catheter and expands while curling outwards, and drawings corresponding to [FIG. 3B] through [FIG. 3D] are shown. In addition, on the right of page 21, there is a statement that the "invented 'web' or mesh-ball" has less sharpness, and better size capacity can be obtained, which corresponds to the effects of Invention 1-3.

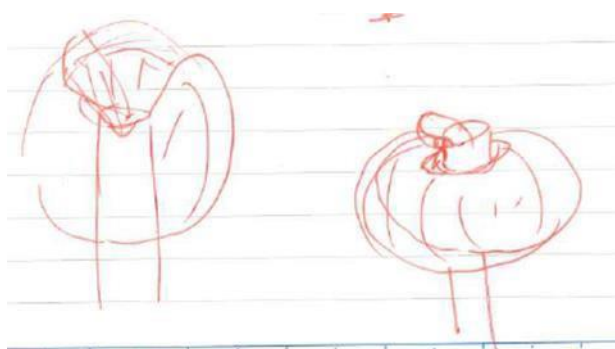
Based on the above, Exhibit Otsu 49 contains a clear statement on the problem of Invention 1-3 and a means of solving it. Therefore, it is reasonable to find that it is Professor A who was actually involved in the completion of the characteristic part of Invention 1-3.

C. The First-instance Plaintiff argued that the First-instance Defendants are not allowed to argue that the inventor of Invention 1-3 is Professor A due to estoppel. However, this is not a case where an employer had filed a patent application by stating that an employee is an inventor but the employer denied that the employee is an inventor in a lawsuit where the employee claims consideration for the employee invention. Therefore, it cannot be said that the First-instance Defendants' argument is not naturally allowed due to estoppel.

In addition, the First-instance Plaintiff argued that the statements of First-instance Defendant Y1 and Professor A have been changed repeatedly. Both First-instance Defendant Y1 (the written statement in the court of prior instance is Exhibit Otsu 10 and the written statement in this instance is Exhibit Otsu 47) and Professor A (the written statement in the court of prior instance is Exhibit Otsu 19 and the written statement in this instance is Exhibit Otsu 46) stated in the court of prior instance concerning Invention 1-3 that Professor A gave an idea (seeds of the invention) and First-instance Defendant Y1 made the invention based on the idea. It is true that the statements are different from those in this instance. However, if there was no clinical knowledge, the problem of Invention 1-3 and the means of solving the problem could not be detected. As stated above, Professor A has broad clinical experience, while it is

not found that First-instance Defendant Y1 has such a background. In addition, in the court of prior instance, the scope of the job of First-instance Defendant Y1 was a big issue. In consideration of the fact that Exhibit Otsu 10, which is the written statement of First-instance Defendant Y1 in the court of prior instance, contains no statement on the specific details of Invention 1-3, Exhibit Otsu 10 and Exhibit Otsu 19 only made an error in the assessment of an inventor. Even if the statements of First-instance Defendant Y1 and Professor A are not true (Professor A approved the patent application under the name of First-instance Defendant Y1 based on the personal relationship with First-instance Defendant Y1), under the situation where Exhibit Otsu 49, which is objective evidence on the background of making Invention 1-3 before the date of the priority claim of PCT Application 2, exists, changes in the statements do not have a decisive impact on the findings and judgment regarding who is an inventor of Invention 1-3.

Moreover, the First-instance Plaintiff argued that the characteristic part of Invention 1-3, which is a configuration where the tip of the stent curls three-dimensionally outwards, has already been shown around in 2015 in Exhibit Ko 93, which is an operational memorandum taken by First-instance Defendant Y1, and therefore that the inventor of Invention 1-3 is First-instance Defendant Y1. Said drawings are as shown below; however, it is completely impossible to read from them what device it is, whether there is a problem, and how the device newly solves it. This is the same even taking the character part at the top of the drawings into consideration. Furthermore, it cannot be read from these drawings the configuration with a movement where the stent at the tip of a catheter curls three-dimensionally outwards. The argument of the First-instance Plaintiff cannot be accepted.



D. The First-instance Plaintiff additionally argued as follows: even if Professor A was involved in Invention 1-3, First-instance Defendant Y1 had already had the idea for the invention; the person who embodied the idea in a way of also satisfying the safety as a medical device was First-instance Defendant Y1, who created a prototype using raw

materials prepared based on the calculation in the First-instance Plaintiff and completed the invention using the facilities of the First-instance Plaintiff; and therefore, it is at least a joint invention of First-instance Defendant Y1 and Professor A.

However, as stated in C. above, the assumption that First-instance Defendant Y1 had already had the idea of Invention 1-3 cannot be accepted. In addition, there is no evidence to find that First-instance Defendant Y1 created a prototype using raw materials prepared based on the calculation in the First-instance Plaintiff and completed the invention using the facilities of the First-instance Plaintiff. Even if the creation of a prototype and other items would be necessary in the stage of filing an application for patent approval or putting it into a product, it cannot be immediately considered to be necessary for completion of Invention 1-3. In Invention 1-3, the concrete configuration of a medical device related to the "vascular plug" is a means to solve the problem. In Exhibit Otsu 49, the problem corresponding to Invention 1-3 and the means to solve it are clearly stated and it provides a specific idea. Therefore, there is no problem in considering Professor A as an inventor. Therefore, it is not found that Invention 1-3 is a joint invention by First-instance Defendant Y1 and Professor A.

(6) Based on the above, without the need to make determinations on the other remaining points, the characteristics as an employee invention cannot be found with Invention 1-3 (First-instance Defendant Y1 cannot be regarded as an inventor of Invention 1-3). Therefore, Invention 1-2, for which the characteristics as an employee invention is subject to those for Invention 1-3, is not found to be an employee invention and Claim 1-2 is groundless.

No. 5 Conclusion

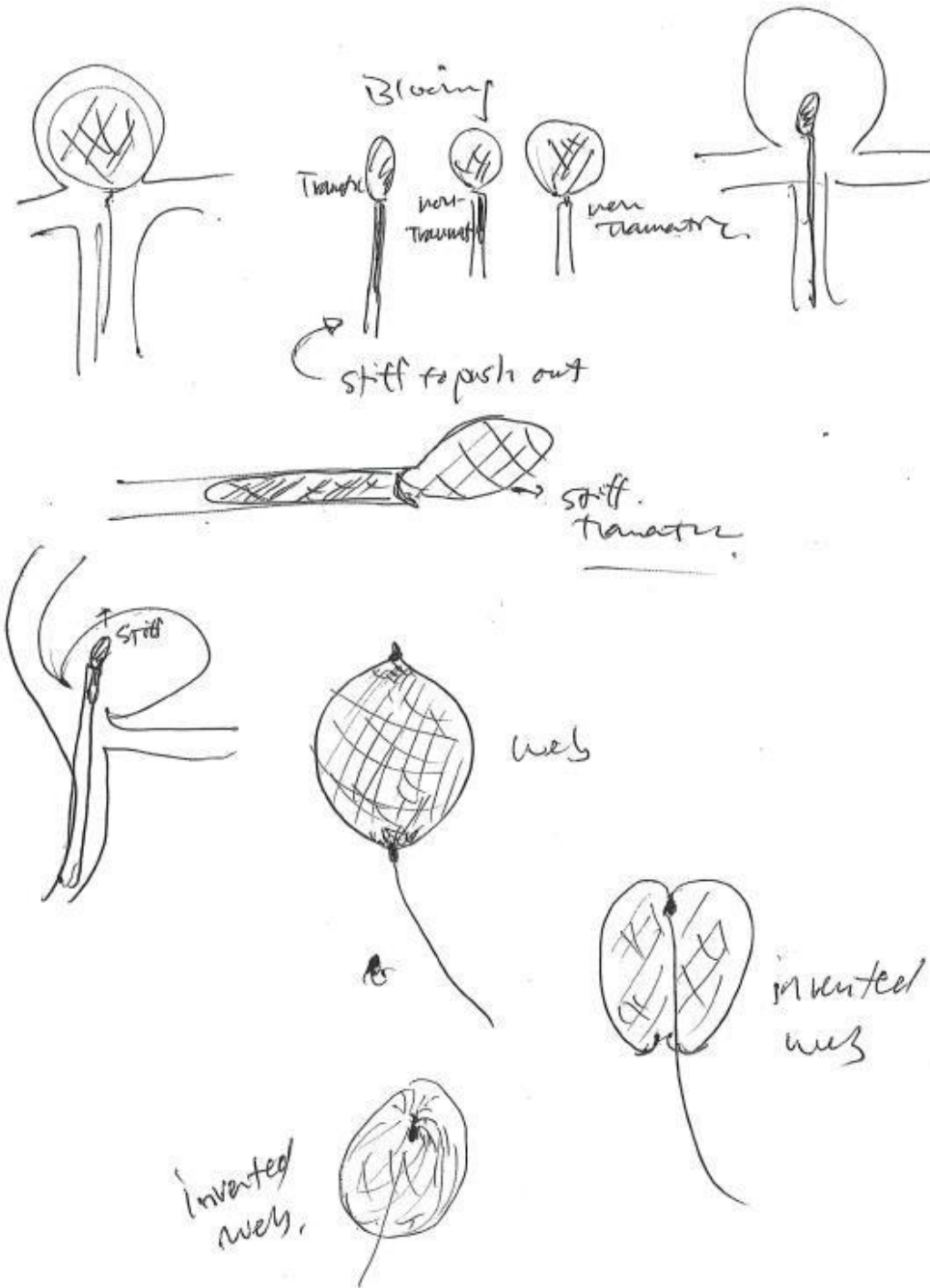
Based on the above, the judgment of the court of prior instance where the claims related to Claims 1-1, 1-3, and 2 lack the interest in filing a legal action is reasonable in conclusion. Therefore, the appeal of the First-instance Plaintiff is dismissed (additional changes to the claims in this instance are not allowed), Invention 1-2 is not found to be an employee invention and Claim 1-2 is groundless. Consequently, Paragraph 1 of the main text of the judgment in prior instance is rescinded based on the appeal of the First-instance Defendant Company, Claim 1-2 is dismissed, and the judgment is rendered as indicated in the main text.

Intellectual Property High Court, Fourth Division
Presiding judge: MASUDA Minoru
Judge: MOTOYOSHI Hiroyuki
Judge: IWAI Naoyuki

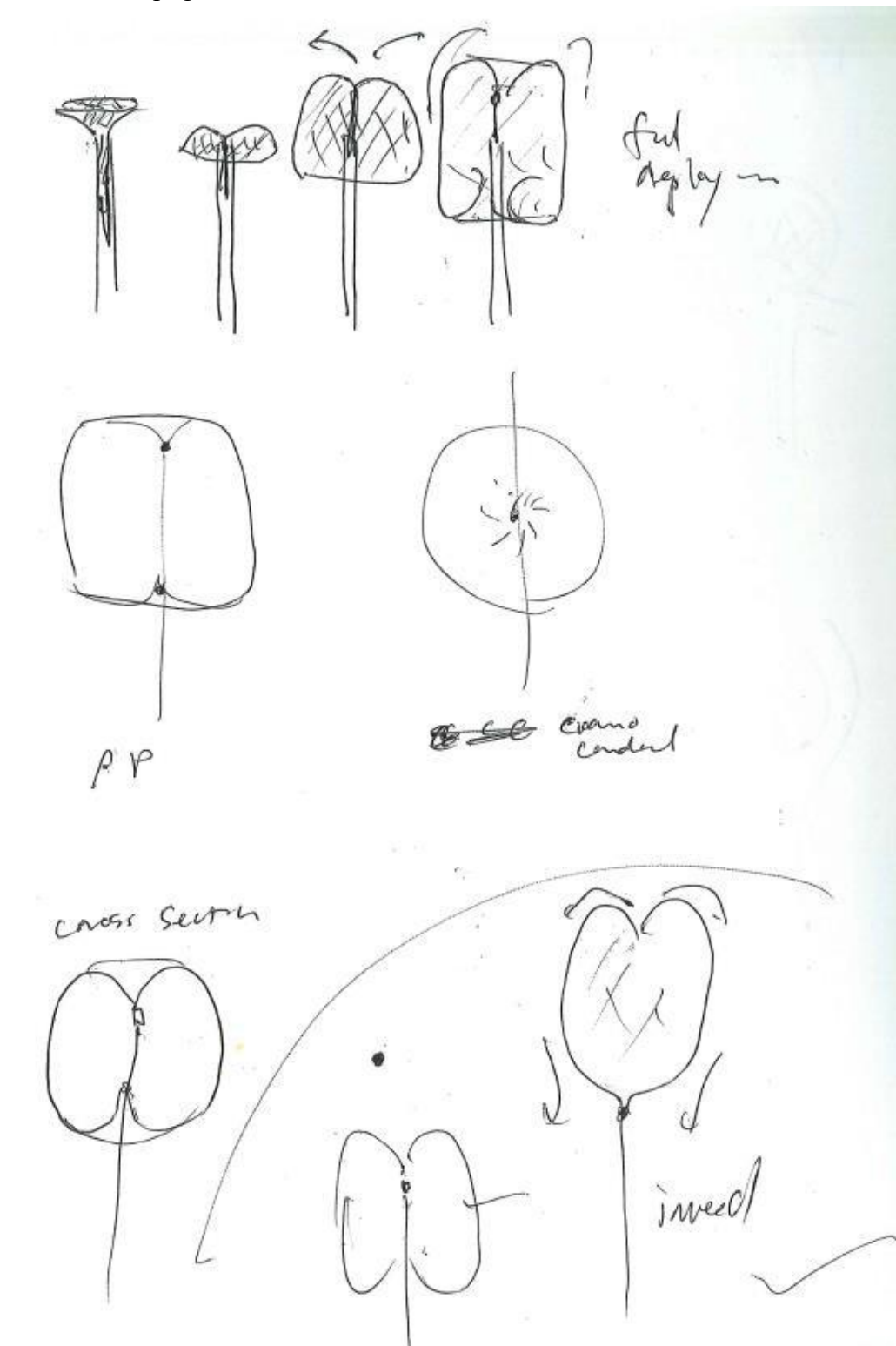
(Attachment) Statements in the study notes of Professor A (Exhibit Otsu 49)

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11/30/2020



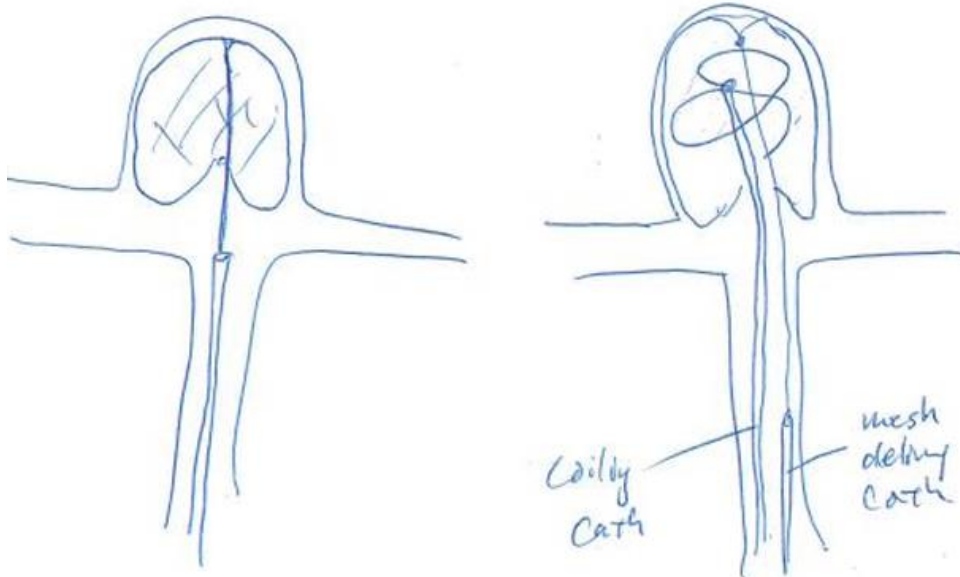
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12/5/2020

Invented 'web' or mesh ball

- less 'poke' from the bagging (upon initial delivery)
- more forgiving in sizing?
- additional cooly for inside?



contain + resistant like devices