

Patent Right	Date	June 11, 2020	Court	Tokyo District Court, 47th Civil Division
	Case number	2018(Wa)36424		
<p>- A case in which the court partially granted a claim of the Plaintiff, a former employee of the Defendant (and one of the joint inventors), made against the Defendant to seek the payment of consideration for employee invention in relation to an invention of a competition game.</p>				

Summary of the Judgment

The Plaintiff, while in employment with the Defendant, invented the following inventions: [i] jointly with other inventors, the inventions relating to a bet controlling method for a competition game (comprising of Invention 1 titled "Invention relating to a function called newspaper betting" and Invention 2 titled "Invention of method relating to a function called an odds-designated betting), and [ii] as a single inventor, the invention of know-how relating to a competition game ("Know-how"). The Plaintiff assigned to the Defendant the rights to obtain patents relating to these inventions. The Defendant obtained registrations for the establishment of patent rights relating to Invention 1 and Invention 2, respectively. The Plaintiff filed an action against the Defendant seeking the payment of consideration for these inventions pursuant to paragraph (3) of Article 35 of the Patent Act (before the amendment by Act No. 79 of 2004), by alleging that a part of a series of horserace medal games for a video game arcade manufactured and sold by the Defendant (Defendant's Product 1) is an embodiment of Invention 1, and that another series of games (Defendant's Product 2) is an embodiment of Invention 2 (whether literally or by the application of the doctrine of equivalents), and also that both of these products are embodying the Know-how.

In this judgment, the court found that Defendant's Product 1 is an embodiment of Invention 1 and granted the Plaintiff's claim for the payment of consideration in respect of the portion not extinguished due to prescription. On the other hand, the court found that Defendant's Product 2 is not an embodiment of Invention 2 and that the Know-how cannot be considered as a technical idea eligible for patent protection and dismissed the claim for the payment of consideration in relation to Defendant's Product 2 and the Know-how. As a reason for finding that Defendant's Product 2 is not an embodiment of Invention 2, the court pointed out the following difference between the composition of Invention 2 and that of Defendant's Product 2: the matter specifying an invention with regard to Invention 2 is that a single betting button for betting on all possible orders of

race finishes appears after they are displayed to the player once the desired range of odds is selected; whereas, with respect to Defendant's Product 2, possible orders of race finishes matching the desired range of odds selected are displayed after selecting an all-bet button. Based on this, the court held that none of the allegedly infringing products is a literal embodiment of Invention 2, or an embodiment by the application of the doctrine of equivalents as the difference mentioned above is the essential element of Invention 2 and therefore the first requirement of the doctrine is not met.