

Patent Right	Date	August 21, 2020	Court	Tokyo District Court, 40th Civil Division
	Case number	2017 (Wa) 27378		

- A case in which, with regard to the Plaintiff's claims for a declaratory judgment on his/her status as an inventor of the patented invention titled "Drug for cancer treatment," the performance of the procedure to register the transfer of a share in the patent right for that invention under Article 74, paragraph (1) of the Patent Act, and the payment of damages, the court dismissed without prejudice the action regarding the Plaintiff's claim for a declaratory judgment on his/her status as an inventor of the patented invention, holding that the Plaintiff has no interest in seeking such a declaratory judgment, and dismissed with prejudice on the merits all the other claims on the grounds that the Plaintiff cannot be recognized as an inventor of the patented invention.

#### Summary of the Judgment

In this case, the Plaintiff, who was enrolled in the master's program at a graduate school of a university, alleged that the invention related to anti-PD-L1 (Programmed cell death ligand 1) antibody, which pertains to the patent right for an invention titled "Drug for cancer treatment" (hereinafter the "Invention" and the "Patent Right"), is based on his/her paper in which he/she described the results of the experiments he/she performed while in the graduate school and the findings obtained from the analysis of these results, and therefore he/she should be credited as one of the inventors. Based on this allegation, the Plaintiff filed this action against the Defendants, who jointly own the Patent Right (a professor and a drug distributor), to seek a declaratory judgment that the Plaintiff is an inventor of the Invention, request the performance of the procedure to register the transfer of a share in the Patent Right based on Article 74, paragraph (1) of the Patent Act, and claim damages based on joint tort.

The issues of the case are as follows: [i] whether the Plaintiff has interest in seeking a declaratory judgment that the Plaintiff is an inventor of the Invention; [ii] whether the Plaintiff is an inventor of the Invention; [iii] whether the request for the performance of the procedure to register the transfer of a share in the Patent Right is acceptable; and [iv] whether a tort has been committed and, if it is committed, the amount of damages.

In this judgment, the court first made determination on Issue [i] as follows: the Plaintiff's claim only seeks a declaration regarding the facts and, for this purpose, it is sufficient for the Plaintiff to claim compensation for damages based on tort in the form

of an action to seek performance of an obligation, and therefore it cannot be said that the Plaintiff has interest in seeking a declaratory judgment. Accordingly, the court found that the part of the action which seeks a declaratory judgment that the Plaintiff is an inventor of the Invention is unlawful, and dismissed it without prejudice.

Regarding Issue [ii], the court held that when finding who should be credited as an inventor of the Invention, it is necessary to take into comprehensive consideration matters regarding the person who claims to be an inventor, including <i> the person's contribution to conceiving of the technical ideas of the Invention, <ii> the person's contribution to preparing and selecting the anti-PD-L1 antibody, <iii> the person's contribution to designing and constructing the experimental system necessary for the demonstration of the hypothesis, and the degree of the person's creative involvement in the process of performing individual experiments. In light of these matters, the court determined that the Plaintiff's contribution to the Invention was limited, on the grounds that: <i> the persons who conceived of the technical ideas of the Invention are the Defendant Professor and the professor who was the Plaintiff's academic advisor; <ii> the main actors who contributed to preparing the anti-PD-L1 antibody were the professor who was the Plaintiff's academic advisor and the professor's assistant; and <iii> the person who designed and constructed the individual experiments that constitute the Invention was the professor who was the Plaintiff's academic advisor. For these reasons, the court determined that the Plaintiff cannot be recognized as an inventor of the Invention, and without making determination on Issues [iii] and [iv], it dismissed all the other claims of the Plaintiff with prejudice on the merits.