

Patent Right	Date	March 14, 2019	Court	Intellectual Property High Court, Fourth Division
	Case number	2018(Gyo-Ko)10002		
<p>- A case in which a judgment was rendered that, with regard to an international patent application filed in a foreign language, filing of the national document and the translation for the description and the like after elapse of the time limit for submitting national documents does not fall under the "legitimate reasons" under Article 184-4, paragraph (4) of the Patent Act, and the dismissal of the procedures without issuing a correction order under Article 184-5, paragraph (2), item (i) of the Act is not unlawful.</p>				

Case type: Rescission of dismissal of procedures, etc.

Result: Appeal dismissed

References: Article 184-4, paragraph (4), Article 184-5, paragraph (2), item (i) of the Patent Act

Number of related rights, etc.: Patent Application No. 2016-505739

#### Summary of the Judgment

1 This case is a case in which, in an international patent application filed in a foreign language, the applicant filed the national document and the translation for the description and the like after elapse of the time limit for submitting national documents, but the filing procedures were dismissed (hereinafter, referred to as the "present dismissal"), and the appellant who succeeded the right to be granted a patent according to the aforementioned application from the applicant claimed for rescission of the present dismissal by asserting that the applicant has the "legitimate reasons" under Article 184-4, paragraph (4) of the Patent Act for the failure to file each of the aforementioned documents within the time limit for submitting national documents, and the present dismissal without issuing the correction order under Article 184-5, paragraph (2), item (i) of the Patent Act is unlawful.

2 The judgment in prior instance (Tokyo District Court, 2017(Gyo-U) 290 rendered on July 13, 2018) did not find the "legitimate reasons" and judged that not to issue the correction order was not unlawful, and dismissed the claim by the appellant.

3 This judgment judged that the "legitimate reasons" could not be found in the elapse of the time limit for submitting the national document and the translation for the description and the like and not to issue the correction order was not unlawful, and dismissed the present appeal as follows:

(1)The due date of the domestic shift procedures of the international patent

application is determined to be 30 months from the priority date in some countries and to be 31 months in other countries, but the patent attorney's office that received the request from the applicant of this case had a practice to send instruction letters on the domestic shift to attorneys in each country before the due date of 30 months also for the countries with the due date of 31 months. However, an assistant in the aforementioned patent attorney's office erroneously made an input on July 20, 2015 that Japan, which has the due date of 30 months, had the due date of 31 months (hereinafter, referred to as the "present erroneous input") and moreover, the assistant was scheduled to take a leave from the 21st of the month to August 5 of the year, and thus decided to process the instruction letter on the domestic shift for the countries with the due date of 31 months after the leave. As a result, the present applicant could not file the national document and the translation for the description and the like by July 29 of the year which was the due date of the domestic shift procedures in Japan.

The appellant asserted that the judgment should be rendered on the ground whether the measure taken by the applicant and the like in accordance with the guideline formulated by the Japan Patent Office is applicable to the "reasonable measure" or not, and since the present erroneous input satisfied the three requirements stipulated in the guideline 3. 1. 5(5), and a "reasonable measure" was considered to be taken, there were "legitimate reasons".

However, the guideline shows guiding principles, operation procedures, and the like of the Japan Patent Office and does not have legal criteria as government or ministry ordinances. And (i) it cannot be considered that the present applicant paid reasonable attention only because the patent attorney's office was using the system certified by ISO9001:2008; (ii) since a work to check accuracy of the description manually input by the assistant was not performed in the regular meeting held on July 27, 2015 when the assistant was taking the leave, it cannot be considered that the present applicant paid reasonable attention because the regular meeting was held; (iii) even if the present erroneous input was caused by the mistake by the assistant, the long-term leave to be taken by the assistant was scheduled in advance, and despite the present erroneous input being avoidable by grasping the leave period, the progress of the operation handled by the assistant, the operations which should be fulfilled by the other staff members during the leave, and the like and by giving required instructions to the assistant or the other staff members before the staff member took the leave, such measures were not taken and thus, it cannot be considered that the present applicant paid reasonable attention. In view of the relationship with the guideline, it

is found that the requirements in "b. Accurate guidance and instructions are given to the assistant" and "c. Sufficient management/supervision is exercised to the assistant" stipulated in the guideline 3.1.5 (5) are not satisfied.

Therefore, the "legitimate reasons" in Article 184-4, paragraph (4) of the Act are not approved.

(2) It is reasonable to interpret that the aim of Article 24 of the Patent Cooperation Treaty is that which part of Article 24 (1)(iii) or (2) of the Treaty is to be adopted is entrusted with the designated states, and Japan decided that to adopt Article 24 (1)(iii) and if the translation for the description and the like are not filed within the time limit for submitting national documents (within the special time limit for submitting translations for the patent application in foreign language in the proviso to Article 24 (1)), the international patent application is deemed to be withdrawn (Article 184-4, paragraph (3) of the Act). Therefore, Article 184-4, paragraph (3) of the Act does not violate the Patent Cooperation Treaty.

Moreover, the provisions in the same paragraph that, when the translation for the description and the like are not filed within the time limit for submitting national documents, it is deemed to be withdrawn, and the provisions in the Article 184-5, paragraph (2) of the Act related to the correction order when the national document is not filed within the time limit for submitting national documents are applicable regardless of whether the applicant of the patent application in a foreign language is a national applicant or a foreign applicant and thus, these provisions do not violate the principle of national treatment provided in Article 2 of the Convention of Paris.

Moreover, since the translation for the description and the like were not filed within the time limit for submitting national documents in this case, the present international patent application was deemed to be withdrawn in accordance with the provisions in the Article 184-4, paragraph (3) and as a result, there was no room for issuing the correction order in Article 184-5, paragraph (2), item (i) of the Act related to the filing of the national document and therefore, the present dismissal without issuing the correction order is lawful.

Judgment rendered on March 14, 2019

2018 (Gyo-Ko) 10002      The appeal case of seeking a rescission of a disposition to dismiss a procedure and the like

(court of Prior Instance: Tokyo District Court, 2017 (Gyo-U) 290)

Date of conclusion of oral argument: January 29, 2019

### Judgment

Appellant                      Redx Pharma Plc

Appellee                      Japan

Disposing administrative authority      The Commissioner of the Japan Patent Office

### Main text

- 1      The appeal shall be dismissed.
- 2      The costs in connection the trial shall be borne by Appellant.
- 3      The additional period for filing a final appeal and a petition for acceptance of final appeal against this judgment shall be 30 days.

### Facts and reasons

#### No. 1 Gist of the Appeal

- 1      The judgment in prior instance shall be rescinded.
- 2      The disposition made by the Commissioner of the Japan Patent Office on December 21, 2016 with regard to Japanese Patent Application No. 2016-505739 to dismiss a procedure according to a national phase document submitted on October 2, 2015 shall be rescinded.

#### No. 2 Outline of the case (abbreviated names are in accordance with those of the judgment in prior instance, unless otherwise specified.)

##### 1      Summary of the case

This case is a case in which a Belgian legal entity of Amachem NV (Applicant) submitted the document (national documents) of Article 184-5, paragraph (1) of the Patent Act and the translation of the description, etc. after the time limit for submitting national documents, claiming against the commissioner of the Japan Patent Office that the Applicant had "a legitimate reason" (Article 184-4, paragraph (4) of the Patent Act) for not having been able to submit the translation of the description,

etc. in Japanese as of the international filing date (hereinafter referred to as "the translation of the description, etc.") within the time limit for submitting national documents of the same article, paragraph (1) of the Patent Act (hereinafter simply referred to as "the Act") with respect to an international patent application filed in a foreign language including Japan as a designated state under the Patent Cooperation Treaty prepared in Washington on June 19, 1970 (the international patent application), but the commissioner of the Japan Patent Office issued a disposition of dismissal (the disposition of dismissal) of the procedure according to the national documents (a procedure of the submission of a national document and a translation of the description, etc.), stating that it cannot be said that the Applicant had a legitimate reason, and thus the international patent application did not satisfy the requirement as provided in Article 184-4, paragraph (4) of the Act, and was thus deemed to be withdrawn under the provision of the same article, paragraph (3). In response, the Appellant, who has acquired a right to obtain a patent of the international patent application from the Applicant, seeks for the rescission of the disposition of dismissal.

The judgment in prior instance dismissed the Appellant's claim, stating that it cannot be recognized that the Applicant had a "legitimate reason" as provided in the same article, paragraph (4) with respect to the Applicant's failure to submit the translation of the description, etc. within the time limit for submitting national documents, and thus the disposition of dismissal without issuing the order to amend under Article 184-5, paragraph (2), item (i) of the Act is not illegitimate.

Accordingly, the Appellant has filed an appeal challenging the dismissal.

2 Provisions of treaty and laws related to this case, the facts used as premise and issues

Except for the fact that "without doing" of page 7, line 12 of the judgment in prior instance is replaced with "without issuing", "Facts and reasons" of the judgment in prior instance, No. 2, 2 to 4 are maintained. Thus these are incorporated by reference.

(omitted)

No. 4 Judgment of the court

The court also determined that the disposition of the dismissal is not recognized as illegitimate as Appellant alleges, and thus the Appellant's claim is groundless. The reason is set forth as below.

1 Facts found

Except for the following correction, the judgment in prior instance, "Facts and reasons", No. 4-1 is maintained. Thus it is incorporated by reference.

Add the following with a carriage return to the end of page 22, line 1 of the judgment in prior instance:

I The Applicant submitted a translation of the description, etc. (Exhibit Ko 1) attached to a national document under Article 184-4, paragraph (4) of the Act with the commissioner of the Japan Patent Office on October 2, 2015, and submitted a reason for restoration (Exhibit Ko 2) that described a legitimate reason for the failure to submit the translation of the description, etc. within a time limit of submitting national documents.

J The commissioner of the Japan Patent Office issued the disposition of dismissal on December 21, 2016 (Exhibit Ko 5) after dispatching a notice of reasons for dismissal on August 3, 2016 (Exhibit Ko 3) for the Applicant."

2 Issue (1) (Presence or absence of errors in the finding and determination of "a legitimate reason" of Article 184-4, paragraph (4) of the Act)

Except for the following correction, "Facts and reasons" of the judgment in prior instance, No. 4-2 is maintained. Thus this is incorporated by reference.

(1) "Heisei nen" of page 23, line 12 of the judgment in prior instance shall be replaced with "Heisei 27-nen".

(2) "the paragraph" of page 25, line 14 of the judgment in prior instance shall be replaced with "the paragraph (4)".

(3) Add the following with a carriage return to the end of page 25, line 16 of the judgment in prior instance:

"(6) Appellant's allegation in this proceeding

Appellant alleges that it is reasonable to determine the presence or absence of "legitimate reason" of Article 184-4, paragraph (4) of the Act by whether the measure taken by the Applicant, etc. in compliance with the guideline planned by JPO (Exhibit Ko 29) might correspond to a "reasonable measure", and in a case that an underlying event of lapse of time is attributed to human errors by an assistant, it is reasonable to determine the "reasonable measure" by whether or not a measure taken by the Applicant, etc. who employs the assistant might conform to three requirements provided in the guideline 3.1.5(5), not whether a supervisor might take a measure to prevent the respective specific human errors, and further alleges that the lapse of time has "a legitimate reason", and the determination of the judgment in prior instance negating this is erroneous since [i] the case/deadline management system of the office (local agent) had obtained the ISO certificate and was operated properly in

compliance with the standard, [ii] the office had held regular meetings to prevent a lapse of time due to human entry errors and maintain a treatment manual for assistants of PCT national entry (Exhibit Ko 36) in compliance with the International Standard ISO 9001, [iii] The assistant A had had sufficient experience and the task was just a standard task, and thus it is not believed that the incorrect entry was attributed to lack of knowledge or experience, but the error was simply a mistake.

However, the guideline (Exhibit Ko 29) describes "the goal of guideline" in the item of "For the use of a guideline according to the remedial provision after lapse of time" (fourth page from the cover page) that "this guideline has a goal to secure predictability for the Applicant, etc. as to whether or not the remedy might be affirmed by showing the content of the remedial requirements, a guideline for the determination of remedy, and examples of procedures necessary for the application of remedial provisions with respect to the remedial provisions." Further, it describes "points of concern of guideline" that "this guideline shows a fundamental concept of remedial provisions. For easily understanding the concept, specific cases are described in places. In fact, it should be noted that various circumstances such as a cause of lapse of time are comprehensively taken into account." As described above, the guideline just shows a guideline of the determination and practice with respect to the "remedial provisions" of JPO, and does not have a nature of rule of law like regulations.

Further, regarding the above [i], as per the finding of the aforesaid (3)A, the fact that the office had received a certificate of the ISO standard, and maintained and operated the system properly in compliance with the standard only shows that the task management and operation system was at a certain level. It cannot be directly inferred from the utilization of the system certified by the standard that the Applicant had exercised due care to avoid the incorrect entry.

Subsequently, regarding the above [ii], as per the finding of the aforesaid (3)C, in a regular meeting held on July 27, 2015 during the vacation of the assistant A, it was only confirmed that an instruction letter of the national entry had been sent to and received by local agents with a time limit of 30 months. The investigation of the correctness was not made by cross checking the description written by the assistant's hand with other documents. Thus it cannot be seen from the holding of the regular meeting that the Applicant had exercised due care to avoid the incorrect entry.

Furthermore, regarding the above [iii], even if the incorrect entry should be attributed to the mistake of A, regardless of the fact that it was preliminarily scheduled for A to obtain a long vacation and it was possible to avoid the incorrect

entry by recognizing the vacation period, no measure was taken to determine the progress of tasks under the charge of and to be done by the other persons instead during the vacation and give a necessary instruction to the assistant or the other colleagues before the departure for the vacation (the aforesaid (3)B). Thus it cannot be seen that the Applicant had exercised due care to avoid the incorrect entry. Also in relation to the guideline, this shows the nonconformance to the requirements of "b proper guidance and instruction to assistants" and "c sufficient management and supervision to assistants" as provided in the guideline 3.1.5(5).

Therefore, the above Appellant's allegation is not acceptable."

3 Regarding Issue (2) (the presence or absence of illegality of the disposition of dismissal without issuing an order to amend under Article 184-5, paragraph (2), item (i) of the Act)

Except for the following correction, "Facts and reasons" of the judgment in prior instance, No. 4-3 is maintained. Thus this is incorporated by reference.

(1) "Without doing" of page 27, line 22 of the judgment in prior instance shall be replaced with "without issuing".

(2) Add the following with a carriage return to the end of page 27, line 23 of the judgment in prior instance:

"(6) Appellant's allegation in this proceeding

Appellant alleges that it is based on different premises to apply the principle of national treatment between national people who select a foreign language in a situation where the mother language of Japanese is selectable and foreign people who have no room to select Japanese, and it is unreasonable to receive a disposition of dismissal of national documents without receiving an order to amend in a case where an applicant of a foreign language patent application incautiously has a time for the submission of national documents lapse, whereas a remedy such as the issuance of an order to amend under Article 184-5, paragraph (2), item (i) of the Act is provided in a case where an applicant of a Japanese language patent application fails to submit national documents within the time limit for submitting national documents; in view of these facts, it violates the principle of national treatment as provided in Article 2 of the Paris Convention (the principle of equality between domestic people and foreign people) to dismiss national documents without giving an opportunity to amend under the same item in a case where an applicant of a foreign language patent application failed to submit a translation of the description, etc. within the time limit for submitting national documents, and the disposition of dismissal without issuing an order to amend is illegitimate, and thus the determination of the judgment in prior

instance against this makes an error."

As explained in the aforesaid (3), however, Article 184-4, paragraph (3) of the Act specifies that an international patent application is deemed to be withdrawn in a case of the failure to submit the translation of the description, etc. within the time limit for submitting national documents (the special time limit for submitting translations in a case of a foreign language patent application as provided in the proviso to item (i) of the same article) because Article 24, paragraph (1), item (iii) of the Patent Cooperation Treaty specifies that an effect of an international application shall be diminished with the same effect as an effect of withdrawing a domestic application in the designated state in a case where an applicant fails to submit translations within a predetermined period.

On the other hand, the same article, paragraph (2) specifies that a designated Office can maintain an effect of international application, notwithstanding the provision of the same article, paragraph (1). It is reasonable to understand that this paragraph is intended for entrusting a designated Office to decide which of the same article, paragraph (1), item (iii), or paragraph (2) should be adopted for an effect of international application in a case of failure to submit translation within a predetermined time limit, and thus the provision of Article 184-4, paragraph (3) of the Act, which adopts the same article, paragraph (1), item (iii) of the Act, does not violate the treaty.

Further, as explained in the aforesaid (2), the provision of the same paragraph in which an application is deemed to be withdrawn in a case where a translation of the description, etc. was not submitted within the time limit for submitting national documents and the provision of Article 184-5, paragraph (2) of the Act with regard to an order to amend in a case of the failure to submit national documents within the time limit for submitting national documents shall be applied regardless of whether an applicant of the foreign language patent application is a domestic person or a foreign person. Thus these provisions do not violate the principle of national treatment as provided in Article 2 of the Paris Convention.

Further, in this case, the translation of the description, etc. was not submitted within the time limit for submitting national documents, and thus the international patent application was deemed to be withdrawn under the provision of Article 184-4, paragraph (3) of the Act. As a consequence, there was no room to issue an order to amend of Article 184-5, paragraph (2), item (i) of the Act according to the submission of national documents. Thus the disposition of dismissal without issuing an order to amend is legitimate.

Therefore, the above Appellant's allegation is not acceptable."

4 Conclusion

As in the foregoing, the Appellant's claim should be dismissed, and the judgment in prior instance with the same gist is reasonable. Thus the appeal should be dismissed. A judgment shall be made as described in the main text.

Intellectual Property High Court, Fourth Division

Presiding Judge OTAKA Ichiro  
Judge FURUKAWA Kenichi  
Judge SEKINE Sumiko