

30-02 P U D T

Prohibition of Double Jeopardy

1. Prohibition of Double Jeopardy

When a trial decision of the trials listed below has become final and binding (→46-00), a party concerned and an intervenor may not file such a trial (hereinafter referred to as “the same trial” in this section 30-02) based on the same facts and the same evidence (Patent Act Article 167, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(1) A trial for invalidation

(2) A trial for invalidation for a registration of an extension of the term

(3) A trial for rescission of registration of trademark

The reason for providing this provision is to prevent providing two or more conflicting final and binding trial decisions based on the same facts and the same evidence, and to prevent excessive or unnecessary filing of trials for avoiding the inconvenience of repeating the same procedures for the same trial.

An effect of prohibition of double jeopardy is one of the effects of a final and binding trial decision.

However, when comparing with judicial precedents in civil litigation, it is not appropriate that the final and binding trial decision effects even on a person who is not related to the trial, and therefore the third party may demand the trial based on the same facts and the same evidence (※).

※ Regarding the fact that effects of a final and binding trial decision had extended to the third party, there was an opinion that it was unreasonable to limit the right of the third party to contest in trial. In this point, the validity of the limitation is not accepted even considering the comparison with the

case where effects of a court decision extend to the third party under the civil litigation, and thereby the third-party effect has been abolished under the partial revision of 2011 (effective on April 1, 2012) (“Act of Industrial Property Right, Clause by Clause Explanation” [the 22nd edition]).

2. Definition of the Same Trial

It should be understood that the same trial means a trial with the same purport of demand, in other words, it means the right subject to the purport of demand is the same, and a type of trial is the same.

3. Same Facts, Same Evidence

(1) Same facts

Same facts herein mean the facts alleged as reasons for invalidation or rescission are the same in a trial for invalidation or a trial for rescission ((1964 (Gyo-Ke) 161), Judgment of the Tokyo High Court, June 28, 1969, “The method for producing oxidized starch liquid for production of glucuronolactone”; (1971 (Gyo-Ke) 128), Judgment of the Tokyo High Court, Feb 28, 1979, “A device for forming seams on the edges of blank plates such as ducts”).

For example, when a final and binding trial decision is made for the reason for demand that the present device is the same as one described in the publication, if a trial is demanded under the reason that the present device would be quite easily arrived from the device described in the same publication, it is considered a demand for trial is made based on the different facts (Invalidation No. 1970-3957, “Metal woven basket edge braiding device” (Apr.2, 1975))

(2) Same evidence

Same evidence herein means evidence of identity.

There are some court precedents: when evidence itself is different but a

content of evidence is substantially same, it is interpreted that they are the same evidence (Court precedent ① shown below; (2019 (Gyo-Ke) 10077), Judgement of the IP High Court, June 11, 2020 “Wide and flat-bottomed grab bucket for dredging”; and (1919 (O) 184), Judgement of the Supreme Court, Oct 19, 1919).

Even if it is the same publication, when a cited part is different and a technical content to be proved is different, it cannot be said that they are the same evidence ((1964 (Gyo-Ke) 161), Judgment of the Tokyo High Court, June 28, 1969, “The method for producing oxidized starch liquid for production of glucuronolactone”).

Among trial decisions or judicial precedents under the Patent Act Article 167, there are some cases where the evidence submitted for the first time in the subsequent trial for invalidation is not approved as new evidence (Court Precedents ②③ shown below).

4. Application to Co-Pending Another Trial Case

The purport of the provision of the Patent Act Article 167 provides once a trial decision to the effect that a demand for invalidation trial is to be groundless (a trial decision not to grant the demand) becomes final and binding, it is not accepted to file a new invalidation trial based on the facts and evidence same as the above invalidation trial. However, the provision of the Patent Act Article 167 does not apply to a demand for invalidation trial which has been already pending at the time when the trial decision not to grant the demand becomes final and binding (in a case where the registration of the trial decision is before April 1, 2012, at the time when a final and binding trial decision of failure of the demand is registered ((1995 (Gyo-Tsu) 105), Judgment of the Supreme Court, 1st Petty Bench Jan 27, 2000, “Lead chromate pigment and its manufacturing method”)).

5. Cases Where Final and Binding Trial Decision Is a Decision of Dismissal

The provision of the Patent Act Article 167 should be applied on the premise that a trial decision is made after the substantial examination have been carried out on invalidity of a patent and other substances of demand for a trial on the matters prescribed in the provision, considering certain facts and evidence submitted by a demandant of a trial (\rightarrow 1.). Therefore, in a case where a demand for trial is rejected (dismissed) for other reasons such as being filed by a person who is not a party concerned, there is a precedent that the provision indicated above should be interpreted as not applicable ((1930 (O) 693), Judgment of the Supreme Court, Dec 24, 1930, “Threshing tooth device”).

6. Eligibility as a Demandant and Prohibition of Double Jeopardy in That Case

There is a precedent when a trial decision to dismiss a demand for trial becomes final and binding for the reason that a demandant is not an interested person as required for eligibility as a demandant (in a case where a trial decision was registered before April 1, 2012, at the time of registration of a final and binding trial decision), it is not possible to file the same trial based on asserting the same facts and submitting the same evidence regarding the eligibility as a demandant ((1942 (O) 187), Judgment of the Supreme Court, Nov 10, 1942, “A device that makes contact between liquid and gas”).

7. Prohibition of Double Jeopardy for Hantei (Advisory Opinion)

Prohibition of double jeopardy does not apply to Hantei (advisory opinion) (\rightarrow 58-03 1.(6)).

8. Prohibition of Double Jeopardy for Opposition to Grant of Patent (Registration of Trademark)

Prohibition of double jeopardy does not apply to an opposition to grant of patent (registration of trademark).

9. Handling of an Invalidation Trial Case That Is Demanded More Than Once

In view of perspective of good faith, it is inappropriate to require a determination different from that of the previous trial decision based on almost the same reason for invalidation. Therefore, in order for a panel to avoid making a determination that is contradictory to the previous decision, the panel takes into account the result of the previous trial decision to conduct a trial the conclusion of which can be drawn by almost the same logical composition as the previous trial decision, even in a case where it cannot be said that the trial should be treated as double jeopardy (for example, there is a demand for invalidation trial with the same reasons for invalidation before the previous trial decision becomes final and binding, or there is a demand for invalidation trial with almost the same reasons for invalidation after the previous trial decision becomes final and binding). In that case, it is desirable to direct the proceedings so that it can be conducted efficiently in consideration of the burden of the parties concerned such as conducting documentary proceedings instead of oral proceedings.

As for a trial case filed before the decision of the previous trial case becomes final and binding, there is a court precedent based on the principle of good faith (2017 (Gyo-Ke) 10153, Judgment of the IP High Court, June 19, 2018, “Plated steel sheet for hot press”), which explains as follows: regarding the assertion already made by the plaintiff as a reason for invalidation in the previous trial case and dismissed in the prior trial decision and the prior litigation judgment, the effect of the Patent Act Article 167 does not reach to the invalidation trial in this case since the demand for the invalidation trial in this case was filed before the decision of the previous trial case (the previous litigation) became final and binding; however, it is unacceptable in

such a case to take advantage of this situation to make the same assertion as in the previous trial case as a reason for rescinding the trial decision in this case because it is substantially a rehash of the previous case and violates the principle of good faith in litigation.

When a reason for demand for the trial in this case changes in gist from the reason for the demand determined by the previous final and binding trial decision (→ 51-16), it does not raise a problem of good faith since it does not rehash the allegation and proof presented in the previous trial that have been made and shown thoroughly.

Court Precedents Involving the Same Facts and the Same Evidence

| Content | Related Item |
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| <p>① 2013 (Gyo-Ke) 10226, Judgment of the IP High Court, March 13, 2014, “KAMUI”</p> <p>It is reasonable to interpret that “the same facts” in the course of requesting a trial for invalidation means the allegations concerning the same grounds for invalidation and that “the same evidence” means the same evidence in substance to prove said allegations. It should be interpreted that, as far as the evidence is submitted to prove the same allegations (the same subject matters of proof), the use of different methods of proof does not necessarily provide reasons for denying the identicalness of evidence in substance. Such interpretation would be perfectly in line with the purpose of the amendment of Article 167 of the Patent Act by Act No. 63 of 2011, i.e., an amendment to abolish the third-party effect of a final and binding JPO decision and to achieve resolution of a dispute by one-time trial between the parties concerned (including interveners).</p> | 3. (2) |
| <p>② 2005 (Gyo-Ke) 10467, Judgment of the IP High Court, April 11, 2006, “Packaging”</p> <p>In a demand for trial of the case, a plaintiff’s allegation is based on “the same facts” as the finalized previous trial decision, but it does not violate the Patent Act Article 167 only when the allegation is based on the new evidence. The new evidence herein means the evidence for proving a reason for invalidation of a defendant’s patent and for being substantially different from the evidence submitted to the previous demand for trial. . . . However, a plaintiff alleges that Exhibit A Nos. 8~10 is</p> | 3. (2) |

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| <p>submitted to indicate and prove an error in the previous trial decision but not to prove a description of the method for producing the product in the plaintiff's patent specification. . . . Originally, the evidence to prove a reason rescinding a trial decision should be submitted in the litigation where a reason for rescission against the trial decision is filed. It is considered unacceptable in view of the purport of the Patent Act Article 167, after the trial decision is final and binding, a demandant (plaintiff) of the previous demand for trial files a demand for trial for the same patent again and submits the evidence to prove a reason for rescission of the trial decision already finalized.</p> | |
| <p>③ 2003 (Gyo-Ke) 43, Judgment of the Tokyo High Court, March 23, 2004 “Process and device for gluing and soldering a metallic catalyst carrier”</p> <p>Considering that a demand for invalidation trial is filed based on the same evidence as the previous demand for invalidation trial, the issues at which the assertion of the trial demandant (plaintiff) was rejected in the previous invalidation trial is ‘easily arriving at Constituent C of the present invention’ in comparison with the publicly known art deriving from Exhibit A Nos. 1~3. The trial decision found the facts ‘when adhering two members together, it is commonly used not only to persons skilled in the art but also to the public that they may adhere partially on the arbitrarily shaped adhesive region if necessary.’ No error can be found in this finding. In the previous invalidation trial, it also becomes subject of the proceedings whether the invention includes the common general art which should be considered in the comparison, and then it should be found that it is examined and judged whether the invention could be easily speculated from</p> | 3. (2) |

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| <p>the publicly known art. The result of the proceedings is also determined on the ground that such common general knowledge has no evidence to be proved. Therefore, there is no error in the determination where it is not allowed to submit evidence for proving the above common general knowledge to the subsequent trial based on said same facts, and Exhibit A Nos. 5 and 6 cannot be approved as new evidence since they merely prove the above common technical knowledge.</p> | |
| <p>④ 2015 (Gyo-Ke) 10260, Judgment of the IP High Court, Sept. 28, 2016, “Rotary disc tumbler lock and key”</p> <p>A. The purpose of Patent Act Article 167 is considered to have the effect of prohibition of double jeopardy on the parties and intervenors in order to promote one-time dispute resolution in a trial for patent invalidation so that there will be neither the situation where multiple different determinations are made in relation to the validity of a patent right, which is an exclusive right, (Article 68 of the Patent Act) nor resurrection of a dispute.</p> <p>The parties and intervenors in the previous trial for patent invalidation made allegations and submitted evidence in relation to the existence of grounds for invalidation in the procedures of said trial and were also given an opportunity to make allegations and submit evidence in relation to the existence of grounds for rescission of the JPO decision on the previous trial for patent invalidation in legal proceedings if an action to seek rescission of said JPO decision is instituted. Therefore, it is not reasonable to understand the “same facts and evidence” in a narrow sense, from the perspective of preventing the resurrection of a dispute.</p> <p>B. In this regard, in Article 167 of the Patent Act prior to amendment by Act No. 63 of 2011, the scope to which the double</p> | <p>3. (1),(2)</p> |

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| <p>jeopardy prohibition effect extends was provided as “anyone,” and the provisions of said Article also restricted the right to file a request for a trial of third parties who have not participated at all in the previous trial. Therefore, it can be said that regarding third parties, it was problematic to interpret the meaning of the “same facts and evidence” in an expansive manner. However, the third-party effect was abolished through the aforementioned amendment, and the scope to which the double jeopardy prohibition effect extends was limited to the parties and intervenors who have participated in the procedures of the previous trial and could do their best for allegation and proof. Therefore, it is reasonable to interpret the meaning of the “same facts and evidence” with more emphasis on the purpose, i.e., promoting one-time dispute resolution in a trial for patent invalidation, as mentioned in A. above.</p> | |
| <p>⑤ 2014 (Gyo-Ke) 10235, Judgment of IP High Court, Aug. 26, 2015, “Detergent composition”</p> <p>In order to allege that any person ordinarily skilled in the art could easily conceive of a patented invention based on publicly known art as of the time of the filing of the application, it is necessary to make a comparison between the patented invention and the invention (the primarily cited invention) presented in the cited document (the primarily cited document) chosen for the purpose of comparison and find the common features and differences between them, and then prove that any person ordinarily skilled in the art could easily conceive of the idea of combining the primarily cited invention and other publicly known art or well-known art and thereby combine the primarily cited invention and the structures of such publicly known art or well-</p> | <p>3. (1),(2)</p> |

known art that constitute the differences. If a different invention is chosen as the primarily cited invention presented in the primarily cited document, which is chosen for the purpose of comparison with the patented invention, different common features and differences would be found between the patented invention and the newly chosen primarily cited invention. As a result, the determination as to whether any person ordinarily skilled in the art could easily conceive of the aforementioned idea would change accordingly. Therefore, if a different invention is chosen as the primarily cited invention, different grounds for invalidation would naturally be alleged.

(omission)

Furthermore, since the primarily cited document is merely required to present publicly known art as of the time of the filing of the application, it is clear that Exhibit No. 1 Document, which presents well-known art as of the time of the filing of the application in this case, could be chosen as the primarily cited document. There are no reasons to consider that Exhibit No. 1 Document cannot be chosen as the primarily cited document. Moreover, even if there is no change in the primarily cited invention, if there is any substantive change in the publicly known art or well-known art chosen for the purpose of combining it with the primarily cited invention, it would result in a change in the specific logical composition adopted to make a determination as to whether any person ordinarily skilled in the art could easily conceive of the invention. As a result, different grounds for invalidation would be alleged.

Therefore, it should be considered that different grounds for invalidation would be alleged both in the case where a different

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| invention is chosen as the primarily cited invention presented in the primarily cited document for the purpose of comparison with the patented invention and in the case where there is no change in the primarily cited invention but different publicly known art or well-known art is chosen for the purpose of combining it with the primarily cited invention. These two cases cannot be considered to be the cases where a trial is requested based on the “same facts and evidence” specified in Article 167 of the Patent Act. | |
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(Revised March 2023)