

**30-02 P U D T**  
**Prohibition of Double Jeopardy**

1. Prohibition of Double Jeopardy

When the following final and conclusive trial decisions have been registered (Enforcement Regulations of the Patent Registration Order Article 37, Enforcement Regulations of the Utility Model Registration Order Article 3(3), Enforcement Regulations of the Design Registration Order Article 6(4), Enforcement Regulations of the Trademark Registration Order Article 16-2), a party concerned and an intervener may not file the such trial (hereinafter referred to as “the same trial” in this section 30-02) based on the same facts and evidence (the Patent Act Article 167, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

- (1) A final and conclusive invalidation trial decision
- (2) A final and conclusive trial decision for invalidation of a registration of extension of duration
- (3) A final and conclusive trial decision for rescission of a registered trademark (the Trademark Act Article 56)

The reason for providing this provision is to prevent from providing two or more conflicting final and conclusive trial decisions based on the same facts and the same evidence, and at the same time to avoid excessive or unreasonable legal litigation for escaping 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 conclusive trial decision.

However, it is not appropriate that the final and conclusive trial decision is effective even on a person who is not related to the trial as a result of

comparison with judicial precedents in civil litigation, therefore, the third party may demand the trial based on the same facts and the same evidence.

The same trial may be demanded again even by the same demandant if the is not based on the same facts or evidence (Note 1).

## 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 facts alleged as reasons for invalidation or rescission are the same in a trial for invalidation or a trial for rescission (Notes 2, 3).

For example, when a final and conclusive 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 (Note 4).

### (2) Same evidence

Same evidence herein means evidence having identity.

Accordingly, when evidence itself is different but a content of evidence is substantially same, it should be considered that they are the same evidence (Notes 5, 9).

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 (Note 2).

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 (Reference 1, 2).

(Reference 1) Judgment of the IP High Court, April 11, 2006 (2005 (Gyo-Ke) 10467, Invalidation (Mukou) 2004-80180)

“In the demand for trial, a plaintiff’s assertion is based on “the same facts” as the previous and final trial decision, but it does not violate the Patent Act Article 167. This is limited to the case where his/her assertion 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 asserts that Exhibit A Nos. 8 ~10 are 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 for proving a reason rescinding a trial decision shall be submitted in the litigation where a reason for rescission against the trial decision is filed. It is understood that it is not allowed in view of the purport of the Patent Act Article 167, after the trial decision is final and conclusive, a demandant 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 finalized trial decision.”

(Reference 2) Judgment of the Tokyo High Court, April 11, 2004 (2003 (Gyo-Ke) 43, Invalidation (Mukou) 2004-80180)

“Considering that the demand for invalidation trial is filed based on the same evidence as the previous demand for invalidation trial, the issue at which the assertion of the trial demandant was dismissed in the previous invalidation trial is ‘easily arriving at Constituent C of the present invention’

in comparison with the publicly known art deriving from Evidence 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 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 judgment 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.”

#### 4. Application to Co-Pending Other Trial Case

The purport of the provision of the Patent Act Article 167 is when a trial decision to the effect that a demand for invalidation trial is considered groundless (the demand is groundless by trial decision) becomes final and conclusive and registered accordingly, it is not allowed after the registration to newly demand for an invalidation trial based on the same facts and evidence as the above invalidation trial demand. Thus, the provision of the Patent Act Article 167 shall not apply to a demand for invalidation trial which has been already pending at the time of registration of a final and conclusive decision in which the demand is groundless (in a case where the registration is after April, 1, 2012, at the time of a trial decision) (Note 6).

#### 5. Cases Where Final and Conclusive Trial Decision Is a Decision of

## Dismissal

The provision of the Patent Act Article 167 shall 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 (→1.). Therefore, in a case where a demand for trial is excluded (dismissed) for other reasons such as being filed a demand by a person who is not a party concerned, there is a court case that should be understood the provision indicated above shall not be applied (Note 7).

## 6. Eligibility of the Demandant and Prohibition of Double Jeopardy

When a registration of a final and conclusive trial decision to dismiss a demand for trial for the reason that a demandant is not an interested person as required for eligibility of the demandant, there is a court case that the same trial shall not be filed by asserting the same facts and submitting the same evidence by a person who is not eligible for a demandant regarding an interest (Note 8).

## 7. Prohibition of Double Jeopardy for Advisory Opinion

Prohibition of double jeopardy shall not apply to an advisory opinion (→ 58-03 1.(5)).

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

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

(Note)

1. Judgment of the Tokyo High Court, 1965 (Gyo-Ke) 64, July 20, 1973, Casebook for a suit rescinding a trial decision 1973, p111, Collection of civil/administrative litigation cases related to intangible property rights Vol. 5 No. 2, p233.
2. Judgment of the Tokyo High Court, 1964 (Gyo-Ke) 161, June 28, 1969, Casebook for a suit rescinding a trial decision 1969, p393.
3. Judgment of the Tokyo High Court, 1971 (Gyo-Ke) 128, Feb 28, 1979.
4. Trial Decision No. 3304, Apr 2, 1970, Collection for reference trial/court decisions Vol. 2, p281.
5. Judgment of the Supreme Court, 1919 (O) 184, Dec 24, 1920, Supreme Court Civil judgment record Vol. 26, p.1534.
6. Judgment of the Supreme Court, 1<sup>st</sup> Petty Bench, 1995 (Gyo-Tsu) 105, Jan 27, 2000.
7. Judgment of the Supreme Court, 1930 (O) 693, Dec 24, 1930, The Legal News, Vol. 3220, p9
8. Judgment of the Supreme Court, 1942 (O) 187, Nov 10, 1942, The Legal News, Vol. 3220, p9, Collection for judicial precedents of civil cases at the Supreme Court, Vol. 21, No. 19, p1025.
9. Judgment of the IP High Court, 2013 (Gyo-ke) 10226, Mar 13, 2013.

(Revised June 2019)