

Trial decision

Invalidation No. 2014-800187

Chiba, Japan Demandant	SASAKI, Tsutomu
Attorney	FUKUOKA, Hideya
Tochigi, Japan Demandee	OGAWA, Osamu
Attorney	SAWADA, Yuji
Attorney	NITTA, Yuko
Attorney	EBIHARA, Hikaru
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The decision on the case of the patent invalidation trial between the above parties on Japanese Patent No. 4958194, entitled "METHOD FOR PRODUCING JET NOZZLE PIPE, AND THE JET NOZZLE PIPE PRODUCED BY THE SAME", dated September 25, 2015 came with a court decision of revocation of the trial decision (2015 (Gyo-Ke) 10230, rendition of decision on January 25, 2017) on the inventions according to Claims 1 and 3 at the Intellectual Property High Court, the case was proceeded further on the invention according to the claims corresponding to the revocation, and another trial decision was handed down as follows.

Conclusion

The patent regarding the inventions according to Claims 1 and 3 of Japanese Patent No. 4958194 was invalidated.

The demand for trial regarding the invention according to Claim 2 of Japanese Patent No. 4958194 is groundless.

1/3 of the costs in connection with the trial shall be borne by the demandant and 2/3 shall be borne by the demandee.

Reason

No. 1 History of the procedures

1 The history before the trial decision as of September 25, 2015 (hereinafter referred to as "the First trial decision")

The application for the inventions according to Claims 1 to 3 (hereinafter referred to as "Invention 1" to "Invention 3") of Japanese Patent No. 4958194 hereinafter referred to as "the Patent") was filed on June 8, 2011, and the establishment of patent right was registered on March 30, 2012.

A trial for invalidation of the patent regarding the invention according to the Inventions 1 to 3 was demanded by the demandant as of November 14, 2014 (sent on November 17, 2014), an order regarding inaccuracies in the formality was made by a written order for amendment (formality) as of December 11, 2014, and a written amendment (formality), a written request for the examination of a witness, and a statement of matters for examination were submitted by the demandant as of January 14, 2015.

An invitation to reply was made as of January 20, 2015. A written reply for the trial case (hereinafter also referred to as "written reply") sent on March 23, 2015 was submitted by the demandee.

Notification of matters to be examined were notified as of May 11, 2015. A written statement was submitted by the demandee as of May 24, 2015 (sent on May 25, 2015). An oral proceedings statement brief was submitted by the demandee as of June 15, 2015. An oral proceeding statement brief was sent and submitted by the demandant on June 22, 2015.

The first oral proceeding and examination of evidence were conducted on July 6, 2015. A written statement was submitted by the demandant as of July 14, 2015. A written statement was submitted by the demandee as of July 21, 2015. The trial decision, "The demand for trial of the case was groundless. The costs in connection with the trial shall be borne by the demandant", was made as of September 25, 2015.

2 History after the First trial decision

The demandant brought an action for revocation of the trial decision against the First trial decision on October 29, 2015. As a result of examination at the Intellectual Property High Court as case 2015 (Gyo-Ke) 10230, a decision to cancel the part of the First trial decision relating to Claims 1 and 3 of Japanese Patent No. 4958194 (hereinafter referred to as "the Decision") was rendered on January 25, 2017. Petition for Acceptance of Final Appeal was made by the demandee (2017 (Gyo-No) 10003) on February 9, 2017. As a result of examination at Japanese Supreme Court Decision First Petty Bench as case 2017 (Gyo-Hi) 181, the decision that the case shall not be received as final appeal proceedings was made on November 16, 2017. As a result of further examination, an advance notice of a trial decision (hereinafter referred to as "the Advance notice") was made by the body as of January 23, 2018.

A description of evidence was submitted by the demandee as of February 20, 2018 (sent on February 21, 2018), and a written statement (1) was submitted as of February 23, 2018 (received on February 26, 2018). A written statement (2) and a description of evidence were submitted by the demandee as of March 29, 2018 (sent on March 30, 2018). Conclusion of trial proceedings was notified by the body as of May 18, 2018. A petition to resume the proceedings was made by the demandee as of May 24, 2018.

No. 2 The Invention

Inventions 1 to 3 of the Patent are as follows which are specified by the matters described in Claims 1 to 3 of the scope of claims, as viewed from the matters described in the specification, the scope of claims, and drawings attached to the application (hereinafter referred to as "the Patent specification").

"[Claim 1]

A method of producing a jet nozzle pipe including a valve function from a nozzle pipe body produced by a thermoplastic synthetic resin material including:

a step of inserting and disposing a needle material having a predetermined radial width into a hollow part of the nozzle pipe body;

a step of softening a predetermined position of the nozzle pipe body by a predetermined length by heating;

a step of pushing in the nozzle pipe body from both longitudinal end sides thereof while holding the heated and softened part of the nozzle pipe body such that the outside diameter of the nozzle pipe body does not change;

a step of cooling the heated portion for curing; and

a step of pulling out the needle material after curing.

[Claim 2]

A method of producing a jet nozzle pipe including a valve function from a nozzle pipe body produced by a thermoplastic synthetic resin material including:

a step of inserting and disposing a needle material having a predetermined radial width into a hollow part of the nozzle pipe body;

a step of fitting a heat-shrinkable tube of a predetermined length in a predetermined position on an outer periphery of the nozzle pipe body;

a step of heating the portion where the heat-shrinkable tube is fitted to soften the nozzle pipe body, and shrinking the heat-shrinkable tube;

a step of cooling the heated portion for curing; and

a step of pulling out the needle material after curing.

[Claim 3]

A jet nozzle pipe produced by the method described in Claim 1 or Claim 2, the jet nozzle pipe including a valve with a through-hole having a diameter smaller than the inside diameter of the nozzle pipe body, arranged in the hollow part of the nozzle pipe body."

No. 3 The demandant's allegation

1 Outline of the demandant's allegation

The Patent was registered under the name of the demandee even though Inventions 1 to 3 were invented by the demandant, so the Patent falls under Article 123(1)(vi) of the Patent Act and should be invalidated (Written demand for trial p.2 l. 15-l. 17).

2 Means of proof

(1) Documentary evidence

Evidence A No. 1: Email as of March 1, 2011

Evidence A No. 2: File of thermo-forming_GateForming (file attached to the Email of Evidence A No.1)

Evidence A No. 3: File of the figure of heating thermoplastic resin tube (file attached to the Email of Evidence A No. 1)

Evidence A No. 4: File of the example of nozzle machining (file attached to the Email of Evidence A No. 1)

Evidence A No. 5: Email as of March 4, 2011

Evidence A No. 6: File of NozzleDesignChart (file attached to the Email of Evidence A No. 5)

Evidence A No. 7: File of the relation with the specifications for gate diameter (file attached to the Email of Evidence A No. 5)
 Evidence A No. 8: Email as of March 4, 2011
 Evidence A No. 9: File of Gate_Nozzle_End forming 01-05 (File attached to the Email of Evidence A No. 8)
 Evidence A No. 10: Email as of March 4, 2011
 Evidence A No. 11: File of Gate_Nozzle_End forming 06-10 (File attached to the Email of Evidence A No. 10)
 Evidence A No. 12: Email as of March 4, 2011
 Evidence A No. 13: File of Gate_Nozzle_End forming 11-12 (File attached to the Email of Evidence A No. 12)
 Evidence A No. 14: File of gate forming process (file attached to the Email of Evidence A No. 12)
 Evidence A No. 15: Email as of March 8, 2011
 Evidence A No. 16: File of gate forming process (file attached to the Email of Evidence A No. 15)
 Evidence A No. 17: File of gate forming process_1 (file attached to the Email of Evidence A No. 15)
 Evidence A No. 18: File of Gate_Nozzle_End forming process (file attached to the Email of Evidence A No. 15)
 Evidence A No. 19: Email as of March 16, 2011
 Evidence A No. 20: File regarding stereoscopic view of gate nozzle (file attached to the Email of Evidence A No. 19)
 Evidence A No. 21: Email as of April 1, 2011
 Evidence A No. 22: File regarding spray-can/nozzle characteristic test (file attached to the Email of Evidence A No. 21)
 Evidence A No. 23: Application document of the patent
 Evidence A No. 24: Written amendment
 Evidence A No. 25: Patent publication
 Evidence A No. 26: Email as of October 6, 2010
 Evidence A No. 27: Email as of October 10, 2010
 Evidence A No. 28: Shooting report
 Evidence A No. 29: Shipping slip
 1 to 5 of Evidence A No. 30: Design drawing of nozzle manufacturing machine
 Evidence A No. 31: Graphic description of nozzle manufacturing machine
 1 and 2 of Evidence A No. 32: 3-dimensional figure of nozzle manufacturing machine

(2) Examination of witness

Demandant

Name Tsutomu SASAKI

No. 4 The demandee's allegation

1 Outline of the demandee's allegation

Inventions 1 to 3 were invented and completed definitely by the demandee before the application of the Patent. The demandant is only related as an assistant in the development stage. The application of the Patent do not fall under the usurped application alleged as the reasons for invalidation (Written reply p. 20 l. 15-l. 18).

2 Means of proof

(1) Documentary evidence

Evidence B No. 1: Facsimile as of September 3, 2013

Evidence B No. 2: Content-certified mail as of September 3, 2013

Evidence B No. 3: Content-certified mail as of September 24, 2014

Evidence B No. 4: Patent register

Evidence B No. 5: Documentary evidence of Hideki KURAMOCHI

Evidence B No. 6-1: Documentary evidence of Nobuo FUKUDA, a patent attorney

Evidence B No. 6-1-1: Picture of the patent file accepted by the patent attorney of the patent application (front)

Evidence B No. 6-1-2: Picture of the patent file accepted by the patent attorney of the patent application (back)

Evidence B No. 6-2: Documentary evidence of the patent attorney Nobuo FUKUDA

Evidence B No. 6-2-1: Picture of a note (front) of the patent attorney Nobuo FUKUDA at the time of undertaking the case

Evidence B No. 6-2-2: Picture of a note (back) of the patent attorney Nobuo FUKUDA at the time of undertaking the case

Evidence B No. 7: Articles of Incorporation of Japan integrated works Co., Ltd.

Evidence B No. 8: Certificate of full registry records of Japan integrated works Co., Ltd.

Evidence B No. 9: Evidence (Evidence A No. 8) submitted by the demandant on the case of trial regarding Invalidation No. 2014-800186

Evidence B No. 10: Notebook of the demandee

Evidence B No. 11: "Document of records on statements of witnesses, etc." in the case of the invalidation No. 2014-800186

Evidence B No. 12: Experimental data

Evidence B No. 13: Email sent by the demandee to Hideki KURAMOCHI

Evidence B No. 14: Email sent by the demandee to Hideki KURAMOCHI

Evidence B No. 15-1: Email from the demandee to a corporate executive of Japan integrated works, Co., Ltd.

Evidence B No. 15-2: Picture of a push button described in the Email of the Evidence B No. 15-1

Evidence B No. 16-1: Documentary evidence of the patent attorney Nobuo FUKUDA

Evidence B No. 16-1-1: Related materials of drawings created by the patent attorney Nobuo FUKUDA

Evidence B No. 17: Notices and replies or the like from the attorney of the demandee to the attorney of the demandant

Evidence B No. 18: Email sent as of June 3, 2011 from the demandee to the demandant

Evidence B No. 20-1: Copy of the original of a note (front) of the patent attorney Nobuo FUKUDA at the time of undertaking the case

Evidence B No. 20-2: Copy of the original of a note (back) of the patent attorney Nobuo FUKUDA at the time of undertaking the case

Evidence B No. 21: Transcription document

Evidence B No. 22: Structural drawing of a pilot jet

Evidence B No. 23: Result of an exhaust gas smoke test of diesel vehicle

Evidence B No. 24: Specifications

Evidence B No. 25: Email (December 25, 2009)

Evidence B No. 26: Email (as of April 6, 2010)
 Evidence B No. 27: Commitment form (as of January 11, 2016)
 Evidence B No. 28: Email (April 12, 2010)
 Evidence B No. 29: Commitment form (January 9, 2016)
 Evidence B No. 30: Email (September 15, 2010)
 Evidence B No. 31-1: Email (September 28, 2010)
 Evidence B No. 31-2: Email (September 28, 2010)
 Evidence B No. 32-1: Notebook
 Evidence B No. 32-2: Method of machining a nozzle pipe using pliers
 Evidence B No. 33-1: Regarding experiment demonstrating patent invention
 Evidence B No. 33-2: DVD-R (video of Empirical Testing of Fact)
 Evidence B No. 34-1: Email (May 18, 2011)
 Evidence B No. 34-2: Quotation
 Evidence B No. 35: Web page of HAGITEC CO., LTD.
 Evidence B No. 36: Data of spreadsheet program "Excel" manufactured by Microsoft regarding the data name "Nozzle design Chart.xls" of Evidence A No. 6"
 Evidence B No. 37-1: Notarial deed for empirical testing of fact
 Evidence B No. 37-2: DVD-R
 Evidence B No. 37-3: same as above
 Evidence B No. 37-4: CD-R
 Evidence B No. 38: Notebook
 Evidence B No. 39: Picture
 Evidence B No. 40: Written statement
 Evidence B No. 41: Note (November 24, 2017)
 Evidence B No. 42: Email (December 20, 2017)
 Evidence B No. 43: Email (June 13, 2012)
 Evidence B No. 44: CD-R (June 10, 2012)
 Evidence B No. 45: CD-R (July 28, 2012)
 Evidence B No. 46: Notebook
 Evidence B No. 47: Notebook
 Evidence B No. 48: Transcription document
 Evidence B No. 49: Transcription document
 Evidence B No. 50: Publication of Unexamined Patent Application (August 14, 2014)
 Evidence B No. 51: Commitment form and notebook
 Evidence B No. 52: Email (November 18, 2006 to November 5, 2012)
 Evidence B No. 53: Written amendment (formality)
 Evidence B No. 54: Notebook
 Evidence B No. 55: Notice (November 29, 2012)
 Evidence B No. 56: Notice (May 15, 2013)
 Evidence B No. 57: Note (February 24, 2017)
 Evidence B No. 58: Drawings for quotation
 Evidence B No. 59: Article in the magazine "Auto-Mechanic" (attached to the email created by Satoru KATSUTA as of January 11, 2011)
 Evidence B No. 60: Notebook and picture (calendar)
 Evidence B No. 61: Explanatory journal
 Evidence B No. 62: Reproduction report on creating a test nozzle
 Evidence B No. 63-1: Report of verification experiment (the case of heating a pipe end)

Evidence B No. 63-2: Report of verification experiment (the case of heating a central part of the pipe)

Evidence B No. 64: Written statement (May 17, 2016)

Evidence B No. 65: Written statement (May 17, 2016)

Evidences B No. 21 to No. 40 were attached to the description of evidence as of February 20, 2018 (sent by February 21, 2018). Evidences B No. 41 to B No. 65 were attached to the description of evidence as of March 29, 2018.

(2) Reference material

Evidence B No. 19: Email as of April 5, 2010.

No. 5 Judgment by the body

The Decision was made as follows, "As in the present case, in an invalidation trial demanded on the ground of a usurped application (Article 123(1)(vi) of the Patent Act before revision by the Act No. 63 of 2011), it is reasonable that the Patentee should bear the burden of proving the allegation for the fact that "a patent application was filed by an inventor of the Invention or those who had succeeded a right to obtain a patent from the inventor". Of course, such interpretation does not mean that the Patentee must prove the allegation, in all cases, individually and concretely about the background of the invention, or the like, in detail. Considering that prior application has some level of significance for assuming that the applicant is the inventor or a person who had succeeded a right to obtain a patent from the inventor, it should be said that the content and the degree of Patentee's argument and establishment may vary depending on the content of specific circumstances suggestive of usurped application or the content and the degree of the argument and establishment activity of the demandant of the trial for invalidation. Thus, when the demandant of the trial for invalidation does not specify any specific circumstances suggestive of usurped application and does not submit any evidence for the usurped application, the degree of Patentee's argument or establishment may be comparatively simple. When the demandant of the trial for invalidation specifies specific circumstances suggestive of usurped application and submits evidence, for the usurped application, it is not considered that the argument and establishment has been completed unless the Patentee surpasses that. In light of the above, in determining the presence of reasons for revocation (errors of finding of the inventor), on the premise that the defendant (Note by the body: "demandee"), who is the Patentee, should bear the burden of proving the allegation that the Inventions were invented by the defendant, we will examine first how specifically the plaintiff (Note by the body: "demandant"), who alleges usurped application, alleges the circumstances suggestive of usurped application (or the circumstances that the Inventions were invented not by the defendant but by the plaintiff), and whether or not evidences for the usurped application have been submitted, and then examine whether the defendant surpasses the plaintiff's argument and establishment and has proved the allegation sufficiently for recognizing that the defendant is the inventor." (Written court decision p. 28 l. 10-p. 29 l. 10)

Regarding the plaintiff's argument and establishment, the court held that "According to the above examination, as for Invention 1 (and the portion in Invention 3 relating to the method of Invention 1), it can be said that the plaintiff alleges the specific circumstances indicating that the plaintiff is the inventor (or the specific circumstances

suggestive of usurped application) and has submitted evidences therefor. Regarding Invention 2 (and the portion in Invention 3 relating to the method of Invention 2), the plaintiff does not allege the specific circumstances indicating that the plaintiff is the inventor and has submitted no evidence therefor. According to the fact that the plaintiff gives no explanation about the circumstances indicating that the plaintiff is the inventor for Invention 2, while specifically explaining (could explain) the circumstances for Invention 1, it can be said that we positively doubt that Invention 2 was invented by the plaintiff." (Written court decision p. 35 l. 19-p.36 l.3)

Regarding the defendant's argument and establishment, as for Invention 1, the court held that "According to the above examination, it can be said that there is no sufficient evidence in the defendant's allegation that Invention 1 was completed by the defendant. It cannot be said that the defendant surpasses the plaintiff's argument and establishment for the fact that Invention 1 was invented not by the plaintiff but by the defendant." (Written court decision p. 43 l.26-p.44 l. 4) As for Invention 2, it is held that "Thus, since the defendant alleges specific circumstances for the fact that the defendant has conceived the method of Invention 2 and materialized it and has submitted a certain evidence therefor, it can be said that the defendant has proved the allegation satisfying the above degree of establishment and argument." (Written court decision p. 45 l.5-p. 45 l.8) As for Invention 3, it is held that "Invention 3 is an invention for both jet nozzle pipes, a jet nozzle pipe having a gate structure manufactured by the method of Invention 1 and a similar jet nozzle pipe manufactured by the method of Invention 2. Therefore, it cannot be said that the defendant has proved the allegation sufficiently for recognizing that the defendant is the inventor, for the entirety of Invention 3 to be specified by Claim 3." (Written court decision p. 45 l. 14-p. 45 l. 18)

The Decision was made as follows, "In view of the above examination, it can be recognized that Invention 2 of the Inventions was invented by the defendant, while it cannot be recognized that Invention 1 and Invention 3 were invented by the defendant." (Written court decision p. 45 l. 19-p.45 l. 21)

Under the provisions of Article 33(1) of the Administrative Case Litigation Act, the re-examination of the case is bound in the court decision of cancellation. This binding power lies in the findings and legal judgments necessary for deriving the main text of court decision. Therefore, in the re-examination, the parties are not allowed to repeat the same allegation as the existing one that the recognition and determination in the grounds for judgment bound in the Decision is an error or to establish a new fact for proving the allegation.

The demandee alleges that the recognition and determination in the Decision is an error and submitted, as a new establishment of fact for proving the allegation, written statement (1), written statement (2), and Evidences B No. 21 to B No. 65 after the Advance notice. The argument and establishment, which have already been made in the trial proceedings relating to the First trial decision and the suit against trial decision, or could have been made, or which repeat the same allegation as the existing one, cannot be accepted by the binding power.

In light of the above, the body determines that, in accordance with the Decision, it can be recognized that the demandee was the inventor of Invention 2 of the Inventions, while it cannot be recognized that the demandee was the inventor of Inventions 1 and 3.

It also cannot be recognized that the demandee has succeeded a right to obtain a patent from the inventor for Inventions 1 and 3.

The patent regarding Inventions 1 and 3 were granted for an application applied by a person who was not the inventor and did not succeed a right to obtain a patent. Therefore, the Patent falls under Article 123(1)(vi) of the Patent Act before revision by the Act No. 63 of 2011, and should be invalidated.

As per the decision, the patent regarding Invention 2, which was invented by the demandee, cannot be invalidated.

1/3 of the costs in connection with the trial shall be borne by the demandant and 2/3 shall be borne by the demandee under the provisions of Article 64 of the Code of Civil Procedure which is applied mutatis mutandis in the provisions of Article 169(2) of the Patent Act.

Therefore, the trial decision shall be made as described in the conclusion.

The demandee submitted a written motion for resumption of trial as of May 24, 2018 (sent on May 25, 2018). The body made an advance notice of a trial decision as of January 23, 2018. Since the demandee did not make a correction request within a designated period, the body made a notice of conclusion of trial proceedings under the provision of Article 156(2) of the Patent Act. The body carefully examined the necessity of resumption of trial, and does not recognize the necessity.

June 11, 2018

Chief administrative judge:	TOMIOKA, Kazuto
Administrative judge:	KANAZAWA, Toshiro
Administrative judge:	SASAKI, Yoshie