Trial decision

Invalidation No. 2017-800055

Tokyo, Japan
Demandant WINGSENSE CO., LTD

Tokyo, Japan
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Osaka, Japan
Demandee MEDION RESEARCH LABORATORIES INC.

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The case of trial regarding the invalidation of Japanese Patent No. 4912492 entitled "VISCOUS COMPOSITIONS CONTAINING CARBON DIOXIDE," between the parties above, has resulted in the following trial decision.

Conclusion

The demand for trial of the case is dismissed.

The costs in connection with the trial shall be borne by the demandant.

Reason

No. 1 Object of the demand

The demandant seeks a trial decision to the effect that the patent for the invention according to Claims 1 through 5 and Claim 7 of Patent No. 4912492 shall be invalidated, and the costs in connection with the trial shall be borne by the demandee.

No. 2 History of the procedures, etc.

1. In regards to the invention entitled "VISCOUS COMPOSITIONS CONTAINING CARBON DIOXIDE," the demandee filed a divisional patent application based on a

patent application with the international filing date of October 5, 1998 (Japanese Patent Application No. 2000-520135; priority claimed on the basis of earlier application: November 7, 1997). Incidentally, in the divisional patent application, the applicant was indicated as Medion Research Laboratories (hereinafter referred to as "Medion") and the inventors were indicated as Masaya Tanaka (hereinafter referred to as "Tanaka") and Masato Hioki.
2. The present divisional application was granted registration as Patent No. 4912492 (having seven Claims). On January 27, 2012, the establishment of the patent was registered, with Medion as the patent holder.
3. On April 21, 2017, the demandant Wingsense Co., Ltd. (hereinafter sometimes referred to as "Wingsense") filed a request for a patent invalidation trial for the invention according to Claims 1 through 5 and Claim 7 of Patent No. 4912492 (hereinafter referred to as "the Patent").
4. On May 29, 2017, the chief trial examiner for the case conducted a hearing with the demandant in order to confirm the contents of allegations of the written request, and the demandant submitted a written response, dated June 1 of the same year, for the hearing.

No. 3 The demandant's allegations
1. Principal allegation

The invention for the Patent (hereinafter referred to as "the Invention") was completed by Tanaka and Hideya Sakata (hereinafter referred to as "Sakata") as an employee invention during their employment at Kanebo, Ltd. (hereinafter referred to as "the Company"). As such, pursuant to the Company's regulations on employee inventions, the Company holds the right for the Patent.

Accordingly, the filing of the application for the Patent by Medion constitutes usurpation, and the Patent falls under the case described in Article 123, paragraph (1), item (vi) of the Patent Act (hereinafter simply referred to as "the Act").
2. Preliminary allegation

Even if the Invention does not fall under the Company's employee invention, at least Sakata, who is one of the inventors of the Invention, did not transfer to Medion the right to be granted the Patent.

Furthermore, since the right to be granted a patent belongs to Sakata and Tanaka, the filing of the application for the Patent by Medion constitutes usurpation, and thus the Patent falls under the case described in Article 123, paragraph (1), item (vi) of the Act.

Or, since the right to be granted a patent belongs to Sakata as well as to Medion, to which Tanaka transferred such right, the filing of the application for the Patent by Medion constitutes violation of a joint application, and thus the Patent falls under the case described in Article 123, paragraph (1), item (ii) of the Act (violation of Article 38 of the Act).
(Note on Trial Decision: The written request seems to indicate, as grounds for invalidation, only the allegation concerning usurpation; however, when the allegations according to the aforementioned written request are comprehensively taken into account, it is understood that the demandant is also making the allegation of violation of a joint application.)

No. 4 Decision by the body

1. Article 123, paragraph (2) of the Act, which provides for eligibility as a demandant in a patent invalidation trial, stipulates that, in the case of requesting for a trial on the grounds of falling under the case described in Article 123, paragraph (1), item (ii) (restricted to the case in which a patent was granted in violation of Article 38 of the Act) or Article 123, paragraph (1), item (vi) of the Act, only a person who is entitled to be granted a patent, or the true right holder, may request for a patent invalidation trial.
2. The demandant alleges in the principal allegation under the above No. 3, paragraph 1 that since the true right holder is Kanebo, the filing of the application for the Patent by Medion constitutes usurpation. In the preliminary allegation, the demandant alleges that the true right holders are Sakata and Tanaka, or Sakata and Medion (in such case, it is understood that the demandant does not argue against the point that Tanaka transferred to Medion the right to be granted a patent).
3. Meanwhile, the present case was filed on the grounds that the Patent falls under the case described in Article 123, paragraph (1), item (vi) of the Act or Article 123, paragraph (1), item (ii) of the Act (violation of Article 38 of the Act). The demandant alleges, as grounds for the demand, that the true right holder is Kanebo, as per the principle allegation, or Sakata and Tanaka or Sakata and Medion, as per the preliminary allegation. However, the demand for trial of the case was not made by Kanebo or Sakata; instead, it was made by Wingsense. Furthermore, the allegation that Wingsense is the true holder is not proven, nor is there any evidence to support the allegation.
4. Accordingly, it must be said that the demand for trial of the case is unlawful because it fails to fulfill the requirement of Article 123, paragraph (2) of the Act.

No. 5 Closing

As described above, while the demandant filed the present case based on the grounds that the Patent falls under the case described in Article 123, paragraph (1), item (vi) of the Act or Article 123, paragraph (1), item (ii) of the Act (violation of Article 38 of the Act), the demandant does not fall under the person who is entitled to be granted a patent as prescribed in Article 124, paragraph (2) of the Act. In that case, the demand for trial of the case is unlawful and is not subject to amendment, and thus, pursuant to Article 135 of the Act, the demand for trial of the case shall be dismissed by a trial decision without granting to the demandee the opportunity to submit a written answer.

The costs in connection with the trial shall be borne by the demandant pursuant to Article 61 of the Code of Civil Procedure, which is applied mutatis mutandis to Article 169, paragraph (2) of the Patent Act.

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

July 3, 2017

Chief administrative judge: OGUMA, Koji
Administrative judge: SUTO, Yasuhiro
Administrative judge: OGAWA, Keiko