

## Trial Decision

Retrial No. 2019-950001

Demandant	OGAWA, Osamu
Representative	OGAWA, Shingo
Intervener	OGAWA, Shingo
Demandee	SASAKI, Tsutomu
Attorney	FUKUOKA, Hideya

The retrial request to the final and binding decision of the case of trial regarding the invalidation (Invalidation No. 2014-800178) between the parties above has resulted in the following trial decision

### Conclusion

The request for retrial shall be dismissed.

The costs in connection with the retrial including those occasioned by intervention shall be borne by the Demandant and the Intervener.

### Reason

No. 1 Objects of the retrial request and the reply

1 Request

Regarding Invalidation No. 2014-800178, of the trial decision made on June 11, 2018, and finalized after that (hereinafter, simply referred to as "the final and binding decision"), the trial decision that the part that "the patent regarding the invention according to Claims 1 and 3 of Japanese Patent No. 4958194 shall be invalidated" is rescinded and that the demand for trial relating to the part is groundless is requested.

(Trial Decision's note: Although in "5 Object of the request" of the written request for retrial, it is described that "the original decision made on Invalidation No. 2014-800187 shall be rescinded," it can be recognized what the Demandant requests is as mentioned above, from the description in Column "2. Number of claims" in the written request for retrial, the history of the case relating to the final and binding decision, and the like.)

## 2 Replay

A trial decision that the request for retrial is groundless is requested.

### No. 2 History of the procedures, etc.

#### 1 Regarding Invalidation No. 2014-800187

Dated November 14, 2014: Written request for trial

September 25, 2015: Trial decision that the request is groundless (First trial decision)

January 25, 2017: Court judgment that the part relating to Claims 1 and 3 of Japanese Patent No. 4958194 shall be rescinded and other requests shall be dismissed (Action for rescission of First trial decision, first court judgment)

June 11, 2018: Trial decision that the patent regarding the invention according to Claims 1 and 3 of Japanese Patent No. 4958194 shall be invalidated (Final and binding decision)

March 6, 2019: Court judgment of dismissal of the request (Action for rescission to Final and binding decision, second court judgment)

(Trial Decision's note: The first and second court judgment both became final and binding legally (A4 and A7).)

#### 2 Regarding the case

Dated October 4, 2019: Written request for retrial

December 5, 2019 : Written partial withdrawal of request

December 25, 2019 : Written statement (Demandant)

March 4, 2020 : Written reply to request for retrial

May 9, 2020 : Written refutation of the trial case (Demandant)

September 2, 2020 : Application for intervention under Article 148(3) of the Patent Act by OGAWA, Shingo

Dated November 9, 2020: Decision of permission for Application for intervention prescribed in Article 149(3) of the Patent Act

### No. 3 The Demandant's allegation

#### 1 Reason for retrial

In the final and binding decision, there are a reason for retrial prescribed in Article 338(1)(ix) of the Code of Civil Procedure which is applied mutatis mutandis in the provisions of Article 171(2) of the Patent Act (hereinafter, referred to as "Reason No. 9"),

a reason for retrial prescribed in Article 338(1)(vii) of the Code of Civil Procedure (hereinafter, referred to as "Reason No. 7") and a reason for retrial prescribed in Article 338(1)(vi) of the Code of Civil Procedure (hereinafter, referred to as "Reason No. 6").

2 Gist of allegation relating to each reason for retrial

(1) Regarding Reason No. 9

A The first court judgment has the following omissions in determination.

(A) Although the finding that the Plaintiff (Demandee) is the inventor in the first court judgment is due to the existence of a specified device, it has not been examined whether the device is a device relating to Japanese Patent N No. 4958194(A10) (hereinafter, referred to as "the Patent") or a device relating to Japanese Patent No. 4619344 (A9) (Written statement 5. 4. A).

(B) There is an omission regarding "Ownership of the patent right" and "Ownership of the right to obtain a patent" relating the Patent (6. (2)- ○2 in Written refutation of the trial case (Trial Decision's note: 2 is an encircled number, the same shall apply hereinafter.)).

(C) On the basis of A11 and A16, it is an excessive burden to ask the Patentee side to prove an allegation that surpasses the intentional false allegation or proof of the Demandee which was revealed in A11, etc., and the judgment of distribution of burden of proof about establishment which is a norm of the judgment of the first court judgment also has an omission in determination (6. (2)- ○3 in Written refutation of the trial case).

B Therefore, the final and binding decision made in accordance with the first court judgment has the same omission in determination as the first court judgment.

(2) Regarding Reason No. 7 (Written request for trial 6. (4))

A According to A11, it is obvious that ENDO, Yasuyuki (hereinafter, referred to as "ENDO") who made and provided main evidence (Trial Decision's note: such as A26, A28, A29, A30, and A36, etc. submitted in the suit against the first trial decision, which were not submitted in the case) underlying in the first court judgment (A3) that bound the final and binding decision, and submitted a written statement, recognized the content of the Patent as "Product relating to structure of jet pipe according to Japanese Patent No. 4619344" when creating and providing the main evidence above, and still does so.

Therefore, there is no way to explain the detailed process for producing a product

like A 62 (page 33, lines 8 and 9 of A3) submitted by ENDO in the suit against the first trial decision, and ENDO's statement was nothing but a false statement.

B According to A11, it is obvious that ENDO recognized that the Patent is owned by Japan Integrated Works, Co., Ltd., was involved in the trial for invalidation of the Patent with doubts that the Demande was the inventor, and is still in doubt that the Demande is the inventor.

Contrary to Endo's memory, this indicates that Endo's allegations of the trial for invalidation of the Patent were proved with doubts, and it must be said that a false statement was used as evidence of the finding of inventor in the final and binding decision.

(3) Regarding Reason No. 6 (Written request for trial 6. (4))

The evidence created and submitted by Endo in the state described in (2) A and B above is forged or altered.

### 3 Evidence

Documentary evidence is submitted as a means of proof, and the following documents (A1 to A16) are submitted.

- A1 Written request for trial of Invalidation No. 2014-800187
- A2 Trial decision dated September 25, 2015 of Invalidation No. 2014-800187 (First trial decision)
- A3 A court judgment dated January 25, 2017 of 2015 (Gyo-ke) No. 10230 (First court judgment)
- A4 Trial record of 2017 (Gyo-hi) No. 181 (Decision)
- A5 Trial Decision dated June 11, 2018 of Invalidation No. 2014-800187 (Final and binding decision)
- A6 A court judgment on March 6 of 2019 of 2018 (Gyo-ke) No. 10099 (Second court judgment)
- A7 Trial record of 2019 (Gyo-hi) No. 186 (Decision)
- A8 Bill dated March 20, 2018 submitted at Utsunomiya District Court
- A9 Japanese Patent No. 4619344
- A10 Japanese Patent No. 4958194
- A11 Examination record of a witness of ENDO (Tokyo District Court, 2018 (Wa) No. 19852)
- A12 Written statement for change of the suit dated January 11, 2019 (Tokyo District

Court, 2018 (Wa) No. 19852)

· A13 Demandee's brief (2) dated November 19, 2018 (Tokyo District Court, 2018 (Wa) No. 19852)

· A14 A court judgment on October 31, 2019 (Tokyo District Court, 2018 (Wa) No. 19852)

· A15 Application for certificate of judgment dated November 20, 2019 (Tokyo District Court, 2018 (Wa) No. 19852)

· A16 Conversation record-transcribed document of 7th Ordinary General Meeting of Shareholders of Japan Integrated Works, Co., Ltd. on May 23, 2013 (extract)

No. 4 The Demandee's allegation (gist)

1 Regarding Reason No. 7 and Reason No. 6

(1) ENDO has never made a sworn statement as a witness in the patent in the request for validation trial and the litigation rescinding the trial decision (In A3 and A5, ENDO's statement is not listed as evidence.).

Therefore, the allegation that ENDO's statement is false does not fall under the reason for retrial.

(2) In the final and binding decision, the evidence such as ENDO's written statement is not the evidence that provides the basis for the determination.

Therefore, the allegation that the evidence in the written statement is forged or altered does not fall under the reason for retrial.

(3) There is no fact that ENDO has been convicted or tried for fines, and it does not fall under Article 338(2) of the Code of Civil Procedure which is applied mutatis mutandis in the provisions of Article 171(2) of the Patent Act. Therefore, it does not fall under the reason for retrial in this point.

2 Regarding No. 9

The Demandant alleges the omission of judgment in the first court judgment, but does not allege the omission of judgment in the final and binding decision, and thus does not fall under the reason for retrial.

No. 5 Judgment by the body

1 Regarding the reason for retrial

(1) It is stipulated that " Article 338(1) and (2) and Article 339 (reason for retrial) of the

Code of Civil Procedure are applied mutatis mutandis pursuant to the request for retrial in the preceding paragraph" in Article 171(2) of the Patent Act, and it is stipulated that "If any of the following circumstances are present, a party may protest a final judgment that has become final and binding through a demand for a retrial; provided, however, that this does not apply if a party, when filing the appeal to the court of second instance or the final appeal, alleged those circumstances or knew of them but did not allege them" in the main paragraph of Article 338 of the Code of Civil Procedure which are applied mutatis mutandis pursuant to Article 171(2) of the Patent Act. It is obvious that "appeal or final appeal" in the proviso to Article 338 of the Code of Civil Procedure refers to "action for suit against trial decision or final appeal against the suit" in accordance with the Patent Act (Intellectual Property High Court judgment 2007 (Gyo-Ke) No. 10407).

(2) It is stipulated that "if any of the circumstances set forth in items (iv) to (vii) of the preceding paragraph are present, a party may demand a retrial only if a guilty verdict or decision imposing a civil fine for the relevant criminally publishable act has become final and binding, or if the reason that it is not possible to obtain a final and binding guilty verdict or final and binding decision imposing a civil fine for the relevant criminally publishable act is something other than the lack of evidence" in the main paragraph of Article 338(2) of the Code of Civil Procedure which is applied mutatis mutandis pursuant to the request for retrial.

Then, in order to meet the requirement that "if the reason that it is not possible to obtain a final and binding guilty verdict or final and binding decision imposing a civil fine for the relevant criminally publishable act is something other than the lack of evidence," it is necessary to prove that it could not be obtained due to the death of a suspect, an extinctive prescription on authority of prosecution, non-prosecution, etc., despite the possibility of getting a final and binding judgment of conviction for an act to be punished. Therefore, it is understood that a party who applies for a retrial if there is no final and binding judgment of conviction for an act to be punished must prove the fact such as an extinctive prescription on authority of prosecution, but also the possibility of obtaining a final and binding judgment of conviction (see Decision by the third petty bench of Supreme Court on June 29, 1967, 1964 (O) No. 1374).

Furthermore, since the requirement is understood to be due to the purpose of preventing the adverse effects of the abuse of suits by limiting the suits for retrial to only the case where there is a significant probability that a reason for retrial exists, in the absence of this requirement, the suits themselves become illegal, and it is understood that the suit for retrial is unavoidable to be dismissed without going into the judgment of

whether or not there is reasons for retrial itself in Article 338(1)(iv)-(vii) of the Code of Civil Procedure (see Judgment of the Supreme Court of Japan, 2nd Petty Bench, October 9, 1970)

Hence, similarly, regarding a retrial against the final and binding decision of a trial for patent invalidation, in absence of this requirement of Article 338(2) of the Code of Civil Procedure which is applied mutatis mutandis pursuant to Article 171(2) of the Patent Act, the request for itself become illegitimate, and the request for retrial is unavoidable to be dismissed without going into the judgment of whether or not there is reasons for retrial itself in Article 338(1)(iv)-(vii) of the Code of Civil Procedure.

(3) Based on the above, each reason No. 6, No. 7, and No. 9 will be examined.

## 2 Regarding Reason No. 9

(1) A Since Reason No. 9 alleged by the Demandant can be immediately recognized by looking at the final and binding decision, regardless of whether or not it is correct, it can be said that the Demandant could allege Reason No. 9 above in the litigation rescinding the trial decision.

Therefore, the matter that the Demandant does not allege Reason No. 9 in the litigation rescinding the trial decision, but alleges Reason No. 9 in the request for retrial of the case, obviously falls under "if a party, when filing the appeal to the court of second instance or the final appeal, (alleged those circumstances or) knew of them but did not allege them".

Consequently, it should be said that the request for retrial of the case based on Reason No. 9 falls under the proviso mentioned in 1 (1) above.

B Further, although the Demandant alleges as described in No. 3 2 (1) above, since in these allegations, in essence, alleged is the omission of judgment in the first court judgment, and not alleged is the omission of judgment in the final and binding decision, the Demandant's allegation cannot be accepted in the premise.

(2) Further, the presence/absence of Reason No. 9 will be also examined

A It is understood that "Omission involving a determination" in Article 338(1)(ix) of the Code of Civil Procedure which is applied mutatis mutandis pursuant to Article 171(2) of the Patent Act is a matter that affects the conclusion of the trial decision depending on the judgment, is the case where the judgment is not shown in the reason of the trial decision, among the allegations and evidence methods legally submitted by the party (Intellectual

Property High Court judgment 2007 (Gyo-Ke) No. 10407).

Considering that, the final and binding decision (A5) was recognized and determined as follows, and the trial decision was made to invalidate the patent of the inventions according to Claims 1 and 3 of Japanese Patent No. 4958194.

"Here, the retrial of the case is subject to the binding effects in the decision of revocation pursuant to the provisions of Article 33 (1) of the Administrative Case Litigation Act. Since the binding effects extend to the fact-finding and legal judgment necessary for the main sentence of the judgment to be derived, it is not permitted that the party repeats the same allegations as before, arguing that the recognition and determination in the reasons to which the binding effects of the court judgment of the case extend, or provides new proof for supporting the above allegations.

Although the Demandeé alleges that the recognition and determination of the court judgment of the case is false incorrect and submitted the written statement (1), the written statement (2), and B21 to B65 as new proof for supporting this, the allegation and proof have already been carried out or could have been carried out in the trial procedure pertaining to the first trial decision and the suit against the first trial decision, or repeats the same allegation as before, and thus cannot be accepted by the binding effects.

From the above, in accordance with the judgment of the case, the body determines that for...Inventions 1 and 3 of the respective inventions of the case, the inventor thereof cannot be admitted to be the Demandeé.

Further, for Inventions 1 and 3, it is also not recognized that the Demandeé has inherited the right to obtain a patent of the invention from the inventor". (Page 10, lines 1 to 18)

That is, the final and binding decision shows the conclusion of the trial decision that invalidates the patent as described above in the reason of the trial decision.

Therefore, it should be said that there is no illegality in the final and binding decision.

B Further, since the final and binding decision merely recognized and determined as described in A above according to the binding effects of the first court judgment that has been legally finalized, it can be said that there is no illegality in the trial decision made in accordance with this, unlike the case where decision is made exceeding the binding effects of a legally finalized court judgment.



C Therefore, Reason No. 9 cannot be applied to the final and binding decision.

3 Regarding Reason No. 7 and Reason No. 6

(1) According to the second court judgment (No. 7 to 9, pages 12 and 13), it is recognized that the Demandant has made the same allegations as stated in No. 3 2 (2) and (3) above, in the litigation rescinding the trial decision.

Therefore, it is obvious that making the above allegations of No. 3 2 (2) and (3) above in this case falls under "if a party, when filing the appeal to the court of second instance or the final appeal, alleged those circumstances".

Consequently, it should be said that the request for retrial of the case based on Reason No. 7 and Reason No. 6 falls under the proviso to Article 338(1) of the Code of Civil Procedure which is applied *mutatis mutandis* pursuant to Article 171(2) of the Patent Act.

(2) Further, considering 1 (2) above about this case, there is no sufficient evidence to admit that ENDO's statement and his actions, such as making a written statement, were "a guilty verdict or decision imposing a civil fine for the relevant criminally publishable act has become final and binding" or "the reason that it is not possible to obtain a final and binding guilty verdict or final and binding decision imposing a civil fine for the relevant criminally publishable act is something other than the lack of evidence".

Although the Demandant alleges that "five years have already passed since the request for trial, and the extinctive prescription may have been established, or since it is impossible for the Demandant and the like to obtain the finalization of judgment of conviction etc. in a short period of time since the discovery of the facts by A11 to the present time, it is considered that it falls under 'when a final and binding judgment cannot be obtained' after 'or' in the latter part of Article 338(1) of the Code of Civil Procedure" (Written refutation of the trial case, pages 11 and 12), the circumstances alleged by the Demandant are not recognized as special circumstances to be taken into consideration, when considering the legal nature of the retrial, which is an extreme relief method such as coordinating the legal stability of a final and binding decision and the justice of remedy of the parties from the existence of serious defects, etc.

Therefore, it should be said that the request for retrial of the case, based on Reason No. 7 and Reason No. 6 lacks the requirement of Article 338(2) of the Code of Civil Procedure which is applied *mutatis mutandis* pursuant to Article 171(2) of the Patent Act.

(3) Also, the presence/absence of Reason No. 7 and Reason No. 6 will be examined.

A Regarding Reason No. 7

Since ENDO did not make a statement as a witness in the invalidation trial relating to the final and binding decision, Reason No. 7 related to ENDO's statement cannot exist in the final and binding decision in the first place.

B Regarding Reason No. 6

If ENDO misunderstood the content of the Patent or had doubts about the inventor of the Patent, it may be said that the content of the evidence (statement, etc.) made by ENDO was incorrect, but this does not mean that the document above is proved to have been forged or altered.

Therefore, Reason No. 6 cannot be applied to the final and binding decision.

No. 6 Closing

Therefore, the request for retrial based on Article 338(1)(vi), (vii), and (ix) of the Code of Civil Procedure which are applied mutatis mutandis in the provisions of Article 171(2) of the Patent Act is illegitimate, and thus is dismissed under the provisions of Article 135 of the Patent Act which is applied mutatis mutandis in the provisions of Article 174(3) of the Patent Act.

The costs in connection with the retrial shall be borne by the Demandant and the Intervener under the provisions of Article 61 and 66 of the Code of Civil Procedure which are applied mutatis mutandis in the provisions of Article 169(2) of the Patent Act which is applied mutatis mutandis in the provisions of Article 174(3) of the Patent Act.

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

December 25, 2020

Chief administrative judge: SUTO, Yasuhiro  
Administrative judge: KATO, Tomoya  
Administrative judge: OHATA, Michitaka