

23-10 PUDT

Procedures in the Case Where There Is No Patent Administrator

1. Where Procedures Are Undertaken without a Patent Administrator

(1) Demandant/Appellant

In the case of a person who is not domiciled or resident (or, in the case of a legal entity, with an establishment) in Japan (hereinafter referred to as "overseas resident"), the procedures must be undertaken through a patent administrator (Patent Act Article 8 (1), Utility Model Act Article 2-5 (2), Design Act Article 68 (2), Trademark Act Article 77 (2)). Accordingly, if the procedures are undertaken without a patent administrator, such procedures will be dismissed by a trial/appeal decision (Patent Act Article 135, Utility Model Act Article 41, Design Act Article 52, Trademark Act Article 56 (1) and Article 68 (4)).

(2) Demande

As in the case of (1), the procedures must be undertaken through a patent administrator in the case of an overseas resident.

(3) These cases, in which the patent administrator is deceased (→23-11), or otherwise ceases to exist any longer after a request for a trial/appeal has been filed, shall be handled in the same manner as the above (1) and (2); provided however, that if the patent administrator ceases to exist due to death, voluntary resignation, dismissal, etc., the opportunity to appoint a patent administrator should be given so that a new patent administrator will be appointed.

(4) While the procedures which are undertaken by an overseas resident without a patent administrator shall follow the above (1) and (2), it is possible for the Patent Office to send notices, etc. directly to the demandant/appellant and demande.

Obviously, motions for exclusion or recusation (→59-01 to 59-05) cannot be filed.

2. In the Case Where There Is No Patent Administrator, the Following Points Should Be Noted with Regard to the Procedures to Be Undertaken by the Patent Office.

- (1) Where a request for a trial (an opposition to grant of patent (or registration of trademark)) is filed against a patent right for which a written proof of authority of representation (hereinafter referred to as "power of attorney") has not been submitted, the person who had previously been a patent administrator should be contacted for confirmation of whether or not such person will accept the appointment as a patent administrator (Form 1).

If the patent administrator responds that it will accept the appointment, the Patent Office serves (sends) a duplicate of the written request for trial (a written opposition to grant of patent (or registration of trademark)) to the patent administrator, and if the patent administrator responds that it will not accept the appointment, the Patent Office serves (sends) the same to the patentee.

- (2) Where a power of attorney has been submitted, however, restriction is placed on the procedures for a patent (or utility model/design/trademark) right in accordance with the proviso of Article 8 (2) of the Patent Act, the Patent Office serves (delivers) a duplicate of the written request for trial (a written opposition to grant of patent (or registration of trademark)) to the patentee.
- (3) Where no patent administrator has been appointed, notice of names of administrative judge and trial clerk (→12-01), notice of documentary proceeding (→32-01), notice of conclusion of trial proceedings (→42-00), etc. shall be dispatched along with the documents to be served (sent) subsequently, such as a decision and a trial/appeal decision (→17-01).
- (4) A trial/appeal decision (a decision over an opposition filed against a patent (or a trademark registration)) may be dispatched without attachment of a translation of the decision.

3. The following points should be noted when documents are dispatched.

- (1) Where an overseas resident has no patent administrator, documents will be dispatched by registered air mail, etc. (refers to service of registered mail or correspondence delivery

that is equivalent to registered mail prescribed by Ordinance of the Ministry of Economy, Trade and Industry) (Patent Act Article 192 (2), Utility Model Act Article 55 (2), Design Act Article 68 (5), Trademark Act Article 77 (5)).

- (2) Where documents are dispatched by registered mail, etc., under (1), the documents shall be deemed to have been served at the time of dispatch (Patent Act Article 192 (3), Utility Model Act Article 55 (2), Design Act Article 68 (5), Trademark Act Article 77 (5)).

4. When a duplicate of the written request for trial (an opposition to grant of patent (or registration of trademark)) is served (sent) to the patentee (→2.(1), (2)), a note in English must be attached to the duplicate, to the effect that "if the demandee intends to proceed with the procedures for this request for a trial, a patent administrator must be appointed in accordance with the Patent Act Article 8 (Utility Model Act Article 2-5 (2), Design Act Article 68 (2), Trademark Act Article 77 (2)), and all the subsequent procedures must be undertaken through the patent administrator."

An example of the English text (Form 2) shall be kept by the trial clerk or the Infringement and Invalidation Affairs Office.

Form 1 (Example of Trial for Patent Invalidation)

Request for Notification of Appointment of Patent Administrator, etc.

Date YY/MM/DD

To: xxxxxx
xxxx Patent Office

Fax: +81-3-xxxx-xxxx

Phone: +81-3-xxxx-xxxx

Number of pages: xx

No. xx Office (Infringement and Invalidation Affairs Office)
Trial and Appeal Division, Trial and Appeal Department, Japan Patent Office

Japan Patent No. xxxxxxxx

Patentee Address:
Name: xx xx xx xx

Invalidation No. 20XX-800xxx

A trial for invalidation was requested for the above patent right on xx xx, xxxx.

Since you are registered as a representative at the time of establishing the patent right, the Japan Patent Office requests for the Notification of Appointment (Acceptance) of Patent Administrator, etc.

Please note that you will explain the patentee that the procedures for a trial/appeal must be undertaken through a patent administrator in accordance with the Patent Act Article 8, and send your reply concerning the acceptance of appointment as a patent administrator within xx days after receipt of this notice to No. xx Office (Infringement and Invalidation Affairs Office), the Trial and Appeal Division by fax (the attached form).

When replying concerning the acceptance of appointment as a patent administrator, please submit, along with your reply, the Notification of Appointment (Acceptance) of Patent Administrator, etc. If the Japan Patent Office does not receive the Notification of Appointment (Acceptance) of Patent Administrator, etc. within xx days, a duplicate of the written request for trial will be sent directly to the patentee.

Note: For questions, please contact No. xx Office (Infringement and Invalidation Affairs Office), Trial and Appeal Division, Trial and Appeal Department, the Japan Patent Office.

Phone: +81-3581-1101, ext. xxxx

Fax: +81-3501-xxxx Contact personnel: xxxxxxxx

**Reply to Request for Notification of Appointment of
Patent Administrator, etc. (for fax transmission)**

Date YY/MM/DD

To: xxxxxxxx

No. xx Office (Infringement and Invalidation Affairs Office)
Trial and Appeal Division, Trial and Appeal Department, Japan Patent Office

Japan Patent No. XXXXXXXX

Invalidation No. 20XX-800XXX

Identification No. Phone: +81-3-xxxx-xxxx
Name of Patent Administrator (xxxxxxxx) xx xx xx xx

Please circle the applicable number.

- 1. I accept the above-mentioned appointment.
- 2. I cannot accept the above-mentioned appointment.

If you accept the appointment

Please submit the Notification of Appointment (Acceptance) of Patent Administrator, etc.
For "a written document proving the authority of representation," please attach a new document (power of attorney), or cite either a document (power of attorney) which has already been submitted or a general power of attorney.

If you cannot accept the appointment

To send documents directly to the patentee, please provide the Japan Patent Office with the most recent information, about the patentee's name and address, held by your agency (the name and address as shown in English as well as the Japanese translation).

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Form 2

Japan Patent Office
3-4-3 Kasumigaseki, Chiyoda-ku
Tokyo, Japan, 100-8915

November 21, 2014

To : xxxxxxxx (Patentee)

Dear Sir/Madam:

The Japan Patent Office hereby notifies you that a request to hold a trial for patent invalidation has been filed against your patent No. XXXXXXXX. As a result of this request being filed, you are required to submit to the Japan Patent Office your response in writing, in duplicate, against the request within ninety (90) days from the date on which this notice was sent.

In submitting your response in writing, however, you first will need to designate a representative domiciled or residing in Japan who is a qualified patent administrator such as a patent attorney, as defined in Article 8 of the Patent Law of Japan. Only your qualified patent administrator will be authorized to deal with the Japan Patent Office and conduct the necessary procedures on your behalf.

Please note that the Japan Patent Office is unable to extend the deadline for you to submit your response in writing, unless you can prove any specific and reasonable grounds for the need to extend the deadline.

Yours faithfully,

Chief Administrative Judge