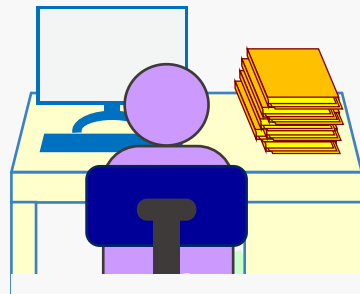


# 1.Overview

# 1.(1) Overview of JPO Trial and Appeal System



Decision  
to  
Refuse

Decision  
To  
Grant

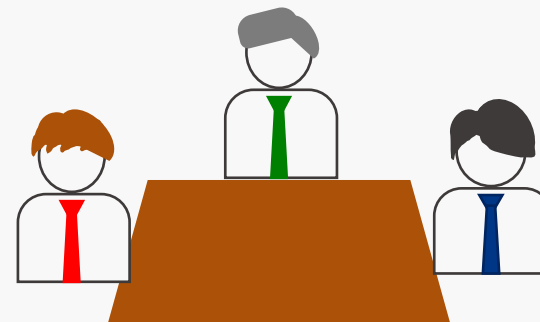
## Request for Trial/Appeal



I'm not  
convinced!



I don't  
believe...



- Trial/appeal shall be conducted by a panel consisting of three or five administrative judges
- A chief administrative judge shall preside over matters relating to the trial
- A trial clerk shall undertake affairs relating to the preparation of the trial, etc.

### Points of Trial and Appeal System

- Review Examiners' Decisions
- Determine the validity of rights

## 1.(2) Roles of TAD

- Reviewing Examiners' Decisions

(1) Determination of appropriateness of a decision of refusal (appeal against an examiners' decision of refusal) \*

(2) Improve the reliability of rights (**opposition to grant of patent**/trademark)

- ✓ Technical expertise
- ✓ Utilization of ex officio proceedings
- ✓ Binding legal effectiveness as to third parties

Examination  
Departments

**TAD**

Intellectual Property  
(IP) High Court

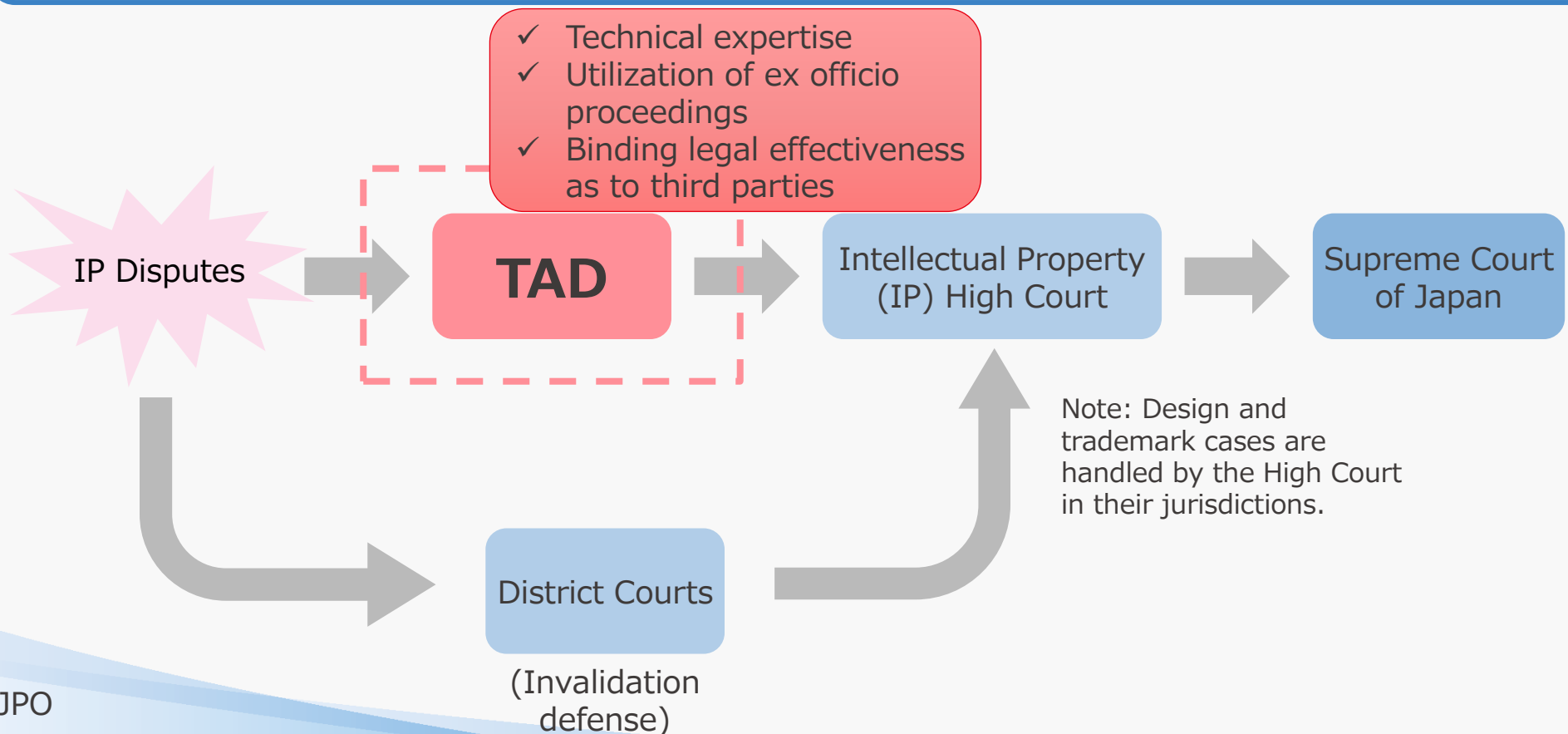
Supreme Court  
of Japan



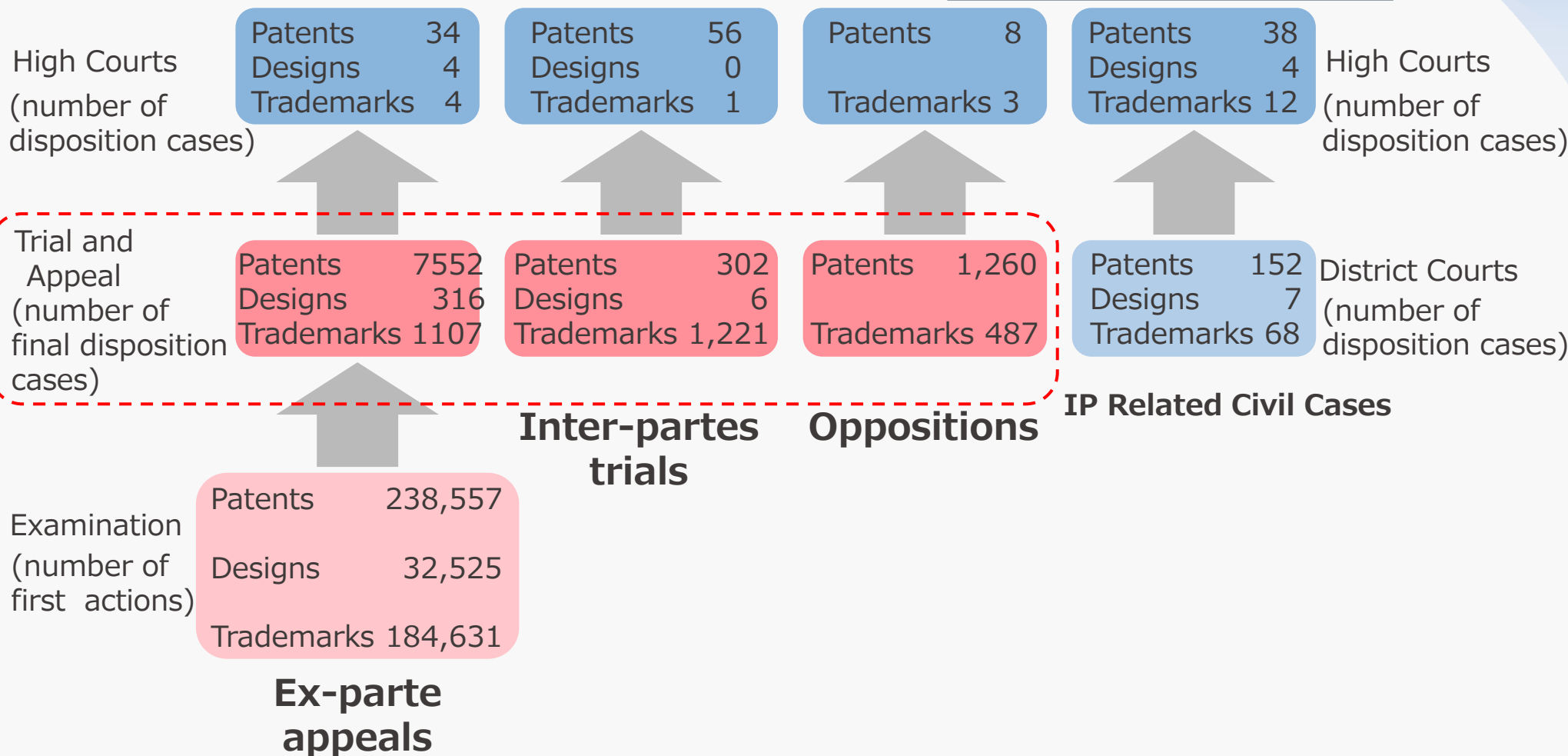
\* In principle, a person who is not satisfied with the administrative disposition of administrative agencies or acts involving the exercise of public authority may 1) file complaints against administrative agencies (Administrative Complaint Review Act), or 2) file a lawsuit to the court (Administrative Case Litigation Act). However, under the Patent Act which provides an unique appeal system, a panel consisting of three or five administrative judges with expertise examines the appropriateness of a decision of refusal.

## 1.(2) Roles of TAD

- Expeditious Resolution of Disputes over Granted IP Rights
  - (1) Determination of validity of patents, etc. (**trial for invalidation**)
  - (2) Correction of scope of claims, etc. (trial for correction)
  - (3) Rescission of registered trademark not in use, etc. (trial for rescission)
  - (4) Advisory opinion on the technical scope of industrial property rights (Hantei)



# 1.(3) Comparison of the Number of Disposition Cases



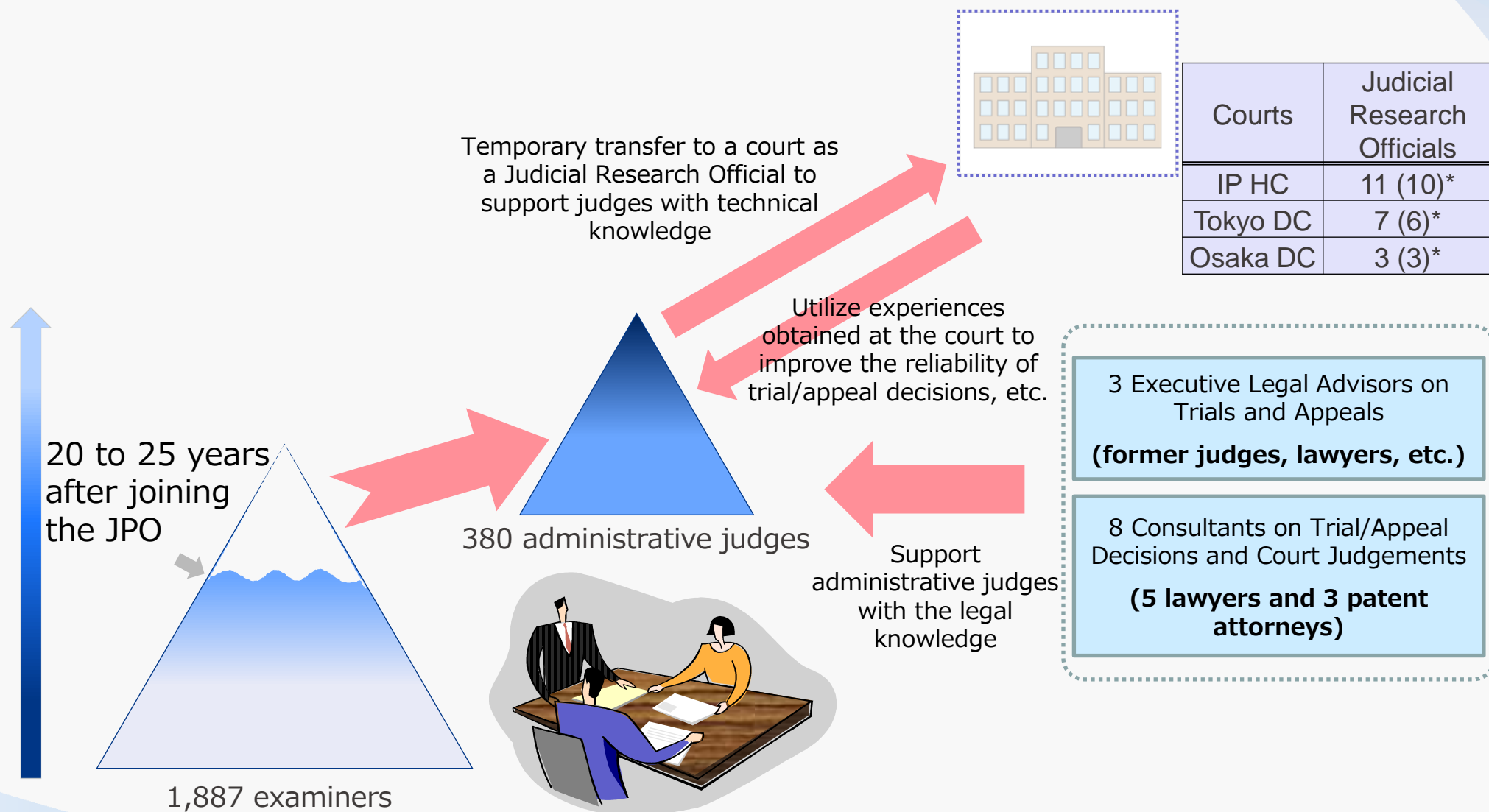
(Sources)- Examination/trial/appeal figures are calculated from the data for 2021.

Court figures are calculated from the data for 2019. "Patents" includes (few) utility model cases.

- These tables are prepared by the JPO based on the information obtained from the Japan Patent Office Annual Report 2022, the Intellectual Property High Court website, etc.

JPO - Breakdown of figures for revocation actions against appeal/trial decisions is collected and calculated by the JPO based on the data for rendition of court decisions or the data for final dispositions. 6

# 1.(4) Career Paths as Administrative Judges



## 1.(5) Administrative Judges, Chief Administrative Judge, and Panel

(Panel system for trial)

Patent Act Article 136

(1) A trial shall be conducted by a panel consisting of three or five administrative judges.

(2) A decision of the panel under the preceding paragraph shall be made by a majority vote.

(3) Qualifications of administrative judges shall be as provided by Cabinet Order.

(Designation of administrative judges)

Patent Act Article 137

(1) The Commissioner of the Patent Office shall designate the administrative judges constituting a panel under Art. 136(1) for each trial (…).

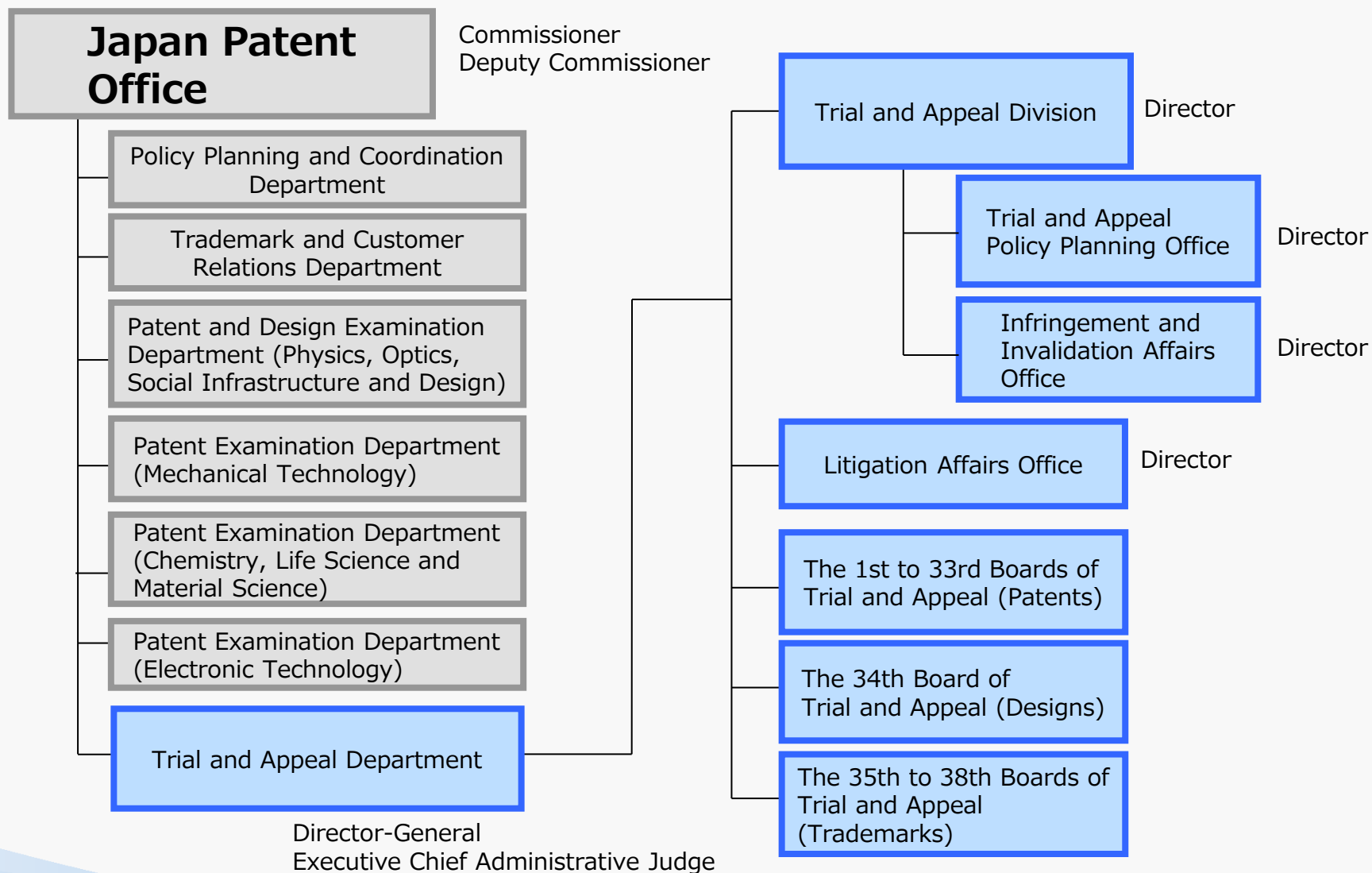
(Chief administrative judge)

Patent Act Article 138

(1) The Commissioner of the Patent Office shall designate one of the administrative judges designated under Art. 137(1) as the chief administrative judge.

(2) The chief administrative judges shall preside over matters relating to the trial.

## 1.(6) Organization of Japan Patent Office (JPO)





# 1.(7) Organization of Trial and Appeal Department (TAD)

Director-General

Executive Chief Administrative Judge

## Patents / Utility Models

### <Boards for physics, optics and social infrastructure>

- 1<sup>st</sup> Board Measurement
- 2<sup>nd</sup> Board Materials Analysis
- 3<sup>rd</sup> Board Amusement Machinery
- 4<sup>th</sup> Board General Amusement
- 5<sup>th</sup> Board Natural Resources and Living Environment
- 6<sup>th</sup> Board Applied Optics
- 7<sup>th</sup> Board Business Machinery
- 8<sup>th</sup> Board Applied Physics and Optical Devices

### <Boards for Machinery>

- 9<sup>th</sup> Board Automatic Control and Living Related Machinery
- 10<sup>th</sup> Board Motive Machinery
- 11<sup>th</sup> Board Transportation and Lighting
- 12<sup>th</sup> Board General Machinery and Logistics
- 13<sup>th</sup> Board Production Machinery
- 14<sup>th</sup> Board Textile Processing and Packaging Machinery
- 15<sup>th</sup> Board Medical Devices
- 16<sup>th</sup> Board Heating, Refrigerating and Air-conditioning Engineering

## <Boards for Chemistry>

- 17<sup>th</sup> Board Inorganic and Environmental Chemistry
- 18<sup>th</sup> Board Material Processing and Metals and Electrochemistry
- 19<sup>th</sup> Board Polymers
- 20<sup>th</sup> Board Food and Plastics Engineering
- 21<sup>st</sup> Board Applied Organic Chemicals
- 22<sup>nd</sup> Board Organic Chemistry
- 23<sup>rd</sup> Board Pharmaceuticals
- 24<sup>th</sup> Board Biopharmaceuticals
- 25<sup>th</sup> Board Biotechnology

## <Boards for Electronics>

- 26<sup>th</sup> Board Electronic Commerce Technology
- 27<sup>th</sup> Board Interfaces
- 28<sup>th</sup> Board Data Processing
- 29<sup>th</sup> Board Electronic Devices Device
- 30<sup>th</sup> Board Video System
- 31<sup>st</sup> Board Transmission Systems
- 32<sup>nd</sup> Board Electronic Components
- 33<sup>rd</sup> Board Digital Communications and Electric Power Systems

## Design

- 34<sup>th</sup> Board Designs

## Trademark

- 35<sup>th</sup> Board Trademarks: Chemicals and Foodstuffs
- 36<sup>th</sup> Board Trademarks: Machinery and Electric Appliances
- 37<sup>th</sup> Board Trademarks: Textiles and General Merchandise
- 38<sup>th</sup> Board Trademarks: Industrial Services and General Service

Administrative judges are assigned by specialized fields

Trial and Appeal Division

Litigation Affairs Office

Trial and Appeal Policy Planning Office

Infringement and Invalidation Affairs Office

In charge of 1<sup>st</sup>, 5<sup>th</sup>, 7<sup>th</sup> ~9<sup>th</sup> Boards

# 1.(8) Types of Trials and Appeals

	Types of trials and appeals	Patents	Utility models	Designs	Trademarks
Before establishment of rights	Appeals against an examiner's decision of refusal (Patent Act Art. 121)	✓	—	✓	✓
	Appeals against an examiner's decision to dismiss amendment (Design Act Art. 47, Trademark Act Art. 45)	—	—	✓	✓
After establishment of rights	Trial for invalidation (Patent Act Art. 123)	✓	✓	✓	✓
	Opposition to registrations (Patent Act Art. 113, Trademark Act Art. 43-2)	✓	—	—	✓
	Trial for correction (Patent Act Art. 126)	✓	—	—	—
	Trial for rescission (Trademark Act Art. 50)	—	—	—	✓
	"Hantei" (for parties concerned) (*1) (Patent Act Art. 71)	✓	✓	✓	✓
	Expert testimony (for courts) (*2) (Patent Act Art. 71-2)	✓	✓	✓	✓

\*1: Advisory opinion on scope of rights

\*2: Opinion on scope of patent claims, etc. of patented inventions (when commissioned by a court)