

00-01 P U D T**Type of Proceedings: Trials and Appeals**

1. Trials/Appeals

(1) Appeal against examiner's decision of refusal (Patent Act Article 121, Design Act Article 46, Trademark Act Article 44, Supplementary Provisions of the Trademark Act Article 13)

(2) Appeal against examiner's decision to dismiss amendment (Design Act Article 47, Trademark Act Article 45)

(3) Trial for invalidation

(i) Trial for patent (registration) invalidation (Patent Act Article 123, the Old Patent Act Article 184-15 (1) (Applications filed on or before Jun 30, 1995), Utility Model Act Article 37, the Old Utility Model Act Article 48-12 (1) (Applications filed on or before Jun 30, 1995), Design Act Article 48, Trademark Act Article 46)

(ii) Trial for invalidation for registration of an extension of the patent term (Patent Act Article 125-2, Patent Act Article 125-3)

(iii) Trial for invalidation of registration of reclassification of trademark registration (Supplementary Provisions of the Trademark Act Article 14)

(4) Trial for correction (Patent Act Article 126)

(5) Trial for rescission of trademark registration

(i) Trial for rescission of a registered trademark not in use (Trademark Act Article 50)

(ii) Trial for rescission based on misuse of a registered trademark (Trademark Act Articles 51, 53)

(iii) Trial for rescission of trademark registration to prevent confusion arising from transfer of similar trademark (Trademark Act Article 52-2)

(iv) Trial for rescission of trademark registration as a result of unauthorized trademark registration by an agent or representative of the owner of a mark in a country of the Union (Trademark Act Article 53-2).

The provisions concerning trademarks and the supplementary provisions of the Trademark Act apply mutatis mutandis to a trial concerning registration of a defensive trademark (Trademark Act Article 68 (4), Supplementary Provisions of the Trademark Act Article 23).

2. Petition, Application

(1) Opposition (final disposition)

(i) Opposition to grant of patent (Patent Act Article 113)

(ii) Opposition to registration of trademark (Trademark Act Article 43-2)

(2) Other petitions, application for intervention (interim disposition)

(i) Petition for exclusion or recusation (Patent Act Articles 139 ~ 144, 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56 (1) and 68 (4))

(ii) Application for intervention (Patent Act Articles 148, 149, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56 (1), 68 (4))

(iii) Petition for preservation of evidence (Patent Act Articles 150, 151, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56 (1), 68 (4))

3. Retrial (Patent Act Article 171 (1), Utility Model Act Article 42 (1), Design Act Article 53 (1), Trademark Act Article 57 (1))

4. *Hantei* (Advisory Opinion) System (Patent Act Article 71 (1), Utility Model Act Article 26, Design Act Article 25 (1), Trademark Act Article 28 (1) and Article 68 (3))

5. Request for Expert Opinion from Court (Patent Act Article 71-2, Utility Model Act Article 26, Design Act Article 25-2, Trademark Act Article 28-2)

6. Inquiry for Opinion of the Director General of Customs (Customs Act Article 69-7 (1) and Article 69-17 (1))

(Revised Dec 2023)

00-02 PUDT
**Trial and Appeal Proceedings by Electronic Data
Processing Systems**

1. Procedures for the Commissioner of the Patent Office or a Chief
Administrative Judge

Procedures for the Commissioner of the Patent Office or a chief administrative judge and specified by the Ordinance of the Ministry of Economy, Trade and Industry (specific procedures) may be carried out by means of electronic data processing systems (Act on Special Provisions for Procedures Related to Industrial Property Right Article 3(1), Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 10).

The specific procedures are deemed to have been carried out by submitting a document specified in the relevant legal provision that was established on the presumption that said specific procedure will be carried out by submitting a document (Act on Special Provisions for Procedures Related to Industrial Property Right Article 3(3)).

From January 2024, procedures for a written demand for invalidation trial or a petition for opposition may also be submitted by means of electronic data processing systems (Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 13(2)(3)). These procedures are called “special electronic applications”. For details, refer to the JPO’ website: “Digitalization of application procedures (https://www.jpo.go.jp/system/laws/sesaku/shinsei_digitalize.html)” and “Special electronic applications in trial/appeal proceedings (https://www.jpo.go.jp/system/trial_appeal/shinpan_digitalize.html)”.

2. Dispositions Executed by the Commissioner of the Patent Office, a Chief Administrative Judge, an Administrative Judge, or a Trial and Appeal Clerk

When the Commissioner of the Patent Office, a chief administrative judge, an administrative judge, or a trial and appeal clerk conducts an act that is required to be carried out by submitting a document under the relevant legal provision, if such act is specified in the Ordinance of the Ministry of Economy, Trade and Industry (specific dispositions, etc.), it may be carried out by means of electronic data processing systems (Act on Special Provisions for Procedures Related to Industrial Property Right Article 4(1), Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 23).

When conducting a specific disposition, etc., he/she identifies his/her status such as an administrative judge, etc. by using the assigned identification card or biometric authentication and entering the PIN number instead of executing a signature and seal (Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 23-3).

A specific disposition, etc. is deemed to have been carried out by submitting a document specified in the relevant legal provision that was established on the presumption that said specific disposition, etc. will be carried out by submitting a document (Act on Special Provisions for Procedures Related to Industrial Property Right Article 4(2)).

When the Commissioner of the Patent Office or a chief administrative judge issues a notice or an order specified in a legal provision, if such notice or order (specific notice, etc.) is specified in the Ordinance of the Ministry of Economy, Trade and Industry, it may be carried out by means of electronic data processing systems (Act on Special Provisions for Procedures Related to Industrial Property Right Article 5(1), Enforcement Regulations of the Act

on Special Provisions for Procedures Related to Industrial Property Right Article 23-4).

When a written demand for invalidation trial, etc. are submitted by the special electronic application, the Commissioner of the Patent Office or a chief administrative judge may provide matters to be included in the duplicate of said written demand for invalidation trial, etc. by means of the electromagnetic method (DVD-R) instead of service of the duplicate upon obtaining the consent of a person receiving the duplicate. In this case, the Commissioner of the Patent Office or a chief administrative judge is deemed to have served the duplicate of the written demand for invalidation trial, etc. (Act on Special Provisions for Procedures Related to Industrial Property Right Article 10(2)).

3. Operation by Types of Trials/Appeals

In principle, the procedures for an appeal against an examiner's decision of refusal and an appeal against the examiner's decision to dismiss amendment are carried out by means of electronic data processing systems.

As stated in the above item 1, the procedures for a demand for invalidation trial and a petition for opposition may be carried out by means of electronic data processing systems (special electronic applications) in addition to a written or documentary procedures. Each section of this Manual for Trial and Appeal Proceedings shows submission of a duplicate, etc. in writing, however, there is no need to provide a duplicate to the other party and for the proceedings when electronic data processing systems are used for the procedures (Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 10-3).

(Revised Dec 2023)

00-03 D**Trials and Appeals Concerning International Applications
for Design Registration**

An international application for design registration means an international application that designates Japan as a designated Contracting Party specified in the Geneva Act Article 1 (xix). The international registration made by said international application under the Geneva Act Article 1 (vi) will be published under the Geneva Act Article 10 (3) (a). Said international application may be deemed to be a design registration application made on the international registration date specified in Article 10 (2) of the Geneva Act in accordance with the Ordinance of the Ministry of Economy, Trade and Industry (Design Act Article 60-6).

Trials and appeals concerning an international application for a design registration is subject to special handling as follows.

1. Demandant/Appellant or Demandee/Appellee**(1) Description of the demandant/appellant or the demandee/appellee**

A. In the procedures of an appeal against an examiner's decision of refusal and an appeal against an examiner's decision to dismiss amendment, an appellant writes in the application documents (a written request for appeal, a written amendment, etc.) the name (appellation) and address (domicile) of the appellant in Japanese as well as in the original language. When writing in the original language, the appellant uses the same characters as those used in the international register (Enforcement Regulations of the Design Act Article 2-3, Enforcement Regulations of the Design Act Form 12). If the appellant writes the identification number, the appellant may omit the address

(Enforcement Regulations of the Design Act Form 12, Act on Special Provisions for Procedures Related to Industrial Property Right Article 2).

B. In the procedures of any trial/appeal other than those mentioned above (an invalidation trial, an advisory opinion, etc.), the demandant or demandee states the name (appellation) and address (domicile) of the registered holder of the international registration in the application documents in the original language. When writing in the original language, the demandant/demandee uses the same characters as those used in the international register (Enforcement Regulations of the Design Act Article 2-3). There is no need to state the same in Japanese.

C. In the procedures of an appeal against an examiner's decision of refusal and an appeal against an examiner's decision to dismiss amendment, the JPO states the name (appellation) and address (domicile) of the appellant in Japanese as well as in the original language in the documents to be dispatched (an appeal decision, etc.).

D. In the procedures of any trial/appeal other than those mentioned above, the JPO states the name (appellation) and address (domicile) of the registered holder of the international registration in the original language in the documents to be dispatched.

(2) Change of the name (appellation) or address (domicile) of the demandant/appellant or the demandee/appellee

A. If the registered holder of the international registration needs to change in the name (appellation) and address (domicile) of the registered holder in the international register, the registered holder sends a notice to the International Bureau of WIPO (hereinafter simply referred to as the "International Bureau") (Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement Article 21).

B. In the procedures of an appeal against an examiner's decision of refusal and an appeal against an examiner's decision to dismiss amendment, if the

registered holder of the international registration needs to change in the name (appellation) and address (domicile) registered as the information of the applicant for use of the identification number, the registered holder of the international registration submits a notice of change to the Commissioner of the JPO. In any trial/appeal other than those specified above, there is no need to submit a notice of change to the Commissioner of the JPO (Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 4 (1)).

(3) Change in ownership

A. The registered holder of the international registration is required to submit a notice to the International Bureau in order to transfer the ownership of the international registration (Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement Article 21).

When the transfer of the ownership is recorded in the international register, the JPO will recognize that the change of the ownership has been properly completed with the JPO. The succession to the right to obtain a design registration or the transfer of the design right based on the international registration will take effect in Japan as well (Design Act Article 60-11, Article 60-19).

However, in Japan, since the design rights to the principal design and related design may not be transferred independently, if any change of ownership that corresponds to such independent transfer is registered in the international register, the JPO sends the International Bureau a declaration to the effect that the change of ownership registered in the international register will not take effect (Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement Article 21-2).

B. In the procedures of an appeal against an examiner's decision of refusal and an appeal against an examiner's decision to dismiss amendment, if a new registered holder who has succeeded the design right does not have an

identification number, the JPO assigns an identification number during the first procedure (submission of a notice of appointment of agent, etc.) that the new registered holder takes with the JPO after the design right has been transferred (Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 3 (3) (xiv)). The JPO does not give an identification number to a new registered holder in any trial/appeal other than those specified above.

(4) Determination on the identity of the demandant/appellant or the demandee/appellee

A. In the procedures of an appeal against an examiner's decision of refusal and an appeal against an examiner's decision to dismiss amendment, the JPO determines the identity of the appellant by verifying the name (appellation) and address (domicile) in the original language as well as in Japanese in the application documents and also the identification number against the registered information on the applicant that links to the international register and the relevant case.

B. In any trial/appeal other than those specified above, if the demandant or the demandee is a registered holder of the international register, the JPO determines the identity of said person by verifying the name (appellation) and address (domicile) of said person in the original language in the application documents against the information registered in the international register.

2. Japanese Translation of Information in the Application

An administrative judge confirms the translation of the article to the design, the description of the article to the design, and the description of the design prepared during the examination. If any amendment is made to such information in a trial/appeal, an administrative judge prepares a Japanese translation of the amended part. If the design is registered, the Japanese

translation is published in a Japanese Design Gazette (Design Gazette concerning the registration) as referential information.

3. Notification to the International Bureau of WIPO

(1) When an appeal decision to the effect that the registration is to be made becomes final and binding in the appeal against an examiner's decision of refusal, and the registration of establishment of the design right is made, the JPO sends a "notification of withdrawal of refusal" or a "statement of grant of protection" to the International Bureau (Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement Article 18, Article 18-2).

(2) When a trial decision to the effect that the registration is to be invalidated becomes final and binding in a trial for invalidation, and the final registration is made, the JPO sends a "notification of invalidation" to the International Bureau (Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs Article 15, Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement Article 20).

4. Refund of Individual Designation Fee

(1) When an international application for design registration has been withdrawn, or an examiner's decision or an appeal decision to refuse an international application for design registration has become final and binding, the JPO refunds the amount as provided in the Cabinet Order upon the request of the person who paid the individual designation fee (Design Act Article 60-22 (1)).

A person who paid an individual designation fee may not file a request for refund after the expiration of six months from the date on which the international application for design registration has been withdrawn, or an examiner's decision or an appeal decision to refuse the international

application for design registration has become final and binding (Design Act Article 60-22 (2)).

(2) A registration fee (an amount that corresponds to the registration fee, which is included in the individual designation fee) for each year from the year following the year in which the JPO finalized its decision that the registration is to be invalidated is not covered by the request of refund (Design Act Article 60-21 (3)).

(Revised Dec 2023)