

01-01 PUDT

Inspection of Document and Submission of Report for Trade Secret

1. Inspection of Document

Any person may file a request for inspection of documents concerning a trial/appeal case, a case for an opposition to grant of patent/an opposition to registration of trademark and a case for advisory opinion. However, the documents listed in the Patent Act Article 186 (1) (i)~(vi) (including cases where applied mutatis mutandis pursuant to the Utility Model Act Article 55 (1)), the Design Act Article 63 (1) (i)~(vii) and the Trademark Act Article 72 (1) (i)~(iv) shall not be permitted to inspect when the Commissioner of the Patent Office considers it necessary that the secret should be protected pursuant to the Formality Examination Handbook 58.20.

(1) Documents for cases for an appeal against examiner's decision of refusal, a trial for correction, or a design (trademark) appeal against the examiner's decision to dismiss amendment

Inspection of documents for the cases specified above (an appeal against examiner's decision of refusal, a trial for correction, or a design (trademark) appeal against the examiner's decision to dismiss amendment)*¹ shall not be permitted until a formality examination of a written request of a trial is completed.

Note:*¹ These cases include a case for retrial against a final and conclusive trial decision.

(2) Documents for cases for a trial for invalidation, a trial for rescission the trademark registration, an opposition to grant of patent/an opposition to registration of trademark, or an advisory opinion

Inspection of documents for the cases specified above (a trial for invalidation (including a trial for invalidation of registration of an extension of term, hereinafter the same applies in this section), a trial for rescission the trademark registration, an opposition to grant of patent/an opposition to registration of trademark*² or an advisory opinion) shall not be permitted until a duplicate of a written request for trial, a written

opposition (patent/registration of trademark) or a request for advisory opinion is served (sent).

Note:*² These cases include a case for retrial against a final and conclusive trial decision.

(3) Rules common to all trial/appeal cases

A. Documents which are drafted by JPO such as a trial/appeal decision shall be permitted to inspect after the service of the documents (or delivery, for the documents which take effect of service by delivery).

B. Documents made by an audiotape, etc. shall be inspected mainly by a duplicate of the audiotape, etc.

C. When an inspection may disrupt the proceedings of a trial/appeal case, the separate specific period of time for inspection shall be designated.

2. Submission of Report that Documents of Trial for Invalidation, Trial for Rescission of Registered Trademark or Advisory Opinion Includes Trade Secret

(1) Overview of submission of report

In a case where a trade secret held by a party concerned or an intervener of a case is included in the document for the case of a trial for invalidation or a trial for rescission of registered trademark*³ (hereinafter referred to as “a trial for invalidation, etc.” in this section), the party concerned or the intervener of the case who demands prohibition of inspection of the document can submit a report to the Commissioner of the Patent Office or a chief administrative judge to the effect that the document includes a trade secret (the Patent Act Article 186 (1) (iv), the Utility Model Act Article 55 (1) the Patent Act Article 186 (1) (iv), the Design Act Article 63 (1) (v), the Trademark Act Article 72 (1) (i), Regulation for Enforcement of the Patent Act Article 50-14, the Utility Model Article 23 (xii) Regulation for Enforcement of the Patent Act Article 50-14, Regulation for Enforcement of the Design Article 19 (viii) Regulation for Enforcement of the Patent Act Article 50-14, Regulation for Enforcement of the Trademark Article 22 (xi) → Regulation for Enforcement of the Patent Act Article 50-14).

In a case where a trade secret held by a party concerned is included in the document for the case of an advisory opinion, the party concerned of the case who demands

prohibition of inspection of the document can submit a report to the Commissioner of the Patent Office or a chief administrative judge to the effect that the document includes the trade secret (the Patent Act Article 186 (1) (ii), the Utility Model Act Article 55 (1) → the Patent Act Article 186 (1) (ii), the Design Act Article 63 (1) (iii), the Trademark Act Article 72 (1) (ii), Regulation for Enforcement of the Patent Act Article 40 → Regulation for Enforcement of the Patent Act Article 50-14, Regulation for Enforcement of the Utility Model Act Article 23 (9) → Regulation for Enforcement of the Patent Act Article 40 → Regulation for Enforcement of the Patent Act Article 50-14, Regulation for Enforcement of the Design Act Article 19 (5) → Regulation for Enforcement of the Patent Act Article 40 → Regulation for Enforcement of the Patent Act Article 50-14, Regulation for Enforcement of the Trademark Act Article 22 (4) → Regulation for Enforcement of the Patent Act Article 40 → Regulation for Enforcement of the Patent Act Article 50-14). Note:*³ These cases include a case for retrial against a final and conclusive trial decision.

(2) Procedures for submission of report

In a case where a party concerned (or an intervener) submits a report that the document for the case of a trial for invalidation, etc. or an advisory opinion includes trade secret held by a party concerned (or an intervener), the party concerned (or the intervener) shall conduct such submission in a format specified by Regulation for Enforcement of the Patent Act Form 65-8 (a Submission of Report concerning Trade Secret). Said report preferably submits with the document which includes the trade secret or submits as soon as possible after submission of said document.

(Revised Jun.2019)