

12—04 PUDT**Exclusion and Refrainment of Administrative Judges
(Administrative Judge's Involvement in Prior Decision
by the Examiner)**

1. A person who satisfies grounds for exclusion (→ 59-01) regulated under the Patent Act Article 139 (1) each item (the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(5)) shall be refrained from the designation of administrative judges (→ 12-01).

2. One of the grounds for exclusion is regulated in the Patent Act Article 139(1) (vi) ((the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(5)), stating “an administrative judge shall be excluded from performing his/her duties when he/she was involved in the procedures relating to the examiner's decision who is being appealed in the case as the examiner”. Therefore, if an administrative judge satisfies any of the following items in an appeal against examiner's decision of refusal, he/she shall not be designated as an administrative judge.

(1) Patent

A. Before a decision of refusal

- (A) An examiner and an assistant examiner notified reasons for refusal
- (B) An examiner and an assistant examiner rendered a decision of refusal
- (C) An examiner and an assistant examiner rendered a decision to dismiss amendment

B. In a reexamination by the examiner before trial

- (A) An examiner and an assistant examiner notified reasons for refusal
- (B) An examiner and an assistant examiner notified a reexamination

before trial

(2) Design

Before a decision of refusal

(A) An examiner and an assistant examiner notified reasons for refusal

(B) An examiner and an assistant examiner rendered a decision of refusal

(C) An examiner and an assistant examiner rendered a decision to dismiss amendment

(3) Trademark

Before a decision of refusal

(A) An examiner and an assistant examiner notified reasons for refusal

(B) An examiner and an assistant examiner rendered a decision of refusal

(C) An examiner and an assistant examiner rendered a decision to dismiss amendment

3. Besides a person who should be excluded ipso jure as mentioned above, a person below shall not be designated as an administrative judge taking into consideration as much as possible of cases satisfying the grounds for exclusion and recusation (→ 59-01) on designation of an administrative judge.

(1) Trial for invalidation

A. Patent

(A) An examiner and an assistant examiner rendered decision for refusal

(B) An examiner and an assistant examiner rendered a decision for grant of patent

(C) An examiner and an assistant examiner notified reasons for refusal

(D) An examiner and an assistant examiner announced a publication after examination

(E) An examiner and an assistant examiner notified a reexamination before trial

B. Design

- (A) An examiner and an assistant examiner rendered decision for refusal
- (B) An examiner and an assistant examiner rendered a decision for registration
- (C) An examiner and an assistant examiner notified reasons for refusal
- (D) An examiner and an assistant examiner rendered a decision to dismiss amendment

C. Trademark

- (A) An examiner and an assistant examiner rendered decision for refusal
- (B) An examiner and an assistant examiner rendered a decision for registration
- (C) An examiner and an assistant examiner notified reasons for refusal

(2) Trial for invalidation of registration of utility model

An examiner and an assistant examiner prepared Examiner's technical opinion as to registrability of the utility model

(3) Opposition to grant of patent (Opposition to registration of trademark)

A. Patent

- (A) An examiner and an assistant examiner rendered decision for refusal
- (B) An examiner and an assistant examiner rendered a decision for grant of patent
- (C) An examiner and an assistant examiner notified reasons for refusal
- (D) An examiner and an assistant examiner notified a reexamination before trial

B. Trademark

- (A) An examiner and an assistant examiner rendered decision for refusal
- (B) An examiner and an assistant examiner rendered a decision for registration
- (C) An examiner and an assistant examiner notified reasons for refusal

(4) Appeal against examiner's decision to dismiss amendment

An examiner and an assistant examiner dismissed a written amendment subject to a decision to dismiss amendment

4. Examples for no involvement of administrative judge in prior decision by the examiner

- (1) Examiner-in-chief or Manager, etc. approved merely as a supervisor
- (2) An examiner and an assistant examiner ordered a written amendment under the name of Commissioner upon examination

5. The following cases are not applicable to involvement of administrative judge in prior decision by the examiner, therefore, substantial refrainment from designation (→ 59-01) shall not be made.

- (1) More than one trials for invalidation for the same right
- (2) Opposition to grant of patent (Opposition to registration of trademark) and Trial for invalidation for the same right
- (3) Trial for invalidation and Trial for correction for the same right
- (4) Appeal against examiner's decision of refusal and Trial for invalidation to the right granted by the appeal case
- (5) Appeal against examiner's decision of refusal and Opposition to grant of patent (Opposition to registration of trademark) to the right granted by the appeal case
- (6) Advisory opinion and other case for the same right

(Revised Oct. 2015)