

12—04 PUDT

Exclusion and Refrainment of Administrative Judges (Administrative Judge’s Involvement in Prior Decision by the Examiner)

1. A person who is applicable to the grounds for exclusion (→ 59-01) regulated under the Patent Act Article 139(1) each item (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) shall be refrained from the designation of administrative judges (→ 12-01).

2. One of the grounds for exclusion regulated under the Patent Act Article 139(1) (vi) (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), states “an administrative judge shall be excluded from conducting his/her duties when he/she was involved as the examiner in the case connected to the appeal that has been filed against the examiner’s decision”. Therefore, if an administrative judge is applicable to any of the following items in the case of 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 who has notified reasons for refusal
- (B) An examiner who has rendered a decision of refusal
- (C) An examiner who has rendered a decision to dismiss amendment

B. In a reexamination by the examiner before trial

- (A) An examiner who has notified reasons for refusal
- (B) An examiner who has notified a reconsideration report

(2) Design

Before a decision of refusal

- (A) An examiner who has notified reasons for refusal
- (B) An examiner who has rendered a decision of refusal
- (C) An examiner who has rendered a decision to dismiss amendment

(3) Trademark

Before a decision of refusal

- (A) An examiner who has notified reasons for refusal
- (B) An examiner who has rendered a decision of refusal
- (C) An examiner who has 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 in principle taking into consideration as much as possible cases being applicable to the grounds for exclusion and recusation (→ 59-01) in designating an administrative judge.

(1) Trial for invalidation

A. Patent

- (A) An examiner who has rendered a decision of refusal
- (B) An examiner who has rendered a decision to grant of patent
- (C) An examiner who has notified reasons for refusal
- (D) An examiner who has announced a publication after examination
- (E) An examiner who has notified a reconsideration report
- (F) An examiner who has rendered a decision to dismiss amendment

B. Design

- (A) An examiner who has rendered a decision of refusal
- (B) An examiner who has rendered a decision of registration
- (C) An examiner who has notified reasons for refusal
- (D) An examiner who has rendered a decision to dismiss amendment

C. Trademark

- (A) An examiner who has rendered a decision of refusal
- (B) An examiner who has rendered a decision of registration

(C) An examiner who has notified reasons for refusal

(D) An examiner who has rendered a decision to dismiss amendment

(2) Trial for invalidation of registration of utility model

An examiner who has 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 who has rendered a decision of refusal

(B) An examiner who has rendered a decision to grant of patent

(C) An examiner who has notified reasons for refusal

(D) An examiner who has notified a reconsideration report

(E) An examiner who has rendered a decision to dismiss amendment

B. Trademark

(A) An examiner who has rendered a decision of refusal

(B) An examiner who has rendered a decision of registration

(C) An examiner who has notified reasons for refusal

(D) An examiner who has rendered a decision to dismiss amendment

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

An examiner who has rendered a decision to dismiss amendment that was the subject of the decision to dismiss amendment

(5) An assistant examiner who has assisted the examiner applicable to the above 2. (1)~(3) or 3. (1)~(4), and has performed administrative work related to examination such as a relevant notice of reasons for refusal.

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

(1) An examiner-in-chief or a manager, etc. who has made a decision merely as a supervisor

5. The following cases are not applicable to involvement of an

administrative judge in the prior decision as the examiner, and therefore, substantial refrainment from designation (→ 59-01) shall not be made.

- (1) More than one trial for invalidation for the same right
- (2) An opposition to grant of patent (opposition to registration of trademark) and a trial for invalidation for the same right
- (3) A trial for invalidation and a trial for correction for the same right
- (4) An appeal against examiner's decision of refusal and a trial for invalidation to the right granted by the appeal case
- (5) An appeal against examiner's decision of refusal and an opposition to grant of patent (opposition to registration of trademark) to the right granted by the appeal case
- (6) Hantei (advisory opinion) and another case for the same right
- (7) A trial case in which a trial decision was rescinded and has been remanded by the court (→ 83-02.2).

(Revised December 2023)