

12—01 PUDT
Notice of Designation and Change of Designation of
Administrative Judge and Trial Clerk

1. Commissioner of the Japan Patent Office shall designate administrative judges consisting of a panel and a trial (appeal) clerk for proceeding a case of an opposition to grant of patent (an opposition to registration of trademark), a trial (appeal), a retrial and an advisory opinion (the Patent Act Articles 71(2), 116, 117, 137(1), 144-2(1), 174(1)-(4); the Utility Model Act Articles 26, 41, 45; the Design Act Article 25(2), 52, 58(2)-(4); the Trademark Act Articles 28(2), 43-5, 43-5-2(1), 56(1), 61, 68(4),(5)).

2. Initial designation and change of designation shall be notified accordingly (Enforcement Regulations of the Patent Act Articles 40, 48(2), 50-16; Enforcement Regulations of the Utility Model Act Article 23(9)(12); Enforcement Regulations of the Design Act Article 19(5)(8); Enforcement Regulations of the Trademark Act Article 22(4)-(6)).

3. In ex-parte cases, the designated names shall be notified after a certain period of time is secured (for submission of a petition, or for request for an interview) before initiation of the proceedings. The proceedings sometimes initiate immediately after the designated names are notified in case an amendment is ordered, the case is subject to an accelerated trial examination, or reasons for refusal are solved by amendment, etc. of the designated goods/services.

4. In ex-parte cases and cases for an opposition to grant of patent (an opposition to registration of trademark), the designated names shall be

notified accompanied with a duplicate of written request for trial, etc. for quick proceedings of a written reply, etc.

5. An appeal against examiner's decision of refusal becomes subject to reexamination by the examiner before trial, administrative judges and an appeal clerk are designated after the reexamination by the examiner before trial.

6. Intervenors are entitled to request exclusion or recusation (→ 59-01) (the Patent Act Articles 140, 141(1), 144-2(5); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). Therefore, when the designation is changed after an intervenor is permitted to join the trial, such the change is also notified to the intervenor.

(Revised Oct. 2015)

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

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