

21—00 PUDT

Examination Procedures of Formality Requirements

1. Basic Concept

Formalities of a demand/request for trial/appeal should be examined to determine whether it complies with the requirements of the law before the proceedings on the merits.

A chief administrative judge has the authority over formalities of cases of a trial/appeal (except a reexamination by the examiner before trial for patent), an opposition to grant of patent (an opposition to registration of trademark), or Hantei (advisory opinion) (Patent Act Article 133), and a trial clerk and a panel respectively conduct formality examinations and proceedings of cases under the authority.

The Commissioner of the Japan Patent Office has the authority over formalities of a trial case related to a reexamination by the examiner before trial for patent.

In the proceedings of formalities, it is examined whether a written demand/request for trial/appeal, an opposition to grant of patent (an opposition to registration of trademark), or a demand for Hantei (advisory opinion) satisfies formal description requirements regulated under the Patent Act Article 131(1), the Patent Act Article 115(1), the Utility Model Act Article 38(1), the Design Act Article 52, the Trademark Act Articles 43-4(1), 56(1) and 68(4). The examination items of formalities are as listed below, and ex officio examination (→ 36-01 3.) items such as requirements of demand/request, etc. are also examined simultaneously.

“Purport of the demand and the reasons therefor” are also a formality requirement item (Patent Act Article 131(1)(iii)). It should be carefully

confirmed whether this requirement is satisfied, otherwise it could interfere with the proceedings on the merits.

2. Inter Partes Trial

(1) Formality requirements of a demand for trial (Patent Act Article 131(1), Utility Model Act Article 38(1), Design Act Article 52, Trademark Act Articles 56(1), 68(4))

Whether a written demand includes a description of a demandant, a demandee, a representative of a corporation or an association which is not a juridical person (only a demandant. If procedures are taken by an agent, no entry required), a legal agent (→ 23-01), an authorized agent (→ 23-02), identification of the trial case, and purport of the demand and the reasons therefor; determination of the subject matter (the industrial property right) (a patent number, a registration number); and payment of fees (such as attachment of patent revenue stamps), etc.

(2) Relationship between reasons and evidence

Whether a relationship between reasons and relevant evidence (Patent Act Article 131(2)) is properly described.

(3) Confirmation of a party concerned

Whether a party concerned is an actual person, whether he/she corresponds to a true party concerned by comparing with the description in a power of attorney, a registration ledger, etc.

(4) Whether a party concerned has ability to conduct the procedures (→ 22-01 6.) (Patent Act Articles 6 ~ 8)

(5) Whether there is authority of representation and the scope of the authority (Patent Act Articles 7 ~ 14 (except Article 10), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(6) Whether a party concerned is eligible for being a party (→ 22-01 7.), whether it is a mandatory joint trial (→ 22-03) (Patent Act Article 132(2)(3)(4), Utility Model Act Article 41, Design Act Article 52, Trademark

Act Articles 56(1), 68(4)).

(7) Whether a demand is filed in a statutory period (Patent Act Articles 126, 173(1)(2)(4), Utility Model Act Article 45, Design Act Article 58(1), Trademark Act Articles 47, 52, 53(3), 53-3, 61).

(8) Whether required documents are attached (→ 21-01), whether the required number (the number of demandees and an additional one for the proceedings) of duplicates are prepared, and especially in a trial for correction or a trial for invalidation whether there is a full text of both the corrected specification and claims (an entirely corrected specification, etc.) or corrected drawings (Patent Act Article 131(4)).

(9) Whether there is an identification number of the case for preservation of evidence only when the examination of evidence was carried out for preservation of evidence before a trial is demanded (Enforcement Regulations of the Patent Act Article 46(2), Rules of Civil Procedure Article 54).

3. Appeal (Ex Parte) Trial

(1) Formality requirements of a request for appeal (Patent Act Article 131(1), Design Act Article 52, Trademark Act Article 56(1))

Same as the above item 2. (1), except that the subject matter of the request is an application, that there is no demandee, and that an association that is not a juridical person cannot be an appellant.

(2) Comparison of the descriptions of an appellant with a power of attorney, application documents, applicant registration information, etc.

(3) Whether there is authority of representation and the scope of the authority (Patent Act Articles 7 ~ 14 (except Article 10), Design Act Article 68(2), Trademark Act Article 77(2)).

(4) Whether a party concerned is eligible for being a party, whether all applicants (or the successors) who “received the final refusal” jointly request an appeal (Patent Act Articles 121(1), 132(3), Design Act Articles 46(1), 47(1), 52, Trademark Act Articles 44(1), 45(1), 56(1)).

(5) Whether a request is filed in a statutory period (Patent Act Articles 121, 173(1)(2)(4), Design Act Articles 46, 47, 58, Trademark Act Articles 44, 45, 61).

(6) Whether required documents are attached (→ 21-01).

4. Opposition to Grant of Patent (Opposition to Registration of Trademark)

(1) Formality requirements of a petition of opposition (Patent Act Article 115(1), Trademark Act Articles 43-4(1), 68(4))

Same as the above item 2. (1).

(2) Whether there is authority of representation and the scope of the authority (Patent Act Articles 7 ~ 14 (except Article 10)).

(3) Whether an opposition is filed in a statutory period (Patent Act Article 113(1), Trademark Act Article 43-2).

(4) Whether required documents are attached (→ 21-01), whether the required number (the number of right holders and an additional one for the proceedings) of duplicates are prepared, etc.

5. Hantei (Advisory Opinion)

Same as the above item 2. The Patent Act Article 131, etc. applies mutatis mutandis to the Patent Act Article 71(3).

(Revised December 2023)