

21—00 PUDT

Examination Procedures of Formality Requirements

1. Basic Concept

A formality of a demand/request for trial/appeal should be examined whether it satisfies with the requirements of the law before proceedings of the merits.

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

Commissioner of the Japan Patent Office has an authority over formalities for a trial case for 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 an 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 are as below and ex officio examination (→ 36-01 3.) items such as requirements of demand/request, etc. are also examined.

“Purport of the demand and the reasons therefor” is also a formality requirement item (the Patent Act Article 131(1)(iii)). It should be confirmed carefully whether this requirement is satisfied, otherwise it could interfere

with the proceedings of the merits.

2. Inter-partes Trial

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

Whether the written demand includes the descriptions such as a demandant, a demandee, a representative of a corporation or an association that 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), indication of the trial case, purport of the demand and the reasons therefor, and also includes determination of the subject matter (the industrial property rights) of the demand (a patent number, a registration number) and payment of fees (such as attachment of patent revenue stamps), etc.

(2) Relationship between reasons and evidences

Whether a relationship between reasons and relevant evidences (the Patent Act Article 131(2)) are described properly.

(3) Confirmation of a party concerned

Whether a party concerned is an actual person, whether he/she corresponds to a true party concerned by checking against a power of attorney and a registration register

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

(5) Whether there is a power of attorney and its scope (the Patent Act Articles 7 ~ 14 excluding Article 10, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(6) Whether a party concerned is eligible for being a party (→ 22-01 7.), whether it is a compulsory joint trial (→ 22-03) (the Patent Act Article 132(2)(3)(4), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

(7) Whether a demand is filed in a statutory period (the Patent Act Articles 126, 173(1)(2)(4), the Utility Model Act Article 45, the Design Act Article 58(1), the 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, specifically, whether there are duplicates of a full text of the corrected specification and claims (an entirely corrected specification, etc.) or drawings in a trial for correction or a trial for invalidation (the Patent Act Article 131(4)).

(9) Whether there is an indication of a case number of preservation of evidences when the evidences are examined for preservation of evidences before a trial is demanded (Enforcement Regulations of the Patent Act Article 46(2), Rules of Civil Procedure Article 54).

3. Appeal Trial

(1) A formality of a request for appeal (the Patent Act Article 131(1), the Design Act Article 52, the Trademark Act Article 56(1))

Similar to the above 2. (1), except for the following points: the subject matter of the request is an application; there is no demandee; and an association that is not a juridical person cannot be an appellant.

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

(3) Whether there is a power of attorney and its scope (the Patent Act Articles 7 ~ 14 excluding Article 10, the Design Act Article 68(2), the 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 (the Patent Act Articles 121(1), 132(3), the Design Act Articles 46(1), 47(1), 52, the Trademark Act Articles 44(1), 45(1), 56(1)).

(5) Whether a request is filed in a statutory period (the Patent Act Articles

121, 173(1)(2)(4), the Design Act Articles 46, 47, 58, the 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) A formality of an opposition (the Patent Act Article 115(1), the Trademark Act Articles 43-4(1), 68(4))

Similar to the above 2. (1).

(2) Whether there is a power of attorney and its scope (the Patent Act Articles 7 ~ 14 (excluding Article 10)).

(3) Whether an opposition is filed in a statutory period (the Patent Act Article 113(1), the 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. Advisory Opinion

Similar to the above 2. The Patent Act Article 131, etc. applies *mutatis mutandis* to the Patent Act Article 71(3).

(Revised December 2020)