

22—01 P U D T

Party Concerned

1. Introduction

Issues of a party concerned are extensive and wide-ranging: therefore, specific examples regarding requirements for a demand/request for trial/appeal will be discussed in Section 22-02, and a joint trial will be covered in Section 22-03. Other issues will be considered in this section. An opposition to grant of patent (an opposition to registration of trademark) shall be handled in the same way as a demand/request for trial/appeal.

2. Party Concerned

A party concerned is a person legally involved in a specific relationship, or in legal requirements, legal facts, etc. that are the cause of the specific relationship. A party concerned of a trial/appeal indicates a demandant and a demandee of a trial/appeal, or a demandant and a demandee of a retrial.

An intervenor is distinct from a party concerned under the Patent Act but is almost in the same position as a party concerned (→ 57-00~57-09).

3. Determination of a Party Concerned

(1) In a trial/appeal, it is necessary to clarify who a party concerned is, which not only determines to whom a trial decision is addressed, but also determines issues such as exclusion (Patent Act Article 139, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) or recusation (Patent Act Article 141, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) of an administrative judge, suspension or termination of the proceedings (Patent Act Articles 22~24, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)). Furthermore, legal capacity, capacity to proceed, and

eligibility for being a party are also matters to be determined about the individual and they should be clarified in a trial/appeal.

(2) A party concerned is determined by comprehensively observing the contents of a written demand/request for trial/appeal, and documents submitted from the time of filing an application to the time of ending the period of filing a request for appeal for ex parte appeal.

An indication of a party concerned is required in a written demand/request for trial/appeal (Patent Act Article 131(1), Utility Model Article 38(1), Design Act Article 52, Trademark Act Articles 56(1) and 68(4)). However, such an indication is not the sole information and a party concerned should be determined from the entire purport in the written demand/request for trial/appeal and documents submitted from the time of filing an application to the time of ending the period of filing a request for appeal for ex parte appeal (→ 22-02 1.).

4. Requirements of a Party Concerned in Demanding/Requesting Trial/Appeal

It is required for a party concerned to fulfill the requirements of a demand/request for trial/appeal such as the existence of a party concerned, capacity to proceed, and eligibility for being a party concerned (→ 5. ~ 8.).

These requirements of a demand/request for trial/appeal are a prerequisite for proceedings of the merits and if a deficiency is found, it is no longer necessary to enter the proceedings or to continue the proceedings.

5. Legal Capacity

Legal capacity is a status or a qualification that can be the subject of rights, and a natural person and a corporation may own legal capacity.

The Civil Code regulates the principle of equality of domestic and foreign people (Civil Law Article 3(2) and Article 35(2)), whereas in the Patent Act, a foreigner who does not have a domicile or residence (a sales office for a corporation) is not considered to have legal capacity except when applicable

to any of the Patent Act Article 25(i), (ii), (iii) (Utility Model Act Article 2-5(3), Design Act Article 68(3), Trademark Act Article 77(3)).

6. Capacity to Proceed

Capacity to proceed is the status or qualification to be the subject of procedures, and in principle a person having legal capacity (\rightarrow 5.) owns capacity to proceed.

In the Patent Act, even an association or a foundation which does not have legal capacity, if it designates a representative or an administrator, capacity to proceed is allowed only limited to a certain procedure such as a demand/request for trial/appeal, an opposition to grant of patent (an opposition to registration of trademark), or a trial for invalidation (Patent Act Article 6, Utility Model Act Article 2-4, Design Act Article 68(2), Trademark Act Article 77(2)).

There is a provision to restrict capacity to proceed of minors, adult wards, etc. (Patent Act Article 7(1)(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) and overseas residents (Patent Act Article 8(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) (a legal representative, a curator, a patent administrator \rightarrow 23-01, 23-06, 23-04).

When a chief administrative judge considers a person performing a procedure is not appropriate for the procedure, the administrative judge may order an agent to perform the procedure instead (Patent Act Article 13(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

7. Eligibility for Being a Party Concerned

(1) Eligibility for being a party concerned is a qualification necessary for performing procedures as a party concerned and receiving a trial/appeal decision regarding a specific legal relationship claimed in the

demand/request. In a particular case, a bankruptcy trustee, etc. also has a qualification of eligibility for being a party concerned.

Eligibility for being a party concerned is determined based on a specific legal relationship and should be distinguished from a qualification or a personal ability which is generally and abstractly determined such as legal capacity or capacity to proceed and has nothing to do with a particular incident.

(2) Eligibility for being a party concerned of a trial/appeal

A. Appellant of ex parte appeal

(A) A person who may request an appeal against examiner's decision of refusal

A person who has received a decision of final rejection (including a successor of the right) (Patent Article 121(1), Design Act Article 46(1), Trademark Act Article 44(1)).

(B) A person who may request an appeal against examiner's decision to dismiss amendment

A person who has received a dismissal of amendment (including a successor of the right) (Design Act Article 47(1), Trademark Act Article 45(1)).

B. A demandant of inter partes trial, etc.

(A) A demandant of inter partes trial (excluding a person who may request a trial for correction)

It is required an interest in demanding a trial for invalidation of patent (the Patent Act Article 123(2)) and trademark registration (Trademark Act Article 46(2)) (→ 31-00~31-02), while anyone may demand a trial for invalidation of utility model registration (Utility Model Act Article 37(2)), a trial for invalidation of design (Design Act Article 48(2)), a trial for rescission of trademark registration (Trademark Act Articles 50, 51, 52-2, 53). However, a demandant for a trial for invalidation of patent, utility model registration and design registration based on reasons for invalidation relating to ownership of rights is limited to a person who has a right to obtain a patent,

a utility model registration and a design registration (the proviso of the Patent Act Article 123 (2), the proviso of the Utility Model Act Article 37(2), the proviso of the Design Act Article 48(2)), and a demandant for a trial for rescission of trademark registration due to unauthorized registration by the agent (representative) is limited to a person who has the right pertaining to the trademark that has been registered without authorization (Trademark Act Article 53-2).

(B) A person who may demand a trial for correction

A person who may demand a trial for correction is a patentee (Patent Act Article 126(1)).

C. Demandee of inter partes trial

A demandee of inter partes trial is a patentee, a right holder of utility model, a right holder of design, or a right holder of trademark.

Sometimes a right holder registered in a patent (registration) register is not a true right holder (for example, the right is succeeded to an inheritor, a surviving company after merger, a split company, etc. for reasons of death of the right holder, extinction of a company due to merger, company split, etc.) Such facts are found by a demandant during confirmation processes of an address and a name of a demandee before filing a trial, a demandant should file a trial with a true right holder as a demandee after searching the true right holder and identifying the address and name.

8. Proceedings of a Party Concerned

Proceedings of a party concerned are conducted prior to the proceedings of the merit regarding the validity of the demand, and when a deficiency is found in the requirements of a party concerned, the case shall be handled as follows.

(1) When an indication of a party concerned violates formalities

When an indication of a party concerned violates formalities (Patent Act Article 131(1), Utility Model Act Article 38(1), Design Act Article 52,

Trademark Act Articles 56(1), 68(4)) (→9.), a chief administrative judge orders a demandant/appellant to make amendments by specifying a reasonable period of time (Patent Act Article 133(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), and then continues the proceedings after having a response.

When a demandant fails to amend within the designated period of time, the written demand/request will be dismissed by decision (Patent Act Article 133(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(2) When requirements of a demand/request for trial/appeal about a party concerned are not fulfilled

(3) When a trial/appeal case which has become once pending and requirements of demand for the trial/appeal about a party concerned (→4.) are not fulfilled, a deficiency of the requirements may be corrected or may not be corrected by amendment. These cases are handled as follows:

A. When a deficiency is corrected by amendment

A chief administrative judge makes an inquiry (Patent Act Article 134(4), Utility Model Act Article 39(4), Design Act Article 52, Trademark Act Articles 56(1), 68(4)) or an order for amendment (Patent Act Article 133(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) by designating the considerable period of time.

(A) To continue the proceedings when a deficiency is corrected by amendment, etc.

(B) To dismiss a written demand/request by decision when a deficiency is not corrected during the designated period of time or the submitted amendment is not approved (Patent Act Article 133(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

B. When there is no possibility of correction by amendment

When there is no possibility of correction by amendment, such as a change of a party concerned, the demand/request for trial/appeal will be dismissed

as unlawful by decision without making an inquiry or an order for amendment (Patent Act Article 135, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

9. Examples of amendments that may be made when requirements for demand/request for trial/appeal about a party concerned are not fulfilled

(1) An appellant of an ex parte trial

A. When it is recognized that an appellant and an applicant are the same person from indications of an appellant in a written request and in documents attached to the written request

B. When it is recognized that an appellant and an applicant are not the same person and a case falls under the following items

(A) When a fact of inheritance or other general succession is not duly proceeded but is simply indicated in a written request, order an amendment and continue the proceedings after having a response.

(B) When a case falls under any of the following, just continue the proceedings without any action

a. Inheritance or other general succession is notified before serving a certified copy of dismissal by appeal decision (Patent Act Article 34(5), Design Act Article 15(2), Trademark Act Article 13(2)).

b. Succession of right (excluding inheritance or other general succession) is notified within the statutory period in which an appeal can be requested (Patent Act Article 34(4), Design Act Article 15(2), Trademark Act Article 13(2)).

c. A voluntary amendment is submitted within the statutory period in which a request for appeal can be made, thereby, an appellant becomes a legitimate appellant (Patent Act Article 121, Design Act Articles 46 and 47, Trademark Act Articles 44 and 45).

(2) A demandant of an inter partes trial (→ Interest (31-00 ~ 31-02))

A demandant of a trial for correction is treated in the same way as a

demandee of item (3) A, below.

(3) A demandee of an inter partes trial

A. When it is recognized that a demandee and a patentee are the same person from indications of a demandee in a written demand and a patentee in a patent (registration) register

Regarding a demandee after extinction of the right (→ 22-04).

B. When it is recognized that a demandee and a patentee are not the same person and falls under the following case

When it is assumed that a demandee is not the same as a patentee based on a reason that cannot be attributed to a demandant in a case where a name of the patentee has been changed extremely close to the time of filing a trial, etc., and in that case an inquiry shall be made, and the proceedings shall be continued after having a response.

Regarding a demandee after extinction of the right (→ 22-04).

(4) Lack of legal capacity to proceed

In some cases, the procedures performed by a person lacking legal capacity can be sometimes ratified (Patent Act Article 16, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) or amended, and in such cases, an inquiry (Patent Act Article 134(4)) or an order for amendment (Patent Act Articles 17(3), 133(2), Utility Model Act Article 41, Design Act Article 52, 68(2), Trademark Act Articles 56(1), 68(4), 77(2)) shall be made and the proceedings shall be continued after having a response.

(5) Death or dissolution of a party concerned

When a party concerned dies or dissolves due to a merger after a case is once pending, the case becomes suspended. The proceedings shall be continued after carrying out the succession procedure if there is a successor who may succeed the case as a party concerned (Patent Act Articles 21 ~ 24, 34(5), Utility Model Act Articles 2-5(2), 11(2), Design Act Article 15(2), 68(2), Trademark Act Articles 13(2), 77(2), Succession → 26-02 ~ 26-05).

However, a procedure for succession is not necessary when there is a

privately appointed agent since no suspension occurs (Patent Act Articles 11, 24, (Code of Civil Procedure Article 124(2)), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) (→ 26-04).

In an opposition to grant of patent (an opposition to registration of trademark), since the status of an opponent may not be succeeded, a procedure for the succession is not necessary. After notifying a reason for revocation of patent (trademark registration), the proceedings are continued for making a decision. Before notifying a reason for revocation, an opposition to the patent (trademark registration) shall be dismissed as an unlawful demand.

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