

## 22—03 P U D T

### Joint Trial

1. A joint trial is associated with an issues of eligibility for being a party concern (→ 22-01, 22-02) and an interest (→ 31-00), but a joint trial in this section includes all trial cases involving more than two demandants or demandees. An intervenor (→ 57-00) is handled as a separate issue.

2. The Patent Act regulates a joint trial as follows:

(1) “Where a request for a trial is filed by a joint owner or owners of a patent right or a right to obtain a patent, with regard to the right under joint ownership, all of the said joint owners shall jointly file the request.” (the Patent Act Article 132(3), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4))

(2) “Where a request for a trial is filed against patentees jointly owning a patent right, the demandees in the said request shall be all the joint owners of the said patent right.” (the Patent Act Article 132(2), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4))

(3) “Where two or more persons file a request for a trial for a patent invalidation or a trial for invalidation of the registration of extension of duration concerning the same patent right, the request may be filed jointly.” (the Patent Act Article 132(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4))

Among those regulations, the Patent Act Article 132(2) and the Patent Act Article 132(3) correspond to Mandatory Joint Suit stipulated in the Code of Civil Procedures.

3. A trial which is filed in violation of the regulations of the above (1) and

(2) when a trial is demanded is handled as follows:

(1) Ex parte trial (including a trial against a decision of dismissal of amendment)

It is presumed whether an intention of a joint trial is substantially indicated by comprehensively observing the documents submitted from the time of filing an application to the time of ending the period of filing a demand for appeal (→ 22-01 3.(2)) and the case shall be handled as below:

A. When considering an intention is indicated

When it is considered an intention of a joint trial is substantially indicated in the documents (including application documents) submitted by the time of ending the period of filing a demand for appeal, a chief administrative judge shall order an amendment (the Patent Act Article 133(1), the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) and dismiss the demand by decision if a deficiency is not eliminated as a result of a response of an appellant (the Patent Act Article 133(3), the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) (→ 22-01 8.)

However, regarding a case related to a reexamination by the Examiner before trial, Commissioner of the Japan Patent Office shall order an amendment (the Patent Act Article 17(3)), and dismiss the demand by decision if a deficiency is not eliminated as a result of a response of an appellant (the Patent Act Article 18 (1)).

When it can be inferred that it is a joint trial but confirmation is still required, an inquiry is conducted and after receiving a response to the inquiry, the determination is made.

B. Specific examples recognizing an intention from an indication

(A) When requesting an appeal, a notification of appointment of the representative is submitted and only a name of said representative is described in the written request.

(B) Only describing “Representative XXX” in a written request for

appeal.

- (C) Only describing a name of one person and (two, for example) others in a written request for appeal.
- (D) Although all members of a joint trial authorize one representative (Besides when a document certifying the authority of representation has been filed, it also includes when power of attorney is expected from the entire purport of the request and the information of said application, etc. that the Japan Patent Office has become aware of.) to submit a written request for appeal, the representative describes only some members of the joint trial in a column of appellant of the request by mistake (→ Court cases (3),(4),(10),(11)).
- (E) There is an omission in a column of applicant in a decision of final rejection, and a request for trial is submitted under the names only described in the decision of final rejection.
- (F) A fact of inheritance or other general succession is indicated (Note)
  - In this case, there is obligation to notify Commissioner of the Japan Patent Office under the provision of Patent Act Article 34(5), the Design Act Article 15(2), the Trademark Act Article 13(2), sometimes it is simply indicated (in the wording such as due to death, merger, etc.) in a written request for appeal.

(Note) attached documents for general succession

- a. When a company surviving the merger (absorption merger, consolidation-type merger) notifies the fact

A document certifying the fact of the merger (such as a certificate of registered matters)

- b. When by inheritance

- (a) When inherited by all inheritors

A copy of the family register and a removal from the family register if necessary of an inheritee, and a certified copy of a resident register and supplementary family register for an inheritee

and all inheritors.

(b) When inherited by not all inheritors

Documents stated in the above (a) and an agreement for division of inherited property (→ Examples of Court Decision (5))

(c) When some inheritors renounce the inheritance

Documents stated in the above (a) and a statement of renunciation of inheritance with a filing receipt of the Family Court

(d) When one of the owners died without any inheritors

Certificate certifying no one asserts the right being an inheritor

C. When not recognized as having an intention from an indication

A request for appeal shall be dismissed by appeal decision without ordering any amendment or making an inquiry (the Patent Act Article 134(4), the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) as the deficiency cannot be amended (the Patent Act Article 135, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) (→ Examples of Court Decision (1), (2), (6)~(9)).

(2) Inter partes trial and trial for correction

A request for trial shall be dismissed by trial decision without ordering an amendment or making an inquiry (the Patent Act Article 134(4), the Utility Model Act Article 39(3), the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) as the deficiency cannot be amended (the Patent Act Article 135, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) (→ Examples of Trial Decision (12)).

However,

A. When recognizing the indication of an intention of being substantially a joint trial from the entire purport in the request, an amendment shall be ordered. As a result of the response of the demandant, if a deficiency cannot be eliminated, a request shall be dismissed by decision (the Patent Act Article 133(3), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

B. If it is anticipated that a request for trial was made in violation of the regulations of the Patent Act Article 132(2) the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4) due to the grounds not attributable to the demandant (for example, a name of a right holder is changed very close to filing a request for trial), an inquiry is made and the request shall be processed after receiving a response to the inquiry.

#### 4. Examples of Court Decision and Trial Decision

(1) 1976 (Gyo-ke) 96, July 27, 1977 (Tokyo High Court)

→ 1977 (Gyo-tsu) 112, March 24, 1978 (Supreme Court of Japan, 2<sup>nd</sup> Petty Bench)

(2) 1978 (Gyo-ke) 163, September 30, 1980 (Tokyo High Court)

(3) 1978 (Gyo-ke) 45, October 25, 1978 (Tokyo High Court)

(4) 1978 (Gyo-ke) 208, July 25, 1979 (Tokyo High Court)

(5) 1982 (Gyo-ke) 106, May 29, 1986 (Tokyo High Court)

(6) 1988 (Gyo-ke) 39, July 27, 1988 (Tokyo High Court)

→ 1988 (Gyo-tsu) 158, October 2, 1990 (Supreme Court of Japan, 3<sup>rd</sup> Petty Bench)

(7) 1992 (Gyo-ke) 228, April 14, 1993 (Tokyo High Court)

(8) 1993 (Gyo-ke) 93, December 24, 1993 (Tokyo High Court)

(9) 2005 (Gyo-ke) 10243, June 22, 2005 (IP High Court)

(10) 2009 (Gyo-ke) 10148, November 19, 2009 (IP High Court)

(11) 2010 (Gyo-ke) 10363, May 30, 2011 (IP High Court)

(12) Trial Case No. 3304, 1966, June 19, 1973

#### 5. Burden of Fees of Joint Trial (→ 47-01)

Description of Reasons of Trial Decision and Indication of Conclusion (→ 45-20)

(Revised Feb 2015)