

## 22—03 P U D T

### Joint Trial

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

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

(1) “Where a demand/request for trial/appeal is filed by a joint owner of a patent right or a right to obtain a patent, with regard to the right under joint ownership, all of the joint owners shall jointly file the demand.”

(Patent Act Article 132(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4))

(2) “Where a demand for trial is filed against patentees that jointly own a patent right, the demand must be filed with all of the joint owners as demandees.” (Patent Act Article 132(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

(3) “Where there are two or more persons filing a demand for trial under the Patent Act Article 123(1) concerning the same patent right, these persons may jointly file the demand for trial.” (Patent Act Article 132(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

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

3. A trial/appeal which is filed in violation of the regulations of the above (1) and (2) is handled as follows:

(1) Ex parte appeal (including an appeal against examiner's decision to dismiss amendment)

It is possible to infer whether the 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 request for appeal (→ 22-01 3.(2)) and the case will be handled as below.

A. When it is recognized that the 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 request for appeal, a chief administrative judge shall order an amendment (Patent Act Article 133(1), Design Act Article 52, Trademark Act Articles 56(1), 68(4)) and dismiss the request by decision if a deficiency is not eliminated as a result of a response of an appellant (Patent Act Article 133(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)) (→ 22-01 8.)

However, regarding a case related to a reexamination by the examiner before trial, an amendment shall be ordered under the name of the Commissioner of the Japan Patent Office (Patent Act Article 17(3)), and the request shall be dismissed if a deficiency is not eliminated as a result of a response of an appellant (Patent Act Article 18(1)).

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

B. Specific examples that the intention is recognized 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 an agent (Besides when a document certifying the authority of representation has been filed, it also includes cases where the authority of representation can be inferred from the entire purport of the written request and the circumstances of said application known to the Japan Patent Office.) to submit a written request for appeal, the agent 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 appeal is submitted under the names only described in the decision of final rejection.
- (F) The fact of inheritance or other general succession is indicated (Note)

In this case, there is an obligation to notify the Commissioner of the Japan Patent Office under the provision of the Patent Act Article 34(5), the Design Act Article 15(2), and the Trademark Act Article 13(2), however, sometimes it is simply indicated (description of death, company 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 (a certificate of registered matters, etc.)

- b. When by inheritance

- (a) When inherited by all heirs

A certified copy of a family register and a closed family register (if necessary) of a decedent, and a certified copy of a resident register or supplementary family register for a decedent and all heirs.

## (b) When inherited by not all heirs

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

## (c) When some heirs 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 heirs

Certificate certifying that no one asserts the right of being an heir

## C. When the intention is not recognized from an indication

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

## (2) Inter partes trial and trial for correction

A demand for trial shall be dismissed by trial decision without ordering an amendment or making an inquiry (Patent Act Article 134(4), Utility Model Act Article 39(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)) as the deficiency cannot be amended (Patent Act Article 135, Utility Model Act Article 41, Design Act Article 52, 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 written demand, an amendment shall be ordered. As a result of the response of the demandant, if a deficiency cannot be eliminated, the demand shall 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)).

B. If it is expected that a demand 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 to be attributable to the demandant (for example, a name of a right holder is changed very close to filing a demand for trial), an inquiry is made and the demand shall be processed after receiving a response to the inquiry.

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

- (1) (1976 (Gyo-Ke) 96) Judgment of the Tokyo High Court, July 27, 1977  
→ (1977 (Gyo-Tsu) 112) Judgment of the Supreme Court of Japan, Second Petty Bench, March 24, 1978
- (2) (1978 (Gyo-Ke) 163) Judgment of the Tokyo High Court, September 30, 1980
- (3) (1978 (Gyo-Ke) 45) Judgment of the Tokyo High Court, October 25, 1978
- (4) (1978 (Gyo-Ke) 208) Judgment of the Tokyo High Court, July 25, 1979
- (5) (1982 (Gyo-Ke) 106) Judgment of the Tokyo High Court, May 29, 1986
- (6) (1988 (Gyo-Ke) 39) Judgment of the Tokyo High Court, July 27, 1988  
→ (1988 (Gyo-Tsu) 158) Judgment of the Supreme Court of Japan, Third Petty Bench, October 2, 1990
- (7) (1992 (Gyo-Ke) 228) Judgment of the Tokyo High Court, April 14, 1993
- (8) (1993 (Gyo-Ke) 93) Judgment of the Tokyo High Court, December 24, 1993
- (9) (2005 (Gyo-Ke) 10243) Judgment of the IP High Court, June 22, 2005
- (10) (2009 (Gyo-Ke) 10148) Judgment of the IP High Court, November 19, 2009
- (11) (2010 (Gyo-Ke) 10363) Judgment of the IP High Court, May 30, 2011
- (12) Trial Case No. 3304, 1966 (June 19, 1973)

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

Description of Reasons for Trial Decision and Indication of Conclusion

(→ 45-20)

(Revised December 2023)