

22—01 P U D T

Party Concerned

1. Introduction

A problem for a party concerned is extensive and wide-ranging, therefore, a specific example regarding the requirements for a demand for trial/appeal leaves to Section 22-02, and a joint trial leaves to Section 22-03. Other than those topics are taken up in this section. An opposition to grant of patent (an opposition to registration of trademark) shall be handled similar to a demand for trial/appeal.

2. Party Concerned

A party concerned legally means a person involved in a particular relationship, or a person involved in legal requirements, legal facts, etc. being the cause of the particular relationship. A party concerned of a trial/appeal indicates a demandant and a demandee of a trial/appeal, a demandant and a demandee of a retrial.

An intervenor is not considered as a party concerned, but is almost in the same position (→ 57-00~57-09).

3. Determination of a party concerned

(1) In a trial/appeal, it should firstly clarify who a party concerned is. This information not only helps knowing to whom a trial decision is addressed, but also (this information) is necessary to determine the following issues such as exclusion (the Patent Act Article 139, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) or recusation (the Patent Act Article 141, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) of an administrative judge, interruption or suspension of the proceedings (the

Patent Act Articles 22~24, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)) and is the basis of judgment on legal capacity, capacity to proceed, eligibility for being a party, etc. of such person.

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

A written demand for trial is required to indicate a party concerned (the Patent Act Article 131(1), the Utility Model Article 38(1), the Design Act Article 52, the Trademark Act Articles 56(1) and 68(4)). The indication of a party concerned in the written demand is not sole information. A party concerned should be determined from the entire purport in the written demand for trial/appeal and for ex parte trial, the documents submitted from the time of filing an application to the time of ending the period of filing a demand for appeal (→ 22-02 11.).

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

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

These requirements of a demand for a trial/appeal are prerequisite for proceedings and if a deficiency is found, it is not necessary to enter the proceedings of the merit or to continue the proceedings.

5. Legal Capacity

Legal capacity is a status or a qualification for being able to be the subject of a right, and a natural person and a corporation may own legal capacity.

The Civil Law regulates the principle of equality of domestic and foreign people (the Civil Law Article 3(2) and Article 35(2)). In the Patent Act, a

foreigner who does not have an address or domicile (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) (the Utility Model Act Article 2-5(3), the Design Act Article 68(3), the Trademark Act Article 77(3)).

6. Capacity to Proceed

Capacity to proceed is an ability for being able to be the subject of procedures, and a person having legal capacity (→ 5.) owns capacity to proceed.

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

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

When a chief administrative judge considers a person performing a procedure is not appropriate for the procedure, he/she orders an agent shall perform the procedure instead (the Patent Act Article 13(1), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the 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 decision regarding a specific legal relationship asserting in the demand. In a special 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 distinguish from a qualification or a personal ability which is generally and abstractly determined and has nothing to do with a particular incident such as legal capacity or capacity to proceed.

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

A. Appellant of ex parte trial

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

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

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

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

B. A demandant of inter partes trial, etc.

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

It is required an interest when demanding a trial for invalidation of patent (the Patent Act Article 123(2)) and trademark registration (the Trademark Act Article 46-2) (→ 31-00~31-02), but anyone may demand a trial for invalidation of utility model registration (the Utility Model Act Article 37(2)), a trial for invalidation of design (the Design Act Article 48(2)), a trial for rescission of trademark registration (the Trademark Act Articles 50,52, 52-2, 53). However, a demandant for a trial for invalidation of patent, utility model registration and design registration based on reasons attribution

of the 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)).

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

A person who may demand a trial for correction is a patentee (the 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.

A right holder registered in a patent (registration) register is sometimes not an actual right holder (for example, the right is succeeded to an inheritor, a surviving company after merger, a split company, etc. for the reasons of death of a right holder, extinction of a company due to merger, company split, etc.) Such fact is found by a demandant in confirmation of an address and a name of a demandee before demanding a trial, a demandant should demand a trial with an actual right holder as a demandee after examining an actual right holder and identify the address and name.

8. Proceedings About a Party Concerned

Proceedings about a party concerned are examined prior to the proceedings of the merit whether the demand is right, when a deficiency is found in the requirements of a party concerned, these cases are handled as follows:

(1) Indication of a party concerned is violation of formality

When an indication of a party concerned is violation of formality (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)) (→ 9.), a chief administrative judge orders a demandant for amendment by specifying a reasonable period of time (the Patent Act Article 133(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1),

68(4)), then continues the proceedings after the response.

When a demandant fails to amend within the designated period of time, the written demand will 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)).

(2) The requirements of a demand for trial about a party concerned is not fulfilled

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

A. When a deficiency may be corrected by amendment

A chief administrative judge makes an inquiry (the Patent Act Article 134(4), the Utility Model Act Article 39(4), the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)) or an order for amendment (the Patent Act Article 133(1), the Utility Model Act Article 41, the Design Act Article 52, the 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 by decision when a deficiency is not corrected during the designated period of time or the submitted amendment is not approved (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. A deficiency is not expected to be corrected by amendment

When a deficiency is not expected to be corrected by amendment, it is considered to be unlawful demand for trial and dismissed by trial decision without an inquiry or an order for amendment (the Patent Act Article 135, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

9. Examples that may be amended when requirements for demand for trial/appeal about a party concerned is not fulfilled

(1) An appellant of an ex parte trial

A. When an appellant and an applicant are considered to be the same person from indications of an appellant in a written demand and in documents attached to the written demand

B. When an appellant and an applicant are not considered to be 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 demand, order an amendment and continue the proceedings after the response.

(B) When a case falls under any of the followings, 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 (the Patent Act Article 34(5), the Design Act Article 15(2), the 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 demanded (the Patent Act Article 34(4), the Design Act Article 15(2), the Trademark Act Article 13(2)).

c. A voluntary amendment is submitted within the statutory period in which a trial can be demanded, thereby, an appellant becomes a legitimate appellant (the Patent Act Article 121, the Design Act Articles 46 and 47, the 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 similarly to a demandee of item (3) A, below.

(3) A demandee of an inter partes trial

A. When it is considered a demandee and a patentee are the same person seen

from an indication of a demandee in a written demand and an indication of a patentee in a patent register

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

B. When it is not considered a demandee and a patentee are 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 demanding a trial, etc., and in that case an inquiry shall be made and the proceedings shall be continued after the response.

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

(4) Lack of legal capacity to proceed

There may be a case that ratification (the Patent Act Article 16, the Utility Model Act Article 2-5(2), the Design Act Article 66(2), the Trademark Act Article 77(2)) or amendment is possible for the procedure that a person lacking legal capacity is performed, an inquiry (the Patent Act Article 134(4)) or an order for amendment (the Patent Act Articles 17(3), 133(2), the Utility Model Act Article 41, the Design Act Article 52, 68(2), the Trademark Act Articles 56(1), 68(4), 77(2)) shall be ordered and the proceedings shall be continued after receiving the response to the order.

(5) Death or disappearance of a party concerned

When a party concerned died or disappeared due to merger after a case is once pending, the case becomes suspended. The proceedings shall be continued after a procedure for succession if there is a successor who may succeed the case as a party concerned (the Patent Act Articles 21 ~ 24, 34(5), the Utility Model Act Articles 2-5(2), 11(2), the Design Act Article 15(2), 68(2), the 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 (the Patent Act Articles 11, 24, (the Code of Civil Procedure Article 124(2)), the Utility Model Act

Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2))
(→ 26-04)

In an opposition to grant of patent (an opposition to registration of trademark), since a position 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 decision. Before notifying a reason for revocation, an opposition to the patent (the trademark registration) shall be dismissed based on an unlawful demand.

(Revised Feb 2015)

22—02 P U D T**Examples of Judgments Related to the Parties**

Examples of court cases involving a party concerned are not many other than cases related to eligibility for being a demandant of an inter partes trial (31-00 ~ 31-02), and joint trial (→ 22-03). This section indicates some court cases for reference of specific trial cases.

1. Court cases where determination of a party concerned should be judged based on not only the indication of a demandant in a column of a written demand for trial, but also comprehensive observation of all purport of demand for trial and the entire documents submitted from the time of filing an application to the time of ending the period of filing a demand for trial:

- (1) 1978 (Gyo-ke) 45, October 25, 1978 (Tokyo High Court)
- (2) 1978 (Gyo-ke) 208, July 25, 1979 (Tokyo High Court)
- (3) 1993 (Gyo-ke) 197, June 7, 1994 (Tokyo High Court)

2. Court cases where a change of the demandee of a trial for invalidation is approved:

- (1) 1969 (Gyo-ke) 62, October 24, 1972 (Tokyo High Court)
- (2) 1970 (Gyo-ke) 98, March 30, 1978 (Tokyo High Court)

(Revised Feb 2015)

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, 2nd 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, 3rd 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)

22—04 P U D T**Demandee's Domicile That Is Written in a Written Request for Trial for Invalidation After the (attacked) Patent Has Been Surrendered or Has Lapsed**

A trial for invalidation may be requested after the right has been abandoned or has lapsed (the Patent Act Article 123(3), the Utility Model Act Article 37(3), the Design Act Article 48(3), the Trademark Act Articles 46(3), 68(4)).

Meanwhile, various written requests for registration submitted after the right has been abandoned or has lapsed are all dismissed. Changes of address, etc. have not been registered in a closed register.

Therefore, even if an address, etc. of a demandee of a request for trial for invalidation may be different from ones in a closed register, a request for trial for invalidation shall be accepted by proving a fact of change of address, etc.

In case a duplicate of the written request may not be dispatched to a demandee, this notifies a demandant and requires an explanation to the demandee.

(Revised Feb 2015)