

23—00 P U D T

Agent in General

1. Significance of Representation

Representation is a system where the person directly acquires legal effects by an independent action (indication of intention) of other person (an agent).

2. Capacity to Act of Agent

The Civil Code (the Civil Code Article 102) stipulates that an agent does not need to be a person with capacity to act (to be a person not restricted in capacity). Regarding patent procedures, however, the Patent Act stipulates that minors or adult wards cannot perform the procedures without a legal agent (the Patent Act Article 7(1), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)). For this reason, it is not preferable that a person who receives a restriction in capacity to act becomes an agent.

When a person without capacity to act undertakes procedures as an agent and it is found that the agent acting for a person who performs procedures is not appropriate for the procedures, the agent may be replaced by order (the Patent Act Article 13(2), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

3. Authority of Representation

(1) Cause of occurrence

A. Voluntary agent (→23-02)

(A) Attorney (→23-02)

(B) Patent Administrator (→23-04)

(C) Authorized agent (→23-03)

Authority of representation of a voluntary agent is occurred by acts of authorization between the person and an agent.

B. Legal agent (→23-01)

(A) When a person in a certain position becomes ipso jure a legal agent, such regulations is a cause of occurrence of authority of representation (the Civil Code Articles 818, 840).

(B) When a court decides and appoints, or a testator designates a legal agent, said appointment, or legal act or designated act is a cause of occurrence authority of representation (the Civil Code Articles 25, 26, 841, 918, 943, 952, 1010, 839, 1006).

(2) Scope

A. Voluntary agent

(A) Attorney

The scope is determined by the content of authorization. The following procedures cannot be made in the absence of special authorization: a change, abandonment, or withdrawal of application; withdrawal of application for registration of the extension of the patent term; withdrawal of a demand, request, or motion; claiming a priority based on the patent application, etc. (the Patent Act Article 41(1), claiming a domestic priority), or withdrawal thereof; a patent application based on the utility model registration (the Patent Act Article 46-2(1)); a request for publication before examination; abandonment of a patent right; a request for an appeal against examiner's decision of refusal or a request for an appeal against examiner's decision to dismiss amendment for an application for design/trademark registration; or designation of sub-agent (the Patent Act Article 9, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(B) Patent Administrator

A patent administrator acts for the person for all procedures including a special authorization (special delegation of powers) (the Patent Act Article 9) and for litigations against a decision made by the administrative agency

under the Patent Act or the regulations of orders based on the Patent Act. However, this shall not apply to the case that a person residing outside of Japan limits the scope of authority of representation of the patent administrator (the Patent Act Article 8(2), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(C) Authorized agent

The scope is determined by the content of authorization.

B. Legal agent

The scope is determined by the regulations of each legal agent (For example, the Civil Code Articles 28, 824, 859, the Patent Act Article 7(3), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(3) Extinction

A. Voluntary agent (→23-02 2.)

B. Legal agent (→23-01 3.)

(4) Unauthorized representation (→23-07)

A person who acts as an agent does not have legitimate authority of representation.

4. Act of Representation

(1) An intention for acting on behalf of the person

(2) An indication of the intention of representation

(3) A juridical act of an agent himself/herself

5. Representation of both parties

Representation of both parties means an agent who acts on behalf of both parties for a certain juridical act, and this is prohibited by the regulations of the Civil Code (the Civil Code Article 108).

Representation of both parties is illegal in principle for the cases of an opposition to grant of patent (an opposition to registration of trademark) and a demand for trial.

If representation of both parties becomes a problem such as by the indication of the party (parties), examine this problem. If it is found such fact, dismiss by decision or by trial decision as an unlawful request or demand (the Patent Act Article 135, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 43-14(1), 56(1) 68(4)).

(Note) In relationship between the Patent Attorney Act Article 31 and Article 48 of the same Act, it is understood that a trial for invalidation, a litigation rescinding a trial decision, and an opposition to grant of patent (an opposition to registration of trademark) all are applicable to “a separate case requested by the opposite party of the case already undertaken”.

Therefore, before judging legal standing (eligibility for being a party), it is understood that the procedure becomes invalid since any of the procedures above is against the Patent Attorney Act Articles 31 and 48.

If the procedure is invalid, a demand or request naturally becomes an unlawful demand or request.

However, when the opposite party does not contend against this issue, it is understood that there is no problem to proceed with the procedures as the opposite party accepts the issue.

If so, it is not necessary for the Japan Patent Office to positively ask for consent of the opposite party, and it is sufficient to take a measure when one of the parties claims and then examine whether a fact of violation of the Patent Attorney Act exists.

6. Joint representation

The term joint representation means authority of representation may exercises only when two or more agents work together. However, regarding procedures of patents, when there are two or more agents undertaking the

procedures for the person, each agent represents the person to the Japan Patent Office (the Patent Act Article 12, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(Revised Feb 2015)