

23—00 P U D T

Agent in General

1. Significance of Representation

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

2. Capacity to Act of Agent

The Civil Code (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 may not perform the procedures without a legal agent (Patent Act Article 7(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)). Considering this provision, 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 for a person undertaking procedures is not appropriate for the procedures, the agent will be replaced by order (Patent Act Article 13(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

3. Authority of Representation

(1) Cause of occurrence of authority of representation

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 occurs by acts of authorization between a principal and an agent.

B. Legal agent (→23-01)

(A) When a person in a certain position becomes ipso jure a legal agent, the relevant laws and regulations are a cause of occurrence of authority of representation (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 of authority of representation (Civil Code Articles 25, 26, 841, 918, 943, 952, 1010, 839, 1006).

(2) Scope of authority of representation

A. Voluntary agent

(A) Attorney

The scope is determined by the content of authorization. The attorney may not undertake the following procedures unless a special authorization is given: conversion, abandonment, or withdrawal of an application; withdrawal of an application for registration of an extension of the patent term; withdrawal of a demand/request, application, or motion; claiming a priority based on a patent application, etc. (Patent Act Article 41(1), claiming a domestic priority), or withdrawal thereof; filing a patent application based on a utility model registration (Patent Act Article 46-2(1)); request for the publication of a patent application; waiver of a patent right; request for an appeal against examiner's decision of refusal or an appeal against examiner's decision to dismiss amendment for a design/trademark registration application; or appointment of a subagent (Patent Act Article 9, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(B) Patent Administrator

A patent administrator represents a principal regarding all procedures including a special authorization (Patent Act Article 9) and litigation against dispositions made by an administrative agency under the provisions of the

Patent Act or an order under the Patent Act. However, this does not apply in the case where the overseas resident limits the scope of authority of representation of the patent administrator (Patent Act Article 8(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), 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, Civil Code Articles 28, 824, 859, Patent Act Article 7(3), Utility Model Act Article 2-5(2), Design Act Article 68(2), 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 in the name of agent does not have legitimate authority of representation.

4. Acts of Agency

(1) There must be an intention for acting on behalf of a principal

(2) There must be an indication of the intention to represent a principal

(3) It must be juridical acts of the 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 it 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. Representation of both parties is also prohibited by the regulations under the Civil Code (Civil Code Article 108).

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

(Note) In a relation to the Patent Attorney Act, it is understood that the provision that prohibits patent attorneys and patent attorney corporations from practicing “a separate case requested by the opposite party of the case already undertaken” (Patent Attorney Act Article 31(iii) and Article 48(1)(iii)) is applicable to cases of an opposition to grant of patent (an opposition to registration of trademark), a demand for trial, and a suit rescinding a trial decision. The procedures performed in violation of this provision is deemed to be invalid before determining eligibility for being a party, and a demand or request naturally becomes an unlawful demand or request.

However, when the opposite party does not express any objection against this issue, it can be understood that there is no problem to proceed with the procedures. In that case, it is not necessary for the Japan Patent Office to positively ask for opinions of the opposite party about the violation of the Patent Attorney Act, and it is sufficient to take a measure such as an inquiry when the opposite party claims and examine whether a violation of the Patent Attorney Act occurs.

(Reference) 1. ((1968 (Gyo-Tsu) 78), Judgement of the First Petty Bench of the Supreme Court, February 13, 1969)

2. ((1992 (Gyo-Ke) 32), Judgement of the IP High Court, September 16, 1992)

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

(Revised December 2023)