

## **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)

## 23—01 P U D T

### Legal Agent

1. A legal agent means an agent directly given authority of representation according to legal regulations.

2. Types of Legal Agents (Note)

(1) Legally natural depending on relatives, status

A. Parental authority (the Civil Code Article 818)

B. Legal guardian (the Civil Code Article 840)

(2) Appointed by a court

A. Administrator of absentee's property (the Civil Code Articles 25 and 26)

B. Appointed guardian (the Civil Code Article 841)

C. Administrator of the inherited property (the Civil Code Articles 918, 943, 952)

D. Executor by will (the Civil Code Articles 1010, 1015)

(3) Designation by a specific designated authority

A. Designated guardian (the Civil Code Article 839)

B. Designated executor by will (the Civil Code Articles 1006, 1015)

3. Legal Authority of Representation

(1) Occurrence, extinction

In principle, occurrence or extinction of authority of representation shall follow in the provisions of the Civil Code, etc. It is preferable to notify the opposite party of the extinction following the example of the Code of Civil Procedure (Article 36(1)).

The procedure is suspended when a legal agent died or lost the authority of representation (the Patent Act Article 24, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2) → the

Code of Civil Procedure Article 124(1)(iii)).

Authority of representation shall be extinct upon:

- A. death of the person or a legal agent, decision of the commencement of bankruptcy procedure of a legal agent, or decision of the commencement of guardianship against a legal agent (the Civil Code Article 111 (1)); or
- B. resignation, appointment or dismissal of a guardian (the Civil Code Articles 844, 845, 846), etc.

(2) Scope

The scope of authority of representation of a legal agent shall be determined by the Civil Code, etc.

[Example] A person who exercises parental authority shall administer the property of the child and represent the child in any legal juristic act in respect of the child's property provided, however, that that if an obligation requiring an act of the child is to be created, the consent of the child shall be obtained (the Civil Code Article 824).

A legal agent may appoint a sub agent under his/her own responsibility (→23-05).

(Revised Feb 2015)

## **23—02 P U D T**

### **Voluntary Agent (Attorney)**

#### 1. Significance

A voluntary agent becomes receiving the confidence of the person, namely, becomes based on the will of the person.

Therefore, a voluntary agent includes an agent under an agreement of business affairs (for example, a partnership agreement, an employment agreement) as well as an “attorney (privately appointed agent)”.

It is understood that a patent administrator (→23-04) and an authorized agent (→23-03) are also included in a voluntary agent, but this section (23-02) only explains an attorney (privately appointed agent).

#### 2. Authority of Representation

##### (1) Occurrence

Authority of representation occurs when the person grants the authority to others.

##### (2) Extinction

It is natural that authority of representation is extinct when the person is replaced. However, authority of representation is not extinct due to, different from reasons for extinction of authority of representation regulated under the Civil Code (the Civil Code Article 111(1)), the death of the person or extinct by merger of the corporation that is the person, or termination of duties of trust of a trustee who is the person, or the death of a legal agency, or change or extinction of the authority of representation of the legal agency (the Patent Act Article 11, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

When keeping the principle of the Civil Code Article 111, a procedure which was made by an agent who has not known the death of the person



becomes invalid, or an urgent procedure will not be possible to be performed by an agent. This causes unforeseen damages to a successor of the person, and also an obstacle in progress of various procedures of examinations or trials.

Therefore, the Industrial Property Law makes provisions to stipulate non-extinction of authority of representation (the Patent Act Article 11, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

### (3) Scope

Authority of representation delegated by a person domiciled or resident (in the case of a legal entity, establishment) in Japan for applications, demands/requests, or other procedures before the Japan Patent Office shall not include the following procedures unless expressly so empowered: conversion, abandonment or withdrawal of an application; withdrawal of an application for registration of extension of the duration of the patent right; withdrawal of a request, demand or motion; claiming a priority based on a patent application, etc. (the Patent Act Article 41(1), claiming a domestic priority) or the withdrawal; filing a patent application based on a utility model registration (the Patent Act Article 46-2(1)); filing a request for publication before examination of an application; abandonment of a patent right; or filing a request for an appeal against examiner's decision of refusal (the Patent Act Article 121(1), the Design Act Article 46(1), the Trademark Act Articles 44(1), 68(4)), or filing a request for an appeal against examiner's decision to dismiss amendment of design/trademark registration (the Design Act Article 47(1), the Trademark Act Articles 45(1)), 68(4)), or appointment of sub agent (→ 23-08) (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)).

It has to be said that an act of agent after the death of the person is on behalf of a successor of the right.

3. Authority to Appoint Sub Agent (Executor's Right to Appoint Sub Agent)

A designated executor may allow to appoint a sub agent as a voluntary agent of a testator (→ 23-05 1.(2)) (the Civil Code Article 1016).

(Revised March 2012)

**23—03 P U D T**  
**Authorized Agent**

1. An authorized agent is a member of the staff designated by the government agency, etc. for procedures which the national or the government agency, etc. is a party concerned.
  
2. Authority of representation of an authorized agent occurs designation or appointment of the national or the government agency. Authority of representation shall extinct by removal of the designation or dismissal from the agent.
  
3. Regarding an authorized agent of a suit rescinding a trial decision, etc. (→ 80-01).

(Revised Oct 2002)

## 23-04 P U D T

### Patent Administrator

#### 1 . Significance

The time- spent on the procedures under the patent system often becomes a problem while these procedures must be carried out under a time constraint. This would cause an overseas resident (a person not domiciled or resident (or an establishment in the case of a legal entity) within Japan) difficulties in terms of geography or time. The purpose of the system with regard to patent administrators is, therefore, to facilitate the progress of the procedures involved in the system by forcing the overseas resident to undertake such procedures through a representative domiciled or resident in Japan, who acts for such person in handling matters related to the person's patent.

With the exception of certain cases, no overseas resident may undertake procedures or institute an action against measures undertaken by a relevant administrative agency in accordance with the provisions of the Patent Act or an order issued under the Patent Act, except through a representative domiciled or resident in Japan, who is acting for such person in handling matters related to the person's patent (Patent Act Article 8 (1), Utility Model Act Article 2-5 (2), Design Act Article 68 (2), Trademark Act Article 77 (2)).

The certain cases referred to above are limited to the case where the overseas resident (or the representative of a legal entity), who has a patent administrator, is living in Japan (Order for Enforcement of the Patent Act Article 1).

#### 2 . Authority

A patent administrator shall represent the principal in all procedures and litigation against measures undertaken by any relevant administrative agency in accordance with the provisions of the Patent Act or an order issued under the Patent Act, including the cases expressly empowered (Patent Act Article 9); provided however, that this shall not apply 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)).

Accordingly, in cases where the scope of authority of representation is not limited, the patent administrator has the authority of representation for all procedures.

The registration system for appointment of a patent administrator, etc. was abolished due to the partial amendment of the Patent Act in 1996, and if the written certificate of the authority of representation, which is submitted to the Patent Office during the filing of an application, mentions, among the matters entrusted to the patent administrator, the empowerment after the registration (including the cases where no limitation is placed on the scope of authority of representation), the patent administrator also has the authority of representation for the procedures after the registration as well as for the procedures pertaining to the patent right.

### 3. In the Event of Death of the Patent Administrator (→23-11)

(Revised Feb. 2015)

**23—05 P U D T****Sub Agent**

## 1. Definition

(1) A sub representation is that an agent appoints another agent under his /her name to represent the person for having the newly appointed agent act within authority. Another agent appointed by an agent is called a sub agent.

(2) Authority to appoint a sub agent (Right to appoint sub agent) is not naturally a part of authority of representation, but separate authority given by permission of the person or directly given by the law.

## 2. Authority and Responsibility of Appointing Sub Agent

## (1) Authority

## A. Voluntary agent

A voluntary agent may not appoint a sub agent without special authorization (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)).

Under the Civil Code, a voluntary agent may not appoint a sub agent in principle without permission of the person or unavoidable reasons to do so (the Civil Code Article 104).

## B. Legal agent

A legal agent has become the agent not based on the person's will. Such authority is generally extensive and may not resign freely. It often happens that the person does not have capacity to permit, therefore a legal agent always has an authority to appoint a sub agent and may appoint a sub agent on its own responsibility (the Civil Code Article 106).

When there is a supervisor of guardian, it is necessary to have the consent of the supervisor (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)).

## (2) Responsibility

### A. Voluntary agent

An agent who appoints a sub agent shall be responsible for compensating for damages suffered by the person only if the agent fails to appoint and supervise the sub agent (the Civil Code Article 105(1)).

However, when an agent appoints a sub agent in accordance with the nomination by the person, the agent shall be responsible only when the agent fails to notify the person or dismiss the sub agent knowing that the sub agent is not qualified or untrustworthy (the Civil Code Article 105(2)).

### B. Legal agent

Responsibility of a legal agent who appoints a sub agent shall extend to, in principle, all acts of a sub agent regardless of negligence for the appointment and supervision of such sub agent (the Civil Code the first sentence of Article 106).

However, if there is any unavoidable reason, a legal agent shall be responsible only for the appointment and supervision of the sub agent (the Civil Code the proviso to Article 106).

## 3. Extinction of Authority of Sub Agent

Extinction of authority of sub agent occurs by general causes of extinction under the Civil Code Article 111, or by cancellation or rescission of delegation or special authorization to an agent or a sub agent, excluding when the authority is not extinct according to the regulations of the Patent Act Article 11 (the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

## 4. Dismissal by the Person

It is understood that the person may also dismiss a sub agent, since a sub agent has the same rights and obligations as an agent to the person and the third party (the Civil Code Article 107(2)), and has a duty of care of a good

manager compliance with the purport of the delegation ( → Formality Examination Manual 02, 26 (Representation -7).

#### 5. Authority of Sub Agent

A sub agent shall represent the person with respect to any act within the scope of its authority (the Civil Code Article 107(1), and shall have the same rights and duties as an agent to the person and the third party (the Civil Code Article 107(2)).

#### 6. Death of Sub Agent (→ 23-11)

(Revised Feb 2015)



**23—06 P U D T****Curator**

1. A curator is a protection agency for a person under curatorship (Note).

When a person under curatorship performs a procedure for industrial property rights, it is necessary to have the consent of a curator (the Patent Act Article 7(2), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)), and submit a written consent (Enforcement Regulations of the Patent Act Article 6, Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1)).

A procedure made by a person under curatorship without consent of a curator may ratify upon obtaining his/her consent (the Patent Act Article 16(3), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)). Therefore, when a person under curatorship appoints an agent for a procedure, it is understood that the consent of curator regarding appointment of an agency is also required.

(Note) A person under curatorship is a person became subject to a ruling of commencement of a curatorship from the family court and is remarkably insufficient to understand right from wrong due to a mental disorder.

2. An indication of a curator is not required in a written demand for trial/appeal. Even a written demand has such indication, the JPO does not indicate a curator in a document from the JPO.

(Revised July 2005)

**23—07 P U D T****Unauthorized Representation**

1. A procedure performed by those without authority of representation may be ratified by a person himself (herself) with capacity to act or a legal agent (the Patent Act Article 16(2), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(1) When certifying authority of representation of an agent for a person who performs procedures, it should be certified in writing (Enforcement Regulations of the Patent Act Article 4-3, Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1)).

(2) When a procedure undertaken by an agent, but there is no written document certifying authority of representation (hereinafter, referred to as “a power of attorney”), or when a name of a person himself (herself) on the power of attorney is different, such procedure is deemed to be unauthorized representation.

(3) In this case, order a person himself (herself) to amend and submit a correct power of attorney (→ 21-00), and a person himself (herself) shall be ratified after the correct power of attorney is filed.

(4) When it is not ratified, the procedure is 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), → a table of 21-03).

(Revised December 2020)

**23—08 P U D T**  
**With or Without an Agent and**  
**Trial and Appeal Proceedings**

1. When There Is an Agent

(1) To confirm whether there is a written document certifying authority of representation (hereinafter, referred to as a “document”) (Enforcement Regulations of the Patent Act Article 4-3, Enforcement regulations of the Utility Model Act Article 23, Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22), and order amendment if the document is not appropriate or the document is not attached (the Patent Act Articles 17(3), 133(2), the Utility Model Act Articles 2-2(4), 41, the Design Act Articles 52, 68(2), the Trademark Act Articles 56(1), 68(4), 77(2)).

(2) A legal agent, in case there is a voluntary agent or a supervisor of guardian, becomes unauthorized agent if the document is not appropriate regardless of amendment (→ 23-07).

(3) Capacity to act (→ 23-00) of agent or capacity to be delegated of agent is not often searched, but only when there is a dispute (allegation and evidence) between the parties and an existence of capacity is contested, the capacity should be searched by ex officio for determination.

2. When There Is No Agent Undertaking Necessary Procedures

(1) In case of a person not domiciled or resident (or an establishment in case of a legal entity) within Japan (an overseas resident)

A. When an overseas resident performs a procedure without a patent administrator (→ 23-04), said procedure is deemed inappropriate and thus dismissed (the Patent Act Articles 18-2, 133-2, 135, the Utility Model Act

Article 41, the Design Act Articles 52, 68(2), the Trademark Act Articles 56(1), 68(4), 77(2)).

B. When a demandee is an overseas resident

(A) By the time documents related to a trial (an opposition to grant of patent, an opposition to registration of trademark) are served (dispatched), when a written power of attorney has been already submitted for the patent

(the Patent Act Articles 7(2), 133(2), Enforcement Regulation of the Patent Act Article 6, the Utility Model Act Articles 2-5(2), 41, Enforcement Regulation of the Utility Model Act Article 23(1), the Design Act Articles 52, 68(2), Enforcement Regulation of the Design Act Article 19(1), the Trademark Act Articles 56(1), 68(4), 77(2), Enforcement Regulation of the Trademark Act Article 22(1)).

C. Even when a legal agent undertakes a procedure, if there is a supervisor of guardian, submission of a letter of consent of a supervisor of guardian shall be ordered (the Patent Act Articles 7(3), 133(2), Enforcement Regulation of the Patent Act Article 6, the Utility Model Act Articles 2-5(2), 41, Enforcement Regulation of the Utility Model Act Article 23(1), the Design Act Articles 52, 68(2), Enforcement Regulation of the Design Act Article 19(1), the Trademark Act Articles 56(1), 68(4), 77(2), Enforcement Regulation of the Trademark Act Article 22(1)).

D. When not responding to the order of A ~ C, the procedure shall be dismissed by decision (the Patent Act Article 133(3), the Utility Model Act Article 41, the Design Act Articles 52, the Trademark Act Articles 56(1), 68(4), 77(2)).

(Revised Feb 2015)

## 23—09 P U D T

### Document Certifying Authority of Representation

1. Only for the procedures that are disadvantageous to a demandant such as abandonment or withdrawal of the application, or that notify appointment or change, etc. of an agent, an agent shall submit a document certifying authority of representation upon the procedures because there is possibility to arise disputes regarding the existence or scope of authority of representation (Enforcement Regulations of the Patent Act Article 4-3, Enforcement Regulations of the Patent Registration Order Article 13-2).

When a chief administrative judge finds it necessary for an procedure undertaken by an agent, he/she may order to submit a document certifying authority of representation regardless of the regulations of Enforcement Regulations of the Patent Act Article 4-3(1), (3) (Enforcement Regulations of the Patent Act Article 4-3(4)).

#### 2. Types of procedures

(1) Procedures that require a power of attorney in a trial/appeal

A. Special authorization regulated under the Patent Act Article 9 (Enforcement Regulations of the Patent Act Article 4-3(1), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

B. Certification of legal authority of representation (Enforcement Regulations of the Patent Act Article 4-3(1), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

C. Notification for appointment or change of an agent in the middle of the procedures or after patented (Acceptance in the middle of the procedures)

(Enforcement Regulations of the Patent Act Article 4-3(2), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

D. Intermediate procedures undertaken by an agent different from an agent notified at the time of filing an application without submitting a notification of appointment of a new agent (Enforcement Regulations of the Patent Act Article 4-3(3), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

E. Notification of succession of a right to obtain a patent, a petition of succession of procedures (Enforcement Regulations of the Patent Act Article 4-3(1)(i)(ii))

F. Request for an advisory opinion (Enforcement Regulations of the Patent Act Article 4-3(1) (vi), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

G. Request for an opposition to grant of patent (Enforcement Regulations of the Patent Act Article 4-3(1)(ix))

H. Request for an opposition to registration of trademark (Enforcement Regulations of the Trademark Act Article 22(1))

I. Filing a written opinion (the Patent Act Article 120-5(1), 174(1), the Trademark Act Articles 43-12, 60-2(1), 68(4), 68(5)) (Enforcement Regulations of the Patent Act Article 4-3(1)(xi), Enforcement Regulations of the Trademark Act Article 22(1))

J. Demand for a trial/appeal (except an appeal against examiner's decision of refusal and an appeal against decision to dismiss amendment) (Enforcement Regulations of the Patent Act Article 4-3(1)(xii), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act

Article 22(1))

K. Filing a written reply (the Patent Act Article 71(3), the Utility Model Act Article 26, the Design Act Article 25(3), the Trademark Act Article 28(3), the Patent Act Articles 84, 92(7), 93(3), the Utility Model Act Articles 21(3), 22(7), 23(3), the Design Act Article 33(7), the Patent Act Article 134(1), the Utility Model Act Article 39(1), the Design Act Article 52, the Trademark Act Article 56(1), the Patent Act Article 174(3), the Design Act Article 58(4), the Trademark Act Article 61) (Enforcement Regulations of the Patent Act Article 4-3(1)(viii),(xiii), Enforcement Regulations of the Utility Model Act 23(1), Enforcement Regulations of the Design Act 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

L. Request for intervention (the Patent Act Articles 119(1), 148(1)(3), 174(1)(3), the Utility Model Act Articles 41(1), 45(1), the Design Act Articles 52, 58(4), Trademark Act Articles 43-7, 56, 61) (Enforcement Regulations of the Patent Act Article 4-3(1)(x)(xiv), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

M. Request for preservation of evidence (Enforcement Regulations of the Patent Act Article 4-3(1)(xv), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

N. Demand for retrial (Enforcement Regulations of the Patent Act Article 4-3(1)(xvi), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1))

O. Notification of deposit number of microorganisms (Enforcement Regulations of the Patent Act Article 4-3(1)(xvii))

P. Request for a renewal registration of the right of trademark registration (only when decreasing a number of classes for goods and services)



(Enforcement Regulations of the Trademark Act Article 22(1))

Q. Request for renewal registration based on the right of defensive mark registration (Enforcement Regulations of the Trademark Act Article 22(1))

R. Application for consolidation of classification, replacement of Goods and Class (Enforcement Regulations of the Trademark Act Article 22(1))

S. Submission of name (appellation), address (residence), general power of attorney, etc. under the special provisions (Enforcement Regulations for the Act on Special Provisions for Procedures related to Industrial Property Right Article 5-2(1))

T. Request for identification number, notification of input/output device, submission of statement of advance payment, etc. under the special provisions (Enforcement Regulations for the Act on Special Provisions for Procedures related to Industrial Property Right Article 5-2(1))

U. Request for identification number, etc. under the provisions of Article 3-2(1) of Ministerial Ordinance (Ministerial Ordinance on Cash) on the procedure of paying in cash for fees, etc. related to Industrial Property Right (2) Procedures not require a power of attorney

A. Submission of explanation of situation for accelerated examination

B. Submission of information statement (Enforcement Regulations of the Patent Act Articles 13-2, 13-3)

### 3. Documents certifying authority of representation

#### (1) Legal agent

A. Documents certifying authority of representation of a legal agent for a minor are a transcript (an abstract) of the family register and a copy of the certificate of the residence of a minor, and a copy of the certificate of the residence of a legal agent

B. Documents certifying authority of representation of a legal agent for an adult ward are a certificate of registered matters on the guardianship registration (when guardianship registration has not registered, a transcript

(an abstract) of the family register and a copy of the certificate of the residence of an adult ward, and a copy of the certificate of the residence of a legal agent)

When a guardian is a legal agent, if there is a supervisor of guardian, an agreement and a certificate of the residence of a supervisor of guardian.

(2) Voluntary agent

A. Voluntary agent (attorney), Patent administrator

A power of attorney (Note)

(Note) A types of power of attorney includes a power of attorney for a particular case and a general power of attorney not specified a particular case and submitted before the Commissioner of the JPO in advance. When certifying authority of representation by a general power of attorney, it is necessary to state that a general power of attorney is used (Enforcement Regulations of the Patent Act Article 9-3(1), Enforcement Regulations of the Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1), Enforcement Regulations for the Act on Special Provisions for Procedures related to Industrial Property Right Article 6(1)(4)).

B. Authorized agent

A certificate of designation

4. Scope of Authority of Representation

(1) Regarding a legal agent (→ 23-01), a patent administrator (→ 23-04), and an authorized agent (→ 23-03), the scope of authority of representation is respectively regulated under Civil Code or the Patent Act, etc.

(2) When a power of attorney certifying authority of representation by voluntary agent indicates the scope of authority of representation, describe a name of attorney (... designate Mr.(Ms.) XX as an attorney and authorize him(her) to conduct the following matters) and specify matters to be authorized and describe “a case number” and “matters concerning ~” as the

authorized matters.

Regarding authority of representation of an agent for a certain application in which a power of attorney has been submitted, when the power of attorney states the procedures of the patent right (the utility model right, the design right, the trademark right), except when there is no particular restriction of the scope of authority of representation of an agent, since the authority of representation has been continued until the right is extinguished, the agent can undertake the following procedures as an agent of the right holder without submitting a power of attorney again: an opposition to grant of patent, an opposition to registration of trademark, a trial for invalidation, a trial for correction, a trial for rescission of trademark registration, etc.

When matters that require the special authorization also authorize an agent, such as withdrawal of the application, abandonment of the patent right, a request for appeal against examiner's decision of refusal, a request for appeal against examiner's decision to dismiss amendment of a design (trademark) application, or appointment of sub-agent, describe clearly in the power of attorney to that effect (the Patent Act Article 11, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

## 5. Wordings of Authorization and Interpretation of the Scope

### (1) Interpretation of "Appeal"

Regarding handling of a power of attorney in a demand for an ex parte appeal case, when a power of attorney submitted for the original appeal has a wording of "appeal", the Trial and Appeal Department of the JPO considers "matters related to an appeal" are also included in the authorized matters.

### (2) Interpretation of "filing an application of intervention"

When authorizing filling an application of intervention, the authorization shall be extended to representation of allegation when realizing the intervention.

(3) Interpretation of “Statement at the court in the oral proceedings”

There is no authorization for the matters after the statement in the oral proceedings.

(4) Interpretation of “Others”, “All others”

It does not include an action adversely affects the person, such as withdrawal of an application, withdrawal of a request, abandonment of the right.

It is not necessary a special authorization for a patent administrator of an overseas resident (→ 23-04 2.), except in cases where an overseas resident restricts the scope of authority of representation of a patent administrator.

(Revised December 2020)

## 23-10 P U D T

### Procedures in the Case Where There Is No Patent Administrator

#### 1. Where Procedures Are Undertaken without a Patent Administrator

##### (1) Demandant/Appellant

In the case of a person who is not domiciled or resident (or, in the case of a legal entity, with an establishment) in Japan (hereinafter referred to as "overseas resident"), the procedures must be undertaken through a patent administrator (Patent Act Article 8 (1), Utility Model Act Article 2-5 (2), Design Act Article 68 (2), Trademark Act Article 77 (2)). Accordingly, if the procedures are undertaken without a patent administrator, such procedures will be dismissed by a trial/appeal decision (Patent Act Article 135, Utility Model Act Article 41, Design Act Article 52, Trademark Act Article 56 (1) and Article 68 (4)).

##### (2) Demande

As in the case of (1), the procedures must be undertaken through a patent administrator in the case of an overseas resident.

(3) These cases, in which the patent administrator is deceased (→23-11), or otherwise ceases to exist any longer after a request for a trial/appeal has been filed, shall be handled in the same manner as the above (1) and (2); provided however, that if the patent administrator ceases to exist due to death, voluntary resignation, dismissal, etc., the opportunity to appoint a patent administrator should be given so that a new patent administrator will be appointed.

(4) While the procedures which are undertaken by an overseas resident without a patent administrator shall follow the above (1) and (2), it is possible for the Patent Office to send notices, etc. directly to the demandant/appellant and demande.

Obviously, motions for exclusion or recusation (→59-01 to 59-05) cannot be filed.

2. In the Case Where There Is No Patent Administrator, the Following Points Should Be Noted with Regard to the Procedures to Be Undertaken by the Patent Office.

(1) Where a request for a trial (an opposition to grant of patent (or registration of trademark)) is filed against a patent right for which a written certification of authority of representation (hereinafter referred to as "power of attorney") has not been submitted, the person who had previously been a patent administrator should be contacted for confirmation of whether or not such person will accept the appointment as a patent administrator (Form 1).

If the patent administrator responds that it will accept the appointment, the Patent Office serves (sends) a duplicate of the written request for trial (a written opposition to grant of patent (or registration of trademark)) to the patent administrator, and if the patent administrator responds that it will not accept the appointment, the Patent Office serves (sends) the same to the patentee.

(2) Where a power of attorney has been submitted, however, restriction is placed on the procedures for a patent (or utility model/design/trademark) right in accordance with the proviso of Article 8 (2) of the Patent Act, the Patent Office serves (delivers) a duplicate of the written request for trial (a written opposition to grant of patent (or registration of trademark)) to the patentee.

(3) Where no patent administrator has been appointed, a notice of names of administrative judge and trial clerk (→12-01), a notice of documentary proceedings (→32-01), a notice of conclusion of trial proceedings (→42-00), etc. shall be dispatched along with the documents to be served (sent) subsequently, such as a decision and a trial/appeal decision (→17-01).

(4) A trial/appeal decision (a decision over an opposition filed against a patent (or a trademark registration)) may be dispatched without attachment of a translation of the decision.

### 3. The Following Points Should Be Noted When Documents Are Dispatched.

(1) Where an overseas resident has no patent administrator, documents will be dispatched by registered air mail, etc. (refers to service of registered mail or correspondence delivery that is equivalent to registered mail prescribed by Ordinance of the Ministry of Economy, Trade and Industry) (Patent Act Article 192 (2), Utility Model Act Article 55 (2), Design Act Article 68 (5), Trademark Act Article 77 (5)).

(2) Where documents are dispatched by registered mail, etc., under (1), the documents shall be deemed to have been served at the time of dispatch (Patent Act Article 192 (3), Utility Model Act Article 55 (2), Design Act Article 68 (5), Trademark Act Article 77 (5)).

4. When a duplicate of the written request for trial (an opposition to grant of patent (or registration of trademark)) is served (sent) to the patentee (→2.(1), (2)), a note in English must be attached to the duplicate, to the effect that "if the patentee intends to proceed with the procedures as a demandee for this request for a trial, a patent administrator must be appointed in accordance with the Patent Act Article 8 (Utility Model Act Article 2-5 (2), Design Act Article 68 (2), Trademark Act Article 77 (2)), and all the subsequent procedures must be undertaken through the patent administrator."

An example of the English text (Form 2) shall be kept by the trial clerk or the Infringement and Invalidation Affairs Office.

## Form 1 (Example of Trial for Patent Invalidation)

**Request for Notification of Appointment of Patent Administrator, etc.**

Date YY/MM/DD

To: xxxxxx  
xxxx Patent OfficeFax: +81-3-xxxx-xxxx  
Phone: +81-3-xxxx-xxxx

Number of pages: xx

No. xx Office (Infringement and Invalidation Affairs Office)  
Trial and Appeal Division, Trial and Appeal Department, Japan Patent Office

Japan Patent No. xxxxxxxx

Patentee Address:  
Name: xx xx xx xx

Invalidation No. 20XX-800xxx

A trial for invalidation was requested for the above patent right on xx xx, xxxx.

Since you are registered as an representative at the time of registration of establishing the patent right, the Japan Patent Office requests for the Notification of Appointment (Acceptance) of Patent Administrator, etc.

Please note that you will explain the patentee that the procedures for a trial/appeal must be undertaken through a patent administrator in accordance with the Patent Act Article 8, and send your reply concerning the acceptance of appointment as a patent administrator within xx days after receipt of this notice to No. xx Office (Infringement and Invalidation Affairs Office), the Trial and Appeal Division by fax or e-mail (the attached form).

When replying concerning the acceptance of appointment as a patent administrator, please submit, along with your reply, the Notification of Appointment (Acceptance) of Patent Administrator, etc. If the Japan Patent Office does not receive the Notification of Appointment (Acceptance) of Patent Administrator, etc. within xx days, a duplicate of the written request for trial will be sent directly to the patentee.

Note: For questions, please contact No. xx Office (Infringement and Invalidation Affairs Office), Trial and Appeal Division, Trial and Appeal Department, the Japan Patent Office.

Phone: +81-3581-1101, ext. xxxx

Fax: +81-3501-xxxx Contact personnel: xxxxxxxx



**Reply to Request for Notification of Appointment of  
Patent Administrator, etc.**

Date YY/MM/DD

To: xxxxxxxx

No. xx Office (Infringement and Invalidation Affairs Office)

Trial and Appeal Division, Trial and Appeal Department, Japan Patent Office

Japan Patent No. XXXXXXXX

Invalidation No. 20XX-800XXX

Identification No.

Phone: +81-3-xxxx-xxxx

Name of Patent Administrator (xxxxxxxxx)

xx xx xx xx

Please circle the applicable number.

1. I accept the above-mentioned appointment.
2. I cannot accept the above-mentioned appointment.

If you accept the appointment

Please submit the Notification of Appointment (Acceptance) of Patent Administrator, etc. For "a written document certifying the authority of representation," please attach a new document (power of attorney), or cite either a document (power of attorney) which has already been submitted or a general power of attorney.

If you cannot accept the appointment

To send documents directly to the patentee, please provide the Japan Patent Office with the most recent information, about the patentee's name and address, held by your agency (the name and address as shown in English as well as the Japanese translation).

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Form 2

Japan Patent Office  
3-4-3 Kasumigaseki, Chiyoda-ku  
Tokyo, Japan, 100-8915

November 21, 2014

To : xxxxxxxx (Patentee)

Dear Sir/Madam:

The Japan Patent Office hereby notifies you that a request to hold a trial for patent invalidation has been filed against your patent No. XXXXXXXX. As a result of this request being filed, you are required to submit to the Japan Patent Office your response in writing, in duplicate, against the request within ninety (90) days from the date on which this notice was sent.

In submitting your response in writing, however, you first will need to designate a representative domiciled or residing in Japan who is a qualified patent administrator such as a patent attorney, as defined in Article 8 of the Patent Law of Japan. Only your qualified patent administrator will be authorized to deal with the Japan Patent Office and conduct the necessary procedures on your behalf.

Please note that the Japan Patent Office is unable to extend the deadline for you to submit your response in writing, unless you can prove any specific and reasonable grounds for the need to extend the deadline.

Yours faithfully,

Chief Administrative Judge

(Revised December 2020)

## 23—11 P U D T

### Handling of the Death of an Agent

1. Authority of representation shall extinct by the death of an agent (Civil Code Article 111(1)(ii)). The death of an agent after filing a demand of trial and a trial decision or a court decision made afterward, only describe a name and an address (location) of a demandant or a demandee, but not describe a name and an address (location) of an agent whose authority of representation has been extinct.

#### 2. Procedures When Death of an Agent

(1) In case of the death of a legal agent, the procedures shall be suspended until a legal agent of the party concerned or the party concerned who has acquired the capacity to act (→22) shall continue the procedure(→26-01) (Code of Civil Procedure Article 124(1)(iii), the Patent Act Article 24, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2) shall apply mutatis mutandis).

(2) In case of the death of a voluntary agent, the procedures shall be performed by a party concerned afterward.

However, in case of a patent administrator (→23-04), an overseas resident must proceed the procedures by a patent administrator (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)), therefore, the party concerned shall receive a trial decision (or a decision) accompanied with a notification for appointing a patent administrator (→23-10).

(3) In case where a sub agent has been appointed

Authority of representation of a sub agent is not extinguished due to the death of an agent. However, this shall not preclude the person from dismissal of the sub agent.

A. In light of the purpose of representation to operate the litigation smoothly and promptly under Code of Civil Procedure, it is understood that authority of representation of a sub agent shall not extinguish despite the death of a litigation agent.

B. A patent procedure is performed in a series of flows and considered to be similar to a litigation procedure, thus, authority of representation of a sub agent shall not extinguish due to the death of the agent.

### 3. In case of Death of Sub Agent

In case of the death of sub agent, a procedure afterwards is performed by an agent.

(Revised Feb 2015)

**23—12 P U D T****Representation of a Legal Entity and Its Indication**

A legal entity (a juridical person) has rights and assuming obligations to the extent of purpose provided in the articles of incorporation, or the articles of incorporation and other basic contracts subject to the applicable provisions of the laws and regulations (Civil Code Article 34). A legal entity appoints a representative representing the corporation for its affairs to claim the rights and fulfill the obligations. Therefore, when a party concerned is a legal entity in a trial/appeal case, a name and address of a party concerned, and a name of representative (in case of a demandant/appellant) must describe in a written demand for trial/appeal (the Patent Act Article 131(1)(i), Enforcement Regulations of the Patent Act Article 46, the Utility Model Act Article 38(1)(i), Enforcement Regulations of the Utility Mode Act Article 23(12), the Design Act Article 52, Enforcement Regulations of the Design Act Article 14(1), the Trademark Act Articles 56(1), 68(4), Enforcement Regulations of the Trademark Act Article 14).

When an agent undertakes the procedures, a name of representative is not required in the documents (Enforcement Regulations of the Patent Act Article 46, Form 61-2 Remarks 12→Form 2 Remarks 17, Form 62 Remarks 12→Form 3 Remarks 11).

(Revised Feb 2015)

**23—13 P U D T**  
**Procedure for Appointing a New Agent**  
**in the Middle of the Proceedings**

1. In case where an agent is appointed or replaced in the middle of procedures of trial/appeal before the JPO, a notification of appointment of attorney accompanied with a power of attorney, etc. should be submitted (Enforcement Regulations of the Patent Act Article 9-2).

2. When only a power of attorney (including the case where there is the description authorizing the whole trial/appeal procedures) is attached to the intermediate documents and the subject agent performs such procedures, the agent is considered to be accepted to have the authority of representation only for said intermediate procedures unless a notification of appointment of an agent, etc. has been submitted (including other intermediate procedures being undertaken at the same time, if any).

If the same agent continues to undertake future procedures, a notification should be submitted according to the provision under Enforcement Regulations of the Patent Act Article 9-2. Regarding a certification thereof, if there is no change in the content of a certification submitted earlier and said notification should include that effect (indication of incorporation by reference), submission of said certification may be omitted (Enforcement of Regulations of the Patent Act Article 10, Enforcement of Regulations of the Utility Model Act Article 23(1), Enforcement of Regulations of the Design Act Article 19(1), Enforcement of Regulations of the Trademark Act Article 22(1)).

(→ Guidelines for Formalities Examination 02.24 (Representative -5))

(Revised March 2012)