

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)

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 (Civil Code Article 818)

B. Legal guardian (Civil Code Article 840)

(2) Appointed by court

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

B. Appointed guardian (Civil Code Article 841)

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

D. Executor of a will (Civil Code Articles 1010, 1015)

(3) Designation by a specific designated authority

A. Designated guardian (Civil Code Article 839)

B. Designated executor of a will (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 (Patent Act Article 24, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2) → Code of Civil Procedure Article 124(1)(iii)).

Authority of representation shall be extinct upon:

- A. Death of the principal or his/her legal agent, bankruptcy of the legal agent, or a decision for commencement of guardianship against the legal agent (Civil Code Article 111(1)); or
- B. Resignation, appointment or dismissal of a guardian (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] The person exercising parental authority manages the child's property and represents the child in juridical acts involving that property; provided, however, that the person must obtain the consent of the child if a juridical act would give rise to the obligation of the child to act (Civil Code Article 824).

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

(Revised February 2015)

23—02 P U D T

Voluntary Agent (Attorney)

1. Significance

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

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 an attorney (privately appointed agent) will be discussed in this section (23-02).

2. Authority of Representation

(1) Occurrence

Authority of representation occurs when a principal grants the authority to others.

(2) Extinction

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

invalid and urgent procedures will not be possible to be performed by an agent. These cause unforeseen damages to a successor of the principal, 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 (Patent Act Article 11, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(3) Scope

Authority of representation delegated by a person domiciled or resident (in the case of a corporation, 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. (Patent Act Article 41(1), claiming a domestic priority) or the withdrawal; filing a patent application based on a utility model registration (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 (Patent Act Article 121(1), Design Act Article 46(1), 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 (Design Act Article 47(1), Trademark Act Articles 45(1)), 68(4)), or appointment of sub agent (→ 23-08) (Patent Act Article 9, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

It has to be said that an act of agent after the death of the principal 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 has a right to appoint a sub agent as a voluntary

agent of a testator (→ 23-05 1.(2)) (Civil Code Article 1016).

(Revised March 2012)

23—03 P U D T
Authorized Agent

1. An official of administrative agencies who is designated to carry out procedures involving the national or government agency as a party concerned.
2. Authority of representation of an authorized agent occurs designation or appointment of the national or the government agency. The authority of representation shall be 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 October 2002)

23-04 P U D T**Patent Administrator****1. Significance**

The time effect of the procedures of the patent administrator system often becomes an issue 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 corporation) 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 an agent domiciled or resident in Japan.

With exception of particular cases, no overseas resident may undertake procedures or institute an action against measures taken by a relevant administrative agency in accordance with the provisions of the Patent Act or an order issued under the Patent Act, except through an agent 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 particular cases referred to above are limited to the case where the overseas resident (or the representative of a corporation) with 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 objecting to a disposition undertaken by any relevant administrative agency under the provisions of the Patent Act or under an order that is based on 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 by partial amendment of the Patent Act in 1996, and if a certificate of authority of representation which is submitted to the Patent Office during application includes authorization after registration in the entrusted matters (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. Death of Patent Administrator (→23-11)

(Revised February 2015)

23—05 P U D T

Sub Agent

1. Definition

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

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

2. Authority of Appointing Sub Agent

(1) Authority

A. Voluntary agent

A voluntary agent may not appoint a sub agent without special authorization (Patent Act Article 9, Utility Model Act Article 2-5(2), the Design Act Article 68(2), Trademark Act Article 77(2)).

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

B. Legal agent

A legal agent has become the agent not based on the intention of a principal. Such authority is generally extensive and may not resign freely. It often happens that the principal does not have capacity of consent, therefore a legal agent always has authority to appoint a sub agent and may appoint a sub agent on its own responsibility (Civil Code Article 105).

When there is a supervisor of guardian, it is necessary to have consent of the supervisor (Patent Act Article 7(3), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

3. Extinction of Authority of Sub Agent

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

Patent procedures are considered similar to judicial procedures provided by the Code of Civil Procedure, and it is understood that authority of representation of a sub agent does not extinct upon death of an agent who has appointed the sub agent (→ Formality Examination Manual 02.26). From the same perspective, it is also understood that authority of representation of a sub agent does not extinct automatically upon resignation or dismissal of an agent.

4. Dismissal by a Principal

It is understood that a principal may also dismiss a sub agent, since a sub agent has the same rights and obligations as those of an agent to the principal and the third party (Civil Code Article 106(2)), and has the duty of care of a prudent manager in compliance with the main purport of the delegation (Civil Code Article 644) (→ Formality Examination Manual 02.26).

5. Authority of Sub Agent

A sub agent shall represent a principal with respect to any act within the scope of its authority (Civil Code Article 106(1)), and shall have the same rights and duties as an agent to the principal and the third party (Civil Code Article 106(2)).

6. Death of Sub Agent (→ 23-11)

(Revised December 2023)

23—06 P U D T**Curator**

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

A person under curatorship must have the consent of a curator when performing procedures for industrial property rights, (Patent Act Article 7(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)), and submit the 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)).

Procedures performed by a person under curatorship without consent of a curator may ratify upon obtaining the consent (Patent Act Article 16(3), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)). Therefore, when a person under curatorship appoints an agent for procedures, it is understood that the consent of a curator to appointment of an agent is also required.

(Note) A person under curatorship means someone who receives a decision to commence a curatorship from the family court due to constantly lacking the capacity to appreciate the person's own situation due to a mental disorder.

2. An indication of a curator is not required in a written demand/request for trial/appeal. Even a written demand has the indication, the JPO does not indicate a curator in documents issued by the JPO.

(Revised July 2005)

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

1. A procedure performed by those without any authority of representation may be ratified by a principal with legal capacity to act or a legal agent (→ 23-01) (Patent Act Article 16(2), Utility Model Act Article 2-5(2), 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 principal on the power of attorney is different, such a procedure is deemed unauthorized representation.

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

(4) When it is not ratified, the procedure is dismissed by decision (Patent Act Article 133(3), Utility Model Act Article 41, Design Act Article 52, 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 (Patent Act Articles 17(3), 133(2), Utility Model Act Articles 2-2(4), 41, Design Act Articles 52, 68(2), 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 (allegations and evidence) between the parties and an existence of the capacity is contested, the capacity should be searched by ex officio for determination.

2. When There Is No Agent for Undertaking Necessary Procedures

(1) In the case of a person who is not domiciled or resident in Japan (i.e. an overseas resident) (or an establishment in the case of a corporation)

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

41, Design Act Articles 52, 68(2), 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), check a power of attorney submitted during the application procedures or appeal procedures under the Patent Act Article 121(1) of the subject case, or a power of attorney attached to the notification of appointment of agent, etc. if they have been already submitted by a patentee (including a power of attorney attached to an application for transfer of registration). If it is found the power of attorney refers to the patent (utility model, design, trademark) right, the related documents shall be served (dispatched) to the latest patent administrator.

(B) When other than the above (A) or when a power of attorney has not been submitted, it should be confirmed the consent whether a patent administrator of a patent application or an appeal case under the Patent Act Article 121 (1) of the subject case, or a patent administrator of an application for transfer of registration has an intention to accept an appointment. If not accepted, the related documents shall be dispatched to the right holder and notify the right holder that the procedures thereafter must be undertaken by a patent administrator (→ 23-10).

(2) In the case of a minor, an adult ward, or a person under curatorship

A. When a minor or an adult ward performs procedures without a legal agent, order amendment to appoint a legal agent (Patent Act Articles 7(1), 133(2), Utility Model Act Articles 2-5(2), 41, Design Act Articles 52, 68(2), Trademark Act Articles 56(1), 68(4), 77(2)). However, this does not apply when a minor is capable of legally acting independently.

B. When a person under curatorship performs procedures without a consent of a curator, order submission of a letter of consent of a curator (Patent Act Articles 7(2), 133(2), Enforcement Regulation of the Patent Act Article 6,

Utility Model Act Articles 2-5(2), 41, Enforcement Regulation of the Utility Model Act Article 23(1), Design Act Articles 52, 68(2), Enforcement Regulation of the Design Act Article 19(1), 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, order submission of a letter of consent of a supervisor of guardian (Patent Act Articles 7(3), 133(2), Enforcement Regulation of the Patent Act Article 6, Utility Model Act Articles 2-5(2), 41, Enforcement Regulation of the Utility Model Act Article 23(1), Design Act Articles 52, 68(2), Enforcement Regulation of the Design Act Article 19(1), Trademark Act Articles 56(1), 68(4), 77(2), Enforcement Regulation of the Trademark Act Article 22(1)).

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

(Revised February 2015)

23—09 P U D T

Document Certifying Authority of Representation

1. Only for 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 a possibility of 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 13-5).

When a chief administrative judge finds it necessary for a procedure undertaken by an agent, he/she may order the submission of 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. Certification of 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 during the procedures or after a patent is granted (Being appointed 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 Hantei (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. Demand for an opposition to grant of patent (Enforcement Regulations of the Patent Act Article 4-3(1)(ix))

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

I. Filing a written opinion (Patent Act Article 120-5(1), 174(1), 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 trial (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 (Patent Act Article 71(3), Utility Model Act Article 26, Design Act Article 25(3), Trademark Act Article 28(3), the Patent Act Articles 84, 92(7), 93(3), Utility Model Act Articles 21(3), 22(7), 23(3), Design Act Article 33(7), Patent Act Article 134(1), Utility Model Act Article 39(1), Design Act Article 52, Trademark Act Article 56(1), Patent Act Article 174(3), Design Act Article 58(4), 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 (Patent Act Articles 119(1), 148(1)(3), 174(1)(3), Utility Model Act Articles 41(1), 45(1), 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 the 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 reclassification of trademark registration (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(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(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 that do 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, 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 been registered, a transcript (an abstract) of the family register, 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 power of attorney, a copy of which is also acceptable, may be a power of attorney specifying a particular case or a general power of attorney submitted before the Commissioner of the JPO in advance and not specifying a particular case. 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 the Civil Code or the Patent Act, etc.

(2) When a power of attorney certifying authority of representation by a voluntary agent indicates the scope of authority of representation, describe the name of the attorney (... designate Mr.(Ms.) XX as an attorney and authorize him(her) to conduct the following matters) and specify matters to be authorized by describing “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 another power of attorney: 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, waiver 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 (Patent Act Article 9, Utility Model Act Article 2-5(2), Design Act Article 68(2), 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 "Application of intervention"

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

(3) Interpretation of "Statement in court at oral proceedings"

There is no authorization for future matters after the statement at the oral

proceedings.

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

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

The special authorization is not required 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 (Patent Act Article 8(2)).

(Revised December 2023)

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 corporation, without an establishment) in Japan (hereinafter referred to as an "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), 68(4)).

(2) Demandee

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 demandee.

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 a "power of attorney") has not been submitted, confirmation should be made to the person who had previously been a patent administrator whether or not the person will accept the appointment as a patent administrator (Form 1).

If the patent administrator responds that it will accept the appointment or submits a notification of acceptance of power of attorney, the Patent Office serves (sends) a duplicate of the written request for trial (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 procedures related to 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 (sends) 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 judges 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 on an opposition to grant of patent (or registration of trademark)) may be sent without attachment of a translation of the decision.

3. The Following Points Should Be Noted When Documents Are Sent.

(1) Where an overseas resident has no patent administrator, documents will be sent by registered air mail, etc. (among services of registered mail or correspondence mail, it is defined as equivalent to registered mail under the 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 sent by registered mail, etc., under (1), the documents shall be deemed to be served at the time they are sent (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 (Form 2) 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."

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 Office

Fax: +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 agent 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 e-mail, etc. (using the attached form).

When a reply is to accept the 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

Patent No. XXXXXXXX

Invalidation No. 20XX-800xxx

Identification No.	Phone: +81-3-xxxx-xxxx
Name of Patent Administrator (xxxxxxxxxx)	xx xx xx xx

Note

Please circle the applicable number.

1. I accept the appointment for the above case.
2. I cannot accept the appointment for the above case.

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 use 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 agent office (the name and address as shown in English (alphabetical notation) as well as the Japanese translation) so that we can send

Form 2

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

November 21, 2014

To : xxxxx (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. XXXXX. 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

(Japanese translation of Form 2 - omitted)

(Revised December 2023)

23—11 P U D T

Handling of the Death of an Agent

1. Authority of representation shall be extinct by death of an agent (Civil Code Article 111(1)(ii)). After filing a demand/request for trial/appeal, a trial decision or a court decision made after death of an agent in the case only includes a name and its domicile (residence) of a demandant or a demandee, but not include a name and its domicile (residence) of the agent whose authority of representation was extinct due to the death.

2. Procedures When Death of an Agent

(1) In case of death of a legal agent, 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 procedures (→ 26-01) (The 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), or the Trademark Act Article 77(2) shall apply mutatis mutandis).

(2) In case of death of a voluntary agent, the procedures afterward will be carried out with a party concerned.

However, in the case of a patent administrator (→ 23-04), an overseas resident cannot proceed with the procedures without 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)), therefore, the related documents shall be directly sent to the party concerned and notify the party concerned to appoint a patent administrator (→ 23-10).

(3) When a sub agent has been appointed

Authority of representation of a sub agent is not extinct due to death of an agent. However, the principal is not prevented from dismissing the sub agent.

A. Considering the purpose of smooth and prompt operation of litigation representation under the Code of Civil Procedure, it is understood that authority of representation of a sub agent is not extinct despite death of a litigation agent.

B. Patent procedures are performed in a series of flows of applications, examinations, trials, etc. and considered like litigation procedures, and thus, authority of representation of a sub agent shall not be extinct due to death of an agent.

3. In Case of Death of Sub Agent

In case of death of a sub agent, the procedures afterwards will be carried out with an agent.

(Revised February 2015)

23—12 P U D T

Representation of a Legal Entity and Its Indication

A legal entity (corporation) has rights and assuming obligations to the extent of purposes 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 legal entity 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 (only in the case of a demandant/appellant) must describe in a written demand for trial/appeal (Patent Act Article 131(1)(i), Enforcement Regulations of the Patent Act Article 46, Utility Model Act Article 38(1)(i), Enforcement Regulations of the Utility Model Act Article 23(12), Design Act Article 52, Enforcement Regulations of the Design Act Article 14(1), 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 February 2015)

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

1. When 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 a case where there is the description authorizing all matters related to trial/appeal procedures) is attached to the intermediate documents and the subject agent undertakes 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. Submission of a certification in this case may be omitted, if there is no change in the content of the certification submitted previously, by notifying that in the notification (indication of incorporation of the previous certification) (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)