

26-02 P U D T

Succession of Rights and Continuation of Procedures

1. Succession of Effects of Procedures

Effects of procedures performed by a person who has a patent right or any right relating to a patent or performed for the person extend to a successor in title (the Patent Act Article 20, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

“A patent right or any right relating to a patent” includes a patent right, an exclusive license, non-exclusive license, or pledges for those. “Procedures performed for a patent right and any right relating to a patent” includes procedures performed by the Japan Patent Office as well as the owner of a patent right, etc.

2. Continuation of Procedures

Where a patent right or any right related to a patent is transferred while a case is pending before the Japan Patent Office, Commissioner of the Japan Patent Office or a chief administrative judge may continue the procedures relating to a case to which a successor in title shall be the party (the Patent Act Article 21, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

However, these provisions do not regulate continuation of the procedures with the successor if the procedures becomes suspended due to death of the person, etc.

3. Notice for Continuation

When a chief administrative judge continues to proceed with the procedures for a successor under the above provision, he/she notifies to the effect to a party concerned (Enforcement Regulations of the Patent Act Article 17,

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)).

(1) Draft of a notice for continuation

When a chief administrative judge receives a notice of transfer of the right from a registration department in charge for a case, a trial clerk shall draft a notice for continuation of procedures, he/she forwards the draft with a record to a panel.

(2) Approval of a notice of continuation

When a panel considers the above notice of continuation of procedures should be notified, a required approval shall be made.

4. Court Cases

(1) Regarding a design right, in case of pending a trial for invalidation before the JPO, there is a transfer of the design right and a chief administrative judge notifies the assignee to continue the procedures *ex officio*. In that case, the assignee of the design right acquires a status of a party concerned and an effect of procedures for the case totally affects to the assignee, regardless whether an assignor has already known about the pendency of the case (Judgment of the Tokyo High Court, 1998 (Gyo-Ke) 391, Jan. 27, 2000).

(2) Regarding an appeal against examiner's decision of refusal which is filed by a person who is a specific successor of the right to obtain a patent from a person addressed by a final rejection of the patent application, when an appeal is filed within the designated time period under the Patent Act Article 121(1) and succession of the right to obtain a patent is filed before the JPO under the Patent Act Article 34(4), an appeal requested by a person who is not the same person as the person addressed by the final rejection, which would be a defect, could be amended, however, if an appeal is requested after the time period has passed, a defect is not corrected (Judgment of the Tokyo High Court, 1985 (Gyo-Ke) 134, Dec. 24, 1985).

(Revised Feb 2015)