

## **26-02 P U D T**

### **Succession of Rights and Continuation of Procedures**

#### **1. Succession of Effects of Procedures**

Effects of the 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 (Patent Act Article 20, Utility Model Act Article 2-5(2), Design Act Article 68(2), 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” include 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 regarding the case to which a successor in title shall be the party (Patent Act Article 21, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

However, these provisions do not regulate continuation of the procedures with the successor if the procedures go into the suspended state due to death, etc. of the original party concerned.

#### **3. Notice for Continuation**

When a chief administrative judge continues the procedures to the successor under the above provisions, the party concerned will be notified to that effect (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 of continuation

When a chief administrative judge receives a notice of transfer of the right from a registration department regarding the case, a trial clerk shall draft a notice of continuation of procedures and forward 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 is required, necessary approval shall be made.

#### **4. Court Cases**

(1) Regarding a design right, when a trial for invalidation is pending 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 effects of the procedures of the case totally affects to the assignee, regardless of whether or not an assignor has already known about the pendency of the case ((1998 (Gyo-Ke) 391) Judgment of the Tokyo High Court, Jan. 27, 2000).

(2) Regarding an appeal against examiner's decision of refusal which was filed by a person who is a specific successor of the right to obtain a patent from a person who is an addressee of the final rejection of the patent application, when the 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), the appeal requested by a person who is not the same person as the addressee of the final rejection, which would be a defect, could be corrected, however, if the appeal is requested after the time period has passed, the defect is not corrected ((1985 (Gyo-Ke) 134) Judgment of the Tokyo High Court, Dec. 24, 1985).

(Revised February 2015)