26-01 P U D T
Stay of Procedures (Suspension, Termination)

1. Stay of procedures

Stay of procedures means, when there are certain reasons, all procedures are stayed until such reasons disappear.

Stay involves legal consequences, and the procedures conducted by the JPO and parties concerned during the stay are invalid in relation to both parties or the other party in principle, the progress of a time limit of the procedures is also stayed. The time limit whose progress was stayed starts again for the entire period at the time of giving a notice of resumption of the procedures, or at the time of continuation of the procedures (Patent Act Article 24 → Code of Civil Procedure Article 132(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2) shall be applied mutatis mutandis).

Stay includes suspension and termination.

2. Suspension

Suspension is a system to stay the progress of procedures: if a reason to replace a party concerned arises during the proceedings, the progress of procedures is stayed to protect interests of a new party concerned until the new party concerned may become involved in the procedures. This event naturally occurs by statutory reasons for suspension of procedures, whether the JPO and parties concerned know about the occurrence of the event or not.

Statutory reasons for suspension are shown below:

(1) Suspension due to death

A. When a party concerned is deceased, procedures are suspended until an heir, an administrator of inherited properties, or a person who should continue procedures according to the laws and regulations shall resume the

procedures (Patent Act Article 24 →Code of Civil Procedure Article 124(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)). Resumption of the procedures is not possible (Patent Act Article 24 → Code of Civil Procedure Article 124(3), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) while inheritance can be renounced (Civil Code Article 938) because the inheritance is uncertain, and a petition for resumption by the other party is also not possible.

B. Different from the Code of Civil Procedure, if there is a reason for suspension on behalf of an intervenor even if it is supporting intervention, trial procedures shall be suspended (Patent Act Article 148(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

Since parties to be supported are a party concerned for trial procedures, when there is a reason for suspension on behalf of the party concerned to be supported, the suspension also has effects on the intervenor.

C. Procedures of resumption in case of death of a party concerned (→26-04)

D. Court cases

(A) When a party concerned is deceased, if the other party is a sole successor of litigation, the litigation shall be concluded since a status of the adverse party is attributed to one person, but it shall not be suspended (Judgement of the Supreme Court, April 8, 1935 (Minshu Vol.14-511).

(B) During the pendency of a suit against a trial decision for patent invalidation where a demandant of a trial for patent invalidation is a defendant of the suit, the suit should be inherited by an heir or any other person who should continue the suit pursuant to laws and regulations based on the Code of Civil Procedure Article 124 when the defendant is deceased, but the suit shall not be concluded ((1977 (Gyo-Tsu)130) Judgment of the Supreme Court, December 18, 1980).

(2) Suspension due to corporate merger

When a corporation as a party concerned disappears due to merger, procedures are suspended until a corporation established by merger or a corporation surviving the merger resumes the procedures (Patent Act Article 24 →Code of Civil Procedure Article 124(1)(ii), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(3) Suspension due to Bankruptcy Act

A. Suspension by a decision of commencement of bankruptcy procedures

When a party concerned has received a decision of commencement of bankruptcy procedures, the procedures shall be suspended until a trustee in bankruptcy resumes the procedures (Bankruptcy Act Article 46 →Article 44(1)(2) of the same Act).

(Court cases)

During the proceedings of an appeal against examiner's decision of refusal for a joint application, a case where one of the appellants has received a decision on commencement of bankruptcy procedures, the appeal procedures are naturally terminated by the decision of commencement of bankruptcy procedures, and the suspension for one of the appellants shall have effects on all appellants (Patent Act Article 132(4)). Therefore, an appeal decision rendered during the suspension shall be invalid ((2010 (Gyo-Ke) 10270) Judgment of the IP High Court, October 25, 2010).

B. Suspension due to completion of bankruptcy procedures

Where procedures are suspended due to a decision of commencement of bankruptcy procedures and the procedures are completed after resumption of the procedures by a trustee in bankruptcy, the procedures shall be suspended until a party concerned who is a bankrupt resumes the procedures (Bankruptcy Act Article 46 →Article 44 (4)(5) of the same Act).

(4) Suspension due to loss of procedural capacity of a party, death of legal agent, extinction of legal authority of representation

A. When a party concerned has lost the capacity for procedures, a legal agent is deceased, or legal authority of representation is extinguished, the

procedures shall be suspended until a legal agent or a party concerned who has acquired procedural capacity resumes the procedures (Patent Act Article 24 →Code of Civil Procedure Article 124(1)(iii), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

B. Extinction of legal authority of representation does not take effect unless the party concerned or the agent notifies that fact to an adverse party (Code of Civil Procedure Article 36(1)). This provision shall apply mutatis mutandis to extinction of authority of a representative or an administrator of a corporation or other organizations (Code of Civil Procedure Article 37, Rule of Civil Procedure Article 18).

C. When a government office is a party concerned, a change of the head of the government office becomes extinction of a legal authority of representation. However, there is no suspension if there is an authorized agent (Patent Act Article 24 →Code of Civil Procedure Article 124(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) ((1915 (O) 572) Judgement of the Supreme Court, October 16, 1915 (Civil Court Decisions at the Supreme Court (Minroku) Vol.21-1644)).

D. When a company goes into dissolution and a former director has become a legal liquidator, it does not change a legal authority of representation (Companies Act Article 478).

(5) Suspension due to completion of trustee's duties

When duties of a trustee who is a party concerned are ended, the procedures shall be suspended until a new trustee resumes the procedures (Patent Act Article 24 →Code of Civil Procedure Article 124(1)(iv), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(6) Suspension due to change of qualification

In a case where a person having a certain qualification acts as a party concerned of the procedures under his/her own name on behalf of another person (including a party concerned based on a certain qualification, namely a party concerned by duty, etc. hereinafter in this section, referred to as "a

qualified party concerned"), when he or she has lost a qualification, the procedures are suspended until a different person with the same qualification resumes the procedures. The same applies upon death of a qualified party concerned (Patent Act Article 24 → Code of Civil Procedure Article 124(1)(v), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(7) Suspension due to application of Corporate Reorganization Act

A. Suspension due to a decision on commencement of reorganization procedures

A company that is a party concerned has received a decision on commencement of reorganization procedures from a court (Corporate Reorganization Act Article 41), the procedures are suspended until a trustee, etc. resumes the procedures (Corporate Reorganization Act Article 53 → Article 52(1)(2) of the same act).

B. Suspension due to completion of reorganization procedures

When procedures are suspended due to a decision on commencement of reorganization procedures and the reorganization procedures are completed after resumption of the procedures by a trustee, the procedures are suspended until a corporation, etc. resumes the procedures (Corporate Reorganization Act Article 53 → Article 52(4)(5) of the same act).

(8) Suspension due to Civil Rehabilitation Act

A. Suspension due to an administration order

Procedures are not suspended when there is a decision on commencement of rehabilitation procedures. However, when an administration order is issued and a rehabilitation debtor is a party concerned in litigation related to properties of a rehabilitation debtor, the procedures are suspended (Civil Rehabilitation Act Article 69 → Article 67(2) of the same act).

B. Suspension due to completion of rehabilitation procedures

When procedures are suspended due to an administrative order, and the rehabilitation procedures are completed after resumption of the procedures

by a trustee or a decision to cancel the administrative order becomes final and binding, the procedures are suspended until a rehabilitation debtor resumes the procedures (Civil Rehabilitation Act Article 69 → Article 68(2)(3)(4) of the same act).

(9) Suspension due to a provisional administration order by court

In a case where commencement of bankruptcy procedures, reorganization procedures or rehabilitation procedures are filed, when a court issues a provisional administration order, the procedures are suspended until a provisional administrator resumes the procedures (Bankruptcy Act Article 96(2)→ Article 44 of the same act, Corporate Reorganization Act Article 34(3)→ Article 52 of the same act, Civil Rehabilitation Act Article 83(3)→ Articles 67, 68 of the same Act).

(Note)

For an opposition to grant of patent (registration of trademark), succession of the procedures is not permitted. Therefore, the above reasons for suspension (1) ~ (9) are not applied to an opponent of opposition to grant of patent (registration of trademark) (→66-02 2., 67-02 2.).

3. Exemption from Suspension

(1) In the cases of (1)A, (2), (4), (5) or (6) in the above 1., suspension is exempted when there is an authorized agent (Patent Act Article 24 →Code of Civil Procedure Article 124(2), Utility Model Act Article 2-5(2), the Design Act Article 68(2), Trademark Act Article 77(2))(→26-04 1. (3)).

(2) Court cases of exemption from suspension

① When a litigation agent does not have a special authorization for filing an appeal, a court decision of said instance is served but due to lack of litigation agent for proceedings with the higher court, the litigation procedures thereafter shall be suspended in relation to filing a higher court ((1931 (Ku) 788) Judgment of the Supreme Court, August 8, 1931).

② In a case where there is a special authorization for appeal or a final appeal, suspension is not caused until a final court decision becomes final and binding, namely until the end of litigation ((1933 (Ku) 1059) Judgment of the Supreme Court, July 27, 1933).

(3)Handling in the event of death of an agent (→23-11)

4. Termination

When the JPO or a party concerned has become impossible or inappropriate to continue trial/appeal procedures, the procedures shall be terminated ipso jure, or by decision of the Commissioner of the JPO or the panel. Statutory reasons for termination are shown below:

(1) Termination due to impossibility of execution of duties by the JPO

When the JPO is impossible to execute its duties due to a natural disaster or any other reasons, the procedures shall be terminated until such a reason ceases to exist (Patent Act Article 24→Code of Civil Procedure Article 130, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(2) A panel may terminate procedures by request or ex officio in the following cases:

A. Termination due to a problem affecting a party concerned

When it is not possible for a party concerned to continue the procedures due to a problem affecting a party concerned for an uncertain period of time, the procedures may be terminated until such a problem ceases to exist (Patent Act Article 24→Code of Civil Procedure Article 131(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

B. Termination of procedures of a joint trial, etc.

For a joint trial or a re-trial of the joint trial, when some of the parties concerned have a problem affecting them and therefore the procedures may not be continued, the whole procedures may be terminated (Patent Act

Articles 132(4), 174(2)~(4), Utility Model Act Article 41, Design Act Articles 52, 58(4), Trademark Act Articles 56(1), 68(4)).

(3) Termination by court order

When there is a court order, procedures shall be terminated.

(Example)

In a case where a petition for commencement of reorganization procedures is filed, if it is found necessary, a court may order termination of procedures for a case relating to the assets of the company that is pending before an administrative agency, by request of an interested party or ex officio, until a decision on the petition for commencement is made (Corporate Reorganization Act Article 24(1)).

5. Order of Termination by decision

When it is impossible for a party concerned to continue trial procedures due to a problem affecting him/her for an uncertain period of time, the Commissioner of the Japan Patent Office or the panel may order termination of the procedures by decision (Patent Act Article 24 → Code of Civil Procedure Article 131(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

6. Termination due to Another Trial or Litigation

(1) If it is found necessary in a trial, trial procedures may be terminated until an opposition to grant of patent (registration of trademark) is determined, a trial decision of another trial becomes final and binding, or court proceedings are completed (Patent Act Article 168(1), Utility Model Act Article 40(1), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(Example) Handling of a trial for patent invalidation related to a trial for correction (→51-22)

(2) Court cases of termination

A. Until completion of civil proceedings and criminal proceedings, it depends on discretion of an administrative judge whether trial procedures should be terminated, but it does not necessarily to terminate the procedures ((1947 (O) 11) Judgment of the Tokyo High Court, May 28, 1948), ((1956 (Gyo-Na) 15) Judgment of the Tokyo High Court, March 12, 1957). It is not permitted the right to request for termination of procedures ((1938 (O) 1270) Judgment of the Supreme Court, November 28, 1938).

B. During the pendency of an invalidation trial case, even if a person who demands a trial case for permission to correct the patent right submits a request for termination of an invalidation trial, the case is neither bound by the request nor necessary a decision on permission of the request ((1935 (O) 2143) Judgment of the Supreme Court, July 11, 1936).

7. Effect of Suspension or Termination

(1) Stay and start of progress of a time limit

When procedures are suspended or terminated, progress of a time limit shall be stayed. When the procedures progress again by resumption or cancellation of termination, the entire time limit will start again from the time of the continuation (Patent Act Article 24→Code of Civil Procedure Article 132(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

It is only procedural time limits to stay the progress by suspension or termination. For example, if a term of the patent right (Patent Act Article 67) is expired during suspension or termination, said patent right becomes extinct.

(2) Joint trial

There is a reason for suspension or termination of trial procedures on any of the demandants of a joint trial or any of the demandees of a demand for a trial for a jointly owned patent right, the said suspension or termination shall have effect on all of the demandants or demandees (Patent Act Article 132(4)).

(3) Prohibition of proceedings

A panel or parties concerned may not proceed with procedures on the case during suspension or termination.

(4) Procedures during suspension or termination

Procedures made during suspension or termination are illegal, however, when a petitioner does not contest validity of the procedures made by a party concerned or the JPO during suspension or termination (hereinafter, referred to as “procedures during suspension”) in filing a petition for resumption or continuation (including a petition for resumption due to a notice of change of applicant), it is not allowed for the petitioner to assert invalidity or cancellation of the procedures during suspension (→Formality Examination Handbook 05.11 (Intermediate Procedures-8).

(5) Court cases regarding validity of suspension or termination

During suspension of procedures of litigation, an act of litigation of a party concerned on the merits is invalid in relation to the other party. However, if the other party clearly recognizes such an act or maintains a litigation act without any objection, it is understood that the other party will lose a right to assert invalidation of the litigation thereafter due to so-called waive of right to allege procedural errors ((1938 (O) 2445) Judgment of the Supreme Court, September 14, 1939).

In a case where the trail procedures are suspended after one of the demandants of the joint trial, Y, is declared bankrupt, but the trial decision is served due to overlooking the suspension, the suspension that has occurred on Y is effective on all defendants who are the demandants of the joint trial (the Patent Act Article 132(4)) ((2000 (Gyo-Ke) 227) Judgment of the Tokyo High Court, January 31, 2001).

8. Resumption of Procedures Which Were Suspended or Terminated

Resumption of procedures which suspended or terminated is made by a petition, specifically, a document stating to that effect is filed to the JPO.

A person who may file a petition shall be a new prosecutor and the other party of the new prosecutor (Patent Act Article 24 → Code of Civil Procedure Article 126).

9. Notice of Petition for Resumption of Procedures Which Were Suspended or Terminated

When a petition for resumption stated in the preceding item is filed, a chief administrative judge should notify that effect to the other party (Patent Act Article 24→Code of Civil Procedure Article 127, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

10. Decision on Resumption of Procedures Which Were Suspended or Terminated

(1) The Commissioner of the Japan Patent Office or administrative judges (a panel) should decide whether to permit a petition for resumption of procedures which suspended after service of a transcript of a decision, an examiner's decision, or a trial decision (Patent Act Article 22(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) (→26-05 1.)

A notice of resumption by the Commissioner of the Japan Patent Office or a chief administrative judge shall cancel the suspension and resume the procedures (Patent Act Article 24→Code of Civil Procedure Article 132(2)).

(2) The Commissioner of the Japan Patent Office or a panel shall examine ex officio a petition for resumption of trial procedures, and if it is found there is no grounds for the petition, it shall be dismissed by decision (Patent Act Article 24→Code of Civil Procedure Article 128(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)). Suspension shall continue if a petition is dismissed.

11. Order of Resumption of Procedures Which Were Suspended or Terminated

If procedures for examination, proceedings and decision for an opposition to grant of patent (registration of trademark), or a trial/appeal or retrial/re-appeal have been suspended and a person who is responsible for resumption of these procedures as a party fails to do so, the Commissioner of the Japan Patent Office or a panel shall order the person to resume the procedures by specifying a considerable time period upon the other party's request or ex officio (Patent Act Article 23(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) (→26-04 1. (1) B).

In this case, if there is no resumption within the designated time period, it may be considered that the resumption is made on the date on which the specific time period has elapsed (Patent Act Article 23(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)). In such a case, the Commissioner of the Japan Patent Office or a chief administrative judge shall notify parties concerned of that effect (Patent Act Article 23(3), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)) (→26-04 1. (1) C, D).

12. Effect of Suspension or Termination to Intervenor (→57-05 3.)

13. Termination Due to Exclusion, Recusation

If there is a petition for exclusion or recusation, trial procedures shall be terminated until a decision is made on the petition, however, this does not apply to urgent actions (Patent Act Article 144, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

14. Termination Due to Dismissal of Amendment for Design/Trademark Registration Applications

The Design Act Article 17-2(4) (applies mutatis mutandis to Article 50(1) of the same Act) and the Trademark Act Article 16-2(4) (applies mutatis mutandis to Article 55-2(2) of the same Act) provide the below: when an

appeal is requested under the Design Act Article 47(1) or the Trademark Act Article 45(1) or a litigation is filed under the Design Act Article 59(1) or the Trademark Act Article 63(1) against the decision of dismissal of amendment regulated under the paragraph (1) of the Design Act Article 17 and the Trademark Act Article 16, the examination or the appeal against examiner's decision of refusal for the design or trademark registration application shall be terminated until the appeal decision or the court decision of litigation becomes final and binding.

(Note) The Design Act Article 17-2(3) and the Trademark Act Article 16-2(3) provide "If a decision dismissing an amendment under paragraph (1) has been rendered, the examiner shall not render any decision on the said application for design registration or trademark registration until three months have lapsed from the date on which a certified copy of the decision has been served." This shall not regulate termination of examination (or appeal).

Therefore, it is not illegal to proceed procedures other than rendering a decision, for example, a notice of reasons for refusal, an order of amendment, on an application for a design or trademark registration within the time limit of 3 months (in the case of an appeal decision, within a time limit of 30 days). A designated time limit, etc. for procedures taken before and after or at the same time of rendering the decision of dismissal of amendment, the progress of time limit does not stay unless an appeal or litigation is filed.

(Revised December 2023)

26-01.1 P U D T
Handling of Cases When, as a Result of Suspension of Procedures for a Long Period of Time, Duration of Right Has Exceeded a Time Limit and Therefore, It Has Become Impossible to Obtain a Right

1. Handling

As a result of suspension of procedures for a long period of time for some reason, if a trial case has become impossible to obtain the right even if it is registered due to excess of duration of the right, the trial procedures shall be terminated ex officio.

(Reference) Cases where duration of the right has exceeded as a result of suspension of procedures for a long period of time

(1) A case where procedures are not resumed after suspension due to death of a patent administrator (Applications filed before 1994).

(2) A case where, after liquidation of a company, there is no cooperation of a liquidator at the time of liquidation and it is unknown whether there is a person succeeding the right to obtain a patent.

(Revised February 2015)

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)

26-03 P U D T
Special Provision to Time Limit for Demand/Request for Trial/Appeal (Retrial)

1. If a demandant/appellant is unable to file a demand/request for a trial/appeal (retrial) in a statutory period (Patent Act Articles 121(1), 173(1), Utility Model Act Articles 45, Design Act Articles 46(1), 47(1), 58, Trademark Act Articles 44(1), 45(1), 61, 68(4)(5)) due to reasons not attributable to the demandant/appellant, the demandant/appellant may file it within 14 days (for overseas residents, within 2 months) from the date on which such reasons no longer exist, but no later than 6 months after the lapse of said statutory period (Patent Act Articles 121(2), 173(2), Utility Model Act Article 45, Design Act Articles 46(2), 47(2), 58, Trademark Act Articles 44(2), 45(2), 61, 68(4)(5)).

2. Court Cases

A. Even though a person responsible for maintenance management work related to industrial property rights in a company is busy, it does not fall under “the reason not attributable to a demandant” ((1972 (Gyo-U) 110) Judgment of the Tokyo High Court, Nov 16, 1973).

B. Even though a demandant goes to hospital and has an operation, it cannot be said there is extremely difficult to prepare and submit a demand for trial except when a person suffers from a serious pain after the operation, it does not fall under “the reason not attributable to a demandant” ((1980 (Gyo-Ke) 227) Judgment of the Tokyo High Court, Jan 27, 1981).

C. When a demandant is an overseas resident and a domestic agent is ill, it does not fall under “the reason not attributable to a demandant” ((1982 (Gyo-

Ke) 91) Judgment of the Tokyo High Court, Oct 28, 1982).

D. If it is based on negligence of a clerk of the agent office, it does not fall under the “reason not attributable to a demandant” ((1989 (Gyo-Tu) 8) Judgment of the Supreme Court, Third Petty Bench, Apr 11, 1989).

(Revised Feb 2015)

26-04 P U D T
Resumption of Procedures

1. Death of a Party Concerned

(1) When an agent is not appointed

Procedures shall be suspended until resumption is completed (→26-01). When a fact of the death is not confirmed, administrative procedures for resumption are as follows:

A. Even if death of a party concerned may be presumed, but cannot be confirmed as indicated in the below, a chief administrative judge requests a local government for a copy of family register and an attachment of a family register using a written commission of an attached Form 1.

(A) When a mail served by the JPO is returned to the JPO as undeliverable due to death of a recipient (Appeal trial 2837, 1955)

(B) When a relative, etc. of a party concerned notifies death of the party concerned by a written statement, etc., however, materials evidencing the notice are not attached with the written statement (Appeal trials 618, 619, 1953)

B. When resumption of procedures is deemed necessary due to death of a party concerned, the Commissioner of the JPO or administrative judges (a panel) shall order resumption of the procedures by a written order of resumption of procedures using Form 2 to an heir who was confirmed according to A. upon designating an adequate time limit by request of the other party or ex officio (Patent Act Article 23(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

C. When there is no resumption within the time limit designated in B., the Commissioner of the JPO or administrative judges (a panel) may consider resumption has been made on the day when the time limit has lapsed (Patent Act Article 23(2), Utility Model Act Article 2-5(2), Design Act Article 68(2),

Trademark Act Article 77(2)).

D. When the Commissioner of the JPO or a chief administrative judge may consider resumption has been made according to C, the Commissioner of the JPO or a chief administrative judge shall notify a party concerned to that effect by a notice of continuation of procedures using Form 3 (Patent Act Article 23(3), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(2) Examples of resumption of procedures

A. An administrative judge who hears of death of a right holder A of an invalidation trial shall commission a municipal office M to send a copy of family register for confirming the death and the heir using Form 1.

B. After confirming the death by a copy of family register, the JPO orders all 6 people who are believed to be an heir to resume the trial procedures by specifying the time limit of 30 days using Form 2.

C. The JPO orders to submit a document proving renouncement of the inheritance of A stating the address and name of all 6 heirs and affixing a seal of all heirs since they have renounced the inheritance of A.

D. There is submission of a renouncement of the inheritance stating that all rights arising from the patent has been renounced, however, the following measure is taken for confirming the effect on the Civil Code.

E. Due to the death (with date) of the patentee A (with address), the JPO commissions a family court M to inform the JPO upon searching whether the heirs accept or renounces the inheritance pursuant to Civil Code Articles 915, 938 within 3 months from the date on which the heirs have known their inheritance.

F. The JPO receives a reply from the family court M that there is no statement on renunciation of the inheritance or qualified acceptance, therefore, there is no reasons for considering there was no inheritance. It is found that later in that trial decision “the inheritance of the patent right has been once done,

then all rights arising from these patent rights in each item were renounced".

(3) When an agent is appointed (→26-01 3. (1))

Since the authority of representation is not extinguished even the party concerned is deceased (Patent Act Article 11, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)), the procedures shall not be suspended by application of the Code of Civil Procedure Article 124(2) as applied mutatis mutandis pursuant to the Patent Act Article 24 (Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)), but note the following points:

A. The procedures shall be suspended when the authority of representation for litigation is lost due to resignation, death of an agent, or other reasons, or when matters within the authority of representation originally given to the agent have been completed.

For example, the authority of representation of the agent is in principle made at each instance (Principle of Appointment of Agent at Instance). The procedures shall be suspended after service of a transcript of a trial decision even there is an agent, except a case where there is the authority of representation for an upper instance court such as there is a special authorization to file a litigation rescinding a trial decision ((1972 (Gyo-Ke) 12) Judgment of the Tokyo High Court, June 29, 1973), ((1967 (Gyo-So) 1) Judgment of the Tokyo High Court, November 21, 1967).

B. If replacement of a party concerned is occurred due to a reason for suspension, an agent shall undertake the trial procedures for a new party concerned. At this time, however, a trial may continue under the name of the previous party concerned and continuation of the proceedings is not prevented from the progress without clarifying who a successor is at that time.

C. Regarding a trial decision made under the name of the deceased person, the decision is valid for a successor that is different from the case where the deceased person was a party concerned from the beginning.

In a case where a party concerned is deceased, etc., the successor submits a power of attorney under his/her name again, eligibility of the succession shall be searched. If the succession considers eligible, a trial decision made under the successor's name shall not be prevented. Even if a trial decision is made under the name of the person who is not eligible for succession, the trial decision is also valid as made for a true successor.

2. Bankruptcy, etc. of Corporation That Is a Party Concerned

(1) Procedures which are suspended due to a decision of commencement of bankruptcy procedures (Bankruptcy Act Article 30(1)), a decision of commencement of rehabilitation procedures (Corporate Reorganization Act Article 41(1)), or an administration order (Civil Rehabilitation Act Article 64(1)) to a party concerned (Bankruptcy Act Article 44(1) as applied mutatis mutandis pursuant to Article 46 of the same Act, Corporate Reorganization Act Article 52(1) as applied mutatis mutandis pursuant to Article 53 of the same Act, Civil rehabilitation Act Article 67(2) as applied mutatis mutandis pursuant to Article 69 of the same Act) may be resumed by a trustee, etc. (Bankruptcy Act Article 44(2) as applied mutatis mutandis pursuant to Article 46 of the same Act, Corporate Reorganization Act Article 52(2) as applied mutatis mutandis pursuant to Article 53 of the same Act, Civil rehabilitation Act Article 67(3) as applied mutatis mutandis pursuant to Article 69 of the same Act).

(2) When bankruptcy procedures or rehabilitation procedures are completed or a decision of cancellation of an administration order is concluded before the resumption of item (1), a party concerned who is a bankrupt, etc. shall automatically resume the procedures (Bankruptcy Act Article 44(6) as applied mutatis mutandis pursuant to Article 46 of the same Act, Corporate Reorganization Act Article 52(6) as applied mutatis mutandis pursuant to Article 53 of the same Act, Civil rehabilitation Act Article 68(4)(1) as

applied mutatis mutandis pursuant to Article 69 of the same Act).

(3) After the resumption of item (1), when the procedures are suspended due to completion of bankruptcy procedures or rehabilitation procedures or finalization of a decision of cancellation of an administration order, a party concerned who is a bankrupt, etc. shall resume the procedures (Bankruptcy Act Article 44(5) as applied mutatis mutandis pursuant to Article 46 of the same Act, Corporate Reorganization Act Article 52(5) as applied mutatis mutandis pursuant to Article 53 of the same Act, Civil rehabilitation Act Article 68(5)(3) as applied mutatis mutandis pursuant to Article 69 of the same Act).

(Revised December 2023)

Form 1（No. 1）

Commission

M/D/Y

To Head of municipality

Chief Administrative Judge, JPO

For the appeal case FUFUKU 20XX-OOOOOO（Patent Application No. 20YY-△△△△△△）, the JPO will ask you to send each one copy of family register and a supplementary of family register of the following person who is an appellant to confirm a fact of decease and an heir of said person (Family Register Act Article 10-2(2)).

Address
Name

Form 1 (No. 2)

Commission

M/D/Y

To Head of municipality

Chief Administrative Judge, JPO

For the invalidation trial case MUKOU 20XX-800OOO（Patent Registration No. OOOOOOO）where, the JPO will ask you to send a copy of residence record, or a copy of deleted residence record if moving out of the following person who is a registered right holder to confirm his/her whereabouts (Act of the Basic Resident Registers Article 12-2(1)).

Address
Name

Form 2

Dispatch No.123456 1/E

Dispatch Date M/D/Y

Order of Resumption of Procedures

M/D/Y

Chief Administrative Judge, JPO

Appeal No. FUFUKU 20XX-000000

(Patent Application No.) (Patent Application No. 20YY-△△△△△△)

Heir presumptive Mr./Ms. ○○○○

For this appeal case, as a result of ex-officio search by the JPO, it is found that Mr./Ms. ○○○○ who is an appellant, is deceased on (month/day/year).

You are recognized as the first rank presumptive (joint) heir(s), therefore, resumption of the appeal procedures must be made within 60 days from the date on which this notice was dispatched.

If you fail to do so within the designated time limit, the appeal procedures shall be continued upon assuming that there was resumption under the provision of the Patent Act Article 23 (2).

Other first rank presumptive heirs ○○○○
○○○○

(Utility Model) The Patent Act Article 23(2) shall apply mutatis mutandis to the Utility Model Act Article 55(2) before the revision of 1993.

(Design) The Patent Act Article 23(2) shall apply mutatis mutandis to the Design Act Article 68(2).

(Trademark) The Patent Act Article 23(2) shall apply mutatis mutandis to the Trademark Act Article 77(2).

Please contact below if any query:
The OOth Trial and Appeal Division
Tel: 03(3581)1101 Extension XXXX Fax: ( )

Form 3

Dispatch No. 123456 1/E
Dispatch Date M/D/Y

Notice of Continuation of Procedures

M/D/Y

Chief Administrative Judge, JPO

Appeal No. FUFUKU 20XX-000000
(Patent Application No.) (Patent Application No. 20YY-△△△△△△)
Heir Mr./Ms. ○○○○

For this appeal case, since Mr./Ms. ○○○○ who is an appellant is deceased (month/day/year), we have asked you to resume the appeal procedures. However, there was no petition filed for resumption within the designated time period. Therefore, the appeal procedures shall be continued upon assuming that there was resumption under the provision of the Patent Act Article 23 (2).

(Utility Model) The Patent Act Article 23(2) shall apply mutatis mutandis to the Utility Model Act Article 55(2) before the revision of 1993.

(Design) The Patent Act Article 23(2) shall apply mutatis mutandis to the Design Act Article 68(2).

(Trademark) The Patent Act Article 23(2) shall apply mutatis mutandis to the Trademark Act Article 77(2).

Please contact below if any query:
The OOth Trial and Appeal Division
Tel: 03(3581)1101 Extension XXXX Fax: ( )

26-05 P U D T
Decision to Approve or Disapprove Resumption of Procedures

1. The Commissioner of the JPO or administrative judges (a panel) shall decide whether to approve (permission) or not to approve (rejection) resumption of procedures when a request is filed for resumption of procedures suspended after service of a certified copy of a decision, an examination decision, or a trial decision (Patent Act Article 22(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

There is a provision under Code of Civil Procedure Article 128 with the same purpose. This provision shall be made to clarify a person receiving an effect of a court decision and a time limit of appeal.

2. A decision prescribed in 1. shall be made in writing and accompanied with reasons (Patent Act Article 22(2), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

3. A certified copy of the decision shall be sent to a party concerned.

4. Example of Decision

Trial No. 3541, Trial decision of 1969.

(Revised Feb 2015)