

30-03 P U D T

Consolidation and Separation of Trial and Appeal Proceedings

1. Consolidation of Proceedings

(1) Significance of consolidation of proceedings

A. Definition of consolidation of proceedings

Consolidation of proceedings is to examine two or more trial/appeal cases by the same trial/appeal procedures. Two or more trial/appeal cases where both or one of the parties concerned are the same may consolidate the proceedings (the Patent Act Article 154(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

However, if each invalidation trial case is largely different in the procedures for allegation and evidence of the parties concerned, those cases shall not be consolidated in principle because the applicable laws are different in each case.

B. Purpose of consolidation of proceedings

A purpose of consolidation of proceedings is to simplify trial/appeal procedures by avoiding redundancy of the proceedings, and also to prevent from contradiction and conflict with mutual trial/appeal decisions.

(Example) When two or more invalidation trials are demanded for the same patent and requests for correction are filed for each trial, subjects of the proceedings in each trial would be different respectively due to an earlier or later final and conclusive trial decision. As a result, the invalidation trials become complicated. Therefore, the trial/appeal procedures such as a request for correction, etc. could be common by taking advantage of consolidation of proceedings.

(2) Requirements for consolidation of proceedings

A. Both parties concerned are the same or one of the parties concerned is the same

Proceedings may be consolidated for either ex parte trial cases or inter partes trial cases if “both parties concerned” or “one of the parties concerned” are the same.

B. Two or more trials/appeals

“Two or more trials/appeals” may be consolidated when they are the same type of trials/appeals.

Regarding a retrial, the regulations for consolidation and separation shall apply mutatis mutandis to a retrial against a final and conclusive trial decision of a patent invalidation trial and an invalidation trial for registration of an extension of the term (the Patent Act Article 174(3), the Utility Model Act Article 45, the Design Act Article 58(4), the Trademark Act Article 61).

C. Necessity of consolidation of proceedings

It is necessary to be judged to expect achievement of the above purpose of consolidation of proceedings by consolidating the proceedings. It is considered that the followings may be expected to achieve the purpose of consolidation:

- (A) Similar examination of evidence;
- (B) Common in technical basis of the subject matter of inventions;
- (C) Same cited references/means of evidence; and
- (D) Two or more invalidation trials against the same right.

It is not permitted that the gist of reasons for demand is changed by an amendment, in an invalidation trial for patent, design, trademark, new utility model and old utility model. Therefore, it should be determined whether the proceedings shall be consolidated in view of the prompt proceedings based on the purpose of consolidated proceedings for the cases different in reasons for invalidation.

D. Time of consolidation of proceedings

Consolidation of proceedings shall be carried out before the conclusion of the proceedings.

(3) Procedures of consolidation of proceedings

A. Determination of administrative judges (a panel)

A panel has authorization to determine whether the proceedings shall be consolidated, and a panel may decide *ex officio* at the discretion of the determination.

B. Notice of consolidation of proceedings

A chief administrative judge shall notify parties concerned of consolidation of the proceedings.

(4) Effect of consolidation of proceedings

A. Trial/Appeal decision

For trial/appeal cases of which proceedings are consolidated, the same written trial/appeal decision is made for each case at the same time.

B. Use of submitted documents and means of evidence, etc.

When two or more proceedings of trials/appeals are consolidated, documents and other materials submitted or presented at each trial case before consolidation, and means of evidence, etc. obtained at the proceedings of each trial case before consolidation may use for the consolidated trial/appeal cases.

However, when said means of evidence shall be applied to the proceedings for the consolidated trial cases, in view of regulation's purposes of the Patent Act Article 153 (*Ex officio* Proceedings), the Patent Act Article 150 (Examination of Evidence and Preservation of Evidence), the Patent Act Article 134 (Submission of Written Reply, etc.), and the Patent Act Article 50 (Notice of Reasons for Refusal) applied *mutatis mutandis* to the Patent Act Article 159 (2), it should be understood that an opportunity must be given to a party concerned to state an opinion or submit a written reply on the related patent, etc. For example, in a case where two patent invalidation trial

Case A and Case B are consolidated, a reason for invalidation X submitted for Case A shall also invalidate Patent B1 of Case B. In this case, if an opportunity to submit a written reply to a reason for invalidation X is not given for Case B, an opportunity to submit a written reply for the above purpose on Patent B1 in the proceedings of the consolidated trial case should be given.

(5) Consolidation of proceedings in *Hantei* (Advisory Opinion)

Proceedings of two or more Advisory Opinion shall be consolidated and also shall be separated (the Patent Act Article 71(3), the Utility Model Act Article 26 → the Patent Act Article 71(3), the Design Act Article 25(3), the Trademark Act Article 28(3)).

Note that, purpose, requirements, procedures and effects thereof shall follow the examples of a trial/appeal.

(6) List of items related to consolidation of proceedings in Manual for Trial and Appeal Proceedings

- A. Procedures of a trial/appeal decision → (45-01 4.)
- B. Matters to be included in an inter partes trial decision → (45-03 2.)
- C. Indication of conclusion of a trial/appeal decision, court decision
→ (45-04 5.(3))
- D. Proceedings of a patent (registration) invalidation trial → (51-09 5.)
- E. Proceedings of a trial for correction → (54-06 4.)
- F. Proceedings of an advisory opinion → (58-02 2.(4))
- G. Proceedings of an opposition to registration of trademark → (66-05 1.(2))
- H. Proceedings of an opposition to grant of patent → (67-07)

2. Separation of Proceedings

(1) Significance of separation of proceedings

Separation of proceedings means to separate consolidated proceedings, namely two or more trial/appeal cases examined under the same trial/appeal

proceedings shall be separated. When proceedings are consolidated, the proceedings shall be also separated (the Patent Act Article 154(2), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

It is intended to separate the proceedings and examine by separate procedures to simplify and promote the procedures, if it is found that a certain trial case has no relevant to other trial cases, and such a case is not merely necessary to proceed in the same procedure with other cases, on the contrary, it becomes a cause of complexity and delay of the proceedings.

(2) Requirements of separation of proceedings

Separation of proceedings are limited only for cases whose proceedings are consolidated.

(3) Procedures of separation of proceedings

A. Determination of administrative judges (panel)

A panel has authorization to determine whether the proceedings shall be separated, and a panel may decide *ex officio* at the discretion of the determination.

B. Notice of separation of proceedings

A chief administrative judge shall notify parties concerned of separation of the proceedings.

(4) Effect of separation of proceedings

A separated trial/appeal shall be examined and determined in a separate and independent procedure and made decisions separately.

Evidence materials such as submitted documents before separation have a common effect on both procedures.

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