

30-01 P U D T

Amendment and Change of Gist of a Written Demand/Request for Trial and Appeal

1. Amendment of Written Demand/Request for Trial and Appeal

(1) A person who demands/requests for a trial/appeal shall file a written demand/request with Commissioner of the Japan Patent Office and an amendment of the filed written demand/request must not change a gist of the filed written demand/request.

Therefore, regarding amendments of the following items A to C, an amendment which changes the gist of the filed written demand/request shall not be permitted in a trial and appeal of patent, utility model (including old utility models before the revision of law in 1993), design, or trademark:

A. a party concerned, etc.;

B. an identification of the trial/appeal case; and

C. a purport of the demand/request and its reason.

(2) However, the above does not apply to an amendment of a reason for demand/request of a trial and appeal other than a trial for invalidation for patent, old utility model, design or trademark (the Patent Act the proviso (i) of Article 131-2(1), Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 4 the Old Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

(3) An amendment of a reason for demand for an invalidation trial is as follows (→51-04)

A. Even if an amendment is made for a reason for demand, it shall not change the gist of written demand for an invalidation trial of patent, old utility model, design or trademark, with except following C (the Patent Act Article 131-2, etc.);

B. An amendment of a reason for demand shall not change the gist of the written demand for a trial for invalidation of new utility model registration registered after January 1, 1994 (the Utility Model Act Article 38-2(i)).

C. A chief administrative judge may permit an amendment to change the gist of a reason for demand for a trial for invalidation of a patent, new utility model, old utility model, design, or trademark (the Patent Act the proviso (i) of Article 131-2(1), the Utility Model Act the proviso of Article 38-2, Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2) the Old Utility Model Act Article 41, the Design Act Article 52).

(4) When the descriptions in a written request for a trial for correction do not satisfy the requirements of descriptions (the Patent Act Article 131(3)), a chief administrative judge shall require a party concerned to amendment under the provision of the Patent Act Article 133(1). Only amendment to be required shall be permitted to change the gist (the Patent Act Article 131 the proviso (iii) of Article 131-2(1)).

2. Amendment of Party Concerned, etc.

(1) Demandant/Appellant

Excluding the case where the identity of demandant/appellant may be maintained (for example, correction of errors), an amendment of demandant/appellant shall change the gist (→22-01 9.).

(2) Demandee/Appellee

Excluding the case where the identity of demandee/appellee may be maintained, an amendment of demandee/appellee shall change the gist (→22-01 9.).

When a written demand for invalidation trial states a part of the joint owners as a demandee, it shall in principal change the gist by adding the remaining joint owners as a demandee by an amendment (→22-03, 51-05 2.).

(3) Representative of corporation

In a case where a party concerned is a corporation, when there is no agent, an amendment to fill in a missing representative's name of a demandant/appellant in a written demand/request or to change the representative's name stated in the demand/request shall not change the gist.

(4) Agent

It shall not change the gist to amend errors of the agent's name. In case of a lawyer/a patent attorney, amendment of his/her address shall not change the gist. When an agent is a patent attorney corporation, etc., an amendment to fill in a missing representative's name of the agent in a written demand/request, or to change the representative's name stated in the demand/request shall not change the gist.

3. Amendment of Identification of Trial/Appeal Case and Purport of Demand/Request

(1) Amendment of the application number or registration number

In a case where an application number or a registration number has an error and the error is amended, only if the amendment does not lose the identity of the subject to the demand/request for a trial/appeal, such as merely an error in writing, the amendment shall not change the gist (\rightarrow 21-05).

(2) Amendment of purport of the demand/request and a reason thereof

A. Amendment of a registration number subject to the demand/request for a trial/appeal (\rightarrow (1)).

B. Amendment to change a subject to a patent (utility model) invalidation trial from a certain claimed invention (device) to another claimed invention (device) described in the claims.

C. In a case where a subject to a patent (utility model) invalidation trial is a certain claimed invention (device), the claimed invention has become another claimed invention (device) as a result of a trial for correction (a request for correction). In that case, an amendment subject to a claimed invention (device) after correction shall not change the gist.

D. Amendment to change a trial for invalidation of trademark registration into a trial for rescission of trademark registration shall change the gist.

E. Amendment of the attached specification, claims or drawings in a trial for correction (\rightarrow 54-05.1).

F. Amendment of the attached specification, claims or drawings in a request for correction (\rightarrow 51-14 3.).

G. In an appeal against examiner's decision to dismiss

amendment of a design or trademark application for registration, an amendment to change the date of the decision to dismiss the amendment shall change the gist (except an obvious error in writing).

4. Amendment of Reasons for Demand/Request (→1. (2)(3))

5. Change of Gist in Opposition to Registration of Trademark
(→66-03 3.)

6. Change of Gist in Opposition to Grant of Patent (→67-04
2.)

(Revised December 2023)

30-02 P U D T

Prohibition of Double Jeopardy

1. Prohibition of Double Jeopardy

When a trial decision of the trials listed below has become final and binding (→46-00), a party concerned and an intervenor may not file such a trial (hereinafter referred to as “the same trial” in this section 30-02) based on the same facts and the same evidence (Patent Act Article 167, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(1) A trial for invalidation

(2) A trial for invalidation for a registration of an extension of the term

(3) A trial for rescission of registration of trademark

The reason for providing this provision is to prevent providing two or more conflicting final and binding trial decisions based on the same facts and the same evidence, and to prevent excessive or unnecessary filing of trials for avoiding the inconvenience of repeating the same procedures for the same trial.

An effect of prohibition of double jeopardy is one of the effects of a final and binding trial decision.

However, when comparing with judicial precedents in civil litigation, it is not appropriate that the final and binding trial decision effects even on a person who is not related to the trial, and therefore the third party may demand the trial based on the same facts and the same evidence (※).

※ Regarding the fact that effects of a final and binding trial decision had extended to the third party, there was an opinion that it was unreasonable to limit the right of the third party to contest in trial. In this point, the validity of the limitation is not accepted even considering the comparison with the

case where effects of a court decision extend to the third party under the civil litigation, and thereby the third-party effect has been abolished under the partial revision of 2011 (effective on April 1, 2012) (“Act of Industrial Property Right, Clause by Clause Explanation” [the 22nd edition]).

2. Definition of the Same Trial

It should be understood that the same trial means a trial with the same purport of demand, in other words, it means the right subject to the purport of demand is the same, and a type of trial is the same.

3. Same Facts, Same Evidence

(1) Same facts

Same facts herein mean the facts alleged as reasons for invalidation or rescission are the same in a trial for invalidation or a trial for rescission ((1964 (Gyo-Ke) 161), Judgment of the Tokyo High Court, June 28, 1969, “The method for producing oxidized starch liquid for production of glucuronolactone”; (1971 (Gyo-Ke) 128), Judgment of the Tokyo High Court, Feb 28, 1979, “A device for forming seams on the edges of blank plates such as ducts”).

For example, when a final and binding trial decision is made for the reason for demand that the present device is the same as one described in the publication, if a trial is demanded under the reason that the present device would be quite easily arrived from the device described in the same publication, it is considered a demand for trial is made based on the different facts (Invalidation No. 1970-3957, “Metal woven basket edge braiding device” (Apr.2, 1975))

(2) Same evidence

Same evidence herein means evidence of identity.

There are some court precedents: when evidence itself is different but a

content of evidence is substantially same, it is interpreted that they are the same evidence (Court precedent ① shown below; (2019 (Gyo-Ke) 10077), Judgement of the IP High Court, June 11, 2020 “Wide and flat-bottomed grab bucket for dredging”; and (1919 (O) 184), Judgement of the Supreme Court, Oct 19, 1919).

Even if it is the same publication, when a cited part is different and a technical content to be proved is different, it cannot be said that they are the same evidence ((1964 (Gyo-Ke) 161), Judgment of the Tokyo High Court, June 28, 1969, “The method for producing oxidized starch liquid for production of glucuronolactone”).

Among trial decisions or judicial precedents under the Patent Act Article 167, there are some cases where the evidence submitted for the first time in the subsequent trial for invalidation is not approved as new evidence (Court Precedents ② ③ shown below).

4. Application to Co-Pending Another Trial Case

The purport of the provision of the Patent Act Article 167 provides once a trial decision to the effect that a demand for invalidation trial is to be groundless (a trial decision not to grant the demand) becomes final and binding, it is not accepted to file a new invalidation trial based on the facts and evidence same as the above invalidation trial. However, the provision of the Patent Act Article 167 does not apply to a demand for invalidation trial which has been already pending at the time when the trial decision not to grant the demand becomes final and binding (in a case where the registration of the trial decision is before April 1, 2012, at the time when a final and binding trial decision of failure of the demand is registered ((1995 (Gyo-Tsu) 105), Judgment of the Supreme Court, 1st Petty Bench Jan 27, 2000, “Lead chromate pigment and its manufacturing method”)).

5. Cases Where Final and Binding Trial Decision Is a Decision of Dismissal

The provision of the Patent Act Article 167 should be applied on the premise that a trial decision is made after the substantial examination have been carried out on invalidity of a patent and other substances of demand for a trial on the matters prescribed in the provision, considering certain facts and evidence submitted by a demandant of a trial (\rightarrow 1.). Therefore, in a case where a demand for trial is rejected (dismissed) for other reasons such as being filed by a person who is not a party concerned, there is a precedent that the provision indicated above should be interpreted as not applicable ((1930 (O) 693), Judgment of the Supreme Court, Dec 24, 1930, “Threshing tooth device”).

6. Eligibility as a Demandant and Prohibition of Double Jeopardy in That Case

There is a precedent when a trial decision to dismiss a demand for trial becomes final and binding for the reason that a demandant is not an interested person as required for eligibility as a demandant (in a case where a trial decision was registered before April 1, 2012, at the time of registration of a final and binding trial decision), it is not possible to file the same trial based on asserting the same facts and submitting the same evidence regarding the eligibility as a demandant ((1942 (O) 187), Judgment of the Supreme Court, Nov 10, 1942, “A device that makes contact between liquid and gas”).

7. Prohibition of Double Jeopardy for Hantei (Advisory Opinion)

Prohibition of double jeopardy does not apply to Hantei (advisory opinion) (\rightarrow 58-03 1.(6)).

8. Prohibition of Double Jeopardy for Opposition to Grant of Patent (Registration of Trademark)

Prohibition of double jeopardy does not apply to an opposition to grant of patent (registration of trademark).

9. Handling of an Invalidation Trial Case That Is Demanded More Than Once

In view of perspective of good faith, it is inappropriate to require a determination different from that of the previous trial decision based on almost the same reason for invalidation. Therefore, in order for a panel to avoid making a determination that is contradictory to the previous decision, the panel takes into account the result of the previous trial decision to conduct a trial the conclusion of which can be drawn by almost the same logical composition as the previous trial decision, even in a case where it cannot be said that the trial should be treated as double jeopardy (for example, there is a demand for invalidation trial with the same reasons for invalidation before the previous trial decision becomes final and binding, or there is a demand for invalidation trial with almost the same reasons for invalidation after the previous trial decision becomes final and binding). In that case, it is desirable to direct the proceedings so that it can be conducted efficiently in consideration of the burden of the parties concerned such as conducting documentary proceedings instead of oral proceedings.

As for a trial case filed before the decision of the previous trial case becomes final and binding, there is a court precedent based on the principle of good faith (2017 (Gyo-Ke) 10153, Judgment of the IP High Court, June 19, 2018, “Plated steel sheet for hot press”), which explains as follows: regarding the assertion already made by the plaintiff as a reason for invalidation in the previous trial case and dismissed in the prior trial decision and the prior litigation judgment, the effect of the Patent Act Article 167 does not reach to the invalidation trial in this case since the demand for the invalidation trial in this case was filed before the decision of the previous trial case (the previous litigation) became final and binding; however, it is unacceptable in

such a case to take advantage of this situation to make the same assertion as in the previous trial case as a reason for rescinding the trial decision in this case because it is substantially a rehash of the previous case and violates the principle of good faith in litigation.

When a reason for demand for the trial in this case changes in gist from the reason for the demand determined by the previous final and binding trial decision (→ 51-16), it does not raise a problem of good faith since it does not rehash the allegation and proof presented in the previous trial that have been made and shown thoroughly.

Court Precedents Involving the Same Facts and the Same Evidence

Content	Related Item
<p>① 2013 (Gyo-Ke) 10226, Judgment of the IP High Court, March 13, 2014, “KAMUI”</p> <p>It is reasonable to interpret that “the same facts” in the course of requesting a trial for invalidation means the allegations concerning the same grounds for invalidation and that “the same evidence” means the same evidence in substance to prove said allegations. It should be interpreted that, as far as the evidence is submitted to prove the same allegations (the same subject matters of proof), the use of different methods of proof does not necessarily provide reasons for denying the identicalness of evidence in substance. Such interpretation would be perfectly in line with the purpose of the amendment of Article 167 of the Patent Act by Act No. 63 of 2011, i.e., an amendment to abolish the third-party effect of a final and binding JPO decision and to achieve resolution of a dispute by one-time trial between the parties concerned (including interveners).</p>	3. (2)
<p>② 2005 (Gyo-Ke) 10467, Judgment of the IP High Court, April 11, 2006, “Packaging”</p> <p>In a demand for trial of the case, a plaintiff’s allegation is based on “the same facts” as the finalized previous trial decision, but it does not violate the Patent Act Article 167 only when the allegation is based on the new evidence. The new evidence herein means the evidence for proving a reason for invalidation of a defendant’s patent and for being substantially different from the evidence submitted to the previous demand for trial. . . . However, a plaintiff alleges that Exhibit A Nos. 8~10 is</p>	3. (2)

<p>submitted to indicate and prove an error in the previous trial decision but not to prove a description of the method for producing the product in the plaintiff's patent specification. . . . Originally, the evidence to prove a reason rescinding a trial decision should be submitted in the litigation where a reason for rescission against the trial decision is filed. It is considered unacceptable in view of the purport of the Patent Act Article 167, after the trial decision is final and binding, a demandant (plaintiff) of the previous demand for trial files a demand for trial for the same patent again and submits the evidence to prove a reason for rescission of the trial decision already finalized.</p>	
<p>③ 2003 (Gyo-Ke) 43, Judgment of the Tokyo High Court, March 23, 2004 “Process and device for gluing and soldering a metallic catalyst carrier”</p> <p>Considering that a demand for invalidation trial is filed based on the same evidence as the previous demand for invalidation trial, the issues at which the assertion of the trial demandant (plaintiff) was rejected in the previous invalidation trial is ‘easily arriving at Constituent C of the present invention’ in comparison with the publicly known art deriving from Exhibit A Nos. 1~3. The trial decision found the facts ‘when adhering two members together, it is commonly used not only to persons skilled in the art but also to the public that they may adhere partially on the arbitrarily shaped adhesive region if necessary.’ No error can be found in this finding. In the previous invalidation trial, it also becomes subject of the proceedings whether the invention includes the common general art which should be considered in the comparison, and then it should be found that it is examined and judged whether the invention could be easily speculated from</p>	3. (2)

<p>the publicly known art. The result of the proceedings is also determined on the ground that such common general knowledge has no evidence to be proved. Therefore, there is no error in the determination where it is not allowed to submit evidence for proving the above common general knowledge to the subsequent trial based on said same facts, and Exhibit A Nos. 5 and 6 cannot be approved as new evidence since they merely prove the above common technical knowledge.</p>	
<p>④ 2015 (Gyo-Ke) 10260, Judgment of the IP High Court, Sept. 28, 2016, “Rotary disc tumbler lock and key”</p> <p>A. The purpose of Patent Act Article 167 is considered to have the effect of prohibition of double jeopardy on the parties and intervenors in order to promote one-time dispute resolution in a trial for patent invalidation so that there will be neither the situation where multiple different determinations are made in relation to the validity of a patent right, which is an exclusive right, (Article 68 of the Patent Act) nor resurrection of a dispute.</p> <p>The parties and intervenors in the previous trial for patent invalidation made allegations and submitted evidence in relation to the existence of grounds for invalidation in the procedures of said trial and were also given an opportunity to make allegations and submit evidence in relation to the existence of grounds for rescission of the JPO decision on the previous trial for patent invalidation in legal proceedings if an action to seek rescission of said JPO decision is instituted. Therefore, it is not reasonable to understand the “same facts and evidence” in a narrow sense, from the perspective of preventing the resurrection of a dispute.</p> <p>B. In this regard, in Article 167 of the Patent Act prior to amendment by Act No. 63 of 2011, the scope to which the double</p>	<p>3. (1),(2)</p>

<p>jeopardy prohibition effect extends was provided as “anyone,” and the provisions of said Article also restricted the right to file a request for a trial of third parties who have not participated at all in the previous trial. Therefore, it can be said that regarding third parties, it was problematic to interpret the meaning of the “same facts and evidence” in an expansive manner. However, the third-party effect was abolished through the aforementioned amendment, and the scope to which the double jeopardy prohibition effect extends was limited to the parties and intervenors who have participated in the procedures of the previous trial and could do their best for allegation and proof. Therefore, it is reasonable to interpret the meaning of the “same facts and evidence” with more emphasis on the purpose, i.e., promoting one-time dispute resolution in a trial for patent invalidation, as mentioned in A. above.</p>	
<p>⑤ 2014 (Gyo-Ke) 10235, Judgment of IP High Court, Aug. 26, 2015, “Detergent composition”</p> <p>In order to allege that any person ordinarily skilled in the art could easily conceive of a patented invention based on publicly known art as of the time of the filing of the application, it is necessary to make a comparison between the patented invention and the invention (the primarily cited invention) presented in the cited document (the primarily cited document) chosen for the purpose of comparison and find the common features and differences between them, and then prove that any person ordinarily skilled in the art could easily conceive of the idea of combining the primarily cited invention and other publicly known art or well-known art and thereby combine the primarily cited invention and the structures of such publicly known art or well-</p>	<p>3. (1),(2)</p>

known art that constitute the differences. If a different invention is chosen as the primarily cited invention presented in the primarily cited document, which is chosen for the purpose of comparison with the patented invention, different common features and differences would be found between the patented invention and the newly chosen primarily cited invention. As a result, the determination as to whether any person ordinarily skilled in the art could easily conceive of the aforementioned idea would change accordingly. Therefore, if a different invention is chosen as the primarily cited invention, different grounds for invalidation would naturally be alleged.

(omission)

Furthermore, since the primarily cited document is merely required to present publicly known art as of the time of the filing of the application, it is clear that Exhibit No. 1 Document, which presents well-known art as of the time of the filing of the application in this case, could be chosen as the primarily cited document. There are no reasons to consider that Exhibit No. 1 Document cannot be chosen as the primarily cited document. Moreover, even if there is no change in the primarily cited invention, if there is any substantive change in the publicly known art or well-known art chosen for the purpose of combining it with the primarily cited invention, it would result in a change in the specific logical composition adopted to make a determination as to whether any person ordinarily skilled in the art could easily conceive of the invention. As a result, different grounds for invalidation would be alleged.

Therefore, it should be considered that different grounds for invalidation would be alleged both in the case where a different

invention is chosen as the primarily cited invention presented in the primarily cited document for the purpose of comparison with the patented invention and in the case where there is no change in the primarily cited invention but different publicly known art or well-known art is chosen for the purpose of combining it with the primarily cited invention. These two cases cannot be considered to be the cases where a trial is requested based on the “same facts and evidence” specified in Article 167 of the Patent Act.	
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(Revised March 2023)

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 than two invalidation trials are demanded for the same patent, if a request for correction is filed for each trial, a subject of the proceedings would be different respectively resulted in becoming complicated due to an earlier or later final and binding trial decision, therefore the procedures of a request for correction, etc. shall take advantage of consolidation of proceedings by standardizing the procedures.

(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 binding 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 than two invalidation trials against the same right.

It is not permitted that amendment to change the gist of reasons for filing an invalidation trial for patent, new utility model, old utility model, design and trademark, therefore, it should be determined whether the proceedings shall be consolidated in view of the prompt proceedings along 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 judges.

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 trial/appeal decision is made by 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 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 regulations 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.), the Patent Act Article 50 shall apply mutatis mutandis to the Patent Act Article 159 (2) (Notice of Reasons for Refusal), 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, and 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)).

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 cases examined under the same trial 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. Judgment of administrative judges (panel)

An authority of judgment whether to separate the proceedings has a panel, and a panel shall decide *ex officio* at their discretion.

B. Notice of separation of proceedings

A chief administrative judge notifies a party 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 a decision separately.

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

(Revised December 2023)

30-04 P U D T**Interview by a Panel (Administrative Judges)**

Refer to “Guideline for Interview (for Trials/Appeals)” (JPO website, https://www.jpo.go.jp/system/trial_appeal/mensetu_guide_sinpan.html) .

(Revised December 2023)

30-07 P U D T**Handling of a Situation Where It Is Found That a Person Undertaking Procedures Is Not Competent or Suitable for Undertaking Such Procedures**

1. When a chief administrative judge has found that a person undertaking procedures is not competent or not suitable for carrying out such procedures, the chief administrative judge may order the person to carry out the procedures through a representative (the Patent Act Article 13(1), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

2. When a chief administrative judge has found that a representative acting for a person undertaking procedures is not competent or not suitable for undertaking such procedures, the chief administrative judge may order the representative be replaced (the Patent Act Article 13(2), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

3. A chief administrative judge may order that a patent agent be a representative in the preceding paragraphs 1 and 2 (the Patent Act Article 13(3), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

4. After a chief administrative judge shall issue an order under the preceding paragraphs 1 and 2, the chief administrative judge may dismiss the procedures before the Japan Patent Office carried out by the person of the preceding

paragraph 1 or by the representative of the preceding paragraph 2 (the Patent Act Article 13(4), the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(Revised Oct 2002)