

**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 professional corporation, 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 (→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 (→(1)).

B. Amendment to change a subject to a patent (utility model) invalidation trial from a certain claimed invention ( ) 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 (→54-05.1).

F. Amendment of the attached specification, claims or drawings in a request for correction (→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 Feb 2015)

**30-02 P U D T**  
**Prohibition of Double Jeopardy**

1. Prohibition of Double Jeopardy

When the following final and conclusive trial decisions have been registered (Enforcement Regulations of the Patent Registration Order Article 37, Enforcement Regulations of the Utility Model Registration Order Article 3(3), Enforcement Regulations of the Design Registration Order Article 6(4), Enforcement Regulations of the Trademark Registration Order Article 16-2), a party concerned and an intervener may not file the such trial (hereinafter referred to as “the same trial” in this section 30-02) based on the same facts and evidence (the Patent Act Article 167, the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

- (1) A final and conclusive invalidation trial decision
- (2) A final and conclusive trial decision for invalidation of a registration of extension of duration
- (3) A final and conclusive trial decision for rescission of a registered trademark (the Trademark Act Article 56)

The reason for providing this provision is to prevent from providing two or more conflicting final and conclusive trial decisions based on the same facts and the same evidence, and at the same time to avoid excessive or unreasonable legal litigation for escaping 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 conclusive trial decision.

However, it is not appropriate that the final and conclusive trial decision is effective even on a person who is not related to the trial as a result of

comparison with judicial precedents in civil litigation, therefore, the third party may demand the trial based on the same facts and the same evidence.

The same trial may be demanded again even by the same demandant if the is not based on the same facts or evidence (Note 1).

## 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 facts alleged as reasons for invalidation or rescission are the same in a trial for invalidation or a trial for rescission (Notes 2, 3).

For example, when a final and conclusive 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 (Note 4).

### (2) Same evidence

Same evidence herein means evidence having identity.

Accordingly, when evidence itself is different but a content of evidence is substantially same, it should be considered that they are the same evidence (Notes 5, 9).

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 (Note 2).

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 (Reference 1, 2).

(Reference 1) Judgment of the IP High Court, April 11, 2006 (2005 (Gyo-Ke) 10467, Invalidation (Mukou) 2004-80180)

“In the demand for trial, a plaintiff’s assertion is based on “the same facts” as the previous and final trial decision, but it does not violate the Patent Act Article 167. This is limited to the case where his/her assertion 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 asserts that Exhibit A Nos. 8 ~10 are 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 for proving a reason rescinding a trial decision shall be submitted in the litigation where a reason for rescission against the trial decision is filed. It is understood that it is not allowed in view of the purport of the Patent Act Article 167, after the trial decision is final and conclusive, a demandant 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 finalized trial decision.”

(Reference 2) Judgment of the Tokyo High Court, April 11, 2004 (2003 (Gyo-Ke) 43, Invalidation (Mukou) 2004-80180)

“Considering that the demand for invalidation trial is filed based on the same evidence as the previous demand for invalidation trial, the issue at which the assertion of the trial demandant was dismissed in the previous invalidation trial is ‘easily arriving at Constituent C of the present invention’



in comparison with the publicly known art deriving from Evidence 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 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 judgment 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.”

#### 4. Application to Co-Pending Other Trial Case

The purport of the provision of the Patent Act Article 167 is when a trial decision to the effect that a demand for invalidation trial is considered groundless (the demand is groundless by trial decision) becomes final and conclusive and registered accordingly, it is not allowed after the registration to newly demand for an invalidation trial based on the same facts and evidence as the above invalidation trial demand. Thus, the provision of the Patent Act Article 167 shall not apply to a demand for invalidation trial which has been already pending at the time of registration of a final and conclusive decision in which the demand is groundless (in a case where the registration is after April, 1, 2012, at the time of a trial decision) (Note 6).

#### 5. Cases Where Final and Conclusive Trial Decision Is a Decision of

## Dismissal

The provision of the Patent Act Article 167 shall 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 (→1.). Therefore, in a case where a demand for trial is excluded (dismissed) for other reasons such as being filed a demand by a person who is not a party concerned, there is a court case that should be understood the provision indicated above shall not be applied (Note 7).

## 6. Eligibility of the Demandant and Prohibition of Double Jeopardy

When a registration of a final and conclusive trial decision to dismiss a demand for trial for the reason that a demandant is not an interested person as required for eligibility of the demandant, there is a court case that the same trial shall not be filed by asserting the same facts and submitting the same evidence by a person who is not eligible for a demandant regarding an interest (Note 8).

## 7. Prohibition of Double Jeopardy for Advisory Opinion

Prohibition of double jeopardy shall not apply to an advisory opinion (→ 58-03 1.(5)).

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

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

(Note)

1. Judgment of the Tokyo High Court, 1965 (Gyo-Ke) 64, July 20, 1973, Casebook for a suit rescinding a trial decision 1973, p111, Collection of civil/administrative litigation cases related to intangible property rights Vol. 5 No. 2, p233.
2. Judgment of the Tokyo High Court, 1964 (Gyo-Ke) 161, June 28, 1969, Casebook for a suit rescinding a trial decision 1969, p393.
3. Judgment of the Tokyo High Court, 1971 (Gyo-Ke) 128, Feb 28, 1979.
4. Trial Decision No. 3304, Apr 2, 1970, Collection for reference trial/court decisions Vol. 2, p281.
5. Judgment of the Supreme Court, 1919 (O) 184, Dec 24, 1920, Supreme Court Civil judgment record Vol. 26, p.1534.
6. Judgment of the Supreme Court, 1<sup>st</sup> Petty Bench, 1995 (Gyo-Tsu) 105, Jan 27, 2000.
7. Judgment of the Supreme Court, 1930 (O) 693, Dec 24, 1930, The Legal News, Vol. 3220, p9
8. Judgment of the Supreme Court, 1942 (O) 187, Nov 10, 1942, The Legal News, Vol. 3220, p9, Collection for judicial precedents of civil cases at the Supreme Court, Vol. 21, No. 19, p1025.
9. Judgment of the IP High Court, 2013 (Gyo-ke) 10226, Mar 13, 2013.

(Revised June 2019)

## **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.

(Revised June 2019)



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

Refer to “Guideline for Interview (for Trials/Appeals)”

(Revised Feb 2015)

**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)).

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