

33-00.1 P U D T

**Trial and Appeal Cases Subject to Oral Proceedings and
Timing for Selecting Those Cases**

1. Trial and Appeal Cases Subject to Oral Proceedings

Application of oral proceedings is considered particularly valid for the following types of cases.

- (i) Trial for invalidation (patent, utility model, design, trademark)
- (ii) Trial for rescission (trademark)
- (iii) Opposition to registration of trademark (trademark)
- (iv) Advisory opinion (patent, utility model, design, trademark)

Regarding a trial for invalidation, for promptly organizing issues and conducting the proceedings precisely, and for enhancing reliability between parties concerned and satisfaction, all cases except the cases below shall be conducted by oral proceedings in principle (→ 51-09 2.):

(1) when a demand for trial or procedures for a demand for trial (a written demand for trial) should be rejected;

Example: when the present demand for invalidation trial is rejected because invalidation is fixed and binding by another invalidation trial on the same patent right, etc.

(2) when it is apparent that parties concerned do not dispute;

Example: when a written reply or refutation is not submitted, claims subject to an invalidation trial are all cancelled by a request for correction, parties concerned state not to dispute, etc.

(3) when all parties concerned (and intervenors) allege documentary proceedings; and

(4) other than the above, when it is determined that there is no need to conduct oral proceedings.

2. Timing for Selection

It is preferable to select the timing for oral proceedings as below.

(1) Case of inter-partes trial

- A. At the stage of submission of a written reply from a demandee (it includes when there is no reply to the demand for a trial. When a request for correction is filed, after refutation if necessary.)
- B. At the early stage of the proceedings, such as before filing a written reply, immediately after filing a written reply (a request for correction).

It is considered for the following situations that oral proceedings focused on explanation of a party concerned are conducted at the early stage of the proceedings: when,

- (A) the technical content is complex and sophisticated so that it takes time to understand the details;
- (B) it is difficult to understand the background of the art and theory which is the premise of the statement;
- (C) a statement of parties concerned is unclear or is contradictory each other;
- (D) lots of evidence are submitted so that it takes time to organize and understand the details of the evidence; and
- (E) it is unclear a purpose of submitted evidence.

(2) Opposition to registration of trademark

- A. When starting the proceedings of the case
- B. When a written opinion is submitted from a trademark owner to a notice of reasons for refusal

(Revised Feb 2015)