

34-01.1 P U D T**Handling of Foreign Documents in Trial for Invalidation and Opposition to Grant of Patent (or, Trademark Registration)**

When foreign documents are submitted as evidence of a trial for invalidation or an opposition to grant of patent (or trademark registration) but no translation document is attached to the foreign documents, or some parts of the foreign documents cited for evidence are not translated, the situation is handled as below.

1. Trial for invalidation

An amendment is ordered due to improper descriptions of the reasons for demand (Patent Act Article 133(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Article 56, 68(4)). If there is no response to this order, the demand shall be dismissed by decision (Patent Act Article 133(3)).

Submission of an amendment or a petition related to translation may be requested by telephone, etc. to accelerate the procedures.

2. Opposition to grant of patent

An amendment is ordered due to improper descriptions of the reasons for demand (Patent Act Article 120-8(1) → Patent Act Article 133(1)). If there is no response to this order, the demand shall be dismissed by decision (Patent Act Article 120-8(1) → Patent Act Article 133(3))(→ 67-04 1.).

3. Opposition to registration of trademark

An amendment is ordered due to improper descriptions of the reasons for demand (Trademark Act Article 43-15 (1) → Patent Act Article 133(1)). If

there is no response to this order, the demand shall be dismissed by decision (Trademark Act Article 43-15 (1) → Patent Act Article 133(3)).

The reasons are shown below.

When evidence is foreign documents, a translation of the documents shall be attached (Enforcement Regulations of the Patent Act Article 61(1), Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(5)(6), Rules of Civil Procedure Article 138(1)).

Translation documents shall be required to be submitted as official documents to ensure fairness and to send the documents to the right holder of patent (utility model, design, trademark). It is not appropriate in view of the fairness to overlook the submission of translation even if the right holder is competent in foreign languages and there is no difficulty for the proceedings without translation documents.

A panel requests a petitioner, a demandant, or an agent to submit translation documents by facsimile or e-mail before submission of formal documents. Based on the submission of translation documents by facsimile or e-mail, or regardless of whether there are translation documents, the proceedings may be developed. However, if formal documents are not filed afterwards, a petition or a written demand shall be dismissed

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