

36-01 P U D T

Ex Officio Principle and Examples of Ex Officio Examination

1. Ex Officio Principle

Ex officio provisions can be seen not a few even in Code of Civil Procedure, including a case that a court proceeds the litigation ex officio. Civil litigation has originally a purpose of settlement of disputes regarding the personal interests which can be disposed at his/her discretion. Therefore, including the provision that a court may not decide on matters the parties have not alleged (Code of Civil Procedure Article 246), it can be said that more weight is placed on a so-called adversary system than an inquisitorial system in the main articles (for example, Code of Civil Procedure Articles 179, 267, 296(1), 320, 348(1)).

On the contrary, because an invalidation trial decision has a large impact on the binding legal effectiveness as to third parties, the provisions of the adversary system in the above do not apply to a trial system: the Patent Act has many articles provided that the administrative judges should positively intervene ex officio in a case and lead the proceedings somewhat irrelevant to the intension of the parties, after a trial is demanded and unless it is withdrawn. Therefore, the ex officio principle is used largely (for a retrial, Patent Act Article 174(5) (Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61) applies mutatis mutandis to Code of Civil Procedure Article 348(1), and thus, a retrial case is somewhat different from a trial case).

From the above, it can be said that one of the specific features of trial proceedings is to widely adopt, based on the ex officio principle, an ex officio investigation principle which is to be mentioned later. The ex officio principle in trial proceedings can be considered two types: a principle of ex

officio proceedings and a principle of ex officio investigation.

(1) Principle of ex officio proceedings

In a policy of this principle, an administrative judge acts to proceed with the trial procedures by his/her own authority where a petition of a party is not necessary or not allowed.

The principle of ex officio proceedings is adopted for the following cases: ex officio extension of the statutory or specific period of time (Patent Act Articles 4, 5, Utility Model Act Article 2-5(1), Design Act Article 68(1), Trademark Act Article 77(1) → 25-04), selection of a proceeding method (Patent Act Article 145, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), proceedings of trial procedures (Patent Act Article 152, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), order of succession of procedures suspended or terminated (Patent Act Article 23, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)), etc.

(2) Principle of ex officio investigation

In a policy of this principle, an administrative judge positively collects materials which can be a basis of a trial decision by his/her own authority without any binding of a petition of a party.

The principle of ex officio investigation is adopted for the following cases: examination of evidence ex officio (Patent Act Articles 150(1), 151 the latter part, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), preservation of evidence ex officio (Patent Act Articles 150(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4), Code of Civil Procedure Article 237), proceedings of the grounds not pleaded by a party or intervenor (Patent Act Articles 153(1)(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), finding out reasons for refusal different from reasons for examiner's decision for refusal (Patent Act

Articles 159(2), Design Act Article 50(3), Trademark Act Articles 55-2(1), 68(4)), etc.

(3) Ex officio examination

An examination upon court's own authority is launched and conducted by a court without any opposition or petition by parties in a civil litigation, etc. Matters to be examined upon court's own authority are those subject to examination upon court's own authority (matters which hardly control of parties due to judicial administration such as jurisdiction, requirements for litigation including eligibility for being a party, capacity to sue or be sued, whether authority of representation exists). On the contrary, matters for defense are those to be covered after a petition of the parties is filed (litigation requirements for interests of the parties such as arbitration agreement, an existence of covenant not to sue, etc.).

In a trial, the principle of ex officio investigation is much widely used, therefore, an ex officio examination is used not only limited to the above, but also includes all general examinations ex officio and actions of investigation under the principle of ex officio investigation (for example, an examination of evidence ex officio).

However, a purport of demand for a trial may not be examined unless a demandant is alleged (Patent Act Article 153(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), and here are the limits of an ex officio examination.

(4) Limitation of the principle of ex officio investigation

When reasons which are not alleged by parties or intervenors are examined, the results of examination shall be notified to the parties or intervenors to give an opportunity to state opinions (Patent Act Article 153(2), Patent Act Article 150(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). A notice of reasons for refusal shall be issued to give an opportunity of submitting a written opinion for an appeal

against examiner's decision of refusal, a trial for correction and a request for correction (Patent Act Article 159(2), Design Act Article 50(3), Trademark Act Articles 55-2(1), 68(4), Patent Act Articles 165, 134-2(5)).

Various conditions, such as an impact on the public interest, prompt proceedings, a possibility of discovering the truth shall be considered in deciding how much effort shall be made for ex officio investigation.

2. Examples of Ex Officio Examination for Formal Matters

(1) Formality of a written demand/request for trial/appeal (Patent Act Article 133, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

A. Examination of errors in identification of rights, etc. (→ 21-05)

B. Examination of appropriateness of filing date of a request for an appeal against examiner's decision of refusal, or an appeal against examiner's decision to dismiss amendment for a design application/a trademark registration application.

When it is suspected that a request is not made in the statutory period, a proof of delivery of a certified copy of decision of refusal or decision to dismiss amendment is requested to a postal office (→ 45-20).

This proof is not issued after one year has been passed, thus it is necessary to examine immediately after receiving a written request for appeal.

(2) Examination of a successor of proceedings for a suspended trial or retrial.

A request for issuance of copy of a family register to a mayor of municipality (→ 26-04 1.(1))

(3) Examination of registry

Examination of the registry in collation or examination of registration matters.

(4) Examination whether a demandant of an invalidation trial is eligible for being a party (→ 31-01 3.)

It is said that the eligibility may be determined based on the materials submitted by a party, such as a written demand for trial, unless the other party disputes this point (an example of an ex officio examination independent from the principle of ex officio investigation).

3. Examples of Ex Officio Examination for Substantive Matters

(1) Examination of an existence of an appropriate reason for refusal when the original decision of reasons for refusal is inappropriate.

(2) When reasons for refusal for the original decision are not sufficient

A. Examination of an existence of conventional means or well-known facts when conventional means or well-known facts not exemplified in the original decision become an issue of dispute of the appeal and the example is deemed necessary.

B. Examination of a date of domestic distribution of a cited publication in the original decision when the date has become an issue of dispute for the appeal

(A) Request for issuance of a certification to a library or a public office where said publication is hold

(B) Ex officio examination of evidence

For example, an ex officio examination of witness when a date of receiving a publication cited in an original decision has become an issue of dispute

C. Examination when lack of evidence admitted in an original decision has become an issue of dispute and is supplemented by ex officio examination

For example, when an original decision has been maintained by conducting an examination of evidence submitted by an information statement

(3) Proceedings for reasons not pleaded by parties or intervenors (Patent Act Article 153, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

4. Procedures and Costs for Ex Officio Examination of Evidence

Preparation Procedures → 35-01 3. (2)

Expenditure → 35-01 5.

When an ex officio examination of evidence or an ex officio preservation of evidence is conducted for inter partes cases, although the cost shall be paid by the party who has finally lost the case, one party to be favored by an examination of evidence shall be ordered to pay in advance tentatively. However, there is a possibility a party does not follow the order of payment and the JPO does not charge the cost late, and ex parte cases (including an opposition to grant of patent, an opposition to registration of trademark) sometimes require an ex officio examination of evidence in case of 3. (2) B (B), necessary expenses have been entered into the JPO's budget.

5. Types of Ex Officio Examination of Evidence

(1) Ex officio examination of evidence under Patent Act Article 150(1) (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

A chief administrative judge shall give parties an opportunity to state an opinion by specifying the reasonable period of time when conducting an examination of evidence by his/her authority.

A notice of ex officio examination of evidence is issued when the results of examination would not be new reasons for invalidation or rescission but will affect the conclusion of a trial decision.

When the results of examination become new reasons for invalidation or rescission, another notice of reasons for invalidation or rescission will be issued.

(Court precedent)

“According to the whole purport of the argument, a panel conducts an examination of evidence by its authority on Publication 1 to 14 in the trial

proceedings of the case, however, it is recognized that a chief administrative judge does not notify the plaintiff of the results of examination and does not give an opportunity to state an opinion.

The trial decision found the publicity and other facts of the mark comprising of characters “POLO” or “Polo” and “by RALPH LAUREN”, and a “figure of a polo player riding a horse”, or the combination thereof, and used for cloths, etc. designed by 【E】 (hereinafter collectively referred to as “Ralph Lauren mark”) . Based on this finding, the conclusion is led that the present trademark application falls under Trademark Act Article 4(1)(xv), which is apparent from the reasons for the trial decision (the trial decision does not take any notice of Trademark Law Article 4 (1)(x) the requirement of which is publicity of the cited trademark. See (xv) in parentheses of the Trademark Act Article 4(1)).

Then, it should be said that there is a defect in the procedures of the present trial, and in general the defect should have affected the conclusion of the trial decision which is a result of the trial.” ((2000 (Gyo-ke) 6) Judgment of the Tokyo High Court, Feb. 15, 2001)

(2) Commissioned ex officio examination of evidence under Patent Act Article 150(6) (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

(3) Ex officio examination of evidence under Code of Civil Procedure Article 184 (Examination of evidence in foreign countries), Article 185 (Examination of evidence out of court, Examination of evidence by a commissioned judge), and Article 186 (Commissioning of examinations) as applied mutatis mutandis pursuant to Patent Act first sentence of Article 151 (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(4) Ex officio examination of evidence on facts confessed by a party which is exempted from applying Code of Civil Procedure Article 179 under Patent Act Article 151 second sentence of Article 151 (Utility Model Act Article 41,

Design Act Article 52, Trademark Act Articles 56(1), 68(4))

In a civil suit, facts admitted by a party do not require to be proven and become a basis of a court decision, whereas in a trial, although a party admitted facts, it is required more reliable evidence to establish conviction sufficient for reasonable determination of administrative judges, and facts on which there is no dispute between the parties also require confirmation based on other concrete facts, except obvious facts recognized by the JPO.

As such, in a trial, it is required evidence of facts for establishing sufficient conviction of administrative judges and the examination therefor in consideration of binding legal effectiveness of patent rights as to third parties.

6. Types of Ex Officio Preservation of Evidence

(1) Ex officio preservation of evidence under Patent Act Article 150(2) (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

(2) Ex officio preservation of evidence as commissioned under Patent Act Article 150(6) (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

(Note) Ex officio principle in a trial for invalidation (→ 51-18)

(Note) Ex officio principle in an opposition to grant of patent (→ 67-05, → 67-05.4,)

(Note) Ex officio principle in an opposition to registration of trademark (→ 66-04)

(Revised Oct. 2015)