

37-00 P U D T
Order, Inquiry, Notice, etc.

Among trial/appeal procedures under the name of a chief administrative judge to parties and people concerned of the case, the procedures other than a trial/appeal decision and a decision provided by law, include an order and an inquiry to direct parties to respond, and a notice only to notify something, according to a purpose of each procedure. When a written document is issued for these procedures, each procedure is handled as below.

1. Order, Inquiry

A purpose of order or inquiry is that a chief administrative judge or a panel asks parties, etc. for performing the specific procedures, replying, or submitting a sample or an experimental result, etc.

For order or inquiry (→ 37-02), in relation to ask parties, etc. for a response, it is necessary to specify the time period, and to state an appropriate indication to identify the content of order, etc. in the document to distinguish from a subsequent notification, and not merely indicate as “Notice”.

For example, “Inquiry” is indicated on a document when asking for explanation for unclear points in the present application. A written document to be submitted responding to the inquiry shall be indicated as a written reply, etc.

[Example]

Order of amendment, Inquiry

Order of advance payment

Order of submitting a sample or a written experimental result

2. Notice

A purpose of notice is that a chief administrative judge or a panel merely informs parties, etc. of generation of pendency of a trial and its content, development of trial procedures and its content, matters to be determined or an opinion of a chief administrative judge or a panel, or inform parties, etc. of an opportunity to state their opinion.

When a notice is a merely information purpose, it is just sent and does not ask for a response such as an opinion of parties, etc., whereas when a notice is sent to give an opportunity to state an opinion of parties, etc., it asks for a response passively like “if you have an opinion on this issue” by specifying a period for response.

[Example]

Notice of demand for a trial for invalidaiton

Notice of documentary proceedings

Notice of date of oral proceedings, examination of evidence

Notice of consolidated proceedings

Notice of reasons for refusal

Notices related to ex parte appeals (such as a notice where retroactive effects from the filing date are not accepted for a divisional or converted application)

Notice of ex officio examination of evidence

Notice of results of preservation of evidence

Notice of delivery of duplicate

Notice of succession

Notice of continuation of procedures

Notice of termination of proceedings

Notice of resumption of proceedings

Notice of additional period to term for an action

(Note) Excluding the following action from this section(37-00): an action

of issuance of a written document to a person other than parties under the name of a chief administrative judge (for example, an order of summons of witness, a commission of examination of evidence, an inquiry for on-site inspection, etc.) (→ 35-01, 35-03, 35-06).

(Revised Feb. 2015)

37-02 P U D T**Inquiry****1. Inquiry**

A chief administrative judge may inquire parties and intervenors orally or in writing regardless of a type of trial/appeal (an appeal against an examiner's decision of refusal, a trial for invalidation, etc.) and a method of proceedings (documentary or oral proceedings) (Patent Act Article 134(4), Utility Model Act Article 39(4), Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(1) In formality examination for a written demand/request, an inquiry may be conducted for confirmation of an intention of procedures of a party (→ 21-02).

(2) An inquiry may be filed when it is necessary to clarify a statement of parties, etc., for example, when there is a doubt whether an amendment or correction is legal, when it clarifies a ground for statement, when it is confirmed a technical common knowledge/a well-known art.

(3) In an appeal against an examiner's decision of refusal for patent, when an amendment is filed with a request for appeal, reconsideration by an examiner before appeal (Patent Act Article 162) is to be examined, a report of results of examination (Patent Act Article 164(3)) including legality of the amendment, patentability of the invention, etc. except when a patent is granted. When it is found necessary for a panel to request a view of an appellant based on the report, an inquiry may be conducted using the report.

2. Format of Inquiry

When an inquiry is conducted in writing, a written inquiry (Form 1) under the name of a chief administrative judge is used.

An inquiry may be conducted for “matters related to a trial/appeal”, therefore, an inquiry may be conducted orally or in writing on a date other than the oral proceeding date in a case by oral proceedings.

A TV conference system (→ 35-01 10.), a facsimile or an electric mail may be used for inquiry. In that case, an interview record or a response record is prepared.

Regarding oral proceedings, Enforcement Regulations of the Patent Act Article 52-2(1) provides that a chief administrative judge may question to a party or an intervenor or encourages a party or an intervenor to prove facts and legal matters for clarifying the case, and Enforcement Regulations of the Patent Act Article 52-2(1) provides that associate judges may take measures prescribed in the preceding paragraph with notification to a chief administrative judge.

3. Handling a Case Where a Party Does Not Respond to Inquiry

When a party, etc. does not respond to an inquiry, the proceedings of a trial/appeal shall be continued. A trial decision to dismiss or a decision to dismiss shall not be rendered, or an unfavorable conclusion against a party, etc. shall not be drawn, on the ground that a party, etc. does not give a response to an inquiry.

4. Inquiry on Refusal to Testify

Code of Civil Procedure Article 199(1) provides “Except in the case as referred to in Article 197, paragraph (1), item (i), the court in charge of the case hears the parties and reaches a judicial decision, in the form of a ruling, on the propriety of the refusal to testify” and this article shall apply mutatis mutandis to Patent Act Article 151 (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). Therefore, refusal to testify may be inquired in an examination of witness of a trial/appeal.

(Reference)

Inquiry of opposition to grant of patent (→67-05 5.(2))

Inquiry of opposition to registration of trademark (→66-04 4.(3))

(Revised Dec. 2020)

Form 1

Inquiry

Request for appeal	Appeal 20xx-123456
(Patent Application No.)	(Patent Application No. 20xx-123456)
Draft date	M/D/Y
Chief Administrative Judge, JPO	
Appellant	
Agent	

Regarding this appeal case, a written reply to the following point (a petition in line with the following purpose) is submitted within xx days from the date on which this inquiry was dispatched.

Note

(Remarks)

If you do not intend to continue an appeal, withdraw a request for appeal without delay.

In a case of withdrawal of the request for appeal, please notify a chief administrative judge or administrative judge listed at the end of the inquiry to that effect as far in advance as possible.

If you have any question, please contact us at the following:

The XXth Board, Trial and Appeal Department, Administrative Judge XXX
Tel:03(3581)1101 Extension xxxx Facsimile 03(xxxx)xxxx