

42-00 P U D T**Conclusion and Resumption of the Proceedings**

1. Conclusion of Proceedings (Conclusion of Trial/Appeal)

(1) When a case reaches the point at which a decision on a trial can be rendered of the case, a chief administrative judge shall notify parties and intervenors (hereinafter referred to as “parties” in this chapter 42) of conclusion of the proceedings for the trial other than an invalidation trial for patent (Patent Act Article 156(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). For a trial for invalidation of patent, when a case reaches the point at which a decision on the trial can be rendered of the case and there is no advance notice of trial decision (→ 51-17), or when there is an advance notice of trial decision and a demandee files neither a request for correction nor a written amendment within the designated period, a conclusion of the proceedings shall be notified to parties (Patent Act Article 156(2)). For inter partes trials, a conclusion of the proceedings shall be notified to both parties even when a dismissal by trial decision is rendered (including a case where a duplicate of the written demand has not been served to a demandee).

(2) A notice of conclusion of the proceedings shall be served to parties notifying that a trial decision shall be soon rendered. Even if a party files allegation and evidence after issuance of this notice, they are not subject to examination (refer to (1964(Gyo-ke)17) Judgment of the Tokyo High Court, July 29, 1965). If further proceedings are needed after issuance of a notice of conclusion of the proceedings, the proceedings are re-opened after resumption of the proceedings (→ 2.) shall be notified to parties. After the proceedings comes to the conclusion, no one may intervene to the trial (→ 57-01) (Patent Act Article 148(1)(3), Utility Model Act Article 41, Design

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

(3) Even after a notice of conclusion of the proceedings is issued, a demand for trial may be withdrawn until a trial decision becomes final and binding (→ 43-02).

(4) “When a case reaches the point at which a decision on the trial/appeal can be rendered of the case” refers to a situation of reaching a conclusion after consideration of all facts necessary for the proceedings and examination of all evidence to be examined.

Therefore, the further proceedings are basically not conducted after issuance of a notice of conclusion of the proceedings.

(5) It is understood that an effect of a notice of conclusion of the proceedings is generated from when it is notified to a party. In the case of written notice, an effect of a notice of conclusion of the proceedings is generated when it is reached to a party. Therefore, when a party submits a written document before a notice of conclusion of proceedings arrives to the party, it is necessary to render a trial/appeal decision upon examination of the submitted written document (See (1961(Gyo-na) 88) Judgement of the Tokyo High Court, May 23, 1963, (1966 (Gyo-ke) 184 Judgement of the Tokyo High Court, March 23, 1971).

(6) There is a provision that a trial/appeal decision shall be rendered within 20 days on which a notice of conclusion of the proceedings is issued (Patent Act Article 156(4), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), but it is an advisory provision and there is no procedural issues even if a trial/appeal decision is not rendered within the period (See (1925 (O) 165) Judgement of the Supreme Court, April 17, 1925).

2. Resumption of Proceedings

(1) A chief administrative judge may resume the proceedings by request of a

party or ex officio, when necessary, even after a notice of conclusion of the proceedings is issued (Patent Act Article 156(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

Resumption of the proceedings aims for perfection of the proceedings, and conducts when a chief administrative judge finds it necessary in cases where an examination of significant evidence has not been completed, a supplementary reason for a trial or an amendment for a specification is filed just after a notice of conclusion of the proceedings was issued, etc.

(2) Resumption of the proceedings is notified to parties when the proceedings are re-opened.

(3) After a notice of conclusion of the proceedings is issued, when a written document is submitted with a petition for resumption of the proceedings, a chief administrative judge carefully considers whether to accept the resumption upon consulting with other administrative judges of the panel. As a result of the consideration, when the resumption of the proceedings is not accepted, a petitioner is notified to that effect in accordance with the content and importance of the submitted document, and a response record is prepared.

If the content of the written document does not seem to affect the proceedings such as a request for an opportunity of amendment, it is sufficient to add to a trial decision to the effect that the need for resumption is not found without contacting with the petitioner.

(4) When only a petition for resumption of the proceedings is filed, it is similar to (3).

(Court precedent)

[Petition for resumption of the proceedings for accepting an amendment after expiration of the period of amendment]

According to history, a plaintiff states that it is a breach of procedure of the JPO who did not resume the proceedings in response to the petition. However, the statement of the plaintiff comes to the proceedings that have

been concluded after a statutory period of amendment should resume to accept the amendment of which a period was expired. Such the statement is against a system of amendment under Patent Act in which an amendment accepts only during a period of amendment.

It is reasonable to understand that a system of resumption of the proceedings under Patent Act applies only when a chief administrative judge finds it necessary for taking all possible measures to ensure the proceedings. Therefore, resumption of the proceedings for accepting an amendment is not planned by the system (1992 (Gyo-ke) 239 Judgment of the Tokyo High Court, Jan 25, 1995).

(Revised Oct. 2015)

42-04 T**Resumption of the Proceedings in Appeal Against an Examiner's
Decision of Refusal of Trademarks**

In an appeal of trademark, since the designated goods, etc. may be amended during the pendency of the appeal proceedings (Trademark Act Articles 68-28(1), 68-40(1)), a case resumes the proceedings when an amendment of the designated goods, etc. is filed to dissolve the reasons for refusal after a notice of conclusion of the proceedings is issued.

However, the following cases made after issuance of a notice of conclusion of the proceedings, do not resume the proceedings because there are no rational reasons for the resumption, and it is outside of the appropriate time.

- (1) Not conducting concrete amendment procedures, but just stating an amendment of the designated goods
- (2) Requesting for deferral of appeal decision to supplement reasons for a request for an appeal or evidence
- (3) Requesting for deferral of appeal decision to negotiate a transfer with a trademark owner of the cited trademark
- (4) Claiming to have filed a trial for cancellation of registered trademark not in use, etc. against a cited trademark, except a case having a rational reason to file said request after a notice of conclusion of the proceedings is issued.

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