

43-02 P U D T**Withdrawal Procedures Related to Demand/Request
for Trial/Appeal (Opposition to Grant of Patent
(Registration of Trademark))**

Withdrawal of demand/request for trial/appeal (opposition to grant of patent (registration of trademark)) is an act of withdrawal of a one-sided request (petition) conducted by a demandant/appellant(petitioner).

If a demand/request for appeal/trial is withdrawn, a situation is returned to the same situation as if there is no request from the beginning. Therefore, the same trial/appeal may demand/request with the same purport of the demand/request against the same demandee/appellee.

1. Process of Written Withdrawal

When a written withdrawal is received, it is processed under the following procedures. An authority of acceptance or rejection of a written withdrawal is referred to 43-01.

(1) Formality examination of a written withdrawal

A content of a written withdrawal is examined as follows.

A. Examine an identification of a case, an address and name of parties, etc. and ensure that the content of the text is the purport of withdrawal.

B. A demand/request for trial/appeal may be withdrawn until a trial/appeal decision becomes final and binding (Patent Act Article 155(1), Utility Model Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

Regarding a trial for invalidation or a trial for rescission of trademark, a demand may not be withdrawn without a consent of the other parties after a written reply is filed (Patent Act Article 155(2), Utility Model Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), thus ensure that a day of submitting a written withdrawal in connection with the above.

Regarding an opposition of trial, an opposition may not be withdrawn after reasons for rejection is notified (Patent Act Article 120-4(1), Trademark Act Articles 43-11(1)), thus ensure that a written withdrawal is submitted within the period of withdrawal.

C. Attached documents are examined as follows.

(A) When a written withdrawal is submitted by an agent or an authorized agent, ensure that entrusted items specialized for withdrawal are stated in a power of attorney or a written designation (Patent Act Article 9, Utility Model Article 55(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(B) When a party resides outside Japan and a person who is appointed under Patent Act Article 8 (a patent administrator) submits a written withdrawal, if any special entrusted items are not stated but general entrusted items stated in the withdrawal such as "... about any procedures", withdrawal is accepted (Patent Act Article 8(2), Utility Model Article 55(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(C) When a written withdrawal is submitted after a written reply is filed for a trial for invalidation or a trial for

rescission of trademark, a consent of the other party is required (Patent Act Article 155(2), Utility Model Article 41, Design Act Article 52, Trademark Act Article 56(1), 68(4)), and thus it is necessary to examine this written consent (See an attached sheet for an example of a written consent).

The other party in this case does not include an intervenor of a demandee under the examination practice.

(D) When a demandant/appellant submits a written withdrawal, if he/she delegates the procedures to an agent of a demandee/appellee and the agent prepares and submits a written withdrawal and a written consent, it seems to fall under Civil Code Article 108 in which an agent working for both parties is not permitted. However, by analogy with the purport of a proviso of Article 108 of the Civil Code, the written withdrawal may be accepted by deciding that there is no problem.

Examples of accepting a written withdrawal:

Trial of 644, 1956

Trial of 373, 1957

(Reference) Civil Code Article 108 “A person may not perform as an agent of the counterparty or as agent of both parties for the same juridical act. However, this does not apply to the performance of an obligation or to an act authorized by the principal in advance.”

(2) Handling of an improper description in a written withdrawal

As a result of the formality examination according to (1), when an improper description is found in a written withdrawal, an amendment is ordered.

Typical reasons for an improper description of formality are below:

- A. a subject for withdrawal is unclear,
- B. omissions or discrepancies of an address and a name, etc. of a demandant (a petitioner),
- C. improper description of a power of attorney,
- D. improper description of a consent.

2. Notice of Withdrawal of Demand for Inter Partes Trial or Trial for Opposition (Enforcement Regulations of the Patent Act Article 50-5, Enforcement Regulations of the Patent Act Article 45-6 → Article 50-5, Enforcement Regulations of Utility Model Act Article 23(10), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6))

(1) When withdrawal is accepted as below, a notice of withdrawal is sent to the other party:

A. when withdrawal is accepted without a consent of the other party,

B. when a written withdrawal is submitted with a consent of the other party, and it is accepted.

(2) When there are intervenors, a notice is also sent to each intervenor. In case of intervention under Patent Act Article 148(1), an original party (a party on the side of which an intervenor is participating) withdraws a trial, the trial does not end (Patent Act Article 148(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56, 68).

3. Partial Withdrawal of Joint Demandants/Appellants (Co-

Petitioners)

(1) When a joint owner of the patent right or a right to be patented demands/requests a trial/appeal related to jointly owned patent right or right to be patented, all joint owners shall demand/request jointly (Patent Act Article 132(3), Design Act Article 52, Trademark Act Articles 56(1), 68(4)). Because of that, one of the members of joint demandants/appellants of a trial for correction and an appeal against an examiner's decision of refusal may not opt out of that demand/request (withdrawal of the demand/request).

(2) For a demand/request for trial/appeal except a trial for correction and an appeal against an examiner's decision of refusal, and a trial for opposition, when one of the members of joint demandants/appellants (petitioners) opts out of the demand/request (petition), a written withdrawal shall be submitted.

For a trial for invalidation and a trial for rescission of trademark registration, a part of the joint demandants submits a written withdrawal after a written reply was submitted, a consent of the other party (not another joint demandant, but a demandee) is required.

(Revised December 2020)

Example of Consent

<p>Consent</p> <p>Date:</p>
<p>Demandant</p> <p>Address:</p> <p>Name:</p> <p>Trial Case No.: *Invalidation No. 20XX-XXXXXX</p> <p>Regarding the above trial case (*against Patent No XXXXXXXX), a demandee consents to demandant's withdrawal of the demand for trial.</p> <p style="text-align: center;">Demandee</p> <p style="text-align: center;">Address:</p> <p style="text-align: center;">Name:</p> <p style="text-align: center;">Agent of Demandee</p> <p style="text-align: center;">Address:</p> <p style="text-align: center;">Name (Patent Attorney):</p>

*“Rescission 20XX-30XXXX”, “(against Trademark Registration No. XXXXXXXX)”

※ Please note an authority of representation (an affair entrusted specially on withdrawal)

(Revised December 2020)