

43-01 P U D T**Authority of Acceptance or Rejection of Written Withdrawal**

When a written withdrawal is submitted, an authority of acceptance or rejection lies with administrative judges of a panel.

After being appointed, a panel should make efforts in the proceedings to the end of the case. Therefore, when a written withdrawal which is a basis of determination whether to discontinue or continue the proceedings of the case is submitted, a panel determines acceptance or rejection of the written withdrawal.

(Court precedent)

“It is apparent from the record that an appellant alleges in the original appeal procedures: although an appellee has withdrawn the demand for invalidation trial of the case at first instance, it is illegal that a trial decision on validity of the registration is made by the first instance. Whether or not the demand has been withdrawn should be willing to investigate by the original trial even without claiming of the parties. Since the parties claim this matter, it is needless to say that this point should be found at first” ((1947 (O) 11) Judgment of the Tokyo High Court, May 28, 1948).

(Revised Feb. 2015)

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If a demand/request for appeal/trial is withdrawn, a situation is returned to the same situation as if there is no request from the beginning.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B. A demand/request for trial/appeal may be withdrawn until a trial/appeal decision becomes final and binding (Patent Act Article 155(1), Utility Model Article 41, Design Act Article 52, Trademark Act Articles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)

43-03 P U D T**Waiver of Demand/Request for Trial/Appeal****1. Waiver of Demand/Request for Trial/Appeal**

A trial/appeal system does not have any provision on waiver of a demand/request as specified in Code of Civil Procedure Article 266. A trial/appeal adopts an ex officio principle; therefore, free disposition of a party is not allowed, and waiver does not end a trial/appeal.

A written waiver (abandonment) of a demand/request for a trial/appeal is considered a mere petition and handled as below according to the content of the description.

(1) A demandant (an appellant) found that a proof and allegation of well-known facts by testimony of witness are based on misunderstanding and decided to waive the demand (request). It is admitted that the demandant has no intention of carrying out further examination of witness, and the trial is concluded without an order of advance payment.

(2) When well-known facts are proved by publications, and when a written waiver is filed after an examination of witness on well-known facts is completed, the case is examined based on evidence regardless of a written waiver.

(3) A written waiver is understood as the meaning of withdrawal, and if there is an intension to withdraw, encourage to take a normal procedure of withdrawal. As a result, a written withdrawal is filed with a written consent of the other party, and then a trial (an appeal) is ended.

2. Waiver of a Right of Demand/Appeal for Trial/Appeal

When a written waiver of a right of demand/appeal for trial/appeal, the document shall be handled as a mere petition. Handling of the document is

similar to 1.

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43-05 P U D T**Partial Withdrawal of Demand/Request for Trial/Appeal
(Opposition to Grant of Patent (Registration of Trademark))**

1. A partial withdrawal of demand/request for trial/appeal is to withdraw a part of subject of a trial/appeal (opposition) based on a free will of a demandant (petitioner). For example, an invalidation trial (opposition) is demanded (alleged) for two inventions A and B of a patent right, then, a part of the inventions, either A or B, is withdrawn of the demand (petition).

2. Possibility of Partial Withdrawal of Demand/Request for Trial/Appeal (Opposition)

(1) A demand for a patent (utility model registration) invalidation trial including two or more claims covered in the patent (utility model registration) may be withdrawn for each claim (Patent Act Article 155(3), Utility Model Act Article 41).

For a patent application filed before December 31, 1987, a patent invalidation trial including two or more inventions covered in the patent may be withdrawn for each invention.

(2) A demand for an invalidation trial for design registration may not be withdrawn partially.

(3) An invalidation trial under Trademark Act Article 46(1) may be withdrawn for each designated good or service under Patent Act Article 155(3) applied *mutatis mutandis* to Trademark Act Article 56(2).

(4) A trial for rescission provided under Trademark Act Articles 50(1), 51(1), 52-2(1), 53(1) and 53-2 respectively may not be withdrawn partially since there is no application of the provision under Patent Act Article 155(3).

(5) An opposition to grant of patent for two or more claims covered in the patent may be withdrawn for each claim (Patent Act Article 120-4 → Patent Act Article 155(3))(→67-03).

(6) Regarding an opposition to registration of trademark for two or more designated goods or services may be withdrawn for each designated good or service (Trademark Act Article 43-11(2) → Patent Act Article 155(3)).

(7) For an appeal against an examiner's decision of refusal (Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Article 44(1)), an appeal against an examiner's decision to dismiss amendment (Design Act Article 47(1), Trademark Act Article 45(1)), a trial for correction (Patent Act Article 126(1)), a demand/request for trial/appeal may not be partially withdrawn since there is no provision for partial withdrawal. However, when a trial for correction is demanded for two or more corrections, an amendment of partial deletion is sometimes accepted (→54-05.1 2.(3)).

(8) When a trial for correction is demanded for each claim (or a group of claims) covered by a patent having two or more claims, the trial correction may not be withdrawn for each claim (or a group of claims) (Patent Act Article 155(4)).

3. Notes for Partial Withdrawal of Demand/Appeal for Trial/Appeal

Requirements for withdrawal and procedures of a trial clerk and administrative judges are the same as 43-01 and 43-02. In the case of a partial withdrawal, reasons and evidence for the partial withdrawal fall under "reasons not pleaded by a party or an intervenor" under Patent Act Article 153(1).

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