

**45-01 P U D T****Procedures for Rendering Trial and Appeal Decision**

1. A trial/appeal decision is generally rendered within 20 days from the date on which a notice of conclusion of the proceedings was issued (Patent Act Article 156(1)(4), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) other than a termination of a trial/appeal by a decision of dismissal (→ 44-01 2.(5)), a withdrawal of demand/request for trial/appeal (→ 43-01,02), or an abandonment, withdrawal or change of application (→ 61-05 9.), and a trial/appeal case is terminated.

2. A trial/appeal decision includes a dismissal by decision due to an unlawful demand/request for trial/appeal (Patent Act Article 135, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), and a trial/appeal decision after the proceedings of the case (Patent Act Article 156(1)(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

3. Matters to Be Stated in a Trial/Appeal Decision (Patent Act Article 157(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)) (→ 45-03)

**4. Consolidation of Trial/Appeal Decisions**

(1) When both parties or one of the parties are identical in two or more trial/appeal cases, these proceedings may be consolidated or the proceedings consolidated may be separately conducted (Patent Act Article 154(1)(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). Therefore, it is possible that a trial/appeal decision of the

consolidated proceedings is rendered by one written trial/appeal decision.

(2) Items to be included for a consolidated trial/appeal decision (→45-03 2.)

5. When a trial/appeal decision is rendered, a certified copy of the decision is served to a party, an intervenor, and a person whose application for intervention was rejected (Patent Act Article 157(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

6. Request for Providing Information Stated in Document to Be Submitted by Electromagnetic Means

When a party or intervenor has an electromagnetic record (a record prepared by an electronic method, a magnetic method, and other methods not recognizable by perception of others, and provided for information processing by computer) that records the information in a submitted document or a document to be submitted, an administrative judge may ask the party or intervenor for providing the information that records in said electromagnetic record by the electromagnetic method when an administrative judge deems it necessary for preparing a trial/appeal decision and other cases (Enforcement Regulations of the Patent Act Article 50-11, Enforcement Regulations of Utility Model Act Article 23(12)→Enforcement Regulations of the Patent Act Article 50-11, Enforcement Regulations of the Design Act Article 19(8)→Enforcement Regulations of the Patent Act Article 50-11, Enforcement Regulations of the Trademark Act Article 22(6)→Enforcement Regulations of the Patent Act Article 50-11). (See the JPO website for the detailed submission method)

(Revised June 2019)

## 45-03 P U D T

### Matters to be Stated in Inter Partes Trial Decision

1. Matters to Be Stated in Trial Decision (Patent Act Article 157(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

Details of matters to be stated and matters that require attention are as below.

All administrative judges belonging to a panel that made a trial decision shall affix the name and seal at the end of a trial decision (Enforcement Regulations of the Patent Act Article 50-10, Enforcement Regulations of Utility Model Act Article 23(12), Enforcement Regulations of Design Act Article 19(8), Enforcement Regulations of Trademark Act Article 22(6)) (Imprint alternative measures → 00-02 2.).

(1) An indication of a trial number such as Invalidation 20xx-800xxx. In case of a trial of exclusion or recusation, identify as a trial for exclusion or a trial for recusation, and do not simply indicate a trial (→ 11-01).

(2) An identification of a name or an appellation and an address or a domicile of a party, an intervenor and an agent as follows.

Identification of a party, etc. in a written trial decision (→ 45-10)

An example that an agent does not required to be identified (→ 45-11)

(3) An identification of a trial case (Enforcement Regulations of the Patent Act Article 46, Form 62, Remarks 3, Enforcement Regulations of the Design Act Article 14, Form 13, Remarks 5, Enforcement Regulations of the Trademark Act Article 14, Form 15, Remarks 1)

A. In an indication of a trial case, the number of the right and type of case (an invalidation, an invalidation of registration of extension of duration, a correction, a rescission, an invalidation of renewal of duration) are

identified, and a fact that a trial decision will be rendered is also indicated.

B. An indication of the right in the identification of a trial case is as follows.

Patent No. xxxxxxxx “Title of invention”

Utility Model Registration No. xxxxxxxx “Title of device”

Design Registration No. xxxxxxxx “Article to the design”

Trademark Registration No. xxxxxxxx

#### (4) Conclusion and reasons for a trial decision

##### A. Conclusion of a trial decision (→45-04)

(A) In case of an inter partes trial, like an ex parte appeal, there is a case where a demand is dismissed due to an unlawful demand, and there is another case where a demand for trial is groundless or successful after the proceedings on the merits. Then, it is stated to that effect and bearing of costs of the trial (→47-01).

When a demand for trial is successful, a content of the demand shall be described in details (→45-04).

(B) A trial decision to accept a part of the demand in an invalidation trial is sometimes made for a patent, utility model, or trademark (a trial decision of partial invalidation against a demand for full invalidation, a trial decision of only some part of partial invalidation against a demand for partial invalidation).

(Sample sentence) A goods “OO” among the designated goods in the registration of Trademark Registration No xxxx shall be invalidated.

##### B. Reasons

In an inter partes trial, the followings are required to be clarified at the beginning: finding of a gist of the contents of right which is a premises of a trial, and obvious findings of an application date, a date of patent granted, or a registration date.

C. A trial decision when a request for correction is filed to a patent

invalidation trial

When a correction is accepted, state to that effect in a conclusion of a trial decision, and when a correction is not accepted, do not include to that effect in the conclusion, but include in reasons of a trial decision (→ 51-19 3.(3)).

(5) Date of trial decision

## 2. Notes in Rendering a Trial Decision After Proceedings Are Consolidated

(1) Case numbers of a consolidated trial case is listed in two rows.

(2) Since the proceedings may be consolidated when both parties or one of the parties is identical, an identification of a party who is not identical (→ 1. (2)) is listed adding a corresponding case number such as “a demandant of Invalidation 20xx-800xxx” before describing a “demandant” or a “demandee” which is listed at the beginning of parties.

(3) “After consolidation of the proceedings” is added before a preamble of a trial decision “the decision shall be made as follows”.

When the rights are different, the identification of the rights (→ 1. (3)B) is listed.

(Sample sentence)

Utility Model Registration No. xxxx “Title of Device”

Utility Model Registration No. oooo “Title of Device”

For each trial case of above to invalidate the registration, after consolidation of the proceedings, a trial decision shall be made as follows under the provision of Patent Act Article 154 as applied mutatis mutandis pursuant to Utility Model Act Article 41.

(4) A conclusion of a trial decision is described for each case consolidated (→ 45-04 5. (3)). When a trial decision has a conclusion corresponding to a part of trial cases, it is deemed an omission in a trial decision (Code of Civil Procedure Article 258) and the remaining trial cases are still pending before

the JPO (See 10129 (Gyo-ke) 2006, Judgment of the IP High Court, Oct 31, 2007). Each conclusion corresponding to all cases should be described.

Regarding reasons for a trial decision, it is necessary to describe that matters common to each case consolidated are indicated in the same way as in the absence of consolidation without identifying a case, and matters different from each case consolidated are, such as shown in sample sentences 1,2, indicated by specifying the case or subject. When there are many different parts, simplification of a trial makes less sense.

(Sample sentence 1) A demandant submits Exhibits A-1~A-8 (for Invalidation 20xx-800xxx, Exhibits A-1~A-7, lacking A-8), but .....

(Sample sentence 2) A demandant of Invalidation 20xx-800xxx submits Exhibit A-O and states..... A demandant of Invalidation 20xx-800xxx states...and requests an examination of witness, but....

(5) Even if a trial decision is made after consolidation of the proceedings, it is necessary to determine on all reasons alleged at each case.

“The trial decision of the case finds and decides only one of the reasons for invalidation in a separate trial case A, and does not find and decide any reasons for rescission in a trial case B and a separate trial case C. This fact is apparent from a description of the trial decision itself and there is no dispute between parties on this fact. Then, for the matters related to a trial case B in the trial decision, there is a serious illegal omission of determination (79 (Gyo-ke) 2001, Judgement of the Tokyo High Court, July 18, 2002).

(Revised Feb. 2015)

**45-04 P U D T****Indication of Conclusion of Trial/Appeal Decision and Decision**

## 1. Indication of Conclusion of Trial/Appeal Decision and Decision

A conclusion of a trial/appeal decision or a decision is a result of determination of a panel or a chief administrative judge in a trial/appeal, indicating to what extent an acceptance or rejection is made against a purport of demand/request, a petition, or a request.

In an item for a conclusion of a trial/appeal decision or a decision, a dismissal of an unlawful demand/request or an unlawful petition, or an acceptance or rejection fully or partially according to a purport of demand is clearly and briefly described. According to that description, an effect and a scope of the trial/appeal decision or decision shall be clear immediately.

Especially when a trial for correction or a request for correction is filed, a scope determined by a trial/appeal decision or a decision is made for each unit of demand/request (for each claim, for each group of claims). Therefore, a conclusion should be described so that it can be specified.

## 2. Indication of Bearing of Costs for Trial/Appeal

(1) A bearing of costs for a trial for patent (registration) invalidation (Patent Act Article 123, Utility Model Act Article 37, Design Act Article 48, Trademark Act Articles 46, 68(4)) or a trial for rescission of trademark registration (Trademark Act Articles 50, 51, 52-2, 53, 53-2) shall be clearly indicated who should bear in a conclusion ex officio with or without a request of a party (Patent Act Articles 120-8(1), 169(1), Design Act Article 52, Trademark Act Articles 43-15(1), 56(1), 68(4)) (Bearing of Costs →47-01).

(2) In cases for an appeal against an examiner's decision of refusal (Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Articles 44(1),

68(4)), an appeal against an examiner's decision to dismiss amendment (Design Act Article 47(1), Trademark Act Articles 45(1), 68(4)), an opposition to grant of patent (Patent Act Article 113(1)), an opposition to registration of trademark (Trademark Act Article 43-2), a trial for correction (Patent Act Article 126(1)), or *Hantei* (an advisory opinion on the technical scope of industrial property rights)(Patent Act Article 71(1), Utility Model Act Article 26(1) → Patent Act Article 71(1), Design Act Article 25(1), Trademark Act Article 28(1)), costs are borne by a demandant (a petitioner), which is provided by law, and it is not necessary to indicate in a conclusion (Patent Act Articles 120-8(1), 169(3), Design Act Article 52, Trademark Act Articles 43-15(1), 56(1), 68(4)).

(3) In decision of accept or not accept an intervention, a bearing of costs incurred by an opinion against a request for intervention is indicated in a conclusion (→ 47-01 3.(3)).

### 3. Basic Policy of Indication of Conclusion

(1) Do not indicate a determination beyond a purport of demand/request or a petition or a request. This restriction, however, does not apply to a dismissal of a written demand/request and the burden of costs.

(2) When a demand/request (a petition or a request) of a demandant/appellant of the case is rejected, indicate that the demand/request is groundless, while when a demand/request is accepted, indicate concretely an acceptance of a purport of a demand/request (a petition or an application).

(3) When a partial dismissal, indicate in order of a partial dismissal, a result of determination of the case, and the burden of costs.

(4) Indicate a conclusion separately from other necessary matters to be stated and just before an item of the reasons.

(5) Regarding correction of a conclusion, Patent Act does not have any provision of decision to correct a trial decision, but a trial decision may be



corrected in court precedents consistently (→47-06 1.).

(6) Indication of a conclusion in various cases (→47-03 1.(4)).

(7) When a trial for correction or a request for correction is filed, a unit of a demand/request that is a scope of determination is specified in a conclusion. Specifically, when claim 1, claims 3,4, and claims 6-9 after correction are a unit of correction respectively, it specifies by stating “Regarding, claim 1, [3,4], [6-9] after correction” (when determining by each group of claims , specify a unit by [] for better understanding).

4. Trial Decision When Request For Correction Is Filed During the Pendency of Trial for Patent Invalidation (→45-03 1. (4) C. , 51-19 3. (3)).

5. Actual Examples of Conclusion of Trial/Appeal Decision

(1) Trial/appeal decision to dismiss a demand/request for trial/appeal

A. The whole dismissal of demand/request

A demand/request for a trial/appeal of the case is dismissed.

Cost of the trial/appeal shall be borne by a demandant/appellant.

B. Partial dismissal of demand/request (→5. (2) C (B) c) .

(2) Trial/appeal decision of the case

A. Appeal against an examiner’s decision of refusal

(A) Request is successful

a. When the original decision is revoked and make own decision

Stating “the original decision is revoked” with a conclusion of the own decision along the following sample sentences.

(a) General sample sentence

The invention (design, trademark) of this application should be patented (registered).

(b) A sample sentence of an application for the trademark registration of renewal of term for a duplicate trademark registration

A renewal of the term for the trademark registration of Trademark Registration No. OO shall be accepted.

(c) A sample sentence of a defensive mark

The application for a defensive mark shall be registered as a defensive mark for Trademark Registration No. OO.

b. When the original decision is revoked and remanded

The original decision shall be revoked.

The present application shall be remanded to the examination.

(B) Request is dismissed

A request for appeal of the case is groundless.

B. An appeal against an examiner's decision to dismiss amendment of an application for design or trademark registration

(A) Request is successful

The original decision shall be revoked.

(B) Request is dismissed

A request for appeal of the case is groundless.

C. Trial for invalidation of patent (registration)

(A) General trial

a. A patent (registration) is invalidated (A trial is successful)

The whole invalidation: A trial is demanded for the whole claims and said whole claims become invalidated

(a) The invention described in claims 1~3 of Patent No. OO is invalidated. The trial costs shall be borne by a demandee.

(b) The device (design, trademark) described in claims 1~5 of Utility Model (Design, Trademark) Registration No. OO is invalidated.

The trial costs shall be borne by a demandee.

Partial Invalidation: A trial is demanded for a part of the claim and said partial claims of the claim become all invalidated

The invention described in claim 1 of Patent No. OO is invalidated.

The trial costs shall be borne by a demandee.

b. Demand is dismissed

A demand for trial of the case is groundless.

The trial cost is borne by a demandant.

c. A patent (registration) is partially invalidated (A trial is partially successful)

(a) The invention described in claim 1 of Patent No. OO is invalidated.

A trial demand for the remaining claims is groundless.

(A demand for trial for the invention described in claim 2 is groundless.)

The trial cost is borne a half by a demandant and the other half by a demandee.

(b) "XX" in the designated goods (designated services) of Trademark Registration No. OO is invalidated.

A trial demand for the remaining designated goods (designated services) is groundless.

The trial cost is borne a half by a demandant and the other half by a demandee.

(B) Special cases for trial for invalidation (registration)

a. Joint trial

A demand for trial of the case is groundless.

The trial cost is paid 2/3 by a demandant A and 1/3 by a demandant B.

b. Invalidation trial with an intervenor

(a) When there is an intervenor on demandant's side, and a demand for trial is successful

Design Registration No. OO is invalidated.

The trial costs and costs incurred by intervention shall be borne by a demandee.

(b) When there is an intervenor on demandant's side, and a demand for trial is dismissed

A demand for trial of the case is groundless.

The trial costs including costs incurred by intervention shall be borne by a demandant and an intervenor.

(c) When there is an intervenor on demandee's side, and a demand for trial is successful

The patent invention of Patent No. OO is invalidated.

The trial costs including costs incurred by intervention shall be borne by a demandee and an intervenor.

(d) When there is an intervenor on demandee's side, and a demand for trial is dismissed

A demand for trial of the case is groundless.

The trial costs and costs incurred by intervention shall be borne by a demandant.

c. Invalidation trial of patent (registration) is partially dismissed and partially accepted

"XX" in the designated goods (designated services) of Trademark Registration No. OO is invalidated.

A trial demand for the remaining designated goods (designated services) is dismissed.

The trial cost shall be borne by ....

(C) Trial for invalidation of patent (registration) with a request for correction

When a correction is accepted for a trial for patent invalidation of the above cases (A) and (B), a conclusion of accepting the correction is also stated before each of the above conclusion as below.

Example

a. Request for correction is accepted (corrections are fully accepted)

(a) Correction is requested for the whole patent right

A correction of a specification and the claims (and drawings) of Patent

No. OO is accepted in accordance with a specification and the claims (and drawings) attached with a written request for correction.

The patented invention described in claim 1 of Patent No. OO is invalidated.

The trial cost shall be borne by a demandee.

(b) Correction is requested per each claim (if a group of claims are defined, a unit should be specified by [] for better understanding.)

A correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with the corrected claims 1, [3,4] and [6-9] in a specification and the claims (and drawings) attached with a written request for correction.

The patented invention described in claims 1,3,4,6-9 of Patent No. OO is invalidated.

The trial costs shall be borne by a demandee.

b. Request for correction is accepted (corrections are partially accepted)

In a request for correction of dated (m/d/y), a correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with the corrected claims [3,4] in a specification and the claims (and drawings) attached with a written request for correction. The patented invention described in claims 1-4 of Patent No. OO is invalidated.

The trial costs shall be borne by a demandee.

c. Dismissal of a request for correction

Descriptions for a determination of appropriateness of correction is the same as above a. and b.

d. Request for correction to delete the whole claims which are alleged for invalidation is accepted, and a demand for trial for patent invalidation is dismissed

Correction to delete claims O ~  $\Delta$  in correction of the claim is accepted.

A demand for trial of the case is dismissed.

The trial costs shall be borne by a demandant.

(The cost may be borne by a demandee partially or the whole (Patent Act Article 169(2), Code of Civil Procedure Articles 62, 63 → 47-01)).

e. Correction to delete the partial claims which are alleged for invalidation is accepted

Correction is accepted in accordance with a written request for correction.

A patented invention described in claims O ~ O is invalidated

A demand for a trial for patented invention described in claims O ~ O is groundless.

A demand for trial of the case for claims O ~ O is dismissed.

The cost for trial is borne O/O by a demandant and O/O by a demandee.

(A demand for the deleted claims shall be dismissed. The burden of cost for the deleted claims shall be the same as c. in the above)

#### D. Trial for rescission of a trademark registration

(A) A trial is successful (in rescinding a registration)

Trademark Registration No. OO is rescinded.

The cost for trial shall be borne by a demandee.

(B) Dismissal of a trial for rescission

The trial of the case is groundless.

The cost for trial shall be borne by a demandant.

#### E. Opposition to grant of patent (registration of trademark)

(A) General petition

a. Decision to maintain

(Fully maintained)

Patented claims 1~2 of Patent No. OO are maintained.

A registration of Trademark No. OO is maintained.

(Partially maintained)

A patented claim 1 of Patent No. OO is revoked.

A patented claim 2 of the same Patent No. OO is maintained.

b. Decision to revoke

A patented claim 3 of Patent No. OO is revoked.

A registration of Trademark No. OO is revoked.

(B) Opposition to grant of patent with a request for correction

When a correction is accepted for an opposition to grant of patent of the above (A), a conclusion of accepting the correction is also stated before each of the above conclusion as below.

Example

a. Decision to maintain (corrections are fully accepted)

(a) Correction is requested for the whole patent right

A correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with a specification and the claims (and drawings) attached with a written request for correction.

Patented claim 1 of Patent No. OO is maintained.

(b) Correction is requested per each claim

A correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with the corrected claims 1, [3,4] and [6-9] in a specification and the claims (and drawings) attached with a written request for correction.

b. Decision to maintain (corrections are partially accepted)

In a request for correction of dated (m/d/y), a correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with the corrected claim [3,4] in a specification and the claims (and drawings) attached with a written request for correction.

Patented claim 3 of Patent No. OO is maintained.

c. Decision to rescission

Descriptions for a determination of appropriateness of correction is the same as above a. and b.

F. Trial for correction

(A) Acceptance of trial for correction (corrections are fully accepted)

a. Trial for correction is requested for the whole patent right

A correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with a specification and the claims (and drawings) attached with a written request for correction.

b. Trial for correction is requested by each claim

A correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with the corrected claims 1, [3,4] and [6-9] in a specification and the claims (and drawings) attached with a written request for correction.

(B) Acceptance of trial for correction (corrections are partially accepted)

In a request for correction of dated (m/d/y), a correction of a specification and the claims (and drawings) of Patent No. OO is accepted in accordance with the corrected claim 1 in a specification and the claims (and drawings) attached with a written request for correction.

A trial for correction for claims 1 and [6~9] is groundless.

(C) Dismissal of a trial for correction (corrections are not accepted)

A request for trial for correction of the case is groundless.

(3) Trial decision when proceedings are consolidated

(A conclusion shall be stated by each consolidated case)

Conclusion

Trial case of Invalidation No. 20xx-800001

A patent described in claims 1~3 of Patent No. OO is invalidated.

The trial costs shall be borne by the demandee.

Trial case of Invalidation No. 20xx-800002

A patent described in claims 1~4 of Patent No. OO is invalidated.

The trial costs shall be borne by the demandee.



Trial case of Invalidation No. 20xx-800003

A trial of the case is groundless.

The trial costs shall be paid by the demandant.

(4) Re-trial

A. Dismissal by trial decision

A request for re-trial of the case is dismissed.

B. Trial decision of the case

(A) A request for re-trial is successful

A trial decision of the case No. OO of 20xx made on (m/d/y) is rescinded.

(A conclusion of the trial decision when said request for re-trial is succeeded is also stated)

(B) A request for re-trial is not successful

A request for re-trial is groundless.

(Note)

A re-trial is requested for a reason of an omission of determination or a fraudulent trial decision, and such the reason is found only after a result of the proceedings of the case comes out, then, as a conclusion, if there is the reason, applying B, if there is no reason, applying A. The burden of the costs and others shall follow the conclusion of the trial.

6. Example of Conclusion of Decision

(1) Decision of dismissal by a chief administrative judge

A. A request for a trial of the case is dismissed.

B. An opposition to grant of patent of the case is dismissed.

C. An opposition to registration of trademark of the case is dismissed.

D. A petition for intervention of the case is dismissed.

(2) Decision of dismissal by a trial

An opposition to grant of patent (registration of trademark, a request for

intervention, a petition for exclusion, a petition for recusation) is dismissed.

(3) Decision of the case

A. Decision to accept or reject of intervention

(A) Acceptance

(Example 1) An intervention of the case is accepted.

(Example 2) An intervention of the case for assisting a demandant (a demandee) by an applicant for intervention is accepted.

(Note) It is possible to indicate a mode of intervention under the provision of Patent Act Article 148(1) or (3) (Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

(B) Rejection

A request for intervention is groundless.

The costs incurred by the request for intervention shall be borne by the applicant of intervention.

B. Decision of dismissal of amendment

A written amendment of (m/d/y) is dismissed.

(4) Decision of preservation of evidence

A. Preservation of evidence is accepted.

(A) An examination of witness is conducted for the matters in the attached sheet.

(B) As an expert for the case, Mr.(Ms.) OO of 1-9, Yushima, Bunkyo-ku, Tokyo is designated.

(C) An inspection and an examination of an expert is conducted at the office and plant of the other party.

B. Preservation of evidence is partially accepted.

An examination of witness is conducted for the matters in the attached sheet at a trial court of the JPO.

An examination of evidence for other requests is not conducted.

(5) Decision to accept or reject of resumption

- A. Resumption by a person who succeeds the procedures is accepted.
  - B. A petition for resumption of the case is groundless.
- (6) Decision of exclusion or recusation
- A. A petition for exclusion (recusation) has a ground.
  - B. A petition for exclusion (recusation) is groundless.

## 7. Example of Conclusion of *Hantei*

### (1) Dismissal

A request for *Hantei* of the case is dismissed.

### (2) *Hantei* of the case

A. A sample sentence of a conclusion of *Hantei* is indicated below.

(A) (Patent/Utility Model) OO described in Figure A and its description does (not) belong to the technical scope of the present invention, or present device.

(B) (Design) A design described in Figure A and its description does (not) belong to the scope of the registered design OO and the designs similar thereto.

(C) (Trademark) A trademark A used for the goods OO does (not) belong to the scope of effects of the trademark rights.

(Revised June 2019)

**45-06 P U D T****Correction of Trial and Appeal Decisions, etc**

1. Code of Civil Procedure provides “If there is a miscalculation, clerical error, or any other clear error equivalent to this in a judgment, the court may issue a corrective ruling (decision) at any time, upon petition or sua sponte (Code of Civil Procedure Article 257(1)). There is no similar provision in Patent Law, and it is not always clear that a trial/appeal decision, etc. may be corrected in a legal text. However, a court precedent consistently allows to correct a trial/appeal decision ((602 (O) 1923) Judgement of the Supreme Court, Dec 3, 1923); (673 (O) 1929), Judgment of the Supreme Court, Oct 16, 1929; (3120 (O) 1933) Judgment of the Supreme Court, May 8, 1934; 245 (Gyo-ke) 1992), Judgment by the Tokyo High Court, Oct 31, 1995).

2. As providing in Patent Act Article 157 (Utility Model Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), a trial/appeal ends by a trial/appeal decision. Therefore, a trial/appeal decision which is an important disposal may not be reclaimed after service of the decision.

3. A corrective ruling (decision) is limited to correcting a fallacy of indication when the fallacy is obvious. A content of trial/appeal decision shall not be substantially changed by a corrective ruling (decision).

4. A corrective ruling (decision) is conducted by a panel of the board (department) making a trial/appeal decision by its authority or petition.

5. When a corrective ruling (decision) is conducted, a certificate of a written corrective ruling (decision) is served to a person to whom a trial/appeal decision was served.

6. A decision (including a decision of opposition to grant of patent (registration of trademark), a decision of dismissal of amendment) may be also corrected similar to a trial/appeal decision.

(Example) Corrective Ruling (Ex Parte Appeal) (Original)

Dispatch No. 112233 1/

### Corrective Ruling

Appeal 20xx-000000

OOOOOOOOOO

Demandant OOOO

OOOOOOOOOO

Agent (Patent Attorney) OOOO

A case of an appeal against an examiner’s decision of refusal of Patent Application No. 20xx-000000 has an obvious error in the appeal decision made on (m/d/y), so that a corrective ruling is conducted ex officio as below.

#### Note

In the item OO of the appeal decision, “△△△” is corrected to “□□□”.

(Date)

A chief Administrative Judge	Administrative Judge of JPO	OOOO
	Administrative Judge of JPO	OOOO
	Administrative Judge of JPO	OOOO

(Teaching under the provision of Administrative Case Litigation Act Article 82)

If an applicant has any complaint against this disposition, a request for examination under Administrative Case Litigation Act may be filed against Commissioner of the JPO within 3 months from the following date on which this notification of disposition was received.

(Teaching under the provision of Administrative Case Litigation Act Article 46)

An action against this disposition may be filed against the government (Minister of Justice represents the country in an action) within 6 months from the following date on which this notification of disposition was received.

(Revised June 2019)

**45-10 P U D T**  
**Indication of Party Concerned, etc.**  
**in Written Trial/Appeal Decision, etc.**

1. A party, etc. in a trial/appeal decision, etc. indicates before an identification of the case shown as a sample sentence (Cases concerning International Application for Design Registration→00-03).

2. When a party and an intervenor are a corporation, a name of representative of the company is omitted.

3. When a party and an intervenor are two or more people, all people are listed and if there is an agent, all agents are listed after each authorizer.

4. When there is a legal agent, describe as “Legal Agent OO”.

5. When there is a trustee in bankruptcy or a trustee for corporate reorganization, describe as “Trustee OO”.

6. When there is an authorized agent, list a job title and name of an authorized agent.

[Explanation]

According to Article 5 under “Act on the Authority of the Minister of Justice over Suits Relating to the Interests of the State”, it is regulated “.....designate one of its officials.....”. Although a job title and name should be described according to this, just describe as above for administrative reasons.

7. When it is found from a patent register, etc. that an address, etc. of a party



has been changed, an address after change is sometimes listed.

Description Example

.... OO, Tokyo

Demandant                    A Corporation

.... OO, Tokyo

Agent Patent Attorney    X

.... OO, Tokyo

Agent Patent Attorney    Y

.... OO, Tokyo

Demandant                    B Corporation

.... OO, Tokyo

Agent Patent Attorney    Z

(Sample Sentence)

Address or domicile

Demandant    Name or Appellation

Address or domicile

Agent            Name or Appellation

Address or domicile

Intervenor    Name or Appellation

Address or domicile

Agent            Name or Appellation

Address or domicile

Demandee    Name or Appellation

Address or domicile

Agent            Name or Appellation

Address or domicile

Intervenor	Name or Appellation
Address or domicile	
Agent	Name or Appellation

(Revised Feb. 2015)

**45-11 P U D T**  
**Cases in Which It Is Not Necessary to Describe Agents in**  
**Written Trial/Appeal Decision**

It is not necessary to describe an agent in a trial/appeal decision in the following cases.

- (1) An agent has already been dismissed at the time of trial/appeal decision.
- (2) It is obvious to the JPO that an agent is dead at the time of trial/appeal decision.
- (3) A notice of death of an agent has been submitted.
- (4) A document certifying an authority of representation (a power of attorney) is not in due form.

It does not apply to the case when the document should be dismissed due to lack of authority of representation of all agents of the demandant/appellant side.

- (5) Even if a power of attorney was submitted, said agent does not carry out any procedures.
- (6) When a new agent is appointed during the proceedings, a power of attorney is submitted but a notice of acceptance of power of attorney is not submitted.

(Revised Feb. 1996)

**45-19 P U D T**  
**Dismissal by Trial/Appeal Decision**

When a demand/request for trial/appeal falls under any of the following reasons, the demand/request is dismissed by trial/appeal decision without order of amendment due to unlawful demand/request (Patent Act Article 135, Utility Model Act Article 41, Design Act Article 52, Trademark Act Article 56).

- (1) A demand/request for trial/appeal outside the period of demanding /requesting the trial/appeal (→45-20)
- (2) A demand/request made by a part of joint applicants(→45-20, 22-03)
- (3) A demand/request with a part of co-owners of the right as a demandee (→45-20)
- (4) A demand/request with a person who is not a patent owner as a demandee (→45-20)
- (5) A demand/request without any subject matter
- (6) A demand/request by a person who resides outside Japan without a patent administrator
- (7) A demand/request after a period of exclusion
- (8) In a trial for cancellation of registered trademark not in use, a demand against a trademark for which 3 years has not been passed since an establishment of the registration of the trademark right
- (9) When more than one appeal against an examiner's decision of refusal is filed to the same patent application, an appeal other than the first appeal

(Revised Feb. 2015)

**45-20 P D T****Clause Example of Dismissal of Trial/Appeal Decisions**

## 1. Lapse of Period for Filing a Request

When a request for an ex parte appeal shall be dismissed (Patent Act Article 135, Design Act Article 52, Trademark Act Article 56(1)) due to non-observance of a term for requesting an appeal (Patent Act Article 121, Design Act Articles 46, 47, Trademark Act Articles 44, 45), a reason for the appeal decision of dismissal may be described as the following clause example.

(Clause example)

**Reason**

A decision of final rejection was made on (M/D/Y) against the patent application (filing date (M/D/Y), and a certified copy of the decision was served on (M/D/Y) to the applicant (or an agent of the applicant) by the electronic data processing system who is an appellant of this appeal case.

(Note)

A request for an appeal against an examiner's decision of refusal shall be filed within 3 months from a date on which a certified copy of a decision of final rejection was served by (M/D/Y) (according to a calculation of the term under the provision of Patent Act Article 3) under the provision of Patent Act Article 121. However, a request for the appeal of the case was filed on (M/D/Y) and thus this is an unlawful request filed after the statutory period has been passed, and such defect may not be amended. Therefore, the request for an appeal of the case shall be dismissed under the provision of Patent Act Article 135.

Consequently, the appeal decision is rendered according to the conclusion.

(Note)

When a certified copy is served by mail, the above clause is replaced after “~, and a certified copy of the decision” with “was served on (M/D/Y) to an applicant (or an agent of the applicant) who is an appellant of the appeal case, that is apparent from a mail delivery certificate.”.

## 2. Clause Example of Appeal Decision to Dismiss a Request for Appeal Filed by Some of the Joint Applicants

For an appeal against an examiner’s decision of refusal (a decision of a dismissal of amendment of a design or a trademark registration application), when a request for appeal which is filed by some of the joint applicants shall be dismissed (→22-01 3., 22-03 3. (1)), a reason for an appeal decision may be described as the following clause example.

A chief administrative judge shall order an amendment when it is presumed that an intention that an appeal is in effect a joint appeal is expressed, for example, if an agent states appellants partially in the request by mistake even though all members of joint applicants entrust a request for an appeal to the agent. In that case, a request for appeal may not be dismissed under the provision of Patent Act Article 135 (→23-02 3.(1) B d).

(Clause Example)

### Reason

This appeal case is an appeal against an examiner’s decision of refusal for a patent application of which the right to be patented is jointly owned by (A) and (B). The request should have been filed under the names of all members of the co-owner; but it was filed only with a part of the members. Therefore, it is an unlawful request, and such defect may not be amended.

(Note)

Accordingly, the request for an appeal of the case shall be dismissed under the provision of Patent Act Article 135.

(Note)

After filing a request for an appeal, an appellant is changed, and when it is recognized that such change alters a gist of the request (→30-01). The following clause shall be inserted after the last sentence “and such defect may not be amended.”: “an amendment to change an appellant by a written amendment filed on (D/M/Y) violates the provision of Patent Act Article 131-2(1) due to alteration of a gist of the request.”

### 3. Clause Example of Trial Decision to Dismiss a Demand for Trial in Which Some of the Joint Owners of the Patent Right Claiming as a Demande

For an invalidation trial on a patent right which is jointly owned, when a demand for trial with some of the co-owners claiming as a demandee shall be dismissed by trial decision (→22-02 3.(2)), a reason for the trial decision may be described as the following clause example. (Note 1)

(Clause Example)

#### Reason

A trial of the case is an invalidation trial for a patent of which the right jointly owned by (A) and (B). When a trial is demanded, all members of the joint owners of the patent should have claimed as a demandee under the provision of Patent Act Article 132(2), but the case was filed claiming only (A) as a demandee who is one of the joint owners. Therefore, it is an unlawful demand, and such defect may not be amended (Note 2).

Therefore, a demand for a trial of the case shall be dismissed under the

provision of Patent Act Article 135.

Consequently, a trial decision is rendered according to the conclusion.

(Note 1) For a trial for rescinding a trademark registration, when a demand for a trial shall be dismissed by trial decision due to claiming only some of the joint owners of the trademark as a demandee, a reason for the decision may be described in the same purport as the clause example.

(Note 2) After filing a demand for trial, a demandant is changed, and when it is recognized that such change alters a gist of the demand (→30-01), the following clause shall be inserted after the last sentence “and such defect may not be amended.”: “An amendment to change a demandee by a written amendment filed on (D/M/Y) violates the provision of Patent Act Article 131-2(1) due to alteration of a gist of the demand.”

#### 4. Clause Example of Trial Decision to Dismiss a Demand for Trial in Which a Demandee Is Not a Patentee

For an invalidation trial, a demand for trial in which a demandee is not a patentee shall be dismissed (→22-01 7., 22-02), a reason for a trial decision may be described as the following clause example (Note 1) .

(Clause Example)

##### Reason

A trial of the case is an invalidation trial for patent in which a patentee is (A). A trial shall be demanded with a patentee claiming as a demandee, however, the demand for the trial has been filed with (B) who is not a patentee claiming as a demandee, therefore, it is an unlawful demand, and such defect may not be amended (Note 2).

Therefore, a demand for a trial of the case shall be dismissed under the



provision of Patent Act Article 135.

Consequently, a trial decision is rendered according to the conclusion.

(Note 1) For a trial for rescinding a trademark registration, when a demand for a trial shall be dismissed by trial decision due to claiming a person who is not a patentee as a demandee, a reason for the decision may be described in the same purport as the clause example.

(Note 2) After filing a request for trial, a demandant is changed, and when it is recognized that such change alters a gist of the demand (→30-01), the following clause shall be inserted after the last sentence “and such defect may not be amended.”: “An amendment to change a demandee by a written amendment filed on (D/M/Y) violates the provision of Patent Act Article 131-2(1) due to alteration of a gist of the demand.”

(Revised June 2019)