

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)