

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 ~ Δ 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)