

46-00 P U D T**Final and Binding Trial/Appeal Decision, etc.****1. Final and Binding Trial/Appeal Decision, etc.**

A trial/appeal decision or a decision becomes final and binding when no action objecting to the trial/appeal decision or the decision is instituted within the statutory period (Patent Act Article 178(3), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)), or even an action is instituted, a trial/appeal decision, etc. is maintained and may not be rescinded by usual appeal.

An appeal decision to grant of patent (registration of utility model) in an appeal against an examiner's decision of refusal, or a trial decision to accept a correction in a trial for correction becomes final and binding when a certified copy of a trial/appeal decision is served because no one has legal interests to enter an appeal.

2. Partial Final and Binding Trial/Appeal Decision, etc.

Trial/appeal decisions of an invalidation trial for patent (registration of utility model) (Patent Act Article 123, Utility Model Act Article 37), an opposition to grant of patent (Patent Act Article 113), a trial for correction (Patent Act Article 126), an opposition to registration of trademark (Trademark Act Article 43-2), a trial for invalidation of trademark registration (Trademark Act Article 46) and a trial for invalidation of reclassification of trademark registration (Supplementary Provisions of the Trademark Act Article 14) (→00-01) become sometimes partially final and binding as shown below.

(1) A partial final and binding trial decision of an invalidation trial for patent (registration of utility model) (Patent Act Article 123, Utility Model Act

Article 37) (→51-19 4.), a partial final and binding decision of an opposition to grant of patent (Patent Act Article 113) (→67-06 5.)

Regarding a patent (registration of utility model) having two or more claims, an invalidation trial for patent (registration of utility model) may be demanded by each claim. When an invalidation trial for patent (registration of utility model) is demanded for two or more claims, it is interpreted in principle that a trial by claim proceeds at the same time. A trial decision against an invalidation trial (successful or unsuccessful demand) is a divisible administrative disposition by determination on each claim. In a suit rescinding the trial decision of the invalidation trial, when only a part of the trial decision is maintained or a suit is not instituted for some of the claims, a part of the trial decision regarding said claims in the whole trial decision becomes a final and binding separately.

Regarding a trial decision of an invalidation trial for patent when a correction is requested per “a group of claims” (Patent Act Article 123-2(3)), the decision becomes final and binding per group of claims when all claims in the group become final and binding.

“A group of claims” is determined by claims before correction. However, when a correction to dissolve a citation relationship or a correction to delete claims is accepted for a specific claim constituting “a group of claims” and a correction for said specific claim is “requested to be a separate unit for correction” (→38-01), said specific claim is handled as a separate unit for correction and a trial decision becomes final and binding separately from other claims of a group of claims.

The same applies to an opposition to grant of patent.

(2) A partial final and binding trial decision (Patent Act Article 167-2) for a trial for correction (Patent Act Article 126)

A patent including two or more claims may request for a trial for correction per each claim or a group of claims. In this case, it is understood in principle

that a trial by claim or by a group of claims proceeds at the same time. A trial decision against a demand for trial for correction (correction accepted or not accepted) is a divisible administrative disposition by determination on each claim or a group of claims.

In a suit rescinding a trial decision of the trial for correction, when only a part of the trial decision is maintained or a suit is not instituted for a part of the trial decision, a part regarding said claims in said part of the trial decision becomes a final and binding by each claim or by a group of claims. The idea of “a group of claims” is the same as (1).

(3) A partial final and binding decision (Trademark Act Article 43-14, 55-3, Supplementary Provisions of the Trademark Act Article 16-2) of an opposition to registration of trademark (Trademark Act Article 43-2), an invalidation trial of trademark registration (Trademark Act Article 46) and an invalidation trial of reclassification of trademark registration (Supplementary Provisions of the Trademark Act Article 14)

Regarding a trademark registration for two or more designated goods or services, it is possible to file an opposition to registration of trademark or a demand for an invalidation of trademark registration by each designated goods or services, and the decision or the trial decision becomes final and binding by each designated goods or services as with an invalidation trial for a patent (registration of utility model).

3. Final and Binding Decision of Patent Invalidation Trial and Opposition to Grant of Patent, and Final and Binding Decision of Acceptance of Correction

When an invalidation trial for patent is demanded by claim, a trial decision becomes final and binding as below.

(1) In a trial decision, a part where a correction is accepted by claim or by group of claims and a part where a trial demand for said claim or said group of claims is successful or unsuccessful inseparably becomes final and binding.

(2) In a trial decision, a part where a correction was determined on a claim or a group of claims for which a suite rescinding a trial decision is not filed becomes final and binding together with a part where a trial demand for said claim or said group of claims is successful or unsuccessful when the period for filing the suit has passed.

(3) In a trial decision, a part where a correction is accepted on a claim or a group of claims for which a demand for invalidation trial is not filed becomes final and binding at the time of service of the trial decision. Even when an invalidation trial is withdrawn after the trial decision to accept a correction is served, it does not affect the final and binding trial decision to accept said correction.

(4) They apply to a final and binding decision for a patent opposition.

(Revised June 2019)