

51-04 P U D T

Subject of a Request for a Trial for Invalidation and Reasons for Invalidation

1. Subject of a Request for a Trial for Invalidation

The subject of a request for a trial for invalidation is a patent (registration) disposition as part of the administrative disposition (the Patent Act Article 123(1); the Utility Model Act Article 37(1); the Design Act Article 48(1); the Trademark Act Articles 46(1), 68(4)).

(1) When a patent or a utility model registration has two or more claims, With regard to the subjects relating to two or more claims of a patent and a utility model, a request for a trial for invalidation may be filed for each claim.

(2) When a trademark registration has two or more designated goods or services, a request for a trial for invalidation may be filed for each designated goods or service.

2. Reasons for Invalidation

Reasons for invalidation are defined as any reason or fact invalidating a right. The reasons are limited to the statutory reasons for invalidation (the Patent Act Article 123(1); the Utility Model Act Article 37(1); the Design Act Article 48(1); the Trademark Act Articles 46(1), 68(4)). No other reasons outside the statutory provisions constitute a reason for the request of a trial for invalidation, which is in accordance with the limitative listing of the reasons for invalidation.

3. Reasons for Invalidation (refer to the list of reasons for invalidation described below)

Reasons for invalidation are almost the same as reasons for refusal, but the former differs in some respects.

(1) Patents and Utility Models

A. Reasons for refusal but not for invalidation

(A) Violation of Requirements of Unity of Invention (the Patent Act Article 37; the Utility Model Act Article 6)

(B) Violation of Ministerial Ordinance in the scope of claims (the Patent Act Article 36(6)(iv); the Utility Model Act Article 5(6)(iv))

(C) Violation of requirements of shift amendment (the Patent Act Article 17-2(4))

(D) Deficiency in descriptions of information relating to documents for publicly-known inventions (the Patent Act Articles 36(4)(ii), 48-7, and 49(v))

B. Reasons for invalidation but not for refusal

(A) Late-coming reasons for invalidation (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi))

(B) Unlawful correction (the Patent Act Article 123(1)(viii); the Utility Model Act Article 37(1)(vii))

(Note) Because of the transitional measures, the reasons for invalidation based on the former Patent Act Article 184-15(1) still apply to foreign language applications submitted on or before June 30, 1995.

(2) Designs

A. Reasons for refusal but not for invalidation

One application per design (the Design Act Article 7)

Design for a set of articles (the Design Act Article 9)

Related design (the Design Act Article 10(1))

B. Reasons for invalidation but not for refusal

Late-coming reasons for invalidation (the Design Act Article 48(1)(iv))

(3) Trademarks

A. Reasons for refusal but not for invalidation

Single trademark on each application (the Trademark Act Article 6(1)(2))

B. Reasons for invalidation but not for refusal

Late-coming reasons for invalidation (the Trademark Act Article 46(1)(v),(vi),(vii))

Registration by a non-right holder (the Trademark Act Article 46(1)(iv))

Earlier Application (the Trademark Act Article 8(1))

4. Time for Determining the Reasons for Invalidation

The time for determining whether any reason exists for invalidation, with reference to the relevant laws or state of facts, differs as per each reason. For patents, utility models, and designs, the time should normally be the time of application and registration for trademarks. However, in case a patent (registration) is granted and a reason for invalidation, such as late-coming, is found afterwards, as stated in the Patent Act Article 123(1)(vii), the Utility Model Act Article 37(1)(vi), the Design Act Article 48(1)(iv), and the Trademark Act Article 46(1)(v), the time to determine invalidation is when the late-coming reason has become applicable.

5. Relation to the Examination of Basic Requirements in a Utility Model

The reason for invalidation of utility models (the Utility Model Act Article 37(1)) and basic requirements (the Utility Model Act Articles 6-2, 14-3) are both independent requirements. However, any utility model registration that fails to fulfill the basic requirements is regarded as having a reason for invalidation, except in the case of a deficiency in the unity of invention (the Utility Model Act Article 6) and of claims failed to be described as per the ministerial ordinance's definition (the Utility Model Act Article 5(6)(iv)).

For instance, a deficiency in the basic requirements of claims being described in a method constitutes a reason for invalidation owing to the violation of the body of Article 3 in the Utility Model Act. A deficiency in the basic requirements of the descriptions being significantly unclear constitutes a reason for invalidation owing to the violation of the Utility Model Act Article 5 (deficiencies of the descriptions).

(For reference, see the period of the exclusion of trademarks.) (→51-06)

List of Reasons for Invalidation in a Trial for Invalidation of
Patents and Utility Models

<p>Addition of new matters (the Patent Act Article 123(1)(i)) (the Utility Model Act Article 37(1)(i))</p>	<p>A patent (utility model registration) was granted with an amendment of an addition of new matters, however, such an amendment was against the Patent Act Article 17-2(3) or the Utility Model Act Article 2-2(2).</p>
<p>Violation of the legal capacity of a foreigner (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted to a foreigner not entitled to possess the right in violation of the Patent Act Article 25 or the Utility Model Act Article 2-5(3).</p>
<p>Non-inventive (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted to what is not regarded as an invention or a device stipulated in the Patent Act Articles 2(1) and 29(1) and as per the Utility Model Act Article 2(1) and 3(1).</p>
<p>Violation of industrial applicability (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted to an invention (device) that does not fulfill the requirements of</p>

	industrial applicability as stipulated in the Patent Act Article 29 (1) or the Utility Model Act Article 3(1).
Violation of novelty (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted to an invention (device) that lacks novelty as stipulated in the Patent Act Article 29(1) or the Utility Model Act Article 3(1).
Violation of inventive step (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted to an invention (device) that lacks an inventive step as stipulated in the Patent Act Article 29(2) or the Utility Model Act Article 3(2).
Prior art effect (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted to a later application invention (design) identical to an invention (device) described in a prior application laid open to the public afterwards as stipulated in the Patent Act Article 29-2 or the Utility Model Act Article 3-2.
Violation of public order (the Patent Act Article 123(1)(ii))	A patent (utility model registration) was granted to an invention (design) that

<p>(the Utility Model Act Article 37(1)(ii))</p>	<p>violates public order as stipulated in the Patent Act Article 32 or the Utility Model Act Article 4.</p>
<p>Violation of the requirements of joint application* (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration), which should have been jointly applied for, was granted to an invention (device) to be shared by right holders, in violation of the requirements as stipulated in the Patent Act Article 38 or the Utility Model Act Article 11(1).</p>
<p>Patent of later application (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted in violation of the requirements to exclude any later application, etc. as stipulated in the Patent Act Article 39(1)-(4) or the Utility Model Act Article 7(1)-(3).</p>
<p>Violation of a treaty (the Patent Act Article 123(1)(iii)) (the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted in violation of a treaty.</p>
<p>Violation of description requirements (the Patent Act Article 123(1)(iv)) (the Utility Model Act Article 37(1)(iv))</p>	<p>A patent (utility model registration) was granted against the description requirements as stipulated in the Patent Act Article 36(4)(i) or the Utility Model</p>

	Act Article 5(4).
Violation of the requirements of the description of the scope of claims (the Patent Act Article 123(1)(iv)) (the Utility Model Act Article 37(1)(iv))	A patent (utility model registration) was granted against the requirements of the description of the scope of claims as stipulated in the Patent Act Article 36(6)(i)-(iii) or the Utility Model Act Article 5(6)(i)-(iii).
New matter beyond the original text (the Patent Act Article 123(1)(v))	A patent was granted to a foreign language patent application wherein some new matter was added in the foreign language text.
Usurped application* (the Patent Act Article 123(1)(vi)) (the Utility Model Act Article 37(1)(v))	A patent (utility model registration) was granted to a party that has no right to hold the patent (utility model registration).
Late-coming (post-granted) reasons for invalidation (the Patent Act Article 123(1)(vii)) (the Utility Model Act Article 37(1)(vi))	The patent (utility model registration) has become subject to “violation of legal capacity of right of a foreigner” or “violation of a treaty” after a patent (utility model registration) was granted.
Unlawful corrections (the Patent Act Article 123(1)(viii)) (the Utility Model Act Article	Any correction that does not fulfill the requirements of corrections was

37(1)(vii))	made in a patent (utility model registration), as stipulated in the Patent Act Articles 126, 134-2 or in the Utility Model Act Article 14-2.
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*Reasons for invalidation relating to vested rights are eliminated from the aforementioned reasons for invalidation upon filing a registration of transfer of a patent right under the provision of the Patent Act Article 74 (1).

List of Reasons for Invalidation in a Trial for Invalidation of
Design Registrations and Applicable Articles

Reasons for Invalidation	Applicable Articles
Violation of Requirements of Design Registration (the Design Act Article 3, 3-2)	The Design Act Article 48(1)(i)
Violation of reasons for unregistrability (the Design Act Article 5)	The Design Act Article 48(1)(i)
Violation of prior application (the Design Act Article 9(1), (2))	The Design Act Article 48(1)(i)
Despite the establishment of an exclusive license for a principal design, a related design registration was made. (the Design Act Article 10(2))	The Design Act Article 48(1)(i)
A design only similar to a related design to be registered (the Design Act Article 10(3))	The Design Act Article 48(1)(i)
Violation of joint application (the Patent Act Article 38 applied mutatis mutandis of the Design Act Article 15(1))	The Design Act Article 48(1)(i)
Violation of the enjoyment of rights by foreign nationals (the Patent Act Article 25 applied mutatis mutandis of the Design Act Article 68(3))	The Design Act Article 48(1)(i)

Violation of a treaty	The Design Act Article 48(1)(ii)
Non-right holder registration	The Design Act Article 48(1)(iii)
Violation of the late-coming enjoyment of rights by foreign nationals and violation of a treaty	The Design Act Article 48(1)(iv)

List of Reasons for Invalidation in a Trial for Invalidation of Trademark Registrations
and Applicable Articles

Reasons for Invalidation	Applicable Articles	Statute of Limitation (the Trademark Act Article 47) (Note 1)
Violation of the requirements of trademark registration (the Trademark Act Article 3)	The Trademark Act Article 46(1)(i)	○
Violation of reasons for unregistrability (the Trademark Act Article 4(1))	The Trademark Act Article 46(1)(i)	○ (viii),(x),(xi)-(xv), (xvii) (Note 2)
Violation of the requirements of registration of regional collective trademarks (the Trademark Act Article 7-2(1))	The Trademark Act Article 46(1)(i)	○
Violation of prior application (the Trademark Act Article 8(1), (2),(3))	The Trademark Act Article 46(1)(i)	○
Violation of prohibition of re-registration under rescission of a trademark registration (the Trademark Act Articles 51(2), 52-2(2), 53(2))	The Trademark Act Article 46(1)(i)	×
Violation of the enjoyment of rights by foreign nationals (The Patent Act Article 25 applied mutatis mutandis of the Trademark Act Article	The Trademark Act Article 46(1)(i)	×
Violation of a treaty	The Trademark Act Article 46(1)(ii)	×

Violation of the requirements of the Trademark Act Article 5(5)	The Trademark Act Article 46(1)(iii)	×
Non-right holder registration	The Trademark Act Article 46(1)(iv)	○
Violation of the late-coming enjoyment of rights by foreign nationals and violation of a treaty	The Trademark Act Article 46(1)(v)	×
Violation of reasons for late-coming unregistrability (the Trademark Act Article 4(1)(i)-(iii),(v),(vii),(xvi))	The Trademark Act Article 46(1)(vi)	×
Violation of the requirements of late-coming registration of regional collective trademarks	The Trademark Act Article 46(1)(vii)	×
Violation of the requirements of application for defensive mark registration (the Trademark Act Article 64)	The Trademark Act Article 68(4)	×

Note 1: The symbol “○” indicates that a trademark in the respective category is not allowed to request for a trial for invalidation after five years from the date of the establishment of trademark rights.

Note 2: Articles 4 (1)(x) and (xvii) are not applicable to any trademark found registered for an unfair competition. Article 4(1) (xv) is not applicable to any trademark found registered for any unlawful purposes.

(Revised June 2019)