

51-05 P U D T

Authorized Party, Concerned Party, and Intervenor of a Trial for Invalidation

1. Authorized Party of a Trial for Invalidation

Any decision regarding invalidation of rights is an exercise of the administrative power, which can be exercised through a trial conducted by a panel of administrative judges (the Patent Act Article 136; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

In other words, any rights with establishment of registration continue to be valid unless a final and binding trial decision to invalidate the rights is made.

2. Concerned Party

The concerned parties in a trial for invalidation refer to the demandant and demandee.

If the demandee indicates an uncertainty of the concerned party, etc., any examination of evidence, such as an examination of parties, is not necessary as long as such matters can be sufficiently examined through proceedings under investigation ex officio. This is because determination of the concerned party and the said party's capability of conducting procedures is a matter to be investigated by the relevant authority.

(1) Demandant

A. Anyone who implements the procedures of a request for a trial for invalidation must be recognized to be a person capable of implementing (legal capacity) procedures. (→ 22-01)

B. Any person, corporation, non-corporation association, or foundation—whose representation or management is defined—may request a trial for invalidation (the Patent Act Article 6(1)(iii); the Utility Model Act Article 2-4; the Design Act Article 68(2); the Trademark Act Article 77(2)).

C. Two or more demandants of the same right may jointly request a trial (the Patent Act Article 132(1); the Utility Model Act Article 41; Supplementary Provisions of the 2011

Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→22-03)

D. Eligibility of a demandant for a trial for invalidation is as follows:

(A) For Requests on or after April 1, 2015

Only an interested party may request a trial for invalidation of patents and trademarks (the Patent Act Article 123(2); the Trademark Act Article 46(2)) (→31-00-02).

For the reasons for invalidation relating to vested rights of a patent (violation of the requirements of joint applications (the Patent Act Articles 123(1)(ii), 38) and usurped applications (the Patent Act Article 123(1)(vi)), only a party that is eligible to be granted the patent may request a trial for invalidation.

For a trial for invalidation of the registrations of utility models and designs, anyone may request a trial for invalidation on the reasons other than those relating to vested rights (the Utility Model Act Article 37(2); Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 37(2)); the Design Act Article 48(2)). For the reasons for invalidation relating to vested rights of a patent (violation of the requirements of joint applications (the Utility Model Act Article 37(1); the Utility Model Act Article 11(1) → the Patent Act Article 38; the Design Act Article 48(1); the Design Act Article 15(1)→ the Patent Act Article 38) and usurped applications (the Utility Model Act Article 37(1)(v); the Design Act Article 48(1)(iii)), only an interested party is allowed to request a trial for invalidation of utility models and designs (the Utility Model Act Article 37(2) provisos; the Design Act Article 48(2) provisos).

However, for registrations of utility models and designs relating to the applications on or after April 1, 2012, only a party eligible to be registered may request a trial for invalidation (the Utility Model Act Article 37(2) provisos; the Design Act Article 48(2) provisos).

(B) For Requests on or before March 31, 2015 (the Patent Act Article 123(2); the Utility Model Act Article 37(2); the Design Act Article 48(2), not applicable to trademarks and

limited to the concerned party)

a. For the reasons for invalidation other than reasons relating to vested rights

As for the reasons for invalidation other than reasons relating to vested rights, anyone is allowed to request a trial for invalidation.

b. For the reasons for invalidation relating to vested rights

As for the reasons for invalidation relating to vested rights, only an interested party may request a trial for invalidation.

However, for patents relating to the applications made on or after April 1, 2012, only a party that is eligible to be granted the patent is allowed to request a trial for invalidation (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 2(9)).

E. The following should be noted for demandants:

(A) Request by a non-existent person for a trial for invalidation

For any request under a name of a non-existent person (anonymous) for a trial for invalidation, the concerned party in such a case cannot be defined because the demandant as the concerned party for a trial for invalidation does not exist; thus, the action for the request cannot be concluded. Such a request for a trial for invalidation is dismissed by a trial decision for being unable to make its amendment due to an unlawful request (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(B) Request for a trial for invalidation under fraudulently use of a name

Actions under fraudulently use of a name, such as a request for a trial for invalidation using a name of an existing person without permission or using a name with permission but with no intention of the named person to proceed with any procedure, is deemed a request for a trial for invalidation that is not based on the intention of a person whose name is fraudulently used (a superficial demandant). Such a case does not constitute an action of a request for trial by the person whose name is used, and the action by the person who committed name theft is deemed as an unauthorized representation that does not deliver effects to the victim of the name theft. Therefore, the request should be

dismissed by trial decision as an unlawful request for trial. (Any litigation of fraudulently use of the name under the Code of Civil Procedure is handled in the same way.)

In case a request for a trial for invalidation is found to be a request under a fraudulent name during communications between the Japan Patent Office and the demandant and through procedures such as an oral proceedings, the chief administrative judge determines whether the person whose name is fraudulently used (a superficial demandant) confirms the procedures undertaken thus far by the person who used the name fraudulently and whether the said person has any intention to continue procedures for the trial. Any procedures undertaken by a person with no authority or representation may be confirmed only by the person whose name is fraudulently used (or a statutory representative) having the capacity to undertake procedures. When there is the intention to confirm the procedures, the procedures undertaken may be ratified (the Patent Act Article 16(2); the Utility Model Act Article 2-5(2); the Design Act Article 68(2); the Trademark Act Article 77) and may proceed with the procedures thereafter for the person whose name is fraudulently used as a demandant. When the said person is found to have no intention to confirm the procedures, the request for a trial for invalidation is deemed unlawful and dismissed by the trial decision since any amendment is not allowable (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)).

In case a request for trial is not dismissed because of an overlook of a deficiency and a trial decision is reached after the proceedings, the patentee once invalidated of the said patent by the trial decision through unlawful procedures can still request dismissal of the trial decision for invalidation through a revocation action against the trial decision (the Patent Act Article 178; the Utility Model Act Article 47; the Design Act Article 59; the Trademark Act Article 63). Furthermore, even after the trial decision for invalidation is final and binding, a patentee having a benefit of a request in the consequent rescinding of the trial decision may be allowed to request a re-trial in the pursuit of rescinding the trial decision for invalidation (the Patent Act Article 171(2))

→ Analogical application of the Code of Civil Procedure, Article 338(1)(iii)).

Accordingly, any request for a trial for invalidation under the fraudulent use of a name may not produce any benefit of invalidation. (Such fraudulent action does constitute the uttering of counterfeit private documents; this is illegal from a criminal perspective.)

(C) Representation based on compensation

In a case where a person having an intention to pursue the procedures requests a trial for invalidation under the person's name and is commissioned by a third party requesting a trial for invalidation, the request for a trial for invalidation shall not be dismissed by the trial decision because this case is not deemed a request under a fraudulently use of a name. However, if anyone who is not a professional representative, such as a patent attorney or an attorney at law, requests a trial as a representative of someone else in pursuit of monetary or other compensations, it is necessary to be careful because this action could possibly develop a problem of violation of the Patent Attorney Act or the Attorney at Law Act (the Patent Attorney Act 75, the Attorney at Law Act 72).

(2) Demandee

A. Demandee is a right holder.

(A) When the right is jointly owned, all co-patentees jointly owning the right are demandees (the Patent Act Article 132(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→ 22- 03)

In principle, a request for a trial that fails to list all co-patentees of the right as demandees may be dismissed by the trial decision.

a. Procedures wherein all or some of the co-patentees are residents abroad, and a patent administrator is not selected. (→23-10)

b. In case of an interruption or a suspension upon the death of one of the co-patentees, the right takes effect on all the other co-patentees. (→ 26-01)

(B) If any right is registered as part of trust property under the Trust Act, the demandee is the trustee.

For a request for a trial for invalidation after a lapse of rights (the Patent Act Article 123(3); the Utility Model Act Article 37(3); the Design Act Article 48(3); the Trademark Act Articles 46(3), 68(4)), the demandee is the right holder at the time of the lapse. Refer to 22-04 when the address, etc. of the demandee differs from that stated in the register.

B. Any demandee's amendment for being wrongly expressed does not constitute a change in the gist of the request stipulated in the Patent Act Article 131-2(1), the Utility Model Act Article 41, the Design Act Article 52, and the Trademark Act Article 56(1) that might eliminate a deficiency (→ 22-01 9.(3)).

3. Intervenor (→ 57-00)

(1) Intervention as a demandant for a joint trial (Intervention of the concerned party)

Anyone entitled to be a demandant for a joint trial may intervene in the case as a demandant until the completion of the proceedings (the Patent Act Article 148(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

The capability of implementing the procedures and the eligibility as a demandant of an intervenor as a demandant for a joint trial are the same as those of a demandant.

In the proceedings, the determination of whether to grant a written request for intervention (the Patent Act Article 149(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)) as a demandant for a joint trial is decided upon hearing the opinions of the concerned parties.

In principle, a demandant for a joint trial is an intervenor as a "demandant," thus, such the intervenor may implement the same procedures as those undertaken by the original demandant. However, if a demandant for a joint trial states new reasons for invalidation that might change the gist of the reasons for request, the panel is allowed to make the new reasons for invalidation the base for proceedings only if the chief administrative judge approves and all the requirements are fulfilled (the Patent Act Article 131-2(2)).

(2) Assisting intervention

Any person having an interest in the trial results may intervene (as in assisting intervention) in the trial for invalidation for assisting one of the concerned parties until completion of the proceedings (the Patent Act Article 148(3); the Utility Model Act Article 41; Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Furthermore, to request having an interest on the part of the right holder as a condition for assisting the intervention is appropriate in that it might limit the concerned parties to be associated with the right's outcome, which is a subjective right at the disposal of the right holder.

In the proceedings, determining whether to grant the application of assisting the intervention is decided upon hearing the opinions of the concerned parties.

(Revised June 2019)