

**51-06 P U D T****Restrictions on a Request for a Trial for Invalidation****1. Time Requirements for Submission of a Request for a Trial for Invalidation**

(1) A request for a trial for invalidation can be filed any time after establishing the registration of the right, even after the right has been extinguished (the Patent Act Article 123(1)(3); the Utility Model Act Article 37(1)(3); Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 37(1)(3); the Design Act Article 48(1)(3); the Trademark Act Article 46(1)(3), 68(4)).

(2) Request for a trial for invalidation can be filed even after the right has been extinguished. For instance, when a claim of damage due to actions of infringement of a right is filed after the right is extinguished because of the expiration of its duration, the counterparty can still request for a trial to invalidate the said right.

(3) However, a request for a trial for invalidation may be dismissed for a right that had expired 20 or more years ago, when any right to seek claims of damage and to file any complaint has extinguished, or when no case for trial is pending, based on the reason that the request for the trial does not provide any benefit (Regulations under the Patent Registration Order, Article 5; Regulations under the Utility Model Registration Order, Article 3(2); Regulations under the Design Registration Order, Article 6(2); Regulations under the Trademark Registration Order, Article 17(2) →51-19 6.(4)).

(4) With regard to trademark rights, any request for a trial for invalidation for the reasons of the Trademark Act Article 3 or part of the Trademark Act Article 4 cannot be filed after five years from the date on which the registration of the trademark was established (the Trademark Act Article 47(1)). However, no statute of limitation is applied to “the case where a trademark is registered for the purpose of unfair competition or misconduct” according to the Trademark Act Article 4(1)(x), (xvii), 4(1)(xv). Additionally, the statute of limitation is not applied to any request for a trial

for invalidation of any unregistered trademark on the reason of late-coming as a reason for invalidation, as per the Trademark Act Article 46(1)(v).

## 2. Request for a Trial for Invalidation to the Right that is Invalidated Against the Late-Coming Reason or Abandoned

When a trademark is invalidated on the reason of late-coming (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v)), any request for a trial for invalidation can be filed for the right for the period before the said invalidation.

When the right is abandoned, a request of a trial for invalidation can be filed for invalidation of the right before the right's abandonment.

(Judicial Precedent)

During a pending trial for invalidation of a patent relating to two or more inventions described in the scope of claims, one invention is abandoned. In such case, the trial decision determined without the proceedings for the concerning abandoned invention is illegitimate (Tokyo High Court Judgment (April 26, 1978) (1977(Gyo-ke) case No. 161)).

## 3. Restrictions on Requests

After a trial decision to maintain the right has become final and binding, any other request for a trial may be restricted because of the application of the principle of prohibition against double jeopardy (the Patent Act Article 167; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4) → 30-02, 51-00 2.(7) C, 51-19 5.(3)).

## 4. Preliminary Registration

When the date of a request for a trial for invalidation stated in the patent registry as a preliminary registration is not coincident with the date of the request for the trial for invalidation recognized by an examiner, this situation will be notified to the trial clerk

after the trial decision. (→ 51-19 6.)

(Revised June 2019)