

**51-09 P U D T****Formalities of Proceedings of a Trial for Invalidation****1. Appointment of a Panel for a Trial**

In a trial for invalidation, a panel of three or five administrative judges appointed by Commissioner of the Patent Office conducts the proceedings. In principle, two or more cases of a trial for invalidation over the same rights are undertaken by the same panel. (Participation in preliminary trials→ (12-04))

**2. Progress of Proceedings of a Case of a Trial for Invalidation**

Any established registration of rights (e.g., patent rights) might sometimes be involved in a multiple pending cases simultaneously. Therefore, for proceedings of a trial for invalidation case, which proceedings should be undertaken with higher priority must necessarily be chosen carefully in the progress of proceedings.

Any trial procedures may be suspended until another a trial decision has become final and binding, or the court procedures have been concluded (the Patent Act Article 168(1); the Utility Model Act Article 40(1); the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(For reference)

Order of proceedings when a trial for correction is pending (→ 51-22)

Proceedings when two or more trials for invalidation of the same right have been simultaneously pending (→ 51-22.1)

Both an opposition to grant of patent and a trial for invalidation over the same right are simultaneously pending (→ 67-09)

Starting and ending of the procedures (→ 26-01 6.)

**3. Formalities of Proceedings****(1) Oral proceedings**

A trial for invalidation is conducted by oral proceedings (→ 33-00). However, the chief trial examiner may change the oral proceedings to documentary proceedings upon a request from concerned parties, intervenors, or ex officio (the Patent Act Article 145(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Nevertheless, after changing the oral proceedings to documentary proceedings, changing it back to oral proceedings is possible. In such a case, a notice of oral proceedings is issued.

Since a trial for invalidation takes the adversary system, oral proceedings facilitate factual findings accurately so that points of dispute between the concerned parties can be organized properly, thereby allowing for fast and precise proceedings.

## (2) Documentary proceedings

A. A trial for invalidation is basically conducted through oral proceedings, but in the following exceptional cases, documentary proceedings may be allowed. (→ 33-00.1)

- If a request for a trial or its procedures (a written request for trial) should be dismissed.
- If concerned parties evidently have no intention of arguing with each other.
- All the concerned parties (including intervenors) are requesting the documentary proceedings.
- Any other cases wherein oral proceedings will not be required.

## B. Notice of the documentary proceedings

When the proceedings are conducted by documents, a notice of documentary proceedings must be issued. However, a notice of documentary proceedings is not necessary for the case of a dismissal of a written request for a trial by a decision of a chief administrative judge, or a dismissal of a request for a trial by a trial decision without giving a demandee an opportunity to submit a written reply.(→ 32-01)

## 4. Ex officio Proceedings (→36-01, 51-18, 51-14 2.)

The principle of ex officio is adopted in any trial because a trial serves not only to

benefit the concerned parties but also to solve problems of broader perspectives wherein interests of any third parties might be involved. Therefore, if the purport of a request that a demandant does not request cannot be subject to proceedings (the Patent Act Article 153(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). However, investigating the facts and examining evidences, or preserving evidences ex officio is possible without being based on or bound by the concerned parties' arguments and, if necessary, the procedures may be suspend (the Patent Act Article 168(1); the Utility Model Act Article 40(1); the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)) or resumed ex officio even after notifying termination of the proceedings (the Patent Act Article 156(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

However, if the concerned parties are mutually confrontational, it is considered appropriate that the proceedings shall be conducted depending on the demandant's assertions and proof. Therefore, proceedings ex officio as a panel are rather exceptional and, to a certain degree, should be interpreted as supplementing the proceedings. (→ 51-18)

## 5. Consolidated Proceedings

(1) General matters of consolidated proceedings (→ 80-03 1.)

(2) Consolidated proceedings in a trial for invalidation

If, in two or more trials for invalidation, both the concerned parties or even one of them is the same (in such a case, rights are not required to be identical), consolidated proceedings of those different trials may avoid overlapping of the proceedings, facilitate procedures efficiently, and prevent trial decisions from contradicting or conflicting with each other (the Patent Act Article 154(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(3) Cases suitable for consolidated proceedings

Examples of cases suitable for consolidated proceedings are as follows:

- A. Any case wherein similar examination of evidence are undertaken, for instance, examination of the same witnesses
- B. Any case having inventions subject to a common technical basis
- C. Any case having the same evidence (documents as the means of proof, object to be inspected, etc.)
- D. Any case over the same rights

However, even when a case falls under one of the above, there might be two or more trials for invalidation requested for the same patent, but on occasions, corrections requested in only one of those trial cases, or different corrections are requested for each case from multiple cases. In that context, a consolidation of the trials may pose an obstacle to proceedings of multiple cases. Thus, it would be appropriate to consider not consolidating the proceedings and rather prioritizing one case for proceedings and suspending the remaining cases. (→ 51-22.1; co-pending of multiple trials for invalidation)

#### (4) Consolidated proceedings in a trial for invalidation of the registration of a utility model

When trials for invalidation over the same utility model registration are co-pending, those cases, in principle, should not be consolidated. Instead, proceedings of individual cases should be undertaken in the chronological order of each request. Proceedings may be consolidated only when it is determined that the consolidated proceedings would handle the case faster and more precisely (e.g., when evidences are in common (the Utility Model Act Article 41; the Patent Act Article 154(1))).

(Explanation) Correction of the utility model registration is a different procedure from a trial for invalidation of the registration of a utility model. Correction of the said registration comes into effect upon the receipt of the documents of correction (the Utility Model Act Article 14-2(3)). Thus, no confusion may exist in the procedures, as seen in the patent for which different corrections corresponding to different trials for invalidation are requested.

Accordingly, a consolidated proceedings may not be necessary in registrations of

utility models, except in a situation of having evidences in common, so that the consolidated proceedings produce faster and more precise proceedings.

(5) Time to consolidate proceedings

The time to consolidate proceedings is before conclusion of proceedings.

(6) Effects of consolidation

A. A trial decision of consolidated cases can be made in one document of a trial decision. However, said document of the trial decision must describe each conclusion and reason by each case of the consolidated cases, as results of the consolidated proceedings.

B. For multiple cases whose proceedings are consolidated, any commonly necessary examination of evidence can be done at one time.

C. The documents and other articles submitted or presented in each case of trials before consolidation and, the means of proof, etc. obtained as a result of the proceedings of each case of trials can be used for the proceedings of each case of trials whose proceedings are consolidated. However, when adopting the means of proof submitted in one case for another case, the concerned parties of another case must be provided with an opportunity for a motion to express their opinions.

(7) To consolidate proceedings

A. To determine whether the proceedings should be consolidated, a panel investigates whether multiple trials for invalidation fulfill the requirements for consolidated proceedings while examining from the view point such as efficiency of the procedures without duplication of the proceedings, or prevention of contradiction and conflict with other trial decisions.

B. If the panel decides to consolidate the proceedings, the chief administrative judge notifies both the concerned parties of the decision to consolidate the proceedings.

C. In multiple trials consolidated for the proceedings, all the procedures and proceedings, including sending duplicates of the documents of counterstatement and related documents to the concerned parties, notices, collegial examinations, oral proceedings (including oral examinations and interviews), examinations of evidences,

and an advance notice of trial decision will be conducted under the same procedures.

In such a case, all the descriptions of the cases of trials to be examined by consolidated proceedings, such as a trial number, a patent number, and names of the concerned parties, must be stated in the spaces in notices and in any other documents .

D. When all trials of the consolidated proceedings are examined sufficiently to make a trial decision, an advance notice of trial decision may be issued, or proceedings may be terminated.

(8) Trial decision of consolidated proceedings

See notes for the trial decision after the proceedings are consolidated (→ 45-03 2.).

(9) Separation of proceedings (30-03 2.)

After consolidation, the consolidated proceedings may still be separated (the Patent Act Article 154(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). The proceedings may be separated ex officio at the panel's discretion. A situation where consolidated proceedings need separation is, for example, when the cases consolidated for proceedings are found to include mutually irrelevant cases for which trials do not have to be implemented under the same procedures, or when a situation might be that the proceedings could be more complicated or delayed unless the proceedings are separated.

(Revised June 2019)