

## 51-13 PUDT

### Proceedings Following the First Answer

#### 1. Proceedings Following a Demandee's First Answer

##### (1) Proceedings of formalities

A chief administrative judge and a panel examine the formalities of a written answer and a written request for correction filed by a demandee when the first answer is made, and give an order for amendment when any deficiency is found (→ 21-00, 51-08) (Proceedings Following the Submission of a Written Request for Correction → 51-14).

##### (2) Basis of proceedings of merits

When no formal deficiency is found in a written answer or a written request for correction, or when a formal deficiency is corrected, the proceedings are conducted on the basis of reasons for invalidation asserted and proved in a written request for a trial, and a written answer, a written request for correction, a corrected specification, and corrected claims or drawings filed by a demandee.

##### (3) Procedure following the first answer

In general, upon a demandee's submission of a written answer, since both the demandant's assertion and the demandee's argument are filed for the present, the point at issue have been made clear.

This is followed by oral proceedings in a trial for invalidation. (→ 33-00)

In the oral proceedings, procedures to clarify the facts that are necessary to determine a case are conducted before the oral proceedings. These procedures include clarifying what is the issue by presenting a panel's conviction, where necessary; notifying the concerned parties of a notice of proceeding matters itemizing subjects examined in the oral proceedings (→ 33-08); and having the parties submit their arguments as an oral proceedings statement brief regarding the subjects listed in the said notice to clarify the facts and findings necessary to determine the case in the oral proceedings. Thus, usually, when arranging a date for the oral proceedings, a notice of

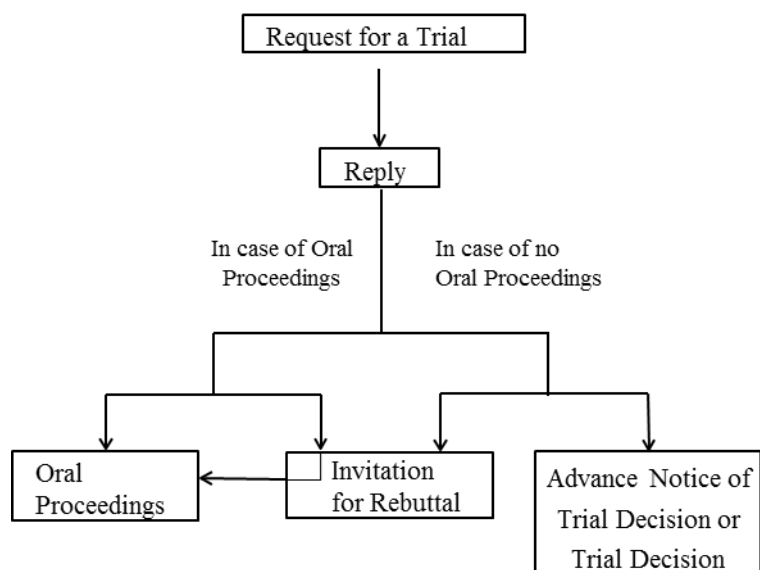
proceeding matters without the date is sent to both parties by facsimile and a duplicate of the written answer, etc. is served on a demandant. After a date for the oral proceedings is fixed, a notice of proceeding matters with the date is sent to the both parties (→ 33-08).

Under special circumstances, such as when seeking an opinion from a demandant prior to the oral proceedings is necessary, a duplicate of the written answer may be served on a demandant before arranging a date for the oral proceedings to give the demandant an opportunity to submit an argument within a specified period of time.

In exceptional cases wherein documentary proceedings are to be conducted in lieu of oral proceedings, a notice of documentary proceedings is made. Subsequently, a judgment is made as to whether the time is ripe for making a trial decision and, when it is decided that the time is ripe, either an advance notice of trial decision (patent) is made, or the proceedings are concluded to make the trial decision.

When giving the advance notice of trial decision or giving a notice of the conclusion of the proceedings, a duplicate of the written answer is served on the demandant by the time of such service.

When the proceedings are deemed not yet ready for a trial decision; for example, when providing a demandant an opportunity to reply to the demandee's refutation is deemed necessary, a duplicate of the written answer is served on the demandant (the Patent Act Article 134(3); the Utility Model Act Article 39(3); the Design Act Article 52; the Trademark Act Article 56(1)), to provide an opportunity to rebut (Enforcement Regulations of the Patent Act 47-3(1); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)).



#### (4) Connections with other cases

When a written answer's content includes content that is inconsistent with the assertions made in other cases (trial for invalidation, opposition to grant of patent, infringement, etc.) concerning the same patent right and when the assertions concerning the inconsistent matters may be treated as file-wrapper estoppel, it is possible that such assertions may not be used.

(Judicial precedent)

“A patentee is not permitted to be inconsistent with assertions made in a written request for the trial decision, a written response to opposition to a grant of patent, and a written supplementary argument of reasons against a request for the trial for patent invalidation.” (the Tokyo District Court, March 25, 1970 (1964 (Wa) No. 3746) Hanrei Times, No. 247, p. 263)

(Revised June 2019)