

51-18 P U D T

Ex-Officio Proceedings in a Trial for Invalidation and Notice of reasons for Invalidation

1. Notice of Reasons for Invalidation (the Patent Act Article 153; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56)

In a trial, because the proceedings may include reasons that were not requested by the parties or intervenors (for example, different provisions), in the case of a trial for invalidation, detecting ex-officio a reason for invalidation that the demandant has not asserted is also possible. However, because the purport of the request that is not claimed by the demandant cannot be examined, as for the claims, designated goods and services for which no trial for invalidation has been requested, reasons for the invalidation of those cannot be conducted ex-officio detection.

If reasons that parties or intervenors did not request are examined, the chief administrative judge must notify the demandee (right holder) of the proceedings' result as the reason for invalidation, the demandant and intervenors as the result of ex-officio proceedings and give an opportunity to file opinions, with a reasonable period of time specified. Correspondingly, both parties and intervenors may state opinions on the notified reason for invalidation.

In a patent trial for invalidation, the demandee may also request a correction within the period specified in the notice of reasons for invalidation (normally 30 days (50 days for overseas residents) → 25-01.2) (the Patent Act Article 134-2(1)).

2. Basic Concepts of Invocation of Ex-officio Proceedings

It is not the panel's duty but its discretion to invoke ex-officio proceedings. Thus, conducting ex-officio proceedings is not mandatory. The panel shall decide whether to invoke the authority of the ex-officio proceedings by comprehensively considering the incident's influence on public interest, the possibility of delay in proceedings due to

the ex-officio detection, the possibility of finding the truth resulting from the said ex-officio detection, etc., as well as in response to the case.

Basically, because the system of a trial for invalidation is an adversarial system, the actions of proceedings on the basis of the demandant's proof of claim and of limiting the ex-officio proceedings to the extent of complementing the proceedings are considered appropriate.

Therefore, in principle, the ex-officio proceedings' discretion concerning the existence or nonexistence of the reason for invalidation is invoked on the basis of the following examples.

A. If an appropriate reason for invalidation is found not to be constructed on the basis of the facts and evidence asserted by the demandant of the trial for invalidation, but when an appropriate reason for invalidation can be configured by correcting the combination of multiple evidences filed in the trial for invalidation case or by complementing the well-known fact, and it is recognized as contributing to appropriate proceedings.

B. When a more appropriate reason for invalidation can be constructed by considering together the facts or evidence indicated in other cases (other trials for invalidation, infringement suit, etc.) for the right, and it is recognized as necessity to avoid conflict with other case's conclusion.

C. If the reason for request filed by the demandant does not constitute an appropriate invalidity reason, when information submitted on the basis of the information provision system (→ 10-04) after the grant, which the demandant did not incorporate in the reason for request, constitutes an obviously appropriate reason for invalidation, and is failure to be adopted as a subject to ex-officio proceedings, the case runs counter to the public interest.

D. If the demandant's requested reason does not constitute an appropriate invalidity reason, but it is highly likely there is a prior art constituting other appropriate reasons for invalidity, thus detecting it by the prior art ex-officio is relatively easy, and failure

to address such as case runs counter to the public interest.

3. Ex-officio Adoption of Disapproved Amendment for Reason for Request

An amendment to change the gist of the reasons for the request for trial for invalidation which was decided to be disapproved, (the Patent Act Article 131-2(2)), is adopted for the reason for invalidation of ex-officio proceedings as the “reason for not making a (lawfully) complaint,” this adoption should be deemed as complementary. Therefore, it is appropriate to carefully decide to adopt the amendment as a subject to ex-officio proceedings by considering the demandant’s previous responses in the case (whether the demandant had sufficiently described the reason for the request from the beginning of the trial request, whether a timely and appropriate attack was taken in the subsequent proceedings, etc.)

(1) Points to note by types of amendment decided on disapproval

A. Violation of the requirements regarding a delay in the proceedings

Adopting afterward the reason for request relating to a disapproved amendment owing to the possibility to unduly delay the proceedings as the reason for invalidation of ex-officio detection may not be deemed to be a reason for invalidation of ex-officio proceedings because of its inconsistency. Exceptions are such cases as when there is a particular change of circumstances or when it is recognized that the ex-officio proceedings should be quicker.

B. Violation of the requirements caused by correction and the requirements of rational reasons for failure of initial descriptions

When an amendment did not become necessary due to the request for correction and relates to the reasons for a request having no rational reasons of the failure to describe the reasons initially, it is a typical example of an amendment that should not permit a change of the gist. Thus, it is not a reason for the invalidation of the ex-officio proceedings, except the case where a failure to make a trial decision to invalidate the patent by adopting the amendment ex officio is unacceptable to the public interest.

C. Violation of only the requirements of the demandee’s consent

If there is no risk of any delay in proceedings, and there is a rational reason for failure to state the reason for request in the original request, and in the case where the amendment of the reason for request was disapproved only because the demandee did not consent, the panel should not be prevented from invoking authority for the sake of the public interest even if the demandee, a private person disagrees with such an amendment. Therefore, as in the aforementioned case of 2. C, the reason for the request obviously constitutes an appropriate reason for invalidation, and the failure to make the reason a subject to the ex-officio proceedings is unacceptable to the public interest, the case can be adopted as a reason for invalidation for the ex-officio detection.

(2) Use of written amendments in the notice of reasons for invalidation

When adopting the reason for request concerning the amendment that has been disapproved as the reason for invalidating the ex-officio detection, it is possible to use the descriptions of the written amendment, written rebuttal, etc. that describes the amendment matters. In this way, a notice of the reason for invalidation for the demandant's intention can be easily transmitted to the demandant.

4. Handling of a Report of Utility Model Technical Opinion in a Trial for Invalidation of a Utility Model Registration

In a trial for invalidation of a utility model registration, when a demandant does not refer to the prior art documents described in a report of the technical opinion of the utility model, if necessary, the prior art documents are subject to ex-officio proceedings.

Additionally, because the trial decision is made on the basis of the panel's independent judgment in consideration of the parties' requests, the report shall not affect the conclusion of the trial decision.

(Revised June 2019)