

51-21 P U D T

Procedures After a Trial Decision on a Trial for Invalidation is Rendered

1. Filing a Revocation Action Against a Trial Decision

A person who is dissatisfied with a trial decision of a trial for invalidation may file a revocation action against the trial decision to seek the cancelation of the trial decision (the Patent Act Article 178(2); the Utility Model Act Article 47(1); the Design Act Article 59(1); the Trademark Act Article 63(1)).

(1) Party for a revocation action

A party in a trial for invalidation case (demandant or demandee), an intervenor, or a person who has been refused an application for intervention in said trial may bring a lawsuit.

A counterparty (demandee or demandant) in the trial for invalidation case becomes the defendant. If the defendant does not respond, it is considered to be the constructive admission in the action, and the court may decide to cancel the trial decision.

(2) Prosecution period

The case may be brought an action within 30 days of the service of a certified copy of the trial decision on a trial for invalidation. This period is invariable (the Patent Act Article 178(3); the Utility Model Act Article 47(2); the Design Act Article 59(2); the Trademark Act Article 63(2)).

For a person in a remote or a traffic-inconvenient area, the chief administrative judge may ex officio provides an additional period for extending the invariable time period (15 days for domestic residents and 90 days for overseas residents), and notifies by service of the trial decision. (→ 25-04 4.)

(3) Jurisdiction

The case against the trial decision on a trial for invalidation is in jurisdiction of the Tokyo High Court, and handled by the Intellectual Property High Court a special branch

of the Tokyo High Court (the Patent Act Article 178(1); the Utility Model Act Article 47(1); the Design Act Article 59(1); the Trademark Act Article 63(1); the Intellectual Property High Court Establishment Act Article 2).

2. A Court Decision on a Revocation Action Against a Trial Decision and Proceedings After Re-Pending of a Trial for Invalidation

(1) When the court decision to maintain the trial decision (i.e., claim rejection decision) is finalized

When the court acknowledges the request as unreasonable (i.e., no illegality exists in the trial decision on the trial for invalidation) and the court dismisses the request, because the trial decision will be decided when the court decision is finalized, no subsequent proceedings will be conducted on the trial.

(2) When the court decision to cancel the trial decision (i.e., claim upholding judgment) is finalized

If the court acknowledges the request as reasonable (i.e., the trial decision of the trial for invalidation is illegal), a court decision is made to admit the request and cancel the trial decision (the Patent Act Article 181(1); the Utility Model Act Article 47(2); the Design Act Article 59(2); the Trademark Act Article 63(2)). When the court decision to cancel the trial decision is made, because an administrative sanction (i.e., a trial decision) for the trial for invalidation still remains not to be disposed, the case of the trial for invalidation is pending at the Patent Office again, and the panel examines the case further. (the Patent Act Article 181(2); the Utility Model Act Article 47(2); the Design Art Article 59(2); the Trademark Act Article 63(2))

Because the final court decision is legally binding the Patent Office for the case (Administrative Procedure Act Article 33(1)), the panel again makes a trial decision according to the conclusion (principal sentence) in the final court decision and the matters described in the court decision as finding of facts and judicial judgment necessary for deriving said conclusion . However, making a trial decision according to the same conclusion based on another reason cannot be avoided.

(3) Proceedings after re-pending

The trial decision is an administrative disposition divisible by each claim (designated goods or services), and a court decision is finalized correspondingly. Depending on the court decision on which the conclusion of the trial decision to be canceled has been made and which part of the decision on rescission of the trial decision has been finalized, the proceedings are proceeded as follows. After re-pending, oral proceedings are only conducted when necessary.

A. Procedures before the proceedings begin after re-pending (patent)

(A) When a court decision is finalized to cancel the trial decision to maintain the right

If the court decision to cancel the trial decision to maintain the right is finalized and the trial for invalidation is re-pending at the Patent Office, within a week from the date on which the decision is finalized, the demandee (i.e., the patentee) may petition for a designated period for filing a request for correction (the Patent Act Article 134-3; Enforcement Regulations under the Patent Act Article 47-6, Form 63-6).

When the request has been filed, the chief administrative judge may provide a designated period (normally 10 days (10 for overseas residents) → 25-01.2) to the demandee for requesting a correction (the Patent Act Article 134-3). The chief trial examiner has the discretion of whether to provide the designated period. However, given that no opportunity is given for correction after the trial decision is rendered, an opportunity for correction before the trial decision should be effectively used for the demandee. Therefore, except when making a trial decision to maintain the right without making a correction (e.g., when the reason for canceling the trial decision to maintain the right is simply a procedure breach, etc., it is possible to make a trial decision to hold the right again after removing the said breach in the trial for invalidation of re-pending, etc.), the allowance of a petition and provision of a designated period are to be stated in a notice of resumption of the proceedings.

When the panel deems it particularly important to prompt the submission of an answer, a notification notifying a designated period for the request for correction shall include a statement to the effect that filing an answer is encouraged.

(B) When a court decision to rescind a trial decision is finalized for some of the claims in the group of claims

When a request is filed against some claims of the “group of claims” and the court decision to cancel the trial decision is made, the trial decision on the remaining claims remains undecided. A group of claims is dealt with in an integrated manner, but in this situation, examining on a consolidated basis for all the parts wherein the trial decision is left undecided is not possible. Therefore, to resume the proceedings, the administrative judge must cancel the trial decision on other claims in the group (the Patent Act Article 181(2)). In this case, in the notice of resumption of the proceedings, etc., the portion canceling the trial decision is described.

B. Procedures until the time is ripe to make the trial decision

(A) When a court decision is finalized to cancel a trial decision to maintain the right

Because the panel is bound by the court decision of rescission (e.g., the reason which determines that the trial decision does not constitute the reason for invalidation), when a court decision shows the judgment to the effect that the judgment in the trial decision is an error, a judgment shows that the trial decision was an error, usually a trial decision is made to invalidate the right. However, for a patent, if a request for correction is submitted within the aforementioned designated period in A (A), whether the correction has eliminated the reason for the invalidation is examined.

If, as a result of the proceedings, the panel finds out that the correction has not eliminated the reason for invalidation, giving the demandant an opportunity to refute is not required, and it can be judged that the time is ripe for making a trial decision. See the following section C for the subsequent procedures.

On the contrary, if the correction is found to satisfy the correction requirements and if the reason for the invalidation has been resolved, the correction request and the corrected specification, etc. are served to the demandant to provide an opportunity for argument.

When the demandee does not petition under the Patent Act Article 134-3, or, in the patent, if no correction request has been submitted within the aforementioned

designated period in A (A), it can be judged that the time is ripe for making the trial decision.

(B) When a court decision is finalized to cancel the trial decision to invalidate the right

At this time, because the panel is bound by the court decision and usually makes the trial decision to maintain the rights, there is no need for the demandee to have the opportunity to submit corrections (patents) or answers nor for the demandant to have the opportunity to submit a written refutation.

Although such cases are exceptional, but based on the previous court decisions, when the panel decides that another reason for invalidation judged not to hold in the previous trial decision does hold, etc., it is possible to make the trial decision to invalidate the right again for another reason so long as it does not fall within the range of the binding power of the court decision. When the panel considers appropriate to have the demandant claim and prove other reasons for invalidation than the reasons adopted in the original trial decision, the demandant might be provided the opportunity to refute. However, this shall remain limited to cases wherein the original trial finds that the claim and proof have not been exhausted. Additionally, because sufficient time has already passed since the court decision was rendered, the response period of an invitation of refutation can be short. (→25-01.2)

C. Procedures after the time is ripe to make the trial decision (patent)

In principle, when it is appropriate for the first time to make the trial decision after re-pending, an advance notice of the trial decision is sent (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(ii)). At this time, whether to send the advance notice of the trial decision or to make the trial decision is regarded the same as the case where the time is ripe to make the trial decision for the first time after starting the proceedings. (→51-17 3.)

(Revised June 2019)