

**51-22.2 P U D T****Trial for Invalidation Requested  
During a Revocation Action Against a Trial Decision Is Pending****1. Proceedings of a Trial for Invalidation Requested during a Revocation Action Against a Trial Decision Is Pending**

(1) When a revocation action against a trial decision is filed for a trial decision to invalidate a right

In principle, the proceedings of the newly filed trial for invalidation are suspended until the court decision is finalized in the litigation for rescission, and a notice of suspension under 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)) is issued.

As a result, in the patent, any complication in the case that a new request for correction is submitted in subsequent proceedings, the correction is finalized first in the subsequent proceedings so that the preferentially examined proceedings are considered as wasted, or the judgments between the court and the Patent Office might be inconsistent, may be avoided. Once the trial decision to invalidate is finalized, proceedings on merits of the new trial for invalidation are not necessary.

If a party submits a written request for canceling the suspension, only when it can be immediately judged that maintaining the rights can be concluded even in consideration of all the previous cases and the reasons and evidence presented in the case (a correction request (draft) has been submitted) or only when it is deemed useful for prompt resolution of the dispute, the suspension shall be canceled.

(2) When a revocation action against a trial decision is filed for a trial decision to maintain a right

In principle, the proceedings of a newly filed trial for invalidation shall be started promptly to examine whether the newly presented reasons, evidence, etc., are to overturn the previous trial decision to maintain the right.

## 2. Specific Handling

(1) When a revocation action against a trial decision is filed for a trial decision to invalidate a right

A. When a document arrives at the panel after a new trial for invalidation has been requested, in principle, a duplicate of the written request is promptly served and the suspension is notified.

Specifically in this case,

(A) The text of “Notice of the service of a duplicate of the request” states that “the duplicate of the request for the trial submitted by the demandant is to be served. As for submission of an answer statement, the procedure of the trial for invalidation is to be suspended, so the opportunity is to be given again when canceling the suspension.”

(B) Draft “Notice of suspension” and decide on the same date as the aforementioned “Notice of the service of a duplicate of the request for trial.”

B. In exceptional cases, in comparison with a trial decision of invalidation in a preceding case, when it is appropriate to look at the demandee’s opinion or at the content of the correction request and decide whether to suspend; for example, when the evidence pertaining to the case of the subsequent proceedings is stronger, a duplicate of the request is immediately served and then review the contents of the submitted response or correction request and decide whether to notify of the suspension. The notice of the suspension is conducted in the stage that the answer submission period has passed. (Note)

(Note) If the proceedings are suspended after the service of the duplicate and before the expiry of the period for presenting the reply, the whole answer period will be provided again after the suspension is canceled. Thereby, it is impossible to immediately begin after the cancelation because of giving another whole answer period after canceling the suspension (the Patent Act Article 24→the Civil Procedure Law 132(2)).

Therefore, after the service of the duplicate, a notice of suspension must be given at

the stage that the answer submission period has been expired.

(2) When a revocation action against a trial decision is filed for a trial decision to maintain a right

A duplicate of the written request for the new trial for invalidation is promptly served to provide an opportunity to submit an answer or a request correction, and begin the proceedings. (Note)

In the patent, if the patentee requests a correction that is different from the correction request accepted in the case preceded, proceedings are to be advanced on the basis of the correction. However, it is to be noted that the criteria of correction for the specification in the subsequent trial for invalidation must be changed when the correction of the precedent case is firstly fixed, and the trial decision to maintain the right of the preceding case is to be canceled almost automatically when the correction in the subsequent trial for invalidation is permitted and is firstly decided.

(Note) In the patent, when the reasons, evidence, etc. presented in the new trial for invalidation do not strongly deny the patentability compared to the reasons, evidence, etc. in the preceding case, and even considering these, it is considered that the conclusion to maintain the right can be obtained for the claims in the previous case, , a trial decision to maintain the right is made (usually), after giving the same opportunity for the correction request as in the one accepted in the previous case (but not yet fixed).

(Revision June 2019)