

## 51- 23.1 P U

### Table Comparing a Trial for Patent Invalidation and Utility Model Registration

	<b>Trial for Patent Invalidation</b>	<b>Trial for Invalidation of the Utility Model Registration</b>
Opportunity to answer or to submit an opinion	<p>If a duplicate of a request for trial is served, an opportunity to answer is provided (the Patent Act Article 134(1)).</p> <p>An opportunity to give an opinion is provided when new reasons for invalidation and evidence are submitted by the ex officio proceedings (the Patent Act Article 153).</p>	Same as on the left (the Utility Model Act Article 39(1); the Utility Model Act Article 41 → the Patent Act Article 153)
Opportunity to refute against the answer	The demandant is given an opportunity to refute as necessary.	Same as on the left
Time period for the submission of an answer, a refutation, and a written opinion	<p>The standard designated period based on the type and nature of procedures (the Patent Act Article 134(1)).</p> <p>For example, the judicial period for submitting an answer for the first legal procedure is 60 days for residents in Japan and 90</p>	<p>Same as on the left (the Utility Model Act Article 39(1)).</p> <p>For example, the judicial period for submitting an answer of the first legal procedure is 30 days for residents in Japan and 60 days for overseas residents.</p>

	days for overseas residents.	
Multiple requests	If multiple requests are made, they can be consolidated for examination as necessary (the Patent Act Article 154).	In principle, proceedings are conducted in the order of requests, but consolidated proceedings occur only when it is judged that they can be processed promptly and accurately owing to common evidence, etc. (the Utility Model Act Article 41 → the Patent Act Article 154; “Manual for Trial and Appeal Proceedings” 51-9 5.(4)).
Conditions for withdrawal of requests	Necessary for counter party’s consent after submitting an answer (the Patent Act Article 155).	Same as on the left (the Utility Model Act Article 39-2(2)) However, if there is a patent application based on the registration of the utility model (the Patent Act Article 46-2), withdrawal of the request for trial within 30 days from the date on which the notice was received to that effect may be made without the consent of the counterparty even after submitting an answer (the Utility Model Act Article

		39-2(3)).
Effect of withdrawal of request	If the request is withdrawn, the procedure is terminated, ex officio continuation is not possible. However, if there is an intervenor, continuation is possible (the Patent Act Article 148(1)(2)).	Same as on the left (the Utility Model Act Article 41 → the Patent Act Article 148(1),(2))
Content of a trial decision	In principle, indicating the propriety of correction and the judgment of each claim is necessary (the Patent Act Articles 185, 157).	Same as on the left (the Utility Model Act Article 50-2; the Utility Model Act Article 41 → the Patent Act Article 157).
Destination for petitioning an objection	Tokyo High Court (Intellectual Property High Court) (the Patent Act Article 178)	Same as on the left (the Utility Model Act Article 47).

	Trial for patent invalidation	Trial for invalidation of Utility Model Registration
A person who can appeal	Both parties, intervenors, persons whose application is rejected for participation (the Patent Act Article 178(2))	Same as on the left (the Utility Model Act Article 47(2) → the Patent Act Article 178(2))
Defendant	The other party (the Patent Act Article 179)	Same as on the left (the Utility Model Act Article 47(2) → the Patent Act Article 179)
Proceedings of correction	The request for correction requires proceedings (the Patent Act Article 134-2)	Correction does not require proceedings (the Utility Model Act Article 14-2)
Opportunity for correction	<p>Period for submission of a written answer accompanied with serving of the duplicate of written request(the Patent Act Article 134(1))</p> <p>Period for submission of a written opinion against a notice of reasons for invalidation(the Patent Act Article 153(2))</p> <p>Period for submission of a written answer accompanied with permission of the amendment of the change in the gist(the Patent Act Article 134(2))</p> <p>Designated period when the court decision to cancel the trial</p>	<p>Possible only once within the period for submission of the first written answer (the Utility Act Article 14-2(1))</p> <p>There is no limit on the number of correction to delete the claims(the Utility Model Act Article 14-2(7))</p>

	<p>decision to maintain the right is fixed (the Patent Act Article 134-3)</p> <p>Designated period for the advance notice of trial decision(the Patent Act Article 164-2(2))</p>	
Correctable range	<ul style="list-style-type: none"> <li>• Restriction of the scope of claims</li> <li>• Correction of errors and incorrect translations</li> <li>• Clarification of unclear statement</li> <li>• Cancellation of citation</li> </ul> <p>However, the followings are not permitted:</p> <ul style="list-style-type: none"> <li>• Correction that contents after correction exceed the disclosure at the time of filing an application</li> <li>• Correction that substantially enlarges or changes the scope of claims.</li> </ul> <p>(the Patent Act Article 134-2)</p>	The same correction as the patent is possible (the Utility Model Act Article 14-2(1),(2),(3),(4),(7)).
Allegation for propriety of the correction	The parties may claim whether the correction is appropriate or not in the procedure of a trial for	A correction is allowed without examining the requirements of correction, and it cannot claim about

	invalidation or during litigation rescinding the trial decision	the propriety of correction. However, it is possible to separately request the trial for invalidation for violation of the correction requirements (the Utility Model Act Article 37(1)(vii)).
Effect of correction	The result of the correction made during the procedure is stated in the trial decision, and the retroactive effect of the correction is produced when the trial decision is finalized after the period for appeals to the High Court has passed (the Patent Act Article 134-2(9)→the Patent Act Article 128).	The retroactive effect of the correction takes place when there is the correction (the Utility Model Act Article 14-2(11)).
Suspension of lawsuit	If the court finds it necessary, the court may suspend the lawsuit procedure until the trial decision is finalized (the Patent Act Article 168(2)).	Similar to patent (the Utility Model Act Article 40(2)).

(Revised June 2019)