

51-23.3 U**Proceedings of a Trial for Invalidation of Utility Model Registration
As a Reason for a Patent Application for the Same Invention****1. How to Proceed with the Proceedings**

Proceedings of a trial for invalidation of the registration of a utility model based on the existence of a patent application claiming the same invention filed on the earlier date (the prior application) or filed on the same day (the Utility Model Act Article 7(3)(6)) proceeds without awaiting finalization of the patent application for preventing any delay in the proceedings. A trial decision is made by determining the identity at the time of conclusion of the proceedings.

In a trial for invalidation of the registration of a utility model based on the existence of a patent application of a prior application or that made on the same day (the Utility Model Act Article 7(3)(6)), the demandee is notified by appending the following statement to the answer invitation.

Example: In addition, in the trial for invalidation of the registration of a utility model on the basis of being identical to the invention relating to the prior patent application or that made on the same day, the proceedings proceed without waiting for the finalization of the decision of this patent application, and a trial decision is made by determining the identity at the time of conclusion of the proceedings.

2. Notice to a Patent Applicant Concerning an Application filed on the Same Day

Although a utility model registration and patent application being filed on the same day cannot be discussed under the Utility Model Act (the Utility Model Act, Article 7(6)), having an opportunity for substantial consultation between the utility model right holder and the patent applicant may be useful to avoid reasons for invalidation or refusal and obtain appropriate protection.

To the patent applicant concerning the same-day application, the following notice

regarding the registered utility model concerning the same-day application shall be given, and a substantial consultation shall be suggested, except when the utility model right holder and the patent applicant are the same person.

In other words, even if a duplicate of the request for a trial for invalidation of the registration of a utility model is served and an answer invitation is issued to the demandee, there is no guarantee that the demandee would actually consult with the patent applicant. Thus, the invalidity of another person's utility model registration on the same day may be determined without the patent applicant's knowledge. Consequently, it might happen that the patent applicant cannot avoid the reasons for refusal and the reason for invalidation for the same claim as the invalidated utility model registration. This is an unjust situation for patent applicants. To prepare an environment wherein patent applicants can avoid the reason for refusal by self-effort, the patent applicant at least needs to be notified of the existence of the registration of a utility model concerning the same-day application in such a case.

A. Content of the notice

(A) The fact that a request for trial for invalidation of the registration of a utility model has been made because the concerned invention and device are the same;

(B) The fact that an answer invitation has been issued; and

(C) The fact that in case of a trial for invalidation of registration of a utility model, the proceedings shall proceed without waiting for finalization of the patent application to make a trial decision;

will be notified at the answer invitation.

B. Format of the notice

Use the following administrative procedures to send a notice by using Form 1 as a notice.

Regarding the trial for invalidation of the registration, the chief administrative judge drafts a notice and its certified copy and passes them to the trial clerk when servicing a duplicate of the request and providing an opportunity to submit an answer (at the time of determination of service of the duplicate of the request).

Then, the trial clerk sends a certified copy of the notice to the patent applicant or the agent in a sealed letter, and the notice is filed in a recording file for a trial for invalidation of the case.

3. How to Proceed with the Proceedings after an Answer Is Submitted

If, as a result of the discussion between the two parties, the demandee (the right holder of the utility model) claims in the answer that an amendment of the patent application would eliminate the reason for invalidation, the panel examines the identity between the invention and the device, other reasons for invalidation, content of the answer, etc. When it is deemed necessary, the panel considers the claim of the demandee, in particular:

(1) If an amendment is made to a patent application without requiring a notice of reasons for refusal to amend the patent application (e.g., when the amendment is made before the designated period of the first notice of reasons for refusal), the content of the amendment is confirmed, and the trial for invalidation of the registration of a utility model is examined.

(2) If a notice of reasons for refusal is required to amend a patent application (e.g., when a request for examination has already been filed), the administrative judge contacts the examiner in charge of the patent application. If a notice of the reason for refusal under the Patent Act Article 39 is available for a patent application, the administrative judge requests the applicant be notified as soon as possible. Then, after waiting for an amendment to the notice of reasons for refusal and after confirming the amendment's content, the trial for invalidation of the registration of the utility model is examined.

(3) In the case of (2) above, when the reason for the refusal of the patent application has already been notified and it becomes a decision of refusal, continue the proceedings of the trial for invalidation of the registration of the utility model. If the demandee (the right holder of the utility model) and the patent applicant are the same person, even if the demandee has asserted in the answer that correction of the patent

application eliminates the reason for invalidation, treat the case similarly.

Form 1

Notice	Date
Chief Administrative Judge, Administrative Judge of the Patent Office	
Applicant agent	
Whether you are the patent applicant or its agent	
Patent application No.	
(Reference to a patent gazette of unexamined patent application No. XX)	
You are hereby notified of the following points regarding the following registration of a utility model filed on the same day as the patent application and that was already registered.	
Description	
(1) Trial for invalidation of the registration of a utility model has been requested because the device pertaining to the claim (XX) in the registration is the same as the invention in claim (YY) claimed in the above patent application (Invalidation No. XX).	
(2) Pursuant to the provisions of the Utility Model Act Article 39, paragraph 1, an order of the written answer order was issued to provide the demandee of the trial for invalidation with the opportunity to submit an answer after delivery of a duplicate of the written request for the trial (year date).	
Additionally, trial for invalidation () of utility model registration based on the fact that it is the same as the invention related to the patent application made on the same day proceeds without waiting for the finalization of the assessment of the application.	
Utility Model Registration No. XX	
(Utility model application No. XX)	
Right Holder of the utility model:	
Address (domicile)	
Name (title)	
Administrator of the utility model	
Address (domicile)	
Name (title)	
Please confirm the details of the holder of the utility model right, exclusive licensee, and non-exclusive licensee by the registration registry.	

(Revised June 2019)