

## 51-25 P U D T

### Planned Proceedings

Trials for invalidation are often requested in relation to disputes such as infringement. To ensure the effectiveness of the protection of rights, there is a need to promptly judge the validity of rights. Therefore, Trial and Appeal Department of the Patent Office decides on a plan for the proceedings (planned proceedings) in line with the 2003 law revision: the both parties and panel of a trial for invalidation set up mutual cooperative relationships; the schedule of the proceeding is clarified; and the proceedings of the trial for invalidation cases are systematically advanced according to the schedule.

#### 1. Designation of a Case to Prepare Planned Proceedings

Where forecasting the schedule is difficult due to the complexity of the case as shown below, prepare planned proceedings.

(1) When the reasons for invalidation and the evidence presented by the demandant, or the point of issues between the two parties are expected to be complicated or varied, and understanding and arranging those for the trial take considerable time, therefore forecasting the schedule of proceedings leading up to the final decision is difficult

(2) When there is high probability that the proceedings period will be prolonged because of a related preliminary decision (in simultaneous pending other trial cases or trial cases for canceling trial decision)

(3) When conduct of effective proceedings for a complicated or difficult case can be expected

As a general rule, the chief administrative judge decides the designation of a case for planned proceedings.

These planned proceedings are implemented on the basis of cooperative relationships between the two parties and the chief administrative judge, and it is not unilaterally imposed on both parties. Therefore, even if the planned proceedings are not able to be

abided for any reason, it does not provide any disadvantage of the treatment in the proceedings.

## 2. Form of Planned Proceedings

A form of the planned proceedings includes the following items, the details of which are at the panel's discretion. (Sample of the plan for proceedings: Reference 1 (1))

- (1) Claim and proof to be sought clarification or to be organized
- (2) Issues to be organized (major issues, arrangement of order of consideration of multiple issues and the schedule)
- (3) Special notes (related pending cases, cases of prosecution, etc.)
- (4) Expected pattern of the proceedings (for example, first answer → first refutation → second answer → oral proceedings → trial decision, etc.)
- (5) Estimated period of the proceedings (scheduled dates of the proceedings)

## 3. How to Make Planned Proceedings

The planned proceedings is prepared by the chief administrative judge and sent to the parties. When the parties request adjustment of the schedule for a rational reason, reschedule the plan.

Additionally, the panel may consult a date of oral proceedings or the planned proceedings with parties by telephone or facsimile.

## 4. When to Make Planned Proceedings

The time of making the planned proceedings is as follows.

- (1) In principle, the planned proceedings should be prepared in the early stages of proceedings. In particular,
  - (i) Make a plan at the stage of sending the duplicate of an answer (for a trademark, at the stage of sending the duplicate of a refutation)
  - (ii) When the first oral proceedings are performed early, prepare a plan on the date of the oral proceedings

(2) The planned proceedings may be revised on the date of the subsequent oral proceedings, etc.

#### 5. Schedule for Agreement of the Trial for Invalidation

At or immediately after the oral proceedings, when it is deemed helpful for smooth conduct of the proceedings that a most recent expected notice, etc. of the panel and the response, etc. required for the parties are shown, the chief administrative judge prepares and sends a simple “Schedule for agreement of the trial for invalidation” (Sample: Reference 2) including the subsequent notices, etc. of the panel and the parties’ required responses

This “Schedule for agreement of the trial for invalidation” is prepared not only for complicated trials for invalidation but also for general trials for invalidation as necessary.

(Revised June 2019)

“Planned Proceedings”

Date: April 18, XX

Trial number: Invalidation 20XX-800001

Demandant: Name of demandant

Demandee: Name of demandee

Chief administrative judge: Name of chief administrative judge

Please contact the chief administrative judge if you have any comments or requests regarding this “planned proceedings.”

Phone: 03-3581-1101 ext. XXXX

< Claim and proof to be sought clarification or to be organized >

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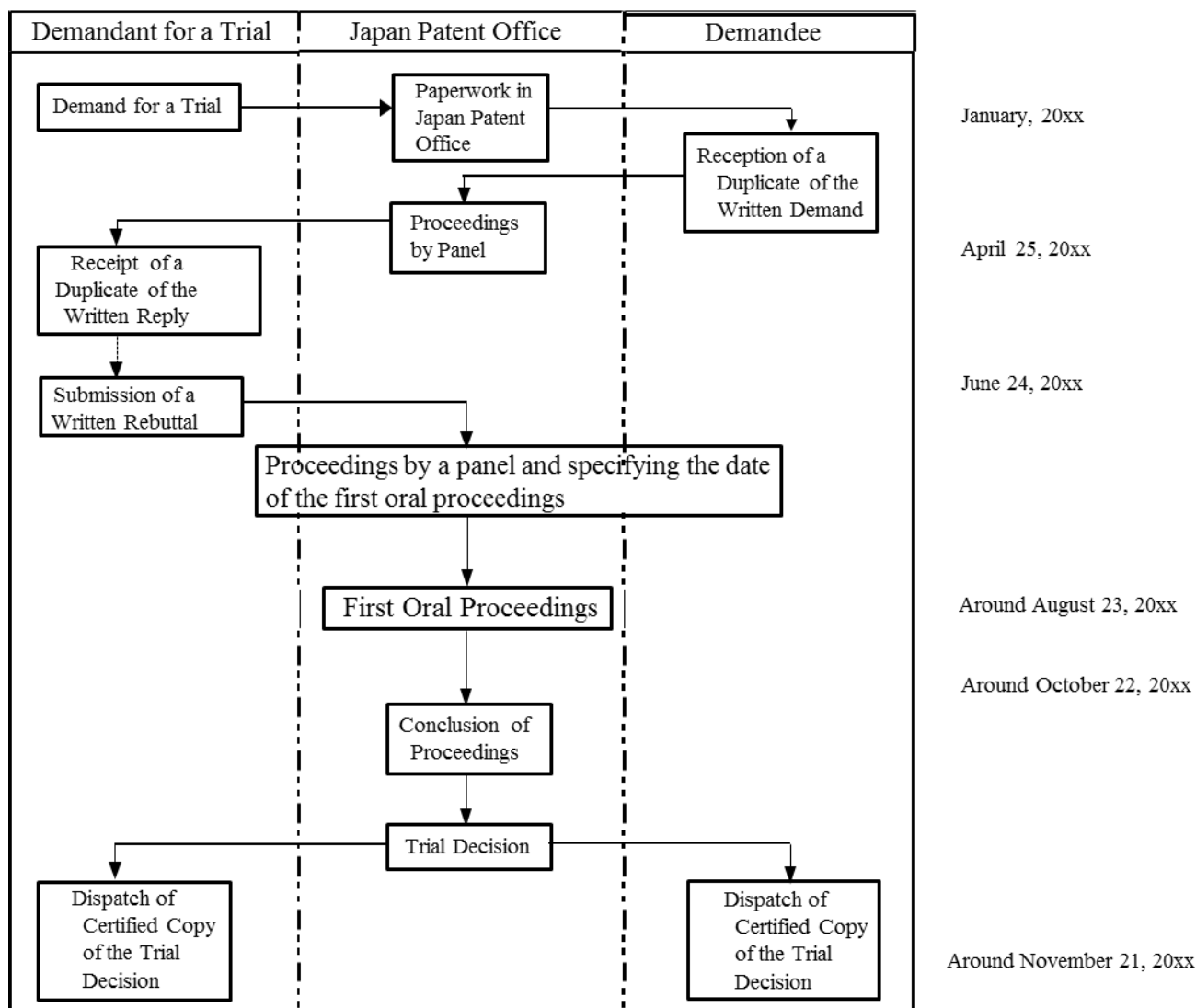
## &lt;Issues to be organized&gt;

1. Regarding interpretation of the word “divided” in claim 1, the demandant (,) and the demandee are in dispute, therefore, before examining the inventive step for the invention described in the demandant’s Exhibits A-1 to A-3 over the claimed invention 1, clarification of the point is necessary.
2. Because the demandee contends for public disclosure of Exhibit A-3, as a premise of the judgment of the inventive step, examining public disclosure of Exhibit A-3 first is necessary.
3. The demandant (,) claims that the description in this specification is for a patent application that does not meet the requirements described in Article 36 (4). In contrast, the demandee has submitted the demandee’s Exhibits B-10 to 25 and asserted that the description has been described to the extent that a person skilled in the art can carry out the invention. Because the relationship between Exhibit Bs is complicated, first, the relationship between Exhibit Bs is organized to examine the appropriateness of the descriptive requirements.

< Remarks (related pending cases, cases of prosecution, etc.) >

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## &lt; Expected Proceedings Pattern and Schedule &gt;



- These proceedings schedule dates and this proceedings pattern serve only as a guide.
- This proceedings schedule can be met when the paperwork has been completed without any delay. If there is a deficiency in the written request, the schedule will suffer a delay. Please be aware of the formal deficiencies and cooperate with us for prompt processing.

Reference 2

“Schedule for Agreement of Trial for Invalidation”

Date: July 15, XX

Trial number: Invalidation 20XX-800001

Demandant: Name of demandant

Demandee: Name of demandee

Chief Administrative Judge: Name of chief administrative judge

Please contact the chief administrative judge if you have any comments or requests regarding this “Schedule for agreement of trial for invalidation.”

Phone: 03-3581-1101 ext. XX



