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(Revised June 2019)

51-00 P U D T**Trial for Invalidation****1. Purport of the System**

If a patent right has any defect, the right holder would receive an unfair, illegitimate privilege, which would not allow any other party to implement or use the invention, causing various harmful barriers in industrial development. In such cases, a patent right needs to be invalidated to prove that such a right did not exist from the beginning or, at least, since the time the right was invalidated for reasons of late-coming invention (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v), etc.). To purposely respond to such a case, the system of a trial for invalidation has been established (the Patent Act Article 123(1); the Utility Model Act Article 37(1); the Design Act Article 48(1); the Trademark Act Article 46(1), 68(4).

2. History of Law Revision

The Patent Act, etc. has been revised in the following ways. In principle, for procedures of a trial for invalidation, the Patent Act valid at the time of the request for a trial for invalidation is applied. Regarding the reasons of invalidation, the Patent Act at the time of filing a patent application is applied.

(1) The 1993 Act on Partial revision of the Patent Act, etc. No. 26 (entered into force on January 1, 1994)

A new system of utility models wherein a right is granted without substantive examination has been introduced. Accordingly, procedures of a trial for invalidation have also been revised. For the utility models, once registered, correction can be made by submission of a written correction without the proceedings on its merits.

For patents (Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 4(2), Supplementary Provisions of the 2011 Act on Partial

Revision of the Patent Act, etc. Articles 19(2)), a new system of a request for correction has been introduced; it allows descriptions or drawings to be corrected during a procedure of a trial for invalidation. Accordingly, any request for a trial for correction is not accepted when a trial for invalidation is pending at the Japan Patent Office.

For patents, a trial for invalidation of correction was repealed. Accordingly, any amendment of adding new matters and any correction of adding new matters should constitute reasons for invalidation (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 37(1)(ii) of (ii)). However, any unlawful correction made by the trial for correction requested prior to December 31, 1993, does not constitute a reason for invalidation but will be contested in a trial for invalidation of the correction (Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 2(5) (the former Patent Act Article 129); Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 4(1), the Utility Model Act Article 40).

(2) The 1994 Act on Partial Revision of the Patent Act, etc. No. 116 (entered into force on January 1, 1996)

For patents, a system of post-grant patent opposition to grant of patent is introduced along with repeal of the system of publication of applications. Thus, the reasons for invalidation in amendments after publication were abolished. The 1994 revision concerning the requirements for patent descriptions and the provisions associated with applications in a foreign language are applied to patent applications filed on or after July 1, 1995 and patents pertaining to those applications (Supplementary Provisions of the 1994 Act on Partial Revision of the Patent Act, etc. Articles 6 and 7).

(3) The 1996 Act on Partial Revision of the Patent Act, etc. No. 68 (entered into force on April 1, 1997)

For trademarks, on the request from the Trademark Law Treaty, a trial for invalidation of renewal registration was repealed. Consequently, reasons for non-registration due to late-coming public interest, as in No. 5, are added in the reasons for invalidation of the Trademark Act Article 46(1).

(4) The 1998 Act on Partial Revision of the Patent Act, etc. No. 51 (entered into force on January 1, 1999)

Any amendment to change the gist of the reasons for the request for a trial for invalidation is not permissible in patents, former utility models, designs, and trademarks.

(5) The 2003 Act on Partial Revision of the Patent Act, etc. No. 47 (entered into force on January 1, 2004)

For patents, the system of post-grant patent opposition to grant of patent was repealed and incorporated into the system of a trial for invalidation, thereby allowing anyone to request a trial for invalidation. Additionally, the description requirements in reasons for the request for a trial shall be clarified and changes to the reasons initially stated in a request for a trial as a new means of attack are allowed as an exceptional case. Furthermore, when a trial for correction is requested after a revocation action against a trial decision for invalidation is filed, a new provision is established to allow the trial decision to be cancelled and to be returned to the Japan Patent Office by the court's decision. Accordingly, "the request for a trial for correction" is incorporated into the returned case of a trial for invalidation as a "request for correction".

(6) The 2004 Act on Partial Revision of the Patent Act, etc. No. 79 (entered into force on April 1, 2005)

For utility models, if a trial for invalidation is pending, correction for the purpose of restriction of the scope of claims of utility model registration is permissible only once during the period of submission of an initial written answer. Any correction that fails to fulfill the requirements is added as a reason for invalidation.

(7) The 2011 Act on Partial Revision of the Patent Act, etc. No. 63 (entered into force on April 1, 2012)

A. In procedures for a patent trial for invalidation, an "advance notice of trial decision" is given, thereby allowing a request for correction. A request for a trial for correction after filing a revocation action against a trial decision for invalidation is prohibited.

B. When a trial for invalidation involves two or more claims of patent, new provisions

concerning units to be corrected and scope of final and binding decisions, etc. are provided.

C. After a final and binding trial decision of a trial for invalidation is made, anyone, except for interested parties and interveners, may request for a trial based on the same facts and the same evidence.

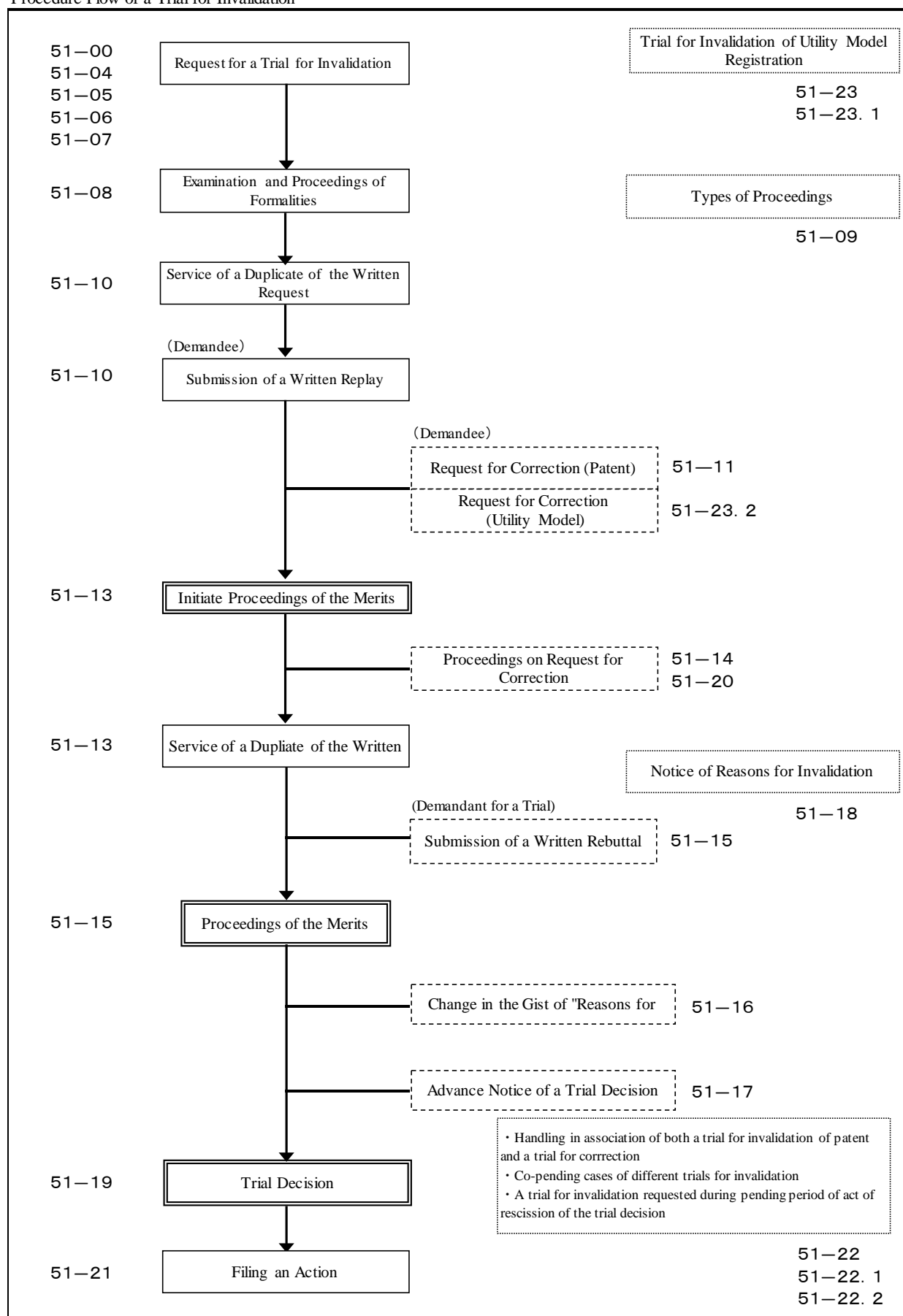
D. When a patent, utility model registration, or trademark registration is granted for an application which was filed by a person who is not entitled to obtain a patent, etc., or for an application with violation of joint applications, any person who is entitled to obtain a patent, etc. may request the illegitimate right holder to transfer the right. In connection with this revision, eligibility of the demandant has been reviewed in relation to the reasons for invalidation concerning attribution of rights.

E. For patents corrected on the basis of Act before the 2011 revision, provisions for the requirements of the purpose for corrections in a trial for invalidation (the Patent Act Article 123 (1) (viii)) by reasons of unlawful corrections is applied to a provision on the basis of laws before the 2011 revision even if the trial for invalidation was requested after April 1, 2012 (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 2(21)).

(8) The 2014 Act on Partial Revision of the Patent Act, etc. No. 36 (entered into force on April 1, 2015)

As a result of the introduction of a system of opposition to grant of patent, only concerned parties are allowed to request a trial for invalidation. For a trial for invalidation of trademark registration, it is clarified for confirmation purpose that only concerned parties are allowed to request.

Procedure Flow of a Trial for Invalidation



(Revised June 2019)

51-03 P U D T**Trial for Invalidation
Flow Charts by IP Type****[Patents]**

FIG.1-1: Basic Flow Chart of a Trial for Invalidation of Patent (Up to Advance Notice of Trial Decision)

FIG.1-2: Basic Flow Chart of a Trial for Invalidation of Patent (After Advance Notice of Trial Decision)

FIG.2: Flow Chart in Case Amendments Change the Gist of “Reasons for Request” in a Written Request for Trial

FIG.3: Flow Chart in Case of Reasons for Invalidation Found by Ex Officio

FIG.4: Flow Chart in Case of Violation of Requirements of Corrections found by Ex Officio

FIG.5: Basic Flow Chart of a Trial for Invalidation of Patent after Trial Decision

[Utility Models]

FIG.6: Basic Flow Chart of a Trial for Invalidation of Utility Model Registration

[Designs]

FIG.7: Basic Flow Chart of a Trial for Invalidation of Design Registration

[Trademark]

FIG.8: Basic Flow Chart of a Trial for Invalidation of Trademark Registration

Pattentee



Basic Flow Chart of a Trial for Invalidation of Patent
(after Advance Notice of Trial Decision)

FIG.1-2

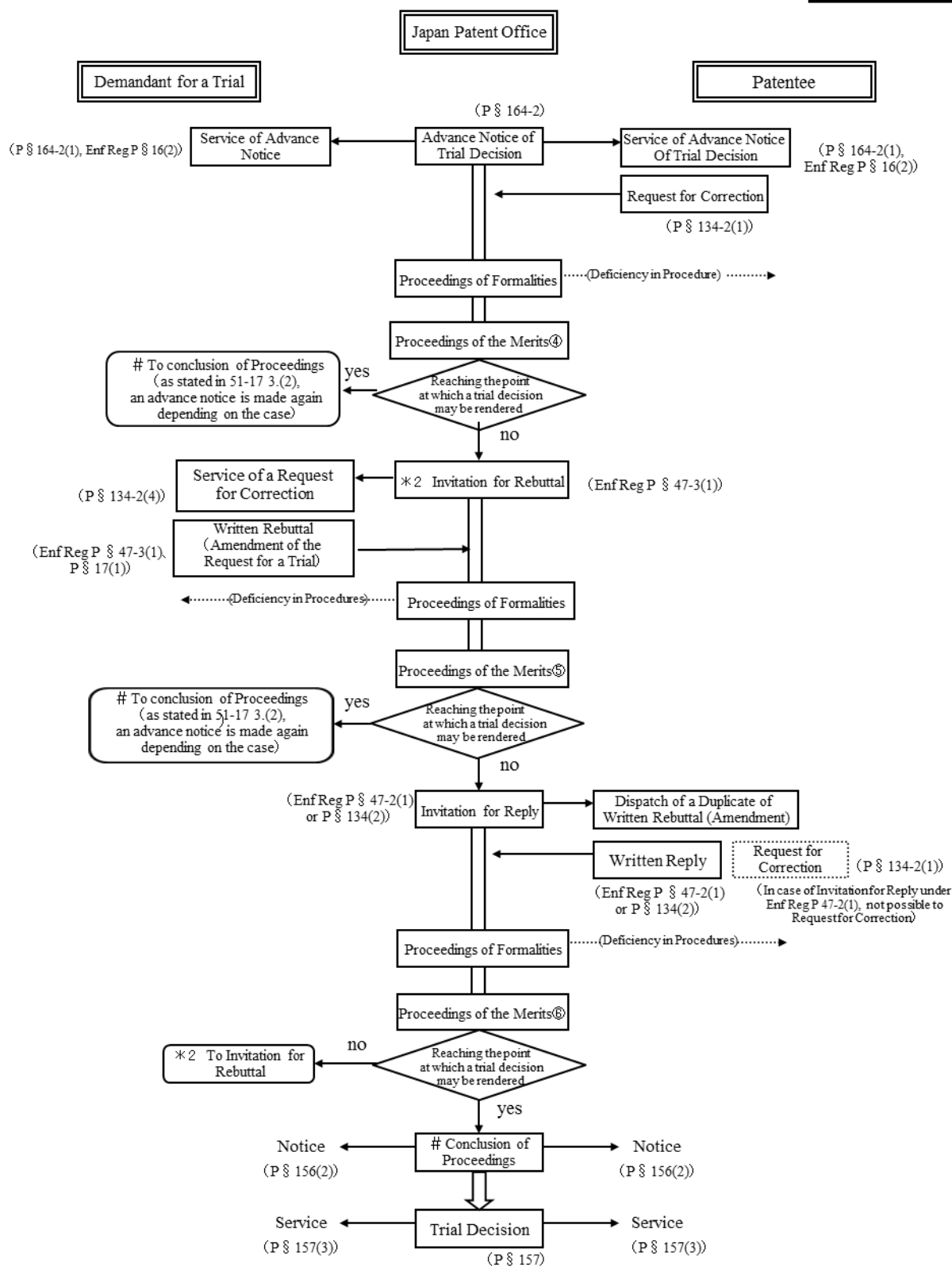


FIG.2

Flow Chart in Case Amendment Changes the Gist
of “Reasons for Request” in a Written Request for Trial
(In the case before Oral Proceedings)

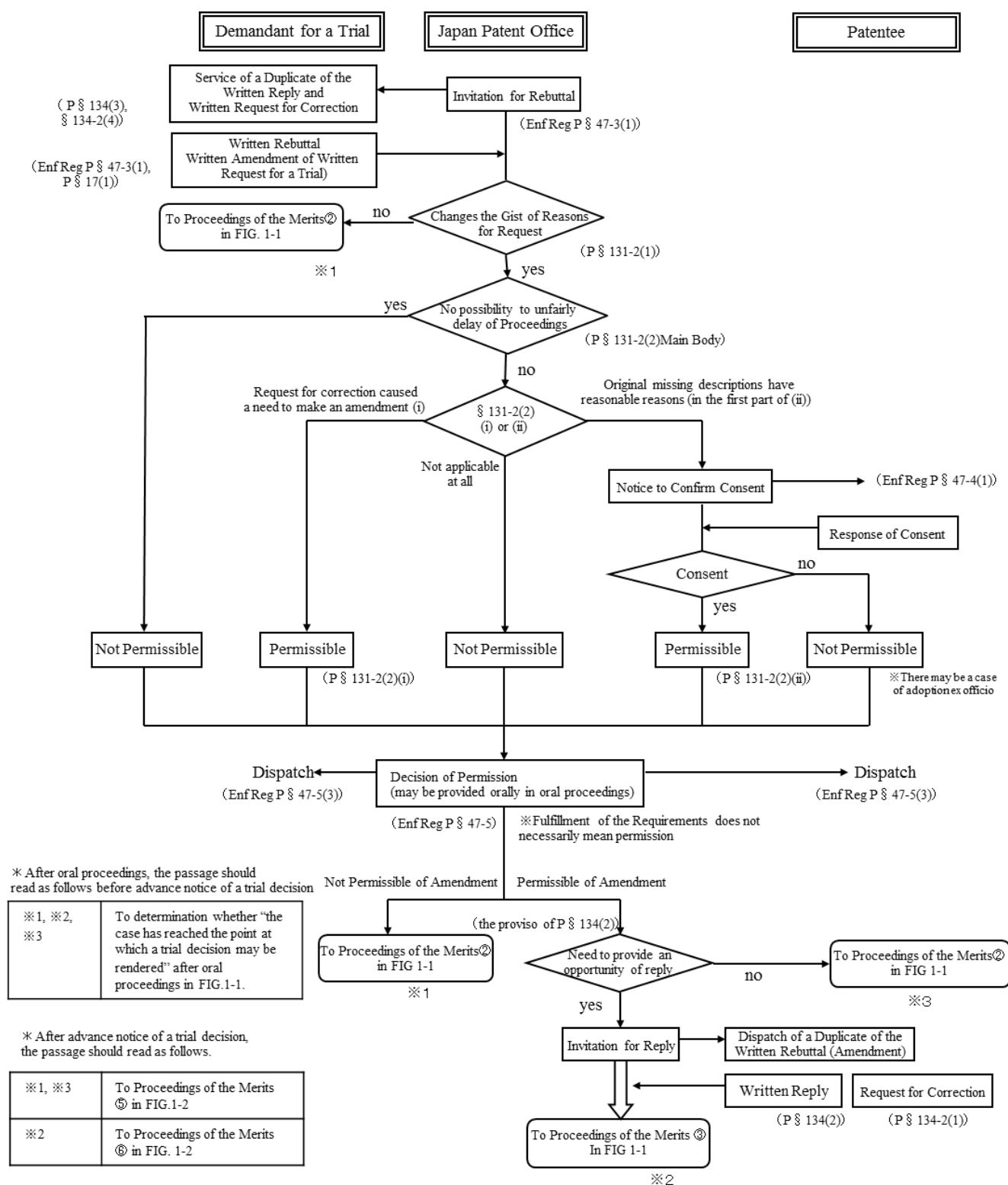


FIG.3

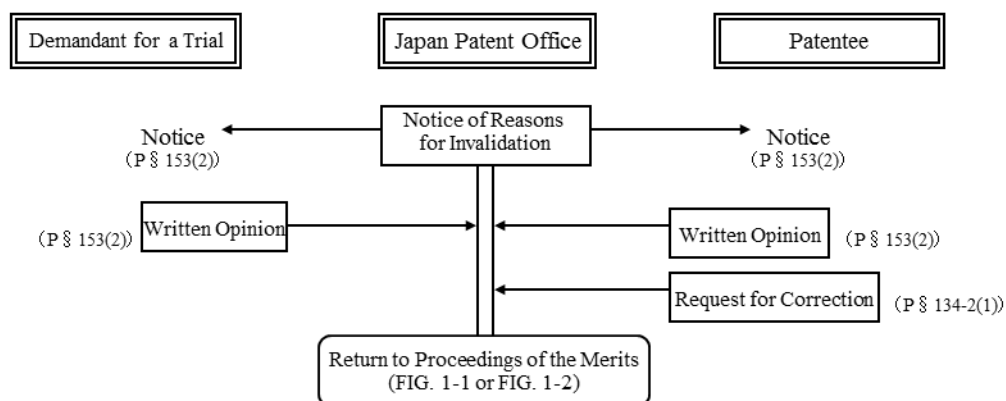
Flow Chart in Case of Finding Reasons
for Invalidation Ex Officio

FIG.4

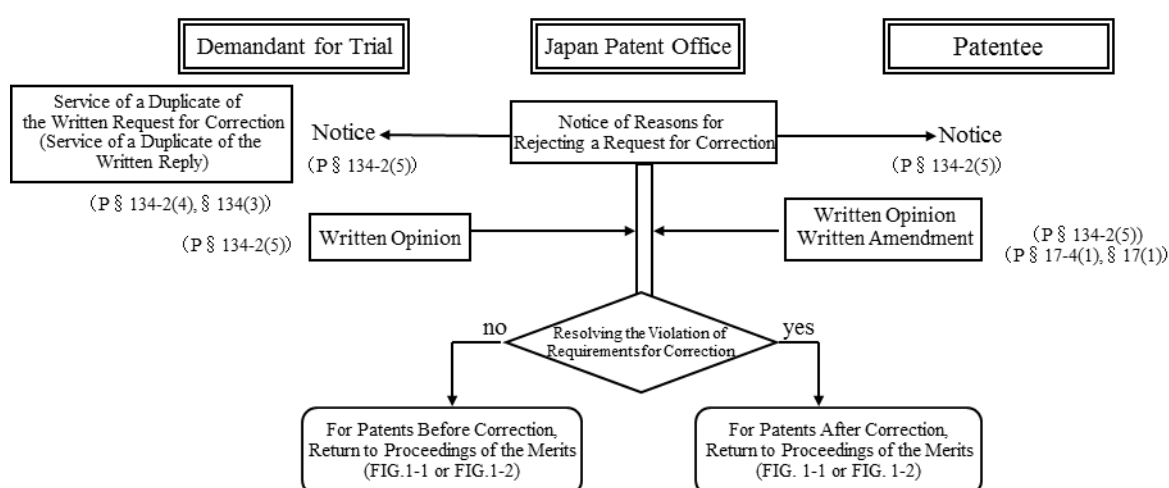
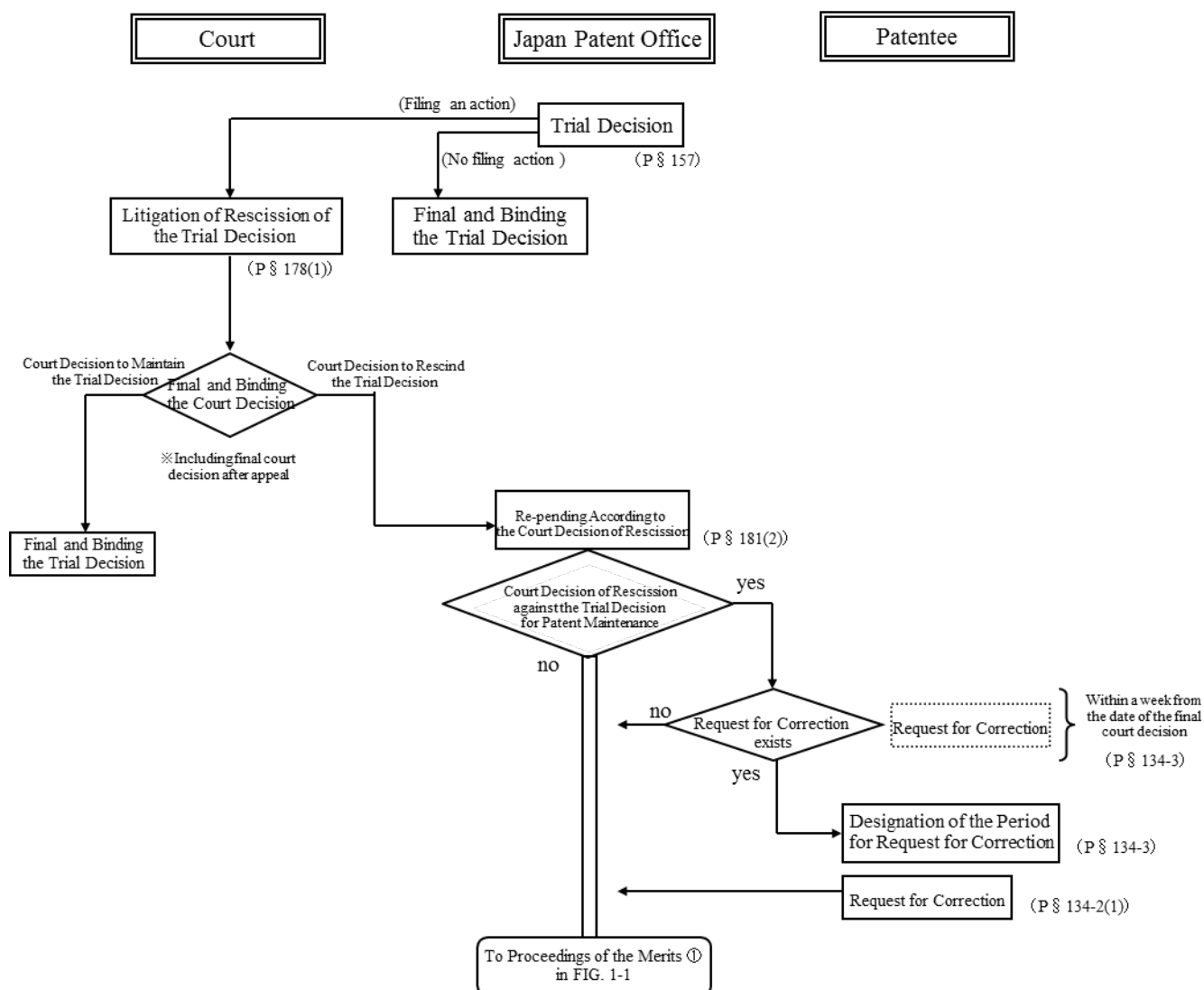
Flow Chart in Case of Finding Violation of Requirements
of Correction Ex officio

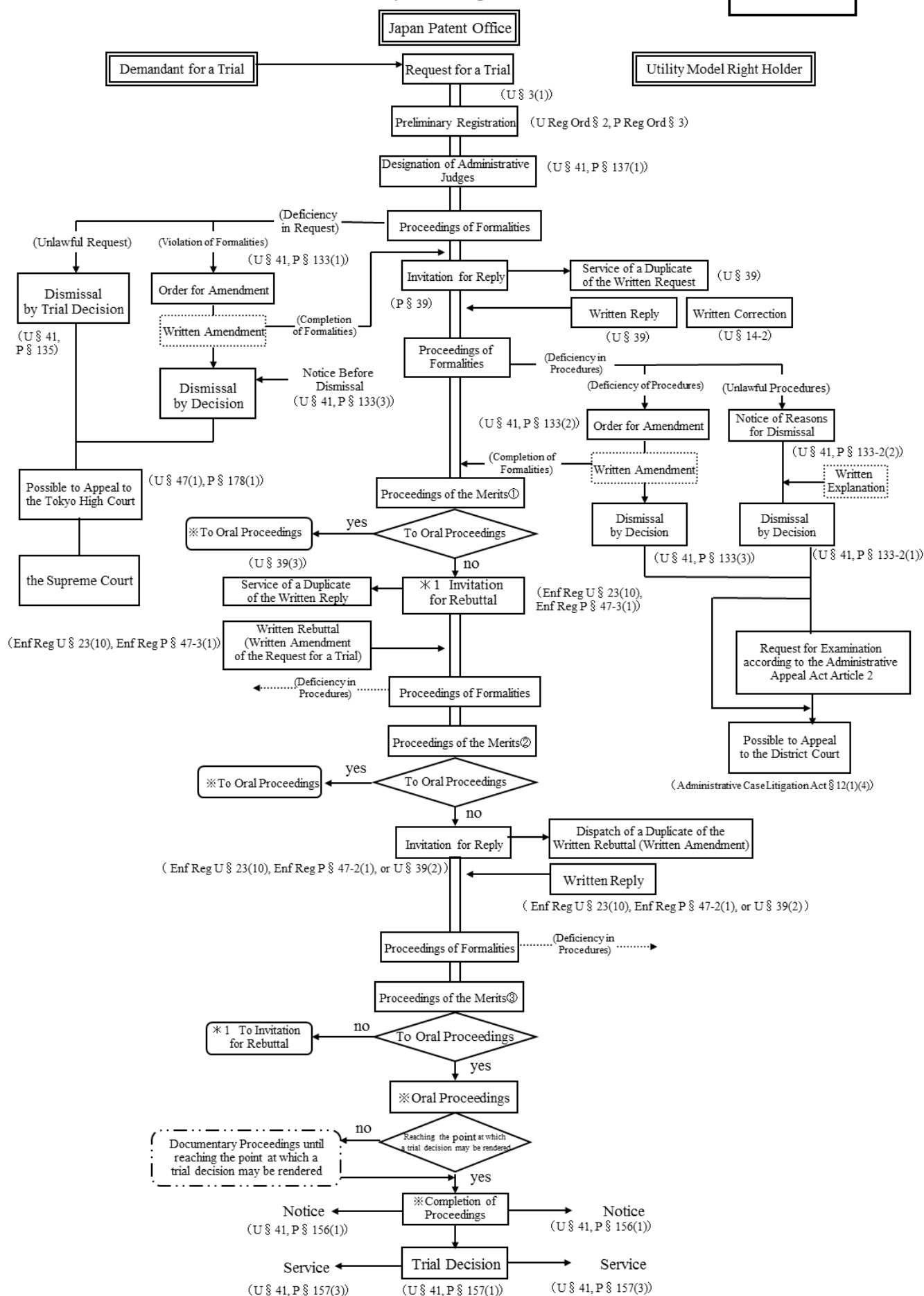
FIG.5

Basic Flow Chart After Trial Decision of
a Trial for Invalidation of Patent



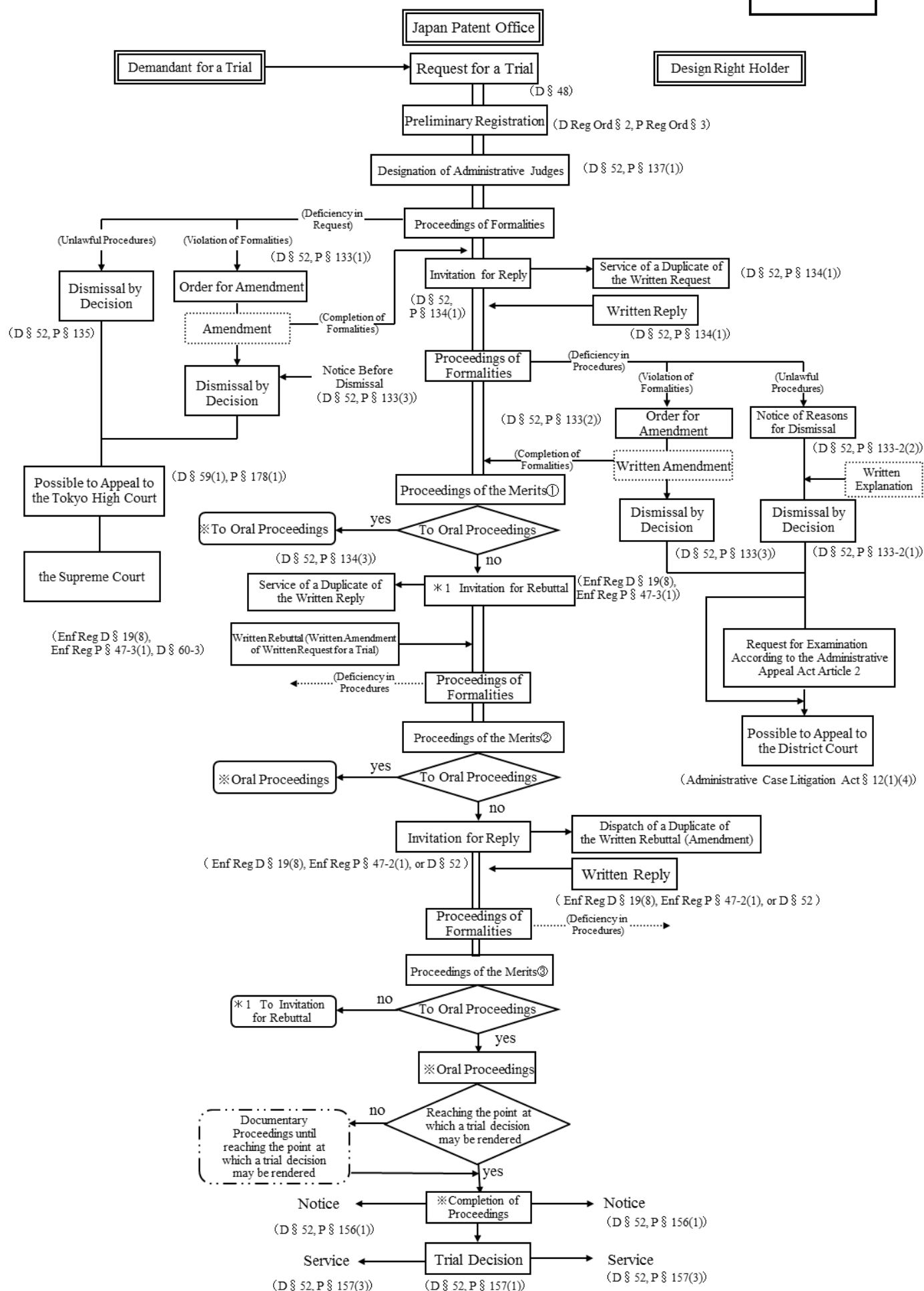
Basic Flow Chart of a Trial for Invalidation of
Utility Model Registration

FIG.6



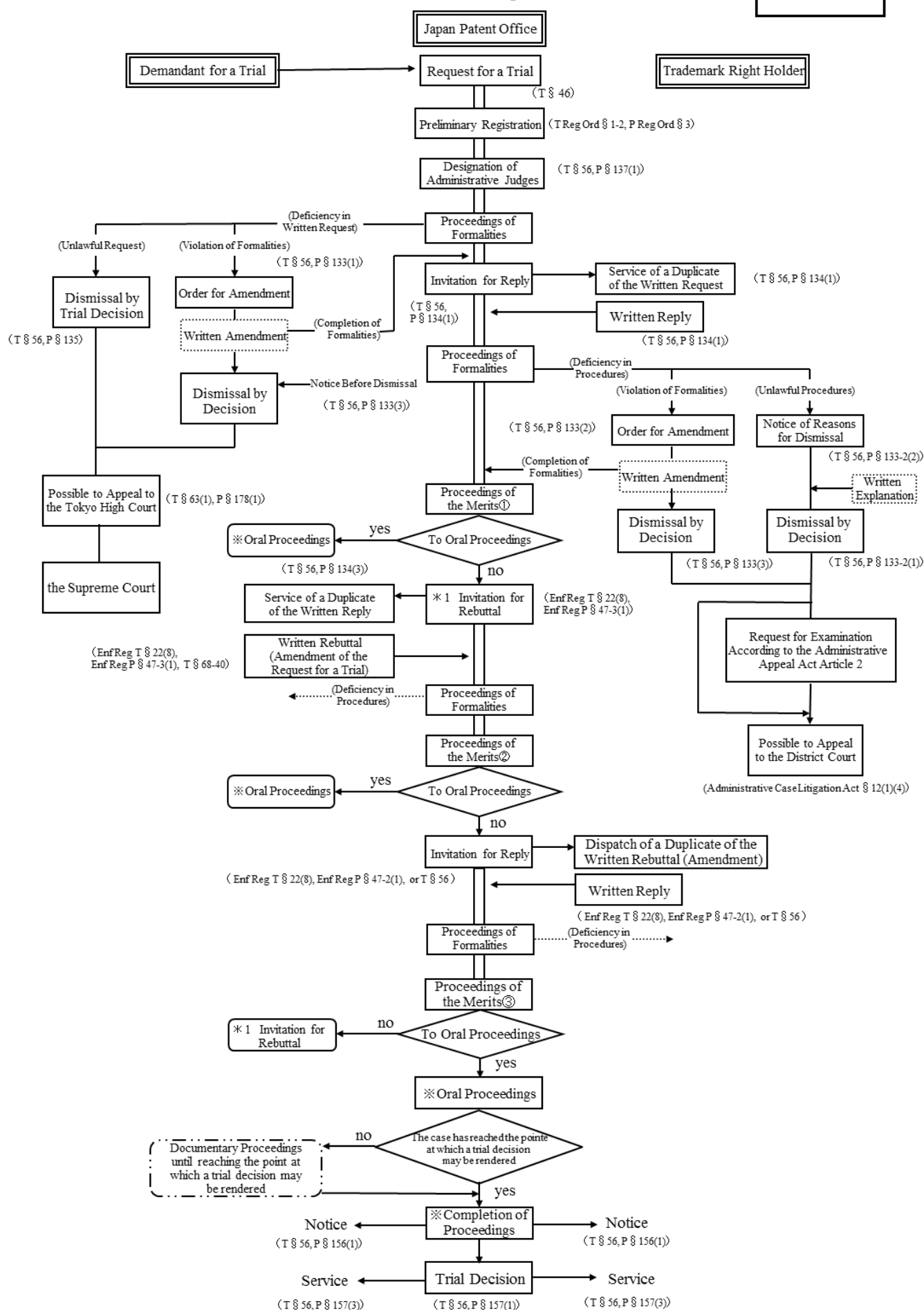
Basic Flow Chart of a Trial for Invalidity of Design Registration

FIG.7



Basic Flow Chart of a Trial for Invalidation of Trademark Registration

FIG.8



51-04 P U D T

Subject of a Request for a Trial for Invalidation, Reasons for Invalidation

1. Subject of a Request for a Trial for Invalidation

The subject of a request for a trial for invalidation is a patent (registration) disposition as part of the administrative disposition (the Patent Act Article 123(1); the Utility Model Act Article 37(1); the Design Act Article 48(1); the Trademark Act Articles 46(1), 68(4)).

(1) When a patent or a utility model registration has two or more claims, With regard to the subjects relating to two or more claims of a patent and a utility model, a request for a trial for invalidation may be filed for each claim.

(2) When a trademark registration has two or more designated goods or services, a request for a trial for invalidation may be filed for each designated goods or service.

2. Reasons for Invalidation

Reasons for invalidation are defined as any reason or fact invalidating a right. The reasons are limited to the statutory reasons for invalidation (the Patent Act Article 123(1); the Utility Model Act Article 37(1); the Design Act Article 48(1); the Trademark Act Articles 46(1), 68(4)). No other reasons outside the statutory provisions constitute a reason for the request of a trial for invalidation, which is in accordance with the limitative listing of the reasons for invalidation.

3. Reasons for Invalidation (refer to the list of reasons for invalidation described below)

Reasons for invalidation are almost the same as reasons for refusal, but the former differs in some respects.

(1) Patents and Utility Models

A. Reasons for refusal but not for invalidation

(A) Violation of Requirements of Unity of Invention (the Patent Act Article 37; the Utility Model Act Article 6)

(B) Violation of Ministerial Ordinance in the scope of claims (the Patent Act Article 36(6)(iv); the Utility Model Act Article 5(6)(iv))

(C) Violation of requirements of shift amendment (the Patent Act Article 17-2(4))

(D) Deficiency in descriptions of information relating to documents for publicly-known inventions (the Patent Act Articles 36(4)(ii), 48-7, and 49(v))

B. Reasons for invalidation but not for refusal

(A) Late-coming reasons for invalidation (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi))

(B) Unlawful correction (the Patent Act Article 123(1)(viii); the Utility Model Act Article 37(1)(vii))

(Note) Because of the transitional measures, the reasons for invalidation based on the former Patent Act Article 184-15(1) still apply to foreign language applications submitted on or before June 30, 1995.

(2) Designs

A. Reasons for refusal but not for invalidation

One application per design (the Design Act Article 7)

Design for a set of articles (the Design Act Article 9)

Related design (the Design Act Article 10(1))

B. Reasons for invalidation but not for refusal

Late-coming reasons for invalidation (the Design Act Article 48(1)(iv))

(3) Trademarks

A. Reasons for refusal but not for invalidation

Single trademark on each application (the Trademark Act Article 6(1)(2))

B. Reasons for invalidation but not for refusal

Late-coming reasons for invalidation (the Trademark Act Article 46(1)(v),(vi),(vii))

Registration by a non-right holder (the Trademark Act Article 46(1)(iv))

Earlier Application (the Trademark Act Article 8(1))

4. Time for Determining the Reasons for Invalidation

The time for determining whether any reason exists for invalidation, with reference to the relevant laws or state of facts, differs as per each reason. For patents, utility models, and designs, the time should normally be the time of application and registration for trademarks. However, in case a patent (registration) is granted and a reason for invalidation, such as late-coming, is found afterwards, as stated in the Patent Act Article 123(1)(vii), the Utility Model Act Article 37(1)(vi), the Design Act Article 48(1)(iv), and the Trademark Act Article 46(1)(v), the time to determine invalidation is when the late-coming reason has become applicable.

5. Relation to the Examination of Basic Requirements in a Utility Model

The reason for invalidation of utility models (the Utility Model Act Article 37(1)) and basic requirements (the Utility Model Act Articles 6-2, 14-3) are both independent requirements. However, any utility model registration that fails to fulfill the basic requirements is regarded as having a reason for invalidation, except in the case of a deficiency in the unity of invention (the Utility Model Act Article 6) and of claims failed to be described as per the ministerial ordinance's definition (the Utility Model Act Article 5(6)(iv)).

For instance, a deficiency in the basic requirements of claims being described in a method constitutes a reason for invalidation owing to the violation of the body of Article 3 in the Utility Model Act. A deficiency in the basic requirements of the descriptions being significantly unclear constitutes a reason for invalidation owing to the violation of the Utility Model Act Article 5 (deficiencies of the descriptions).

(For reference, see the period of the exclusion of trademarks.) (→51-06)

List of Reasons for Invalidation in a Trial for Invalidation of Patents and Utility Models

<p>Addition of new matters</p> <p>(the Patent Act Article 123(1)(i))</p> <p>(the Utility Model Act Article 37(1)(i))</p>	<p>A patent (utility model registration) was granted with an amendment of an addition of new matters, however, such an amendment was against the Patent Act Article 17-2(3) or the Utility Model Act Article 2-2(2).</p>
<p>Violation of the legal capacity of a foreigner</p> <p>(the Patent Act Article 123(1)(ii))</p> <p>(the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted to a foreigner not entitled to possess the right in violation of the Patent Act Article 25 or the Utility Model Act Article 2-5(3).</p>
<p>Non-inventive</p> <p>(the Patent Act Article 123(1)(ii))</p> <p>(the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted to what is not regarded as an invention or a device stipulated in the Patent Act Articles 2(1) and 29(1) and as per the Utility Model Act Article 2(1) and 3(1).</p>
<p>Violation of industrial applicability</p> <p>(the Patent Act Article 123(1)(ii))</p> <p>(the Utility Model Act Article 37(1)(ii))</p>	<p>A patent (utility model registration) was granted to an invention (device) that does not fulfill the requirements of</p>

	industrial applicability as stipulated in the Patent Act Article 29 (1) or the Utility Model Act Article 3(1).
Violation of novelty (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted to an invention (device) that lacks novelty as stipulated in the Patent Act Article 29(1) or the Utility Model Act Article 3(1).
Violation of inventive step (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted to an invention (device) that lacks an inventive step as stipulated in the Patent Act Article 29(2) or the Utility Model Act Article 3(2).
Prior art effect (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted to a later application invention (design) identical to an invention (device) described in a prior application laid open to the public afterwards as stipulated in the Patent Act Article 29-2 or the Utility Model Act Article 3-2.
Violation of public order (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article	A patent (utility model registration) was granted to an invention (design) that violates public order as stipulated in the

37(1)(ii))	Patent Act Article 32 or the Utility Model Act Article 4.
Violation of the requirements of joint application* (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration), which should have been jointly applied for, was granted to an invention (device) to be shared by right holders, in violation of the requirements as stipulated in the Patent Act Article 38 or the Utility Model Act Article 11(1).
Patent of later application (the Patent Act Article 123(1)(ii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted in violation of the requirements to exclude any later application, etc. as stipulated in the Patent Act Article 39(1)-(4) or the Utility Model Act Article 7(1)-(3).
Violation of a treaty (the Patent Act Article 123(1)(iii)) (the Utility Model Act Article 37(1)(ii))	A patent (utility model registration) was granted in violation of a treaty.
Violation of description requirements (the Patent Act Article 123(1)(iv)) (the Utility Model Act Article 37(1)(iv))	A patent (utility model registration) was granted against the description requirements as stipulated in the Patent Act Article 36(4)(i) or the Utility Model Act Article 5(4).

<p>Violation of the requirements of the description of the scope of claims (the Patent Act Article 123(1)(iv)) (the Utility Model Act Article 37(1)(iv))</p>	<p>A patent (utility model registration) was granted against the requirements of the description of the scope of claims as stipulated in the Patent Act Article 36(6)(i)-(iii) or the Utility Model Act Article 5(6)(i)-(iii).</p>
<p>New matter beyond the original text (the Patent Act Article 123(1)(v))</p>	<p>A patent was granted to a foreign language patent application wherein some new matter was added in the foreign language text.</p>
<p>Usurped application* (the Patent Act Article 123(1)(vi)) (the Utility Model Act Article 37(1)(v))</p>	<p>A patent (utility model registration) was granted to a party that has no right to hold the patent (utility model registration).</p>
<p>Late-coming (post-granted) reasons for invalidation (the Patent Act Article 123(1)(vii)) (the Utility Model Act Article 37(1)(vi))</p>	<p>The patent (utility model registration) has become subject to “violation of legal capacity of right of a foreigner” or “violation of a treaty” after a patent (utility model registration) was granted.</p>
<p>Unlawful corrections (the Patent Act Article 123(1)(viii)) (the Utility Model Act Article 37(1)(vii))</p>	<p>Any correction that does not fulfill the requirements of corrections was made in a patent (utility model registration),</p>

	as stipulated in the Patent Act Articles 126, 134-2 or in the Utility Model Act Article 14-2.
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*Reasons for invalidation relating to vested rights are eliminated from the aforementioned reasons for invalidation upon filing a registration of transfer of a patent right under the provision of the Patent Act Article 74 (1).

List of Reasons for Invalidation in a Trial for Invalidation of
Design Registrations and Applicable Articles

Reasons for Invalidation	Applicable Articles
Violation of Requirements of Design Registration (the Design Act Article 3, 3-2)	The Design Act Article 48(1)(i)
Violation of reasons for unregistrability (the Design Act Article 5)	The Design Act Article 48(1)(i)
Violation of prior application (the Design Act Article 9(1), (2))	The Design Act Article 48(1)(i)
Despite the establishment of an exclusive license for a principal design, a related design registration was made. (the Design Act Article 10(2))	The Design Act Article 48(1)(i)
A design only similar to a related design to be registered (the Design Act Article 10(3))	The Design Act Article 48(1)(i)
Violation of joint application (the Patent Act Article 38 applied mutatis mutandis of the Design Act Article 15(1))	The Design Act Article 48(1)(i)
Violation of the enjoyment of rights by foreign nationals (the Patent Act Article 25 applied mutatis mutandis of the Design Act Article 68(3))	The Design Act Article 48(1)(i)

Violation of a treaty	The Design Act Article 48(1)(ii)
Non-right holder registration	The Design Act Article 48(1)(iii)
Violation of the late-coming enjoyment of rights by foreign nationals and violation of a treaty	The Design Act Article 48(1)(iv)

List of Reasons for Invalidation in a Trial for Invalidation of Trademark Registrations
and Applicable Articles

Reasons for Invalidation	Applicable Articles	Statute of Limitation (the Trademark Act Article 47) (Note 1)
Violation of the requirements of trademark registration (the Trademark Act Article 3)	The Trademark Act Article 46(1)(i)	○
Violation of reasons for unregistrability (the Trademark Act Article 4(1))	The Trademark Act Article 46(1)(i)	○ (viii),(x),(xi)-(xv), (xvii) (Note 2)
Violation of the requirements of registration of regional collective trademarks (the Trademark Act Article 7-2(1))	The Trademark Act Article 46(1)(i)	○
Violation of prior application (the Trademark Act Article 8(1), (2),(3))	The Trademark Act Article 46(1)(i)	○
Violation of prohibition of re-registration under rescission of a trademark registration (the Trademark Act Articles 51(2), 52-2(2), 53(2))	The Trademark Act Article 46(1)(i)	×
Violation of the enjoyment of rights by foreign nationals (The Patent Act Article 25 applied mutatis mutandis of the Trademark Act Article	The Trademark Act Article 46(1)(i)	×
Violation of a treaty	The Trademark Act Article 46(1)(ii)	×

Violation of the requirements of the Trademark Act Article 5(5)	The Trademark Act Article 46(1)(iii)	×
Non-right holder registration	The Trademark Act Article 46(1)(iv)	○
Violation of the late-coming enjoyment of rights by foreign nationals and violation of a treaty	The Trademark Act Article 46(1)(v)	×
Violation of reasons for late-coming unregistrability (the Trademark Act Article 4(1)(i)-(iii),(v),(vii),(xvi))	The Trademark Act Article 46(1)(vi)	×
Violation of the requirements of late-coming registration of regional collective trademarks	The Trademark Act Article 46(1)(vii)	×
Violation of the requirements of application for defensive mark registration (the Trademark Act Article 64)	The Trademark Act Article 68(4)	×

Note 1: The symbol “○” indicates that a trademark in the respective category is not allowed to request for a trial for invalidation after five years from the date of the establishment of trademark rights.

Note 2: Articles 4 (1)(x) and (xvii) are not applicable to any trademark found registered for an unfair competition. Article 4(1) (xv) is not applicable to any trademark found registered for any unlawful purposes.

(Revised June 2019)

51-05 P U D T

Authorized Party, Concerned Party, and Intervenor of a Trial for Invalidation

1. Authorized Party of a Trial for Invalidation

Any decision regarding invalidation of rights is an exercise of the administrative power, which can be exercised through a trial conducted by a panel of administrative judges (the Patent Act Article 136; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

In other words, any rights with establishment of registration continue to be valid unless a final and binding trial decision to invalidate the rights is made.

2. Concerned Party

The concerned parties in a trial for invalidation refer to the demandant and demandee.

If the demandee indicates an uncertainty of the concerned party, etc., any examination of evidence, such as an examination of parties, is not necessary as long as such matters can be sufficiently examined through proceedings under investigation ex officio. This is because determination of the concerned party and the said party's capability of conducting procedures is a matter to be investigated by the relevant authority.

(1) Demandant

A. Anyone who implements the procedures of a request for a trial for invalidation must be recognized to be a person capable of implementing (legal capacity) procedures. (→ 22-01)

B. Any person, corporation, non-corporation association, or foundation—whose representation or management is defined—may request a trial for invalidation (the Patent Act Article 6(1)(iii); the Utility Model Act Article 2-4; the Design Act Article 68(2); the Trademark Act Article 77(2)).

C. Two or more demandants of the same right may jointly request a trial (the Patent Act Article 132(1); the Utility Model Act Article 41; Supplementary Provisions of the 2011

Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→22-03)

D. Eligibility of a demandant for a trial for invalidation is as follows:

(A) For Requests on or after April 1, 2015

Only an interested party may request a trial for invalidation of patents and trademarks (the Patent Act Article 123(2); the Trademark Act Article 46(2)) (→31-00-02).

For the reasons for invalidation relating to vested rights of a patent (violation of the requirements of joint applications (the Patent Act Articles 123(1)(ii), 38) and usurped applications (the Patent Act Article 123(1)(vi)), only a party that is eligible to be granted the patent may request a trial for invalidation.

For a trial for invalidation of the registrations of utility models and designs, anyone may request a trial for invalidation on the reasons other than those relating to vested rights (the Utility Model Act Article 37(2); Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 37(2)); the Design Act Article 48(2)). For the reasons for invalidation relating to vested rights of a patent (violation of the requirements of joint applications (the Utility Model Act Article 37(1); the Utility Model Act Article 11(1) → the Patent Act Article 38; the Design Act Article 48(1); the Design Act Article 15(1)→ the Patent Act Article 38) and usurped applications (the Utility Model Act Article 37(1)(v); the Design Act Article 48(1)(iii)), only an interested party is allowed to request a trial for invalidation of utility models and designs (the Utility Model Act Article 37(2) provisos; the Design Act Article 48(2) provisos).

However, for registrations of utility models and designs relating to the applications on or after April 1, 2012, only a party eligible to be registered may request a trial for invalidation (the Utility Model Act Article 37(2) provisos; the Design Act Article 48(2) provisos).

(B) For Requests on or before March 31, 2015 (the Patent Act Article 123(2); the Utility Model Act Article 37(2); the Design Act Article 48(2), not applicable to trademarks and

limited to the concerned party)

a. For the reasons for invalidation other than reasons relating to vested rights

As for the reasons for invalidation other than reasons relating to vested rights, anyone is allowed to request a trial for invalidation.

b. For the reasons for invalidation relating to vested rights

As for the reasons for invalidation relating to vested rights, only an interested party may request a trial for invalidation.

However, for patents relating to the applications made on or after April 1, 2012, only a party that is eligible to be granted the patent is allowed to request a trial for invalidation (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 2(9)).

E. The following should be noted for demandants:

(A) Request by a non-existent person for a trial for invalidation

For any request under a name of a non-existent person (anonymous) for a trial for invalidation, the concerned party in such a case cannot be defined because the demandant as the concerned party for a trial for invalidation does not exist; thus, the action for the request cannot be concluded. Such a request for a trial for invalidation is dismissed by a trial decision for being unable to make its amendment due to an unlawful request (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(B) Request for a trial for invalidation under fraudulently use of a name

Actions under fraudulently use of a name, such as a request for a trial for invalidation using a name of an existing person without permission or using a name with permission but with no intention of the named person to proceed with any procedure, is deemed a request for a trial for invalidation that is not based on the intention of a person whose name is fraudulently used (a superficial demandant). Such a case does not constitute an action of a request for trial by the person whose name is used, and the action by the person who committed name theft is deemed as an unauthorized representation that does not deliver effects to the victim of the name theft. Therefore, the request should be

dismissed by trial decision as an unlawful request for trial. (Any litigation of fraudulently use of the name under the Code of Civil Procedure is handled in the same way.)

In case a request for a trial for invalidation is found to be a request under a fraudulent name during communications between the Japan Patent Office and the demandant and through procedures such as an oral proceedings, the chief administrative judge determines whether the person whose name is fraudulently used (a superficial demandant) confirms the procedures undertaken thus far by the person who used the name fraudulently and whether the said person has any intention to continue procedures for the trial. Any procedures undertaken by a person with no authority or representation may be confirmed only by the person whose name is fraudulently used (or a statutory representative) having the capacity to undertake procedures. When there is the intention to confirm the procedures, the procedures undertaken may be ratified (the Patent Act Article 16(2); the Utility Model Act Article 2-5(2); the Design Act Article 68(2); the Trademark Act Article 77) and may proceed with the procedures thereafter for the person whose name is fraudulently used as a demandant. When the said person is found to have no intention to confirm the procedures, the request for a trial for invalidation is deemed unlawful and dismissed by the trial decision since any amendment is not allowable (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)).

In case a request for trial is not dismissed because of an overlook of a deficiency and a trial decision is reached after the proceedings, the patentee once invalidated of the said patent by the trial decision through unlawful procedures can still request dismissal of the trial decision for invalidation through a revocation action against the trial decision (the Patent Act Article 178; the Utility Model Act Article 47; the Design Act Article 59; the Trademark Act Article 63). Furthermore, even after the trial decision for invalidation is final and binding, a patentee having a benefit of a request in the consequent rescinding of the trial decision may be allowed to request a re-trial in the pursuit of rescinding the trial decision for invalidation (the Patent Act Article 171(2))

→ Analogical application of the Code of Civil Procedure, Article 338(1)(iii)).

Accordingly, any request for a trial for invalidation under the fraudulent use of a name may not produce any benefit of invalidation. (Such fraudulent action does constitute the uttering of counterfeit private documents; this is illegal from a criminal perspective.)

(C) Representation based on compensation

In a case where a person having an intention to pursue the procedures requests a trial for invalidation under the person's name and is commissioned by a third party requesting a trial for invalidation, the request for a trial for invalidation shall not be dismissed by the trial decision because this case is not deemed a request under a fraudulently use of a name. However, if anyone who is not a professional representative, such as a patent attorney or an attorney at law, requests a trial as a representative of someone else in pursuit of monetary or other compensations, it is necessary to be careful because this action could possibly develop a problem of violation of the Patent Attorney Act or the Attorney at Law Act (the Patent Attorney Act 75, the Attorney at Law Act 72).

(2) Demandee

A. Demandee is a right holder.

(A) When the right is jointly owned, all co-patentees jointly owning the right are demandees (the Patent Act Article 132(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→ 22- 03)

In principle, a request for a trial that fails to list all co-patentees of the right as demandees may be dismissed by the trial decision.

a. Procedures wherein all or some of the co-patentees are residents abroad, and a patent administrator is not selected. (→23-10)

b. In case of an interruption or a suspension upon the death of one of the co-patentees, the right takes effect on all the other co-patentees. (→ 26-01)

(B) If any right is registered as part of trust property under the Trust Act, the demandee is the trustee.

For a request for a trial for invalidation after a lapse of rights (the Patent Act Article 123(3); the Utility Model Act Article 37(3); the Design Act Article 48(3); the Trademark Act Articles 46(3), 68(4)), the demandee is the right holder at the time of the lapse. Refer to 22-04 when the address, etc. of the demandee differs from that stated in the register.

B. Any demandee's amendment for being wrongly expressed does not constitute a change in the gist of the request stipulated in the Patent Act Article 131-2(1), the Utility Model Act Article 41, the Design Act Article 52, and the Trademark Act Article 56(1) that might eliminate a deficiency (→ 22-01 9.(3)).

3. Intervenor (→ 57-00)

(1) Intervention as a demandant for a joint trial (Intervention of the concerned party)

Anyone entitled to be a demandant for a joint trial may intervene in the case as a demandant until the completion of the proceedings (the Patent Act Article 148(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

The capability of implementing the procedures and the eligibility as a demandant of an intervenor as a demandant for a joint trial are the same as those of a demandant.

In the proceedings, the determination of whether to grant a written request for intervention (the Patent Act Article 149(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)) as a demandant for a joint trial is decided upon hearing the opinions of the concerned parties.

In principle, a demandant for a joint trial is an intervenor as a "demandant," thus, such the intervenor may implement the same procedures as those undertaken by the original demandant. However, if a demandant for a joint trial states new reasons for invalidation that might change the gist of the reasons for request, the panel is allowed to make the new reasons for invalidation the base for proceedings only if the chief administrative judge approves and all the requirements are fulfilled (the Patent Act Article 131-2(2)).

(2) Assisting intervention

Any person having an interest in the trial results may intervene (as in assisting intervention) in the trial for invalidation for assisting one of the concerned parties until completion of the proceedings (the Patent Act Article 148(3); the Utility Model Act Article 41; Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Furthermore, to request having an interest on the part of the right holder as a condition for assisting the intervention is appropriate in that it might limit the concerned parties to be associated with the right's outcome, which is a subjective right at the disposal of the right holder.

In the proceedings, determining whether to grant the application of assisting the intervention is decided upon hearing the opinions of the concerned parties.

(Revised June 2019)

51-06 P U D T

Restrictions on a Request for a Trial for Invalidation

1. Time Requirements for Submission of a Request for a Trial for Invalidation

(1) A request for a trial for invalidation can be filed any time after establishing the registration of the right, even after the right has been extinguished (the Patent Act Article 123(1)(3); the Utility Model Act Article 37(1)(3); Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 37(1)(3); the Design Act Article 48(1)(3); the Trademark Act Article 46(1)(3), 68(4)).

(2) Request for a trial for invalidation can be filed even after the right has been extinguished. For instance, when a claim of damage due to actions of infringement of a right is filed after the right is extinguished because of the expiration of its duration, the counterparty can still request for a trial to invalidate the said right.

(3) However, a request for a trial for invalidation may be dismissed for a right that had expired 20 or more years ago, when any right to seek claims of damage and to file any complaint has extinguished, or when no case for trial is pending, based on the reason that the request for the trial does not provide any benefit (Regulations under the Patent Registration Order, Article 5; Regulations under the Utility Model Registration Order, Article 3(2); Regulations under the Design Registration Order, Article 6(2); Regulations under the Trademark Registration Order, Article 17(2) → 51-19 6.(4)).

(4) With regard to trademark rights, any request for a trial for invalidation for the reasons of the Trademark Act Article 3 or part of the Trademark Act Article 4 cannot be filed after five years from the date on which the registration of the trademark was established (the Trademark Act Article 47(1)). However, no statute of limitation is applied to “the case where a trademark is registered for the purpose of unfair competition or misconduct” according to the Trademark Act Article 4(1)(x), (xvii), 4(1)(xv). Additionally, the statute of limitation is not applied to any request for a trial

for invalidation of any unregistered trademark on the reason of late-coming as a reason for invalidation, as per the Trademark Act Article 46(1)(v).

2. Request for a Trial for Invalidation to the Right that is Invalidated Against the Late-Coming Reason or Abandoned

When a trademark is invalidated on the reason of late-coming (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v)), any request for a trial for invalidation can be filed for the right for the period before the said invalidation.

When the right is abandoned, a request of a trial for invalidation can be filed for invalidation of the right before the right's abandonment.

(Judicial Precedent)

During a pending trial for invalidation of a patent relating to two or more inventions described in the scope of claims, one invention is abandoned. In such case, the trial decision determined without the proceedings for the concerning abandoned invention is illegitimate (Tokyo High Court Judgment (April 26, 1978) (1977(Gyo-ke) case No. 161)).

3. Restrictions on Requests

After a trial decision to maintain the right has become final and binding, any other request for a trial may be restricted because of the application of the principle of prohibition against double jeopardy (the Patent Act Article 167; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4) → 30-02, 51-00 2.(7) C, 51-19 5.(3)).

4. Preliminary Registration

When the date of a request for a trial for invalidation stated in the patent registry as a preliminary registration is not coincident with the date of the request for the trial for invalidation recognized by an examiner, this situation will be notified to the trial clerk

after the trial decision. (→ 51-19 6.)

(Revised June 2019)

51-07 P U D T**Written Request for a Trial for Invalidation****1. General**

(1) In filing a request for a trial for invalidation, the demandant is required to submit the relevant written request that fulfill the requirements defined in the Patent Act Article 131(1)(2), the Utility Model Act Article 38(1)(2), the Design Act Article 52, and the Trademark Act Article 56(1)) (Enforcement Regulations of the Patent Act Article 46(1); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 14(1); Enforcement Regulations of the Trademark Act Article 14).(→21-00)

(2) The number of duplicates (for dispatch and for proceedings) to be submitted

Regarding the written request and its attachments, duplicates of each document corresponding to the number of counterparties (including intervenors) and (for other cases when proceedings are consolidated) one duplicate (Enforcement Regulations of the Patent Act, Article 4; Enforcement Regulations of the Utility Model Act Article 23(1); Enforcement Regulations of the Design Act Article 19(1); Enforcement Regulations of the Trademark Act Article 22(1); Enforcement Regulations of the Patent Act Article 50(2); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)) for proceedings (Enforcement Regulations of the Patent Act Article 50-4; Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)) must be submitted.

This requirement applies to all the concerned documents of a trial for invalidation (including evidence and written request for correction according to the Patent Act Article 134-2).

2. Purport of a Request

(1) The request of a demandant must identify the contents of the request (the conclusion of the trial decision that the demandant attempts to obtain), wherein the subject of the request must be clearly defined.

(2) In general, a statement should read “the demandant hereby requests a trial decision that the patent granted in Japanese Patent No. XX (the registered utility model in registration No. XX, the registered Design in registration No. XX, the registered trademark in registration No. XX) shall be invalidated and the demandee shall bear all the cost of the trial.”

When two or more claims or multiple designated goods/services are involved, and when a trial for invalidation is requested for each claim or designated goods/services, a statement should read as, “The demandant hereby requests a trial decision that claim X described in the scope of claims under the patented invention in Japanese Patent No. XX shall be invalidated, and the cost for trial must be borne by the demandee.” or as “The demandant hereby requests a trial decision that “XX” in class X among the designated goods of the Japanese trademark registration No. XX shall be invalidated. The cost for trial must be borne by the demandee.”

The trial for invalidation of a patent is handled on the assumption that the request is filed by “each claim” even if the claim for trial is not specified in the purport of the request.

(3) When the number of claims has changed in a trial for invalidation of a patent as a result of, for instance, a trial for correction, etc., the purport of the request for a trial for invalidation may change. However, the request should not be handled as having changed its gist.

3. Reasons for a Request

The “reasons for request” for a trial for invalidation of a patent, utility model, or registered design must specifically identify the facts on which the proposed invalidation is based and must describe the relations of each evidence with the facts that require

proof (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52).

(1) “Specifically identify the facts on which the proposed invalidation is based.”

A. “The facts on which the proposed invalidation is based”—Comprehensive coverage of principal facts—

“The facts on which the proposed invalidation is based” refers to the specific facts (i.e., the principal facts) composing the requirements in line with the provisions of the Act (“required facts”) providing the reason for the reasons for invalidation.

In general, specific reasons for invalidation in line with provisions of the Act are constituted by a plural number of requirements, while “The facts on which the proposed invalidation is based” should also exist in response to each requirement. Therefore, all “facts” corresponding to each of the requirements must be described comprehensively. See the following examples:

(A) If invalidation has been claimed on the reason that the reference date is fluctuated, such as the filing date of the application is post-dated, the requirements in the provisions of the Act in relation to post-dated application (for example, the Patent Act Article 44(2)) are the principal facts.

(Example) The violation of the requirements of division of the application (the Patent Act Article 44(2)), the violation of the requirements of conversion of the application (the Patent Act Article 46(5)→ the Patent Act Article 44(2)), the invalidity of claiming priority (the Patent Act Article 41(2)(3),etc.)), or the non-conformity with the requirements of exceptions to lack of novelty (the Patent Act Article 30(1)(2)).

(B) Even well-known facts (e.g., well-known arts, commonly used technology) must be described as reasons for the request or as facts on the reason of the invalidation of rights, as long as those facts constitute principal facts composing the requirements in the provisions of the Act.

(C) Any indirect facts that might lead to the assumption of principal facts or any supporting facts that might enhance the value of the evidence necessary to prove the principal facts do not constitute the principal facts; therefore, they are not necessarily

described as the initial reasons for the request. It is desirable to describe such supplementary information if necessary. However, depending on the nature of the case, wherein showing the existence of principal facts by any means is not possible and the only available principal facts could be expressed in the form of indirect facts that should certainly lead to an assumption of the principal facts, such indirect facts must be described in the initial reasons for the request because those indirect facts substantially claim the principal facts.

B. “Specifically identify”—Specificity and Identity of principal facts —

It is required to describe “specifically identify” the facts that should constitute reasons to invalidate the existing rights. Therefore, principal facts must be described precisely enough to satisfy the requirement.

For instance, if a lack of novelty is the reason for invalidation, claiming the fact that the patented invention was described in a publication that had been distributed prior to filing the application, then it is required to specifically describe that the invention’s content (identifying the invention) was listed in which particular publication (identifying the publication), was publicized when (identifying the fact of the antecedent), where (identifying the place of distribution), on what page of the publication, and where the said invention is described (identifying the description).

In a description of the reason for request, merely stating the name of the publication as a fact of an existence of a prior art does not identify the specific facts to which the right holder can respond, therefore, such description does not fulfill the requirement for the description requirements (the descriptions lack specificity and identity in that there is no specific fact of the antecedent that can be based on the descriptions).

In other words, the descriptions of a reason for the request must be specifically stated with principal facts in a way that the facts providing the reason to invalidate the right can be understood without carefully examining the publication as a proof.

If a demandant fails to attach any proof to the initial request for the trial on the assumption that the subsequent examination of evidence might follow, the demandee

cannot understand any content of the fact as proof. Therefore, specifically identifying the principal facts is necessary so that they can be understood by merely reading the descriptions of the reasons for a trial.

(2) “Describe the relations of each evidence by the facts that require proof.”

The descriptions of reasons for request are required to describe the relations of each evidence respectively to the facts that require proof (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52).

A. “Facts that require proof” (“factum probandum”)

The term “facts that require proof” in a trial for invalidation is defined as every “fact providing the reason to invalidate the right,” specifically identifying principal facts claimed by a demandant according to (1) above.

However, obvious facts evident to a panel are not required to be proved and hence cannot be the facts that require proof. Additionally, any application of laws is not considered the issue of a fact; therefore, this is not a fact that requires proof. In a trial for invalidation under the principle of *ex officio*, differing from a civil suit, any confession is not deemed valid. (See replaced provisions of the Civil Procedure Act Article 179 in the Patent Act Article 151.) Therefore, any principal fact that a right holder has no intention to argue still requires proof; hence, every principal fact is a fact that requires proof (except for obvious facts evident to a panel).

B. “Describe the relations of each evidence with the facts that require proof.”

The requirement “to describe the relations of each evidence respectively to the facts that require proof” is based on the assumption that facts (almost the same as principal facts) that require proof may be plural, because provisions of the Act of the grounds of reasons for invalidation are in general configured of a plural number of requirements.

When each fact that requires proof is supported by different evidence, the relations between each fact and each evidence may possibly become ambiguous. In such case, describing how each fact that requires proof corresponds to each evidence is required, to avoid a right holder having the burden of response or to avoid any delay in proceedings.

(Example) When a violation of inventive step is claimed as the fact basis of the reason for invalidation and a prior art document is submitted as an evidenced document, assuming that the document corresponds to a publication stipulated in the Patent Act Article 29(1)(iii), clarification might be required to determine whether to prove the existence of “the invention listed in the respective items of the preceding paragraph,” as stated in the Patent Act Article 29(2), or to prove “the ordinary skill in the art to which the invention pertains,” as stated in the Patent Act Article 29(2). In such case, the description must be one that can clearly identify what facts requiring proof can be proved by that evidence.

For a case wherein only a small part of an extremely large volume of evidence is used to prove facts that require proof, a description is required to indicate not only the relation of that large volume of evidence to the facts that require proof by a reference number of the evidence attached to the whole evidence, but also to indicate more specifically what part of the large volume of evidence corresponds to the facts that require proof is necessary.

(3) Description examples of “Reasons for request” (Patents, Utility Models)

When claiming reasons for invalidation of a patented invention based on the violation of the inventive step, specifically describe the facts (the principal facts) relating to the reasons for invalidation in line with the requirements (required facts) stipulated in the Patent Act Article 29(2), which states, “the invention that a person skilled in the art could have easily achieved before the application of the patent based on the invention prescribed in any of the items of the Patent Act Article 29(1).”

A. Identify a patented invention (the claimed patented invention) subject to request

Define the reasons for invalidation of a patented invention relating to what claims are subject to invalidation, so as to identify the patented invention by summarizing the descriptions of the scope of the claims for patent (claims) of the concerning patented invention. Additionally, describe the problems to be solved and the technical effects of the patented invention to claim and prove the reasons for invalidation if the request is based on the violation of inventive step.

B. Existence of a prior art invention

In particular, describe the fact of the existence of a prior art invention before filing an application concerning the patented invention under any items in the Patent Act Article 29(1). For example, when proving the existence of a prior art invention by a publication describing the claimed invention, as stated in the Patent Act Article 29(1)(iii), the descriptions should be “In a publication written by XXX, titled “XXXX,” Xth edition of XX publisher, on page XX, line XX to line XXX describes XXXXX of the invention, distributed on XXX year, XX month, XX date, which is prior to the date of the application of the concerning patent dated YY year YY month YY date.” Identify the following: publication title, author’s name, edition number, country of publication, publisher, date of publication, and also specifically identify the descriptions of concern in the publication so as to specify the prior art invention provided from the descriptions in the publication.

C. Comparison between the subject patented invention and the prior art invention

Based on the descriptions of the scope of the claims relating to the subject patented invention, describe the subject patented invention by divided into small sections, if necessary, as well as compare with a prior art invention to specify points of agreements and differences.

D. A point of differences which can be easily achieved by a person skilled in the art

Describe the facts providing the differences between the two inventions can be easily achieved by a person skilled in the art.

To meet the requirements of the Patent Act Article 29(2), it is necessary to assert that a person skilled in the art could have easily achieved the invention before the application of the subject patented invention. If necessary, define a person skilled in the art (having ordinary skill in the art that the invention belongs to) prior to the application of the subject patented invention (for instance, identifying the “technical field the invention belongs to,” “ordinary skill,” and “before the application”). Then, describe the facts providing the reason that any person skilled in the art could have easily achieved the claimed patented invention (including a logical structure for easily

achieving the invention).

E. Conclusion

The subject patented invention is an invention that was described in a publication (Exhibit No. 1), or an invention which could have been easily achieved by a person skilled in the art based on the descriptions in a publication (Exhibit No. 1) , distributed prior to the date of application of the subject patented invention. Thus, the subject patented invention was granted in violation of the provisions in the Patent Act Article 29(2); therefore, it is hereby concluded that the patent shall be invalidated under the provisions of the Patent Act Article 123(1)(ii).

(Reference: “Evidence in general”) (→34-01 - 01.1)

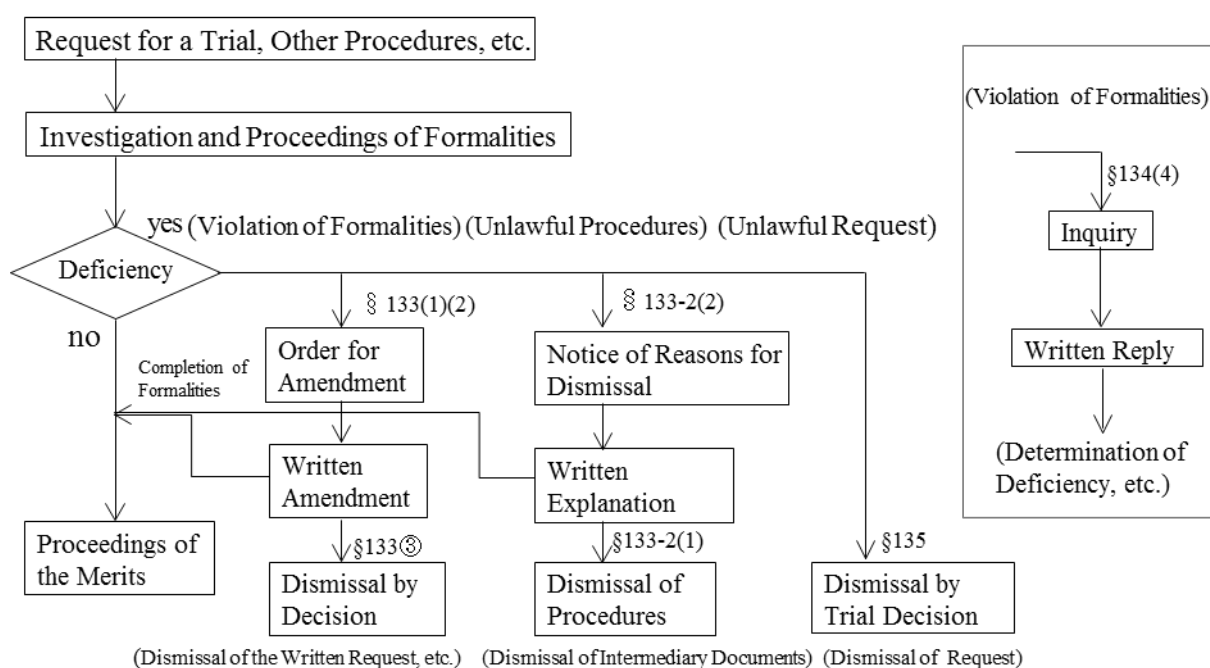
(Revised June 2019)

51-08 P U D T

Deficiency and Amendment of a Request for a Trial for Invalidation

1. Deficiency of a Request (in writing) and Disposition

A chief administrative judge has an authority regarding formalities (the Patent Act Article 133). Under this authority, in the process of a request for trial, examinations of the formalities by a trial clerk and proceedings of the formalities by a panel are conducted prior to the proceedings of the merits (→21-00).



A demandant may make amendments in the written request for a trial when the case is in pending before the Japan Patent Office (the Patent Act Article 17(1); the Utility Model Act Article 2-2; the Design Act Article 60-3; the Trademark Act Article 68-40(1)).

If any violation of the requirements of descriptions is found in the written request for trial and a demandant does not make any voluntary amendments, the JPO can take one of the following actions:

(1) If the violation of the requirements of descriptions has not been resolved after the chief administrative judge has provided an opportunity to amend with an order for amendments, the chief administrative judge will dismiss the written request for trial by

decision (the Patent Act Article 133(1) (3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(2) The panel dismisses the request for trial by a trial decision without providing an opportunity to amend (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(3) Conducting an inquiry to clarify facts and findings (the Patent Act Article 134(4); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4))

The action to be taken will be determined by the degree of possibility of resolving the violation of the description requirements in the written request for a trial through lawful amendments.

(Notes) Amendment by the concerned party: (→ 22-01 9.(2))

- a. Should be a change in the gist except where both a demandant and a demandee remain the same
- b. Should be a change in the gist, in principle, where only some co-patentees are listed as demandees and to supplement the rest of the co-patentees (to be comprehensively determined by reviewing the whole purport)
- c. Should not be a change in the gist for an amendment of supplementing the missing name of a representative of a corporation and changing the name of the representative that is already shown
- d. Should not be a change in the gist for the amendment of correcting the representative's incorrect name and the patent attorney's address

2. Order for Amendment and Dismissal of a Written Request for a Trial by Decision

(1) Descriptions other than “Reasons for request” in the written request for a trial

When the violation of the requirements of descriptions other than “reasons for request” in the written request for trial is minor and may be resolved, amendments will be ordered (the Patent Act Article 133(1); the Utility Model Act Article 4; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Examples of the order for amendments are as follows:

- A. A request filed by any person (minors, adult wards, etc.) who does not have sufficient capacity of implementing the procedures;
- B. A request filed in violation of the provisions of the scope of authority of representation;
- C. A request made in violation of the laws in the Patent Act, etc. or formalities pursuant to the governmental or ministerial ordinances;
- D. A request with unpaid predetermined fees; and
- E. Evidence in a foreign language without translated descriptions.

(2) About “Reasons for request”

The requirements of descriptions of the “reasons for request” (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52) serve to reduce the demandee’s unnecessary task of addressing matters owing to insufficient descriptions of original reasons for request in writing and to prevent any delay in the proceedings resulting from any violation of the requirements of descriptions.

Accordingly, determining whether the “reasons for request” satisfy the requirements of descriptions may be, for instance, based on the following:

- (1) Whether the descriptions of reasons for the request allow the demandee to identify a subject for counterargument;
- (2) Even if the demandee can identify a subject for counterargument, whether the descriptions of reasons for the request may create any unreasonable burden on the demandee; and
- (3) Whether any deficiency of the descriptions of reasons for the request may cause the demandee to provide any irrelevant response to the subject and thus any substantial counterargument cannot be expected.

Determining whether the reasons for request satisfy the description requirements has a nature to be made by each case based on, for example, the nature or content of the requirements according to acts and provisions in line with reasons for invalidation and the content and complexity in the case’s relations of facts and findings. Therefore, the

determination should be reasonable and suitable according to the circumstances of the individual case.

The requirements of descriptions of the “reasons for request” are requirements of formalities; hence, they are not related to whether the request is accepted based on the descriptions of principal facts or not. In the same manner, the descriptions of the relations between facts and evidence may be satisfactory so long as corresponding relations are defined between the facts that require proof and evidence for proof; however, this has nothing to do with whether the evidence successfully prove the facts that require proof.

Examples of the order for amendments are as follows:

- A. When the volume or length of prior art publications, etc. is too extensive to identify the descriptions that indicate the existence of a prior art invention in evidence;
- B. When facts requiring proof and their evidence are listed to the extent that the descriptions fail to precisely identify each of those relations; and
- C. When relations between facts requiring proof and their evidence are described to a certain extent but fail to precisely identify what part of the evidence is attempting to prove the facts, and when such points are still missing even after an examination of the written request for a trial and other attached documents

(3) Decision to dismiss a written request for trial

In response to an order for amendments set forth in the aforementioned (1) and (2), when a demandant fails to follow the order, when any violation of the requirements of descriptions still remains unresolved even after the amendment, or when the amendment violates the Patent Act Article 131-2(1) (for example, when the amendment changes the gist of the reasons for the request or the gist of the purport of the request), the written request for trial for invalidation may be dismissed by a decision (the Patent Act Article 133(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

3. Dismissal by Trial Decision

If there is any substantial violation of the requirements of descriptions in the written request for a trial and if the amendment is made to resolve the violation, it may evidently require, without intention, a change in the gist of the written request for a trial or it may miss the essential requirements in the written request for trial. On such occasions, the said request will be dismissed by a trial decision as “unlawful request for a trial but unamendable,” without providing any order for amendments as well as any opportunity for submitting a written reply to the right holder (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(Explanation)

Any amendment in the written request for a trial shall not change the gist of the written request. Therefore, if the amendment needs to change the gist of the written request to resolve a violation of the requirements of descriptions in a written request for a trial, such an amendment is not allowed and results into the inability to resolve the violation.

However, some amendments changing the gist of the reasons for request may be permitted in exceptional cases by a chief administrative judge (the Patent Act Article 131-2(2); the Utility Model Act Article 38-2(2); the Design Act Article 52). Even if an amendment changing the gist is made to resolve the violation of the requirements of descriptions of the reasons for request before servicing a duplicate of the written request to the demandee, the chief administrative judge still cannot permit the amendment. Consequently, violation of the requirements of descriptions will never be resolved.

Thus, the case should be handled as mentioned above (The Patent Act Article 131-2(3), the Utility Model Act Article 38-2(3), the Design Act Article 52).

The following cases is applicable to any substantial violation of the requirements of descriptions in the written request for trial, or to any essential requirements that are missing in the request. Therefore, the request shall be dismissed by a trial decision.

A. No descriptions about the reasons for request

(Example 1) Either when nothing is described about the reasons for request in writing or when the description simply says, “To be supplemented.”

(Example 2) When asserting the reasons for invalidation that do not fall under any statutory reasons for invalidation.

B. Substantially, nothing is described about the reasons for request

(Example 1) Even though the reasons for invalidation are described abstractly, the absence of specific facts and evidence indicating the reason for invalidation.

(Example 2) Even though specific facts are described to a certain extent and evidence is presented, it is impossible to identify which reasons for invalidation is applicable to the subject patent (registration) in the argument from the facts and the evidence presented in the request.

C. No descriptions about the principal facts on critical requirements

(Example 1) In the reasons for invalidation in violation of inventive step (the Patent Act Article 29(2)), nothing is described about the fact of existence of “inventions (prior art inventions) listed in the respective items of the preceding paragraph.”

(Example 2) Failure to describe a comparison between the subject patented invention and a prior art invention, thereby resulting into the inability to understand specific reasons for the request.

(Example 3) Failure to describe the reasons for having easily arrived at the patented invention on the basis of the prior art invention (including its logical structure for the arrival), thereby resulting into the inability to understand specific reasons for the request.

D. Failure to precisely describe principal facts and to include appropriate evidence

(Example) When any evidence is not attached to the written request for a trial, the descriptions of the reasons for request are not specific enough to understand the principal facts without evidence.

(Even though failure to attach any evidence in the initial request for a trial does not constitute violation of the description requirements on the assumption that any evidence

be presented in the subsequent examination of evidence, it should be noted that such a case necessitates the descriptions of reasons for request to be more specific to understand the principal facts without presenting any evidence unlike any other cases that have evidence attached.)

E. Others

(Example 1) Failure to identify all co-owners of right as demandees (the Patent Act Article 132(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→ 22-03 2.; 51-05 2.; an example of a trial decision 45-20)

(Example 2) A person who is not a right holder is identified as a demandee (the Patent Act Article 132(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→ 22-01; 51-05 2.; an example of a trial decision 45-20). (Example 3) In a trial for invalidation of a patent, or a trial for invalidation of a trademark registration, a demandant is not a party concerned (the Patent Act Article 123(2), the Trademark Act Article 46(2)) (→ 31-01).

(Example 4) In a trial for invalidation of a patent, the claims requested for invalidation are all deleted as a result of correction (→ 51-19 3.).

(Example 5) In a trial for invalidation of a patent, some of the claims requested for invalidation are deleted as a result of correction (Dismissal of the trial decision on the deleted claims → 51-19 3.).

(Example 6) Invalidation or rescission of the right has become final and binding as a result of another case of a trial for invalidation or any other case of opposition to grant of patent.

(Example 7) Any request for trial is filed after the lapse of the period of statute of limitations (Trademarks).

4. Dismissal of Other Unlawful Procedures

Any deficiency in the formalities other than the written request in procedures relating to any case of trials shall be ordered for amendments. Failure to amend the deficiency

within a designated period shall cause the procedures to be dismissed by a decision of the chief administrative judge (the Patent Act Article 133; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1)). In addition, other than the written request for trial, any unlawful and unamendable procedures shall be dismissed by a decision after an opportunity is provided for submitting a statement of explanation by notifying reasons for dismissal (the Patent Act Article 133-2(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1)).

5. The Chief Administrative Judge's and Panel's Discretion

(1) Order for Amendments and Dismissal

Formal proceedings of the requirements of descriptions of the reasons for request are a matter to be examined *ex officio*. Accordingly, if any violation of the requirements of descriptions is found in the written request for trial, the chief administrative judge shall order amendments to those written request for a trial. An order for amendments serves to ensure an opportunity to resolve any violation of the description requirements. Therefore, as for any request for a trial that will not be dismissed definitively by a decision, an order for amendments may not be required. The chief administrative judge has the discretion to determine whether issuing an order for amendments is required.

If an amendment by order is found unable to resolve the violation of the requirements of descriptions, "the procedures may be dismissed by a decision" (the Patent Act Article 133(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)). Accordingly, the chief administrative judge has the discretion to determine whether a case should be dismissed by a decision.

If existing substantial violation of the requirements of descriptions in a written request for trial cannot be resolved through amendments, the request can be dismissed by a trial decision (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)). However, the panel has the discretion to determine whether to dismiss the request by a trial decision or to order

an amendment.

Therefore, if violation of the requirements of descriptions is minor, causing no substantial problem, it does not matter even if the chief administrative judge, or the panel does not order amendments and dismiss the procedures by a decision, or does not dismiss the procedures by a trial decision. Similarly, when the matter to be amended by an order still retains an unresolved part even after the amendment, whether to dismiss the case by a decision will be determined by considering significance of the violation.

(2) Handling when an Amendment Changes the Gist

Some amendments that might change the gist of reasons for request prior to the service of a duplicate of a written request for a trial to a patentee are in the stage before proceedings of the merits and hence might not cause any significant delay in the proceedings. Thus, if an order is issued for amendments of any deficiency in the requirements of descriptions prior to the service of a duplicate of a written request for trial to a patentee, if amendments corresponding to the order may resolve the violation of requirements of descriptions in the reasons for request, and if such amendments do not significantly change the gist, such amendments might be acceptable (→51-16 1.).

Meanwhile, given the purport that maintains the principle of prohibiting any amendment that may change the gist of reasons for request, amendments of reasons for request after conducting the proceedings of the merits should be stricter to be determined under the provisions of the prohibition of change of the gist than those before conducting the proceedings of the merits.

6. Filing an Appeal

Actions of an appeal against a trial decision to dismiss a request for a trial according to the Patent Act Article 135, or an appeal against a decision to dismiss the written request for a trial according to the Patent Act Article 133(3) may be filed at the Tokyo High Court (the intellectual Property 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)).

Meanwhile, actions of appeals against any dismissal of other procedures may be requested according to the Administrative Appeal Act Article 2, or may be filed at a district court.

(Revised June 2019)

51-09 P U D T

Formalities of Proceedings of a Trial for Invalidation

1. Appointment of a Panel for a Trial

In a trial for invalidation, a panel of three or five administrative judges appointed by Commissioner of the Patent Office conducts the proceedings. In principle, two or more cases of a trial for invalidation over the same rights are undertaken by the same panel. (Participation in preliminary trials → (12-04))

2. Progress of Proceedings of a Case of a Trial for Invalidation

Any established registration of rights (e.g., patent rights) might sometimes be involved in a multiple pending cases simultaneously. Therefore, for proceedings of a trial for invalidation case, which proceedings should be undertaken with higher priority must necessarily be chosen carefully in the progress of proceedings.

Any trial procedures may be suspended until another a trial decision has become final and binding, or the court procedures have been concluded (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)).

(For reference)

Order of proceedings when a trial for correction is pending (→ 51-22)

Proceedings when two or more trials for invalidation of the same right have been simultaneously pending (→ 51-22.1)

Both an opposition to grant of patent and a trial for invalidation over the same right are simultaneously pending (→ 67-09)

Starting and ending of the procedures (→ 26-01 6.)

3. Formalities of Proceedings

(1) Oral proceedings

A trial for invalidation is conducted by oral proceedings (→ 33-00). However, the chief trial examiner may change the oral proceedings to documentary proceedings upon a request from concerned parties, intervenors, or ex officio (the Patent Act Article 145(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Nevertheless, after changing the oral proceedings to documentary proceedings, changing it back to oral proceedings is possible. In such a case, a notice of oral proceedings is issued.

Since a trial for invalidation takes the adversary system, oral proceedings facilitate factual findings accurately so that points of dispute between the concerned parties can be organized properly, thereby allowing for fast and precise proceedings.

(2) Documentary proceedings

A. A trial for invalidation is basically conducted through oral proceedings, but in the following exceptional cases, documentary proceedings may be allowed. (→ 33-00.1)

- If a request for a trial or its procedures (a written request for trial) should be dismissed.
- If concerned parties evidently have no intention of arguing with each other.
- All the concerned parties (including intervenors) are requesting the documentary proceedings.
- Any other cases wherein oral proceedings will not be required.

B. Notice of the documentary proceedings

When the proceedings are conducted by documents, a notice of documentary proceedings must be issued. However, a notice of documentary proceedings is not necessary for the case of a dismissal of a written request for a trial by a decision of a chief administrative judge, or a dismissal of a request for a trial by a trial decision without giving a demandee an opportunity to submit a written reply.(→ 32-01)

4. Ex officio Proceedings (→36-01, 51-18, 51-14 2.)

The principle of ex officio is adopted in any trial because a trial serves not only to

benefit the concerned parties but also to solve problems of broader perspectives wherein interests of any third parties might be involved. Therefore, if the purport of a request that a demandant does not request cannot be subject to proceedings (the Patent Act Article 153(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). However, investigating the facts and examining evidences, or preserving evidences ex officio is possible without being based on or bound by the concerned parties' arguments and, if necessary, the procedures may be suspend (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)) or resumed ex officio even after notifying termination of the proceedings (the Patent Act Article 156(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

However, if the concerned parties are mutually confrontational, it is considered appropriate that the proceedings shall be conducted depending on the demandant's assertions and proof. Therefore, proceedings ex officio as a panel are rather exceptional and, to a certain degree, should be interpreted as supplementing the proceedings. (→ 51-18)

5. Consolidated Proceedings

(1) General matters of consolidated proceedings (→ 80-03 1.)

(2) Consolidated proceedings in a trial for invalidation

If, in two or more trials for invalidation, both the concerned parties or even one of them is the same (in such a case, rights are not required to be identical), consolidated proceedings of those different trials may avoid overlapping of the proceedings, facilitate procedures efficiently, and prevent trial decisions from contradicting or conflicting with each other (the Patent Act Article 154(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(3) Cases suitable for consolidated proceedings

Examples of cases suitable for consolidated proceedings are as follows:

- A. Any case wherein similar examination of evidence are undertaken, for instance, examination of the same witnesses
- B. Any case having inventions subject to a common technical basis
- C. Any case having the same evidence (documents as the means of proof, object to be inspected, etc.)
- D. Any case over the same rights

However, even when a case falls under one of the above, there might be two or more trials for invalidation requested for the same patent, but on occasions, corrections requested in only one of those trial cases, or different corrections are requested for each case from multiple cases. In that context, a consolidation of the trials may pose an obstacle to proceedings of multiple cases. Thus, it would be appropriate to consider not consolidating the proceedings and rather prioritizing one case for proceedings and suspending the remaining cases. (→ 51-22.1; co-pending of multiple trials for invalidation)

(4) Consolidated proceedings in a trial for invalidation of the registration of a utility model

When trials for invalidation over the same utility model registration are co-pending, those cases, in principle, should not be consolidated. Instead, proceedings of individual cases should be undertaken in the chronological order of each request. Proceedings may be consolidated only when it is determined that the consolidated proceedings would handle the case faster and more precisely (e.g., when evidences are in common (the Utility Model Act Article 41; the Patent Act Article 154(1))).

(Explanation) Correction of the utility model registration is a different procedure from a trial for invalidation of the registration of a utility model. Correction of the said registration comes into effect upon the receipt of the documents of correction (the Utility Model Act Article 14-2(3)). Thus, no confusion may exist in the procedures, as seen in the patent for which different corrections corresponding to different trials for invalidation are requested.

Accordingly, a consolidated proceedings may not be necessary in registrations of

utility models, except in a situation of having evidences in common, so that the consolidated proceedings produce faster and more precise proceedings.

(5) Time to consolidate proceedings

The time to consolidate proceedings is before conclusion of proceedings.

(6) Effects of consolidation

A. A trial decision of consolidated cases can be made in one document of a trial decision. However, said document of the trial decision must describe each conclusion and reason by each case of the consolidated cases, as results of the consolidated proceedings.

B. For multiple cases whose proceedings are consolidated, any commonly necessary examination of evidence can be done at one time.

C. The documents and other articles submitted or presented in each case of trials before consolidation and, the means of proof, etc. obtained as a result of the proceedings of each case of trials can be used for the proceedings of each case of trials whose proceedings are consolidated. However, when adopting the means of proof submitted in one case for another case, the concerned parties of another case must be provided with an opportunity for a motion to express their opinions.

(7) To consolidate proceedings

A. To determine whether the proceedings should be consolidated, a panel investigates whether multiple trials for invalidation fulfill the requirements for consolidated proceedings while examining from the view point such as efficiency of the procedures without duplication of the proceedings, or prevention of contradiction and conflict with other trial decisions.

B. If the panel decides to consolidate the proceedings, the chief administrative judge notifies both the concerned parties of the decision to consolidate the proceedings.

C. In multiple trials consolidated for the proceedings, all the procedures and proceedings, including sending duplicates of the documents of counterstatement and related documents to the concerned parties, notices, collegial examinations, oral proceedings (including oral examinations and interviews), examinations of evidences, and an advance notice of trial decision will be conducted under the same procedures.

In such a case, all the descriptions of the cases of trials to be examined by consolidated proceedings, such as a trial number, a patent number, and names of the concerned parties, must be stated in the spaces in notices and in any other documents .

D. When all trials of the consolidated proceedings are examined sufficiently to make a trial decision, an advance notice of trial decision may be issued, or proceedings may be terminated.

(8) Trial decision of consolidated proceedings

See notes for the trial decision after the proceedings are consolidated (→ 45-03 2.).

(9) Separation of proceedings (30-03 2.)

After consolidation, the consolidated proceedings may still be separated (the Patent Act Article 154(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). The proceedings may be separated ex officio at the panel's discretion. A situation where consolidated proceedings need separation is, for example, when the cases consolidated for proceedings are found to include mutually irrelevant cases for which trials do not have to be implemented under the same procedures, or when a situation might be that the proceedings could be more complicated or delayed unless the proceedings are separated.

(Revised June 2019)

51-10 P U D T

Initiation of Proceedings of a Trial for Invalidation

1. Procedures at the Initiation of Proceedings of a Trial for Invalidation

(1) Service of a duplicate of a written request

When a trial for invalidation is requested, upon examining whether the request for a trial meets the formal requirements (any deficiency in a request for a trial for invalidation and amendments thereof (→ 51-08), a chief administrative judge shall serve a duplicate of the written request on a demandee and give the demandee an opportunity to submit a written answer within an adequate, specified period of time (→ 25-01.2) (Invitation to submit a written answer) (the Patent Act Article 134(1); the Utility Model Act Article 39; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(2) Notice to an exclusive licensee, etc.

When a trial for invalidation is requested, a notice to that effect is notified to an exclusive licensee under the concerned patent right and any other persons with registered rights under that patent (the Patent Act Article 123(4); the Utility Model Act Article 37(4); the Design Act Article 48(4); the Trademark Act Article 46(4), 68(4) →11-02).

(3) Dispatch of the submitted documents

Duplicates of the submitted documents are served to the counterparty.

(4) When a demandant requests an examination of evidence

When a demandant requests an examination of evidence, such as interrogation of a witness from the outset of the request for a trial, and when it is deemed appropriate to provide the demandee an opportunity to answer or request correction after having a demandant submit evidence that may substantiate the demandant's assertion in the examination of evidence, first serving a duplicate of the request for a trial and then conducting the examination of evidence, thereafter providing an opportunity to answer

or request correction is permissible.

In this case, a notice with which a duplicate of the request for trial is served shall include a notice to the effect that a period of time for answering or requesting correction will be specified after conducting an examination of evidence. Notably, before the said period of time is specified, while the demandee may not be precluded from filing a written answer, the demandee may not request for correction either.

(For reference) When a request for intervene has been made (→57-00 - 09)

2. Written Answer and a Request for Correction

(1) Opportunity to answer

A demandee (right holder) may refute the reasons for invalidation asserted by a demandant by filing a written answer during opportunities to answer, provided as follows:

A. Statutory opportunity to answer

Upon receiving the service of a duplicate of a written request, a demandee may file a written answer within a specified period of time (→ 25-01.2) (the Patent Act Article 134(1); the Utility Model Act Article 39(1); the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Likewise, when a chief administrative judge permits an amendment to change the gist of reasons for request stated in a written request for a trial for invalidation (including an amendment changing the gist of reasons for the request in a written argument or a brief of an oral proceedings statement), in principle, an opportunity is given to file a written answer within a specified period of time (the Patent Act Article 134(2); the Utility Model Act Article 39(2); the Design Act Article 52).

In a trial for patent invalidation, a request may be made to make corrections in a specification, claims, or drawings attached to an application within these specified periods of time (Patent Act Article 134-2(1)) (→ 51-11).

B. Opportunity to answer as provided for in enforcement regulations

In addition to giving said statutory opportunities to answer, when deemed necessary,

a chief administrative judge may request that a demandee file a written answer within an adequate, specified period of time (Enforcement Regulations of the Patent Act Article 47-2(1); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)).

While a demandee may file a written answer to a chief administrative judge within the specified period of time, the demandee may not request for correction even within the said period of time.

(2) Form of the written answer

A written answer must be prepared in Form 63 pursuant to Enforcement Regulations of the Patent Act (Enforcement Regulations of the Patent Act 47(1); Enforcement Regulations of the Utility Model Act Article 23(13); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)).

(Revised June 2019)

51-11 P

Request for Correction by Patentees

1. Request for Correction

In a trial for invalidation of a patent, the right holder may request correction in a specification, claims, or drawings attached to an application during the procedure for a trial for invalidation (the Patent Act Article 134-2(1)).

(1) Time period within which a request for correction may be made

A request for correction may only be made within one of the periods of time specified below (the Patent Act Article 134-2(1)). A written request for any correction filed other than the specified time period is dismissed as noncompliant with the time requirement upon notification of the reasons for dismissal.

A. A time period for filing a written answer after service of a duplicate of the request for a trial for invalidation (the Patent Act Article 134(1));

B. When a chief administrative judge has permitted amendment to change the gist of the “Reasons for Request” in a written request for trial, a time period for filing a written answer after service of a duplicate of the written amendment of the procedure of the said written request for trial (the Patent Act Article 134(2));

C. A time period for requesting correction in response to a right holder’s motion for correction when a trial decision to maintain the right has been rescinded in litigation rescinding a trial decision on a trial (the Patent Act Article 134-3);

D. A time period for filing a written opinion in response to an ex-officio notice of reasons for invalidation (the Patent Act Article 153(2));

E. A time period for requesting correction in response to an advance notice of trial decision (the Patent Act Article 164-2(2)).

(2) Subject for which correction may be requested (→ 38-00)

Since an opportunity for requesting a trial for correction is restricted when a trial for invalidation is pending, a request for correction may also be made for a claim for which

a trial for invalidation is not requested (the Patent Act Articles 134-2(9), 126(7)).

A. Unit of request for correction and a group of claims (→ 38-00 - 01)

B. Correction of specification or drawing (→ 38-02)

(3) Requirements for correction (→ 38-03)

The requirements for correction in a request for correction are the same as those for a trial for correction, except that a requirement that corrections be such as would allow an invention as corrected to be patented independently upon filing a patent application (requirements for independent patentability; corrections are limited to those for restriction of the claims and correction of errors or mistranslations) applies only to claims for which a trial for invalidation has not been requested (the Patent Act Articles 134-2(9), 126(7)).

2. Formal Requirements for a Request for Correction

(1) Written request for correction

A request for correction shall be made by filing a specified written request for correction (Enforcement Regulations of the Patent Act Article 47(2), Form 63-2). A purport of and reasons for the request to be stated in a written request for correction must be described to meet the requirements of description of a written request for correction (the Patent Act Articles 134-2(9), 131(3); Enforcement Regulations of the Patent Act Article 46-2).

To a request for correction, provisions for consent of an exclusive licensee (the Patent Act Article 127), formal requirements for a request for trial (the Patent Act Article 131), and a joint trial (the Patent Act Article 132(3)) are applied mutatis mutandis (the Patent Act Article 134-2(9)) as in a trial for correction.

(2) Purport and reasons for request (→ 38-04)

(3) Corrected specification, etc. (→ 38-05)

(4) Fees (→ 38-06)

(5) Submission of duplicates of the request for correction, etc.

When filing a written request for correction, a corrected specification, etc., a

demandee (patentee) shall submit a required number of duplicates thereof (the number of demandants + the number of intervenors + 1 (for the proceedings)) (Enforcement Regulations of the Patent Act Articles 4, 50-4)

3. Handling the Case When Multiple Requests for Correction Are Made

When multiple requests for correction are made in one case of a trial for invalidation, the preceding requests for correction are deemed to be withdrawn (the Patent Act Article 134-2(6)).

However, when corrections made in relating to the preceding requests for correction become final and binding, the request for correction concerning those corrections (wherein a part thereof has become final and binding) is not deemed to be withdrawn.

Accordingly, from the second request for correction onward, a specification, claims, and drawings of a patent based on which the corrections are to be made are the specification, claims, and drawings as registered (or as corrected where corrections already made final and binding exist) and not the corrected specification, corrected claims, or corrected drawings attached to the immediately preceding request for correction.

The provision for “deemed withdrawn” is applied when a request for correction is made multiple times in one case of trial for invalidation but not applied when separate requests for corrections are made in multiple cases of trials for invalidation of the same right.

Even when one request for correction is made in one case of a trial for invalidation of a right and another request for correction is made in another case of a trial for invalidation of the said right, before or after the one said request, the said request for correction in the said case of a trial for invalidation is not deemed to be withdrawn because of such circumstances. As a result, requests for correction in respective cases exist as respective procedures for a trial for invalidation and remain to be subject for proceedings.

(For reference) When multiple trials are pending on one patent right, the following is

to be noted:

When a trial decision to allow corrections becomes final and binding, the effects of the corrections are retroactive to the date on which the patent application was filed pursuant to the provisions of the Patent Act Article 128 (effects of corrections → 46-00 3.). Therefore, when multiple trials for invalidation (a trial for invalidation, a trial for correction, an opposition to grant of patent, etc.) are pending on the same patent right and when a trial decision to allow the corrections becomes final and binding in one of the cases, the effects of corrections of the patent right made final and binding extend to all the other cases.

For example, when a request for correction has been made in another case, the subject of correction is changed as a result of the corrections made final and binding, and the judgment as to whether the said request for correction is proper may change, or other effects might be caused.

To prevent such a situation, a chief administrative judge needs to see that proceedings advance properly by, for instance, suspending (→ 26-01 6.) or consolidating (→ 30-03 1.) the proceedings with those of other cases of trial for invalidation.

4. Withdrawal of a Request for Correction

Request for correction may be withdrawn only within the period of time in which an amendment referred to in the Patent Act Article 17-5(2) may be made (the Patent Act Article 134-2(7)). When the request for correction has been withdrawn, the counterparty is notified thereof (Enforcement Regulations of the Patent Act Article 50-5-2).

When a request for correction is withdrawn, the entire request must be withdrawn (the Patent Act Article 134-2(7)).

Accordingly, when only a part of a request for correction is to be cancelled, a procedure for deleting the part of the matters to be corrected must be followed by amending a written request for correction (the Patent Act Article 17(1)) and amending the specification, claims, and drawings concerning the corrections (the Patent Act Article 17-5(1)) in lieu of withdrawing said part of the request for correction.

Since a request for correction presupposes a trial for invalidation, when a trial for invalidation is withdrawn, the request for correction is also deemed to be withdrawn. Likewise, when a request for a trial for invalidation is withdrawn for each claim, the request for correction is deemed to be withdrawn on a claim-by-claim basis (the Patent Act Article 134-2(8)). (In this case, even when claims constitute “a group of claims” (→ 38-01), only the request for correction relating to the applicable claims on a claim-by-claim basis is deemed to be withdrawn.)

5. Effects of Correction (→ 46-00 3.)

When a trial decision to allow the correction in a trial for invalidation becomes final and binding, a patent application, a publication of the unexamined of a patent application, an examiner’s decision or a trial decision to the effect that the patent is to be granted, and a registration of the establishment of a patent right are all deemed to have been conducted based on the corrected application, etc. (the Patent Act Articles 134-2(9), 128).

A request for correction, unlike a trial for correction, is never made only by concluding that “the correction is allowed” but includes a judgment allowing the correction in the conclusion of a trial decision on a trial for invalidation; thus, the correction becomes effective only at the time when a trial decision to allow the correction becomes final and binding, i.e., at the time when a trial decision on a trial for invalidation becomes final and binding. Accordingly, when litigation rescinding a decision on a trial is instituted over a trial decision on a trial for invalidation where a request for correction is submitted, the trial decision on the trial for invalidation does not become final and binding until litigation is concluded, and the correction takes effect thereafter.

6. Preliminary Registration of a Request for Correction

Because a third party may predict the possibility that a request for correction of a specification, etc. may be filed from a preliminary registration of a trial for invalidation

(the Patent Registration Order, Article 3), no preliminary registration to the effect that a request for correction is filed, unlike in a trial for correction.

(Revised June 2019)

51-13 P U D T**Proceedings After the First Answer****1. Proceedings Following a Demandee's First Answer****(1) Proceedings of formalities**

A chief administrative judge and a panel examine the formalities of a written answer and a written request for correction filed by a demandee when the first answer is made, and give an order for amendment when any deficiency is found (→ 21-00, 51-08) (Proceedings Following the Submission of a Written Request for Correction → 51-14).

(2) Basis of proceedings of merits

When no formal deficiency is found in a written answer or a written request for correction, or when a formal deficiency is corrected, the proceedings are conducted on the basis of reasons for invalidation asserted and proved in a written request for a trial, and a written answer, a written request for correction, a corrected specification, and corrected claims or drawings filed by a demandee.

(3) Procedure following the first answer

In general, upon a demandee's submission of a written answer, since both the demandant's assertion and the demandee's argument are filed for the present, the point at issue have been made clear.

This is followed by oral proceedings in a trial for invalidation. (→ 33-00)

In the oral proceedings, procedures to clarify the facts that are necessary to determine a case are conducted before the oral proceedings. These procedures include clarifying what is the issue by presenting a panel's conviction, where necessary; notifying the concerned parties of a notice of proceeding matters itemizing subjects examined in the oral proceedings (→ 33-08); and having the parties submit their arguments as an oral proceedings statement brief regarding the subjects listed in the said notice to clarify the facts and findings necessary to determine the case in the oral proceedings. Thus, usually, when arranging a date for the oral proceedings, a notice of proceeding matters

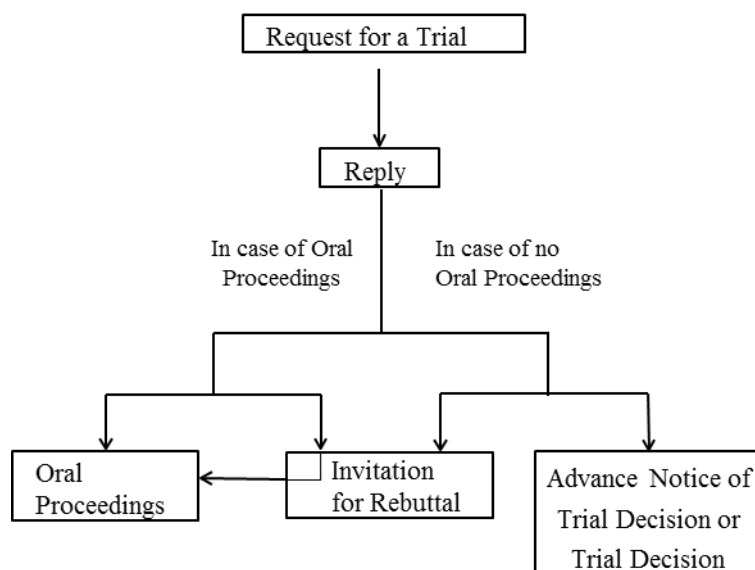
without the date is sent to both parties by facsimile and a duplicate of the written answer, etc. is served on a demandant. After a date for the oral proceedings is fixed, a notice of proceeding matters with the date is sent to the both parties (→ 33-08).

Under special circumstances, such as when seeking an opinion from a demandant prior to the oral proceedings is necessary, a duplicate of the written answer may be served on a demandant before arranging a date for the oral proceedings to give the demandant an opportunity to submit an argument within a specified period of time.

In exceptional cases wherein documentary proceedings are to be conducted in lieu of oral proceedings, a notice of documentary proceedings is made. Subsequently, a judgment is made as to whether the time is ripe for making a trial decision and, when it is decided that the time is ripe, either an advance notice of trial decision (patent) is made, or the proceedings are concluded to make the trial decision.

When giving the advance notice of trial decision or giving a notice of the conclusion of the proceedings, a duplicate of the written answer is served on the demandant by the time of such service.

When the proceedings are deemed not yet ready for a trial decision; for example, when providing a demandant an opportunity to reply to the demandee's refutation is deemed necessary, a duplicate of the written answer is served on the demandant (the Patent Act Article 134(3); the Utility Model Act Article 39(3); the Design Act Article 52; the Trademark Act Article 56(1)), to provide an opportunity to rebut (Enforcement Regulations of the Patent Act 47-3(1); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)).



(4) Connections with other cases

When a written answer's content includes content that is inconsistent with the assertions made in other cases (trial for invalidation, opposition to grant of patent, infringement, etc.) concerning the same patent right and when the assertions concerning the inconsistent matters may be treated as file-wrapper estoppel, it is possible that such assertions may not be used.

(Judicial precedent)

“A patentee is not permitted to be inconsistent with assertions made in a written request for the trial decision, a written response to opposition to a grant of patent, and a written supplementary argument of reasons against a request for the trial for patent invalidation.” (the Tokyo District Court, March 25, 1970 (1964 (Wa) No. 3746) Hanrei Times, No. 247, p. 263)

(Revised June 2019)

51-14 P

Proceedings After Submission of a Written Request for Correction

1. Formalities of a Written Request for Correction and the Amendment Thereof

(1) Matters of proceedings of the formalities of a request for correction

A chief administrative judge and the associated panel conduct proceedings of formalities to determine whether a written request for correction, its appendices, or other similar documents comply with the provisions of the Patent Act Article 131 (the Patent Act Article 131(1)(3)(4)), which are applied mutatis mutandis to the Patent Act Article 134-2(9); whether such documents fall under one of the items of the provisions of the Patent Act Article 133(2); or whether such documents comply with other matters (the Patent Act Article 134-2(9)→the Patent Act Article 127; the Patent Act Article 132(3), etc.). (Procedures for Request for a Trial for Correction → 54-04)

(2) Amendable noncompliance with formal requirements (the Patent Act Article 133)

When a written request for correction has amendable instances of noncompliance with formal requirements, such as insufficient payment of fees, formal deficiency of the power of attorney, or formal deficiency of a written consent in a case wherein an exclusive licensee exists, but no voluntary amendments have been made, a chief administrative judge orders the patentee to make the amendment within an adequate, specified period of time (normally 10–30 days, depending on the content of the formal deficiency; → 25-01.2) (the Patent Act Article 134-2(9) → the Patent Act Article 133(1); the Patent Act Article 133(2)).

When a purport of and reasons for a request stated in a written request for correction do not comply with the description requirements (the Patent Act Article 131(3); Enforcement Regulations of the Patent Act Article 46-2) (e.g., when a request for correction is not made on a claim-by-claim basis, although a request for a trial for invalidation is made on a claim-by-claim basis; when a group of claims is not accurately specified; or when not all the claims related to corrections of a specification or drawings

are designated as subjects for correction), a chief administrative judge orders the patentee to make amendments within an adequate, specified period of time (normally 30 days (50 days for overseas residents → 25-01.2)).

When the patentee does not correct matters for which correction is ordered, the chief administrative judge dismisses the written request for correction by a decision (the Patent Act Article 134-2(9) → the Patent Act Article 133(3)).

The patentee may institute an action objecting to the decision of the dismissal of the written request for correction in the Tokyo High Court (the Intellectual Property High Court) (the Patent Act Article 178(1)).

(3) Non-amendable noncompliant request for correction (the Patent Act Article 133-2)

When the noncompliance is such that no amendment thereof is permissible (e.g., when a request is made after a specified period of time, or when not all joint owners have jointly undertaken the necessary procedures), the patentee is notified of reasons for dismissal and given an opportunity to file a written explanation, after which a chief administrative judge dismisses the request for correction by a decision (the Patent Act Article 133-2(1)).

The patentee may file a complaint with regard to the decision of dismissal of a request for correction pursuant to the Administrative Complaint Review Act.

When making a trial decision on a case wherein the decision to dismiss a request for correction has been made, the panel adds a statement in the reasons for the said decision to the effect that the request for correction has been dismissed.

(4) Amendment of a written request for correction in response to an order

While an amendment of a written request for correction should not modify the gist thereof, correction of a matter that has been ordered is permitted even when the gist of the written request for correction is thereby modified, provided that such an amendment complies with the said order for correction (the Patent Act Article 131-2(1)(iii)).

(5) Inquiry (the Patent Act Article 134(4))

When examining a request for correction for compliance with the requirements, a chief

administrative judge may conduct the required inquiry; for example, when necessarily seeking clarification from a demandant for correction, to clarify the facts, the content of the request, etc.

2. Proceedings of the Content of Correction

(1) Requirements for correction (→38-03)

A. Purposes of correction (the Patent Act Article 134-2(1), provisos)

(A) Restriction of the scope of claims (the Patent Act Article 134-2(1), Proviso 1);

(B) Correction of errors or mistranslations (the Patent Act Article 134-2(1), Proviso 2);

(C) Clarification of an ambiguous statement (the Patent Act Article 134-2(1), Proviso 3); and

(D) Removal of dependency between the claims (rewriting a claim that cites another claim into a claim that does not cite the said other claim) (the Patent Act Article 134-2(1), Proviso 4).

B. Prohibition of addition of new matter (the Patent Act Article 134-2(9) → the Patent Act Article 126(5))

C. Prohibition of substantial expansion and change of claims (the Patent Act Article 134-2(9) → the Patent Act Article 126(6))

D. Requirements for independent patentability (claim for which no trial for invalidation has been requested and purposes falling under A (A) or (B) above) (the Patent Act Article 134-2(9) → the Patent Act Article 126(7))

(2) Examination of corrections and notice of reasons for rejecting a request for correction

The panel conducts a proceeding to identify whether a request for correction meets the requirements for correction based on a written request for correction and descriptions attached thereto, such as an entire specification with corrections.

When conducting an examination to identify whether the requirements for corrections are met, a judgment is made on each corrected matter's compliance with the requirements for correction.

Prior to judging compliance with the requirements B–D, judgment is made as to whether the requirements regarding the purposes of correction stated in A above are met. For any corrected matter found not to be meeting the requirements regarding the purposes of correction apparently, no further judgment on compliance with other requirements for correction need to be made.

Furthermore, regarding a correction concerning a claim for which no request for a trial for invalidation has been made, when such correction fails to comply with any of the requirements B–C even the correction is requested with regard to the purposes stated in A (A) or (B) above, no judgment on compliance with the requirements for independent patentability stated in D need to be made.

Final judgment on compliance of a requested correction with the requirements for correction is made on the basis of unit of request for correction. More specifically, judgment on compliance of a requested correction is made on the basis of each claim when a request for correction is made on a claim-by-claim basis; judgment is made on the basis of a group of claims when a request is made on a group-by-group basis; and judgment is made on the whole specification when a request for correction is made for the whole specification (a group of claims → 38-01; a correction of the specification or drawings → 38-02). As for a group of claims, for example, even when only a part thereof is found not to comply with requirements for correction, the correction is not admitted as a whole.

When a request for correction clearly does not comply with the requirements for correction and when ex-officio notification of reasons for rejecting a request for correction without awaiting the demandant's assertion help conduct prompt and accurate proceedings, a chief administrative judge notifies both parties and intervenors of the reasons for rejecting a request for correction on the reason of noncompliance with the requirements for correction (results of ex-officio proceedings), giving an opportunity to file an opinion within an adequate, specified period of time (normally 30 days (50 days for overseas residents → 25-01.2) (the Patent Act Article 134-2(5))). A notice of the reasons for rejecting a request for correction may be given in parallel

with an opportunity to file arguments as described in (3) below.

When a demandant asserts the illegitimacy of corrections, a notice of reasons for rejecting a request for correction need not necessarily be made, as specified in (3) below.

(3) Opportunity for a demandant to submit an opinion

When correction is requested, a duplicate of the written request is sent to a demandant to give the demandant an opportunity to state an opinion about the request for correction by submitting a written argument, an oral proceedings statement brief, etc. (opportunity for refutation).

However, a demandant need not be given an opportunity to state an opinion in the following cases:

- A. When the request for correction is deemed not to overcome the reasons for invalidation asserted and proved in a written request for trial;
- B. When reasons for request for trial for invalidation do not constitute proper reasons for invalidation of a patent that is yet to be corrected:

Example 1: When the reasons asserted by a demandant do not constitute proper reasons for invalidation, regardless of whether a request for correction has been made;

Example 2: When correction is requested only to a part for which no reasons for invalidation have been asserted and to a part for which no correction is requested, no proper reasons for invalidation are constituted.

- C. When it cannot be said the necessity for amending a reason for request has arisen due to a request for correction and when it cannot be said there is no rational reason for not having stated such reason for invalidation in the written request at the time of requesting a trial even if a new reason for invalidation has been added by giving a demandant an opportunity to state an opinion (the Patent Act Article 131-2(2)).

Example 1: When corrections in response to a request are minor;

Example 2: When corrections in response to a request involves only deletion of alternative matters specifying the invention or deletion of the claim(s).

3. Patentee's Response to the Notice of Reasons for Rejecting a Request for Correction

- (1) A demandee (patentee) who has received a notice of reasons for rejecting a request

for correction may file a written opinion and amend a corrected specification, etc. attached to a written request for correction (and also amend the written request for correction for consistency) within a specified period of time. When an exclusive licensee, etc. on a patent right exists, consent to the amendment must be given (the Patent Act Article 127).

A second amendment in a specified period of time is not permitted.

(2) Amendment of a corrected specification, etc. attached to a written request for correction may be amended only within one of the following periods of time (the Patent Act Article 17-5(2)):

- A. A time period for filing a written answer (the Patent Act Article 134(1) and (2));
- B. A time period for filing a written opinion about an ex-officio notice of reasons for patent invalidation (the Patent Act Article 153(2));
- C. A time period for filing a written opinion against a notice of reasons for rejecting a request for correction (the Patent Act Article 134-2(5); the Patent Act Article 134-2(3), 2003);
- D. A time period for requesting corrections when a rescission judgment, etc. has been given (the Patent Act Article 134-3, 2011; the Patent Act Article 134-3(1) and (2), 2003); and
- E. A time period for requesting corrections in response to an advance notice of trial decision (the Patent Act Article 164-2(2)).

A written request for correction may be amended before the service of a notice of the conclusion of proceedings (the Patent Act Articles 156(2), 17(1)). However, since the purport of the request in a written request for correction and a corrected specification, etc. should be essentially inseparable and consequently must be amended at the same time, in most cases, a written request for correction maybe amended, in effect, only when amendment of a corrected specification, etc. is permitted.

(3) In response to a notice of reasons for rejecting a request for correction, an amendment is permitted, provided that it does not change the gist of a written request for correction, such as deletion of a matter to be corrected, amendment of a minor defect,

etc.

As in amendment of a written request for a trial for correction, adding a new matter to be corrected or changing a matter to be corrected is treated as changing the gist of a written request for correction (the Patent Act Article 134-2(9) → the Patent Act Article 131-2(1)).

However, (1) an amendment in which a matter of correction concerning a claim is changed to a matter of deletion of the said claim and an amendment of a matter of correction concerning a corrected specification, etc. for consistency therewith, and (2) an amendment in which a matter of correction being a matter of deletion of a claim is added and an amendment of a matter of correction concerning a corrected specification, etc. for consistency therewith are not treated as changing the gist of a written request for correction (→ 54-05.1).

(4) After examining a written opinion and an amendment in response to a notice of reasons for rejecting a request for correction, when it is determined that the request for correction still does not comply with the requirements for correction, judgment is made on the reasons for invalidation on the supposition that the correction was not made. When it is determined that a request for correction complies with the requirements for correction, judgment is made on the reasons for invalidation on the premise that the correction should be allowed.

(Revised June 2019)

51-15 P U D T

Proceedings After Refutation of a Demandant

1. Proceedings After the First Refutation (an Argument Against the Answer) of a Demandant

(1) Proceedings of the formalities

A chief administrative judge and the panel examine the formalities of a written refutation (Enforcement Regulation of the Patent Act Article 47 3(1)), a written amendment of a written request for trial and a written opinion submitted by the demandant, and if there are any deficiencies, order an amendment, etc. (→21-00).

(2) Basis of the merits proceedings

If there is no deficiency in the formalities of the document, and the deficiency is corrected, the proceedings shall be conducted based on this document.

At this stage, any amendment to change the gist of the written request for trial is prohibited except as otherwise provided (the Patent Act Article 131-2(1)(2); the Utility Model Act Article 38-2(1)(2); the Design Act Article 52). First, it is examined whether the method of attack (such as a written refutation, a brief of an oral proceedings statement, a written amendment of a written request for trial, or a written opinion) submitted by the demandant constitutes a new invalidity reason that is equivalent to the amendment to change the gist of the reason for request listed in the original written request for trial. Next, when the gist of the reason for request is changed, it is examined whether the change is acceptable (for gist change → 51-16).

Even if the demandant's attack is conducted by a written refutation or a brief of an oral proceedings statement, etc., the same requirements are imposed as those for amendment permission to change the gist; in other words, it is similar to the way a written amendment is imposed, as it is substantially equal to the amendment of the reason for request written in the original document.

As a result of the examination, if it does not constitute a new reason for invalidation

equivalent to the change in the gist of the reason for request, or if it is a change in the gist of the reason for request but needs to be permitted, it will be the basis of the proceedings. Meanwhile, when it constitutes a new reason for invalidation equivalent to the change in the gist of the reason for request and is not to be authorized by the chief administrative judge, it will not be the basis of the proceedings.

2. Case of Not Including an Amendment that Changes the Gist of the Reason for Request

When the demandant's method of attack does not include amendment matters that change the gist of the reason for request, it usually does not need to request the demandee submitting a written answer again, and the oral proceedings can thus begin. However, if it is necessary to request a resubmission of a written answer because of special circumstances, it is possible to encourage the demandee to submit a written answer again within a specific period of time by sending a duplicate of a written refutation, a written amendment, etc. prior to the oral proceedings. . In this case, a new reason for invalidation is not constituted; therefore, usually, the provision of an opportunity to answer under the enforcement regulations that cannot request for correction is applied (Enforcement Regulation of the Patent Act Article 47-2(1); the Regulation under the Utility Model Act Article 23(12); the Regulation under the Design Act Article 19(8); the Regulation under the Trademark Act Article 22(6)).

In contrast, when the documentary proceedings are conducted exceptionally, it is determined whether the time is ripe to make a trial decision. If the time is ripe, an advance notice of a trial decision (patent) will be given, or the proceedings will be concluded to make a trial decision. For both cases of the advance notice of a trial decision and the proceedings' conclusion, a duplicate—such as the written refutation/written amendment of the written request for trial—is sent with a notice of the advance notice or of the conclusion of the proceedings to the demandee, but it does not prompt the submission of an answer. Additionally, if it is determined that the time is not yet ripe to make a decision, a duplicate of the written refutation/written amendment of the written request for trial is sent to the demandee. Then, after

specifying the appropriate period (normally 30 days (50 days for overseas residents) → 25-01.2), resubmission of a written answer is prompted (Enforcement Regulation of the Patent Act Article 47-2(1)).

If the claim and proof at the time of the refutation does not fall under the change of the gist, the provision of an opportunity to answer under the enforcement regulations (Enforcement Regulation of the Patent Act Article 47-2(1)) can usually be applied. However, it should be noted that even at such times, it is appropriate on occasion to reapply the provision of the first opportunity of statutory answer (the Patent Act Article 134(1)) to provide a request for correction.

3. Case of Including an Amendment that Changes the Gist of the Reasons for Request

(1) Requirements that allow amendments to change the gist (referred to as “requirements for permission to amend”) (the proviso of the Patent Act Article 131-2(1), 131-2(2); the proviso of the Utility Model Act Article 38-2(1), 38-2(2); the Design Act Article 52→the Patent Act Article 131-2 (except the Patent Act Article 131-2(2)(i)) Requirement 1: “It is obvious that the amendment does not unduly delay the proceedings” and

Requirement 2: “(1) There has been a request for correction under Article 134-2, paragraph 1, in the trial for invalidation of patent, and it has become necessary to amend reasons for request due to the request for correction.

(2) A rational reason exists for not stating the reason for request for concerning an amendment in a written request at the time of request for a trial, and the amendment has been agreed upon by the demandee.”

Thus, the chief administrative judge approves that there is a reason that falls under either (1) or (2).

A. There is no risk of a delay in the proceedings (Requirement 1) (a main paragraph of the Patent Act Article 131-2(2))

When an amendment that was made late without amending the reason for request at

the given opportunity for refutation, or an amendment that adds a reason for request not obviously constituting a proper reason for invalidation, it would only cause a delay in the proceedings; therefore, such amendments violate this requirement (see Examples 1–3 below).

(Example 1) When it is recognized that the reason for request replaced or added by the amendment does not constitute an appropriate reason for invalidation

(Example 2) When the reason for request added is substantially the same as that for reasons for invalidation constituted by the previously submitted facts or evidences

(Example 3) When it is necessary to give an additional opportunity for an answer to a demandee provided that the amendment is permitted, in case that the amendment is made late without amending the reason for request at the given opportunity for refutation

B. Attributable to the request for correction (Requirement 2) (the Patent Act Article 131-2(2)(i)) (patent)

It must be the amendment of the reason for request which should be attributable to and necessitated by a request for correction for patent, but taking advantage of adding a new reason for invalidation is not permitted, for example, regarding a claim that does not require correction in the request for correction.

(Example 1: Permission) In a case where an attempt is made to correct matters specifying the invention (A and B) relating to claims subject to a trial for invalidation into (A, B, and C) by a correction request corresponding to the reduction of the claims, when newly asserting that the corrected invention (A, B, and C) as well as the prior art corresponding to (C) as an evidence have an invalid reason based on the inventive step violation, it can be said that the necessity for amending the reason for request has arisen due to the correction mentioned above.

(Example 2: Non-permission) In a case where only claim 1 is subject to a request for correction, when asserting that reasons for invalidation not only on the basis of the inventive step violation as per a new evidence A against the corrected claim 1, but also on the basis of a lack of the inventive step as per a new evidence B against claim 2

which has not been corrected by taking advantage of the corrected claim 1, it cannot be said for the latter that the necessity for amending the reason for a request has arisen due to the correction. Moreover, when newly asserting the reason for invalidation for description deficiency in the description of the specification that is not corrected and not affected by the correction of claims, it cannot be said that the necessity for amending the reason for request has arisen due to the correction.

C. Rational reason not to be stated (Requirement 2) (the Patent Act Article 131-2(2)-(ii))

(A) When a submission of a patentee's written answer makes clear at the first time the interpretation of the claims, etc. of the patent invention claimed by the patentee and another reason for invalidation could be constituted based on the patentee's view of its interpretation, the demandant additionally alleges the reason for invalidation. However, when the description of the claims, etc. is clear and the interpretation of the claims by the patentee stays in normal interpretation, thereby the demandant for the trial for invalidation can naturally expect the interpretation, this shall not apply.

(Example) In a case where the reason for invalidation based on the violation of inventive step (the Patent Act Article 29(2)) was asserted for the reasons for request in the initial statement, but the patentee has answered that the claim should be interpreted in a limited manner and therefore has inventive step against the prior art, when the demandant argues to the effect that the amendment of the claim made before granted the patent violates the requirement for prohibition of adding new matter (the Patent Act Article 17-2(3)), according to the interpretation of the claim made by the patentee, a rational reason exists for not stating the refutation on the original written request for the trial.

(B) If the information under a third party's control (such as a client of the demandant for the trial for invalidation) is required as the grounds of the reasons for request for the trial for invalidation, and it took time to obtain the third party's consent to present the information in a trial for invalidation. However, rational reasons that requested the trial for invalidation are necessary prior to obtaining the consent. (Additionally, if the

initial reasons for request in a written request for an invalidation trial, which should be other than those based on the information available from the third party, are not described in the form of satisfying the description requirements as the “facts on which they are based for the patent invalidation”, this description violates the description requirements for the reasons for request.)

(C) When the demandant has asserted that the evidence could not be included in the reason for the original request for a trial for invalidation because a prior art document is described in a rare language, this assertion, however, cannot be approved as a rational reason that the original request for the trial for invalidation did not state the reason for the request. Another rational reason must be explained for the necessity that the trial has been requested without obtaining the prior art document of a rare language.

(2) In the case of not permitting amendments

When a demandant’s method of attack includes an amendment that changes the gist of the reason for request, regardless of a type of the document, the chief administrative judge cannot approve the amendment if the amendment does not satisfied the above-mentioned requirements for permission to amend.

Meanwhile, when the amendment satisfies the requirements for permission to amend, usually the amendment may be permitted; however, because the permission is at the discretion of the chief administrative judge, if the chief administrative judge has found that the amendment should not be permitted considering individual circumstances, it may be disapproved.

If the amendment may not be permitted, any arguments and evidences corresponding to the unauthorized amendment item will not be adopted as an effective method of attack for the proceedings’ basis, so only an effective attack and defense will be considered and examined.

When sending documents to both parties, a written decision for permission to amend indicating the amendment is not permitted (Enforcement Regulation under the Patent Act Article 47-5) shall be prepared and sent at the same time, or a decision for permission to amend shall be made at the oral proceedings.

(3) In the case of permitting amendments that do not require a confirmation of the demandee's consent

When the demandant's method of attack contains an amendment that changes the gist of the reasons for request, but it is clear that such amendment is not likely to delay the proceedings (the main paragraph of the Patent Act Article 131-2(2)) and the amendment is required due to the request for correction (the Patent Act Article 131-2(2)(i)), the chief administrative judge may approve the amendment.

When allowing an amendment to change the gist of the reasons for request, the demandee is prompted to submit a second written answer within a reasonable time period (normally 30 days (50 days for overseas residents) → 25-01.2) by applying the statutory provision of the Patent Act Article 134 (2) where a request for correction may usually be filed. At that time, a decision for permission to amend indicating the amendment is permitted (Enforcement Regulation under the Patent Act Article 47-5) is made and sent to both parties, and a duplicate of the written refutation and the written amendment, etc. of the written request for trial are sent to the demandee.

However, "when there are special circumstances that are not deemed necessary to give the demandee an opportunity to submit an answer" listed in (A) and (B) below (the proviso of the Patent Act Article 134(2)), it is appropriate to proceed with the oral proceedings.

(A) When it is recognized that the patent cannot be invalid even by the arguments and evidence concerning the amendment item

(B) When the patent is determined to be invalid based on the reason for invalidation that the demandee has already received the opportunity to defend, such as an argument or correction, at the previous opportunities to answer.

If the case corresponds to the above "when there are special circumstances," but if it is deemed appropriate to ask more opinions, the submission of a written re-answer is prompted by applying the provisions of the opportunity to answer under the enforcement regulations (Enforcement Regulations under the Patent Act Article 47-2(1)), and the above documents will be sent.

When it is determined that the time is ripe to make a trial decision, an advance notice of trial decision (patent) is given, or the proceedings are concluded and the trial decision is made; when an advance notice of trial decision is to be sent, the above documents are to be sent at the same time. When the proceedings are to be terminated, the above documents are to be sent along with the notice.

(4) In the case of making a decision on approving or disapproving the amendment after confirming the demandee's consent

If the demandant's method of attack includes an amendment item that changes the gist of the reason for request but it is clear that it is not likely to delay the proceedings (the main paragraph of the Patent Act Article 131-2(2)) and furthermore, a rational reason exists for not stating the reason for the request for amendment at the time of the request for the trial (the first sentence of the Patent Act Article 131-2(2)), the chief administrative judge may approve the amendment, subject to the demandee's consent (the second sentence of the Patent Act Article 131-2(2)).

In this case, the chief administrative judge confirms the demandee's consent (Enforcement Regulations under the Patent Act Article 47-4). Under this situation, when it is considered appropriate to make a decision on allowing the amendment after hearing the demandee's opinion on compliance with its requirement in advance, the demandee's said opinion may be sought in conjunction with the confirmation of the consent (in this case, confirmation of consent includes asking for a petition containing an opinion to that effect).

(5) Procedures for the confirmation of consent

The chief administrative judges sends a document (a written refutation, a brief of an oral proceedings statement, a written amendment, a written opinion, etc.) stating the demandant's method of attack to the demandee, and notifies of "confirmation of consent"; then, the demandee is given an opportunity to submit a "written reply for consent" (Enforcement Regulation under the Patent Act Article 47-4(1); Enforcement Regulation under the Design Act Article 19(8)) by specifying a reasonable time period (normally 30 days (50 days for overseas residents) → 25-01.2). Additionally, when

confirming the consent in oral proceedings, it is sufficient to confirm the intention of the consent in the oral proceedings, and there is no need in writing (the proviso of the Regulation under the Patent Act Article 47-4(1); Enforcement Regulation under the Design Act Article 19(8)).

In response to a notice of the confirmation of consent by the chief administrative judge, a demandee needs to submit a written reply for consent, clearly stating whether the demandee is consent or is not consent to the amendment within the designated period for reply (the Regulation under the Patent Act Article 47-4(1)(2), form 63-5; the Regulation under the Design Act Article 19(8)).

In addition to express consent or disagreement, the demandee may also describe an opinion (for example, that there is no rational reason for not including reasons for the request for amendment initially, or that the matter of amendment delays the proceedings because it does not constitute an appropriate reason for invalidation) on the suitability of other amendment permission requirements in the written reply for consent.

If the demandee expresses disagreement, the chief administrative judge cannot permit the amendment as the amendment permission requirement is not satisfied. Meanwhile, if the demandee agrees to the amendment, the chief administrative judge may permit the amendment as long as other requirements for permission of amendment are satisfied.

If the demandee does not clarify consent or disagreement of the amendment within the period for reply, the chief administrative judge may allow the amendment and proceed with the proceedings as if consent had been obtained. However, as with the reason for invalidation of the ex-officio, when the patent is invalidated for the reason for request relating to permission for amendment, the demandee must be given opportunities to answer to the reason for request and to request for correction (the Patent Act Article 134(2)).

4. Decision of Approving or Rejecting an Amendment

(1) Unit of the decision of approving or rejecting an amendment

In the case where the demandant's method of attack includes an amendment item that

corresponds to the change in the gist of the reason for the request and an amendment item that does not constitute it, or of the amendment items that change the gist of the reason for the request, the amendment items that can be permitted and those that cannot be permitted are included, if the entire method of attack is not permitted, there is the possibility that it may be harsh for the demandant and may hinder accurate proceedings.

Therefore, the determination on the change of the gist and the decision on approving the amendment shall be made in units of the amendment item, even if part of the amendment item is a gist change and is not permitted. The whole amendment is not disapproved.

(2) Decision of approving or disapproving amendment to the reason for the request (the Patent Act Article 131-2(2); the Design Act Article 52)

Decision of approving or disapproving amendment to the reason for the request is made in a document, and a certified copy of the decision is sent to the parties and intervenors (Enforcement Regulations under the Patent Act Article 47-5; Enforcement Regulations under the Design Act Article 19(8)).

If an amendment is denied in the decision of approving or disapproving the amendment, after identifying amendment items subject to the decision, which have been determined to change the gist of the request (the Patent Act Article 131-2(1); the Design Act Article 52) and are rejected, the conclusion that the amendment items are disapproved shall be described in the document.

If an amendment is permitted, except when necessary, it is sufficient to identify the method of attack (a refutation, a written amendment, a written opinion, etc.), including the amendment items without specifying those that need to be permitted, and to describe the conclusion that the amendment items included in the method of attack are permitted.

In the decision of approving or disapproving an amendment, it is sufficient to describe the conclusion, but it is not necessary to explain the specific reason for the conclusion. However, in a trial decision not to permit the amendment, the trial decision should state that the amendment of the reason for request, which has become the basis of the decision of disapproval, changes the gist of the request, thus indicating the reason

for the decision. (When the demandant does not contest against said trial decision, a brief description is acceptable.)

An appeal against the trial decision of approving or disapproving of an amendment cannot be filed pursuant to the Patent Act Article 131-2(2) (the Patent Act Article 131-2(4); the Design Act Article 52).

(3) Handling of oral proceedings

Consent Confirmation of consent, response of consent, and decision of approving or disapproving an amendment can be conducted orally at the oral proceedings and shall be described in the record. The content of the decision of approving or disapproving the amendment described in the record shall be the same as in (2).

5. Proceedings After the Second Answer of the Demandee

The process of the proceedings in the re-written answer stage is basically the same as the “proceedings after the first answer” (→ 51-13), but pay attention to the following points in particular because of the second answer.

(1) Proceedings of the formalities

When a re-written answer invitation is made under the enforcement regulations (Enforcement Regulations under the Patent Act Article 47-2(1)), a request for correction cannot be filed. Therefore, if a request for correction is filed by mistake, the chief administrative judge notifies the reason for dismissal as an unlawful request for correction and then dismisses the request by the decision (the Patent Act Article 133-2; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)).

(2) A response of the parties against the decision of approving or disapproving an amendment

With regard to the previously made decision on permitting the amendment, even when the demandee has made a complaint in the re-answer, the decision of the chief administrative judge cannot be appealed (the Patent Act Article 131-2(4); the Utility Model Act Article 38-2(4); the Design Act Article 52). Therefore, the panel does not

have to consider the appeal.

Meanwhile, when the decision not to permit the amendment has already been made, it does not prevent the demandee from making a preliminary argument against the demandant's allegation and proof regarding the amendment items that were not permitted by the decision.

(3) Handling a request for another correction

If a request for another amendment is made, the request for the previous correction is deemed to be withdrawn (the Patent Act Article 134-2(6)). Usually, the patent specification is used as a reference to examine the latest correction.

(4) Procedure after re-answer

The panel proceeds with the proceedings based on the idea of "Proceedings after the first answer" (→51-13 1.(3)). With regard to giving the demandant an another opportunity for refutation at this stage, , the panel shall judge by considering that there has already given the demandant an opportunity for refutation in addition to filing the original request for a trial for invalidation., and a prompt trial decision shall be desired.

6. Proceedings After the Second Refutation of the Demandant

The process of the proceedings in the second refutation stage is basically the same as those mentioned in above 1. However, the following points are particularly noted in a second refutation stage.

(1) The party's response against the decision of approving or disapproving the amendment

It is also conceivable that the demandant may appeal in the second refutation regarding the decision for disapproving an amendment that is already made. However, there is no need to consider such a petition because it is not possible to appeal against the decision to approve or disapprove the amendment under the Patent Act Article 131-2(2) (the Patent Act Article 131-2(4); the Design Act Article 52).

(2) Procedure after the second refutation

Furthermore, with regard to giving the demandee an opportunity to answer at this stage, considering that the demandee has already been given opportunities to answer and to request for correction, and also an opportunity to correct for the advance notice of trial decision, the judgment shall be made with the aim of a prompt trial decision.

7. Request for a Trial for Invalidation Based on the Late-Coming Reasons for Unregistability

(1) When requesting a trial for invalidation of a trademark registration falling under a late-coming reason for unregistability pursuant to the Trademark Act Article 46(1)(vi), the reason for the request for a trial should state the fact that the registered trademark regarding the designated goods or services under the request falls under said reason for invalidation, and means of proof must be also submitted. Specifically, it is necessary to clarify in the reason for request and the means of proof, that the date (y/m/d) when said late-coming reason for invalidation has become applicable, and that the fact falling under the reason for invalidation continues even at the time of the request for trial.

(2) With regard to a late-coming reason for invalidation under the Trademark Act Article 46(1)(v), the means of proof are necessary to prove the date (y/m/d) when said late-coming reason for invalidation has become applicable.

(3) Even if a trademark registration falls under a late-coming reason for invalidation under the Trademark Act Article 46(1)(v) or (vi), it does not always identify the date(y/m/d) when said reason for invalidation has become applicable. For instance, if the registered trademark is a trademark that might cause misleading as to the product's quality (the Trademark Act Article 4(1)(xvi)) because of a change in the actual situation of the product transactions after registration of the trademark, it is considered extremely difficult to identify the date when it falls. In such a case, it is necessary that the fact is clarified to be true, at least at the time of the request for the trial for invalidation.

(Revised June 2019)

51-16 P U D

Change of the Gist of “Reasons for a Written Request for Trial”

1. Basic Concepts

The purport of restriction of amendment of a reason for request stated in the request for a trial for invalidation (the Patent Act Article 131-2; the Utility Model Act Article 38-2; the Design Act Article 52) is to prevent a delay in the proceedings caused by re-proceedings due to the amendment of the reason for request.

Therefore, the scope of proceedings required to determine existence or non-existence of the “facts on which the invalidation of the right is based” described in the original written request for trial is substantially changed because of the amendment of the reason for request. Thereby, existence of change in the gist of reasons for request can be determined by whether such change will require substantial re-proceedings of the trial or rebuttal by the right holder.

2. Procedure of Judgment

Determination of changing the gist depends on the viewpoint of substantially changing the “facts on which the invalidation of the right is based” (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52) specifically identified in the reason for request in the original request for a trial.

When adding or changing an evidence, change of the gist shall be determined from the viewpoint whether an assertion is made where the “facts on which the invalidation of the right is based” specifically identified as the reason in the original written request can be substantially changed along with the addition or change of the evidence..

3. Examples That Change the Gist of Reasons for Request

(1) Addition or replacement of a new reason for invalidation based on the different laws and regulations

Any other additional reasons for invalidation based on the laws and regulations that differ from those for the specific reason for invalidation described in the original request for trial, or replacement of the original reason with that based on the different laws and regulations, constitutes an amendment that changes the gist of the reason for the request. Even if an amendment which does not specify the laws and regulations relied on the reason, such amendment is deemed to change the gist if it actually adds or changes the “facts on which the invalidation of the right is based.”

(Examples of changing the gist)

(Example 1) A case that initially claimed the reason for invalidation on the basis of a violation of inventive step (the Patent Act Article 29(2)) and described the facts accordingly, but later claimed the reason for invalidation on the basis of a violation of the requirements of the descriptions (the Patent Act Article 36(4)(i)) and added a statement of facts as the basis for the violation of the stated requirements.

(Example 2) A case that initially claimed the reason for invalidation on the basis of a violation of novelty (the Patent Act Article 29(1)) and described the facts accordingly, but later changed the claim to a reason for invalidation based on inventive step (the Patent Act Article 29(2)) and added a description of the factual relationship that violates the said inventive step.

(2) Replacement or addition of principal facts

Amendments to replace, add or change the “facts on which the invalidation of the right is based” as described in the original written request, generally constitute changing the gist (including an amendment that substantially changes the “facts on which the invalidation of the right is based” by clarifying the statement of the unclear reasons for the request. Meanwhile, if the amendment is minor in the reason for the request and thus does not substantially change the “facts on which the invalidation of the right is based”, this amendment may not be deemed changing the gist.)

(Examples of changing the gist)

(Example 1) Initially, a request was asserted on the fact that the description of the specific part A in the specification did not satisfy the requirements of the description

(the Patent Act Article 36(4)) as the basis for the reason for invalidation of the specification, but the assertion has been changed to the fact that the description in the other specific part B does not satisfy the said description requirements.

(Example 2) Initially, a request was asserted on the fact that the description of the specified part C in the patent specification was a new matter as the basis for the reason for invalidation against the requirement for prohibition of adding a new matter (the Patent Act Article 17-2(3)), but the assertion has been changed to the fact that the description in the different specific part D is a new matter.

(3) Replacement or addition of direct evidence

As a result of replacement or addition of “direct evidence” to prove the “facts on which the proposed invalidation of the right is based” described in the reason for the original request, if the “facts on which the invalidation of the right is based” described in the reason for the original request are changed to different “facts on which the invalidation of the right is based” which are based on said replaced or additional evidence, this case is deemed changing the gist because this case is the same as the above (2).

Additionally, even if only a direct evidence is replaced or added without substantially changing the description of the “facts on which the invalidation of the right is based” described in the original reason for request formally, when claiming a request for new “facts on which the invalidation of the right is based” based on said replaced or added evidence, this case is deemed changing the gist because the case is the same as the above (2).

Moreover, even if an evidence added to, is simply referred to as a “reference material”, and a new “facts on which the invalidation of the right is based” is asserted by using the reference material as an evidence, this case is deemed changing the gist.

(Examples of changing the gist)

(Example 1) Initially, it was claimed that the prior art inventions E and F could be easily invented as evidence of reasons for invalidation based on inventive step (the Patent Act Article 29(2)) violation, and the evidence concerning the prior art invention

G was added later, claiming easily conceivable of the invention. (Example 2) Initially, the secret prior art (the Patent Act Article 29-2) is used as a basis for reasons for invalidation, and the prior application H as proof, it was insisted that the invention was identical to that disclosed in the prior application, but later, the evidence was replaced with another prior application J and the secret prior art was claimed as the reason for invalidation.

4. Examples That Do Not Change the Gist of Reasons for Request

(1) Additional claim and proof of well-known facts

Similar to “well-known facts” that anybody should know, the “well-known art,” “commonly used art,” and “common general technical knowledge” should be known by people skilled in the art and thus do not have to be shown the existence of those known arts one by one. Therefore, additionally claiming the facts that there exists the well-known art, commonly used art, common general technical knowledge, etc. and providing an evidence to prove those facts (for example, the prior art documents, etc. for showing the art is well-known or commonly used) usually do not constitute changing the gist of the reason for request.

However, in a case where the scope of proceedings required to determine the existence or nonexistence of the principal facts is substantially changed as a result of providing an additional claim and proof of the well-known facts, if significant re-proceedings or substantial arguments by the right holder are required, the case is handled as it complies with the changing of the gist of the reason for request. Additionally, if the well-known art, commonly used art, etc., which is claimed by the demandant is not truly well-known facts, but it stays an addition of direct evidence, such assertion and proof also changes the gist.

(2) Addition of indirect facts, supporting facts, and indirect evidence

Adding the “facts that indirectly infer principal facts (indirect facts),” adding the “facts to clarify the proof ability of the evidence that proves the principal facts (supporting facts),” and adding the “evidence for establishing indirect facts or

supporting facts (indirect evidence)” are not deemed addition of principal facts or direct evidence. Therefore, these are not regarded amendments that substantially change “the facts on which the invalidation of the right is based (principal facts)” (See Examples 1–3 below).

(Example 1) In the “facts on which the invalidation of the right is based (principal fact)” of the reason for the original request, it is claimed that the invention is made based on the prior art invention with the catalog as evidence; the right holder responds to the dispute over the date listed in the catalog; while the demandant claims that the issuing date of the catalog is prior to filing the application based on the date of the order form of the printing house as an evidence where the request for printing the catalog was received; it may constitute the submission of an indirect fact and an indirect evidence.

(Example 2) Regarding the prior art documents (direct evidence) that prove the “facts on which the invalidation of the right is based (principal facts)” of the reason for the original request, submitting additional materials to properly understand the technical details described in the documents may constitute the submission of supporting facts and an indirect evidence.

(Example 3) Regarding a witness who proves the fact of “publicly worked” claimed as the “facts on which the invalidation of the right is based (principal fact)” in the reasons of the original request, presenting facts indicating the character of the witness (reliability) and an interest with a demandee (no interest with a demandee) etc., may constitute the submission of supporting facts and an indirect evidence.

However, amendments that actually change principal facts substantially in the name of addition of indirect facts, supporting facts, and an indirect evidence constitute changing the gist of reasons for request. Likewise, if the principal facts are missing in the reasons of the original request (normally a violation of the requirements of the description), claiming that the missing principal facts can be inferred by subsequently adding indirect facts or an indirect evidence also changes the gist of the reasons for request.

(3) Presentation of evidence in examination of evidence after a request for a trial

In the case that the “facts on which the invalidation of the right is based” are sufficiently specified in the reason of the original request, presenting an evidence to prove the principal facts in the later examination of evidence, refutation, etc. is an action of establishing an evidence, but does not change or add to the “facts on which the invalidation of the right is based”. , described in the reason for the original request. Therefore, this does not constitute changing the gist.

For example, in cases on the reason for the original request, the fact is specifically described to the effect that the patented invention violates novelty based on the invention publicly implemented prior to the filing of the application of the patented invention (for instance, the fact that the product of the invention has been sold), and it is also stated that such fact is to be proven by an interrogation of a witness later, when an interrogation of a witness, etc. is field at a later date, this does not constitute changing the gist of reasons for request even if the evidence is presented, because the principal facts themselves have not been changed and the evidence to prove the principal facts in the later examination of evidence is simply presented.

However, when presentation of an evidence is, in practical, equivalent to claiming a new “facts on which the invalidation of the right is based”, for instance, “facts on which the invalidation of the right is based” is not specifically identified at the beginning and presenting an evidence later, it is deemed the change of the gist of the reason for request.

If “facts on which the invalidation of the right is based” is not specifically identified at the initial reasons for request, it could be violation of the description requirements of the reason for request (→ 51-08).

(4) Claiming and proving on violation of the requirements for correction (patent)

When claiming and proving that the request for correction should not be admitted because it violates the requirements, and consequently the original patent before correction should be invalidated based on the “facts on which the invalidation of the patent is based” as described in the original request for a trial, the “facts on which the invalidation of the patent is based” which is described as the reason for the original

request have not been changed at all. Therefore, the case does not constitute changing the gist of the reason of request.

Meanwhile, instead of claiming and proving against the violation of the requirement of correction, claiming and proving are made to the effect that the patent corrected by the correction request will have a new reason for invalidation, because the correction is to additionally claim and prove the “facts on which the invalidation of the patent is based” which are not described at the beginning, it constitutes changing the gist. (However, because this case falls under the Patent Act Article 131-2(2)(i), it may be subject to permission for amendment by the chief administrative judge’s n.)

(5) Claiming and proving by objection only against the opposite facts that the right holder asserts and proves

Against the fact that the demandant claimed and proved in the reason for request, while the right holder asserts or disproves the opposite fact for the purpose of denial of said fact in the written answer, etc., the demandant sometimes claims and proves to deny the existence of the opposite fact. In this case, if the demandant’s argument is exclusively made to deny the existence of the opposite fact claimed by the right holder, but it does not change the “facts on which the invalidation of the patent is based” described as the reason for the original request, the gist of the reason for request is not deemed to have changed.

Meanwhile, in the name of opposing against the opposite fact claimed and proved by the right holder, when the demandant claims and proves the fact of a reason for invalidation which is substantially different from the “facts on which the invalidation of the patent is based” as described in the reason for the original request, the gist of the reason for the request is deemed to have changed.

(Example 1) In case the patentee claims and proves the fact (or the opposite fact) that it is possible to work a patented invention under the experimental data as evidence against the reason for request based on violation of enablement requirements when the demandant submits the opposite experimental data indicating that the patentee’s experimental data is inaccurate or incorrect in order to deny the existence of the

opposite fact, it is an exclusive objection denying the existence of the opposite fact that the patentee claims and proves, yet does not change the “facts on which the invalidation of the patent is based” described as the reason for the original request.; Thus, such a case is deemed that the gist of the reason for request has been changed. Meanwhile, when submitting the experimental data that is not related to the patentee’s experimental data and claiming specific facts of violation of different enablement requirements that differ from the original, because the “facts on which the invalidation of the patent is based” described as reasons for the original request implies claiming facts of reasons for invalidity, which are substantially different, the gist of the reason for the request is deemed to have changed.

(Example 2) In case the patentee claims a fact (or the opposite fact) of existence of an obstructive factor of combination of the prior arts (for example, that the primary cited invention does not function if the secondary cited invention is applied to the primary cited invention) against the reason for request based on violation of inventive step where the invention could be easily invented on the basis of a combination of a plurality of prior art documents, if the demandant asserts to deny the existence of said opposite fact (for example, claiming to the effect that it does not happen the primary cited invention does not function if the secondary cited invention is applied to the primary cited invention),, it is an exclusive objection denying the existence of the opposite fact that the patentee claims and proves, yet does not change the “facts on which the invalidation of the patent is based ” described as the reason for the original request. Thus, such a case is deemed the gist of the reason for the request does not change. Meanwhile, when claiming a fact (a fact based on another prior art document) other than the fact of the original inventive step violation regardless of the patentee’s claim of the obstructive factor, because the “facts on which the invalidation of the patent is based” described as the reason for the original request implies claiming substantially different facts of reasons for invalidity, the gist of the reason for the request is deemed to have changed.

(6) A denial of the patentee’s defense that does not change the reason for request

In the original request for trial, in contrast to requesting the reason for request based on violation of novelty by using the prior art document as evidence, the patentee made a defense to the effect that the prior art document did not lose novelty under the provision of exception of loss of novelty because it corresponds to “disclosure against the will of a person who has a right to obtain a patent” (the Patent Act Article 30(1)). When the demandant presents facts, evidence, etc. showing that the disclosure is not against the will as a denial of the patentee’s defense, because “facts on which the invalidation of the patent is based” described in the reason for the original request have not been changed at all, the gist of the reason for request is not deemed to have changed.

(7) Correction of the applicable provision of law

Maintaining the request concerning the “facts on which the invalidation of the patent is based” as stated in the original request for trial, because amendments or refutation that simply corrects errors of the applicable provision (including errors in the choice of the revised law) do not substantially change the “facts on which the invalidation of the right is based” described in the reason for request, the gist is not deemed to have changed.

However, in the name of correcting an error of the applicable law, adding a new reason for invalidation (“facts on which the invalidation of the right is based”) corresponds to changing the gist of the reason for request.

Even if the demandant did not amend or rebut that corrects an error of the provision of the applicable law, because application of the law is a matter of the administrative judge’s exclusive authority, the administrative judge, while finding facts claimed by the demandant, may make a trial decision for invalidation applied the article that is bases for the decision and different from the claim.

For instance, from the beginning, in a case where the principal facts that underlie reasons for invalidation based on the violation of novelty (the Patent Act Article 29(1)) are described as the “facts on which the invalidation of the patent is based”, when it is considered substantially equivalent to describing the principal facts underlying reasons for invalidation based on the violation of an inventive step (the Patent Act Article 29(2)),

the panel may find the fact and apply the provisions of reasons of invalidation over the inventive step violation (the Patent Act Article 29(2)) to make the trial decision considering the descriptions and evidence of the principal facts comprehensively,

However, if argument from the patentee is necessary, providing an opportunity to answer before the trial decision is appropriate except when a substantial opportunity for argument has already been provided.

(Revised June 2019)

51-17 P

Advance Notice of a Trial Decision

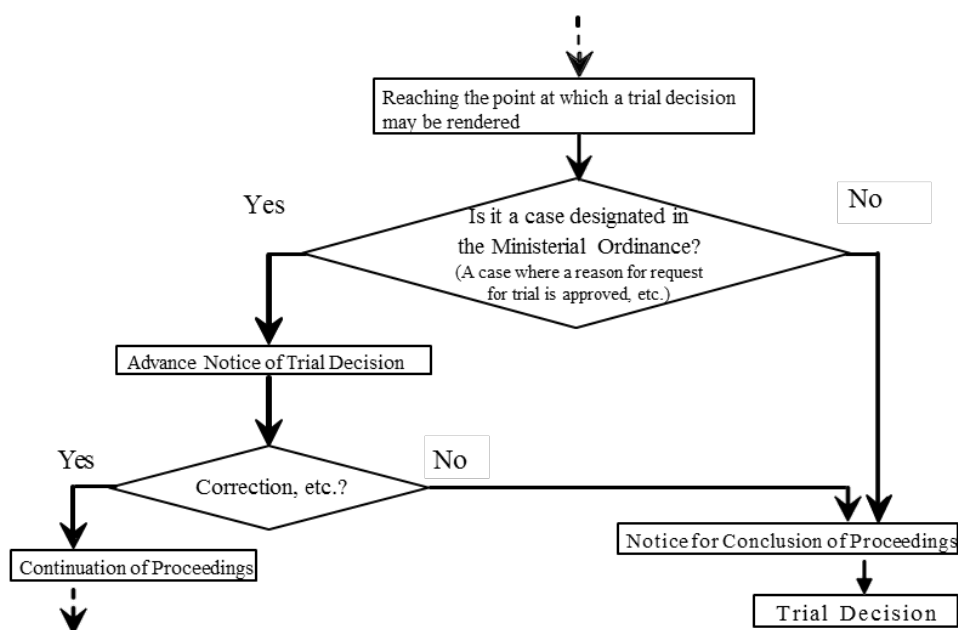
1. Outline of the Proceedings Procedure Concerning the Advance Notice of Trial Decision

In a patent trial for invalidation filed on or after April 1, 2012, if the case is considered ripe for trial decision, and if it is so determined by ministerial ordinance (when it is determined that the request for trial is reasonable, that the request for correction is not accepted, etc.), an “advance notice of trial decision” is given (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2).

If the “advance notice of trial decision” is not given, the trial decision is made after conclusion of the proceedings (the Patent Act Article 156(2), (4)).

In response to the “advance notice of trial decision,” the demandee may make a request for correction or amend a corrected specification, etc. (the Patent Act Article 164-2(2), 134-2(1)), and if this is not done, the proceedings are concluded, and the trial decision is made (the Patent Act Article 156(2), (4)).

【Figure】 Outline of the procedures after the case has reached the point at which a trial decision may be rendered



2. Outline of the Advance Notice of Trial Decision

An advance notice of the trial decision is a procedure established to prevent the occurrence of the “catch-ball phenomenon: “inefficiently the issue goes back and forth” between the court and the patent office, where the panel shows the decision to the demandee, and provides the demandee with an opportunity for correction based on the decision.

(1) Contents of the advance notice of trial decision

In an advance notice of a trial decision, the same matters as in a trial decision shall be described (the Patent Act Article 164-2(3) → the Patent Act Article 157(2)). In conclusions and reasons, a determination whether or not all corrections are allowable, and a determination whether or not all the claims demanded for the trial are valid are described as detailed as the trial decision (Description of trial decision → 51-19 3.). Of these, with regard to determining the validity, in principle, all the reasons (reasons claimed by the demandant and reasons for invalidation by ex-officio if notified) shall be examined in the proceedings, and then described in the advance notice of trial decision.

(2) Procedure for the advance notice of trial decision by the party

The period (normally 60 days (90 days for overseas residents) → 25-01.2) is specified for the demandee to request for corrections, but for the both parties, to request their arguments are not asked again by specified the period (the Patent Act Article 164-2(2)).

3. Proceedings When the Case is Ripe for Making a Trial Decision

(1) When the case is ripe for the first trial decision after starting the proceedings

In principle, when the time is ripe to make the first trial decision after starting the proceedings, an advance notice of trial decision shall be made (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(i)).

However, in the following cases where there is no need to give a demandee an opportunity to make corrections, a trial decision shall be made without providing the advance notice of trial decision. (Enforcement Regulations under the Patent Act Article

50-6-2(i); the Patent Act Article 156(2))

- Where a demandee offers not wishing to receive the advance notice of the trial decision
- Where no request for correction has been made, and all the claims after the appeal have been deemed valid
- Where all corrections concerning to the claims for a request for a trial are permitted, and all the claims for a request for a trial are determined to be valid

If an advance notice of the trial decision is made, the procedure continues as follows, depending on whether the demandee has requested for correction.

A. In cases with a request for correction

Generally, the demandant is given an opportunity to refute.

If the advance notice of the trial decision has been already given, the oral proceedings may be conducted only when deemed necessary.

B. In cases without a request for correction

Because the subject of the proceedings remains unchanged, if there is no other change in circumstances, usually, the proceedings are concluded (the Patent Act Article 156(2)), and the trial decision is made on the basis of content of the judgment described in the advance notice of the trial decision.

Basically, the content described in the advance notice of the trial decision may be described in the trial decision, but it is acceptable to refer to the written statement, etc. submitted after the advance notice of the trial decision. Furthermore, if giving another opportunity for correction is accepted to be reasonable (for example, an addition or a change of evidence is involved), the advance notice of the trial decision is made once again.

(2) When the case is ripe to make a trial decision again

In principle, as a result of the proceedings in accordance with the above (1) a, when the time is ripe to make a trial decision again, the trial decision shall be made on the basis of the purport of the advance notice of the trial decision described in the above 2.

The demandant sometimes adds or changes reasons for invalidation after a request for correction is made against the advance notice of the previous trial decision (when an amendment has been made to change of gist in the written appeal, and the chief

administrative judge has granted it as a result of the correction, etc.), but with regard to these reasons for invalidation, an advance notice of a trial decision is not given. When an amendment to change the gist is permitted, an opportunity for correction and answer is provided (the Patent Act Article 134(2)).

Meanwhile, depending on the reason filed by the time of the advance notice of the

○ An example where it is appropriate to give a chance of correction

When a reason for invalidation B accompanied by an examination of evidence is filed at the proceedings, together with the reason for invalidation A based on the document as evidence, from the viewpoint of efficiently conducting the trial, it may be possible to give an advance notice of the trial decision only with the invalidation reason A, while the trial examination of the invalidation reason B is pending due to taking a long time to examine the evidence. At this time, when the reasons for invalidation A described in the advance notice of the previous trial decision cannot be maintained, and as a result of proceedings of the reasons for invalidation B held, it becomes a conviction for invalidation, if a trial decision is made without disclosing a mental evidence for invalidation reason B and without giving a chance for correction, it would be a surprise for the demandee, so an advance notice of trial decision is made on the invalidation reason B.

Such a case is an exception, and it is the principle that all the trial examinations are made at the time of giving an advance notice of the earlier trial decision, as to the reason for which the demandant had filed.

previous trial decision or depending on the reason notified as the result of the ex-officio proceedings (limited to those for which an advance notice of trial decision has not been made for the stated reason), if a reason is found for a request for appeal, an advance notice of a trial decision is made. (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(iii))

(3) In cases where the trial decision is canceled and remanded to the Patent Office and

where the time is ripe for the first trial decision after starting the proceedings

These cases are the same as the above (1) because it is necessary to redo the previous procedures and proceedings. As a general rule, an advance notice of trial decision is given when the case is deemed ripe to make a first trial decision since the proceedings started after remanded. (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(ii)) See (1) and (2) above for further proceedings procedure.

(Revised June 2019)

51-18 P U D T**Ex-Officio Proceedings in a Trial for Invalidation,
a Notice of Reasons for Invalidation**

1. Notice of Reasons for Invalidation (the Patent Act Article 153; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56)

In a trial, because the proceedings may include reasons that were not requested by the parties or intervenors (for example, different provisions), in the case of a trial for invalidation, detecting ex-officio a reason for invalidation that the demandant has not asserted is also possible. However, because the purport of the request that is not claimed by the demandant cannot be examined, as for the claims, designated goods and services for which no trial for invalidation has been requested, reasons for the invalidation of those cannot be conducted ex-officio detection.

If reasons that parties or intervenors did not request are examined, the chief administrative judge must notify the demandee (right holder) of the proceedings' result as the reason for invalidation, the demandant and intervenors as the result of ex-officio proceedings and give an opportunity to file opinions, with a reasonable period of time specified. Correspondingly, both parties and intervenors may state opinions on the notified reason for invalidation.

In a patent trial for invalidation, the demandee may also request a correction within the period specified in the notice of reasons for invalidation (normally 30 days (50 days for overseas residents) → 25-01.2) (the Patent Act Article 134-2(1)).

2. Basic Concepts of Invocation of Ex-officio Proceedings

It is not the panel's duty but its discretion to invoke ex-officio proceedings. Thus, conducting ex-officio proceedings is not mandatory. The panel shall decide whether to invoke the authority of the ex-officio proceedings by comprehensively considering the incident's influence on public interest, the possibility of delay in proceedings due to

the ex-officio detection, the possibility of finding the truth resulting from the said ex-officio detection, etc., as well as in response to the case.

Basically, because the system of a trial for invalidation is an adversarial system, the actions of proceedings on the basis of the demandant's proof of claim and of limiting the ex-officio proceedings to the extent of complementing the proceedings are considered appropriate.

Therefore, in principle, the ex-officio proceedings' discretion concerning the existence or nonexistence of the reason for invalidation is invoked on the basis of the following examples.

A. If an appropriate reason for invalidation is found not to be constructed on the basis of the facts and evidence asserted by the demandant of the trial for invalidation, but when an appropriate reason for invalidation can be configured by correcting the combination of multiple evidences filed in the trial for invalidation case or by complementing the well-known fact, and it is recognized as contributing to appropriate proceedings.

B. When a more appropriate reason for invalidation can be constructed by considering together the facts or evidence indicated in other cases (other trials for invalidation, infringement suit, etc.) for the right, and it is recognized as necessity to avoid conflict with other case's conclusion.

C. If the reason for request filed by the demandant does not constitute an appropriate invalidity reason, when information submitted on the basis of the information provision system (→ 10-04) after the grant, which the demandant did not incorporate in the reason for request, constitutes an obviously appropriate reason for invalidation, and is failure to be adopted as a subject to ex-officio proceedings, the case runs counter to the public interest.

D. If the demandant's requested reason does not constitute an appropriate invalidity reason, but it is highly likely there is a prior art constituting other appropriate reasons for invalidity, thus detecting it by the prior art ex-officio is relatively easy, and failure

to address such as case runs counter to the public interest.

3. Ex-officio Adoption of Disapproved Amendment for Reason for Request

An amendment to change the gist of the reasons for the request for trial for invalidation which was decided to be disapproved, (the Patent Act Article 131-2(2)), is adopted for the reason for invalidation of ex-officio proceedings as the “reason for not making a (lawfully) complaint,” this adoption should be deemed as complementary. Therefore, it is appropriate to carefully decide to adopt the amendment as a subject to ex-officio proceedings by considering the demandant’s previous responses in the case (whether the demandant had sufficiently described the reason for the request from the beginning of the trial request, whether a timely and appropriate attack was taken in the subsequent proceedings, etc.)

(1) Points to note by types of amendment decided on disapproval

A. Violation of the requirements regarding a delay in the proceedings

Adopting afterward the reason for request relating to a disapproved amendment owing to the possibility to unduly delay the proceedings as the reason for invalidation of ex-officio detection may not be deemed to be a reason for invalidation of ex-officio proceedings because of its inconsistency. Exceptions are such cases as when there is a particular change of circumstances or when it is recognized that the ex-officio proceedings should be quicker.

B. Violation of the requirements caused by correction and the requirements of rational reasons for failure of initial descriptions

When an amendment did not become necessary due to the request for correction and relates to the reasons for a request having no rational reasons of the failure to describe the reasons initially, it is a typical example of an amendment that should not permit a change of the gist. Thus, it is not a reason for the invalidation of the ex-officio proceedings, except the case where a failure to make a trial decision to invalidate the patent by adopting the amendment ex officio is unacceptable to the public interest.

C. Violation of only the requirements of the demandee’s consent

If there is no risk of any delay in proceedings, and there is a rational reason for failure to state the reason for request in the original request, and in the case where the amendment of the reason for request was disapproved only because the demandee did not consent, the panel should not be prevented from invoking authority for the sake of the public interest even if the demandee, a private person disagrees with such an amendment. Therefore, as in the aforementioned case of 2. C, the reason for the request obviously constitutes an appropriate reason for invalidation, and the failure to make the reason a subject to the ex-officio proceedings is unacceptable to the public interest, the case can be adopted as a reason for invalidation for the ex-officio detection.

(2) Use of written amendments in the notice of reasons for invalidation

When adopting the reason for request concerning the amendment that has been disapproved as the reason for invalidating the ex-officio detection, it is possible to use the descriptions of the written amendment, written rebuttal, etc. that describes the amendment matters. In this way, a notice of the reason for invalidation for the demandant's intention can be easily transmitted to the demandant.

4. Handling of a Report of Utility Model Technical Opinion in a Trial for Invalidation of a Utility Model Registration

In a trial for invalidation of a utility model registration, when a demandant does not refer to the prior art documents described in a report of the technical opinion of the utility model, if necessary, the prior art documents are subject to ex-officio proceedings.

Additionally, because the trial decision is made on the basis of the panel's independent judgment in consideration of the parties' requests, the report shall not affect the conclusion of the trial decision.

(Revised June 2019)

51-19 P U D T

Trial Decision of a Trial for Invalidation, Registration in a Patent Register of the Trial Decision, etc.

1. Timing of Rendering a Trial Decision

When the case has matured to the point of making a trial decision (when all the facts necessary for the proceedings have been considered, all the evidence to be examined has been examined, and a state is reached at which a conclusion can be drawn), an advance notice of the trial decision is made (the Patent Act Article 164-2 (1)), or a trial decision is made by a notice of conclusion of the proceedings (the Patent Act Article 156(2), (4); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4))

With regard to whether the case has matured to the point of making the trial decision, the panel decides by comprehensively considering the following points in general.

(1) Whether approve or disapprove of the facts are acknowledged by or exchanged between the parties, and what the disputed facts are is clear to the parties and to the panel (normally completed by the first answer stage).

(2) Whether the point of dispute was subject to proof by the party responsible for proof, and whether the opposing party had an opportunity to counter or rebut (usually completed by oral proceedings, in the first answer stage or the first refutation stage. Additionally, when making a trial decision as “purport of the request” or “purport of the reply” by the opposing party, providing an opportunity for refusal or rebuttal is not necessary).

(3) Whether there is a need to give the counterparty an opportunity to dispute further by requesting a correction (the Patent Act), correction (the Utility Model Act), or presenting a new reason for invalidation (usually considered at the first answer or the first refutation stage).

(4) Whether further listening to the counterparty’s argument against one party’s claim

and proof to form the panel's conviction is necessary.

2. Trial Decision of a Trial for Invalidation

(1) Patent, utility model, and trademark

A trial decision on a trial for invalidation includes the following four types:

A. All requests of the demandant are permitted (with regard to patents and utility models, the patent (or utility model registration) relating to all claims for which the demandant requested are invalidated. With regard to trademark registrations, all of the designated goods or services for which the demandant requested are invalidated.)

B. Part of the requests of the demandant are permitted (with regard to patents and utility models, the patent (or utility model registration) relating to a part of the claims for which the demandant requested are invalidated, but other claims are not subject to invalidation). With regard to trademark registrations, the designated goods or services for which the demandant requested are invalidated, but other part of the designated goods or services are not subject to invalidation.) (the Patent Act Article 125; the Patent Act Article 185; the Trademark Act Articles 46-2(1), 69)

C. None of the requests of the demandant is permitted (with regard to patents and utility models, the patent (or utility model registration) relating to all the claims for which the demandant requested are not invalidated. With regard to trademark registrations, all designated goods or services for which the demandant requested are not invalidated.)

D. The request for a trial is dismissed (→ 51-08, 45-04 5.)

(2) Design

Following three are trial decisions on a trial for invalidation.

A. A request of the demandant is permitted.

B. None of the requests of the demandant is permitted.

C. A request for trial is dismissed. (→ 51-08, 45-04 5.)

3. Description of a Trial Decision

(1) General matters in writing the trial decision (→ 45-03)

Because the “conclusion” of the trial decision is the result of a panel’s decision indicating the extent to which the purport of the request by the party of the case has been permitted or excluded, the conclusion should not contain judgments beyond the purport of the request.

The burden of costs relating to the trial for invalidation (the Patent Act Article 123) shall be clearly indicated in the conclusion section, which party should be borne by the ex-officio, regardless of whether the parties have filed a petition.

The point of dispute and the judgment on it are described in the reasons of the trial decision. At that time, in principle, all the reasons (reasons claimed by a demandant and reasons for invalidation ex officio if notified) are examined and judged, and the conclusion of the decision and its specific reasons are shown. However, for the reasons for invalidation that are not directly linked to the conclusion of the trial decision, although the conclusion of the judgment is shown, the degree of the statement, etc. of the reason can be considered appropriate by the panel.

In the case where the decision to accept or decline the amendment of the reason for request is made (→ 51-15 4.(2) (the Patent Act Article 131-2(2); the Design Act Article 52))) and if it is decided to disallow the amendment, the judgment that the amendment of the reason for request, which is on the premise of the denial, changes the gist of the written request are described, and the reason for making such a decision is indicated. (If the demandant is not contesting against the judgment of the gist change, a brief description is acceptable.)

(2) The case of invalidation based on the late coming reason of invalidity

At the conclusion of the trial decision when invalidating the right on the basis of the late-coming reasons (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v),(vi),(vii)), it is desirable indicating clearly when the right falls under the item described above (the Patent Registration Order, Article 9(3); Enforcement Regulations of the Patent Registration Order, Article 37; the Utility Model Registration Order, Article 3(3); Enforcement Regulations of the Utility Model Registration Order, Article

3(4); Design Registration Order, Article 3(3); Enforcement Regulations of the Design Registration Order, Article 6(4); the Trademark Registration Order, Article 3(4); Enforcement Regulations of the Trademark Registration Order, Article 16 -2).

(3) When there is a request for correction in the patent trial for invalidation (→ 45-04 5. (2)C(c))

A. If allowing the correction or a part of the correction requested in the procedure of the trial for invalidation, the effect of the correction requested by the correction request is produced by stating that effect in the conclusion of the trial decision (the Patent Act Article 134-2(9)→the Patent Act Article 128).

When allowing a correction to delete all the claims requested invalidity, the request for a trial for invalidation is dismissed by the trial decision. (→ 51-08 3. E)

When allowing a correction to delete a part of the claims requested invalidity, the request for a trial for invalidation for the deleted claims shall be dismissed by the trial decision. (→ 51-08 3.E)

B. If the correction requested during the procedure of the trial for invalidation is not allowed, it is not described in the conclusion of the trial decision but in the reason to the effect that no correction is allowed, because the dispute simply against “do not allow correction” provides no benefit.

4. Final and Binding a Trial Decision

Partial final can binding trial decision may occur (the Patent Act Article 167-2). (→ 46-00)

5. Effect of a Trial Decision

(1) Effect of the trial decision to invalidate

A. When the trial decision for invalidation is final and binding, the right is considered not to have existed from the beginning (the Patent Act Article 125; the Utility Model Act Article 41; the Design Act Article 49; the Trademark Act Articles 46-2(1), 68(4)).

B. According to the late-coming reasons for invalidity (the Patent Act Article

123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v), (vi), (vii)), if a trial decision to invalidate the right is finalized, the right shall be deemed not to have existed since the right falls under the item (the proviso of the Patent Act Article 125; the Utility Model Act Article 41; the proviso of the Design Act Article 49; the proviso of the Trademark Act Article 46-2(1)).

C. Under the Civil Procedure Code, the trial decision of the case may be a reason for retrial under the Criminal Procedure Code (the Civil Procedure Code, Article 338(1)(viii); the Criminal Procedure Code, Article 435-5). However, with regard to legal treatment under the Civil Procedure Code, if a trial decision for invalidation is final and binding after a court decision of an infringement litigation, etc. is finalized (when the provisions of the Patent Act Article 104-3(i) are applied), the retrial of the final court decision, based on the fact that the trial decision has been made, is limited (the Patent Act Article 104-4(i); 2011 Supplementary provisions of the 2011 Act on partial revision of the Patent Act Article 2(15)).

D. When the trial decision to invalidate a patent or utility model partially is final and binding, only the patent related to the applicable claim is invalidated (the Patent Act Articles 123(1), 185). With regard to a design, even if the design includes the principal design and the related design, only the design subject to invalidation is invalidated, and with regard to a trademark, the invalidation is applied to each of the designated goods and services.

(2) Effect of a trial decision to allow correction in a trial for patent invalidation

A. When a trial decision of a trial for invalidation to allow the correction by the request for correction is decided as per the corrected description, claims, or drawings, it is considered that filing a patent application, an application publication before examination, a decision or a trial decision of a patent grant, and a registration of establishment of a patent right are rendered based on the corrected specification, claims, or drawings (the Patent Act Article 134-2(9)).

B. When a trial decision (limited to those regulated by Cabinet Order) to the effect that correction is to be made becomes final and binding after a court decision for an

infringement case, etc. is fixed, a retrial against the fixed court decision based on the reason that the correction is fixed is limited (the Patent Act Article 104-4(iii), Order for Enforcement of the Patent Act Article 8).

(3) Prohibition of double jeopardy in the trial decision of the trial for invalidation

A. If registration of the final trial decision of the trial for invalidation is after April 1, 2012

If a trial decision of a trial for invalidation is finalized, the parties and intervenors of the trial may not request for a trial based on the same fact and the same evidence (the Patent Act Article 167; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4))(→30-02).

B. If the registration of the final trial decision of the trial for invalidation is before March 31, 2012

When there is a registration for a final trial decision of the trial for invalidation, no one can claim a trial based on the same fact and the same evidence.

(4) Effect of a trial decision that a trademark registration should be invalidated because of a late-coming reasons of invalidation

In the case where a trademark registration falls under the Trademark Act Article 46(1)(v), (vi), (vii)), if a trial decision to invalidate the trademark registration is finalized, the trademark right is deemed not to have existed since the time when the trademark registration reached the applicable reason for invalidation (the proviso of the Trademark Act Article 46-2(1)).

Additionally, if identification of when the trademark registration came under the Trademark Act Article 46(1)(v), (vi), (vii)) is not possible, a trademark right is deemed not to have existed from the date of registration (the date of preliminary registration) of the request for trial requested to invalidate the trademark registration (the Trademark Act Article 46-2(2)).

6. Registration, etc.

(1) Preliminary registration of a request for trial

When a request for trial for invalidation is made, it is preliminary registered in the patent registry (the Patent Registration Order, Article 3(4); the Utility Model Registration Order, Article 2; the Design Registration Order, Article 1-3(3); the Trademark Registration Order, the Article 1-2(3)).

Preliminary registration is achieved by recording the date (y/m/d) of the request for the trial, a reference number of the trial, and the purport of the request on the display section (Enforcement Regulations of the Patent Registration Order, Article 38; Enforcement Regulations of the Utility Model Registration Order, Article 3(4); Enforcement Regulations of the Design Registration Order, Article 6(4); Enforcement Regulations of the Trademark Registration Order, Article 16-3).

(2) Registration of the final trial decision

The final trial decision of the trial for invalidation is registered under the authority the Commissioner of the Patent Office (the Patent Registration Order, Article 16-10; the Utility Model Registration Order, Article 6-5; the Design Registration Order, the Article 6-3; the Trademark Registration Order, Article 7-5).

The registration is achieved by recording a reference number of the trial, the fact and the date (y/m/d) that the trial decision has been made and the date, and an outline of the final trial decision on the display section (Enforcement Regulations of the Patent Registration Order, Article 37; Enforcement Regulations of the Utility Model Registration Order, Article 3(4); Enforcement Regulations of the Design Registration Order, Article 6(4); Enforcement Regulations of the Trademark Registration Order, Article 16-2(1)). Furthermore, if the trial decision is partially made (→ 46-00), it is registered as a “registration of a partial final decision of the trial decision”.

The original document of the trial decision is considered as a part of the patent registry (the Patent Registration Order, Article 9-3; the Utility Model Registration Order, Article 3(3); the Design Registration Order, Article 3(3); the Trademark Registration Order, Article 3(4)).

(3) Registration of corrections in a specification, claims, or drawings

A correction of the specification, claims, or drawings for a trial for invalidation of a

patent or a utility model registration shall be registered under the authority of the Commissioner of the Patent Office (the Patent Registration Order, Article 16-2; the Utility Model Registration Order, Article 6-2). When the title of the patented invention is changed, the changed title shall be registered (Enforcement Regulations of the Patent Registration Order, Article 31; Enforcement Regulations of the Utility Model Registration Order, Article 2-5(2)).

Additionally, when the decision on the correction request is finalized based on the partial final decision of the trial decision (→ 46-00 2.(1)), it is registered in the patent register as a “registration of a partial final decision of the trial decision.”

The specification, claims, and drawings of the patented invention are regarded as a part of the patent registry (the Patent Registration Order, Article 9(2); the Utility Model Registration Order, Article 3(2); the Design Registration Order, Article 3(2); the Trademark Registration Order, Article 3(2)).

(4) Handling when the right becomes extinct

Extinction of the right (including a case of invalidation) is registered under the authority of the Commissioner of Patent Office (the Patent Registration Order, Article 16-1; the Utility Model Registration Order, Article 6-1; the Design Registration Order, Article 6-1; the Trademark Registration Order, Article 7-1).

When extinction of the right is registered, the registration concerning the right in the registry is transferred to the closed registry (the Patent Registration Order, Article 12; the Utility Model Registration Order, Article 4; the Design Registration Order, Article 4; the Trademark Registration Order, Article 5).

The retention period of the closed register is 20 years (Enforcement Regulations of the Patent Registration Order, Article 5(1); Enforcement Regulations of the Utility Model Registration Order, Article 3(2); Enforcement Regulations of the Design Registration Order, Article 6(2); Enforcement Regulations of the Trademark Registration Order, Article 17(2)).

7. Fees and Expenses

(1) Fee

A fee for a request for trial shall be paid in accordance with the provisions under the Patent Act Article 195(2) (the Utility Model Act Article 54(2); the Design Act Article 67(2); the Trademark Act Article 76(2)).

A. Regarding a trial for patent invalidation, a fee must be paid in accordance with the number of claims requested in the trial.

B. If the number of claims above increases due to a correction in a trial for correction or in a request for correction, when the request for a trial for invalidation shall also be filed for the increased additional claims (inventions), the demandant has to pay the fee for those claims (inventions).

(2) Burden of expenses (→ 47-01, 02, 03)

The burden of expenses in a trial for invalidation shall be determined ex-officio, according to a trial decision when the trial is concluded by the trial decision, or according to a decision of the panel when the trial is concluded without a trial decision (the Patent Act Article 169(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

In this case, the burden of expenses shall be considered for the application of the Civil Procedure Code Article 62 etc., which is commonly applied under the provisions of the Patent Act Article 169(2).

8. Others

(1) Certificate of patent (registration)

In the case where a trial decision to allow correction in a specification attached to, claims, or drawing attached to an application is finalized, if the registration is made, the Commissioner of the Patent Office issues a patent (registration) certificate to the patentee (the Patent Act Article 28(1); Enforcement Regulations under the Patent Act Article 66; the Utility Model Act Article 50(1); the Utility Model Registration Order, Article 1(1); Enforcement Regulations under the Utility Model Act Article 19; the Design Act Article 62(1); Enforcement Regulations under the Design Act Article 16;

the Trademark Act Article 71-2(1); Enforcement Regulations under the Trademark Act Article 16-2).

(2) Decision on trial gazette, patent gazette

When a specification, claims, or drawings have been corrected in a trial for invalidation of a patent, the final trial decision of the trial and the corrected specification, the matters described in the claims, and the contents of the drawings are published in the patent gazette (the corrected patent specification) (the Patent Act Article 193(2)(vii), (viii)).

The gazette mentioned above is issued when the case is fixed, and when all the requests relating to the case are decided, the decision on trial gazette is issued in the form of continuously binding the full text of corrected specification (or multiple if there are multiple corrected descriptions). If it is partially finalized, a partial final trial decision gazette is issued and a partial decision information is published.

(Revised June 2019)

51-20 P**Handling of Prohibition of Double Jeopardy
in a Request for Correction**

When a trial decision to admit the correction (the Patent Act Article 134(2)) requested during the procedure of the trial for invalidation is finalized (In the case a registration of a final trial decision is made on or before March 31, 2012, “When a final trial decision for a trial for invalidation is registered”), and regarding the judgment of the appropriateness of the correction, the prohibition of double jeopardy (the Patent Act Article 167; the Utility Model Act Article 41) is applied. The party and intervenor of the previous trial for invalidation (if the registration of the final trial decision is on or before March 31, 2012; “Anyone”) may not request a trial for invalidation (the Patent Act Article 123(1)8) insisting that the correction is inappropriate as per the same facts and the same evidence. If such a request is made, it is to be dismissed by a trial decision.

(1) According to the Patent Act Article 167, the prohibition of double jeopardy is applied to the trial decision of the trial for patent invalidation or of the trial for invalidation for the term extension registration.

(2) When the trial decision to maintain the right is finalized, allowing the correction requested during the procedure of the trial for patent invalidation, as proceedings that are substantially equivalent to the case—wherein a trial for invalidation has been made because of an improper correction—is being conducted, with regard to the facts and evidence adopted as the basis for allowing the said correction—as described in the above trial decision—it is reasonable to consider that the doctrine of prohibiting double jeopardy is applied. Therefore, it shall not be possible to request a trial for invalidation on the grounds of unlawful correction, with said facts and evidence. If such a request is made, it is to be dismissed by the trial decision.

(3) Additionally, the application of prohibition of double jeopardy (the Patent Act Article 167) disallows the trials for patent invalidation or the trials for invalidation for

the term extension registration. Therefore, when the trial decision to maintain the right without allowing the correction is finalized, in the subsequent trial for correction, prohibition of double jeopardy is not applied to request the correction of the same content in the form of refuting the same facts and evidences adopted in the trial decision. (4) Moreover, because the request is for a trial but not for correction that is prohibited by the application of the prohibition of double jeopardy, when a trial decision to maintain the right without allowing a correction is finalized, in the subsequent corrections during the procedures of other trials for invalidation, the prohibition of double jeopardy is not applied to the request for the correction of the same content in the form of refuting the same facts and evidences adopted in the trial decision.

(Revised June 2019)

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)

51-22 P**Handling of a Trial for Patent Invalidation
and a Trial for Correction Pending at the Same Time****1. Handling of a Trial for Patent Invalidation related to a Trial for Correction**

During a trial for invalidation becomes pending at the Patent Office until a trial decision is made, a trial for correction concerning the same right cannot be requested (the Patent Act Article 126(2)).

However, “When the trial for invalidation becomes pending at the Patent Office” refers to the time when a duplicate of the request for trial is served to the demandee (→54-03). If a trial for correction is requested before serving the duplicate of the filed request for invalidation to the demandee, the Patent Office will hold the trials for invalidation and correction simultaneously.

To promptly and accurately conduct the proceedings both of the trial for invalidation and the trial for correction, understanding the relevance of the both trials is necessary for examination.

2. Proceedings by the Same Panel

Because the trials for correction and invalidation are not related to the upper and lower courts, and they are different cases, thus, involvement in the prior trial (→12-04) does not matter. Therefore, in principle, the same panel takes both the trials for invalidation and correction.

3. Handling When the Trials for Invalidation and Correction Are Simultaneously Pending

(1) As a rule, prioritize a trial for invalidation.

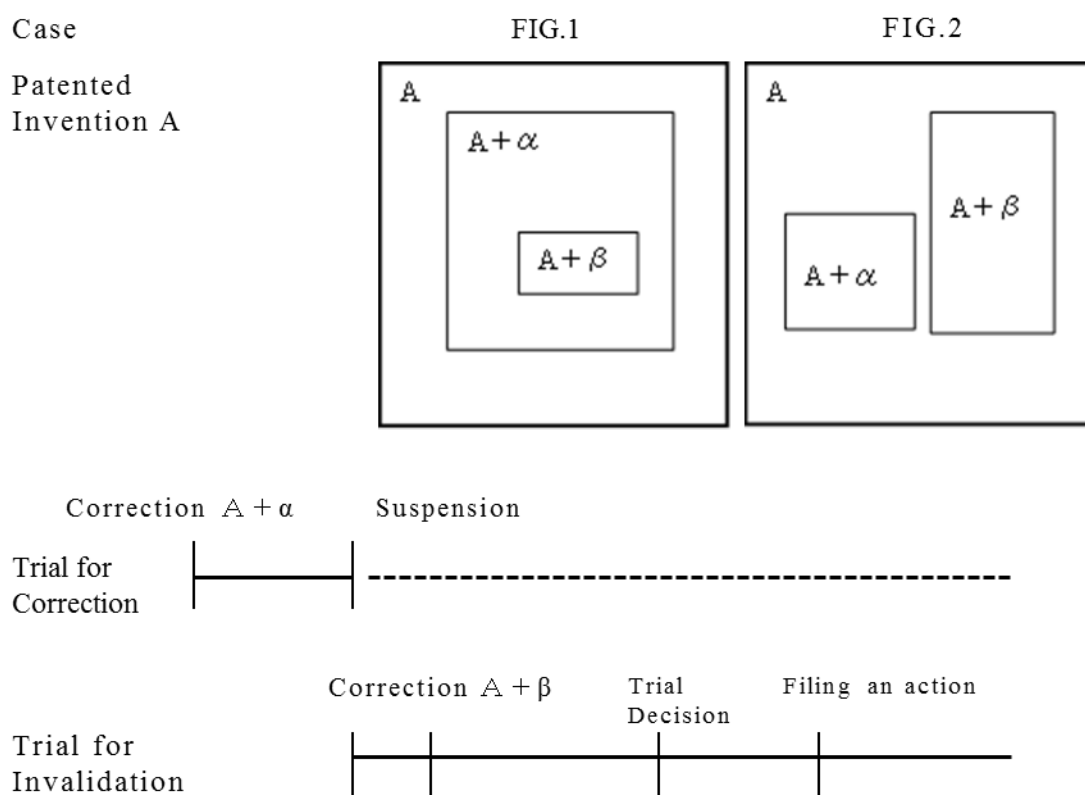
If a trial for correction (the Patent Act Article 126) and a trial for invalidation (the Patent Act Article 123) are co-pending at the Patent Office, in principle, the trial for

invalidation is preferentially examined.

When priority is given to the proceedings of one of the trials, the proceedings of the other trial is suspended as necessary (the Patent Act Article 168(1)), and the party is notified of the suspension.

This is done because (A) while the trial for invalidation is pending, requesting correction can be filed in consideration of all previous circumstances in the trial for invalidation, and examining the request for correction meets the right holder's intention; and (B) in the trial for invalidation which takes an adversarial system, the demandant can make an argument to the request for correction, which contributes to a more accurate trial. This can prevent occurrence of the following cases.

In Figure 1, because the correction $A + \alpha$ by the trial for correction is restricted by the correction $A + \beta$ necessary for the trial for invalidation, it is scarcely necessary to perform the trial for correction. Furthermore, in Figure 2, when the correction $A + \alpha$ is determined, the correction $A + \beta$ cannot be performed.



(2) When a trial for correction is preferentially examined

In contrast to the aforementioned situation, if the right holder asserts in the answer that the trial for correction should be examined first because its correction content can sufficiently counter the reason for invalidation, and the panel determines that prioritizing the trial for correction is more appropriate, give priority to the proceedings for the trial for correction. (However, even if the right holder claims that proceedings for the trial for correction should be conducted first, if the content of the correction for the trial for correction is clearly unacceptable, or if it is recognized that the request for the trial for invalidation does not stand regardless of the result of the trial for correction; the trial for invalidation is preferentially examined.)

Additionally, when the trial for invalidation is requested just before the end of the proceedings for the trial for correction and accordingly the proceedings have progressed to a considerable extent, the said proceedings may be prioritized.

4. Proceedings of the Subsequent Trial

In principle, the other trial's proceedings are continued immediately after making the trial decision of the trial preferentially examined. At that time, pay attention to the following points.

(1) If a trial for invalidation is preferentially examined and a trial decision to invalidate the right is finalized, the request for the trial for correction shall be dismissed by a trial decision as an unlawful request (the Patent Act Article 135)(Reference: Court Decision of Supreme Court of Japan, the 3rd Petty Bench, April 24, 1984, (1982 (Gyo-Tsu) No. 27)).

Moreover, if a trial decision to accept the request for correction during the trial for invalidation and to maintain the right is finalized, notably, the content of the request for the trial for correction on the premise of the original patent may not be consistent with the patent after the correction is finalized, and thus may not satisfy the correction requirement.

(2) When the proceedings for a trial for correction are prioritized, if the trial decision

to allow correction is finalized and the result of the correction, the subject of the trial for invalidation is changed, the demandant of the trial for invalidation is notified of the contents of the trial for correction (→ Form 1), and is given an opportunity of refutation for filing an opinion on the corrected patent subject to a trial within a specified period of time (Enforcement Regulations under the Patent Act Article 47-3).

If the patentee has not requested correction under the trial for invalidation by the time of the opportunity to refute, and if the demandant of the trial for invalidation has amended to change the gist of the reason for the request at the opportunity to refute, a decision will be made on whether to permit an amendment to change the gist based on the provisions of the Patent Act Article 131-2(2)(ii) (rational reasons not initially stated / consent of demandee (patentee)), but not based on the provisions of the Patent Act Article 131-2(2)(i) (amendments required by the request for correction) . (Because no request for correction exists, and because the trial for correction was requested before the request for the trial for invalidation, it cannot be assumed that the demandee naturally agrees with the demandant to present a new reason for invalidation in response to the request for correction; therefore, the case is handled in this manner.)

(3) When the trial for correction is preferentially examined, a trial decision is made stating that the correction is not permitted, and a revocation action against the trial decision is filed, proceedings of a trial for invalidation are conducted without waiting for the final trial decision of the trial for correction from the viewpoint of making prompt and accurate determination on the proprieties of the correction and the validity of the patent in the invalidation trial under the adversarial system.

(Revised June 2019)

Form 1

Notice of the final trial decision to allow a correction to the demandant

Notice of Final Trial Decision to Allow Correction

Date

Chief Administrative Judge of the Patent Office

Trial Number: Muko (invalidation) xxxx-xxxx
 (Patent No.(s)) (Patent XXXX)
 Demandant
 Patent Attorney

We hereby notify you of this patent as follows: If you have any opinion, etc. regarding this trial for invalidation case of the patent, please submit it in writing within 30 days on which this notice was dispatched.

Description

Regarding the specification, etc. of the invention pertaining to the Patent No. XX, a request for a trial for correction was filed (Correction No. XX). A trial decision was made on XX,YY, that was fixed on XX,YY.

51-22.1 P U D T**Multiple Co-Pending Trials for Invalidation****1. Proceedings of Multiple Trials for Invalidation Pending at the Same Time**

If two or more trials for invalidation are “simultaneously pending in the proceedings” for the same right (when one case is about to be examined and the other is ready to be examined, or when one becomes ready to be examined while the other is being examined), the proceedings should be conducted as follows.

(1) Consolidated Proceedings (→ 51-09 5.)

When multiple trials for invalidation are “pending” simultaneously, consider the possibility of consolidated proceedings; for cases that can be efficiently examined in such a manner, consolidate the proceedings (the Patent Act Article 154(1)).

(2) Factual Consolidated Proceedings

If conducting consolidated proceedings for multiple trials for invalidation which are pending simultaneously are inappropriate and if multiple, simultaneous proceedings of trials for invalidation do not preclude the smooth progress of the procedure, simultaneously examine multiple cases without conducting consolidated proceedings and make the trial decisions at the same time if possible.

By synchronizing timings of the answer invitation, the refutation invitation, the notice of reasons for invalidation, the oral proceedings, etc. in both cases, make the content and timing of attacks against the right holder as similar as possible and ensure proceedings so that the right holder’s defense methods are common to multiple cases.

(3) Prioritized Proceedings

When prioritizing a particular case can contribute to a prompt resolution of the dispute, decide the proceedings’ priority, select the most appropriately prioritized trial(s) for invalidation case(s) to be examined, and examine the trials for invalidation earlier than the remaining trials for invalidation.

A. Consider reasons, evidence, etc. asserted in the trial for invalidation case that is not

preferentially examined as a subject of ex officio proceedings in the trial for invalidation case that is preferentially examined.

B. In a trial for invalidation case that is not preferentially examined, in principle, a notice of suspension is prepared according to 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)). If a party submits a written request to cancel the suspension, considering that the presented reasons and evidence have already been taken into account in the priority proceedings, canceling the suspension is allowed only if it is considered useful for prompt resolution of the dispute.

C. Handling of the case in subsequent proceedings is decided according to the conclusion (whether the right is invalid or maintained) of the case that has been preferentially examined.

(A) If the conclusion of the preferentially examined case is invalid, in principle, proceedings of the subsequent case are suspended until the trial decision is decided.

(B) If the conclusion of the preferentially examined case is to preserve the rights, in principle, proceedings of the subsequent case are begun promptly thereafter.

In the patent, if a preferentially examined case of trial for invalidation is filed and if the correction in the said preferentially examined case of trial for invalidation has not been fixed, then set proceedings in consideration of consistency with the correction in the trial for invalidation which is subsequently examined (→ 51-22.2 2.(2)).

(Revised June 2019)

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)

51-23 U**Trial for Invalidation of a Utility Model Registration****1. Applicable Subject**

This applies to the trial for invalidation filed against those registered as utility models on or after January 1, 1994 (Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Articles 4(1), 5).

2. Feature of Trial for Invalidation of Utility Model Registration

The procedure for the trial for invalidation of a utility model registration differs from the trial for patent invalidation in the following respects.

(1) The utility model registration can be corrected and finalized without submission of a correction document and without conducting proceedings on the proposal. (→ 51-23.2)

(2) Anyone may claim the trial for invalidation of a utility model registration.

(3) There is no request for correction in the trial for invalidation of a utility model registration.

(4) There is no advance notice of trial decision in the trial for invalidation of a utility model registration.

(Reference) Proceedings of the trial for invalidation of a utility model registration based on the patent applications for the same invention (→51-23.3)

3. Handling of a Utility Model Registration Filed on or after April 1, 2005

For utility model registrations filed on or after April 1, 2005, the 2004 Act on Partial Revision of the Patent Act, etc. (2004 Act No. 79) is applied (Supplementary Provisions of 2004 Act on Partial Revision of the Patent Act, etc. Article 3, 2004), and it is treated as follows.

(1) Addition of reasons for invalidation due to enlarged allowance of correction

A. In addition to the correction for deleting a claim(s) (the Utility Model Act Article 14-2(7)), corrections (hereinafter, referred to as “correction such as restriction”) for the following purposes may be made : (A) restriction of the scope of claims, (B) correction of errors, (C) clarification of unclear description, and (D) dissolution of citation relation between the claims (rewriting a claim that cites another claim into a claim that does not cite the said other claim). (the Utility Model Act Article 14-2(2)) In addition to the restrictions for correction purpose, there are restrictions of adding new matters and substantial enlargement or change in the scope of the claims for the utility model registration (the Utility Model Act Article 14-2(3)(4)).

(Note) The corrections in (D) above are limited to those after April 1, 2012 (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 3).

B. Timing and limitation of the number of times

By (A) two months after the service of the certified copy of the technical opinion for the first time for the request of the technical opinion of the utility model or (B) the first answer submission period of the trial for invalidation, whichever comes first, correction for restriction, etc. may be done only once (the Utility Model Act Article 14-2(1)).

When a trial for invalidation is pending, a correction by deletion of the claim is possible at any time until the notice of conclusion of the proceedings is issued. There is no limit on the number. (the Utility Model Act Article 14-2(7)).

C. Correction requirements and invalid reasons

In respect of “correction such as restriction”, regardless of whether there is violation of the correction requirements specified in the Utility Model Act Article 14-2(2), (3), (4), if the timing and frequency and other requirements are satisfied, the correction is accepted; the said correction’s effect occurs; and the fact that the correction has been made is published in the “Utility Model Gazette” (the Utility Model Act Article 14-2(11),(12)). The issue of the propriety of the correction requirements in the correction by restriction, etc. is handled as a question of whether a reason for invalidation in the registration of the utility model exists after the correction (the Utility Model Act Article

37(1)(vii)).

(2) Patent application based on utility model registration and trial for invalidation

If a patent application based on utility model registration is filed after the request for invalidation of utility model registration, the chief administrative judge notifies that effect to the demandant and the intervenor (the Patent Act Article 39(5)). The request for a trial for invalidation can be withdrawn without the counterparty's consent only within 30 days from the date on which the notice was received (the Utility Model Act Article 39-2(3)). If the request for a trial for invalidation or an application for intervention is withdrawn within the 30 days, the fee is refunded upon request (the Utility Model Act Article 54-2(2),(4),(8)).

(Revised June 2019)

51- 23.1 P U

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

	Trial for Patent Invalidation	Trial for Invalidation of the Utility Model Registration
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 days</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>

	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"> • Restriction of the scope of claims • Correction of errors and incorrect translations • Clarification of unclear statement • Cancellation of citation <p>However, the followings are not permitted:</p> <ul style="list-style-type: none"> • Correction that contents after correction exceed the disclosure at the time of filing an application • Correction that substantially enlarges or changes the scope of claims. <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)

51-23.2 U

Correction in a Trial for Invalidation of a Utility Model Registration

1. Correction

(1) Correctable range

In the registration of a utility model, a correction may be made to delete the claim (the Utility Model Act Article 14-2(7)).

Regarding any such registration filed on or after April 1, 2005, in addition to the correction aiming to delete a claim(s), correction (A) to restrict the scope of the claims of a utility model registration, (B) to errors, (C) to clarify unclear description, if any, and (D) to dissolve the citation relationship between claims (the statement of the claim that refers to the statement of another claim shall not be cited in the statement of the said other claim) (hereinafter, referred to as “correction such as restriction”) can be done only once (the Utility Model Act Article 14-2(1),(2)). (Note) The correction in (D) above is limited to those on or after March 1, 2012 (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 3).

Addition of new matter or substantial enlargement or change in the scope of claims in the utility model registration is limited (the Utility Model Act Article 2(2),(3), (4)). If a correction is made that does not meet these requirements, it becomes an invalid reason (the Utility Model Act Article 37(1)(vii) in 2004).

(2) Period till when a correction can be made

A. In principle, a correction to delete a claim is possible at any time without any limitation on the number of times.

However, if a trial for invalidation of the registration of a utility model is pending at the Patent Office, no correction can be made (the Utility Model Act Article 14-2(7)) after the notice of conclusion of the proceedings (the Utility Model Act Article 41 → the Patent Act Article 156(1)) has been received (if proceedings are resumed (the Utility

Model Act Article 41 → the Patent Act Article 156(3)) after the further notice of conclusion of the proceedings has been received). Additionally, the end time of the period that the correction cannot be made after the notice of conclusion of the proceedings shall be until the service of the trial decision of the trial for invalidation of the registration of a utility model. (Note 1)

B. A correction intended to delete a claim can be made even after the extinction of the utility model right, but it cannot be made (the Utility Model Act Article 2(8)) after being invalidated by the trial for invalidation of registration of a utility model (the Utility Model Act Article 37(1)) (Note 2), (Note 3).

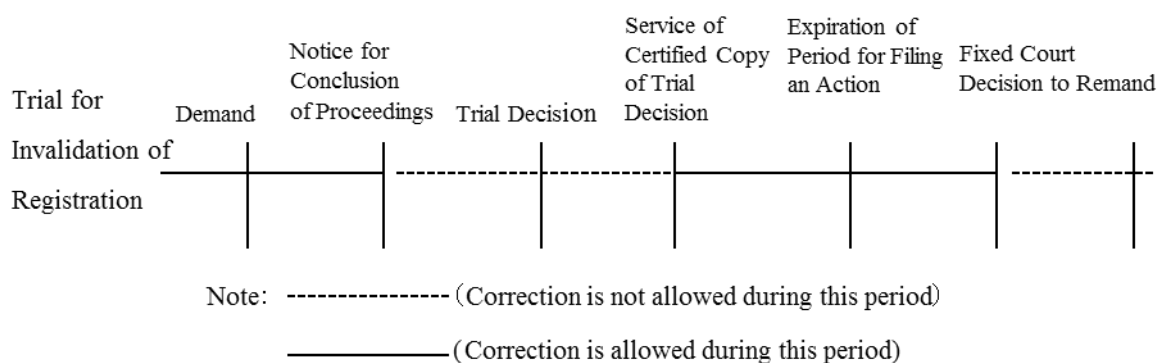
C. By the deadline of two months the date on which a certified copy of the first technical opinion is dispatched for the request of the technical opinion of the first utility model or the submission period of the first answer about the trial for invalidation, whichever is earlier, correction such as restriction can be done only once (the Utility Model Act Article 14-2(1)).

(Note 1) The intent of the law that while the trial for invalidation of the utility model registration is pending, it cannot be corrected after the notice of conclusion of the proceedings is for prompt and accurate proceedings for the validity of the registration of a utility model by preventing the object of the proceedings from being changed by the correction after the proceedings of the trial for invalidation of the registration of a utility model is concluded, and by preventing the proceedings and trial decision drafting done so far from being wasted and having to resume the proceedings. Therefore, after the trial decision of the trial for invalidation of the registration of a utility model is served, making corrections is acceptable.

Additionally, if the decision to remand the trial for invalidation of the registration of a utility model case is fixed by the litigation rescinding the trial decision, it again becomes “pending in the Patent Office” in relation to corrections.

Furthermore, correction of the utility model is a procedure for the Commissioner of the Patent Office, and a correction submitted at a time when it cannot be made is treated as dismissal of procedures. (→21-08)

Here, at the end of the period when the trial for invalidation of the registration of a utility model is “pending at the Patent Office” in relation to submission procedure of the correction, it is handled as shown in the following figure.



(Note 2) When there is a correspondence to the following prescribed in the Utility Model Act Article 37(1)(vi): “After the utility model registration is made, when the utility model right holder becomes a person who cannot hold the utility model right according to the provision of the Patent Act Article 25 (enjoyment of rights by foreign nationals) as applied mutatis mutandis pursuant to the Utility Model Act Article 2-5(3) or when the utility model registration has become in violation of a treaty,” even when the trial decision to invalidate the utility model registration is finalized as per the provision of the proviso of the Patent Act Article 125 to be applied mutatis mutandis to the Utility Model Act Article 41, the utility model right is valid until it becomes to fall under the same item, so corrections can be made (the Utility Model Act Article 41→the Patent Act Article 125).

(Note 3) For a utility model registration claimed two or more claims described in the scope of the claims for the utility model registration, when those for which some claims have become invalid (the latter part of the Utility Model Act Article 37-1), corrections can be made to the remaining claims (the Utility Model Act Article 14-2(8)).

(3) Effect of correction

The correction is effective when appropriate corrections are received and it is

considered that the application and establishment of registration have been made according to the corrected description, the claims or the drawings for a utility model registration (the Utility Model Act Article 14-2(11)).

(4) Correction form, etc.

A person who intends to correct a utility model registration must submit a written correction of the registration of a utility model prepared by Form 8, Form 8-2 according to Enforcement Regulations under the Utility Model Act, with a prescribed fee (see the attached table of the Utility Model Act Article 54(2)) (Enforcement Regulations under the Utility Model Act Article 10).

For example, the claim to be deleted is displayed by the claim number.

(5) Handling of formal deficiency or unlawful corrections

A. If there is a deficiency in the form, an amendment (the Utility Model Act Article 2-2(4)) is ordered in the name of Commissioner of the Patent Office. In cases where the deficiency is not resolved, the procedure is dismissed in the name of Commissioner of the Patent Office (the Utility Model Act Article 2-3(1)).

B. If corrections cannot be amended due to unlawful procedures, notify of the reasons for rejection and provide an opportunity to submit a written explanation; then, dismiss the procedures (the Utility Model Act Article 2-5 → the Patent Act Article 18-2(1)).

C. If basic requirements, such as a corrected specification, is deficient, an amendment is ordered (the Utility Model Act Article 14-3) in the name of Commissioner of the Patent Office. Dismiss the procedure in the name of Commissioner of the Patent Office if the deficiency is not resolved (the Utility Model Act Article 2-3(1)).

(Note) Dismissal of procedures other than a written request for trial (→21-08)

2. Related Handling of a Trial for Invalidation of a Utility Model Registration and Correction

(1) If the correction is made during the pendency of the trial for invalidation of the registration of a utility model, the duplicate of the written correction must be served to the demandant (the Utility Model Act Article 39(3)). In the case of a trial for

invalidation, because making corrections such as restriction, etc is also possible, a refutation shall be invited as required. (→ 51-13)

Additionally, when a correction of the utility model registration aims only to delete the claim (claims subject to a trial for invalidation may be deleted, but their contents may not be changed), generally, there is no need to provide the demandant an opportunity to file another opinion.

(2) Handling of the trial for invalidation of the registration of a utility model according to corrections

If the correction effects a change in the number of claims and if the purport of the request for a trial for invalidation of the utility model registration is changed accordingly, it is not handled as a change in the gist of the written request. (→51-07 2.)

(3) Permission for amendment to change the gist of reasons for request due to correction

If the demandant corrects the reason for request in response to the correction such as restriction, etc. and if the correction changes the gist of the reason for request (as in the trial for patent invalidation), examine whether the amendment to change in the gist due to the correction is permitted, and determine permission or rejection for the amendment (the Utility Model Act Article 38-2(2)).

(Revised June 2019)

51-23.3 U**Proceedings of a Trial for Invalidation of a Utility Model Registration,
Based on a Patent Application Relating to 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
<p>Chief Administrative Judge, Administrative Judge of the Patent Office</p> <p>Applicant agent</p> <p>Whether you are the patent applicant or its agent</p> <p>Patent application No.</p> <p>(Reference to a patent gazette of unexamined patent application No. XX)</p> <p>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.</p> <p style="text-align: center; padding: 10px 0;">Description</p> <p>(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).</p> <p>(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).</p> <p>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.</p> <p>Utility Model Registration No. XX (Utility model application No. XX)</p> <p>Right Holder of the utility model:</p> <p>Address (domicile)</p> <p>Name (title)</p> <p>Administrator of the utility model</p> <p>Address (domicile)</p> <p>Name (title)</p> <p>Please confirm the details of the holder of the utility model right, exclusive licensee, and non-exclusive licensee by the registration registry.</p>	

(Revised June 2019)

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)

Reference 1 (1)

“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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<Issues to be organized>

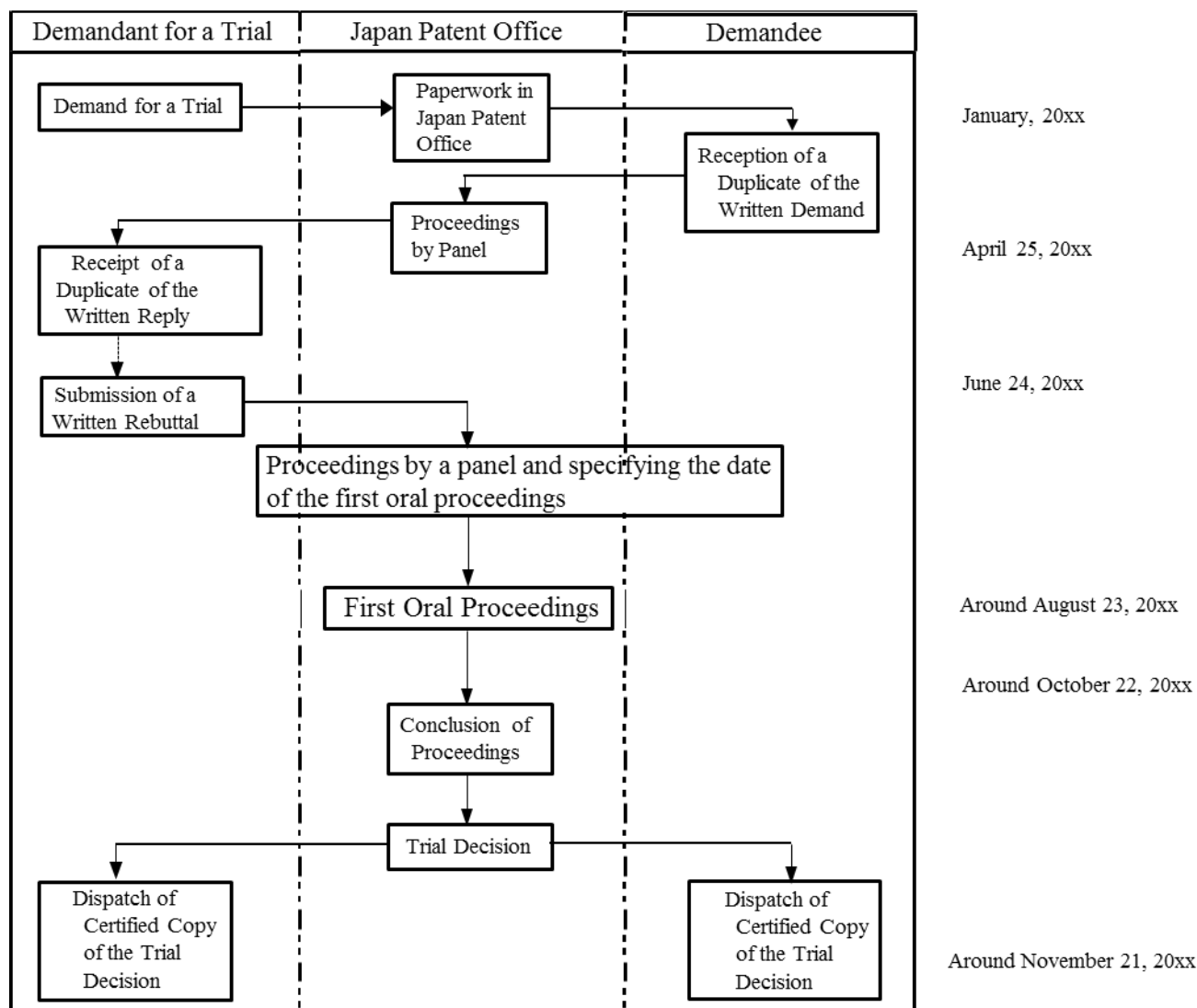
1. Regarding interpretation of the word “divided” in claim 1, the demandant (,) and the demandee are in dispute, therefore, before examining the inventive step for the invention described in the demandant’s Exhibits A-1 to A-3 over the claimed invention 1, clarification of the point is necessary.
2. 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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Reference 1 (2)

< Expected Proceedings Pattern and Schedule >



- 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

