

## 58-02 PUDT

### Organizations that Provide Hantei and Procedures of Proceedings

#### 1. Advisory Opinion Agency

##### (1) Advisory opinion agency

An advisory opinion is provided by a panel consisting of administrative judges appointed pursuant to the provisions of the Patent Act Article 71(2) (the Utility Model Act Article 26→the Patent Act Article 71(2); the Design Act Article 25(2); the Trademark Act Article 28(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(2)).

The panel reaches its decision by a majority vote (the Patent Act Article 71(3)→the Patent Act Article 136(2); the Utility Model Act Article 26→the Patent Act Article 71(3)→the Patent Act Article 136(2); the Design Act Article 25(3)→the Patent Act Article 71(3)→the Patent Act Article 136(2); the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 136(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 136(2)).

##### (2) Appointment of the chief administrative judge and administrative judges

Upon demand for an advisory opinion, the Commissioner of the Japan Patent Office appoints three administrative judges, from whom one is appointed as the chief, who administers clerical affairs relating to the demand for an advisory opinion.

Appointment of administrative judges is subject to the conditions of exclusion and recusation of administrative judges pursuant to the provisions of the Patent Act Articles 139 and 141 (the Patent Act Article 71(3)) (→59-01).

#### 2. Procedure of Proceedings

##### (1) Documentary proceedings

In principle, proceedings for a demand for an advisory opinion are conducted by documentary proceedings (the Patent Act Article 71(3)→the Patent Act Article 145(2); the Utility Model Act Article 26→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Design Act Article 25(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article

28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2)).

Among other reasons, this is because determination of an object (Object A) for which an advisory opinion is demanded shall be based on a document (e.g., drawings), because cases of demand for an advisory opinion do not necessarily employ the adversary system, and because simplicity and promptness are required in the procedure.

## (2) Oral proceedings (→ 33-00)

While in principle, proceedings for a demand for an advisory opinion are conducted by documentary proceedings, the chief administrative judge may decide, upon a motion made by a party to the case or ex officio to conduct oral proceedings(→ 33-00) (the Patent Act Article 71(3)→the Patent Act Article 145(2); the Utility Model Act Article 26→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Design Act Article 25(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2)). When it is decided that the demand be examined by oral proceedings, a notice of oral proceedings is sent to the party (or parties) to the case.

Oral proceedings might be chosen because, in proceedings on an advisory opinion, there may be cases on occasions where oral proceedings are more appropriate than documentary proceedings for establishment of facts.

## (3) Proceedings by authority

A. Proceedings on an advisory opinion are based on the principles of ex officio (→36-01) (the Patent Act Article 71(3)→the Patent Act Articles 152 and 153). This is because an advisory opinion is an expert opinion provided by the Japan Patent Office, an administrative office with highly specialized and technical knowledge and skills, and results are publicized and the content thereof is broadly disclosed to third parties.

Therefore, the scope and content required for the proceedings may be changed ex officio to include an examination of reasons not presented by a party to the case (the Patent Act Article 71(3)→the Patent Act Article 153(1)), or the proceedings may be changed ex officio from documentary to oral proceedings (the Patent Act Article 71(3)→the Patent Act Article 145(2)).

B. However, any purport not stated by a demandant may not be examined (the Patent Act Article 71(3)→the Patent Act Article 153(3)).

Among other reasons, this is because the purport of a demand should be defined by the demandant, and because permitting proceedings to be conducted with regard to a purport not stated is equivalent to altering the purport of the demand against the demandant's intention.

#### (4) Consolidated proceedings

When the panel decides, in consideration of a plurality of cases of demand for an advisory opinion, that the cases may be promptly and accurately examined if proceedings are consolidated, consolidated proceedings may be conducted on the advisory opinion procedure without departing from the purport of the system for advisory opinion and in the absence of any specific expressions of intentions that are contrary to those of a party to the case (the Patent Act Article 71(3)→the Patent Act Article 154).

#### (5) Proceeding order and expeditious proceedings

A. In principle, demands for an advisory opinion are addressed in the order of the date on which they were filed.

However, when cases of an advisory opinion are relating to a case such as a trial for invalidation, a trial for correction, or infringement, demands for an advisory opinion may not be necessarily addressed in the order of the date on which they were filed, but in a rather comprehensive manner in consideration of the plurality of mutually related cases.

B. Preferably, proceedings on a demand for an advisory opinion are conducted as promptly as possible because the demand itself often involves an actual dispute in progress over, for example, the technical scope of the patented invention in question or because of a current effort to prevent such a dispute, or possible implementation of a business, thereby requiring an early settlement.

(Revised Jun.2019)