

**59-01 P U D T****Grounds for Exclusion and Recusation, etc.**

1. The Commissioner of the JPO shall designate an administrative judge and a trial/appeal clerk for each trial/appeal case (Patent Act Articles 137(1), 144-2(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), and when there is a person who is unable to participate in a trial/appeal as an administrative judge or a trial/appeal clerk, the Commissioner of the JPO shall release the designation and replace it with another administrative judge (Patent Act Articles 137(2), 144-2(3), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). To ensure impartiality of a trial, if a designated administrative judge has a special relationship with a specific trial/appeal case, it is necessary to prevent him/her from performing the duties. This refers to the system of exclusion or recusation (Patent Act Articles 139~144-2, Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

2. Exclusion is legally excluded from performing the duties based on a certain ground, while recusation is excluded from performing the duties when a motion requesting exclusion from executing the duties is filed by a party, etc. with circumstances that might prevent impartiality of the trial/appeal.

3. Grounds for Exclusion, Formal Requirements for a Motion Requesting an Exclusion, Time of Exclusion

(1) Grounds for exclusion are shown below (Patent Act Articles 139 (i)~(viii), 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

A. When an administrative judge or a trial/appeal clerk, or his/her spouse or his/her ex-spouse is or was a party or an intervenor of the case, or a patent opponent of the case (in this section 59-01, hereinafter referred to as “a person involved in requesting the trial/appeal”) (i)

B. When an administrative judge or a trial/appeal clerk is or was a relative by blood within the fourth degree of kinship, a relative by affinity within the third degree of kinship or a relative living together, of a person involved in requesting the trial/appeal (ii)

C. When an administrative judge or a trial/appeal clerk is a guardian, a supervisor of the guardian, a curator, a supervisor of the curator, an assistant, or a supervisor of the assistant, of a person involved in requesting the trial/appeal (iii)

D. When an administrative judge or a trial/appeal clerk becomes a witness or an expert witness of the case (iv)

E. When an administrative judge or a trial/appeal clerk is or was an agent of a person involved in requesting a trial/appeal (v)

F. When an administrative judge was involved in the case related to an appeal that has been filed against the examiner’s decision as the examiner (vi) (→12-04)

G. When an administrative judge was involved as an examiner in the decision of the patent application pertaining to the patent right in the case of the application for registration of extension of duration under Article 67(2) (vii)

H. When an administrative judge or a trial/appeal clerk has a direct interest to the case (viii)

I. A direct interest herein includes a legal interest, but not includes a financial interest. An example of a legal interest is shown below.

(A) An administrative judge or a trial/appeal clerk is a lienholder of the right that is subject to the dispute in the case

(B) An administrative judge or a trial/appeal clerk is a pledgee of the

the right that is subject to the dispute in the case

(C) An administrative judge or a trial/appeal clerk is a licensee of the right that is subject to the dispute in the case

(D) An administrative judge or a trial/appeal clerk is a guarantor of the right that is subject to the dispute in the case

(2) A motion requesting an exclusion (Patent Act Article 140, 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

Although there are grounds for exclusion, if an administrative judge or a trial/appeal clerk is involved in the case, a party, etc. may file a motion requesting an exclusion.

#### A. Movant

Those who may file a motion requesting an exclusion is a party or an intervenor (Patent Act Articles 140, 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)). An opponent of a patent (registration of trademark) opposition may also file a motion.

Other administrative judges may express an opinion on a ground for exclusion to the manager.

B. Formal requirements for motion (Patent Act Articles 142, 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4), Enforcement Regulations of the Patent Act Article 48-2, Form 64, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6))

Regardless of a motion being filed in writing or orally (→6.), it is necessary to clarify a trial/appeal case, a name of administrative judge or a trial/appeal clerk to be excluded and a ground for exclusion (indicate a corresponding number in Patent Act Article 139).

However, a motion made orally is accepted only at the oral proceedings.

### C. Time of exclusion

A motion for exclusion may be filed before a trial/appeal decision is made.

(Note) 1. It may be a ground for filing a motion until a trial/appeal decision is made.

2. After a trial/appeal decision becomes final and binding, it may be a ground for retrial (Patent Act Article 171(2), Code of Civil Procedure Articles 338(1)(2), 339, Utility Model Act Article 42(2), Design Act Article 53(2), Trademark Act Articles 57(2), 68(5)).

### 4. Grounds for Recusation, Formal Requirements for a Motion Requesting an Recusation, Time of Recusation

(1) Grounds for recusation (Patent Act Article 141, 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

A ground for recusation is regulated where there are circumstances that would prejudice the impartiality of the trial/appeal proceedings. This refers to objective rational grounds for concern by a party about impartiality of the proceedings made by the administrative judge or impartiality of the clerical work performed by the trial/appeal clerk. The followings are not a ground for exclusion, but they might be a problem about recusation.

A. An administrative judge or a trial/appeal clerk is a close friend of a party to the case.

B. An administrative judge or a trial/appeal clerk has an enemy relationship with a party to the case.

C. An administrative judge or a trial/appeal clerk has a special financial interest to the case.

D. An administrative judge or a trial/appeal clerk submitted a private expert opinion to the case.

E. An administrative judge or a trial/appeal clerk has a common-law or engagement relationship with a party.

(2) Motion for recusation (Patent Act Articles 142, 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4), Enforcement Regulations of the Patent Act Article 48-2, Form 64, Enforcement Regulations of the Utility Model Act Article 23(12), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6))

#### A. Movant

Those who may file a motion requesting a recusation is a party or an intervenor (Patent Act Articles 1401(1)).

#### B. Formal requirements for recusation (Patent Act Article 142)

Regardless of a motion being filed in writing or orally (→6.), it is necessary to clarify a trial/appeal case, a name of administrative judge or a trial/appeal clerk to be recused and a ground for recusation. However, a motion made orally is accepted only at the oral proceedings.

#### C. Time of exclusion

A motion may not be filed after making a written or oral statement with regard to the case. However, this shall not be applied where a party or an intervenor was not aware of the ground of the recusation, or the ground for recusation occurred after such the statement, a motion may be filed even after making the statement (Patent Act Articles 141(2), 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

Regarding the statement, when a party or an intervenor files a certain motion in oral proceedings, even a ground has not been stated yet, it can be said there was a statement.

### 5. Substantial Avoidance

For avoiding a motion for exclusion or recusation filed by a party, etc. and for the sake of ensuring impartiality of trial/appeal proceedings, when an

administrative judge or a trial/appeal clerk is likely to fall under the causes, the Commissioner of the JPO shall not designate that person (→12-04).

If there is such concern, an administrative judge or a trial/appeal clerk reports the manager to that effect.

6. See 33-04 3.(6) for the proceedings for a trial case concerning exclusion or recusation made in the oral proceedings.

7. For an appeal to be examined an exclusion or recusation case, an administrative judge other than an administrative judge named in the motion or a trial/appeal clerk other than a trial/appeal clerk named in the motion shall be designated (Patent Act Articles 143(1), 144-2(5), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4)).

8. Abuse of Rights to Motion for Exclusion or Recusation and the Countermeasures

Regarding a motion requesting an exclusion (recusation) that has a clear intention of delaying the trial procedures, an administrative judge subject to the motion also participates in deciding a dismissal since it is abuse of the right to motion.

This decision shall be made with great deliberation so as not to lose the guarantee of impartiality.

(Revised October 2015)