

**59-02 P U D T****Effects of a Motion Requesting an Exclusion and  
Procedures for Trial for Exclusion and Effects of the Decision**

## 1. Effects of a Motion Requesting an Exclusion

When a motion for exclusion is filed, the trial procedures shall be terminated until a decision of a trial for exclusion is rendered, provided, however, that this shall not apply to the case requiring an urgent action (Patent Act Article 144)(→26-01 13.).

Examples of an act requiring urgency are as follows:

- (1) a witness will leave abroad, or a witness will die if an inquiry is not made urgently, and
- (2) an object will be changed or disappeared if an examination is not made urgently.

## 2. Procedures for a trial for exclusion

(1) When a request for exclusion is filed by a party, etc. in writing or orally during the oral proceedings (→33-04 3. (6)), a trial clerk conducts procedures for commencement of a trial for exclusion.

(2) When a motion requesting an exclusion is filed, procedures of the related trial case are terminated, and a new panel is formed consisting of administrative judges designated by the Commissioner of the JPO (→ 59-01 7.) as a judgement body for the motion for exclusion. In this case, an administrative judge named in the motion may not participate in the panel but may express an opinion (Patent Act Article 143(1)).

A trial/appeal clerk whose name is in the motion may not participate in a trial for exclusion. A new trial/appeal clerk who is designated by the Commissioner of the JPO participates in a trial for exclusion.

Regarding an administrative judge named in the motion in the case where it is found that it is abuse of the right to motion for exclusion, see 59-01 8.

(3) Measure when a motion requesting an exclusion is filed during oral proceedings (or examination of evidence)

A. When a motion for exclusion orally during oral proceedings (or examination of evidence), (When a motion is filed in writing, since the motion is addressed to the Commissioner of the JPO, it is interpreted that the motion is filed to the Commissioner of the JPO through an administrative judge in charge of the oral proceedings) a chief administrative judge shall order a trial clerk to state in a trial record of the oral proceedings that a motion requesting an exclusion is filed and declare that the trial procedures will be terminated until the decision of the motion is rendered.

Considering a ground for a motion which is made prima facie showing when the motion for exclusion is filed orally (or in writing), if the motion is immediately determined that it is clearly abuse of a right to motion for exclusion, a consultation shall be started immediately after filing the motion and a decision to dismiss the motion due to abuse of the right to motion may be made after confirming other prima facie grounds are not filed (59-01 8.).

B. When the subject administrative judge shall conduct an urgent action (→1.), a party, etc. is notified to that effect and the proceedings are continued without termination.

(4) The grounds for exclusion shall be made prima facie showing within 3 days from the date on which the motion is filed. If it is failed to do so, since the subsequent completion of the motion is not allowed, the motion shall be dismissed by decision (Clause examples of Decision of Dismissal→59-05 2.).

Prima facie showing is to make a trial examiner presume that facts of petitioner's allegation are certain. A means for proof applying the above has no limitation.

(5) A trial for a motion requesting an exclusion shall be examined and reached

the conclusion as soon as possible. The trial procedures for the case are terminated because of a motion for exclusion.

(6) A trial for exclusion is principally conducted through documentary proceedings (Patent Act Article 145(2)).

(7) A decision on a motion for exclusion shall be made in writing and the reason for the decision must be given, and an appeal against this decision may not be filed (Patent Act Article 143(2)(3)) (Form of Decision →59-05 1.)). This decision becomes final and binding immediately.

(8) When a decision is rendered against a motion for exclusion, a trial clerk binds a copy of the decision to the record of the case contiguously and a piece of paper indicating to that effect is put in the record wrapper and circulate it to a chief administrative judge of the case.

(9) When an administrative judge or a trial clerk who participates in a trial for a motion for exclusion is named in another motion for exclusion, the procedures are the same as above.

### 3. Effects of Decision of a Trial for Exclusion

An administrative judge who has a ground for exclusion may not perform the duties for the subject trial case ipso jure (Exception →the proviso of Article 144 of the Patent Act). This effect occurs regardless of whether the administrative judge or a party, etc. knows a ground for exclusion.

As a result of the trial, the proceedings in which an administrative judge who clearly has a ground for exclusion is involved should be procedurally invalid, therefore the trial should be examined again if a trial decision has not yet been made, whereas if a trial decision has been already made and an action against this decision is filed, the trial decision shall be rescinded in the court. If a trial decision becomes final and binding, this becomes a reason for re-trial (Patent Act Article 171(2) →Code of Civil Procedure Article 338(1)(ii)).

When a motion requesting an exclusion is filed and a trial decision for the exclusion is rendered, an appeal against this decision may not be filed (Patent Act Article 143(3)). It also may not be a reason for re-trial.

(Revised Feb 2015)