59-05 P U D T
Form of Decision of Exclusion or Recusation and Case Examples

1. A form of decision of a motion for exclusion or recusation (hereinafter simply referred to as “exclusion”) should be included below.

(1) Trial number

(2) Name (appellant) and address (domicile) of a movant for exclusion, and a name of his/her agent

(3) Case identification

(4) Conclusion of decision

(5) Ground for decision (Patent Act Article 143(2))

(6) Date of decision

(7) Signature and seal of administrative judges (Alternative to Imprint →00-02 2.)

2. A form and a clause example of decision of dismissal are shown in the following page when there is no prima facie showing for a ground of exclusion within 3 days from the date of filing a motion requesting an exclusion.

(Form)

Exclusion 20xx-960OOO

Decision

Movant for exclusion Address Name or Appellant

Agent Name

A motion requesting an exclusion was filed against a chief administrative judge (or an administrative judge, an appeal clerk) regarding Appeal 20XX-OOOOO, and the decision is rendered as follows.

Conclusion

The motion for exclusion is dismissed.

Reason

A movant was filed a motion requesting an exclusion against a chief administrative judge OOOOO (or an administrative judge, an appeal clerk) on (D/M/Y) regarding Appeal 20XX-OOOOOO, however, no prima facie ground was filed within 3 days on which the application was filed. A ground for a motion must be made prima face showing within 3 days from the date of filing the motion under the provision of Patent Act Article 142 (2), however, the movant failed to do so within the designated period. Therefore, the motion requesting an exclusion is unlawful.

Consequently, the decision is rendered according to the conclusion.

(D/Y/M)

Chief Administrative Judge of the JPO (name)

Administrative Judge of the JPO (name)

Administrative Judge of the JPO (name)

3. Court Precedents for Trial/Appeal for Exclusion or Recusation (a conclusion shows in a brackets)

(1) A motion requesting a recusation was dismissed since the circumstances of another trial case may not be a ground for recusation of the present case. Trial for recusation No. 1, 1965. (Dismissal of the motion for recusation)

(2) Since an administrative judge involved in a trial for correction of the specification and approved the correction and an administrative judge notified a reason for invalidation of the patent against the corrected patent are the same person, the administrative judge must have been confident that the patent invention after correction satisfied the requirement of “an invention can be patented independently” provided in Patent Act Article 126(3) and thus the present patent did not fall under a reason for patent invalidation. However, the administrative judge decided there was a reason for invalidation. From this fact, it can be said that this leads to instability in the determination of the administrative judge. In this regard, a motion for a recusation was filed on the grounds that there are circumstances for the administrative judge that would prejudice the impartiality of the trial, but the motion for recusation was dismissed because it cannot be said that there are such circumstances from the purport of the provision of Patent Act Article 153. Trial for recusation, No. 1, 1973. (Dismissal of the motion for recusation)

(3) A motion requesting a recusation was dismissed since the facts that a chief administrative judge did not specify the term for submitting a means of proof and made a notice of documentary proceedings ex officio do not fall under the circumstances that would prejudice the impartiality of the trial. Trial for recusation, No. 3 1965. (Dismissal of the motion for recusation)

(4) A motion requesting a recusation was filed on the grounds that an administrative judge has a close relation with an agent of the demandant of the (district court) infringement injunction case, etc. involving the same

party as the present case but being different case, and at the same time the administrative judge clearly states to the effect that the administrative judge would like to reach a conclusion of the advisory opinion (Hantei) case filed at a later date and involving the same party and subject as the present case while leaving this case without making any progress. This motion requesting a recusation has no grounds since there is no circumstances that would prejudice the impartiality of the trial because there is no prima facie evidence sufficient for accepting objective reasonable grounds which concerns impartial intervention, and it cannot be said that the administrative judge has an exceptional relationship with the agent. Trial for recusation, No. 2, 1976. (Motion for recusation unsuccessful)

(5) A motion requesting a recusation against an administrative judge executing the duties of the request for the advisory opinion (Hantei) was dismissed due to unlawful request because there is no regulations for filing a motion requesting a recusation against an administrative judge in the procedures of the advisory opinion. Trial for recusation, No. 1, 1976. (Dismissal of the motion for recusation)

(6) A motion requesting a recusation on the ground that an administrative judge participating the decision of dismissal of amendment is involved as a chief administrative judge in the case (an invalidation trial) where the invention that has the same purpose and operation with similar contents and the same party is involved, and there are circumstances for the administrative judge that would prejudice the impartiality of the trial. However, this motion is groundless since the circumstances do not violate the provision under Patent Act Article 139 (6). Trial for recusation, No. 2, 1975. (Motion for recusation unsuccessful)

(7) A motion requesting a recusation on the ground that there is a fact in the different case that an administrative judge refused an interview with a party of one side but had an interview with a party of the other side and ignored a

request for oral proceeding. This clearly lacks impartiality of the proceedings and is examined with prejudice, and there are the reasonable grounds to suspect that the proceedings of this case are made with prejudice as well. However, this motion for the recusation is groundless because the facts may not be acknowledged that the proceedings of the present case lacks impartiality and performed with prejudice in that only the circumstances that there was a refusal of interview and the point that it was not found the necessity for oral proceedings only with the reasons of various circumstances between a demandant, a demandee and an intervenor each other. Trial for recusation, No. 2, 1978. (Motion for recusation unsuccessful)

(8) A trial decision and a retrial against the trial decision does not involve the previous trial. Trial for recusation, No. 1, 1980. (Trial for motion for exclusion)

4. Reference Court Precedents

(1) Regarding the decision on a motion requesting an exclusion or recusation under the Patent Act, an action for the judicial review of administrative dispositions may not be filed separately and independently from an appeal against the trial decision of the case ((1960(O)1072) Judgement of Supreme Court, 2nd Petty Bench, March 24, 1961, 15-3 Saikosaibansho Minji Hanreishu (“Minshu”) (Supreme Court Collection of Civil Cases) p587).

(2) Procedures for an examination for an application for patent and an application for a utility model registration are separate and independent each other, therefore, when a patent application is converted to an application for a utility model registration, there is no reason that an examiner involved in the original patent application is excluded from an appeal against a decision of refusal of an application for utility model registration ((1969 (Gyo-U) 81) Judgment of Tokyo High Court, Oct 30, 1970, 2-2 Mutaizaisanken-kankei

Min・Gyo Saibanreishuu (Civil Administrative Court Precedents of Intangible Property Rights) 546).

(3) It is not an involvement in the previous trial in a case where an administrative judge who affixed the censorship seal to the written assessment issued by the examiner during his/her tenure as Director of Examination Division or Chief Examiner performs his/her duty on the case ((1941 (O) 1104, Judgment of Supreme Court, Jan 23, 1942) Trial Decision Extra No. 23, p415, "Tokkyohou Gaisetsu (Overview of Patent Act)", Yoshifuji, (9th enlarged edition) p535).

(4) A. "Participated in the prior instance" (Code of Civil Procedure Article 23(1)(vi)) means a judge participates in reaching the judicial decision in the prior instance. Even if there is a fact that a judge directed an oral argument and examined evidence in the prior instance, he/she is not excluded from performing the duties ((1951 (O) 759) Judgement of Supreme Court, 2nd Petty Bench, June 26, 1953, 7 Minshu 783).

B. "Participated in the prior instance" (Code of Civil Procedure Article 23(1)(vi)) means to participate in forming the national will of justice, more specifically, to participate in the judicial decision and written judgment.
It should be interpreted that preparatory procedures or preparation of oral arguments that remain as preparatory acts for trial are not included in the participation ((1964 (Gyo-Tsu) 28, Judgment of Supreme Court, Oct 13, 1964, 18-8 Minshu 1619).

C. A patent attorney who participated in the trial for a trial decision subject to a suit rescinding a trial decision as an administrative judge in his/her tenure (appointed June 9, 1964, retired end of March 1965, not participated in the trial decision of the case but participated in the proceedings as a chief administrative judge) was filed an action as an agent for the action. Such action is invalidated because the other party made an objection as violation of Patent Attorney Act Article 8(2) and the action was

dismissed as unlawful demand and maintained the original trial ((1968 (Gyo-Tsu) 78) Judgement of Supreme Court, 1st Petty Bench, Feb 13, 1969, 234 Hanrei Times 131, etc.)

(5) The provision under Rules of Civil Procedure Article 10 only specifies to make prima facie showing of grounds for recusation within three days from the date on which the motion was filed for preventing unsubstantiated allegations, but it does not specify not to commence a judgment on the motion until three days have been passed from the date of filing the motion (1978 (Ra)751) Judgment of Tokyo High Court, July 25, 1978、898 Hanrei Jiho 36).

(6) If a supporting intervenor also has a self-specific ground, namely, a ground that there are circumstances existing between the intervenor and the administrative judge that would prejudice the impartiality of the trial, the supporting intervenor may also file a motion requesting a recusation as long as the principal parties don't lose the right to recusation and it does not go against the will ((1975 (Ra) 91) Judgment of Nagoya High Court, November 26, 1975, 815 Hanrei Jiho 62).

(7) A fact that a judge is a son-in-law of a procedural attorney does not fall under a ground for recusation ((1953 (O) 277) Judgement of Supreme Court, 2nd Petty Bench, Jan 28, 1955, 9-83 Minshu).

(8) A ground for recusation occurs when an existence of a special relationship both personal and materials between a judge and a specific case where objectively impartial judgment may not be expected. The motion shall be dismissed since general reasons not directly related to a specific case such as ineligibility, behaviors including subsequent behaviors, thought, legal opinions of the judge may not be interpreted as constituting grounds for recusation ((1970 (U) 283) Judgment of Tokyo High Court, May 8, 1970, 590 Hanrei Jiho 18; (1970 (Ku) 191) Judgment of Supreme Court, 1st Petty Bench, September 29, 1970, 100 Saishumin (Supreme Court Collection of Precedents Civil Affairs) 499).

(9) An act requiring urgency (Code of Civil Procedure the proviso of Article 26) refers to acts to be taken when it is necessary to perform immediately the judgment for avoiding the damages due to delay such as preservation of evidence, provisional seizure (disposition), etc. and realize urgently the results according to the content of the judgment. In view of a purport of the recusation system, it is reasonable to interpret that an act where the procedures in the instance are concluded such as by issuing a decision to dismiss an application for provisional disposition, but it does not form any new legal status is not included in the act requiring urgency. ((1976 (Ra) 676) Judgment of Tokyo High Court, Feb 18, 1977, 847 Hanrei Jiho 49).

(10) An application before and after division has become different cases, thus, it is not illegal an examiner or an administrative judge of the former case relates to an examination or a trial of the latter case, and it does not become a ground for recusation when an administrative judge of the former case who suggested a division during the trial proceedings is involved in a trial after a division ((1957 (O) 985) Judgment of Supreme Court, 3rd Petty Bench, April 4, 1961).

(11) A suit rescinding a trail decision may not be instituted against the decision of dismissal of a motion requesting a recusation of an administrative judge of the JPO ((1960 (O) 1072) Judgment of Supreme Court, 2nd Petty Bench, March 24, 1961).

(12) Regarding an execution of an authority to ask for explanation, even if a court considers another legal argument is possible from evidential materials already submitted and suggests this legal configuration to the party, it falls within a range of authority to ask for explanation and thus it cannot be said that there is a circumstance that would prejudice the impartiality of the trial ((1971 (Gyo-Ta) 1) Judgment of Tokyo High Court, April 3, 1971, 263 Hanrei Times 226).

(Revised June 2019)