

70-00 P U D T**Retrial**

1. Summary

A system of retrial is a method of appeal that a party, etc. request a cancellation of a final and binding decision to revoke or trial/appeal decision when there are serious defects in an opposition to grant of patent (registration of trademark) or trial/appeal procedures, or critical errors in materials on which the determination was based were overlooked, etc. After a decision to revoke or a trial/appeal decision becomes final and binding, it is natural that a solution by the decision to revoke or trial/appeal decision should be respected for the legal stability, but if no exception is allowed even if there are serious defects, it would be contradictory to the requirements for appropriateness of the proceedings. Therefore, it makes possible that an opposition to grant of patent (registration of trademark) or a trial/appeal may be demanded/requested again at the same instance.

2. Request for Retrial

(1) A party in a decision to revoke or in a trial/appeal decision may file a retrial against the final and binding revocation decision and a final and binding trial/appeal decision (Patent Act Article 171(1), Utility Model Act Article 42(1), Design Act Article 53(1), Trademark Act Article 57(1)).

When a retrial for invalidation (including a trial for invalidation for registration of an extension of the term) is filed, it is not required to make all co-owners demandants since Patent Act Article 174(3) does not apply *mutatis mutandis* to Patent Act Article 132(3).

(2) Code of Civil Procedure Articles 338(1)(2) and 339 apply *mutatis mutandis* to a demand/request for retrial (Patent Act Article 171(2), Utility

Model Act Article 42(2), Design Act Article 53(2), Trademark Act Article 57(2)). The grounds for retrial are limited as below. Other than those grounds, for example, an error in determination of inventive step of a patent, etc. do not become a ground for retrial.

Code of Civil Procedure Article 338

1. If any of the following circumstances are present, a party may appeal against a final judgment that has become final and binding by filing a retrial; provided, however, that this does not apply if a party, when filing the appeal to the court of second instance or the final appeal, alleged those circumstances, or knew of them but did not allege them:

- (i) the court that pronounced judgment was not composed in accordance with the law;
- (ii) a judge who, by law, is not permitted to participate in the judgment, has participated in the judgment;
- (iii) statutory representative authority, authority for representation in litigation, or the delegation of powers that a representative needs in order to perform procedural acts, was lacking;
- (iv) a judge who participated in the judgment has committed a crime in connection with that judge's duties in the case;
- (v) another person's criminally punishable act has caused the party to make an admission or prevented the party from advancing allegations or evidence that would have influenced the judgment;
- (vi) the documents or any other objects used as evidence toward the judgment were forged or altered;
- (vii) false statements by a witness, expert, or interpreter, or by a party or statutory agent who had been sworn in, were used as evidence toward the judgment;

- (viii) the civil or criminal judgment or other judicial decision, or the administrative disposition, on which the judgment in question was based has been modified by a subsequent judicial decision or administrative disposition;
- (ix) there has been an omission involving a determination with regard to a matter of material import that would have influenced the judgment;
- (x) the judgment to which the protest pertains conflicts with a previous judgment that has become final and binding.

2. If presenting any of the circumstances set forth in items (iv) to (vii) of the preceding paragraph, a party may demand a retrial only if a guilty verdict or decision imposing a civil fine for the relevant criminally publishable act has become final and binding, or if the reason that it is not possible to obtain a final and binding guilty verdict or final and binding decision imposing a civil fine for the relevant criminally publishable act is something other than the lack of evidence.

Code of Civil Procedure Article 339

If the circumstances prescribed in paragraph (1) of the preceding Article are present with regard to the judicial decision based on which a judgment is made (limited to the case prescribed in paragraph (2) of said Article if any of the circumstances set forth in items (iv) to (vii) of said paragraph are present), such circumstances may be given as grounds for retrial in connection with the judgment, even if the means of filing an independent protest against such judicial decision have been specified.

(3) When a demandant/appellant and a demandee/appellee have conspired to bring about a decision on the trial or appeal with the aim of harming the rights or interests of a third party, the third party may file a request for a retrial to overturn the final and binding decision (Patent Act Article 172(1),

Utility Model Act Article 43(1), Design Act Article 54(1), Trademark Act Article 58(1)). This retrial must be filed against the demandant/appellant and the demandee/appellee as joint demandees/appellees (Patent Act Article 172(2), Utility Model Act Article 43(2), Design Act Article 54(2), Trademark Act Article 58(2)).

(4) A written request for a retrial must attach a copy of a trial/appeal decision (decision) regarding the appeal (Patent Act Article 171, Enforcement of Regulations of the Patent Act Article 50-12, Rules of Civil Procedure Article 211(1)).

3. Period for Demand/Request for Retrial

(1) A request for a retrial must be filed within 30 days from the date on which the appellant becomes aware of the grounds for the retrial after the decision to revoke or the trial/appeal decision becomes final and binding (Note that a request for retrial may not be filed during the statute of limitations) (Patent Act Article 173(1), Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61).

(2) If a person who is to file a request for a retrial is unable to file the request within the period provided for in the above due to reasons not attributable, the person may file the request within 14 days after the date on which those reasons cease to exist, but not later than six months after the end of the aforementioned period (Patent Act Article 173(2), Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61).

(3) When a request for a retrial is filed on the grounds that the appellant was not represented in accordance with the provisions of law, the request is filed within 30 days from the day after the appellant or the statutory agent learns of the revocation decision or the trial/appeal decision has been rendered through the service (Patent Act 173(3), Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61).

(4) A request for a retrial may not be filed after three years have passed from the date on which the revocation decision or the trial/appeal decision became final and binding. However, if reasons for a retrial arise after the revocation decision or the trial/appeal decision becomes final and binding, a request for a retrial may be filed within 3 years from the day arising the reasons for a retrial. (Patent Act Article 173(4)(5), Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61).

(5) Items (1) and (4) do not apply to the period for a request for a retrial on the reasons that the revocation decision or the trial/appeal decision conflicts with the final and binding revocation decision or trial/appeal decision previously rendered (Patent Act Article 173(6), Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61).

4. Proceedings of Retrial

(1) When a trial/appeal decision should be dismissed

For example, a request for a retrial is dismissed by a trial/appeal decision or a decision when a request for a retrial falls under the followings where it is an unlawful request and not amendable.

A. When a request for a retrial is not against a final and binding trial/appeal decision or a final and binding revocation decision (Patent Act Article 171(1), 172(1)).

B. When an appellant does not meet eligibility for being an appellant for retrial (Patent Act Articles 171(1), 172(1)(2)).

C. When a period that a demand/request for a retrial may be filed has passed (Patent Act Article 173).

D. When a party has already alleged on the grounds of the retrial at a suit rescinding the trial/appeal decision or the final appeal, or a party did not allege even though the party has known the grounds (Patent Act Article 171(2) → Code of Civil Procedure a proviso of Article 338(1)).

E. The grounds alleged in a request for a retrial do not fall under any of the grounds for a retrial provided in Code of Civil Procedure Article 338(1) each item.

(2) When a request for a retrial should be found to be groundless

When a request for a retrial is procedurally lawful and it reaches a conclusion that a retrial is found to be groundless as a result of examination of the grounds for the retrial (Code of Civil Procedure Article 338(1) each item), a trial/appeal decision or a decision is made to be groundless against the request for a retrial rather than dismissing the request for a retrial by a trial/appeal decision or a decision.

[Explanation]

In the provision of the Code of Civil Procedure for a retrial, when a request for a retrial is unlawful, it will be dismissed (Code of Civil Procedure Article 345(1)), and when a request for a retrial is groundless, it will be rejected (Code of Civil Procedure Article 345(2)). In the Patent Act, it does not apply mutatis mutandis to the provisions of the Code of Civil Procedure, but similar to cases of the Code of Civil Procedure, when the case is examined on the merits as to whether there are grounds for a retrial, it is not appropriate to dismiss by trial/appeal decision under Patent Act Article 135, thus it is handled as per the above item 4. and item 5. This arrangement is explained in a court precedent ((2007 (Gyo-ke) 10407), Judgment of the IP High Court, May 28, 2008).

This also applies to Utility Model Act (Utility Model Act Article 42), Design Act (Design Act Article 53), Trademark Act Article (Trademark Act Article 57).

5. Application Mutatis Mutandis of Provisions of Trial/Appeal

(1) For procedures and proceedings of a retrial, the provisions of trial/appeal and an opposition to grant of patent are applied mutatis mutandis (Patent Act

Article 174, Utility Model Act Article 45, Design Act Articles 57, 58, Trademark Act Articles 60-2, 61, 62).

(2) The provision of the Code of Civil Procedure Article 348(1) (Note) applies *mutatis mutandis* to a retrial (Patent Act Article 174(5), Utility Model Act Article 45(1), Design Act Article 58(1), Trademark Act Article 61).

(Note)

Code of Civil Procedure Article 348

1. When a decision to commence a retrial becomes finalized, a court examines and judges the merits of the case within the limits of the appeal.

6. Restriction on Effects of Patent Rights Restored by Retrial

(1) When a patent right, etc. pertaining to a patent, etc. revoked or invalidated have been restored through a retrial, or when the establishment of a patent right of a patent application that was refused by a trial decision has been registered through a retrial, effects of the patent right, etc. do not extend to the working of the patented invention in good faith after rendering the final and binding decision of the revocation decision or trial appeal decision but before the registration of a request for a retrial (Patent Act Article 175, Utility Model Act Article 44, Design Act Article 55, Trademark Act Article 59).

(2) When a patent right, etc. pertaining to a patent, etc. revoked or invalidated have been restored through a retrial, or when the establishment of a patent right of a patent application that was refused by a trial decision has been registered through a retrial, a person doing the business or preparing for the business to work the patented invention in good faith after the final and binding decision of the revocation decision or trial appeal decision but before registration of a demand/request for a retrial, has a non-exclusive license on the patent right, to the extent of the invention that the person is working and preparing to work and also of the purpose of the business (Patent

Act Article 176, Utility Model Act Article 45, Design Act Article 56). Regarding a trademark, as a result of using a trademark in good faith after a final and binding trial/appeal decision but before a registration of a demand/request for retrial, when a trademark has been widely known among consumers and traders as that indicating the own products in filing a retrial, the right to use the trademark has been continued (Trademark Act Article 60).

7. Others

(1) Preliminary registration of a request for a retrial

When a retrial is requested, a preliminary registration is filed (Patent Registration Order Article 3(iv)). When a retrial for an appeal against examiner's decision of refusal is requested, it is registered preliminary to the original register of a request for a retrial against an appeal decision of refusal of patents (Patent Registration Order Article 9) which is a binder type ledger (Patent Registration Order Article 10(2)). A request for a retrial against inter partes trial and an opposition are registered preliminary in a patent registration register.

(2) Registration of final and binding decision of a retrial

When there are a final and binding appeal decision (decision) of a retrial, or a correction for the specification, claims or drawings by a retrial, it is registered in the original register (Patent Registration Order Article 16 (ii) (x)). A withdrawal or dismissal of the decision for a retrial is also registered there. A registration register, etc., are as mentioned in the above (1).

(3) Publication in a patent gazette

A request for a retrial or a withdrawal thereof, or a final and binding appeal decision (decision) (limited to an application of which a registration of the patent right is established, or an application was laid-open) is published in a patent gazette to that effect (Patent Act Article 193(2)(vi)(vii)).

8. Reference Court Precedent

The ground stating that there is a failure in determination of a trial/appeal decision made by the JPO does not affect a conclusion of the original trial/appeal decision in content. Therefore, there is no room to interpret that this corresponds to a failure in determination that is the ground for a retrial, and consequently, it is an unlawful request for a retrial under this reason (1989 (Gyo-ke) 128, Judgement of Tokyo High Court, Oct 12, 1989).

(Revised Oct 2015)