

**80-00 P U D T****A Suit Rescinding a Trial/Appeal Decision**

## 1. A Suit Rescinding a Trial/Appeal Decision

## (1) Summary

A suit rescinding a trial/appeal decision, etc. is administrative litigation that may be filed with a court requesting rescission of an administrative disposition of a trial/appeal decision, etc. made by the Japan Patent Office as an administrative agency.

## (2) Jurisdiction

The Tokyo High Court has the exclusive jurisdiction over the following cases and the IP High court, a special branch of the Tokyo High Court handles those cases: a lawsuit against a decision to revoke, a trial/appeal decision, a decision to dismiss an amendment in trial/appeal (Design Act Article 17-2, Trademark Act Article 16-2), or a law suit against a dismissal of a written opposition to grant of patent (registration) or a dismissal of a request for trial/appeal, a retrial, or correction (Patent Act Article 178(1), Utility Model Act Article 47(1), Design Act Article 59(1), Trademark Act Article 63(1), Act for Establishment of the Intellectual Property High Court Article 2).

## (3) Party

A. A plaintiff is a person who receives a decision to revoke, a trial/appeal decision, a decision to dismiss an amendment in a trial/appeal, or a decision to dismiss an opposition to grant of patent (registration), a request for a trial/appeal, a retrial, or correction. A plaintiff is also a successor, an intervenor or a person whose application for intervention was refused for the above cases (Patent Act Article 178(2), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)).

A succession of a status of a party in an opposition to grant of patent (registration) is not accepted, and therefore a successor does not become a plaintiff (→22-01 9. (5)).

B. The Commissioner of the Japan Patent Office must become a defendant in a lawsuit against a decision to revoke or a trial/appeal decision (except those related to an invalidation trial, an invalidation trial for registration of an extension of the term, a trial for recession, and a retrial against a final and binding trial decisions for those trials), and a lawsuit against a decision to dismiss an opposition to grant of patent (registration), a request for trial/appeal, a retrial and a request for correction.

For a lawsuit against an invalidation trial, an invalidation trial for registration of an extension of the term, a trial for recession, and a retrial against a final and binding trial decisions for those trials, a demandant or a demandee of the trial or the retrial must be the defendant (Patent Act Article 179, Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)).

#### (4) Statute of limitations for filing an action

An action may be filed within 30 days from the date on which a certified copy of a trial/appeal decision or a decision was served. This time frame is not extendable (Patent Act Article 178(3)(4), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)). A chief administrative judge may decide an additional period to this unextendable period ex officio for a person living in a remote area or a place with inconvenient transportation (Patent Act Article 178(5), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)) (→25-04 4.).

#### (5) Court decision

When a court finds, as a result of the proceedings, there are grounds for a demand/request, a trial/appeal decision or a decision must be rescinded

(Patent Act Article 181(1), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)). A court decision to rescind an original administrative disposition or an administrative judgment is binding on the administrative agency as a party and any other administrative agencies related to the case (Administrative Case Litigation Act Article 33(1)). When a court decision rescinding a trial/appeal decision or a decision has become final and binding, an administrative judge must conduct further proceedings and make a trial/appeal decision or a decision (Patent Act Article 181(2), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)). Regarding a lawsuit against a trial/appeal decision, etc. filing after April 1, 2012, when a court decision rescinding a trial/appeal decision, etc. becomes final and binding regarding a part of the claims in a group of claims, the administrative judge must rescind the trial/appeal decision on other claims in the group of claims upon re-opening the proceedings (Patent Act Article 181(2)). The proceedings are conducted on “a group of claims” as a unit thereafter. In this case, the part rescinding the trial/appeal decision etc. is described in a notice of re-opening the proceedings.

If a court finds there is groundless for requesting a lawsuit, it will be rejected.

## 2. Procedure Between Parties

### (1) Summary

According to the Code of Civil Procedure, this procedure is carried out between a plaintiff (an applicant, a right holder) and a defendant (the JPO) directly without going through the Tokyo High Court (the IP High Court) in the proceedings of a case of a suit rescinding the trial decision under the Patent Law, the Utility Model Act, Design Act or Trademark Act (including “a suit rescinding a decision to revoke case” regarding an opposition to grant of patent (registration)).

(2) Summary of the procedures

A. Direct sending of preparatory documents, etc. (Rules of Civil Procedure Article 83(1))

<Document subject to direct sending>

(A) Preparatory documents (including a written reply), a copy of documentary evidence

In principle, “preparatory documents (including a written reply)” must be sent directly to the other party without going through the court under the provision of the Rules of Civil Procedure Article 83(1).

A “copy of documentary evidence” is in principle sent by the court, but may be also sent directly to the other party under the provision of the Rules of Civil Procedure Article 137(2).

(B) Receipt

The other party who received the documents directly must send a receipt in principle to the party who sent the documents and to the court.

<Methods of sending documents>

(A) Types of the methods

The Rules of Civil Procedure Article 47 provides direct sending and other types of sending documents are conducted by delivering a copy of the documents to be sent or by sending the documents by facsimile. Namely, when preparatory documents (including a written reply) or a copy of documentary evidence is sent directly, it is sent to a delivery location of the other party by using any sending method such as “mailing”, “submission at the counter”, “facsimile.”

(B) Advantage and disadvantage of sending by facsimile

“Sending by facsimile” has an advantage of promptness and convenience, thus it uses positively for sending and receiving a “receipt”.

However, considering “preparatory documents (including a written reply)” sometimes include a chemical formula, a drawing, etc. and a “copy of

documentary evidence” includes documents containing many drawings such as patent gazettes or technical documents, etc., these documents are not appropriate for “sending by facsimile”.

(C) Requests from a court

A court requests “preparatory documents” or a “copy of documentary evidence” is submitted with one additional copy for the court (three copies in total) without using a facsimile, and the JPO takes this request and submits those documents at the counter of the court without using a facsimile.

(D) Submission of documents directly from the JPO

For the reasons described above, preparatory documents or a copy of documentary evidence directly delivered by the JPO is in principle sent “by mail.” However, if the deadline is imminent, they are sent “by mail” after “by facsimile.”

Regarding a delivery of a receipt from the JPO, when documents are directly sent by mail, a receipt is sent “by facsimile” in principle, but there is no facsimile number in a complaint, a receipt is sent by mail. However, when documents are submitted at the counter of the court directly, a receipt will be given on the spot.

(E) Submission of documents directly from a plaintiff (an applicant)

Regarding a direct sending of documents from a plaintiff or the agent, preparatory documents or a copy of documentary evidence is “sent by mail” or “submitted at the counter.” However, if the deadline is imminent, they are “sent by mail” or “submitted at the counter” as soon as possible after “sent by facsimile.”

A method of delivery of a receipt is in principle “sent by a facsimile”, but it is possible to “send by mail” or “submit at the counter.”

For delivery of a duplicate, etc. of a self-represented lawsuit, if there is time until the next due date, it is not directly sent by the JPO but sometimes sent by the Tokyo High Court (the IP High Court).

## B. Inquiry by a party (Code of Civil Procedure Article 163)

The Code of Civil Procedure provides “the system of inquiry by a party” where a party may obtain the necessary information for allegations or proof from the other party directly. It regulates “while litigation is pending, a party may specify a reasonable time frame for response and direct a written inquiry to the adverse party, so as to elicit from that party a response in writing, with regard to particulars that are necessary for preparing allegations or proof” (Code of Civil Procedure Article 163 main text).

### (A) Possible period for inquiry by a party

A time possible for inquiry is “while litigation is pending”, namely it is after having served a duplicate of complaint to the plaintiff until the end of the oral argument.

### (B) Matters that can be inquired

Matters that can be inquired are those necessary for preparation for allegations or proof (it is wider than a request for clarification necessary “for clarifying litigation relationships”). Matters for inquiry include such as a place storing publicly known publications which are out of print (a name of library, etc.), or presence or absence of a drawing of a product, a production flow chart, experimental data.

### (C) Matters that cannot be inquired (Code of Civil Procedure proviso of Article 163 (i)~(vi))

- a. Inquiry that is not specific or individual
- b. Inquiry that insults or confuses the opposite party
- c. Inquiry that is duplicate of the previous inquiry
- d. Inquiry that asks for opinion
- e. Inquiry that requires an unreasonable cost or time for the opposite party to reply
- f. Inquiry on matters similar to those which can be refused to testify under the provision of the Code of Civil Procedure Articles 196, 197

(D) Matters to be described in a written inquiry

Matters to be described in a written inquiry are shown below. Inquiries are described separately by items (Rules of Civil Procedure Article 84(2)).

a. Name of a party and his/her agent

b. Indication of the case

c. Indication of a court where the suit is pending

d. Date of inquiry

e. Inquiries and their necessity

f. Inquiry pursuant to the provision of the Code of Civil Procedure Article 163

g. Period of reply

h. Address, postal code and facsimile number of a person who makes inquiries

(E) Inquiry address

Inquiries are addressed to the Litigation Affairs Office, Trial and Appeal Department, JPO, where documents are delivered by mail or at the counter (not addressed to an authorized agent of a plaintiff).

However, when the deadline is imminent, inquiries may be delivered by facsimile and afterwards they are delivered by mail or at the counter.

### 3. Final Appeal

#### (1) Final appeal

When there an appeal against a court decision of the High Court, an appellant may file a final appeal to the Supreme Court.

A petition for a final appeal is submitted to the Tokyo High Court (the IP High Court) (Code of Civil Procedure Article 314(1)).

#### (2) Period for a final appeal

A final appeal may be filed within two weeks from the date on which a court decision was served, and this is an inalterable time frame (Code of Civil Procedure Article 313 → Article 285).

### (3) Reasons for a final appeal

A final appeal may be filed under the limited reasons set forth in the Code of Civil Procedure Article 312 (2) each item, for example, the judgment involves an error in the interpretation of the Constitution, or the judgment is unconstitutional judgment (Code of Civil Procedure Article 312(1)).

However, regarding “a case that is found to involve matters of importance in the interpretation of laws and regulations” such as a case that conflicts with a Supreme Court precedent, it may rule to accept as the final appellate court by decision (A system for a petition for the acceptance of a final appeal, Code of Civil Procedure Article 318).

Regarding a judgment or an order, from the perspective of unifying interpretation of laws and regulations, there is a system of appeal with permission where an appeal may be filed to the Supreme Court by permission of the High Court against a judgment or an order of the High Court (Code of Civil Procedure Article 337).

### (4) Court decision

Court decisions include a dismissal of a final appeal, reversal and remand, and reversal and decision by final appellate court.

(Revised Feb 2015)



**80-01 P U D T****Administrative Work Associated with Filing a Lawsuit****1. Complaint**

When a suit rescinding a trial/appeal decision, etc. (Patent Act Article 178(1), Utility Model Act Article 47(1), Design Act Article 59(1), Trademark Act Article 63(1)) is filed, a notice of filing a suit (hereinafter referred to as a “notice”), etc. are delivered (Patent Act Article 180(1)(2), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Article 63(2)) for a suit where the Commissioner of the JPO is not a defendant (inter partes case) from a clerk of the IP High Court (Sections 1-4), while a notice is delivered for a suit where the Commissioner of the JPO is a defendant (an ex parte case), and after that a complaint and summons for an appearance date are delivered (Administrative Case Litigation Act Article 7, Code of Civil Procedure Articles 138(1), 94).

**2. Examination of Documents**

The Litigation Affairs Office examines the above documents when receiving on the following points verifying with the record of the trial/appeal case in connection with the suit (including application documents if the case is an ex parte case).

- (1) Name of a party
- (2) Indication of a case
- (3) Period for filing a suit

**3. Results of Verification**

If there is a discrepancy in indications in the above documents or the above filing period has passed, an authorized agent in charge by each section of the

Litigation Affairs Office prepares and submits a written reply to dismiss the appeal to the court. However, when the case is inter partes case, they are notified to the court.

#### 4. Entry in the Ledger and Preparation for Record of Court Cases

The Litigation Affairs Office prepares a record of court cases, etc. by making an entry of required information based on the above documents to “Case Files” and “Due Date Book of Cases.”

#### 5. Authorization of Agent

An authorized agent is an official designated by the Commissioner of the JPO as executing a suit rescinding a trial/appeal decision, etc.

(Reference)

Act on the Authority of the Minister of Justice over Suits Relating to the Interests of the State Article 5(1)

An administrative agency may designate one of its officials to conduct a suit where the administrative agency is a party or intervenor.

An authorized agent has the authority to perform any and all acts in court with regard to a suit rescinding an appeal decision, etc., except for the appointment of an agent (Article 8 of the same Act in the above). When a suit rescinding an appeal decision, etc. is filed, the Litigation Affairs Office takes the procedure for designating an authorized agent of the defendant, the Commissioner of the JPO, and delivers a written designation of authorized agent to the IP High Court.

An authorized agent is a chief administrative judge and an administrative judge of the Department, and a chief administrative judge and an administrative judge of the Litigation Affairs Office. The former becomes a chief authorized agent. However, when reasons for rescission are related to a

general legal interpretation and application of the law, or when a case involves the violation of the Examination Guidelines or practices or requires the changes (common cases), the latter becomes a chief authorized agent.

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