

## **4.Opposition to Grant of Patent**

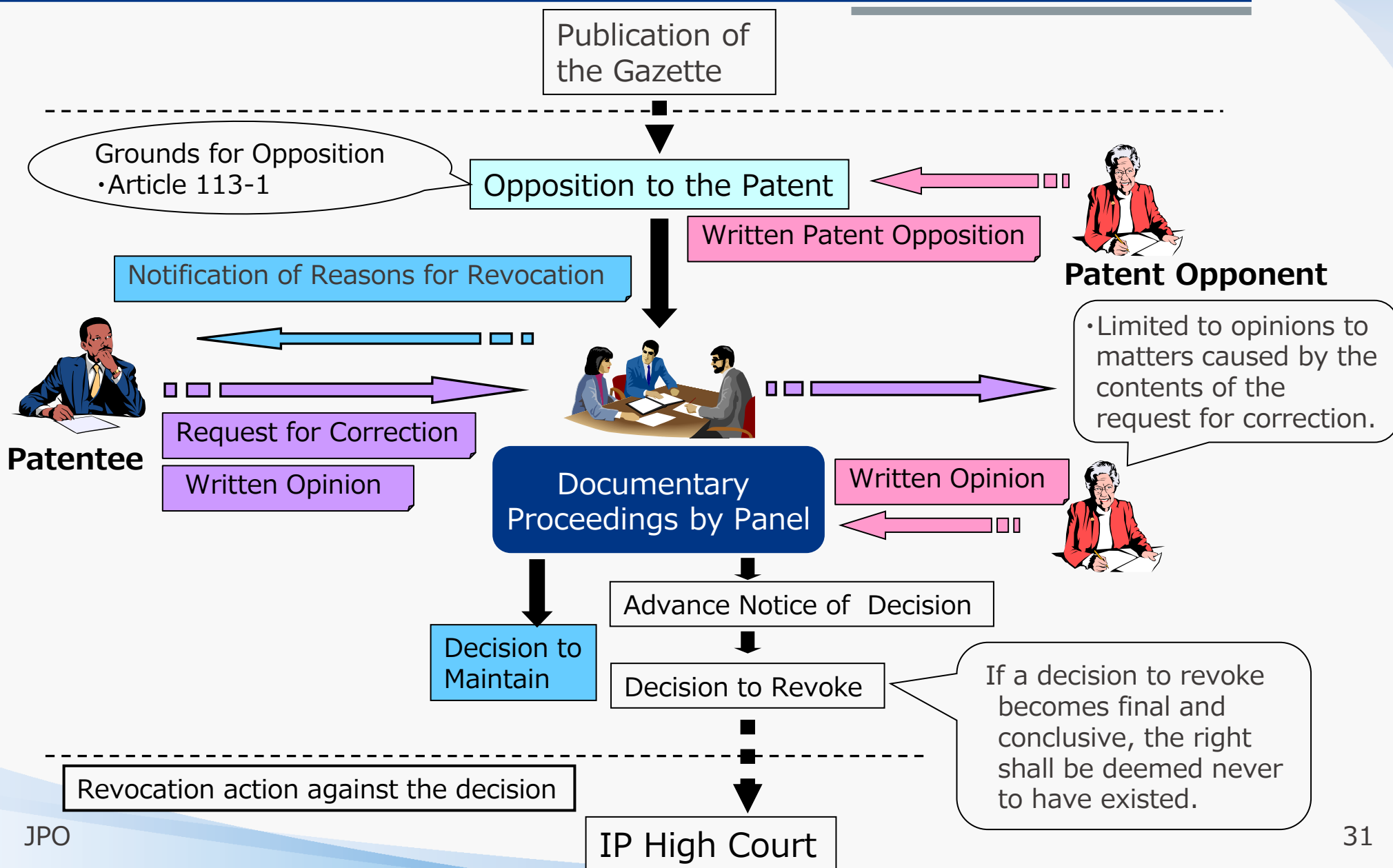
## 4.(1) Comparison: Opposition and Trial for Invalidation

	Opposition to Grant of Patent	Trial for Patent Invalidation
Purposes of the system	To grant stable patent rights at an early stage	To resolve disputes between parties concerned regarding the validity of patents
Procedures	Ex Parte (In principle, conducted between the JPO and the patentee)	Inter Partes (conducted between the demandant and patentee (demandee))
Person(s) eligible to file a request for opposition/trial	Any persons (Anonymity is not acceptable)	Interested persons only
Period of time to file	Within 6 months from the publication date of the Gazette of the patent (requests will not be accepted if the opposed patent has been surrendered or has lapsed)	Any time after the registration of establishment of rights (even if the opposed patent has been surrendered or has lapsed)
Unit of filing a request	On a claim-by-claim basis Requests for withdrawal will not be accepted after the issuance of notification of reasons for revocation	On a claim-by-claim basis Requests for withdrawal after the submission of a written reply will require approvals from the adverse party

## 4.(1) Comparison: Opposition and Trial for Invalidation

	Opposition to Grant of Patent	Trial for Patent Invalidation
Reasons	novelty, inventive steps, new matter, description requirement, etc. (=Grounds of public interest)	1. novelty, inventive steps, new matter, description requirement, etc. (=Grounds of public interest) 2. Reason related to ownership of rights 3. Reason occurring after the grant of patent
Examined by	Documentary proceedings	Oral proceedings in principle
Appeals	Decision to revoke → May be filed with the IP High Court naming the JPO Commissioner as a defendant Decision to maintain → Not accepted	May be filed with the IP High Court naming the adverse party as a defendant
Fees	16,500 yen + (the number of filed claims x 2,400 yen)	49,500 yen + (the number of requested claims x 5,500 yen)

## 4.(2) Procedures for Opposition to Grant of Patent



## 4.(3) Requirements for Filing

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### (1) Person(s) eligible to file

“Anyone” has the right to file a request for oppositions to patent.

### (2) Patentee

Patentee means all joint holders of patent right.

### (3) Time limit for filing

Within six months from the publication date of the Gazette containing the patent

### (4) Reasons for the opposition

Limited to reasons related to public interests (Art. 113 of Patent Act)

(OK) Novelty / inventive step (Art. 29, 29-2 and 39)

(OK) Description requirements (Art. 36)

(NG) Reasons related to formality (such as cases related to unity of invention / shift amendment / formal description requirement)

(NG) Reasons related to attribution of right

## 4.(4) Proceedings for Opposition

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### (1) Scope of Proceedings

- The subject of a proceedings is restricted to claims of which an opposition to grant of patent has been filed (Art. 120-2 (2))
- Proceedings Based on Reasons for Opposition
  - ✓ An opposition to grant of patent shall be examined based on reasons pleaded by an opponent and evidence
- Ex Officio Proceedings
  - ✓ Reasons that have not been pleaded by an opponent may also be examined ex officio (Art. 120-2 (1))
  - ✓ Since it is necessary to make a final determination at an early stage in the opposition, evidence that has not been submitted by an opponent shall be adopted as long as the evidence can be very easily obtained by administrative judges.
- Documentary Proceedings
  - ✓ All cases of opposition to grant of patent shall be examined through documentary proceedings (Art. 118 (1)).

## 4.(5) Notice of Reasons for Revocation

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### (1) Purport

- Where a panel determines that a patent shall be revoked, a notice of reasons for revocation is issued to notify the patentee of the reasons therefor and give the patentee an opportunity to submit a written opinion and make a correction.

### (2) Procedures

- Where a patent examined by a panel has been determined to be revoked, a patentee shall be notified of reasons for revocation and given an opportunity to submit a written opinion and make a correction within a designated adequate time limit
- A notice of reasons for revocation shall not be sent to an opponent
- When reasons for revocation have been notified, a patentee may submit a written opinion within a designated time limit
- The patentee may file a request for correction of the description, scope of claims, or drawings attached to the application

## 4.(6) Decision

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Effects of a decision that becomes final and binding

### 1. Decision becomes final and binding

- Decision to maintain: becomes final and binding upon a service of certified copies
- Decision to revoke: becomes final and binding after the time limit for institution of action is expired, or when a decision is rendered after a request for opposition is filed and proceedings are conducted.

### 2. Effects of the decision

- Where a decision to revoke has become final and binding, the patent right shall be deemed never to have existed.

### 3. Revocation decision becomes final and binding

- Revocation action may be instituted against the decision to revoke with the IP High Court, naming the Commissioner of the JPO as a defendant within 30 days (120 days for overseas residents) from the service of the certified copies.



## 4.(7) Statistics - Results of Proceedings (As of the end of June 2021)

**The number of requests for opposition filed: 6,902**

The number of gazettes on granted patent between April 2015 and December 2021: 1,294,058

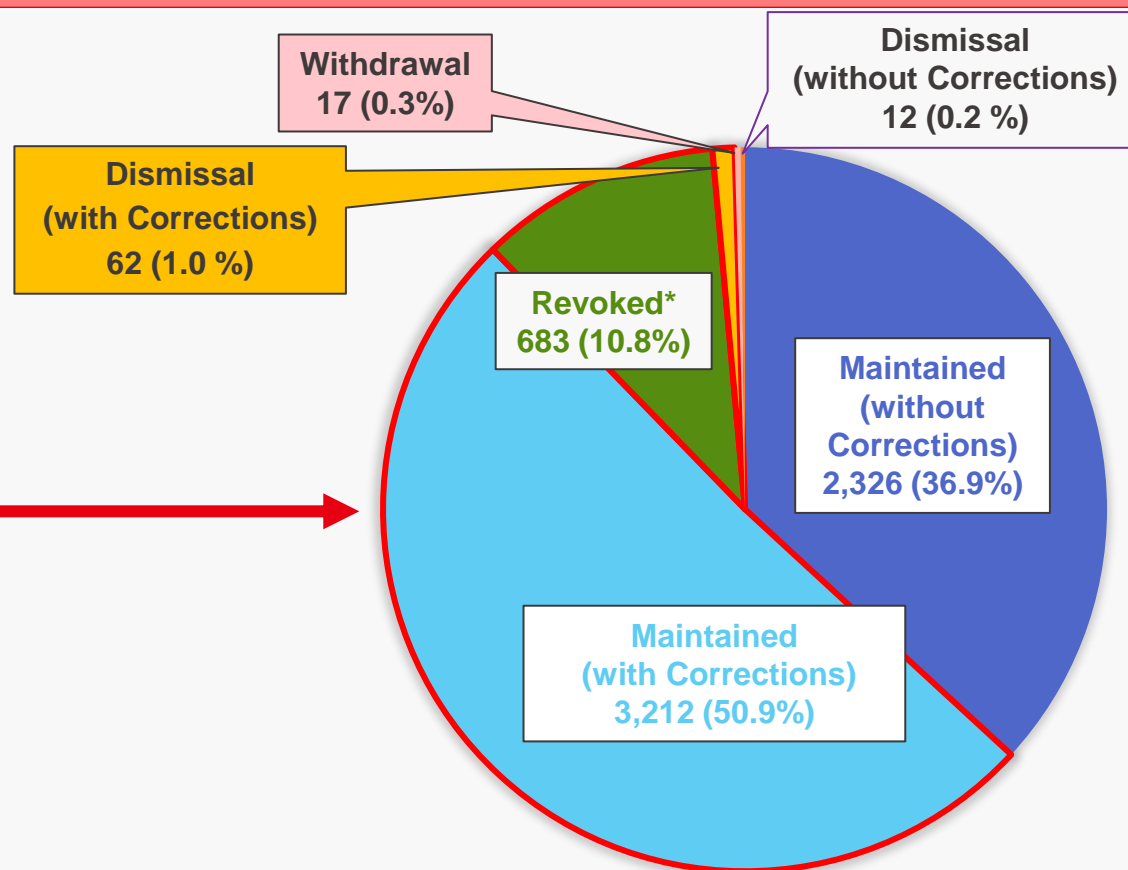
### Conclusions

(Requests for opposition filed between April 2015 and December 2021)

Revocation or Correction



Some changes have been made to 63.3% of the opposed patents



\*\*Revoked" includes revocation of all or part of claims subjected under opposition.

"Dismissal(with corrections)" includes cases where a request is dismissed after the claims at issue have been dropped by correction.

	2019	2020	2021
Pendency period	7.4 months	7.4 months	7.8 months