

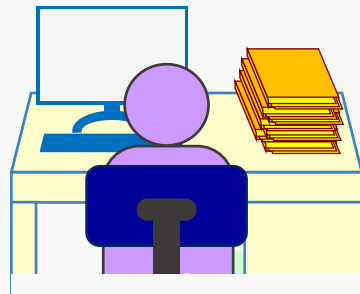
JPO Trial and Appeal Systems



- 1 Overview
- 2 Appeal against an Examiner's Decision of Refusal
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- 5 Summary

1.Overview

1.(1) Overview of JPO Trial and Appeal System



Decision
to
Refuse

Decision
To
Grant

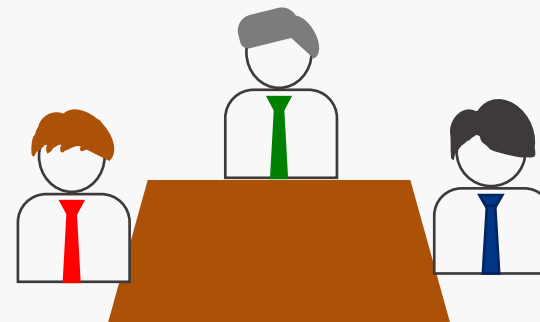
Request for Trial/Appeal



I'm not
convinced!



I don't
believe...



- Trial/appeal shall be conducted by a panel consisting of three or five administrative judges
- A chief administrative judge shall preside over matters relating to the trial
- A trial clerk shall undertake affairs relating to the preparation of the trial, etc.

Points of Trial and Appeal System

- Review Examiners' Decisions
- Determine the validity of rights

1.(2) Roles of TAD

- Reviewing Examiners' Decisions

(1) Determination of appropriateness of a decision of refusal (appeal against an examiners' decision of refusal) *

(2) Improve the reliability of rights (**opposition to grant of patent**/trademark)

- ✓ Technical expertise
- ✓ Utilization of ex officio proceedings
- ✓ Binding legal effectiveness as to third parties

Examination
Departments

TAD

Intellectual Property
(IP) High Court

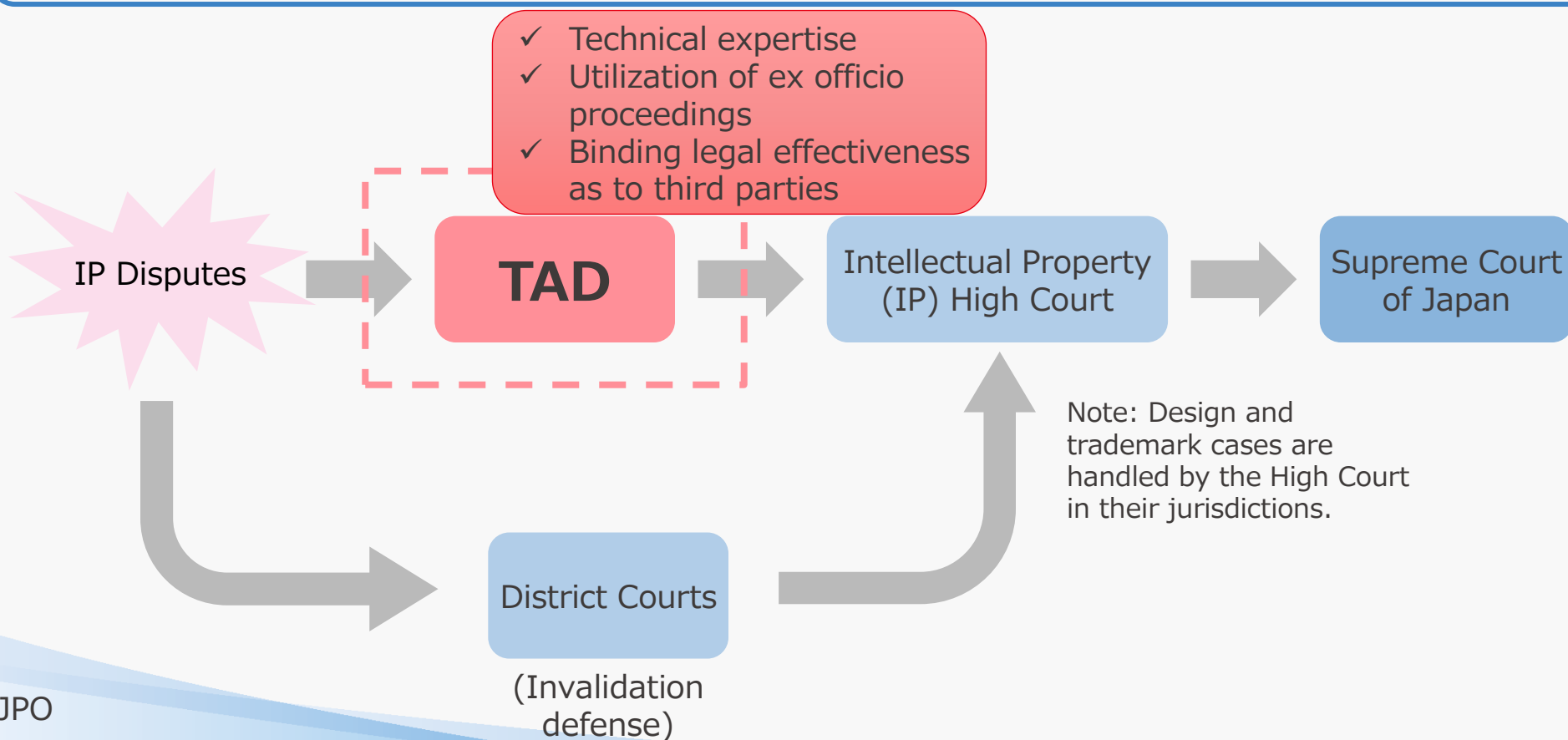
Supreme Court
of Japan



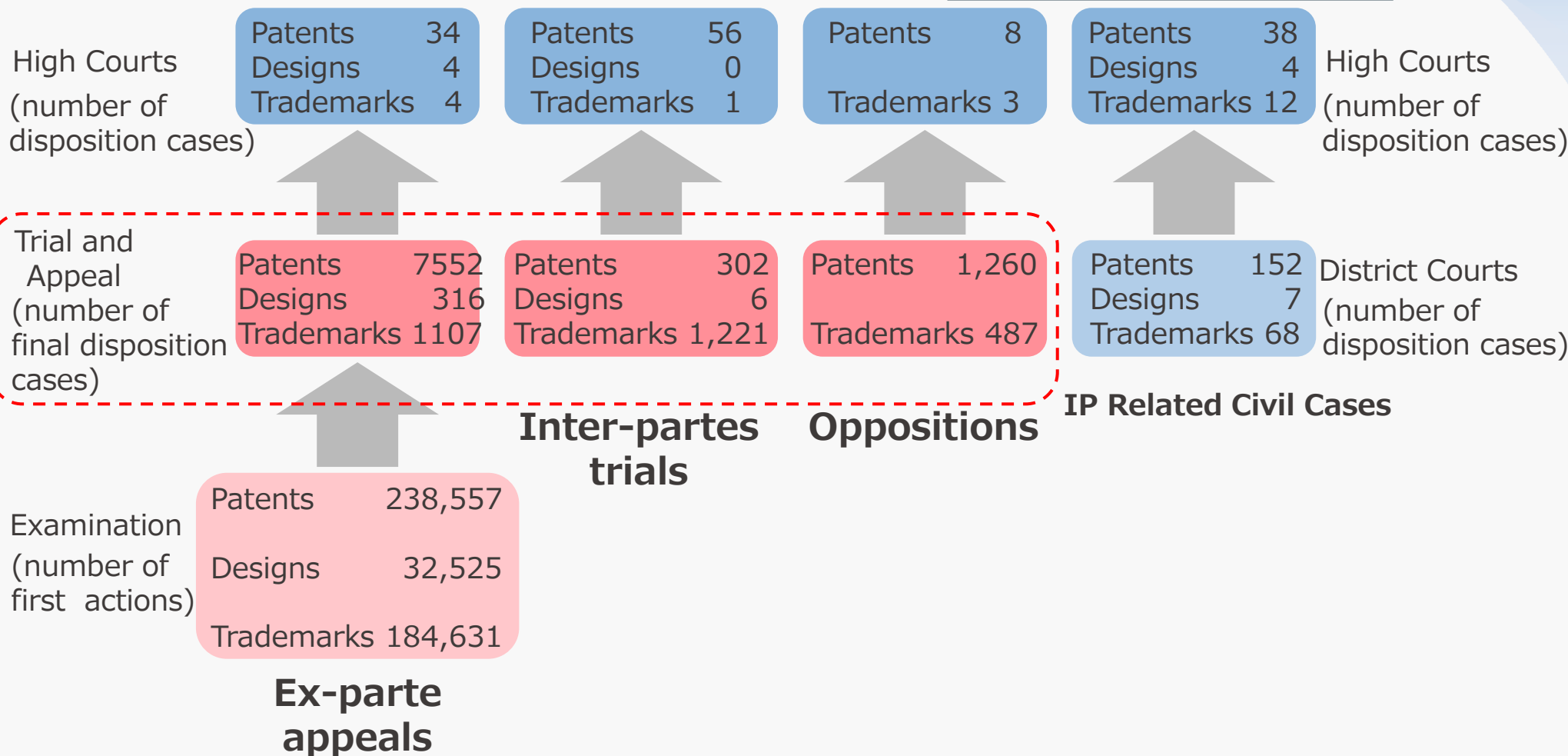
* In principle, a person who is not satisfied with the administrative disposition of administrative agencies or acts involving the exercise of public authority may 1) file complaints against administrative agencies (Administrative Complaint Review Act), or 2) file a lawsuit to the court (Administrative Case Litigation Act). However, under the Patent Act which provides an unique appeal system, a panel consisting of three or five administrative judges with expertise examines the appropriateness of a decision of refusal.

1.(2) Roles of TAD

- Expeditious Resolution of Disputes over Granted IP Rights
 - (1) Determination of validity of patents, etc. (**trial for invalidation**)
 - (2) Correction of scope of claims, etc. (trial for correction)
 - (3) Rescission of registered trademark not in use, etc. (trial for rescission)
 - (4) Advisory opinion on the technical scope of industrial property rights (Hantei)



1.(3) Comparison of the Number of Disposition Cases



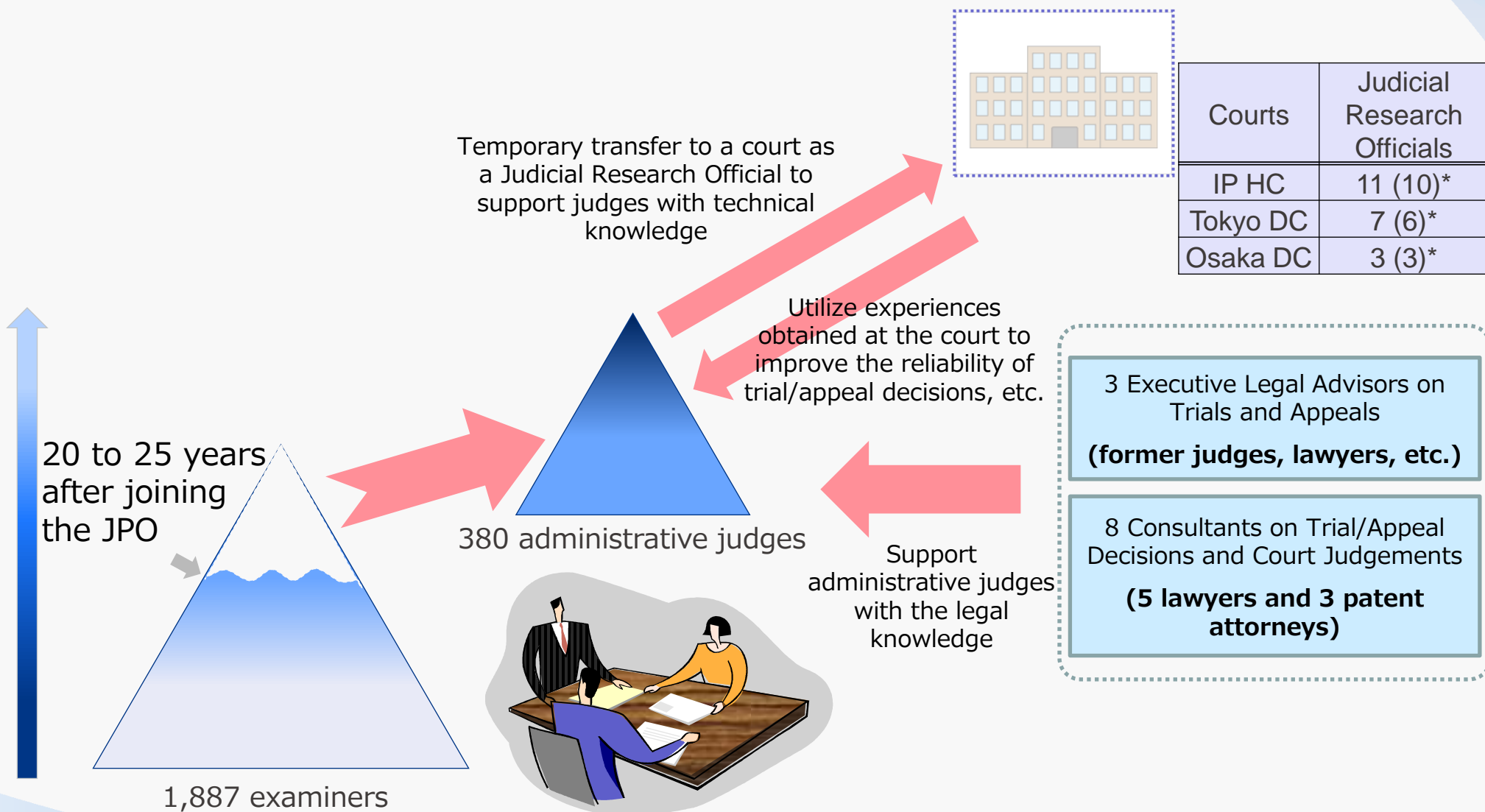
(Sources)- Examination/trial/appeal figures are calculated from the data for 2021.

Court figures are calculated from the data for 2019. "Patents" includes (few) utility model cases.

- These tables are prepared by the JPO based on the information obtained from the Japan Patent Office Annual Report 2022, the Intellectual Property High Court website, etc.

JPO - Breakdown of figures for revocation actions against appeal/trial decisions is collected and calculated by the JPO based on the data for rendition of court decisions or the data for final dispositions. 6

1.(4) Career Paths as Administrative Judges



1.(5) Administrative Judges, Chief Administrative Judge, and Panel

(Panel system for trial)

Patent Act Article 136

(1) A trial shall be conducted by a panel consisting of three or five administrative judges.

(2) A decision of the panel under the preceding paragraph shall be made by a majority vote.

(3) Qualifications of administrative judges shall be as provided by Cabinet Order.

(Designation of administrative judges)

Patent Act Article 137

(1) The Commissioner of the Patent Office shall designate the administrative judges constituting a panel under Art. 136(1) for each trial (…).

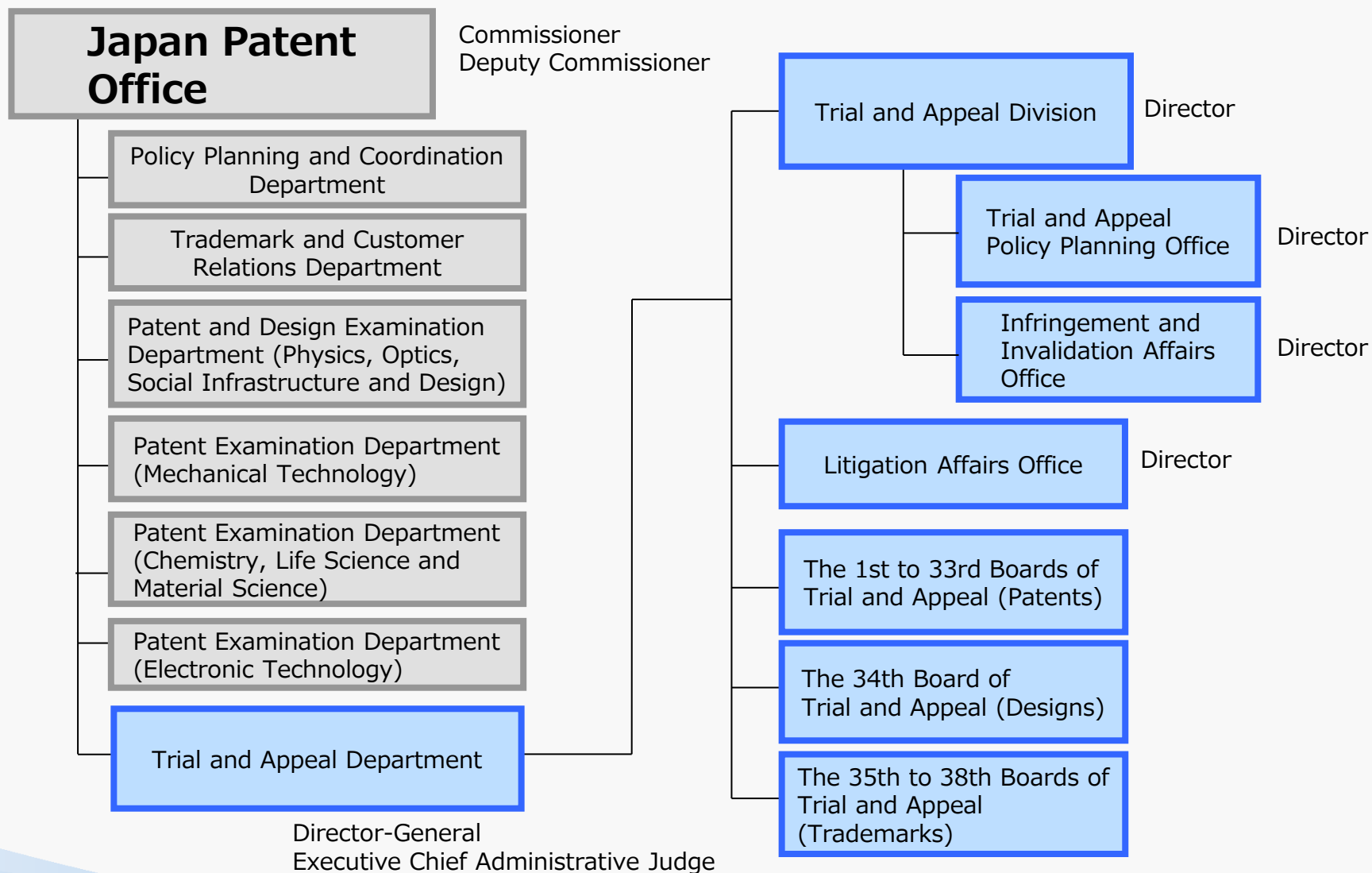
(Chief administrative judge)

Patent Act Article 138

(1) The Commissioner of the Patent Office shall designate one of the administrative judges designated under Art. 137(1) as the chief administrative judge.

(2) The chief administrative judges shall preside over matters relating to the trial.

1.(6) Organization of Japan Patent Office (JPO)



1.(7) Organization of Trial and Appeal Department (TAD)

Director-General

Executive Chief Administrative Judge

Patents / Utility Models

<Boards for physics, optics and social infrastructure>

- 1st Board Measurement
- 2nd Board Materials Analysis
- 3rd Board Amusement Machinery
- 4th Board General Amusement
- 5th Board Natural Resources and Living Environment
- 6th Board Applied Optics
- 7th Board Business Machinery
- 8th Board Applied Physics and Optical Devices

<Boards for Machinery>

- 9th Board Automatic Control and Living Related Machinery
- 10th Board Motive Machinery
- 11th Board Transportation and Lighting
- 12th Board General Machinery and Logistics
- 13th Board Production Machinery
- 14th Board Textile Processing and Packaging Machinery
- 15th Board Medical Devices
- 16th Board Heating, Refrigerating and Air-conditioning Engineering

<Boards for Chemistry>

- 17th Board Inorganic and Environmental Chemistry
- 18th Board Material Processing and Metals and Electrochemistry
- 19th Board Polymers
- 20th Board Food and Plastics Engineering
- 21st Board Applied Organic Chemicals
- 22nd Board Organic Chemistry
- 23rd Board Pharmaceuticals
- 24th Board Biopharmaceuticals
- 25th Board Biotechnology

<Boards for Electronics>

- 26th Board Electronic Commerce Technology
- 27th Board Interfaces
- 28th Board Data Processing
- 29th Board Electronic Devices Device
- 30th Board Video System
- 31st Board Transmission Systems
- 32nd Board Electronic Components
- 33rd Board Digital Communications and Electric Power Systems

Design

- 34th Board Designs

Trademark

- 35th Board Trademarks: Chemicals and Foodstuffs
- 36th Board Trademarks: Machinery and Electric Appliances
- 37th Board Trademarks: Textiles and General Merchandise
- 38th Board Trademarks: Industrial Services and General Service

Administrative judges are assigned by specialized fields

Trial and Appeal Division

Litigation Affairs Office

Trial and Appeal Policy Planning Office

Infringement and Invalidation Affairs Office

In charge of 1st, 5th, 7th ~9th Boards

1.(8) Types of Trials and Appeals

	Types of trials and appeals	Patents	Utility models	Designs	Trademarks
Before establishment of rights	Appeals against an examiner's decision of refusal (Patent Act Art. 121)	✓	—	✓	✓
	Appeals against an examiner's decision to dismiss amendment (Design Act Art. 47, Trademark Act Art. 45)	—	—	✓	✓
After establishment of rights	Trial for invalidation (Patent Act Art. 123)	✓	✓	✓	✓
	Opposition to registrations (Patent Act Art. 113, Trademark Act Art. 43-2)	✓	—	—	✓
	Trial for correction (Patent Act Art. 126)	✓	—	—	—
	Trial for rescission (Trademark Act Art. 50)	—	—	—	✓
	"Hantei" (for parties concerned) (*1) (Patent Act Art. 71)	✓	✓	✓	✓
	Expert testimony (for courts) (*2) (Patent Act Art. 71-2)	✓	✓	✓	✓

*1: Advisory opinion on scope of rights

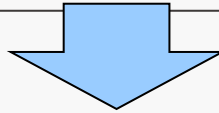
*2: Opinion on scope of patent claims, etc. of patented inventions (when commissioned by a court)

2. Appeal against an examiner's decision of refusal

2.(1) Appeal against an Examiner's Decision of Refusal

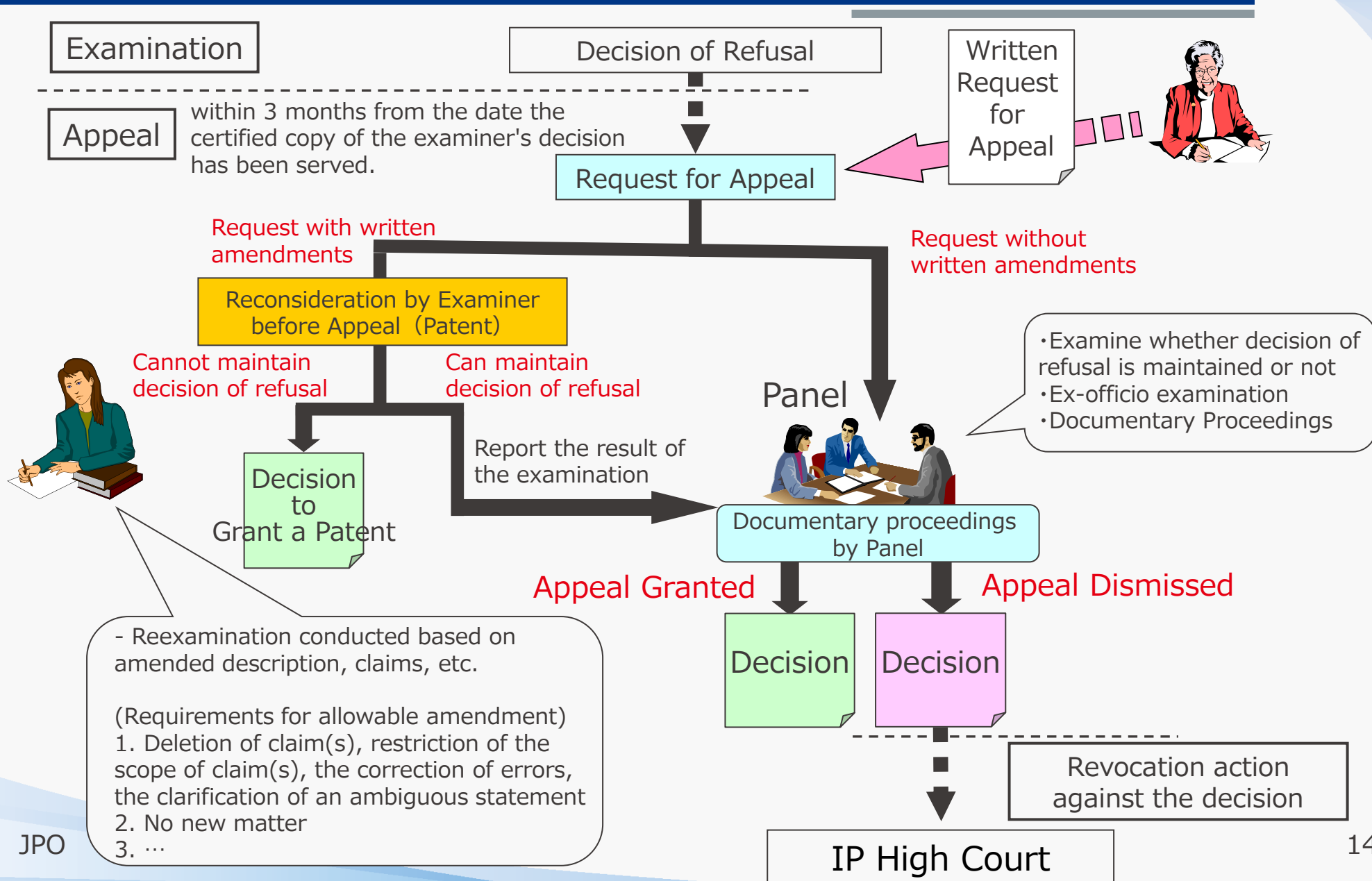
Patent Act Article 121(1)

A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for an appeal against the examiner's decision of refusal **within 3 months** from the date the certified copy of the examiner's decision has been served.

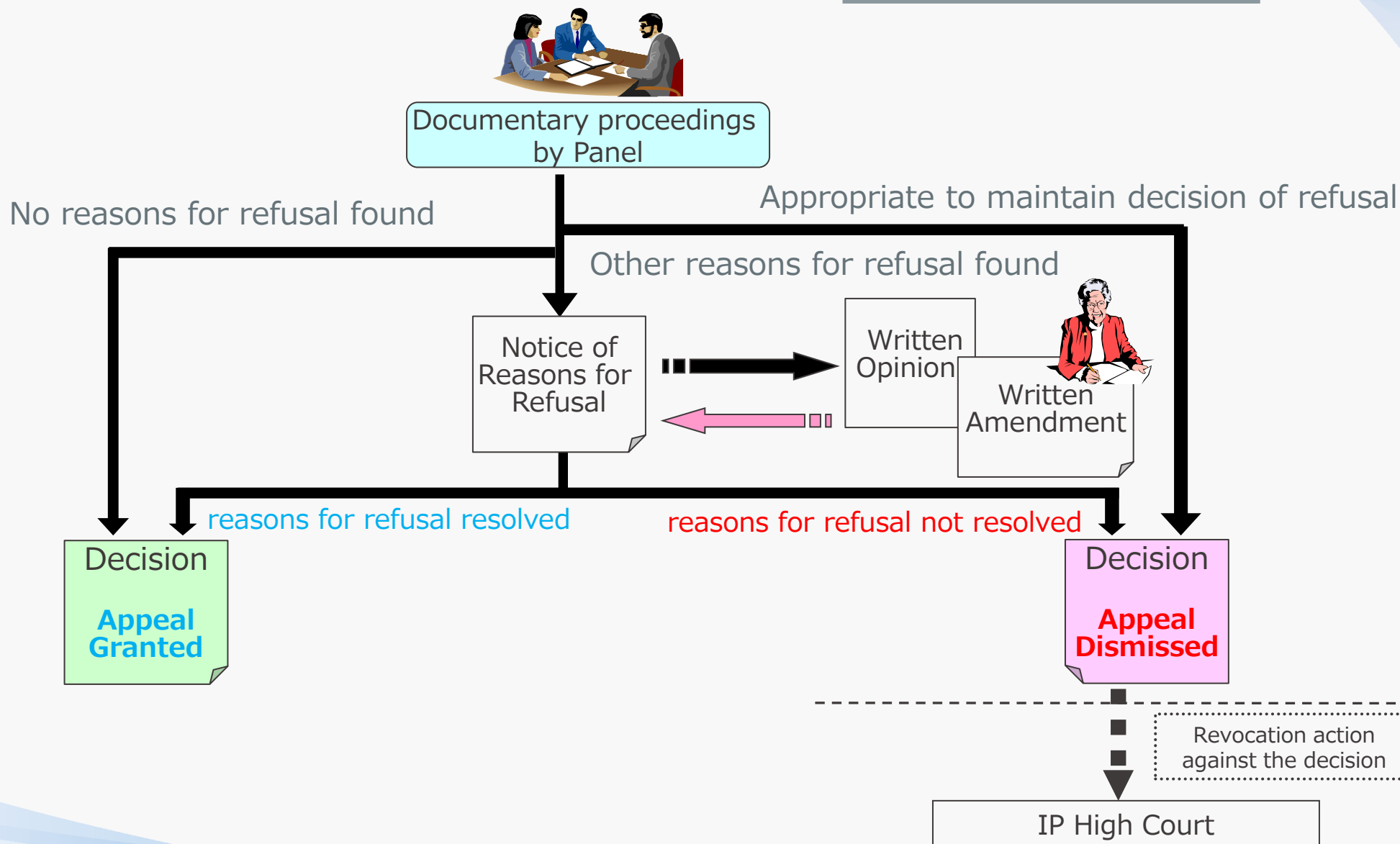


- In general, a person who is not satisfied with the administrative disposition of administrative agencies may file a lawsuit with the court. However, the Patent Act provides an unique appeal system which serves as a means to determine the appropriateness of examination results.
- A panel consisting of three or five administrative judges determines the appropriateness of a decision of refusal made by an examiner after conducting an ex officio investigation, and renders an appeal decision.

2.(2) Procedures for Appeal against an Examiner's Decision of Refusal



2.(2) Procedures for Appeal against an Examiner's Decision of Refusal

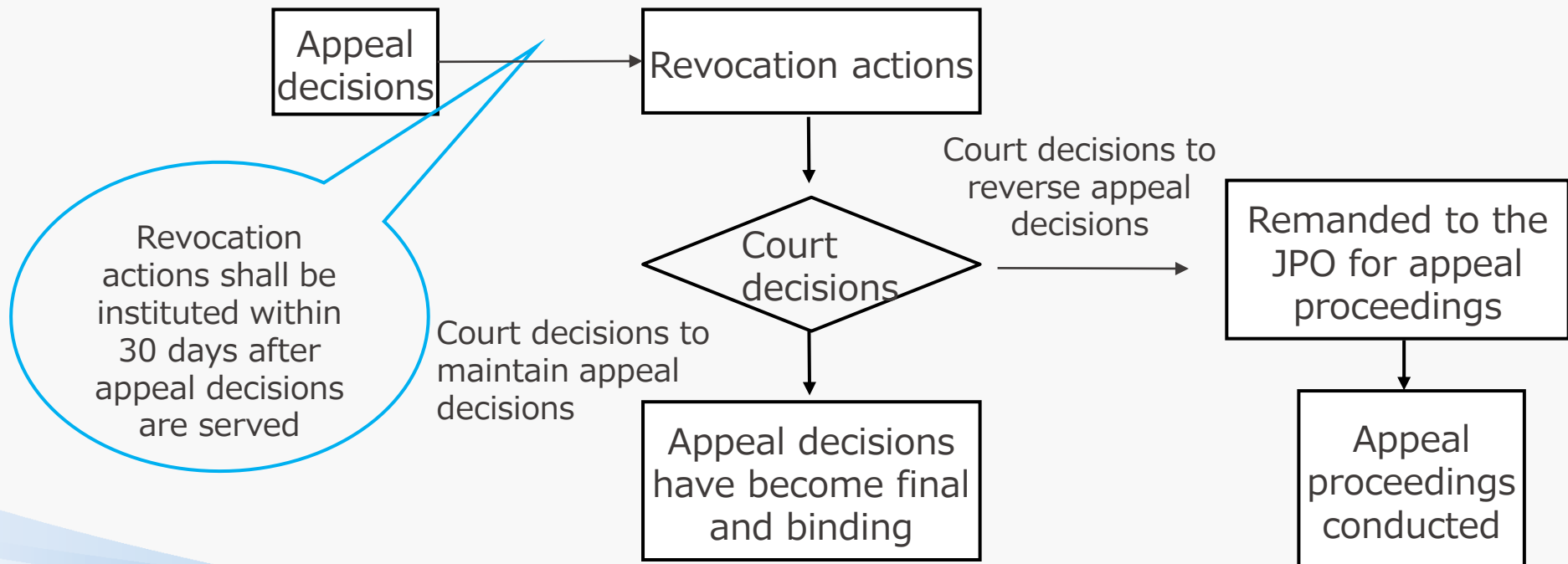


2.(2) Procedures for Appeal against an Examiner's Decision of Refusal

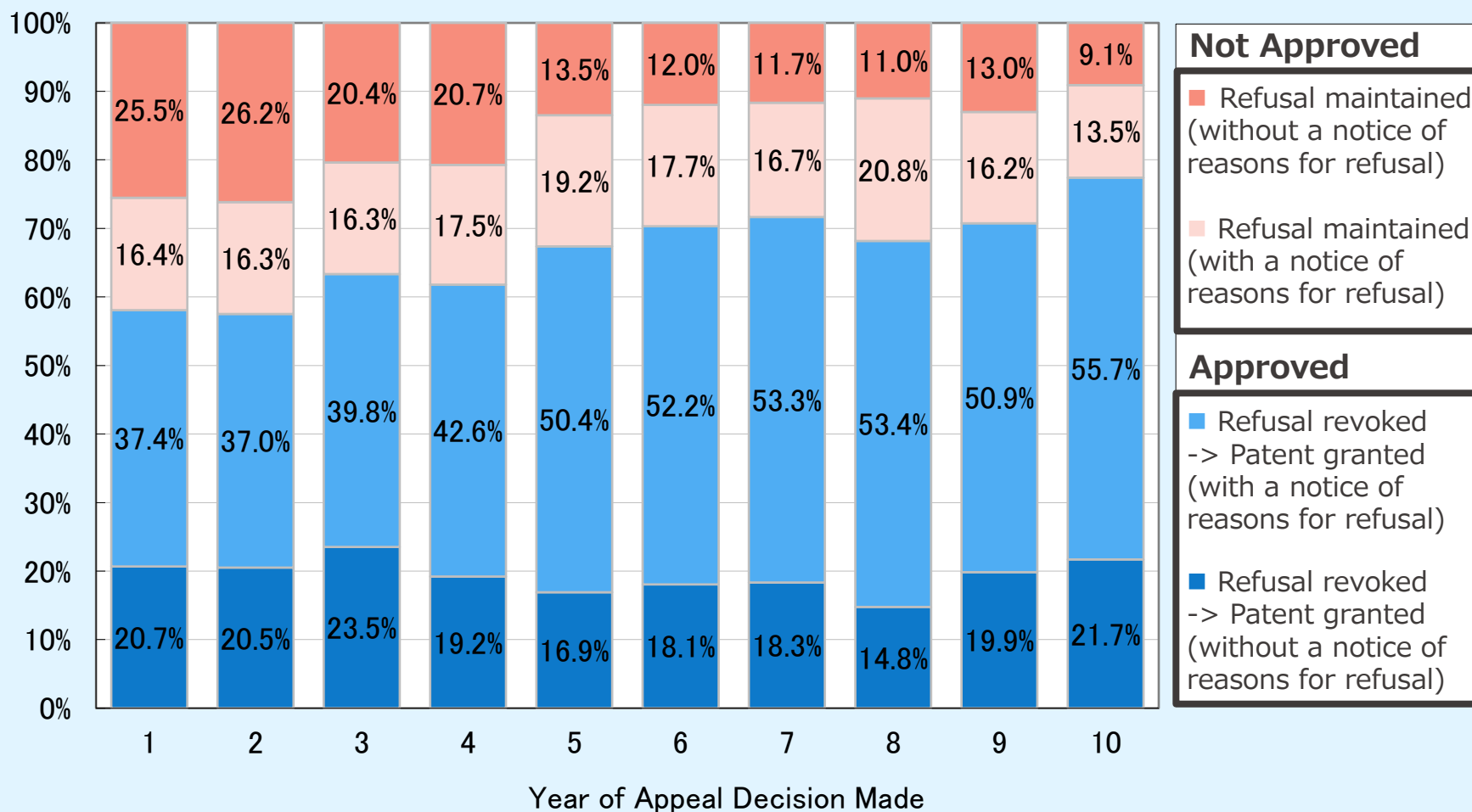
Procedures after an appeal decision to maintain an examiner's decision is rendered

A person who is not satisfied with the JPO's appeal decision may file a **revocation action against an appeal decision before the court.**

A revocation action may be instituted naming **the Commissioner of the JPO as a defendant** with the Intellectual Property High Court

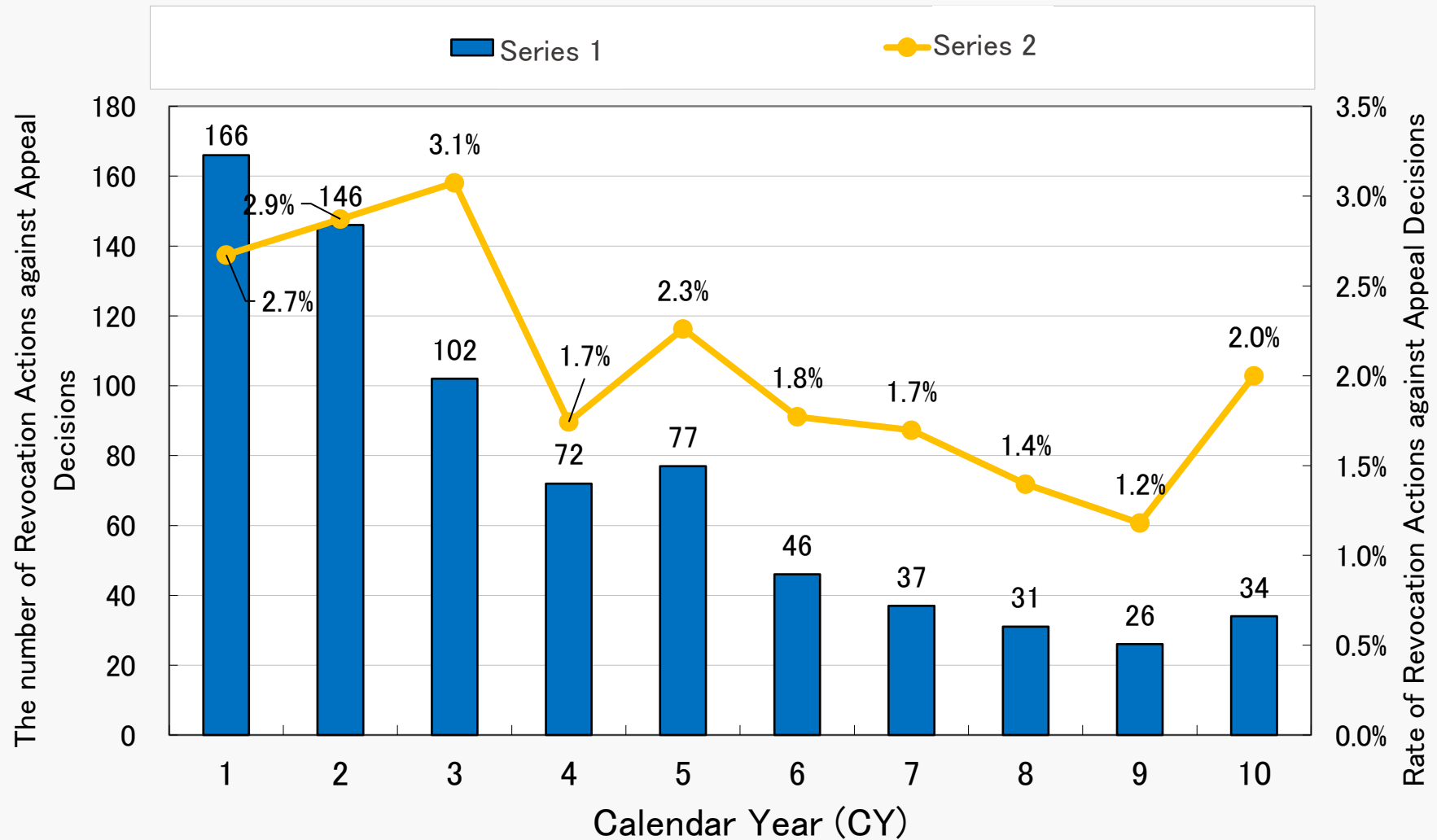


2.(3) Statistics - Results of Proceedings



Note: excluding decision to grant a patent upon reconsideration by examiner, dismissal, withdrawal, and abandonment

2.(3) Statistics - Revocation Actions against Appeal Decisions

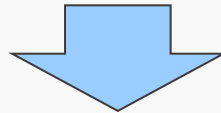


3.Trial for Invalidation

3.(1) Trial for Invalidation

Art. 123(1) of Patent Act

Where a patent falls under any of the following, a request for a trial for patent invalidation may be filed.



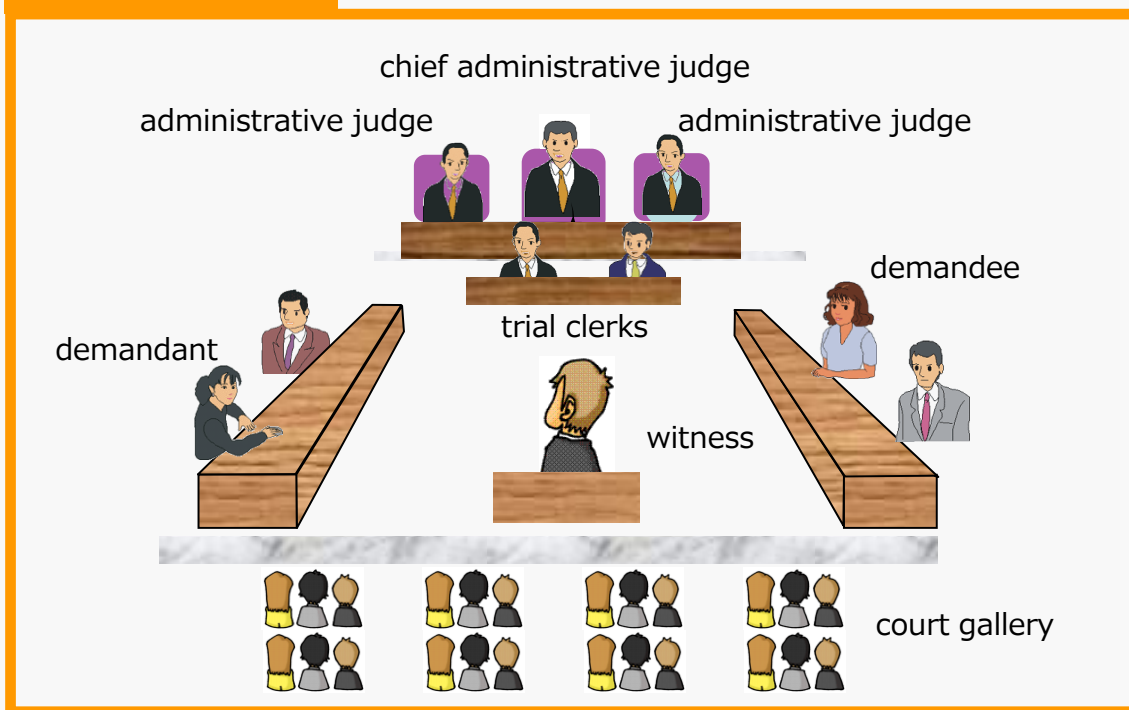
- A trial for invalidation serves as the means to invalidate a patent if the patent is suspected to be invalid.
- A trial for Invalidation for a patent shall be conducted by oral proceedings in principle. (Art. 145 of Patent Act)

3.(2) Procedures for Trial for Invalidation

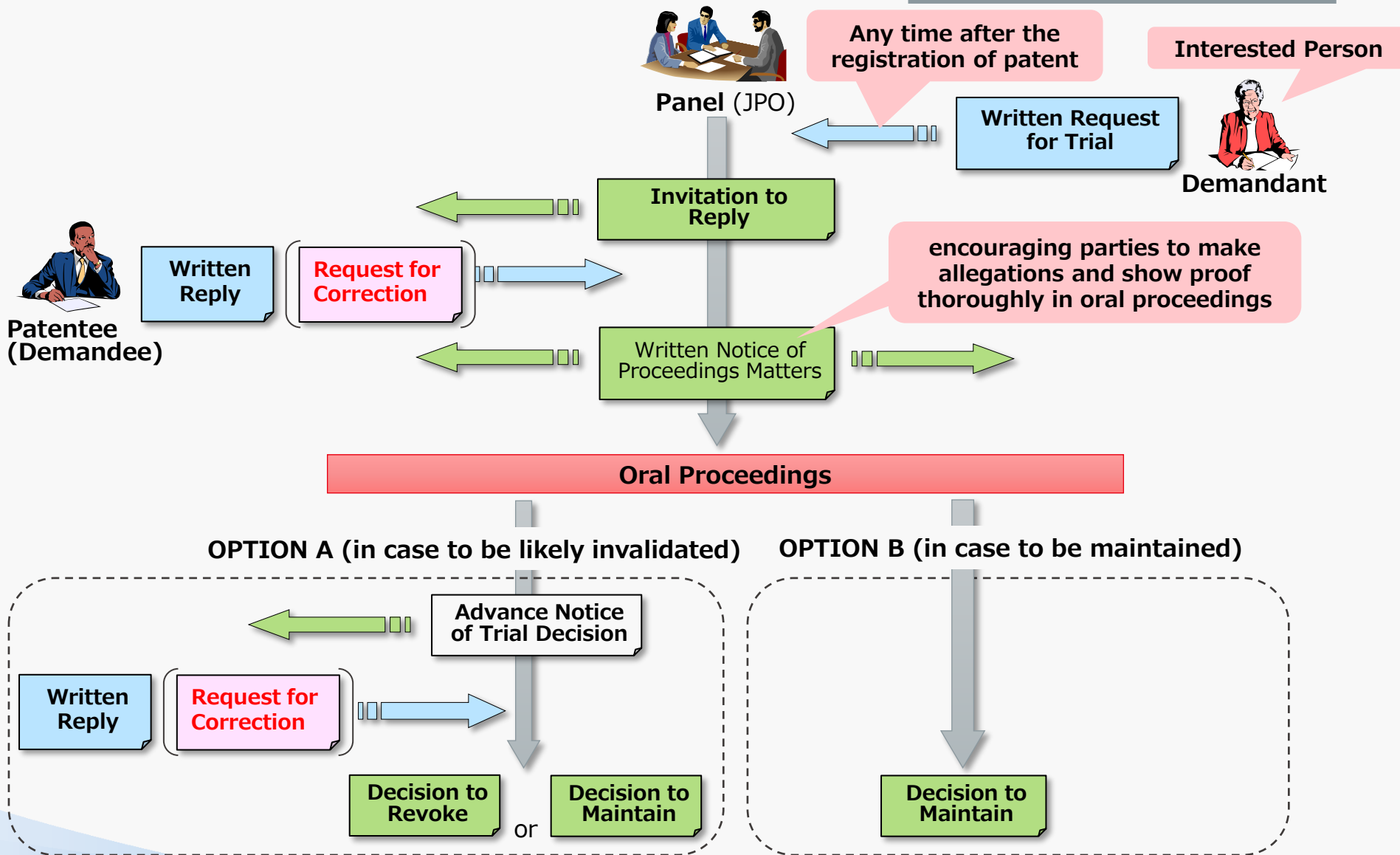
- In a trial for invalidation, a trial decision shall be made by the panel after going through multiple stages (a request for trial for invalidation, formality check, consultation, and oral proceedings)
- In oral proceedings, the panel and the parties concerned meet together to discuss the issues in dispute



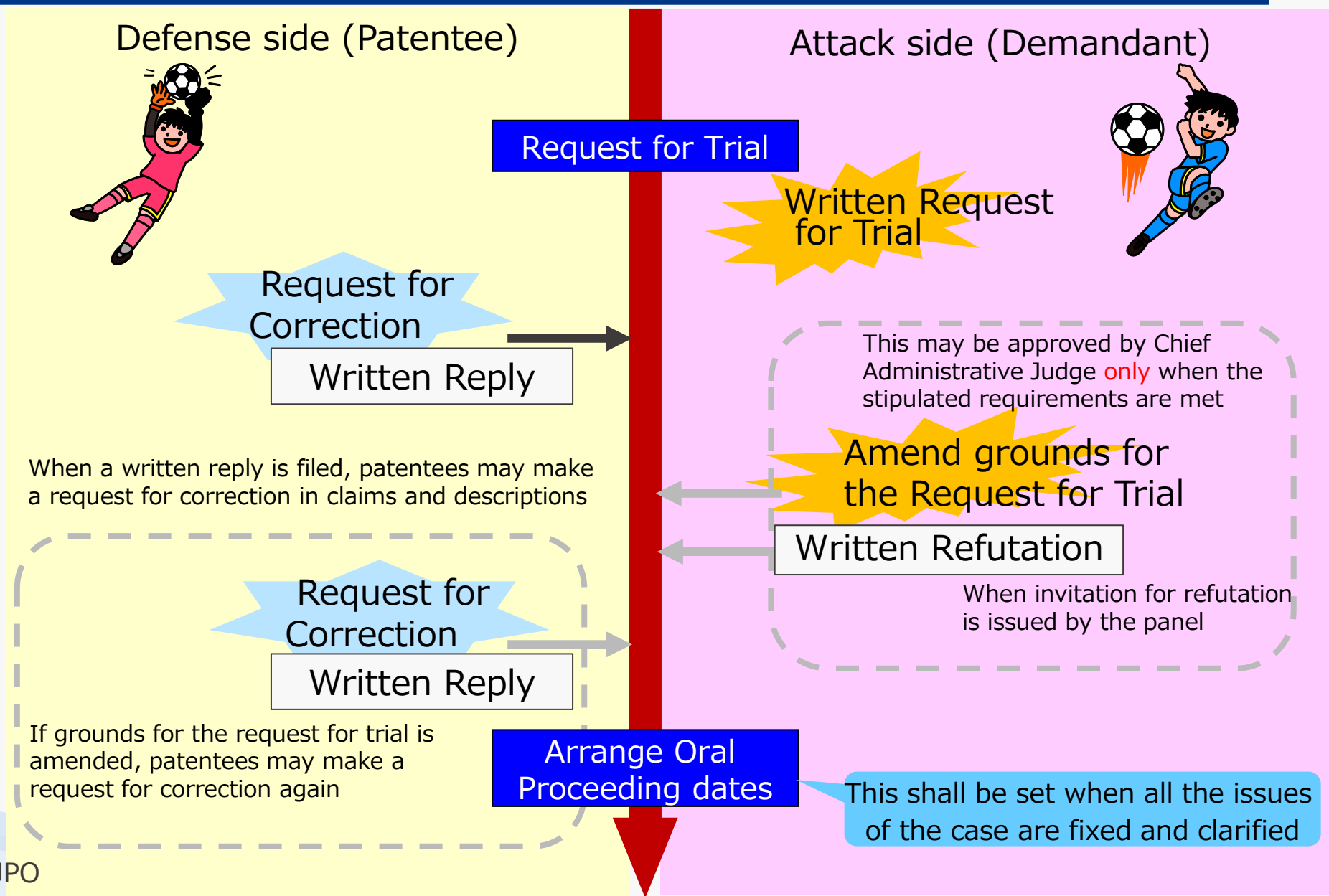
Trial Court



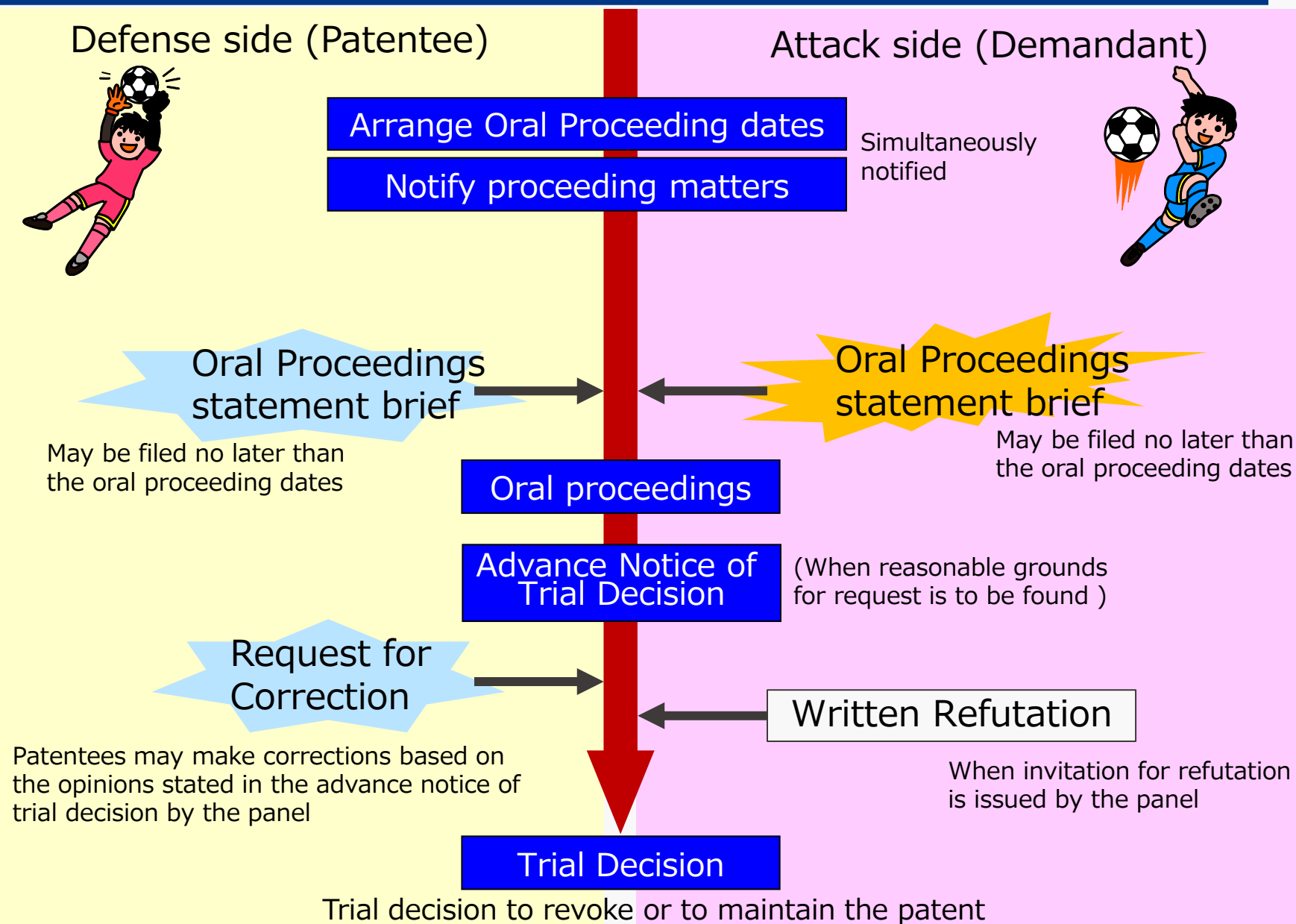
3.(3) Procedures for Trial for Invalidation



3.(4) Attack and Defense in Trial for Invalidation



3.(4) Attack and Defense in Trial for Invalidation



3.(5) Request for Correction



Defense side (Patentee)

Request for Correction



<Requirements for the contents of the correction> (Art. 134-2)

Correction may be made in descriptions, claims or drawings under the following conditions

- Correction is limited to one of the following purposes (Art. 134-2(1))
 - Restricting the scope of claims
 - Correcting errors or incorrect translations
 - Clarifying ambiguous description
 - Dissolving citation relation between the claims
- New matters may not be added (Art. 126(5))
- Correction shall not substantially enlarge or alter the scope of claims (Art. 126(6))

3.(6) Oral Proceedings

Trial for invalidation is examined by **oral proceedings in principle**

- Expeditiously sort out issues in dispute and precisely conduct proceedings
- To improve reliability and feeling of satisfaction of parties concerned about proceedings



Oral proceedings

- Enable the panel and the parties concerned to precisely grasp and sort out issues in dispute through verbal communication
- Enable the panel to precisely conduct proceedings at once rather than exchanging documents multiple times even for a complicated case in which the issues in dispute are intricately intertwined or a case in which the parties' allegations are not clear

Documentary proceedings

- Enable the parties concerned to describe their allegations in detail and to accurately express highly technical matters in writing

Compared to those of civil lawsuits:

1. In order to solve the case, administrative judges may also ex officio demand the parties concerned provide a clarification of the non-conflict issues at oral proceedings if it is needed for proceedings
2. There is neither binding force for extrajudicial confessions nor fictional confession system
3. Since allegations in writing are also legally valid, it is not necessary for the parties to reiterate allegations at oral proceedings

Features

3.(7) Trial Decisions

Trial decisions

- Describe issues in dispute and determination thereof in “reasons for trial decisions”
- In “reasons for trial decisions,” all reasons (why a demandant has filed a request and why a panel has sent a notice of reasons for invalidation ex officio) shall be determined and conclusions of the determinations as well as concrete reasons shall be mentioned in principle

Procedures after a trial decision is rendered

Those who is not satisfied with a trial decision (demandant, patentee, intervenor) may make a “revocation action against the trial decision.”

A revocation action may be made with the IP High Court, the other party as a defendant. (The JPO will not be a defendant.)

4.Opposition to Grant of Patent

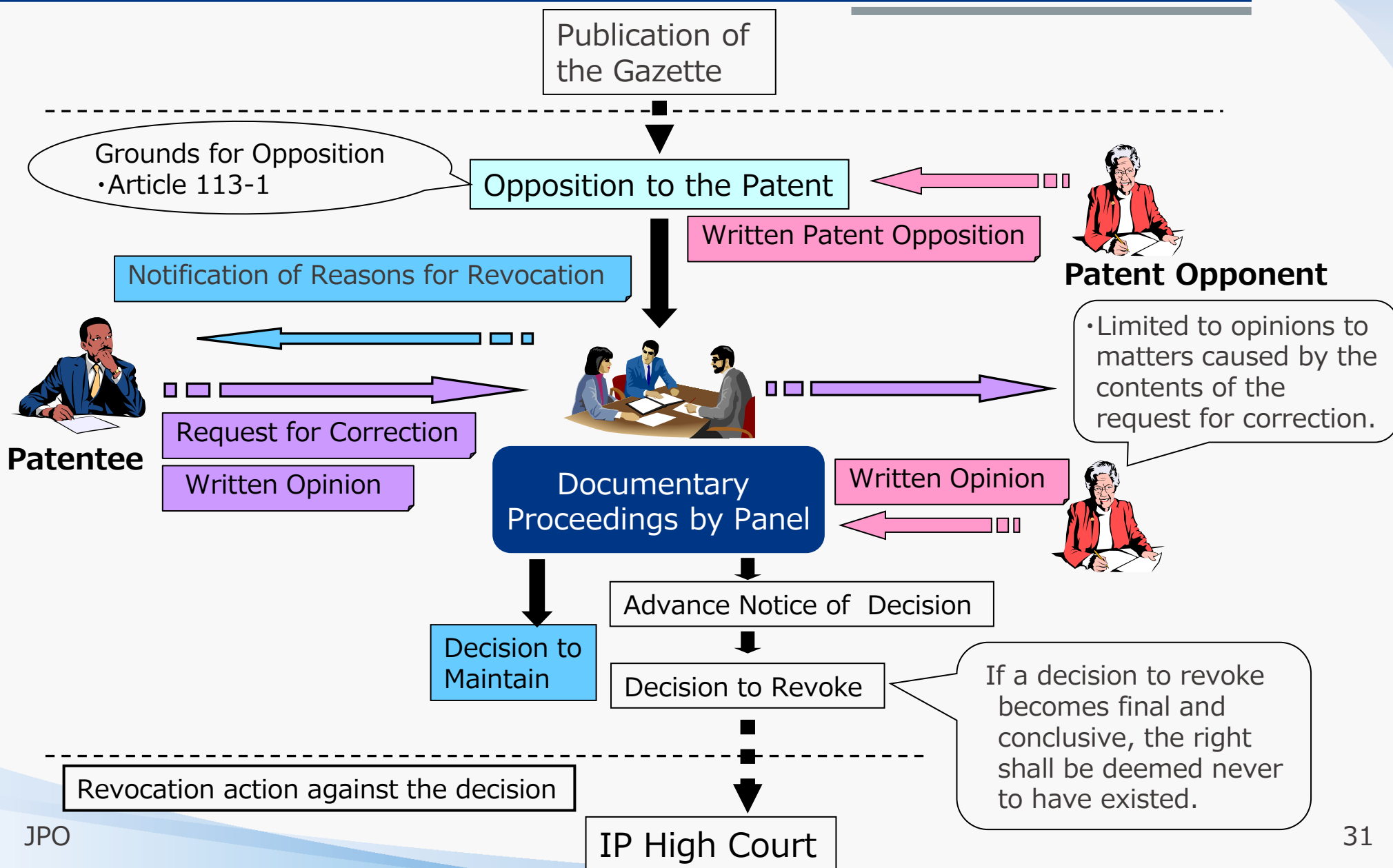
4.(1) Comparison: Opposition and Trial for Invalidation

	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

(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

(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

(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

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

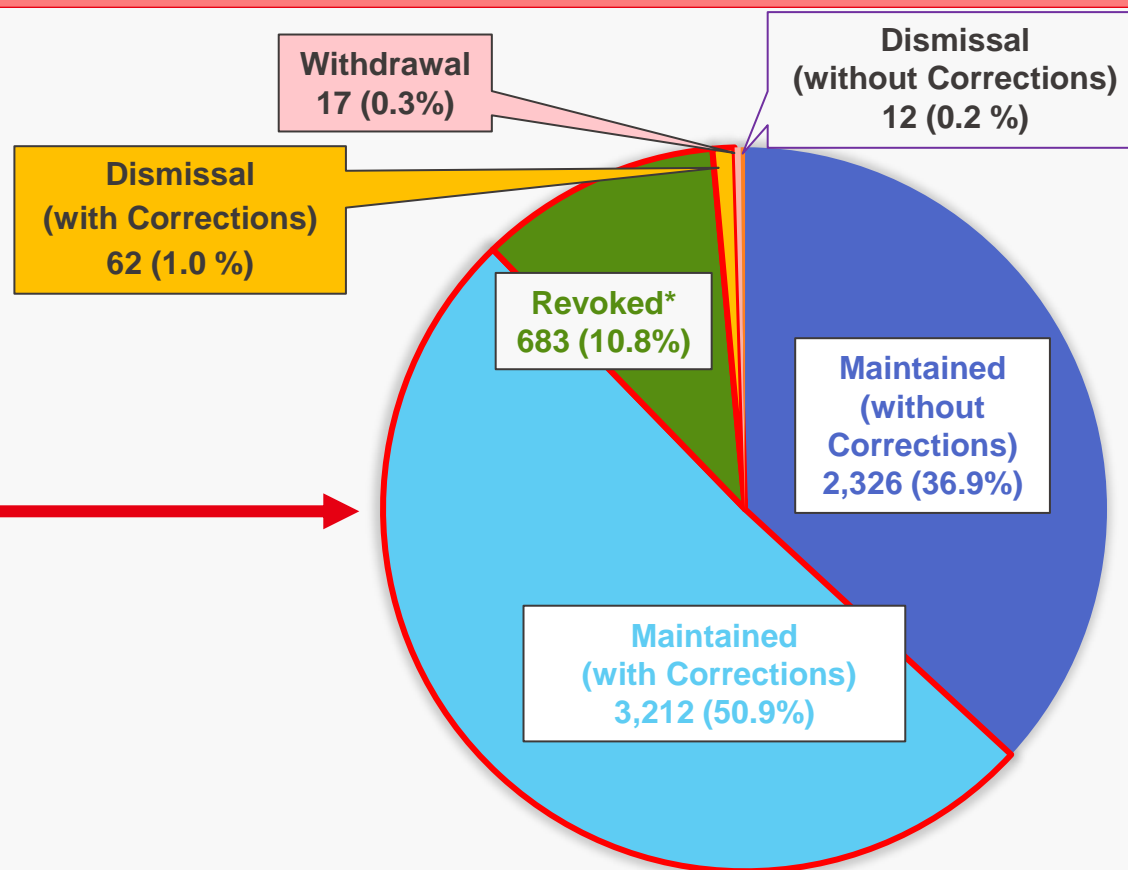
Conclusions

(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



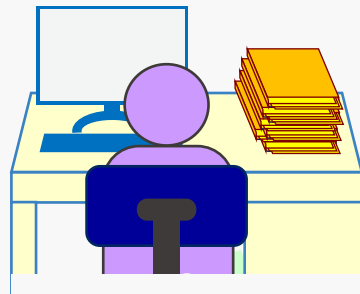
**Revoked" includes revocation of all or part of claims subjected under opposition.

"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

5.Summary

5. Summary of JPO Trial and Appeal system



Decision
to
Refuse

Decision
To
Grant

Request for
Trial/Appeal

Appeal against an
Examiner's Decision of
Refusal

Trial for Invalidation

Opposition to Grant of
Patent



I'm not
convinced!



I don't
believe...

