

Manual of “Hantei” (Advisory Opinion) for
Essentiality Check
(Revised Version)

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provisional translation

1. Background

In recent years, the dissemination of Internet of Things (“IoT”) has led to a rapid development of so-called the “Fourth Industrial Revolution” at home and abroad where various infrastructures and devices can be connected through the Internet. The environment surrounding the patent strategies of private companies is undergoing a significant change. In particular, due to the advancement of IoT, it has become increasingly necessary for companies in diverse industries to comply with information and telecommunications standards. These changes greatly affected the environment surrounding standard-essential patents (“SEPs”).

The nature of licensing negotiations has been changing as well mainly for the following two reasons. First, while most of the licensing negotiations used to be conducted by companies in the telecommunications industry, there is an increasing need among companies in different industries, including final product manufacturers of automobiles, service providers, etc. to take part in such negotiations. Secondly, these new entries in licensing negotiations have made it difficult to solve problems by such conventional method as a cross-licensing within the same industry. Also, opinions are increasingly divided as to essentiality of patent and reasonable license fees.

A licensing negotiation between the parties concerned would be greatly influenced by a determination as to whether the patented invention subject to licensing negotiation is a SEP. If there is a dispute over the essentiality of the patented invention between the parties concerned, it would be difficult to resolve the dispute by themselves.

Therefore, if such determination is made by the Japan Patent Office (“JPO”) from a fair, neutral perspective, it would greatly contribute to facilitating the licensing negotiation and dispute resolution between the parties concerned.

In reality, the industry voiced their concerns that the parties concerned involved in a licensing negotiation sometimes start a dispute over the essentiality of a patented invention and never reach common ground. The

industry places high expectation that if the JPO conducts essentiality check based on the allegations and proofs submitted by those parties and publicizes the results of the “Hantei” (Advisory Opinion), it will facilitate the dispute resolution.

Under these circumstances, the report made by the Patent System Subcommittee of the Intellectual Property Committee under the Industrial Structure Council in FY2017 states that “if the JPO makes and publicizes a fair, neutral determination as to whether the virtual subject article, etc. specified from standard documents falls within the technical scope of a patent right based on the allegations and proofs submitted by the parties concerned disputing over the essentiality, it would increase the predictability and transparency with regard to whether the disputed patent is essential to the standard and would facilitate licensing negotiations conducted by any other parties. Thus, when filing a request for an advisory opinion of the JPO under the Patent Act Article 71, a request for an advisory opinion for an essentiality check on a patented invention should be allowed.”

In its response, JPO has clarified as to how the “Hantei” (Advisory Opinion) system shall be operated for ¹essentiality check (hereinafter referred to as the “Operation”). Thereby, the JPO prepared and decided to publicize the “Manual of ‘Hantei’ (Advisory Opinion) for an Essentiality Check” (hereinafter referred to as the “Manual”) for practitioners seeking the Operation, which commenced on April 1, 2018.

After the commencement of the Operation, the JPO received requests from users¹ that a case other than licensing negotiations be included into the subject of the Operation where there is conflict of views between the parties over the standard essentiality of the patented invention. In response to the request, the JPO reviewed and have reached the conclusion that there may be a case other than licensing negotiations where conflict of views between the parties may be solved by applying the Operation .

¹ There are requests from users that: a determination of non-essentiality of the patented invention be led by a request to the effect that a Virtual Object does not fall within the technical scope of the patented invention; buying and selling a patent right be included as a subject into the Operation.

The content of the Manual was reviewed and revised so that the Operation may be used more easily by users. The Operation based on the revised Manual shall be commenced on July 1, 2019, and the content of the Manual will continue to be reviewed as appropriate.

2. Operation of an advisory opinion system to determine standard essentiality for an essentiality check

(1) Purpose of the Operation

The purpose of the operation is, when there is conflict of views between the parties concerned about standard essentiality of the patented invention, to facilitate licensing negotiations, etc.² and quickly resolve disputes by determining the standard essentiality provided in an advisory opinion (“Hantei” system) based on the highly specialized technical knowledge of the JPO.

(2) What is an advisory opinion

The Patent Act Article 71 provides the basis for an advisory opinion. The system allows the JPO, which is involved in the establishment of patent rights, to express, upon request of any person who has an interest in a patented invention, an official opinion with regard to the technical scope of that invention from a fair, neutral perspective by using its highly specialized technical knowledge.

When a request for an advisory opinion is filed, a panel consisting of three administrative judges determines whether or not the object product (or process) “A” specified by the demandant falls within the technical scope of the patented invention (Figure 1).

All the JPO’s advisory opinions are entirely open to the public; that is, documents concerning an advisory opinion are made available for public inspection. However, either of the parties concerned has stated to the effect

² This refers to the negotiations of licensing, those of buying and selling of a patent right, those of transfer of business including a patent right, and those of establishment of mortgage for a patent right.

that the relative document includes a trade secret owned by either of the parties concerned and when the JPO Commissioner admits the secret should necessarily be held, the inspection by a third party shall be restricted.³

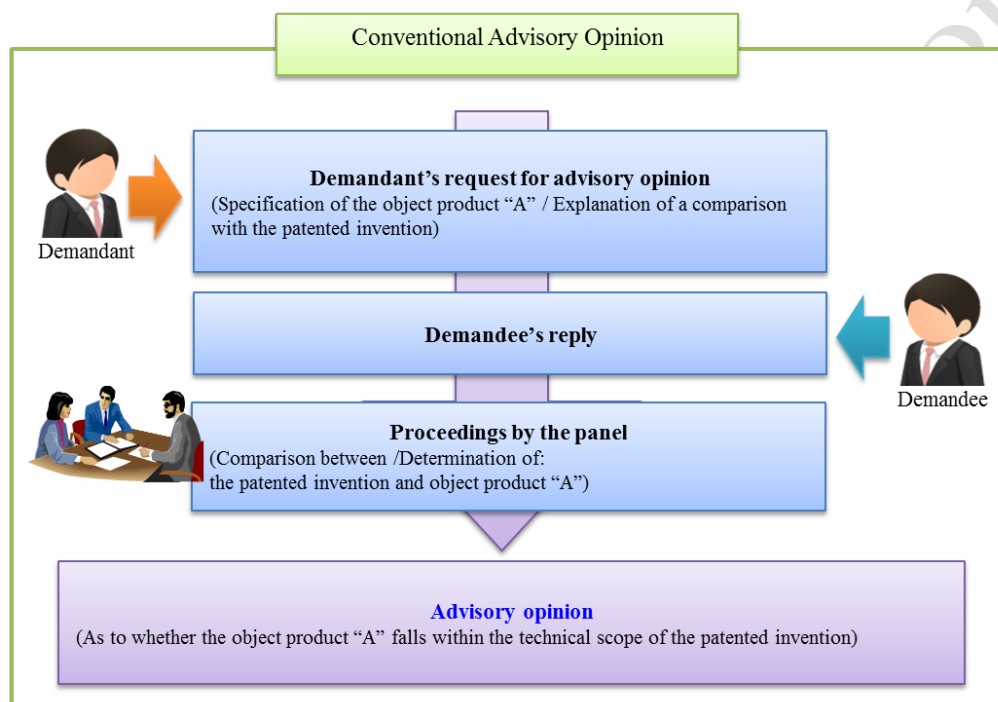


Figure 1 Conventional advisory opinion

An advisory opinion is an official opinion of the JPO (panel) on the technical scope of the patented invention. Such opinion functions merely as an expert opinion, without any legally binding force. However, because such opinion is expressed by the JPO, where highly specialized and technical administrative officers are involved, it is considered that the opinion is deemed as one of the determinations which are socially respected and authoritative. (In this manual, a “conventional advisory opinion” refers to an opinion other than an advisory opinion to check the essentiality.⁴)

³ Note that the feature of the Virtual Object, which is a premise of determination in checking shown in or below Section 2 (4) (B), is not generally regarded as inspection restrictions. A statement that the document includes the trade secret may be filed by a form “Statement of Trade Secret” in Form No, 65-8.

⁴ The Conventional Advisory Opinion is operated as per the Manual for Trial and Appeal Proceedings Chapter 58 “Hantei (Advisory Opinion on the Technical Scope of Industrial Property Rights) and the Commissioning of the Provision of an Expert Opinion by a Court” (in Japanese) and “JPO Advisory Opinion System” (in Japanese) on the JPO’s HP. While the advisory opinion system is also provided in the Utility Model Act, the Design Act, and the Trademark Act, these rights are not subject to an advisory opinion for an essentiality check according to the Operation because a dispute arising over the essentiality of any right of those Acts is unlikely.

(3) Standard essentiality of a patented invention and its operation

The standards are a set of technical specifications with which products must be complied within each technical field.

Products, etc. compliant with the standard have all indispensable configurations (technical subject matters) (hereinafter a “configuration” refers to a technical subject matter in this manual.) for the standard documents.

If such “products, etc. compliant with the standard” (i.e., the products, etc. that have all indispensable configurations for the standard documents) cannot be worked (manufactured, etc.) without using a specific patented invention; in other words, if “products, etc. compliant with the standard” fall within the technical scope of the patented invention, the patented invention is an “invention essential to the standards.” The issue of whether a patented invention is essential to the standards is called the issue of “standard essentiality of the patented invention.”⁵ A patent for an invention essential to the standards is called a “standard-essential patent (SEP)”.

In the operation, in order to determine whether a patented invention is an invention essential to the standards, instead of an object “A” used for the conventional advisory opinion, a virtual object product, etc. (Virtual Object) specified from the standard document is specified, and a request for an advisory opinion is filed for the technical scope of the patented invention. Depending on the purpose, the request can comprise the following aspects:

https://www.jpo.go.jp/e/system/trial_appeal/sinpan-binran_18.html
https://www.jpo.go.jp/e/system/trial_appeal/shubetu-hantei/index.html

⁵ The operation determines whether a Virtual Object specified from the standards document falls within the technical scope of the patented invention, but it does not determine whether a specific product adopted the standards actually complies with the standards. It is not necessarily that a Virtual Object specified by the operation equals to a specific product adopted the standards. Therefore, please be noted that even if the determination that the patented invention is essential for the standards is made, the determination that a specific product adopted the standards falls under the technical scope of the patented invention would not be made.

⁶ In the operation, the essentiality of a patented invention refers to the technical essentiality; in other words, a determination would be made as to whether the patented invention is technically unavoidable. A determination is not made with regard to commercial essentiality. In other words, in the case of a patented invention that is technically avoidable, a determination would not be made as to whether a means of avoidance is economically reasonable.

- A. On determining that the patented invention is essential to the standards, a request for an advisory opinion is filed with the purport that the Virtual Object consisting of indispensable configurations for the standard documents falls within the technical scope of the patented invention.
- B. On determining that the patented invention is not essential to the standards, a request for an advisory opinion is filed with the purport that the Virtual Object consisting of indispensable configurations for the standard documents does not fall within the technical scope of the patented invention.

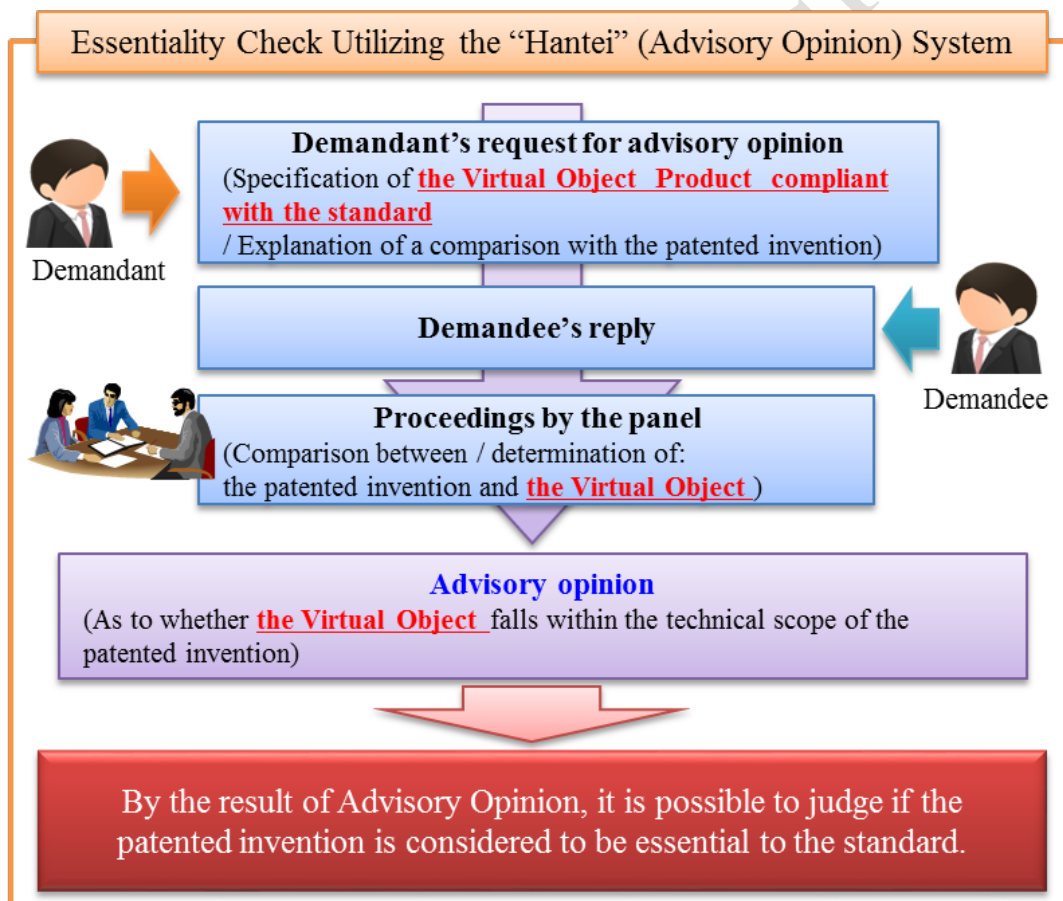


Figure 2 Essentiality check utilizing the “Hantei” (Advisory Opinion) System

(4) When a request can be filed for an advisory opinion based on the operation

A. Parties concerned who can request an advisory opinion based on the operation.

In order to file a request for an advisory opinion based on the operation, parties concerned must benefit from filing the request according to the purport of the advisory opinion system (hereinafter referred to as “benefit of request”).

An advisory opinion based on the operation can be used in the following cases: It is clear that the parties concerned who have conflict of views in the standard essentiality of the patented invention become a demandant and a demandee, in negotiations of licensing, buying and selling a patent right, a transfer of business including a patent right, and establishment of mortgaging a patent right (hereinafter referred to as “licensing negotiations, etc.”). Such parties concerned can use the advisory opinion based on the operation since they have “benefit of request.”

On the contrary, when there is no conflict of views in the standard essentiality of the patented invention in licensing negotiations, etc. (e.g., cases without an opposing party), the operation cannot be used since no benefit of request exists (in this case, the request shall be dismissed by decision because the request is non-compliant).

B. Specification of a Virtual Object

(A) When a request for an advisory opinion is filed with the purport that a Virtual Object falls within the technical scope of the patented invention

a. General remarks

An advisory opinion for an essentiality check must be directed to a virtual object product, etc. (hereinafter referred to as “Virtual Object” or “Virtual Object which is compliant with the standard”), and the configuration must be concretely specified to correspond to the constituent configurations of the

patented invention for which the request is filed, from the indispensable configurations for the standard documents (Figure 3).

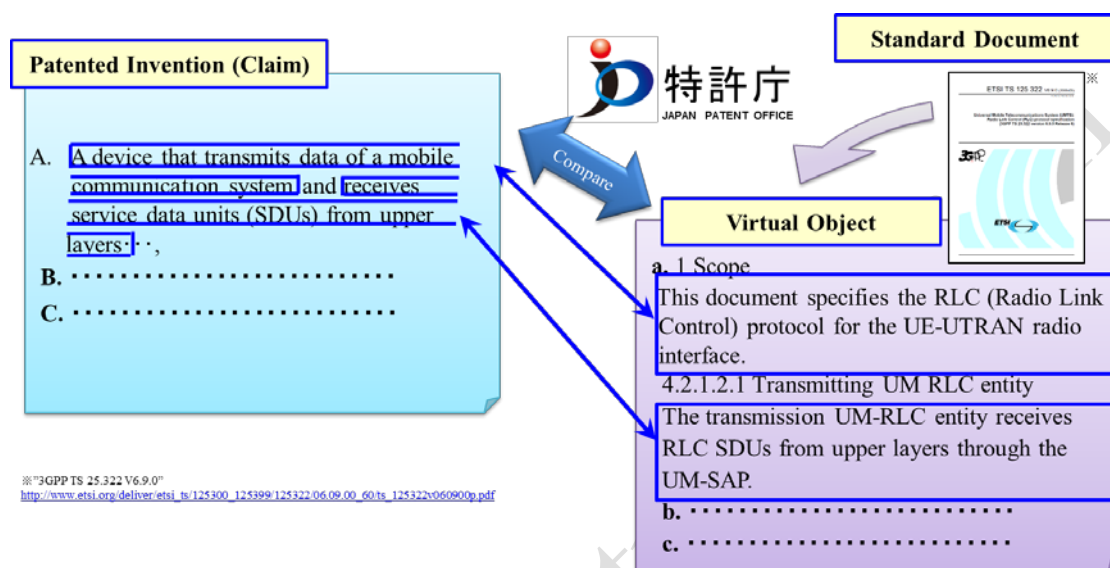


Figure 3 Virtual Object

b. Standard documents and specification of Virtual Object

In principle, the standards subject to the operation shall be limited to those standard documents that are set, as technical specifications with which the products, etc. should be complied, by a single entity, such as a standard setting organization, etc. ("SSO") establishing the standards; and that can be submitted to the JPO as evidence (an entity establishing the standards includes a standard establishing project participated by a group of companies, but excludes de facto standards or mere product specifications established by a single company).

It is not allowed to specify a Virtual Object across multiple standard documents from multiple SSOs in principle, because it remains unclear as to which standards essentiality check must conform to. However, if a specific statement of other standard documents (including those by another SSO) is cited in the standard document subject to essentiality check and only if the

standards for the filed request for an essentiality check is clear, specifying a Virtual Object including the citation is possible.

Additionally, sometimes an SSO has not reached consensus on its standard documents' finalization, or it might be unclear to which version of the standard documents should be referred. Furthermore, parties concerned sometimes dispute over standard documents' validity. In such cases, a Virtual Object cannot be specified on the basis of the referenced standard documents. Therefore, a request cannot be filed for an advisory opinion for an essentiality check.

c. Configurations that can be used to specify a Virtual Object

Configurations indispensable for the standard documents, which can be used to specify a Virtual Object in the operation, are as follows:

- (1) A configuration (unconditionally) essential in the standard document (hereinafter referred to as "Configuration essential in the standard document")
- (2) A configuration among configurations other than (1) essential when it is necessary to select any of the multiple configurations and such selection involves a specific configuration in the standard document⁶ (hereinafter referred to as "Configuration selectively essential in the standard document")

"Configuration essential" in (1) and (2) above includes configurations that are self-evidently technically essential, although the standard document does not explicitly describe them, that can be proven to be so, or configurations that are self-evidently technically essential, although the standard document describes them but does not specify them as essential, that can be proven to be so.⁷

⁶ For example, when it is written in the standard document that (1) it is essential to select either an LED lamp or a fluorescent lamp as a warning lamp, and (2) a warning lamp comprises a DC power supply if it is an LED lamp, and a warning lamp comprises an AC power supply if it is a fluorescent lamp, if an LED lamp is selected as a warning lamp, a DC power supply is an essential feature in addition to the warning light consisting of the LED lamp.

⁷ For the operation, as described in (Note 4), if the patented invention is technically avoidable, its commercial essentiality is not determined, including whether the avoidance means is economically reasonable.

(B) When a request is for filed with the purport that the Virtual Object does not fall within the technical scope of the patented invention

Likewise, specifying the Virtual Object according to the principle shown above in (A).

Additionally, if when a request for an advisory opinion for essentiality check is filed with the purport that the Virtual Object does not fall within the technical scope of the patented invention, the Virtual Object must be specified only from the standard document's statement cited to show the correspondence with the claims of the subject patent in the claim chart⁸ sent from the opposing party (demandee) of the licensing negotiation to the demandant.

In general, even if one Virtual Object does not fall within the technical scope of the patented invention, it does not necessarily mean that "the patented invention should not be essential to the standards" because the standard documents usually contain a large amount of technical subject matters. Virtual Object could be specified in different ways depending on how the indispensable configurations for the standard documents are specified. Thus, if a demandant specifies a Virtual Object in a different way, another Virtual Object might still be found to fall within the technical scope of the patented invention, and the patented invention could be found essential to the standards (Figure 4).

⁸ This refers to the material that expresses correspondence between the claims of the subject patent and the description of the standard document.

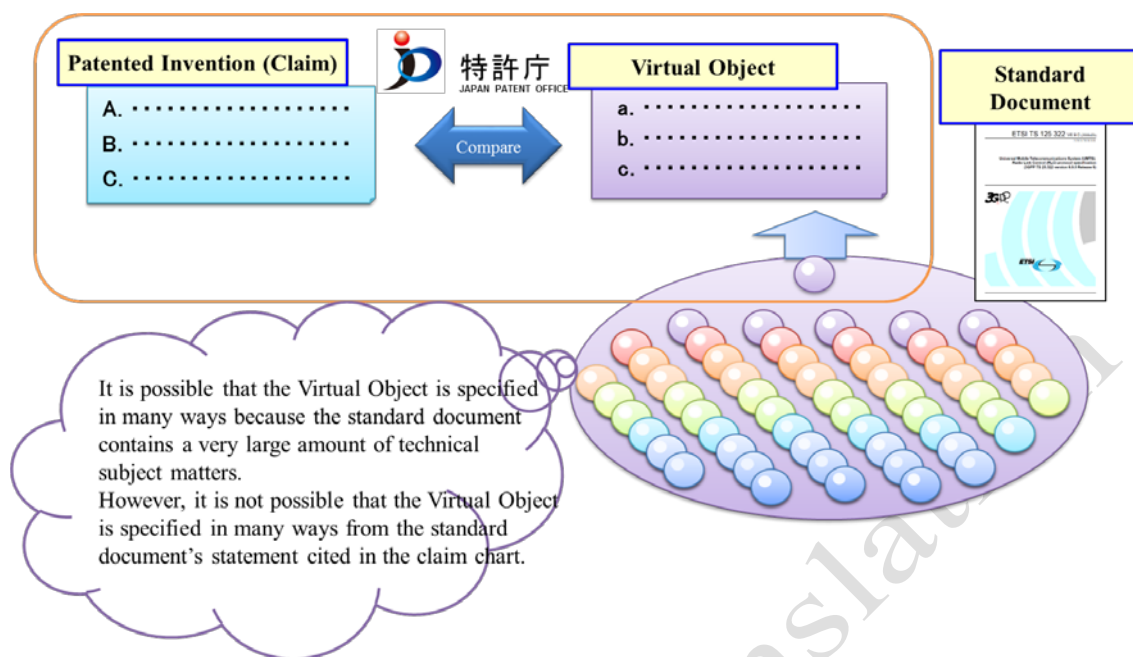


Figure 4 Relationship among a standard document, a Virtual Object and a patented invention

However, when the opposing party (demandee) sends a claim chart to the demandant as a ground for claiming that the patented invention is essential to the standards, the standard document's statement cited to indicate correspondence with the claims of the subject patent in the claim chart is considered as the standard document's most appropriate part for the opposing party (demandee) to request an essentiality check of the present patented invention. Even for the demandant, if the statement is considered as the most appropriate for the present patented invention's essentiality check, resolving conflict of views between the parties concerned over the essentiality is possible by determining that the present patent is not essential to the standard so long as it is determined that Virtual Object—as specified only from the statement—does not fall within the technical scope of the patented invention.

Therefore, when a request for an advisory opinion for an essentiality check is filed with the purport that the Virtual Object does not fall within the technical scope of the patented invention, in addition to the principle in (A) above, the claim chart sent from the opposing party (demandee) is required

to specify the Virtual Object only from the standard document's statement cited to show correspondence with the claim of the subject patent.

If the Virtual Object is not specified only from the standard document's statement cited to show the correspondence with the claim of the subject patent in the claim chart sent from the opposing party (demandee), it is only determined whether the Virtual Object falls within the technical scope of the patented invention, and the judgment on the essentiality check is not shown.

C. Summary

From the description above, the subject of the operation is summarized as follows. (For a specific flowchart, see Figure 5.)

Subject of the Operation	
(1)	In a licensing negotiation, etc., it is clear that the parties concerned (the demandant and the demandee) have conflict of views in the essentiality of the patented invention.
(2)	It is possible to specify a Virtual Object only by indispensable configurations for the standard documents set by an SSO. (Standard documents should be set by an SSO etc. and be capable of being submitted as evidence. Additionally, the "indispensable configurations" include configurations that are essential to the standard documents and those that are selectively essential to the standard documents.)
(3)–1	A request for an advisory opinion is filed with the purport that the specified Virtual Object falls within the technical scope of the patented invention.
	or
(3)–2	A request for an advisory opinion is filed with the purport that the specified Virtual Object does not fall within the technical scope of the patented invention and only from the standard document's statement cited to indicate the

correspondence with the claim of the subject patent in the claim chart sent from the opposing party (demandee) to specify Virtual Object.

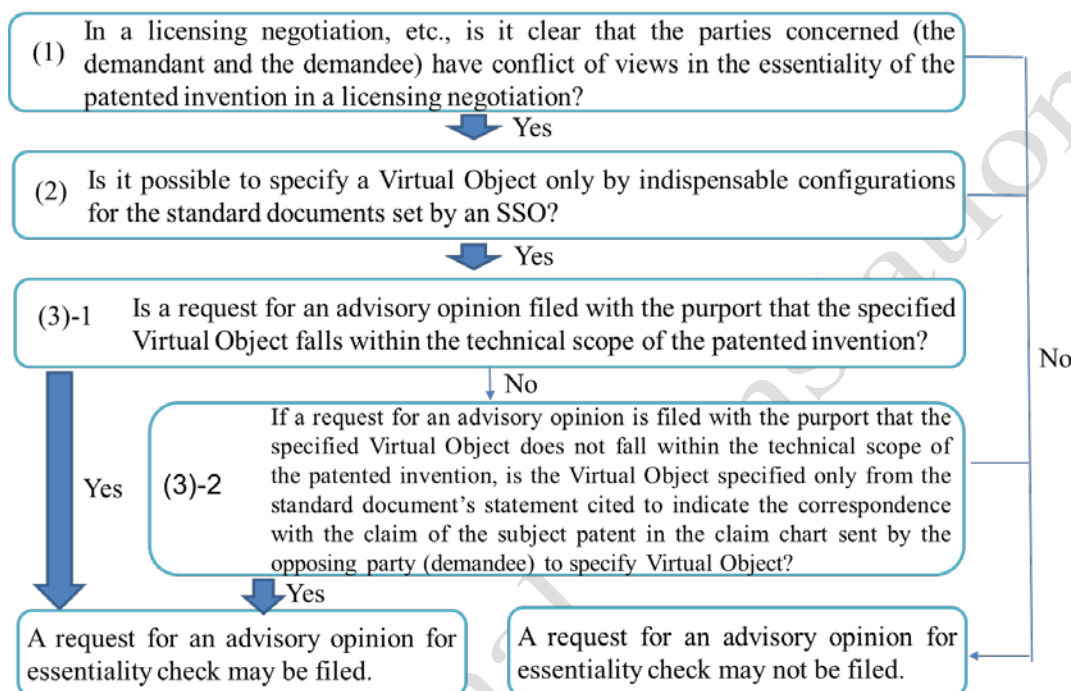


Figure 5 Subject of the Operation

When the parties concerned dispute over a specific product to be implemented, the dispute would be more beneficially resolved if a request is filed for a conventional advisory opinion concerning the specific product to be implemented. In such a case, the patentee or the person implementing the patented invention should consider filing a request for an advisory opinion determining whether the specific product to be implemented falls within the technical scope of the patented invention.⁹

3. How to write a request for an advisory opinion for an essentiality check

Based on the explanation provided above, this section explains how the demandant should write a request for an advisory opinion for an essentiality

⁹ When a request is filed for an advisory opinion to determine whether a specific product to be implemented falls within the technical scope of a patented invention, if the product complies with a standard, a part of its features could be specified from the standard documents.

check¹⁰. (Section 5 illustrates a general example, and the numerals of examples in Section 3 are shown according to those of Section 5.)

(1) Statement of “purport of the request”

A. General remarks

In filing a request for an advisory opinion for an essentiality check, first of all, it should be clarified that determination of essentiality check is requested for the advisory opinion. Thus, it is required to state “for the purpose of essentiality check” in the request form’s section titled “purport of the request”. Additionally, it should be clarified according to which standard the request is asking for; to this end, specify the standard’s name and version. Any amendment to the purport of the request would be considered as a change of the gist and would therefore be unacceptable. Hence, please state the purport of the request carefully.

B. When a request is filed with the purport that the Virtual Object falls within the technical scope of the patented invention

Following is an example of a statement of the purport of the request:

5 Purport of the request

For the purpose of essentiality check ..., we would like to request an advisory opinion that a Virtual Object product¹¹ which complies with the standards in XXX, falls within the technical scope of the patented invention for Japanese Patent No. XXX.

When an advisory opinion is issued in response to a request filed for such purport, the presented conclusion would state solely whether the Virtual

¹⁰

This section provides tips for those who file a request for an advisory opinion for an essentiality check. Regarding general matters about the form of a written request for an advisory opinion, please refer to the example of a written request for an advisory opinion in “JPO Advisory Opinion System” (in Japanese).

<https://www.jpo.go.jp/tetuzuki/sinpan/sinpan2/hantei2.htm>

¹¹ Here, Virtual Object Product is described for clarity; however, Virtual Object can also be expressed as “virtual subject article A” or “Virtual Object Process ‘A.’” The same can be said about all of the example statements below.

Object falls within the technical scope of the patented invention. If the conclusion states that the Virtual Object falls within the technical scope, the section on reasons in the advisory opinion would also refer to determination for an essentiality check of the patented invention. (See the description example in Section 6.(1).)

C. When a request is filed with the purport that the Virtual Object does not fall within the technical scope of the patented invention

Following is an example of a statement of the purport of the request:

5 Purport of the request

For the purpose of an essentiality check ..., we would like to request an advisory opinion that Virtual Object Product, which complies with the standards in XXX, does not fall within the technical scope of the patented invention for Japanese Patent No. XXX.

When an advisory opinion is issued in response to a request filed for such a purport, the presented conclusion would state solely whether the Virtual Object falls within the technical scope of the patented invention or not. If the conclusion states that the Virtual Object does not fall within the technical scope, the section on reasons in the advisory opinion would also refer to determination for an essentiality check of the patented invention. (See the description example in Section 6.(2).)

(2) Statement of the demandee

When a request for an advisory opinion for an essentiality check is filed, it should be mentioned in the request that the parties concerned have conflict of views over the standard essentiality of the patented invention as the demandee in the licensing negotiations. Thus, as shown in Section 2. (4) (A), when there is no opposing party concerned, there is no benefit of request. (In such a case, the request for an advisory opinion is dismissed by the decision due to an unlawful request for an advisory opinion.)

When the counterargument, etc. presented in a written reply reveals that

the demandant and demandee are not the parties concerned have conflict of views , the request for an advisory opinion could be dismissed by the decision that the request is unlawful.

(3) Statement of reason for the request

A. Statement of “necessity for the request for an advisory opinion”

When requesting an advisory opinion for determining an essentiality check, in the item “Necessity for the request for an advisory opinion” on the written request for an advisory opinion, the demandant clarifies that the demandant and the demandee are the parties concerned who dispute over the essentiality of the patented invention in the licensing negotiations etc..

If there is no conflict of views (e.g., cases without an opposing party) on the essentiality of the patented invention, as mentioned above in 2. (4) A., there can be no benefit of the request.

The following exemplifies the necessity for the request for an advisory opinion:

6. Reason for the request

(1) Necessity for the request for an advisory opinion

The demandant and the demandee concerning this request have discussed in the patent’s licensing negotiation on the standards in XXX whether the patented invention is essential for said standards, however, the views in the both parties still differ, and hence no agreement has been reached.

Therefore, for this essentiality check, we would like to request the JPO to provide us with an official opinion from a fair and neutral perspective that a product of the Virtual Object conforming to the standards in XXX falls within the technical scope of the present invention.

B. Statement of explanation of the Virtual Object

(A) When a request is filed with the purport that the Virtual Object falls

within the technical scope of the patented invention

In the explanation of the Virtual Object, please identify and explain one Virtual Object consisting only of the essential configuration in the standard document corresponding with the constituent configuration of the patented invention for which the advisory opinion is requested. Similar to the general advisory opinion, a drawing or a statement of Virtual Object may be attached for the explanation.

It is required to identify the Virtual Object according to the statement of the standard document. The configuration of the Virtual Object should not substantially change from the one specified in the statement of the standard document or should not identify as a generic concept or subordinate concept.

In this operation, there are two types of “essential configurations in the standard document” that can be used to identify the Virtual Object: (1) the configuration essential in the standard document and (2) the configuration selectively essential in the standard document (See 2. (4) B. (A) c.).

Additionally, the Virtual Object may be (α) specified only by an essential configuration in the standard document (i.e. a case where specified only by (1) above) or by (β) specified by containing the selectively essential configuration in the standard document (i.e. a case where specified by (1) and (2) above and/or when specified only by (2) above). Because the premise on an essentiality check shown in a written advisory opinion differs depending on whether the Virtual Object is specified according to (α) or (β), thus, the demandant should clarify whether the Virtual Object is specified either (α) or (β) by providing the information in the section “Configuration used to identify the Virtual Object” for the identification of the Virtual Object.

In (α) in the section “Configuration used to identify Virtual Object,” it should be stated that “this Virtual Object Product is identified only with the essential configuration in the standard document.”

On the contrary, in (β) in the section “Configuration used to identify Virtual Object,” it should be stated that “this Virtual Object Product is

identified by including the configuration that is selectively essential in the standard document.”

Furthermore, in (β), prior to the identification of the Virtual Object, in the item “Specification of the configuration that is selectively essential,” is provided, and specify multiple configurations where any of which should be essentiality selected and which one is actually selected.

Additionally, like an amendment that adds and specifies the configuration of the Virtual Object from a place differing from the standard document’s statement portion, shown as the reason in the request for an advisory opinion, and because the amendment to change the Virtual Object is not accepted as a change of the gist, please be careful in identifying the Virtual Object.

In the explanation of the Virtual Object, for each configuration of the identified Virtual Object, the demandant must describe the explanation where the configuration is stated and its content in the standard document and the specific reason that the configuration is essential in the standards as a basis for the request. If the standard document’s statement portion that is the basis for the request is not indicated merely regarded as the technical common sense or if a specific reason the configuration is essential in the standards is not indicated, such a configuration may not be recognized as a configuration of Virtual Object, which is the premise of the determination of falling within the technical scope of the patented invention.

Additionally, in a case where a part of the configuration for specifying the Virtual Object is an obvious configuration technically essential although not explicitly described, or is described but not specified as being essential in the standard document and is an obvious technically essential configuration, it is necessary to indicate that said configuration is essential for the standards by explaining the specific statement part and its content as well as showing the document¹² that proves the case. .

In the case of (α), for example, the section “Explanation of the Virtual Object” is described as follows.

¹² For example, recording a conference when creating the standards may be considered.

6. Reason for the request

...

(4) Explanation of the Virtual Object¹³

A. Configuration used to identify Virtual Object

This Virtual Object Product is identified only by the configuration that is essential in the standard document.

B. The Virtual Object Product is a data transmission device with the following configurations a ,

a. Using the Radio Link Control (RLC) protocol of the UE-UTRAN radio interface, the transmitting UM-RLC entity receives the RLC service data units (SDUs) from the upper layer via UM-SAP

...

C. Explanation of a.

The following is described in Exhibit No. A-x (the standard document).

“The present document specifies the Radio Link Control protocol for the UE-UTRAN radio interface.” (Page 8, “1 Scope”)
(Japanese translation: ...)

“The transmitting UM-RLC entity receives RLC SDUs from the upper layer through the UM-SAP.” (Page. 14 “4.2.1.2.1 Transmitting UM-RLC entity”)
(Japanese translation: ...)

In addition, these statements define the most basic communication protocol in the data transmission apparatus conforming to the standard. As it is also

¹³ This description example is created by the JPO based on “3GPP TS 25.322 V 6.9.0”
http://www.etsi.org/deliver/etsi_ts/125300_125399/125322/06.09.00_60/ts_125322v060900p.pdf

described as ... on page XX, lines XX of Exhibit No. A-x, it relates to the configuration that is essential in the relevant standards.

...

In the case of (β), for example, the section “Explanation of the Virtual Object” is described as follows.

6. Reason for the request

...

(4) Explanation of the Virtual Object

A. Configuration used to identify Virtual Object

The Virtual Object Product is identified by including the configuration that is selectively essential in the standard document.

B. Identification of configurations that are selectively essential

In this standard, wherein it is essential to have either an LED lamp or a fluorescent lamp as a warning light (see page XXX of Exhibit No. A-x [standard document]), in this advisory opinion request, it is premised that an LED lamp is selected as the warning light.

C. The Virtual Object Product is a ... device with the following configuration a, and

a. Equipped with a warning light consisting of LED lamps,

b. Having a DC power supply that drives the warning light,

...

D. Explanation of a.

The following items are described in Exhibit No. A-x.

“In this standard, either an LED lamp or a fluorescent lamp must be provided as the warning light.” (Page XXX)

Additionally, as described in the aforementioned “specification of the configuration that is selectively required,” assuming that the LED lamp is selected as the warning light, a warning lamp consisting of LEDs is an essential component of this standard document.

E. Explanation of b

The following items are described in Exhibit No. A-x.

“As a power supply for driving the warning light, a DC power supply should be provided if the warning light is an LED lamp, and an AC power supply should be provided if the warning light is a fluorescent light.” (Page XXX)

As described in the section “Specifically selected configuration essential,” the present request is premised on selecting the LED lamp as the warning light; therefore, the product is equipped with a DC power supply for driving the warning light.

Additionally, as described in the aforementioned “specification of the configuration that is selectively essential,” assuming that the LED lamp is selected as the warning light, a DC power supply—a power supply for driving a warning light—is an essential configuration of this standard document.

...

Moreover, when the Virtual Object includes a configuration that is selectively essential in the standard document, this fact is also referred to in determination of the essentiality check in the written advisory opinion (See the description examples of statement 6. (1) (2) (※ ※)).

(B) When a request is filed with the purport that the Virtual Object does not fall within the technical scope of the patented invention

In this case, the Virtual Object is identified in the same way as described in the previous section (A).

Additionally, to show the judgment on the essentiality check, in a claim chart sent from an opposing party (demandee) for licensing negotiations, etc., it is necessary to show that the Virtual Object is specified only from the standard document's statement portion cited to show the correspondence relationship with the subject patent claims, and to attach the claim chart to the request for an advisory opinion.

For example, when describing each configuration of the identified Virtual Object in addition to the standard document's statement portion as the basis, along with its content, identifying and describing the statement part in the claim chart sent from an opposing party (demandee) is possible.

Below, examples of statement of the explanation of the Virtual Object are shown below, including a reference example of the attached claim chart and a statement indicating that the Virtual Object is specified from the standard document's statement portion cited in the claim chart.

(Reference example of the attached claim chart)

	Present patented invention (Claim 1)	Statement in the standard document
Element A	A device for transmitting data in a mobile communication system, which receives a service data unit (SDU) from upper layers, ...	<p>"The present document specifies the Radio Link Control protocol for the UE-UTRAN radio interface." (Page8 "1 Scope")</p> <p>"The transmitting UM-RLC entity receives RLC SDUs from upper layers through the UM-SAP." (Page14 "4.2.1.2.1 UM RLC entity")</p>
Element B	b.

(Example of a statement of explanation of the Virtual Object including the statement showing that the Virtual Object is specified from the statement portion of the standard document cited in the claim chart)

6. Reason for the request

...

(4) Explanation of the Virtual Object

...

B. The Virtual Object Product is a data transmission device with the following configuration a ,

a. Using the Radio Link Control (RLC) protocol of the UE-UTRAN radio interface, the transmitting UM-RLC entity receives the RLC SDUs from the upper layer via UM-SAP,

...

C. Explanation of a

The following content is described in Exhibit No. A-x (the standard document).

“The present document specifies the Radio Link Control protocol for the UE-UTRAN radio interface.” (Page 8 “1 Scope”)

(Japanese translation: ...)

...

Then, in the “Statement of the standard document” of “Element A,” page 1 of Exhibit No. A-x (the claim chart sent from the demandee), page 8 “1 Scope” XXX is cited.

...

(C) Statement of the technical contrast between the patented invention and the Virtual Object

In the item “Technical comparison between the patented invention and the

Virtual Object,” use the comparison table and explain specifically the correspondence relationship between each constituent configuration of the patented invention and each configuration of the specified Virtual Object

In the same manner as in the general advisory opinion, indicate whether the configuration of the Virtual Object the patented invention’s constituent configurations. For example, even if it cannot be said that a configuration is formally satisfactory but it can be said that the configuration is substantially satisfied according to the interpretations, etc., describe specifically those interpretations divided by each configuration. If the interpretation of terms in the standard document becomes a problem, describe the reason that the demandant interprets that way along with the relevant grounds (e.g., evidence, etc.).

Additionally, describe as specific as possible about the issues that have been clarified in the licensing negotiations, etc. and the content that the demandee is asserting, or would assert regarding the essentiality check.

(Example of statement of a technical comparison between the patented invention and the Virtual Object)

6. Reason for the request

...

(5) Technical comparison between the patented invention and the Virtual Object Product

The correspondence relationship between the constituent configuration A, of the present patented invention and the configuration a, of the Virtual Object Product is shown in the following table.

Present patented invention	Virtual object product "A"	Fulfillment
A. A device for transmitting data in a mobile communication system, which receives a protocol data unit (PDU) from upper layers, ...	a. Using the RLC(Radio Link Control) protocol of the UE-UTRAN radio interface, the transmitting UM- RLC entity receives RLC SDUs from upper layers via UM SAP, ...	○
B. ...	b. ...	

...

(Explanation)

(i) “UE” is an acronym for “User Equipment” (Japanese translation: ...), and “UTRAN” is an acronym for “Universal Terrestrial Radio Access Network” (Japanese translation: ...). These indicate the user terminal in the mobile communication system and the network that the user terminal accesses.

“RLC (Radio Link Control)” (Japanese translation: ...) is one of the communication protocols.

“UM” is an acronym for “Unacknowledged Mode” (Japanese translation: ...) and is one of the operation modes in communication.

“SAP” is an acronym for “Service Access Point” (Japanese translation: ...) and refers to a point to receive service in network processing.

Therefore, the “data transmission device,” “upper layer,” and “service data unit (SDU)” of the patented invention correspond to “UE,” “upper layer,” and “RLC SDU” of the Virtual Object Product respectively. Thus, the configuration a of the Virtual Object Product satisfies the constituent configurations of A of the present invention.

...

(D)Statement of the explanation that the Virtual Object belongs to the technical scope of the patented invention and that the patented invention is standard and essential (or the Virtual Object does not fall within the technical scope of the patented invention, and the patented invention is not standard and essential).

Based on the technical comparison in C above, describe the explanation that the Virtual Object falls within (or does not fall within) the technical scope of the patented invention and that the patented invention is standard and essential (or not standard and essential).

(An example of a statement of the explanation that the Virtual Object falls within the technical scope of the patented invention and that the patented invention is standard and essential)

6. Reason for the request

...

(6) Explanation that the Virtual Object Product falls within the technical scope of the patented invention and that the patented invention is standard and essential

Because the configuration a, of the Virtual Object Product satisfies all the present invention's constituent configurations A, respectively, the Virtual Object Product having the configuration a, falls within the technical scope of the present patented invention.

Additionally, because the Virtual Object Product falls within the technical scope of the patented invention, the patented invention is essential to standards of XXX.

(An example of a statement of the explanation that the Virtual Object does not fall within the technical scope of the patented invention and that the patented invention is not standard and essential)

6. Reason for the request

...

(6) Explanation that the Virtual Object Product does not falls within the technical scope of the patented invention and that the patented invention is not standard and essential.

Because the configuration a, of the Virtual Object Product does not satisfy the present invention's constituent configurations A, respectively, the

Virtual Object Product having the configuration a does not fall within the technical scope of the present invention.

...

Additionally, because the Virtual Object Product does not fall within the technical scope of the patented invention, the patented invention is not essential to the standards in XXX.

(4) Statement of “means of evidence”

The statement of means of evidence is the same as in the case of general judgment, but if the standard document to be submitted as evidence is written in a foreign language, it is required to attach a translation of the relevant part (Article 61 is applied mutatis mutandis pursuant to the Regulations under the Patent Act Article 40).

4. Written reply submitted by the demandee

- (1) A written reply to a request for an advisory opinion on determining that the Virtual Object Product falls within the technical scope of the patented invention

In the section “Purport of the reply,” it is required to state that the demandee seeks an advisory opinion that Virtual Object Product¹⁴ does not fall within the technical scope of the patented invention.” In the section “Reason for the reply,” it is mandatory to state, among other things, the reasons and grounds for the demandee’s allegation that the said product does not fall within the technical scope and the counterargument against the demandant’s allegation for each configuration decomposed by the demandant. The demandee may also submit an evidence as Exhibit No. B-x, if necessary.

For example, the content of the counterargument includes the following. (a) Part of the configuration of the Virtual Object Product does not fulfill the

¹⁴ While Virtual Object Product is used here for the sake of clarity, as described in (Note 10), Virtual Object can be expressed as “Virtual Object Product” or “Virtual Object Process”. Please describe according to the statement of the written request for an advisory opinion.

corresponding patented invention's constituent configurations because of misinterpreting the standard document's statement specified the Virtual Object Product. (b) In the configuration corresponding to the patented invention's constituent configurations, the configuration that the demandant alleges as indispensable to the standards is not actually indispensable. Concerning issues about which the demandee has submitted no counterargument, the JPO makes a determination as per the demandant's allegations and proof. Thus, in such a case, please note that the JPO's determination could be disadvantageous to the demandee.

When the demandee believes that the demandee should not be considered as having a different opinion on essentiality, the demandee may give specific reasons for such a belief. For instance, the demandee could explain that while the demandee received a request from the demandant for a licensing negotiation on the patent for which an advisory opinion is sought, the demandee has no conflict of views with the demandant over the essentiality of the patented invention.

Under this advisory opinion system, the demandee can allege about the technical scope of the patented invention but cannot do so about the validity of the patent right. It would be meaningless to state reasons for invalidation as a patent invalidity defense. Hence, the demandee can file a separate request for a trial for invalidation, etc. if necessary.

(Example of a statement of the purport of the reply)

We would like to request an advisory opinion to the effect that a Virtual Object Product does not fall within the technical scope of the patented invention of Japanese Patent No. XXX.

(Example of a statement of reason for the reply)

Concerning a configuration ... of the Virtual Object Product, while the demandant interprets the statement ... contained in the standard document as ..., the statement concerning the said configuration should be interpreted as ..., based on the statement presented in lines XX–XX on page XX of Exhibit No. A-x and in the statement presented in lines XX–XX on page XX of Exhibit No. B-x.

When statements contained in the standard document are thus interpreted, the configuration ... of the Virtual Object Product does not fulfill the constituent configuration ... of the patented invention.

Furthermore,

On grounds set forth above, the Virtual Object Product does not fall within the technical scope of the patented invention of Japanese Patent No. XXX.

(2) A written reply to a request for an advisory opinion determining that the Virtual Object Product does not fall within the technical scope of the patented invention

In the section “Purport of the reply,” it is mandatory to state that the demandee seeks an advisory opinion that Virtual Object Product falls within the technical scope of the patented invention.” In the section “Reason for the reply,” it is required to state, among other things, the reasons and grounds for the demandee’s allegation that Virtual Object Product falls within the technical scope and the counterargument against the demandant’s allegation. The demandee may also submit an evidence as Exhibit No. B-x, if necessary.

When the demandee makes a counterargument, showing that the configuration of the Virtual Object Product fulfills all the corresponding constituent configurations of the patented invention is necessary by specifically explaining the relationships between each constituent configuration of the patented invention and each configuration of the specified Virtual Object. Consider using a comparative table, if necessary.

For instance, the demandee can possibly present another such counterargument that the configuration that the demandant does not allege as indispensable is, in fact, indispensable.

(Example of a statement of the purport of the reply)

We would like to request an advisory opinion to the effect that the Virtual Object Product falls within the technical scope of the patented invention of Japanese Patent No. XXX.

(Example of a statement of the reason for the reply)

Concerning configuration ... of the Virtual Object Product, while the demandant interprets the statement ... contained in the standard document as ..., the statement concerning the said configuration should be interpreted as ..., based on the statement presented in lines XX–XX on page XX of Exhibit No. A-x and the statement presented in lines XX–XX on page XX of E No. B-x.

When statements contained in the standard document are thus interpreted, the configuration ... of the Virtual Object Product fulfills the constituent configuration ... of the patented invention.

Furthermore,

Therefore, because the Virtual Object Product fulfills all the constituent configurations of the patented invention, it falls within the technical scope of the patented invention of Japanese Patent No. XXX.

In a case where it is considered that the Virtual Object Product is not specified only from the standard document's explanation cited to show the relationship with the patent claim in the claim chart sent by the demandee to the demandant, stating in the written reply the specific reason to have thought so is required.

As a result, when it is recognized that the Virtual Object is not specified only from the standard document's explanation cited in the claim chart sent by the demandee to the demandant, the JPO only determines whether the Virtual Object falls within the technical scope of the patented invention. Then, the JPO does not make a determination for an advisory opinion for an essentiality check.

(Example of a statement of reason for the reply)

The Virtual Object that the demandant specifies is not specified only from the standard document's explanation cited to show the relationship with the patent claim in the claim chart sent by the demandee.

The claim chart sent by the demandee to the demandant does not state the configuration “...” in the Virtual Object Product identified by the demandant.

Furthermore,

5. Example of a statement of a written request for an advisory opinion for an essentiality check

An example of a statement of a written request for an advisory opinion for an essentiality check is presented below.

(1) An example of a statement of a written request for an advisory opinion on determining that the Virtual Object falls within the technical scope of the patented invention

<p>1. Indication of the case of an advisory opinion request Case of an advisory opinion request concerning Japanese Patent No. XXX</p> <p>2. Demandant ...</p> <p>3. Attorney of the demandant ...</p> <p>4. Demandee ...</p> <p>5. Purport of the request For the purpose of an essentiality check ..., we would like to request an advisory opinion determining that a Virtual Object Product, which is complied with the standards in XXX , does not fall within the technical scope of the patented invention for Japanese Patent No. XXX.</p> <p>6. Reason for the request (1) Necessity for the request for an advisory opinion The demandant and the demandee concerning this request have discussed in the patent's licensing negotiation on the standards in XXX whether the patented invention is essential for said standards, however, the views in the both parties still differ, and hence no agreement has been reached. Therefore, for this essentiality check, we would like to request the JPO to provide us with an official opinion from a fair and neutral perspective that a</p>
--

product of the Virtual Object conforming to the standards in XXX falls within the technical scope of the present invention.

(2) Procedures before the JPO related to the patented invention

...

(3) Explanation of the patented invention

Based on the description and drawings, the patented invention ... is as described in Claim 1 as follows. The configuration is decomposed into each constituent configuration and called A,

“A. A device that transmits data of a mobile communication system and receives service data units (SDUs) from the upper layer, ...

(4) Explanation of the Virtual Object

A. Configuration used to identify the Virtual Object (*)

(B. Identifying configurations that are selectively essential (**))

...

B. Virtual Object Product is a data transmission device with the configuration a, ... as follows.

a. By using the RLC (Radio Link Control) protocol for the UE-UTRAN radio interface, the transmitting UM-RLC entity receives RLC SDUs from the upper layer through UM-SAP, ...

C. Explanation of a.

The following is described in Exhibit No. A-x (the standard document).

“The present document specifies the Radio Link Control protocol for the UE-UTRAN radio interface.” (Page 8, “1 Scope”)
(Japanese translation: ...)

“The transmitting UM-RLC entity receives RLC SDUs from the upper layer

through the UM-SAP.” (Page 14, “4.2.1.2.1 Transmitting UM-RLC entity”) (Japanese translation: ...)

These statements specify the most basic communication protocol for data transmission devices that comply with the standards, and because it is stated in page XX, lines XX to XX of Exhibit No. A-x that ..., the configurations are indispensable for the standards.

...

(5) Technical comparison between the patented invention and Virtual Object Product

The correspondence relationship between the constituent configuration A, of the present patented invention and the configuration a, of the Virtual Object Product is shown in the following table.

Patented invention	Virtual Object Product “A”	Fulfillment
A. A device that transmits data of a mobile communication system and receives the service data unit (SDU) from upper layers, ...	a. By using the RLC (Radio Link Control) protocol for the UE UTRAN radio interface, the transmitting UM -RLC entity receives RLC SDUs from upper layers through the UM-SAP, ...	○
B. ...	b. ...	

...

(Explanation)

(i) “UE” is the acronym of “User Equipment” (Japanese translation: ...). “UTRAN” is the acronym of “Universal Terrestrial Radio Network” (Japanese translation: ...). They refer to a user’s terminal of a mobile communication system and the network to which the user’s terminal accesses.

“RLC (Radio Link Control)” (Japanese translation: ...) is one of the communications protocols.

“UM” is the acronym of “Unacknowledged Mode” (Japanese translation: ...),

which is one of the operating modes in communication.

“SAP” is the acronym of “Service Access Point” (Japanese translation: ...), which means the point at which network processing services are provided.

Therefore, the “data transmitting device,” “upper layer,” and “Service Data Unit (SDU)” of the patented invention correspond to the “UE,” “upper layers,” and “RLC SDU” of Virtual Object Product, respectively. The configuration a of the Virtual Object Product fulfills the constituent configuration of A of the patented invention.

...

(6) Explanation that the Virtual Object Product falls within the technical scope of the patented invention and that the patented invention is essential to the standard

Because the configuration a, of the Virtual Object Product does not satisfy the present invention’s constituent configurations A, respectively, the Virtual Object Product having the configuration a does not fall within the technical scope of the present invention.

...

Additionally, because the Virtual Object Product does not fall within the technical scope of the patented invention, the patented invention is not essential to the standards in XXX.

(7) Conclusion

Because the Virtual Object Product, which complies with the standards in XXX, fulfills all of the patented invention’s constituent configurations, the Virtual Object Product falls within the technical scope of the patented invention.

7. Means of evidence

(1) Exhibit No. A-1: Patent Gazette No. XXX

(2) Exhibit No. A-2: Standard document XXX

8. List of attached documents and items

(1) Request for an advisory opinion 2 (duplicates)

(2) Explanation of object A 1 (original)

2 (duplicates)

(3) Certified copy of the patent register	1 (original) 1 (duplicate)
(4) Power of attorney	1

(*) When the Virtual Object Product is specified only by essential configurations in the standard document, it is required to state, “The Virtual Object Product is specified only by the configurations essential in the standard document.” If the Virtual Object Product is specified as containing configurations that are selectively essential in the standard document, it is required to state, “The Virtual Object Product is specified containing the configurations that are selectively essential in the standard document.”

(**) When the Virtual Object is specified using configurations that are selectively essential, it is necessary to state and explain the configurations, adding an item of “Selectively essential configurations” in the “Explanation of the Virtual Object.”

(2) An example of a statement of a written request for an advisory opinion determining that the Virtual Object does not fall within the technical scope of the patented invention

1. Indication of the case of advisory opinion request Case of an advisory opinion request concerning Japanese Patent No. XXX
2. Demandant ...
3. Attorney of the demandant ...
4. Demandee ...
5. Purport of the request For the purpose of essentiality check, we would like to request an advisory opinion determining that the Virtual Object Product, which complies with the

standards in XXX, does not fall within the technical scope of the patented invention of Japanese Patent No. XXX.

6. Reason for the request

(1) Necessity for the request for an advisory opinion

The demandant and the demandee concerning this request have discussed in the patent's licensing negotiation on the standards in XXX whether the patented invention is essential for said standards, however, the views in the both parties still differ, and hence no agreement has been reached.

Therefore, for this essentiality check, we would like to request the JPO to provide us with an official opinion from a fair and neutral perspective that a product of the Virtual Object conforming to the standards in XXX falls within the technical scope of the present invention.

(2) Procedures before the JPO related to the patented invention

...

(3) Explanation of the patented invention

Based on the description and drawings, in the patented invention is described as in Claim 1 as follows. The configuration is decomposed into each constituent configuration and called A,

"A. A device that transmits data of a mobile communication system and receives the SDUs from the upper layer, ..."

(4) Explanation of the Virtual Object

A. Configuration used to identify the Virtual Object (*)

(B. Identifying configurations that are selectively essential (**))

...

B. Virtual Object Product is a data transmission device with the configuration a, ... as follows.

a. By using the RLC (Radio Link Control) protocol for the UE-UTRAN radio interface, the transmitting UM-RLC entity receives RLC SDUs from the upper layer through UM-SAP, ...

C. Explanation of a.

Exhibit No. A-x (standard document) states as follows.

“The present document specifies the Radio Link Control protocol for the UE-UTRAN radio interface.” (Page 8, “1 Scope”)

(Japanese translation: ...)

“The transmitting UM-RLC entity receives RLC SDUs from the upper layer through UM-SAP.” (Page 14, “4.2.1.2.1 Transmitting UM-RLC entity”)

(Japanese translation: ...)

These statements specify the most basic communication protocol for data transmission devices that comply with the standard, and because it is stated in page XX, lines XX–XX of Exhibit No. A-x that ..., the configurations are indispensable for the standard.

In the explanation of “Element A” on page 1 of Exhibit No. A-y (claim chart sent by the demandee), “1 Scope” on page 8 and “4.2.1.2.1 Transmitting UM RLC entity” on page 14 are cited.

...

(5) Technical comparison between the patented invention and the Virtual Object Product

The following table shows the relationships between the constituent configuration A, ... of the patented invention and the configuration a, ... of the Virtual Object Product.

Patented invention	Virtual Object Product “A”	Fulfillment
A. A device that transmits data of a mobile communication system and receives the service data unit (SDU) from upper layers, ...	a. By using the RLC (Radio Link Control) protocol for the UE UTRAN radio interface, the transmitting UM -RLC entity receives RLC SDUs from upper layers through the UM-SAP, ...	×
B. ...	b. ...	

(Explanation)

(i) “UE” is the acronym of “User Equipment”. “UTRAN” is the acronym of “Universal Terrestrial Radio Access Network” (Japanese translation: ...). They refer to a user terminal of a mobile communication system and the network to which the user terminal accesses.

“RLC (Radio Link Control)” (Japanese translation: ...) is one of the communications protocols.

“UM” is the acronym of “Unacknowledged Mode” (Japanese translation: ...), which is one of the operating modes.

“SAP” is the acronym of “Service Access Point” (Japanese translation: ...), which means the point at which network processing services are provided.

“SDU” (Japanese translation: ...) is the acronym of “Service Data Unit”.

Therefore, the “data transmitting device” and “upper layer” of the patented invention correspond to the “UE” and “upper layer” of the Virtual Object Product respectively. On the contrary, it is clear that the SDU is technically different from the protocol data unit (PDU). Therefore, the “PDU” of the patented invention does not correspond to the “RLC SDU” of the Virtual Object Product.

Thus, the configuration a of the Virtual Object Product does not fulfill the constituent configuration A of the patented invention.

...

(6) Explanation that the Virtual Object Product does not fall within the technical scope of the patented invention and that the patented invention is not essential to the standards

Because the configuration a, of the Virtual Object Product does not satisfy the present invention's constituent configurations A, respectively, the Virtual Object Product having the configuration a does not fall within the technical scope of the present invention.

...

Additionally, because the Virtual Object Product does not fall within the technical scope of the patented invention, the patented invention is not essential to the standards in XXX.

(7) Conclusion

Because the Virtual Object Product, which complies with the standards in XXX, does not fulfill the constituent configuration A, ... of the patented invention, the Virtual Object Product does not fall within the technical scope of the patented invention.

7. Means of evidence

- (1) Exhibit No. A-1: Patent Gazette No. XXX
- (2) Exhibit No. A-2: Standard document XXX
- (3) Exhibit No. A-3: Claim chart sent by Demandee to Demandant

8. List of attached documents and items

- | | |
|---|----------------|
| (1) Request for an advisory opinion | 2 (duplicates) |
| (2) Explanation of the article A | 1 (original) |
| | 2 (duplicates) |
| (3) Certified copy of the patent register | 1 (original) |
| | 1 (duplicate) |
| (4) Power of attorney | 1 |

(*) When the Virtual Object Product is specified only by configurations that are essential in the standard document, it is required to state, "The Virtual Object Product is specified only by the configurations that are essential in the standard document." If the Virtual Object Product is specified as containing the configurations that are selectively essential in the standard document, it is required to state, "The Virtual Object Product is specified containing the configurations that are selectively essential in the standard document."

(**) When the selectively essential configurations are specified, it is necessary to explain the configurations, adding an item of “Selectively essential configurations” in the “Explanation of the Virtual Object”.

provisional translation

6. Example of a statement of a written advisory opinion for an essentiality check

The JPO's advisory opinion is made available to the public. The following example of a statement shows a written advisory opinion in cases of containing and not containing determination of essentiality check.

(1) An example of a statement of a written request for an advisory opinion determining that the Virtual Object falls within the technical scope of the patented invention

(Example of a statement of a written advisory opinion containing comment on essentiality)

[Indication of the case]

The following advisory opinion on the technical scope of a patented invention for Japanese Patent No. XXX between the parties above is stated and concluded as follows.

[Conclusion]

The Virtual Object Product, which complies with the standards in XXX, falls within the technical scope of the patented invention of Japanese Patent No. XXX.

[Reason]

1. Purport of the request

The stated purport of the request for an advisory opinion is that the demandant seeks an advisory opinion for an essentiality check determining that Virtual Object Product, which complies with standard XXX, falls within the technical scope of the patented invention of Japanese Patent No. XXX.

2. History of the procedures of the patent...

3. Patented invention

...

4. Virtual Object Product

(1) Identification of the configurations that are selectively essential (*)

(2) ...

5. Comparison and determination

...

On the grounds set forth above, the Virtual Object Product fulfills all constituent configurations of the patented invention.

6. Conclusion

As described above, the Virtual Object Product, which complies with the standards in XXX, falls within the technical scope of the patented invention.

Therefore, the advisory opinion shall be made as stated in the conclusion.

The following comment (**) is added with regard to the patented invention.

Based on the allegations made and evidence submitted by the parties concerned, the Virtual Object Product, which complies with the standards in XXX, falls within the technical scope of the patented invention. Therefore, the patented invention shall be considered as essential to the standards in XXX (when adopting the configuration stated in “Identification of the configurations that are selectively essential” above).

(*) “(1) Identification of the configurations that are selectively essential” will be stated on the assumption of the content only when “identifying configurations that are selectively essential” is stated in the written request for an advisory opinion.

(**) When the Virtual Object Product is specified only by the configurations that are essential in the standard document, the content shown in parentheses in the comment above will not be stated. On the contrary, when the Virtual Object Product is specified as containing the configurations that are selectively essential in the standard document, it is required to state the content shown in parentheses in the comment above.

(Example of a statement of an advisory opinion that does not contain any

comment to essentiality)

...

[Conclusion]

The Virtual Object Product, which complies with standard XXX, does not fall within the technical scope of the patented invention of Japanese Patent No. XXX.

[Reason]

...

5. Comparison and determination

...

Thus, the Virtual Object Product does not fulfill the patented invention's constituent configurations.

6. Conclusion

As described above, the Virtual Object Product, which complies with the standards in XXX, does not fall within the technical scope of the patented invention.

Therefore, the advisory opinion shall be made as stated in the conclusion.

(2) An example of a statement of a written request for an advisory opinion determining that the Virtual Object does not fall within the technical scope of the patented invention

(Example of a statement of a written advisory opinion containing determination on essentiality)

[Indication of the case]

The following advisory opinion on the technical scope of a patented invention for Japanese Patent No. XXX between the parties above is stated and concluded as follows.

[Conclusion]

The Virtual Object Product, which complies with the standards in XXX, does not fall within the technical scope of the patented invention of Japanese

Patent No. XXX.

[Reason]

1. Purport of the request

For an essentiality check, the stated purport of the request for an advisory opinion is that the demandant seeks the advisory opinion determining that the Virtual Object Product, which complies with the standards in XXX, does not fall within the technical scope of the patented invention of Japanese Patent No. XXX.

2. History of the procedures

...

3. Patented invention

...

4. Virtual Object Product

((1) Identification of the configurations that are selectively essential (*))

(2) ...

...

Each of the aforementioned standard document's statements is included in the content in the standard document's explanation cited to show the relationship with the claim of the patented invention in the claim chart sent by the demandee to the demandant.

5. Comparison and determination

...

On these grounds, the Virtual Object Product does not fulfill the constituent configurations A, ... of the patented invention.

6. Determination

As described above, the Virtual Object Product, which complies with the standards in XXX, does not fall within the technical scope of the patented invention.

Therefore, the advisory opinion shall be made as stated in the “Conclusion” section above.

The following comment (**) is added about the patented invention.

Based on the allegations and evidence submitted by the parties concerned, the Virtual Object Product, which complies with standard XXX, does not fall within the technical scope of the patented invention. Therefore, as long as it is determined from the standard document’s explanation cited to show the relationship with the claim of the patented invention in the aforementioned claim chart, the patented invention (when adopting the configuration stated in “Identifying configurations that are selectively essential” above) cannot be considered as essential to the standards in XXX.

(*) “(1) Identifying configurations that are selectively essential” will be stated on the assumption based on the content when “identifying configurations that are selectively essential” is stated in the written request for an advisory opinion.

(**) When the Virtual Object Product is specified only by those configurations that are essential in the standard document, the content shown in parentheses in the comment above will not be stated. On the contrary, when the Virtual Object Product is specified as containing the configurations that are selectively essential in the standard document, it is necessary to state the content shown in parentheses in the comment above.

(Example of a statement of a written advisory opinion not containing determination on essentiality)

...

[Conclusion]

The Virtual Object Product, which complies with the standards in XXX, falls within the technical scope of the patented invention.

[Reason]

...

5. Comparison and determination

...

Thus, the Virtual Object Product does not fulfill the constituent configurations of the patented invention.

6. Determination

As described above, the Virtual Object Product, which complies with the standards in XXX, falls within the technical scope of the patented invention.

Therefore, the advisory opinion shall be made, as stated in the "Conclusion".