

The current state of trials and appeals in Japan

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Trial and Appeal Department (TAD),
Japan Patent Office (JPO)



■ Roles of Trials and Appeals, and Handling of Procedures Affected by COVID-19

■ Globalization of IP Disputes

■ Initiatives in the International Field

■ Inventive Step of AI and IoT Related Inventions in Japan

1. Reviewing examinations

- (1) Resolve appeals from applicants
(appeal against an examiner's decision of refusal)
- (2) Improve the reliability of rights
(opposition to granting patent, trademark registration)

2. Early dispute resolution

- (1) Determine the validity of rights
(trial for invalidation)
- (2) Correction of patent claims, etc.
(trial for correction)
- (3) Rescission of trademark registration not in use, etc.
(trial for rescission of trademark registration)
- (4) Expert opinion regarding the scope of rights
("Hantei" Advisory Opinion)

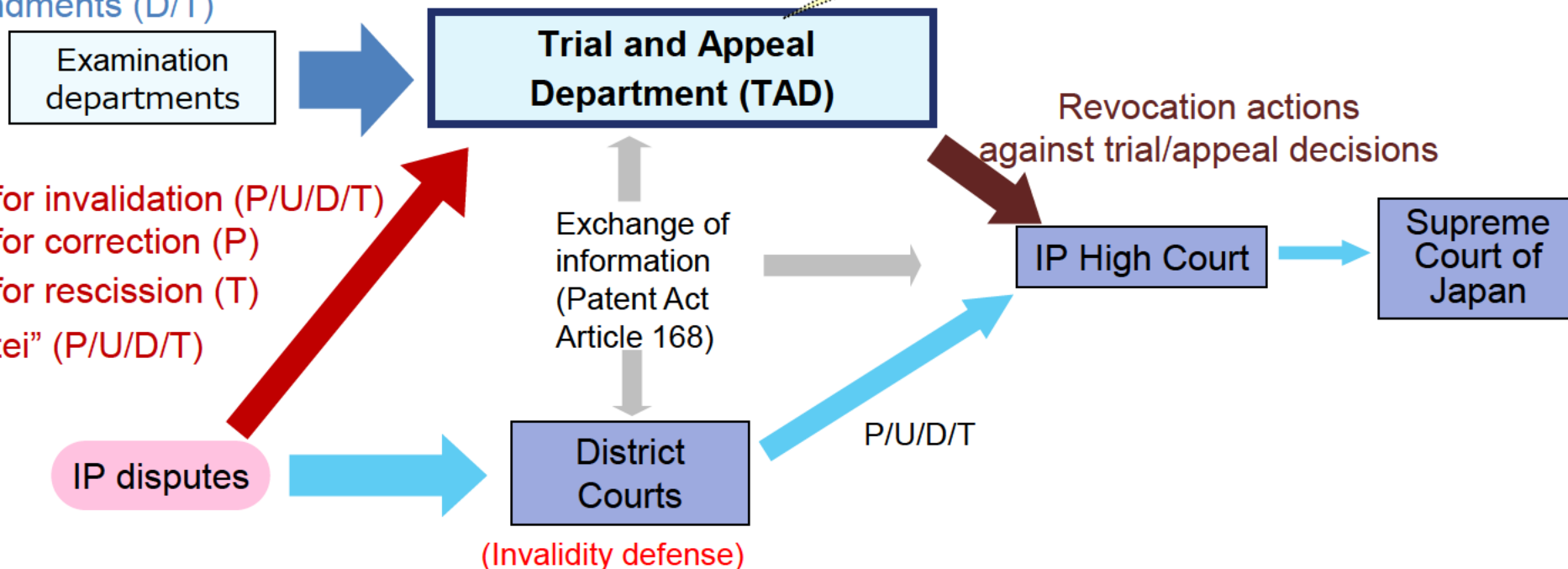
Position of Trials and Appeals

- Appeal against examiner's decision of refusal (P/D/T)
- Appeal against examiner's decision to dismiss amendments (D/T)

- Opposition to granting of patent, trademark registration (P/T)

Role equivalent to the first instance

- Trial for invalidation (P/U/D/T)
- Trial for correction (P)
- Trial for rescission (T)
- "Hantei" (P/U/D/T)



Note: P(patents), U(utility models), D(designs), T(trademarks)

Timeliness of Trial / Appeal Decisions

(Goals to Be Achieved via JPO/TAD-Related Goals)



	Appeals Against Examiner's Decision of Refusal				Trials for Invalidation	Oppositions	
	Patents	Designs	Trade-marks	Accelerated appeal proceedings		Patents	Trade-marks
Average Pendency (months) FY 2021 Goals	9 ~ 11	4 ~ 6	5 ~ 7	2 ~ 4	7 ~ 9	7 ~ 9	5 ~ 7
FY 2020 Results							
Average Pendency (months)	10 . 0	5 . 1	5 . 4	2 . 7	7 . 5	7 . 4	5 . 0

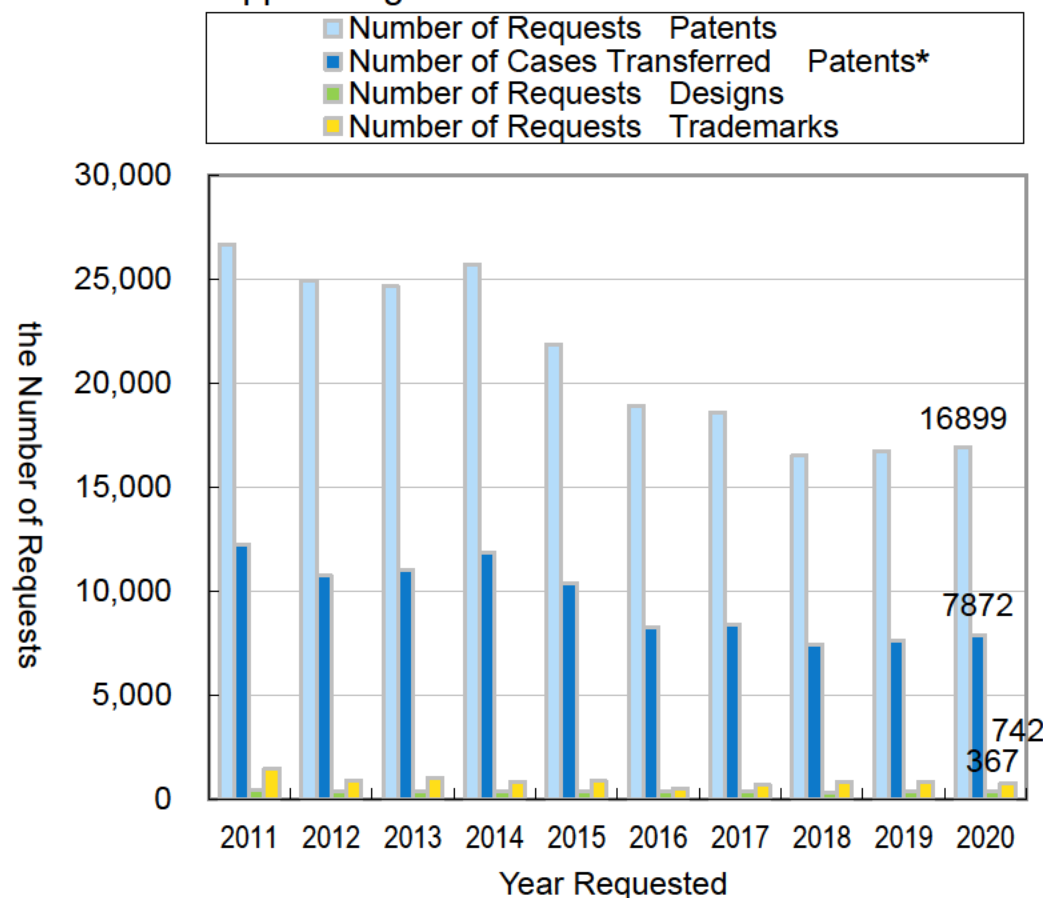
Trends in the Number of Requests:

Appeals against Examiner's Decision of Refusal, Trials for Invalidation

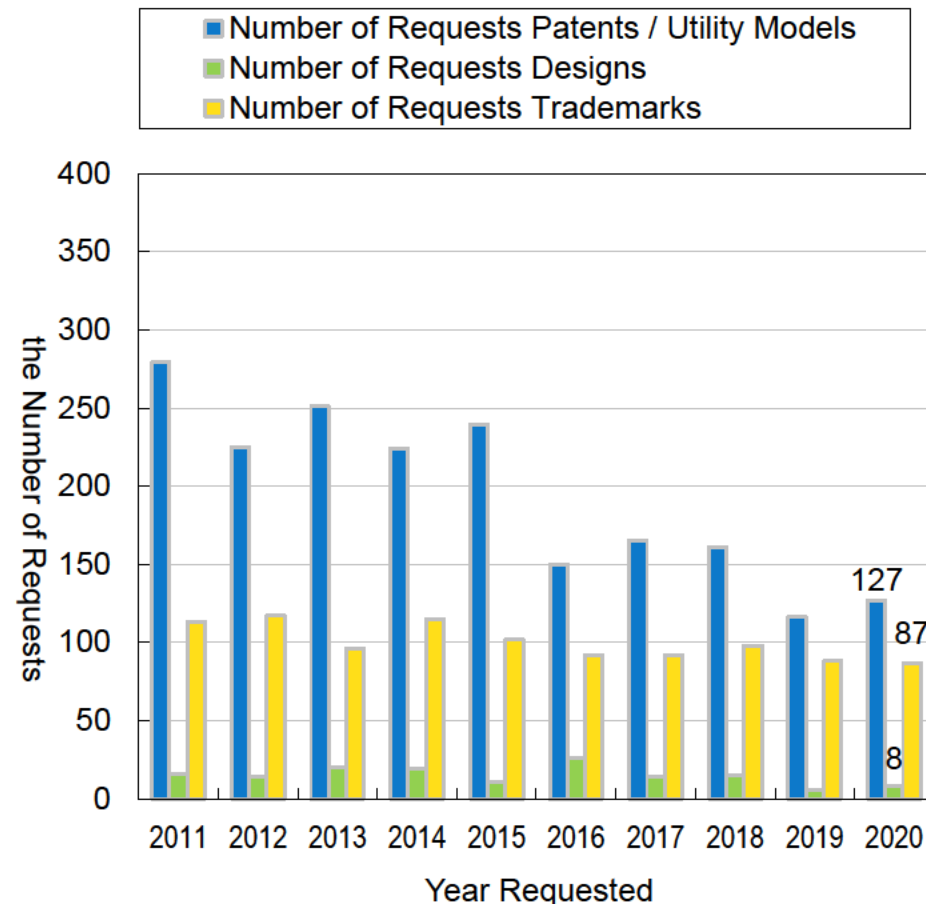


- ✓ The number of requests for appeals against examiner's decision of refusal for
 - Patents: Decreased once with the decrease in the number of decisions of rejection, and has generally remained unchanged since then.
 - Designs/trademarks: Has generally remained unchanged.
- ✓ The number of invalidation trial requests for patents has decreased since 2016 with the introduction of the opposition system.

Appeals against Examiner's Decision of Refusal



Trials for Invalidation

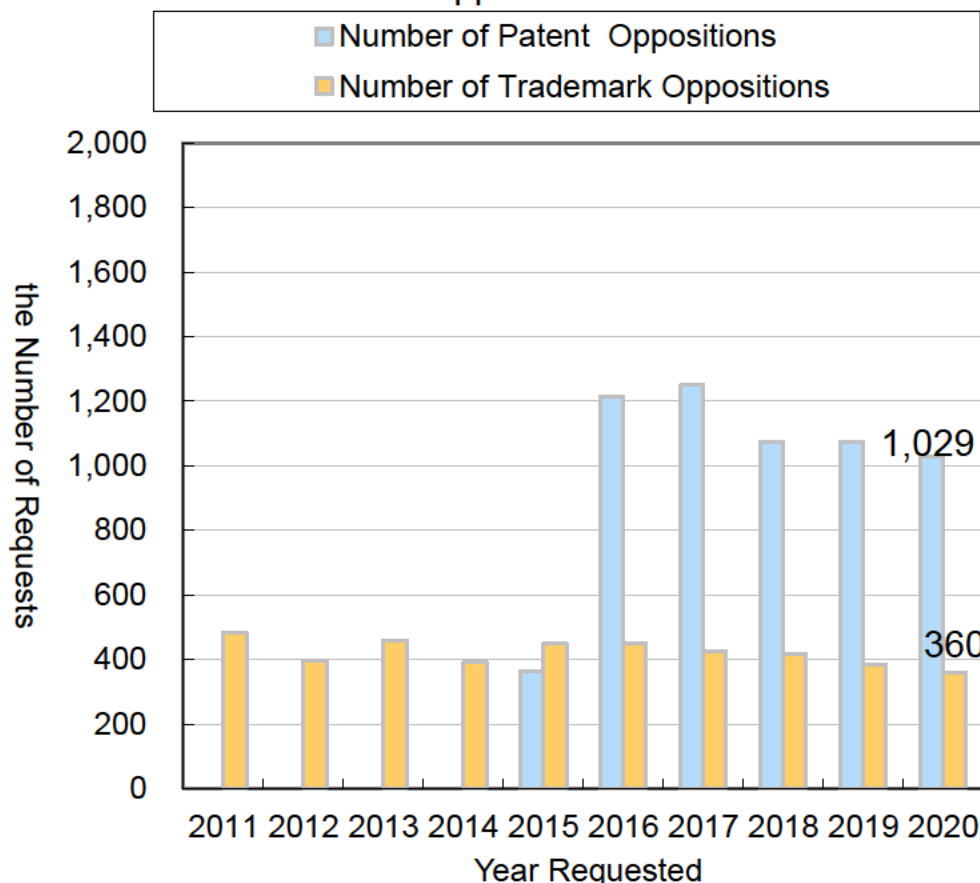


Trends in the Number of Requests:

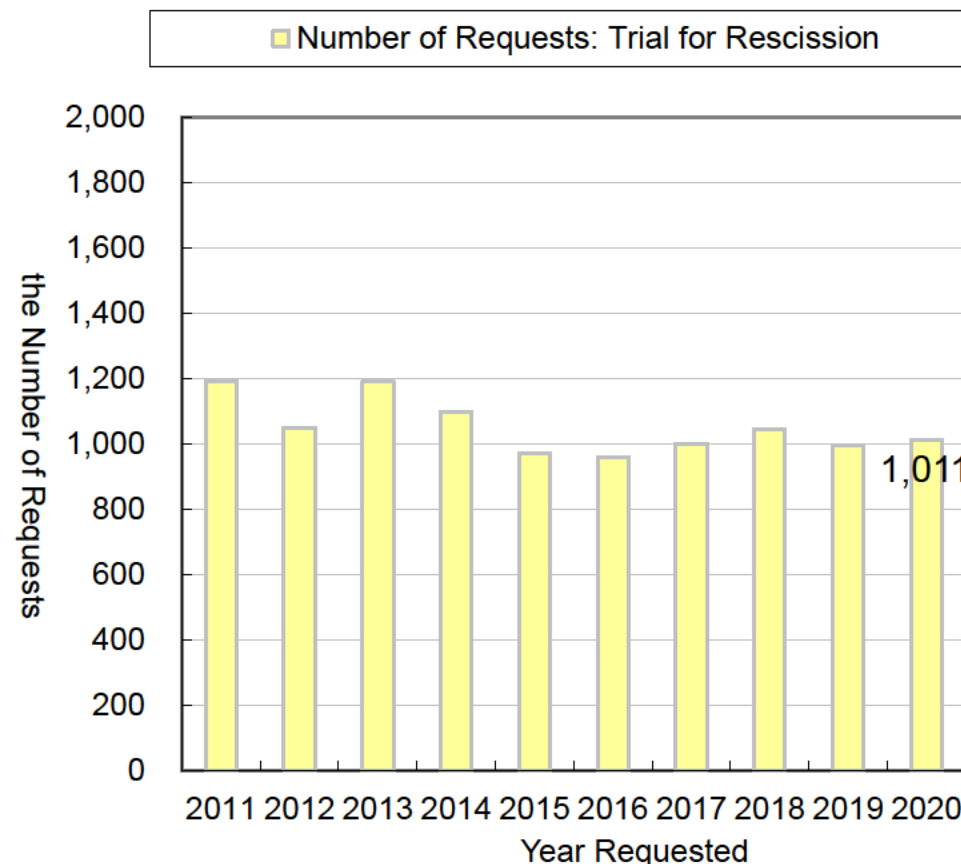
Oppositions, Trials for Rescission

- ✓ The number of requests for
 - Patent opposition (per patent right) has hovered around 1,000.
 - Trademark opposition cases (per trademark right) has generally remained unchanged.
- ✓ The number of requests for rescission trials has generally remained unchanged.

Oppositions

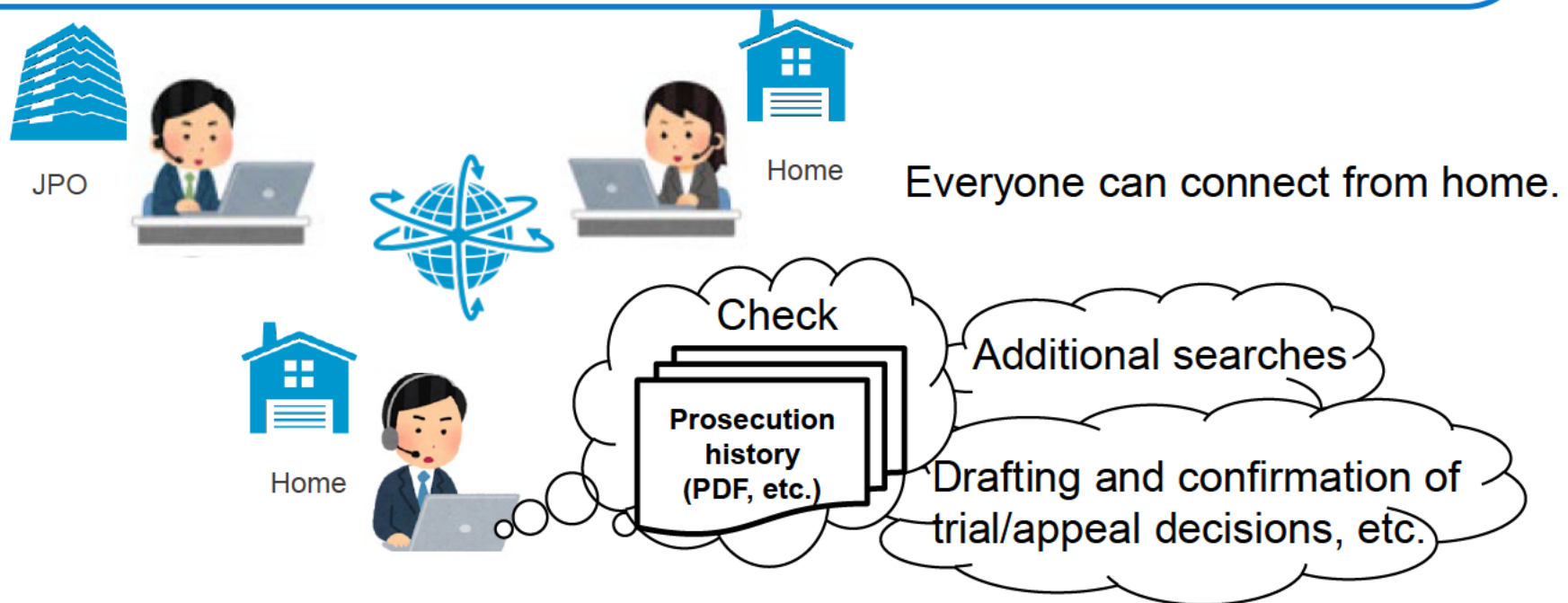


Trials for Rescission



Proceedings for trial and appeal cases During the COVID-19 Pandemic

- ✓ Even if all three administrative judges of the panel are unable to come to work, proceedings will be conducted online.
- ✓ The panel drafts trial/appeal decisions, etc. and confirms the drafting online.
- ✓ The panel proactively conducts online interviews, etc. when interviews, etc. are necessary.



Maintain full, high quality proceedings despite the COVID-19 pandemic

Online Appearance of Parties at Oral Proceedings

Oral proceedings for trials for invalidation, etc.

Previously: Parties were required to "appear" in person before the JPO trial court



- Concerns about the COVID-19
- Responding to changes in social structure, such as digitization

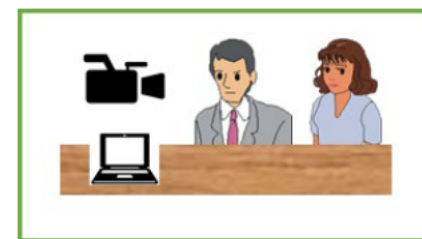
Parties can be involved in oral proceedings through web conference systems, etc. (on or after October 1, 2021)

[Example of oral proceedings using a web conference system]



Demandants to appear remotely
(demandant's corporate
conference room, etc.)

*All demandants can appear remotely



Demandees to appear remotely
(demandee's corporate
conference room, etc.)

*All demandees can appear remotely



Abolition of Obtaining Consent of Non-exclusive Licensees for Corrections, abandonment of Patent Rights, etc.



Consent of non-exclusive licensees will be no longer required for **corrections, abandonment of patent rights, etc.***, on or after April 1, 2022.



	Consent of non-exclusive licensees	Consent of exclusive licensees and pledgees
Corrections, abandonment of patent rights, etc.*	Required -> No longer required	Required
Abandonment of trademark rights	Required	Required

*** Corrections, abandonment of patent rights, etc. means:**

- Requests for correction trials
- Requests for correction during proceedings in patent invalidation trials or oppositions to granting of patent.
- Corrections of utility model rights
- Abandonment of patent rights, utility model rights and design rights

■ Roles of Trials and Appeals, and Handling of
Procedures Affected by COVID-19

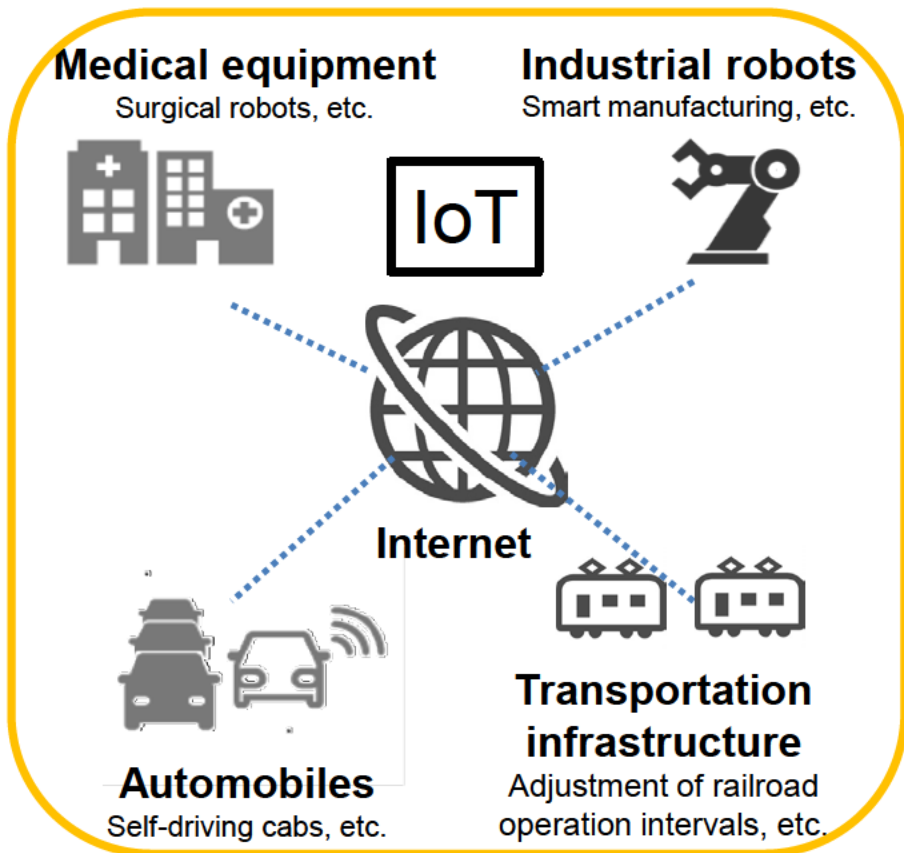
■ **Globalization of IP Disputes**

■ Initiatives in the International Field

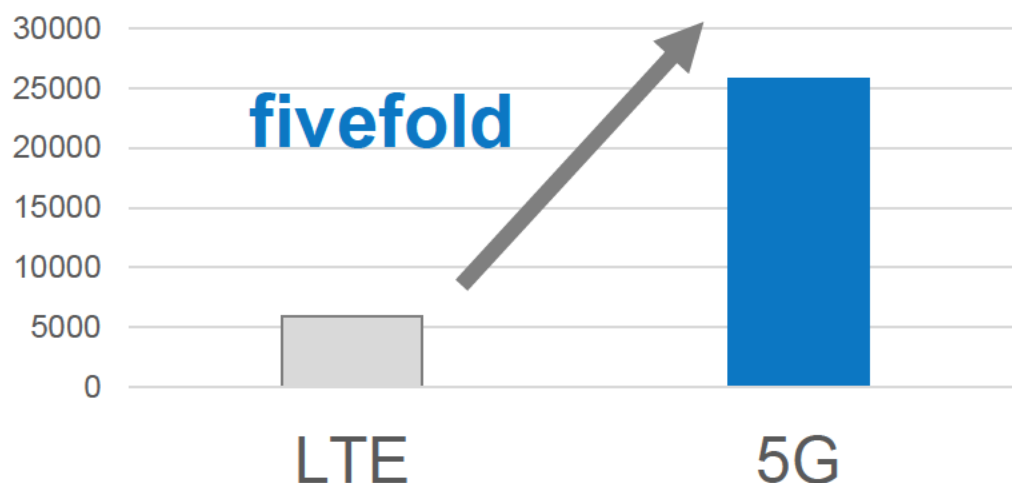
■ Inventive Step of AI and IoT Related
Inventions in Japan

Rapidly Penetrating IoT and Increasing Number of SEPs

- Automobiles, industrial equipment, transportation infrastructure, electric power infrastructure, buildings and residences are connected with the penetration of the Internet of Things (IoT).
- The number of Standard Essential Patents (SEPs) related to IoT has also increased significantly.



Number of SEPs declared to European Telecommunications Standards Institute (ETSI) (per patent family)*



(Source) Prepared by the JPO based on "Evaluation of LTE essential patents declared to ETSI Version 3.0," "5G Ni Shisuru Tokkyo-syutsugan Kisho-teian Ni Kansuru Chosa-hokokusho (Version 2) (Excerpts)," Cyber Creative Institute Co. Ltd.

Note: Based on the ETSI SEP declaration list as of November 2012 for LTE, and as of November 2019 for 5G. The number of patents declared to be essential to ETSI is recounted by Cyber Creative Institute Co. Ltd. per patent family.

(Source) Prepared by the JPO based on material 3 "Consideration of a new ADR system with a view to the fourth industrial revolution," the 20th Patent System Subcommittee of the Intellectual Property Committee under the Industrial Structure Council.

Previously

Conflicts between IT industries
(Example)

Telecom industry
vs
Telecom industry

IoT Era

Conflicts between different industries
(Example)

Telecom industry
vs
Other industries

Supplier

Resolved through cross-licensing

Possible

Difficult

Market forecast of licensing fees

Generally agreed

Extremely different

Essentiality check

It is easy for the parties to evaluate

It is difficult for licensees to evaluate

Global Disputes Over SEPs

[Major lawsuits and administrative dispositions related to SEPs]

Parts in orange:

conflicts between
different
industries



United Kingdom

- Unwired Planet v. Huawei
- Conversant Wireless Licensing v. Huawei
- TQ Delta v. Zyxel



EU

- European Commission (EC) v. Qualcomm
- Huawei v. ZTE



Germany

- **Nokia v. Daimler**
- **Sharp v. Daimler**
- Sisvel v. Haier
- Unwired Planet v. Huawei



China

- National Development and Reform Commission (NDRC) v. Qualcomm
- Iwncomm v. Sony
- Huawei v. Samsung



Japan

- Japan Fair Trade Commission (JFTC) v. Qualcomm
- Apple v. Samsung
- **Sharp v. Tesla**



Korea

- Korea Fair Trade Commission (KFTC) v. Qualcomm

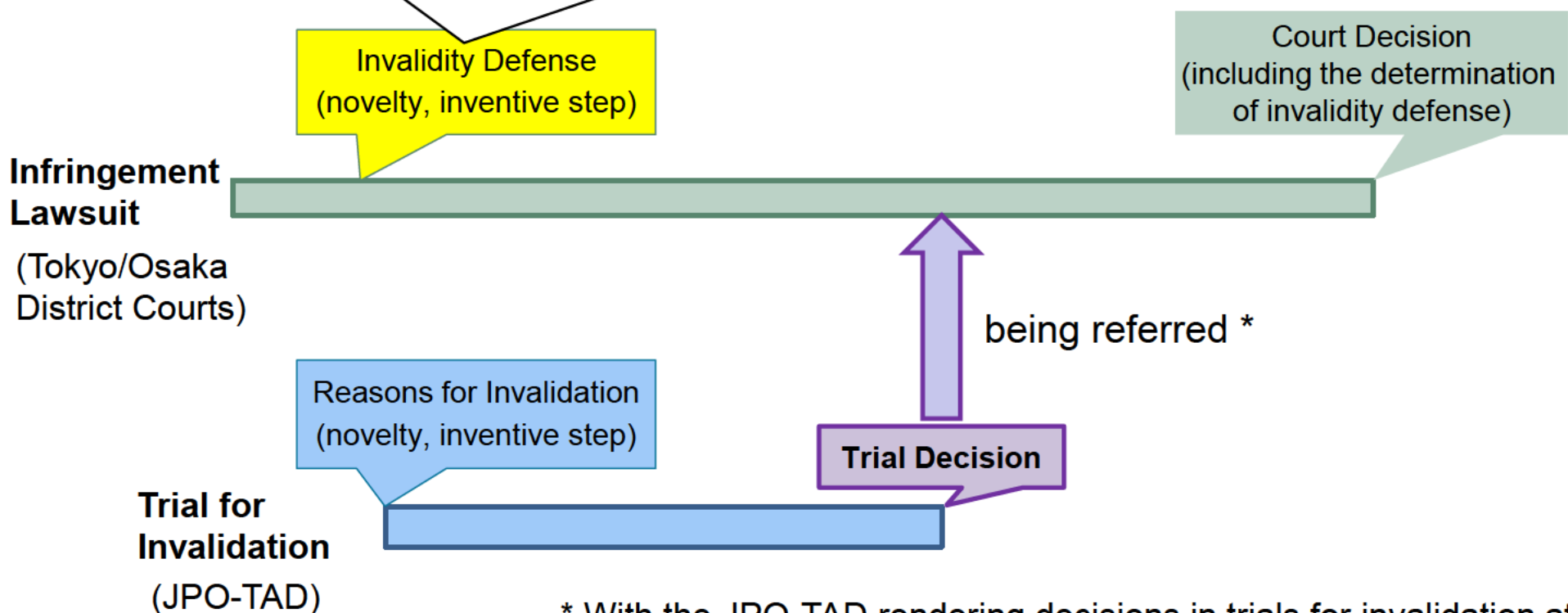
-> Related trials for invalidation are also filed and used to resolve disputes.

(Source) Prepared by the JPO based on "GUIDE TO LICENSING NEGOTIATIONS INVOLVING STANDARD ESSENTIAL PATENTS (June 5, 2018 JPO)," "Actual Situation of Dispute Resolution over Standard Essential Patents (SEPs) (2019 and 2020)," etc.

Double Track Proceedings in Infringement Lawsuit and Trial for Invalidity

Restriction on Exercise of Rights by the Patentees (Patent Act Article 104-3(1))

If litigation involving the infringement of a patent right or the violation of an exclusive license results in the finding that the patent **should be invalidated** through a trial for patent invalidation, etc., **the rights** of the patentee or exclusive licensee **may not be exercised** against the adverse party.

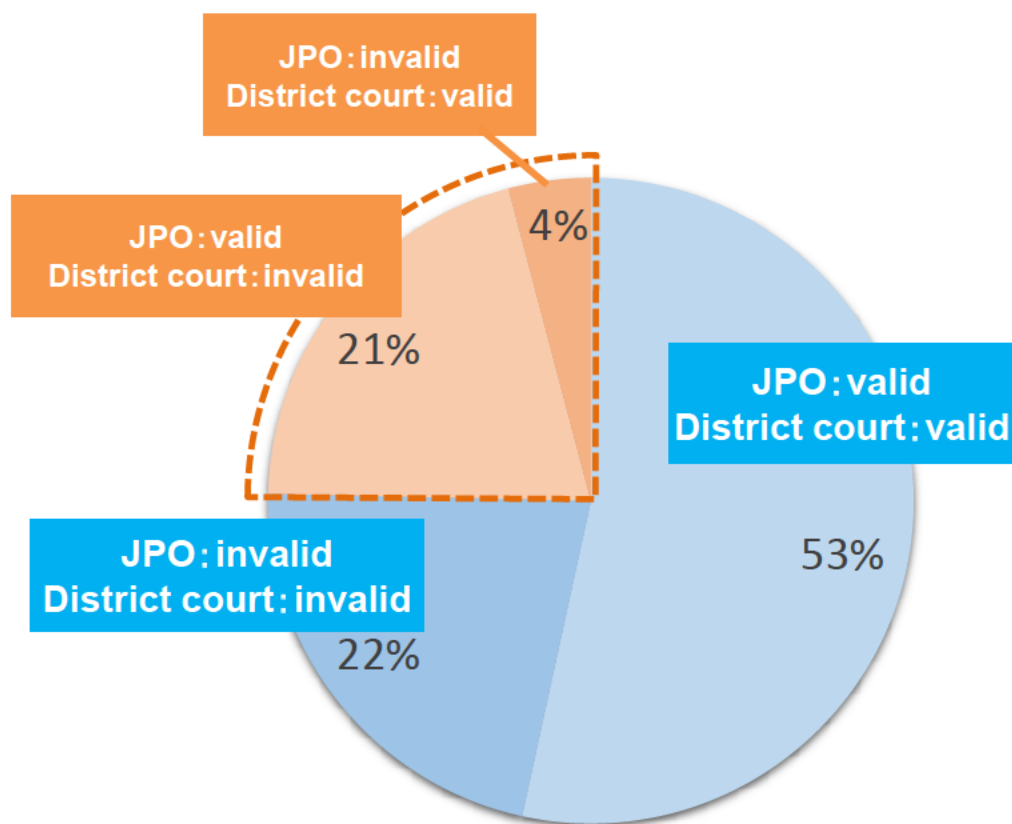


* With the JPO-TAD rendering decisions in trials for invalidation at an early stage, the court can refer to the determination made by the JPO-TAD in infringement lawsuits pending concurrently, thereby contributing to dispute resolution.

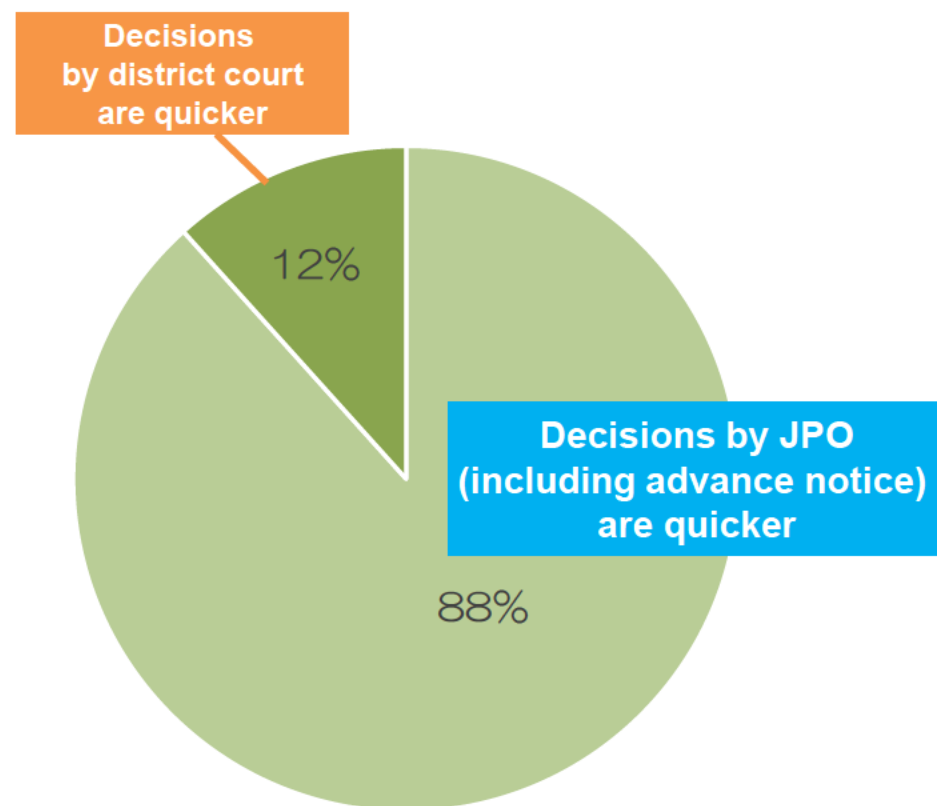
Analysis: Double Track Proceedings (2015-2020)

- ✓ Concordance rate of determinations on validity/invalidity between conclusions of JPO trial decisions (trials for invalidation) and district court decisions (infringement lawsuits): 75%
- ✓ Rate of determinations in trial decisions rendered prior to those in district court decisions: 88%

Concordance rate of determinations on validity/invalidity



Rate of determinations by JPO prior to those by district court

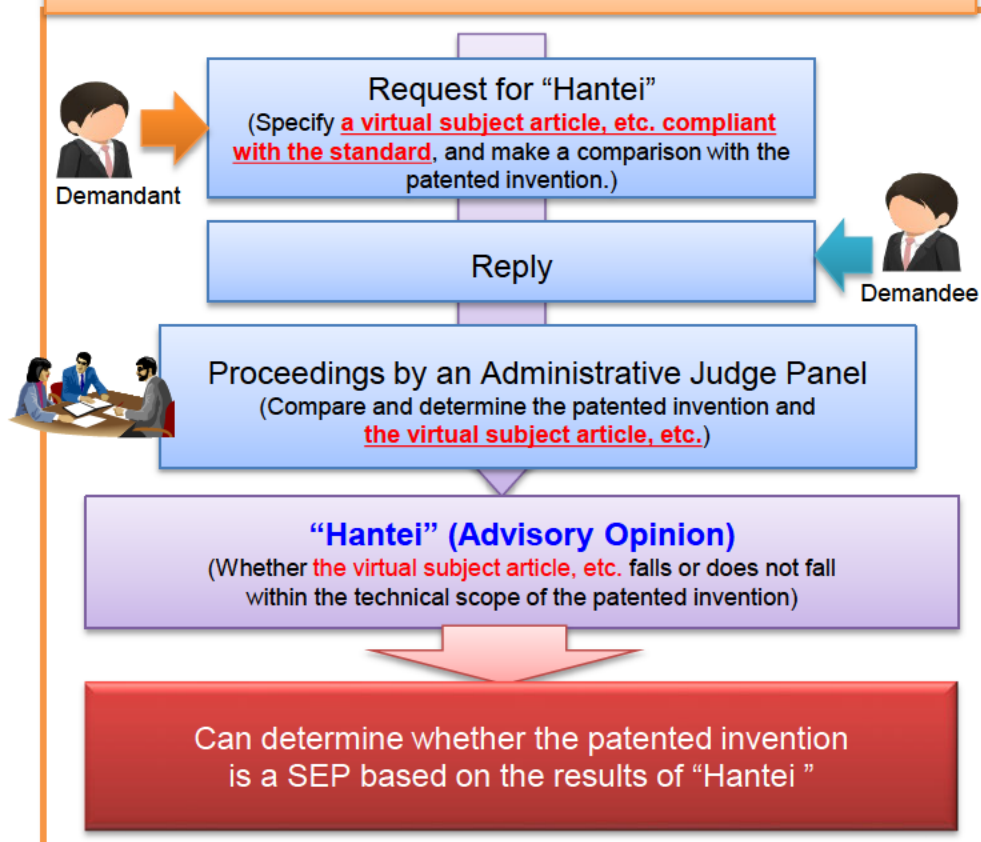


“Hantei” (Advisory Opinion) for Essentiality Checks

✓ “Hantei” can also be used for essentiality checks.

(When there is conflict of views between the parties over the standard essentiality of the patented invention in licensing negotiations, etc.)

Essentiality check utilizing the “Hantei” system



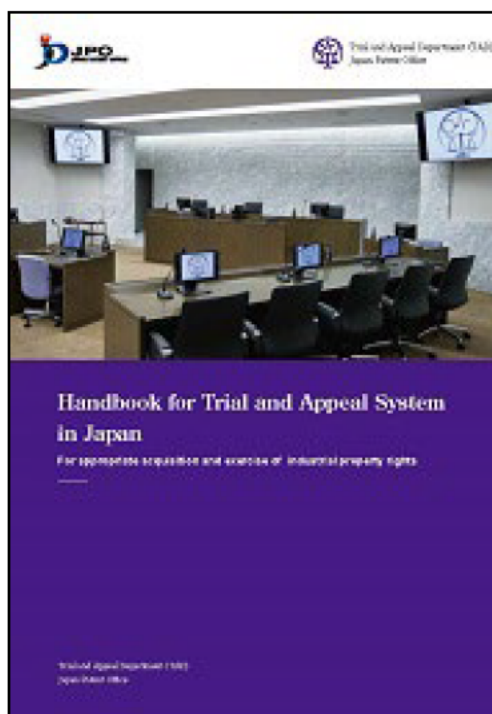
Manual of “Hantei” (Advisory Opinion) for Essentiality Check
https://www.jpo.go.jp/e/support/general/sep_portal/document/index/manual-of-hantei.pdf




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Dissemination Activities for Users: "Handbook for Trial and Appeal System in Japan"

- The "Handbook for Trial and Appeal System in Japan" is available in English.
- It explains general information regarding Japan's trial and appeal system in simple language, with a clear focus on the main points.



	1	2	3	4	5	6
Eligible person(s)	Who received a decision of refusal in the examination	Anyone can oppose.	Interested parties	Anyone can demand.	Patentee	Who needs the opinion of the JPO
When	Dissatisfaction with examiner's decision of refusal	Oppose to patent and trademark registrations	Want to invalidate the right	Want to rescind the trademark registration	Want to correct deficiencies of the patent right	Want to obtain opinions of the JPO regarding the scope of the right
Types in the system	Appeal against examiner's decision of refusal	Opposition to grant of patent/Opposition to registration of trademark	Trial for invalidation	Trial for rescission	Trial for correction	<i>Hantei</i> (Advisory opinion)
Applicable IP law	Patent Design Trademark	Patent Trademark	Patent Utility model Design Trademark	Trademark	Patent	Patent Utility model Design Trademark

 Trial and Appeal Department (TAD),
the Japan Patent Office

Click here for the full text of the handbook in Japanese
https://www.jpo.go.jp/resources/report/sonota-info/document/panhu/shinpan_gaiyo.pdf



Click here for the full text of the handbook in English
https://www.jpo.go.jp/resources/report/sonota-info/document/panhu/shinpan_gaiyo_e.pdf



Improved User Convenience: External Dissemination of Trial/Appeal Decisions in English



Dissemination of information on trial/appeal decisions, etc. in English (beginning in January 2016)

[Background]

Users have shown strong interest in trial/appeal information along with the increase in global economic activities.

[Implementation]

The JPO provides **trial/appeal information (trial/appeal decisions, opposition decisions, Hantei advisory opinion) in English** through expeditious trial/appeal proceedings.

- FY 2020 results: **100 English translations** of trial/appeal decisions and other matters **were provided**, providing helpful insight into understanding the interpretation and practices of the law at the Trial and Appeal Department (TAD).
- FY 2021 plan:
About 100 English translations are provided.

[Home](#) > [Systems/Procedures](#) > [Appeals/Trials](#) > Decisions

Decisions

The Japan Patent Office (JPO) provides professional English translations of trial/appeal decisions, decisions on oppositions, and Hantei (advisory opinions on the scope of industrial property rights) categorized by type, field, or other attributes of a case that help in the understanding of the law and its operation, for the purpose of improving and enhancing the international reach and quality of information provided on industrial property rights applicable in Japan.

List

- [English translations of decisions \(Excel:150KB\)](#)
Last updated decisions are colored with yellow in the Excel file.

Table of Contents

- [Last Updated documents \(March 2021\)](#)
- [Updated documents \(January 2021\)](#)
- [Updated documents \(November 2020\)](#)
- [Updated documents \(August 2020\)](#)
- [Updated documents \(July 2020\)](#)
- [back number](#)
- [Note](#)

Last Updated documents (March 2021)

1. Patents and Utility Models

Types	JPO Docket Numbers	Decisions (JP)	Decisions (EN)	Topics	Abstracts
Appeal	2017-011744	Japanese (PDF)	English (PDF)	Inventive Step	Concerning the invention relating to an image reading device having a global electronic shutter control, it is judged that it is a publicly-known technology to provide a lens holder and a support assembly, and it is a matter that can be appropriately achieved by a person skilled in the art to make the configuration relating to the different feature, by adopting the publicly known technology, and therefore the inventive step thereof is denied.

International Cooperation in Trials and Appeals

- IP5 Trial and Appeal Boards High-level Meeting in June 2021 (video conference hosted by the JPO).
- Regular meetings and exchange of opinions with IP Offices in various countries and regions.

IP5 Trial and Appeal Boards
High-level Meeting
in June 2021



JPO-KIPO-CNIPA Joint Experts
Group for Trial and Appeal
(JEGTA) in November 2020



- Since 2017, the JPO, the Supreme Court of Japan, the Intellectual Property High Court, the Ministry of Justice, the Japan Federation of Bar Associations, and the IP Lawyers Network Japan have co-hosted the JSIP every year, bringing together IP judicial officials/practitioners from various countries.
- FY 2017, FY 2019, FY 2021: Japan/China/Korea + ASEAN, etc.
FY 2018, FY 2020: Japan, the United States and Europe



JSIP 2019 (Areas including Japan/China/Korea + ASEAN, etc.)



Panel discussion during the JPO part of the proceedings

JSIP 2020 (Japan, the United States and Europe)

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- For inventions such as **AI-related technologies**, etc., the determination of **inventive step** is as important in the examination as for other inventions.



Examination Guidelines Part III Chapter 2 Section 2 Inventive Step

- Comprehensively assess factors in support of the non-existence and the existence of an inventive step.

Factors in support of the non-existence of an inventive step

1. Motivation for applying secondary prior art to primary prior art
 - (1) Relation of technical fields
 - (2) Similarity of problems to be solved
 - (3) Similarity of operations or functions
 - (4) Suggestions shown in the content of prior art
2. Design variation of primary prior art
3. Mere aggregation of prior art

Factors in support of the existence of an inventive step

1. Advantageous effects
2. Obstructive factors
Example: It is contrary to the purpose of the primary prior art to apply the secondary prior art to the primary prior art.

Specific example in the trial decision

Inventive step was denied for the invention that **merely states that "machine learning is used"** to adjust various parameters of machining conditions that have conventionally been done by humans, but **does not specify the details of the machine learning**.

Excerpts from the trial decision



"...It can be said that there is a motivation to have the machine adjust the machining conditions based on the machining accuracy and machining time of the cited invention, because having the machine perform the learning that used to be performed by humans and adjustments that used to be made based on empirical rules will lead to labor savings and improved production efficiency.

As mentioned above, since there is a motivation in having a machine perform the learning of the cited invention, and since the types of input and output parameters handled by the machine have been used in the past, **there is no inventive step in performing machine learning to handle these parameters, i.e., in having artificial intelligence simply do what people have conventionally done by trial and error.**" (Appeal No. 2018-4652)



If there are advantageous effects, obstructive factors, etc., the existence of an inventive step is likely to be supported.

**Thank you very much
for your attention.**