Recent Trends in Trial and Appeal Measures in Japan

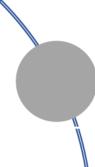
October 19, 2023

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Recent Topics at the Trial and Appeal Boards



Statistical Trend in the Trial and Appeal



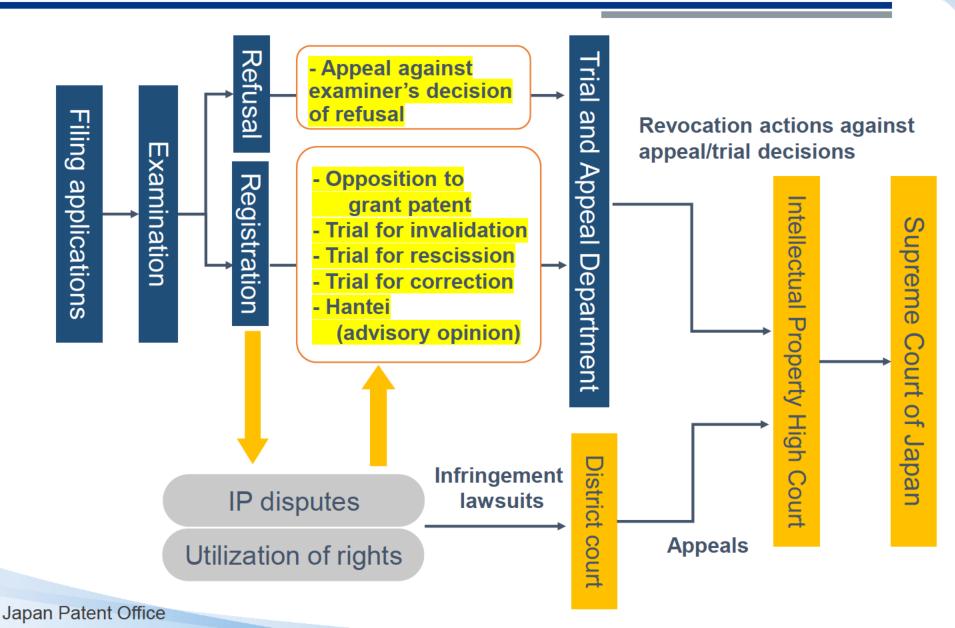
Promotion of Online Procedures and Digitization



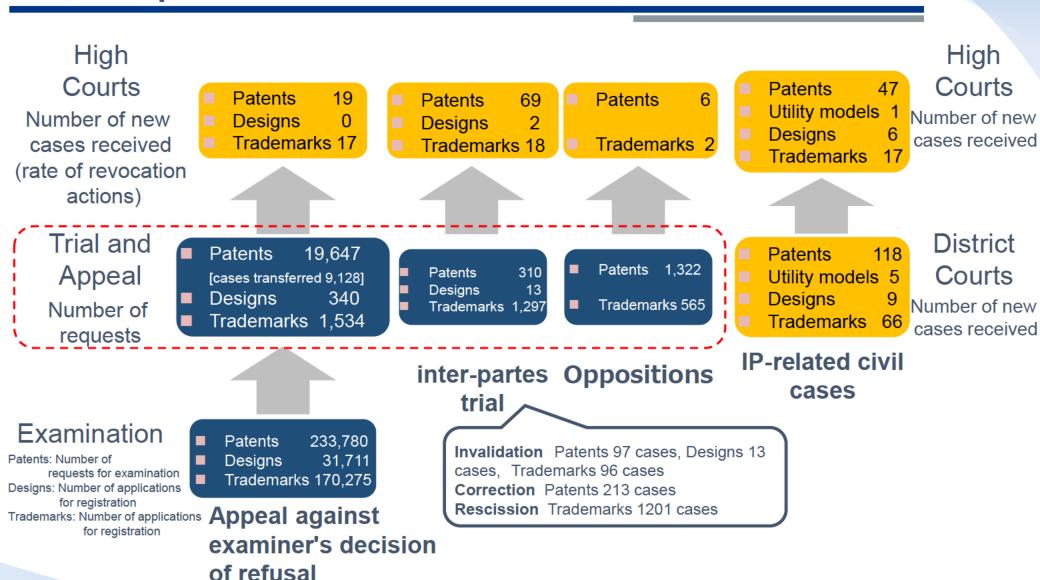
Operational Improvement, Information Sharing and International Cooperation



Roles and Procedures of Trial and Appeal - Trial and Appeal Procedures

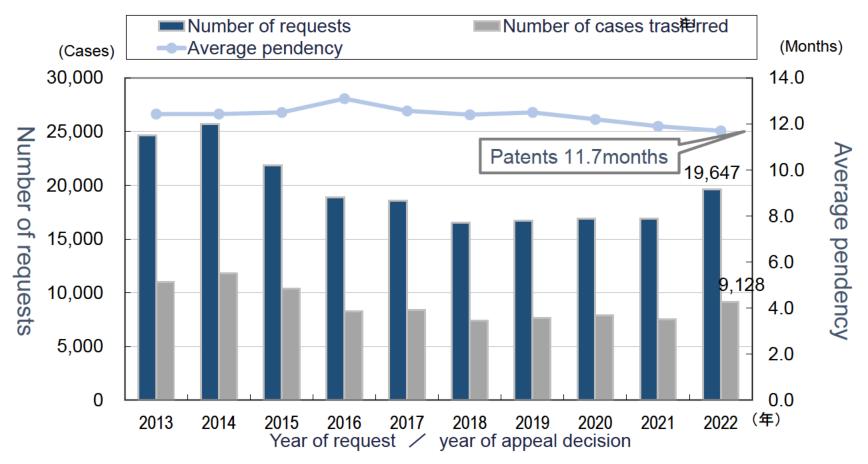


Comparison of number of cases



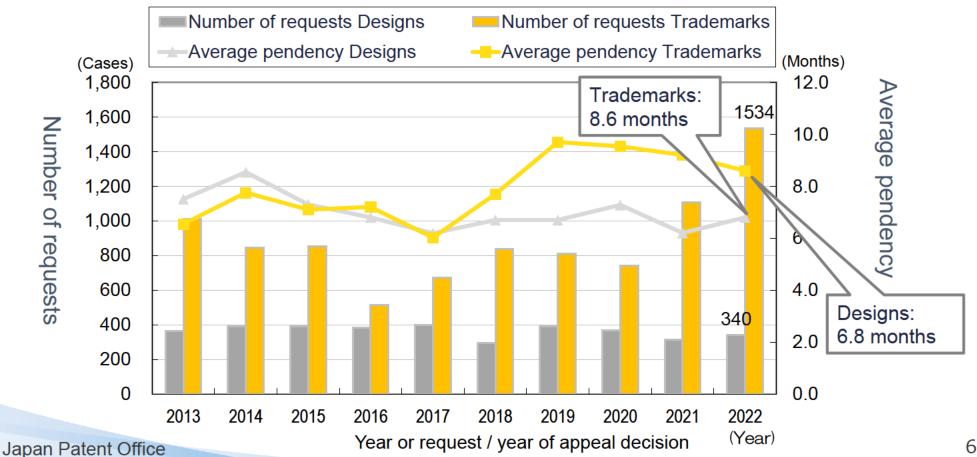
Appeal Against Examiner's Decision of Refusal (Patents)

- The number of requests for patents has remained generally unchanged, with approximately 20,000 cases in recent years.
- The average pendency for patents was 11.7 months in 2022.



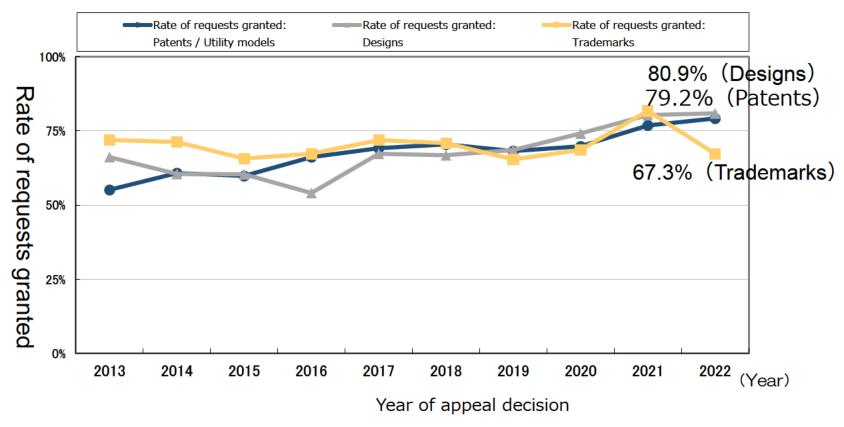
Appeal Against Examiner's Decision of Refusal (Designs/Trademarks)

- The average number of requests for designs is approximately 360.
- The number of requests for trademarks has been increasing in recent years, with approximately 1,500 in 2022.
- The average pendency in 2021 was 68 months for designs and 8.6 months for trademarks.



Appeal Against Examiner's Decision of Refusal - Rate of Requests Granted

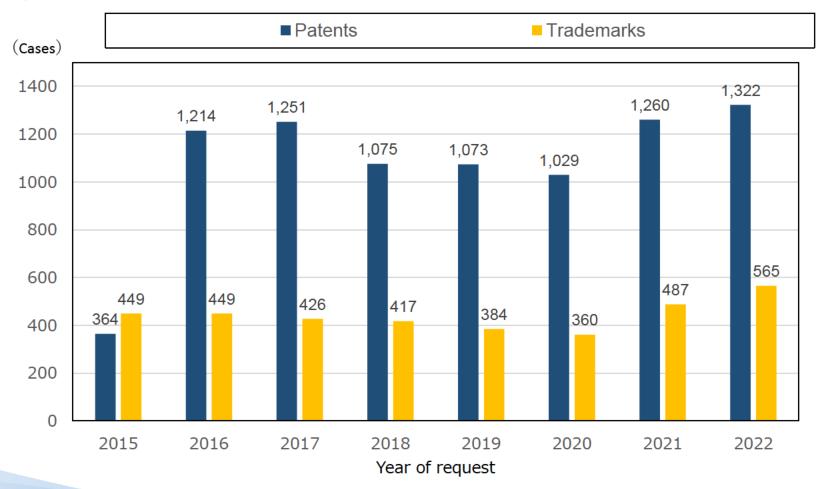
- The rate of requests granted for patents (the percentage of examiner's decisions of refusal that are reversed) has been gradually increasing in recent years and reached 79.2% in 2022.
- The rate of requests granted for trademarks has fluctuated but reached 67.3% in 2022.



Note: Rate of Requests Granted (%) = Number of requests granted / (number of decisions + number of dismissals) ("Rate of requests granted for patents" does not include the number of "decision to grant patents upon reconsideration by examiners before appeal proceedings".)

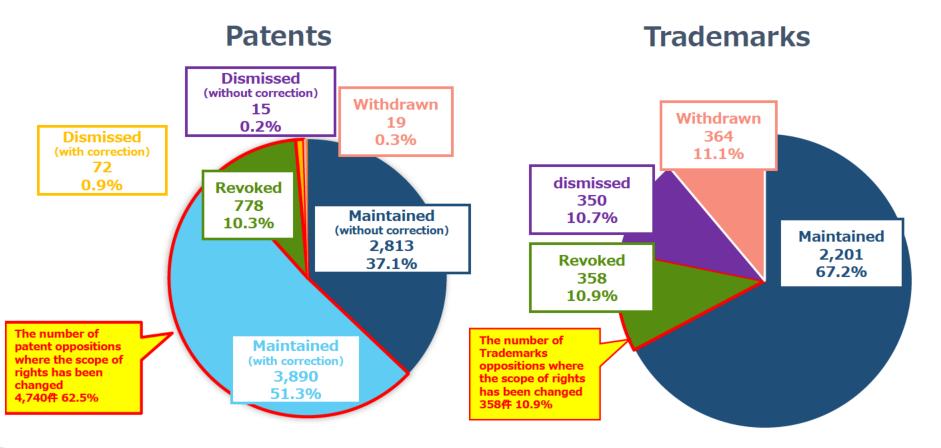
Opposition to Grant of Patent

- The number of oppositions to grant of patent has been hovering around 1,000.
- The number of oppositions to registration of trademark has increased in recent years.



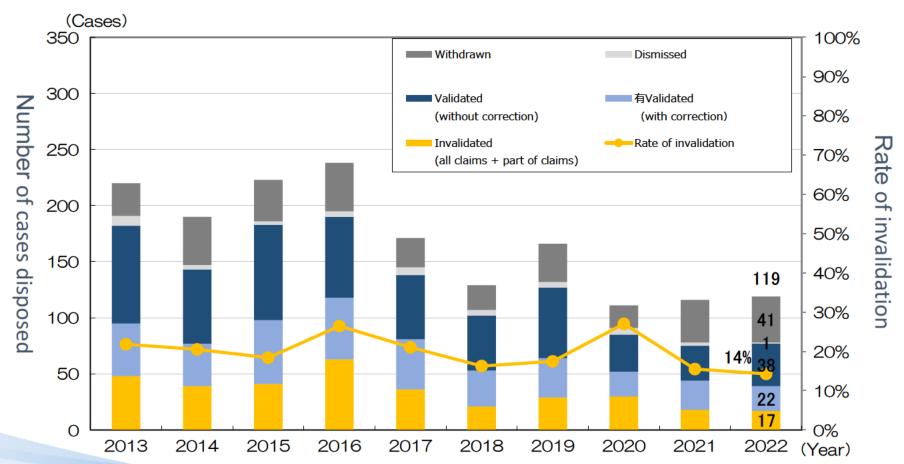
Oppositions – Results of Proceedings in Japan

- Among the cases with final dispositions from April 2015 to December 2022, 62.5% resulted in changes to the scope of rights due to opposition.
- 10.9% of Trademarks have been revoked.



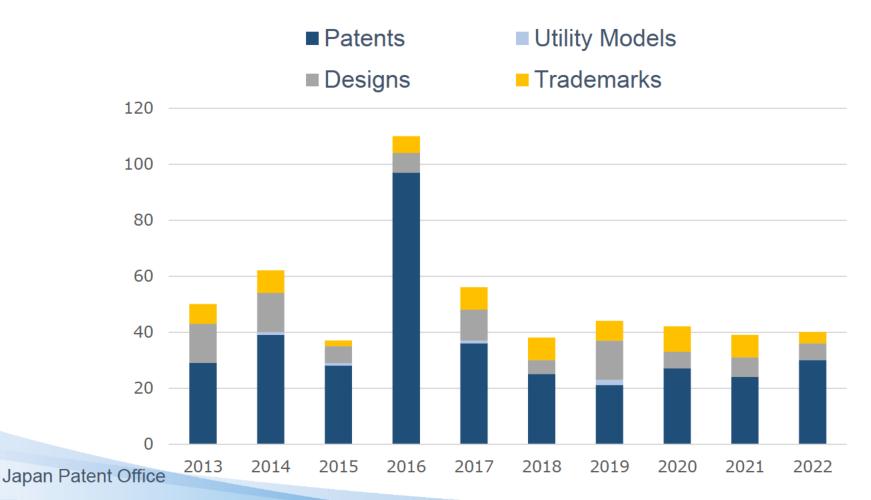
Trial for Invalidation – Results of Proceedings

- The rate of trial decisions to invalidate (requests granted) for patents / utility models has been decreasing since 2011 and has remained generally unchanged in recent years.
- In 2022, the rate of trial decisions to maintain without correction was 32% and the rate of trial decisions to invalidate was 14%.



Trends in Requests for Hantei (Advisory Opinion)

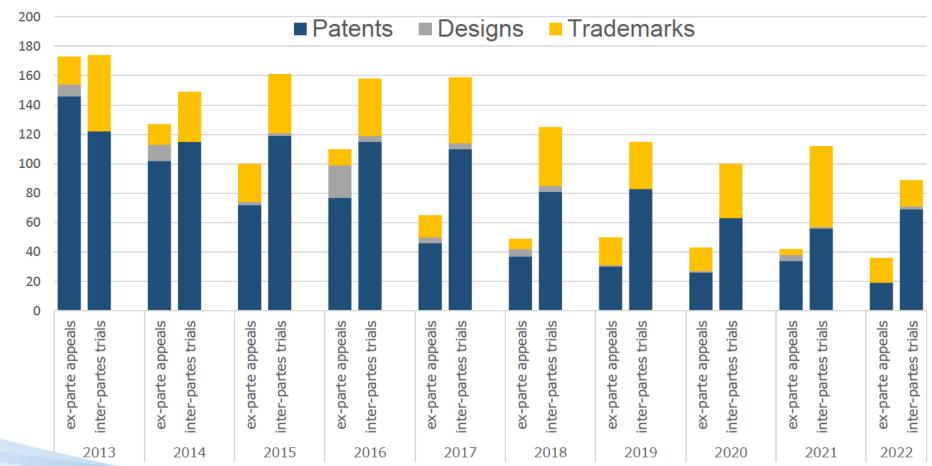
- The number of requests for Hantei (advisory opinion) for patents have remained at around 30 in recent years.
- Similarly, the number of requests for Hantei for designs and trademarks has remained around 10 or less.



Trends in Revocation Actions against Trial/Appeal Decisions (Patents + Designs + Trademarks)

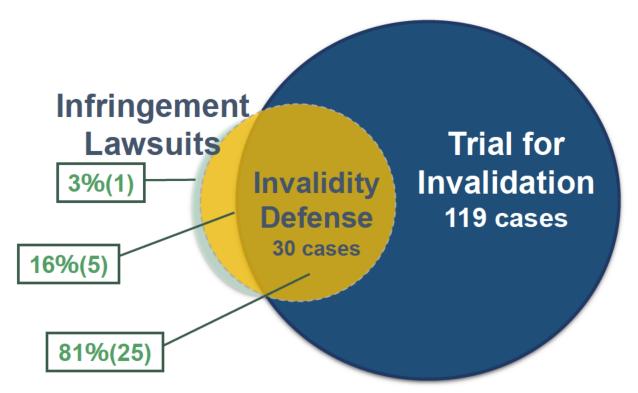
■ The number of revocation actions in 2022 (124) significantly decreased to about one third of the total number of revocation actions in 2013 (347).

(the number of revocation actions)



Infringement Lawsuits and Trials for Invalidation

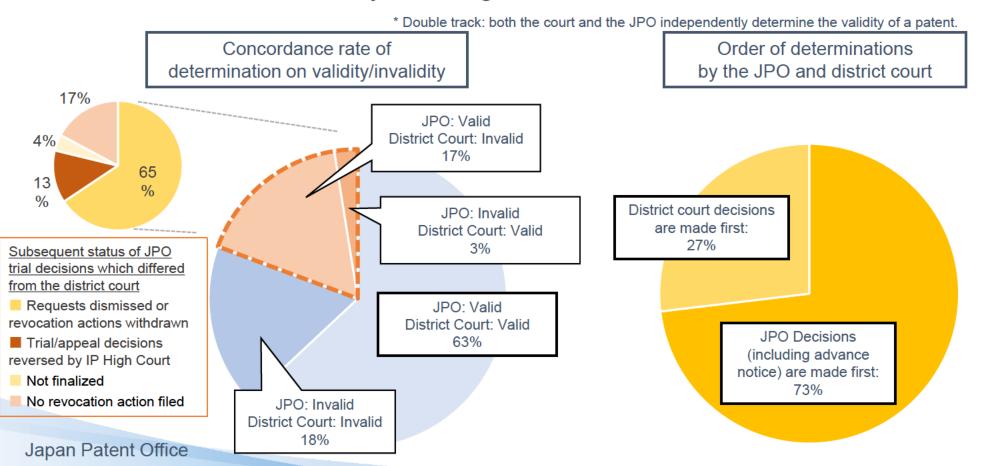
■ In patent infringement lawsuits with a court decisions in 2022, 81% of the cases involved both invalidity defense and trials for invalidation, 16% involved only invalidation defense, and 3% involved no invalidation defense.



Note: Aggregated for patent infringement lawsuits with court decisions rendered in 2022.

Trial and Appeal Statistics Analysis: Double Track* Proceedings in Japan (2016-2020) (patents)

- Concordance rate of determinations on validity/invalidity between conclusions of JPO trial decisions (trials for invalidation) and district court decisions (infringement lawsuits invalidity defense): 81%
- Among the cases where trial decisions and district court decisions differed, the rate of trial decisions reversed by the IP High Court is 13%.



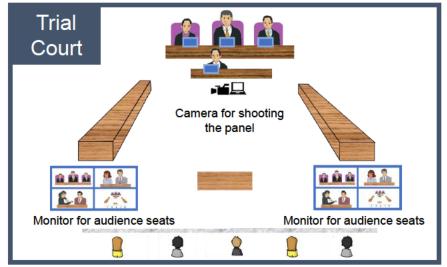


Online Oral Proceedings (1)

- The Patent Act, and other acts were amended to allow oral proceedings to be conducted without being affected by COVID-19 infection, and to allow parties, etc. residing in a remote area to participate in oral proceedings without having to appear before the trial court (effective October 2021).
- Parties, etc. can now participate in oral proceedings using a web conference system (online oral proceedings). Chief administrative judge may also allow video transmission (online distribution) to the parties and other interested parties, subject to the consent of all parties and other interested parties.



Demandants: remote participation (demandant's corporate meeting room).

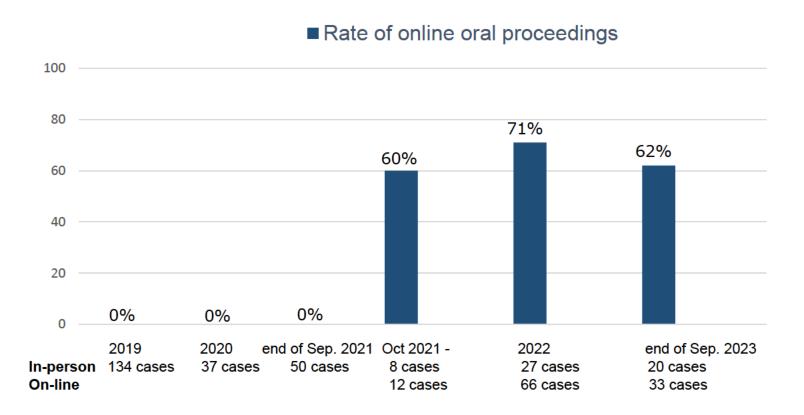




Demandees: remote participation (demandee's corporate meeting room).

Online Oral Proceedings (2)

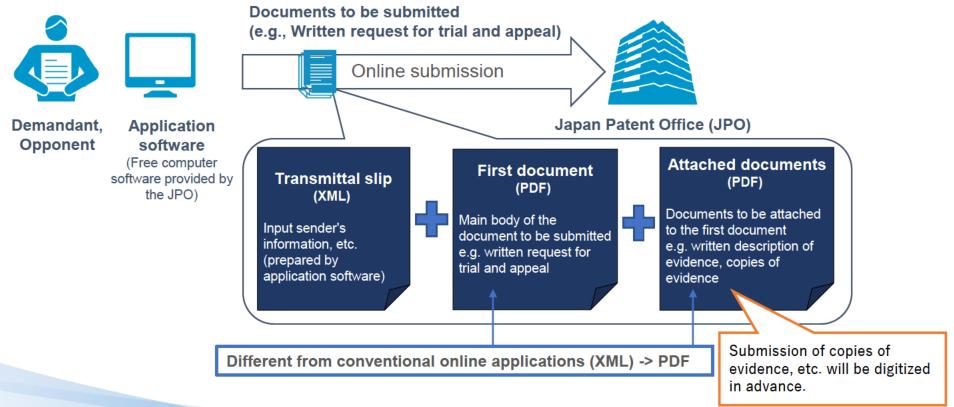
✓ The overall number of oral proceedings during the period from the start of operation in October 2021 to the end of September 2023 was 167, of which 115 were conducted online (67% of the total).



Note: 2019 includes patents and utility models (21) in circuit trial examination.

Digitization of Application Procedures (1)

- Some documents in trial and appeal cases cannot currently be submitted to the JPO online (e.g., submission of documents in trials for invalidation and oppositions).
- It is expected that the submission can be made in the form of a transmittal slip and PDF by the end of FY2023 (Paper submissions will continue).



Efforts towards One JPO

- ✓ In May 2023, the Trial and Appeal Departments, which had been dispersed, was consolidated into the JPO Headquarters. (Designs, trademarks, and some administrative work will be relocated by the middle of FY2025)
- ✓ JPO promotes telework, non-territorial and paperless office.





Revision of the Manual for Trial and Appeal Proceedings on the Principle of Prohibition of Double Jeopardy (2023)

- At the 47th and 49th meetings of the Patent System Subcommittee, the subcommittee discussed the "review of the concept of the principle of double jeopardy" and decided to further disseminate the current operation of the system.
- The Manual for Trial and Appeal Proceedings was revised to add recent judicial decisions in order to disseminate judicial decisions and the operation of trials and appeals concerning the principle of prohibition of double jeopardy (March 13, 2023).

Principle of Prohibition of Double Jeopardy

- When a trial decision on a trial for invalidation, etc. becomes final and binding, neither parties nor intervenors may file a request for such trial based on the same facts and the same evidence (prevention of a reopening of trial proceedings).
- If the facts or evidence are substantially different, a second or subsequent request for a trial for invalidation, etc. can be filed.
- Subject trials:
- (1) trials for invalidation, (2) trials for patent invalidation concerning the registration of a patent term extension, and (3) trials for invalidation of trademark registration.

When considering a request for a second or subsequent trial for invalidation, etc., care should be taken not to bring up the same allegation again by making a request that would be subject to the principle of prohibition of double jeopardy or an argument that would violate a rule of credibility.

Revision of the Manual for Trial and Appeal Proceedings

- ✓ The purpose of the Manual for Trial and Appeal Proceedings is to ensure a uniform understanding within the Trial and Appeal Department of the purport of enactment of laws and regulations, interpretation of laws and regulations as shown in court decisions and trial/appeal decisions; and fair and accurate trial/appeal decisions, etc.
- ✓ In light of the revisions to the law since the 19th edition of the manual, including the commencement of online oral proceedings, the JPO have issued an invitation for public comments to revise the manual.
- √ Major Revisions
 - 1. Description of electronic special application to be started in January 2024.
 - 2. Reorganization of the grounds for disqualification of administrative judges.
 - 3. Addition of a section on online oral proceedings.
 - 4. Clarification of operation regarding trials for invalidation.
- 5. Clarification of the operation of Hantei (advisory opinion) and commissioning of the provision of expert opinions from courts.
 - 6. Clarification of the operation of patent oppositions, etc.
- ✓ Solicitation Period October 11 to November 13, 2023



Trial and Appeal Practitioner Study group

- Established in FY2006.
- To share the understanding of trial/appeal practice with users of the trial/appeal system by analyzing actual trial/appeal decisions and court decisions, improving future trial/appeal proceedings based on the analysis results, and widely disseminating the results of the analysis.
- Other than IP experts, patent attorneys, attorneys, and the JPO's administrative judges, judges of the IP High Court and the Tokyo District Court have also participated in the Study Group as observers.
- In FY2023, the Study Group will study a total of 6 cases: 4 patent cases, design case and trademark case.
- A report summarizing the results of the study (in Japanese and English) is prepared and published on the JPO website.

Some of the topics and points at issues in the field of patents (FY2021)

(Field: Patent - Machinery)

- Support requirements for numerically limited inventions:
- (1) How to determine support requirements for invention by numerical limitation.
- (2) How many or to what extent examples are required in the description.

(Field: Patent - Chemistry)

- How should the clarity requirement of matters specifying the invention that are not unambiguously obvious from the claims alone be determined?
- Inherent characteristics in the determination of novelty

(Field: Patent - Electricity)

- Regarding the determination of inventive step when the differences are matters related to business methods, game rules or arrangements.

International Cooperation

- Regular meetings and exchanges of opinions with IP Offices and other organizations in each country/region:
- JPO-CNIPA-KIPO Joint Experts Group for Trial and Appeal (planned for December).
- Japan-Korea Trial and Appeal Expert Meeting: Exchange of opinions on Japan/Korea trial and appeal system (September 2023).
- Indo-Pacific Judicial Colloquium on Intellectual Property, Innovation, and Technology: Judicial officials from the Indo-Pacific region meet to discuss IP, innovation and technology (July 2023).





the Indo-Pacific Judicial Colloquium
(July 2023)

JPO-KIPO Trial and Appeal Experts Meeting (September 2023) 24

Judicial Symposium on Intellectual Property / TOKYO

- "Judicial Symposium on Intellectual Property / TOKYO (JSIP)" has been cohosted annually since 2017 by the JPO, the Supreme Court of Japan, the IP High Court, the Ministry of Justice (MOJ), the Japan Federation of Bar Associations (JFBA) and the Intellectual Property Lawyers Network Japan (IPLNET), inviting IP practitioners.
- 2017, 2019, 2021: China, Korea, ASEAN and Japan 2018, 2020, 2022: Europe, United States and Japan



Intellectual Property / TOKYO 2022



Intellectual Property / TOKYO 2021

Thank You

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