

2. Trials for Invalidation

<<Eligibility and prescribed period for requesting an invalidation trial>>

Q1: When can a request for a trial for invalidation be filed, and who is eligible for doing so?

A1: In the case of requesting an invalidation trial on the grounds of public interest (lack of novelty, lack of inventive steps, etc.) other than on grounds related to attribution of rights (violation of requirements for joint applications and usurped applications), eligible demandants should be limited to interested persons. In cases where the demandant is an industry body, etc., without the status of a legal entity, if the industry body corresponds to an association or foundation for which a representative or an administrator has been designated, then the demandant is recognized to be able to request a trial for patent invalidation.

With regard to the period for filing the request, the demandant may request a trial for invalidation even after the lapse of a patent right, as long as the request is after the registration of establishment.

Q2: When a request for a trial for invalidation is filed on grounds related to the attribution of rights such as a usurped application (Patent Act Article 123, Paragraph 1 (vi)), etc., only persons who have the right to obtain a patent shall be eligible to file such request (the proviso of Patent Act Article 123, Paragraph 2). Here, what is the scope of the persons indicated by “persons who have the right to obtain a patent”?

A2: Persons who have the right to obtain a patent are those who are entitled to obtain a patent, including true joint owners of the right to obtain a patent, or those to whom the right to obtain a patent has been assigned by the true inventor. Even if the person is the true inventor, those who have already fully assigned the right to obtain a patent to another party are not included in the above.

<<Intervention>>

Q3: Is an intervenor required to be an interested person when intervening in a trial for invalidation as stipulated in the Patent Act Article 148, Paragraph 1? Is the same true in the case of intervention in a trial for invalidation as stipulated in Paragraph 3 of the same Article (so-called “assisting intervention”)?

A3: The provisions of the Patent Act Article 148, Paragraph 1 stipulate that a person intervenes in a trial for invalidation as a demandant. As such, the same requirements as those for a demandant will be imposed on the intervenor, and, with the exception of cases where a trial for invalidation is requested on the grounds of invalidation related to attribution of rights (the proviso of Patent Act §123 (2)), only an interested person may intervene in the trial.

On the other hand, since the provisions of Paragraph 3 of the same Article include cases of intervening to assist the demandee (i.e., the patentee) side as well, an intervenor is required to have an interest in the result of the trial (example: in the case of a request for an invalidation trial for a patent right, for example, a person who has a license for the patent can intervene).

Q4: What sort of verification is required for “a person with an interest,” which is a requirement for assisting intervention as stipulated in the Patent Act Article 148, Paragraph 3?

A4: Since assisting intervention as stipulated in Patent Act Article 148, Paragraph 3 is normally assumed to be cases of intervening to assist the demandee side, verification of interest requires verifying that the person is “a licensee or a person in a license agreement.”

<<Eligibility to file a lawsuit seeking revocation of a trial decision>>

Q5: In the case of a trial for invalidation requested by the end of March 2015, if a non-interested person requests a trial for invalidation but the trial decision validates the patent, can the demandant who requested the trial for invalidation institute an action with the Intellectual Property High Court to seek rescindment of the trial decision, due to the expected “benefit of suit”?

A5: The person may institute the action (Patent Act §178 (2)).

<<Waiver of rights and trials for invalidation>>

Q6: When a patent claim for which an invalidation trial is pending is waived (Patent Act §97 (1)), will the claim no longer be subject to proceedings?

A6: Since a request for a trial for invalidation may be filed even after the lapse of the rights concerning the claim (designated goods/services) in question (Patent Act §123 (3)), the claim related to the waiver will be subject to proceedings.

<<Participation in a prior instance>>

Q7: In a case where the administrative judge (trial examiner) in a trial for invalidation is the same person who participated in the procedures of an appeal against the examiner’s decision as the examiner concerned, does this not count as participation in a prior instance?

A7: Patent Act Article 139, Item (vi) stipulates that an examiner will be excluded from duties in the case “where the trial examiner was involved in the procedures relating to the examiner’s decision who is being appealed in the case as the examiner”.

In a pre-grant opposition, an examiner who has made a decision for public notice or made a decision to grant a patent is automatically excluded from being appointed as an administrative judge in a trial for a invalidation case (Chapter 12-04 3. (1) (i) of the Manual for Trial and Appeal Proceedings).

In addition, a post-grant opposition (abolished in 2003) and a trial for patent invalidation are not in the relationship between higher court and lower, being considered to be separate cases. This also applies to the relationship between an opposition to a patent (in force from 2015) and a trial for patent invalidation. As such, participation in such cases does not count as participation in a prior instance (Chapter 12-04 5. (2) of the Manual for Appeal and Trial Proceedings).

<<Joint conduct of proceedings>>

Q8: When requests for multiple trials for invalidation have been filed with respect to the same right, (1) will the proceedings be conducted together through jointly conducted proceedings? In addition, (2) when trial proceedings are conducted separately, not jointly, and a request for correction is filed for only one out of multiple trials for invalidation, how will the other trials for invalidation be handled?

A8:

- (1) Even if multiple trials for invalidation have been separately requested, if the parties concerned in each of such requests are mutually related, the use of jointly conducted proceedings would enable the reduction of overlap in proceedings and more efficient trial proceedings, and also would prevent contradictions/conflicts among trial decisions. For these reasons, proceedings will be jointly conducted if the requirements for doing so are met.
- (2) If the requirements for jointly conducted proceedings in trials for invalidation are not met, it will not be possible to jointly conduct the proceedings. For that reason, administrative judges may wait for the results of trials for invalidation for which a request for correction has been filed, with proceedings for other trials for invalidation suspended (Patent Act §168 (1)). If a decision to invalidate a patent is issued in a trial for invalidation for which a request for corrections has been filed, the benefit of suit will be lost for the other trials for invalidation and a decision of dismissal will be made.

<<Co-pending of trials for invalidation and trials for correction>>

Q9: When a request for a trial for invalidation is filed while a trial for correction is pending, or when the date of a request for a trial for correction is the same as the date of a request for a trial for invalidation, which request for trial will be given priority?

A9: When a trial for invalidation and a trial for correction are requested on the same day, the trial for invalidation is normally given priority in proceedings. When a trial for invalidation is pending, it is generally considered appropriate to give priority to proceedings for the trial for invalidation, as long as there are no special reasons not to, due to the following reasons: a) it is possible to file a request for corrections in a trial for invalidation proceedings, taking into account all circumstances up to that time, and the proceedings of the requested corrections would satisfy the intent of the demandee (i.e., patentee); and b) in a trial for invalidation where two parties are in conflict, the demandant may state objections to the requested corrections, contributing to more accurate proceedings (Chapter 51-22 of the Manual for Appeal and Trial Proceedings).

Q10: When a trial for correction and a trial for invalidation are co-pending, if proceedings for the trial for correction are given priority and a decision to approve the correction becomes finalized first, is it possible for the demandant of the trial for invalidation to learn of the decision on the requested correction?

A10: When a correction is approved in a trial for correction and a decision is rendered ahead of a trial for invalidation, a Notice of Appeal Decision Concerning Approving Corrections will be sent to the demandant of the trial for invalidation. Thus, the demandant of the trial

for invalidation can learn of the decision on the requested correction. Moreover, after receiving this Notice, the demandant of the trial for invalidation may submit a Written Opinion on the modified patent (Chapter 51-22 of the Manual for Appeal and Trial Proceedings).

<<Addition of evidence of grounds for invalidation (amendment to change the gist of a request for a trial for invalidation)>>

Q11: In a trial for invalidation, is it possible to add evidence to the grounds for invalidation at a later date?

A11: As the addition of evidence of grounds for invalidation essentially changes “the facts on which the invalidation of the patent is based” (i.e., the principal facts), this in principle corresponds to an amendment to change the gist of the grounds for the request, and thus is not allowed. However, as stipulated in the proviso of Paragraph 1 of Patent Act Article 131-2 and in Paragraph 2, when it is clear that there is no possibility of unreasonable delay of the proceedings by such amendment and circumstances exist that apply to the items of Paragraph 2 of the same Article, such amendment may be allowed as an exception at the discretion of the chief administrative judge, even when this corresponds to an amendment to change the gist of the grounds for the request (Chapter 51-15 3. of the Manual for Trial and Appeal Proceedings).

<<Unit of filing a request for a correction>>

Q12: If a trial for invalidation is requested per claim, a request for a correction must also be filed per claim. However, when a trial of invalidation is requested for all claims, does a request for correction still have to be filed per claim?

A12: A decision in a trial for invalidation is an administrative disposition that is divisible by claim and is finalized by claim. As such, it is normally considered that a request is filed per claim (with the same being true when a trial for invalidation is requested with respect to all claims). Therefore, a request for a correction must also be normally filed per claim.

<<Proceedings for a violation of the requirements for a correction>>

Q13: When there has been a violation of the requirements for a correction within a request for a correction, a corrected description, etc. in a trial for invalidation, a notice of reasons for refusal of the corrections is sent to the demandee with regard to the violation that was discovered in the ex officio proceedings. Given this, why is a notice of reasons for refusal of the corrections not sent to the demandee with regard to the violation that was stated by the person who requested the trial?

A13: In a request for a correction in a trial for invalidation, it is considered appropriate that proceedings for the requirement for a correction be left to allegation or defense by the party concerned. As such, if there is an assertion concerning the requirement for correction from the person who requested the trial, normally the opinion of the other party concerned is sought through a directive to submit a re-written answer, through oral proceedings, etc.

<<Request for a correction with regard to product-by-process claims>>

Q14: With regard to product-by-process claims (i.e., claims concerning inventions of products reciting manufacturing processes of the products), in response to the judgments by the Supreme Court in June 2015, the JPO posted “Interim Handling Procedures for Examinations and Appeals/Trials involving Product-by-process Claims” on its website on July 6, 2015.

According to this, “After a final notice of reasons for refusal is issued, when making an amendment to a claim where the manufacturing process of a product is recited together with the product itself, if an applicant wishes to change it into simply reciting the product in terms of structure or characteristics, or, into simply reciting the manufacturing process of the product, at the time of requesting an appeal against an examiner’s decision of refusal, or after receiving a notice as per the Patent Act Article 50-2, such amendments shall be normally recognized as an amendment that corresponds to a clarification of an ambiguous statement (Patent Act 17-2, Paragraph 5 (iv)).”

In a trial for invalidation, when requesting a correction to specify the invention only by the structure or characteristics of a product, or a correction to change the reciting of the claim into that of the manufacturing process of the product alone, does this correspond to clarification of an ambiguous statement in the same manner as in the handling of examinations?

A14: With regard to the “clarification of an ambiguous statement” stipulated in Patent Act Article 134-2, Paragraph 1, proviso (iii) in a request for correction in a trial for invalidation, the requirement of “limited to the matters stated in the reasons for refusal in the Notice of Reasons for Refusal” that is taken into account when applying Patent Act Article 17-2, Paragraph 5 (iv) to amendments does not apply here. Therefore, when the manufacturing process of a product is recited in a claim concerning an invention of the product, a correction that specifies the invention by the structure or characteristics of the product, or a correction that is made to the manufacturing process of the product is recognized as a correction made for the purpose of clarifying an ambiguous statement.

However, it must be noted that, unlike the requirements for amendments, the requirements for corrections include that the correction “shall not substantially enlarge or alter the scope of claims” (Patent Act Article 126, Paragraph 6 applied mutatis mutandis pursuant to Patent Act Article 134-2, Paragraph 9).

With regard to the handling of a product-by-process claim in a request for a correction in a trial for invalidation, the JPO, while analyzing case studies, will indicate the decisions of the panel in accordance with a case, based upon laws and regulations.

<<Opportunity to amend a request for correction>>

Q15: In a request for corrections in a trial for invalidation, if a notification of reasons for refusal of corrections is issued with regard to a portion of the requested corrections, what happens if I do not make amendments to the request for corrections within the time limit for submission of written opinions?

A15: When a notification of reasons for refusal of corrections has been issued with regard to a portion of the corrections in a request for corrections in a trial for invalidation, if the

reasons for refusal of correction are not dissolved by a Written Opinion alone and if amendments to the Written Request for Correction are not made, the reasons for refusal of correction are considered to have not been dissolved. As such, corrections concerning claims that include the correction items (or if a portion of a unit of claims, correction to the entire unit of claims) are not approved, and therefore, the proceedings for the trial for invalidation are carried out based on the patent description, etc. prior to corrections

<<Deemed withdrawal of requests for correction in accordance with withdrawal of a request for a trial for invalidation>>

Q16: Patent Act Article 134-2, Paragraph 8 stipulates that, when a request for a trial for patent invalidation has been withdrawn by claim, requests for correction are deemed to have been withdrawn by claim. However, when only a trial for invalidation of a portion of the claims composing a unit of claims has been withdrawn, how are corrections to that unit of claims deemed to have been withdrawn?

A16: While a “unit of claims” is, in principle, handled as a whole, this stipulation concerning the “deemed” action constitutes an exception. In other words, when a request for a trial for invalidation with respect to a portion of the claims composing a unit of claims has been withdrawn, only the requests for correction made to the claims for which the request for a trial for invalidation was withdrawn are deemed as having been withdrawn.

As a result, there may be lack of overviewability, meaning the scope of invention cannot be identified by a single document since there has become multiple versions of Description or Claims through the claim-based correction procedures to be looked at in order to identify the scope of invention.

To withdraw a request for a trial for invalidation when corrections have been requested, the consent of the demandee is required. Therefore, whether the request for corrections is withdrawn or not is effectively a matter of choice of the demandee, depending upon whether or not the demandee consents to the withdrawal of the request for the trial for invalidation.

<<Time period>>

Q17: Is it possible for a request for an extension of the submission period of a written answer, etc. to be approved?

A17: In principle, the extension is not approved. However, if a period has been specified that is shorter than the standard specified period, or if an answer requires a longer period due to the amount or nature of evidence, then an extension may be approved ex officio (or through a Written Statement urging the invocation of ex officio, or requests for extension) (Chapter 25-04 of the Manual for Trial and Appeal Proceedings).

<<Proceedings for grounds for invalidation based on violations of Patent Act Article 39>>

Q18: In cases where a single applicant filed a patent application and an application for utility model registration for the same claim on the same day, and the provision of the Patent Act Article 39, Paragraph 4 was overlooked at the examination stage and both the patent

and the utility model were registered, and, following that, a trial for invalidation was requested on the grounds of reasons for invalidation specified in Patent Act Article 123, Paragraph 1 (ii), then, if a Written Correction is submitted with regard to the registered utility model and correction is made to eliminate the same claim, will the grounds for invalidation of the patent be dissolved?

A18: When a claim in the registered utility model has been eliminated through correction, the grounds for invalidation of the patent are dissolved.

<<Oral proceedings>>

Q19: The Patent Act stipulates that trials for invalidation are conducted in principle through oral proceedings, although the chief administrative judge can decide to use documentary proceedings upon a motion by the party concerned or ex officio. What are the respective characteristics of oral proceedings and documentary proceedings?

A19: Oral proceedings allow proper understanding, organization, etc. of points of conflict between the assertions of both sides, through oral interaction between a panel and the parties concerned, at a venue with both parties concerned in attendance. As such, oral proceedings have the merit of enabling proper proceedings even in cases in which numerous points of conflict are involved in a complex manner or cases in which the assertions of parties concerned are unclear, without exchanging documents multiple times. Conversely, documentary proceedings have the merit of allowing a party to describe its assertions in detail, and to express even highly technical matters in an accurate manner, in writing.

<<Advance notice of a trial decision>>

Q20: When is advance notice of a trial decision issued? Also, what happens when advance notice of a trial decision is not issued?

A20: In order to avoid a back-and-forth “game of catch” between courts and the JPO, and to guarantee opportunities for corrections based on the panel judgments presented in trial decisions, judgments on whether to allow corrections and their validity are presented to parties concerned during trial proceedings as advance notice of a trial decision, which provides demandees (i.e., patentees) with the opportunity for corrections. Based on such purport, when proceedings for the trial for invalidation have first reached the point for a trial decision to be rendered, advance notice of a trial decision is in principle issued. When advance notice of a trial decision is not issued, proceedings are concluded and a final and binding decision is rendered (Chapter 51-17 of the Manual for Trial and Appeal Proceedings).

Q21: What happens when, after advance notice of a trial decision has been issued, proceedings further advance and again reach the point for another trial decision to be rendered?

A21: Based on the purport of the advance notice of a trial decision mentioned in Q&A20 (i.e., the guarantee of opportunities for corrections based on the panel’s judgments), after an opportunity for corrections has been granted through the advance notice of a trial

decision and proceedings further advance to again reach the point for another trial decision to be rendered, the trial decision is in principle rendered without advance notice thereof.

After a request for corrections has been filed in response to the advance notice of the first trial decision, the demandant who requested the trial may make additions or changes to the grounds for invalidation in response to the request for corrections. In such case, proceedings are concluded and a final and binding trial decision is rendered without advance notice thereof being issued based on these added or changed grounds for invalidation (Chapter 51-17 3. (2) of the Manual for Trial and Appeal Proceedings).

<<Decision of partial invalidation>>

Q22: When a decision to invalidate a portion of a claim or claims is rendered, is it necessary to file a request for corrections to organize the form of the remaining claim or claims? For example, when an independent claim has been deleted and there are dependent claims citing the independent claim, is it necessary to file another request for corrections to change those dependent claims into independent claims?

A22: It is not necessary for you to file a request for corrections. Since the original text of a trial decision is deemed to be part of the register, when an independent claim has been revoked, its dependent claims are interpreted on the assumption that the revoked independent claims exist. The same holds in cases of partial revocation by a decision on a petition for opposition to a patent.

<<Handling of a lawsuit for revocation of a trial decision on corrections made in a trial for invalidation>>

Q23: In a case where decisions that (1) corrections are allowed and (2) the patent is invalidated have been rendered in a trial for invalidation, and then the demandee (i.e., the patentee) has filed a lawsuit seeking revocation of the trial decision, if the person who requested the trial for invalidation has an objection to the corrections approved in (1), is there a means for filing the objection? Have the corrections in (1) already been finalized by a final and binding trial decision?

A23: A request for corrections is considered to be finalized by a final and binding trial decision (Patent Act §128 as applied mutatis mutandis under Patent Act §134-2 (9)). However, if a lawsuit for revocation of the trial decision is pending in the Intellectual Property High Court, the corrected patent descriptions, etc. are not deemed to have been filed, published, etc. In many of the lawsuits seeking a revocation of a trial decision, only the grounds for revocation of the trial decision asserted by the plaintiff are examined, and in the absence of the judge's control of court proceedings, (2) the invalidation of the patent" alone would be the point of conflict, and it would be highly likely that there is not an opportunity for the defendant to assert their opinions about (1) the approved corrections, which does not constitute grounds for revocation.

Even if the above cannot be asserted in the lawsuit, in the case that a trial decision is revoked and, in repeat proceedings for the trial, the corrections are approved and a trial decision is rendered as "not invalid," the defendant may file a lawsuit seeking revocation

of the trial decision and may assert violations of requirements for corrections in (1) as the grounds for revocation of the trial decision.

<<Statement of opinions>>

Q24: According to the provisions of the Patent Act Article 180-2 (system for seeking opinions and system for stating opinions), can the party concerned in a lawsuit seeking revocation of a decision made in a trial for invalidation (i.e., a demandee (patentee) or a demandant of a trial) seek a statement of opinion on the lawsuit from the JPO?

A24: When a party wishes to hear the opinion of the JPO in a lawsuit seeking revocation of a trial decision, the party needs to urge the invocation of ex officio by the judge so that the court will seek the opinion of the JPO (“call for opinion”) (however, whether or not to call for opinion is at the discretion of the judge).

Also, the Patent Act Article 180-2, Paragraph 2 stipulates that the JPO Commissioner may, with the permission of the judge, express opinions to the court. However, the JPO Commissioner shall not state opinions to the court based on the requests of parties concerned.

<<Withdrawals of a trial for invalidation and a lawsuit seeking revocation of a trial decision>>

Q25: <Background to the case>

- (1) A request for a trial for invalidation was filed, and a trial decision of invalidation was rendered.
- (2) The demandee filed a lawsuit seeking revocation of the trial decision of invalidation.
- (3) At present, the demandant has withdrawn the trial for invalidation, and the demandee is considering withdrawing the lawsuit.

<Question (1)>

If the demandant has withdrawn the request for a trial for invalidation and, on the same day, the demandee has withdrawn the lawsuit seeking revocation of the trial decision, then will the situation not be one in which the withdrawal of the lawsuit seeking revocation of a trial decision comes into force before the withdrawal of the request for a trial for invalidation takes effect, and thus the trial decision becomes final and binding and the request for a trial for invalidation cannot be withdrawn?

<Question (2)>

At what point in time does a withdrawal take effect? For example, does a withdrawal take effect immediately upon submission of a Written Withdrawal?

A25: (1) Although the consent form of the demandee is appended to the Written Withdrawal for a Trial for Invalidation, it is interpreted as a manifestation of the demandee’s intention on the assumption of upholding of rights. Accordingly, in the case of withdrawals occurring on the same day, the effect of the withdrawal of the trial case that is the basis for the lawsuit takes priority.

(2) If formal requirements are in order (as long as the procedures are not dismissed), a withdrawal takes effect on the day that it is accepted by the JPO.

<<Granting of an opportunity for a request for correction when a judgment on revocation of a trial decision has been finalized>>

Q26: In a case where after a decision to uphold the patent in a trial for invalidation was rendered, a lawsuit seeking revocation of the trial decision has been filed and a judgment on its revocation has been finalized in the Intellectual Property High Court, will an opportunity be granted to file a request for correction in the trial for invalidation that has again become pending?

A26: The person who requested a trial for invalidation cannot become the plaintiff in a lawsuit seeking revocation of the trial decision invalidating the patent, in objection to the decision.

Also, a request for correction is considered to be finalized by a final and binding trial decision (Patent Act §128 as applied mutatis mutandis under Patent Act §134-2 (9)). The portion for which corrections have been approved and the portion based upon which the decision has been made regarding whether or not to approve the request for revocation of the trial decision invalidating the patent are inseparably approved and finalized together if both are in the same claim (Chapter 46-00 3. (1) of the Manual for Trial and Appeal Proceedings). Accordingly, if the lawsuit seeking revocation of the trial decision is pending in the Intellectual Property High Court, the corrected patent descriptions, etc. are not deemed to have been filed, published, etc.

<<Prohibition of double jeopardy in a trial for invalidation>>

Q27: With regard to a patent for which a final and binding trial decision to uphold the patent was registered before the enactment date of the 2011 Act on Partial Revision of the Patent Act, etc., will the principle of prohibition of double jeopardy apply to cases where a person who is not the demandee that requested the earlier trial for invalidation, and who files a request for a trial for invalidation after said enactment date but on the basis of the same facts and evidence?

A27: With regard to a patent for which a final and binding trial decision to uphold the patent was registered prior to the aforementioned enactment date, the stipulations prior to the revision are applied after said enactment date as well. As such, no person can file a request for a trial for invalidation on the basis of the same facts and evidence (supplementary provisions of the 2011 Act on Partial Revision of the Patent Act, etc. §2(22)).

Q28: After a trial decision to uphold a patent has been rendered in a trial for invalidation and the decision becomes final and binding, I am now thinking about adding new evidence to the evidence used in the initial trial for invalidation and requesting another, separate trial for invalidation. Will the principle of prohibition of double jeopardy be applied to this case?

A28: If adding new evidence to the evidence used in the earlier trial for invalidation to request another trial for invalidation has an impact on the evaluation of the grounds for invalidation that were presented in the earlier trial for invalidation (for example, when the technical content to be proven differs, etc.), this may be considered as a case that the principle of prohibition of double jeopardy does not apply to. However, when there is no impact on the evaluation of the earlier grounds for invalidation, including a case where the technical content to be proven is the same despite differing evidence, the likelihood of the principle of prohibition of double jeopardy applying can be considered high.