

Q&A: Opposition to Patents

August 2015

This "Q&A: Opposition to Patents" section collects responses to questions received by the JPO concerning the Patent Opposition System that entered into force on April 1, 2015. Please use this as an aid to understanding the system and its operation.

Along with the publication of the "Manual for Appeal and Trial Proceedings (15th edition)," the JPO has created and published the "Manual for Practice of the Patent Opposition System," offering simple explanations of the practices described in the Manual for Appeal and Trial Proceedings and incorporating written examples of procedural formats and documents. Please make use of these resources together.

Table of Contents

1. [Patent Opposition System](#)
2. [Proceedings of the Patent Opposition System](#)
3. [Procedures for the Opponents and Their Agents](#)
4. [Procedures for the Patentees and Their Agents](#)
5. [Other](#)

1. Patent Opposition System

Q1-1. What is the Patent Opposition System?

A1-1. The Patent Opposition System is a system that provides a range of third parties with an opportunity to seek review of the final disposition of a patent within a fixed period (within six months of the publication date of the Gazette containing the patent). When an opposition to a patent is filed, the JPO itself examines the appropriateness of the disposition, and, if defects are found to be present, make efforts to grant stable patent rights in a prompt manner through corrections (Chapter 67-00, No. 1 of the Manual for Appeal and Trial Proceedings).

Q1-2. 1. Under the Patent Opposition System that came into force on April 1, 2015, can we file an opposition to any patents?

A1-2. You can file an opposition to patents in a Gazette published on April 1, 2015 or later (Act No. 36 of 2014, Supplementary Provision §2 (16), Government Ordinance No. 25 of 2015) (Chapter 67-00, No. 2 of the Manual for Appeal and Trial Proceedings).

Q1-3. What is the period for filing an opposition to a patent?

A1-3. You can file an opposition to a patent within six months of the publication date of the Gazette containing the patent (Introductory Clause of the Patent Act §113) (Chapter 67-01, No. 3 of the Manual for Appeal and Trial Proceedings).

Please note, however, that even within the prescribed period, you cannot file an opposition to a patent after the lapse of the patent right (Chapter 67-11, No. 1 of the Manual for Appeal and Trial Proceedings).

Q1-4. Who can file an opposition to a patent?

A1-4. “Any person (not limited to interested persons)” can file an opposition to a patent (Introductory Clause of the Patent Act §113).

Specifically, this corresponds to a natural person, juridical person, or an association or foundation which is not a juridical person but for which a representative or an administrator has been designated (the Patent Act §6 (1) 2). An opposition may not be filed anonymously. When an overseas resident files an opposition, an agent domiciled or resident in Japan, who is acting for the person in handling matters related to the person's patent (a patent administrator), is required to perform procedures (Chapter 67-02, No. 2. of the Manual for Appeal and Trial Proceedings).

Q1-5. If the opponent no longer exists due to death or a merger, can I succeed to the status as opponent?

A1-5. You cannot succeed to the status as opponent (Supreme Court of Japan, Case 1978 (Gyo-Tsu) 103) (Chapter 67-02, No. 2 of the Manual for Appeal and Trial Proceedings).

Q1-6. Can I file an objection against a decision on an opposition to a patent?

A1-6. The patentee, etc. can file an objection with the Tokyo High Court (Intellectual Property High Court) seeking to revoke a decision of revocation of a patent (Patent Act § 178 (1)).

It is not possible to file an objection against a decision of maintenance of a patent (Patent Act § 114 (5)) (Chapter 67-06, No. 7 of the Manual for Appeal and Trial Proceedings).

Q1-7. What is the effect of finalizing a decision of revocation?

A1-7. When a decision of revocation has been finalized, the patent right is deemed never to have existed from the beginning (Patent Act § 114 (3)).

When revocation of a patent concerning a portion of claims is finalized, only the patent right concerning the relevant claims is deemed never to have existed from the beginning (Patent Act § 185) (Chapter 67-06, No. 6 of the Manual for Appeal and Trial Proceedings).

Q1-8. What is the difference between opposition to a patent and a trial for invalidation?

A1-8. Please see the following table contained in Chapter 67-00, No. 1 of the Manual for Appeal and Trial Proceedings.

Reference: Comparison of the Patent Opposition System and the Trial for Invalidation System

	Patent Opposition System	Trial for Patent Invalidation System
Objectives	To grant stable patent rights in a prompt manner	To resolve conflict between parties regarding the validity of patents
Procedures	Ex parte procedures (Conducted in principle between the JPO and the patentee)	Inter partes procedures (Conducted between the demandant and demandee (patentee))
Eligible Opponents/ Demandants	Any persons (Anonymity is not possible)	Interested persons only
Period of Filing a Request	Within six months of the publication date of the Gazette containing the patent (not possible after the lapse of the patent right)	Any time after the registration of establishment (possible even after the lapse of the patent right)
Filing and Withdrawing Requests	Possible to file on a claim-by-claim basis Withdrawal is not possible after notice of reasons for revocation has been issued.	Possible to file on a claim-by-claim basis Withdrawal is possible after a Written Reply is submitted if the adverse party consents.
Grounds for Opposition / Invalidation	(1) Grounds of public interest (lack of novelty, lack of inventive steps, inaccuracies in description, etc.)	(1) Grounds of public interest (lack of novelty, lack of inventive steps, inaccuracies in description, etc.) (2) Grounds related to attribution of rights (violation of requirements for usurped applications and joint applications) (3) Grounds having emerged after the grant of a patent (violation of the provision on the enjoyment of rights, violation of treaties)
Method of Proceedings	Documentary proceedings (Oral proceedings are not possible)	Oral proceedings in principle (Documentary proceedings are also possible)
Handling of Multiple Requests/ Cases	Proceedings are conducted jointly in principle.	Proceedings are conducted separately, not jointly, per case.
Advance Notice of Decisions/ Trial Decisions	Notice of reasons for revocation is issued before decision of revocation is made (advance notice of decision)	Notice of the trial decision is provided before the request is approved (trial decision of invalidation)
Decisions/ Trial Decisions	Decision of revocation or maintenance of a patent, or dismissal of the petition	Trial decision of approving the request or not, or dismissal of the request

	Patent Opposition System	Trial for Patent Invalidation System
Filing of Objections	A Patentee can file a lawsuit against a decision of revocation with the Tokyo High Court (Intellectual Property High Court) naming the JPO Commissioner as a defendant. Objection to a decision of maintenance or a decision dismissing a petition is not possible.	Both a demandant and a patentee can file a lawsuit with the Tokyo High Court (Intellectual Property High Court) naming the adverse party as a defendant
Fee (yen)	¥16,500 + (the number of claims petitioned x ¥2,400)	¥49,500 + (the number of claims requested x ¥5,500)

2. Proceedings of the Patent Opposition System

Q2-1. How is an appeal examination for opposition to a patent carried out?

A2-1. Appeal examinations are carried out entirely through documentary proceedings (Patent Act §118 (1)). Oral proceedings are not conducted. However, examination of evidence, such as examinations of witnesses, may be conducted (Chapter 67-05 of the Manual for Appeal and Trial Proceedings).

Q2-2. What is the examination body in an opposition to a patent, and what is examined in an appeal examination?

A2-2. In order to assure accuracy in the appeal examination, a panel consisting of 3 or 5 administrative judges conducts an appeal examination (Patent Act §114 (1)).

What is examined in the appeal examination is limited to the claims against which an opposition to a patent has been pleaded (Patent Act §120-2 (2)). However, as far as the panel is concerned, it is allowed to examine grounds that the opponent has not pleaded (Patent Act §120-2 (1)) (Chapter 67-05 of the Manual for Appeal and Trial Proceedings).

Q2-3. How does the appeal examination proceed when multiple oppositions to the same patent have been filed?

A2-3. When multiple oppositions to the same patent have been filed, the panel in principle organizes all the grounds for those petitions and examines them as a group (Jointly conducted proceedings) (Patent Act §120-3 (1)).

Accordingly, regardless of when each opposition to the patent has been filed, the panel waits until the expiry of the period for filing an opposition (within six months of the date of publication of the Gazette containing the Patent) before commencing the appeal examination.

However, when the patentee has submitted a "Written Statement to Request Early Commencement of Appeal Examination before the Expiry of the Period for Filing an Opposition," the panel commences the appeal

examination without waiting for the prescribed expiration date (Chapter 67-08, No. 1 of the Manual for Appeal and Trial Proceedings).

Q2-4. An appeal examination for opposition to a patent is conducted on the basis of grounds and evidence for the petition. Might the panel change the grounds or add to the evidence?

A2-4. In an *ex officio* appeal examination, the panel may adopt grounds or evidence not pleaded by the opponent. Specific examples include changing the combination of evidence; adopting evidence discovered through an *ex officio* investigation in order to supplement the evidence already presented to support the grounds for revocation, such as lack of inventive steps as claimed by the opponent based on evidence presented in a Written Opposition (literature indicating common general technical knowledge in the technical field of the claimed invention, etc.), or evidence for proving a violation of description requirements that forms the grounds for petition; changing the provisions to be applied; etc. (Chapter 67-05, No. 3 of the Manual for Appeal and Trial Proceedings).

Q2-5. The method for conducting an appeal examination is documentary proceedings. Are there cases in which examinations of evidence, such as examinations of witnesses, are conducted?

A2-5. Examinations of evidence including examinations of witnesses may be conducted upon request by the opponent, the patentee, etc., or may be conducted *ex officio* (Patent Act §120 → Patent Act §150, Patent Act §151) (Chapter 67-05 of the Manual for Appeal and Trial Proceedings).

Q2-6. When both an opposition to a patent and a request for a trial for invalidation have been filed, which proceeding is conducted first? Or, are both proceedings conducted jointly?

A2-6. Regardless of whether an opposition to a patent or a request for a trial for invalidation came first, in principle, a trial for invalidation is given priority and examined first. The proceedings of the two are not conducted jointly (Chapter 67-09 of the Manual for Appeal and Trial Proceedings).

Q2-7. When both an opposition to a patent and a request for a trial for correction have been filed, which proceeding is conducted first? Or, are both proceedings conducted jointly?

A2-7. When an opposition to a patent has become pending first, a request for a trial for correction cannot be filed. When a request for a trial for correction has been filed first and is followed by an opposition to a patent, in principle, an opposition to a patent is given priority and examined first. The proceedings of the two are not conducted jointly. In this case, a request for corrections containing the same content as the trial for corrections may be required to be filed during the proceedings of opposition to a patent (Chapter 67-10 of the Manual for Appeal and Trial Proceedings).

3. Procedures for Opponents and Their Agents

Q3-1. How should I prepare a Written Opposition?

A3-1. Please prepare a Written Opposition by noting the required information (a seal, etc. is also required) in accordance with the Regulations under the Patent Act, Form No. 61-2.

Follow the procedural forms and written examples given in the "Manual for Practice of the Patent Opposition System."

Q3-2. Can I file an opposition to a patent online?

A3-2. Online filing is not available. You must file an opposition in writing.

Q3-3. When an agent undertakes procedures for opposition to a patent on behalf of the opponent, is it necessary to submit a document proving authority of representation?

A3-3. According to the stipulations of the Regulations under the Patent Act §4-3 (1) No. 9, documents proving authority of representation for undertaking procedures for opposition to a patent must be submitted (Chapter 23-09 of the Manual for Appeal and Trial Proceedings).

Q3-4. When procedures for opposition to a patent are delegated, what kind of statements must be included in the power of attorney?

A3-4. The Power of Attorney for agent(s) of the opponent must contain the statement, "**Filing and withdrawing an opposition to Patent No. _____.**" If you plan to submit a General Power of Attorney, it must contain the statement, "**Filing and withdrawing oppositions to any other party's patents**" or "**Filing oppositions to any other party's patents or to any other party's registered trademarks (defensive marks).**" You can then refer to it by noting its number on a Written Opposition or on a Written Notice of Appointment of Attorney.

Q3-5. When filing an opposition to a patent, can I provide an identification number in the documentation instead of an address?

A3-5. Since procedures for opposition to a patent must be performed in writing, you cannot omit writing the address.

Q3-6. When filing an opposition to a patent, can I use an identification label?

A3-6. You cannot use identification labels. Seals are required on both originals and duplicates.

Q3-7. On what grounds can an opposition to a patent be filed?

A3-7. An opposition to a patent can be filed on grounds of public interest (lack of novelty, lack of inventive steps, inaccuracies in description, etc.) stipulated in the items of Patent Act §113 (1). Unlike trials for invalidation, grounds related to the attribution of rights (violation of requirements for usurped applications, joint applications, etc.) are not treated as grounds for filing an opposition to a patent (Chapter 67-01, No. 2 of the Manual for Appeal and Trial Proceedings).

Q3-8. Is it possible to file an opposition to a patent on a claim-by-claim basis?

A3-8. For a patent involving two or more claims, it is possible to file an opposition to the patent on a claim-by-claim basis (Introductory Clause of the Patent Act §113) (Chapter 67-01, No. 1. (2) of the Manual for Appeal and Trial Proceedings).

Q3-9. How is the fee for filing an opposition to a patent calculated?

A3-9. The fee is calculated as follows: a basic fee of ¥16,500 + (the number of claims against which the opposition is filed x ¥2,400) (Patent Act §195 (2)).

For example, when an opposition is filed against two claims, the fee is ¥21,300 (¥16,500 + (2 x ¥2,400)).

Q3-10. How many duplicates of the Written Opposition do I have to submit along with the original?

A3-10. You must submit one duplicate for each patentee plus one for use in the appeal examination (Regulations under the Patent Act §4, Regulations under the Patent Act §50-4). The duplicates also require seals. Please note that a copy of the Written Opposition with a copied seal is recognized as simply being a "copy" and is thus not accepted as a duplicate (Chapter 67-03, No. 1. (1) of the Manual for Appeal and Trial Proceedings).

Q3-11. I plan to use only Official Gazettes as evidence. Can I refer to the Gazettes kept at the JPO instead of including the relevant attachments?

A3-11. No, attachments must be included. Please submit copies of your evidence (Chapter 34-01, No. 4. (3) of the Manual for Appeal and Trial Proceedings).

Q3-12. I plan to use documents written in a foreign language as evidence. Is a translation necessary?

A3-12. When you use documents written in a foreign language as evidence, you must attach a translation of the cited portions (Regulations under the Patent Act §61 (1)) (Chapter 34-01, No. 4. (5) of the Manual for Appeal and Trial Proceedings).

Q3-13. I plan to send a set of written documents, including the Written Opposition, its duplicates, etc. to the JPO by home delivery service. Are there any points for attention that I should be aware of?

A3-13. Since a home delivery service is deemed to be neither postal mail nor correspondence delivery (Act on Correspondence Delivery by Private Business Operators §2 (3)), the date of the documents' arrival at the JPO will be taken as the date of the filing of the opposition (Patent Act §19). Therefore, please ensure that you send the documents sufficiently prior to the expiry of the prescribed period for filing an opposition.

Q3-14. Can I make amendments that change the gist of an opposition to a patent, such as by changing the grounds or adding evidence?

A3-14. Amendments that change the gist of the Written Opposition are accepted if they are filed by the expiry of the prescribed period for filing an opposition or by the time that a Notice of Reasons for Revocation is sent to the patentee, whichever comes first (the proviso of the Patent Act §115 (2)) (Chapter 67-04, No. 2. (2) c of the Manual for Appeal and Trial Proceedings).

Q3-15. Can the opponent be interviewed by the panel?

A3-15. Appeal examinations of an opposition to a patent are carried out entirely through documentary proceedings. Moreover, appeal examinations for an opposition are not conducted between the parties as in a trial for invalidation, but are conducted between the JPO and the patentee. Therefore, the opponent is not allowed to request an interview. Please ensure that the grounds for opposition in the Written Opposition are clear enough to allow a full understanding.

However, in cases such as where the panel has determined that a technical explanation, with regard to evidence, etc. described in the Written Opposition, would contribute to the accuracy of appeal examinations, the panel may request an interview with the opponent, as needed, prior to providing a Notice of Reasons for Revocation.

Please see the Interview Guidelines for Trials and Appeals, for more information.

Q3-16. What is the "filing number" noted on the Notice of Opposition Number? Is it required to be presented during the subsequent procedures?

A3-16. The filing number is a serial number to distinguish individual oppositions when multiple oppositions have been filed with regards to the same patent right. It will not be used by the opponent in subsequent procedures.

Q3-17. Does the opponent have an opportunity to state opinions on documents submitted by the patentee?

A3-17. If a Written Request for Correction has been submitted, the chief administrative judge will send the duplicate of the Written Request for Correction to the opponent along with a document describing the reasons for revocation of the patent in order to grant an opportunity for the submission of a Written Opinion, setting an adequate time limit (normally 30 days, or 50 days for overseas residents).

However, if the chief administrative judge has determined that there are special circumstances under which granting an opportunity for submission of a Written Opinion is considered to be unnecessary, such opportunity will not be granted (e.g., in the case of minor corrections, such as corrections of errors) (Patent Act §120-5 (5)) (Chapter 67-05. 4 of the Manual for Appeal and Trial Proceedings).

Q3-18. How can I withdraw an opposition to a patent?

A3-18. An opposition to a patent can be withdrawn until the time that a Notice of Reasons for Revocation is sent to the patentee (Patent Act §120-4 (1)).

When multiple oppositions to a patent have been filed against two or more claims of the patent, the oppositions can be withdrawn on a claim-by-claim basis (Patent Act §120-4 (2) → Patent Act §155 (3)).

When an opposition to a patent has been withdrawn, the patentee and the intervenor(s) will be notified of the withdrawal (Regulations under the Patent Act §45-6 → §50-5) (Chapter 67-03, No. 3 of the Manual for Appeal and Trial Proceedings).

Q3-19. Following a request for correction, the opponent is granted an opportunity to state opinions within the prescribed period. Is it possible to request an extension of this period?

A3-19. The extension of the prescribed period will not be permitted even though the opponent requests. It is handled in the same way as a Written Refutation in a trial for invalidation.

Q3-20. Following a request for correction, the opponent is granted an opportunity to state opinions. Is it possible to submit, for example, new evidence at this time?

A3-20. If such evidence is necessary in relation to the content of a request for correction, it may be adopted as a reason for revocation. However, evidence not pertaining to the content of a request for correction will not be adopted as a reason for revocation (Chapter 67-05. 4, No. 1 of the Manual for Appeal and Trial Proceedings).

Q3-21. Even if a request for correction has been filed, is it possible to choose not to submit a Written Opinion?

A3-21. Yes, it is possible. In such cases, you can file the Written Opposition, etc. with a statement to the effect that you do not wish to submit a Written Opinion (Patent Act §120-5 (5)) (Regulations under the Patent Act §45-2, Form No. 61-2) (Chapter 67-05. 4, No. 1 (1) of the Manual for Appeal and Trial Proceedings).

Q3-22. I wish to file an opposition to a patent, but do not wish to submit a Written Opinion or have an interview. What should I do?

A3-22. If you respond "No" to the question of "Do you wish to submit a Written Opinion?" in the written opposition form, you will not be asked to submit a Written Opinion (Regulations under the Patent Act §45-2, Form No. 61-2).

You can also decline a request by the panel for an interview.

4. Procedures for the Patentees and Their Agents

Q4-1. How do I know if an opposition has been filed to my patent?

A4-1. If an opposition to a patent has been filed, the patentee receives a Notice of Opposition Number issued by the JPO.

If the patentee is an overseas resident, the patent administrator receives the Notice.

Q4-2. What is the "filing number" noted on the Notice of Opposition Number? Is it required to be presented during the subsequent proceedings?

A4-2. The filing number is a serial number to distinguish individual oppositions when multiple oppositions are filed with regards to the same patent right. It will not be used by the patentee in subsequent proceedings.

Q4-3. When an exclusive license to a patent has been registered, does the exclusive licensee receive any notifications?

A4-3. Exclusive licensees of the patent against which an opposition has been filed, and any other persons who hold registered rights concerning the patent will be notified that an opposition to the patent has been filed (Patent Act §115 (4) → Patent Act §123 (4)) (Chapter 67-03. 2 (4) of the Manual for Appeal and Trial Proceedings).

Q4-4. I acted as an agent when filing a patent application, but so far have not submitted a Power of Attorney. Can I undertake the procedures for opposition to a patent as an agent of the patentee?

A4-4. You must submit documents proving authority of representation. When an opposition to a patent is filed, a Notice of Opposition Number is sent by a postcard to the patent administrator if the patentee is an overseas resident, or is otherwise sent to the patentee and his/her agent at the time of patent registration. If you wish to undertake procedures as the agent of the patentee, please submit the "Notice of Acceptance of Appointment as Attorney" within 24 days of receipt of the Notice of Opposition Number.

Points for attention to this effect are noted in the Notice of Opposition Number.

Q4-5. I acted as an agent when filing a patent application, and at that time, I referred to a General Power of Attorney containing a statement noting that post-grant procedures were also delegated to the agent. Can I undertake the procedures for opposition to a patent as an agent of the patentee?

A4-5. Since you are authorized to act as the agent of the patentee (the applicant) with regard to procedures before the JPO by reason of the General Power of Attorney which was referred to at the time of filing the patent application, you may undertake the procedures for opposition to the patent as an agent (Chapter 23-09, No. 4 of the Manual for Appeal and Trial Proceedings).

Q4-6. I acted as an agent when filing a patent application, and at that time, I referred to a General Power of Attorney containing a statement noting that post-grant procedures were also delegated to the agent. Recently I received a Notice of Opposition Number by postcard, but the power of attorney agreement has already expired. What should I do?

A4-6. Under such condition, you technically remain the agent of the patentee (the applicant) with regard to procedures before the JPO by reason of the General Power of Attorney which was referred to at the time of filing the patent application. As such, please promptly submit a "Written Notice of Resignation of Attorney" if you shall no longer act as the agent.

Points for attention to this effect are noted in the Notice of Opposition Number.

Q4-7. When a patentee delegates procedures for opposition to a patent, what kind of statements must be included in the Power of Attorney?

A4-7. The Power of Attorney for the agent(s) of the patentee must contain the statement "Undertaking and withdrawing of the procedures concerning Patent No. _____ " or "Filing and withdrawing an opposition to Patent No. _____." A General Power of Attorney containing the statement "Undertaking and withdrawing of the procedures concerning all patent rights described below and any rights related to them" can be referred to if its number is noted on a Written Notice of Appointment of Attorney.

Q4-8. When is a duplicate of a Written Opposition sent to the patentee (or agent)?

A4-8. A duplicate is sent each time an opposition to a patent is filed, even if the prescribed period for filing an opposition (Patent Act §115 (3)) has yet to expire. The duplicate is sent to the agent(s), or to the patentee if there is no agent.

If the Written Opposition contains improper descriptions, no duplicate shall be sent until they are resolved (Chapter 67-03, No. 2. (2) of the Manual for Appeal and Trial Proceedings).

Q4-9. I have received a duplicate of a Written Opposition. What should I do?

A4-9. Even though you have received a duplicate of a Written Opposition, you do not need to immediately undertake any procedures before the JPO. The JPO will conduct an examination of the opposition to your patent, and if you are notified of reasons for revocation as a result of the examination, you may consider submitting a Written Opinion, filing a request for correction, etc. If you are not notified of any reasons for revocation and a decision of maintenance of your patent is made, you (the patentee) do not need to undertake any procedures.

Q4-10. What should I know about the Notice of Reasons for Revocation?

A4-10. When making a decision to revoke an opposed patent as a result of examination, the chief administrative judge notifies the patentee of the reasons for the revocation in order to grant an opportunity to state opinions on the reasons for revocation, setting an adequate time limit (normally 60 days, or 90 days for overseas residents) (Patent Act §120-5 (1)). The patentee may submit a Written Opinion or make a request for correction within the prescribed period.

Please note that the patentee only needs to state opinions on the Notice of Reasons for Revocation, and does not need to state opinions on the grounds or evidence described in the Written Opposition (Chapter 67-05. 1 of the Manual for Appeal and Trial Proceedings).

Q4-11. What is a notice of reasons for revocation (advance notice of decision)?

A4-11. As with an advance notice of trial decision issued in a trial for patent invalidation, when a patent opposition case has reached the point at which a decision needs to be rendered and it is found to have reasonable grounds for revocation, the JPO issues a Written Notice of the Reasons for Revocation containing a clear statement that it is an "advance notice of decision" to grant the patentee an opportunity for filing a request for correction (Patent Act §120-5 (2)).

Please note that when the patentee expresses his/her wish not to receive an "advance notice of decision" so that a decision may be made more swiftly, or when neither a Written Opinion has been submitted nor a request for correction has been filed in response to the previously issued Notice of Reasons for Revocation, the JPO will not issue an "advance notice of decision" (Chapter 67-05. 5 of the Manual for Appeal and Trial Proceedings).

Q4-12. Can I request an extension of the period for submission of a Written Opinion in response to a Notice of Reasons for Revocation?

A4-12. In principle, the extension of the period for submission of a Written Opinion is not permitted. However, if you submit a Written Request for the Extension of Term stating rational and concrete reasons necessitating extension of the period, etc., sufficiently prior to the expiry of the period, and if the chief administrative judge determines that there are rational and concrete reasons necessitating extension of the period, the extension may be permitted as an exception (Chapter 25-04, No. 3. of the Manual for Appeal and Trial Proceedings).

Q4-13. What is the period for filing a request for correction?

A4-13. You may file a request for correction to a Description, Claims, or Drawings within the period for submission of Written Opinions (normally 60 days, or 90 days for overseas residents) that is specified in the Notice of Reasons for Revocation (including the one issued as an advance notice of decision) (Patent Act §120-5 (2)) (Chapter 67-05. 2, No. 1. (2) of the Manual for Appeal and Trial Proceedings).

Q4-14. When filing a request for correction of a patent to which an exclusive license has been registered, is the consent of the exclusive licensee required?

A4-14. When there is an exclusive licensee, pledgee, non-exclusive licensee based on employee invention, or non-exclusive licensee by consent, the patentee may file a request for correction only with the consent of the relevant person (Patent Act §120-5 (9) → Patent Act §127).

Please attach a Written Consent to the Written Request for Correction (Chapter 67-05. 2, No. 1. (2) of the Manual for Appeal and Trial Proceedings).

Q4-15. How is the fee for filing a request for correction calculated?

A4-15. The fee is calculated as follows: a basic fee of ¥49,500 + (the number of claims x ¥5,500) (Patent Act §195 (2)). "The number of claims" here refers not to the number of claims to be corrected, but refers to the number of claims recorded in the patent register.

For example, even if you make a correction that reduces the number of claims from five to three, or you make partial corrections to the Claims, such as making corrections only to Claim 1 through Claim 3 out of Claim 1 through Claim 5, the fee calculation is based on five claims, which is the number of claims prior to correction. In the above example, the fee for filing a request for correction is ¥77,000 (¥49,500 + (5 x ¥5,500)) (Chapter 67-05. 2, No. 1. (2) D (b) of the Manual for Appeal and Trial Proceedings).

Q4-16. Is it possible to make a request for correction of the claims against which an opposition to the patent has not been filed?

A4-16. Yes, it is possible (Patent Act §120-5 (9) → Patent Act §126 (7)) (Chapter 67-05. 2, No. 1. (2) of the Manual for Appeal and Trial Proceedings).

Q4-17. When filing a request for correction, is there anything that I should be aware of regarding claims?

A4-17. When correction of a Description or Drawings concerns an invention claimed in multiple claims, you must file a request for correction for all the claims (or group of claims) that concern the corrected Description or the corrected Drawings, since the Description or the Drawings after the corrections should be based on (Patent Act §120-5 (9) → Patent Act §126 (4)) (Chapter 67-05. 2, No. 1. (2), Chapter 51-11, No. 2. (2) of the Manual for Appeal and Trial Proceedings).

Q4-18. When creating a corrected Description to be attached to a Written Request for Correction, is there anything that I should be aware of?

A4-18. You must create a corrected Description, etc. using the prescribed form in order to prevent renumbering of claim numbers or paragraph numbers by adding or deleting claims, paragraphs, etc. for the sake of ensuring “overviewability”, whereby the scope of invention can be identified by a single document (Regulations under the Patent Act, Form No. 29, Note 14c, e, 16, 19; Form No. 29-2, Note 15, 16; Form No. 30, Note 13).

In addition, when correcting a Description, etc., you must attach its complete text (Patent Act §131 (4)) (Chapter 67-05. 2, No. 1. (2)).

Q4-19. When multiple requests for correction have been filed for a single patent opposition case, how are the previous requests for correction handled?

A4-19. When a new request for correction is filed, the previous requests are deemed to have been withdrawn (Patent Act §120-5 (7)).

Please note that the Description, etc. to which corrections should be made is the one at the time of establishment of registration, etc. (Chapter 67-05. 2, No. 1. (3) of the Manual for Appeal and Trial Proceedings).

Q4-20. When the claims against which an opposition to the patent has been filed have all been deleted through a request for correction, what happens to the patent opposition case?

A4-20. Since the subjects of the opposition to the patent no longer exist, the opposition to the patent will be dismissed (Chapter 67-06, No. 3. (3) of the Manual for Appeal and Trial Proceedings).

Q4-21. 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 an opposition to a patent, 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?

A4-21. With regard to the “clarification of an ambiguous statement” stipulated in Patent Act Article 120-5, Paragraph 2, proviso (iii) in a request for correction during the opposition proceedings, the requirement that it be “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 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 to specify the invention only by the structure or characteristics of the product, or a correction to change the reciting of a claim into that of the manufacturing process of the product alone 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 120-5, Paragraph 9).

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

Q4-22. Can I make amendments that change the gist of a request for correction, such as by changing or adding grounds for the request?

A4-22. You cannot make amendments that change the gist of a Written Request for Correction. However, as an exception, if you are given an instruction to the effect that you should make amendments to the Written Request for Correction, then you can make amendments only to the items for which the said instruction was given even if they may change the gist of the Written Request for Correction (Patent Act §120-5 (9) → Patent Act §131-2 (1) iii) (Chapter 67-05. 3, No. 4. (1) of the Manual for Appeal and Trial Proceedings).

Q4-23. What is the period for withdrawal of a request for correction?

A4-23. You may withdraw a request for correction only within the period for submission of a Written Opinion specified in the Notice of Reasons for Revocation (including the one issued as an advance notice of decision) or the Notice of Reasons for Refusal of Correction (Patent Act §120-5 (8), Patent Act §17-5 (1)).

Please note that when filing the withdrawal, even if you have filed multiple requests for correction by claim or group of claims, you must withdraw all of the requests (Patent Act §120-5 (8), Regulations under the Patent Act §45-6 → Regulations under the Patent Act §50-2-2). If you wish to partially cancel the request for correction, you may delete a portion of the correction items through amendment to the Description, the Claims, or the Drawings involved in the correction (Patent Act §17-5) (Chapter 67-05. 2, No.1 (4) of the Manual for Appeal and Trial Proceedings).

Q4-24. When a decision on opposition that approves corrections has become final and binding, what is the effect of the corrections?

A4-24. The filing of the patent application, the publication of the patent, the trial/appeal decision or the final and binding decision to grant the patent right, and the registration of the establishment of the patent right are

deemed to have been made based on the corrected Description, etc. (Patent Act §120-5 (9) → Patent Act §128).

Q4-25. Can the patentee request an interview with the panel?

A4-25. As in the case of an appeal against an examiner's decision of refusal, an interview with the patentee is, in principle, conducted at least once during the proceedings if requested.

Please see the Interview Guidelines for Trials and Appeals for more information about how to request an interview, etc.

5. Other

Q5-1. What is "intervention" in the patent opposition system?

A5-1.

(1) Persons eligible to intervene

Only persons with rights concerning the patent (for example, exclusive licensee and non-exclusive licensee) and interested persons concerning the patent may intervene in a proceeding to assist the patentee (Patent Act §119 (1)).

(2) Period for intervention

They can intervene until a decision on the opposition to the patent is made (Patent Act §119 (1)).

(3) Effect of intervention

To assist the patentee, the intervenor can submit methods of allegation and evidence, and undertake any other procedures concerning opposition to a patent (Patent Act §119 (2) → Patent Act §148 (4)). In addition, the related documents sent to the patentee are also sent to the intervenor (Chapter 67-02. No.3 of the Manual for Appeal and Trial Proceedings, Chapter 57-00 to 57-09 of the Manual for Appeal and Trial Proceedings).

Q5-2. Can a third party check whether an opposition has been filed to the patent of another party?

A5-2. Using the Japan Platform for Patent Information (J-PlatPat) database, it is possible to check whether Written Oppositions or other documents have been submitted*. However, it takes about three weeks until the submission of documents is reflected in the information in J-PlatPat. When you wish to check the content of written documents that have been submitted, please ask to view documents at the JPO service desk.

*Please contact the helpdesk (helpdesk@j-platpat.inpit.go.jp) for more information.

[Updated: August 7, 2015]