

8. Post-Grant Submission of Information by Third Parties

<<System for Post-Grant Submission of Information by Third Parties>>

Q1: Will a trial examination based on materials submitted in accordance with the provisions of Regulations under the Patent Act, Article 13-3 (System for Post-Grant Submission of Information by Third Parties) not be held if a trial for invalidation is not requested? (In other words, does the JPO not autonomously re-examine a registered right?)

A1: Once registration of the establishment of a patent has been carried out as an administrative disposition, the panel cannot begin examination of the validity or invalidity of a patent without a request for a trial for invalidation. Even if a request for a trial for invalidation has been filed, if the demandant of the trial is not asserting grounds for invalidation based on the materials, the question of whether or not to make the submitted materials subject to *ex officio* trial examination is at the discretion of the panel. However, when the grounds for request petitioned by the demandant of the trial for invalidation do not constitute reasonable grounds for invalidation, but if it is deemed that the submitted information constitutes reasonable grounds for invalidation and should be subject to *ex officio* trial examination from a public interest point of view, then it is more likely that the discretionary power for an *ex officio* trial examination will be invoked. Moreover, if you wish to seek a judgment on grounds for invalidation based on submitted materials when requesting a trial for invalidation, it is necessary for you to assert these grounds for invalidation in advance.

Q2: Will an *ex officio* trial examination be held if a person other than the party concerned submits information during a pending trial for invalidation through the system for the post-grant submission of information by third parties?

A2: When information has been submitted during a pending trial for invalidation, it will be promptly distributed to the administrative judges in charge of the trial for invalidation. The question of whether to subject the submitted information to *ex officio* trial examination is left to the discretion of the administrative judges, and therefore, it may not necessarily be subjected to *ex officio* trial examination. Essentially, it is appropriate that a trial for invalidation be examined on the basis of the assertions of and proof supplied by the demandant of the trial; invocation of *ex officio* trial examination is limited to supplementary and exceptional cases.

Q3: Regarding the post-grant submission of information by third parties, can literature, etc. submitted after establishment of the patent be used as evidence in a trial for invalidation?

A3: There are no special restrictions on the use of the submitted literature, etc. in a request for a trial for invalidation.