

## **10—02 PUT**

### **Pre-Grant Provision of Information**

#### 1. Purpose

A system of provision of information is regulated under Enforcement Regulations of the Patent Act for the purpose of improving accuracy and promptness of examinations accompanied with introduction of the disclosure system for disclosure of applications in 1970 (Enforcement Regulations of the Patent Act Article 13-2).

For trademarks, this system is regulated under Enforcement Regulations of the Trademark Act for the purpose of improving accuracy and promptness of examinations and also preventing the occurrence of defective trademark rights accompanied with introduction of the opposition system for registration of trademarks in 1996 (Enforcement Regulations of the Trademark Act Article 19).

Enforcement Regulations of the Utility Model Act has the similar provisions (Enforcement Regulations of the Utility Model Act Article 22).

#### 2. Overview

##### (1) Persons allowing to provide Information

Anyone can provide information.

A name (appellation), an address (location) and a seal, etc. can be omitted, thus the information can be provided anonymously (Enforcement Regulations of the Patent Act Article 13-2(3)(4), Enforcement Regulations of the Trademark Act Article 19(3)).

##### (2) Applications subject to provision of information

Information can be provided to patent/trademark applications which are pending at the Japan Patent Office (Enforcement Regulations of the Patent Act Article 13-2, Enforcement Regulations of the Trademark Act Article 19).

Information cannot be provided to patent/trademark applications which are no longer pending at the Japan Patent Office (for instance, patent applications rendered a decision of final rejection, abandonment of applications, withdrawal or dismissal of patent applications). It does not matter whether a request for examination is filed. Regarding provision of information to patents which have already registered establishment of the right, see Post-Grant Provision of Information (→ 10-04) .

### (3) Types of information that can be provided

Information can be provided to applications having specific reasons for refusal (Enforcement Regulations of the Patent Act Article 13-2 (1), Enforcement Regulations of the Trademark Act Article 19(1)).

#### A. Patent

Specifically, provision of information is limited to the following specific reasons for refusal: an amendment adding a new matter (the Patent Act Article 17-2 (3)); patent eligibility (the Patent Act Article 29(1) and the Patent Act Article 2 (1)); a lack of industrial applicability (the Patent Act Article 29(1)); a lack of novelty (the Patent Act Article 29(1)); a lack of inventive step (the Patent Act Article 29(2)); secret prior art (the Patent Act Article 29-2); prior application (the Patent Act Article 39 (1)-(4)); violation of description requirements of specification (the Patent Act Article 36 (4)); violation of description requirements of claims (the Patent Act Article 36 (6)); and a new matter beyond the original text (the Patent Act Article 36-2 (2)).

#### B. Trademark

Specifically, provision of information is limited to the following specific reasons for refusal: requirements for trademark registration (the Trademark Act Article 3); unregistrability of trademark (the Trademark Act Article 4(1) (i), (vi)-(xi), (xv)-(xix)), a lack of corporate status for regional collective trademark (the Trademark Act Article 7-2(1)); and prior application (the Trademark Act Article 8(2),(5)).

(4) Materials that can be provided

Materials that can be submitted to the Japan Patent Office under provision of information are only “documents”, and other materials than documents (such as a DVD recording the operation of a device) cannot be submitted. Specifically, a typical document that can be submitted is “publications” or “a copy of a specification, claims and drawings attached to the original patent applications/utility model registration applications”. It is also possible to submit “other documents” including a catalogue and a certificate of experimental results (Enforcement Regulations of the Patent Act, the body of Article 13-2(1), Enforcement Regulations of the Trademark Act, the body of Article 19(1)).

(5) Handling when examination of evidences is necessary to determine whether there are reasons for refusal based on the information provided

Based on a purport of the system of a trial for invalidation or an opposition to grant of patent/opposition to registration of trademark, when there is a high probability to refuse patentability of the invention (or registrability of the trademark) of the relevant application by adopting the provided information, examination of evidences shall be conducted based on ex-officio investigations.

(6) Formalities of information statement

When submitting documents for provision of information, an information statement shall be prepared according to the designated form (Enforcement Regulations of the Patent Act Article 13-2(2) Form 20, Enforcement Regulations of the Trademark Act Article 19(2) Form 20).

When preparing, it is necessary to clearly describe reasons that the patent at issue falls under reasons for refusal in the above (3) based on the submitted documents in the above (4).

When the information statement is submitted anonymously, describe “omitted” into the columns of the designated form such as an identification number, an address or a domicile, a name or an appellation, for both of a provider and a patent attorney. It is desirable to underline or frame the citations in the publications, etc. to be submitted for easy understanding.

(7) Submission method of an “information statement”

It is possible to submit an “information statement” either in writing or online using the official internet application software. Payment for a submission fee is not necessary whichever method the information provider takes. When the “information statement” in writing is submitted, the documents should be sent to the address below:

Commissioner of the Japan Patent Office  
3-4-3 Kasumigaseki, Chiyoda-ku  
Tokyo, Japan 100-8915

(8) Feedback to a provider of information

Feedback can be appropriately conducted upon the request of the provider, which includes:

A. Whether the information provided has been already used for any notification of reasons for refusal before the provision of information; and

B. Whether the information provided has been used for the first notification of reasons for refusal after the provision of information.

(It is not necessary to feed back whether the provided information has been used from the second notification of reasons for refusal, and the results of the final examination.)

(9) Notification to a demandant

The fact that the information was provided is notified to a demandant.

(10) Access to the provided information

The provided information is available for browsing.

Among cases where the information is provided to on-line applications, if the provided information is suitable for computerization, the information will be available in the electronic documents.

(11) Creation of a record for utilization of the provided information in examinations

Such a record is not created since it is possible to investigate the utilization by browsing of application documents.

(12) Opportunity of explanations/interviews on the information by the information provider

The information provider is not a party of the trial/appeal. Therefore, it is not permitted for the information provider to communicate with the administrative judges of the case through the interview, etc. for explaining the provided information or for explaining such as patentability of the patent in the patent application concerned (or registrability of the trademark in the trademark application concerned). The information provider shall not be a person who is requested to submit documents, etc. by the chief administrative judge under the Patent Act Article 134(4) (including a case where the Trademark Act Article 56(1) shall apply *mutatis mutandis*).

(Revised Feb. 2015)