

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).

2. Overview

(1) Persons being able to provide information

Anyone may provide information (Enforcement Regulations of the Patent Act Article 13-2(1), Enforcement Regulations of the Trademark Act Article 19(1)).

Since a name (trade name), a domicile (residence) , etc. of an information provider may be omitted, it is possible to provide information anonymously (Enforcement Regulations of the Patent Act Article 13-2(3), Enforcement Regulations of the Trademark Act Article 19(3)).

(2) Applications subject to provision of information

Information may be provided to patent applications and applications for trademark registration which are pending at the Japan Patent Office (Enforcement Regulations of the Patent Act Article 13-2(1), Enforcement

Regulations of the Trademark Act Article 19(1)). Information may not be provided to patent applications and applications for trademark registration which are no longer pending at the Japan Patent Office (for instance, patent (trademark) applications for which a decision of rejection has become final and binding, patent (trademark) applications which have been abandoned, withdrawn or dismissed, or patent (trademark) applications for which patent (trademark) rights have already been established and registered). It does not matter whether a request for examination is filed. Regarding provision of information to a patent right the establishment of which has already been registered, see Post-Grant Provision of Information (→ 10-04) .

(3) Types of information that may be provided

Information may be provided to applications having only 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 the body of Article 29(1)); a lack of industrial applicability (the Patent Act the body of 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)(i)~(iii)); 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); un-registrability of trademark (the Trademark Act Article 4(1) (i), (vi)-(xi), (xv)-(xix)), requirements for registration of regional collective

trademark (the Trademark Act Article 7-2(1)); and prior application (the Trademark Act Article 8(2),(5)).

(4) Materials that may be provided for provision of information

Materials that may be submitted to the Japan Patent Office for providing information are only “documents”, and other materials than documents (for example, a DVD recording the operation of a device) may not be submitted. Specifically, a typical document that may 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 evidence is necessary to determine whether there are reasons for refusal based on the provided information

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 evidence shall be conducted based on ex-officio investigations.

(6) Formalities of a document of “information statement”

When submitting documents for providing 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 (trademark) 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” in the columns of an identification number, a domicile or a residence, and a name or a trade name, for both of a provider and a patent attorney, in the designated form. It is desirable to underline or frame, etc. 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. No submission fee is required whichever method the information provider takes. When the “information statement” in writing is submitted, it 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 about utilization of the information may be appropriately conducted upon the request of the provider, which includes:

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

B. Whether the provided information has been used for the first notification of reasons for refusal after the provision of information. (It is not necessary to provide feedback on whether the provided information has been used for the second notification of reasons for refusal and the results of the final examination.)

(9) Notification to a demandant of trial/appeal

The fact that the information was provided is notified to a trial demandant or an appeal appellant.

(10) Access to the provided information

The provided information is made available for browsing.

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

(12) Opportunity of explanation/interview, etc. 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 or other means, even if its purpose is to clarify the provided information or explain the 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 December 2023)