

## 10—04 PU

### Post-Grant Provision of Information

#### 1. Purpose

It is not considered to be an ideal situation where a patent (a utility model registration) is granted to an invention (a device) that is not originally patentable (registrable). In this regard, it is meaningful to allow provision of information even after a patent (a utility model registration) is granted to enhance the means of collecting information on validity of rights.

A system of post-grant provision of information is regulated under Enforcement Regulations of the Patent Act and Enforcement Regulations of the Utility Model Act (Enforcement Regulations of the Patent Act Article 13-3 and Enforcement Regulations of the Utility Model Act Article 22-2).

A system of post-grant provision of information for a patent will be explained in detail below (Regarding a registration of a utility model, only references to the related provisions are shown).

#### (1) Advantages of the system of post-grant provision of information

A. Patent owners may consider the provided information before utilizing their patent and at the same time solve any defects of their patent by a trial for correction if necessary. Thereby, unnecessary disputes may be avoided.

B. A person demanding a trial for invalidation may submit more fulfilling reasons and evidence for invalidation with reference to the information provided so far, and it may help to complement a patent review function.

C. When a trial for invalidation or a patent opposition is filed, since a panel has discretion on proceedings ex officio, provision of information may be a subject to ex officio proceedings if a panel finds it appropriate. Thereby more prompt and accurate proceedings may be expected.

#### (2) Comparison between a trial for invalidation, an opposition to grant of

## patent and post-grant provision of information

	Trial for Invalidation	Opposition to Grant of Patent	Post-Grant Provision of Information
Demandant • Petitioner • Information Provider	Only interested person	Any person (Anonymous is not allowed)	Any person (Anonymous is allowed)
Period of: Demand • Allegation • Provision of Information	Any time after establishing the right	Within 6 months after publishing a patent gazette	Any time after establishing the right
Existence of Proceedings	Yes	Yes	No (possible to become a subject of ex officio proceedings in a trial for invalidation or a patent opposition)
Involvement in Proceedings	Involvement as a party	Involvement as submitting a written opinion when a request for correction is filed	No involvement

Appeal Against Disposition	Possible to bring a suit to the Tokyo High Court (IP High Court) against a trial decision.	Possible to bring a suit to the Tokyo High Court (IP High Court) against a decision to revoke.  Not possible to bring a suit against a decision to maintain.	No measure for appeal.
Fee (Yen)	49,500 + (the number of claims x 5,500)	16,500 + (the number of claims x 2,400)	No fee

## 2. Overview

### (1) Persons being able to provide information

Anyone may provide information after a patent has been granted (Enforcement Regulations of the Patent Act Article 13-3 (1), Enforcement Regulations of the Utility Model Act Article 22-2(1)).

Since a name (trade name), a domicile (residence), etc. of an information provider can be omitted, the information can be provided anonymously (Enforcement Regulations of the Patent Act Article 13-3(3), Enforcement Regulations of the Utility Model Act Article 22-2(3)).

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

All patents (registered utility models) are subject to provision of information.

### (3) Time to provide information

Information may be provided any time after establishing the registration

of the rights (Enforcement Regulations of the Patent Act Article 13-3(1), Enforcement Regulations of the Utility Model Act Article 22-2 (1)).

(4) Types of information that may be provided

Information may be provided to the effect that the patent falls under the reasons for invalidation listed in the Patent Act each item of Article 123(1), but the reasons applicable to the provision are limited and not all reasons listed in the Article (Enforcement Regulations of the Patent Act Article 13-3(1) each item, Enforcement Regulations of the Utility Model Act Article 22-2 (1) each item).

Specifically, provision of information is limited to: an amendment adding a new matter (Patent Act Article 17-2(3)); patent eligibility (Patent Act the body of Article 29(1)); a lack of industrial applicability (Patent Act the body of Article 29(1)); a lack of novelty (Patent Act Article 29(1)); a lack of inventive step (the Patent Act Article 29(2)); secret prior art (Patent Act Article 29-2); prior application (Patent Act Article 39 (1)~(4)); violation of description requirements of specification (Patent Act Article 36(4)(i)); violation of description requirements of claims (Patent Act Article 36 (6) (i)~(iii)); a new matter beyond the original text (Patent Act Article 36-2 (2)); and unlawful correction (Patent Act the proviso of Article 120-5(2)), Patent Act the proviso of Article 126(1), (5)~(7), Patent Act the proviso of Article 134-2(1)).

On the other hand, the following types of reasons are not subject for provision of information: a lack of capacity of enjoyment of rights by foreign nationals (Patent Act Article 25); violation of public order and morality (Patent Act Article 32); violation of requirements for joint applications (Patent Act Article 38); violation of a treaty (Patent Act Article 123(1)(iii)); usurped applications (Patent Act Article 123(1)(vi)); and subsequent reasons for invalidation (Patent Act Article 123(1)(vii)).

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

Materials that may be submitted to the Japan Patent Office for provision

of information are only “documents”, and other materials than documents (such as a DVD recording the operation of a device) may not be submitted. Specifically, a typical document for submission 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 13-3(1), Enforcement Regulations of the Utility Model Act, the body of Article 22-2(1)).

(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 13-3(2) Form 20, Enforcement Regulations of the Utility Model Act Article 22-2(2) Form 15).

When preparing, it is necessary to clearly describe a reason that the patent at issue falls under one of the reasons for invalidation in the above (4) based on a submitted document listed in the above (5).

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) Storage and Access to the provided information

The contents of the provided information can be observed by an original record (stored in the system) or the submitted document stored in a file wrapper.

(9) Distribution of the provided information to a panel

The provided information stored in a system as an original record or stored in a file wrapper as the document shall be distributed to a panel together with the application record in a trial and appeal record file wrapper of a trial for invalidation, etc. As a result, a trial may be examined ex officio if the panel finds it appropriate.

(10) Notification to a right holder

The JPO notifies a right holder of the provision of information.

(11) Opportunity of explanation/interview on the information by the information provider

The information provider is not a party of a trial for invalidation or an opposition to grant of patent. 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 registrability of the right of the case.

(Revised December 2023)