

## **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)

**10—04 PU****Post-Grant Provision of Information**

## 1. Purpose

It is not considered to be an ideal situation where a patent is granted for an invention (a utility model) that is not originally patentable (registrable). In this regard, it is meaningful to approve provision of information even after granted a patent (registered a utility model) for improving 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 details below (and regarding the system for a utility model, only a related article will be shown for reference).

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

A. A patent owner may consider the provided information before utilizing the patent and at the same time solve a defect of a 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 evidences 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 trial for correction is requested, 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.

D. When a trial for correction is demanded at the same time as an

infringement suit, an alleged infringer (normally, a defendant) may take advantage of this system to provide an evidence used at an invalidity defense with an administrative judge. The accurate proceedings on the requirements for correction such as the independent patentability requirements may be performed in the proceedings of a trial for correction with no counterparty.

(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)
Involvement	Involvement as	Involvement as	No involvement

in Proceedings	a person concerned	submitting a written opinion when a request for correction is filed	
Statement of Dissatisfaction 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 statement of dissatisfaction
Fee (Yen)	49,500 + (the number of claims x 5,500)	16,500 + (the number of claims x 2,400)	No fee

## 2. Summary

### (1) Persons allowing to provide Information

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



(2) Rights subject to provision of information

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

(3) When information can be provided

Information can 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 can be provided

Information can 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.

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 patent application (the Patent Act Article 39 (1)-(4)); violation of description requirements of specification (the Patent Act Article 36(4)(i)); violation of description requirements of claims (the Patent Act Article 36 (6) (i)-(iii)); a new matter beyond the original text (the Patent Act Article 36-2 (2)); and unlawful correction (the Patent Act Article 126, the Patent Act Article 134-2).

On the other hand, the following types of reasons are not subject for provision of information: a lack of capacity of enjoyment of rights of foreign nationals (the Patent Act Article 25); violation of public order and morality (the Patent Act Article 32); violation of requirements for joint applications

(the Patent Act Article 38); violation of a treaty (the Patent Act Article 123(1)(iii)); usurped applications (the Patent Act Article 123(1)(vi)); and subsequent reasons for invalidation (the Patent Act Article 123(1)(vii)).

(5) Materials that can be submitted for provision of information

Materials that can 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) cannot 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 (1)).

(6) Formalities of a document 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 13-3(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 refusal in the above (4) based on a submitted document listed in the above (5).

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) 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, a trial for correction, etc. As a result, a trial may be examined ex officio if the panel finds it appropriate.

(10) Notification to a right holder

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

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

The information provider is not a party of a trial for invalidation, a trial for correction 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, etc. for clarifying the provided information or for explaining such as registrability of the right of the case.

(Revised Feb. 2015)