

## **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which a decision of rejection has become final and binding, patent (trademark) applications which have been abandoned, withdrawn or dismissed, or patent (trademark) applications for which patent (trademark) rights have already been established and registered).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)

**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)