

51-00 P U D T**Trial for Invalidation****1. Purport of the System**

If a patent right has any defect, the right holder would receive an unfair, illegitimate privilege, which would not allow any other party to implement or use the invention, causing various harmful barriers in industrial development. In such cases, a patent right needs to be invalidated to prove that such a right did not exist from the beginning or, at least, since the time the right was invalidated for reasons of late-coming invention (the Patent Act Article 123(1)(vii); the Utility Model Act Article 37(1)(vi); the Design Act Article 48(1)(iv); the Trademark Act Article 46(1)(v), etc.). To purposely respond to such a case, the system of a trial for invalidation has been established (the Patent Act Article 123(1); the Utility Model Act Article 37(1); the Design Act Article 48(1); the Trademark Act Article 46(1), 68(4).

2. History of Law Revision

The Patent Act, etc. has been revised in the following ways. In principle, for procedures of a trial for invalidation, the Patent Act valid at the time of the request for a trial for invalidation is applied. Regarding the reasons of invalidation, the Patent Act at the time of filing a patent application is applied.

(1) The 1993 Act on Partial revision of the Patent Act, etc. No. 26 (entered into force on January 1, 1994)

A new system of utility models wherein a right is granted without substantive examination has been introduced. Accordingly, procedures of a trial for invalidation have also been revised. For the utility models, once registered, correction can be made by submission of a written correction without the proceedings on its merits.

For patents (Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 4(2), Supplementary Provisions of the 2011 Act on Partial

Revision of the Patent Act, etc. Articles 19(2)), a new system of a request for correction has been introduced; it allows descriptions or drawings to be corrected during a procedure of a trial for invalidation. Accordingly, any request for a trial for correction is not accepted when a trial for invalidation is pending at the Japan Patent Office.

For patents, a trial for invalidation of correction was repealed. Accordingly, any amendment of adding new matters and any correction of adding new matters should constitute reasons for invalidation (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2), the Utility Model Act Article 37(1)(ii) of (ii)). However, any unlawful correction made by the trial for correction requested prior to December 31, 1993, does not constitute a reason for invalidation but will be contested in a trial for invalidation of the correction (Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 2(5) (the former Patent Act Article 129); Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 4(1), the Utility Model Act Article 40).

(2) The 1994 Act on Partial Revision of the Patent Act, etc. No. 116 (entered into force on January 1, 1996)

For patents, a system of post-grant patent opposition to grant of patent is introduced along with repeal of the system of publication of applications. Thus, the reasons for invalidation in amendments after publication were abolished. The 1994 revision concerning the requirements for patent descriptions and the provisions associated with applications in a foreign language are applied to patent applications filed on or after July 1, 1995 and patents pertaining to those applications (Supplementary Provisions of the 1994 Act on Partial Revision of the Patent Act, etc. Articles 6 and 7).

(3) The 1996 Act on Partial Revision of the Patent Act, etc. No. 68 (entered into force on April 1, 1997)

For trademarks, on the request from the Trademark Law Treaty, a trial for invalidation of renewal registration was repealed. Consequently, reasons for non-registration due to late-coming public interest, as in No. 5, are added in the reasons for invalidation of the Trademark Act Article 46(1).

(4) The 1998 Act on Partial Revision of the Patent Act, etc. No. 51 (entered into force on January 1, 1999)

Any amendment to change the gist of the reasons for the request for a trial for invalidation is not permissible in patents, former utility models, designs, and trademarks.

(5) The 2003 Act on Partial Revision of the Patent Act, etc. No. 47 (entered into force on January 1, 2004)

For patents, the system of post-grant patent opposition to grant of patent was repealed and incorporated into the system of a trial for invalidation, thereby allowing anyone to request a trial for invalidation. Additionally, the description requirements in reasons for the request for a trial shall be clarified and changes to the reasons initially stated in a request for a trial as a new means of attack are allowed as an exceptional case. Furthermore, when a trial for correction is requested after a revocation action against a trial decision for invalidation is filed, a new provision is established to allow the trial decision to be cancelled and to be returned to the Japan Patent Office by the court's decision. Accordingly, "the request for a trial for correction" is incorporated into the returned case of a trial for invalidation as a "request for correction".

(6) The 2004 Act on Partial Revision of the Patent Act, etc. No. 79 (entered into force on April 1, 2005)

For utility models, if a trial for invalidation is pending, correction for the purpose of restriction of the scope of claims of utility model registration is permissible only once during the period of submission of an initial written answer. Any correction that fails to fulfill the requirements is added as a reason for invalidation.

(7) The 2011 Act on Partial Revision of the Patent Act, etc. No. 63 (entered into force on April 1, 2012)

A. In procedures for a patent trial for invalidation, an "advance notice of trial decision" is given, thereby allowing a request for correction. A request for a trial for correction after filing a revocation action against a trial decision for invalidation is prohibited.

B. When a trial for invalidation involves two or more claims of patent, new provisions

concerning units to be corrected and scope of final and binding decisions, etc. are provided.

C. After a final and binding trial decision of a trial for invalidation is made, anyone, except for interested parties and interveners, may request for a trial based on the same facts and the same evidence.

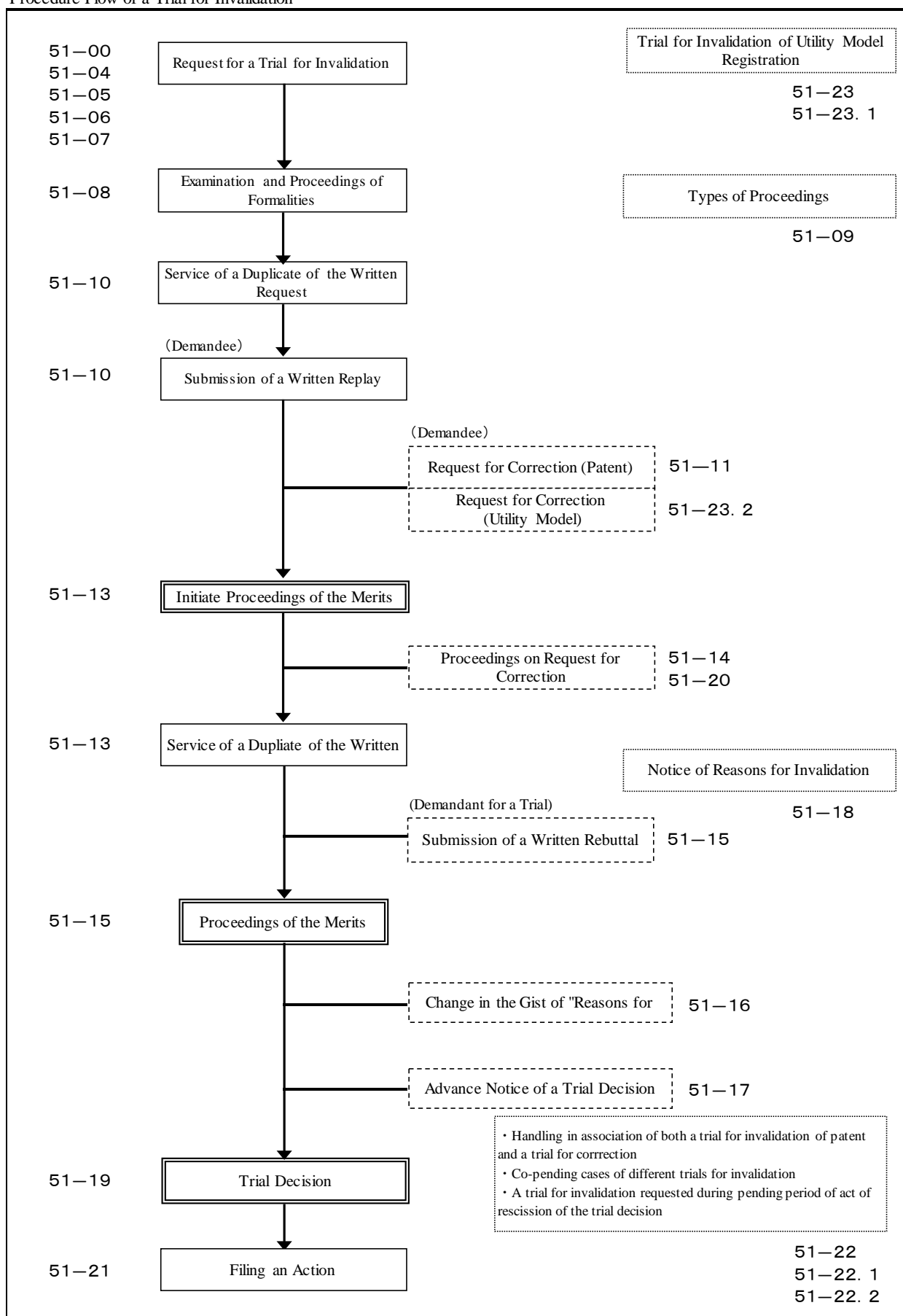
D. When a patent, utility model registration, or trademark registration is granted for an application which was filed by a person who is not entitled to obtain a patent, etc., or for an application with violation of joint applications, any person who is entitled to obtain a patent, etc. may request the illegitimate right holder to transfer the right. In connection with this revision, eligibility of the demandant has been reviewed in relation to the reasons for invalidation concerning attribution of rights.

E. For patents corrected on the basis of Act before the 2011 revision, provisions for the requirements of the purpose for corrections in a trial for invalidation (the Patent Act Article 123 (1) (viii)) by reasons of unlawful corrections is applied to a provision on the basis of laws before the 2011 revision even if the trial for invalidation was requested after April 1, 2012 (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 2(21)).

(8) The 2014 Act on Partial Revision of the Patent Act, etc. No. 36 (entered into force on April 1, 2015)

As a result of the introduction of a system of opposition to grant of patent, only concerned parties are allowed to request a trial for invalidation. For a trial for invalidation of trademark registration, it is clarified for confirmation purpose that only concerned parties are allowed to request.

Procedure Flow of a Trial for Invalidation



(Revised June 2019)