

51-07 P U D T**Written Request for a Trial for Invalidation**

1. General

(1) In filing a request for a trial for invalidation, the demandant is required to submit the relevant written request that fulfill the requirements defined in the Patent Act Article 131(1)(2), the Utility Model Act Article 38(1)(2), the Design Act Article 52, and the Trademark Act Article 56(1)) (Enforcement Regulations of the Patent Act Article 46(1); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 14(1); Enforcement Regulations of the Trademark Act Article 14).(→21-00)

(2) The number of duplicates (for dispatch and for proceedings) to be submitted

Regarding the written request and its attachments, duplicates of each document corresponding to the number of counterparties (including intervenors) and (for other cases when proceedings are consolidated) one duplicate (Enforcement Regulations of the Patent Act, Article 4; Enforcement Regulations of the Utility Model Act Article 23(1); Enforcement Regulations of the Design Act Article 19(1); Enforcement Regulations of the Trademark Act Article 22(1); Enforcement Regulations of the Patent Act Article 50(2); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)) for proceedings (Enforcement Regulations of the Patent Act Article 50-4; Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)) must be submitted.

This requirement applies to all the concerned documents of a trial for invalidation (including evidence and written request for correction according to the Patent Act Article 134-2).

2. Purport of a Request

(1) The request of a demandant must identify the contents of the request (the conclusion of the trial decision that the demandant attempts to obtain), wherein the subject of the request must be clearly defined.

(2) In general, a statement should read “the demandant hereby requests a trial decision that the patent granted in Japanese Patent No. XX (the registered utility model in registration No. XX, the registered Design in registration No. XX, the registered trademark in registration No. XX) shall be invalidated and the demandee shall bear all the cost of the trial.”

When two or more claims or multiple designated goods/services are involved, and when a trial for invalidation is requested for each claim or designated goods/services, a statement should read as, “The demandant hereby requests a trial decision that claim X described in the scope of claims under the patented invention in Japanese Patent No. XX shall be invalidated, and the cost for trial must be borne by the demandee.” or as “The demandant hereby requests a trial decision that “XX” in class X among the designated goods of the Japanese trademark registration No. XX shall be invalidated. The cost for trial must be borne by the demandee.”

The trial for invalidation of a patent is handled on the assumption that the request is filed by “each claim” even if the claim for trial is not specified in the purport of the request.

(3) When the number of claims has changed in a trial for invalidation of a patent as a result of, for instance, a trial for correction, etc., the purport of the request for a trial for invalidation may change. However, the request should not be handled as having changed its gist.

3. Reasons for a Request

The “reasons for request” for a trial for invalidation of a patent, utility model, or registered design must specifically identify the facts on which the proposed invalidation is based and must describe the relations of each evidence with the facts

that require proof (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52).

(1) “Specifically identify the facts on which the proposed invalidation is based.”

A. “The facts on which the proposed invalidation is based”—Comprehensive coverage of principal facts—

“The facts on which the proposed invalidation is based” refers to the specific facts (i.e., the principal facts) composing the requirements in line with the provisions of the Act (“required facts”) providing the reason for the reasons for invalidation.

In general, specific reasons for invalidation in line with provisions of the Act are constituted by a plural number of requirements, while “The facts on which the proposed invalidation is based” should also exist in response to each requirement. Therefore, all “facts” corresponding to each of the requirements must be described comprehensively. See the following examples:

(A) If invalidation has been claimed on the reason that the reference date is fluctuated, such as the filing date of the application is post-dated, the requirements in the provisions of the Act in relation to post-dated application (for example, the Patent Act Article 44(2)) are the principal facts.

(Example) The violation of the requirements of division of the application (the Patent Act Article 44(2)), the violation of the requirements of conversion of the application (the Patent Act Article 46(5)→ the Patent Act Article 44(2)), the invalidity of claiming priority (the Patent Act Article 41(2)(3),etc.)), or the non-conformity with the requirements of exceptions to lack of novelty (the Patent Act Article 30(1)(2)).

(B) Even well-known facts (e.g., well-known arts, commonly used technology) must be described as reasons for the request or as facts on the reason of the invalidation of rights, as long as those facts constitute principal facts composing the requirements in the provisions of the Act.

(C) Any indirect facts that might lead to the assumption of principal facts or any supporting facts that might enhance the value of the evidence necessary to prove the principal facts do not constitute the principal facts; therefore, they are not necessarily

described as the initial reasons for the request. It is desirable to describe such supplementary information if necessary. However, depending on the nature of the case, wherein showing the existence of principal facts by any means is not possible and the only available principal facts could be expressed in the form of indirect facts that should certainly lead to an assumption of the principal facts, such indirect facts must be described in the initial reasons for the request because those indirect facts substantially claim the principal facts.

B. “Specifically identify”—Specificity and Identity of principal facts —

It is required to describe “specifically identify” the facts that should constitute reasons to invalidate the existing rights. Therefore, principal facts must be described precisely enough to satisfy the requirement.

For instance, if a lack of novelty is the reason for invalidation, claiming the fact that the patented invention was described in a publication that had been distributed prior to filing the application, then it is required to specifically describe that the invention’s content (identifying the invention) was listed in which particular publication (identifying the publication), was publicized when (identifying the fact of the antecedent), where (identifying the place of distribution), on what page of the publication, and where the said invention is described (identifying the description).

In a description of the reason for request, merely stating the name of the publication as a fact of an existence of a prior art does not identify the specific facts to which the right holder can respond, therefore, such description does not fulfill the requirement for the description requirements (the descriptions lack specificity and identity in that there is no specific fact of the antecedent that can be based on the descriptions).

In other words, the descriptions of a reason for the request must be specifically stated with principal facts in a way that the facts providing the reason to invalidate the right can be understood without carefully examining the publication as a proof.

If a demandant fails to attach any proof to the initial request for the trial on the assumption that the subsequent examination of evidence might follow, the demandee

cannot understand any content of the fact as proof. Therefore, specifically identifying the principal facts is necessary so that they can be understood by merely reading the descriptions of the reasons for a trial.

(2) “Describe the relations of each evidence by the facts that require proof.”

The descriptions of reasons for request are required to describe the relations of each evidence respectively to the facts that require proof (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52).

A. “Facts that require proof” (“factum probandum”)

The term “facts that require proof” in a trial for invalidation is defined as every “fact providing the reason to invalidate the right,” specifically identifying principal facts claimed by a demandant according to (1) above.

However, obvious facts evident to a panel are not required to be proved and hence cannot be the facts that require proof. Additionally, any application of laws is not considered the issue of a fact; therefore, this is not a fact that requires proof. In a trial for invalidation under the principle of *ex officio*, differing from a civil suit, any confession is not deemed valid. (See replaced provisions of the Civil Procedure Act Article 179 in the Patent Act Article 151.) Therefore, any principal fact that a right holder has no intention to argue still requires proof; hence, every principal fact is a fact that requires proof (except for obvious facts evident to a panel).

B. “Describe the relations of each evidence with the facts that require proof.”

The requirement “to describe the relations of each evidence respectively to the facts that require proof” is based on the assumption that facts (almost the same as principal facts) that require proof may be plural, because provisions of the Act of the grounds of reasons for invalidation are in general configured of a plural number of requirements.

When each fact that requires proof is supported by different evidence, the relations between each fact and each evidence may possibly become ambiguous. In such case, describing how each fact that requires proof corresponds to each evidence is required, to avoid a right holder having the burden of response or to avoid any delay in proceedings.

(Example) When a violation of inventive step is claimed as the fact basis of the reason for invalidation and a prior art document is submitted as an evidenced document, assuming that the document corresponds to a publication stipulated in the Patent Act Article 29(1)(iii), clarification might be required to determine whether to prove the existence of “the invention listed in the respective items of the preceding paragraph,” as stated in the Patent Act Article 29(2), or to prove “the ordinary skill in the art to which the invention pertains,” as stated in the Patent Act Article 29(2). In such case, the description must be one that can clearly identify what facts requiring proof can be proved by that evidence.

For a case wherein only a small part of an extremely large volume of evidence is used to prove facts that require proof, a description is required to indicate not only the relation of that large volume of evidence to the facts that require proof by a reference number of the evidence attached to the whole evidence, but also to indicate more specifically what part of the large volume of evidence corresponds to the facts that require proof is necessary.

(3) Description examples of “Reasons for request” (Patents, Utility Models)

When claiming reasons for invalidation of a patented invention based on the violation of the inventive step, specifically describe the facts (the principal facts) relating to the reasons for invalidation in line with the requirements (required facts) stipulated in the Patent Act Article 29(2), which states, “the invention that a person skilled in the art could have easily achieved before the application of the patent based on the invention prescribed in any of the items of the Patent Act Article 29(1).”

A. Identify a patented invention (the claimed patented invention) subject to request

Define the reasons for invalidation of a patented invention relating to what claims are subject to invalidation, so as to identify the patented invention by summarizing the descriptions of the scope of the claims for patent (claims) of the concerning patented invention. Additionally, describe the problems to be solved and the technical effects of the patented invention to claim and prove the reasons for invalidation if the request is based on the violation of inventive step.

B. Existence of a prior art invention

In particular, describe the fact of the existence of a prior art invention before filing an application concerning the patented invention under any items in the Patent Act Article 29(1). For example, when proving the existence of a prior art invention by a publication describing the claimed invention, as stated in the Patent Act Article 29(1)(iii), the descriptions should be “In a publication written by XXX, titled “XXXX,” Xth edition of XX publisher, on page XX, line XX to line XXX describes XXXXX of the invention, distributed on XXX year, XX month, XX date, which is prior to the date of the application of the concerning patent dated YY year YY month YY date.” Identify the following: publication title, author’s name, edition number, country of publication, publisher, date of publication, and also specifically identify the descriptions of concern in the publication so as to specify the prior art invention provided from the descriptions in the publication.

C. Comparison between the subject patented invention and the prior art invention

Based on the descriptions of the scope of the claims relating to the subject patented invention, describe the subject patented invention by divided into small sections, if necessary, as well as compare with a prior art invention to specify points of agreements and differences.

D. A point of differences which can be easily achieved by a person skilled in the art

Describe the facts providing the differences between the two inventions can be easily achieved by a person skilled in the art.

To meet the requirements of the Patent Act Article 29(2), it is necessary to assert that a person skilled in the art could have easily achieved the invention before the application of the subject patented invention. If necessary, define a person skilled in the art (having ordinary skill in the art that the invention belongs to) prior to the application of the subject patented invention (for instance, identifying the “technical field the invention belongs to,” “ordinary skill,” and “before the application”). Then, describe the facts providing the reason that any person skilled in the art could have easily achieved the claimed patented invention (including a logical structure for easily

achieving the invention).

E. Conclusion

The subject patented invention is an invention that was described in a publication (Exhibit No. 1), or an invention which could have been easily achieved by a person skilled in the art based on the descriptions in a publication (Exhibit No. 1) , distributed prior to the date of application of the subject patented invention. Thus, the subject patented invention was granted in violation of the provisions in the Patent Act Article 29(2); therefore, it is hereby concluded that the patent shall be invalidated under the provisions of the Patent Act Article 123(1)(ii).

(Reference: “Evidence in general”) (→34-01 - 01.1)

(Revised June 2019)