

51-17 P

Advance Notice of Trial Decision

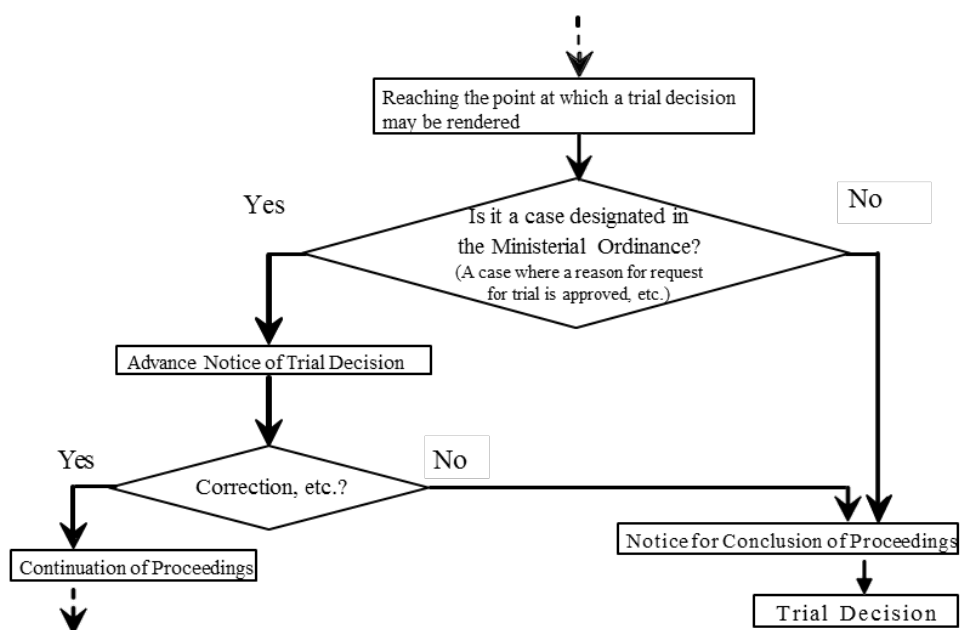
1. Outline of the Proceedings Procedure Concerning the Advance Notice of Trial Decision

In a patent trial for invalidation filed on or after April 1, 2012, if the case is considered ripe for trial decision, and if it is so determined by ministerial ordinance (when it is determined that the request for trial is reasonable, that the request for correction is not accepted, etc.), an “advance notice of trial decision” is given (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2).

If the “advance notice of trial decision” is not given, the trial decision is made after conclusion of the proceedings (the Patent Act Article 156(2), (4)).

In response to the “advance notice of trial decision,” the demandee may make a request for correction or amend a corrected specification, etc. (the Patent Act Article 164-2(2), 134-2(1)), and if this is not done, the proceedings are concluded, and the trial decision is made (the Patent Act Article 156(2), (4)).

【Figure】 Outline of the procedures after the case has reached the point at which a trial decision may be rendered



2. Outline of the Advance Notice of Trial Decision

An advance notice of the trial decision is a procedure established to prevent the occurrence of the “catch-ball phenomenon: “inefficiently the issue goes back and forth” between the court and the patent office, where the panel shows the decision to the demandee, and provides the demandee with an opportunity for correction based on the decision.

(1) Contents of the advance notice of trial decision

In an advance notice of a trial decision, the same matters as in a trial decision shall be described (the Patent Act Article 164-2(3) → the Patent Act Article 157(2)). In conclusions and reasons, a determination whether or not all corrections are allowable, and a determination whether or not all the claims demanded for the trial are valid are described as detailed as the trial decision (Description of trial decision → 51-19 3.). Of these, with regard to determining the validity, in principle, all the reasons (reasons claimed by the demandant and reasons for invalidation by ex-officio if notified) shall be examined in the proceedings, and then described in the advance notice of trial decision.

(2) Procedure for the advance notice of trial decision by the party

The period (normally 60 days (90 days for overseas residents) → 25-01.2) is specified for the demandee to request for corrections, but for the both parties, to request their arguments are not asked again by specified the period (the Patent Act Article 164-2(2)).

3. Proceedings When the Case is Ripe for Making a Trial Decision

(1) When the case is ripe for the first trial decision after starting the proceedings

In principle, when the time is ripe to make the first trial decision after starting the proceedings, an advance notice of trial decision shall be made (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(i)).

However, in the following cases where there is no need to give a demandee an opportunity to make corrections, a trial decision shall be made without providing the

advance notice of trial decision. (Enforcement Regulations under the Patent Act Article 50-6-2(i); the Patent Act Article 156(2))

- Where a demandee offers not wishing to receive the advance notice of the trial decision

- Where no request for correction has been made, and all the claims after the appeal have been deemed valid

- Where all corrections concerning to the claims for a request for a trial are permitted, and all the claims for a request for a trial are determined to be valid

If an advance notice of the trial decision is made, the procedure continues as follows, depending on whether the demandee has requested for correction.

A. In cases with a request for correction

Generally, the demandant is given an opportunity to refute.

If the advance notice of the trial decision has been already given, the oral proceedings may be conducted only when deemed necessary.

B. In cases without a request for correction

Because the subject of the proceedings remains unchanged, if there is no other change in circumstances, usually, the proceedings are concluded (the Patent Act Article 156(2)), and the trial decision is made on the basis of content of the judgment described in the advance notice of the trial decision.

Basically, the content described in the advance notice of the trial decision may be described in the trial decision, but it is acceptable to refer to the written statement, etc. submitted after the advance notice of the trial decision. Furthermore, if giving another opportunity for correction is accepted to be reasonable (for example, an addition or a change of evidence is involved), the advance notice of the trial decision is made once again.

(2) When the case is ripe to make a trial decision again

In principle, as a result of the proceedings in accordance with the above (1) a, when the time is ripe to make a trial decision again, the trial decision shall be made on the basis of the purport of the advance notice of the trial decision described in the above 2.

The demandant sometimes adds or changes reasons for invalidation after a request for correction is made against the advance notice of the previous trial decision (when

an amendment has been made to change of gist in the written appeal, and the chief administrative judge has granted it as a result of the correction, etc.), but with regard to these reasons for invalidation, an advance notice of a trial decision is not given. When an amendment to change the gist is permitted, an opportunity for correction and answer is provided (the Patent Act Article 134(2)).

Meanwhile, depending on the reason filed by the time of the advance notice of the

○ An example where it is appropriate to give a chance of correction

When a reason for invalidation B accompanied by an examination of evidence is filed at the proceedings, together with the reason for invalidation A based on the document as evidence, from the viewpoint of efficiently conducting the trial, it may be possible to give an advance notice of the trial decision only with the invalidation reason A, while the trial examination of the invalidation reason B is pending due to taking a long time to examine the evidence. At this time, when the reasons for invalidation A described in the advance notice of the previous trial decision cannot be maintained, and as a result of proceedings of the reasons for invalidation B held, it becomes a conviction for invalidation, if a trial decision is made without disclosing a mental evidence for invalidation reason B and without giving a chance for correction, it would be a surprise for the demandee, so an advance notice of trial decision is made on the invalidation reason B.

Such a case is an exception, and it is the principle that all the trial examinations are made at the time of giving an advance notice of the earlier trial decision, as to the reason for which the demandant had filed.

previous trial decision or depending on the reason notified as the result of the ex-officio proceedings (limited to those for which an advance notice of trial decision has not been made for the stated reason), if a reason is found for a request for appeal, an advance notice of a trial decision is made. (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(iii))

(3) In cases where the trial decision is canceled and remanded to the Patent Office and where the time is ripe for the first trial decision after starting the proceedings

These cases are the same as the above (1) because it is necessary to redo the previous procedures and proceedings. As a general rule, an advance notice of trial decision is given when the case is deemed ripe to make a first trial decision since the proceedings started after remanded. (the Patent Act Article 164-2(1); Enforcement Regulations under the Patent Act Article 50-6-2(ii)) See (1) and (2) above for further proceedings procedure.

(Revised June 2019)