

## **58-00 PUDT**

### **Hantei**

#### **1. Advisory Opinion System and Purport of the System**

The advisory opinion system is a system in which the Japan Patent Office expresses an official opinion, upon request, on the technical scope of a patented invention or of a registered utility model, the scope of a registered design or a design similar to it, or the scope of effect of a trademark right (referred to as “the technical scope of a patented invention, etc.” in 58-00 to 58-03 below) from a neutral and fair standpoint (the Patent Act Article 71). The purport of the system is that the Japan Patent Office expresses an official opinion on the technical scope of the patented invention upon request, thereby contributing to protection and use, etc of the invention adapted to the purpose of the law, as well as prevention of a dispute or early resolution of a dispute.

To explain it using a patent right as an example, the patentee has an exclusive right to work the patented invention business (the Patent Act Article 68), and the right has an effect extensively also on third parties. The effect continues even after expiration of a patent term: the patentee may claim compensation for damages for patent right infringement committed by a third party during the patent term.

With regard to a patent right, the following issues may arise:

- (1) The patentee desires to know whether or not a patented invention owned by a third party, or a technology implemented by a third party, etc., falls within the technical scope of the patented invention of the patentee.
- (2) A non-patentee desires to know whether or not a technology for which a plan of development investment or project implementation is being made or a technology actually being worked does not fall within the technical scope of a patented invention owned by a patentee.

In such cases, it is advantage of the system to provide a determination of the technical scope of a patented invention at issue without delay and from a neutral standpoint by a person who has highly specialized and technical knowledge, and it is further advantage that a person who desires to obtain the determination can readily use the same, so that the system can contribute to protecting and

using the invention adapted to the purpose of the law and also contributes to preventing a dispute or early resolving a dispute

Thus, the advisory opinion system is a system based on the provisions of the Patent Act Article 71, wherein the Japan Patent Office which participated in the establishment of a patent right, expresses an official opinion upon a demand therefor on the technical scope of a patented invention using its highly specialized and technical knowledge.

The aforementioned purport of an advisory opinion system is concerning a patent right but it also applies to advisory opinion systems concerning a utility model right, a design right, and a trademark right.

## **2. Nature of Advisory Opinion**

An advisory opinion is provided to express the Japan Patent Office's official opinion on the patented invention's technical scope, etc, and it is by nature limited to providing an expert opinion without any legal binding force, and it does not correspond to dispositions by a relevant administrative agency pursuant to the Administrative Complaint Review Act or any other deed corresponding to an exercise of a public authority (the Administrative Complaint Review Act Article 1).

Nevertheless, being an expert opinion provided by the Japan Patent Office, which is a highly specialized and technical government administrative office, an advisory opinion is deemed one of determinations that are fully appreciated in society and considered authoritative (Decision of June 14, 1967, Kanazawa Branch, Nagoya High Court (1966, (Ne) No. 137)).

## **3. Advisory Opinion for Determination Concerning the Standard Essentiality**

With regard to an advisory opinion concerning a patent right, a demand for an advisory opinion as to whether a patented invention is essential to a specific standard may be made (an advisory opinion for essentiality check). An explanation will be provided in 58-04 below on an advisory opinion for determination concerning the standard essentiality.

(Revised Jun.2019)