

## **58-01 PUDT**

### **Hantei Procedures**

#### **1. Subject on Which a Request for an Advisory Opinion May Be Made**

A request for an advisory opinion may be made on the technical scope of a patented invention, etc. (→58-00 1.) (the Patent Act Article 71((1)9; the Utility Model Act Article 26 → the Patent Act Article 71(1) → the Design Act Article 25(1); the Trademark Act Article 28(1); the Trademark Act Article 68(3) → the Trademark Act Article 28(1)). This section primarily explains an advisory opinion concerning a patent right.

#### **2. Party to an Advisory Opinion**

##### **(1) Party and a benefit of request**

Because an advisory opinion's result has no legally binding force on a party to the case, no legal interest is required for demanding an advisory opinion. Nevertheless, it is necessary to have a benefit of request in demanding an advisory opinion pursuant to the purport of the advisory opinion system: 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. Thus, it is desirable to clarify a benefit of request when demanding an advisory opinion pursuant to the purport of the system by stating in a written request the necessity of demanding an advisory opinion in the section for reasons therefor.

##### **(2) Demandant and demandee**

Because a benefit of request is required in demanding an advisory opinion pursuant to the purport of the system, there exists a demandee and the adversary system is employed in most cases. However, even when there is no demandee, leaving the demandant as a sole party, an advisory opinion may be demanded, given that the party has a benefit of request in demanding an advisory opinion pursuant

to the purport of the system. It is noted that, in a demand for an advisory opinion, it is prohibited to conceal the existence of a demandee while a person who should be a demandee exists or to designate an imaginary counterparty who is not the person working Object A and to receive an advisory opinion, thereby making inappropriate use of the determination (→58-03-1(1) B(E), (F)).

The following cases are provided as examples of the mode in which an advisory opinion is demanded:

A. Cases where a demandee exists and the adversary system is employed

(A) A patentee demands an advisory opinion on a technology that is, or was, actually worked by a third party designated as a demandee.

(B) A patentee who desires to have better understanding of the use relationship of the patent right demands an advisory opinion on a patented invention owned by another patentee, designating those including said another patentee as a demandee.

(C) A person other than the patentee demands an advisory opinion on a technology that the said person is working or intends to work on, designating the patentee as a demandee.

(D) An exclusive licensee demands an advisory opinion on a technology that a third party is actually working or has worked, designating the third party as a demandee.

(E) A person other than an exclusive licensee demands an advisory opinion on a technology that the said other person is working or intends to work on, designating the exclusive licensee as a demandee.

B. Cases where no demandee exists

(A) A patentee demands an advisory opinion on a technology that the patentee is working or intends to work on.

(B) A patentee demands an advisory opinion on a technology whose worker is unknown.

(C) An exclusive licensee demands an advisory opinion on the technology that the exclusive licensee is working on.

(D) An exclusive licensee demands an advisory opinion on the technology whose worker is unknown.

### **3. Written Request for an Advisory Opinion**

(1) General

A demandant shall submit a written request for an advisory opinion to the Commissioner of the Japan Patent Office, stating the following (the Patent Act Article 71((3)); Enforcement Regulations of the Patent Act Article 39; the Utility Model Act Article 26 → the Patent Act Article 71((3)); Enforcement Regulations of the Utility Model Act Article 23(7) → Enforcement Regulations of the Patent Act Article 39; the Design Act Article 25(3) → the Patent Act Article 71((3)); Enforcement Regulations of the Design Act Article 19(5) → Enforcement Regulations of the Patent Act Article 39; the Trademark Act Article 28(3) → the Patent Act Article 71(3); the Trademark Act Article 68(3) → Article 28(3) → the Patent Act Article 71(3); Enforcement Regulations of the Trademark Act Article 22(4) → Enforcement Regulations of the Patent Act Article 39).

item (i): indication of the case of demand for an advisory opinion (→ (2));

item (ii): the name and domicile or residence of a party and an agent and a representative's name when the party is a corporation or an association, etc, other than a corporation. (→ (3));

item (iii): the purport of the demand and the reasons therefor (→ (4), (6)).

#### (2) Indication of the case of a demand for an advisory opinion

A statement is made, indicating a patent (registration) number, as “Demand for Advisory Opinion on Patent No. XX” (Enforcement Regulations of the Patent Act Article 39, Form 57, Remark 1).

#### (3) Indication of the party

A. When a demandee exists, the demandee shall be stated without fail.

However, when there is no demandee (→ 2. (2)B), the demandee need not be stated (→ in a case where a demandee is not stated for no obvious reasons or in case of a strongly suspected concealment of a demandee's existence; 58-03, 1. (1)B(E)).

When a demandee is a right holder, the demandee's domicile (residence) and name stated in a written request for an advisory opinion shall agree with the right holder's domicile (residence) and name stated in the register.

B. Likewise, when a demandant is a right holder, the demandant's domicile (residence) and name stated in a written request for an advisory opinion shall agree with the right holder's domicile (residence) and name stated in the register.

#### (4) Purport of demand

In a procedure on an advisory opinion concerning a patent right, the section for the purport of a demand is used for specifying and stating whether the given technical content (typically specified by

drawings of Object A or an explanatory document of Object A) does or does not belong in the technical scope of the patented invention.

The same applies to a registered utility model.

With regard to a registered design or a design similar to it, it is typically stated that an advisory opinion is demanded to confirm that the design shown in drawings of Object A and an explanatory document thereof belongs (or does not belong) in the scope of the registered design or a design similar to it.

With regard to a registered trademark, it is typically stated that an advisory opinion is demanded to confirm that a mark, Object A, which is designated for the goods “XXX,” belongs (or does not belong) in the effective scope of a trademark right under Trademark Registration No. XX.

#### (5) Object A and specification thereof

##### A. Object A

In a demand for an advisory opinion, Object A refers to, when a counterparty to a right holder exists, a technology worked by the counterparty, and refers to a technology compared with a patented invention of a right holder when the right holder demands an advisory opinion without any counterparty.

Object A is indicated as drawings of Object A, an explanatory document of Object A, a mark of Object A, or the like. There exists one Object A in a single demand for an advisory opinion.

##### B. Specification of Object A

It is required that a written request for an advisory opinion sufficiently specifies Object A so as to enable administrative judges to examine it.

When Object A exists as a tangible product, the product is specified by its trade name, model number, etc.

The technical features of Object A shall be sufficiently in writing to a degree that enables comparison with the recitation of claims of a patented invention. In this case, the category of Object A shall agree with the category (product or process) of the patented invention.

#### (6) Reasons for the demand

The section for stating “Reasons for the Demand” is used to specifically describe the necessity of demanding an advisory opinion (→ 2(1)), the history from application through registration of establishment (when a relevant request for trial, appeal, or a lawsuit was filed, the case number

thereof, etc.), a patented invention of the present case, the technical feature of Object A, comparison of Object A to the patented invention, explanation that Object A belongs (or does not belong) in the technical scope of the patented invention, etc.

#### (7) Means of Proof

The section “Means of Proof” is used for indicating a proof, facts to be proved, and explanation of the proof, etc. Furthermore, a written explanation of the proof shall be presented by clarifying the document’s headings, the author thereof, and facts to be proved , unless these are obvious from the statements in the document.

When the document filed as proof is written in a foreign language, the translation of relevant parts thereof shall accompany the document.

Upon filing a request for an advisory opinion, it is desirable that all necessary items of proof be presented.

#### **4. Time Period in Which a Demand May Be Made**

In principle, a demand may be made after the registration of the right’s establishment.

Also, a demand may be made even after lapse of the right, except when 20 years have passed after the right’s lapse and, at that point in time, rights concerning the patented right, such as the right to claim compensation for damages and the right to file a complaint, have all expired by prescription or when there is no pending trial case (Regulations under the Patent Registration Order Article 5).

#### **5. Registration in patent registry**

When an advisory opinion is demanded, the demand is entered on the margin of the patent registry and is disclosed in the patent gazette.

(Revised Jun.2019)