58-03 PUDT

Proceedings of Hantei

1. Proceedings on Advisory Opinion

This section primarily explains an advisory opinion concerning a patent right.

(1) Written request for an advisory opinion

A. General

Information necessary in a written request (→58-01-3(1)).

Handling of a written request with informalities (→21-00).

B. Relevant parties

(A) Cases including those in which a written request fails to state some demandees in the case of a jointly owned patent right (the Patent Act Articles 71(3) and 132(2))

Since an advisory opinion has no legally binding force, not all patentees need to be designated as demandees. Therefore, even when some joint patentees are not indicated in the section for the demandee, the procedure is conducted without ordering for amendment.

However, since there may be cases in which some patentees have an imperative interest in the case, an administrative judge shall, with regard to a demand designating some joint owners as demandees, send a duplicate to the other joint owners and seek their opinions ex officio if the administrative judge deems it is necessary.

Likewise, when a demand for an advisory opinion is made on a patent right for which an exclusive licensee exists, designating the patentee as a demandee, an administrative judge shall send a duplicate to the exclusive licensee and seek the opinion ex officio if the administrative judge deems it is necessary.

(B) Since the Patent Act Article 132(3) is not applied mutatis mutandis to the Patent Act Article 71(3), it is not necessary for a case in which a patented invention, on which a demand for an advisory opinion is made, is jointly owned, that all patentees be designated as joint demandants.

(C) When a succession to a right on which a demand for an advisory opinion has been made occurs while the case is pending, the procedure may be continued with the successor in title to the right.

(D) In case of death of a party

Proceedings on the demand for an advisory opinion are conducted on the understanding that the provisions relating to the suspension and termination of the procedure (the Patent Acts 22 to 24 and the Code of Civil Procedure, Article 124 onward) do not apply to the procedure on the advisory opinion.

a. When a deceased party is the patentee

The procedure may be continued with a successor in title to the right.

b. When a deceased party is a non-patentee

(a) When a deceased party is the demandee

Since there may be a case in which a demand with no demandee should be admitted for an advisory opinion, proceedings are conducted on such a demand as filed in the absence of a demandee.

(b) When a deceased party is the demandant

No right to demand an advisory opinion is legally provided, nor is a succession thereto conceivable. Accordingly, when no succession is reported, the case is closed on the understanding that the demand ceased to exist with the demandant's demise. However, when an actual conflict such as an infringement on a right has occured, to save the successor to a business working on the technical content of Object A the trouble of newly demanding an advisory opinion, the procedure is continued with the successor only upon receiving the successor's petition to do so. When a demandee exists, the demandee shall be also notified thereof.

The same applies as it is to the case of dissolution of a corporation.

(E) With regard to an advisory opinion seeking determination to "belong" (positive opinion) to the technical scope, etc. of the patented invention with no demandee indicated, when reasons for not indicating a demandee are not explicit, an inquiry is conducted. As a result of the inquiry, when one who should be designated as a demandee exists, it is ordered to state the demandee. When it is strongly suspected that the existence of one who should be the demandee is concealed, it is ordered for amendment to indicate the demandee in the request.

In the demand for an advisory opinion, if, although one who should be a demandee exists, the existence thereof is concealed, or an imaginary counterparty, who is not the person working Object A is indicated, so as to obtain an advisory opinion and inappropriately use the determination thereof, adverse effects might be expected, such as an undesirable conflict in the relevant industry. Another

reason for issuing such an order is that an advisory opinion provided on the basis of a one-sided allegation of a demandant, without considering the counterparty's response, is not the result of a fair, appropriate procedure; which should be avoided whenever possible.

(F) In a demand made by a third party seeking an advisory opinion with regard to the technical scope of a patented invention, etc. "not to belong" (negative opinion), when no demandee is indicated, a notification is made that a right holder (patentee or exclusive licensee) in the registry be indicated as a demandee and that if there is no response to such a notification, the right holder will be treated as the demandee.

In this case, when the demandant fails to respond by indicating a right holder as demandee, the proceedings are continued with the right holder in the registry as the demandee.

(Note) A duplicate of the request for an advisory opinion is sent to the right holder in the registry. A written advisory opinion states the name of the right holder.

(G) Benefit in demanding an advisory opinion pursuant to the purport of the system

Any demand for an advisory opinion is dismissed when no benefits are acknowledged in demanding an advisory opinion pursuant to the purport of the system (the Patent Act Article 71(3)→Article 135).

C. Purport and reasons for demand

(A) Any amendment altering the purport and reasons for a demand is not permitted because it will result in alteration in the gist of the written request for an advisory opinion (the Patent Act Articles 71(3) and 131-2(1)), Main Paragraph). For example, changing Object A (for which an advisory opinion is demanded) to something that is not identical thereto is equivalent to changing the object for which an advisory opinion is demanded, thereby altering the purport of the demand (→30-01).

(B) When the purport and reasons for the demand are not mutually consistent, the reasons should be amended to conform to the purport.

(C) When it is recognized that a plurality of Object A are substantially exist (including a case in which a plurality thereof are stated in the purport of the request), an inquiry, etc. is conducted on the demandant and the demandant is ordered to submit a written response to specify a single Object A (in substitution for the written response, a response by facsimile or telephone is acceptable, in which case a response record should be made). In this case, it is advised that a separate demand for an advisory opinion be made on the other OjbectA.

(2) Service of duplicate and submission of written answer

A. Where a request for an advisory opinion is filed, the chief administrative judge shall serve a duplicate of the written request for an advisory opinion to the demandee and give the demandee an opportunity to file a written answer, designating an appropriate period of time therefor (the Patent Act Articles 71(3) and 134(1); the Utility Model Act Article 26; the Design Act Article 25(3); the Trademark Act Articles 28(3) and 68(3)). The designated period of time for filing the written answer shall be 30 days for residents of Japan and 60 days for overseas residents (→25-01(II)).

A written answer is prepared on Form No. 63 (Enforcement Regulations of the Patent Act Articles 40 and 47(1); Enforcement Regulations of the Utility Model Act Article 23(9); Enforcement Regulations of the Design Act Article 19(5); and Enforcement Regulations of the Trademark Act Article 22(4)).

Upon accepting the written answer (Note), the chief administrative judge shall serve a duplicate thereof to a demandant for an advisory opinion (the Patent Act Articles 71(3) and 134(3); the Utility Model Act Article 26; the Design Act Article 25(3); and the Trademark Act Articles 28(3) and 68(3)).

(Note) A written answer not prepared in an orderly manner might result in a disposition of the procedure's dismissal.

B. When it is clarified in the written answer by the demandee that the demandee is not working and does not intend to work Object A in the future, the written answer is sent to the demandant to await a rebuttal by the demandant before determination is made.

(3) Cognovit, Withdrawal, and Waiver of Demand

A. Cognovit of Demand

A demandee's cognovit of the demand shall not be permitted.

The reason is that an advisory opinion is provided to establish the technical scope of a patented invention based on the recitation of the scope of claims attached to the application request as a question of fact, and to define a conclusion of the advisory opinion not only based on the affirmations presented by a party to the case but also ex officio, and hence not relevant by nature to the cognovit of the demand.

B. Withdrawal of demand

When a demand is withdrawn, the Commissioner of the Japan Patent Office shall notify the demandee thereof (Enforcement Regulations of the Patent Act Article 40→Enforcement Regulations of the Patent Act Article 50-5; Enforcement Regulations of the Utility Model Act Article 23(9); Enforcement Regulations of the Design Act Article 19(5); and Enforcement Regulations of the Trademark Act Article 22(4)).

C. Waiver of demand

When a demand is waived, such a waiver shall be treated as an equivalent to a withdrawal of demand, and the Commissioner of the Japan Patent Office shall notify the demandee thereof.

(4) Proceedings

Explanations will be given herein, taking an advisory opinion concerning a patent right as an example.

A. Finding of patented invention

Finding of a patented invention is made pursuant to the wording of the scope of claims for patent, except in special circumstances.

In principle, when the constitution recited in the scope of claims for the patent includes a feature that differs from Object A, it may not be said that Object A belongs in the technical scope of the patented invention (as an exception, refer to C. Requirements for Establishment of Equivalence below).

B. Finding of object A

Since the technical features describing Object A in writing constitute a premise for determining whether Object A belongs in the technical scope of the patented invention, Finding shall be made so as to enable comparison with the scope of claims for the patented invention.

In the event that the constitution of Object A as asserted by a party to the case is inappropriate, such as a case that a party asserts the constitution of Object A to its advantage, the panel may find Object A ex officio.

When Object A itself is unclear and may not be found through the drawings or explanatory materials, etc., an inquiry is conducted. When it is impossible to clearly found Object A even after the inquiry and, therefore, to conduct the proceedings, the

proceedings are dismissed by decision (the Patent Act Article 71(3)→the Patent Act Article 135).

C. Requirements for the establishment of equivalence

Even when the constitution recited in the scope of claims for the patent includes a feature that differs from the object product (Object A) (referred to as “differentfeature” in section 58-03), Object A is understood to be equivalent to the constitution recited in the scope of claims for the patent and to belong in the technical scope of the patented invention when all of the following requirements (1)–(5) are met:

(1) The different feature is not an essential part of the patented invention.

(2) Even when the different feature is replaced, the purpose of the patented invention may be achieved, and the same working effect may be produced.

(3) A party to the case may readily arrive at replacing the different feature at the time of manufacture of the object product, etc.

(4) The object product, etc. is not identical to the known art at the time of filing the application or is not what a person skilled in the art could have readily conceived at the time of filing the application.

(5) There are no special circumstances in which, for example, the object product, etc. is deemed one that was intentionally removed from the scope of claims for the patent in the procedure of application of the patented invention.

(For reference) Finding by the Supreme Court of Japan, 3rd Petty Bench, February 24, 1998 (No. 1083, 1994 (O)); Ballspline case, wherein an equivalence was affirmed)

In principle, the applicability of the doctrine of equivalents is determined only when a party to the case alleges application of the doctrine of equivalents. When it may be presumed that a party substantially alleges that equivalence is applicable although the word “equivalence” is not explicit, the requirements for equivalence are determined, except when it is obvious that there is no need to do so.

D. When an allegation is made that a patented invention is invalid

In the event that a purport for demanding an advisory opinion remains “Object A does not belong in the technical scope of the patented invention of the present case since the patented invention is

invalid," it is advised that a demand for a trial for invalidation be made and that the demand for an advisory opinion be withdrawn. When this advice is not accepted, the proceedings are continued without considering the invalidity, etc. of the patented invention of the present case.

E. In the event of allegation of indirect infringement, etc.

With regard to a request for an advisory opinion concerning a patent right, an examination is made on the technical scope of a patented invention (the Patent Act Article 71(1)). Accordingly, even when an allegation of an indirect infringement is made pursuant to the provisions of the Patent Act Article 101, the allegation is not considered. Likewise, when an allegation that a patent right is not effective pursuant to the provisions of the Patent Act Article 69, or when an allegation of a non-exclusive license based on prior use is made pursuant to the provisions of the Patent Act Article 79, no such allegation is considered.

(5) Notice of conclusion of the proceedings, suspension, and termination (the Patent Act Articles 167,156(1),and 22–24)

These are not applied to an advisory opinion.

(6) Prohibition of double jeopardy and repetition of same demands for advisory opinion

There is no prohibition of double jeopardy for an advisory system, but repetition of the same demand likely leads to the same result.

(7) Examination of evidence (→35-00)

Evidence may be examined in the procedure on an advisory opinion (the Patent Act Articles 71(3), 150(1); the Utility Model Act Article 26; the Design Act Article 25(3); the Trademark Act Articles 28(3) and 68(3)).

(8) Burden of costs

The payment (of costs) and other required payment for undertaking a procedure for an advisory action are governed by the relevant provisions of the Act on Costs of Civil Procedure (Act No. 40 of 1971) (excluding provisions in Chapter II, Sections 1 and 3 of the Act) unless doing so is contrary to their nature) (the Patent Act Articles 71-3 and 169-6).

(9) Exclusion, recusation, and refrainment (→59-01)

(10) Request for provision of information described in the document to be submitted using anelectromagnetic means

In the case of using for making the document or recognizing as necessary for other reasons, the administrative judge can request the party concerned to provide information recorded in an electromagnetic record when the party concerned has an electromagnetic record (i.e. an electro means, a magnetic means, or any other means which cannot be recognized by human perception and made available for use for the information processing by electronic computers) containing the content of the information described in the document which has already been submitted or will be submitted (Enforcement Regulations under the Patent Act Article 40 → Enforcement Regulations under the Patent Act Article 50-11). (Regarding the detailed method of submission, see the JPO website.)

2. Written Advisory Opinion

(1) A written advisory opinion shall be signed and sealed by the administrative judge (Enforcement Regulations of the Patent Act Articles 40 and 50-10; Enforcement Regulations of the Utility Model Act Article 23(9); Enforcement Regulations of the Design Act Article 19(5); Enforcement Regulations of the Trademark Act Article 22(4)) (alternative sealing → 00-02-2).

(2) Statement of the conclusion (→45-04-7.)

A. Examples of statement of the conclusion of an advisory opinion are provided below.

(Example 1)

The "…" indicated in a drawing of Object A and its explanation belongs (or does not belong) in the technical scope of the present invention (or the present device).

(Example 2)

The design "…" indicated in a drawing of Object A and its explanation belongs (or does not belong) in the scope of the registered design of Design Registration No. XX or a design similar thereto.

(Example 3)

The mark, Object A, used for the goods XXX belongs (or does not belong) in the scope of effect of the trademark right of a trademark under Trademark Registration No. XX.

B. In the case of dismissal, the present demand for an advisory opinion is dismissed.

3. Termination of Procedure of Advisory Opinion

(1) The procedure of providing an advisory opinion terminates with service of a certified copy of the advisory opinion to a party to the case (the Patent Act Articles 71(3) and 157(3)), withdrawal of a demand for an advisory opinion, service of a certified copy of a decision of dismissal of a demand for an advisory opinion (the Patent Act Article 71(3) → the Patent Act Article 135) to a party to the case (the Patent Act Articles 71(3) and 157(3)), or decision of dismissal of a written demand for an advisory opinion (the Patent Act Article 71(3) → the Patent Act Article 133 (3)) (expiry of the period for filing a complaint about the said decision).Waiver of a demand is dealt with in the same manner, as in the case of the withdrawal of a demand (→1. (3)C).

(2) Notice of termination of proceedings would not be given even when the proceedings on an advisory opinion terminate (→1. (5)).

(3) Procedure accompanying termination of advisory opinion

A. Upon the termination of proceedings of an advisory opinion, the Commissioner of the Japan Patent Office shall serve a certified copy of the advisory opinion to the party to the case (the Patent Act Articles 71(3) and 157(3)).

B. When a demand for an advisory opinion is dismissed by decision (the Patent Act Article 71(3) → the Patent Act Article 135), the same action is taken as mentioned in item “A”.

C. When a written demand for an advisory opinion is dismissed by decision (the Patent Act Article 71(3) → the Patent Act Article 133(3)), the Commissioner of the Japan Patent Office shall serve a certified copy of the advisory opinion to the party to the case (the Patent Act Article 189, Enforcement Regulations under the Patent Act Article 16(2)).

(4) Statement of Complaint against a written advisory opinion, etc.

A. An advisory opinion is not provided as an administrative disposition, thus, a statement of complaintagainst anadvisory opinion pursuant to the Administrative Complaint Review Act, or an appeal to the district court pursuant to the Administrative Case Litigation Act may not be filed (→58–00–2).

B. When a demand for an advisory opinion is dismissed by decision (the Patent Act Article 71(3) → the Patent Act Article 133(3)), a statement of complaint against an advisory opinion pursuant to the Administrative Complaint Review Act, or an appeal to the district court pursuant to the Administrative Case Litigation Act may not be filed (the Patent Act Article 71(4)).

C. When a written demand for an advisory opinion is dismissed by decision (the Patent Act Article 71(3) → the Patent Act Article 133(3)), a statement of complaint against an advisory opinion pursuant to the Administrative Complaint Review Act, or an appeal to the district court pursuant to the Administrative Case Litigation Act may be filed.

(Revised Jun.2019)