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)

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) ObjectA 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 ofObject 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)

58-02 PUDT

Organizations that Provide Hantei and Procedures of Proceedings

1. Advisory Opinion Agency

(1) Advisory opinion agency

An advisory opinion is provided by a panel consisting of administrative judges appointed pursuant to the provisions of the Patent Act Article 71(2) (the Utility Model Act Article 26→the Patent Act Article 71(2); the Design Act Article 25(2); the Trademark Act Article 28(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(2)).

The panel reaches its decision by a majority vote (the Patent Act Article 71(3)→the Patent Act Article 136(2); the Utility Model Act Article 26→the Patent Act Article 71(3)→the Patent Act Article 136(2); the Design Act Article 25(3)→the Patent Act Article 71(3)→the Patent Act Article 136(2); the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 136(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 136(2)).

(2) Appointment of the chief administrative judge and administrative judges

Upon demand for an advisory opinion, the Commissioner of the Japan Patent Office appoints three administrative judges, from whom one is appointed as the chief, who administers clerical affairs relating to the demand for an advisory opinion.

Appointment of administrative judges is subject to the conditions of exclusion and recusation of administrative judges pursuant to the provisions of the Patent Act Articles 139 and 141 (the Patent Act Article 71(3)) (→59-01).

2. Procedure of Proceedings

(1) Documentary proceedings

In principle, proceedings for a demand for an advisory opinion are conducted by documentary proceedings (the Patent Act Article 71(3)→the Patent Act Article 145(2); the Utility Model Act Article 26→the Patent Act Article 71(3)→the Patent Act Article145(2); the Design Act Article 25(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article

28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2)).

Among other reasons, this is because determination of an object (ObjectA) for which an advisory opinion is demanded shall be based on a document (e.g., drawings), because cases of demand for an advisory opinion do not necessarily employ the adversary system, and because simplicity and promptness are required in the procedure.

(2) Oral proceedings (→ 33-00)

While in principle, proceedings for a demand for an advisory opinion are conducted by documentary proceedings, the chief administrative judge may decide, upon a motion made by a party to the case or ex officio to conduct oral proceedings(→ 33-00) (the Patent Act Article 71(3)→the Patent Act Article 145(2); the Utility Model Act Article 26→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Design Act Article 25(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2); the Trademark Act Article 68(3)→the Trademark Act Article 28(3)→the Patent Act Article 71(3)→the Patent Act Article 145(2)). When it is decided that the demand be examined by oral proceedings, a notice of oral proceedings is sent to the party (or parties) to the case.

Oral proceedings might be chosen because, in proceedings on an advisory opinion, there may be cases on occasions where oral proceedings are more appropriate than documentary proceedings for establishment of facts.

(3) Proceedings by authority

A. Proceedings on an advisory opinion are based on the principles of ex officio (→36-01) (the Patent Act Article 71(3)→the Patent Act Articles 152 and 153). This is because an advisory opinion is an expert opinion provided by the Japan Patent Office, an administrative office with highly specialized and technical knowledge and skills, and results are publicized and the content thereof is broadly disclosed to third parties.

Therefore, the scope and content required for the proceedings may be changed ex officio to include an examination of reasons not presented by a party to the case (the Patent Act Article 71(3)→the Patent Act Article 153(1)), or the proceedings may be changed ex officio from documentary to oral proceedings (the Patent Act Article 71(3)→the Patent Act Article 145(2)).

B. However, any purport not stated by a demandant may not be examined (the Patent Act Article 71(3)→the Patent Act Article 153(3)).

Among other reasons, this is because the purport of a demand should be defined by the demandant, and because permitting proceedings to be conducted with regard to a purport not stated is equivalent to altering the purport of the demand against the demandant's intention.

(4) Consolidated proceedings

When the panel decides, in consideration of a plurality of cases of demand for an advisory opinion, that the cases may be promptly and accurately examined if proceedings are consolidated, consolidated proceedings may be conducted on the advisory opinion procedure without departing from the purport of the system for advisory opinion and in the absence of any specific expressions of intentions that are contrary to those of a party to the case (the Patent Act Article 71(3)→the Patent Act Article 154).

(5) Proceeding order and expeditious proceedings

A. In principle, demands for an advisory opinion are addressed in the order of the date on which they were filed.

However, when cases of an advisory opinion are relating to a case such as a trial for invalidation, a trial for correction, or infringement, demands for an advisory opinion may not be necessarily addressed in the order of the date on which they were filed, but in a rather comprehensive manner in consideration of the plurality of mutually related cases.

B. Preferably, proceedings on a demand for an advisory opinion are conducted as promptly as possible because the demand itself often involves an actual dispute in progress over, for example, the technical scope of the patented invention in question or because of a current effort to prevent such a dispute, or possible implementation of a business, thereby requiring an early settlement.

(Revised Jun.2019)

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)

58-04 P

Hantei for an Essentiality Check

1. Outline of Advisory Opinion for Essentiality Check

An advisory opinion for determination concerning standard essentiality is provided for demanding an advisory opinion on a virtual object product (virtual Object A) specified in a standards document with regard to the technical scope of a patented invention in lieu of Object A as presented in the proceedings of a normal advisory opinion (→58-01-3.(5)) to determine whether a certain patented invention is essential to certain standards.

With regard to an advisory opinion for essentiality check, a benefit of request pursuant to the purport of the system are required, as in the case of a normal advisory opinion. Therefore, any demand is dismissed by decision where no benefit is acknowledged in demanding an advisory opinion for essentiality check (the Patent Act Article 71(3) → Article 135).

The written advisory opinion for determination for essentiality check states in the conclusion section whether the virtual ObjectA belongs in the technical scope of the present patented invention. When it is concluded, as a purport of the demand, for example that virtual Object A belongs in the technical scope of the patented invention, reasons provided in the written advisory opinion includes a statement of essentiality check to the effect that the patented invention is essential to the relevant standards.
(For details on the procedure, refer to “Manual of Advisory Opinion for Essentiality Check” on the Japan Patent Office website.)

(Supplement Jun.2019)

58-10 PUDT

Commissioning of the Provision of an Expert Opinion by a Court

1. Outline of the System

When the Japan Patent Office is commissioned by a court to provide an expert opinion on the technical scope of a patented invention, the Commissioner of the Japan Patent Office shall appoint three administrative judges to provide an expert opinion on the matter (the Patent Act Article 71-2; the Utility Model Act Article 26; the Design Act Article 25-2; and the Trademark Act Article 28-2).

2. Content of Expert Opinion

An expert opinion basically encompasses the following points (1)–(3), as provided in the Patent Act Article 71-2; the Utility Model Act Article 26; the Design Act Article 25-2; and the Trademark Act Article 28-2:

(1) Expert opinion on the technical scope of a patented invention or a registered utility model (the Patent Act Article 71-2 (the Utility Model Act Article 26))

(2) Expert opinion on the scope of a registered design or a design similar thereto (the Design Act Article 25-2).

(3) Expert opinion on the effect of a trademark right (the Trademark Act Article 28-2).

In any of the above cases, three administrative judges hold a collegial examination, and the chief administrative judge administers the clerical affairs.

3. Fees for Expert Opinion and Travel Expenses required for Exposition

(1) Basic idea

An expert opinion is provided pursuant to the provisions of the Code of Civil Procedure when required as part of the process of providing proof in a court, and the fees for the expert opinion are paid by a party to the case.

For reference: The Act on Costs of Civil Procedure

Obligation to Pay (Article 11), the Request for Travel Expenses by a Witness, etc. (Article 18), the Request for Travel Expenses by an Expositor, etc. (Article 19), and the Payment of Compensation for a Commissioned Examination (Article 20).

Accordingly, for an expert opinion provided by the Japan Patent Office, fees for the expert opinion and travel expenses for exposition thereof shall be paid pursuant to the provisions of the Act on Costs of Civil Procedure.

It is noted that when a judge of the court issues a commission ex officio to provide an expert opinion, a person designated by the court (a party to the case) pays the fees.

(2) Specific operation

A. Fees for an expert opinion are the same as those for an advisory opinion (i.e., ¥40,000 per case)(*).

(*) For calculation of fees, the expert opinion provided for one object(Object A) with regard to one patent right is defined as one case of expert opinion, and the fee for the one case is ¥40,000. Accordingly, when a request is made for an expert opinion on a combination of three Objects A, B, and C with respect to two patent rights, the number of cases of expert opinion is six (2 x 3), and the fee is given by the equation below:

¥40,000 x 6 = ¥240,000.

B. When an exposition is requested on the provided expert opinion, fees paid by the court pursuant to the Act on Costs of Civil Procedure are appropriated for travel expenses. Therefore, travel expenses would not be paid by the Japan Patent Office.

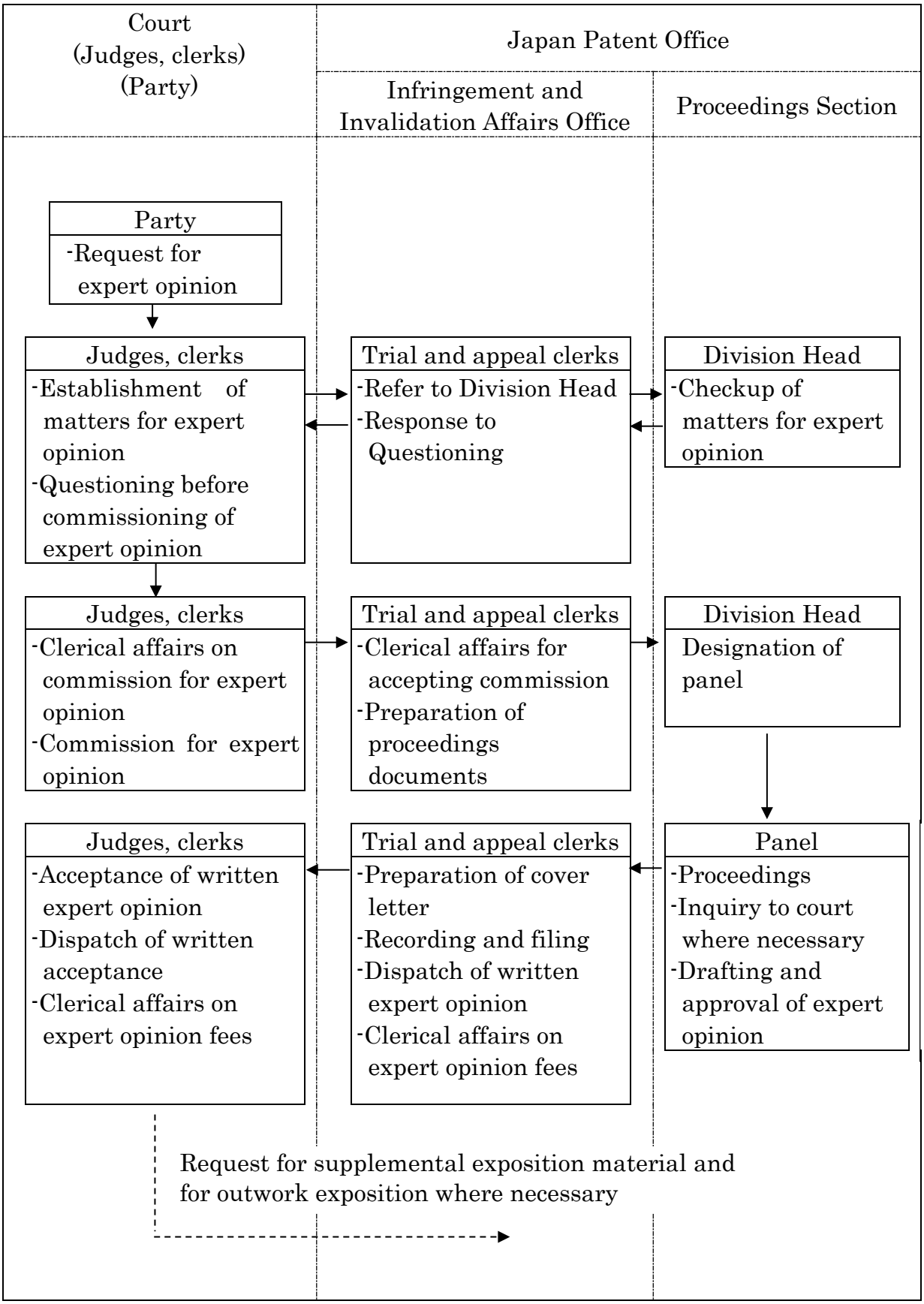
4. Management of Written Commission for Expert Opinion

A written commission for expert opinion are filed under relevant proceedings numbers.

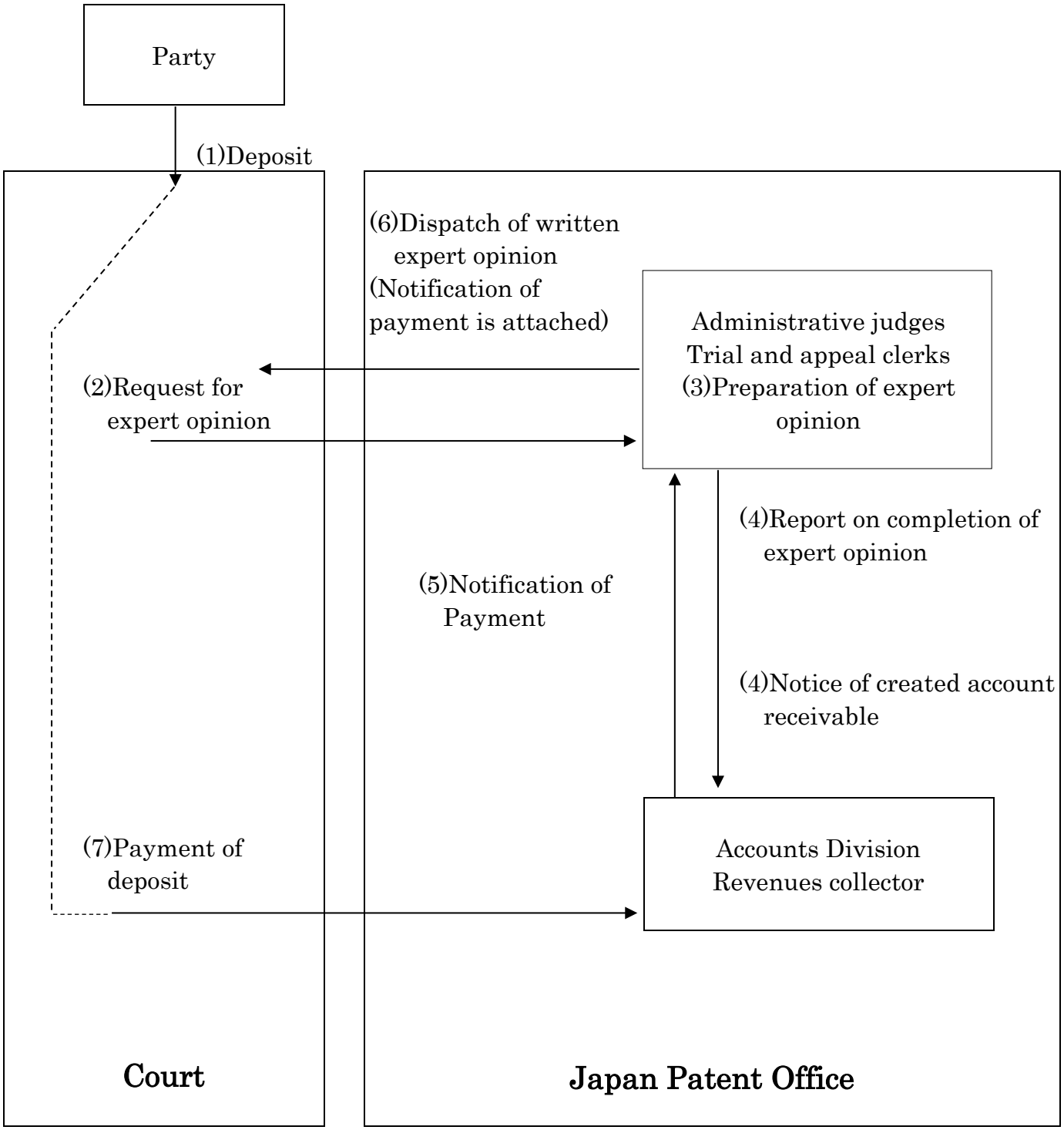
(Expert Opinion (Kantei) No. XXXX-99XXXX)

Year, Serial number in each year

WORKFLOW DIAGRAM CONCERNING EXPERT OPINION



WORK DIAGRAM CONCERNING EXPERT OPINION FEES



(Note) Numerals (1) to (7) designate the order of procedures, the same numeral indicating concurrency.

(Revised Jun.2019)

58-12 PUD

Seeking the Opinion of Director of Customs

1. Outline of the System of Inquiry for Opinions

When a customs verification procedure (note) is initiated on a patent right, utility model right, or design right, a right holder, an exporter, or an importer may, within a certain period of time, petition the Director-General of Customs to request an opinion from the Commissioner of the Japan Patent Office as to whether said right belongs in the technical scope of the patented inventionor registered utility model, or belongs in the registered design or design similar thereto (Customs Act Articles 69-7(1) and 69-17(1)).

The Director-General of Customs may also request an opinion from the Commissioner of the Japan Patent Office on the technical scope, etc. when the former finds it necessary to do so, without a petition from a right holder, an exporter, or an importer (Customs Act Articles 69-7(9) and 69-17(9)).

The Director-General of Customs notifies a petitioner and an exporter or an importer about the content of the opinion provided by the Commissioner of the Japan Patent Office, and verifies whether the goods for exportation or importation constitute infringement in consideration of said opinion and other relevant materials.

(Note) “Verification procedure” refers to a procedure to verify whether the goods deemed to infringe an intellectual property right (“the goods suspected of infringement”) fall under the goods that constitute infringement (Customs Act Articles 69-3(1) and 69-12(1)).

2. Requirements for Requesting Inquiry for Opinions

(1) Subject: the goods on which a verification procedure concerning a patent right, a utility model right, or a design right is in progress.

(2) Requester: a patentee, a utility model right holder, a design right holder, or an exporter or importer.

(3) Time period for the request: within ten days (excluding the administrative organization holidays) (until the lapse of ten days) and, when the term is extended, within 20 days (excluding administrative organization holidays) (until the lapse of 20 days), from the date on which the notification for initiating a verification procedure wasreceived.

(4) Content of the opinion requested: the technical scope relating to the right of the goods on which a verification procedure is in progress.

(5) Required material: a material that clarifies acondition of a product or a process deemed to constitute (or not to constitute) infringement of a right in a specific manner.

3. Outline of the Procedure

(1) Inquiry from the Director-General of Customs

The Director General of Customs seeks an opinion regarding the technical scope of a patented rightora registered utility model, or the scope of a registered design or a design similar thereto, with the following documents, etc.:

A. Written inquiry seeking the Commissioner of Patent Office’s opinion

A condition of the goods in a concrete manner concerning inquiry of opinions, which is specified by the Director-General of Customs

B. Written petition seeking the Commissioner of the Patent Office’s opinion and appendices

Documents and the appendices submitted by a petitioner to seek said opinion.

C. Other materials to be used as reference

(2) Response by the Commissioner of the Patent Office

The Commissioner of the Japan Patent Office states an opinion in writing within 30 days of the date on which the written inquiry seeking an opinion was submitted (Customs Act Articles 69-7(4) and 69-17(4)). The Commissioner of the Japan Patent Office orders the Trial and Appeal Division to deal with the clerical affairs relating to the technical scope of a patented inventionor a registered utility model, or a registered design or a design similar thereto.

The Trial and Appeal Division appoints three administrative judges pursuant to designation by the division head.

(Revised Jun.2019)

58-14 PUDT

Asking Opinions and Statement of Opinions

1. Outline of System of Seeking Opinions and System of Stating Opinions

In a suit against thedecision, such as in a trial for invalidation, etc. (including a trial for invalidation of registration of an extension of a patent term, a trial for rescission of a registered trademark not in use, and a trial for rescission for unfair use; the same applies to the present section 58-14 hereinafter), the court may seek an opinion of the Commissioner of the Japan Patent Office on an application of the Patent Act, etc. or any other necessary matters relating to the case concerned (the system of seeking opinions) (the Patent Act Article 180-2(1) and (3)).

In a suit against the decision, such as in a trial for invalidation, the Commissioner of the Japan Patent Office may, upon the court's consent, state an opinion to the court regarding an application of the Patent Act, etc. or on any other necessary matters relating to the case concerned (the system of stating opinions) (the Patent Act Article 180-2(2) and (3)).

2. The Purport of Establishment of the Systems of Seeking Opinions and Stating Opinions

In a suit against the decision, such as in a trial for invalidation, the Commissioner of the Japan Patent Office may not participate as a party to the case in the proceedings thereof. However, when the Patent Office's legal interpretations or application standards has become a point of issue in a trial for invalidation, and the court makes a decision rescinding a trial decision based on its legal interpretations or application standards differing from those of the Patent Office, said court decision thus made may have a great impact on the legal interpretations or application standards of the Patent Office. Accordingly, in a suit against the decision, such as in a trial for invalidation, it is desirable that the point of view of the Japan Patent Office, the specialized government office, be reflected in the trial proceedings and that a determination be made in consideration thereof.

Accordingly, in a suit against the decision, such as in a trial for invalidation, the system of seeking an opinion is established, wherein the court may seek an opinion of the Commissioner of the Japan Patent Office, and the system of stating an opinion is also established, wherein the Commissioner of the Japan Patent Office may state an opinion to the court upon a motion made by the Patent Office and upon the court's consent.

(Revised Jun.2019)