

67-03 P**Opposition to Grant of Patent Procedures****1. Written Oppositions, etc.****(1) General Matters**

To file an opposition to grant of patent, a prescribed written opposition shall be filed (Patent Act Article 115, Regulations under the Patent Act Article 45-2, Form 61-2).

In this case, a written opposition and attachments must be filed with duplicates thereof as necessary (for the number of patentees + 1 for proceedings) (Regulations under the Patent Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4).

(2) Indication of Patent, Opponent, etc.**A. Indication of patent relating to an opposition to grant of patent**

A written opposition shall indicate a patent number relating to an opposition and claims for which the opposition is filed.

B. Opponents, etc. (→ 21-00-4.)

A written opposition shall contain the name and the domicile or residence of the opponent and the agent.

Where an opponent is not a natural person, a written opposition shall contain the name of the opponent and the name of the representative. However, where procedures are carried out by an agent, a written opposition does not require the name of a representative.

Where there are multiple agents, or a patent business corporation serves as an agent, an agent (a patent attorney, etc.) who is in charge shall be indicated if possible.

In addition, for communication with the Patent Office, the telephone and facsimile numbers shall be stated if possible.

(3) Reasons for Opposition to Grant of Patent and Indication of Supporting Evidence

A written opposition shall contain reasons for opposition to grant of patent and indication of supporting evidence.

A. Reasons for opposition to grant of patent

A written opposition shall contain provisions of any applied item of the Patent Act Article 113 (applicable provisions) on which revocation of the patent is based and concrete reasons for revocation of the patent.

B. Indication of supporting evidence (→ 34-01)

Evidence to prove concrete facts claimed as reasons for opposition to grant of patent shall be indicated (Regulations under the Patent Act Article 45-2, Note 6 of Form 61-2).

Means of proof of an opposition to grant of patent shall be a document in general and may also be an inspection item, witness, expert witness, and an opponent him/herself.

Where means of proof is a document, the original shall be submitted to the Patent Office along with copies thereof according to the number of patentees (Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50 (2)).

To submit a document prepared in a foreign language, a Japanese translation of the part of the document for which examination is sought shall be attached thereto (Regulations under the Patent Act Article 61 (1)).

C. Amendment of reasons and evidence (→ 67-04)

It is desirable to file an opposition to grant of patent upon completion of reasons and evidence in the first place. However, addition or change of reasons or evidence in an amendment made before the earlier of the expiration of an opposition period or the time of notice of reasons for revocation shall be possible (Patent Act Article 115 (2)). In other words, basically, addition or change of reasons or evidence shall be allowed before the expiration of an opposition period. However, if a notice of reasons for revocation is issued during the opposition period, the allowed period shall be reduced to a period before the time on which the said notice of reasons for revocation is issued (→ see 67-08 for trial proceedings before the expiration of the opposition period) (→ see 67-07-3. for multiple opposition filed to grant of patent).

2. Procedures after Opposition to Grant of Patent is Filed

(1) Assignment of Opposition Number and Case Number (→ 11-01)

Oppositions to grant of the same patent right shall be assigned with the same opposition case number irrespective of the number of oppositions, and further assigned with case numbers in units of oppositions.

(Examples) Patent right 1	Opponent A	Opposition 20XX-000001	Case No. 01
Patent right 1	Opponent B	Opposition 20XX-000001	Case No. 02
Patent right 2	Opponent C	Opposition 20XX-000002	Case No. 01

(2) Sending a Duplicate of a Written Opposition

The chief administrative judge shall send a duplicate of a written opposition to a patentee (Patent Act Article 115 (3)).

Where multiple oppositions to grant of patent have been filed, a duplicate of a written opposition shall be sent according to each opposition and shall not be sent collectively after the expiration of an opposition period.

(3) Notice of Consolidation

Where multiple oppositions to grant of patent have been filed, proceedings thereof shall be consolidated in principle, and therefore, a notice of consolidation of proceedings shall not be issued.

(4) Notice to Exclusive Licensees, etc. (→ 11-02)

Where an opposition to grant of patent is filed, the chief administrative judge shall notify the opposition to exclusive licensees of the patent right and other persons who have a right registered in relation to the patent (referred to as the "exclusive licensees, etc." in this Chapter 67) (Patent Act Article 115 (4) → Patent Act Article 123 (4)).

(5) Preliminary Registration of an Opposition to Grant of Patent

Where an opposition to grant of patent is filed, it shall be preliminarily registered in the patent registry (Patent Registration Order Article 3 iii). The date of an opposition to grant of patent, an opposition case number, and indication of a patent (patent number and indication

of claims) relating to the opposition shall be recorded in the indication part of the patent registry (Patent Registration Order Enforcement Regulation Article 38)

(6) Publication in the Patent Gazette

Where an opposition to grant of patent is filed, it shall be published in the patent gazette (Patent Act Article 193 (2) vi).

3. Withdrawal of Opposition to Grant of Patent

An opposition to grant of patent may be withdrawn before a notice of reasons for revocation (Patent Act Article 120-4 (1)) (→ see 67-07-4. for multiple oppositions filed to grant of patent). When opposition to grant of patent with regards to two or more claims covered by the patent, the opposition can be withdrawn on a claim-by-claim basis (Patent Act Article 120-4 (2) → Patent Act Article 155 (3)) (→ 43-05). When an opposition to grant of patent has been withdrawn, a patentee and an intervenor shall be notified of the withdrawal (Regulations under the Patent Act Article 45-6 → Article 50-5).

In contrast, an opposition to grant of patent may not be withdrawn after a notice of reasons for revocation (Patent Act Article 120-4 (1)).

When a written withdrawal has been submitted after a notice of reasons for revocation, a trial proceedings shall be carried out by giving an opponent an opportunity to explain and then dismissing the written withdrawal (Patent Act Article 120- (1) → Patent Act Article 133-2).

When all the oppositions to grant of patent right have been withdrawn, a trial proceedings thereof shall be terminated.

(Revised December 2020)