

67-04 P

Deficiencies and Amendment in Opposition to Grant of Patent

1. Deficiencies and Disposition in Opposition to Grant of Patent (Written Opposition) (→ 21-00 to 09)

(1) Order to Amend and Dismissal of Opposition

If an opponent does not make amendments on his/her own initiative to violation of formal requirements of a written opposition (lack of description items, ambiguity, underpayment of fees, or no payment of fees, etc.), the chief administrative judge shall either order the opponent to amend the opposition or make an inquiry to the opponent depending on the content of violation of formal requirements (Patent Act Article 120-8 (1) → Patent Act Article 133 (1), (2), Patent Act Article 134 (4)) (→ 21-02). If an amendment is not made within the designated time limit (normally 10 to 30 days depending on the contents of deficiencies → 25-01.5) according to the order to amend, the chief administrative judge shall dismiss a written opposition by decision (Patent Act Article 120-8 (1) → Patent Act Article 133 (3)).

(2) Unlawful and Not Amendable Opposition to Grant of Patent and Dismissal of the Opposition

An unlawful and not amendable opposition to grant of patent (such as an opposition filed during the period other than the opposition period, and an opposition filed with non-existence of a patent as a subject, etc.) shall be dismissed by a decision by a panel (Patent Act Article 120-8 (1) → Patent Act Article 135).

If an amendment of reasons and evidences for an opposition to grant of patent is not made before the earlier of the expiration of an opposition period or the time of notice of reasons for revocation with regard to a part of claims covered by the opposed patent, and no substantial statement or indication is provided for reasons for opposition and evidences thereof, the opposition shall be dismissed, however, this shall not apply where the opposition has been withdrawn with regard to said claims by that time.

(3) Appeal against Decision to Dismiss

If a person is dissatisfied with a decision on dismissal of a written opposition under the above (1), an appeal may be instituted before the Tokyo High Court (Intellectual Property High Court) (Patent Act Article 178 (1)).

No appeal shall be available against a decision on dismissal of a written opposition to grant of patent under the above (2) (Patent Act Article 120-8(2), Article 135, Article 195-4).

2. Amendment in Opposition to Grant of Patent (Written Opposition)

(1) Amendment in General

A written opposition shall contain the subject of the opposition (an opponent), the object (indication of a patent, i.e. patent number and claims, relating to the opposition), reasons for the opposition, and supporting evidence (Patent Act Article 115 (1)). The written opposition may be amended at any time but shall not change its gist (Patent Act Article 115 (2) text).

(2) Concrete Approach

A. Amendment of the subject (opponent)

An amendment of the subject (opponent) of an opposition to grant of patent is deemed to be a change of the gist if the identity of the opponent is lost. An amendment of errors of description in such a way that its subject remains identical is not deemed to be a change of the gist.

B. Amendment of the object (patent number and claims)

An amendment of the object (patent number and claims) of an opposition to grant of patent is deemed to be a change of the gist if the identity of the patent number and claims is lost.

However, even though deletion of claims as the subject of an opposition is deemed to be a change of the gist per se, it can be handled in the same manner as withdrawal of claims covered by an opposition (→ 67-03-3) and therefore it is not deemed to be a change of the gist until notice of reasons for revocation is issued, on an exceptional basis.

C. Amendment of reasons and evidences

Concerning an amendment of reasons for opposition to grant of patent and evidence, even if the gist thereof is changed, addition or change of reasons or evidence shall be possible on an exceptional basis until the earlier of the expiration of an opposition period or the time of notice of reasons for revocation (provision to Patent Act Article 115 (2)) (→ 21-06).

After that, an amendment shall be possible only within the scope without changing the gist of a written opposition.

(Reference) System flow from an opposition to grant of patent to the start of a trial on the merits (→ 20-00)

(Revised Sep. 2018)