

## **67-05.1 P**

### **Notice of Reasons for Revocation**

#### **1. Purport and Types of “Notice of Reasons for Revocation” (Patent Act Article 120-5)**

##### (1) Purport of Notice of Reasons for Revocation

Where the panel determines that a patent shall be revoked, a notice of reasons for revocation is issued to notify the patentee of the reasons therefor and give the patentee an opportunity to submit a written opinion and make a correction.

##### (2) Types of Notice of Reasons for Revocation

There are two types of “notice of reasons for revocation” for operational reasons: a usual “notice of reasons for revocation” and another “notice of reasons for revocation” in order to give a patentee an opportunity to submit a “written request for correction” before a decision to revoke is made (referred to as the "notice of reasons for revocation (advance notice of trial decision)" in this chapter 67) (→ 67-05.5).

#### **2. Procedure for Notice of Reasons for Revocation**

Where a patent examined by a panel has been determined to be revoked, a patentee shall be notified of reasons for revocation and given an opportunity to submit a written opinion and make a correction within a designated adequate time limit (normally 60 days, or 90 days for overseas residents → 25-01.4). A notice of reasons for revocation shall not be sent to a patent opponent (when a patentee later submits a request for correction, document which describes reasons for revocation notified to the patentee is sent to the opponent (Patent Act Article 120-5(5))) (67-05.4). It will be enough for a patentee to state an opinion about the reasons for revocation described in a notice of reasons for revocation. Therefore, a patentee shall not have to state his/her opinion on the reasons described in a written opposition, or a written opinion that is submitted by a patent opponent, and a written response to inquiry (→ 67-05-2. (3)).

Upon issuance of a notice of reasons for revocation, a required number of duplicates of a written opinion, etc. submitted by a patentee (the number of opponents + the number of intervenors + 1 for proceedings) shall be specified (Regulations under the Patent Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4).

### **3. Consideration of Notice of Reasons for Revocation**

- (1) All of the reasons for opposition to a patent and evidence shall be taken into consideration in proceedings. In addition, reasons for opposition to a patent and evidence that have not been submitted by a patent opponent may be also examined ex officio when necessary (→67-05-3.(3)).
- (2) Where it is not possible to constitute any reasons for revocation, a decision to maintain a patent shall be rendered (referred to as the "decision to maintain" in this Chapter 67) (→ 67-06-3. (2)).
- (3) Where multiple reasons for revocation can be constituted, all of those shall become reasons for revocation in principle. Reasons for revocation under different applicable provisions shall be reasons for revocation with regard to respective applicable provisions.
- (4) However, where it is possible to constitute multiple reasons for revocation in the above (3), an appropriate reason may be selected therefrom according to a case and regarded as the reason for revocation in order to facilitate efficient and reasonable resolution of the case as a whole. In this case, reasons and evidence shall be taken into account in view of the possible restriction of the scope of claims so as not to issue a notice of reasons for revocation multiple times or make another decision to revoke based on another reason after the court decision to rescind the JPO's decision to revoke the patent becomes final and binding.
- (5) A panel shall describe its finding and determination in a notice of reasons for revocation. There is a possibility that the panel's citing the patent opponent's allegation concerning reasons for revocation described in a written opposition only by indicating the part of the document (page and line numbers) may be regarded as that the panel's finding and determination are not indicated. In order to avoid any misleading, the panel shall not cite the opponent's allegation. However, the panel may cite the opponent's allegation to explain

evidence, etc. described in the written opposition only when it is necessary for the panel to use the allegation as grounds for finding.

(Revised Sep. 2018)