

67-05.4 P

Submission of Written Opinion by Opponent

1. Submission of Written Opinion by Opponent

(1) When a compliant request for correction was filed against a notice of reasons for revocation, except for a case where the opponent does not wish to (see note below) or a case where a special circumstance in which it is found to be unnecessary to grant an opportunity (proviso to Patent Act Article 120-5 (5)), the duplicate of a written opinion, a request for correction, and a corrected description, scope of claims or drawings (referred to as the "corrected description, etc." in this chapter 67-05.4) attached thereto along with a document describing the reasons for revocation of the patent (document describing the same details as reasons for revocation notified to the patentee) shall be sent to the opponent, and a reasonable time limit (normally 30 days, or 50 days for overseas residents, → 25-01.4) shall be designated to grant an opportunity for submission of a written opinion (Patent Act Article 120-5 (5)).

(Note) The case where an opponent does not wish to submit a written opinion denotes to the case where a request to the effect that an opponent does not wish to submit a written opinion is stated in a written opposition (refer to Form 61-2, Note 4 in the Regulations under the Patent Act Article 45-2).

(2) A panel shall conduct proceedings by considering contents of a written opinion submitted by an opponent. However, when contents of an opinion substantially present new reasons and evidence, the said substantially new reasons and evidence shall not be adopted, considering the impact on the public interest and the purport of restricting an opposition period to be within six months from the publication date of the gazette containing the patent, except for the cases where the reasons arise pertaining to contents of a request for correction including an opinion on items added by the correction or where it is at a glance obvious that the reasons constitute appropriate reasons for revocation.

2. Special Circumstances

Cases where special circumstances exist mean, from the viewpoint of a timely and efficient proceedings, those where it is obvious that hearing opinions from the opponent is not necessary, including those where contents of a request for correction would not affect the substantial decision, etc. In such circumstances, an opponent shall not be given an opportunity to submit a written opinion.

Cases falling under the case where an opponent shall not be given an opportunity to submit a written opinion are as follows.

(1) The case where a request for correction does not comply with correction requirements.

The case where a request for correction is unlawful and has been withdrawn (Patent Act Article 120-5 (9) → Patent Act Article 133 (3), Patent Act Article 120-8 → Patent Act Article 133-2 (2)) or a correction has not been granted (→ 3. (1)) does not fall under "where a request for correction has been filed."

(2) The case where a correction is minor one such as correction of errors in writing.

(3) The case where a correction is made by only deleting a part of claims.

(4) The case where a correction is made only for a claim to which an opposition to grant of patent has not been filed.

For special circumstances after a notice of reasons for revocation (advance notice of decision) is issued, please refer to 67-05.5-4. (1).

3. Procedure for Submission of Written Opinions by Opponents

(1) The chief administrative judge shall send necessary documents to an opponent according to the above 1. (1). When there are formal deficiencies in a written request for correction, the chief administrative judge shall also send the opponent duplicates of a written amendment that has been voluntarily submitted by a patentee or a written amendment that the chief administrative judge has order a patentee to amend deficiencies within and submit (→ 21-02).

In addition, when a written request for correction does not comply with correction requirements, a "notice of reasons for rejecting a request for correction" shall be issued and then necessary documents shall be sent after a request for correction has been amended to

comply with correction requirements. In this case, documents to be sent shall include, in addition to the above document, a document describing reasons for rejecting a request for correction and a document submitted by a patentee in response to a “notice of reasons for rejecting a request for correction” (duplicates of a written opinion, a written amendment of a written request for correction, the corrected description, etc. attached thereto).

In the case where a written request for correction still does not comply with correction requirements even after an amendment thereof is made, it shall be deemed to be a special circumstance (→ 2.(1)) in which an opponent shall not be asked to provide his/her opinion and no documents shall be sent.

- (2) An opponent shall prepare and submit a written opinion within a designated time limit (normally 30 days, or 50 days for overseas residents → 25-01.4) (Form 61-5 in the Regulations under the Patent Act Article 45-3 (3)).

Items concerning a request for correction, which particularly require clear statement, shall be described specifically in a detailed opinion column of a written opinion (→ 1. (2)). Where a written opinion is submitted, a required number of duplicates (the number of patentees + the number of intervenors +1 for proceedings) shall be submitted (Regulations under the Patent Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4). A required number of duplicates is described in a written notice to notify an opponent of an opportunity to submit a written opinion.

(Revised Sep. 2018)