

67-05.5 P

Notice of Reasons for Revocation (Advance Notice of Decision)

1. The Case Where a “Notice of reasons for Revocation” (Advance Notice of Decision) Is Required

(1) With the revision of the Patent Act in 2011, an opportunity for correction shall be given by an "advance notice of trial decision" in the trial for invalidation and a request for a trial for correction shall be prohibited in pending revocation action against an trial decision in order to prevent a "play catch phenomenon" (→ 51-17-2.) between the Patent Office and the court. In an opposition to grant of patent, a request for a trial for correction shall be prohibited in pending revocation action against decision of revocation (Patent Act Article 126 (2)) and therefore, in the case where a decision of revocation has been rendered after a notice of reasons for revocation is sent, a notice of reasons for revocation (advance notice of decision) shall be sent to a patentee to give an opportunity for correction again.

By doing so, an opportunity for correction shall be given twice, the first by the first notice of reasons for revocation and the second by the notice of reasons for revocation (advance notice of decision). This will ensure to give an opportunity for correction twice based on the determination by the panel.

Furthermore, since the purport of the trial for invalidation system is to resolve disputes related to validity of the patent between the parties, it is necessary for a panel to render a trial decision after both parties make allegations and show proof thoroughly. Meanwhile, since the purport of the opposition to grant of patent system is to realize stable establishment of patent rights at an early stage, a panel is expected to demonstrate a final determination at an early stage while considering procedures that should be taken by the parties.

Based on the above, the second notice of reasons for revocation shall be the notice of reasons for revocation (advance notice of decision) in principle.

However, in a case where the second notice of reasons for revocation is intended solely to give an opportunity for correction (for instance, in a case where a panel has a belief that

the patent may be maintained by dissolving minor deficiencies in the description, etc.), the second notice of reasons for revocation shall not be the notice of reasons for revocation (advance notice of decision), and rather an ordinary notice of reasons for revocation.

(2) Notice of reasons for revocation (advance notice of decision) shall clearly indicate that it is an "advance notice of decision" at the beginning. A patentee may submit a written opinion as well as file a request for correction within the designated time limit (normally 60 days, or 90 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (1) (2)).

(3) When it has been determined to maintain a patent, a decision to maintain shall be rendered.

2. The Case Where a Notice of Reasons for Revocation (Advance Notice of Decision) is Not Required

A decision shall be rendered without a notice of reasons for revocation (advance notice of decision) in the following cases.

(1) The case where there has been no response to a notice of reasons for revocation (no submission of a written opinion or no request for correction)

In the case where there has been no response to a notice of reasons for revocation, it is not necessary to further give an opportunity for correction and therefore, an advance notice of decision shall not be issued (→ 67-05.3-3.).

(2) The case where a patentee requests that he/she does not wish to receive an advance notice of decision

When the patentee does not wish to receive an advance notice of decision for the purpose of obtaining a decision on an opposition to grant of patent at an early stage, an advance notice of decision shall not be issued. A patentee shall state a request in a written opinion to a notice of reasons for revocation to the effect that he/she does not wish to receive an advance notice of decision.

3. The Content of the Description in the Notice of Reasons for Revocation (Advance Notice of Decision)

In a conclusion of a notice of reasons for revocation (advance notice of decision), a conclusion (to maintain, to revoke, to dismiss a written request for opposition, etc.) concerning all of the claims requested for an opposition to grant of patent shall be described. In reasons of a notice of reasons for revocation (advance notice of decision), reasons of a determination to revoke made by the panel, that should be the same as the content of the decision, shall be described.

Where a request for correction is filed to correct description, scope of claims, or drawings attached to an application and the said correction is granted by a panel, the grant of a correction shall be indicated in a conclusion of a notice of reasons for revocation (advance notice of decision) while reasons to grant a correction shall be described within the reasons of a notice of reasons for revocation (advance notice of decision).

Where the said request for correction is not granted by a panel, the panel's determination not granting the said request as well as reasons not to grant a correction shall be described within the reasons of a notice of reasons for revocation (advance notice of decision), rather than in a conclusion of a notice of reasons for revocation (advance notice of decision).

4. Proceedings after the Notice of Reasons for Revocation (Advance Notice of Decision)

Proceedings after a notice of reasons for revocation (advance notice of decision) shall be carried out as follows depending on whether a request for correction has been filed or not.

(1) The Case Where a Request for Correction Has Been Filed

Where there is no request from an opponent to the effect that he/she does not wish to submit a written opinion and it does not fall under a special circumstance with no need to give an opportunity to submit a written answer to an opponent, an opportunity to submit a written opinion shall be given to an opponent (→ refer to 67-05.4-1. for detailed procedures). A notice of reasons for revocation (advance notice of decision), etc. shall be sent to the opponent (Patent Act Article 120-5(5)).

A case where an opportunity to submit a written opinion shall not be given to an opponent after a notice of reasons for revocation (advance notice of trial decision) is sent shall include (5) and (6), in addition to the following (1) to (4) in an ordinary notice of reasons for revocation (→ 67-05.4-2.).

- (1) The case where a request for correction does not comply with correction requirements.
- (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 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.
- (5) The case where a panel has determined to revoke a patent despite consideration of the content of a correction.
- (6) The case where an opportunity to submit a written opinion has been already given to an opponent; the scope of claims is reduced to a considerable extent by a request for correction; and a panel has determined to reach a conclusion that a patent shall be maintained even if proceedings are further carried out based on all the evidence and opinions submitted for the case.

(2) The Case Where There Is No Request for Correction

In the case where it is possible to determine revocation of a patent based on reasons described in a notice of reasons for revocation (advance notice of decision) after proceedings, without giving an opportunity to submit a written opinion to an opponent, and consideration of contents of a written opinion submitted by a patentee if any, a decision shall be rendered based on contents described in a notice of reasons for revocation (advance notice of decision) (Patent Act Article 114 (2)).

Basically, contents described in a notice of reasons for revocation (advance notice of decision) may be described in the decision while correction of errors in writing or a written opinion submitted by a patentee after the notice of reasons for revocation (advance notice of decision) shall be referred as needed.

Still, in the case where no request for correction has been filed, it is possible for a panel to make an inquiry to the opponent if there is a question arising from the reasons based on which the panel has determined to revoke a patent upon the patentee's allegation.

(Revised Sep. 2018)