

67-05 P**Opposition to Grant of Patent Proceedings****1. Proceedings Body and Administrative Judges****(1) Proceedings Body (Patent Act Article 114 (1))**

An opposition to grant of patent shall be examined by a panel constituting of administrative judges to sufficiently secure fairness, independence and appropriateness of the proceedings.

(2) Designation of Administrative Judges and a Trial Clerk (Patent Act Article 116 → Patent Act Article 137 (1), Patent Act Article 117 (1), Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 48 (2)) (→ 12-01 to 04)

The Commissioner of the Patent Office shall designate administrative judges and a trial clerk for each case of an opposition to grant of patent.

When the administrative judges and the trial clerk have been designated or changed, the names of the administrative judges and the trial clerk shall be notified to a patentee, an opponent, and an intervenor.

(3) Authority of the Chief Administrative Judge (Patent Act Article 116 → Patent Act Article 138)

The Commissioner of the Patent Office shall designate one of the designated administrative judges as a chief administrative judge. The chief administrative judge shall preside over matters relating to the opposition case.

(4) A Motion Requesting an Exclusion or Recusation (Patent Act Article 116 → Patent Act Article 139 to 144, Patent Act Article 117 (2) → Patent Act Article 144-2 (5)) (→ 59-01)

A patentee, an opponent or an intervenor may file a motion requesting an exclusion or recusation to administrative judges and a trial clerk.

2. Start of Proceedings of Opposition to Grant of Patent

- (1) When multiple oppositions to grant of patent have been filed, proceedings thereof shall be consolidated and a panel shall organize all the reasons for opposition to examine them jointly (Patent Act Article 120-3 (1)) (→ 67-07)). Proceedings on the case shall be conducted after the expiration of the period for filing an opposition.
- (2) Even before the expiration of the period for filing an opposition, proceedings shall begin upon request by a patentee (→ 67-08).
- (3) An opposition to grant of patent shall be processed by having a patentee present a written opinion, etc. in response to reasons for revocation notified by the chief administrative judge, rather than by having a patentee answer to reasons and evidence stated in a written opposition, or written opinion submitted by an opponent.

3. Scope of Proceedings

(1) Subject of Proceedings

The subject of a proceedings is restricted to claims of which an opposition to grant of patent has been filed (Patent Act Article 120-2 (2)).

When multiple requests for opposition to grant of patent have been filed, proceedings thereof shall be consolidated in principle (→ 67-07) and all the claims opposed by any of the consolidated oppositions are deemed to be the subject of the proceedings.

(2) Proceedings Based on Reasons for Opposition to Grant of Patent and Evidence

An opposition to grant of patent shall be examined based on reasons pleaded by an opponent and evidence (Examples 1 to 3).

(Example 1) Adoption of reasons for opposition to grant of patent and evidence without addition or change

The case where a combination of evidence A and evidence B submitted by an opponent A is found to be appropriate and therefore used without addition or change.

(Example 2) Adoption of appropriate reasons and evidence to serve as reasons for revocation from reasons for opposition to grant of patent and evidence

The case where a combination of evidence A and evidence B is used as reasons for revocation after a combination of evidence A and evidence B or evidence C and evidence D was selectively submitted by an opponent A.

(Example 3) Adoption of reasons and evidence to serve as reasons for revocation based on reasons for multiple oppositions to grant of patent and evidence

The case where a combination of evidence A and evidence B, and evidence E are used respectively as reasons for revocation after a combination of evidences A and B was submitted by an opponent A, a combination of evidences C and D by an opponent B, and evidence E by an opponent C respectively.

(3) Ex Officio Proceedings

Reasons that have not been pleaded by an opponent may also be examined ex officio (Patent Act Article 120-2 (1)) and evidence that has not been pleaded by an opponent may also be adopted by a panel.

The panel does not have an obligation to implement ex officio proceedings but rather may implement them at its discretion. The panel should determine whether or not to exercise its discretion to implement ex officio proceedings on a case by case basis. In order to determine, the panel shall take into account the purport of the system, under which the Japan Patent Office shall conduct proceedings for whether or not the disposition of the said patent is appropriate, and if there is any defect in the said patent, it shall realize stable establishment of patent rights at an early stage (→ 67-00) by correcting the defect. Then, the panel shall give comprehensive consideration to the impact of the case on the public interest, a possible delay in the proceedings due to ex officio examination of evidence, a possible finding of the truth as a result of the ex officio examination of evidence, etc.

Examples of using, by ex officio proceedings, reasons and evidence that have not been pleaded by an opponent include a combination of evidences (Example 4), adoption of evidence that has not been submitted by an opponent (Example 5), and change of applicable provisions (Example 6), etc.

(Example 4) Combination of evidences submitted in multiple oppositions to grant of patent

The case where a combination of evidences A and D is used as the grounds for revocation after evidences A and B were submitted by an opponent A and evidences C and D by an opponent B.

(Example 5) Use of evidence that has not been submitted by an opponent

The case where, in addition to evidences A and B submitted by an opponent, evidence C presented in a proceedings is used as the grounds for revocation.

The case where evidence discovered through an ex officio investigation is used in order to supplement evidence to support reasons for revocation of inventive step, etc. based on evidence pleaded by a written opposition (document indicating the common general technical knowledge in the technical field, etc.) or evidence to prove violation of description requirements serving as a reason for opposition.

(Example 6) Change of applicable provisions

The case where application of inventive step (Patent Act Article 29 (2)) is determined to be appropriate as reasons for opposition to grant of patent even though application of novelty (Patent Act Article 29 (1)) is claimed.

Furthermore, since it is necessary to make a final determination at an early stage in an opposition to grant of patent, evidence that has not been submitted by an opponent shall be adopted as long as, in addition to the above mentioned “(Example 5),” the evidence can be very easily obtained by administrative judges.

Meanwhile, considering that the period for filing an opposition is restricted to be within six months from the publication date of the patent gazette containing the patent (Patent Act Article 113(1)), a written opposition has to contain description of reasons for request for opposition to grant of patent (Patent Act Article 115 (1) iii), and restriction is placed on amendment to a written opposition after the period for filing an opposition (Patent Act Article 115 (2)), a document submitted with a “information offer form” after the expiration of the period for filing an opposition shall not be used as evidence except in the case where it is evident at a glance that the document constitutes appropriate reasons for revocation.

4. Documentary Proceedings

All opposition cases to grant of patent shall be examined through documentary proceedings (Patent Act Article 118 (1)).

5. Examination of Evidence and Inquiry

(1) Examination of Evidence (Patent Act Article 120 → Patent Act Article 150, Patent Act Article 151)

A. Examination of evidence (→ 35-00)

Evidence shall be examined, upon request of an opponent, etc. or ex officio, when a panel finds it to be necessary.

Where evidence is an object other than the patent gazette, etc. (witness to testify or object to be inspected), evidence may be examined in which an opponent, a patentee and an intervenor shall be required to appear for proceedings of evidence.

B. Notice of reasons for revocation

Where a patent is determined to be revoked as a result of proceedings based on the examination of evidence, reasons for revocation shall be notified and an opportunity to submit a written opinion and a request for correction shall be given to a patentee.

C. The case where multiple oppositions to a patent have been consolidated

As multiple oppositions to a patent shall be consolidated in principle, the result of examination of evidence may be used as a basis to determine all of the consolidated oppositions.

(2) Inquiry (Patent Act Article 120-8 → Patent Act Article 134(4)) (→ 37-02)

A panel shall make an inquiry to a patentee or an opponent if it is found necessary.

6. Request for Electronic Data to a Patentee, etc. or an Opponent

The administrative judges may request a patentee, an opponent or an intervenor to submit a copy of magnetic disk recording contents of a document submitted thereby (including media capable of unfailingly recording certain matters by means equivalent to those of magnetic disks*)

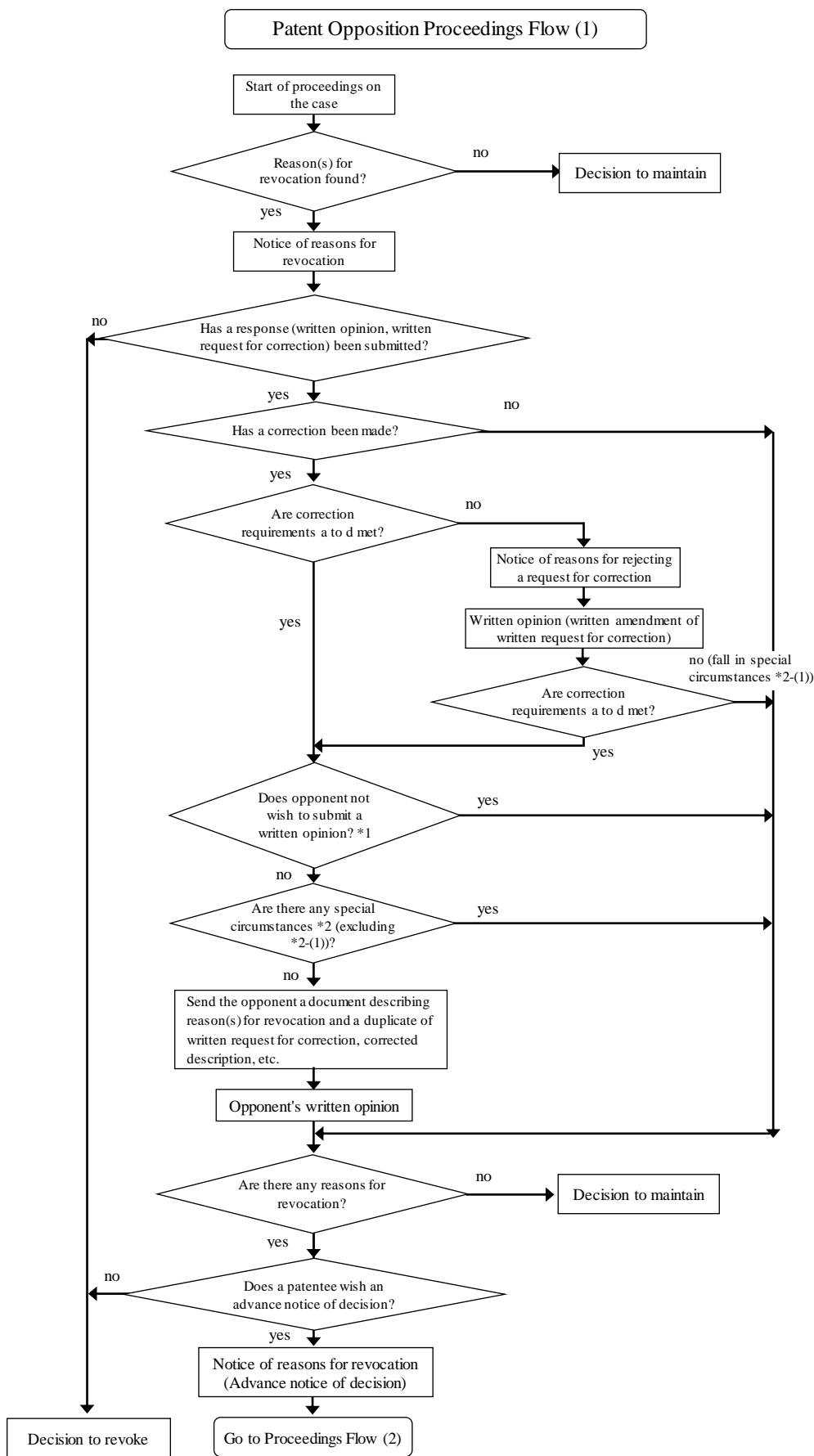
where it is found necessary in preparation for a written ruling, etc. (Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-11). (* For the definition of "magnetic disk," refer to the Regulations under the Patent Act Article 27-5 (2)).

Upon submission of the document, it is desirable that a Microsoft Word, Ichitaro or text format file should be either mailed by CD-R or DVD-R, or sent attached to an email.

7. Proceedings of the Case Where a Decision to Revoke Has Been Cancelled

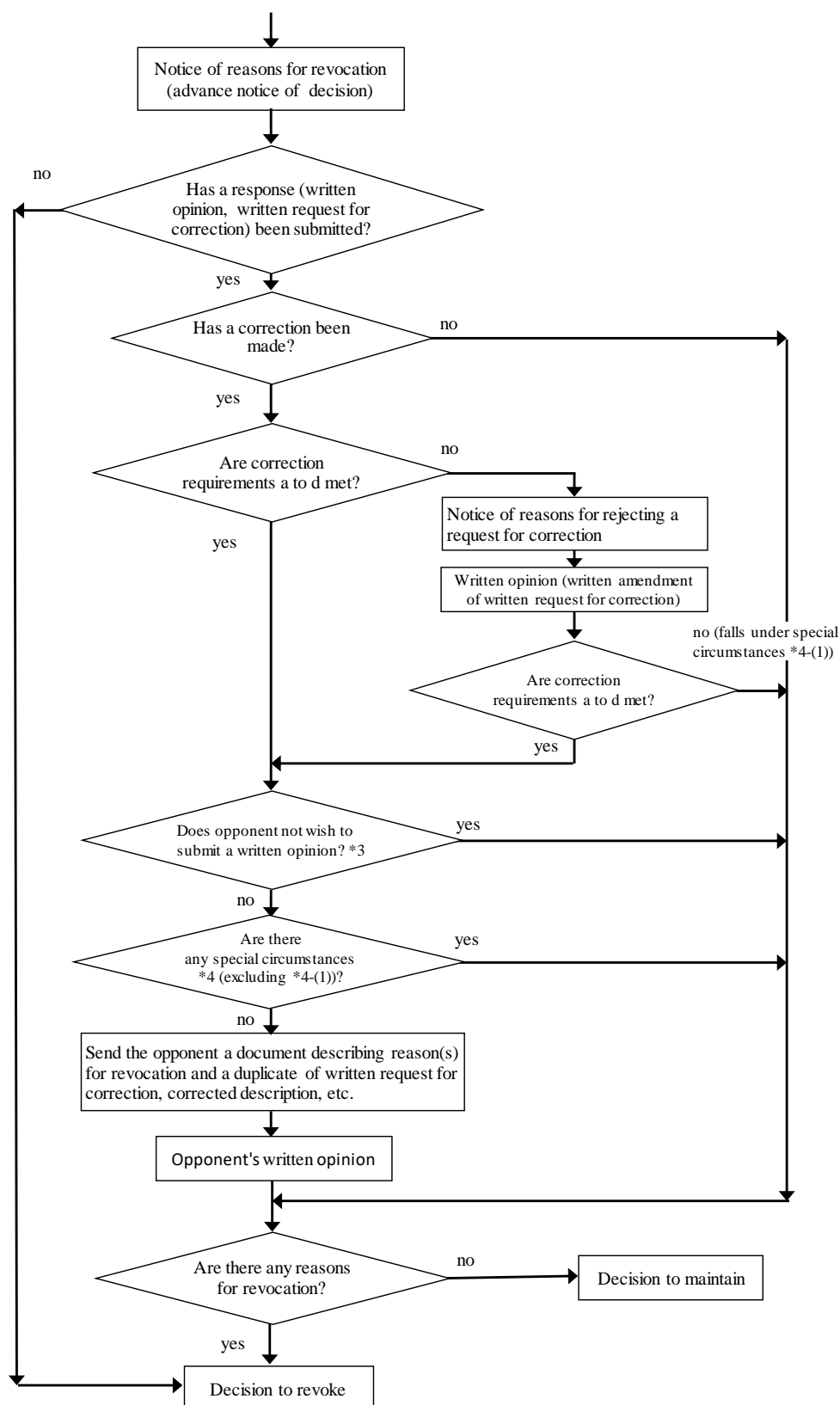
Proceedings of the case where a decision to revoke has been cancelled by the court shall be resumed similar to the usual proceedings in the Patent Office. Notice of reasons for revocation (advance notice of decision) shall be sent where a decision for revocation of a patent is made based on different reasons from those adopted for a decision by the court to revoke the patent. Where it is not possible to constitute reasons for revocation, a decision to maintain shall be rendered.

(Revised Sep. 2018)



*1. Has an opponent informed the JPO that the opponent does not wish to submit a written opinion?
 *2. See 67-05.4-2. for the case of special circumstances.

Patent Opposition Proceedings Flow (2)



*3. Has an opponent informed the JPO that the opponent does not wish to submit a written opinion?

*4. See 67-05.5-4. for the case of special circumstances (after "notice of reasons for revocation (advance notice of decision)").