

67-06 P

Decision on Opposition to Grant of Patent

1. Procedures for Decision

(1) The Case Where an Opposition to Grant of Patent Has Been Filed for Multiple Claims

When multiple requests for opposition to grant of patent has been filed for multiple claims, a decision to revoke a patent, a decision to maintain a patent, or a decision to dismiss the request shall be rendered for each of these claims by one decision.

(2) The Case Where Multiple Oppositions Have Been Filed to a Patent

In the case where multiple requests for opposition has been filed to a patent, proceedings thereof shall be consolidated in principle (→ 67-07-1.) and whether to revoke or maintain the patent shall be determined by one decision.

2. Matters to Be Described in the Decision

A decision on an opposition to grant of patent shall contain the opposition number of an opposition case, date of filing a request for opposition, the names of a patentee, an opponent and an agent, etc., indication of a patent concerning the decision, a conclusion of and reasons for the decision, and date of a decision (Patent Act Article 120-6 (1)) and all the administrative judges who have rendered the decision shall affix their names and seal thereto (Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-10) (Alternative Sealing Measure → 00-02-2.) (→ 45-03).

3. Drafting of Reasons for Decision

(1) Decision to Revoke

In a conclusion and reasons of a decision to revoke in an opposition to grant of patent, a conclusion (to maintain, to revoke, to dismiss a written request for opposition, etc.) and reasons concerning all of the claims requested for an opposition to grant of patent shall be

described. A decision to revoke shall not be rendered based on reasons that have not been described in a notice of reasons for revocation (or said notice of reasons for revocation issued as “advance notice of decision” if any). In order to avoid a situation where, after a decision to revoke has been canceled by a revocation action, a decision to revoke is rendered again based on reasons for revocation that have not been described in the original decision of revocation, a decision to revoke shall be drafted by describing, in the reasons for the decision, all of the reasons for revocation, on which the decision to revoke is based, that are described in a notice of reasons for revocation (or, said notice of reasons for revocation issued as an advance notice of decision if any).

(2) Decision to Maintain

- A. When a decision to maintain is rendered without notifying reasons for revocation, reasons that a patent is not revoked by reasons of an opposition to grant of patent shall be described in the reasons for decision on the opposition.
- B. When a decision to maintain is rendered after a notice of reasons for revocation or a notice of reasons for revocation (“advance notice of decision”), reasons that a patent is not revoked based on all of the reasons for revocation described in the last written notice of reasons for revocation (or a written notice of reasons for revocation (“advance notice of decision”) shall be described in the reasons for decision. Reasons why the patent is not revoked based on the reasons in a request for opposition that have not been adopted in the said last notice of reasons for revocation (or a notice of reasons for revocation (“advance notice of decision”)) shall also be described in the reasons for decision.

(3) The Case Where a Request for Correction Has Been Filed (→ 45-04-5.(2)E. (B))

When a request for correction has been filed for the description, scope of claims or drawings attached to the application and said correction is approved, said grant shall be indicated in the conclusion of a decision on an opposition to grant of patent and reasons for said grant shall be described in the reasons for the decision.

When said request for correction is rejected, said rejection and reasons for said rejection shall be described in the “reasons for a decision” without stating said rejection in the “conclusion of the decision.”

When a request for correction for deletion of a part of the claims has been filed, and said request is approved and there is no subject to the opposition, it shall be described that the request for opposition to deleted claims shall be dismissed.

When all of the claims covered by an opposition to grant of patent have been deleted by a request for correction, there is no subject of the opposition so that said request for correction shall be approved and the opposition shall be dismissed (Patent Act Article 120-8(1) → Patent Act Article 135).

4. Service of a Certified Copy of Decision

Where a decision has been rendered, a certified copy of the decision shall be served to a patentee, an opponent, an intervenor and persons whose application for intervention in proceedings of an opposition to grant of patent has been refused (Patent Act Article 120-6 (2)).

5. Final and Binding Decision (→ 46-00)

A decision to revoke shall become final and binding when the time limit of action against decision (→ 7. (3)) has expired. A decision to maintain shall become final and binding when a certified copy of the decision has been served.

However, in the case where an opposition to grant of patent has been filed on a claim-by-claim basis and a request for correction has been filed for each group of claims, a decision on a request for correction shall become final and binding for said each group of claims, and a decision on a request for correction filed on a claim-by-claim basis shall become final and binding on said claim-by-claim basis (Patent Act Article 120-7).

6. Effect of the Decision to Revoke

(1) When a decision to revoke has become final and binding, a patent right shall be deemed never to have existed from the beginning (Patent Act Article 114 (3)).

(2) When revocation of a patent concerning a part of claims has become final and binding, only the patent right concerning said claims shall be deemed never to have existed from the beginning (Patent Act Article 185).

Still, there is no provision established for an opposition to grant of patent that is the same as those of double jeopardy concerning a trial decision in a trial for invalidation (Patent Act Article 167) (→ 51-19-5. (3)) and double jeopardy shall not work in an opposition to grant of patent. Double jeopardy shall not work between an opposition to grant of patent and a trial for invalidation.

7. Appeal Against the Decision

(1) Decision Against Which an Action Can Be Filed

An action against a decision to revoke may be filed before the Tokyo High Court (Intellectual Property High Court) by a patentee, an intervenor or persons whose application for intervention in proceedings of opposition to grant of patent has been refused (Patent Act Article 178 (1)).

No appeal shall be available under the Administrative Appeal Act against a decision of revocation (Patent Act Article 195-4).

(2) Decision Against Which No Action Can Be Filed

A. Decision to maintain (Patent Act Article 114 (4))

B. Decision to dismiss a request for opposition to grant of patent against the deleted claims

(Patent Act Article 120-8 (1) → Patent Act Article 135)

No appeal shall be made against the above decision A. or B. even under the Administrative Appeal Law (Patent Act Article 114 (5), Patent Act Article 120-8(2) → Patent Act Article 114 (5), Patent Act Article 195-4).

(3) Time Limit of Action against Trial or Appeal Decision

An action may be filed before the Tokyo High Court (Intellectual Property High Court) within thirty days from the date on which a certified copy of the decision has been served (Patent Act Article 178 (3)). 90 days shall be added ex officio by a chief administrative judge for overseas residents who carry out procedures (Patent Act Article 178 (5)) (→ 25-04).

(4) Defendant

In an action against a decision, the Commissioner of the Patent Office shall be the defendant (Patent Act Article 179).

8. Registration of Final and Binding Decision

When a decision concerning an opposition to grant of patent has become final and binding, it shall be registered in the patent registry (Patent Registration Order Article 1 i).

9. Retrial

A patentee or an intervenor may file a request for a retrial against a final and binding decision to revoke (Patent Act Article 171 (1)). Reasons for a request for retrial are restricted to be statutory ones (→ 70-00).

10. Others

(1) Patent Certificate

The Commissioner of the Patent Office shall issue the certificate of patent to a patentee when a decision to grant a correction of the description, scope of claims, or drawings attached to the application has become final and binding and said decision has been registered in the patent registry (Patent Act Article 28 (1)).

(2) Publication in the Patent Gazette

An opposition to grant of patent and withdrawal thereof shall be published in the patent gazette (Patent Act Article 193 (2) vi).

A final and binding decision of an opposition to grant of patent, matters stated in the corrected description and scope of claims, and contents of drawings (of which a final and binding decision of correction has been made) shall be published in the patent gazette (Patent Act Article 193 (2) vii, viii).

(3) Paid Patent Fees

Patent fees for each year subsequent to the year in which a decision to revoke became final and binding shall be refunded upon the request of the person who paid them within six months from the final and binding decision (Patent Act Article 111 (1) ii, (2)).

(4) Inspection of a Written Opposition, etc.

Any person may file a request for inspection of the record of oppositions to grant of patents except for "documents which are liable to cause damage to an individual's reputation or peaceful life" or "documents which are liable to cause damage to public order or morality" where the Commissioner of the Patent Office considers it is necessary to keep such documents confidential (Patent Act Article 186 (1)) (→ 01-01-2.(2)).

(Revised Sep. 2018)