

## 67-07 P

### Handling of Multiple Oppositions to Grant of Patent

#### 1. Consolidation of Proceedings

##### (1) Principle of Consolidation of Proceedings

When multiple oppositions to the same patent right have been filed, proceedings thereof shall be consolidated, irrespective of whether claims covered by the oppositions, reasons thereof and evidence are the same or not, unless special circumstances exist (Patent Act Article 120-3 (1)).

A proceeding at issue shall be conducted after the time limit for filing an opposition expires (six months from the publication date of the patent gazette containing the patent, main paragraph of the Patent Act Article 113) (→ 67-08).

##### (2) Special Circumstances

The case under special circumstances refers to the case where consolidation of proceedings makes it difficult to continue the proceedings or causes a significant delay, etc.

The following cases are assumed as an example.

- A. The case where a decision of dismissal of written oppositions has been rendered in a part of multiple oppositions to grant of patent due to formality deficiencies and an action has been instituted against the said decision.
- B. The case where, after a decision had become final and binding following an early proceedings of an opposition to grant of patent, another opposition to grant of patent has been filed.

##### (3) Effect of Consolidation of Proceedings

###### a. Procedures after Consolidation of Proceedings

Procedures after consolidation of proceedings including a notice of reasons for revocation, submission of a written opinion or a written request for correction, a notice of

reasons for revocation (advance notice of decision), a decision on oppositions to grant of patent, etc. shall be consolidated into one procedure.

It is therefore possible to prevent inconsistency among corrections made in requests for correction that have been filed on an opposition-by-opposition basis.

**b. Use of Submitted Documents, Means of Proof, etc.**

After consolidation of proceedings, means of proof submitted on an opposition-by-opposition basis may be used in consolidated proceedings for all the oppositions to grant of patent.

**(4) Procedures for Consolidation of Proceedings**

When multiple oppositions to grant of patent have been filed, proceedings thereof shall be consolidated in principle and therefore consolidation of proceedings shall not be notified.

**(5) Identification of Each Opposition to Grant of Patent**

When multiple oppositions to grant of patent have been filed to a patent right, a case number of an opposition case, an opponent and the date of filing an opposition shall be combined to identify one of the multiple oppositions (→ 67-03-2. (1)).

**2. Separate Conduct of Proceedings**

**(1) The Case Where Proceedings Are Conducted Separately**

When multiple oppositions to grant of patent have been filed, proceedings thereof shall be consolidated in principle according to the above 1. (1). However, in the case where consolidation of proceedings may cause a significant delay etc., proceedings shall be conducted separately.

**(2) Effect of Separate Conduct of Proceedings**

Opposition cases whose proceedings have been separated shall be examined as different cases under separate independent procedures and decisions thereof shall be rendered separately.

It should be noted that materials including documents, etc. submitted before separation of proceedings shall be valid commonly in respective separated procedures.

### **(3) Procedures for Separation of Proceedings**

When proceedings are separated, it shall be notified to a patentee, an opponent and an intervenor.

In this case, inconsistency may be found among corrections made in respective requests for correction and therefore when a proceedings for a single case is conducted, proceedings of other cases shall be suspended.

### **3. Handling of Amendment of Reasons for Oppositions to Grant of Patent and Evidence**

In a opposition to grant of patent, addition or changes of reasons and evidence shall be approved where an amendment has been made before the earlier of the expiration of the time limit for filing an opposition or the time of receiving a notice of reasons for revocation (Patent Act Article 115 (2)) (→ 67-03-1. (3) C.).

In consolidated multiple oppositions to grant of patent, addition or changes of reasons and evidence shall not be approved for any of those opposition cases after a notice of reasons for revocation has been sent because reasons for revocation shall become common for all of the opposition cases by a single procedure after consolidation. If a notice of reasons for revocation for a single case has been sent after oppositions to grant of patent have been consolidated and then separated, it shall not have an effect on the other opposition cases, and therefore addition and changes of reasons and evidence in the other opposition cases shall be approved as long as addition and changes are made before notice of reasons for revocation is sent for the said opposition to grant of patent and before the time limit for filing a request for opposition expires.

### **4. Handling of Withdrawal of Oppositions to Grant of Patent**

Consolidated multiple oppositions to grant of patent shall be handled as a single case. However, the opposition to grant of patent may be withdrawn for each pre-consolidation case as long as it is withdrawn before a notice of reasons for revocation is sent (Patent Act Article 120-4 (1)) (→ 67-03-3.). After a notice of reasons for revocation is sent, the notice shall be deemed to

have been sent for all of the consolidated opposition cases. Therefore, the opposition to grant of patent may not be withdrawn.

When oppositions to grant of patent have been consolidated and then separated (→ 2.), each of them becomes a different case, and therefore an opposition to grant of patent may be withdrawn as long as it is withdrawn before notice of reasons for revocation is sent for said opposition to grant of patent, even if it is withdrawn after notice of reasons for revocation has been sent for other oppositions to grant of patent.

(Revised Sep. 2018)