

67-08 P**Proceedings before Expiration of a Time Limit for Filing a Request for Opposition to Grant of Patent****1. Proceedings before Expiration of a Time Limit for Filing a Request for Opposition to Grant of Patent**

(1) Proceedings shall be commenced prior to the expiration of the time limit for filing an opposition (opposition period) where a patentee has submitted, after receipt of a duplicate of a written opposition, a written statement (written statement to request early commencement of proceedings before the expiration of the period for filing an opposition) to a chief administrative judge of the Patent Office stating that he/she wishes to have proceedings commenced prior to the expiration of the opposition period.

However, such a request to the same effect shall not be accepted from an opponent.

(2) Where a new opposition to grant of patent has been filed after proceedings were commenced prior to the expiration of an opposition period, proceedings of said opposition shall be consolidated in principle.

(3) After a notice of reasons for revocation has been issued prior to the expiration of an opposition period, an amendment to change the gist of a written opposition (such as addition or changes of reasons for an opposition and addition or changes of indication of supporting evidence) shall not be granted (Patent Act Article 115 (2)) (→ 67-04-2.). In particular, it should be noted that where a new opposition to grant of patent is filed after a notice of reasons for revocation is issued prior to the expiration of an opposition period and proceedings thereof have been consolidated, an amendment to change the gist of the new written opposition shall not be granted from the date of filing of the new written opposition.

(4) Where proceedings commenced in advance for an opposition to grant of patent have progressed to a considerable extent in comparison with an proceedings of a new opposition and it is possible to render a decision at an early stage, these proceedings shall be separated upon sending a notice of separation thereof and the said preceding oppositions shall be

examined in a preferential manner. In this case, when proceedings of a single case are conducted, proceedings of other cases shall be suspended because inconsistent requests for correction may be further filed.

2. Handling of a Case Where a Notice of Reasons for Revocation Is Issued Prior to the Expiration of an Opposition Period

- (1) Where a notice of reasons for revocation is issued prior to the expiration of an opposition period, the notice shall contain the case number of the opposition to grant of patent that have been examined as well as specify a required number of duplicates of a written opinion, etc. submitted by a patentee (the number of opponents + the number of intervenors + 1 for proceedings) (Regulations under the Patent Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4).
- (2) Where a request for correction has been filed by a patentee in response to a notice of reasons for revocation, an opportunity to submit a written opinion shall be given to an opponent falling under the case number described in a notice of reasons for revocation (except for an opponent who has made a request that he/she does not wish to submit a written opinion) (Patent Act Article 120-5 (5)) (→ 67-05.4-1., 3.).
- (3) In contrast, where a new opposition to grant of patent has been filed after a notice of reasons for revocation is issued prior to the expiration of an opposition period and after a request for correction is made by a patentee, the number of duplicates is insufficient and therefore a copy of a document describing the reasons for revocation as well as a written opinion, a request for correction, a corrected description, scope of claims, or drawings attached thereto shall be prepared and sent to a new opponent (except for an opponent who has made a request that he/she does not wish to submit a written opinion).

3. Handling of a Case Where a Decision Is Rendered Prior to the Expiration of an Opposition Period

In the case where proceedings of an opposition to grant of patent have been commenced prior to the expiration of an opposition period and progressed to a considerable extent and it is

possible to render a decision at an early stage prior to the expiration of the opposition period, a decision may be rendered prior to the expiration of the opposition period. Where a new opposition to a patent has been filed after a decision is rendered, it shall be examined as a different case.

(Revised Sep. 2018)