

## 67-09 P

### **Co-pending Opposition to Grant of Patent and Trial for Invalidation**

#### **1. Proceedings When an Opposition to Grant of Patent and a Trial for Invalidation Are Pending Concurrently on a Patent**

(1) An opposition to grant of patent and a trial for invalidation are cases under different categories and therefore proceedings thereof may not be consolidated.

(2) Parallel proceedings of the two cases are possible when the two cases are pending concurrently. However, the following problems arise with parallel proceedings and therefore one of the proceedings shall be prioritized.

A. Since the two cases are different in types of procedures and parties concerned, parallel proceedings may give rise to inconsistency in the timing and contents of procedures, complication of procedures, and inconsistent results therebetween.

B. Where a request for correction has been filed in one or both of the two cases and the correction has become final and binding in one of the two cases, the subject of proceedings is changed in the other case and therefore a repeated proceedings will be required. Consequently, procedures for a written reply (written opinion), a written request for correction, a written refutation (written opinion), a notice of reasons for invalidation (notice of reasons for revocation), a trial decision (opposition decision), procedures for court proceedings against thereto, etc. that have been presented by the Patent Office and the parties will be wasted.

C. Where a patent is to be invalidated (revoked) in one of the two cases, it will not be necessary to conduct proceedings in another case. Despite this, if parallel proceedings of the two cases are conducted, it may impose an unnecessary burden on the Patent Office and the parties.

(3) When an opposition to grant of patent and a trial for invalidation are pending concurrently, proceedings of the trial for invalidation shall be prioritized in principle.

It is i) because a request for a trial for invalidation is often filed in relation to patent disputes including the case of infringements, etc. and therefore prompt proceedings are

required from the viewpoint of early dispute resolution, and ii) for respecting the intention of a demandant of a trial for invalidation to the extent that the demandant has filed a request for the trial for invalidation seeking a resolution of dispute by inter-partes procedures without filing an opposition to grant of patent and selected a trial for invalidation assuming a possible litigation action depending on the result of a trial decision.

- (4) However, where proceedings of an opposition to grant of patent have already progressed to a considerable extent and it is possible to render a decision on the opposition at an early stage, proceedings of the opposition shall be prioritized as an exceptional case.

Where evidence concerning a request for an opposition to grant of patent clearly has a higher probative value than evidence concerning a request for a trial for invalidation and proceedings conducted by prioritizing the opposition contribute to prompt dispute resolution of the said patent right, proceedings of the opposition may be prioritized as an exceptional case.

- (5) In the case where proceedings of an opposition to grant of patent are prioritized, reasons and evidence submitted in a trial for invalidation shall not be adopted ex officio in the proceedings of the opposition because a demandant of the trial for invalidation is not involved in the proceedings of the opposition to grant of patent and the gist of the trial for invalidation system falling under an inter-partes procedure is jeopardized.

If it is not possible to constitute reasons for revocation without adopting reasons and evidence submitted in a trial for invalidation, i) a decision to maintain shall be rendered in the case where proceedings of an opposition to grant of patent have progressed to a considerable extent, or ii) proceedings of an opposition to grant of patent shall be suspended in other cases to prioritize proceedings of a trial for invalidation where proceedings of an opposition to grant of patent have not progressed to a considerable extent.

## **2. Details of the Handling**

### **(1) The Case Where Proceedings of a Trial for Invalidation Are Prioritized**

Proceedings of an opposition to grant of patent shall be suspended (Patent Act Article 120-8 → Patent Act Article 168) and proceedings of a trial for invalidation shall be prioritized.

In this case, proceedings of the opposition shall be resumed by waiting for the trial decision of the trial for invalidation to become final and binding.

## **(2) The Case Where Proceedings of an Opposition to Grant of Patent Are Prioritized**

Proceedings of a trial for invalidation shall be suspended (Patent Act Article 120-8 → Patent Act Article 168) and proceedings of an opposition to grant of patent shall be prioritized.

In this case;

- A. Where a decision to revoke is rendered on an opposition to grant of patent, proceedings of a trial for invalidation shall be resumed by waiting for the decision to become final and binding.
- B. Where a decision to maintain is rendered, the decision becomes final and binding immediately after a certified copy of the decision has been served. Therefore, proceedings of a trial for invalidation shall be resumed promptly.

## **3. Suspension of Procedures (→ 26-01-6.)**

(1) Where a procedure of a case is suspended, a written notice of suspension of procedure shall be sent to a patentee, an opponent, a demandant of a trial for invalidation, and an intervenor.

(2) Where a procedure of a case is suspended prior to sending a duplicate of a written opposition or prior to the service of a duplicate of a written request for a trial, a written notice of suspension of procedure and a duplicate of the same shall be sent or served together to suspend a procedure. A time limit for submitting a written reply shall be specified in due course in suspension of a trial for invalidation case (→ 56-02-2. (1) A (A)).

In this case, where a notice of suspension of a case of a trial for invalidation has been issued, an opportunity to submit a written reply shall be given in a notice of cancellation of suspension by designating an adequate time limit (normally 60 days, or 90 days for overseas residents → 25-01.2).

(3) Where a procedure of a case to be suspended falls in a time limit for responding to an office action, a notice of suspension shall be issued by waiting for the time limit to expire (→ 56-02-2. (1) b).

#### 4. Cancellation of Suspension of Procedures

- (1) Where suspension of a procedure of a case is cancelled, a written notice of cancellation of suspension of procedure shall be issued to a patentee, an opponent, a demandant of a trial for invalidation, and an intervenor to cancel suspension of a procedure.
- (2) In cancellation of suspension of a procedure for an opposition to grant of patent, where a correction has become final and binding in a trial for invalidation which proceedings are prioritized and the subject of the opposition has been changed, contents of the said correction (a written request for correction and a corrected description, scope of claims, or drawings attached thereto) shall be notified to an opponent except for the case where an opponent has made a request that he/she does not wish to submit a written opinion, etc., and an opportunity to submit a written opinion on the corrected patent shall be given to the opponent by designating an adequate time limit (normally 30 days, or 50 days for overseas residents → 25-01.4) (→ 67-05.4).
- (3) In cancellation of suspension of a procedure for a trial for invalidation, where a correction has become final and binding in an opposition to grant of patent which proceedings are prioritized and the subject of the trial for invalidation has been changed, contents of the said correction (a written request for correction and a corrected description, scope of claims, or drawings attached thereto) shall be notified to a demandant of the trial for invalidation and an opportunity to submit a written refutation shall be given to the demandant by designating an adequate time limit (normally 30 days or 50 days for overseas residents, → 25-01.2).

Where a change in the subject of a trial for invalidation has given rise to a change of the gist of reasons for a request, the chief administrative judge shall seek the consent of a demandee to grant an amendment of the written request (Patent Act Article 131-2 (2) ii: note that Patent Act Article 131-2 (2) i shall not be applicable because such a correction is not the one made by a request for correction in a trial for invalidation).

(Revised Sep. 2018)