

## **67-11 P**

### **Handling of Opposition to Grant of Patent Case after the Opposed Patent Has Been Surrendered or Has Lapsed**

#### **1. Handling of Opposition to Grant of Patent Case after the Opposed Patent Has Been Surrendered or Has Lapsed**

It is specified that a request for a trial for invalidation may be filed after the surrender or lapse of the patent right (Patent Act Article 123 (3)) and therefore a request for a trial may be filed even after the surrender or lapse of the patent right.

In contrast, there is no provision in an opposition to grant of patent specifying the same as the above provision of a trial for invalidation and therefore it shall be interpreted as that an opposition to grant of patent is not expected after the surrender or lapse of a patent right.

Therefore, an opposition to grant of patent that has been filed within an opposition period and after the surrender or lapse of a patent right which is the subject of the opposition will become an unlawful opposition subjected to a patent right which does not exist. Consequently, a panel shall dismiss such an opposition by a decision (Patent Act Article 120-8 (1) → Patent Act Article 135).

Such handling shall not cause a serious detriment because an interested party may file a request for a trial for invalidation even after a patent right has been surrendered or has lapsed.

#### **2. Handling of the Case Where a Patent Right Has Been Surrendered or Lapsed after an Opposition to Grant of Patent Is Requested**

Even if a patent has been surrendered or has lapsed during appeal proceedings of an opposition to grant of patent (due to abandonment of patent right, unpaid fees, expiration of the period of the right, invalidation according to Patent Act Article 123 (1) vii, etc.), the opposition is lawful at the time of filing the opposition of grant of patent.

On the assumption that no decision is rendered based on the reasons of surrender or lapse of a patent right during proceedings resulting from abandonment of the patent right by a patentee,

etc.: i) a conclusion as to whether or not to render a decision is different exclusively depending on whether a period of proceedings is long or short before the surrender or lapse of a patent right, in which fairness is impaired, or ii) interests of a patentee resulting from the presence of a patent right in the past shall remain and an opponent who filed a lawful opposition to grant of patent is forced to file a request for a trial for invalidation.

Thus, the surrender or lapse of a patent right does not necessarily give rise to immediate elimination of the necessity of attaining a correction of a patent having defects and it is therefore required to render a decision except for the case where a patent right is deemed never to have existed.

Accordingly, when a patent right has been surrendered or has lapsed after filing an opposition to grant of patent, proceedings shall be conducted to render a decision except for the cases where a patent right shall be deemed never to have existed, including a case where a patent has been invalidated by a trial for invalidation, a case where all the claims have been deleted by a trial for correction or a request for correction, etc.

(Revised Sep. 2018)