

67-00 P

Opposition to Grant of Patent

1. Objective of the System

The System of Opposition to Grant of Patent provides third parties with a wide range of opportunities to seek review of a patent within a fixed period after the grant of the patent so that the Japan Patent Office examines the appropriateness of the disposition of the patent in response to an opposition thereto and, if defects are found in the patent, attains early stabilization of the patent through corrections.

[Comparison with the System of Trial for Invalidation]

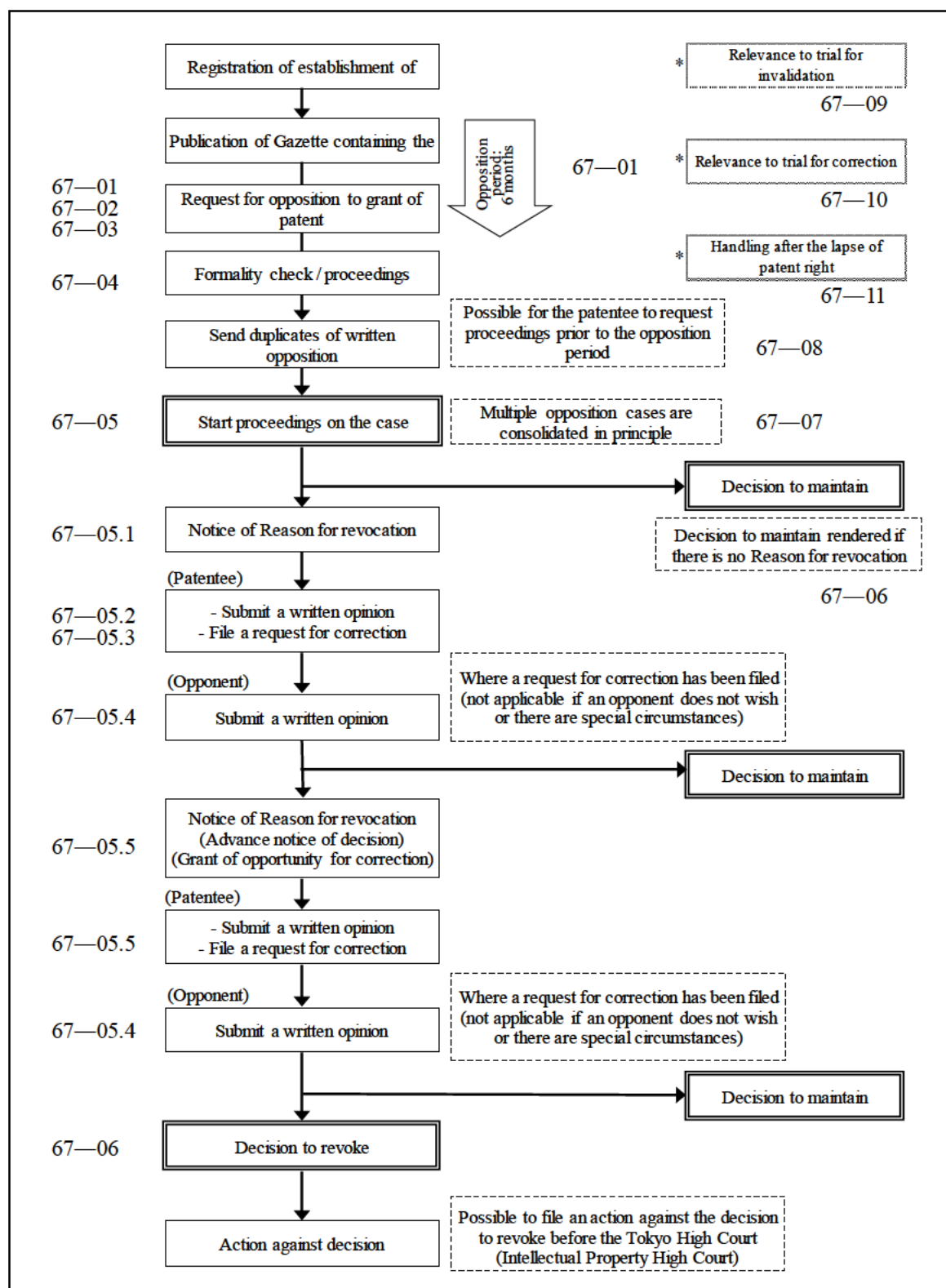
	System of Opposition to Grant of Patent	System of Trial for Invalidation
Purport of the System	To realize stable establishment of patent rights at an early stage	To resolve disputes between parties regarding the validity of a patent
Procedures	Ex-parte procedures (carried out between the Japan Patent Office and the patentee in principle)	Inter-partes procedures (carried out between a demandant and a demandee or patentee)
Eligible Opponent/ Demandant	Any persons (no anonymous person)	Interested persons only
Opposition/ Request Period	Within six months from the publication date of the patent gazette containing the patent (not possible after the lapse of the patent right)	Any time after the registration of establishment (possible even after the lapse of the patent right)
Opposition/ Request and Withdrawal thereof	Possible on a claim-by-claim basis Withdrawal is not possible after notice of reasons for revocation	Possible on a claim-by-claim basis Withdrawal after submission of written reply is possible with consent of the counterparty
Reasons for Opposition/ Invalidation	(1) Reasons of public interest (lack of novelty, lack of inventive step, violation of description requirements, etc.)	(1) Reasons of public interest (lack of novelty, lack of inventive step, violation of description requirements, etc.) (2) Reasons related to attribution of rights (usurped application, violation of joint application) (3) Reasons occurring after the grant of patent (violation of enjoyment of rights, violation of treaties)

Method of Proceedings	Documentary proceedings (no oral proceedings)	Oral proceedings in principle (documentary proceedings are also possible)
Handling of Multiple Oppositions/Cases	Consolidated proceedings in principle	Proceedings on a case-by-case basis without consolidated proceedings in principle
Advance Notice of Decisions/Trial Decisions	Notice of reasons for revocation before decision to revoke is made (advance notice of decision)	Advance notice of trial decision before decision to uphold demandant's claim (trial decision on invalidation)
Decisions/Trial Decisions	Decision to revoke or maintain, or decision to dismiss	Trial decision to approve, reject or dismiss
Appeal	An action may be filed by a patentee against a decision to revoke before the Tokyo High Court (Intellectual Property High Court) by appointing the Commissioner of the Japan Patent Office as a defendant. An appeal against a decision to maintain or a decision to dismiss is not possible.	An action may be filed by both a demandant of a trial and a patentee before the Tokyo High Court (Intellectual Property High Court) by appointing the counterparty as a defendant.
Fees	16,500 yen + (the number of claims opposed \times 2,400 yen)	49,500 yen + (the number of claims requested \times 5,500 yen)

2. Applicable Subjects

An opposition to a patent is applicable to patents contained in the patent gazette published on April 1, 2015 or later (Act No. 36 of 2014, Supplementary Provision Article 2 (16), Government Ordinance No. 25 of 2015).

Procedure Flow of Patent Opposition System



* Numbers in the figure (e.g. 67-01) refer to sections (or chapters) describing related matters.

(Revised Sep. 2018)

67-01 P

Reasons for Opposition to Grant of Patent and Time Limit for Filing a Request for Opposition to Grant of Patent

1. Opposition to Grant of Patent

(1) Any person may file to the Commissioner of the Japan Patent Office an opposition to grant of patent on the ground that a patent falls under any of the items of the Patent Act Article 113.

(2) In the event that a patent has two or more claims, an opposition to grant of patent may be filed for each claim. (Patent Act Article 113).

However, in the event that requests for an opposition to grant of patent are filed for all claims, a request shall be deemed to have filed for each claim.

(3) With regard to a patent of which patent right has lapsed, an opposition to grant of patent may not be filed (→ 67-11).

2. Reasons for Opposition to Grant of Patent

Reasons for opposition to grant of patent are restricted to those specified under the Patent Act Article 113 and the other reasons are not eligible.

(1) Reasons for Opposition to Grant of Patent Specified Under the Patent Act Article 113

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|--------------------------|---|
| A. Paragraph (1) related | new matter beyond the original text (excluding foreign language applications) (Patent Act Article 17-2 (3)) |
| B. Paragraph (2) related | Violation of requirements for enjoyment of rights by foreign nationals (Patent Act Article 25)

Violation of requirement for patentability (Patent Act Article 29, Article 29-2)

Unpatentable invention reason (Patent Act Article 32)

Earlier/later application (Patent Act Article 39 (1) to (4)) |
| C. Paragraph (3) related | Violation of a treaty (Patent Act Article 113 iii) |

- | | |
|--------------------------|---|
| D. Paragraph (4) related | Violation of description requirements (Patent Act Article 36 (4) i, (6) excluding iv) |
| E. Paragraph (5) related | New matter beyond the original text in foreign language applications (Patent Act Article 113 v) |

(2) Relationship between the Reasons for Opposition and the Reasons for Refusal

Among the reasons for refusal as specified in the Patent Act Article 49, the following reasons shall not be grounds of opposition to grant of patent: formality reason (shift amendment, Patent Act Article 17-2 (4), Article 49 i), violation of ministerial ordinance requirements in description requirements (Patent Act Article 36 (6) iv, Article 49 iv), violation of requirements of unity of invention (Patent Act Article 37, Article 49 iv), violation of description requirements of information known through publication after notice under Patent Act Article 48-7 (Patent Act Article 36 (4) ii, Article 49 v) and reasons concerning attribution of right (violation of requirements of joint applications, Patent Act Article 38, Article 49 ii), and usurped applications (Patent Act Article 49 vii).

(3) Relationship between the Reasons for Opposition and Reasons for Invalidation

Among the reasons for invalidation as specified in the Patent Act Article 123 (1), the following reasons shall not be grounds of opposition to grant of patent: reasons concerning attribution of right (violation of requirements of joint applications, Patent Act Article 38, Article 123 (1) ii), usurped applications (Patent Act Article 123 (1) vi), reasons occurring after the grant of patent (violation of requirements for enjoyment of rights by foreign nationals and violation of a treaty due to reasons occurring after the grant of patent, Patent Act Article 123 (1) vii), and violation of correction requirements (Patent Act Article 123 (1) viii).

3. Time Limit for Filing a Request for Opposition to Grant of Patent

Any person may file to the Commissioner of the Patent Office an opposition to grant of patent within six months from the publication date of the patent gazette containing the patent (main paragraph of Patent Act Article 113).

An opposition to grant of patent that has been filed during the period other than the said period, or an opposition to grant of patent that has been filed within said period but after the lapse of the patent right is deemed to be an unlawful opposition which may not be corrected by an amendment, and therefore shall be dismissed by a decision by a panel (Patent Act Article 120-8 (1) → Patent Act Article 135) (→ 67-04, 67-11).

4. Inspection of Filed Documents, etc.

Matters recorded in a file of a patent application which has been registered (filed documents, etc.) may be inspected free of charge within one year from the publication date of the patent gazette containing the patent (Law concerning the Special Provisions to the Procedure, etc. relating to an Industrial Property Right Article 40 (1) ii, Special Decree for Fee Article 5 (2)).

(Revised Sep. 2018)

67-02 P**Patentee, Opponent, and Intervenor of Opposition to Grant of Patent****1. Patentees**

When a patent right is jointly owned, all of the joint owners of the said patent right are deemed to be patentees.

2. Patent Opponents

An opposition to grant of patent may be filed by "any person" without being restricted to interested persons (Patent Act Article 113). Specifically, a natural person, a juridical person, or an association or foundation which is not a juridical person, but for which a representative or an administrator has been designated may file an opposition (Patent Act Article 6 (1) ii). However, an opposition to grant of patent shall not be filed anonymously (Patent Act Article 115 (1) i).

When a patent opponent has died or has been extinguished as a result of merger, the status of the patent opponent may not be succeeded (→ 22-01, 26-01).

(Judicial precedent) (Oppositions before the grant of patent prior to December 31, 1995)

"The patent opposition system was established from the viewpoint of public interest to exclude any error in the examination of application for trademark registration and ensure appropriate examination by allowing any person, irrespective of whether the person has any interest or not, to file an opposition. If a company serving as an opponent has been extinguished as a result of merger, the opposition shall lapse by the merger and the status of the opponent shall not be succeeded to a company surviving the merger."

(Judgment of the Supreme Court, June 19, 1981 (Sho 53 (Gyo-Tsu) No. 103))

3. Intervenor (Patent Act Article 119 → Patent Act Article 148) (→ 57-00 to 09)

(1) Person Eligible to Intervene (→ 57-01)

A. A person who has a right related to a patent right, has an interest in other patent rights, and assists a patentee may intervene in the proceedings (Patent Act Article 119 (1)).

A person who has a right related to a patent right is, for example, an exclusive licensee or non-exclusive licensee.

B. Since intervention from the patent opponent side is not provided in the Patent Act, it shall not be granted.

(2) Effect of Intervention (→ 57-05)

To assist a patentee, an intervenor may advance allegations and evidence and undertake all procedures for opposition to grant of patent (Patent Act Article 119 (2) → Patent Act Article 148).

Related documents sent to a patentee shall also be sent to an intervenor.

In this Chapter 67, the "patentee" may include an "intervenor" to the extent of the purpose of assisting a patentee.

(3) Decision on Approval or Disapproval of Intervention (→ 57-07)

(Revised Sep. 2018)

67-03 P**Opposition to Grant of Patent Procedures****1. Written Oppositions, etc.****(1) General Matters**

To file an opposition to grant of patent, a prescribed written opposition shall be filed (Patent Act Article 115, Regulations under the Patent Act Article 45-2, Form 61-2).

In this case, a written opposition and attachments must be filed with duplicates thereof as necessary (for the number of patentees + 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) Indication of Patent, Opponent, etc.**A. Indication of patent relating to an opposition to grant of patent**

A written opposition shall indicate a patent number relating to an opposition and claims for which the opposition is filed.

B. Opponents, etc. (→ 21-00-4.)

A written opposition shall contain the name and the domicile or residence of the opponent and the agent.

Where an opponent is not a natural person, a written opposition shall contain the name of the opponent and the name of the representative. However, where procedures are carried out by an agent, a written opposition does not require the name of a representative.

Where there are multiple agents, or a patent business corporation serves as an agent, an agent (a patent attorney, etc.) who is in charge shall be indicated if possible.

In addition, for communication with the Patent Office, the telephone and facsimile numbers shall be stated if possible.

(3) Reasons for Opposition to Grant of Patent and Indication of Supporting Evidence

A written opposition shall contain reasons for opposition to grant of patent and indication of supporting evidence.

A. Reasons for opposition to grant of patent

A written opposition shall contain provisions of any applied item of the Patent Act Article 113 (applicable provisions) on which revocation of the patent is based and concrete reasons for revocation of the patent.

B. Indication of supporting evidence (→ 34-01)

Evidence to prove concrete facts claimed as reasons for opposition to grant of patent shall be indicated (Regulations under the Patent Act Article 45-2, Note 6 of Form 61-2).

Means of proof of an opposition to grant of patent shall be a document in general and may also be an inspection item, witness, expert witness, and an opponent him/herself.

Where means of proof is a document, the original shall be submitted to the Patent Office along with copies thereof according to the number of patentees (Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50 (2)).

To submit a document prepared in a foreign language, a Japanese translation of the part of the document for which examination is sought shall be attached thereto (Regulations under the Patent Act Article 61 (1)).

C. Amendment of reasons and evidence (→ 67-04)

It is desirable to file an opposition to grant of patent upon completion of reasons and evidence in the first place. However, addition or change of reasons or evidence in an amendment made before the earlier of the expiration of an opposition period or the time of notice of reasons for revocation shall be possible (Patent Act Article 115 (2)). In other words, basically, addition or change of reasons or evidence shall be allowed before the expiration of an opposition period. However, if a notice of reasons for revocation is issued during the opposition period, the allowed period shall be reduced to a period before the time on which the said notice of reasons for revocation is issued (→ see 67-08 for trial proceedings before the expiration of the opposition period) (→ see 67-07-3. for multiple opposition filed to grant of patent).

2. Procedures after Opposition to Grant of Patent is Filed

(1) Assignment of Opposition Number and Case Number (→ 11-01)

Oppositions to grant of the same patent right shall be assigned with the same opposition case number irrespective of the number of oppositions, and further assigned with case numbers in units of oppositions.

(Examples) Patent right 1	Opponent A	Opposition 20XX-000001	Case No. 01
Patent right 1	Opponent B	Opposition 20XX-000001	Case No. 02
Patent right 2	Opponent C	Opposition 20XX-000002	Case No. 01

(2) Sending a Duplicate of a Written Opposition

The chief administrative judge shall send a duplicate of a written opposition to a patentee (Patent Act Article 115 (3)).

Where multiple oppositions to grant of patent have been filed, a duplicate of a written opposition shall be sent according to each opposition and shall not be sent collectively after the expiration of an opposition period.

(3) Notice of Consolidation

Where multiple oppositions to grant of patent have been filed, proceedings thereof shall be consolidated in principle, and therefore, a notice of consolidation of proceedings shall not be issued.

(4) Notice to Exclusive Licensees, etc. (→ 11-02)

Where an opposition to grant of patent is filed, the chief administrative judge shall notify the opposition to exclusive licensees of the patent right and other persons who have a right registered in relation to the patent (referred to as the "exclusive licensees, etc." in this Chapter 67) (Patent Act Article 115 (4) → Patent Act Article 123 (4)).

(5) Preliminary Registration of an Opposition to Grant of Patent

Where an opposition to grant of patent is filed, it shall be preliminarily registered in the patent registry (Patent Registration Order Article 3 iii). The date of an opposition to grant of patent, an opposition case number, and indication of a patent (patent number and indication

of claims) relating to the opposition shall be recorded in the indication part of the patent registry (Patent Registration Order Enforcement Regulation Article 38)

(6) Publication in the Patent Gazette

Where an opposition to grant of patent is filed, it shall be published in the patent gazette (Patent Act Article 193 (2) vi).

3. Withdrawal of Opposition to Grant of Patent

An opposition to grant of patent may be withdrawn before a notice of reasons for revocation (Patent Act Article 120-4 (1)) (→ see 67-07-4. for multiple oppositions filed to grant of patent). When opposition to grant of patent with regards to two or more claims covered by the patent, the opposition can be withdrawn on a claim-by-claim basis (Patent Act Article 120-4 (2) → Patent Act Article 155 (3)) (→ 43-05). When an opposition to grant of patent has been withdrawn, a patentee and an intervenor shall be notified of the withdrawal (Regulations under the Patent Act Article 45-6 → Article 50-5).

In contrast, an opposition to grant of patent may not be withdrawn after a notice of reasons for revocation (Patent Act Article 120-4 (1)).

When a written withdrawal has been submitted after a notice of reasons for revocation, a trial proceedings shall be carried out by giving an opponent an opportunity to explain and then dismissing the written withdrawal (Patent Act Article 120- (1) → Patent Act Article 133-2).

When all the oppositions to grant of patent right have been withdrawn, a trial proceedings thereof shall be terminated.

(Revised December 2020)

67-04 P**Deficiencies and Amendment in Opposition to Grant of Patent****1. Deficiencies and Disposition in Opposition to Grant of Patent (Written Opposition) (→ 21-00 to 09)****(1) Order to Amend and Dismissal of Opposition**

If an opponent does not make amendments on his/her own initiative to violation of formal requirements of a written opposition (lack of description items, ambiguity, underpayment of fees, or no payment of fees, etc.), the chief administrative judge shall either order the opponent to amend the opposition or make an inquiry to the opponent depending on the content of violation of formal requirements (Patent Act Article 120-8 (1) → Patent Act Article 133 (1), (2), Patent Act Article 134 (4)) (→ 21-02). If an amendment is not made within the designated time limit (normally 10 to 30 days depending on the contents of deficiencies → 25-01.5) according to the order to amend, the chief administrative judge shall dismiss a written opposition by decision (Patent Act Article 120-8 (1) → Patent Act Article 133 (3)).

(2) Unlawful and Not Amendable Opposition to Grant of Patent and Dismissal of the Opposition

An unlawful and not amendable opposition to grant of patent (such as an opposition filed during the period other than the opposition period, and an opposition filed with non-existence of a patent as a subject, etc.) shall be dismissed by a decision by a panel (Patent Act Article 120-8 (1) → Patent Act Article 135).

If an amendment of reasons and evidences for an opposition to grant of patent is not made before the earlier of the expiration of an opposition period or the time of notice of reasons for revocation with regard to a part of claims covered by the opposed patent, and no substantial statement or indication is provided for reasons for opposition and evidences thereof, the opposition shall be dismissed, however, this shall not apply where the opposition has been withdrawn with regard to said claims by that time.

(3) Appeal against Decision to Dismiss

If a person is dissatisfied with a decision on dismissal of a written opposition under the above (1), an appeal may be instituted before the Tokyo High Court (Intellectual Property High Court) (Patent Act Article 178 (1)).

No appeal shall be available against a decision on dismissal of a written opposition to grant of patent under the above (2) (Patent Act Article 120-8(2), Article 135, Article 195-4).

2. Amendment in Opposition to Grant of Patent (Written Opposition)

(1) Amendment in General

A written opposition shall contain the subject of the opposition (an opponent), the object (indication of a patent, i.e. patent number and claims, relating to the opposition), reasons for the opposition, and supporting evidence (Patent Act Article 115 (1)). The written opposition may be amended at any time but shall not change its gist (Patent Act Article 115 (2) text).

(2) Concrete Approach

A. Amendment of the subject (opponent)

An amendment of the subject (opponent) of an opposition to grant of patent is deemed to be a change of the gist if the identity of the opponent is lost. An amendment of errors of description in such a way that its subject remains identical is not deemed to be a change of the gist.

B. Amendment of the object (patent number and claims)

An amendment of the object (patent number and claims) of an opposition to grant of patent is deemed to be a change of the gist if the identity of the patent number and claims is lost.

However, even though deletion of claims as the subject of an opposition is deemed to be a change of the gist per se, it can be handled in the same manner as withdrawal of claims covered by an opposition (→ 67-03-3) and therefore it is not deemed to be a change of the gist until notice of reasons for revocation is issued, on an exceptional basis.

C. Amendment of reasons and evidences

Concerning an amendment of reasons for opposition to grant of patent and evidence, even if the gist thereof is changed, addition or change of reasons or evidence shall be possible on an exceptional basis until the earlier of the expiration of an opposition period or the time of notice of reasons for revocation (provision to Patent Act Article 115 (2)) (→ 21-06).

After that, an amendment shall be possible only within the scope without changing the gist of a written opposition.

(Reference) System flow from an opposition to grant of patent to the start of a trial on the merits (→ 20-00)

(Revised Sep. 2018)

67-05 P**Opposition to Grant of Patent Proceedings****1. Proceedings Body and Administrative Judges****(1) Proceedings Body (Patent Act Article 114 (1))**

An opposition to grant of patent shall be examined by a panel constituting of administrative judges to sufficiently secure fairness, independence and appropriateness of the proceedings.

(2) Designation of Administrative Judges and a Trial Clerk (Patent Act Article 116 → Patent Act Article 137 (1), Patent Act Article 117 (1), Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 48 (2)) (→ 12-01 to 04)

The Commissioner of the Patent Office shall designate administrative judges and a trial clerk for each case of an opposition to grant of patent.

When the administrative judges and the trial clerk have been designated or changed, the names of the administrative judges and the trial clerk shall be notified to a patentee, an opponent, and an intervenor.

(3) Authority of the Chief Administrative Judge (Patent Act Article 116 → Patent Act Article 138)

The Commissioner of the Patent Office shall designate one of the designated administrative judges as a chief administrative judge. The chief administrative judge shall preside over matters relating to the opposition case.

(4) A Motion Requesting an Exclusion or Recusation (Patent Act Article 116 → Patent Act Article 139 to 144, Patent Act Article 117 (2) → Patent Act Article 144-2 (5)) (→ 59-01)

A patentee, an opponent or an intervenor may file a motion requesting an exclusion or recusation to administrative judges and a trial clerk.

2. Start of Proceedings of Opposition to Grant of Patent

- (1) When multiple oppositions to grant of patent have been filed, proceedings thereof shall be consolidated and a panel shall organize all the reasons for opposition to examine them jointly (Patent Act Article 120-3 (1)) (→ 67-07)). Proceedings on the case shall be conducted after the expiration of the period for filing an opposition.
- (2) Even before the expiration of the period for filing an opposition, proceedings shall begin upon request by a patentee (→ 67-08).
- (3) An opposition to grant of patent shall be processed by having a patentee present a written opinion, etc. in response to reasons for revocation notified by the chief administrative judge, rather than by having a patentee answer to reasons and evidence stated in a written opposition, or written opinion submitted by an opponent.

3. Scope of Proceedings

(1) Subject of Proceedings

The subject of a proceedings is restricted to claims of which an opposition to grant of patent has been filed (Patent Act Article 120-2 (2)).

When multiple requests for opposition to grant of patent have been filed, proceedings thereof shall be consolidated in principle (→ 67-07) and all the claims opposed by any of the consolidated oppositions are deemed to be the subject of the proceedings.

(2) Proceedings Based on Reasons for Opposition to Grant of Patent and Evidence

An opposition to grant of patent shall be examined based on reasons pleaded by an opponent and evidence (Examples 1 to 3).

(Example 1) Adoption of reasons for opposition to grant of patent and evidence without addition or change

The case where a combination of evidence A and evidence B submitted by an opponent A is found to be appropriate and therefore used without addition or change.

(Example 2) Adoption of appropriate reasons and evidence to serve as reasons for revocation from reasons for opposition to grant of patent and evidence

The case where a combination of evidence A and evidence B is used as reasons for revocation after a combination of evidence A and evidence B or evidence C and evidence D was selectively submitted by an opponent A.

(Example 3) Adoption of reasons and evidence to serve as reasons for revocation based on reasons for multiple oppositions to grant of patent and evidence

The case where a combination of evidence A and evidence B, and evidence E are used respectively as reasons for revocation after a combination of evidences A and B was submitted by an opponent A, a combination of evidences C and D by an opponent B, and evidence E by an opponent C respectively.

(3) Ex Officio Proceedings

Reasons that have not been pleaded by an opponent may also be examined ex officio (Patent Act Article 120-2 (1)) and evidence that has not been pleaded by an opponent may also be adopted by a panel.

The panel does not have an obligation to implement ex officio proceedings but rather may implement them at its discretion. The panel should determine whether or not to exercise its discretion to implement ex officio proceedings on a case by case basis. In order to determine, the panel shall take into account the purport of the system, under which the Japan Patent Office shall conduct proceedings for whether or not the disposition of the said patent is appropriate, and if there is any defect in the said patent, it shall realize stable establishment of patent rights at an early stage (→ 67-00) by correcting the defect. Then, the panel shall give comprehensive consideration to the impact of the case on the public interest, a possible delay in the proceedings due to ex officio examination of evidence, a possible finding of the truth as a result of the ex officio examination of evidence, etc.

Examples of using, by ex officio proceedings, reasons and evidence that have not been pleaded by an opponent include a combination of evidences (Example 4), adoption of evidence that has not been submitted by an opponent (Example 5), and change of applicable provisions (Example 6), etc.

(Example 4) Combination of evidences submitted in multiple oppositions to grant of patent

The case where a combination of evidences A and D is used as the grounds for revocation after evidences A and B were submitted by an opponent A and evidences C and D by an opponent B.

(Example 5) Use of evidence that has not been submitted by an opponent

The case where, in addition to evidences A and B submitted by an opponent, evidence C presented in a proceedings is used as the grounds for revocation.

The case where evidence discovered through an ex officio investigation is used in order to supplement evidence to support reasons for revocation of inventive step, etc. based on evidence pleaded by a written opposition (document indicating the common general technical knowledge in the technical field, etc.) or evidence to prove violation of description requirements serving as a reason for opposition.

(Example 6) Change of applicable provisions

The case where application of inventive step (Patent Act Article 29 (2)) is determined to be appropriate as reasons for opposition to grant of patent even though application of novelty (Patent Act Article 29 (1)) is claimed.

Furthermore, since it is necessary to make a final determination at an early stage in an opposition to grant of patent, evidence that has not been submitted by an opponent shall be adopted as long as, in addition to the above mentioned “(Example 5),” the evidence can be very easily obtained by administrative judges.

Meanwhile, considering that the period for filing an opposition is restricted to be within six months from the publication date of the patent gazette containing the patent (Patent Act Article 113(1)), a written opposition has to contain description of reasons for request for opposition to grant of patent (Patent Act Article 115 (1) iii), and restriction is placed on amendment to a written opposition after the period for filing an opposition (Patent Act Article 115 (2)), a document submitted with a “information offer form” after the expiration of the period for filing an opposition shall not be used as evidence except in the case where it is evident at a glance that the document constitutes appropriate reasons for revocation.

4. Documentary Proceedings

All opposition cases to grant of patent shall be examined through documentary proceedings (Patent Act Article 118 (1)).

5. Examination of Evidence and Inquiry

(1) Examination of Evidence (Patent Act Article 120 → Patent Act Article 150, Patent Act Article 151)

A. Examination of evidence (→ 35-00)

Evidence shall be examined, upon request of an opponent, etc. or ex officio, when a panel finds it to be necessary.

Where evidence is an object other than the patent gazette, etc. (witness to testify or object to be inspected), evidence may be examined in which an opponent, a patentee and an intervenor shall be required to appear for proceedings of evidence.

B. Notice of reasons for revocation

Where a patent is determined to be revoked as a result of proceedings based on the examination of evidence, reasons for revocation shall be notified and an opportunity to submit a written opinion and a request for correction shall be given to a patentee.

C. The case where multiple oppositions to a patent have been consolidated

As multiple oppositions to a patent shall be consolidated in principle, the result of examination of evidence may be used as a basis to determine all of the consolidated oppositions.

(2) Inquiry (Patent Act Article 120-8 → Patent Act Article 134(4)) (→ 37-02)

A panel shall make an inquiry to a patentee or an opponent if it is found necessary.

6. Request for Electronic Data to a Patentee, etc. or an Opponent

The administrative judges may request a patentee, an opponent or an intervenor to submit a copy of magnetic disk recording contents of a document submitted thereby (including media capable of unfailingly recording certain matters by means equivalent to those of magnetic disks*)

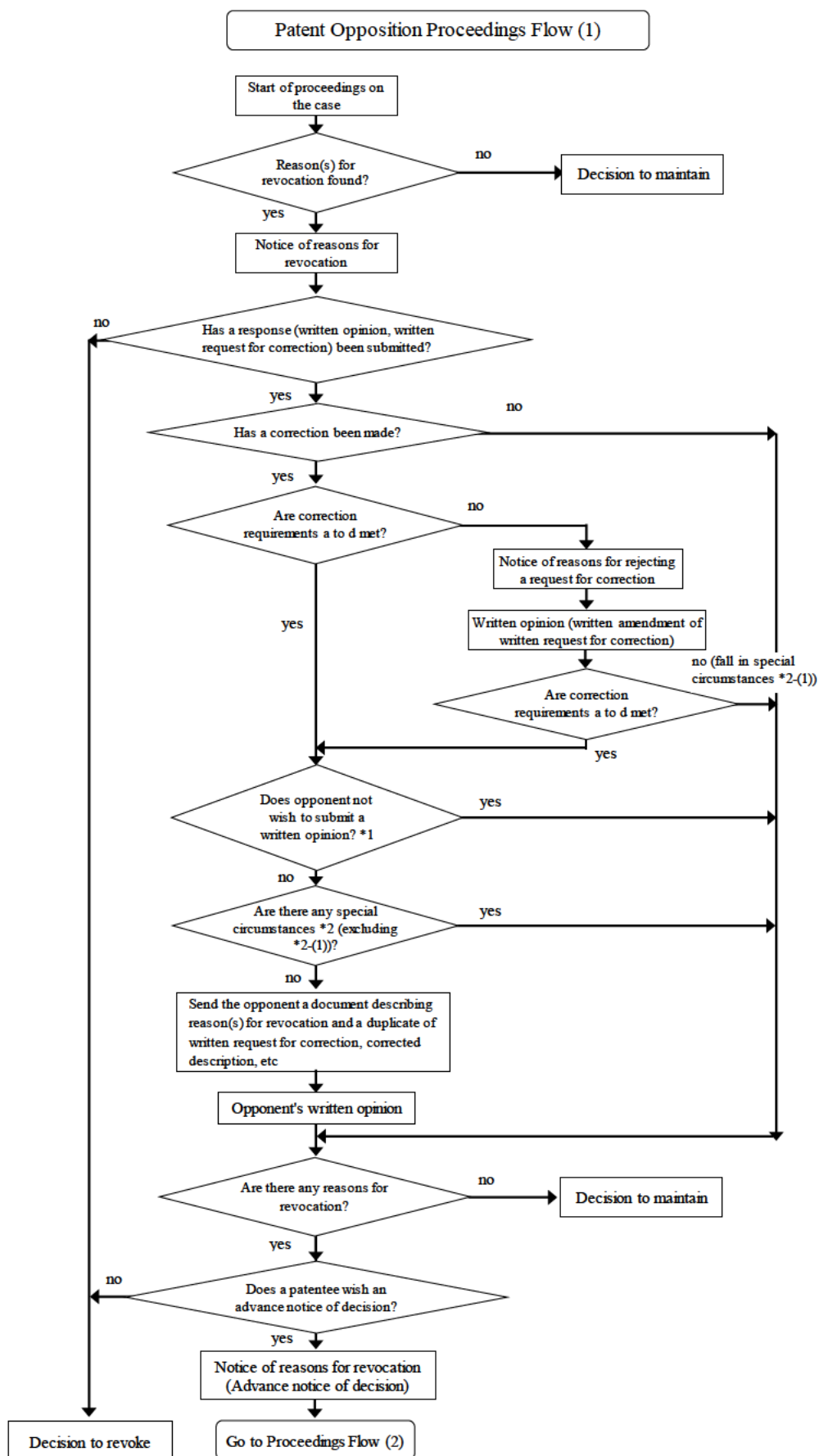
where it is found necessary in preparation for a written ruling, etc. (Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-11). (* For the definition of "magnetic disk," refer to the Regulations under the Patent Act Article 27-5 (2)).

Upon submission of the document, it is desirable that a Microsoft Word, Ichitaro or text format file should be either mailed by CD-R or DVD-R, or sent attached to an email.

7. Proceedings of the Case Where a Decision to Revoke Has Been Cancelled

Proceedings of the case where a decision to revoke has been cancelled by the court shall be resumed similar to the usual proceedings in the Patent Office. Notice of reasons for revocation (advance notice of decision) shall be sent where a decision for revocation of a patent is made based on different reasons from those adopted for a decision by the court to revoke the patent. Where it is not possible to constitute reasons for revocation, a decision to maintain shall be rendered.

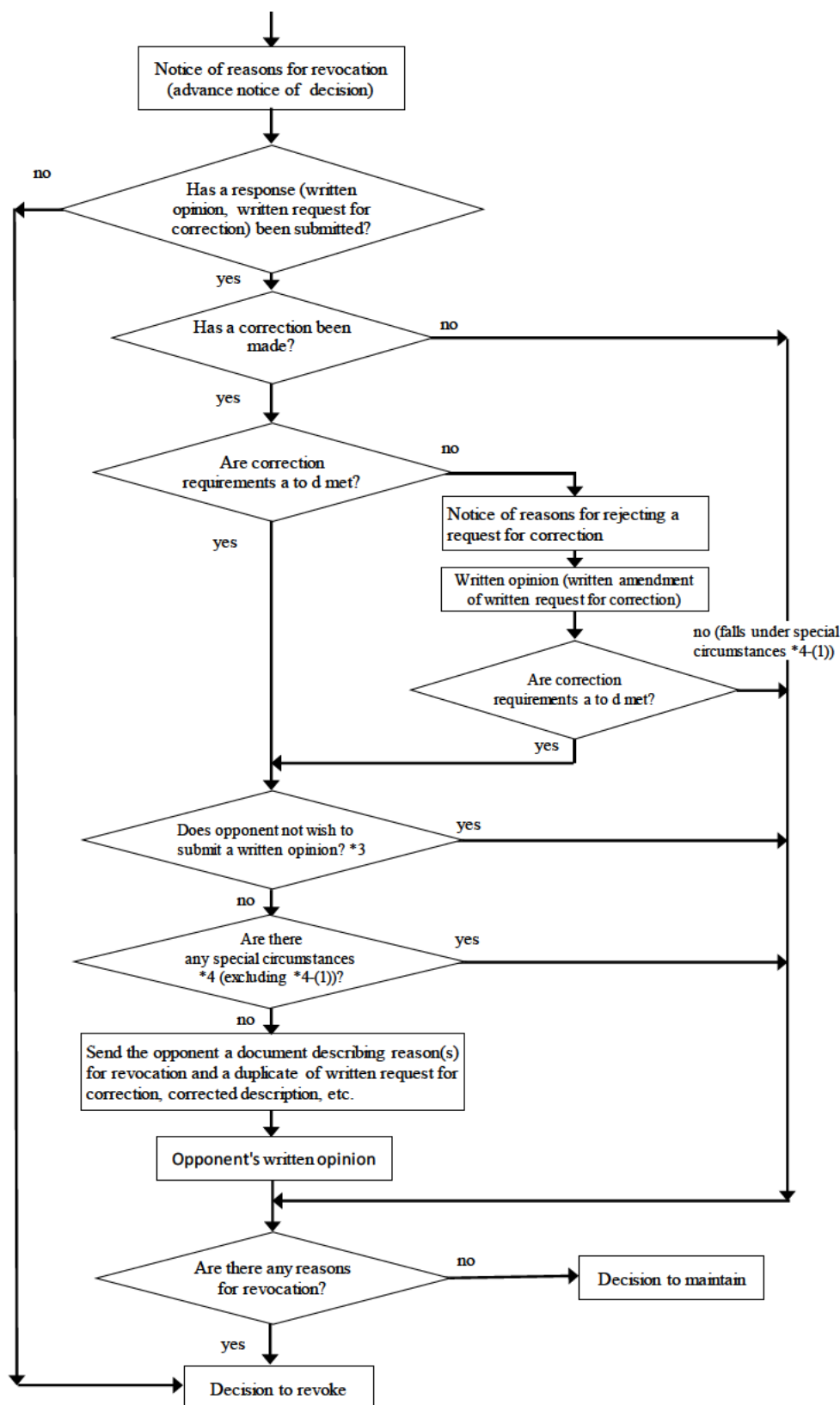
(Revised Sep. 2018)



*1 Has an opponent informed the JPO that the opponent does not wish to submit a written opinion?

*2. See 67-05.4-2. for the case of special circumstances.

Patent Opposition Proceedings Flow (2)



*3. Has an opponent informed the JPO that the opponent does not wish to submit a written opinion?

*4. See 67-05.5-4. for the case of special circumstances (after "notice of reasons for revocation (advance notice of decision)").

67-05.1 P

Notice of Reasons for Revocation

1. Purport and Types of “Notice of Reasons for Revocation” (Patent Act Article 120-5)

(1) Purport of Notice of Reasons for Revocation

Where the panel determines that a patent shall be revoked, a notice of reasons for revocation is issued to notify the patentee of the reasons therefor and give the patentee an opportunity to submit a written opinion and make a correction.

(2) Types of Notice of Reasons for Revocation

There are two types of “notice of reasons for revocation” for operational reasons: a usual “notice of reasons for revocation” and another “notice of reasons for revocation” in order to give a patentee an opportunity to submit a “written request for correction” before a decision to revoke is made (referred to as the "notice of reasons for revocation (advance notice of trial decision)" in this chapter 67) (→ 67-05.5).

2. Procedure for Notice of Reasons for Revocation

Where a patent examined by a panel has been determined to be revoked, a patentee shall be notified of reasons for revocation and given an opportunity to submit a written opinion and make a correction within a designated adequate time limit (normally 60 days, or 90 days for overseas residents → 25-01.4). A notice of reasons for revocation shall not be sent to a patent opponent (when a patentee later submits a request for correction, document which describes reasons for revocation notified to the patentee is sent to the opponent (Patent Act Article 120-5(5))) (67-05.4). It will be enough for a patentee to state an opinion about the reasons for revocation described in a notice of reasons for revocation. Therefore, a patentee shall not have to state his/her opinion on the reasons described in a written opposition, or a written opinion that is submitted by a patent opponent, and a written response to inquiry (→ 67-05-2. (3)).

Upon issuance of a notice of reasons for revocation, 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) shall be specified (Regulations under the Patent Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4).

3. Consideration of Notice of Reasons for Revocation

- (1) All of the reasons for opposition to a patent and evidence shall be taken into consideration in proceedings. In addition, reasons for opposition to a patent and evidence that have not been submitted by a patent opponent may be also examined ex officio when necessary (→67-05-3.(3)).
- (2) Where it is not possible to constitute any reasons for revocation, a decision to maintain a patent shall be rendered (referred to as the "decision to maintain" in this Chapter 67) (→ 67-06-3. (2)).
- (3) Where multiple reasons for revocation can be constituted, all of those shall become reasons for revocation in principle. Reasons for revocation under different applicable provisions shall be reasons for revocation with regard to respective applicable provisions.
- (4) However, where it is possible to constitute multiple reasons for revocation in the above (3), an appropriate reason may be selected therefrom according to a case and regarded as the reason for revocation in order to facilitate efficient and reasonable resolution of the case as a whole. In this case, reasons and evidence shall be taken into account in view of the possible restriction of the scope of claims so as not to issue a notice of reasons for revocation multiple times or make another decision to revoke based on another reason after the court decision to rescind the JPO's decision to revoke the patent becomes final and binding.
- (5) A panel shall describe its finding and determination in a notice of reasons for revocation. There is a possibility that the panel's citing the patent opponent's allegation concerning reasons for revocation described in a written opposition only by indicating the part of the document (page and line numbers) may be regarded as that the panel's finding and determination are not indicated. In order to avoid any misleading, the panel shall not cite the opponent's allegation. However, the panel may cite the opponent's allegation to explain

evidence, etc. described in the written opposition only when it is necessary for the panel to use the allegation as grounds for finding.

(Revised Sep. 2018)

67-05.2 P

Submission of Written Opinion or Written Request for Correction by Patentee

1. Response to a Notice of Reasons for Revocation by a Patentee

(1) Submission of Written Opinion

When reasons for revocation have been notified, a patentee may submit a written opinion within a designated time limit (normally 60 days, or 90 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (1)).

Where a patentee does not wish to receive a notice of reasons for revocation (advance notice of decision) (→ 67-05.5) for the purpose of obtaining an early decision, a patentee shall state a note to that effect in a written opinion (→ 67-05.5-2.).

(2) Request for Correction

A patentee may file a request for correction of the description, scope of claims, or drawings attached to the application (referred to as the "description, etc." in this Chapter 67-05.2) (Patent Act Article 120-5 (2)). A patentee has to obtain consent of an exclusive licensee, etc. if there is any such person (Patent Act Article 120-5 (9) → Patent Act Article 127).

A. Time Limit Allowed for Filing a Request for Correction

A time limit in which a request for correction may be filed is a time limit for submitting a written opinion as designated in a notice of reasons for revocation (normally 60 days, or 90 days for overseas residents, → 25-01.4) (Patent Act Article 120-5 (1)).

B. Object of the Request for Correction (→ 38-00)

Claims of which an opposition to grant of patent has not been filed may be also corrected (Patent Act Article 120-5 (9) → Patent Act Article 126 (7)).

(a) A group of claims and a request for correction (→ 38-01)

(b) Correction of the description or drawings (→ 38-02)

C. Correction Requirements (→ 38-03)

Claims of which an opposition to grant of patent has been filed shall be examined by allowing a correction thereof as long as the correction complies with other correction requirements, without applying a correction requirement that a corrected invention must be one which could have been patented independently at the time of filing of the patent application (requirements for independent patentability).

In contrast, a correction of claims of which an opposition to grant of patent has not been filed, or a correction of a part of claims becomes final and binding upon request for correction that was previously made shall be decided based on requirements for independent patentability in addition to other correction requirements (Patent Act Article 120-5 (9) → Patent Act Article 126 (7)) (→ 51-11-1. (3)).

D. Method of Filing a Request for Correction, etc.

(A) Written Request for Correction

A request for correction shall be filed according to a prescribed written request for correction (Regulations under the Patent act Article 45-3 (2), Form 61-4 in the Regulations under the Patent Act). The object and statement therefor in a written request for correction have to comply with the description requirements of the written request for correction (Patent Act Article 120-5 (9) → Patent Act Article 131 (3), Regulations under the Patent Act Article 46-2).

Provisions concerning the consent of the exclusive licensee, etc. (Patent Act Article 127), formality of request for trial (Patent Act Article 131 (1), (3) and (4)), and joint trial (Patent Act Article 132 (3), (4)) shall apply mutatis mutandis to a request for correction in the same manner as a trial for correction (Patent Act Article 120-5 (9)).

(B) Object of and Reasons for the Request (→ 38-04)

(C) Corrected Description, etc. (→ 38-05)

(D) Fees (→ 38-06)

(E) Submission of Duplicates of Written Opinion, and Written Request for Correction, etc.

To submit a written opinion, a written request for correction, a corrected description, etc., a patentee shall submit a required number of copies (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).

A required number of duplicates shall be described in a notice of reasons for revocation.

(3) Multiple Requests for Correction

When a request for correction has been filed more than once in specific case of an opposition to grant of patent, previous requests for correction shall be deemed to have been withdrawn (Patent Act Article 120-5 (7)).

Therefore, scope of claims, description and drawings at the time of registration of the establishment of the patent right (or, at the time of correction if there is any correction that has already become final and binding) shall become a basis for correction of scope of claims, description and drawings in the second or later request for correction. Corrected scope of claims, description and drawings that are attached to the last written request for correction shall not become a basis.

Furthermore, a final and binding correction shall not be deemed to have been withdrawn by a subsequent request for correction (→ 51-11-3.).

(4) Withdrawal of Request for Correction

A “request for correction” in an “opposition to grant of patent” may be withdrawn only within a time limit for submission of a written opinion as specified in a “notice of reasons for revocation” (including a “notice of reasons for revocation” issued as an “advance notice of decision”) (normally 60 days, or 90 days for overseas residents → 25-01.4) or within a time limit for submission of a written opinion as specified in a “notice of reasons for rejecting a request for correction” (normally 30 days, or 50 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (8), Patent Act Article 17-5 (1)). In this case, when a request for correction has been filed on a claim-by-claim basis or for a group of claims, all of the requests for correction have to be withdrawn (Patent Act Article 120-5 (8), Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-2-2). If a person wishes to cancel a part of a request for correction, a portion of correction items may be cancelled through amendment to a request for correction (Patent Act Article 17(1)) as well as

amendment to the description, scope of claims, or drawings concerning the correction (Patent Act Article 17-5(1)).

2. Effects of Correction

Where a decision to grant a correction in an opposition to grant of patent has become final and binding, the filing of the patent application, the publication of patent application, the examiner's decision or the appeal decision to grant the patent, or the registration of the establishment of the patent right shall be deemed to have been made based on the corrected description, etc. (Patent Act Article 120-5 (9) → Patent Act Article 128).

3. Preliminary Registration of Request for Correction

Since it is possible for a third party to predict the possibility of a request for correction of the description, etc. by preliminary registration of an opposition to grant of patent (Patent Registration Order Article 3 iii), preliminary registration of a request for correction shall not be made.

(Revised Sep. 2018)

67-05.3 P**Proceedings after Submission of Written Opinion or Written Request for Correction****1. Proceedings after Submission of a Written Opinion or a Written Request for Correction, etc.**

When a written opinion or a written request for correction has been submitted by a patentee in response to a notice of reasons for revocation, proceedings shall be conducted as follows according to the submitted document.

2. Proceedings in the Case Where Only a Written Opinion Has Been Submitted

When only a written opinion has been submitted in response to notified reasons for revocation without submission of a written request for correction, proceedings shall be conducted without giving an opportunity to submit a written opinion to an opponent (opportunity to submit a written opinion must be given to an opponent when a legitimate request for correction has been filed: Patent Act Article 120-5 (5)) in principle. However, when any question arises within the reasons for revocation determined by the panel upon patentee's allegation, inquiry may be made to the demandant (Patent Act Article 120-8 (1) → Patent Act Article 134(4)).

Based on the above, the panel shall handle the case as follows.

(1) When it is determined that a patent should be revoked, an opportunity to make a correction shall be given to a patentee in principle by a notice of reasons for revocation (advance notice of decision) (→ 67-05.5).

(2) Where it is determined that it is not possible to revoke a patent, a decision to maintain shall be rendered.

3. Proceedings in the Case Where neither a Written Opinion nor a Written Request for Correction Has Been Submitted

Where neither a written opinion nor a written request for correction has been submitted, even if a notice of reasons for revocation (advance notice of trial decision) is further issued, submission of a written request for correction shall not be expected even if a notice of reasons for revocation (advance notice of trial decision) is further issued (→ 67-05.5). Therefore, a decision to revoke a patent (referred to as the "decision to revoke" in this Chapter 67) may be issued without issuing a notice of reasons for revocation (advance notice of trial decision).

4. Proceedings in the Case Where a Written Request for Correction Has Been Submitted

(1) Violation of Formality Requirements and Amendment of Written Request for Correction

A. Handling of the Case of Violation of Formality Requirements of Written Request for Correction which is Amendable

When a written request for correction does not comply with formality requirements due to insufficiency of fees, deficiencies of power of attorney, or deficiencies of written consent of exclusive licensee if there is any exclusive licensee (Patent Act Article 120-5(9) → Patent Act Article 127) while it is amendable, if it has not been amended voluntarily, the chief administrative judge shall order a patentee to amend the written request by designating an adequate time limit (normally 10 to 30 days depending on the contents of deficiencies → 25-01.5) (Patent Act Article 120-5 (9) → Patent Act Article 133 (1), Patent Act Article 120-8 (1) → Patent Act Article 133 (2)).

When the purport of and reasons for filing a written request for correction do not comply with description requirements (Patent Act Article 120-5 (9) → Patent Act Article 131 (3), Regulations under the Patent Act Article 46-3) (e.g., cases where a written correction has not been made on a claim-by-claim basis even though an opposition to grant of patent has been filed on a claim-by-claim basis, where a group of claims has not been specified correctly (including a case where there is a deficiency in a request that a claim be

a different unit of correction), where all the claims relating to a correction of the description or drawings are not the subject to the request, etc.), the chief administrative judge shall order a patentee to amend the written request by designating an adequate time limit (normally 30 days → 25-01.5).

When a patentee, who has been ordered to make an amendment to an item, fails to make such necessary amendment, the chief administrative judge shall dismiss the written request for correction by a decision (Patent Act Article 120-5 (9) → Patent Act Article 133 (3)).

A patentee may file an action before the Tokyo High Court (Intellectual Property High Court) against a decision of dismissal of written request for correction (Patent Act Article 178 (1)).

B. Handling of an Unlawful Request for Correction Which Is Not Amendable

Where a matter which violates formality requirements is not amendable (such as a request filed after the expiry of a time period), the chief administrative judge shall notify a patentee of reasons for dismissal, give the patentee an opportunity to submit a written explanation (Patent Act Article 120-8 (1) → Patent Act Article 133-2 (2)), and then dismiss the request for correction by a decision (Patent Act Article 120-8 (1) → Patent Act Article 133-2(1)).

Appeal may be entered pursuant to the “Administrative Appeal Act” or an action may be made at a district court pursuant to the “Administrative Case Litigation Act” against a decision to dismiss a written request for correction (Patent Act Article 120-8 → Patent Act Article 133-2(1)).

To make a decision on an “opposition to grant of patent” concerning a case in which a decision of dismissal of a “request for correction” has been rendered, a panel shall state a note in its reasoning to the effect that the request for correction has been dismissed.

C. Handling of an Amendment of a Written Request for Correction in Response to the Order

An amendment of a written request for correction shall not change the gist thereof except the reasons for making a request. However, an amendment of an item ordered to amend shall be granted only when it complies with the said order to amend, even if the

amendment changes the gist of the “written request for correction” (Patent Act Article 120-5(9) → Patent Act Article 131-2 (1) iii).

(2) Proceedings of Request for Correction

A. Determination of Whether or Not the Correction is Appropriate

(A) Consideration of Correction Concerning the Scope of Claims

To determine whether a request for correction fulfills with correction requirements, suitability of each correction item with correction requirements shall be determined first.

[Correction Requirements]

- a. Patent Act Article 120-5 (2): Purpose of the correction (any one of restriction of the scope of claims, correction of errors or incorrect translations, clarification of ambiguous description, or elimination of citation of statement of a claim that cites statement of another claim, i.e. elimination of citation)
- b. Patent Act Article 120-5 (9) → Patent Act Article 126 (5): Correction within the scope of the patent description, etc. (or the original description, etc. in the case of correction of errors or incorrect translations) (prohibition of addition of new matter beyond the original text,)
- c. Patent Act Article 120-5 (9) → Patent Act Article 126 (6): Prohibition of enlargement or alteration of the scope of claims
- d. Patent Act Article 120-5 (9) → Patent Act Article 126 (7): Requirements for independent patentability (concerning claims of which no opposition to grant of patent has been filed, and restricted to those which purpose is restriction of the scope of claims, or correction of errors or incorrect translations)

A final determination of suitability of correction shall be rendered according to the unit of the request for correction. For example, suitability of correction shall be determined on a claim-by-claim basis in the case of a request filed on a claim-by-claim basis, based on each group of claims in the case of a request filed for each group of claims, or based on an entire patent in the case of a request filed for the entire patent.

(B) Consideration of Correction Concerning the Description or Drawings

Suitability of correction items in the description or drawings relating to multiple claims shall be determined for each request concerning claims containing the said correction items (or a group of claims).

B. Handling of the Case Where a Request for Correction Does Not Comply with Correction Requirements

When a request for correction does not comply with correction requirements (any of the items in the proviso to Patent Act Article 120-5 (2), Patent Act Article 120-5 (9) → Patent Act Article 126 (5) (6) (7)), a notice of reasons for rejecting a request for correction shall be issued (Patent Act Article 120-5 (6)).

It should be noted in particular that a notice of reasons for rejecting a request for correction shall be issued even if a request for correction of claims of which no opposition to grant of patent has been filed does not comply with requirements for independent patentability (Patent Act Article 120-5 (9) → Patent Act Article 126 (7)), (→ 67-05.2-1. (2) C).

(3) Patentee's Response to Notice of Reasons for Rejecting a Request for Correction

A. In response to a notice of reasons for rejecting a request for correction, a written opinion may be submitted or the corrected description, scope of claims, or drawings (referred to as the "corrected description, etc." in this Chapter 67-05.3) attached to a "written request for correction" may be amended (Patent Act Article 120-5 (6), Article 17-5 (1)). The consent of an exclusive licensee, etc., if any, is required for amendment (Patent Act Article 120-5 (9) → Patent Act Article 127).

B. In response to a notice of reasons for rejecting a request for correction, an amendment such as deletion of correction items, an amendment of minor defects, etc. that do not change the gist of a "written request for correction" may be made.

As is the case with the amendment of a written request for trial for correction, addition of a correction item or change a correction item shall be regarded as change of the gist of a "written request for correction."

However, (i) an amendment to change from “a correction item in a certain claim” to “a correction item to delete the said claim,” and an amendment of a correction item concerning the corrected description, etc. for consistency thereto, and (ii) an amendment to add “a correction item to delete a claim,” and an amendment of a correction item concerning the corrected description, etc. for consistency thereto shall not be regarded as change of the gist of the purport of a request in a “written request for correction” (→ 54-05.1-2.).

C. If it is determined that a request for correction still does not comply with correction requirements after consideration of a written opinion or a written amendment in response to a notice of reasons for rejecting a request for correction, proceedings shall be conducted without allowing the said correction. In contrast, if it is determined that a request for correction complies with correction requirements, proceedings shall be conducted while allowing the said correction.

(4) Time Limit During Which a “Written Request for Correction” or “Corrected Description,” etc. May Be Amended

A “written request for correction” may be amended only when the case is pending before the Patent Office (Patent Act Article 17 (1)). However, the corrected description, scope of claims, or drawings attached to a “written request for correction” may be amended only within the following time limit (Patent Act Article 17-5 (1)).

A. A time limit for submission of written opinion in response to a “notice of reasons for revocation” (including a “notice of reasons for revocation” issued as an advance notice of trial decision) (normally 60 days, or 90 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (1))

B. Period of submission of written opinion in response to a “notice of reasons for rejecting a request for correction” (normally 30 days, or 50 days for overseas residents, → 25-01.4) (Patent Act Article 120-5 (6))

Since the corrected description, etc. is integral with the purport of filing a “written request for correction,” both must be amended at the same time. Therefore, the time limit during which a “written request for correction” may be amended is substantially restricted to a designated time limit for a “notice of reasons for rejecting a request for correction,” which is the same as the time limit during which the corrected description, etc. may be amended.

(Revised Sep. 2018)

67-05.4 P**Submission of Written Opinion by Opponent****1. Submission of Written Opinion by Opponent**

(1) When a compliant request for correction was filed against a notice of reasons for revocation, except for a case where the opponent does not wish to (see note below) or a case where a special circumstance in which it is found to be unnecessary to grant an opportunity (proviso to Patent Act Article 120-5 (5)), the duplicate of a written opinion, a request for correction, and a corrected description, scope of claims or drawings (referred to as the "corrected description, etc." in this chapter 67-05.4) attached thereto along with a document describing the reasons for revocation of the patent (document describing the same details as reasons for revocation notified to the patentee) shall be sent to the opponent, and a reasonable time limit (normally 30 days, or 50 days for overseas residents, → 25-01.4) shall be designated to grant an opportunity for submission of a written opinion (Patent Act Article 120-5 (5)).

(Note) The case where an opponent does not wish to submit a written opinion denotes to the case where a request to the effect that an opponent does not wish to submit a written opinion is stated in a written opposition (refer to Form 61-2, Note 4 in the Regulations under the Patent Act Article 45-2).

(2) A panel shall conduct proceedings by considering contents of a written opinion submitted by an opponent. However, when contents of an opinion substantially present new reasons and evidence, the said substantially new reasons and evidence shall not be adopted, considering the impact on the public interest and the purport of restricting an opposition period to be within six months from the publication date of the gazette containing the patent, except for the cases where the reasons arise pertaining to contents of a request for correction including an opinion on items added by the correction or where it is at a glance obvious that the reasons constitute appropriate reasons for revocation.

2. Special Circumstances

Cases where special circumstances exist mean, from the viewpoint of a timely and efficient proceedings, those where it is obvious that hearing opinions from the opponent is not necessary, including those where contents of a request for correction would not affect the substantial decision, etc. In such circumstances, an opponent shall not be given an opportunity to submit a written opinion.

Cases falling under the case where an opponent shall not be given an opportunity to submit a written opinion are as follows.

- (1) The case where a request for correction does not comply with correction requirements.

The case where a request for correction is unlawful and has been withdrawn (Patent Act Article 120-5 (9) → Patent Act Article 133 (3), Patent Act Article 120-8 → Patent Act Article 133-2 (2)) or a correction has not been granted (→ 3. (1)) does not fall under "where a request for correction has been filed."

- (2) The case where a correction is minor one such as correction of errors in writing.
- (3) The case where a correction is made by only deleting a part of claims.
- (4) The case where a correction is made only for a claim to which an opposition to grant of patent has not been filed.

For special circumstances after a notice of reasons for revocation (advance notice of decision) is issued, please refer to 67-05.5-4. (1).

3. Procedure for Submission of Written Opinions by Opponents

- (1) The chief administrative judge shall send necessary documents to an opponent according to the above 1. (1). When there are formal deficiencies in a written request for correction, the chief administrative judge shall also send the opponent duplicates of a written amendment that has been voluntarily submitted by a patentee or a written amendment that the chief administrative judge has order a patentee to amend deficiencies within and submit (→ 21-02).

In addition, when a written request for correction does not comply with correction requirements, a "notice of reasons for rejecting a request for correction" shall be issued and then necessary documents shall be sent after a request for correction has been amended to

comply with correction requirements. In this case, documents to be sent shall include, in addition to the above document, a document describing reasons for rejecting a request for correction and a document submitted by a patentee in response to a “notice of reasons for rejecting a request for correction” (duplicates of a written opinion, a written amendment of a written request for correction, the corrected description, etc. attached thereto).

In the case where a written request for correction still does not comply with correction requirements even after an amendment thereof is made, it shall be deemed to be a special circumstance (→ 2.(1)) in which an opponent shall not be asked to provide his/her opinion and no documents shall be sent.

- (2) An opponent shall prepare and submit a written opinion within a designated time limit (normally 30 days, or 50 days for overseas residents → 25-01.4) (Form 61-5 in the Regulations under the Patent Act Article 45-3 (3)).

Items concerning a request for correction, which particularly require clear statement, shall be described specifically in a detailed opinion column of a written opinion (→ 1. (2)). Where a written opinion is submitted, a required number of duplicates (the number of patentees + the number of intervenors +1 for proceedings) shall be submitted (Regulations under the Patent Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4). A required number of duplicates is described in a written notice to notify an opponent of an opportunity to submit a written opinion.

(Revised Sep. 2018)

67-05.5 P

Notice of Reasons for Revocation (Advance Notice of Decision)

1. The Case Where a “Notice of reasons for Revocation” (Advance Notice of Decision) Is Required

(1) With the revision of the Patent Act in 2011, an opportunity for correction shall be given by an "advance notice of trial decision" in the trial for invalidation and a request for a trial for correction shall be prohibited in pending revocation action against an trial decision in order to prevent a "play catch phenomenon" (→ 51-17-2.) between the Patent Office and the court. In an opposition to grant of patent, a request for a trial for correction shall be prohibited in pending revocation action against decision of revocation (Patent Act Article 126 (2)) and therefore, in the case where a decision of revocation has been rendered after a notice of reasons for revocation is sent, a notice of reasons for revocation (advance notice of decision) shall be sent to a patentee to give an opportunity for correction again.

By doing so, an opportunity for correction shall be given twice, the first by the first notice of reasons for revocation and the second by the notice of reasons for revocation (advance notice of decision). This will ensure to give an opportunity for correction twice based on the determination by the panel.

Furthermore, since the purport of the trial for invalidation system is to resolve disputes related to validity of the patent between the parties, it is necessary for a panel to render a trial decision after both parties make allegations and show proof thoroughly. Meanwhile, since the purport of the opposition to grant of patent system is to realize stable establishment of patent rights at an early stage, a panel is expected to demonstrate a final determination at an early stage while considering procedures that should be taken by the parties.

Based on the above, the second notice of reasons for revocation shall be the notice of reasons for revocation (advance notice of decision) in principle.

However, in a case where the second notice of reasons for revocation is intended solely to give an opportunity for correction (for instance, in a case where a panel has a belief that

the patent may be maintained by dissolving minor deficiencies in the description, etc.), the second notice of reasons for revocation shall not be the notice of reasons for revocation (advance notice of decision), and rather an ordinary notice of reasons for revocation.

(2) Notice of reasons for revocation (advance notice of decision) shall clearly indicate that it is an "advance notice of decision" at the beginning. A patentee may submit a written opinion as well as file a request for correction within the designated time limit (normally 60 days, or 90 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (1) (2)).

(3) When it has been determined to maintain a patent, a decision to maintain shall be rendered.

2. The Case Where a Notice of Reasons for Revocation (Advance Notice of Decision) is Not Required

A decision shall be rendered without a notice of reasons for revocation (advance notice of decision) in the following cases.

(1) The case where there has been no response to a notice of reasons for revocation (no submission of a written opinion or no request for correction)

In the case where there has been no response to a notice of reasons for revocation, it is not necessary to further give an opportunity for correction and therefore, an advance notice of decision shall not be issued (→ 67-05.3-3.).

(2) The case where a patentee requests that he/she does not wish to receive an advance notice of decision

When the patentee does not wish to receive an advance notice of decision for the purpose of obtaining a decision on an opposition to grant of patent at an early stage, an advance notice of decision shall not be issued. A patentee shall state a request in a written opinion to a notice of reasons for revocation to the effect that he/she does not wish to receive an advance notice of decision.

3. The Content of the Description in the Notice of Reasons for Revocation (Advance Notice of Decision)

In a conclusion of a notice of reasons for revocation (advance notice of decision), a conclusion (to maintain, to revoke, to dismiss a written request for opposition, etc.) concerning all of the claims requested for an opposition to grant of patent shall be described. In reasons of a notice of reasons for revocation (advance notice of decision), reasons of a determination to revoke made by the panel, that should be the same as the content of the decision, shall be described.

Where a request for correction is filed to correct description, scope of claims, or drawings attached to an application and the said correction is granted by a panel, the grant of a correction shall be indicated in a conclusion of a notice of reasons for revocation (advance notice of decision) while reasons to grant a correction shall be described within the reasons of a notice of reasons for revocation (advance notice of decision).

Where the said request for correction is not granted by a panel, the panel's determination not granting the said request as well as reasons not to grant a correction shall be described within the reasons of a notice of reasons for revocation (advance notice of decision), rather than in a conclusion of a notice of reasons for revocation (advance notice of decision).

4. Proceedings after the Notice of Reasons for Revocation (Advance Notice of Decision)

Proceedings after a notice of reasons for revocation (advance notice of decision) shall be carried out as follows depending on whether a request for correction has been filed or not.

(1) The Case Where a Request for Correction Has Been Filed

Where there is no request from an opponent to the effect that he/she does not wish to submit a written opinion and it does not fall under a special circumstance with no need to give an opportunity to submit a written answer to an opponent, an opportunity to submit a written opinion shall be given to an opponent (→ refer to 67-05.4-1. for detailed procedures). A notice of reasons for revocation (advance notice of decision), etc. shall be sent to the opponent (Patent Act Article 120-5(5)).

A case where an opportunity to submit a written opinion shall not be given to an opponent after a notice of reasons for revocation (advance notice of trial decision) is sent shall include (5) and (6), in addition to the following (1) to (4) in an ordinary notice of reasons for revocation (→ 67-05.4-2.).

- (1) The case where a request for correction does not comply with correction requirements.
- (2) The case where a correction is minor one such as correction of errors in writing.
- (3) The case where a correction is made by only deleting claims.
- (4) The case where a correction is made only for a claim to which an opposition to grant of patent has not been filed.
- (5) The case where a panel has determined to revoke a patent despite consideration of the content of a correction.
- (6) The case where an opportunity to submit a written opinion has been already given to an opponent; the scope of claims is reduced to a considerable extent by a request for correction; and a panel has determined to reach a conclusion that a patent shall be maintained even if proceedings are further carried out based on all the evidence and opinions submitted for the case.

(2) The Case Where There Is No Request for Correction

In the case where it is possible to determine revocation of a patent based on reasons described in a notice of reasons for revocation (advance notice of decision) after proceedings, without giving an opportunity to submit a written opinion to an opponent, and consideration of contents of a written opinion submitted by a patentee if any, a decision shall be rendered based on contents described in a notice of reasons for revocation (advance notice of decision) (Patent Act Article 114 (2)).

Basically, contents described in a notice of reasons for revocation (advance notice of decision) may be described in the decision while correction of errors in writing or a written opinion submitted by a patentee after the notice of reasons for revocation (advance notice of decision) shall be referred as needed.

Still, in the case where no request for correction has been filed, it is possible for a panel to make an inquiry to the opponent if there is a question arising from the reasons based on which the panel has determined to revoke a patent upon the patentee's allegation.

(Revised Sep. 2018)

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)

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)

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 opposition 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.

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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).

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67-10 P**Relationship between Opposition to Grant of Patent and Trial for Correction****1. Handling of a Trial for Correction in the Case Where an Opposition to Grant of Patent is Pending**

A request for a trial for correction may not be filed between the time a relevant opposition to grant of patent has become pending before the Patent Office and the time a decision thereof (decision on all the claims when an opposition has been filed on a claim-by-claim basis) has become final and binding (Patent Act Article 126 (2)). When an action seeking revocation of a decision of revocation has been filed before the court, a request for a trial for correction may not be filed until said decision of revocation becomes final and binding.

2. Time Limit to Request a Trial for Correction (→ 54-03)

- (1) A trial for correction requested between the time a relevant opposition to grant of patent has been filed and the time a duplicate of a written opposition has been sent (received) shall be handled as a lawful trial for correction.
- (2) A trial for correction requested after a certified copy of a decision to maintain has been served shall be handled as a lawful trial for correction.
- (3) A trial for correction that has been requested for claims that are not revoked after the time limit for action against opposition decision (30 days from the day of service of a certified copy of a decision, or 90 days shall be added for overseas residents → 25-01.5) (→ 67-06-7.(3)) (Patent Act Article 178 (3) (5)) has expired and a decision to revoke has become final and binding or after the said decision of an filed action (decision on all the claims when an opposition has been filed on a claim-by-claim basis) has become final and binding shall be handled as a lawful trial for correction.

3. Proceedings When an Opposition to Grant of Patent and a Trial for Correction Are Pending Concurrently on a Patent

(1) An opposition to grant of patent and a trial for correction are cases under different categories, 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, or inconsistent results therebetween.

B. Where a correction has become final and binding in one of the two cases, the subject of proceedings is changed in the other case and therefore repeated proceedings will be required. Consequently, procedures that have been presented by the Patent Office and the parties will be wasted.

C. Where a patent is to be revoked in an opposition to grant of patent case, it will not be necessary to conduct proceedings in a trial for correction 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 correction are pending concurrently, an opposition to grant of patent shall be prioritized in principle because a request for correction may be filed again in proceedings of the opposition in response to a notice of reasons for revocation in the opposition even if a request for a trial for correction has been filed already.

Where it is evident that a correction submitted in a trial for correction does not comply with the correction requirements, a supplementary note stating that the correction submitted in the trial for correction does not comply with the correction requirements may be added in the reason of a notice of reasons for revocation in proceedings of an opposition to grant of patent.

However, where proceedings of a trial for correction have already progressed to a considerable extent and it is possible to render a trial decision at an early stage, proceedings of the trial for correction shall be prioritized as an exceptional case.

4. Suspension of Procedures

When proceedings of either one of the opposition to grant of patent and the trial for correction are prioritized, proceedings of the other one shall be suspended (Patent Act Article 168 (1)) and a notice of suspension of procedure shall be notified to a patentee, an opponent, requester for trial for correction and an intervenor (→ 51-09-1.).

5. Points to Note When Proceedings Are Prioritized

(1) The Case Where Proceedings of an Opposition to Grant of Patent Has Been Prioritized

Where all the claims have been revoked by an opposition to grant of patent of which proceedings were prioritized and have become final and binding, a trial for correction, which is the other case, has become an unlawful request and therefore the request shall be dismissed by a trial decision (Patent Act Article 126 (8), Patent Act Article 135) (→ 54-04-3.).

Furthermore, where a request for correction has been approved and a decision to maintain has become final and binding in an opposition to grant of patent of which proceedings were prioritized, it should be noted that contents of a request for a trial for correction based on an patent before correction may not be consistent with a patent after a final and binding correction and may not comply with the correction requirements.

(2) The Case Where Proceedings of a Trial for Correction Has Been Prioritized

Where a correction has been granted in a trial for correction of which proceedings were prioritized, an opportunity to submit a written opinion shall be given to an opponent according to the case where a request for correction has been filed in proceedings of an opposition to grant of patent after cancellation of suspension thereof (→ 67-09-4. (2)). Specifically, contents of the said correction (a final and binding written trial decision of a trial for correction) shall be notified to an opponent and an opportunity to submit a written opinion on a patent after

correction shall be given to the opponent by designating an adequate time limit (normally 30 days, or 50 days for overseas residents → 25-01.4).

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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.

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