

Guide to Hantei (Advisory Opinion) System

- For those who have problems with
infringement or non-infringement of rights -

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Trial and Appeal Department, Japan Patent Office

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1. Hantei (Advisory Opinion) System

(1) What is Hantei (advisory opinion) system?

The Japan Patent Office (JPO), upon request, provides an official opinion from a fair, neutral perspective on the followings:

- (i) technical scope of the patented invention or registered utility mode
- (ii) scope of registered design and designs similar thereto
- (iii) scope of the effect of trademark right

Hantei may be used in the following situations

<From the perspective of patentees>

I would like to know whether other people's products, etc. are included within the technical scope of my patented invention (which may infringe my rights).

<From the perspective of those who work the patented invention>

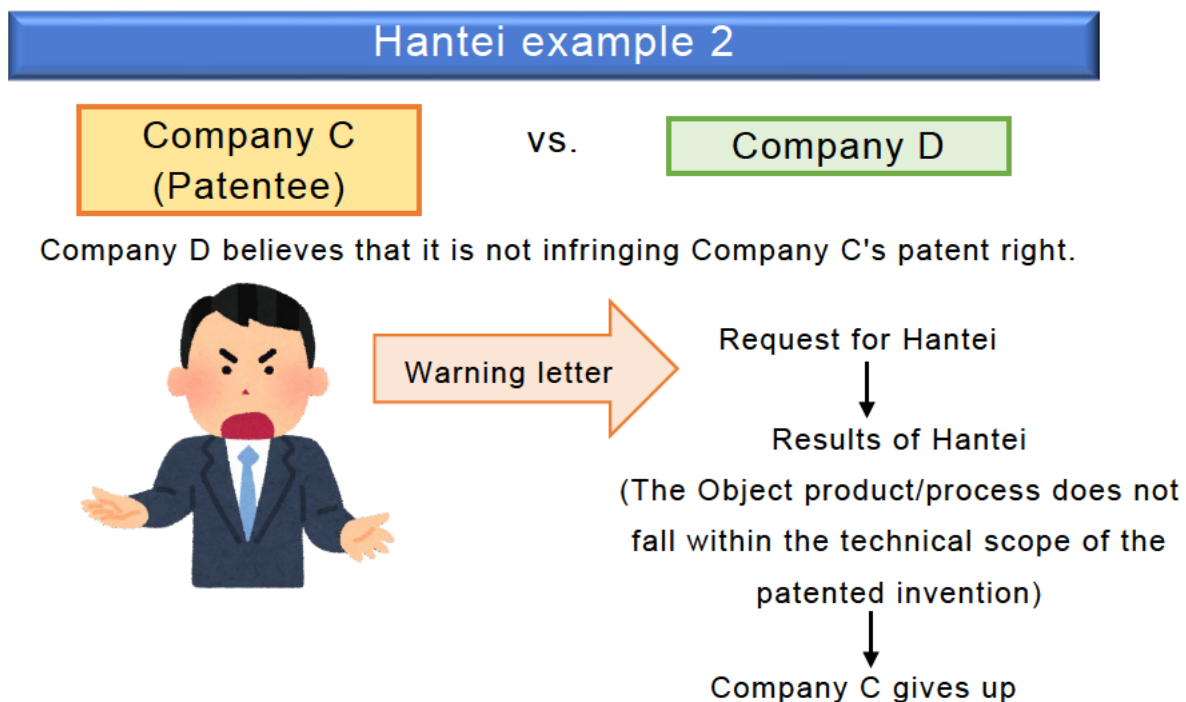
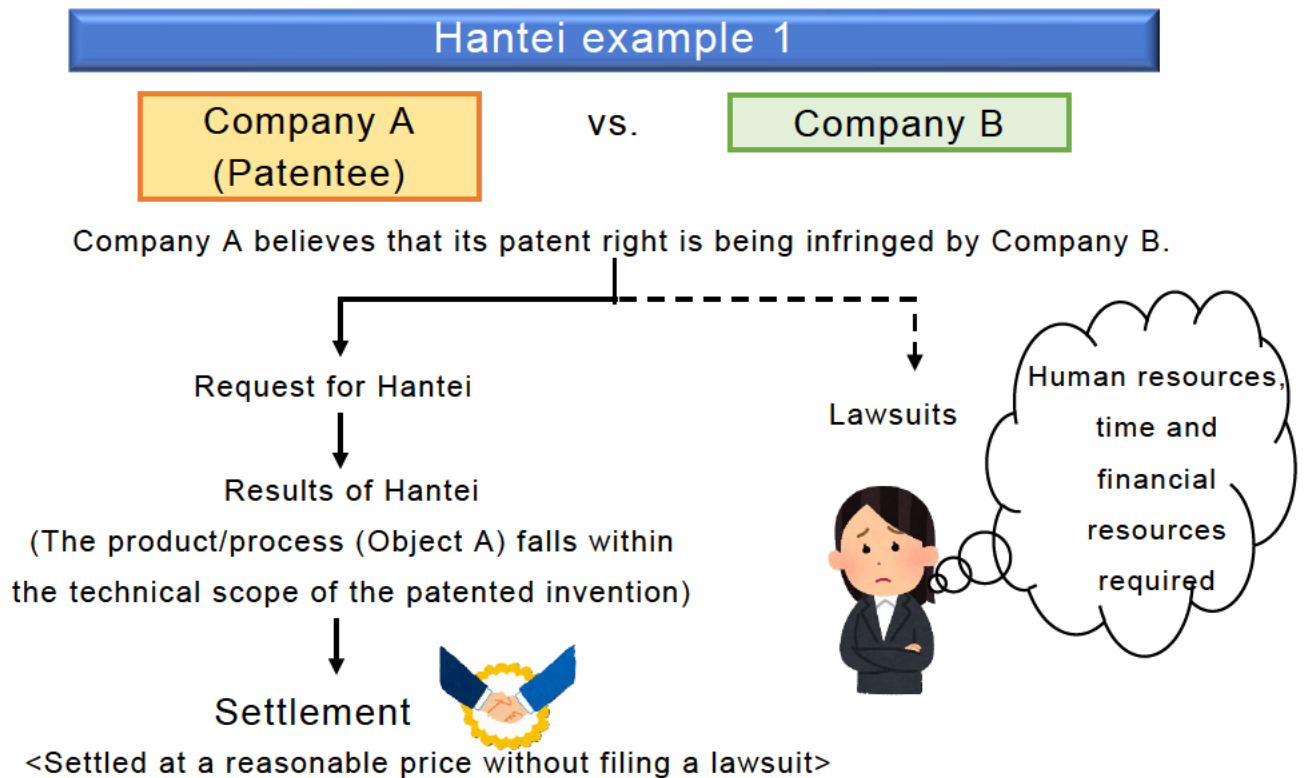
We would like to know whether the products, etc. that we are planning or working are included within the technical scope of others' patented inventions (which may infringe others' rights).

Features of Hantei system

- ✧ Fair and neutral determination.
- ✧ Prompt conclusion (as early as 3 months).
- ✧ Low cost (40,000 yen per request to the JPO for Hantei).
- ✧ Simple procedure (same as a trial/appeal procedure).
- ✧ Type of administrative service, not legally binding.

(2) What you can do with Hantei (advisory opinion)

Hantei system is established in all four industrial property right acts (Patent Act, Utility Model Act, Design Act, and Trademark Act). This section will focus on Hantei related to patents.



Use of Hantei examples

- ✧ You can request the JPO to prepare a written Hantei as a basis for determining whether another party is infringing your patent right or whether you are not infringing the patent right of another party. The written Hantei can then be used as the basis for a warning letter to stop the other party from working the patented invention. It can also be used as a basis for a counterargument when you are warned to stop your own action.
- ✧ By signing a contract between the parties to abide by the results of Hantei , the parties can resolve the dispute quickly and inexpensively according to the results of Hantei (this may be especially effective for small disputes).
- ✧ Hantei can also be used in actual litigation, such as patent infringement lawsuits, as follows:
 - (a) Means of proof for the infringement theory to determine whether the accused product falls within its technical scope, as a precondition for infringement (whether Object A is included in the scope of the right).
 - (b) Means of proof on Object A as an equivalent.
 - (c) Means of proof in an action for declaratory judgment of absence of a right to demand an injunction or a right to claim compensation for damages.
- ✧ When its own goods are indicated with patent numbers in order to prevent counterfeit goods, the results of Hantei can be utilized in order to identify that one's own goods actually fall within the technical scope of the patent right that has been obtained.
- ✧ Hantei can be used in license negotiations, license agreements, and rights assignment agreement negotiations.
- ✧ Hantei can be used as attachments to petitions to customs or a letter of information (request for border enforcement of imported infringing goods).

- ✧ Hantei can be used as a basis for filing a complaint with the police.
- ✧ Early resolution is possible by using the information as a reference when requesting for arbitration with an arbitration institution such as the Japan Intellectual Property Arbitration Center.
- ✧ Hantei can also be used as a means of proof for claiming abuse of rights, violation of Antitrust Law, etc.
- ✧ Additionally, Hantei can also be used as a basis for alleging your opinion to the court when a provisional disposition is applied for.

(3) Official opinion based on sophisticated expertise

Proceedings by an administrative judge panel with sophisticated expertise

Proceedings for Hantei are conducted by a panel composed of three administrative judges with sophisticated expertise.

The results of the proceedings will be stated in a written Hantei as the official opinion of the JPO.

Ex officio principle

In the Hantei system, determinations are made based on ex officio, which means that determinations are not based solely on allegations of the parties, but also on the expertise of the administrative judges. Therefore, it is expected to yield results closer to the truth even in cases where the allegations of the parties are insufficient or inappropriate, or where there are no objections from the opposing party.

(4) Who can request Hantei (advisory opinion) and when?

<Who>

The person requesting Hantei does not need to be a person with a legal interest in the matter for which the determination is sought.¹

However, in view of the purpose of the system, the person should briefly describe the necessity of requesting Hantei. In the column of reasons for requesting Hantei, this could include background information such as "there is a possibility that another company is infringing our rights."²

<When>

A request for Hantei can be made after the registration of the establishment of the patent, utility model, design, or trademark right.

In addition, because there may be cases where the fact of infringement during the term of the right is disputed after the right has been extinguished, a request for Hantei may be filed even after the right has been extinguished (see the "Manual for Trial and Appeal Proceedings 58-01, 4.").

¹ However, in the case of requesting Hantei for performing essentiality check on standard essential patents (SEPs), a demandant and a demandee must be the parties with the conflict of views between them about standard essentiality of the patented invention to facilitate licensing negotiations, etc. (see 1. (8)).

² The "Manual for Trial and Appeal Proceedings 58-01, 2. (1)" states, "Because results of Hantei are not legally binding on the parties to the case, no legal interest is required for requesting Hantei. On the other hand, it is necessary to have a benefit of requesting Hantei pursuant to the purport of the Hantei system in which the JPO expresses an official opinion on the technical scope of the patented invention upon request, thereby contributing to the protection and utilization of inventions applied for the purpose of the law, as well as to the prevention of disputes or early resolution of disputes. Therefore, it is desirable to clarify a benefit of a request when requesting Hantei pursuant to the purpose of the system by stating the necessity of requesting Hantei in the column of reasons therefor in the Hantei Request."

(5) Comparison between patented inventions, etc. and products, etc.

In Hantei, by comparing the patented invention, etc. with the products, etc. (object A), the JPO determines whether the products, etc. fall within the technical scope, etc. of the patented invention.

If a certain product is determined to fall within the technical scope of the patented invention, the product is likely to infringe the patent.³

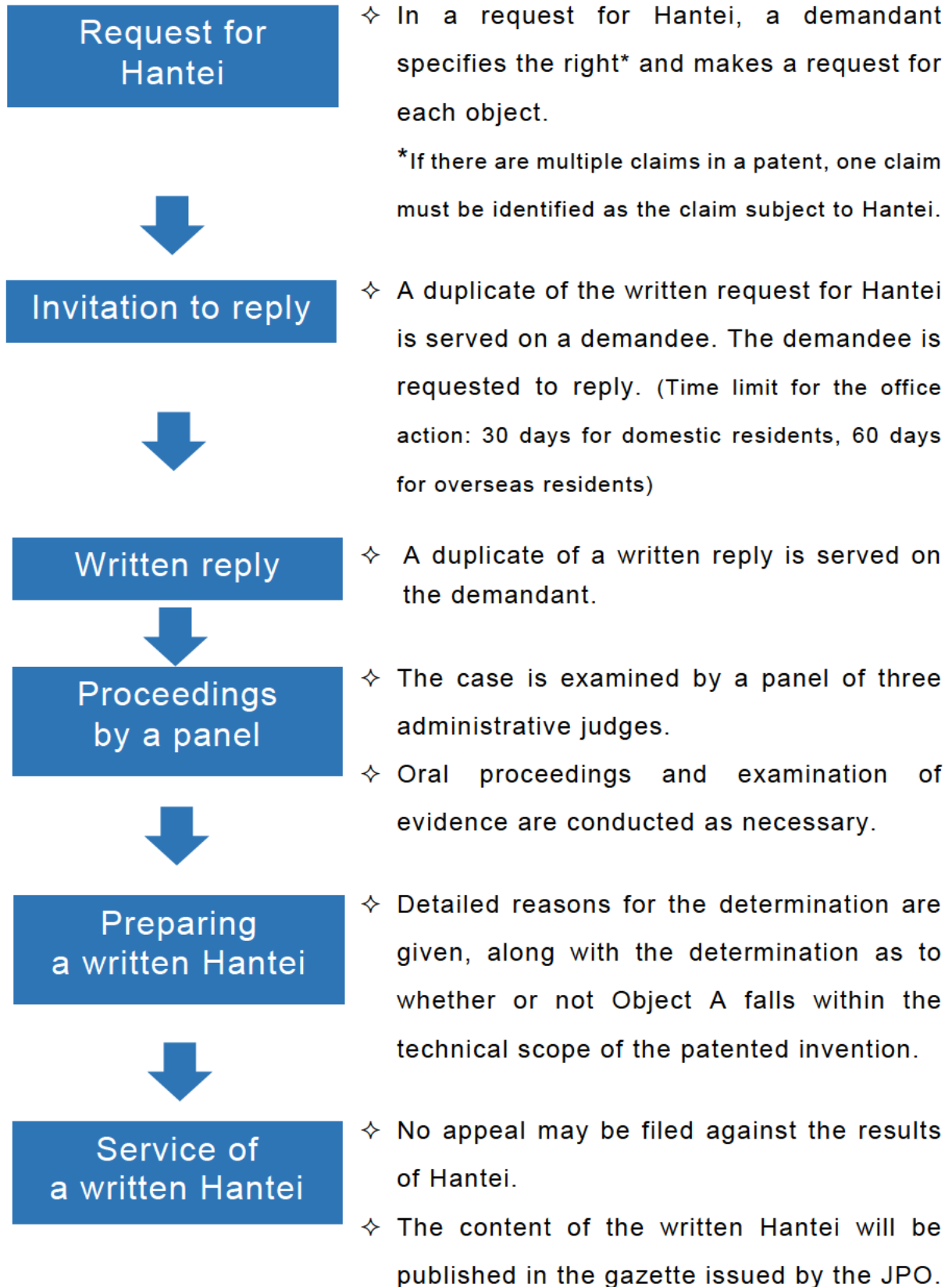
What is “Object A”?

In Hantei, products, etc. that are the subject of comparison with patented inventions, etc. are conventionally referred to as “Object A.”

“Object A” is indicated as Article A, Process A, Drawing A, Written instructions A, Design A, or Mark A.

³ Infringement/non-infringement is determined based on not only whether or not the product falls within the technical scope of the patented invention, but also whether or not the licensee has a non-exclusive license by prior use. However, except for trademarks, Hantei is not determined based on the existence of a non-exclusive license by prior use.

(6) Procedure for requesting Hantei (advisory opinion)



(7) Statement about trade secrets

A. Inspection of documents and a statement about trade secrets

Any person may request the Commissioner of the JPO to inspect the documents in a Hantei case. However, if the documents in the Hantei case include trade secrets owned by the parties, the inspection of the documents including the trade secrets may be restricted by the party's submitting a written statement to the JPO that trade secrets have been described.

Examples of trade secrets included in the documents of Hantei cases

- ✧ In the case where the Hantei system is used to resolve a dispute concerning a software-related invention, corporate information including trade secrets such as source code, etc., which cannot be obtained from the software product itself, is described in the documents of the Hantei case.
- ✧ In the case where a party negotiating a license for a standard essential patent uses the Hantei system, trade secrets are described in the claim chart submitted by the party to the JPO (showing the correspondence between the claims of the patent and the cited standard documents).
- ✧ In the case where a party, who has been warned of infringement of the patented invention relating to a manufacturing process, requests for Hantei that the party's invention does not fall within the technical scope of the patented invention, the party submits a document containing corporate information including trade secrets such as manufacturing know-how, etc. in order to prove that the party's invention does not fall within the technical scope of the patented invention.

B. Documents subject to a statement about trade secrets

All documents related to Hantei are subject to the statement. Examples of the documents:

- A written request for Hantei submitted by a demandant
- A written reply submitted by a demandee
- Claim charts and other documents submitted by the parties in addition to the above

When submitting documents including trade secrets to the JPO

If the documents submitted to the JPO include trade secrets, the original documents held by the JPO can be restricted from being inspected by a third party provided that the party submits a statement about trade secrets to the JPO.

However, a duplicate copy of the document submitted to the JPO will be sent to the other party in the Hantei case. Inspection of the document by the parties in the Hantei case is not restricted (Formality Examination Manual 58.20, 2.). Therefore, please note that the contents of the document will be disclosed to the other party when submitting a document including trade secrets to the JPO.

C. How to submit a statement

A person shall submit a statement in the form prescribed in Form 65-8 of the Implementing Regulations under the Patent Act (see 2. (5) Written statement about trade secrets).

In order to properly protect trade secrets, the form should specifically and clearly state the name of the document including the trade secret and the part of the document where the trade secret is described.

If the document to be submitted itself falls under the category of a trade secret (e.g. if a claim chart managed by the patentee as a trade secret is submitted as a document pertaining to Hantei), please inform us to that effect.

D. Time period for submitting a statement

There is no limitation on time period for submitting a statement. However, because there is a possibility that the documents will be made available for inspection by a third party immediately after they are submitted, please submit the statement at the same time as you submit the documents pertaining to Hantei.

E. Documents for which inspection, etc. is not restricted

“Documents that are clearly found not necessary to be kept confidential” are not subject to restrictions on inspection, etc.⁴

The following can be cited as examples of “documents that are clearly found not necessary to be kept confidential.” Please note that the need to maintain confidentiality is determined on a case-by-case basis, and it does not mean that documents not listed in the examples below are always subject to inspection restrictions.

- Documents that are clearly not managed as trade secrets, such as content described in widely distributed materials including product catalogs, etc. or content published on the Internet.
- The configuration of Object A itself as approved by the panel based on the above documents that are clearly not managed as trade secrets.

In Hantei for essentiality check (see 1. (8)), if the claim chart submitted by a party includes trade secrets, it may be subject to restrictions on inspection. However, the configuration of the Virtual Object itself is not usually subject to restrictions on inspection because it is a precondition in determining Hantei and is generally identified from publicly known standard documents.

Even if the information is a combination of publicly known information, it may

⁴ According to the Formality Examination Manual 58.20, “Only a person who has obtained the consent of the party, the intervenor and the submitter may file a request to inspect, etc. documents concerning Hantei, with respect to which a party in the case has submitted a statement that a trade secret owned by the said party has been described, except for those documents that are clearly not required to be kept confidential (If any part of the document includes a description to that effect or an attached document, the relevant part or the relevant attached document).”

fall under the category of trade secrets if there is a value in how the information is combined.⁵

F. How to restrict inspection, etc.

When a third party requests inspection, etc. of a document, with respect to which a party in the case has submitted a statement that a trade secret owned by the said party in the case has been described, the part that is deemed necessary to maintain confidentiality will be blacked out.

(8) Would like to request a determination on whether a patent is a Standard Essential Patent (SEP) or not

When there is a dispute between the parties regarding the standard essentiality of the patented invention, the parties can request the JPO to determine whether or not a Virtual Subject Article, etc. (Virtual Object) identified from a standard document falls within the technical scope of the patented invention for essentiality check.

For details of the procedure, please see the 'Manual of "Hantei" (Advisory Opinion) for Essentiality Check' posted on the JPO website.

⁵ The "Management Guidelines for Trade Secrets" (Ministry of Economy, Trade and Industry, last update: January 23, 2019) states that:

"A "trade secret" usually consists of an item of information that is the result of combining know-how and other information. However, the fact that a fragment of information is published in various publications and that collecting those fragments could lead to a reconstruction of information similar to the information that constitutes the relevant trade secret does not immediately mean that the information is in the public domain. This is due to the fact that there can be several items of information or methodologies etc. that, if employed, would produce other outcomes, and if value lies in the question as to which items of information should be combined in what way, then those pieces of information can constitute a trade secret. Information is judged for applicability to the trade secret criteria by whether it can be generally obtained outside the control of the holder, and depending on its ease of combination, time and capital costs incurred in the process, or other efforts that are required for its acquisition"

(9) Validity of Patents, etc.

Although the validity of patents, etc., is not determined in Hantei, it is possible to obtain a determination on the validity of patents, etc. by separately filing a request for a trial for invalidation, opposition, or trial for rescission (hereinafter referred to as "trial for invalidation, etc.").

In cases where Hantei and a trial for invalidation, etc. are co-pending, the result of the Hantei determination will be announced in a timely manner, taking into account the status of the proceedings on the validity in a trial for invalidation, etc.

Coordination of proceedings in cases where Hantei and a trial for invalidation, etc. are co-pending

If Hantei and a trial for invalidation, etc. are co-pending, both proceedings will be conducted by a panel consisting of the same administrative judges, in principle, in order to facilitate the coordination of the proceedings between the cases and to avoid conflicts of the determination.

When Hantei and a trial for invalidation, etc. are co-pending, there is a possibility that the patent, etc. will be invalidated or that the technical scope of the patented invention will be restricted by correction. Therefore, if the panel decides that it is desirable to clarify the relationship of rights in consideration of these possibilities before making a Hantei determination, the proceedings of a trial for invalidation, etc. will be given priority in principle.

On the other hand, in cases where a party shows special circumstances that hasten the conclusion of Hantei; where the conclusion of Hantei can be reached regardless of the conclusion of a trial for invalidation, etc.; or where a revocation action is filed against the trial decision of a trial for invalidation, etc., and where waiting for the finalization of a trial decision, etc. is likely to significantly delay the proceedings for Hantei; the proceedings for Hantei may be preceded.

2. Preparing Hantei (Advisory Opinion) Request, etc.

(1) Hantei (Advisory Opinion) Request form

(Implementing Regulations under the Patent Act Article 39 Form 57)

NOTE: The “Hantei Request” form must be completed and submitted in Japanese (English submissions will not be accepted).

Patent
revenue
stamp

(JPY 40,000)

Sample of “Hantei
Request” Form

Hantei: Patent

When a patent attorney is
the agent

Hantei Request

August XX, 2050

Dear Commissioner,

1. Indication of the case requesting Hantei

Patent No. ○○○○○○ Request for Hantei case

2. Demandant

Domicile (residence) ○○ x-x-x, ○○ City, XX Prefecture

Phone number ○○○—○○○—○○○○

Fax ○○○—○○○—○○○○

Name ○○ ○○

3. Agent

(Identification number (registration number) ○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo

Phone number 03-xxxx-xxxx

Fax 03-xxxx-xxxx
Name Patent attorney ○○ ○○

(Identification number (registration number) ○○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo
Phone number 03-xxxx-xxxx
Fax 03-xxxx-xxxx
Name Patent attorney ○○ ○○
Contact information Name of a person in charge

4. Demandee

Domicile (residence) ○○ x-x-x, ○○ City, XX Prefecture
Name ○○ Corporation

5. Purport of the request

I request Hantei that the △△△△⁶ shown in drawings of Object A and its explanatory document falls (or does not fall) within the technical scope of the patented invention of No. ○○○○○○○○.

6. Reasons for request

(1) Necessity of request for Hantei:

(2) Prosecution history of the patented invention

Application filed: March XX, 2050

Registration of establishment: June XX, 2050

(3) Explanation of the patented invention

(4) Explanation of Article A (Process A)⁷

(5) Comparison between the patented invention and Article A (Process A)

(6) Explanation that Article A (Process A) falls (or does not fall) within the technical scope of the patent invention

(7) Conclusion

⁶ In "△△△△," enter the name of the product, etc. (Object A) that is subject to Hantei .

⁷ If it is an invention of a product, it should be described as "Article A"; if it is an invention of a process, it should be described as "Process A."

7. Means of proof

Evidence A No. 1: Patent Gazette Patent No. ○○○○○○○○

Evidence A No. 2: Japanese Unexamined Patent Application Publication
No. 20xx-○○○○○○○

8. List of attached documents and attached articles

- | | |
|---|--------------------------------------|
| (1) Hantei Request | two duplicates |
| (2) Drawings of Object A and its explanatory document | one original copy,
two duplicates |
| (3) Certified copy of the Patent Register | one original copy,
two duplicates |
| (4) Evidence A No. 1 | one original copy,
two duplicates |
| (5) Evidence A No. 2 | one original copy,
two duplicates |
| (6) Power of attorney | one |

Patent
revenue
stamp

(JPY 40,000)

Sample of "Hantei Request"
Form

Hantei: Design
When a patent attorney is
the agent

Hantei Request

August XX, 2050

Dear Commissioner,

1. Indication of the case requesting Hantei

Design Registration No. ○○○○○○ Request for Hantei case

2. Demandant

Domicile (residence) ○○ x-x-x, ○○ City, XX Prefecture

Phone number ○○○—○○○—○○○○

Fax ○○○—○○○—○○○○

Name ○○ ○○

3. Agent

(Identification number (registration number) ○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo

Phone number 03-xxxx-xxxx

Fax 03-xxxx-xxxx

Name Patent attorney ○○ ○○

(Identification number (registration number) ○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo

Phone number 03-xxxx-xxxx

Fax 03-xxxx-xxxx

Name Patent attorney ○○ ○○

Contact information Name of a person in charge

4. Demandee

Domicile (residence) ○○ x-x-x, ○○ City, XX Prefecture
Name ○○ Corporation

5. Purport of the request

I request Hantei that the design shown in a design of Object A and its explanatory document falls (or does not fall) within the scope of a registered design of No. ○○○○○○○ or a design similar thereto.

6. Reasons for request

- (1) Necessity of request for Hantei:
- (2) Prosecution history of the registered design
 - Application filed: March XX, 2050
 - Registration of establishment: June XX, 2050
- (3) Explanation of the registered design
- (4) Explanation of the design of Object A
- (5) Comparison between the registered design and the design of Object A
- (6) Explanation of the reasons why the design of Object A falls (or does not fall) within the scope of the registered design and designs similar thereto
- (7) Conclusion

7. Means of proof

Evidence A No. 1	Monthly magazine	March 2010 issue
	○○ Company Limited	March XX, 2010 issued
	On page XX, XX Figure	
Evidence A No. 2	○○○○○○○○	

8. List of attached documents and attached articles

- | | |
|---|--------------------------------------|
| (1) Hantei Request | two duplicates |
| (2) Design of Object A and its explanatory document | one original copy,
two duplicates |

(3) Certified copy of the Design Registry	one original copy, two duplicates
(4) Evidence A No. 1	one original copy, two duplicates
(5) Evidence A No. 2	one original copy, two duplicates
(6) Power of attorney	one

Patent
revenue
stamp

(JPY 40,000)

Sample of "Hantei
Request" Form
Hantei: Trademark
When a patent attorney is
the agent

Hantei Request

August XX, 2050

Dear Commissioner

1. Indication of the case requesting Hantei

Trademark Registration: No. ○○○○○○○ Request for Hantei case

2. Demandant

Domicile (residence) ○○ x-x-x, ○○ City, XX Prefecture
Phone number ○○○—○○○—○○○○
Fax ○○○—○○○—○○○○
Name ○○ ○○

3. Agent

(Identification number (registration number) ○○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo
Phone number 03-xxxx-xxxx
Fax 03-xxxx-xxxx
Name Patent attorney ○○ ○○

(Identification number (registration number) ○○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo
Phone number 03-xxxx-xxxx
Fax 03-xxxx-xxxx
Name Patent attorney ○○ ○○
Contact information Name of a person in charge

4. Demandee

Domicile (residence) ○○ x-x-x, ○○ City, XX Prefecture
Name ○○ Corporation

5. Purport of the request

I request Hantei that a mark of Object A, used by the demandee for the goods (services) ○○○, does not fall within the scope of the effect of trademark right registration No. ○○○○○○○○.

6. Reasons for request

- (1) Summary of reasons for a request for Hantei
- (2) Necessity of request for Hantei
- (3) Explanation of a mark of Object A (explanation of the use of the registered trademark (goods or services), if necessary)
- (4) Explanation that the mark of Object A falls (or does not fall) within the scope of the effect of the trademark right
- (5) Conclusion

7. Means of proof

Evidence A No. 1	Date: March XX, 2040 ○○Newspaper Morning Edition, Page XX
Evidence A No. 2	Certificate of the reader ○○ of ○○Newspaper

8. List of attached documents and attached articles

- | | |
|---|--------------------------------------|
| (1) Hantei Request | two duplicates |
| (2) Mark of Object A and its explanatory document | one original copy,
two duplicates |
| (3) Certified copy of the Trademark Register | one original copy,
two duplicates |
| (4) Evidence A No. 1 | one original copy,
two duplicates |

(5) Evidence A No. 2

one original copy,
two duplicates

(6) Power of attorney

one

Sample of "Hantei Request" Form

Hantei: Patent, design, trademark

When a patent professional
corporation is the agent

(Only "3. Agent" shall be rewritten as follows, and the rest shall be as in the above Hantei Request form.)

3. Agent

(identification number (registration number) ○○○○○○○○○○)

Domicile ○○ x-x-x, ○○-Ku, Tokyo

Phone number 03-xxxx-xxxx

Fax 03-xxxx-xxxx

Name Patent professional corporation ○○○○

Representative Patent attorney ○○ ○○

Contact information Name of a person in charge

(2) Guidelines for preparing a Hantei (Advisory Opinion) Request Form

NOTE: The "Hantei Request" form must be completed and submitted in Japanese (English submissions will not be accepted).

A. Form

- (a) Paper should be of the size of Japanese Industrial Standards, Column A, No. 4 (21 cm in width and 29.7 cm in height), white in color that does not bleed ink and does not allow letters to be seen through, and should be used vertically. The paper must not contain any unnecessary characters, symbols, borders, or rules.
- (b) For patents and utility models, the margins should be at least 2 cm on the left, right, top and bottom of the paper, but not more than 2.3 cm on the left and right of the paper. For designs and trademarks, the margins should be at least 2 cm on the left, 2 cm on the top, and 3 cm on the right and bottom.
- (c) Letters should be typed in black, clearly and not easily erasable with a font size of 10 to 12 points.
- (d) The text should be written horizontally from left to right, with 36 characters per line, with at least 4 mm between each line, and no more than 29 lines per page.
- (e) When you make corrections, please indicate "how many characters to delete" or "how many characters to insert" in the margin of 2 cm on the right side.
- (f) The request form should be bound on the left side so that it does not come off easily.

B. Fees

- (a) A fee for requesting Hantei is 40,000 yen per case per any right (patents, utility models, designs and trademarks) (Patent Act Article 195, Order on Fees Related to the Patent Act, etc. Article 1).
- (b) When affixing patent revenue stamps, please indicate the amount of the affixed stamps for the request in parentheses below the upper left margin of the request form.

Note:

- Patent revenue stamps must not be sealed over the edges of adjacent

sheets.

- Please note that the fees, etc. are subject to revision.

- (c) Where the fee has been paid in cash pursuant to the proviso of the Patent Act Article 195 (8), and the payment is made in the form of a statement of payment, affix a certificate of payment (for submission to the JPO) in the Attachment Form No. 4-12 of the Administrative Rules for Revenue Collectors to a separate sheet of paper. Where the fee has been paid in cash pursuant to the proviso of the Patent Act Article 195 (8), and the payment is made in the form of payment information, provide a column for "Payment number" next to the "Reason for request" column and enter the payment number.
- (d) Patent fees paid in error or in excess will be refunded if the person, who made the payment, requests for a refund of fees within one year from the date of payment.

C. "Date of submission" column

- (a) Please indicate the date of submission if possible.
- (b) If the application is to be submitted directly to the JPO, please indicate the date of the submission to the JPO.
- (c) When submitting by mail, please indicate the date when the form is handed to a post office.

Note: When submitting by mail, please use a method that can prove the date of handing to a post office, such as a registered mail.

D. "Indication of the case requesting Hantei (advisory opinion)" column

For a patent case, for example, please enter the patent number or registration number in the "Indication of the case requesting Hantei" column, e.g. "Patent No. ○○○○○○, case requesting Hantei." Do not use any other numbers (application number, publication of examined patent application number, etc.).

E. "Demandant" column

- (a) Where the demandant of Hantei is a patentee or a person entitled to the registration, the demandant in the Hantei Request must match the right holder in the register. The current handling of exclusive licensees is similar to that of patent/registration right holders (the "Manual for Trial and Appeal Proceedings 58-01, 2.(2)"). If a change in the matters concerning the right

holder in the register is requested for at the same time as the date of the request for Hantei, which is the date of arrival at the JPO, please explain thereof and indicate the new matters. The same applies to the exclusive licensees.

(b) "Domicile (residence)" column

In the "Domicile (residence)" column, please provide details of the domicile (residence) such as XX Prefecture, XX County, XX Village, Oaza XX, Aza XX, XX, No. XX. If there is no street address, write "(no street address)" at the end of the domicile (residence) in the "Domicile (residence)" column.

(c) "Name" column

In the "Name" column, if the demandant is a corporation, enter its name. Provide a column for "Representative" next to the "Name" column and enter the name of its representative in the column.

If the "Name" is difficult to pronounce or easy to mispronounce, write the *furigana* in *katakana* (for showing the reading of Chinese characters).

In the case of a foreign corporation with a business office in Japan, if the procedure is to be carried out by a representative in Japan, provide a column for "Business Office in Japan" next to the "Name" column and enter the location of the business office in the column, followed by the "Representative" column.

When the procedure is to be carried out by an agent, it is not necessary to provide a column for "Representative."

(d) "Nationality/Region" column

If the applicant is a foreign national, provide a column for "Nationality/Region" and enter the "nationality/region." However, if the applicant's nationality/region is the same as the country/region stated in the "Domicile (residence)" column (or the omitted country/region in cases where such description is omitted pursuant to the provisions of the Regulations under the Act on Special Provisions for Procedures related to Industrial Property Rights Article 2 (3)), there is no need to provide a column for "Nationality/Region."

(e) If there are two or more persons to be entered in the "Demandant" column, repeat the column and enter the information as follows.

Demandant

Domicile (residence)

Phone number

Fax

Name

(Representative)

(Nationality/Region)

Domicile (residence)

Phone number

Fax

Name

(Representative)

(Nationality/Region)

F. "Agent" column

(a) If the procedure is to be carried out by an agent, please provide a column for "Agent" next to the "Demandant" column, and provide the "Domicile (residence)" and "Name" columns in the same manner as in E.

(b) When a patent attorney or a lawyer acts as an agent, please enter the qualification such as "Patent attorney (lawyer) ○○ ○○" in the "Name" column, and also enter the identification number (registration number).

(c) If there are two or more persons to be entered in the "Agent" column, please enter them in the same manner as in (e) of E. "Demandant" column above.

Please provide a column for contact information in the "Agent" column for the patent attorney in charge and write "in charge" (If the agent is a patent professional corporation (PPC), enter the contact information as follows: "The person in charge is a patent attorney: ○○○○." in the "Contact information" column of the agent to whom the patent attorney in charge belongs. If the Hantei case uses the designated employee system, enter the contact information as follows: "The person in charge is a designated employee: ○○○○.") and provide a column for a telephone number and enter a telephone number.

If the patent attorney in charge is changed during the course of the procedure, please indicate the new patent attorney in charge in the

intermediate documents, etc., or submit a written statement to that effect.

G. “Demandee” column

(a) If the demandee is a patentee or a person entitled to the registration, the indication must match the indication of the right holder in the register.

In the case where the demandee is the right holder, if the demandant is aware of any discrepancy between the indication of the right holder in the register and the fact at the time of filing the request for Hantei, a demandant shall add a note to that effect in the “Reason for request”- column.

(b) For patent rights, etc. held under the joint ownership, all joint owners should be listed as the demandee. In this case, enter the information in the same way as in (e) of E. “Demandant” column.

(c) If the demandee is a corporation, the description of the representative of the corporation can be omitted.

(d) When a right holder requests for Hantei for which there is no demandee (the “Manual for Trial and Appeal Proceedings 58-01, 2(2) B”), there is no need to provide a column for a demandee. In this case, please clarify the reason why the demandee does not exist in the "Reason for request" column (the “Manual for Trial and Appeal Proceedings 58-03, 1(1)B(E)").

H. “Purport of the request” column

Upon request for Hantei, the JPO determines whether or not a product or a process described using drawings of Object A, an explanatory document of Object A, etc. falls within the technical scope of the patented invention (you cannot ask the JPO to decide which side should be requested).

In requesting Hantei for a patent right, please describe the purport in the "Purport of the request" column as follows: "I request Hantei that the △△△△ shown in drawings of Object A and an explanatory document of Object A falls (or does not fall) within the technical scope of the patented invention of No. ○○○○○○○." In "△△△△," enter the name of the product, etc. (object A). One request can be made for each "Object A." It is not possible to request multiple number of objects together as a single case.

In Hantei for a design, the request is made as to whether or not it falls within the scope of a registered design or a design similar thereto.

In Hantei for a trademark, unlike patents, utility models and designs, the subject of Hantei is "the effect of a trademark right" (Trademark Act Article 28). If the scope of Hantei is limited to simply determining whether the trademark is similar or not, or whether the goods (services) are similar or not, Hantei will not be effective in resolving disputes over trademark rights. Therefore, it is interpreted as a measure to make the scope of Hantei for a trademark including limitations of effect of trademark right (Trademark Act Article 26) and the right to use a trademark arising from prior use (Trademark Act Article 32). Consequently, if the demandant or the demandee alleges the specific use mode of the trademark, it will be determined in the reasons for Hantei and the conclusion will be drawn.

Usually, when the holder of trademark right requests for Hantei, the following statement will be made in the "Purport of the request" of the trademark Hantei: "a mark of Object A used by the demandee for the goods (services) 'XXX' falls within the scope of the effect of the trademark right, the trademark registration No. ○○○○○○○." When a person has been warned of trademark infringement by the holder of trademark right and wishes to request Hantei, the following statement will be made: "a mark of Object A used by the demandant for the goods (services) 'XXX' does not fall within the scope of the effect of the trademark right, the trademark registration No. ○○○○○○○."

I. "Reasons for request" column

In the "Reasons for request" column, please describe in detail the necessity of requesting Hantei, the prosecution history from filing the application to the registration of establishment of right (including the case number of the related request for trial/appeal or lawsuit, if any), technical contents of the patented invention, the technical contents of Object A, the comparison between them, the reasons, etc. (for details, please see 2.(3) "Reasons for request").

Because a request for Hantei can be filed at any time, please prepare sufficient evidence and state all the reasons as much as possible at the time of filing the request.

J. "Means of proof" column

(a) As a means of proof, product catalogs, brochures, appraisals, certificates of

experimental results, standard documents, etc. may be submitted.

- (b) It is preferable to submit all necessary evidence as much as possible at the time of filing the request.
- (c) In the "Means of proof" column, describe the indication of evidence, facts to be proven, and an explanation of the evidence. As for the indication of evidence, for ordinary documents, the number should be indicated as Evidence A No. ○ (for properties, it should be indicated as checked Evidence A No. ○). In addition, unless it is obvious from the description of the document, please submit a written description of evidence that clarifies the title of the document, the author, and facts to be proven (Form 65-3 of the Implementing Regulations under the Patent Act Article 50). Although a written description of evidence is not mandatory, submission of a written description of evidence may be required depending on the case, such as when there are many pieces of evidence.
- (d) In cases where a number of publications are combined to prove a single fact, the relationship between the parts and the whole must be made clear. If the original is stored in the JPO, it is permissible to submit certified copies (in duplicate) and invoke the original stored in the JPO. Other items for which the original cannot be submitted may not be used as evidence. However, even a certified copy may be used as evidence if the other party admits that the certified copy is valid. Items that are owned by others may be used as evidence by ordering their submission or inspection.

When requesting the examination of a witness, please clarify in advance the matters to be proven and the matters for examination by the witness.

K. "List of attached documents and attached articles" column

- (a) When requesting Hantei, duplicates in proportion to the number of opposing party (demandee) and one duplicate for proceedings must be submitted.
- (b) When omitting the submission of a certificate pursuant to the provisions of Implementing Regulations under the Patent Act Article 10, enter the name of the proving document in the "List of attached documents and attached articles" column, provide a column for "Indication of invocation" next to it, and enter the indication of the case pertaining to the procedure in which the proving document, to be invoked, was submitted (if pertaining to a right, the registration number, the name of the document, and the date of its submission) and attach a certified copy

thereof.

- (c) If you are invoking a general power of attorney, provide a column for "General power of attorney number" in the "List of attached documents and attached articles" column, and enter the number of the general power of attorney.
- (d) When submitting an object to be inspected or other evidence and wishing to have them returned at a later date, it is necessary to make an indication such as "Return requested" in the section of the documents to be submitted and on the relevant article at the time of submission.

L. Others

(a) Method of submitting a request for Hantei

a. Submission by bringing it directly to the JPO

Please submit the request at the counter on the 1st floor of the JPO building.

b. Submission by mail

Please send the request to the Commissioner of the Japan Patent Office at 3-4-3 Kasumigaseki, Chiyoda-ku, Tokyo 100-8915. When submitting by mail, please use a method that can prove the date of delivery, such as registered mail.

- (b) Since it takes a considerable amount of time for the notification of the number to be sent for Hantei, those who wish to confirm that the written request has been received by the JPO as soon as possible when submitting by mail may enclose a postcard with a description of the procedure and the address, or prepare a copy of the procedure document, affix the necessary amount of stamps, and enclose a self-addressed envelope, which will be sent after the receipt stamp is affixed.

(3) Details on how to write "Reasons for Request"

<Patents>

A. Reasons why a request for Hantei (advisory opinion) is necessary:

- (a) Please briefly describe why you are requesting Hantei (e.g., background information such as the possibility that another company is infringing your patent right).
- (b) Please describe the relationship between Object A and the demandant (demandee), the relationship between the demandant and the demandee, the reason if there is no other party, and the current situation regarding Object A.

B. Prosecution history of the right pertaining to the request for Hantei (advisory opinion) (hereinafter referred to as "the patented invention"):

- (a) Describe in bullet points the prosecution history from filing application to registration of establishment of the patent right.
- (b) List any oppositions, trials for invalidation, trials for correction, infringement lawsuits, etc., that have been filed in the past or are currently in progress. Please describe the type (lawsuit, trial/appeal), the type of trial/appeal (invalidation, correction, patent opposition, etc.), the case number (court case number, trial/appeal number), as well as the current status and a prosecution history.

C. Explanation of the patented invention:

- (a) If there are multiple claims (inventions) in the scope of claims of the patent right, please clarify the one claim (invention) that is the subject of Hantei.
- (b) Please describe the claim that is the subject of Hantei, and excerpts (including paragraph numbers) of detailed explanations (fields of industrial application, effects, embodiments, etc.) of the parts necessary for comparison, by dividing them into sections.
- (c) It is also effective to number (divide) the subject claims by constituent features so that they can be easily compared with Object A (especially for claims with long sentences).
- (d) Enclose in a red frame the cited parts in the attached gazette, such as the claims, excerpts of detailed descriptions (embodiments) necessary for comparison, drawings necessary for comparison, etc. If there is a part that you want to emphasize further, please underline it.

- (e) It would be easier to understand if you insert the number of each part of the drawings in parentheses in the claims, etc.
- (f) If there are no numbers in the drawings, mention them and provide additional numbers.
- (g) To explain the patented invention using a gazette, please specify the page, line, paragraph number, etc. of the gazette.
- (h) If necessary, add explanations of technical terms used by people skilled in the art and explanations of the state of the art available prior to the filing of the patent application. If interpretation of the patented invention is necessary, please explain how you interpreted the patented invention, along with the reasons.

D. Explanation of Object A (may be attached as an explanatory document):

- (a) If an actual product exists for Object A, identify it by its product name, model number, etc. If an actual product does not exist but is to be worked, explain to that effect. In explaining, it is effective to clarify the product name, product number, serial number, etc. You may also submit a product catalog or the actual product of Object A. In addition, in order for the panel to find Object A using the actual product of Object A, it is necessary to inspect the actual product, so please submit a request for inspection when submitting the actual product of Object A as evidence for finding Object A.
- (b) Please specify the technical elements of Article A in writing to the extent that it can correspond to the description of the claims of the patented invention (create a hypothetical claim for Object A). In doing so, please make sure to match the category (product or process) of Article A with that of the patented invention. Technical features of the parts corresponding to the elements of the claims of the patented invention in Article A should be described without omission to the same extent as the claims. In particular, please describe the features of the product, etc. in more detail for the part that may be an issue. In doing so, please divide the part into sections and number them in the same manner as the claims in the patented invention.
- (c) If necessary, explain Object A using photographs, drawings, etc. In doing so, it is effective to attach symbols to each part in the photographs, drawings, etc., and to write the name of the part together with the symbol.
- (d) Photographs, drawings, etc. should include not only the entirety and

appearance of Object A, but also the parts that constitute the invention.

- (e) It is preferable to divide the explanation into sections such as elements, operation, action and effect.
- (f) If the actual product exists, an explanatory document should be accurate according to the actual product.

Note: Explaining Object A by interpreting it in a way that is convenient only for you may not only lead to counterarguments from the other party and delay the proceedings, but may also prevent the resolution of disputes by Hantei. Please note that if Object A itself is unclear and cannot be identified from the drawings, explanatory materials, etc., and as a result of the inquiry, Object A cannot be clearly identified, the case will be dismissed by a decision (Patent Act Article 135 as applied mutatis mutandis in the Patent Act Article 71(3)).

E. Notes for each technical field:

- (a) For substances with complex structures, please use chemical formulas as much as possible.
- (b) For a pharmaceutical product, identify it by the product name (structural formula and applicable disease) for which manufacturing approval has been obtained based on the Act on Securing Quality, Efficacy and Safety of Products Including Pharmaceuticals and Medical Devices.
- (c) For an invention characterized by a DNA sequence, specify the sequence in principle. For an analytical value, limited raw material, or limited manufacturing process, explain the relationship with the relevant DNA sequence.
- (d) For compositions, please clarify the ingredients and the amount of content. For compounds with functional expressions, please compare the specific compounds with each other as well as compare the functions with each other.
- (e) For compounds that are expressed in terms of parameters, including high-molecular compounds, please clarify the details of the conditions under which they were measured and analyzed (measurement equipment and analysis conditions), and show the experimental results that show that they fall within the scope of the compounds that are expressed in terms of parameters (generally, the results of tests conducted at public testing facilities are considered to be highly provable).
- (f) For an invention of a manufacturing process, clearly indicate the identity of

the raw materials, the process of analyzing the identity, etc.

- (g) For an invention of a device with a complicated operation, etc., an operating diagram, moving image medium, etc. can be attached. For diagrams including a device or circuit diagram, etc. with a complex structure, it is effective to color-code each part or element and provide an explanation.

Note: Although the above points are described in general terms, if the demandant and the demandee have agreed in advance, the agreed points may not need to be specified in any particular detail.

F. Comparison between the patented invention and Object A:

- (a) Please divide into sections as much as possible (identical features, different features, interpretation of the different features, and the subject claims should be divided into sections for each constituent feature).
- (b) It is preferable to make a comparison table between the patented invention and Object A (for each constituent feature of the claim, member, operation, action, and effect) and explain it.
- (c) For each member, explain which part of the patented invention corresponds to (satisfies) which part of Object A (which numbered member corresponds to which numbered member).
- (d) If the expressions are different but the substance is the same, or if there is a relationship of a generic concept and a more specific concept, please state so.
- (e) If there are points that need to be interpreted for each member, etc., please add further explanation.
- (f) Interpretation of the differences should be explained in as much detail as possible, using evidence as necessary. (e.g., if it is a mere design issue, explain why it is so by using prior art, a problem to be solved, similarity of effects, etc.)
- (g) Comparison of actions and effects may also be an important indirect fact concerning the combination of the divided constitutions.
- (h) If there are matters that have been agreed upon in advance with the demandee, such as the explanatory text divided into sections in object A, identical features and different features, etc., please provide an item such as points of agreement or points of dispute and state to that effect. If there are any documents, etc. presented in the negotiations prior to filing the request

for Hantei, they can be attached.

G. Explanation that Object A seems to fall within the technical scope of the patented invention:

- (a) When showing that Object A is equivalent to the technical scope of the patented invention, please indicate that it satisfies the requirements from a. to e. in “(reference)” below, in order by dividing them into sections. In doing so, in order to show that Object A is neither identical to an art publicly known at the time of filing the patented invention nor one that could have been easily arrived by a person skilled in the art at the time of filing, please show the prior art documents (the documents used in the examination and trial/appeal proceedings for this patented invention are considered to be influential), and then explain that the explanatory text divided into sections in the technical content of object A is not identical to the prior art or could not have been easily arrived (e.g., please explain the differences in constitutions, industrial field used in the case, use, effect, etc.).

Note: As a means to investigate whether Object A could not have been easily arrived by a person skilled in the art at the time of filing, cited reference sections on the front page of the patent gazette containing the patent and the documents related to the application (also known as the file wrapper) can be browsed, and prosecution history can be searched on the Japan Platform for Patent Information (J-PlatPat) (it may be useful to know the prosecution history by browsing the file wrapper in some cases.)

- (b) If there are materials that are useful in making a Hantei determination, it is acceptable to submit a copy of the materials with attachments and an explanation of them.
- (c) Based on the Patent Act Article 101: For example, even if an allegation of indirect infringement is made based on the Patent Act Article 101 (iv) that “in relation to the invention of a process, because the object itself used only for the work of the invention is Article A, it infringes this patent right and therefore falls within the technical scope of the patented invention,” such allegation will not be considered.
- (d) If the purport of the request itself is merely an allegation such as “Object A does not fall within the technical scope of the patented invention because the patented invention is invalid,” such allegation will not be considered in the

Hantei determination. Please file a separate request for a trial for invalidation.

H. Conclusion:

Please state, for example, "Since Object A falls within the technical scope of the patent No. ○○○○○○○ invention, a determination as per the purport of the request is requested.

(Reference) Requirements for determination of equivalents (see the Supreme Court, court decision No. 1083 of 1994 (O), date of court decision: February 24, 1998)

Even if the compositions described in the patent claims contain a part which is different from the accused products or process ("products"), if:

- a. The different part is not the essential part of the patented invention;
 - b. The purpose of the patented invention can be achieved and an identical function and effect can be obtained even if the different part is replaced with a corresponding part in the accused products;
 - c. A person ordinarily skilled in the art could easily arrive at the idea to replace the different part at the time of production of the accused products;
 - d. The accused products are not identical to the technology in the public domain at the time of filing the patent application of the patented invention or could not have been easily arrived by a person ordinarily skilled in the art at the time of filing the application of the patented invention; and
 - e. There were no special circumstances such as the fact that the accused products had been intentionally excluded from the scope of the patent claims during the patent application process;
- the product should be regarded as identical with the construction as indicated in the scope of the patent claim and falls within the scope of the technical scope of the patented invention.

<Designs>

A. Necessity of request for Hantei (advisory opinion):

- Please briefly explain the necessity of requesting Hantei (e.g., background information such as the possibility that another company is infringing your design right).
- Please describe the relationship between a design of Object A and the demandant (demandee), the relationship between the demandant and the demandee, and the current situation regarding a design of Object A.

B. Prosecution history of the registered design:

Please provide the date of filing the application, application number, registration date, registration number, etc.

C. Explanation of the registered design:

As for the contents of the design, please attach copies of the application and accompanying drawings (or a copy of the design gazette) as attached documents and describe it to that effect.

In addition, it is necessary to concretely describe the elements (shape, pattern, color) that are indispensable to the constitution of the registered design or how they are combined.

When describing each part of the registered design with its name, etc., please attach a drawing showing the correspondence between the part and the name, etc., as an attached document and describe it to that effect.

D. Explanation of a design of Object A:

As for the contents of a design of Object A, if the demandee is working the registered design, please attach a photograph as an attached document in accordance with the guidelines for preparing a photograph substituted for drawing at the time of filing the application. In addition, when drawing it up in a drawing, it is necessary to accurately represent the worked design.

For other explanations, please see C.

E. Comparison between the registered design and a design of Object A:

Please explain identical features and different features between the two designs based on "C. Explanation of the registered design" and "D. Explanation of a design of Object A" above.

In this case, it is also preferable to insert a comparison of each drawing showing the form of each part of the design and explain it.

F. Explanation as to whether or not a design of Object A falls within the scope of the registered design and designs similar thereto:

Based on the explanation of the registered design or the design of Object A, please examine in depth the identical features and different features between the two designs extracted in E., then describe an allegation of the similarity between the two designs in order to clarify why the design of Object A does or does not fall within the scope of the registered design and designs similar thereto.

If there are any prior or peripheral public known designs, etc. to support the allegation, please provide their bibliographic items (name of the magazine, date of issue, page of publication, etc.) and attach the original or a copy of the publication, etc. describing the prior or peripheral public known designs as reference material.

If necessary, please clarify a purport of the reference material in the form of a design map, etc.

<Trademarks>

A. Summary of reasons for request for Hantei (advisory opinion):

In the summary of the request for Hantei, the following shall be described by sorting out and summarizing in a tabular format so that the entire reasons for the request, evidence, etc. can be easily understood; (1) a registered trademark and its designated goods (services) of the trademark right pertaining to the request for Hantei, (2) a trademark that is the subject of Hantei (hereinafter referred to as "a mark of Object A") and the goods (services) for which the trademark is used, (3) reasons and evidence, etc. for deriving the purport of the request.

B. Necessity of the request for Hantei (advisory opinion):

Briefly describe why you are requesting Hantei (e.g., background information such as the possibility that another company is infringing your trademark rights).

C. Explanation of a mark of Object A:

Please provide a detailed explanation of a mark of Object A with evidence, including; (1) modes, (2) goods (services) for which the mark is used, (3) a mode of use, including affixing a mark to goods (services) or packages of goods, (4) a time period of use, and (5) a region of use.

In addition, depending on the case, an explanation of the use of the registered trademark may be required in order to determine whether the registered trademark is similar to a mark of Object A.

D. Explanation that a mark of Object A falls (or does not fall) within the scope of the effect of the trademark right:

Please compare the registered trademark with the mark of Object A and explain the similarity between two marks based on factors such as appearance, pronunciation, and concept.

Please also explain whether the designated goods (services) of the registered trademark are similar to the goods (services) of the mark of Object A.

E. Conclusion:

Please describe that you are seeking Hantei as stated in the purport of the request.

(4) Written reply

NOTE: The “Written reply” form must be completed and submitted in Japanese (English submissions will not be accepted).

A. Form

Please fill out the form in accordance with the form for trial/appeal procedures (Implementing Regulations under the Patent Act Article 47(1) Form 63).

<Example>

Written Reply to Hantei Request	
(September XX, 2050)	
Dear Chief Administrative Judge ○○○○	
1. Case number	20xx Hantei Request No. ○○○○○○ Patent No. ○○○○○○ Request for Hantei case
2. Demandee	
Domicile (residence)	○○ x-x-x, ○○ City, XX Prefecture
Phone number	○○○—○○○—○○○
Fax	○○○—○○○—○○○
Name	○○ ○○
3. Demandee's agent	
(Identification number (registration number) ○○○○○○○○○)	
Domicile	○○ x-x-x, ○○-Ku, Tokyo
Phone number	03-xxxx-xxxx
Fax	03-xxxx-xxxx
Name	Patent attorney ○○ ○○
4. Demandant	
Domicile (residence)	○○ x-x-x, ○○ City, XX Prefecture
Name	○○ Corporation
5. Demandant's agent	
Domicile	○○ x-x-x, ○○-Ku, Tokyo
Name	Patent attorney ○○ ○○
6. Purport of the reply	
I request Hantei that the △△△△ shown in drawings of Object A and its explanatory document falls (or does not	

fall) within the technical scope of the patented invention of No. ○○○○○○.	
7. Reasons for the reply	
8. Means of proof	
9. List of attached documents	
(1) Written reply for Hantei:	two duplicates
(2) Evidence B No. 1	one original copy
	two duplicates
(3) Power of attorney	one

B. Notes: when preparing a written reply

(a) Reasons for the reply

In the "Reasons for the reply" column, enter the grounds for alleging that Object A "falls (or does not fall)" within the scope of rights and the counterarguments to the demandant's allegations. If there are no counterarguments to the demandant's respective allegations, the allegation may be deemed to be admitted in some cases.

(b) No allegation of invalidation of the right itself, etc.

During the procedure for requesting Hantei, the allegation that the registered right is invalid or has reasons for revocation will not be determined. If necessary, please file a separate request for a trial for invalidation or a trial for rescission.

(c) Argument by showing evidence and reasons

In the case where the demandant is claiming that Article A is equivalent with the patent, when claiming that Article is the same as the publicly known art at the time of filing the application or could have been easily arrived by a person skilled in the art in order to show that Article A is not equivalent, it is necessary to present evidence (indicated as "Evidence B No. ○," etc. in the documentary evidence) and reasons (stated in the same manner as the reasons for invalidation and reasons for opposition, and a comparison table shall be also attached).

(d) The subject of the determination is the presented Object A itself

Even if the demandee claims that the right, that is the subject of the

determination, is not related to Article A, the request for Hantei will not be rejected for that reason. In other words, since the subject matter of the determination is only Object A, the determination will be indicated as to whether or not Article A falls within the technical scope of the right.

(5) Written statement about trade secrets

A. Form

NOTE: The “Written statement about trade secrets” form must be completed and submitted in Japanese (English submissions will not be accepted).

Please fill out the form in accordance with the form for trial/appeal procedures (Implementing Regulations under the Patent Act Article 50-14(1) Form 65-8).

<Example>

Written Statement about Trade Secrets	
(August XX, 2050)	
Dear Commissioner ○○○○ (Dear Chief Administrative Judge ○○○○)	
1. Case number	20xx Hantei Request No. ○○○○○○ Patent No. ○○○○○○ Request for Hantei case
2. Person submitting a statement	
Domicile (residence)	○○ x-x-x, ○○ City, XX Prefecture
Name	○○ ○○
3. Agent	
(Identification number (registration number)	○○○○○○○○○○)
Domicile	○○ x-x-x, ○○-Ku, Tokyo
Phone number	03-xxxx-xxxx
Fax	03-xxxx-xxxx
Name	Patent attorney ○○ ○○
4. Contents of the statement	
I hereby submit a statement that the contents of page XX to page XX of Form XX submitted on August XX, 2050 are trade secrets managed by the person submitting a statement and that trade secrets are included therein.	

B. Note: when preparing a statement about trade secrets

In order to properly protect trade secrets, the statement should specifically and

clearly state the name of the document including the trade secret and the part of the document including the trade secret.

If the document to be submitted itself falls under the category of a trade secret (e.g., if a claim chart managed by the patentee as a trade secret is submitted as a document pertaining to Hantei), please provide a statement to that effect.

3. Reference Materials

(1) Examples of reasons for request

NOTE: The "Hantei Request" form must be completed and submitted in Japanese (English submissions will not be accepted).

<Example: Patent>

(1) Necessity of the request for Hantei (advisory opinion)

The patentee of the patented invention "tire" (Evidence A No. 1) (demandant ○○○○, the person requesting Hantei in this case) has confirmed that △△△△ Corporation (the demandee) manufactures the tire with model number 123 (Article A) shown in the explanatory document of Object A and the photograph of Object A.

The demandant in this Hantei case believes that Article A falls within the technical scope of the patented invention. In order to use the results of Hantei as a basis for negotiations with the demandee, the demandant requests Hantei by the JPO from a strictly neutral standpoint, which has a high level of specialized technical knowledge.

(2) Prosecution history of the patented invention

- Application filed: XX ○○, 20xx (Patent Application No. 20**-000001)
- Application published: XX ○○, 20xx (Japanese Unexamined Patent Application Publication No. 20**-150001)
- Notice of Reasons for Refusal: XX ○○, 20xx
- Written opinion: XX ○○, 20xx
- Registration of establishment of patent: XX ○○, 20xx (Patent No. *****)
(See the register in Evidence A No. 2)
- Request for a trial for correction: XX ○○, 20xx (Correction No. 20**-390001)
- Trial decision: XX ○○, 20xx (Correction accepted, final and binding)

(3) Explanation of the patented invention

According to the description and drawings, the "tire" of the patented invention is described in claim 1 of the scope of claims as follows:

“(1) having an outer periphery surface part molded of AAA rubber; and

(2) having a U-shaped cross-sectional groove intersecting with BB at an acute angle on the outer periphery surface part.

(3) a vehicle tire.”

And the patented invention has the advantageous effect of preventing slipping on snowy roads.

(4) Explanation of Object A

As shown in the following explanation, Object A can be described in accordance with the patented invention as follows:

- “a. having an outer peripheral surface part (10) molded of ABC rubber; and
- d
- b. having a semicircular cross-sectional groove (20) intersecting with BB (12) at an acute angle on the outer periphery surface part (10).
- c. a vehicle tire.”

Explanation of a.:

In the Evidence A No. 1 (an advertising pamphlet issued by the demandee in which Object A is listed), it is stated that the tire of model No. 123 is characterized by "excellent durability due to the use of ABC as the surface rubber, and is not slippery even on snowy roads."

In addition, in the Evidence A No. 2 (the result of the demandant's request to XXXX to analyze the composition of the outer surface rubber of Object A), the result shows that the rubber is "ABC."

Explanation of b.:

It is clear that the groove is semicircular in cross-section, intersecting with BB at an acute angle, from the portions indicated by a symbol ○ in Evidence A No. 3(1) through 3(5) (photographs of a tire of Object A taken from various angles).

Explanation of c.:

In Evidence A No. 1, there is a photograph of a tire being used on a vehicle, although it is not the same tire as the tire of Object A, and there is a description of the tire of Object A as "not slippery even on snowy roads. Therefore, it can be understood that the tire of Object A is a tire for vehicles. Furthermore, as shown in Evidence A No. 4 (a photograph of the overall

shape of the tire of Object A), unless there are particular grounds for believing that a tire with such an overall shape is not for use on vehicles, it is reasonable from common sense to conclude that it is for use on vehicles.

(5) Comparison between the patented invention and Object A

the patented invention	Object A	identical
(i) AAA rubber...	a. ABC rubber...	✓✓
(ii) intersecting with BB at an acute angle... U-shaped cross-sectional groove	b. intersecting with BB (12) at an acute angle... semicircular cross-sectional groove (20)	✓
(iii) a vehicle tire	c. a vehicle tire	✓✓✓
preventing slipping on snowy roads	not slippery even on snowy roads	✓✓✓

Note: ✓✓✓ when they are completely identical; ✓✓ when they are partially identical; ✓ when interpretation is added; and X when they are different.

Interpretation of identical features and different features

- (i) and a.

As shown in Evidence A No. 5, ABC rubber is a more specific concept of AAA rubber. Therefore, the constitution of (i) is identical with the composition of a.

- (ii) and b.

The semicircular shape is a form of U-shape, and there is no substantial difference in such points. Even if there is a difference, it is included in the scope of being equivalent. Therefore, the constitution of (ii) is identical with the constitution of b.

- (iii) and c.

Both are "tires for vehicles" and there is no difference. Therefore, the constitution of (iii) is identical with the constitution of c.

(6) Explanation that Object A falls within the technical scope of the patented invention

(ii) and b. in the preceding paragraph (5) that the groove shape is equivalent, which was preliminarily alleged.

- Non-essential part

The most important feature of the patented invention is that the grooves are formed by intersecting with BB in an acute angle to prevent slipping on snowy roads. As stated in the Evidence A No. 6 (a written opinion submitted during the examination), the "grooves intersecting with BB at an acute angle" contribute greatly to the prevention of slippage. Therefore, the groove shape is not an essential part of the product.

- The same purpose and effect

The only difference between the U-shaped groove and the semicircular groove is the presence or absence of a straight line formed at the groove entrance, and the tangential angle of the groove entrance is perpendicular to the surface. Therefore, the difference in shape does not cause any particular difference in the effect.

Furthermore, the above-mentioned Evidence A No. 1 describes the same purpose and effect as that of the patented invention, namely, "less slippery on snowy roads."

Therefore, Object A has the same purpose and effect as that of the patented invention.

- Ease of substitution

Therefore, it is easy for a person skilled in the art to substitute.

- Ease of arriving at Object A

As is clear from the prosecution history of the patented invention, the feature of the patented invention is "a groove intersecting with B at an acute angle." Moreover, prior to the filing of the application for the patented invention, there is no document that describes or suggests "a semicircular groove intersecting with BB at an acute angle."

Therefore, Object A could not have been easily arrived from publicly know

n documents.

- Consideration of prosecution history

During the examination and trial/appeal proceedings of the patented invention, there is no statement to the effect that a semicircle-shaped groove is excluded.

As described above, Object A is identical or at least equivalent to the constitution described in the claims of the patented invention, and thus falls within the technical scope of the patented invention.

(7) Conclusion

Because object A falls within the technical scope of the patented invention No. *****, Hantei is requested as per the purport of the request.

<Example: Design>

(1) Necessity of the request for Hantei (advisory opinion)

The demandant in this case (○○○○ Co., Ltd.) is the holder of the design right of the registered design "screwdriver" (Evidence A No. 1, "the registered design") pertaining to this request for Hantei.

Because the screwdriver of a design of Object A (Evidence A No. 2) currently sold by the demandee (△△△△ Co., Ltd.) infringes the design right of the registered design, the demandant sent a warning letter (Evidence A No. 3) that the screwdriver of a design of Object A infringes the design right of the registered design to the demandee on XX ○○, 20xx.

In response, the demandee in this Hantei case alleges that "the design of Object A does not fall within the scope of the registered design and designs similar thereto," and therefore the demandant requests Hantei of the JPO from a strictly neutral standpoint, which has a high level of specialized technical knowledge.

(2) Prosecution history of the registered design

Application filed: March ○○, 2034 (Design application No. 20XX-000001)

Registration: XX ○○, 20xx (Registration No. 1500000)

(3) Explanation of the registered design

The registered design refers to a "screwdriver" as the article to the design, and the gist of its form is as follows (see Evidence A No. 1).

In other words

- A. The basic constitution consists of a shaft for turning screws ("shaft") and a handle, the shaft being an elongated rod, the rear end of which is buried in the front end of the handle and firmly attached, and the handle being an elongated conical trapezoid with a narrower front end and a narrower rear end in the middle is formed with bulging portions in the front and rear to form an overall gourd shape. An annulus is placed around the abbreviated center of the bulging portions.
- B. The specific constitution is as follows: the tip of the shaft is used as a cutting edge for a Phillips screw, the front end of the handle is covered with a tapered tubular insulator, and the rear bulging portion is shaped

like a sphere, each annulus is slightly wide and is provided near the large diameter part of the respective bulge, and the front-end annulus has a rhombic knurling pattern on the entire surface, leaving some of the front and rear edges. The rear-end annulus has its width approximately the same size as the radius of the rear bulging portion, and a rhombic knurling pattern appears on the entire surface of the remainder of the annulus, leaving some of the front and rear edges, and a small circular dish-shaped recess for preventing slippage ("a dish-shaped recess") with a diameter slightly smaller than its width is present in each of the opposing positions of the rear-end annulus.

(4) Explanation of a mark of Object A

Omitted (described in accordance with (3) above)

(5) Comparison between the registered design and the design of Object A

A. Identical features between the two designs:

- (a) The two designs are identical in that the article to the design is a "screwdriver."
- (b) In the basic constitution, the shaft being an elongated round bar, and the handle being an elongated conical trapezoid with a thin tip with a narrower front end and a narrower rear end in the middle is formed with bulging portions in the front and rear to form an overall gourd shape. An annulus is placed around the abbreviated center of the rear bulging portions.
- (c) In the specific constitution, the tip of the shaft is used as the cutting edge for the Phillips screw, the handle is covered with a tapered tubular insulator at the front end to make the rear bulging portions spherical, and the rear-end annulus is provided near the large diameter part of the rear bulging portions, with its width being approximately the same size as the radius of the rear bulging portions.

B. Different features between the two designs:

- (a) In the registered design, the annulus is provided on the front and rear bulging portions, whereas in the design of Object A, the annulus is present only on the rear-end annulus, and two narrow grooves are present

at a slightly spaced distance in the part where the front-end annulus of the registered design is present.

- (b) For the purpose of preventing slippage, the registered design has one dish-shaped recess around the rear-end annulus at each opposing position, while the design of Object A has six slightly raised portions elongated in the axial direction at equal intervals.

(6) Explanation of the reasons why the design of Object A falls within the scope of the registered design and designs similar thereto:

A. Prior peripheral designs related to this registered design

- Evidence A No. 4: Publication name: "Monthly XXXX, XXth month issue"
(Issued on March ○○, 20xx by XX Corporation.
Page XX, Figure XX.
- Evidence A No. 5: (described in the same way as above)
- Evidence A No. 6: (described in the same way as above)

B. Key part of the registered design:

If we discuss the main points of the registered design based on the above mentioned designs, it is clear that the main subject of design creation in this type of article is the constitution of the handle. In this registered design, the overall shape of the handle, which is completely unique, and the shape of a rear bulging portions, which is also important in terms of its function as it is grasped when in use, together express the overall tone of this registered design.

C. Consideration of the similarity between the registered design and the design of Object A

The following is a comparative study of the identical features and the different features between the registered design and the design of Object A.

- (a) The identical features between the two designs relate to their basic constitution. In particular, the gourd-shaped overall shape of the handle, which is the key part of the registered design, and the spherical shape of the rear annulus and the loose-width annulus near the large diameter of the rear annulus are common to both designs, and have a significant impact on the determination of similarity between the two designs.

- (b) With regard to the different feature (5)B(a) between the two designs, since the two narrow grooves of the design of Object A are slightly spaced apart, it can be recognized as a single annular body if viewed from a different perspective. Therefore, this is not an exceptionally remarkable difference, and its impact on the determination of similarity between the two designs is slight. As for the different feature (5)B(b), it is a common practice in this type of article to add concave-convex parts in the part in order to prevent slippage, and it is not a key part of this registered design. Thus, this is also not an exceptionally remarkable difference, and its impact on the determination of similarity between the two designs is slight.
- (c) Considering the two designs as a whole based on the above findings and determination, it can be said that the differences between the two designs have only a slight impact on the determination of similarity and do not outweigh the identical features and, even if they are put together, their impact on the determination of similarity between the two designs is not enough to affect the conclusion.

(7) Conclusion

Therefore, since the design of Object A falls within the scope of the registered design and designs similar thereto, Hantei is requested as per the purport of the request.

<Example: Trademark>

(1) Summary of the reasons for request for Hantei

	The registered trademark Trademark registration No. ○○○	a mark of Object A
Modes	○○○	××× (drawing) Note: Composite trademark composed of letters and figures
Products	Class of designated goods Class ○○ ○○○, ○○○, ○○○ Class ○○ ○○○, ○○○	Goods used ○○○
Prosecution history	Application filed: March XX, 2050 Registration of establishment: June XX, 2050 Publication date: July XX, 2 050	Start date of use: June XX, 2050 Now in use
Main points of reasons	The registered trademark consists of the letters "○○○" which give the pronunciation of "○○○" and the concept of "△△△." On the other hand, a mark of Object A consists of the letters "XXX" which give the pronunciation of "○○○" and the concept of "△△△." These marks are similar marks that share the pronunciation "○○○" and the concept "△△△." In addition, the goods in Class ○ "○○○, ○○○" in the designated goods to the registered trademark and the goods in use of the mark of Object A "○○○" are similar.	

(2) Necessity of the request for Hantei

The demandant is the holder of trademark right of the registered trademark No. XXXX (hereinafter referred to as "the trademark") pertaining to this request. On XXxx, XX, 20xx, the demandant issued a warning to the effect

that the demandee was infringing the trademark right of the aforementioned trademark registration (Evidence A No. XX) based on the fact that the demandee is using the mark "○○○" (hereinafter referred to as "a mark of Object A") on the goods "○○○" (Evidence A No. XX).

Subsequently, as a result of negotiations between the demandant and the demandee, they agreed to request the JPO to make a determination, Hantei on the scope of the effect of the trademark right of the aforementioned trademark registration from a neutral standpoint with expert knowledge, and to resolve this issue based on this Hantei.

Therefore, they are requesting this Hantei.

(3) Explanation of a mark of Object A

The demandee has been manufacturing goods "○○○" with an affixed mark of Object A, which is composed of the letters "×××" and the drawing of ..., and, selling them at ... stores in Tokyo since around XX xx, 20xx (Evidence A No. XX).

The demandant began to use the trademark in connection with the goods "○○○, ○○○" in around XX xx, 20xx (Evidence A No. XX), and has continued to use the trademark thereafter up to the present. The production volume, sales volume, sales area, etc. of the said goods are as shown in Evidence A No. x through Evidence A No. xx. As a result of the demandant's long-time use of this trademark, it has become well known among consumers as that indicating goods in connection with the demandant's business in Tokyo, and other prefectures ... by around XX xx, 20xx, at the latest, when the aforementioned warning was issued to the demandee.

(4) Explanation that a mark of Object A falls within the scope of the effect of the trademark right

The trademark consists of the letters "○○○," which gives rise to the pronunciation "○○○" and the concept "△△△△."

On the other hand, a mark of Object A is composed of the letters "×××" and a drawing of ..., however, because it is, the pronunciation "○○○" and the concept "△△△" are also derived from the letters "×××."

Therefore, even if the appearance of the two marks is different, they are likely to cause confusion about the source of the goods because they share

the pronunciation "ooo" and the concept of "△△△." For that reason, they should be similar marks.

In addition, because Class xx "ooo, ooo" in the designated goods in connection with the trademark and the goods using a mark of Object A "ooo" are, they are similar.

As stated above, a mark of Object A is a mark similar to the trademark, and the goods in use and the designated goods are also similar, therefore, a mark of Object A used by the demandee on the goods "ooo" falls within the scope of the effect of the trademark right of the registered trademark No. ooo.

(5) Conclusion

Therefore, Hantei is requested as per the purport of the request.

(2) Examples of written Hantei (advisory opinion)

Hantei ○○○○ — ○○○○○○

Demandant ○○

Demandee ○ ○

The case between the above-mentioned parties requesting Hantei on registration No. 000000 is hereby determined as follows.

Conclusion

The "Anywhere Shower" shown in drawing of Object A and its explanatory document fall within the technical scope of the registered utility model No. 000000.

Reasons

1. Purport of the request

The purport of this request for Hantei is to seek determination on that the "Anywhere Shower" ("Article A") described in a photograph of Object A and its description falls within the technical scope of the registered utility model No. 000000000.

2. Prosecution history of the device

The following is a summary of the prosecution history for the device.

(1) Application: March xx, 20xx

(2) Registration of establishment of utility model: March 31, 20xx

3. The registered device

This device is specified in claim 1 of the scope of claims for a utility model registration in view of the description and drawings attached to the application as follows

"[Claim 1] A mobile foot-operated shower characterized in that water in a polyethylene tank for water supply is discharged by compressing air with a foot pump, "bellows ("Fuigo")." (hereinafter referred to as "the registered device 1") The word "Fui" in claim 1 is a clerical error for "Fui-go," so it was approved as

above.

4. Article A

Taking into consideration that the demandee admits that "Article A is equipped with a polyethylene tank for water supply and a foot pump, which constitute the device 1" (lines 15-16, p. 2) in the description of the photograph of Object A and the explanatory document of Object A attached to the Hantei Request as well as a written reply dated XX xx, 20xx, it is recognized that Article A consists of the following structure.

(Article A)

"Anywhere shower that releases water by compressing air with a foot pump from a polyethylene tank for water supply."

5. Comparison and determination

Comparing the device 1 with Article A, the "polyethylene tank for water supply" and the "foot pump" of the Article A correspond to the "polyethylene tank for water supply" and the "foot pump, FUIGO" of the device 1, respectively.

Because Article A is called "Anywhere Shower," it is a "shower" that can be used "anywhere." Taking into consideration the photograph of Object A, because the "polyethylene tank for water supply" has a handle at its upper end and has a capacity of 20 liters, which is enough to carry even when it is filled with water, it is clear that Article A is a mobile (or movable) product, just like the device 1.

In this way, it is clear that Article A satisfies all the constituent features of the device 1.

6. Conclusion

As explained above, Article A falls within the technical scope of the device 1. Therefore, the determination for Hantei is as follows.

December ○○, 20xx

Chief administrative judge	Administrative judge	○○	○○
	Administrative judge	○○	○○
	Administrative judge	○○	○○