

## **An Outline of the System of Opposition to Grant of Patent**

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.

### **1. 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).

### **2. Opposition Period**

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).

### **3. Fees**

16,500 yen + (the number of claims opposed × 2,400 yen)

### **4. Reason for Opposition**

Reasons for opposition to grant of patent are restricted to those specified under the Patent Act Article 113 (e.g., new matter, patentability and description requirements. See the website link below) and the other reasons are not eligible.

### **5. Procedures**

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). It includes:

- (1) Indication of Patent, Opponent, etc.
- (2) Reasons for Opposition to Grant of Patent and Indication of Supporting Evidence

### **6. Proceedings Body and Administrative Judges**

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.

### **7. Scope and Method 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 and all the claims opposed by any of the consolidated oppositions are deemed to be the subject of the proceedings.

An opposition to grant of patent shall be examined based on reasons pleaded by an opponent and evidence. 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.

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

## **8. Notification of Reasons for Revocation and Request for Correction**

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. A patentee may submit a written opinion within a designated time limit (Patent Act Article 120-5 (1)), and may file a request for correction of the scope of claims, etc. (Patent Act Article 120-5 (2)). The second notice of reasons for revocation shall be the notice of reasons for revocation (advance notice of decision) in principle.

## **9. Decision to Revoke and Appeal**

When multiple requests for opposition to grant of patent has been filed for multiple claims, a panel shall make a decision of revocation or a decision of maintenance for each of these claims.

Revocation action against an appeal decision may be made by a patentee to the Tokyo High Court (Intellectual Property High Court) (the Patent Act Article 178(1)).

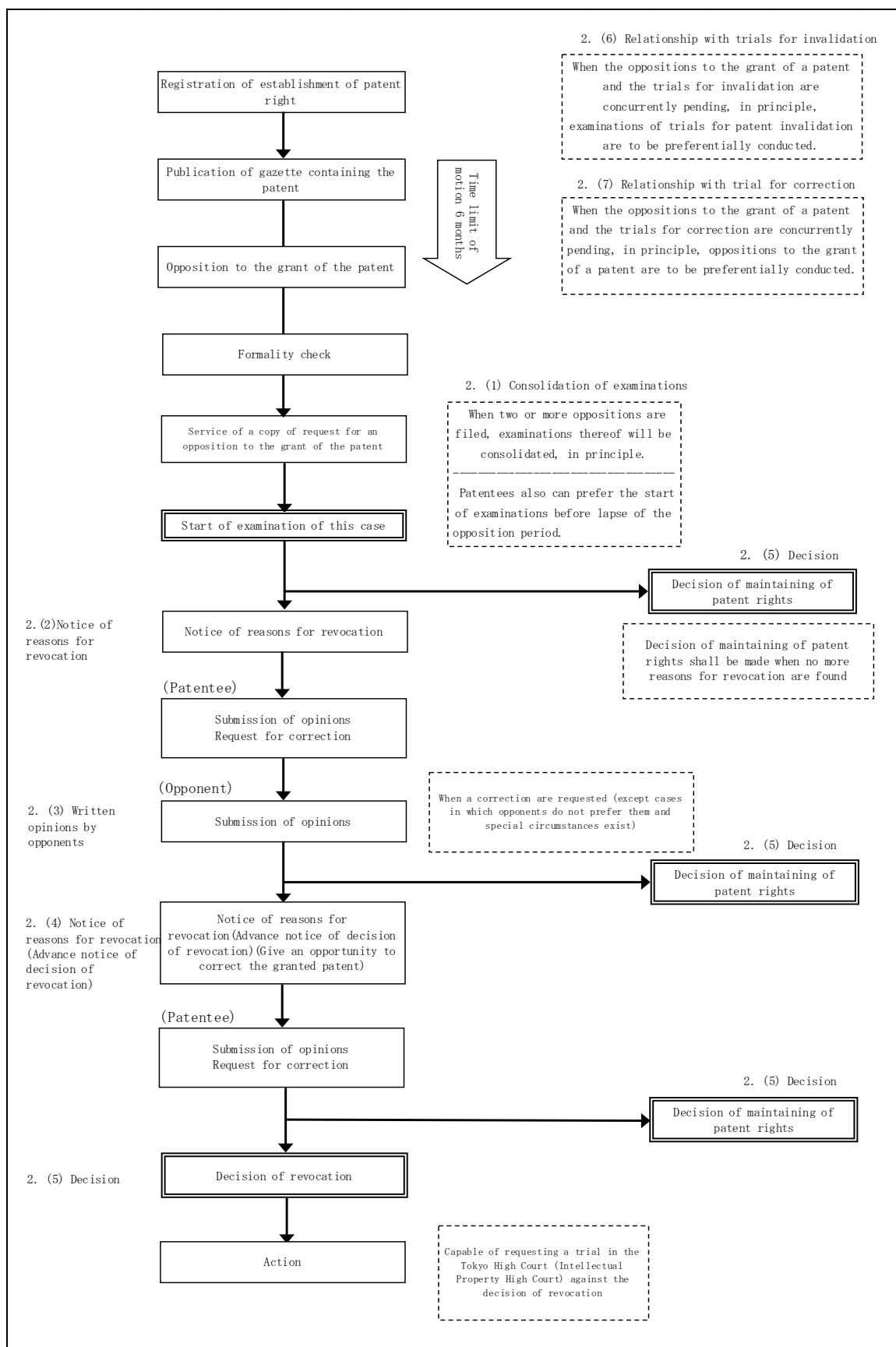
No revocation action shall be made against a decision of maintenance (the Patent Act Article 114(5)).

Click on the link below for more information on the system of opposition to grant of patent:

<Manual for Trial and Appeal Proceedings (17th edition) >

[https://www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/pdf/sinpan-binran\\_17/67\\_e.pdf](https://www.jpo.go.jp/torikumi_e/t_torikumi_e/pdf/sinpan-binran_17/67_e.pdf)

Procedure flow chart of the patent opposition system and a comparison table with the System of Trial for Invalidation are shown in the following pages:



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

### Comparison with the System of Trial for Invalidity

	System of Opposition to Grant of Patent	System of Trial for Invalidity
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	<p>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.</p> <p>An appeal against a decision to maintain or a decision to dismiss is not possible.</p>	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)