

Patent Invalidation and Opposition Systems in Japan

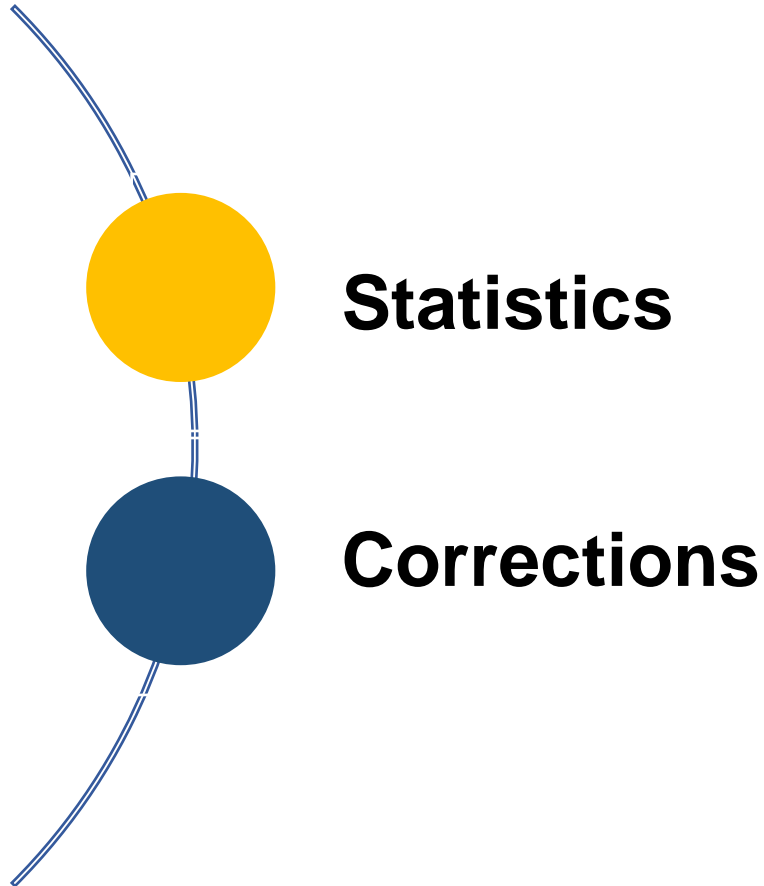
October 28, 2022

YASUDA Futoshi, Director-General

Trial and Appeal Department (TAD), Japan Patent Office (JPO)



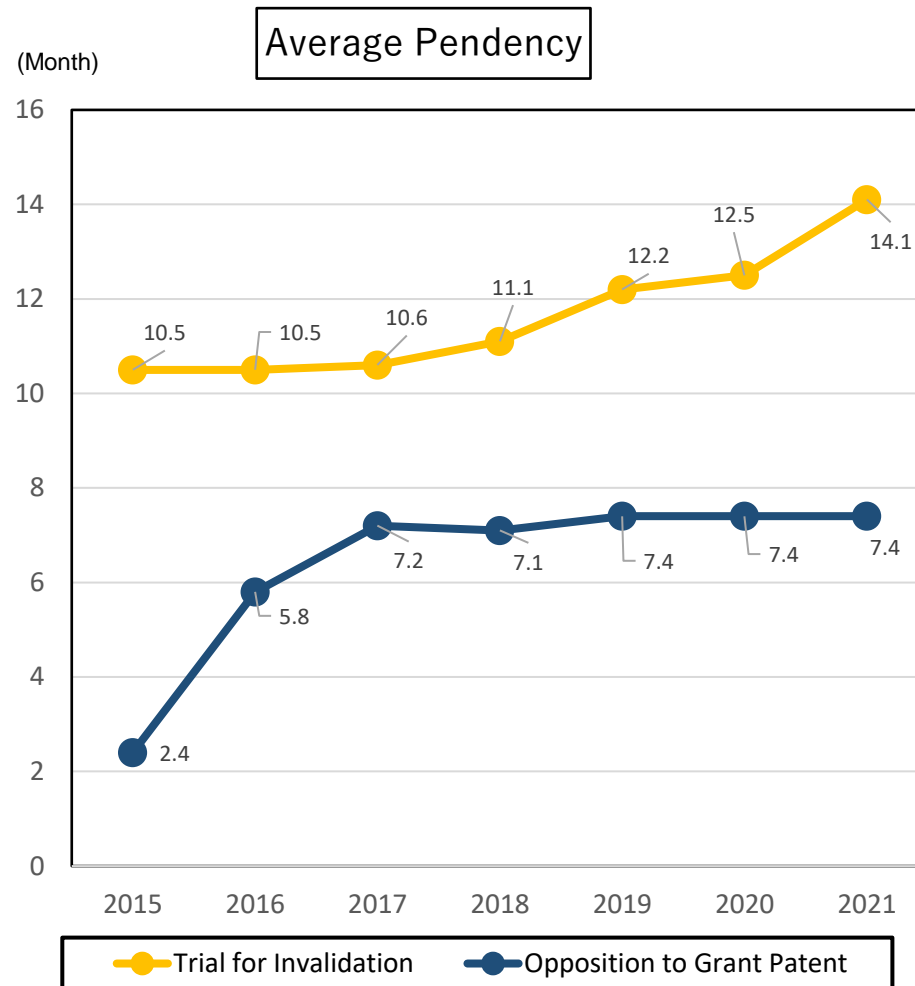
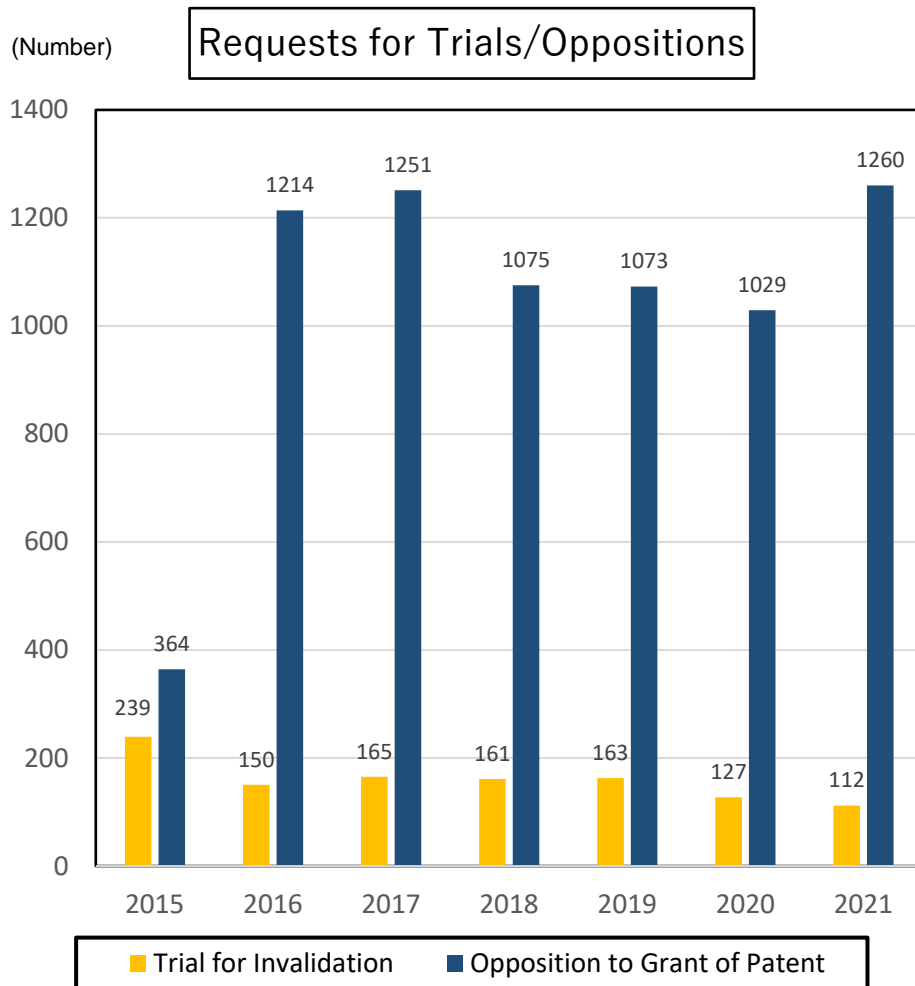
Patent Invalidation and Opposition Systems in Japan





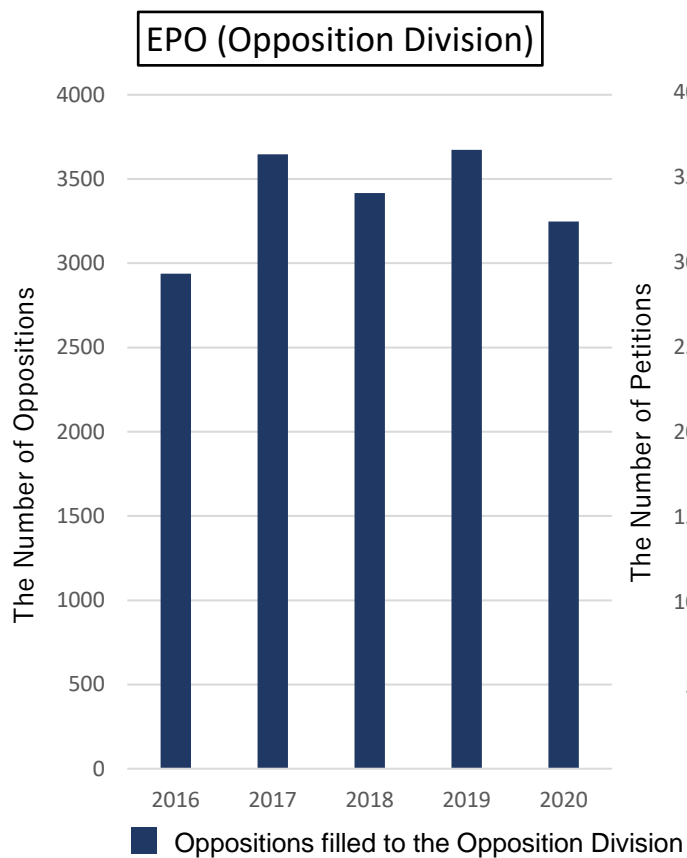
Statistics

Requests and Pendency in Japan

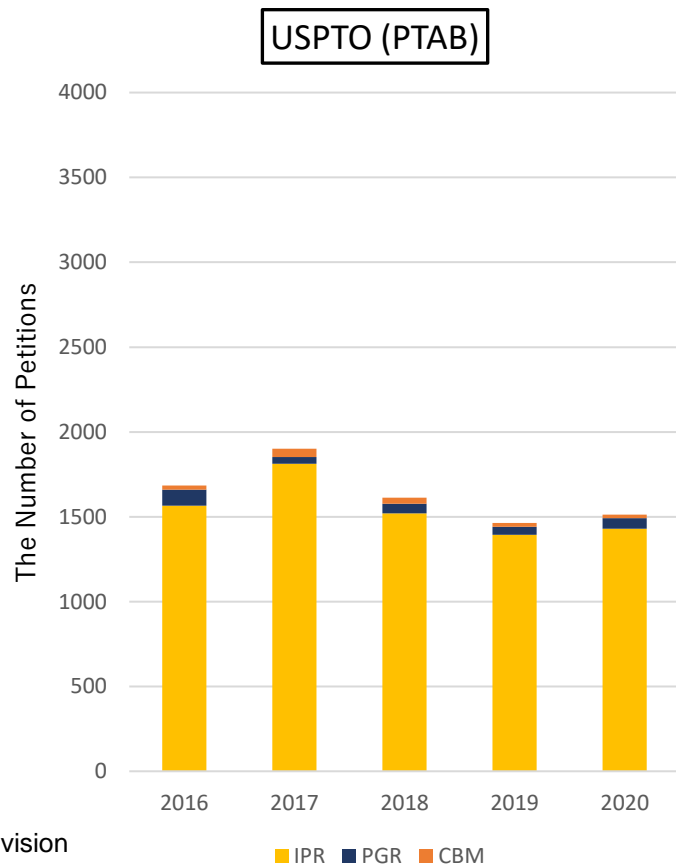


The number of “trial for invalidation” includes trials for patents and utility models (the same applies hereafter).

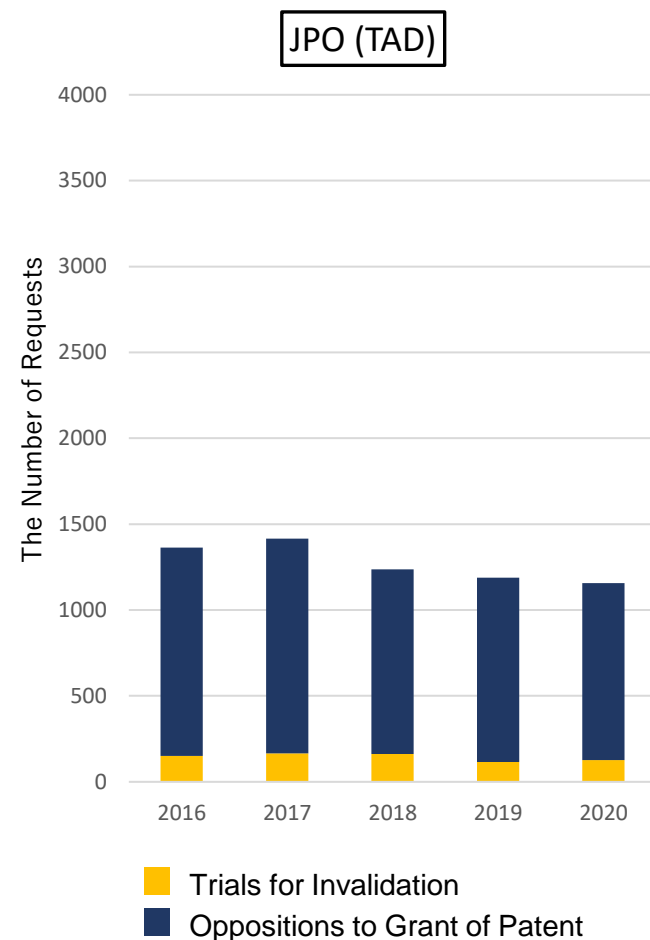
Requests in Europe / Japan / the United States



The Boards of Appeal (BoA) handle requests for appeals against decisions of the Opposition Division. The number of requests for appeals is approximately 1,500 to 2,000 each year.

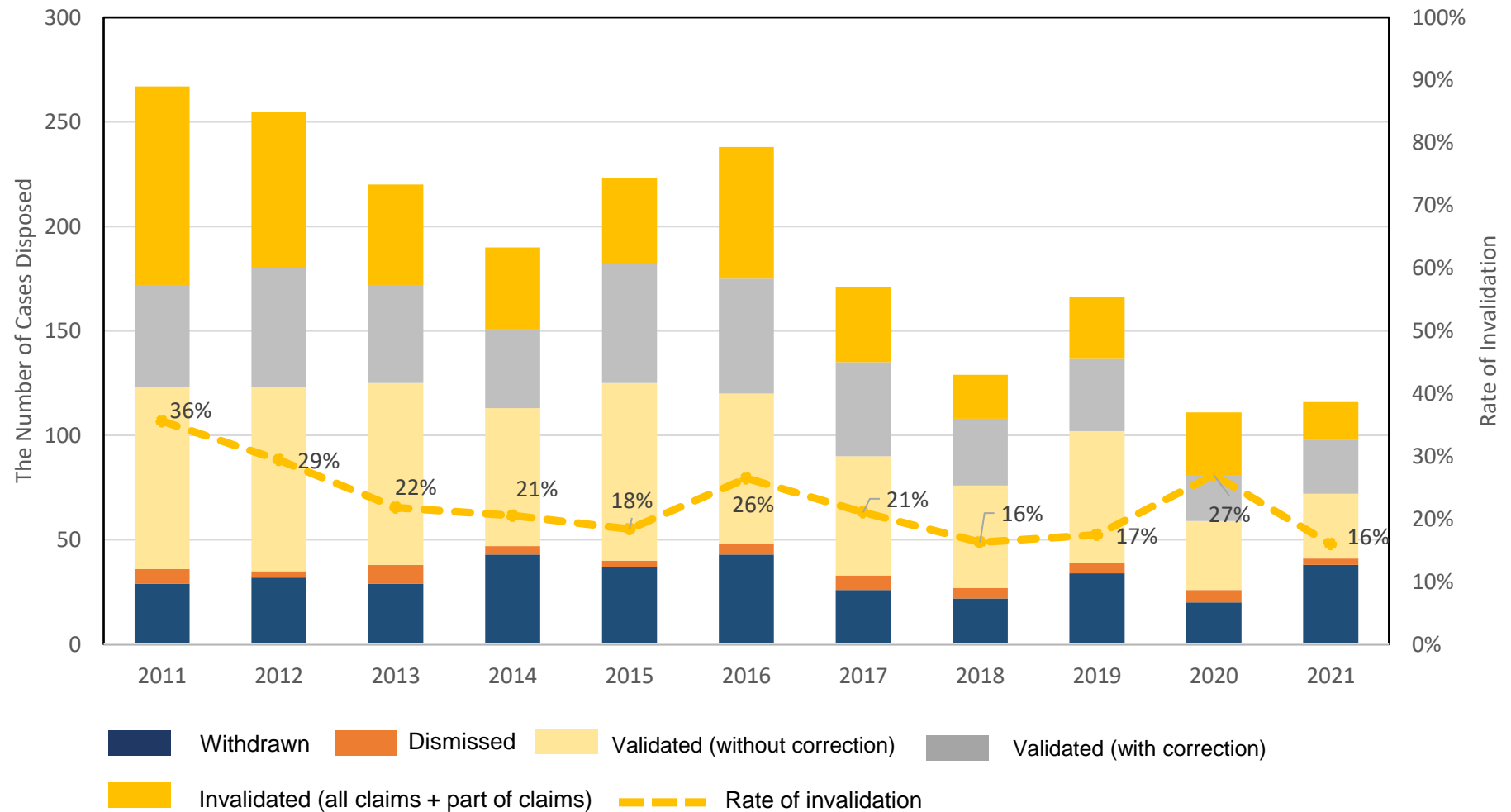


IPR (**I**nter **P**artes **R**eview)
 PGR (**P**ost **G**rant **R**eview)
 CBM (**C**overed **B**usiness **M**ethod)

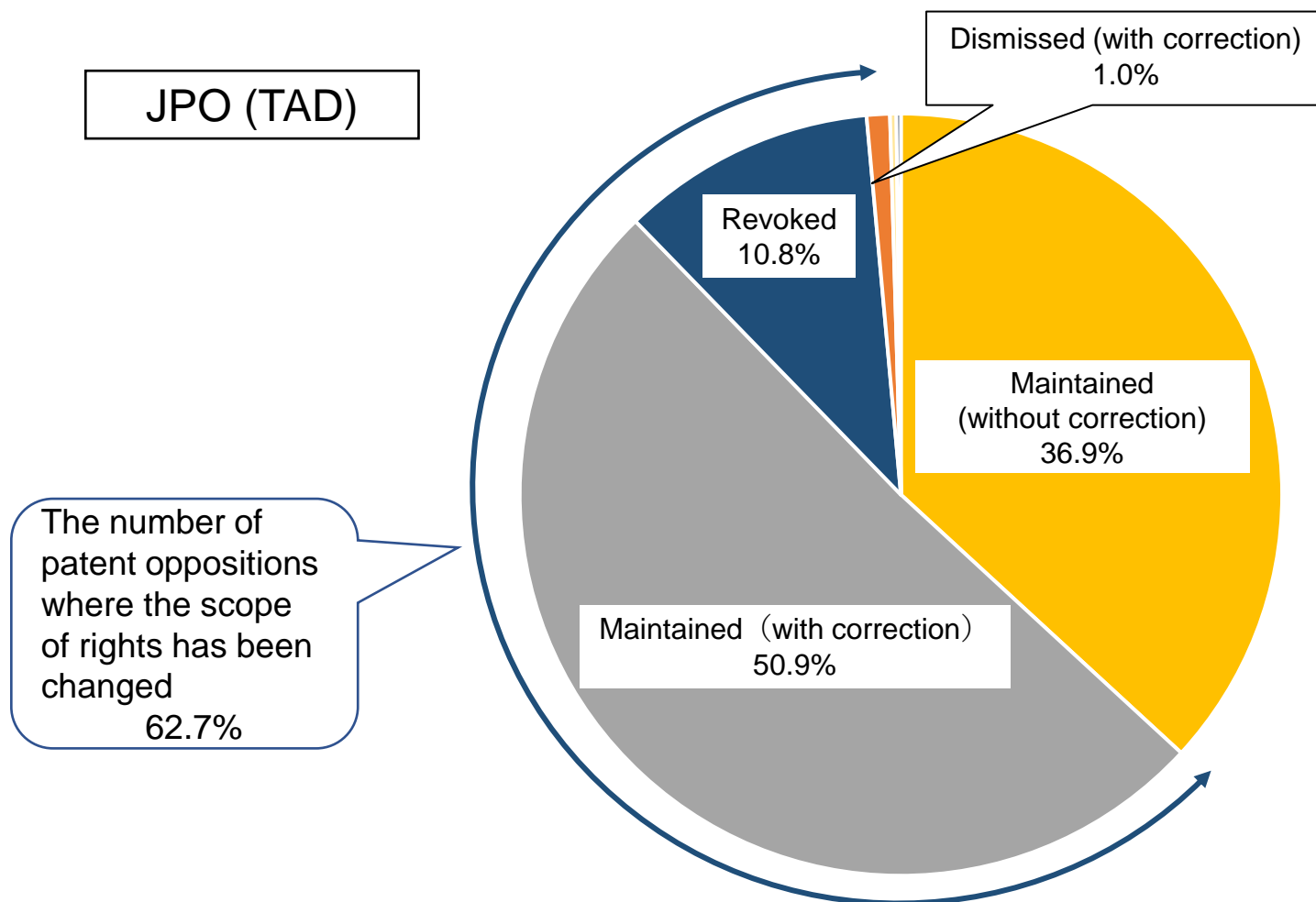


Source of EPO and USPTO information: EPO and USPTO websites

Trial for Invalidation – Results of Proceedings in Japan



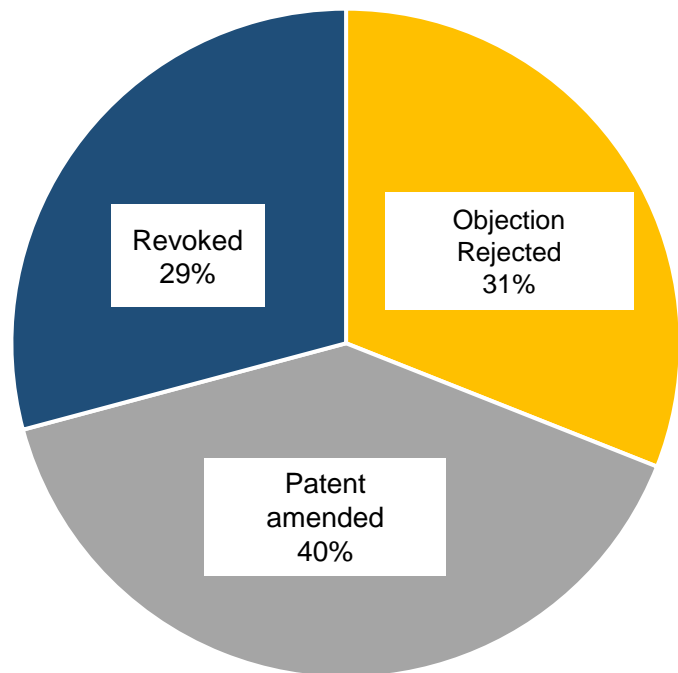
Opposition - Results of Proceedings in Japan



Results of Proceedings for Opposition from April 2015 to December 2021 (6,312 in total)

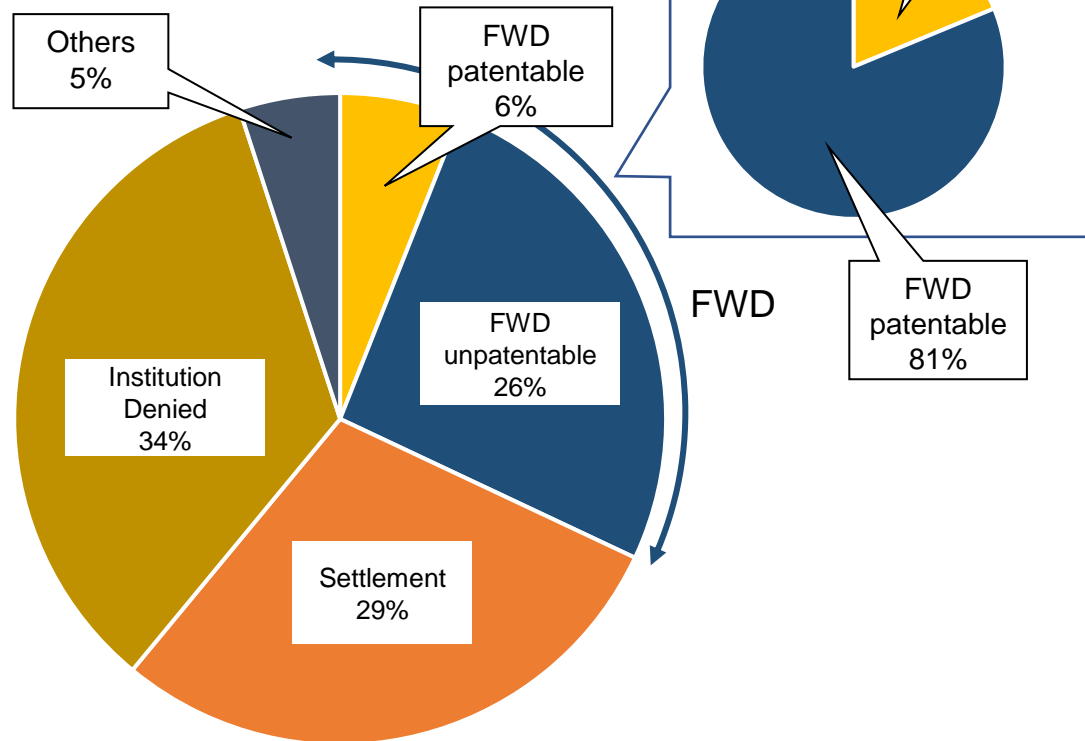
Results of Proceedings in Europe / the United States

EPO (Opposition Division)



Results of Proceedings for Opposition from 2018 to 2020 (10,336 cases in total)

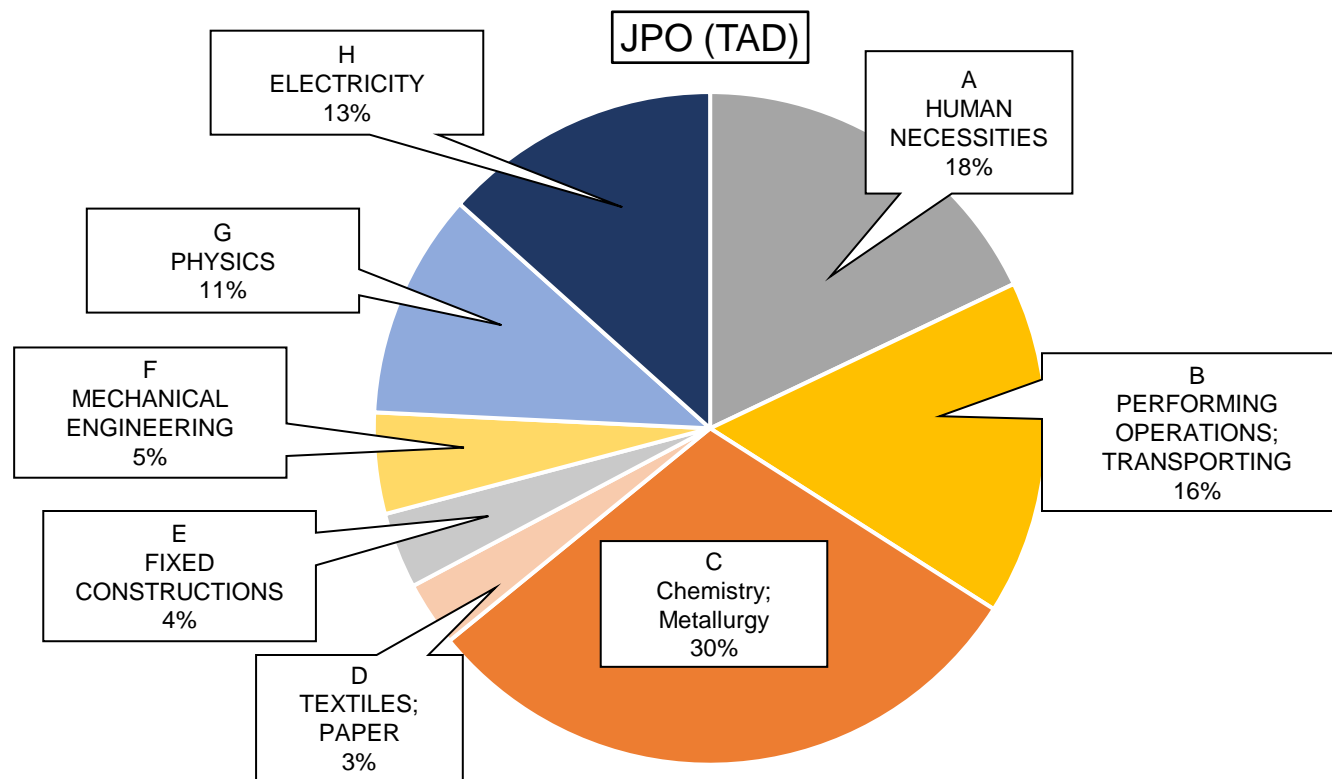
USPTO (PTAB)



Results of Outcomes by petitions for IPR, PGR, and CBM from 2019 to 2021 (4,462 petitions in total)

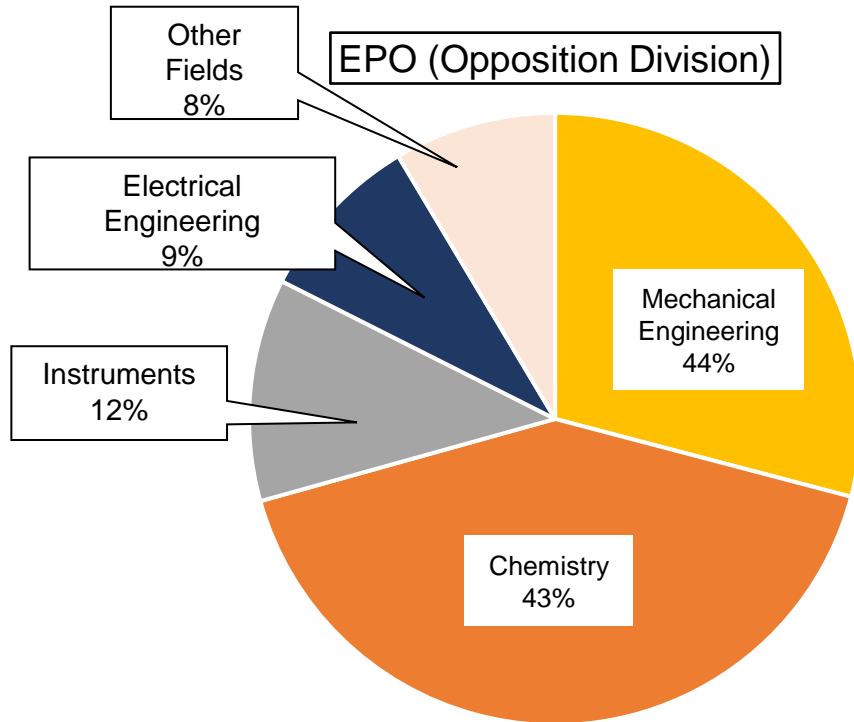
Source : EPO, USPTO websites

Requests for Opposition by IPC in Japan

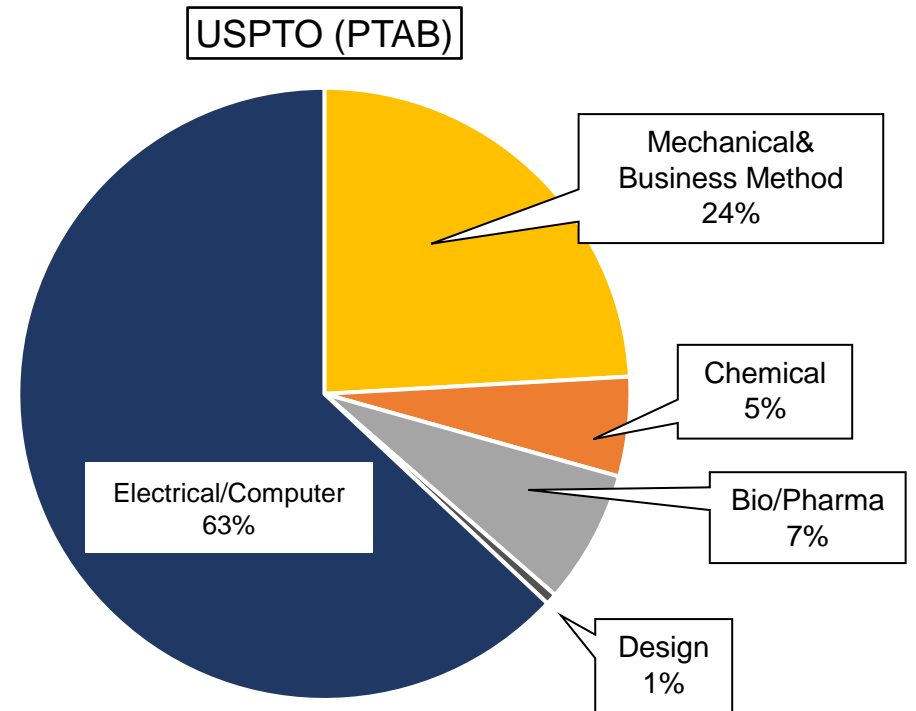


Section	A	B	C	D	E	F	G	H
Number of Requests	1132	1016	1899	197	231	307	686	844
Ratio of the number of patents registrations (%)	0.53	0.46	1.20	1.75	0.52	0.27	0.24	0.29

Rate of Requests in Europe / the United States by Technology



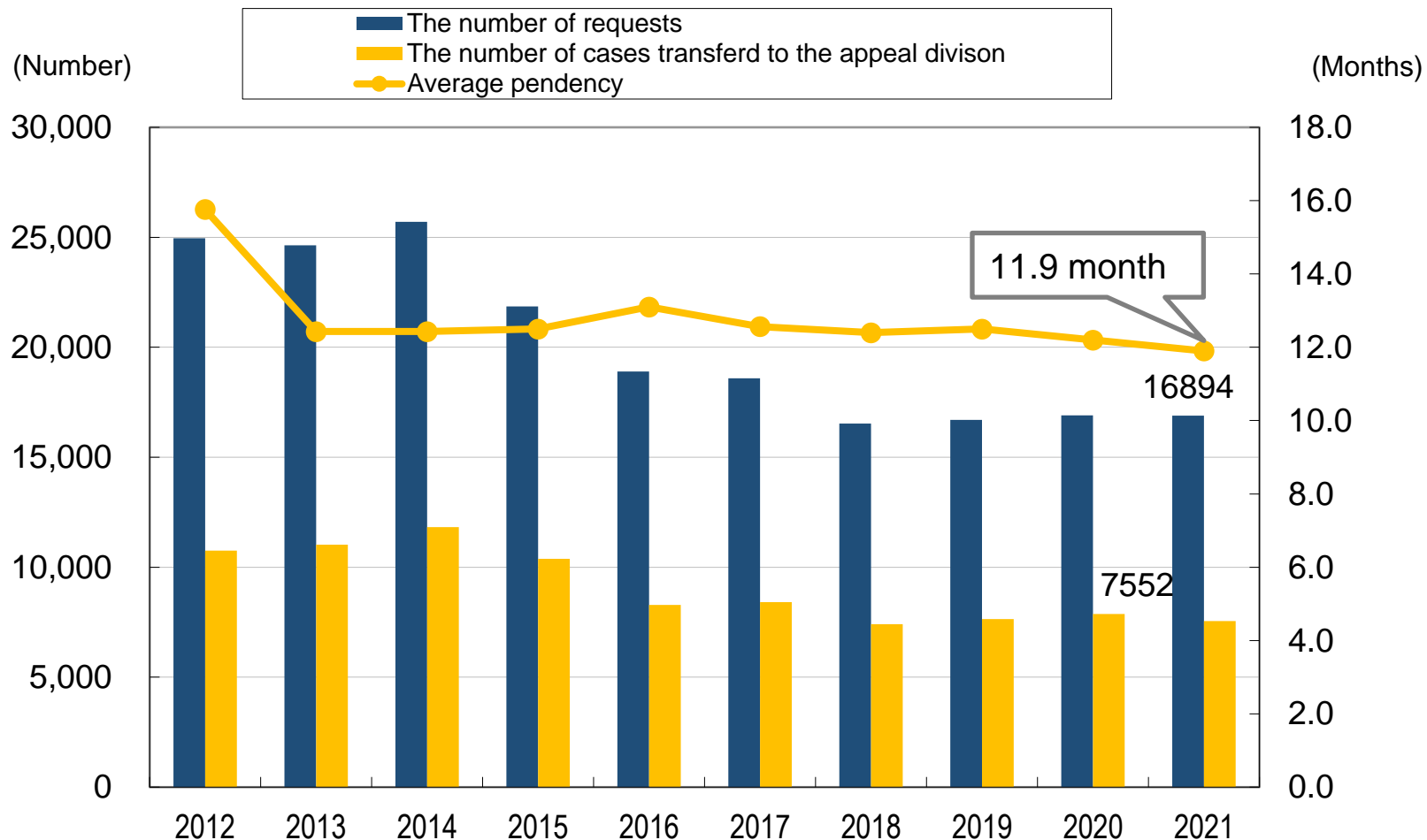
Rate of appeals for oppositions by technical fields
(2018-2020, 10,336 requests in total)



Rate of Petitions for IPR, PGR and CBM by technical fields
(2019-2021, 4,378 petitions in total)

Source : EPO, USPTO websites

Appeal against Examiner's Decision of Refusal in Japan - Requests and Pendency



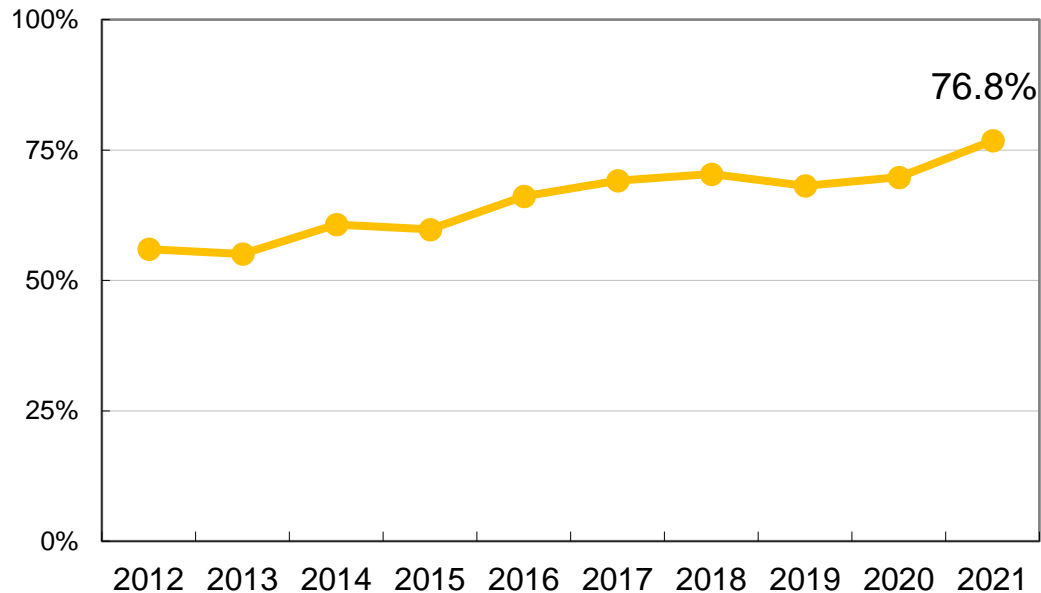
The number of cases transferred to the appeal division means cases transferred to the boards after reconsideration.

Appeal against Examiner's Decision of Refusal in Japan

- Rate of Requests Granted

- The rate of requests granted (the percentage of examiner's decisions of refusal reversed) for patents has been gradually increasing in recent years (76.8% in 2021).

Rate of Requests Granted (Patent)



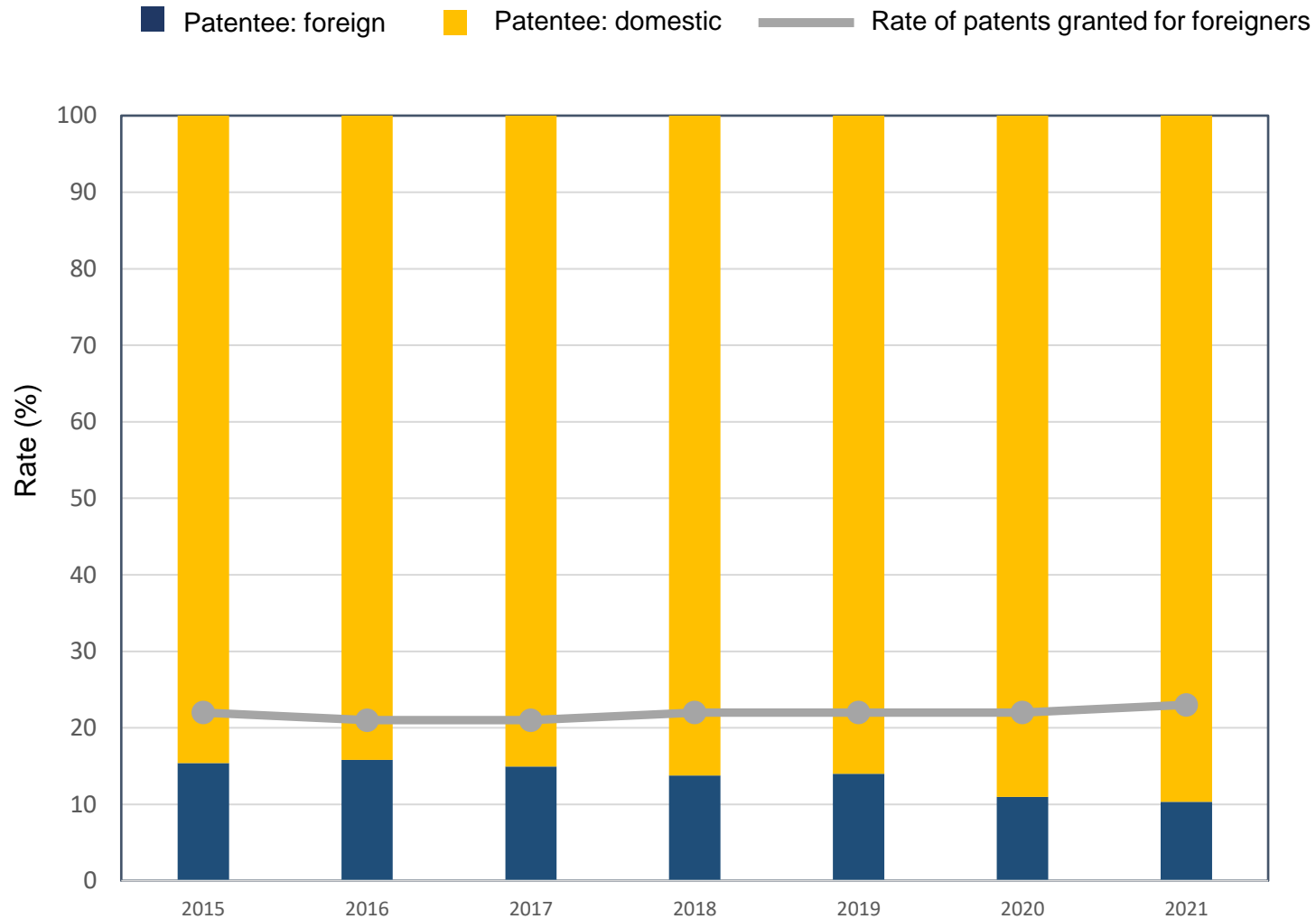
Rate of requests granted by technical fields (Patent)

Technical Field	Rate (2021)
Physics/Others	68.3%
Mechanics	79.3%
Chemistry	80.1%
Electronics	78.7%
All	76.8%

Rate of requests granted = Number of requests granted / (number of requests granted + number of requests not granted)

"Number of requests granted" does not include the number of "decisions to grant a patent upon reconsideration by examiners."

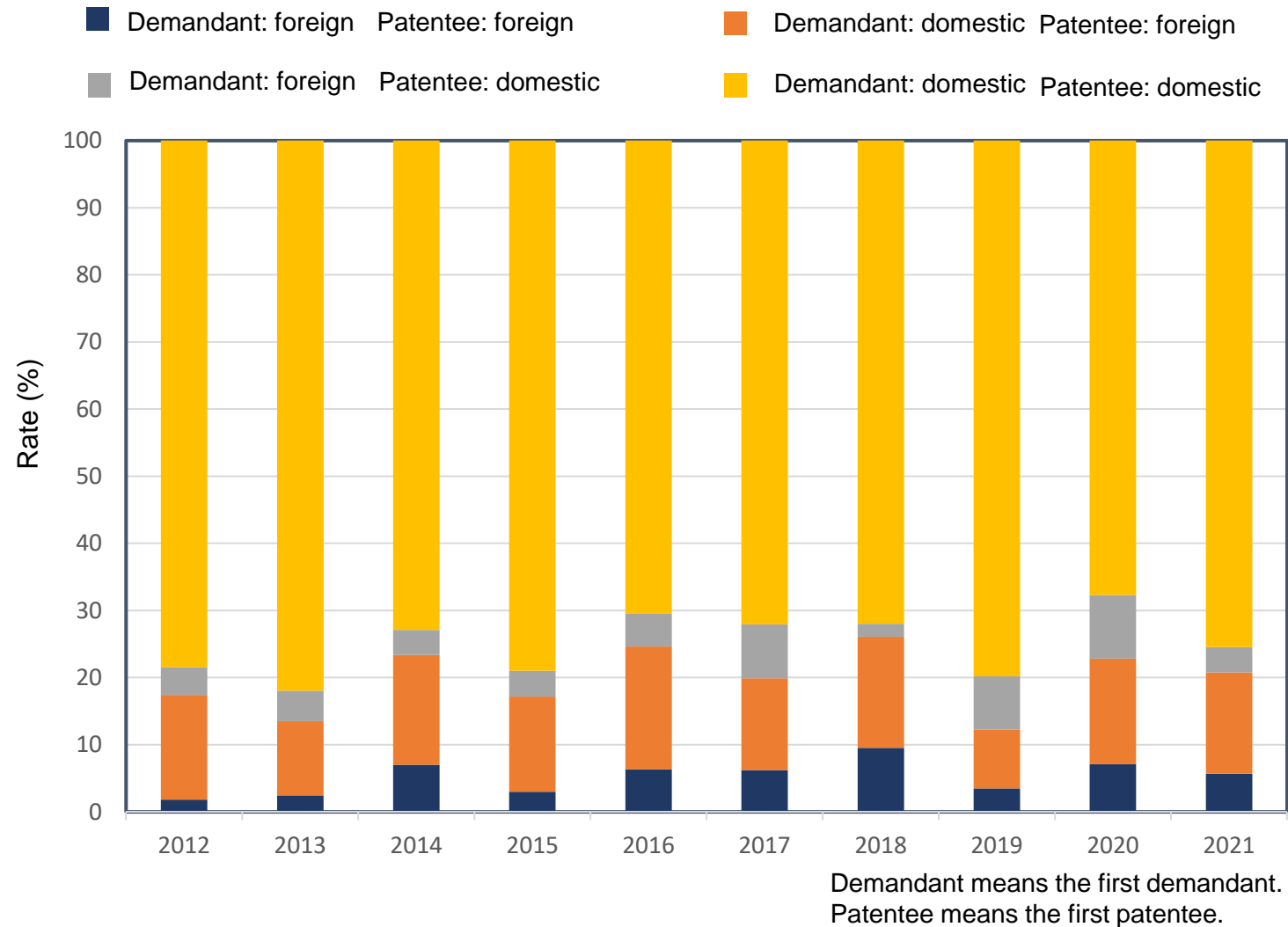
Opposition to Grant of Patent in Japan - Patentees by Nationality



Patentee means the first patentee.

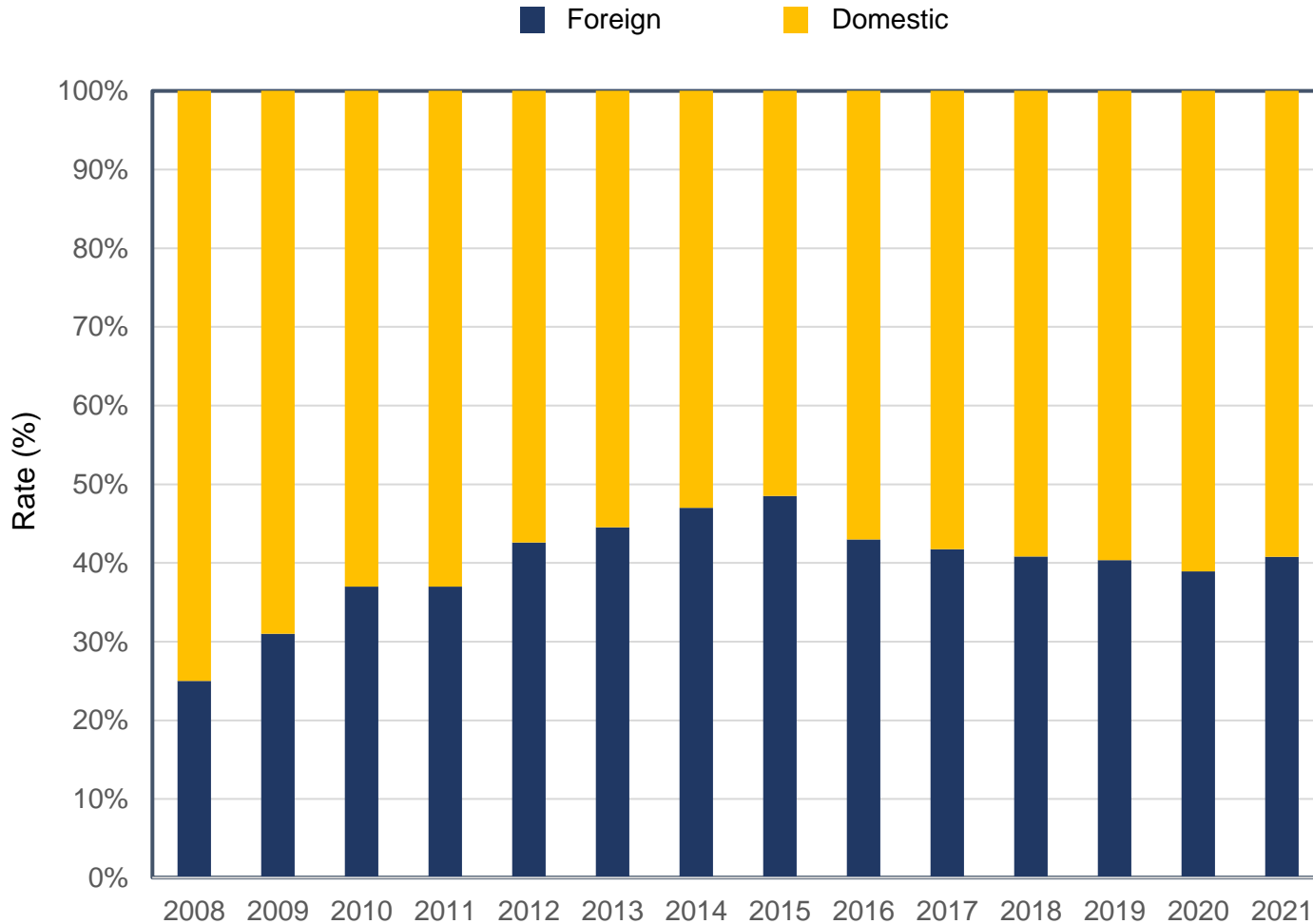
Trial for invalidation in Japan

- Demandants and Patentees by Nationality



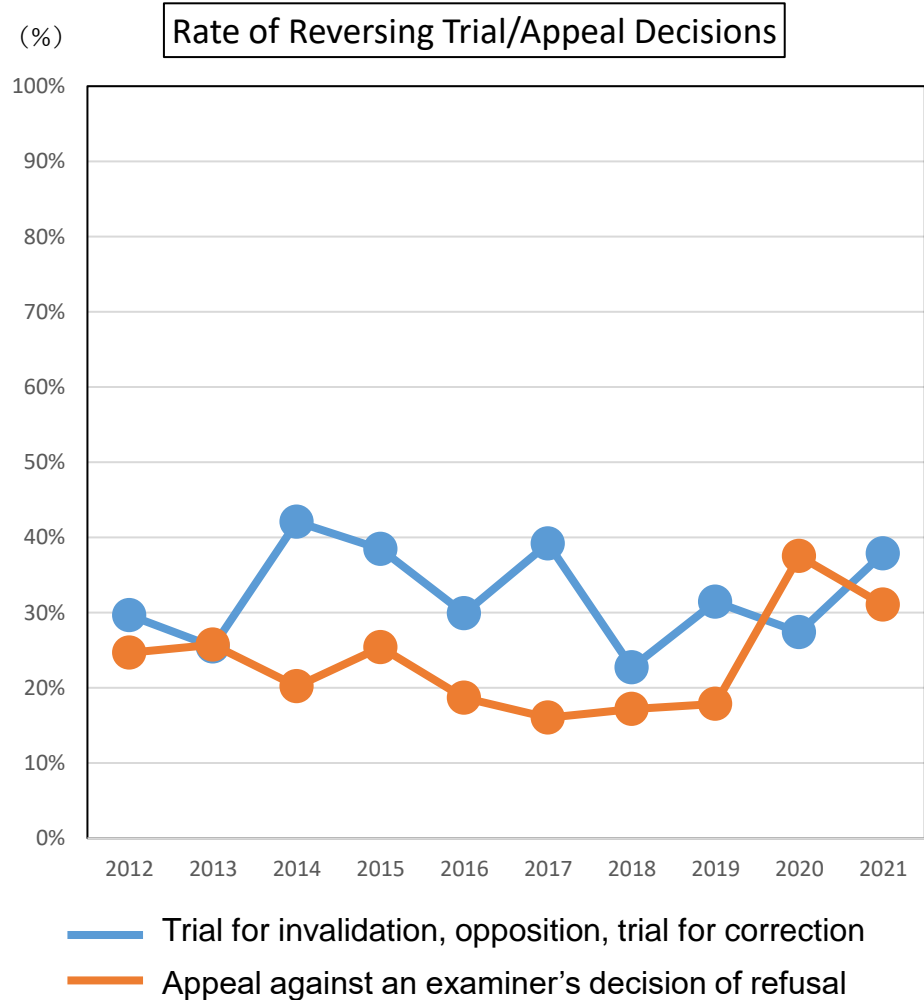
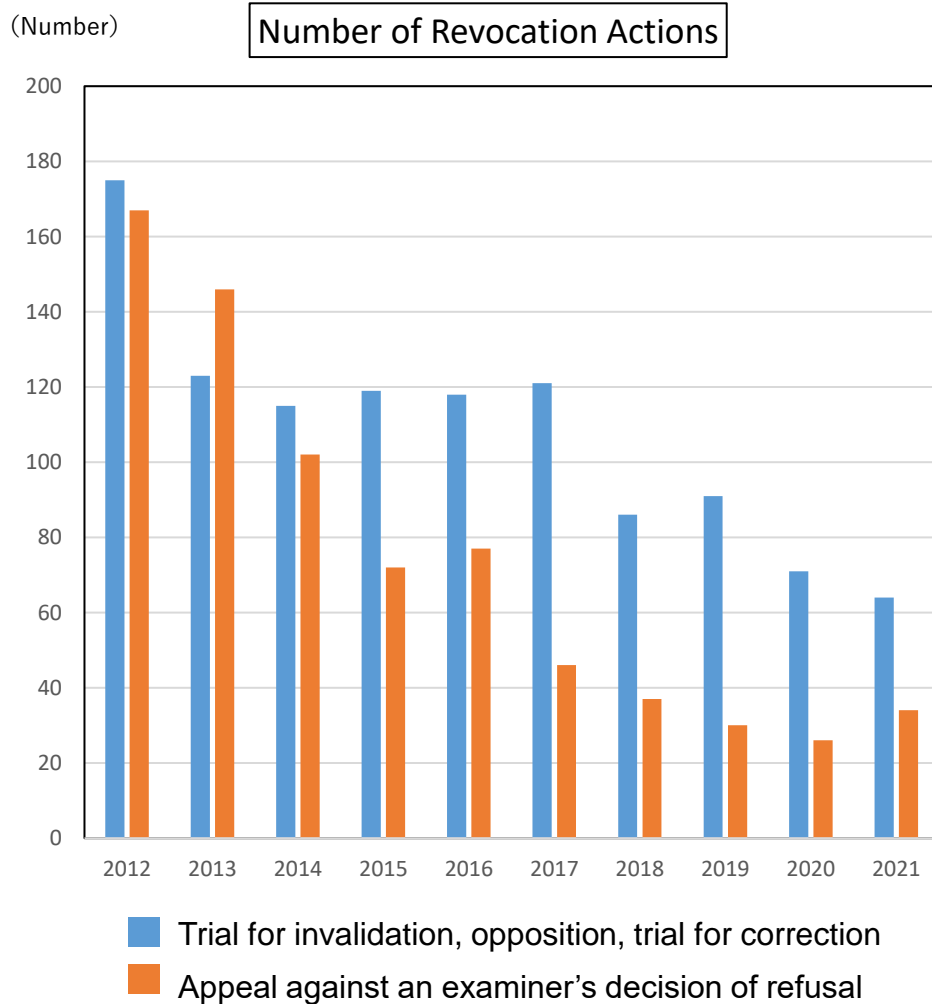
Appeal against Examiner's Decision of Refusal in Japan

- Demandants by Nationality



Demandant means the first demandant.

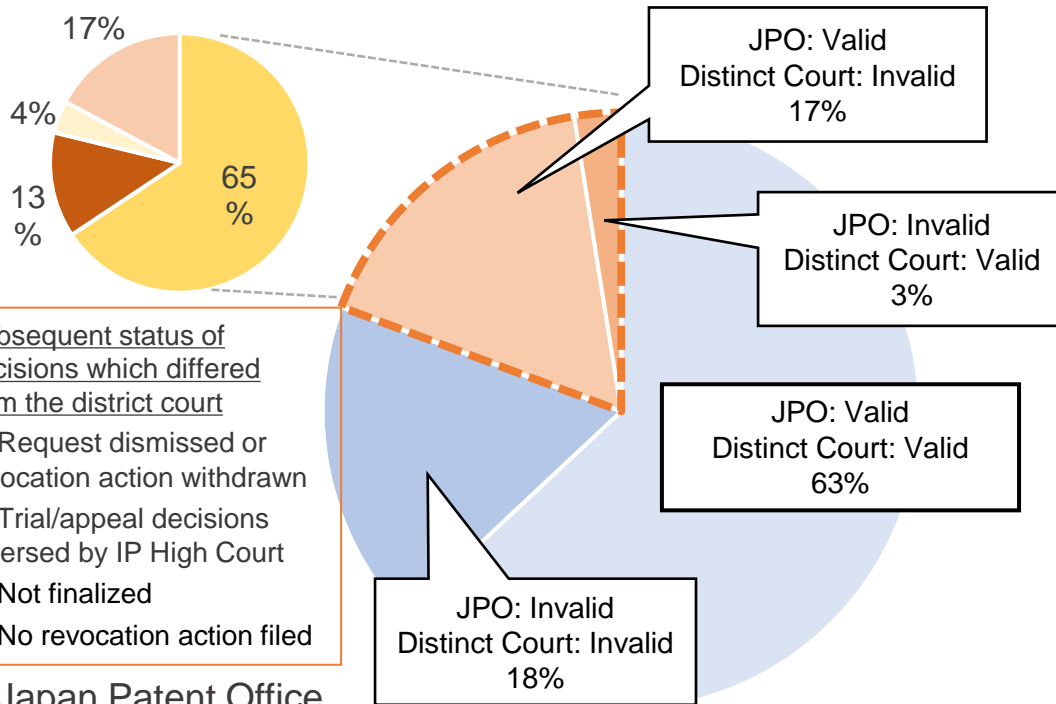
Revocation Actions against Trial/Appeal Decisions in Japan



Analysis: Double Track Proceedings in Japan (2016-2020)

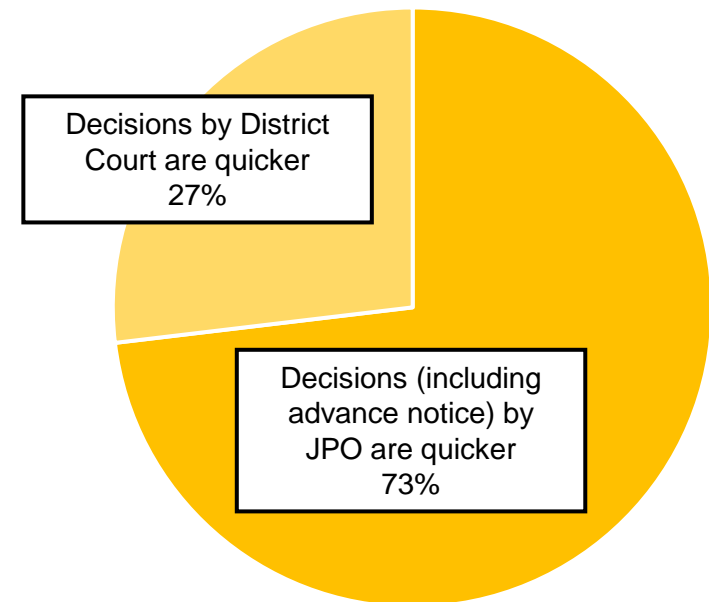
- Concordance rate of determinations on validity/invalidity between conclusions of JPO trial decisions (trials for invalidation) and distinct court decisions (infringement lawsuits): 81%
- Of the cases where the trial decision and the district court decision differed, the rate of trial decisions reversed by the IP High Court: 13%.

Concordance rate of determination on validity/invalidity



Japan Patent Office

Order of determinations by JPO and distinct court





Corrections

Requirements for Correction in Japan

- The patentee (defender) can file a request for correction for the purpose of avoiding reasons for invalidation.
- When filing a request for correction, it is necessary to satisfy “Requirements for Correction.”

<Requirements for Correction>

(1) Purpose

- a. Restriction of claims
- b. Correction of errors or mistranslations
- c. Clarification of an ambiguous description
- d. Dissolving citation relation between claims

(2) Prohibition of addition of new matters

(3) No substantial broadening or modification of claims

Of the recent 85 IP High Court decisions in which “addition of new matters” is determined, approximately 75% determined that corrections did not fall within “new matters” (“Patent” 2022 Vol. 75 No.9).

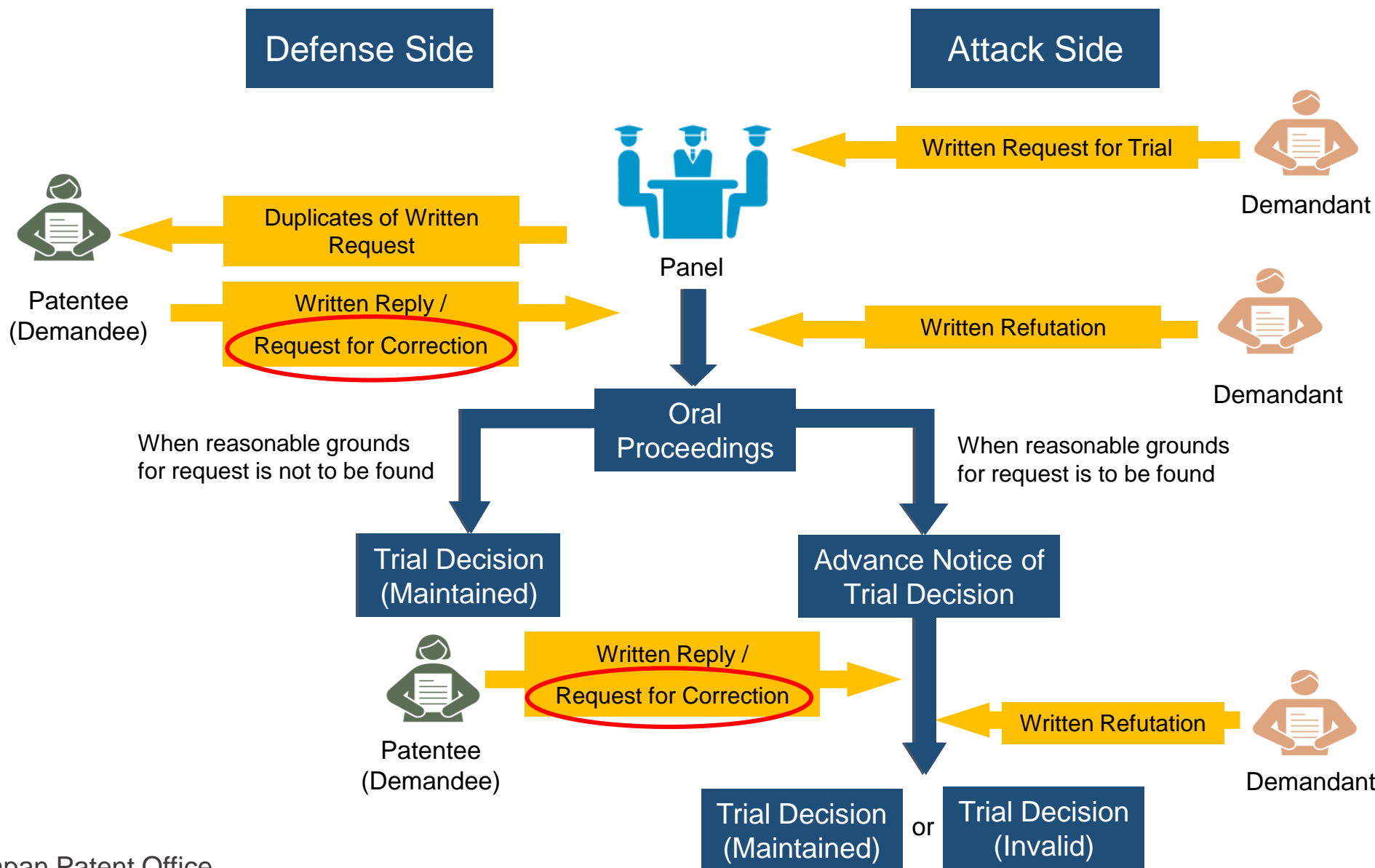
Note:

Requirements are basically the same as above in opposition and trial for correction.

(If the corrected invention is not patentable, the patentee receives a notice to that effect (e.g. reasons for rejecting a request for correction or reasons for revocation, depending on the type of trial).)

We will discuss later using hypothetical cases how to determine addition of new matters during the trial proceedings.

Timing of Corrections in Trial for Invalidation Proceedings in Japan



Comparison of Corrections/Amendments (1)

	JPO	USPTO	EPO
Substantive requirements	<ul style="list-style-type: none"> - Purpose (Restriction of claims/ Correction of errors/ Clarification of an ambiguous description / Dissolving citation relation between claims) - Prohibition of addition of new matters - No substantial broadening or modification <p>(PA § 134-2 (1), (9)→ § 126 (5), (6))</p>	<ul style="list-style-type: none"> - Responding to a ground of unpatentability - No enlargement of claims - Prohibition of addition of new matters <p>(35 USC § 316 (d) (3), 37 CFR § 42.121 (a) (2), (b))</p>	<ul style="list-style-type: none"> - Occasioned by a ground for opposition (even if not invoked by the opponent) - Prohibition of addition of matter extending beyond the content of the application as filed - No enlargement of scope of protection of granted claims <p>(R. 80 EPC, Art. 123 EPC)</p>

Comparison of Corrections/Amendments (2)

	JPO	USPTO	EPO
Time limit for corrections/ amendments	Designated time limit in multiple timing (PA § 134-2 (1))	Three (3) months after the proceedings begin	As the appeal proceedings progress, the possibilities to amend the patent become increasingly limited ("convergent approach") (i) with statement of grounds of appeal and reply; (ii) after this moment but before notification of the summons to oral proceedings (or before expiry of a period specified in a communication of the board under R. 100(2) EPC); (iii) after this point in time. (Art. 12, 13 RPBA)
The number of times of corrections/ amendments	More than once, or more than twice if a patent right is to be revoked (an earlier request for correction shall be deemed withdrawn) (PA § 134-2 (1), (6))	Once in principle (35 USC § 316 (d) (1), (2), 37 CFR § 42.121 (c))	Any amendment to a party's case may be considered at the Board's discretion, however at the last stage of the proceedings only if there are exceptional circumstances (Art. 12, 13 RPBA)

Comparison of Corrections/Amendments (3)

	JPO	USPTO	EPO
Auxiliary requests*	NO	NO	Yes (both a main request and auxiliary requests for amendment may be filed, while the order of these requests shall be set)
Relationship between permission of correction/amendment and conclusion of decision	Permission of correction and conclusion of decision to maintain or invalidate a patent are independent. (A trial decision to invalidate a patent may be made to corrected claims after permissible correction.)	No amendment shall be permitted if a trial decision is the one that is to invalidate a patent	No amendment shall be permitted if a trial decision is the one that is to invalidate a patent

* Patentee can submit the first choice of claims as a main request and the second and subsequent claims as auxiliary requests to amend his/her claims.

Thank you

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