

# Recent Trends in Trial and Appeal Measures in Japan

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October 28, 2022

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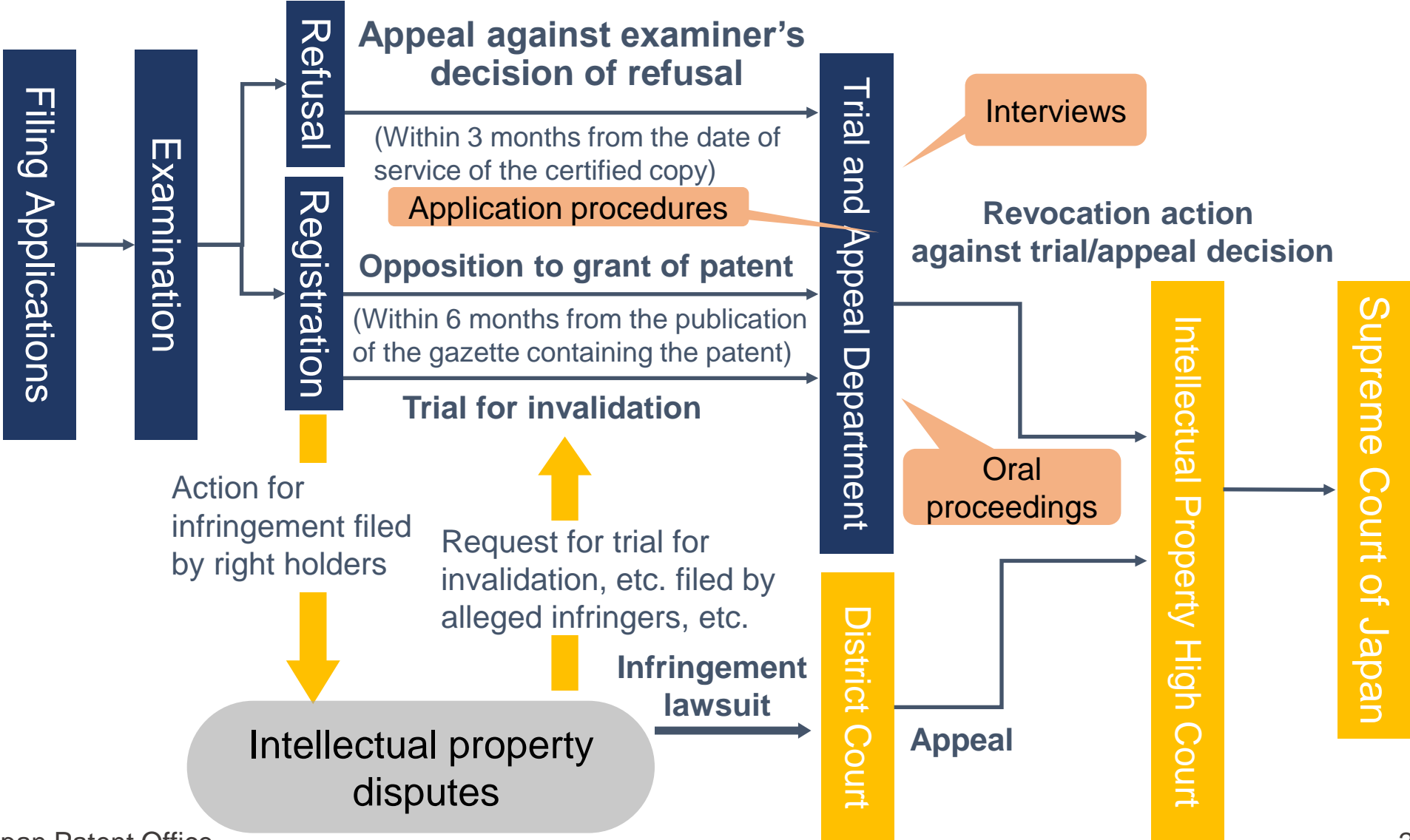


# Recent Topics at the Trial and Appeal Boards

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# Patent Examination and Trial and Appeal Procedures





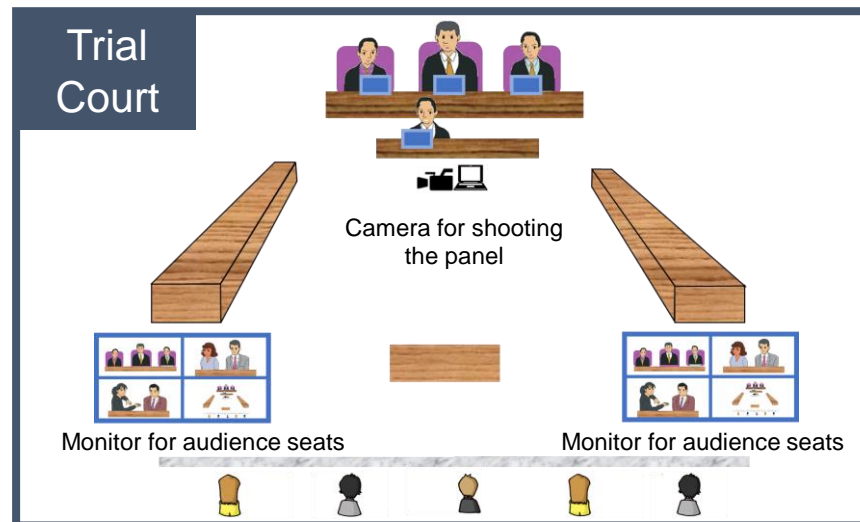
**Promotion of Online Procedures and  
Digitization**

# Online Oral Proceedings (1)

- The Patent Act, and other acts were amended to allow oral proceedings to be conducted without being affected by COVID-19 infection, and to allow parties, etc. residing in a remote area to participate in oral proceedings without having to appear before the trial court (effective October 2021).
- Parties, etc. can now participate in oral proceedings using a web conference system (online oral proceedings). Chief administrative judge may also allow video transmission (online distribution) to the parties and other interested parties, subject to the consent of all parties and other interested parties.



Demandants: remote participation (demandant's corporate meeting room).



Demandees: remote participation (demandee's corporate meeting room).

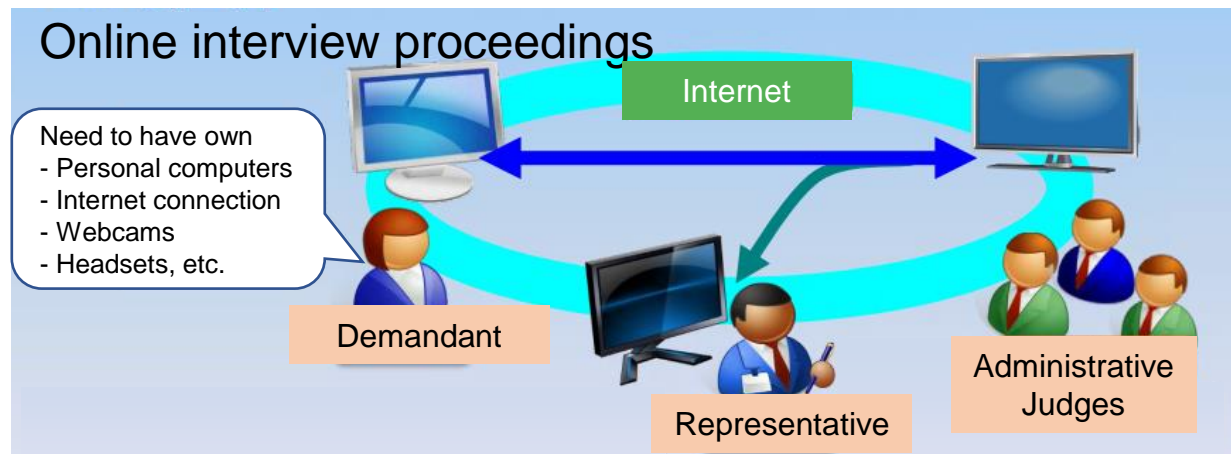
## Online Oral Proceedings (2)

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- From the start of operation in October 2021 to the end of August 2022, the overall number of oral proceedings is 82, of which 58 were online oral proceedings (71% of the total).
- Online appearances are allowed up to 4 persons per party and up to 3 calling locations per party. Online distribution is allowed up to 2 locations per party (2 to 3 persons per location).
  - Note: Recipients of online distribution will not be permitted to speak during the oral proceedings, unlike parties who participate online.
- With the introduction of 4K cameras for shooting the panel, etc. and the installation of a new dedicated high-speed Internet connection, stable online oral proceedings have been conducted without any particular problems.

# Online Interviews

- At the trial and appeal proceedings, opportunities for interviews can be used to facilitate close communication between demandants, etc. and administrative judges and to help the proceedings.
- Online interview proceedings using a web application can be conducted. Demandants, etc. can participate in the interview from his/her own PC and communicate with the administrative judges.
- Documents may be transmitted via e-mail.



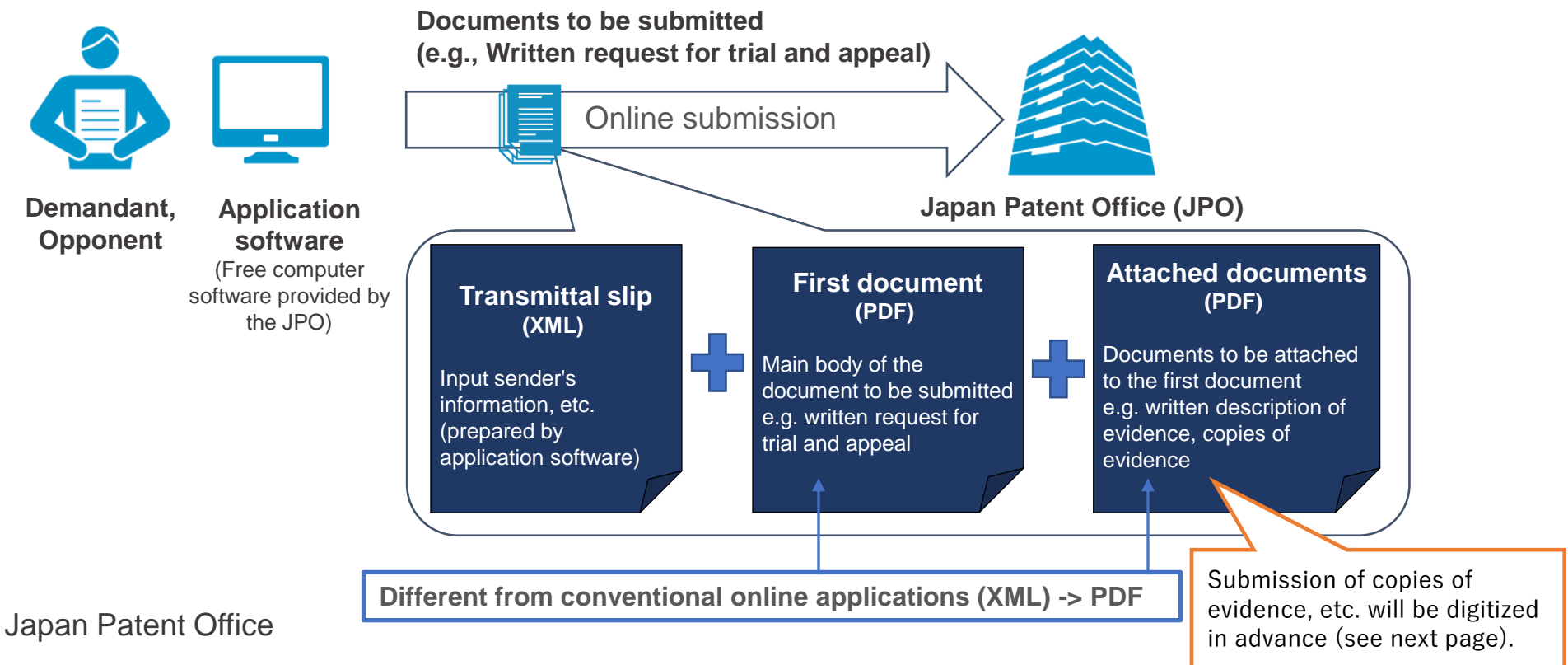
For details of online interview proceedings (Japanese):

[https://www.jpo.go.jp/system/trial\\_appeal/general-mensetsu/online-mensetsu.html](https://www.jpo.go.jp/system/trial_appeal/general-mensetsu/online-mensetsu.html)



# Digitization of Application Procedures (1)

- Some documents in trial and appeal cases cannot currently be submitted to the JPO online (e.g., submission of documents in trials for invalidation and oppositions).
- It is expected that the submission can be made in the form of a transmittal slip and PDF by the end of FY2023.



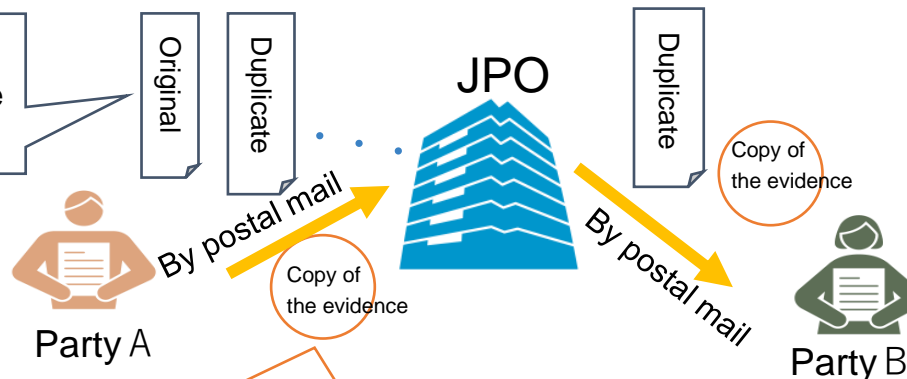


## Digitization of Application Procedures (2)

- **Submission of copies of evidence, etc. will be digitized before the other documents (the Ministerial Ordinance will be revised to allow submission of evidence in DVD-R format from November 1, 2022 (no need to submit multiple copies)).**
- Currently, a copy of the evidence must be attached to each original and duplicate of the written request for trial and appeal, etc., and all must be submitted in writing. However, the number of pages of copies of evidence tends to be large, placing a heavy burden on the demandants. (The JPO also took on the burden of checking the identity of the original and duplicate copies of evidence.)
- Documents shall also be sent to the other party (party B) in DVD-R format. It is also possible to continue submitting the documents in writing (submit to the JPO plus the number of opposing parties).

Procedures for submitting written requests for trial for invalidation, written request for opposition and written reply, etc.

It is expected that the online submission will be available for all documents by the end of FY2023 (see previous page).




Submissions will be available in DVD-R format from November 2022 onward.

# Promotion of Digitization

## (Cooperation from the Public is Solicited in Provision of Electronic Data of Paper Documents)

- For the purpose of streamlining trial and appeal decision writing and proceedings, the Trial and Appeal Department (TAD) of the JPO asks cooperation from the public for providing electronic data of paper documents for inter-partes trial cases.

 特許庁 JAPAN PATENT OFFICE		Form for providing electronic data of trial and appeal paper documents	
<p>審決の作成及び審理の効率化のため、無効審判、異議申立て、取消審判、判定、訂正審判について、<a href="#">所定の紙原本書面</a>の特許庁に提出した際には、当フォームから、提出した紙原本書面の電子データを提供いただきますよう、よろしくお願いいたします。</p> <p>なお、電子データをご提供いただく際は、下記の点にご留意ください。</p> <ul style="list-style-type: none"><li>● ご提供いただいた電子データは原本として扱われません。電子データを提供いただいた場合でも、紙原本書面は、副本を含め、省略することなくご提出ください。</li><li>● ご提供いただいた電子データは、閲覧に供されることはありません。</li></ul> <p>ご不明な点がある場合には、<a href="#">Q &amp; A集</a>をご覧ください。特許庁審判企画室（電話：03-3581-1101、内線：5851）へお問い合わせください。</p>			
審判種別 <b>[必須]</b>	<input type="text"/>	▼	(選択してください)
審判事件番号 <b>[必須]</b>	<input type="text"/> (半角数字で入力してください。例：2099800001)		





# **Review of Systems and Relaxation of Requirements**

# Review of Requirement for Consent of Non-exclusive Licensees in Trial for Correction, etc.

- Procedures for which the consent of the non-exclusive licensees will be no longer required on or after April 1, 2022:
  - ✓ Request for a trial for correction (patents / utility models)
  - ✓ Request for correction made in a trial for patent invalidation or opposition to grant of patent (patents)
  - ✓ Correction of utility models (utility models)
  - ✓ Abandonment of patent rights, utility model rights or design rights (patents / utility models / designs)

Even in cases where patent rights are aggregated (pooled) among multiple patent holders (patent pool) and there are many non-exclusive licensees, it is expected that it will be easier to correct such patent rights.

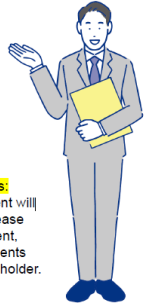
Note 1: If you wish to continue to give your consent, a license agreement may be reviewed.


Note 2: The consent of the holders of exclusive right to use, pledgees and holders of non-exclusive right to use (trademarks) will be still required to abandon trademark rights.

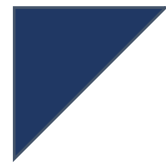
Effective April 1, 2022,  
the consent of the non-exclusive  
licensees will be no longer  
required for corrections or  
abandonment of patent rights, etc.

**For holders of rights:**  
The burden of submitting  
a written consent of the  
non-exclusive licensees in  
the correction or  
abandonment procedures  
will be reduced.

**For non-exclusive licensees:**  
If you hope that your consent will  
continue to be required, please  
review the license agreement,  
etc., so that prior arrangements  
can be made with the right holder.



 特許庁



## **Dissemination to Users and International Cooperation**

# Trial and Appeal Practitioner Study Group

- Established in FY2006.
- To share the understanding of trial/appeal practice with users of the trial/appeal system by analyzing actual trial/appeal decisions and court decisions, improving future trial/appeal proceedings based on the analysis results, and widely disseminating the results of the analysis.
- Other than IP experts, patent attorneys, attorneys, and the JPO's administrative judges, judges of the IP High Court and the Tokyo District Court have also participated in the Study Group as observers.
- In FY2021, the Study Group studied a total of 12 cases: 8 patent cases, 2 design cases, and 2 trademark cases. It also published a report that compiles the findings of the studies.

## Some of the topics and points at issues in the field of patents (FY2021)

(Field: Patent - Machinery)

- How should a determination be made of whether an amendment or correction introduces any new technical matter?

(Issue 1) In the case of an amendment or correction for further generalizing or abstracting the invention so as to encompass any constitution that is not explicitly stated in the description.

(Issue 2) In the case of an amendment or correction for adding any matter specifying the invention that is not explicitly stated in the description.

(Field: Patent - Chemistry)

(Issue 1) How should the unexpected advantageous effect be determined in determining inventive step?

(Issue 2) How should parties allege and prove such unexpected advantageous effect?

(Field: Patent - Electricity)

How should the presence of eligibility for patent be determined?

# Dissemination of the Hantei (Advisory Opinion) System

- In order to improve the convenience of the Hantei (advisory opinion) System and promote its use, the JPO prepared and published “Guide to Hantei (Advisory Opinion) System” and the “leaflet of Hantei (Advisory Opinion) System” in May 2020, summarizing the characteristics of the Hantei (advisory opinion) System, examples of its use, and the format and writing method of the Hantei (advisory opinion) request form.
- English versions of these publications were also published in May 2022.

## Characteristics of the Hantei (Advisory Opinion) System

- ✓ The JPO determines and publishes official opinions on the technical scope of the patented invention from a **fair, neutral perspective**.
- ✓ **Three administrative judges** conduct proceedings taking advantage of **advanced professional and technical knowledge**.
- ✓ Proceedings by a panel composed of **three administrative judges with sophisticated expertise**.
- ✓ **A conclusion may be promptly made** (three months at the earliest)
- ✓ **Low cost** (40,000 yen per case).

Note: Hantei, one of the administrative services, functions as an expert opinion without any legally binding force.



(\*) The number of Hantei requests  
Patent : 24 (FY2021) , 27 (FY2020)  
Trademark : 8 (FY2021) , 9 (FY2020)  
Design : 7 (FY2021) , 6 (FY2020)

Click here for the JPO Guide to Hantei (Advisory Opinion) System: [guide.pdf \(jpo.go.jp\)](https://www.jpo.go.jp/guide.pdf)

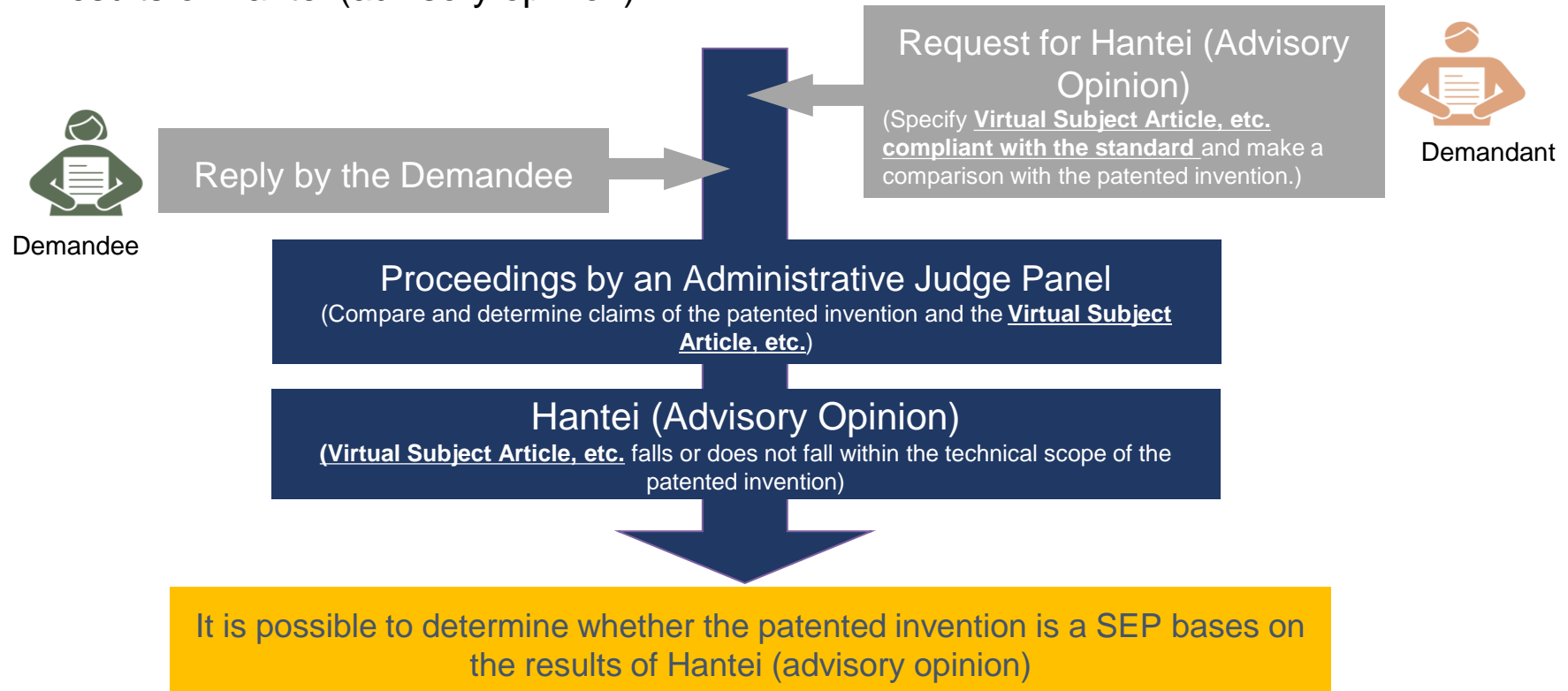


Click here for the leaflet of Hantei (Advisory Opinion) System: [leaflet.pdf \(jpo.go.jp\)](https://www.jpo.go.jp/leaflet.pdf)



# Hantei (Advisory Opinion) for Essentiality Check

- For the purpose of early dispute resolution involving Standard Essential Patents (SEPs), the JPO considered an operation of Hantei (advisory opinion) system to determine standard essentiality, and then published a “Manual of “Hantei” (Advisory Opinion) for Essentiality Check.” The JPO implemented the operation on April 1, 2018.
- Transparency of the information about SEPs has been improved by publishing the results of Hantei (advisory opinion).





# International Cooperation

- Regular meetings and exchanges of opinions with IP Offices and other organizations in each country/region
- **IP5 Trial and Appeal Boards High-Level Meeting:** Information exchanged on post-pandemic initiatives and methods of human resource development for administrative judges (June 2022)
- **JPO-CNIPA Trial and Appeal Experts Meeting:** Information exchanged on the operation of ex officio proceedings and efficient proceeding methods in trials for invalidation (September 2022)
- **JPO-CNIPA-KIPO Joint Experts Group for Trial and Appeal (JEGTA):** Comparative study of trial and appeal practices conducted (results published on website), exchange of statistical information, etc. (November 2021)



IP5 Trial and Appeal Boards High-Level Meeting  
June 2022

# Judicial Symposium on Intellectual Property / TOKYO

- “Judicial Symposium on Intellectual Property / TOKYO (JSIP)” has been co-hosted annually since 2017 by the JPO, the Supreme Court of Japan, the IP High Court, the Ministry of Justice (MOJ), the Japan Federation of Bar Associations (JFBA) and the Intellectual Property Lawyers Network Japan (IPLNET) , inviting IP practitioners.
- 2017, 2019, 2021: China, Korea, ASEAN and Japan  
2018, 2020, 2022: Europe, United States and Japan



Judicial Symposium on Intellectual Property / TOKYO 2020



Judicial Symposium on Intellectual Property / TOKYO 2021

**Thank You**

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