

Relationship between JPO Trial and Appeal Department (TAD) and Courts

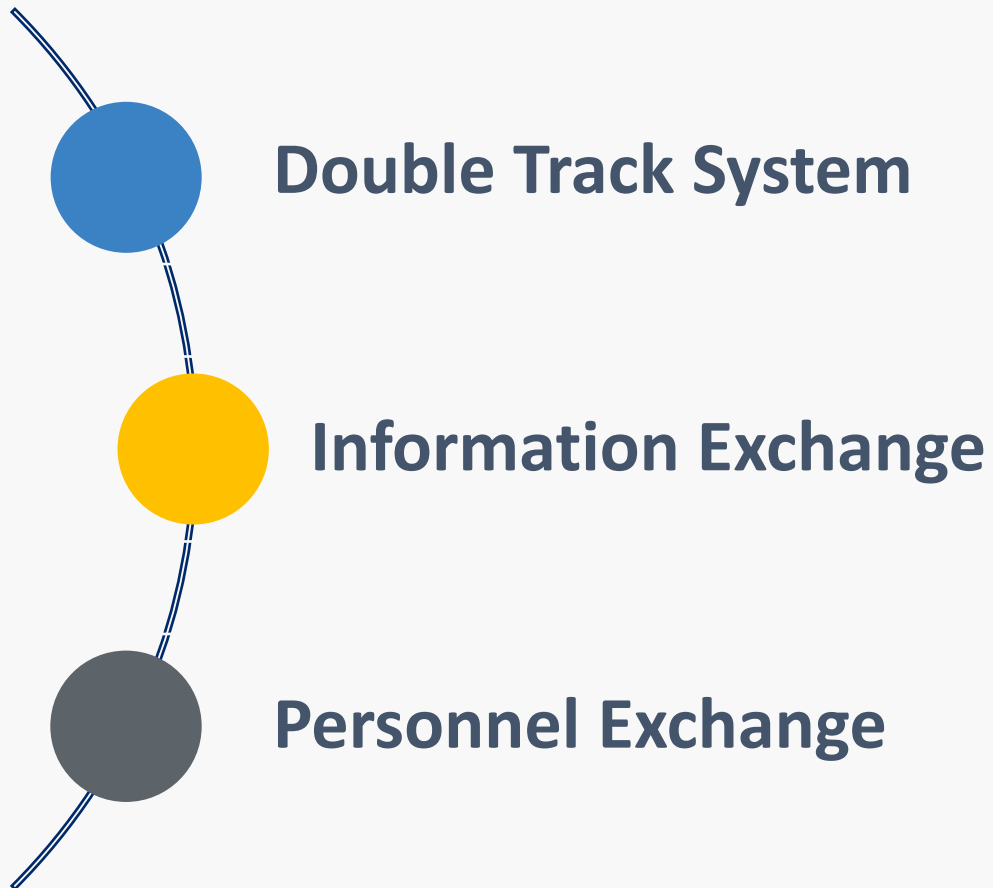
October 25, 2024

TAMURA Kiyoko

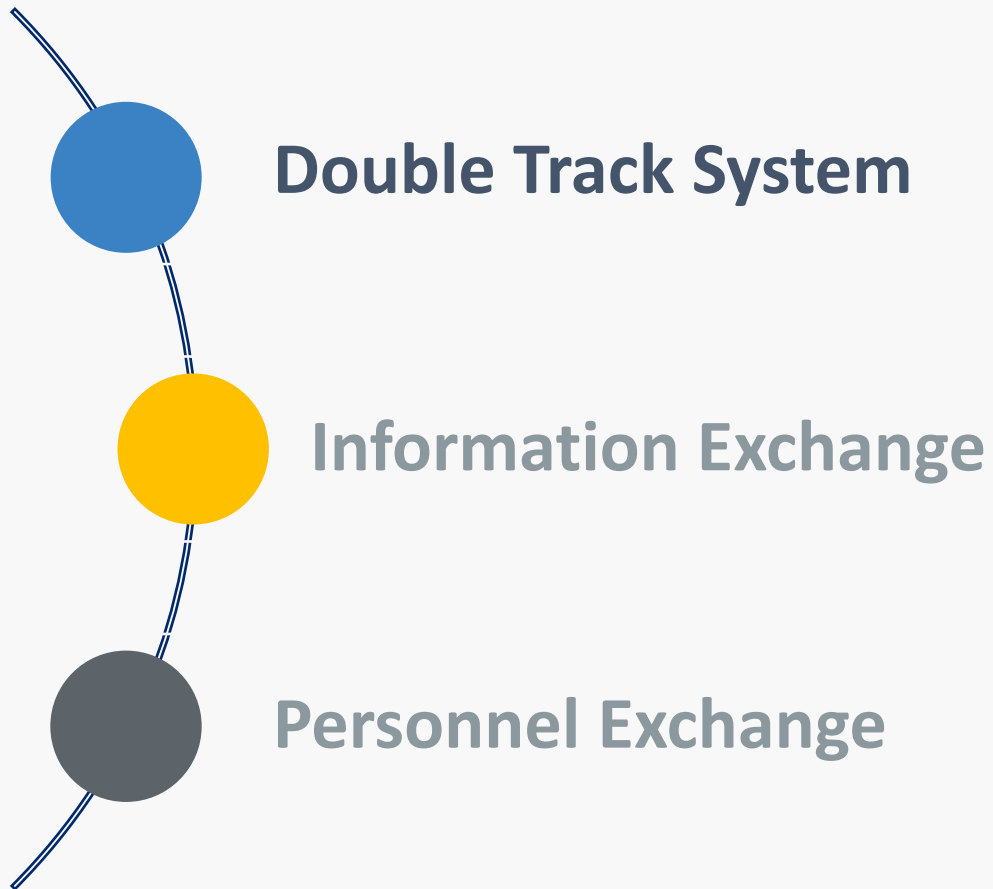
Director-General, Trial and Appeal Department (TAD),
Japan Patent Office (JPO)



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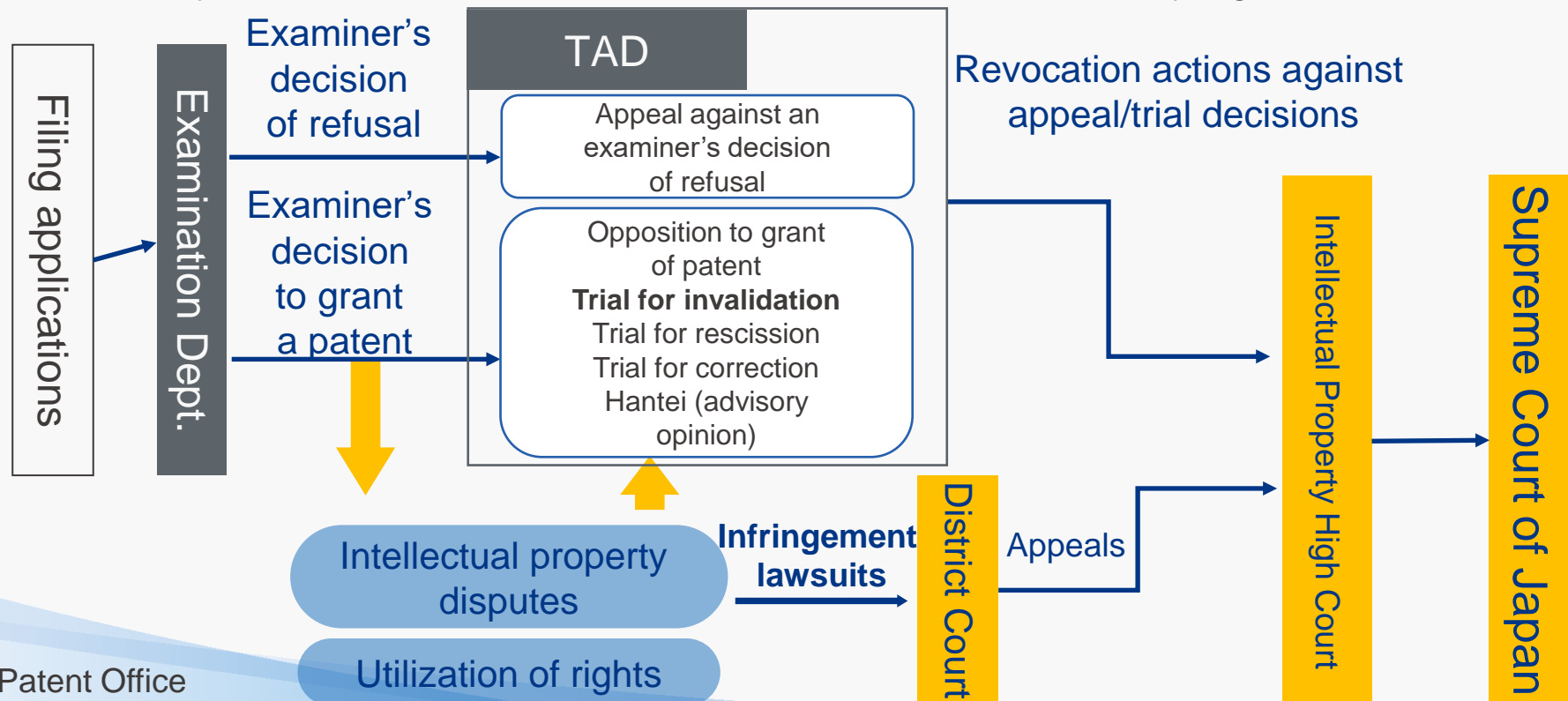


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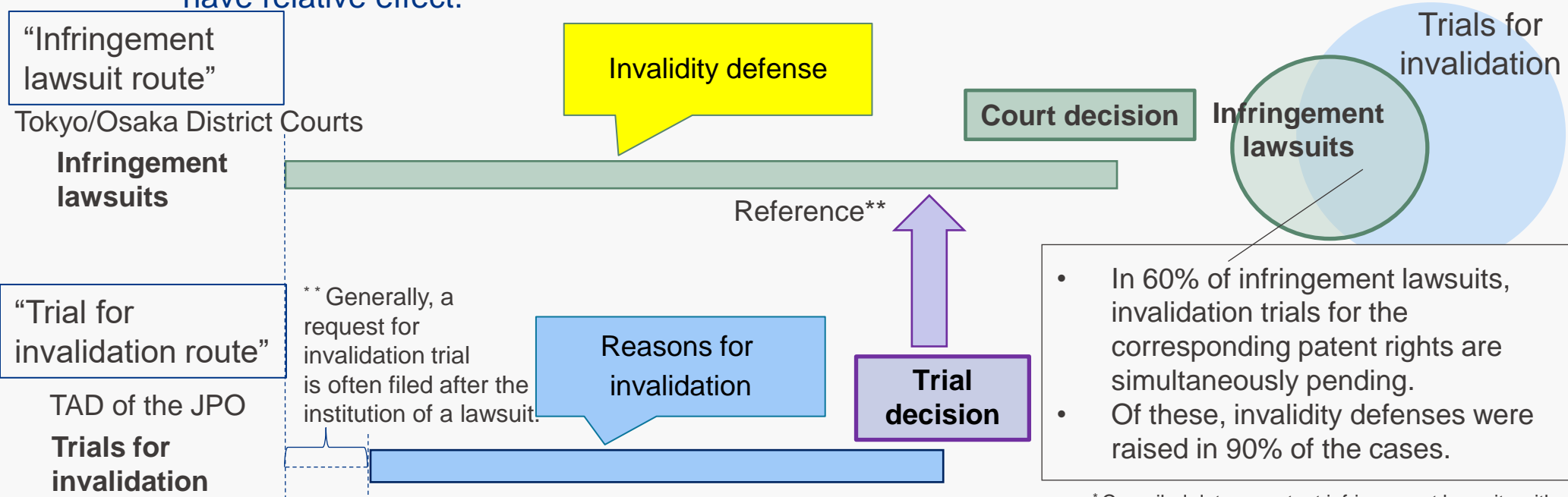
Flow of the Trials and Appeals / Litigations

1. Reviewing examiners' decisions
 - (appeal against an examiner's decision of refusal, opposition)
2. **Expeditious resolution of disputes over granted IP rights**
 - **Determination of validity of patents, etc. (trial for invalidation)**
 - Correction of claims, etc. (trial for correction)
 - Rescission of registered trademark not in use, etc. (trial for rescission)
 - Advisory opinion on the technical scope of industrial property rights (Hantei)



Flow of the Double Track System*1

- There are two routes (the so-called “double-track”) for determining the validity of a patent: the “**trial for invalidation route**” and the “**infringement lawsuit route**” in Japan.
 - Trials for invalidation proceedings are conducted ex officio, and their decisions have binding legal effectiveness as to third parties.
 - Infringement lawsuit proceedings are conducted by adversarial system, and their decisions have relative effect.

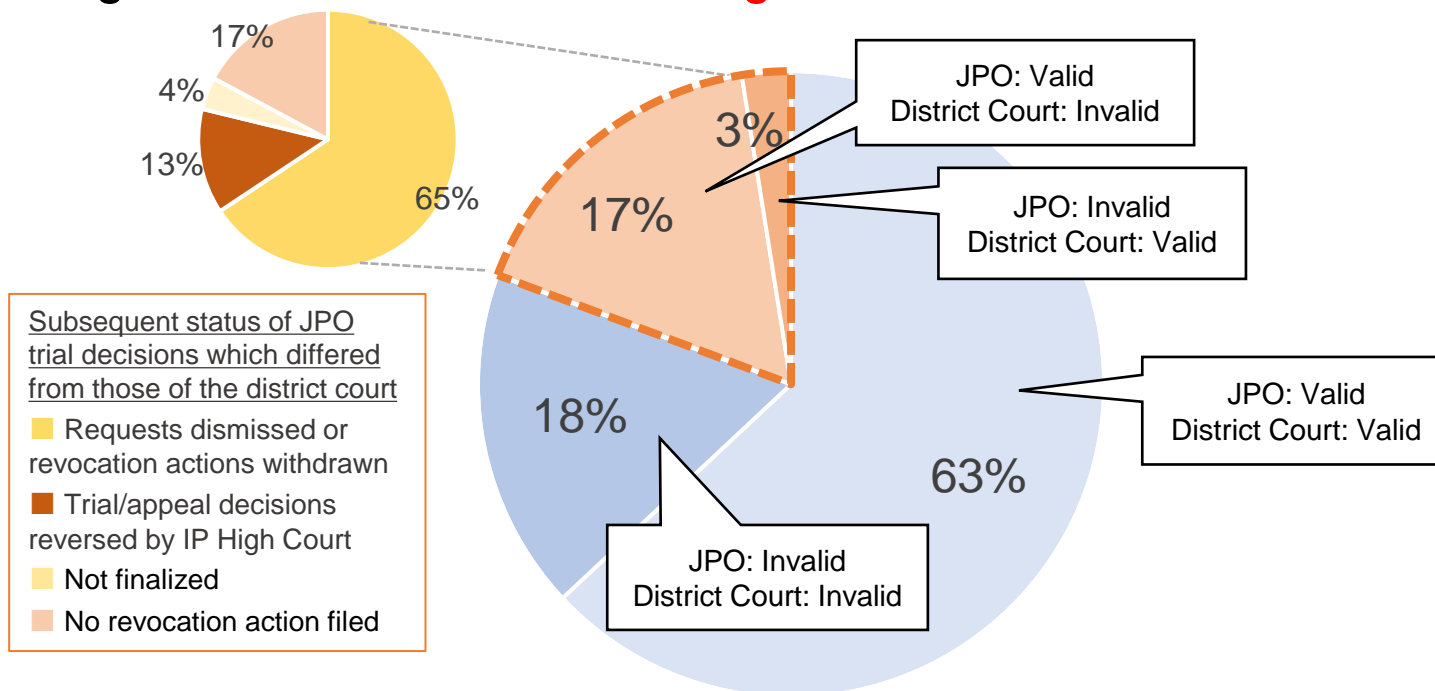


* Compiled data on patent infringement lawsuits with court decisions made in 2023.

By **rendering trial decisions early**, determinations made by the Trial and Appeal Department (TAD) of the Japan Patent Office (JPO) can be referred to by parties and courts in infringement lawsuits pending simultaneously, thereby contributing to dispute resolution.

Concordance Rate of Determinations between JPO and Courts

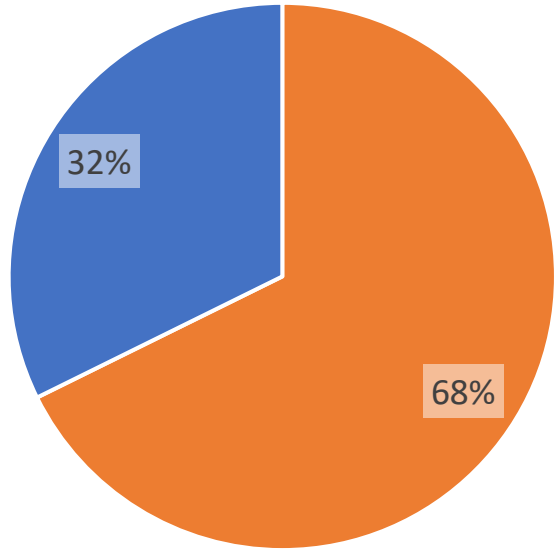
- **Concordance rate of determinations** on validity/invalidity between conclusions of JPO trial decisions (trials for invalidation) and district court decisions (infringement lawsuits – invalidity defenses raised) was **81%**
- Of the cases where JPO trial decisions and district court decisions differed, **the rate of IP High Court decisions reversing JPO trial decisions was 13%.**



Note: Compiled data on patent infringement lawsuits with court decisions made in between 2019 and 2023.

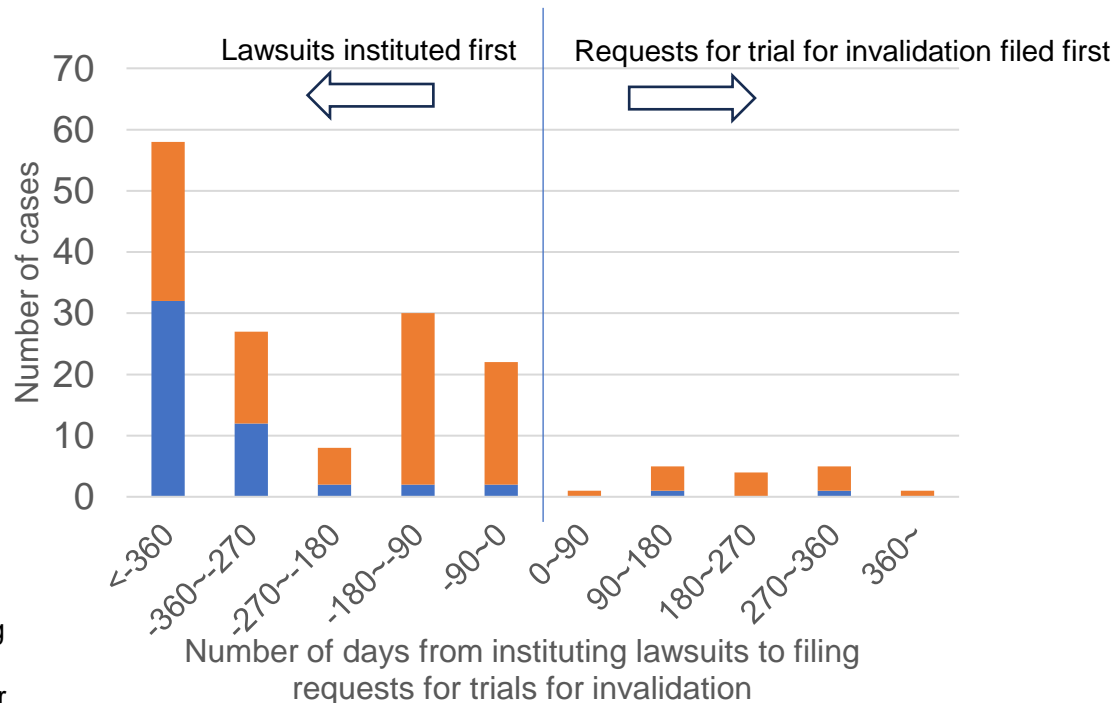
Order of determinations by JPO and Courts

- In many double-track cases (concurrently pending at the JPO and courts), infringement lawsuits are instituted before requests for trials for invalidation are filed.
- In about 70% of the court cases in which invalidity defenses were raised, the JPO rendered its trial decisions (including advance notice of trial decisions) first for the corresponding patent rights.
- Even for requests filed more than one year after the lawsuits were instituted, nearly half (45%) of trial decisions (including advance notice) were rendered first.



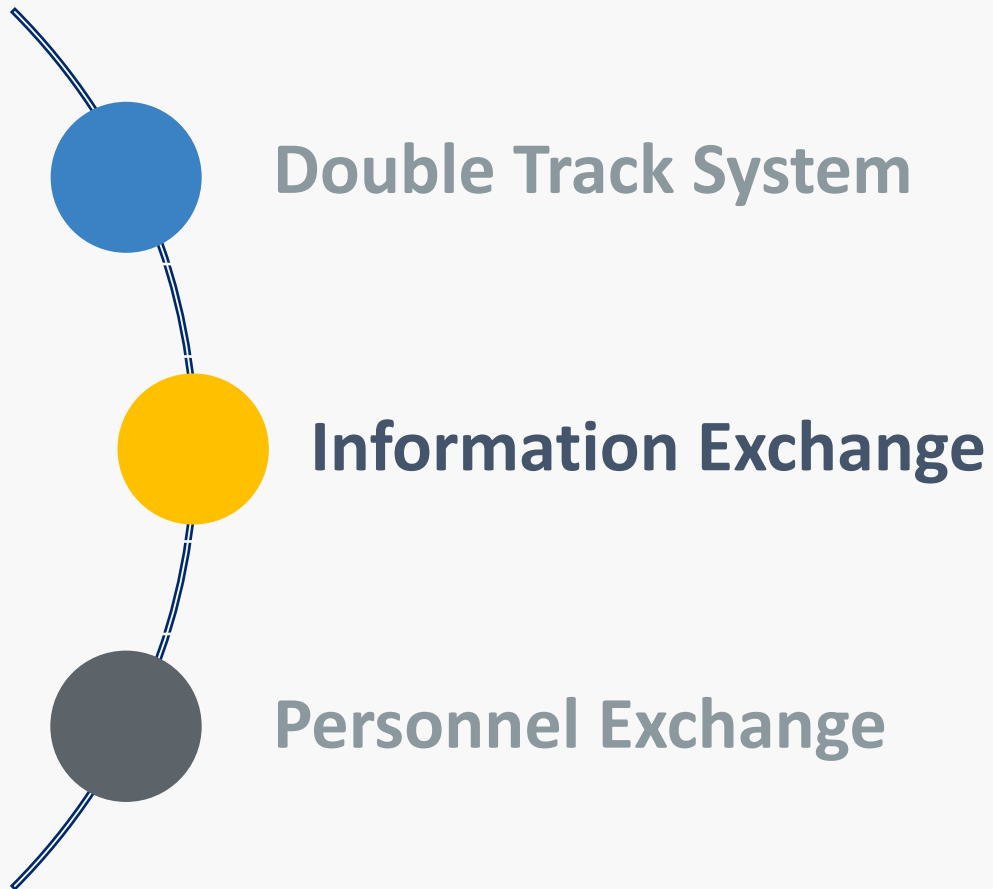
Trial decisions (including advance notice of trial decisions) rendered first

Trial decisions (including advance notice of trial decisions) rendered later



Where determinations by the JPO TAD and the courts are generally concordant, the JPO considers that it would be a contribution to users if the JPO TAD strives to render trial decisions before the courts make court decisions.

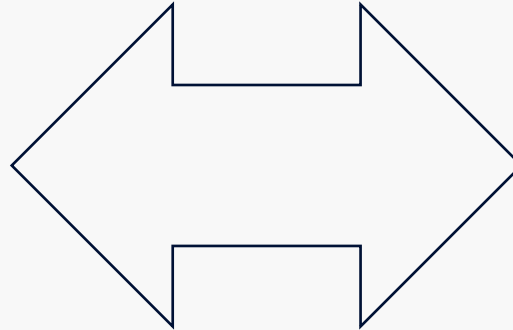
Relationship between JPO Trial and Appeal Department (TAD) and Courts



Exchange of Information between JPO and Courts

Japan Patent Office

Courts



■ Patent Act Article 168 (connection with litigation)

Provides for a proceeding relationship between trials and lawsuits.

- **By obtaining information** on the institution of infringement lawsuits, **the JPO will aim for early conclusion of the proceedings** in trials for invalidation cases, etc. for the corresponding patent rights.
- In cases where an infringement lawsuit and an invalidation trial are concurrently pending, **the JPO should be aware of this in the ex officio proceedings in the trial for invalidation** and proceed with the proceedings while taking into consideration the relationship between the two procedures, thereby **preventing discrepancies in determinations** between the two procedures as much as possible.

Exchange of Information between JPO and Courts - Patent Act Article 168 (3)-(6)

Japan Patent Office



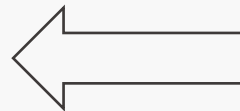
Courts



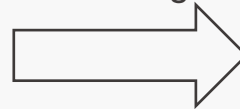
Instituting infringement lawsuits

Patent Act Article 168 (Connection with Litigation)

① Information that an infringement lawsuit has been instituted (paragraph 3)



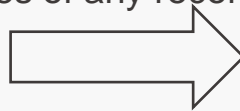
② Information on whether a request for a trial has been filed with the JPO (with respect to the patent right pertaining to the infringement lawsuit notified in ① above) (paragraph 4)



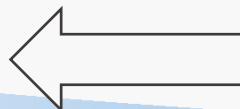
③ (If notified of the filing of a request in ② above) Information on invalidity defense if raised (paragraph 5)



④ (If considered necessary when being notified of the information in ③ above) Request for sending copies of any record of the infringement lawsuit (paragraph 6)



⑤ (If having received the request in 4. above,) The copies of record of the infringement lawsuit (paragraph 6)



Related Articles in Patent Act

Patent Act 168 (3) – (6)

(3) If an action is instituted with respect to infringement of a patent right or violation of an exclusive license, the court is to notify the Commissioner of the Japan Patent Office of this. The same applies once the litigation proceedings conclude.

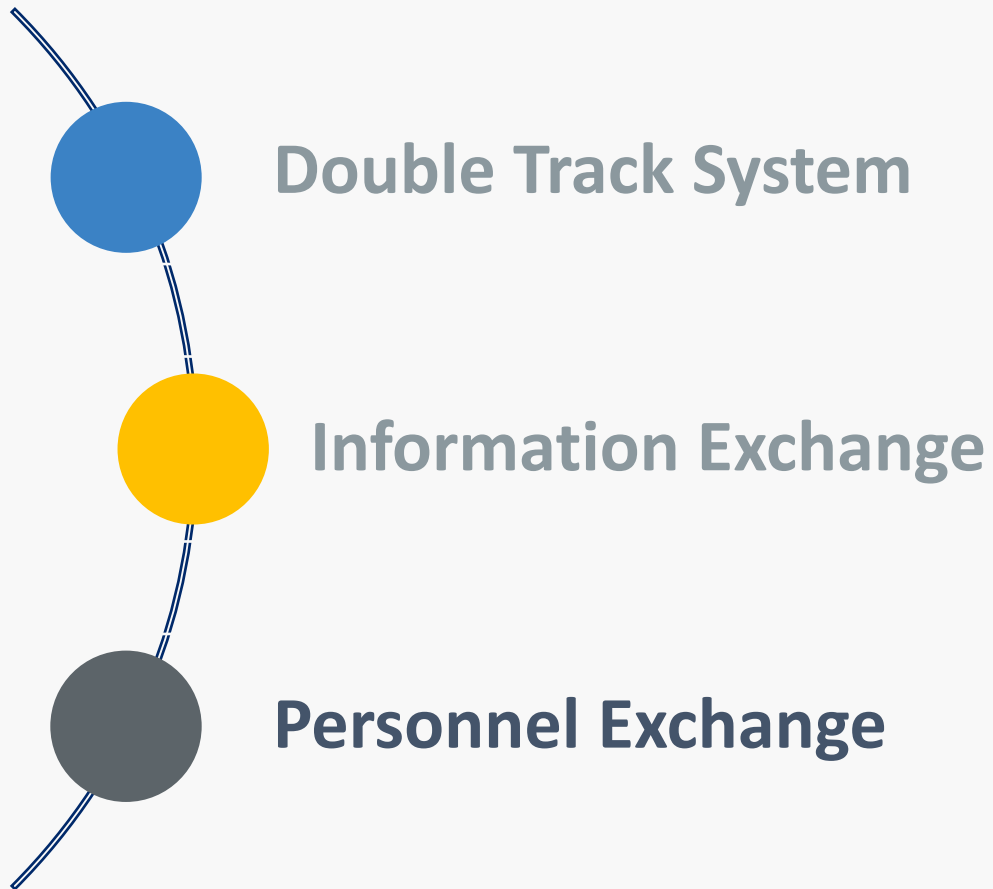
(4) If the Commissioner of the Japan Patent Office is notified as provided in the preceding paragraph, the Commissioner is to notify the court of whether a request for a trial or appeal has been filed with the Japan Patent Office with regard to that patent right. The same applies if the Japan Patent Office issues a ruling dismissing the written request for the trial or appeal, if it renders a decision on the trial or appeal in such a trial or appeal, or if the request for such a trial or appeal is withdrawn.

(5) If the court is notified pursuant to the preceding paragraph that a request for a trial or appeal with regard to the relevant patent right has been filed, and if a document stating a method of allegations or evidence under Article 104-3 (1) has already been submitted in the litigation prior to the notice or the document is submitted for the first time after the notice, the court must notify the Commissioner of the Japan Patent Office of that fact.

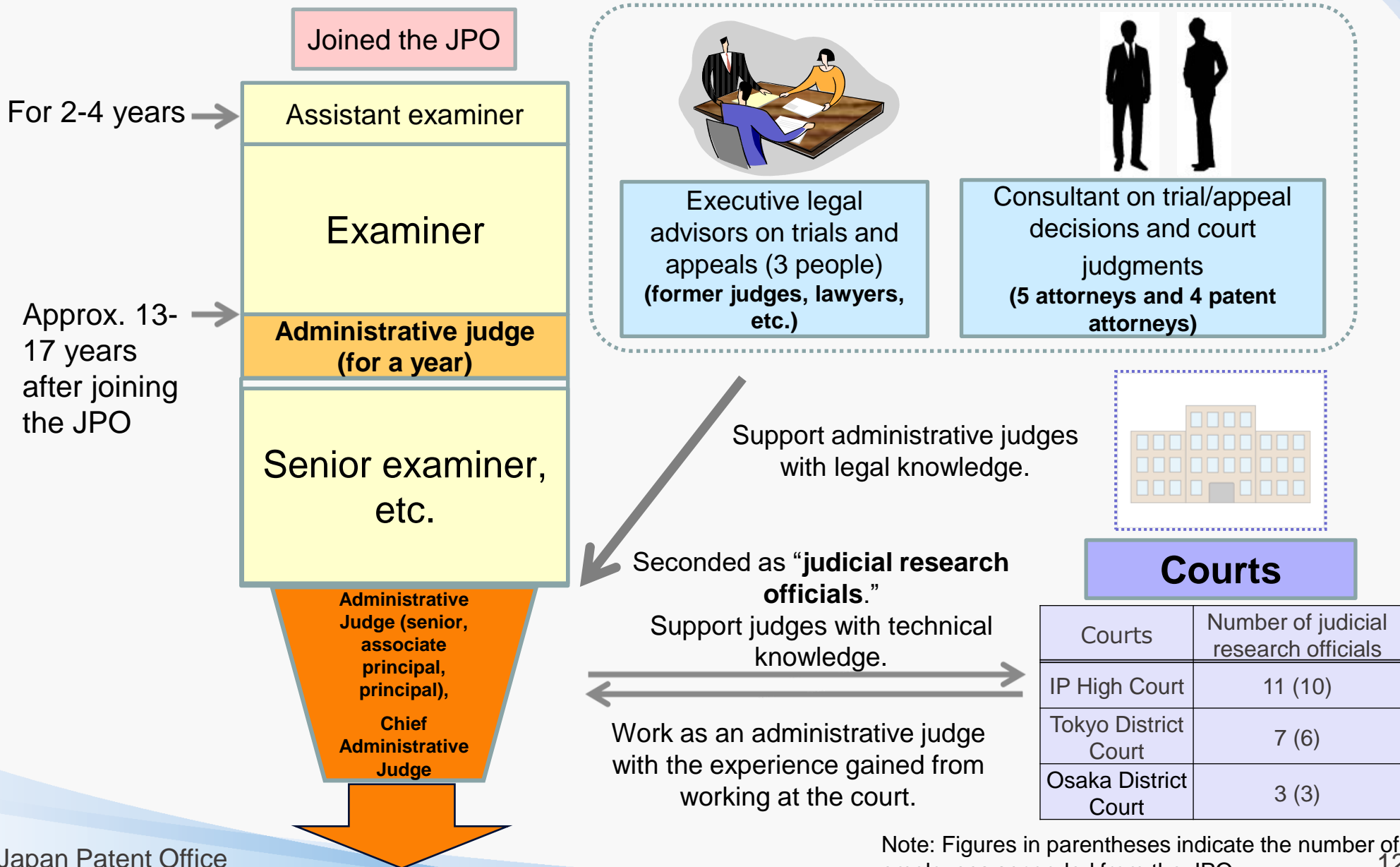
(6) If the Commissioner of the Japan Patent Office is notified as provided in the preceding paragraph, the Commissioner may request the court to send copies of any record of the litigation which the administrative judges consider necessary for the trial or appeal.

(Reference) Similar or mutatis mutandis provisions apply to Utility Model Act, Design Act, and Trademark Act.

Relationship between JPO Trial and Appeal Department (TAD) and Courts



Cooperation with Legal Professionals



Overview of “Judicial Research Officials”

- The Courts Act Article 57 provides the assignment of judicial research officials in each court.
- **Judicial research officials are full-time employees of the court.**
- Salary, working hours, leave, etc. are based on the law (Act on Temporary Measures concerning Court Officials) and are subject to the same laws as national public officers, such as the National Public Service Act.
- **Duties are provided in the Code of Civil Procedure Article 92-8.**

**Administrative judges
(senior, associate principal,
principal),
Chief administrative
judges**

Seconded as judicial research officials.
Support judges with technical
knowledge.



Courts	Number of judicial research officials
IP High Court	10
Tokyo District Court	6
Osaka District Court	3

Note: Figures indicate the number of employees seconded from the JPO.

Duties of “Judicial Research Officials”

(1) Asking questions of the parties or urge them to offer proof of factual and legal matters, on the following court date or in the following proceedings, in order to clarify matters that are related to litigations:

- a date for oral arguments or hearing;
- proceedings for arranging issues or evidence;
- proceedings for determining whether there exists an obligation to submit a document or an obligation to present an object for inspection;
- proceedings for deliberating on the particulars involved in the arrangement of issues or evidence or any other necessary particulars involved in the progress of litigation proceedings.

(2) Asking questions directly of a witness, the parties themselves, or an expert on a date for the examination of evidence;

(3) Giving an explanation based on expert knowledge on a date for attempting to arrange a settlement;

(4) Stating opinions about the case to a judge.

Thank you for your attention

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

