

## Post-Grant Opposition System (Revision of the Patent Act in 2014)

On May 14, 2014, a law for the partial revision of the Patent Act, etc., was promulgated, through which the Post-Grant Opposition System was established. A brief summary of the established opposition system is provided below.

### 1. Summary of the system

The opposition system established at this time consists of a revival almost as is of the prior opposition system which was absorbed into the trial for invalidation of a patent and abolished in 2003. Major changes to the prior opposition system are that oral proceedings have been abolished and all cases must be conducted by documentary proceedings, making it easier for opponents to use the system, and that when a patentee files a demand for correction, an opponent is allowed to submit his/her arguments against the correction.

The system as well as these changes will be explained below. Please also refer to the flowchart of the system (Appendix 1).

### 2. Content of the system

#### (1) Subject patents

Patents published in Patent Gazettes on or after April 1, 2015 shall be subject to opposition. In addition to patent applications filed on or after this date, patent applications filed before this date and published in Patent Gazettes on or after this date shall be subject to opposition.

#### (2) Term for opposition

The term for opposition shall be six months from the date on which the Patent Gazette was published. Within this term, the opponent must submit a written opposition describing a reason or reasons for the opposition to the Japan Patent Office.

#### (3) Opponent

Any person can file an opposition. Under the revised patent act, since any person can file an opposition, only an interested party shall be permitted to file a request for a trial for invalidation. This makes it clear that opposition is positioned as a system for reviewing examinations, while the trial for invalidation is positioned as a system for parties disputing a patentee to contest the validity of a patent.

(4) Written oppositions, etc.

(a) A written opposition shall state the names and addresses of the opponent and the attorney, the patent that is the subject of the opposition, and the reason(s) (evidence) for the opposition. The opponent cannot be anonymous, but because any person can file an opposition, any person (a dummy) having an address where documents can be received can be the opponent.

(b) When filing a written opposition, fees amounting to 16,500 yen per opposition plus 2,400 yen per claim must be paid. An opposition can be filed against each claim. For example, an opposition filed against two claims among 10 claims of a patent amounts to 21,300 yen (16,500 yen + 2,400 yen × 2 claims). (Incidentally, fees for filing a request for a trial for invalidation or correction are 49,500 yen + 5,500 yen × the number of claims).

(c) Only public reasons (lack of novelty, lack of an inventive step, addition of new matters, indefiniteness, etc.) may be used as reasons for an opposition. Misappropriated applications and breaches of joint applications shall be excluded from reasons for an opposition (a misappropriated application, etc., shall be included as reasons for a trial for invalidation).

(d) Amendments to reason(s) and evidence described in a written opposition can be made within the term for opposition, but where the patentee has been notified by the Japan Patent Office of a reason or reasons for revocation within the term for opposition, further amendment is not permitted. In this case, a patent or a claim which is the subject of an opposition cannot be changed even within the term for opposition.

(5) Examination

(a) Where a written opposition satisfies formality requirements, a duplicate shall be sent to the patentee (an attorney). The duplicate is sent only to notify the patentee of the content of the opposition, and therefore the patentee may not respond to the content of the duplicate.

(b) Once the formality examination is complete, a panel consisting of (three or five) trial examiners starts documentary proceedings. If a reason or reasons for revocation is/are found during the documentary proceedings, the patentee shall be notified of the reason(s). On the other hand, if no reasons for revocation are found, a decision to the effect that the patent is to be maintained shall be rendered, and a copy of the decision, which is described below, shall be served to the patentee and the opponent.

(c) A patentee who has received a reason or reasons for revocation may file a written argument against the reason(s) for revocation, and may file a demand for correction of the scope of the claims (including the description, etc.) in order to avoid the reason(s) for revocation.

(d) When a demand for correction has been made, a duplicate of the written demand for correction and the same reason or reasons for revocation sent to the patentee shall be sent to the opponent. The opponent shall scrutinize these documents, and may then file a written argument against the correction. (In this written argument, presenting a new prior art document and/or a new reason or reasons for revocation corresponding to the corrected part is permitted). In this case, a written argument does not necessarily have to be filed. If the correction is limited in scope and it is found that the corrected patent can be maintained without causing problems, filing a written argument is not necessary.

(e) If a new reason or reasons for revocation is/are found when the examination is continued after the correction has been made, notification of the reason(s) for revocation shall be sent again. The patentee may then submit a written argument and make a demand for correction in response to this notification of the reason(s) for revocation. If a demand for correction has been made, the opponent may further file a written argument against the correction.

(f) If multiple oppositions are filed, the oppositions shall be examined in a consolidated manner. For this reason, the examination shall start after the term for filing an opposition has expired. An examination of an opposition and an examination of a trial for invalidation shall not be conducted in a consolidated manner. When an opposition and a trial for invalidation are pending at the same time, in principle, the examination of the trial for invalidation shall be prioritized.

(g) The panel shall conduct an examination of reasons other than the reason(s) argued by the opponent. Therefore, a reason or reasons for revocation may be provided based on the evidence presented by the trial examiners.

#### (6) Decision (Conclusion of Examination)

The examination shall be concluded when a copy of the decision stating the conclusion and the reasons for the decision has been served to the patentee and the opponent. When a decision to revoke the patent has been rendered, patent rights shall be deemed not to have existed ab initio. After receiving a decision of revocation, the patentee may file a lawsuit against the Commissioner of the Patent Office as a defendant to the Intellectual Property High Court. The opponent, on the other hand, may not file an appeal against a decision to maintain the patent. As a decision made in relation to an opposition has no effect in terms of prohibiting double jeopardy, a trial for invalidation can be filed based on the same evidence, etc.

### 3. Comments

Under this system, an opposition may be filed by a dummy, whereas a request for a trial for invalidation may not be filed by a dummy. Oral proceedings may not be conducted during opposition proceedings, and therefore the validity of patents from other companies can be contested more easily than in a trial for invalidation.

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## FLOWCHART OF POST-GRANT OPPOSITION SYSTEM

