

Patent Opposition System in Japan

The new patent opposition system enables a third party to request revocation of a granted patent, allow quick correction of patents and help ensure stronger granted patents.

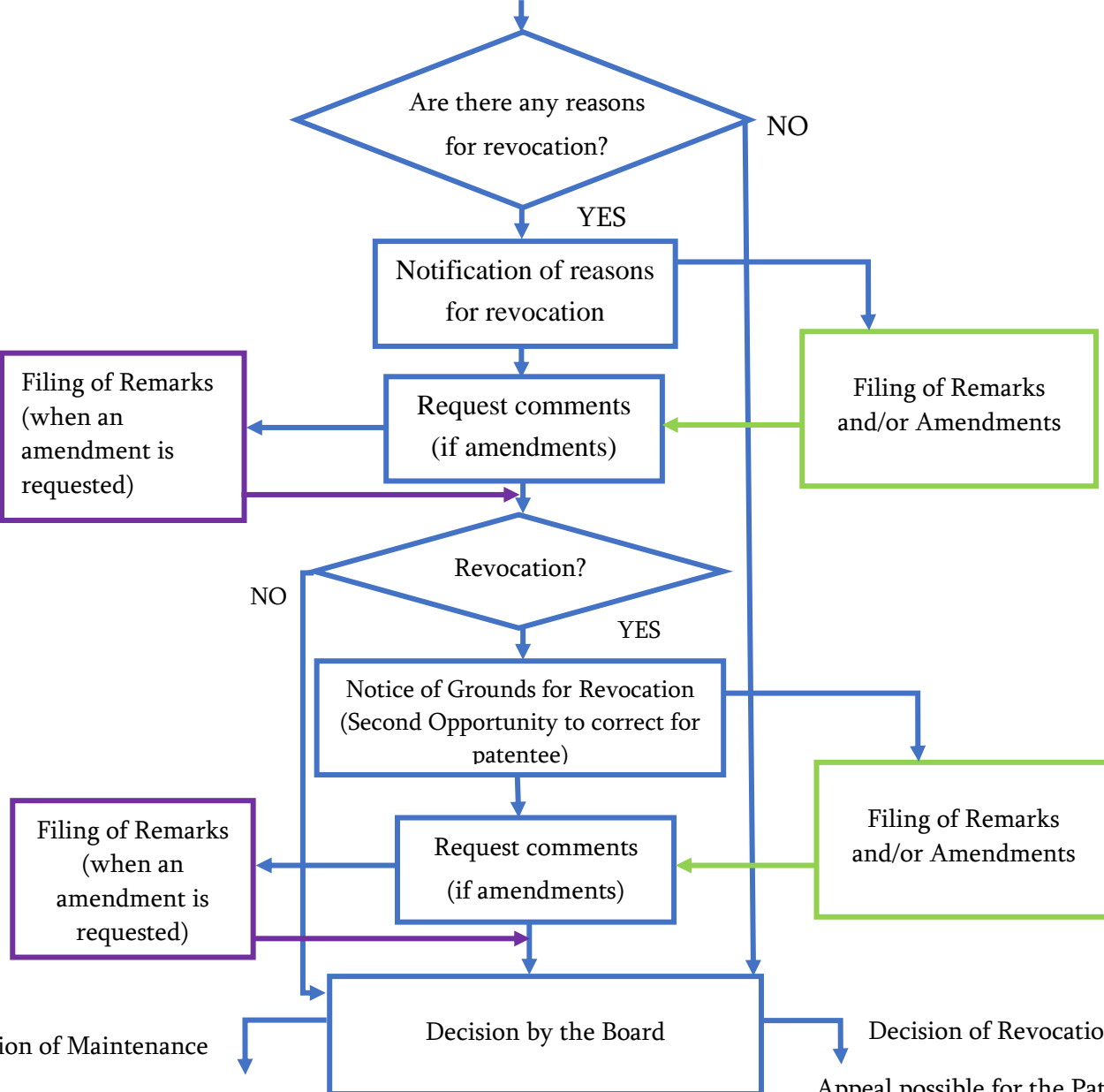
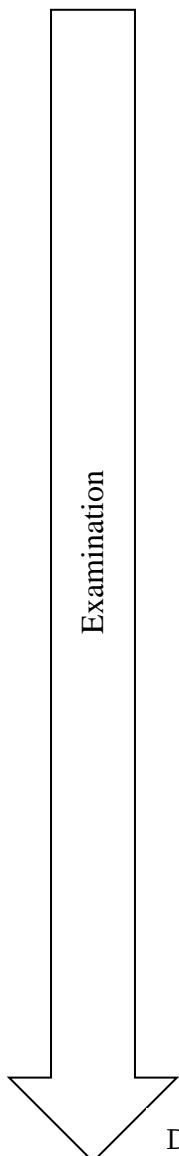
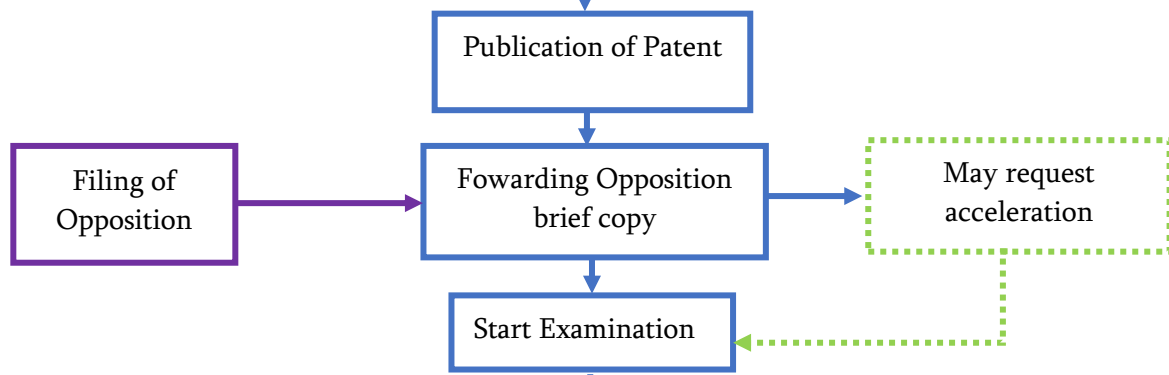
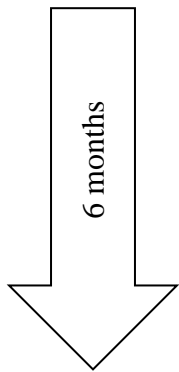
Under the new system, oppositions can be filed against patents published from April 1, 2015.

Summary of Patent Opposition system in Japan

| | |
|---------------------------------|--|
| Opposition Period | Within 6 months from publication of patent. |
| Opponent | Anyone, possibility to use a straw man |
| Grounds for Opposition | <ul style="list-style-type: none"> • Novelty and Inventive Step • Lack of support, clarity or enablement • Introduction of new matter by amendments or by translation • Double patenting • Non-patentable subject matter • Prior application • Violation of enjoyment of rights of foreigners |
| Type of Examination | Documentary |
| Opposition Unit | Claim |
| Ex officio Examination | Unraised grounds also examinable |
| Patentee Procedure | May submit remarks or amendments after notice of reasons for revocation |
| Opponent Procedure | May submit remarks after submission of amendments by patentee |
| Multiple Oppositions | Joint examination as a general rule |
| Withdrawal of Opposition | Not possible after Notice of Reasons for Revocation is communicated |
| Ne bis in Idem Rule | Not applicable |
| Official Fee | JPY 16,500 (€131) + JPY 2,400 (€19) x Number of claims (<i>Exchange rate as of September 8th, 2020</i>) |
| Appeal | <ul style="list-style-type: none"> • Revocation may be appealed only by patentee at IP High Court • Invalidation may be filed by opponent if patent is maintained |

Opposition versus Invalidation

| | Opposition | Invalidation | Comments |
|------------------------------------|---|--|--|
| Purpose | Early reevaluation of patent after grant | Dispute resolution between concerned parties | |
| Filing Period | Within 6 months from patent publication | Any time after grant (even after expiry) | Only Invalidation is available after passing of 6 months |
| Petitioner | Any third party | Interested party | A strawman may be used for Opposition |
| Possible reasons for filing | Reasons for Rejection | Reasons for rejection and ownership of rights | Only Invalidation is available for ownership |
| Proceedings style | Initiative by the Board of Appeal | <i>Inter partes</i> | New arguments and reasons can be found by JPO in opposition but not invalidation. |
| Arguments presentation | Documentary | Documentary and Oral examination | No disadvantage for foreign party in Opposition |
| Petitioner Procedure | May submit remarks after correction by patentee | Involved throughout the procedure | Limited influence on the patent amendments by the petitioner during opposition proceedings |
| Withdrawal | Not possible after Notice of Reasons for Revocation is communicated | Anytime before finalization of the decision | Considerations for Negotiation Strategy |
| Official fees | JPY 16,500 + JPY 2,400 x Number of claims | JPY 49,500 + JPY 5,500 x Number of claims | Total costs tend to be higher for Nullity Actions |
| Speed | 6 months to one year | One year | Difference insubstantial if appealed |
| Appeals | Revocation may only be appealed by patentee at IP High Court Invalidation may be filed by opponent if patent is maintained | All decisions may be appealed to IP High Court | Once Opposition is rejected, new evidence will likely be needed to invalidate the same patent by an Invalidation |



No Appeal possible but Nullity Action available for Opponent

Decision of Revocation
Appeal possible for the Patentee
info@patents.jp