

VII. INTERFACE BETWEEN THE DIFFERENT MECHANISMS

A. RECENT REFORMS OF NATIONAL SYSTEMS

267. The national and regional opposition systems have seen many changes in recent years. Some of those changes in national legislation are further described below.

Japan, China and the Republic of Korea

268. The changes made to the Japanese opposition system during the past 20 years are interesting from a policy perspective. Prior to 1996, the Japan Patent Law provided a pre-grant opposition system which allowed the public to complement the examination by substantive examiners. However, concerns over delays in granting patents became stronger,¹⁹⁷ and in 1996, the pre-grant opposition system was replaced by a post-grant opposition system.

Consequently, two mechanisms to challenge the validity of granted patents coexisted in Japan, i.e., a post-grant opposition system and trial for invalidation system. The post-grant opposition could be filed by anyone within six months from publication of the gazette containing the patent. However, the opponent could not fully participate in the review process, which was conducted between the patent Office and the patentee. The system was designed so that the patent Office reviews its prior decision based on the evidence provided by the opponent and the counter-argument, if any, submitted by the patentee.¹⁹⁸ Therefore, the previous post-grant opposition system in Japan was conducted mostly *ex parte*.¹⁹⁹ On the other hand, a request for a trial for invalidation, which was an *inter partes* procedure, could be filed by an interested party any time after the registration. Such a dual system was later found problematic, since the same patent could be subject to both post-grant opposition and trial for invalidation in two separate cases. The situation became even more complicated after the Supreme Court's decision in April 2000, in which the Court held that judicial courts were capable of reviewing the validity of patents regardless of the status and outcome of the trial for invalidation at the Japan Patent Office.²⁰⁰

269. In order to streamline the post-grant review procedures, the post-grant opposition system was abolished in 2004, and the mechanism to challenge a granted patent was streamlined into a single procedure, namely the trial for invalidation. The revised trial for invalidation allows, in principle, anyone to file an appeal. In order to maintain a

simpler and cheaper option to assist invalidating patents that have been inadvertently granted, the Office has created a mechanism that allows third parties to submit, free of charge, any information which may be relevant to various patentability requirements even after the grant of a patent.²⁰¹

However, although the number of requests for trial for invalidation was temporarily increased after the mechanism to challenge a granted patent was streamlined into a single procedure, the number of requests was back to the level before the legal revision within few years. This is because there is essentially a significant burden of procedures on the parties concerned and also because there is a disadvantage of costs for users in local regions. Furthermore, with a rapid increase in the number of patent applications filed globally by Japanese companies, it has been frequently pointed out that it is important to support applicants so as to enable them to acquire stable and strong patent rights at an early stage in other Offices for the purpose of utilizing patent rights globally by using technologies that are created in Japan as a core. Under these circumstances, a new patent opposition system was established in Japan in 2015, by devising opportunities for parties concerned to independently state opinions with a simple procedure. It was revised to limit only an interested party to file a request for a trial for patent invalidation while allowing any person to file an opposition to a patent.