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**FINAL REPORT**

**COMPARATIVE STUDY ON PATENT APPEALS/TRIALS  
SYSTEM AND ITS EXAMINATION PROCESS BETWEEN  
CHINA AND JAPAN**

**-----TO REFINE AND HARMONIZE THE PATENT APPEALS/TRIALS  
SYSTEM AND ITS EXAMINATION PRACTICES**

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## **Abstract**

Under the current IP situation in the world in which the number of patent disputes is increasing, prevention of disputes and quick settlement of litigation are growing in importance. The role of patent appeal has become increasingly important because the final responsibility is left to the patent appeals for establishing stable and high-quality rights. The patent appeal system in each country is placed between the jurisdiction of the patent examination system and that of the judicial system. It also varies substantially from one country to another as far as its organizational structure, system, and practices of patent appeals are concerned.

This research report makes the comparison of the patent appeal/trial system between Japan and China, especially in the field of practical examination proceedings and finds the main differences between two countries mainly in common matters for all kind of Appeal/Trial including the legal nature of patent appeal/trial, prohibition of double jeopardy, consolidation/separation of appeal/trial examinations, interview by collegial body, ex-officio principle and ex-officio investigation, oral proceeding and evidence. This research report also makes the detailed comparison between two countries in the proceedings of the appeal against the examiner's decision of refusal and in proceedings of the trial for invalidation. At the same time, this research report introduces some especial appeal/trial systems in Japan, which are not existent in China, for example, such as trial for correction, Hantei system, retrial system, system of request for opinion/statement, information providing system. This research report still makes a brief introduction of IP judicial system of Japan. Based on the comparison and analysis of above information, some recommendations are provided for the purpose of being useful and helpful to the revision of the Patent Law of China regarding the change of the role or position of the Patent Reexamination Board of SIPO, constitution of Hantei system, retrial system and appeal/trial interview system and how to utilize the ex-officio principle.

## TABLE OF CONTENTS

Abstract.....	i
Table of contents .....	ii
Acknowledgement.....	iv
Chapter 1 Introduction .....	1
1.1 Background.....	1
1.2 Objective.....	3
1.3 Methodologies.....	3
Chapter 2 Brief Introduction of Patent Trials System of Japan and China.....	4
2.1 Brief Introduction of Patent Trials System of Japan.....	4
2.2 Brief Introduction of Patent Trials System of China.....	11
2.3 Brief Summary .....	16
Chapter 3 Comparison of Common Matters for All Kind of Appeal or Trial (General).....	16
3.1 Legal Nature of Patent Trials/Appeals and Trial/Appeal Decisions.....	16
3.2 Prohibition of Double Jeopardy.....	19
3.3 Consolidation/Separation of Appeal/Trial Examination.....	21
3.4 Interview by Collegial Body.....	25
3.5 Ex-Officio Principle and Ex-Officio Investigation.....	28
3.6 Oral Proceeding.....	33
3.7 Evidence.....	36
Chapter 4 Comparison of Proceeding of Reexamination (Appeal against Decision of Refusal).....	44
4.1 Outline of the Appeal against Decision of refusal.....	44
4.2 Demand.....	45
4.3 Amendment to the Specification and Drawings Attached to an Appeal.....	45
4.4 Appeal Examination.....	46
4.5 Reconsideration by the Examiner.....	47
4.6 Accelerated Appeal Examination.....	48
4.7 Examination Proceedings.....	49
4.8 Notification of Conclusion of an Appeal Examiner.....	50
4.9 Remanding to Examination.....	51
4.10 Appeal Decision.....	52
4.11 After Making the Appeal Decision.....	54
4.12 Flow Chart of Appeal against the Decision of Refusal in JPO.....	55
Chapter 5 Comparison of Proceeding of Trial for Invalidation.....	56
5.1 Outline of the Trial for Invalidation.....	56

5.2	Demand.....	58
5.3	Amendment to a Written Demand for Trial.....	59
5.4	Transmitting a Duplicate of the Written Demand for Trial for Invalidation and Submitting a Written Reply.....	60
5.5	Demand for Correction.....	60
5.6	Trial Examination.....	62
5.7	Withdrawal of a Demand for Trial.....	64
5.8	Conclusion of a Trial Examination.....	65
5.9	Trial Decision.....	65
5.10	Conclusion of a Trial Case.....	66
5.11	After a Trial Decision.....	67
5.12	Final and Conclusive Trial Decision.....	67
5.13	Flow Chart of a Trial for Invalidation in JPO.....	68
Chapter 6	Appeal/Trial Proceedings of JPO Which are Not Existent in SIPO.....	69
6.1	Trial for Correction.....	69
6.2	Hantei System (System of Advisory Opinion on the Technical Scope of the Patent Invention) .....	75
6.3	Opinion Statement System and Request for Opinion System.....	80
6.4	Retrial System.....	82
6.5	Information Providing System.....	84
Chapter 7	Brief Introduction of IP Judicial System of Japan.....	86
7.1	Judicial System in Japan.....	86
7.2	Courts in Japan.....	87
7.3	Procedures concerning Industrial Property Rights.....	87
7.4	Composition of Expert Department Specializing in Intellectual Property Rights.....	88
7.5	Judges at the Expert Department.....	88
7.6	Inquisitor.....	89
7.7	Procedural Representative.....	89
7.8	Suits against Appeal/Trial Decision (Suits for Objection to Appeal/Trial Decision).....	90
7.9	Patent Right Suits against Infringement.....	90
Chapter 8	Conclusion and Recommendations.....	92
8.1	Conclusion.....	92
8.2	Recommendations.....	97
ANNEX I	—List of Reference.....	100
ANNEX II	--Questionnaires and Corresponding Answers.....	101

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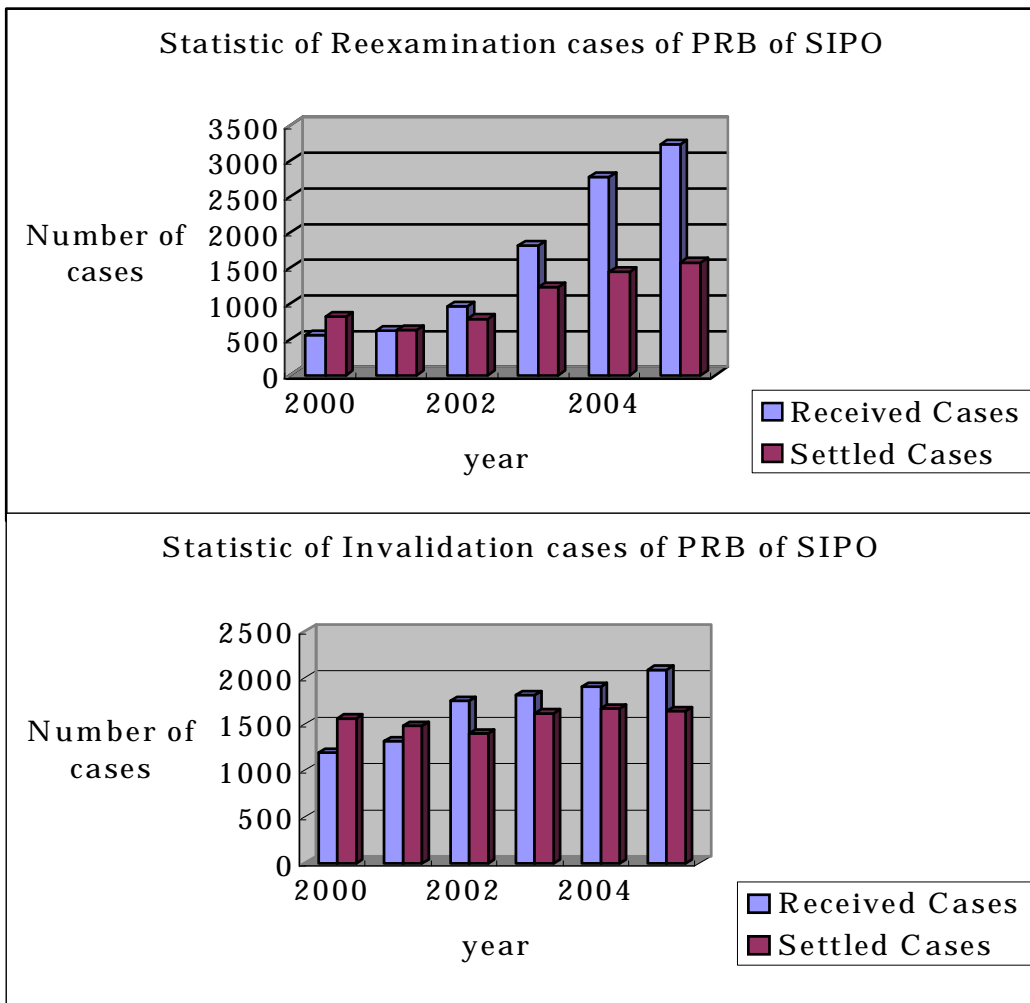
**It should be noted that opinions expressed in this report are purely personal and do not necessarily reflect those of the organization to which the author belongs.**

# Chapter 1 Introduction

## 1.1 Background (Current situation of the Patent Appeal/trial system of China)

Chinese Patent Law came into force on April 1, 1985, only 21 years have passed and it is really a short period. Fortunately, when the Law was drafted, the legislature comprehensively studied different patent systems in the world and drew up the first Patent Law in the Chinese history based on our country's social and economic development at that time. More than two decades have passed since then, and the Chinese patent system has achieved remarkable developments. For instance, in 1985, the total numbers of applications (including utility model and design) were 14,372 (including 4,961 applications from abroad), and the number reached 476,264 in 2005, 33.15 times increased.

At the same time, the patent reexamination or appeal system is also developed. For example, from 1985 to 2005, the number of requests for reexamination and invalidation accepted by the Patent Reexamination Board of the Chinese Patent Office (PRB) increased rapidly, especially in recent five years.



More and more attention is being paid to the reexamination or appeal system in China. One of the reasons is that it has developed in close relation with the judicial system and sometimes it has much influence on an undergoing court case.

China is a huge market which attracts many foreign companies and investors to do business there, meanwhile, they wish their intellectual property right including patent right to be protected completely. Chinese government has made promises on this issue and the Chinese legislative has made the twice amendments to the Patent Law in 1993 and in 2001 which have made improvements to the benefit of the owner of patent right and to the patent system. However, China is a developing country, its patent system is also developing, so as the people's knowledge and understanding to the patent system. It needs time to make things better.

Under the current situation in which the number of patent disputes is increasing, prevention of disputes and quick settlement of litigation are growing in importance. The stability of intellectual property rights is regarded as an important factor for the enforcement of rights; especially with regard to the patents involving complicated and sophisticated technological subjects. The role of patent appeal has become increasingly important because the final responsibility is left to the patent appeals for establishing stable and high-quality rights.

The patent appeal system in each country is placed between the jurisdiction of the patent examination system and that of the judicial system. It also varies substantially from one country to another as far as its organizational structure, system, and practices of patent appeals are concerned.

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With the rapidly development of the number of requests for reexamination and invalidation accepted by the Patent Reexamination Board of SIPO, the Patent Reexamination Board of SIPO is facing the more and more issues, for example, such as how to improve the Appeal/Trial examination system, how to training the new examiners increasing rapidly as well, how to improve the examination standard of Appeal/Trial cases, and so on. Among these issues or problems, it is noted that how to improve the Appeal/Trial examination system is most important because it is the basis of other issues.

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<sup>1</sup> See: "A desirable patent appeal system in the new era" by Takeshi Isayama, November 19, 1998, <http://www.jpo.go.jp/shiryoe/index.htm>, visited on May 5<sup>th</sup>, 2006.



Nowadays, confronted with the rapid development of technology and more and more legal issues spring up, it is necessary to improve the Patent Law of China. Now SIPO is beginning to submit suggestions to revise the Patent Law for the third time.

Japanese Patent Office has more than one hundred years history, and Japan also experienced from a developing country to a developed country. So it is very important and helpful for the Patent Reexamination Board of SIPO to study the patent Appeal/Trial examination system of JPO.

## **1.2 Objective**

For the purpose of those reasons, in this report, the Appeal/trial examination system of JPO will be studied and compared with the relevant examination system of SIPO. The objective of this study is to find the differences of the Appeal/Trial examination proceedings between the JPO and SIPO by comparing the Patent Laws, relevant regulations, examination standards, and examination manual and so on.

At the same time, this study also attempts to analyze the merit and deficiency of these differences.

Moreover, this study still makes an attempt to submit some suggestions regarding Patent Appeal/Trial system which may be useful to the revision of the Patent Law of China.

From the other standpoint, this study may exchange the information between two countries to understand better each other the Appeal/Trial system and the relevant examination situations which can promote the harmonization of the Patent Appeal system in the future.

## **1.3 Methodologies**

This research is conducted firstly by way of extensively collecting knowledge, information regarding the patent appeal/trial examination proceedings, appeal/trial examination standards etc. from the books, internet, and if necessary and possible, relevant knowledge, information also may be available by the interview with the experts, the examiners of JPO, the patent attorneys of the patent agency and the patent staffs of the enterprises.

After collecting the knowledge and information, it is the step to read and study the relevant materials earnestly so as to understand the materials thoroughly.

Then it is to make analyses of the materials read and studied in order to find the differences of the Appeal/Trial examination proceedings between the JPO and SIPO and to analyze the merit and deficiency of these differences.

At last, it is to provide some suggestions regarding Patent Appeal/Trial system which may be useful to the revision of the Patent Law of China.

## **Chapter 2 Brief Introduction of Patent Trials System of Japan and China**

### **2.1 Brief Introduction of Patent Trials System of Japan<sup>2</sup>**

#### **2.1.1 Kinds of cases faced by the Appeal Department**

- ( 1 ) Trials against examiner's decision of refusal**
- ( 2 ) Trials for invalidation**
- ( 3 ) Trials for correction**
- ( 4 ) Hantei ( Advisory Opinion on the Technical Scope of Patented Invention )**
- ( 5 ) Suit against Trial Decision and Supreme Court Appeals**
- ( 6 ) Retrial**

The first trial( 1 )takes place before registration, while ( 2 ), ( 3 )and ( 4 )are after. In practice, ( 1 ) and ( 3 ) are referred to as an ex-parte trial and ( 2 ) and ( 4 ) as inter-parte trial in view of the composition of the parties concerned.

It is provided that administrative organs conduct trials for preliminary determination ( Section 3 of the Court Law ) but they shall not have final judicial power ( Article 76 of the Constitution of Japan ) . If a party is dissatisfied with the judgment at a trial ( trial decision ) , court action may be brought to the IP High Court ( IP High Court (Tokyo High Court) ) or even to the Supreme Court as proceeding ( 5 ) mentioned-above ( Section 178 ) .

Regarding ( 6 ) , against a final and conclusive trial decision, the party concerned or an intervenor may demand a retrial ( Section 171 ) .

#### **2.1.2 Content of cases faced by the Appeal Department**

##### **2.1.2.1 Trial against an Examiner's Decision of Refusal**

###### **( 1 ) Purpose**

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<sup>2</sup> See: IPR 2005 Training Textbooks ( CD-ROM ) , 2005, Japan Paten Office, Asia-Pacific Industrial Property Center, JIII

This trial is one which a party whose application has been refused by an examiner's decision and is dissatisfied may demand; it allows for examination to be reheard ( Section 158 and 159 )

### **( 2 ) Time limit for demanding a trial**

( i ) Within 30 days from the transmittal of a copy of the examiner's decision that the application has been refused ( Section 121 ( 1 ) )

( ii ) Exceptions to the time limit

a ) Where the demandant resides in a place that is remote or difficult to access.<sup>3</sup>

b ) Where the demandant is unable to demand a trial within the time limit prescribed under the preceding ( 1 ) due to reasons beyond control, he may notwithstanding that subsection, make the demand within 14 days ( where he is a resident abroad, within two months ) from the date when reasons to be ceased to be applicable but not later than six months, following the expiration of said time limit. ( Section 121 ( 2 ) )

### **( 3 ) Reconsideration by examiner before an appeal**

Where an amendment has been made by a demandant for a trial to the specification, drawings, or the extent of the claims within 30 days of such demand, the Director-General of the Patent Office shall cause the examiner to examine the demand ( Section 162 ) .

### **( 4 ) Remanding to examination**

1 ) The cases where an examiner's decision has been canceled in a trial ( Section 160 of the Patent Law )

( i ) Where a demand for a trial is adequate and the decision of refusal cannot be maintained.

( ii ) Where proceedings of examination had a material defect and cannot be used as foundation for a trial as is.

( iii ) where there was a violation of laws and ordinances in the process of making a decision itself and the presence of the decision is suspect.

2 ) The adjudication in the trial decision shall be binding on the examiner with respect to the case concerned ( Section 160 ( 2 ) ) .

Where the case is remanded, publication of application shall not be made ( Section 160 ( 3 ) ) .

## **2.1.2.2 Trial for Invalidation**

### **( 1 ) Purpose**

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<sup>3</sup> See: Section 4 of the Patent Law of Japan

Where any of the reasons for invalidation apply to a patent( Section 123( 1 )of the Patent Law ), a trial may be demanded for the invalidation of the patent. A patent cannot be invalidated for reasons other than those listed in the provision. Also, a patent can be invalidated only by this trial, and other organs such as courts cannot invalidate a patent.

A trial for invalidation of patent is different from ex-parte trials in the point that there exist a respondent( patentee )as a party concerned other than the demandant. Where a trial for invalidation has been demanded, the trial examiner-in-chief shall notify the exclusive licensee with respect to the patent right and other persons who have any registered rights relating to the patent ( Section 123 ( 4 ) of the Patent Law ) .

## **( 2 ) Reasons for invalidation**

The reasons for invalidation of patent are listed in each categorical item for Subsection1, section 123 of the Patent Law and the reasons shall be limited to them. The reasons including the following:<sup>4</sup>

1 )Where the amendment does not meet conditions set forth in Clause 3 of Section 17<sup>bis</sup>( 17-2 ) ( Prohibition against adding new matters ) ( Item 1 )

2 ) Where the patent has been granted contrary to Section 25 ( Enjoyment of rights by foreign citizen ) , 29, 29<sup>bis</sup> ( Patentability ) , 32 ( Unpatentable inventions ) ,38 ( Joint application ) or 39 ( 1 ) to ( 4 ) ( First-to-file rule ) ( Item2 ) .

3 ) Where the patent has been granted contrary to the provision of a treaty ( Item3 ) .

4 ) Where the patent has been granted for a patent application which does not comply with the requirements of Section 36 ( 4 ) ( i ) or ( 6 ) ( excluding paragraph ( iv ) ) ( Item4 ) .

5 ) Where the features disclosed in the specification or drawings attached to the request with respect to the patent under application in foreign language do not remain within the scope of the features disclosed in the foreign language document ( Item5 ) .

6 ) Where the patent has been granted on a patent application filed by a person who is not the inventor and has not succeeded to the right to obtain a patent for the invention concerned( Item6 ) .

7 ) Where, after the grant of patent, the patentee has become a party no longer capable of enjoying a patent right under Section 25( Enjoyment of rights by foreign citizens ) or the patent no longer complies with a treaty ( Item7 ) .

8 ) Where the correction of the specification, drawings, or the extent of the claims attached to the request with respect to the patent has been made contrary to the proviso ( Item8 ) .

The failure to meet requirement as provided in Paragraph 4, Subsection 6, Section 36 ( Statement form of claims ) and Section 37 of the Patent Law may become the reason for a decision to refuse, but not invalidate, because such are procedural defects and it would be too

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<sup>4</sup> See: the Patent Law of Japan

severe on the patentee to invalidate a patent as long as no defect exists in the invention itself, the subject of the patent right.

Also, as Paragraph 7, Subsection 1, Section 123 of the Patent Law relates to reasons occurring after the grant of the patent, it shall not naturally be equivalent to reasons for refusal but shall be that for invalidation of the patent.

If there are two or more claims, a trial for invalidation of patent may be demanded for each claim ( Section 123 preamble of the Patent Law ) .

### **( 3 ) Term for demand**

A trial for invalidation of patent may be demanded any time not only during the term of a patent right but also after the extinguishment of a patent right ( Section 123 ( 2 ) of the Patent Law ) .

### **( 4 ) Effect for invalidation**

Where a trial decision that a patent is to be invalidated has become final and conclusive, the patent right shall be deemed to have never existed. As a result, when a trial decision for invalidation has become final and conclusive, any pending civil or criminal suits regarding infringement on that patent right shall become irrelevant in subject matter and the demand shall be dismissed or ruled as not guilty. When a demand has been accepted and a guilty ruling has become final and conclusive, a retrial shall be justifiable.

However, if a trial decision that the patent is to be invalidated has become final and conclusive in the case where the patent falls under Paragraph 7, Subsection 1, Section 123 of the Patent Law ( Reasons for invalidation after patent ), the patent right shall be deemed not to have existed from the time it first under that paragraph ( Section 125 of the Patent Law ) .

## **2.1.2.3 Trials for Correction**

### **( 1 ) Purpose**

Where partial defects exist in a patent, a trial for invalidation may be demanded in regard to the entire patent because of the defect. The system for trials for correction allows for voluntarily elimination of defective elements in applications as prior preparations for such strategic attacks and as a means to handle infringement brought on by ambiguous description. As it is sufficient to permit correction within a minimum range to achieve the purpose, the patentee may demand a correction of the specification, drawings, or the extent of the claims attached to the request only with the purpose provided in Paragraphs of Subsection 1, Section 126 of the Patent Law ( Section 126( 1 ) ). However, as the effects of the correction will have a material influence on the interested

party, if there is an exclusive licensee, a pledge or a non-exclusive licensee, the patentee may demand a trial only with the consent of such person.<sup>5</sup>

## **( 2 ) Range for Correction**

The above matters provided in Paragraph in Subsection 1, Section 126 of the Patent Law are as follows:

- 1 ) The restriction of claim ( s ) ( Item 1 )
- 2 ) The correction of errors in the description or translation ( Item 2 )
- 3 ) The clarification of an ambiguous descriptions ( Item 3 )

The correction of the specification or drawings may neither add new items to the claims ( Section 126 ( 3 ) ) nor substantially enlarge or modify the claim ( s ) ( Section 126 ( 4 ) ) . Also , if the restriction of claim ( s ) is sought, an invention constituted by the feature described in the corrected claim must be one which could have been patented independently at the time of filling of the patent application ( Section 126 ( 5 ) ) .

## **( 3 ) Term for demand**

A trial may be demanded not only within the term of the patent right but also even after the extinguishment of the patent right. However, a trial may not be demanded after the patent has been invalidated on a trial ( Section 126 ( 5 ) ) .

## **( 4 ) Effect for correction**

Where a trial ruling that a correction may be made has become final and conclusive, all materials including the patent application, the laying open of the application, the examiner's decision/trial decision stating that the patent is to be granted, and the registration of establishment of the patent right shall be deemed to have been made on the basis of the corrected specification, drawings, or the extent of the claims ( Section 128 ) .

## **( 5 ) Procedures for correction**

Where a demand for a trial does not relate to any of the matters in Paragraph 1 to 3, Subsection 1, Section 126 or does not comply with Subsection 3 to 5, Section 126, the trial examiner-in-chief shall notify the demandant of the reasons therefore and shall designate an adequate time limit so as to give an opportunity to submit necessary views in writing ( Section 165 ) .

When a trial decision allowing correction of the specification, drawings, or the extent of the claims as attached to the request has become final and conclusive as well as registered, a new certificate of patent shall be issued to the patentee ( Section 128 ( 1 ) ) .

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<sup>5</sup> See: Section 127 of the Patent Law of Japan

#### **2.1.2.4 Hantei ( Advisory Opinion on Technical Scope of a Patented Invention )**

##### **( 1 ) Significance of the Hantei system**

When a dispute over a matter such as patent infringement arises, or when an invention is to be worked, it becomes necessary to make sure that the patent right is not infringed upon. In this case, the parties concerned tend to make favorably-prejudiced judgments on the technical scope of the patented invention, that is, the extent of the patent right. Thus, an official body is required to make a fair judgment on the technical scope of the patented invention. The Patent Office respond to the above request with a Hantei system ( Section 71 ) .

Hantei requests are limited to those which determine whether certain technical contents belong to the technical scope of a specific patent right or not.

Hantei is in the nature of a judgment and not legally binding, but as the determination is made by the Administrative Office, according to proceedings conforming to a trial, the judgment has a value higher than individual appraisals.

##### **( 2 ) Hantei Procedure**

Each Hantei shall be conducted by three appeal examiners designated by the Director-General of the Patent Office ( Section 71 ( 2 ) ) , and the Hantei procedure is prepared for in ruling procedures.

#### **2.1.2.5 Suit against Trial and Supreme Court Appeals**

##### **( 1 ) Suit against Trial Decision**

( i ) The trial decision and rulings by the Patent Office are administrative dispositions, and action taken against them, such as suits, is administrated by judicial courts so as to determine whether the trial decision by the Patent Office which is an administrative office, was illegal or not. Thus, the Administrative Case Litigation Law shall apply in principle. But as litigation in the form of suits against trial decision is slightly different in nature from ordinary administrative cases, special provisions are provided in Section 178 to 184<sup>bis</sup> of the Patent Law. This falls under special provisions in another law provided in Section 1 of the Administrative Case Litigation Law stating that this law shall apply to administrative case litigation unless there are special provisions in another law.

( ii ) An action against a trial decision, a ruling to revoke a patent or dismiss a written opposition, or a demand for a trial or retrial, shall come under the exclusive jurisdiction of the IP High Court (Tokyo High Court) ( Section 178 ( 1 ) of the Patent Law ) . As trial proceedings are

conducted at the Patent Office, strictly according to judicial proceedings similar to those in the courts, if a thrice-held trial( District Court to Supreme Court )takes place, closure of case would be delayed in vain. Also, since inner workings of the case are extremely professional and technical, trial proceedings by patent experts may be respected. Thus, the first court may be omitted and an action may be brought directly to the IP High Court (Tokyo High Court).

Trial decisions by the Fair Trade Commission and rulings by the High Marine Tribunal shall also come under the exclusive jurisdiction of the IP High Court (Tokyo High Court). The decisions here include both trial and retrial decisions. The rulings do not include those on exclusion, challenge or acceptance of intervention.

( iii )an action against trial decision or other matters may be instituted only by an original party, an intervenor, or an applicant to intervene in examination of opposition to the grant of a patent in the trial or retrial ( Section 178 ( 2 ) ) .

In an action against a trial for invalidation ( i.e. inter-partes trial ) , the defendant shall be the demandant or defendant in the trial or retrial for invalidation, or shall be the Director-General of the Patent office in other trials( Section 179 of the Patent Law, Section 47( 2 )of the Utility Model Law ) .

( iv )The time limit for instituting an action is 30 days from the date of transmittal of the ruling, and this time shall be invariable ( Section 178 ( 3 ) and ( 4 ) ) .

The trial examiner-in-chief may ex officio designate a period additional to the above invariable period for benefit of a person residing in a place that is remote or difficult of access ( Section 175 ( 5 ) ) .

( v ) Where the court find for the plaintiff in a court trial, it shall annul the trial decision or ruling ( Section 181 ( 1 ) ) , and when the court's decision annulling a trial decision or ruling has become final and conclusive, the trial examiner shall carry out a further trial examination and render a trial decision or ruling ( Section 181 ( 5 ) ) . The court cannot make a decision on whether the patent is to be granted or invalidated.

## **( 2 ) Appeal to the Supreme Court**

( i ) A party dissatisfied with the decision of the IP High Court (Tokyo High Court) may appeal to the Supreme Court.

( ii )The time limit for making appeals is two weeks from the date of the decision( Section 396 of the Code of Civil Procedure ) , and this time limit shall be invariable( Civil Code Section 285 as applies mutatis mutandis to Section 313 ) . Appeals shall be submitted to the High Court ( Same as above ) .



( iii ) The reasons for appeals shall be limited to those provided in Section 394 of the Code of Civil Procedure such as misinterpretation of the Constitution in the decision or the absolute reasons for appeal provided in Section 395.

( iv ) The decision shall be dismissal of appeal, rejection of appeal, reverse or reverse and remand, or own judgment.

#### **2.1.2.6 Retrial**

##### **( 1 ) Significance of the Retrial System**

Retrial were originally only allowed based on special reasons, conceptually contained in the codes of procedure and extraordinary measures for filing complaints after a decision has become final and conclusive. The retrial system has been introduced to the Patent Law. To dispute a final and conclusive trial decision should not generally be allowed since it would impair legal stability, but if the course for appeals is totally shut down, the valid request would also be effectively shut out. Thus, a retrial may be demand only for reasons limited to such items as material defects in trial proceedings ( Section 171 ) .

As for the limited reasons, Section 1 and 2, Section 420 and Section 421 ( grounds for retrial ) of the Code of Civil Procedure shall apply mutatis mutandis to the demand for a retrial ( Section 171 ( 2 ) ) .

##### **( 2 ) Retrial procedures**

###### **( i ) Time limit on demands for retrials**

A retrial must be demanded within 30 days from the date on which the demandant became aware of the grounds for the retrial after a trial decision has become final and conclusive ( Section 173 ( 1 ) ) . However, no demand for a retrial may be made after the expiration of three years from the date on which the trial decision became final and conclusive ( Section 173 ( 4 ) ) .

###### **( ii ) Other proceedings**

Trial proceedings shall apply mutatis mutandis to retrial proceedings ( Section 174 ) .

## **2.2 Brief Introduction of Patent Trials System of China<sup>6</sup>**

### **2.2.1 Kinds of cases faced by the Patent Reexamination Board of SIPO in China**

#### **( 1 ) Trials against examiner's decision of refusal**

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<sup>6</sup> See: the Part IV of the Guidelines for Examination of SIPO ( English vision ) , which was promulgated and effective as of October 18, 2001.

## **( 2 ) Trials for invalidation**

### **( 3 ) Suit against Trial Decision and High Court Appeals**

The first trial ( 1 ) takes place before registration, while ( 2 ) is after. In practice, ( 1 ) is referred to as an ex-parte trial and ( 2 ) as inter-parte trial in view of the composition of the parties concerned.

It is provided that the Reexamination Board conduct trials for preliminary determination, but they shall not have final judicial power ( Article 41 and 47 of the Patent Law of China ) . If a party is dissatisfied with the judgment at a trial ( trial decision ) , court action may be brought to the Beijing First Intermediate Court or even to the Beijing High Court as proceeding ( 3 ) mentioned-above.

## **2.2.2 Content of cases faced by the Patent Reexamination Board of SIPO in China**

### **2.2.2.1 Trial against an Examiner's Decision of Refusal**

#### **( 1 ) Purpose**

In accordance with the provision of Article 41.1 of the Patent law of China, cases of request for reexamination by the Patent Reexamination Board are those made for reexamination out of dissatisfaction with the decision of rejection by the Patent Office, including cases involving reexamination of the rejection applications in the preliminary and substantive examination.

#### **( 2 ) Time limit for demanding a trial**

( i ) Within 3 months from the transmittal of a copy of the examiner's decision that the application has been refused.<sup>7</sup>

( ii ) Exceptions to the time limit

a ) Where the demandant is unable to demand a trial within the time limit prescribed under the preceding ( i ) because of force majeure, resulting in loss of his or its right, he or it may, within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit.<sup>8</sup>

b ) Where the demandant is unable to demand a trial within the time limit prescribed under the preceding ( i ) because of any justified reason, resulting in loss of his or its right, he or it may, within two months from the date of receipt of a notification from the Patent Administration Department under the State Council. ( Rule 7.2 of Implementing Regulations of the Patent Law of China )

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<sup>7</sup> See: Article 41.1 of the Patent Law of China

<sup>8</sup> See: Rule 7.1 of the Implementing Regulations of the Patent Law of China

### **( 3 ) Reconsideration by examiner before an appeal**

The Patent Reexamination Board shall remit the request for reexamination which the board has received to the examination department which has made the examination of the application concerned to make an examination. Where that examination department agrees to revoke its former decision upon the request of reexamination, the Patent Reexamination Board shall make a decision accordingly and notify the requesting person ( Rule 61 of Implementing Regulations of the Patent Law of China ) .

### **( 4 ) Remanding to examination**

1 ) The cases where an examiner's decision has been canceled in a trial ( Rule 62.2 of Implementing Regulations of the Patent Law of China )

- ( i ) the laws and regulations applied in the decision of rejection are not correct;
- ( ii ) the grounds for rejection are not supported by the necessary evidence;
- ( iii ) the examination has violated the set legal procedures;
- ( iv ) any other circumstances where grounds of rejection are not tenable.

2 ) Where the reexamination decision revokes the decision made by the examination department that made the initial examination, the said examination department shall carry out the reexamination decision and no decision contrary to the reexamination decision shall be made based on the same reason and evidence.<sup>9</sup>

## **2.2.2.2 Trial for Invalidation**

### **( 1 ) Purpose**

In accordance with the provision of Article 45 of the Patent law of China, where, starting from the date of the announcement of the grant of the patent right by the Patent Administration Department under the State Council, any entity or individual considers that the grant of the said patent right is not in conformity with the relevant provisions of this law, it or he may request the Patent Reexamination Board to declare the patent right invalid.

A trial for invalidation of patent is different from ex-parte trials in the point that there exist a respondent ( patentee ) as a party concerned other than the demandant.

### **( 2 ) Reasons for invalidation**

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<sup>9</sup> See: 9 of the Chapter 2 of the Part IV of the Guidelines for Examination of SIPO ( English version ) , which was promulgated and effective as of October 18, 2001.

The reasons for invalidation of patent are listed in Rule 64.2 of the Implementing Regulations of the Patent Law of China:<sup>10</sup>

1 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 22 or 23 of the Patent Law of China ( Lack of Patentability ) .

2 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 26.3 of the Patent Law of China ( the Description not setting forth the invention-creation in a manner clear and complete sufficiently ) .

3 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 26.4 of the Patent Law of China ( the Claims not being supported by the description to state the extent of the patent protection asked for ) .

4 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 33 of the Patent Law of China ( Amendment beyond the scope of the disclosure contained in the initial description and claims ) .

5 ) The invention-creation for which the patent right is granted does not comply with the provisions of Rule 2 of the Implementing Regulation of the Patent Law of China ( the concept of the “invention”, “utility model” and “design” ) .

6 ) The invention-creation for which the patent right is granted does not comply with the provisions of Rule 13.1 of the Implementing Regulation of the Patent Law of China ( Only one patent right for any identical invention-creation ) .

7 ) The invention-creation for which the patent right is granted does not comply with the provisions of Rule 20.1 of the Implementing Regulation of the Patent Law of China ( The claims not being defined clearly and concisely ) .

8 ) The invention-creation for which the patent right is granted does not comply with the provisions of Rule 21.2 of the Implementing Regulation of the Patent Law of China ( the independent claim lack of the essential technical features necessary for the solution of its technical problem ) .

9 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 5 of the Patent Law of China ( Contrary to the law of the State or social morality or being detrimental to public interest ) .

10 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 25 of the Patent Law of China ( the unpatentable subject matters ) .

11 ) The invention-creation for which the patent right is granted does not comply with the provisions of Article 9 of the Patent Law of China ( the first-file principle ) .

### **( 3 ) Term for demand**

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<sup>10</sup> See: the Patent Law of China and the Implementing Regulations of the Patent Law of China

A trial for invalidation of patent may be demanded at any time only after the date of the announcement of the grant of the patent right ( Article 45 of the Patent Law of China ) .

#### **( 4 ) Effect for invalidation**

Any patent right which has been declared invalid shall be deemed to be non-existent from the beginning.

The decision declaring the patent right invalid shall have no retroactive effect on any judgment or ruling of patent infringement which has been pronounced and enforced by the people's court, on any decision concerning the handling of a dispute over patent infringement which has been complied with or compulsorily executed, or on any contract of patent license or of assignment of patent right which has been performed prior to the declaration of the patent right invalid; however, the damage caused to other persons in bad faith on the part of the patentee shall be compensated.

If , pursuant to the provisions of the preceding paragraph, the patentee or the assignor of the patent right makes no repayment to the licensee or the assignee of the patent right of the fee for the exploitation of the patent or of the price for the assignment of the patent right, which is obviously contrary to the principle of equity, the patentee or the assignor of the patent right shall repay the whole or part of the fee for the exploitation of the patent or of the price for the assignment of the patent right to the licensee or the assignee of the patent right. ( Article 47 of the Patent Law of China ) .

### **2.2.2.3 Suit against Trial and High Court Appeals**

#### **( 1 ) Suit against Trial Decision**

a ) Where the entity/person who requests for reexamination is not satisfied with the reexamination decision, it/ he may institute legal proceedings in the people's court according to Article 41.2 of the Patent Law of China within three months from the date of receipt of the reexamination decision. The Patent Reexamination Board shall appear before court ( "the court" refers to the Beijing First Intermediate People's Court ) .

b ) After the Patent Reexamination Board makes the decision of examination on request for invalidation, where the party concerned to whom the decision is unfavorable is not satisfied with the invalidation decision, it/ he may institute legal proceedings in the people's court according to Article 46.2 of the Patent Law of China within three months from the date of receipt of the invalidation decision. The Patent Reexamination Board shall appear before court. The people's court shall notify the person that the opponent party of that party in the invalidation procedure is to appear as a third party in the legal proceedings ( "the court" refers to the Beijing First Intermediate People's Court ) .

## **( 2 ) Appeal to the High Court**

( i ) A party dissatisfied with the decision of the Beijing First Intermediate People's Court may appeal to the Beijing High Court.

( ii ) The time limit for making appeals is 15 days from the date of the decision, and this time limit shall be invariable. Appeals shall be submitted to the Beijing High People's Court.

## **2.3 Brief Summary**

The basic structure of patent trials system of Japan and China is similar. For example, the ex-parte trial and inter-parte trial are all set up in two country's patent trials systems. Among them, the reexamination procedure of SIPO is corresponded to the trial against an examiner's decision of refusal of JPO; the invalidation procedure of SIPO is corresponded to the trial for invalidation of JPO. But there are some types of trials, for example, trial for correction, Hantei, retrial and so on, which are not existent in SIPO. Even regarding the reexamination and invalidation, it also has some differences in detail between two country's proceedings.

The author will compare patent appeals examination proceedings between JPO and SIPO, especially for reexamination and invalidation. The first subject to be compared is the common matters for all kind of appeal or trial (General), for example, the nature of appeal system, prohibition of double jeopardy, consolidation or separation of appeal/trial examination, interview by collegial body, ex-officio principle and ex-officio investigation, and so on. The next subject to be compared is the invalidation proceeding and reexamination proceeding which will be compared in detail.

After that, the author will introduce emphatically what he have learned from appeal/trial system of JPO, that are some appeal/trial proceedings which are not existent in the Patent Reexamination Board of SIPO, such as trial for correction, Hantei, information providing system, retrial, the Japanese IP judicial system and so on.

## **Chapter 3 Comparison of Common Matters for All Kind of Appeal or Trial (General)**

### **3.1 Legal Nature of Patent Trials/Appeals and Trial/Appeal Decisions**

#### **3.1.1 The Legal Nature of Patent Trials/Appeals in JPO**

1. Administrative Dispositions Akin to Lawsuits in Nature

Decisions which are examined in suits against trial/appeal decisions are classified as administrative dispositions. However, in terms of their legal nature, such dispositions can be called “quasi-lawsuit administrative dispositions.”

There are various types of administrative dispositions, but the nature of trial/appeal decisions that are the subjects of lawsuits filed to revoke such decisions are most akin to those of lawsuits in that (a) the decisions are directly related to the creation and lapse of a patent right, which is a private right, (b) they are allowed no latitude (namely, they have no discretion) and (c) for other reasons. Although classified as administrative dispositions, such trial/appeal decisions are closely akin to court actions in essence. In terms of the general characteristics (such as discretion and policy aims, etc.) of “typical” administrative dispositions, such trial/appeal decisions fall in the category farthest from “typical” administrative dispositions.

## 2. Special Characteristics of Patent Trial/ Appeal Proceedings

Patent trial/appeal proceedings have the following special characteristics compared with other general administrative procedures: (i) In terms of their nature, these are proceedings intended for quasi-lawsuit administrative dispositions; (ii) Viewed from the procedural aspect, these are proceedings closely akin to judicial proceedings (in the sense that procedural due process is highly guaranteed); (iii) Subjects taken up in patent appeal/trial procedures are technical and specialized.<sup>11</sup>

## 3. A Trial is Equivalent to the First Instance in Judicial Three-instance System

A suit against a trial decision is an exclusive jurisdiction of the IP High Court (Tokyo High Court).

A trial is the last administrative disposition by the Patent Office. The Constitution stipulates that an administrative organ is not prevented from conducting trials as preliminary trials (Section 3 of the Court Organization Law), but cannot conduct a trial as a last resort (Section 76, Subsection 2 of the Constitution). A party dissatisfied with a trial decision can file a suit against a trial decision in court.

This suit is an exclusive jurisdiction of the Intellectual Property High Court (Section 178 of the Patent Law). There are two possible reasons for this: trials are carried out by quasi-judicial proceedings similar to court, and Section 3, Subsection 2 of the Court Organization Law stipulates that an administrative organ is not prevented from conducting trials as preliminary trials.<sup>12</sup>

In one word, the patent trials/appeals in JPO have its “quasi-judicial” nature.

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<sup>11</sup> See: P307-P309 of “Basic Structure Theory of the Suit against the Patent Trial”, Japanese vision, “特許審決取消訴訟基本構造論”, 大淵哲也, 有斐閣, 2003

<sup>12</sup> See: the lecture named “The Appeal/Trial System” by Mr. Yoshio Mizutani, Patent Lawyer, JPO/IPR Training Course for Lawyers (FY 2006)

### **3.1.2 The legal nature of Patent Trial/Appeals in SIPO**

In SIPO, the Patent Reexamination Board acts as a typical administrative organization factually though the invalidation cases dealt with by it appear like so-called “quasi-judicial” proceeding. So the decisions made by the Patent Reexamination Board are the administrative disposition. Some one think the Patent Reexamination Board has “quasi-judicial” position. The others think that Reexamination cases are applied with administrative proceeding, while Invalidation cases are applied with “quasi-judicial” proceeding. So some one think the Patent Reexamination Board is a “quasi-lawsuit” administrative organization. But in fact, the Patent Reexamination Board only acts as a typical administrative organization because laws do not give it the position like the court. So the decisions made by the Patent Reexamination Board are only the administrative disposition yet. In practical examination, when the parties/party were/was dissatisfied the decision made by the Patent Reexamination Board and instituted legal proceedings in the people’s court, the Patent Reexamination Board would acts as a defendant in the cases including the Reexamination and Invalidation. Although the Patent Reexamination Board acts as an administrative organization, the Invalidation procedures applied by it are more like the court proceedings.<sup>13</sup>

### **3.1.3 Comparison**

1. The position of the Appeal Department of JPO and the Patent Reexamination Board of SIPO is different

The Appeal Department of JPO acts as a “quasi-judicial” role, at least as a “quasi-lawsuit administrative” role. On the other hand, the Patent Reexamination Board of SIPO only acts as an administrative role.

The Appeal Department of JPO is in charge of the Appeals/Trials examination of Patent, Utility Model, Design, and Trade Mark. The Patent Reexamination Board of SIPO is only in charge of the Reexamination/Invalidation examination of Patent including Invention, Utility Model and Design.

2. The judicial system of patent administrative cases is different

Regarding inter-parte patent administrative cases, such as trial for invalidation, the Appeal Department of JPO is not acted as the defendant in court proceedings, while the Patent Reexamination Board of SIPO must be acted as the defendant in court proceedings, the dissatisfied party as the plaintiff, the virtual adversary as the third party.

Moreover, there are three instances examination in the judicial system of Japan, and regarding the patent administrative cases, the Appeal Department of JPO conducts the first instance examination, that is, the So-called “Preliminary Trial”. In china, there are two instances

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<sup>13</sup> All viewpoint expressed in this research are researcher’s and not those of his organization



examination in the judicial system, and the Patent Reexamination Board of SIPO only conducts the administrative procedures, not one instance examination of judicial.

3. The common points of both organizations lie as follows:

a. Regarding Reexaminations/Trials against examiner's decision of refusal, the procedures and the position of both organizations is similar.

b. Regarding Invalidations/Trials for Invalidation, the procedures is similar, that is, the demands of invalidation are dealt with as administrative cases in civil procedures.

## **3.2 Prohibition of Double Jeopardy**

### **3.2.1 The Regulations of JPO**

#### **1. Prohibition of Double Jeopardy<sup>14</sup>**

When a final and conclusive decision has been registered (Patent Registration Order Enforcement Regulation Section 37) for any of following trial examinations, no one may demand trial examinations of the same kind (hereafter referred to as "same trials") on basis of same facts and same evidence. (Patent Law Section 167)

(1) Final and Conclusive Trial Decision of Trial for Invalidation

(2) Final and Conclusive Trial Decision of Trial for Invalidation of Registration of Extension of Term for Patent Right

The aim for providing such restriction lies in maintaining the authority of final and conclusive decisions, by avoiding the occurrence of two or more conflicting decisions based on the same facts and same evidence, as well as preventing needless demands for trial, and thus relieving the opposing party from the trouble of repeated preparation of responses for the same trials. The effect of prohibition of double jeopardy is another effect of the final and conclusive trial decision.

#### **2. Same trials**

Same trials are understood to mean trials seeking the same relief, or in other word, trials of the same type having the same right as the object of demand.

As there is no provision regarding the demandant of trial, the prohibition of double jeopardy is not affected by the sameness of demandant. Hence, for example, the same demandant may demand a trial for invalidation again, provided it is not based on the same facts and evidence.

#### **3. Same Facts, Same Evidence**

##### **(1) Same Facts**

By Same Facts is meant, the same facts being cited as grounds for invalidation in trials for invalidation.

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<sup>14</sup> See: Part of 30-02 of Manual of Appeal and Trial Proceedings in JPO (Japanese version), that is, 30-02 of "審判便覧", <http://www.jpo.go.jp/shiryuu/index.htm>

For example, where a final and conclusive decision has been made on grounds of demand that the present device is identical to a device described in a publication, a demand made on grounds that the present device could very easily have been derived from the device described in the same publication, is deemed as a demand based on different fact.

#### (2) Same Evidence

By Same Evidence is meant, evidence that is identical in content.

Hence, even when the evidence themselves are different, if they are essentially of the same content, they are deemed the same. On the other hand, evidence cited from the same publication are not deemed the same, if they cite different portions, and are cited with the aim of showing different technical contents.

#### 4. Application to Other Concurrent Trial Cases

Where two demands for same trials based on the same facts and same evidence have been made against a patent, and a trial decision made for one of the demands has become final and conclusive, there are two opposing thoughts as to whether the other demand could be dismissed on grounds of Patent Law Section 167. It is more commonly thought that the second demand could not be dismissed.

In such cases where two same trials have been demanded, and no trial decision has been made for either, combination of the examinations or decisions for the two cases is possible. (Patent Law Section 154)

#### 5. When the Final and Conclusive Decision is of Dismissal

There is a precedent court decision stating that, the provision of Patent Law Section 167 does not apply when a demand for trial examination has been dismissed for reasons such as the case being raised by a demandant who is not an interested party, the reason being that the said provision should apply under the premise that the trial examination is made upon completion of examination of substance of the demand relating to the invalidation of patent and other items specified in said provision, taking into account the facts and evidence submitted by the demandant of trial.

#### 6. Proprietary Interest and Prohibition of Double Jeopardy

There is a precedent court decision stating that, demand for same trials based on the same facts and same evidence regarding proprietary interest is not allowed, after registration of a final and conclusive trial decision of dismissal of demand made on grounds of lack of proprietary interest.

### **3.2.2 The Regulations of SIPO<sup>15</sup>**

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<sup>15</sup> See: 3.3 of the Chapter3, Part IV of the Guidelines for Examination of SIPO ( English vision ) , which was promulgated and effective as of October 18, 2001.

1. Non Bis in Idem (Used by SIPO which have the same meaning with the concept of “Prohibition of Double Jeopardy”)

According the provision of Rule 65.2 of Implementing Regulations of The Patent Law of China, where, after a decision on any request for invalidation of the patent right is made, invalidation based on the same facts and evidence is requested once again, the Patent Reexamination Board shall not accept it.

2. Principle of Non Bis in Idem

Any patent right that is covered in a closed invalidation case, if requested for invalidation on the same grounds and evidence, shall not be allowable.

For any request for invalidation that is raised at a second time, if the grounds and the evidence of which were not taken into consideration in the prior examination decision due to limit of time etc., shall not belong to cases that are not allowable as mentioned above.

### 3.2.3 Comparison

Regarding the **Prohibition of double jeopardy** in JPO and the **Non Bis in Idem** in SIPO, they have the similar meaning and their aim and effect is same, only the expression in word is different.

Regarding application to other concurrent trial cases, where two demands for same trials based on the same facts and same evidence have been made against a patent, when no trial decision has been made for either, the prefer choice in SIPO is combination of the examinations or decisions for the two cases, which is similar to JPO; but when a trial decision made for one of the demands has become final and conclusive, it is a commonly thought in SIPO that second demand could be dismissed, which is different from JPO.

## 3.3 Consolidation/Separation of Appeal/Trial Examination

### 3.3.1 The regulation of JPO

I. Consolidation of Appeal/Trial Examinations<sup>16</sup>

1. Definition of Consolidation of Appeal/Trial Examinations

By consolidation of appeal/trial examinations is meant, consolidation of examination of two or more appeal or trial cases under the same examination proceedings. Patent Law Section 154(1) provides that two or more appeal or trial examination cases having in common one or both of interested parties may be consolidated.

2. Purpose of Consolidation of Appeal/Trial Examinations

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<sup>16</sup> See: Part of 30-03 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 30-03 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

The consolidation of appeal/trial examinations avoids duplication of examination and economies on examination procedures, and at the same time avoids contradiction and interference between decisions.

### 3. Requirement for Consolidation of Appeal/Trial Examinations

#### (1) Sameness of One or Both of Interested Parties

Either one or both of the interested parties being in common is sufficient for consolidation of examinations, for both inter-partes and appeal examinations.

#### (2) Two or More Appeal/Trial Examination Cases

The “two or more appeal/trial examinations cases” that could be consolidated must be those of the same type.

#### (3) Necessity of Consolidation of Appeal/Trial Examinations

It is required to be found that the consolidation of cases could be expected to result in the purpose of consolidation being attained.

The following are examples of conditions which could be expected to result in attaining the purpose of consolidation:

- (i) Cases calling for similar examinations of evidence.
  - (ii) Cases with common technical basis for the inventions involved.
  - (iii) Cases with common cited reference and means of proof.
  - (iv) Two or more trials for invalidation against the same patent.
- #### (4) Timing of Consolidation

Consolidation of cases shall take place before conclusion of examination.

### 4. Procedures for Consolidation of Appeal/Trial Examination

#### (1) Determination by (Collegial Body of) Appeal/Trial Examiner(s)

The power of determining whether or not to consolidate examination procedures lies with the collegial body of) appeal/trial examiner(s).The examiner(s) may decide ex officio, under free judgment.

#### (2) Notification of Decision to Consolidate Appeal or Trial Examinations

When examinations are to be consolidated, the Appeal/Trial Examiner-in-chief shall notify the party (ies) involved to that effect.

### 5. Effect of Consolidation of Appeal/Trial Examination

(1) Appeal/trial decisions can be made at the same time with a single decision, for the number of cases that have been consolidated.

#### (2) Utilization of Submitted Documents and Means of Proof etc.

When two or more appeal/trial examinations have been consolidated, documents and other items submitted or shown for each case prior to consolidation, and means of proof obtained in the

examination of each case prior to consolidation, may be utilized in the consolidated appeal or trial case.

## II. Separation of Appeal/trial examination<sup>17</sup>

### 1. Significance of Separation of Examinations

By separation of appeal or trial examination is meant, the separation of cases that have been consolidated, i.e. two or more appeal/trial examination cases that have been consolidated for examination under the same examination proceedings. Patent Law Section 154(2) states that cases that have been consolidated under the provisions of the proceeding paragraphs may be separated again.

Separation of appeal or trial examination cases simplifies and accelerates proceedings, when a case is found to be unrelated to another, and hence that not only is there no need to examine the cases under the same procedures, but also that examining the cases under the same procedures is causing complication and delay of proceedings.

### 2. Requirements for Separation of Examinations

Examinations may be separated only where they have been consolidated.

### 3. Procedures for Separation of Examinations

The power to determine whether or not to separate examinations lies with the (collegial body of) examiner(s). Separation is carried out with a decision made ex officio.

When cases are to be separated, the Appeal Examiner-in-Chief shall notify the party (ies) involved to that effect.

### 4. Effect of Separation of Examinations

Appeal/trial examination cases, separated by a decision to separate examinations, are examined under separate and independent examination proceedings, and decided separately.

Documents and other evidence submitted prior to separation are equally effective in the examination of each of the separated cases.

## **3.3.2 The Regulation of SIPO**

There is no detailed regulation regarding the consolidation or separation of appeal/trial examination in the Patent Law and the Implementing Regulations of the Patent Law of China. Only in the Guidelines for Examination of SIPO is there a Principle of Consolidated Examination. The Principle of Consolidated Examination is that if more than one request for invalidation have

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<sup>17</sup> See: Part of 30-03 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 30-03 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

been put forward in respect of one patent right, the requests shall be handled together as much as possible and all the persons requesting for invalidation shall be the parties concerned.<sup>18</sup>

### **3.3.3 Comparison**

1. The purpose of Consolidation/Consolidated Examination in both countries is same, which is to avoid duplication of examination and economies on examination procedures, and at the same time to avoid contradiction and interference between decisions.

2. In JPO, the Consolidation of Appeal/Trial Examination is applied to many kinds of cases including the trials for examiner's decision of refusal, trials for invalidation, and so on. On the other hand, in SIPO, the Consolidated Examination is only applied to the invalidation cases, not being applied to the Reexamination cases. But in practical examinations in the Appeal Department of JPO, the Consolidation of Appeal/Trial Examination is mainly focused on the invalidation cases. So from the view point of practical examination, it is similar for both countries.

3. In SIPO, only in the case that there are two or more trials for invalidation against the same patent, it is possible to conduct the consolidated examination. But in JPO, as long as the cases which could be expected to result in attaining the purpose of consolidation, they could be consolidated together, for example, (i) Cases calling for similar examinations of evidence, (ii) Cases with common technical basis for the inventions involved and (iii) Cases with common cited reference and means of proof. But in practical examination of the Appeal Department of JPO, the main case to conduct the consolidated examination is also that there are two or more trials for invalidation against the same patent, which is similar to the situation of the Patent Reexamination Board of SIPO.

4. In JPO, when two or more appeal/trial examinations have been consolidated, documents and other items submitted or shown for each case prior to consolidation, and means of proof obtained in the examination of each case prior to consolidation, may be utilized in the consolidated appeal or trial case. Whether the request of the documents and the means of proof obtained in the examination of each case prior to consolidation being used together may be accepted depend on the trial examiner-in-chief, that is, there is possibility to utilize the former documents and the means of proof together against the same patent. On the other hand, in the Patent Reexamination Board, although the documents and the means of proof obtained in the examination of each case prior to consolidation may be utilized in the consolidated invalidation, they only are used independently, that is, it is not permitted to utilize the former documents and the means of proof together against the same patent.

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<sup>18</sup> See: 3.5 of the Chapter3, Part IV of the Guidelines for Examination of SIPO ( English vision ) , which was promulgated and effective as of October 18, 2001.

5. In SIPO, there is no related regulation regarding the Separation of Appeal/Trial examination. And in practical examinations, there is also nearly no case about separation of Invalidation Examination. Once the cases have been consolidated together, they would not be separated again. This is different from the regulation of JPO.

### **3.4 Interview by Collegial Body**

#### **3.4.1 The Regulation of JPO<sup>19</sup>**

##### 1. Intent of an Interview

“Interview” refers to face-to-face talks between a collegial body and appellant’s party (appellant, representative, etc.) or an appellee’s party (appellee, representative, etc.), in an attempt to enhance mutual understanding, thereby facilitating procedures.

Procedures in Appeal consist of appeals against decisions taken by examiners and inter-partes cases, each having different circumstances.

For example, in inter-partes cases, rigid procedures similar to those employed in general courts should be complied with, and, even a communication for clarification with only one party should be avoided.

It is noted here that the followings are treated *mutatis mutandis* as interview above: communications by telephone, facsimile, etc. between a collegial body and an appellant or representative in relation to appeal cases intended for mutual understanding; a hand delivery of a notice of reason for rejection conducted subsequent to those communications. When an “interview” involves these acts, it is referred to collectively as “interviews, etc.”

In contrast, such communications as follows are not intended for mutual understanding concerning appeal cases, etc. and are not included in above mentioned “interviews, etc.”: 1) clerical communications, 2) inquiries on the progress of procedures, or 3) clarification on technical matters or goods in appeal cases which do not include arguments on patentability (registability of utility models), or registability of design patents, requirements for description in specification, requirements for unity of invention, requirements for amendment, existence of priority rights, or requirements for special applications (divisional and converted applications, etc.) (hereinafter referred to as “arguments of patentability”).

A collegial body above mentioned shall read as an appeal examiner where an appeal examiner in charge of the case conducts interviews, etc. alone.

##### 2. Circumstances in which an interview is conducted

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<sup>19</sup> See: Part of 30-04 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 30-04 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

(1) Ex-parte cases

(a) The appeal examiner in charge conducts an interview alone if he or she considers it necessary prior to the examination by the collegial body in such cases as:

1) The complicated contents of descriptions, arguments or amendments make it difficult to understand the present inventions (utility models) design, and the differences against prior arts, thereby hindering an evaluation of patentability, etc. of the present invention or design.

2) Documents are so complicatedly inter-related that arguments for patentability, etc. or differences against prior arts can not be understood.

3) Inconsistency between the grounds of appeal or the arguments, and the description or the amendment makes it difficult to understand on what grounds the appellant intends to argue against the examiner's decision.

(b) The collegial body or the appeal examiner in charge alone conducts an interview if the body considers it necessary in such cases as:

1) A notice of reason for rejection is to be issued on the basis of, for example, deficiencies in the description, and it seems better to hold an interview in advance for communicating with the appellant rightly.

2) Other cases where an interview seems necessary for promoting the procedures or furthering mutual understanding.

It is noted that, in asking for an interview, attention should be paid not to give undue burden to an appellant or representative, taking into account for example geographical inconvenience. Communication over the telephone or facsimile in advance is invited to facilitate an interview.

(c) An interview should be held except for exceptional case at least one time during the appeal procedure when an appellant or representative requests it. Request of late or second interview may not be accepted unless it contributes to the furtherance of proceedings.

(2) Inter-partes cases

(a) An interview may be held ex-officio or on request even in inter-partes, if it facilitates proceedings just like the case in (1) (a) above. Inter-partes cases are proceeded in principle by oral proceedings. An interview is not necessary required in such case.

(b) Fairness and transparency of proceedings should be highly observed in inter-partes cases. The other party shall be invited to the interview. An interview with only one party should be avoided. However, an interview at the presence of only one party may be allowed in the circumstance where fairness is assured. When matters relating to patentability are considered in an interview with one party, the minutes of the interview shall be serviced to the other party.

3. Procedures for interview



In the interview, the attendant should cooperate with the collegial body (appeal examiner) so as to effectively achieve the goal of the interview as noticed in advance. On presenting an interview memo or other things, attendant should explain its contents. The attendant arranges the presence of a interpreter, if necessary. The attendant affixes his or her seal on the interview record prepared by the collegial body and receives a copy thereof.

The collegial body confirms the identity of the attendant by the presented seal, power of attorney, etc. In the case that there are any deficiencies in the power of attorney, the collegial body does not accept it; and if the attendant commits himself or herself to submit a corrected power of attorney, the collegial body conducts the interview (on condition of confirmation afterwards). In this case, the collegial body keeps the interview record until a corrected power of attorney is submitted. The collegial body makes the interview records and hand over a copy thereof to the attendant.

#### **3.4.2 The Regulation of SIPO<sup>20</sup>**

There is no any detailed regulation regarding interview by collegial body in the Reexamination/Invalidation examination procedures in SIPO. But in the Guidelines for Examination of SIPO, there are regulations regarding the interview in the substance examination procedures that are also applied mutatis mutandis to the Reexamination/Invalidation examination procedures, especially to the Reexamination procedures. The related regulation is listed as follows.

Where necessary, the examiner may accelerate the examination by holding an interview with the applicant. If possible, the examiner may have discussion with the applicant about a specific issue by telephone.

The examiner may invite the applicant to have an interview, or the applicant may also request for an interview. If the examiner believes the holding of an interview beneficial, he/she shall agree to have the interview; otherwise, the examiner may refuse the request for interview. No matter invited by the examiner or requested by the applicant, each interview shall be fixed in advance by issuing a “Notification of Interview” or by appointment of phone call. The duplicate of the “Notification of Interview” or the “Record of the Telephone Conversation concerning Appointment of an interview” shall be included in the application file. It shall be indicated clearly in the said Notification or the Record the contents, time and place of the interview confirmed by the examiner. If new document is to be put forward in the interview by the examiner or the applicant, it shall be submitted to the other party before the interview.

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<sup>20</sup> See: 4.12 of the Chapter8, Part II of the Guidelines for Examination of SIPO ( English vision ), which was promulgated and effective as of October 18, 2001.

The time of the interview shall not be changed at will once it is fixed. If, without any justified reason, the applicant fails to show up in the interview, the examiner may refuse to fix new interview and decide that the examination shall be continued in documentary form.

Where an agent is appointed by the applicant, the agent shall be present at the interview and shall produce his/her certificate of agent. Where there is any change of agent, the power of attorney of the applicant shall be produced. When an interview is over, the examiner shall fill in the “Record of Interview”. The record shall be in duplicate and signed by the examiner and applicant (or its/his agent) present in the interview: One copy shall be given to the applicant and the other shall be kept in the application file. The “Record of Interview” shall not replace the formal response to the Office Action and the amendment of the applicant. Even though consensus on how to make the amendment has been reached by both parties in the interview, the applicant still has to submit the formal amendment document and the examiner can’t make any amendment on the applicant’s behalf.

Communication by telephone shall apply only to minor issues or non-misleading issues. The examiner shall make a record of the discussion and keep it in the application file. For the amendments agreed by the examiner in the telephone conversation, the applicant shall usually re-submit the revised documents in written form. The examiner shall make conclusion according to the written amendment.

### **3.4.3 Comparison**

In the Manual of Appeal and Trial Proceedings of JPO, there are detailed interpretations and regulations regarding the interview by collegial body, but in the Reexamination/Invalidation part of Guidelines for Examination of SIPO, there is nearly no record regarding the interview.

Although there are detailed interpretations and regulations regarding the interview by collegial body in the Manual of Appeal and Trial Proceedings of JPO, including the ex-parte cases and inter-parte cases, the interview by collegial body is mainly applied to the ex-parte cases in practical examination, that is, the interview by collegial body was conducted mainly in the procedures of appeal against examiner’s decision of refusal. In general, the interview only has been conducted in the procedure of Reexamination in the Patent Reexamination Board of SIPO. So regarding the interview, from the viewpoint of practical examination, it is similar for two countries.

It is possible to have interview even in the inter-parte cases in JPO, for example, in the procedures of trials for invalidation, so it provides a convenient measure to accelerate/ facilitate the examination proceedings.

## **3.5 Ex-Officio Principle and Ex-Officio Investigation**

### 3.5.1 The Regulation of JPO<sup>21</sup>

#### 1. Ex-Officio Principle

Although there may be found many examples of provisions based on the ex-officio principle under the Code of Civil Proceedings also, such as the progression of litigation proceedings by the court, since the aim of civil proceedings lies primarily in resolving conflicts over private interests at the disposal of the parties concerned, it can be said that, among the principle provisions of the Code of Civil Proceedings, provisions based on the so-called inter-partes principle outweigh provisions based on the ex-officio principle, as exemplified by the provision of Section 246 of said Code stating that: “The court shall not make decisions on matters which the parties concerned do not dispute,” and Sections 267, 296(1), 320, 348, etc.

In contrast, since in appeal/trial examination, the effect of decisions extend to third parties, and may have significant influence on the society, there are many provisions in relevant legislations such as the Patent Law, which do not apply mutatis mutandis provisions of the Code of Civil Proceedings based on the inter-partes principle, but instead state that the appeal/trial examiner should actively involve oneself with the case ex-officio and play a leading role in the examination, independent of the will of the parties concerned, once an appeal/trial examination is requested, unless it is withdrawn, the weight of provisions based on the ex-officio principle being much greater. (N.B. In retrial, Patent Law Section 174(5) (Utility Model Law Section 45, Design Law Section 58 (1)) applies Section 348(1) of the Code of Civil Proceedings mutatis mutandis, a distinguishing point from other forms of appeal/trial examinations.)

Hence, it may be said that one of the characteristic of appeal/trial examination proceedings is found in its being largely based on the ex-officio principle, particularly in the extensive adoption of the principle of ex-officio detection, which will be described later. The ex-officio principle in appeal/trial examination may be considered in two parts, the principle of ex-officio procedure and the principle of ex-officio detection.

##### (1) Principle of Ex-Officio Procedure

This stands for the principle under which the examiner makes actions aimed at the progression of examination procedures, not requiring, or not allowing motion from the parties concerned. The principle of ex-officio procedure is adopted, for example, in the ex-officio extension of legal or designated time period (Patent Law Section 4, 5, Utility Model Law Section 2<sup>quinquies</sup> (1), Design Law Section 68(1)), choice of mode of conducting examination (Patent Law Section 145, Utility Model Law Section 41, Design Law Section 52), progression of proceedings (Patent Law Section

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<sup>21</sup> See: Part of 36-01 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 36-01 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

152, Utility Model Law Section 41, Design Law Section 52), and order to resume interrupted or suspended procedures(Patent Law Section 23, Utility Model Law Section 2<sup>quinquies</sup> (2), Design Law Section 68(2)).

#### (2) Principle of Ex-Officio Detection

This stands for the principle under which the appeal/trial examiner collects materials forming the basis of decision ex-officio, regardless of the attitude of the parties concerned. The principle of ex-officio detection can be found, for example, in ex-officio examination of evidence (Patent Law Section 150(1), Section 151, Utility Model Law Section 41, Design Law Section 52), ex-officio preservation of evidence (Patent Law Section 150(2), Utility Model Law Section 41, Design Law Section 52, Code of Civil Proceedings Section 237), examination of grounds not raised by parties concerned (Patent Law Section 153(1) and (2), Utility Model Law Section 41, Design Law Section 52), and examination of finding refusal reason different from the reason of decision of refusal(Patent Law Section 159(2), Design Law Section 50(3)).

#### 2. Ex-Officio Investigation

In civil proceedings, etc., ex-officio investigation stand for the court considering and determining, without waiting for the parties concerned to point out, and regardless whether there is any dispute between the parties concerned, matters of public interest necessary in maintaining the court system, mainly concerning requirements for litigation or legality of each action in litigation, etc. (Called matters of ex-officio investigation. For example, jurisdiction, capacity of party, capacity to file suit, power of attorney, requirements for consolidation of litigations, observation of invariable time limits, existence of res judicata, applicable section of law, etc.) The collection of material for determination on matters of ex-officio investigation is commonly done ex-officio (principle of ex-officio detection).

However, in appeal/trial examination, ex-officio investigation is not restricted to the above, partly because ex-officio detection is carried out on a far wide scope, and the term ex-officio research also includes, general investigation made ex-officio, and investigation activities based on the principle of ex-officio detection (e.g. ex-officio examination of evidence).

#### 3. Examples of Ex-Officio Investigation on Formality Matters

- (1) Formality check on demand for Appeal/Trial
- (2) Investigation on interrupted Appeal/Trial, or of resume of retrial procedures
- (3) Investigation of register
- (4) Investigation whether the demandant of Trial for invalidation has the capacity of becoming party.

It is said that, unless there is objection from the opposing party, the determination may be made on basis of material submitted by the party concerned, such as the demand for trial.

#### 4. Examples of Ex-Officio Investigation of Substantive Matters

(1) Investigation whether there exist any other appropriate reasons for rejection, when the reasons for rejection in the examiner's decision is found to be inappropriate.

(2) When the reasons for rejection in the examiner's decision is insufficient.

a: Where commonly used means or publicly known facts of which examples are not cited, has become subject of argument in appeal against examiner's decision, and where furnishing of such examples are found to be necessary, investigation on existence of such commonly used means or publicly known facts.

b: Where the date of distribution within Japan of document cited in examiner's decision has become subject of argument in appeal against examiner's decision, investigation of said date.

(a) Request for issue of certificate to library or public institution holding the document.

(b) Ex-officio examination of evidence

c: Supplementable investigation when there is defect in the evidence used in the prior decision on opposition, and that defect has become subject of argument in the appeal against the decision.

(3) Examination of grounds not raised by the parties concerned or participant (Patent Law Section 153, Utility Model Law Section 41, Design law Section 52)

In civil proceedings, the court adopts as basis of judgment any confession of facts without determining the authenticity of the confession. However, in appeal/trial examination, more solid evidence is required for the appeal/trial examiner to have conviction sufficient for rational determination, despite confessions on fact made by parties concerned. Facts not disputed by parties concerned also need to be verified against other concrete evidence, with the exception of facts that are evident before the Patent Office.

As described above, in appeal/trial examination, and study thereof, for the appeal/trial examiner to attain sufficient conviction, is required, considering the effect that a patent has on society.

#### 5. Restriction on Ex-officio Investigation under the Principle of Ex-Officio Detection

Though efforts are made in finding out the truth under the principle of ex-officio detection as appeal/trial decisions have effects extending over the whole society, examination is not allowed on relief sought not claimed by the demandant (Patent Law Section 153(3), Utility Model Law Section 41, Design Law Section 52), and when examining grounds not raised by the parties concerned or participants, the result of the examination must be notified to the parties concerned and participants, and opportunity to respond be given (Patent Law Section 153(2), Section 150(5), Utility Model Law Section 41, Design Law Section 52)

In appeal against decision to reject an application and appeal for correction, and in demand for correction, the reason for rejection must be notified, and a chance to submit a written argument be given. (Patent Law Section 159(2), Design Law Section 50(3))

In addition, the extent of effort for ex-officio detection should depend on some factors, for example, the influence on the public interests, delay of examination and possibility of finding the facts, etc., which should be considered in the proceedings of ex-officio detection.<sup>22</sup>

### 3.5.2 The Regulation of SIPO

1. The Principle of Conducting Investigations Ex Officio is regulated in the Reexamination/Invalidation part of Guidelines for Examination of SIPO, which is that the Patent Reexamination Board may conduct investigation ex officio of the cases under its examination.<sup>23</sup>

2. In Reexamination cases, if necessary, the examination may be performed on the grounds and evidence that have not been mentioned in the decision of rejection, for example, when the application is apparently not conformed to the Patent Law of China, like the Section 33 or Section 26.3 of Patent Law of China. In this case, the collegial body shall issue a “Notification of Reexamination” notifying the person who requests for reexamination, which may give the person concerned the opportunity to make a statement or an argument responding the notification.<sup>24</sup>

3. In invalidation cases, when necessary, the collegial body may, ex officio, request the party concerned to supplement evidence in respect of the facts alleged by it/him within the prescribed time limit.

When necessary, such general knowledge as technical dictionary, technical manual, textbooks, etc. which have fallen into public domain in the technical field may be introduced into the examination as evidence by the collegial body.

The Patent Reexamination Board may itself investigate relevant facts or verify relevant evidence, or entrust a local administrative authority for intellectual property affairs (or any corresponding functional organs), or other relevant entities to do so. The necessary costs shall be borne by either the Patent Reexamination Board or the party concerned.

When necessary, especially when a meaningful examination conclusion can not be drawn from the grounds as submitted by the person in its/his request for invalidation due to the miss of some of the defects which exist in the patent right by the person requesting for invalidation, the collegial body may perform examination ex officio on the grounds which have been missed by the said person.<sup>25</sup>

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<sup>22</sup> See: 園部逸夫編著「注解 行政事件訴訟法」(株)有斐閣 P335-338

<sup>23</sup> See: 5.4 of the Chapter 1, Part IV of the Guidelines for Examination of SIPO (English vision), which was promulgated and effective as of October 18, 2001.

<sup>24</sup> See: 6 of the Chapter 2, Part IV of the Guidelines for Examination of SIPO (English vision), which was promulgated and effective as of October 18, 2001.

<sup>25</sup> See: 3.2 of the Chapter 3, Part IV of the Guidelines for Examination of SIPO (English vision), which was promulgated and effective as of October 18, 2001.

### **3.5.3 Comparison**

1. From the related regulation, we know that in Appeal Department of JPO, since in appeal/trial examination, the effect of decisions extend to third parties, and may have significant influence on the society, there are many provisions in relevant legislations such as the Patent Law, which do not apply mutatis mutandis provisions of the Code of Civil Proceedings based on the inter-partes principle, but instead state that the appeal/trial examiner should actively involve oneself with the case ex-officio and play a leading role in the examination, independent of the will of the parties concerned, once an appeal/trial examination is requested, unless it is withdrawn, the weight of provisions based on the ex-officio principle being much greater, although the Appeal Department of JPO acts as a “quasi-judicial” role, at least as a “quasi-lawsuit administrative” role. Nevertheless, although the legal nature of the Patent Reexamination Board of SIPO is only the administrative organization, when making examination of cases including Reexamination and Invalidation, the thinking is that provisions based on the so-called inter-partes principle outweigh provisions based on the ex-officio principle.

2. In practical examination, there are similar points regarding conducting the principle of ex-officio in two countries, which is that they both pay more attention on the ex-officio principle in the procedures of trials for examiner’s decision of refusal, other from the procedures of trials for invalidation, because the trials for examiner’s decision of refusal is not the procedures for inter-parties.

## **3.6 Oral Proceeding**

The basic procedures of oral proceedings, for example, the order of oral proceeding, are similar in two countries. Now only choose some topics to make comparison which have their own characteristics.

### **3.6.1 Nature of oral proceeding**

#### **In JPO**

In practical examinations, the documentary proceeding and oral proceeding are two main examination principles in Appeal/Trial examinations. The oral proceedings are mainly utilized in the inter-parte cases, for example, such as the trial for invalidation. Whether to choose the oral proceeding depends on the appeal examiner-in-chief.

Moreover, the oral proceedings of the Appeal/Trial cases in JPO are paid more attention to the principle of ex-officio that is different from the oral procedures in court of civil lawsuit.

#### **In SIPO**

Being similar to JPO, oral proceedings are also mainly utilized in the invalidation cases. Where the party concerned has requested for oral proceeding in writing, the collegial panel shall generally agree to carry out the oral procedure. Where the collegial panel finds such oral proceeding necessary, it may decide ex officio to carry out the oral according to the case.

The collegial panel considers not only the principle of ex-officio but also the principle of petition and principle of disposition by parties concerned in the oral proceedings in SIPO which is more like the procedure of civil lawsuit.

### **3.6.2 Regulations regarding direction to the parties to appear for oral proceeding**

#### **In JPO**

1. The appeal examiner makes a schedule for appearance with the appellant, the opponent, or the agent (the telephone number and the facsimile number should be set forth in the written appeal).

2. When the appeal examiner directed the date for oral proceeding, he firstly chooses to inform the parties through phone call or FAX. Only when he couldn't contact with the parties through the phone call or FAX, or the party/parties request to acquire the notification of oral proceeding, he will send summons to the parties by mail.

3. The summons is in general to be sent by a day two weeks before the scheduled date. When a summary for statement in oral proceeding is submitted, it is desirable that it is submitted around a week before the scheduled date.

4. In case that the transmission of the summons is impossible, the summons shall be served by means of public notification. If the scheduled date is before the effective date of the public notification (or a date 20 days after the publishing date of the Official Gazette), a public notification is made after the scheduled date is made change.<sup>26</sup>

#### **In SIPO**

1. In SIPO, when the appeal examiner directed the date for oral proceeding, he should send the written notification (written summons) of oral proceeding to the parties.

2. The summons is in general to be sent by a day at least 37 days before the scheduled date. The parties shall submit the acknowledgment of receipt of the notification to the board within 7 days from the date on which it is received.<sup>27</sup>

### **3.6.3 Procedure when the party did not report at the scheduled date for oral proceeding**

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<sup>26</sup> See: Part of 33-01 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 33-01 of “審判便覧”, <http://www.jpo.go.jp/shiryu/index.htm>

<sup>27</sup> See: 3 of the Chapter 4, Part IV of the Guidelines for Examination of SIPO (English vision), which was promulgated and effective as of October 18, 2001



### **In JPO<sup>28</sup>**

1. Where a person who is summoned by the JPO does not report without due cause, the person may be subject to fine of 100,000 Japanese yen or less (Patent Law Section 203).

2. In a case where both parties do not appear at the scheduled date for oral proceeding, no oral proceeding can be entered. Therefore:

(1) Only an oral proceeding record in which the fact of non-appearance is set forth is made where no witness examination is scheduled together at that date.

(2) Where a witness examination is scheduled at that date,

a. and where no witness reports, it is treated in a manner as described in above(1).

b. and where the witness reports, a witness examination only can be made (Code of Civil Procedure Section 183). In this case, the Appeal Examiner-in-Chief examines the witness mainly based on a writing setting forth questions submitted by the person who called the witness. The Appeal Examiner-in-Chief, as a result, makes a witness examination record and oral proceeding record setting forth the fact of non-appearance regarding the oral examination.

3. Where one party does not report at the scheduled date for oral proceeding, an oral proceeding is conducted generally.

(1) If examination of the witness is not scheduled at that date, only an oral proceeding record is produced.

(2) If examination of the witness is scheduled at that date,

a. and if the witness does not report, it is treated in a manner as described in above 2(1).

b. and if the witness reports, the witness can be examined together (Code of Civil Procedure Section 183). The examiner consequently produces an oral proceeding record and a witness examination record. In this examination,

(a) Where the party who asked examination of the witness does report, the party mainly makes questions to witness.

(b) Where the party who asked examination of the witness does not report and the party opponent appears, the witness is examined in a manner described above 2(b), providing that the party opponent will have an opportunity to make a cross examination.

### **In SIPO**

Where the person requesting for invalidation fails to submit the said acknowledgment of receipt of the oral proceeding notification within the specified time limit and is not present at the oral proceeding, the request for invalidation shall be deemed to have been withdrawn. If the patentee does not participate in the hearing, the hearing shall be performed by default.<sup>29</sup>

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<sup>28</sup> See: Part of 33-03 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 33-03 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

<sup>29</sup> See: Rule 69.3 of the Implementing Regulations of the Patent Law of China

Where one of the parties fails to take part in the oral procedure, the collegial panel shall conduct the oral procedure according to the prescribed procedures so long as the presence of one of the parties concerned at the oral procedure complies with the requirements.<sup>30</sup>

There is no detailed regulation regarding witness' presence at oral procedure in SIPO. In practical examination, the collegial panel shall deal with the relevant situation according the factual case.

### **3.6.4 Compromise**

#### **In SIPO**

Due to application the civil proceedings in invalidation cases, especially in oral proceeding, it is noted that the parties of the invalidation have the right to negotiate for compromise. The parties may negotiate for compromise by themselves at any time before making the invalidation examination decision.

In the course of the oral proceeding, the collegial panel may give the parties opportunity to negotiate for compromise at least two times which is at the beginning or by the end of the oral proceeding. If the both parties express that they have the intention to negotiate for compromise before the collegial panel in the course of oral proceeding, the head of the collegial panel may announce the suspension of oral proceeding and if necessary, shall fix the date for the resume of the oral procedure.<sup>31</sup>

#### **In JPO**

There is no relevant regulation regarding the compromise in the trial for invalidation or in the course of the oral proceeding.

## **3.7 Evidence**

#### **In JPO**

Lay witness, expert witness, parties, documents, inspection materials, and the like are used as tangible subjects serving as means of proof, or subjects to examination of evidence.

No production or withdrawal of evidence can be made after the end of appeal examination. In a case where an appeal examiner allows entry of evidence after the end of appeal examination in an

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<sup>30</sup> See: 8 of the Chapter 4, Part IV of the Guidelines for Examination of SIPO ( English vision ) , which was promulgated and effective as of October 18, 2001

<sup>31</sup> See: 5 of the Chapter 4, Part IV of the Guidelines for Examination of SIPO ( English vision ) , which was promulgated and effective as of October 18, 2001

adversarial appeal (inter-parties trial), the examiner shall reopen the appeal/trial examination and give the party opponent an opportunity to reply and render rebuttal (Patent Law Section 134).

When evidence is submitted, the producing party shall specify in writing the evidence in detail as well as clarify facts to be proved and relations between facts to be proved and evidence (Patent Law Section 151). Therefore, the appeal examiner checks as to whether the submitted documents have any defect or error in accordance with the types of evidences listed below, and according to determination of the collegial body, may order an amendment or the like when necessary or correct ex officio the defect or error.

(1) Lay witness

In a case of a lay witness, non party of this case, who in an appeal proceeding makes statements about his recognition to past facts and situations, a writing for requesting questions to a lay witness shall expressly indicate his name, age, occupation, and address, etc. as requirements to identify the lay witness (Regulation under the Code of Civil Procedure Section 106), and have, as separate sheets to be attached, writings describing questions, given to the witness, of the required number. Therefore, if the writing has any error, a proper response is required.

(2) Expert

In a case of an expert, non party, who in an appeal proceeding makes his opinion based on special academic knowledge or experiences to supplement knowledge and experiences of the appeal examiner, the collegial body may call the expert (Code of Civil Procedure Section 213) and the party may not be required to call the expert; where the party calls such an expert, a writing requesting an expert opinion shall expressly indicate, as requirements to identify the witness, his name, age, occupation and address, etc.

Regarding calling or not calling an expert, the writing requesting an expert opinion shall be accompanied with writings describing matters subject to the expert opinion of a required number, as separate sheets to be attached, and the appeal examiner treats it in substantially the same manner as in the case of a lay witness.

An expert who was called by one party, can be called, where the party opponent consented and the collegial body allowed as proper.

(3) Expert witness

In a case of a non party who in an appeal proceeding makes his statement about his recognition to past fact and situation which he could know because of his special academic knowledge and experiences, who is distinguishable from an expert above (2) because the expert witness is not replaceable, a written request for questioning an expert witness shall expressly show his name, age, occupation and address, etc. as requirement to identify the expert witness, and have, as separate sheets to be attached, writings describing questions, given to the expert witness, of the

required number, therefore, the appeal examiner treats it in substantially the same manner as in the case of a lay witness above (1).

(4) Party witness and the like

In a case of a party himself, legal representative, or representative of a legal person or group as the party who in an appeal proceeding makes his statement about his recognition to past facts and situations as supplemental evidence where any other evidence cannot be made or other evidence would be inadequate to establish factual situations, a written request for questioning an witness shall expressly show his name, age, occupation and address, etc. as requirement to identify the party witness or the like who will be questioned, and have, as separate sheets to be attached, writings describing questions, given to the expert witness, of the required number, therefore, the appeal examiner treats it in substantially the same manner as in the case of a lay witness above (1).

In a case of an intervenor, it is appropriate to treat it in substantially the same manner as in the case of a party.

(5) Documents, documentary evidence

Documentary evidence is originally an examination of evidence in which, where a document is a means of proof, language expression set forth thereon constitute evidential materials. However, because it frequently refers to documents themselves, the term “documentary evidence” is used in practice.

In a case when a document is produced as an evidence material, it is required to submit the document or to move for an order for submission of the document, and according to a person who possesses the document, a motion for commission for document transmission may be required.

In any event, a party who made a motion shall submit copies of the document multiplied by a number corresponding to the JPO and a number of the opponents (including intervenor and representatives). If those are not in compliance with rules the examiner order an amendment.

If the evidence material is “document”, “Description for evidence” shall be submitted except that is apparent from the description of the document. A document apparent from the description of the document refers to such document having the clear publishing date, clear publisher, and so on, like the Patent Office Gazette published by the JPO. “Description for evidence” shall set forth the publishing date, production date, and purpose of the document evidence, and be submitted in a number corresponding to the JPO and the number of the opponents.

The document thus submitted or sent shall be any of the original, the legitimate copy, and the certified copy.

If the document is a book, the following points should be regarded. And the appeal examiner shall order an amendment if the document is improper.

i. Where the original document is submitted, with respect to copies of the document to be sent to the persons related to the appeal, whether copies of necessary portions to specifically identify the document among the front cover, the inside of the front cover, the referred or related pages, the index pages, the back cover, the shelf back, or the like of the book are satisfactory or not.

ii. When the party submitted an original document and is seeking for return of the document, whether the copies to be filed as the record are satisfactory likewise copies of (a) or not.

It is to be noted that when the original document is to be returned, the examiner makes sure that the copies is not different from the original document and records a brief statement of such a meaning on copies.

iii. When no original document is submitted, whether the copies thereof are satisfactory likewise copies of (a) or not.

Where the evidence is a document other than the following documents, or where the original document is not submitted, it is ordinarily to move for examination of witness together with the submission of the document, to make clear the authentication and the contents to be proved.

i. Publication having a clear publishing date.

ii. Official certification made by an official or public entity for proving the contents of the certification.

iii. Official certification made by a university or laboratory having a facility and its engineers.

iv. Certification for medical effect officially made by a famous hospital where a drug is apparently used for medical care done at the hospital.

#### (6) Inspected Materials

As inspection, there are inspection within a courtroom in which the inspection site is in a JPO appeal court and inspection outside a courtroom in which the inspection site is a place in question, where the appeal examiners inspect directly with their five senses a material in which the characters and phenomenon are examined, or namely a inspection material.

The party who moved for inspection shall submit necessary drawings, models or specimens required for identifying the inspection material in a number corresponding to the number of the JPO and opponents, and therefore, if not satisfactory, the appeal examiner will order an amendment.

When the inspection material is submitted, an inspection is held in an appeal courtroom of the JPO (inspection within courtroom).

When the inspection material cannot be submitted, or when necessary, the inspection is held at a site where the inspection material is located. In such situation, the writing for motion for inspection (written request for inspection, written appeal, or written reply, etc.) shall expressly show the situations of the inspection material as a requirement for identifying the inspection material.

Inspections are frequently accompanied at the same time with questionings of witness, requests for presence of expert witness and submissions of sketches and photographs, and therefore, the appeal examiner pays attentions to improper procedures of such requests or submissions.

Even if a material is in a form of a document, the material that is not a means of proof produced by its contents but a basis for an impression to the discretion of the appeal examiner from the characters or conditions thereof, is not a document but an inspection material.<sup>32</sup>

#### (7) Examination of evidence

##### (a) Direct Principle and Indirect Principle

This distinction is made from a difference, when the JPO decides based on some evidence, between a process in which the collegial body, who render the final decision of the present case, touches the evidence directly to make its mind and a process in which an Appeal examiner who is a member constituting the collegial body indirectly makes its mind based on a report from the person or institution who made the examination.

In general, the direct principle is said as the superior process because it allows the judge to render his mind without delay and with accuracy. In the Civil Procedure Code, the direct principle is adopted generally (Code of the Civil Procedure Section 249), and in exceptional cases, appointed or commissioned judge can examine the evidence (Code of the Civil Procedure Section 185).<sup>33</sup>

##### (b) Inspection

Inspection is an examination of evidence in which the appeal examiner inspects the characteristics and phenomenon of the matter directly with his sense, and uses the result of the inspection as evidential material. His sense includes senses of hearing, taste, smell and touch. The matter to be inspected is referred to be material subject to inspection. The difference between inspection and testimonial or documentary evidence is in that the latter evidence is the evidence of a person's thought such as testimonies or written statement; on the other hand, the former is that

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<sup>32</sup> See: Part of 34-01 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 34-01 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

<sup>33</sup> See: Part of 35-00 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 35-00 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

the sense gained by a person is the direct material for judgment. Consequently, a human being can be a material subject to inspection when his physical appearance is inspected, and a document can be a material subject to inspection when the paper quality or color of black ink becomes evidence. Recording of human's language is getting considered rather as written evidence from a view that thoughts are used as evidence in the present time with developed voice recordings. (see, Kaneko, Hajime "Minji Soshyo Hou Taikai" (Code of Civil Procedure System)).

The rule of procedure relating to documentary evidence is applied *mutatis mutandis*. To move for inspection, the material subject to inspection must be indicated in addition to the facts to be proved.

When the inspection is carried out together with oral proceeding or witness interrogation, the record of inspection may not be prepared as a separate piece, and the items such as the indication of the material subject to inspection, the purpose of the inspection, explanation and instruction made by the party, the process of the inspection and the result of the inspection can be described in the record.

When inspection is conducted out of the court, an oral proceeding can be held on the inspection site if it is required.<sup>34</sup>

#### (8) Preservation of Evidence

Preservation of evidence is the procedure of the appeal for specific evidence which might be impossible or difficult to be examined if waited until an ordinary examination of evidence in the appeal procedure to examine the evidence beforehand and preserve the result of the evidence. (Patent Law Section 150, 151, Code of Civil Procedure Section 234)

In the ordinary examination of evidence, the request for the examination of appeal is made first, then the issues of the case are summarized, and the only disputing matters are subject for examination of evidence. In this case, evidence unrelated or unnecessary is not subject of the examination because the examination is made for not all matters and because only matters related to the disputing matters and needed to prove the issues are examined. Thus, when the motion for examination of evidence is made, it is usual in appeal procedures to designate the date of the examination of evidence and carry out the examination, in this standpoint. However, there might be some circumstances where examination of evidence is impossible or difficult if waited until such time passes, e.g., when a witness might pass away or matters to be examined might disappear. If there is such a special circumstance as above, it is required to examine and preserve the evidence.

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<sup>34</sup> See: Part of 35-06 of Manual of Appeal and Trial Proceedings in JPO (Japanese version), that is, 35-06 of "審判便覧", <http://www.jpo.go.jp/shiryuu/index.htm>

The motion for the preservation of evidence is made with submitting of the written motion for the preservation of evidence to the Appeal Examiner-in-chief where the appeal is already pending, or to the Commissioner in the case where the appeal is not yet filed. The written motion must indicate the movant, the opponent, the facts to be proven, evidence, and the matters (reasons) for preserving the evidence. Also, the prima facie proof for the matters of preserving the evidence must be made.<sup>35</sup>

### **In SIPO**

There is no such detailed regulation like JPO regarding the evidence in SIPO. And furthermore, the Patent Reexamination Board of SIPO has no position like the Appeal Department of JPO because the Patent Reexamination Board is only the administrative organization, but the Appeal Department acts as a “quasi-lawsuit administrative” role that is similar to the court. So in China, the Patent Reexamination Board has no power to preserve the evidence like the court, and so on.

In practical examination of evidence, the procedures and thinking is similar in two countries, only lack of detailed relevant regulation in China. Now list some regulations regarding the evidence of the Patent Reexamination Board of SIPO as follows.

#### 1. Evidence

Evidence includes documentary evidence, material evidence, audiovisual material, testimony of witness, statement of the party concerned, conclusion of appraisal and record of on-site investigation and examination. Furthermore, evidence is divided into direct evidence and indirect evidence. The direct evidence refers evidence that can be used independently and directly to prove the facts that need to be proved. The indirect evidence refers to evidence that can not be used independently and directly to prove the said facts, but need to be used in combination with other evidence to prove the facts that need to be proved.

#### 2. Determination of evidence

The evidence can be used only after it is investigated and verified. The panel shall comprehensively and objectively examine and verify the evidence according to the written statement made by the party concerned in respect of the evidence and its/his oral statement provided in the oral procedure. The panel shall also examine and verify the evidence according to the written statement in respect of the evidence and oral statement made by the adversary party during the cross-examination of the oral procedure in a comprehensive and objective way. The truthfulness and reliability of the evidence can be examined from the two aspects of the source of the evidence and the content of the evidence. When the truthfulness and reliability of the evidence

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<sup>35</sup> See: Part of 35-08 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 35-08 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>



is examined from the standpoint of the source of the evidence, it shall be mainly focused whether, during the course of its formation, there are any factors that may affect the truthfulness and reliability of the evidence and whether, with regard to the provider of the evidence, there are any factors that may affect the truthfulness and reliability of evidence. When the truthfulness and reliability of evidence is examined from the standpoints of the content of evidence, it shall be mainly focused on whether the facts revealed by the evidence are reasonable and free of inconsistency.

The following rules shall be followed when using indirect evidence to prove the facts:

- (1) The evidence per se must be true and reliable;
- (2) There is no inconsistency among the indirect evidences used for the determination of the facts;
- (3) The indirect evidences must be of itself complete system of proofs;
- (4) The conclusion drawn from the system of proofs comprising indirect evidences must be unique.

Any written testimony can be used only after the cross-examination and cross-confirmation with other evidence. The oral evidence of a person incapable of expressing his/her intention correctly cannot be used as the basis for the determination of facts.

For audiovisual materials, the statement of the party concerned, documentary and material evidence under objection or query, they shall be examined in combination with the other evidences of the case so as to determine whether they may be used as the basis for the determination of the facts.

Legal acts, legal facts and legal instruments that have been notarized by the legal procedures may be used as the basis for determination of the facts, on condition that there is no evidence to overturn the notary attestation. The party concerned may submit such proofs as the notary certificate from the notary office to prove the legal act, legal facts, and legal instruments that are notarized by the notary office. Nevertheless, any notary certificate of such office, content of which goes beyond its scope of notarization, cannot be used as the basis for the determination of the facts.

The evidence material obtained by illegal means shall not be used as evidence.

### 3. Burden of Producing Evidence

The party concerned shall be under the burden of producing evidence for its/his allegation. Where it is necessary to present evidence, the party concerned shall provide evidence sufficient to support its/his allegation. For the same facts, the party concerned who raised the allegation shall generally put to the proof first. Where the facts proved by the evidence can be confirmed after cross-examination, the burden of producing evidence shall be transferred to its/his adversary. If no evidence which is sufficient to overturn the said proof of the facts could be put forward by the

parties concerned of the adversary, the facts may be confirmed. If the party concerned of the adversary has put forward evidence sufficient to overturn the facts, the burden of producing evidence goes back to the party who raises the allegation. Where any party who is under the burden of producing evidence cannot provide sufficient evidence, it/he shall bear the legal consequences of not tenable of its/his allegation or tenability of the allegation of the adversary.<sup>36</sup>

## **Chapter 4 Comparison of Proceeding of Reexamination (Appeal against Decision of Refusal)**

### **4.1 Outline of the Appeal against Decision of Refusal**

#### **In JPO**

When an examination is rendered a decision of refusal, and the applicant is dissatisfied with the decision, the applicant is entitled to demand an appeal against the decision of refusal. The applicant must demand an appeal within 30 days from the transmittal of the examiner's decision of refusal.

The appeal process is prescribed to be a continuation of the examination procedure (Section 158).

Formalities required for the examination are also valid for the appeal. Therefore, all the cited references used for the examination may be cited at the appeal. For this reason, reissuing of the notice of reasons for refusal is not required in order for the appeal to be refused. However, if the decision of refusal is based on a reason or a cited reference that was not indicated at the examination, a new notice of reasons for refusal must be issued (Section 153).

The collegial panel conducts the appeal examination by documentary proceeding (Section 145, Subsection 2).

The object of an appeal examination is to grant a patent or to refuse an application, and is not to decide whether the decision of the refusal is correct or not (Section 159, Subsections 2 and 3).

Therefore, the original decision of refusal is upheld even if the reason for rejecting the appeal is different from the original reason for rejection.

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<sup>36</sup> See: 11 of the Chapter 1, Part IV of the Guidelines for Examination of SIPO (English version), which was promulgated and effective as of October 18, 2001

In addition, an appeal against the decision of refusal responds to the social demand by creating the reconsideration system and the accelerated appeal examination system.

### **In SIPO**

The appeal against the decision of refusal in JPO is called “Reexamination” in SIPO. Generally speaking, the purpose and the nature of the appeal against the decision of refusal are similar to the Reexamination.

Reexamination has some differences as follows.

1. The time limit is different. The applicant must demand a request for Reexamination within 3 months from the receiving of the examiner’s decision of refusal.<sup>37</sup>

2. If the collegial body agrees to the opinions of former examiner making the decision of refusal, although all the cited references used for the examination may be cited at the appeal, reissuing of the notice of reasons for refusal is still required in order for the appeal to be refused. Of course, if the decision of refusal is based on a reason or a cited reference that was not indicated at the former examination, a new notice of reasons for refusal must be issued, because the collegial body has to obey to the principle of hearing.

3. The process of Reexamination is not only prescribed to be a continuation of the examination procedure, but also to correct the errors of the decision of refusal. Of course, the weight of continuation of the examination procedure is greater.

## **4.2 Demand**

### **4.2.1 Standing for a demandant**

#### **In JPO:**

(1) A person who received the decision of refusal.

(2) All of the joint owners of the industrial property right must demand the appeal examination.

(Section 132, Subsection 3)

#### **In SIPO:**

It is same to JPO

## **4.3 Amendment to the Specification and Drawings Attached to an Appeal**

### **In JPO**

The demandant of an appeal may amend the specification and drawings within 30 days from the day of the demand for appeal (Section 17-bis).

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<sup>37</sup> See: Section 41.2 of the Patent Law of China

The amendment to the patent claim(s) shall be limited to the following:

- (i) The cancellation of the claim(s)
- (ii) The restriction of the claim(s)
- (iii) The correction of errors in the description
- (iv) The clarification of an ambiguous description (only the amendment with respect to the matters mentioned in the reasons for the refusal concerned in the notification of the reasons for the refusal)

#### **In SIPO**

The demandant of Reexamination may have the opportunity to amend the claim(s), description and drawings when it/he make the reply with respect to the notification of reexamination issued by the collegial body.

The amendment shall comply with the Section 33 of Patent Law of China, which is regulated that an applicant may amend his/its application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of the disclosure contained in the initial description and claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.

### **4.4. Appeal Examination**

#### **In JPO**

The appeal examination is conducted by documentary proceeding by a collegial panel (body) (composed of 3 or 5 appeal examiners) appointed by the Commissioner, not by an oral proceeding (Section 136, Section 145, Subsection 2).

A collegial panel is composed of 3 appeal examiners appointed by the Commissioner, including an appeal examiner-in-chief and 2 appeal examiners. (Section 138)

One of the appeal examiners takes charge of the case, and examines it together with the other two (or four) appeal examiners, said appeal examiner may be the appeal examiner-in-chief. The appeal examiner-in-chief presides over the matters relating to the appeal. Decisions are made by a majority vote. (Section 136, Subsection 2)

The Patent law provides regulations for the exclusion (Section 139), challenge (Section 141), and involvement in the prior decision (Section 139, Paragraph 6) of appeal examiners for fair and impartial appeal examinations.

Appeal examinations are conducted by a documentary proceeding, but they can also be conducted by an oral proceeding (Section 145, Subsection 2).

#### **In SIPO**

It is similar to the JPO.

Cases that are collegially examined by the Patent Reexamination Board shall be examined by a collegiate panel consisting of 3 or 5 members, including a panel leader, one chief examiner and one or three participating examiners. The panel leader is similar to the appeal examiner, but if someone acts as the panel leader, he/she can not act as the chief examiner. It is for fair and impartial examination.

For cases to be reexamined after the initial examination decision is cancelled by the effective judgments of the People's Court, the panel-numbers shall be re-determined, and the chief examiner who has made the initial examination decision shall not participate in the new round reexamination.<sup>38</sup>

The Patent Law of China also provides regulation for the exclusion and challenge which is for fair and impartial examination (Rule 38 of the Implementing Regulations of the Patent Law of China).

### **4.5 Reconsideration by the Examiner**

#### **In JPO**

Most demands for appeals are accompanied with amendment of the specification. Since the decision of refusal has a tendency to be revoked in case of amendment, reconsideration is made by the examiner who is familiar with the application. This process assists in handling the appeal efficiently (Section 162).

The examiner in charge of the appeal examines the propriety of the amendment. If the reason for refusal is resolved by the amendment, the examiner revokes the original decision of refusal, and renders a decision to grant a patent (Section 164, Subsection 1).

However, if the examiner decides to refuse the appeal despite the amendment, the decision is reported to the Commissioner (Reconsideration Report).

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<sup>38</sup> See: 6 of the Chapter 1, Part IV of the Guidelines for Examination of SIPO (English version), which was promulgated and effective as of October 18, 2001

If the reconsideration is applied, the demandant is notified accordingly. If the examiner reports with reconsideration, the reconsideration release notice is given to the demandant. The Commissioner then appoints the appeal examiners and notifies the demandant before the appeal proceeds.

#### **In SIPO**

The reconsideration by the examiner is called interlocutory examination in SIPO that has no limited condition with respect to the amendment of the description, claim(s) or drawing(s).

The Patent Reexamination Board shall remit the request for reexamination that the board has received to the examination department that has made the examination of the application concerned to make an examination. Where that examination department agrees to revoke its former decision upon the request of reexamination, the Patent Reexamination Board shall make a decision accordingly and notify the requesting person ( Rule 61 of Implementing Regulations of the Patent Law of China ) .

The former examination department shall provide an Office Action of Interlocutory Examination that can not transfer to the petitioner (demandant), and only acts as the reference of the collegial body. Except in special situations, the interlocutory examination shall be completed within one month from the date of receipt of the file for request for reexamination.<sup>39</sup>

## **4.6 Accelerated Appeal Examination**

#### **In JPO**

The accelerated examination/accelerated appeal examination has been implemented since February 1986.<sup>40</sup>

In general, an appeal examination is conducted in the order of the date on which the demand for appeal was made. If the appeal against the decision of refusal involves working invention-related application, and requires an urgent action, an accelerated appeal examination may be offered.

Currently, the scope of accelerated appeal examinations has been expanded to include: applications involving a working invention-related application, an internationally filed application, an academic institutes-related application, small/medium enterprise-related and individual applications.

The number of applicants using this process is gradually increasing. Starting in July 2000, with the view to strengthening the competitiveness of Japanese industries, the implementation of this

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<sup>39</sup> See: 5 of the Chapter 2, Part IV of the Guidelines for Examination of SIPO ( English vision ) , which was promulgated and effective as of October 18, 2001

<sup>40</sup> See: Part of 61-12 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 61-12 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

process has been under drastic review, in light of the timely utilization of the outcomes of basic research, enhanced support for applicants conducting innovative R&D, timely support for global economic activities and so forth.

Specifically, the accelerated examination/appeal examination has been open upon request to applications filed by SMEs (that is small or medium enterprises), startups, universities and public research institutions which are expected to play an important role in strengthening the competitiveness of Japanese industries, in addition to work-related applications and foreign country-related applications.

Besides, as to the procedures to follow, the requirements for a description in the statement of reasons for an accelerated examination/appeal examination were simplified for the better convenience of applicants, etc.

Additionally, in June 2004, in order to improve the effectiveness of the accelerated examination/appeal examination system to a further extent, its implementation was reviewed and redefined for clarification.

Specifically, the following project areas were identified:

- To clarify the definition of a “working-related application”
- To extend the scope of “SMEs”
- To extend the scope of “foreign country-related applications”
- To clarify the implementation in cases where the specification contains a description concerning prior art
- Others

#### **In SIPO**

There is no detailed regulation regarding the accelerated examination/accelerated appeal examination. The accelerated examination/accelerated appeal examination has been conducted by the examiner/collegial body in practical examination according the detailed situation of cases.

### **4.7 Examination Proceedings**

#### **In JPO**

The appeal examiner in charge studies all the documents in the case file (file wrapper) such as application documents, the specification, the drawings, changes in scope of claim for a patent, the notifications of refusal, and cited references. Then the documents are sorted to single out unclear issues, and to organize the points under discussion.

After sufficient preparations have been made, the case is examined with the other examiners in the collegial examination.

The appeal examiner in charge explains and points out all the facts necessary for the discussion, and the examiner-in-chief controls the discussion.

If the collegial panel determines that the original decision (decision for refusal) is suitable, the appeal decision to uphold the original decision is immediately made.

However, if one of the examiners finds new grounds for refusal, the collegial panel gives notification of reasons for refusal to the demandant to give him/her an opportunity to submit the argument and the amendment. (Section 159, Subsection 2)

If the collegial panel decides that the original decision of refusal is not appropriate, and cannot find any other reasons for refusal, it revokes the original decision, and grants a patent.

#### **In SIPO**

The examination proceedings of the Patent Reexamination Board of SIPO are similar to the Appeal Department of JPO. Except for documentary examination, the collegial panel also utilizes the interview or oral examination.

If the collegial panel determines that the original decision (decision for refusal) is tenable, before making the appeal decision to uphold the original decision, it is essential to notify the demandant what are reasons for refusal of his/its application.

In general, the collegial panel nearly can not introduce new grounds for refusal except that there are some other apparent defects in the claim (s), description(s) or drawing(s) of the application in the procedures of Reexamination.

If the collegial panel decides that the original decision of refusal is not appropriate, and cannot find any other reasons for refusal, it shall remand the case to the former examination department to reexamine said application, and grants a patent. In general, the collegial panel can not grant a patent directly.

### **4.8 Notification of Conclusion of an Appeal Examination**

#### **In JPO**

When it becomes high time to decide an appeal after the discussion, the appeal examiner-in-chief gives a notification of conclusion of an appeal examination to the demandant (Section 156).



With respect to appeal cases, the notification is given upon decision of refusal. The appeal decision must be made within 20 days after the notification. If a decision to grant a patent is rendered, the notification of conclusion of an appeal examination will not be given.

Even after the notification of conclusion of an appeal examination has been given, the appeal examination can resume by ex officio or at the request of the concerned party or an intervener (Section 156, Subsection 2).

As a matter of course, a written notice is given for the reopening of the appeal examination.

#### **In SIPO**

It is not necessary for the collegial body to issue the Notification of Conclusion of a Reexamination in SIPO before making the reexamination decision, as long as the party concerned to whom the decision may be unfavorable shall be given a chance to make observations regarding the grounds, evidence, and the ascertained facts adopted in the examination decision before the examination decision is made, that is, the party concerned to whom the examination decision is unfavorable shall have been informed of the grounds, evidence and the ascertained facts adopted in the examination decision in the process of notification, document communication, interview or oral procedure.

### **4.9 Remanding to Examination**

#### **In JPO**

1 ) The cases where an examiner's decision has been canceled in a trial ( Section 160 of the Patent Law )

( i ) Where a demand for a trial is adequate and the decision of refusal cannot be maintained.

( ii ) Where proceedings of examination had a material defect and cannot be used as foundation for a trial as is.

( iii ) where there was a violation of laws and ordinances in the process of making a decision itself and the presence of the decision is suspect.

2 ) The adjudication in the trial decision shall be binding on the examiner with respect to the case concerned ( Section 160 ( 2 ) ) .

Where the case is remanded, publication of application shall not be made ( Section 160 ( 3 ) ) .

In practical examinations, there are few cases remanded to the former examination department.

#### **In SIPO**

1 ) The cases where an examiner's decision has been canceled in a trial ( Rule 62.2 of Implementing Regulations of the Patent Law of China )

( i ) the laws and regulations applied in the decision of rejection are not correct;

- ( ii ) the grounds for rejection are not supported by the necessary evidence;
- ( iii ) the examination has violated the set legal procedures'
- ( iv ) any other circumstances where grounds of rejection are not tenable.

2 ) Where the reexamination decision revokes the decision made by the examination department that made the initial examination, said former examination department shall carry out the reexamination decision and no decision contrary to the reexamination decision shall be made based on the same reason and evidence.

In practical examinations, there are not so few cases remanded to the former examination department.

#### **4.10 Appeal Decision**

##### **In JPO**

The following particulars are stated on the appeal decision (Section 157, Subsection 2):

- (1) The number of the appeal case
- (2) The name and the domicile or residence of the parties and interveners and their representatives
- (3) The indication of the appeal case
- (4) The conclusion and reason of the appeal decision
- (5) The date of the appeal decision

##### **Conclusion and Grounds of Appeal Decision**

The grounds for the appeal decision are based on the following.

For an appeal decision relating to an inventive step:

History of the establishment of the patent

Identifying of the patent

Identifying of the cited references

Identifying of the differences

Evaluation of the differences

Conclusion

The conclusion of an appeal decision is the result of the appeal examination by the collegial panel. There are three types:

- (1) Rejection of an unlawful demand

(2) If a demand is accepted, → “the original decision is revoked. The invention is granted a patent.” or “the original decision is revoked. The application concerned requires further examination.”

In this case, the examiner is bound by the appeal decision. (Section 160, Subsections 1 and 2)

(3) If a demand is deemed to be un-established, → “the demand cannot be established”.

#### Conclusion of a Case

An appeal case opens upon an appeal, and concludes when the appeal decision is reached (Section 157, Subsection 1). Apart from the appeal decision, the appeal case is concluded upon withdrawal of the demand (Section 155) or withdrawal of the application itself.

A demand can be withdrawn at any time until the trial decision becomes final and conclusive (Section 155).

#### **In SIPO**

The examination decision includes the following components<sup>41</sup>

- (1) Bibliographic data of the examination decision
- (2) Legal bases
- (3) Main points of the decision

The main points of the decision are essential summaries and core expositions of the grounds on which the text of the decision is based. It is the criteria for the judgment of the issues in dispute or for the difficult points of the case.

- (4) Cause of action
- (5) Grounds of decision
- (6) Conclusion

There are three types of reexamination decisions:<sup>42</sup>

- (1) The grounds for request for reexamination are untenable, the request is rejected and the initial decision of rejection upheld;
- (2) The grounds for request for reexamination are tenable and the initial decision of rejection revoked; and

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<sup>41</sup> See: 9.2 of the Chapter 1, Part IV of the Guidelines for Examination of SIPO (English version), which was promulgated and effective as of October 18, 2001

<sup>42</sup> See: 7 of the Chapter 2, Part IV of the Guidelines for Examination of SIPO (English version), which was promulgated and effective as of October 18, 2001

(3) The initial decision of rejection is revoked based on the new text after defects as indicated in the initial decision of rejection was removed after amendments having been made to the patent application documents by the person who requests for reexamination.

Where the reexamination decision revokes the decision made by the examination department that made the initial examination, the said examination department shall carry out the reexamination decision and no decision contrary to the reexamination decision shall be made based on the same reason and evidence.

The procedure of reexamination shall terminate if the person who requests for reexamination withdraws its/his request for reexamination before a reexamination decision is made.

#### **4.11 After Making the Appeal Decision**

##### **In JPO**

(1) If the appeal is accepted by the appeal decision:

The case is concluded upon the appeal decision. No other demand based on dissatisfaction is possible. If a third party is dissatisfied with the appeal decision, the only way is to demand a trial for invalidation.

(2) If the appeal is deemed to be un-established by the appeal decision:

The dissatisfied party can file a suit against the appeal decision with the IP High Court (Tokyo High Court) (Section 178).

The plaintiff is the demandant of the trial, and the defendant is the Commissioner of the Patent Office. This suit cannot be filed after 30 days have passed from the date on which the appeal decision was dispatched.

If a suit against appeal decision is not filed, the appeal decision to deem the appeal as un-established is confirmed. The refusal of that patent application becomes final and conclusive. If, during a suit against appeal decision, the appeal decision is maintained, and the judgment becomes final and conclusive, the appeal decision to deem the appeal as un-established is settled at the same time.

However, if, during a suit against appeal decision, the appeal is found reasonable, and the appeal decision is revoked, the case returns to the Patent Office (Section 181, Subsections 1 and 2). If there are no other grounds for rejection, the appeal is then accepted.

##### **In SIPO**

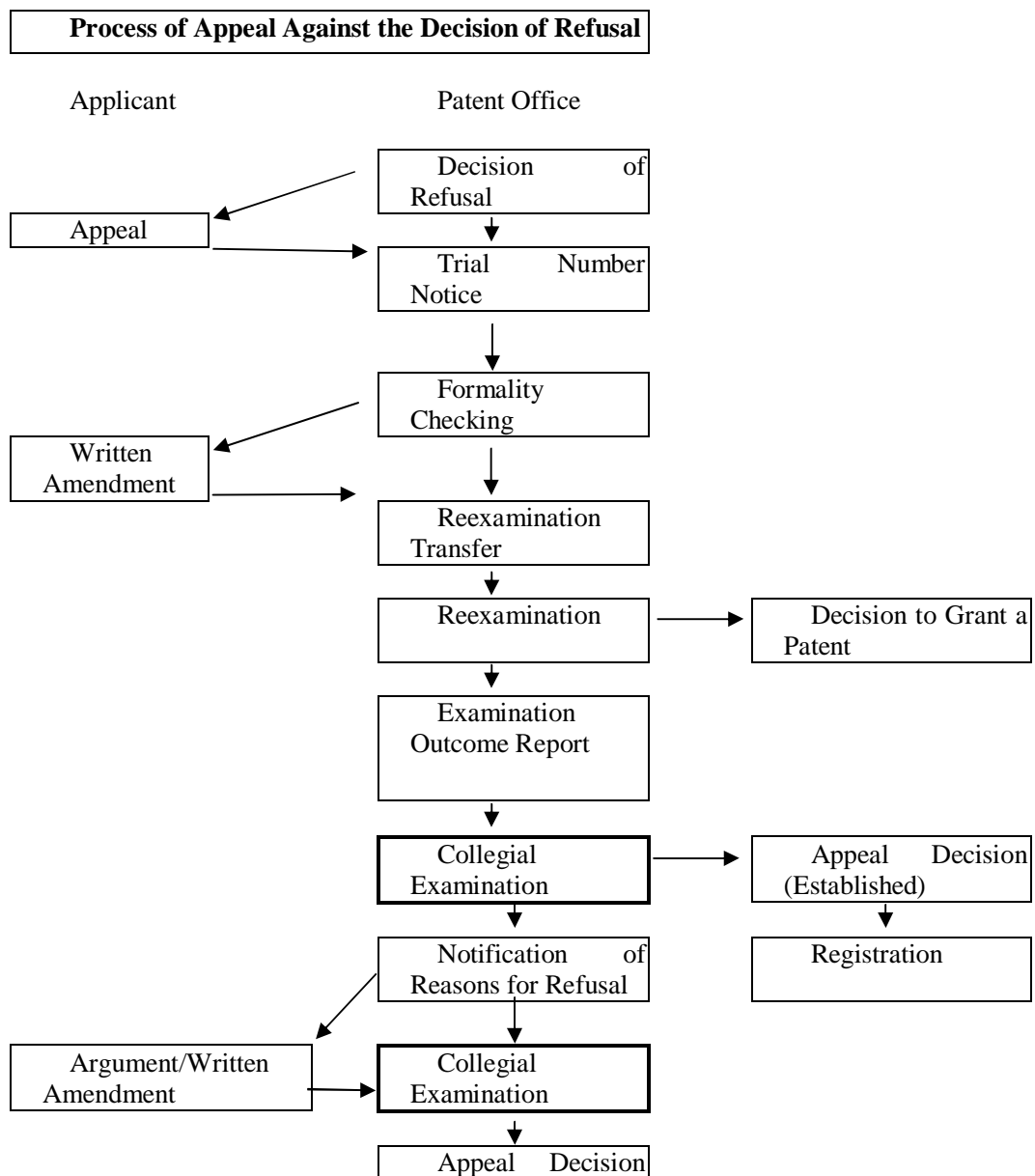
The procedure of reexamination shall terminate if the request for reexamination is deemed to have been withdraw for failure of making a response when the time is due.

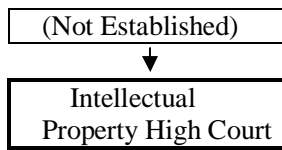
Where the person who requests for reexamination is not satisfied with the reexamination decision, it/he may institute legal proceedings in the People's Court according to Section 41.2 of

the Patent Law within three months from the date of receipt of the reexamination decision. The Patent Reexamination Board shall appear before court as the defendant.

When no legal proceedings are instituted in the court within the specified time limit, the reexamination decision shall take effect and the reexamination procedures terminate. The Patent Reexamination Board shall return the relevant application file to the examination department that made the initial examination. The examination department shall continue the procedures of examination and approval according to the reexamination decision.

#### 4.12 Flow Chart of Appeal against the Decision of Refusal in JPO





## **Chapter 5 Comparison of Proceeding of Trial for Invalidation**

### **5.1 Outline of the Trial for Invalidation**

#### **In JPO**

The patent right becomes effective once a decision to grant a patent is accepted, and the patent right is registered. If there is a flaw in this patent right which makes it essentially invalid, the patent would place undue restriction on the use of otherwise free technology. Therefore, the patent must be removed from the society, as it is harmful to the society. The trial to invalidate this patent right is called a trial for invalidation.

Many trials for invalidation are related to infringement cases. When an infringement case arises, the accused demands a trial for invalidation as one of the countermeasures. If the trial decision invalidates the patent, the patent right is deemed never to have existed (Section 125).

A trial for invalidation may only seem as a conflict between the concerned parties, but its binding legal effect extends to third parties. For this reason, a trial for invalidation is a proceeding by *ex officio*.

There is no time restriction placed on a demand for a trial for invalidation. Except for the instance when the demandant is using the same facts and the same evidence (Prohibition of Double Jeopardy, Section 167), complaints can be filed as many times as required. This aim is to prevent registration of the invention of non-patentability from adversely affecting the profits of large numbers of the general public. However, opinions are divided over this issue.

A trial for invalidation proceeds according to the adversarial system and by oral proceeding (Section 145).

A party dissatisfied with a trial decision can file a suit against the trial decision with the Intellectual Property High Court (Section 178, Subsection 1). The concerned party is the demandant or the defendant of the trial for invalidation (Section 178, Subsection 2).

(Note) Law No. 47 of 2003 (came into force on January 1, 2004)

With the view to realizing prompt and precise settlement of a dispute, in accordance with the revision of the Law in 2003, the opposition system was abolished and integrated into the invalidation trial system. Additionally, to ensure appropriate offense and defense in a trial for invalidation, the requirements for grounds for appeal described in a written demand are clarified and a party is granted a new opportunity for offense by changing the gist of the grounds for demand originally described. Furthermore, the revised Law lays down the provision that in a suit against a trial decision reached in a trial for invalidation, if a trial for correction is demanded after institution of the action, the Court may decide in its judgment to revoke the trial decision and remand the case to the Patent Office so that the invalidation trial case remanded should absorb the “demand for a trial for correction” as a “demand for correction.” [In addition, a system of request for opinion/statement was introduced to enable the Patent Office to be involved in a suit against the trial decision of a trial for invalidation to which the Patent Office is not a litigant party, when necessary, if interpretation of the law and/or standard of enforcement is brought into question and so on.]<sup>43</sup>

### **In SIPO**

The trial for invalidation in JPO is called “Invalidation” in SIPO. The purpose and the basic procedures of Invalidation in SIPO are similar to the trial for invalidation in JPO.

Regarding the trial for invalidation, the position of the Appeal Department of JPO and the Patent Reexamination Board is different

The Appeal Department of JPO acts as a “quasi-judicial” role, at least as a “quasi-lawsuit administrative” role. On the other hand, the Patent Reexamination Board of SIPO only acts as an administrative role.

The judicial system of patent administrative cases is also different with respect to the trial for invalidation. The Appeal Department of JPO is not acted as the defendant in court proceedings, while the Patent Reexamination Board of SIPO must be acted as the defendant in court proceedings, the dissatisfied party as the plaintiff, the virtual adversary as the third party.

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<sup>43</sup> See: Part of 51-00 of Manual of Appeal and Trial Proceedings in JPO (Japanese version), that is, 51-00 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

Moreover, there are three instances examination in the judicial system of Japan, and regarding the patent administrative cases, the Appeal Department of JPO conducts the first instance examination, that is, the So-called “Preliminary Trial”. In china, there are two instances examination only in the judicial system, and the Patent Reexamination Board of SIPO only conducts the administrative procedures, not one instance examination of judicial.

## **5.2 Demand**

### **5.2.1 Standing of the Parties**

#### **Standing of a Demandant:**

##### **In JPO**

As a rule, there are no restrictions for the number of persons. If there are several demandants, a joint trial is possible (Section 132, Subsection 1).

##### **In SIPO**

It is same to JPO.

#### **Standing of a Defendant:**

##### **In JPO**

A person currently registered as a patentee in the patent register. In case of a joint patent, all of the co-proprietors must be the defendants (Section 132).

##### **In SIPO**

It is same to JPO.

#### **Intervener:**

##### **In JPO**

When a third party joins one of the concerned parties in the proceedings during a trial for invalidation, the third party is called to be an intervener.

##### **In SIPO**

There is no related regulation regarding the “Intervener”.

### **5.2.2 Demand Period**

**In JPO:** A demand can be made at any time (Section 123, Subsection 2).

**In SIPO:** It is same to JPO.

### **5.2.3 Object of Demand**



**In JPO:** A demand can be made for each claim (Section 123, Subsection 1).

**In SIPO:** It is same to JPO.

### **5.3 Amendment to a Written Demand for Trial**

#### **In JPO**

Amendment to a written demand for a trial must not alter the gist of the demand (Section 131-bis). Some examples of amendment to a written demand for a trial are a change of the concerned party and a change of object for a trial.

To accelerate the trial examination for the trial for invalidation, the 1998-revised law relating to the trial examination was provided so that changing the grounds for demand in the written demand for a trial for invalidation may be considered as altering the gist of the written demand (Section 131, Subsection 2).

Where an amendment made to the grounds for the demand change the gist thereof, the trial examiner-in-chief may permit the amendment by a ruling, when there is clearly no apprehension that the amendment does not cause unreasonable delay in the trial and the amendment is recognized by him to fall under any of the following paragraphs:

(i) Where the demand for correction is made in the patent invalidation trial, it is necessitated thereby to make an amendment to the ground for the demand.

(ii) Where there are the justifiable reasons for omitting the statement with respect to the grounds for the demand relating to relevant amendment in the written demand at the time when the demand was filed, in addition to the case referred to in the preceding paragraph, and when the defendant has agreed to the amendment concerned.

#### **In SIPO**

It is regulated in the Rule 66 of the Implementing Regulations of the Patent Law of China that after a request for invalidation is accepted by the Patent Reexamination Board, the person making the request may add reasons or supplement evidence within one month from the date when the request for invalidation is filed. Additional reasons or evidence which is submitted after the specified time limit may be disregarded by the Patent Reexamination Board.

New grounds for invalidation that are submitted by the person who requests for invalidation after one month from the date of submitting the request for invalidation and which need to be supported by new evidence and new evidence which is used to support the specific facts which fail to be supplied with the burden of proof within one month from the date of submitting the request for invalidation may be disregarded by the panel.

Now, the Guideline for Examination of SIPO has been revised and the relevant regulation has changed, that is, in general, the person making the request **shall** add reasons or supplement evidence within one month from the date when the request for invalidation is filed. Additional reasons or evidence which is submitted after the specified time limit **should** be disregarded by the Patent Reexamination Board.

#### **5.4 Transmitting a Duplicate of the Written Demand for Trial for Invalidation and Submitting a Written Reply**

##### **In JPO**

The examiner-in-chief transmits a duplicate of the written demand to the patentee (Section 134).

In response, the patentee (**defendant**) opposes the demand by means of a written reply within 60 days (Section 134). A demand for correction may accompany the submission of the written reply. The examiner-in-chief transmits duplicates of this written reply and the amendment to the demandant (Section 134, Subsection 4). The demandant opposes the written reply and the demand for correction by means of a written reply.

##### **In SIPO**

It is similar to JPO. The time limit is generally one month which is short than that regulated by JPO.

#### **5.5 Demand for Correction**

##### **In JPO**

When there is a demand for a trial for invalidation, corrections are made in many cases to protect the patent. For this reason, the examination for correction can be conducted as part of the trial for invalidation. This is called a demand for correction.

Period in which a demand for correction can be made: submission period for a written reply, or submission period for an argument in response to the notification of reasons for invalidation (Section 134-bis).

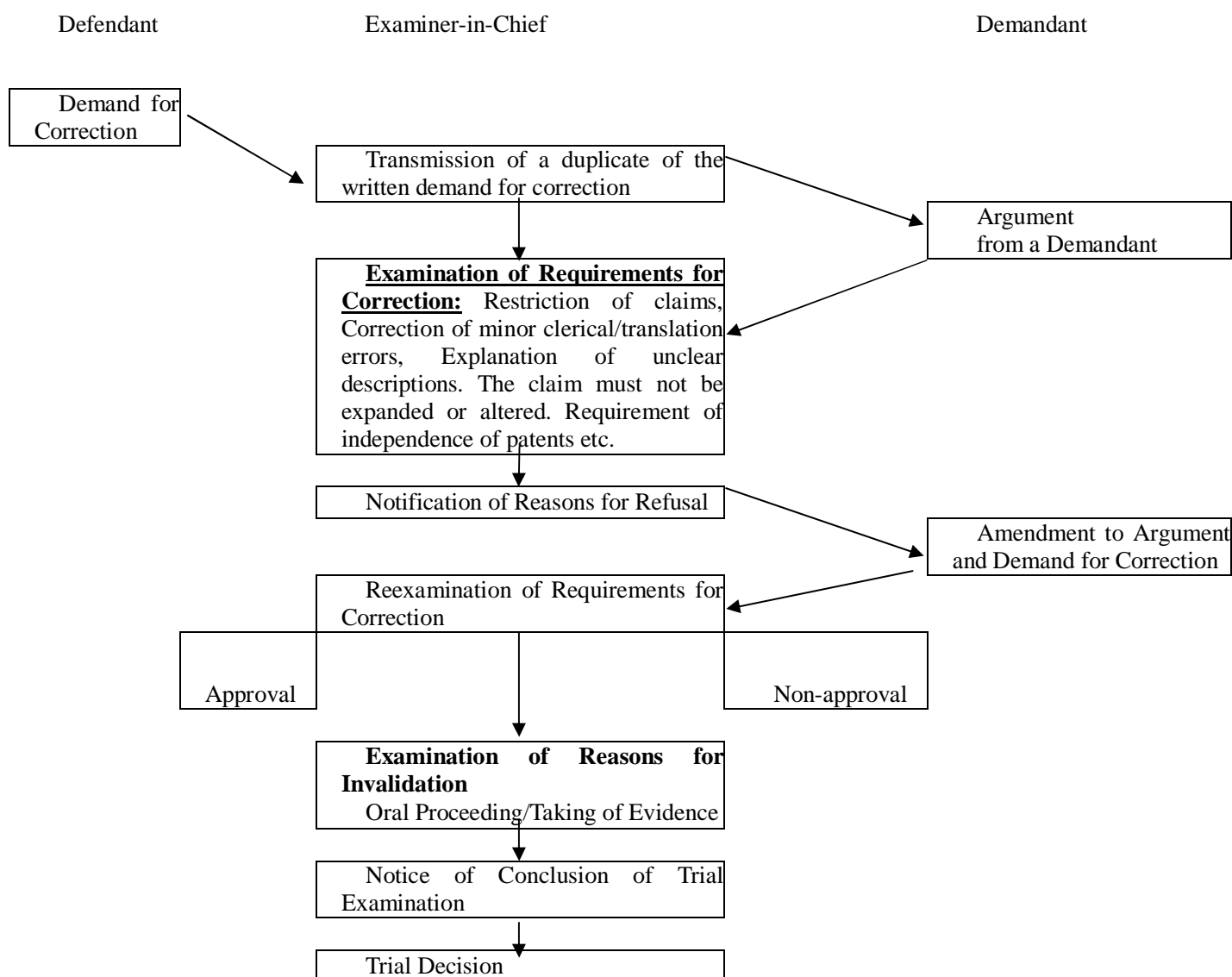
New periods for submitting a demand for correction have been added to the above periods in 2003:

(1) Submission period for a written reply in response to eligible new grounds for invalidation (Section 134-bis).

(2) A specified period for a demand for correction for a trial for invalidation resuming due to the decision for remand (Section 181, Subsection 2) during a suit against a trial decision (Section 134-ter, Subsection 2).

(3) A specified period for a demand for correction when a decision to maintain a patent is revoked during a suit against a trial decision (Section 134-ter, Subsection 1).

### Flow Chart of a Demand for Correction



If correction is approved, a clause stating such is entered in the conclusion of the trial decision.

When the trial decision approves the correction, it is considered that all the necessary phases have already been completed using the specification or drawings after correction. These phases

are: a patent application, publication of unexamined applications, a decision to grant a patent or a trial decision, and registration of establishment of the patent right (Section 128).

### **In SIPO**

There is no independent correction proceeding in Appeal/Trial system in SIPO. There is an amendment of patent documents only in invalidation procedure.

The amendment to the documents of the patent for invention or utility model shall be limited only to the claims which is different from the regulation of JPO and shall follow the principles set forth below:<sup>44</sup>

- (1) The title of the subject matter of the initial claim shall not be changed;
- (2) Compared with the claim of the granted patent, the amendment shall not extend the scope of protection of the initial patent;
- (3) The amendment shall not go beyond the scope of the disclosure contained in the initial description and claims; and
- (4) Addition of technical features that is not included in the claims of granted patent is usually not allowed.

On condition that the above-mentioned principles for amendment are satisfied, the amendment of the claims shall limit usually to the deletion or combination of claims and the deletion of the technical solution. The above-mentioned amendments may be used separately or in combination.

After the expiration of the time limit prescribed by the Patent Reexamination Board in the transfer of request for invalidation, the notification of new ground or new evidence documents or the notification of examination of invalidation in which new grounds or new evidence that have not been referred to by requesting party are introduced, the patentee of patent for invalidation can amend the claim only by way of deletion.

Before the examination decision is made, the patentee may either delete the claim or delete the technical solution contained in the claim.

Where a claim is amended by way other than the deletion, the person requesting for invalidation shall be given an appropriate opportunity by the collegial panel to present new grounds and evidence of and observations for the request of invalidation in respect of the amended claim.

The patentee for design shall not be allowed to amend its/his patent documents.

## **5.6 Trial Examination**

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<sup>44</sup> See: 5.4 of the Chapter 3, Part IV of the Guidelines for Examination of SIPO (English version), which was promulgated and effective as of October 18, 2001

### **5.6.1 Method of Trial Examination**

**In JPO:** A Trial for patent invalidation is conducted by an oral proceeding. The examiner-in-chief may change the method to a documentary proceeding.

**In SIPO:** it is similar to the regulation of JPO.

### **5.6.2 Oral Proceeding**

#### **In JPO**

Around the year 2000, the number of demands for a trial for invalidation began to rise. To deal with these demands in a speedy fashion, the oral-proceeding method began to be employed for a trial for invalidation. In addition, “scheduled trial examinations” were introduced in 2001 to enable a trial decision to be made in approximately one year. Oral proceedings are open to the public (Section 145, Subsection 5).

**In SIPO:** The situation of development of oral proceeding is similar to that of JPO.

### **5.6.3 Scheduled trial examination**

#### **In JPO**

Trial for invalidation is often demanded in conjunction with a dispute over infringement, etc. In order to ensure the effectiveness of the protection of rights, it is increasingly necessary to pronounce adjudication upon the validity of a right without delay. For this purpose, the Department of Appeal, the Patent Office has implemented a “scheduled trial examination in a trial for invalidation” under which both parties to a trial for invalidation and the collegial body mutually coordinate to create cooperative relationships, lay out a schedule for the trial examination clearly and conduct the trial examination of a trial for invalidation according to the schedule.<sup>45</sup>

In practical examination, there is nearly no case of scheduled trial examination in trial for invalidation because the efficiency of examination of invalidation has been increased.

**In SIPO:** There is no relevant regulation regarding the scheduled trial examination in SIPO.

### **5.6.4 Trial Examination by Ex Officio**

#### **In JPO**

At a trial for invalidation, reasons that have not been stated by the concerned party or the intervener can be examined (Section 153, Subsection 1). In other words, an appeal examiner can

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<sup>45</sup> See: Part of 51-12 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 51-12 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

collect basic references for the trial decision by ex officio in order to examine the reasons that have not been stated by the concerned party or the intervener.

This is because a trial is a disposition by the Patent Office that is a government office, and any such disposition will have an influence on the society's view. However, if reasons that have not been stated by the concerned party or the intervener are examined, the result of such a trial examination must be given to the concerned party or the intervener to provide an opportunity for an argument.

However, this ex-officio principle is restricted to a degree for a trial for invalidation. The regulations state that the purport of a demand which has not been stated by the demandant cannot be examined (Section 153, Subsection 3).

#### **In SIPO**

In invalidation cases, when necessary, the collegial body may, ex officio, request the party concerned to supplement evidence in respect of the facts alleged by it/him within the prescribed time limit.

When necessary, such general knowledge as technical dictionary, technical manual, textbooks, etc. which have fallen into public domain in the technical field may be introduced into the examination as evidence by the collegial body.

The Patent Reexamination Board may itself investigate relevant facts or verify relevant evidence, or entrust a local administrative authority for intellectual property affairs (or any corresponding functional organs), or other relevant entities to do so. The necessary costs shall be borne by either the Patent Reexamination Board or the party concerned.

When necessary, especially when a meaningful examination conclusion can not be drawn from the grounds as submitted by the person in its/his request for invalidation due to the miss of some of the defects which exist in the patent right by the person requesting for invalidation, the collegial body may perform examination ex officio on the grounds which have been missed by the said person.

### **5.7 Withdrawal of a Demand for Trial**

#### **In JPO:**

A demand for a trial can be withdrawn up to the time the trial decision becomes final and conclusive (Section 155, Subsection 1). However, after the submission of a written reply has taken place, the demand for a trial cannot be withdrawn without the consent of the opposing party (Section 155, Subsection 2).

The withdrawal can be made on a claim-by-claim basis (Section 155, Subsection 3).

#### **In SIPO:**

A demand for a trial can be withdrawn up to the time before making the invalidation decision without the consent of opposing party at any time.

## **5.8 Conclusion of a Trial Examination**

### **In JPO:**

When it becomes high time to make a trial decision, the examiner-in-chief must give notice of conclusion of a trial examination to the concerned party and the intervener (Section 156, Subsection 1). This notice is called a Notice of Conclusion of a Trial Examination. It is done either verbally or in writing.

### **In SIPO:**

In SIPO, it is not necessary to issue the Notice of Conclusion of a Trial Examination before making the invalidation examination decision.

## **5.9 Trial Decision**

### **In JPO**

Details to be described in the trial decision are essentially the same as those of the appeal decision for the appeal against the decision of refusal. The differences are explained below.

#### Conclusion of a Trial Decision

When a demand is established, → “the patent for the invention as claimed in claim xx of the specification for Patent No. xxxx is recognized invalid. The court costs shall be borne by the defendant”.

When a demand is not established, → “the demand examined in this trial cannot be established”.

#### Grounds for a Trial Decision

Grounds for a trial decision consist of the following. The point of difference from the appeal decision is that the argument of the concerned party is taken into consideration, and the disputed points are organized and interpreted before a decision is reached.

History of the establishment of the patent

Identifying of the patent

The demandant’s argument

The defendant’s argument

Interpretation of the disputed point

Conclusion

### **In SIPO**

The examination decision includes the following components

- (1) Bibliographic data of the examination decision
- (2) Legal bases
- (3) Main points of the decision

The main points of the decision are essential summaries and core expositions of the grounds on which the text of the decision is based. It is the criteria for the judgment of the issues in dispute or for the difficult points of the case.

- (4) Cause of action
- (5) Grounds of decision
- (6) Conclusion

There are three types of examination decision with regard to a request for invalidation:

- (1) Decision on declaring invalidation of patent right;
- (2) Decision on declaring part invalidation of patent right;
- (3) Decision on maintenance of validity of patent right.

## **5.10 Conclusion of a Trial Case**

### **In JPO**

A trial case opens upon demand for a trial, and concludes when a trial decision is reached (Section 157, Subsection 1). A trial case is also concluded if a demand is withdrawn (Section 155).

A demand for a trial can be withdrawn up to the time the trial decision becomes final and conclusive (Section 155). However, after the submission of a written reply has taken place, the demand for a trial cannot be withdrawn without the consent of the opposing party (Section 155, Subsection 2).

### **In SIPO**

Where the person requesting for invalidation withdraws its/his request before the Patent Reexamination Board makes an examination decision on it, the procedures of invalidation shall terminate.

Where the person requesting for invalidation fails to make a response to the notification of oral procedure within the prescribed time limit and fails to take part in the oral procedure, and its/his request for invalidation is deemed to have been withdrawn, procedures of invalidation shall terminate.



Of course, when the collegial panel has finished making the examination decision and issued it, the invalidation case concerned concludes.

## **5.11 After a Trial Decision**

### **In JPO**

Whether a trial decision accepts or rejects a demand, one of the concerned parties may be dissatisfied with the trial decision.

The dissatisfied party can file a suit against the trial decision in the IP High Court (Tokyo High Court) within 30 days from the date on which the trial decision is dispatched (Section 178). If the demand for trial is established, the patentee becomes the plaintiff, and the demandant of the trial becomes the defendant. If the demand for trial is not established, the roles are reversed.

If a suit against the trial decision is not filed, the trial decision becomes final and conclusive.

### **In SIPO**

It is similar to JPO, but there are two differences as follows:

(1) The time limit is different. The dissatisfied party can file a suit against the invalidation decision in the Beijing First Intermediate People's Court within 3 months from the receipt of notification of the decision.

(2) No matter which party who is not satisfied with the decision made by the Patent Reexamination Board, the Patent Reexamination Board shall act as a defendant before the court.

## **5.12 Final and Conclusive Trial Decision**

### **In JPO**

If the decision to cancel the trial decision has been reached during the suit against the trial decision, the trial proceedings will resume at the Patent Office. However, if the decision to dismiss the demand has been made, the trial decision becomes final and conclusive.

The final and conclusive trial decision is registered in a register (Section 16, Subsection 7 of the Patent Registration Order).

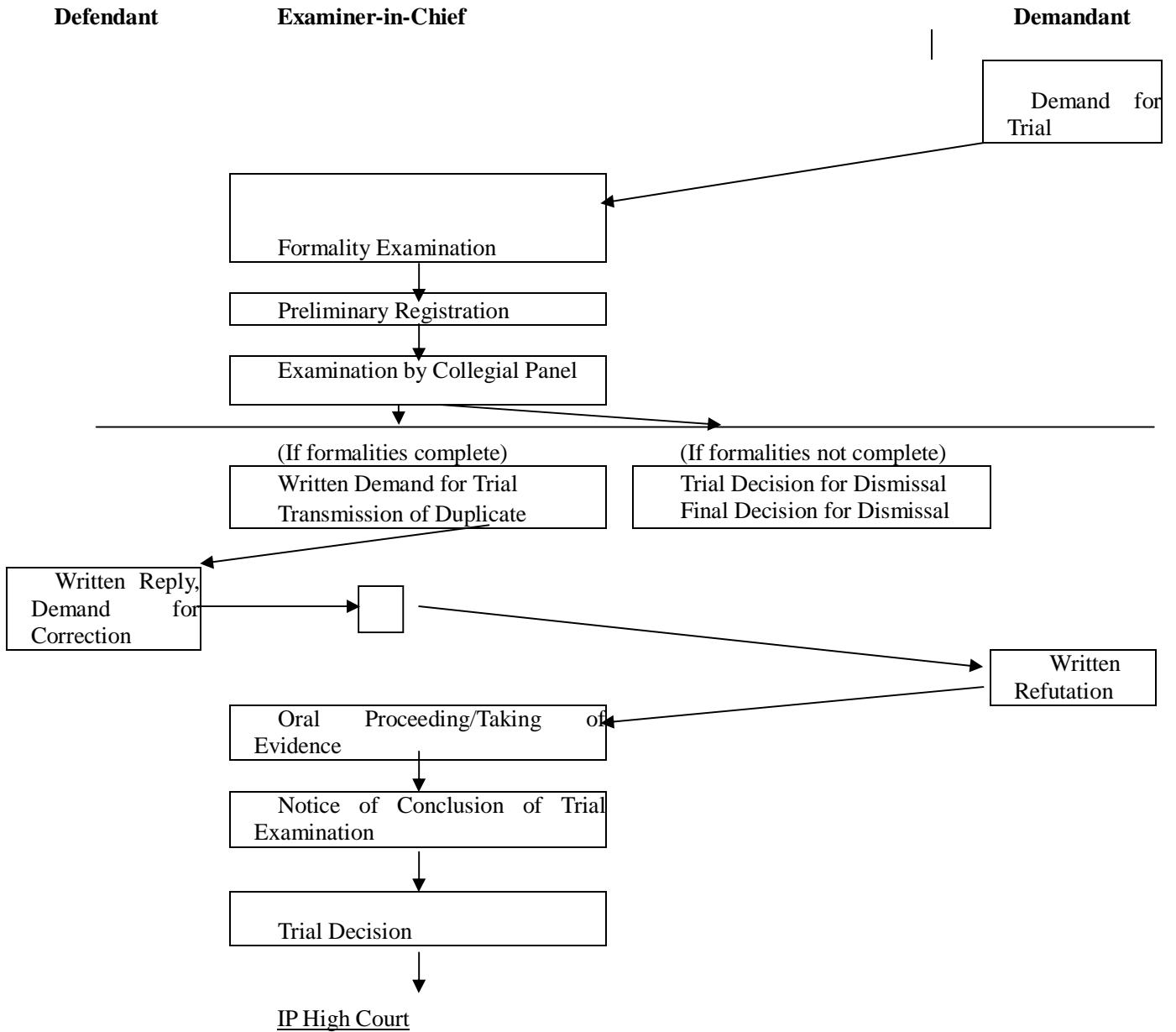
When a trial decision to invalidate a patent is final and conclusive, the patent right is deemed never to have existed (Section 125).

When a final and conclusive decision from a trial for invalidation of a patent has been registered, a trial cannot be demanded based on the same facts and the same evidence (Section 167, prohibition of double jeopardy).

**In SIPO**

It is regulated like JPO.

**5.13 Flow Chart of a Trial for Invalidation in JPO**



## **Chapter 6 Appeal/Trial Proceedings of JPO Which Are Not Existent in SIPO**

### **6.1 Trial for Correction<sup>46</sup>**

#### **6.1.1. Purpose of the system**

In cases where there are grounds for invalidation of patent, it is necessary to defend against the patent being invalidated through a demand for trial for invalidation made on the basis of those grounds, or to take preventive measures against a trial for invalidation being demand, and, in cases where the items relating to a patent are unclear, it is necessary to clarify the unclear portions, since they should come to affect the profit of third parties, by giving rise to infringement incidents or hindering making contracts. The system of trial for correction serves to ensure the right of patentees to make voluntary corrections to the specifications or drawings attached to the requests in such situations.

In connection with this, by the Patent Law revision which was effected by Revising Law No. 26 of 1993 (entered in force on January 1, 1994), as part of the general work on simplification of trial procedures, it is made possible, within the invalidation trial proceedings, to demand correction of the specification or drawings attached to the request (Section 134 (2)), but, on the other hand, when a trial for invalidation is pending in the Patent Office, it is not possible to demand a trial for correction separately (the Patent Law, Section 126 (1)).

Furthermore, the Patent Law revised in accordance with Law No. 116 of 1994 introduced a post-grant opposition system (came into force on January 1, 1996). As a consequence, during the pendency of an opposition to the granting of a patent, it is permissible to enter a demand for correction of the specification or drawing(s) attached to the request in the procedures thereof (Patent Law 120-4(2)), as a result of which a trial for correction may not be demanded independently (Patent Law 126(1)). Subsequently, however, the Patent Law revised in accordance with Law No. 47 of 2003 (came into force on January 1, 2004) abolished the opposition system.

Additionally, pursuant to the revision of the Patent Law in accordance with Law No. 47 of 2003 (came into force on January 1, 2004), the period for demand for a trial for correction to be entered after a suit against the trial decision is filed shall be subject to restriction under which in principle, a trial for correction may not demanded after the institution of an action, yet a trial for correction may be demanded exceptionally for a period of 90 days after the action is instituted (to be

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<sup>46</sup> See: Part of 54 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 54 of “審判便覧”, <http://www.jpo.go.jp/shiryuu/index.htm>

computed from the date when the action is instituted) (Patent Law, Section 126 (2)). At the same time, the revised Law laid down the provision that in the case that a trial for correction is demanded after the institution of an action against a trial for invalidation demanded after the said Law came into force, if the Court holds it appropriate for the propriety of the correction and the validity of the patent for correction to be examined at a trial for invalidation, the Court may decide to revoke the trial decision by decision and remand the invalidation trial case to the Patent Office (Patent Law, Section 181(2)(3)), and the provision that if remanded, the demand for a trial for correction shall be absorbed into the procedures of a trial for invalidation as a demand for correction (Patent Law, Section 134-3). As a trial for correction is very often related to a case for invalidation trial /a case for *Hantei* (advisory opinion on the technical scope of a patented invention) or an infringement case and can affect the conclusion arrived at in a trial decision or a judgment, it is desirable to conduct the trial examination at a stage as early as possible. However if a trial for invalidation is demanded after the trial for correction is demanded, it is necessary to proceed with the trial examination with due consideration to the proceeding of the trial for invalidation, because in some cases a more precise demand for correction is entered in the course of the trial for invalidation (→51-09. Also it should be noted that the effect of a patent based on the specification, the scope of claim(s) or drawing(s) as corrected shall extend to persons skilled in the art and the general public).

The Law revised in accordance with Law No. 116 of 1994 (came into effect on July 1, 1995) provides for post-grant correction of incorrect translations.

(Revised in July, 2005)

#### **6.1.2 Scope in which Correction may be made**

The scope over a patentee can demand trial for correction relating to the specification or drawings attached to the request is prescribed in the Patent Law, Section 126.

The objective of the prescription of the scope of corrections in this article is that, in view of the fact that there is the undesirable situation that effects on those skilled in the art other than the patentee and also on many other unspecified ordinary third parties if correction of the specification or drawing results in changes relating to the descriptions per se of the specification of the drawings, or to the scope of the efficacy of the patent rights, which derive from such descriptions, or to the identity of the content or concept, etc. of the invention before and after the correction, and from consideration of the profits to the patentee and to third parties who rely on the representations of the specification or the drawings attached to the request, it is necessary to keep the scope of corrections to the necessary minimum.

It should be noted that the scope correctable upon demand does not include any correction to add new matters, regardless of the filing date, in a trial for correction demanded on and after January 1, 1994.

(1) Within the scope of matters described in the specification or drawings attached to the request, demands may only be made for a trial for corrections with whose objects are the following (the Patent Law, Section 126(1); the Supplementary Provisions, Section 4(2); the former Utility Model Law, Section 39(1)).

a: Restriction of claim or claims (the Patent Law, Section 126(1) Proviso No. 1)

b: Correction of errors (the Patent Law, Section 126(1) Proviso No. 2 )

c: Clarification of unclear description (the Patent Law, Section 126(1) Proviso No. 3 )

Corrections may be suitable combinations of these.

(2) Restriction of the scope of claim(s) (Patent Law 126(1), proviso (i))

“Restriction of the scope of claim(s)” means to restrict the scope of claims(s) by limiting descriptions in claim(s), in the likelihood that the description of the scope of claim(s), if left uncorrected, is found defective involving publicly-known art, thus becoming susceptible to grounds for invalidation or revocation of a patent.

(3) Correction of errors (Patent Law 126(1), proviso (ii), former Utility Model Law 39(1), proviso (ii))

“Correction of errors” means the correction of the description that does not represent the original purport by mistake to a description that represents the original purport.

(4) Correction of incorrect translations (Patent Law 126(1), proviso (ii))

“Correction of incorrect translations” means the correction of a description in the translation different from the purport in the original document written in a foreign language (incorrect translation) to a description that represents the purport in the original document written in a foreign language.

(5) Clarification of an ambiguous description (Patent Law 126(1), proviso (iii), former Utility Model Law 39(1), proviso (iii))

“Clarification of an ambiguous description” means to rectify such deficiency in what is described in the specification, claim(s) or drawing(s) as an unclear description in the specification, the scope of claim(s) or drawings(s) it purports, or a description leaving uncertainty due to disagreement with other descriptions in the specification, the scope of claim(s) or drawing(s) for clarification of the original purport. For the clarification of an ambiguous description to be accepted, it is required that (1) there should be an unclear description in the specification, the scope of claim(s) or drawing(s), and (2) the description as corrected should fall within the scope of what is described in the specification, the scope of claim(s) or drawing(s), in other words,

should be matters explicitly described in the specification, the scope of claim(s) or drawing(s) or self-evident from the description in the specification, the scope of claim(s) or drawing(s).

(6) The correction may not substantially enlarge or modify the scope of claim(s) (Patent Law 126(4), former Utility Model Law 39(2))

“Substantially enlarge” means to enlarge the scope of claim(s) by modifying the description of the scope of claim(s) itself (for example, correction by replacing with an expression representing matters described in the claim(s) in the broader sense), as well as by merely modifying what is described in the specification or drawing(s) without making any modification in the scope of claim(s).

(7) Application of Prohibition of double jeopardy

The provisions of Section 167 of the Patent Law (prohibition of double property) shall not apply, but the provisions of Section 142 of the Code of Civil Procedures (prohibition of institution of a double suit) could apply by analogy to such case that a patentee repeatedly enters a demands for trial for correction with exactly the same details.

(8) Correction of the specification along with the restriction of the scope of claim(s)

If the scope of claims(s) is to be restricted and accordingly the description in the specification is to be corrected, generally speaking, the patentee corrects the scope of claim(s) for the purpose of “restriction” and corrects the specification for the purpose of “clarification of an ambiguous description.” (Revised in July 2005)

### **6.1.3 Time requirements for demanding a trial for correction**

1. When trial may be demanded

(1) After the registration of patent right

The patentee may demand a trial for correction after the registration of the patent right, but a trial for correction may not be demanded during the period between the time when a trial for invalidation comes to pendency before the Patent Office and the time when the trial decision thereof becomes final and conclusive, except for a period of 90 days from the date when action is instituted against the trial decision of a trial for invalidation (Patent Law 126(1)(2), 1993 Supplementary Provisions<sup>4</sup>(2), former Utility Model Law 39(1)).

(2) During the pendency of a trial for invalidation

After a trial for invalidation is instituted, during its pendency, it is necessary to defend by correcting the specification, etc. to avert the grounds for invalidation contended by the appellant

for an invalidation trial. In this case, as the patentee may enter a “demand for correction” during the period specified by the trial examiner-in-chief in the course of the trial for invalidation, a trial for correction may not be separately demanded in principle.

(3) After a suit against a trial decision is instituted

A trial for correction may be demanded during the period limitedly to 90 days from the date when action is instituted against the trial decision of a trial for invalidation (inclusive of the day when action is instituted) (Patent Law 126(2) proviso). Also, during the said period, a trial for correction may be demanded even if a separate trial for invalidation is pending before the Patent Office.

(Explanation)

Section 126(1) of the Patent Law before its revision in 2003 provided that a trial for correction may be demanded “except when a trial for invalidation is pending before the Patent Office,” thus allowing a trial for correction to be demanded at any time after a suit against the trial decision is filed.

On the other hand, the Judgment of the Supreme Court rendered in 1999 (Case No. 1995 (Administrative) 204: a case concerning a large-diameter square steel pipe) holds that if the correction to restrict the scope of claim(s) concerning the relevant patent becomes final and conclusive while a suit against the trial decision is pending before the Court, it is not appropriate for the Court to proceed with the examination of the patent for correction, so that the trial examination of the patent for correction must be conducted in a trial for invalidation in the first place, continuing that in such a case, the trial decision shall be revoked and a trial examination shall be conducted again in a trial for invalidation under the Patent Office. Following the said Judgment, it is prevailing judicial practice to revoke the trial decision of a trial for invalidation almost automatically once the trial decision for correction becomes final and conclusive.

In consequence of the said Judgment of the Supreme Court, in an increasing number of cases, the patentee given the decision for invalidation demanded a trial for correction while instituting action at the same time in order for such a decision to be automatically revoked, but also there were more cases reported where a trial for correction was demanded just before the closing of a suit against the trial decision before the IP High Court (Tokyo High Court) or at the critically later stage scheduled for filing an appeal to the Supreme Court.

Against this background, under the Law of 2003, restriction is put on the period when a trial for correction may be demanded after the institution of a suit against a trial decision of a trial for

invalidation, providing that the trial for correction may not be demanded after an action is instituted in principle with the exception that a trial for correction may be demanded during the period of 90 days from the date of action instituted.

By putting the said restriction on the period when a trial for correction may be demanded after an action is instituted, it would resolve the prolonged procedures starting with a suit continuing over a long period of time, through the re-pendency of a trial for invalidation before the Patent Office, up to the final conclusion of the trial examination in a trial for invalidation. On the other hand, a certain period of time is granted to the demanding for a trial for invalidation even after action is instituted, instead of denying such demand completely, because it enables the patentee to make corrections corresponding to the determination made by the appeal examiners.

Note:

As to a trial for invalidation “coming to pendency before the Patent Office,” the following rules apply:

A trial for correction demanded in the period from the demanding for a trial for invalidation to the service of a duplicate of a written demand for a trial upon the appellee shall be treated as a lawful demand for a trial.

(Explanation)

(i) A trial for correction may not be demanded if a trial for invalidation comes to pendency before the Patent Office.

The purport stipulated in the provisions of (Patent Law 126(1)) lies in the expectation for a more prompt and precise trial examination in the course of a trial for invalidation, by limiting the correction of the specification or drawing(s) attached to the request to the procedures for the trial for invalidation during the pendency of the case of a trial for invalidation before the Patent Office so that the immediate and precise offense and defense are entered during the trial examination in a trial for invalidation, compared to a trial for correction proceeded independently of the trial for invalidation.

(ii) On the other hand, since it is the right of the patentee to correct the specification, when it comes to restricting such right to correction, the restriction should be to the minimum necessary for realizing the purport mentioned above in (i).

(iii) In view of (i) and (ii), the time of commencement of the restriction should be the time when both the appellant and the appellee take part in offense and defense, namely, the time of service of a duplicate of a written demand for a trial upon the appellee.

(iv) Therefore, it is appropriate to treat as lawful a demand for a trial for correction entered during the period from the demanding of a trial for invalidation to the service of a duplicate of the



written demand for a trial upon the appellee, while the patentee is unlikely to know that a trial for invalidation has been demanded.

(4) After the extinguishment of the patent right

A trial for correction may be demanded even after the extinguishment of the patent right. However, this provision does not apply after the patent is invalidated with regard to all of the claims in a trial for invalidation (Patent Law 123(1)) (Patent Law 126(6), former Utility Model Law 39(4)).

## **6.2 Hantei System (System of Advisory Opinion on the Technical Scope of the Patent Invention)<sup>47</sup>**

### **6.2.1 What is *Hantei* ?**

(1) The Japan Patent Office, having a high degree of expertise regarding technology, design and goods, will render an official *Hantei* in a strictly neutral manner regarding whether the subject article falls under the technical scope of the patented invention in question within as soon as three months from the time of filing of the *Hantei* demand.

(Note)

Since the patent right holder may, for the purpose of profit, exclusively manufacture, sell and exploit the patented invention, enforcement of this right will not only affect those in the same industry but will widely affect third parties. Even after lapse of the term of the patent right (20 years after the date of filing of the patent application, 15 years from the date of design registration), the patent right holder may demand damages for infringement that took place during the patent right term.

The following cases may therefore arise:

- i) A patent right holder wishing to know whether the goods of another party (object of working of invention) fall under the technical scope of the right holder's patented invention (infringement of the registered patent right),
- ii) A party other than the patent right holder wishing to know, when investing in research and development (R&D) or actually working an invention, whether the object of investment or

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<sup>47</sup> See: Part of 58-00 to 58-02 of Manual of Appeal and Trial Proceedings in JPO (Japanese version), that is, 58-00 to 58-02 of “審判便覧”, <http://www.jpo.go.jp/shiryou/index.htm>

working falls under the technical scope of another party's patented invention(The party wishes to work the invention without anxiety).

The *Hantei* system, in which the JPO, which granted the original patent right, renders an official opinion regarding the technical scope (including matters concerning equivalents) of the patented invention, has therefore been provided.

The *Hantei* system enables prevention of unnecessary patent disputes and is especially useful for venture businesses and small and medium enterprises for whom legal expenses may be burdensome.

(A duplicate of the demand for *Hantei* is delivered to the defendant for the purpose of notification.)

The *Hantei* system has been established for all areas of industrial property - patents, utility models, designs and trademarks.

- i) Technical Scope of Patented Invention (Patent Law Subsection 71(1), Patent Law Enforcement Ordinance Section 2, Patent Law Enforcement Rule Section 39 Form 57)
- ii) Technical Scope of Registered Utility Model (Utility Model Law Section 26)
- iii) Scope of Registered Design and the Like (Design Law Subsection 25(1))
- iv) Effect of Trademark Registration (Trademark Law Subsections 28(1) and 68(3))

Since *Hantei* results have no binding legal affects on defendants or third parties, it neither constitutes an official procedure of an administrative Office nor an exercise of public authority. However, since a *Hantei* is an official opinion of the JPO, the Office that granted the right in question, regarding the technical scope of the patented invention it is equivalent to an expert opinion, is sufficiently respected in society and is an authoritative opinion.

Moreover, in judgement Heisei 6 (1994) (O), 1083, Heisei 10 (1998) 2.24, the Japanese Supreme Court determined that, as a requirement for determining equivalency, it is necessary to determine whether the item in question is identical to publicly-known art at the time of filing of the patent application or could have been easily been made using publicly-known art at the time of filing of the patent application. The JPO, exploiting its capability as the authority carrying out patent examination, renders a decision regarding the scope of equivalency of the patent right upon rendering a decision on the patentability of the item in question as regards the possibility of substitution or ease of substitution. *Hantei* results contribute greatly to claims of equivalency in court.

(Note) What does "item in question" mean?

In demands for *Hantei*, if a demand has been filed in a case of the defendant actually working or having worked an invention or the patent right holder files a demand without a defendant, the "item in question" means the registered patent right of the demander.

Item in question is indicated as "item in question", "method in question", "drawing in question", "description in question", "design in question" or "trademark in question". When conflicting registrations are involved, the right of the recipient of the *Hantei* notification becomes the item in question. However, this party's right may also be directly indicated by its registration number (patent number).

If the item in question is a drawing, for the *Hantei* procedure to proceed smoothly the parties involved should confirm beforehand the drawing or a document expressing its contents in writing (virtual claim).

Items submitted by the recipient of the *Hantei* notification should be indicated by a character not used by the *Hantei* demander such as "item in question 2".

### **6.2.2 *Hantei* usage**

#### **A. Usage of *Hantei* results**

- (a) Confirmation of patent infringement (continuation or cessation of working)
- (b) Resolution of conflict by agreement of the parties involved in accordance with *Hantei* results (especially useful for petty disputes)
- (c) Use in legal proceedings:
  - i) As documentary evidence proving infringement
  - ii) As documentary evidence proving the item in question is an equivalent (evidence regarding the patentability of the item in question)
  - iii) As documentary evidence proving non-existence of cause of action in equitable action for injunction or in common law for claiming damages
- (d) Indication of patent numbers on goods
- (e) Use in negotiation for licensing, license agreement or transfer agreement
- (f) Use as an attachment to an application or information provision document (request of shoreline control of infringing goods) to customs
- (g) As a document providing the Police with grounds for accusation
- (h) As a document supporting a demand made to an arbitration institution
- (i) As evidence in a warning letter or rebuttal against such warnings
- (j) As a document to support claims of infringement of registered rights or antitrust laws

(k) As grounds to demand to the courts the opportunity to state an opinion if a claim seeking provisional injunction is submitted

B. Advantages of the *Hantei* system

- (a) Results rendered with strict neutrality
- (b) Reasonable fee of 40,000 yen (paid to the JPO)
- (c) Speedy rendering of results (as soon as three months from filing of the demand for *Hantei* )
- (d) Easy procedures (the same as trial examination procedures)

**6.2.3 Eligible parties and time periods for *Hantei* demands**

A. Eligible parties

Parties requesting *Hantei* opinions are not required to have legal interest in the *Hantei* result. However, from the perspective of the purpose of the system, the demander must briefly explain their need to demand a *Hantei* opinion in the space for reason in the *Hantei* demand form.

B. Eligible time period (Patent Registration Enforcement Regulation Ordinance Section 5)

The time period in which a *Hantei* opinion may be demanded for patents, utility models, designs and trademarks extends from the date of establishment of the right to 20 years after the registration lapses.

**6.2.4 *Hantei* demand procedures**

*Hantei* demand procedures are conducted in a fair and deliberate manner similar to trial examination procedures (The current *Hantei* system was previously called the "Trial examination identifying scope of registration" under the law of Taisho 10 (1935)) and are stipulated in Chapter 2, Sections 2 to 11 of the Patent Law Enforcement Ordinance.

A separate *Hantei* demand must be filed for each item in question.

In the *Hantei* demand the item in question should be described in the greatest possible detail. Also, the publicly-known art (document) closest to the item in question should be described in the greatest possible detail at the time of filing of the patent application.

When a demand for *Hantei* is submitted, a copy of the demand is sent to the defendant if one exists (A copy of the demand is not sent to the defendant if it is considered that the defendant did essentially give a plea or if there is no defendant). This provides the other party with the opportunity to submit a plea within the designated time period of, in principle, thirty days from receipt of the copy of the demand for *Hantei* for parties with domicile in Japan and sixty days for those with domicile outside of Japan. Extension of this designated time period by demand is not possible (Patent Law Enforcement Ordinance Subsection 7(1)).

A copy of the plea shall be sent to the demander of the *Hantei* opinion (Patent Law Enforcement Ordinance Subsection 7(2)).

After the copy of the plea of the other involved party is sent to the demander of the *Hantei*, trial examination (search and verification of evidence if necessary) begins and a *Hantei* is prepared. If the need arises, submission of refutations (plea rebuttal), second pleas and responses to interrogations may be demanded. For the purpose of *Hantei* preparation, submission of electronic data such as *Hantei* demands in floppy disk or e-mail format may also be demanded. Care must be taken in filing a demand for *Hantei* since any deficiencies in form may result in rejection of the demand.

### **6.2.5 Method of *Hantei* trial examination and trial examination period**

#### **A. Method of trial examination**

If a demand for *Hantei* is filed, *Hantei* is to be conducted by three examiners designated by the Commissioner of the JPO (Patent Law Subsection 71(2), Patent Law Enforcement Ordinance Section 5).

No examiner having a special relationship (grounds for disqualification or evasion) to a specific *Hantei* case shall be appointed to the case for the purpose of fairness. If any impediments arise regarding an examiner after their appointment, the examiner shall be discharged and replaced by a newly appointed examiner (Patent Law Enforcement Ordinance Sections 3 and 4).

One of the appointed examiners shall assume the role of chief examiner (similar to the chief appeal examiner in appeal cases). The chief examiner shall manage all clerical affairs for the case (Patent Law Enforcement Ordinance Section 6)

In principle, *Hantei* trial examination shall be document based trial examination. However, the chief examiner may conduct oral proceedings in accordance with a demand from the involved parties or ex officio (Patent Law Enforcement Ordinance Sections 8). If specification of the item in question is deemed to require a significant amount of time then the specification procedure shall be carried out with both involved parties in attendance.

The collegial body of examiners may also examine any grounds not raised by the parties involved. In such a case, however, the chief examiner must inform the parties involved of the result of the trial examination and specify a reasonable period of time for the parties to present their opinions in this regard (Patent Law Enforcement Ordinance Section 10).

When the *Hantei* trial examination concludes, a document shall be prepared containing certain items (*Hantei* demand number, description of the case for which *Hantei* was demanded, names or

corporate names and addresses or domiciles of the parties involved or their representatives, the *Hantei* result and the reason for the result and the completion date of the trial examination) and bearing examiners signatures and seals. The Commissioner of the JPO shall send a certified copy of this document to each party (Patent Law Enforcement Ordinance Section 11).

#### B. Period of Trial Examination

The period from demand for *Hantei* procedures to sending of the *Hantei* opinion shall be a minimum of three months (three months for cases in which both parties involved have domicile in Japan and there are no defects in formalities, etc.). The period required for *Hantei* will be prolonged to the greater part of the designated time period if either or both of the parties involved have domicile overseas. And/or if there any defects in formalities, etc. a further extension will be necessary.

#### 6.2.6 Objections to *Hantei* results

No protests against *Hantei* results may be lodged by any party. (According to judicial precedent)

### 6.3 Opinion Statement System and Request for opinion System<sup>48</sup>

In the case that the interpretation of the law and/or standard of implementation on the part of the Patent Office is the point at issue in a suit against the trial decision of a trial for invalidation, etc. (including a trial for invalidation of extended registration, a trial for cancellation by reason of non-use, a trial for cancellation by reason of unauthorized use; the same applies hereinafter), and if the IP High Court (Tokyo High Court) passes judgment to revoke the trial decision on grounds different from the interpretation of law and/or standard of implementation on the part of the Patent Office, the judgment is only binding on the relevant case. However, considering that the Patent Office is called for to apply interpretation of the law and standard of implementation impartially to any case in light of administrative fairness and integrity, it is essential for the Patent Office to discuss whether or not the Patent Office itself needs to change its interpretation of the law and/or standard of implementation in application to other cases as well.

In such a case, it is desirable that not only inter-party discussion among private circles but also the opinion of the Patent Office as the competent authority is presented as the basis for the Court to make a determination in a suit against the trial decision.

The Law revised in 2003 provides for a system under which the Court may request the Patent Office for an opinion and a system under which the Patent Office presents an opinion before the

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<sup>48</sup> See: Part of 58-14 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 58-14 of “審判便覧”, <http://www.jpo.go.jp/shiryou/index.htm>

Court with the permission of the Court at the request of the Patent Office in a suit against the trial decision of a trial for invalidation, etc. (Patent Law, Section 180-2). In respect of the purpose of the revision, the Patent Office is called for to deal with the aforementioned situation properly by making the most of these systems. To this end, the systems are to be implemented as follows:

It should be noted that the revised Law applies to trials for invalidation, etc. demanded before the effective date and suits against trial decision pending before the Court as of the effective date.

### **6.3.1 Implementation of the opinion statement system**

A qualifying case where the Patent Office may request the Court for permission to state an opinion is typically categorized as a case where the propriety of interpretation of the law and/or standard of implementation on the part of the Patent Office is the point at issue. It is not certain whether our interpretation of the law and/or standard of implementation is the point at issue in a suit against a trial decision until we obtain the Complaint, etc. and examine the party's case and arguments, but it would be inefficient to obtain and examine the Complaint, etc. for all cases in which suits against trial decisions are filed.

For the purpose of efficient implementation, cases deemed likely to require the Patent Office to state opinions are marked as "candidate cases" at the time of the trial decision, and concerning candidate cases on the list, whenever necessary, we obtain the Complaint, etc. and discuss whether we need to state an opinion before the Court.

### **6.3.2 Implementation of the request for an opinion system**

As it is the Court that requests the opinion, the practical business for the system is in the hands of the Court. Considering the purpose of introduction of the system, the Court may request an opinion in the following cases:

A. When interpretation of the law and/or standard of implementation on the part of the Patent Office is the point at issue in a suit

B. When the Patent Office's explanation is necessary with regard to a trial decision, etc.

Concerning the contents of a written trial decision and background circumstances not directly mentioned in written trial decision, as it is likely that the party fails to explain the written trial decision properly, the Court may employ the request for an opinion system if it is deemed in the interest of the proceedings to hear the Patent Office's explanation.

In addition, ex-officio examination of evidence can be employed in a suit against a trial decision. Given differences in common knowledge and obviousness of a fact between the Court and the Patent Office, explanation may be requested if the Court determines it appropriate to let the Patent Office fill the gap, if any. (July 2005)

## 6.4 Retrial System<sup>49</sup>

### 6.4.1 Outline of Retrial

A retrial system is a method to file an urgent objection seeking cancellation of a trial decision which has become irrevocable by a party involved, such as where a serious defect exists in the trial proceedings or an unusual defect in reference materials that constitutes the basis of the judgment has been overlooked. Upon conclusion of a decision it is natural that the resolution by the decision will be respected for the sake of legal stability; however, if no exception is allowed notwithstanding a serious mistake or effect, it will contradict the proper requirement of a trial. So, a retrial can be demanded for the same examination level of 「 the previous 」 trial.

### 6.4.2 Demand for a Retrial

(1) Parties involved in a decision shall be able to demand for a retrial of the decision which has become irrevocable (the Patent Law, Section 171(1); the Utility Model Law, Section 42(1); the Design Law, Section 53(1). The Code of Civil Procedure, Section 338 (1), 338 (2) and Section 339 shall apply mutatis mutandis with respect to the demand for retrial (the Patent Law, Section 171(2); the Utility Model Law, Section 42(2); the Design Law, Section 53(2))

(Note)

*The Code of Civil Procedure, Section 420*

**Section 420.** *A final judgment that has become irrevocable may be attached by action for retrial, unless the cause therefore was asserted by recourse by the party or was not asserted although it was known to exist:*

- 1. If the Court adjudicating was not constituted by law prescribed;*
- 2. If a Judge, precluded by law from participating in the decision, participating therein;*
- 3. If there was a defect in the powers of the legal representative or process-attorney or the authority of the attorney necessary for doing acts of procedure;*
- 4. If a judge who participating in the decision was guilty of an offence relating to his official duties in connection with the particular case;*
- 5. If the party was led to make a confession or prevented from producing a means of attack or defense calculated to affect the decision, by a criminally punishable act of another person;*

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<sup>49</sup> See: Part of 70-00 of Manual of Appeal and Trial Proceedings in JPO (Japanese version), that is, 70-00 of “審判便覧”, <http://www.jpo.go.jp/shiryu/index.htm>



6. *If a document or any other object used as evidence for judgment was forged or fraudulently altered;*

7. *If the judgment was on the false testimony of witness, an expert witness or an interpreter or a sworn party or legal representative;*

8. *If a civil or criminal judgment or any other decision or administrative disposition on which the judgment was based has been altered by subsequent decision or administrative disposition;*

9. *If decision was omitted respecting a material factor calculated to affect the judgment;*

10. *If the judgment attacked conflicts with an irrevocable judgment previously pronounced.*

*In the case of Nos. 4 to 7 of the foregoing paragraph, an action for retrial may be instituted only when a judgment of conviction or decision imposing a non-penal fine has become irrevocable in regard to the punishable actor or an irrevocable judgment of conviction or decision imposing a non-penal fine cannot be obtained for a cause other than defective evidence.*

*The Code of Civil Procedure, Section 339*

**Section 339.** *If any of the causes specified in the foregoing section exists in regard to a decision on which the judgment is based that cause may be made the ground for retrial against the judgment even though independent means of attacking such decision are provided.*

(2) If a demandant for a trial and a defendant causes a trial decision for the purpose of injuring the right or interest of a third party, such third party shall be able to demand for a retrial against the trial decision which was become irrevocable (the Patent Law, Section 172 (1); the Utility Model Law, Section 43(1); the Design Law, Section 54(1)). The retrial must be appealed jointly by the appellant and defendant (the Patent Law, Section 172(2); the Utility Model Law, Section 43(2); the Design Law, Section 54(2) ).

#### **6.4.3 Time Limit for Demand for a Retrial**

(1) A retrial must be demanded for within 30 days from the date on which the demandant became aware of the reasons for the retrial after the trial became irrevocable (the Patent Law, Section 173 (1); the Utility Model Law, Section 45; the Design Law, Section 58(1)).

(2) Where, due to reason outside his/her control, a person is unable to demand for a retrial within the time limit prescribed, he or she may make a demand within 14 days from the date when the reasons ceased to be applicable but not later than 6 months following the expiration of said time limit (the Patent Law, Section 173 (2); the Utility Model Law, Section 45(1); the Design Law, Section 58(1)).

(3) Where a retrial is demanded for by the reason that the demandant was represented in accordance with the legal provision applicable, the retrial must be appealed for within 30 days from the date on which the demandant or his legal representative became aware of that the trial

decision has been rendered due to the service of copy thereof (the Patent Law, Section 173 (3); the Utility Model Law, Section 45(1); the Design Law, Section 58(1)).

(4) A retrial may not be demanded after 3 years passed from the date the trial decision become irrevocable. However, in the event the reason for retrial arises after conclusion of decision, retrial can be demanded for within 3 years for the date such reason arises (the Patent Law, Section 173 (4) and (5) ; the Utility Model Law, Section 45(1); the Design Law, Section 58(1)) .

(5) Items (1) & (4) above shall not apply to a period for demand for a retrial made on the grounds that the trial decision conflicts with an irrevocable decision previously rendered (the Patent Law, Section 173 (6); the Utility Model Law, Section 45(1); the Design Law, Section 58(1)).

#### **6.4.4 Application mutatis mutandis of provision on trial**

(1) Provisions of a trial shall apply mutatis mutandis to a retrial proceedings (the Patent Law, Section 174; the Utility Model Law, Section 45; the Design Law, Section 57, 58 ) .

(2) Provisions of the Code of Civil Procedure, Section 348(1) shall apply mutatis mutandis to a retrial (the Patent Law, Section 174 (5); the Utility Model Law, Section 45(1); the Design Law, Section 58(1)).

(Note)

*The Code of Civil Procedure, Section 348*

*1. Oral proceedings and decisions in the suit may be allowed only within the scope of objection.*

5. Restriction on effect of patent right, etc. restored by retrial

(1) Where a patent right relating to an invalidated patent or a patent right has been restored through a retrial or where the establishment of a patent right with respect to a patent application which was rejected by an appeal decision has been registered through a retrial, the effects of the patent right shall not extend to any working in good faith after the time when the trial decision become irrevocable before the demand for a retrial was registered (the Patent Law, Section 175; the Utility Model Law, Section 44; the Design Law, Section 55).

(2) Where a patent right relating to an invalidated patent has been restored through a retrial or where the establishment of a patent right with respect to a patent application which was rejected by an appeal decision has been registered through a retrial, those who are engaged in the business of working in good faith or those who are in the preparation of such business, prior to the registration of the demand for a retrial upon said irrevocable decision, they shall have a non-exclusive license, with respect to the patent right, etc. (the Patent Law, Section 176; the Utility Model Law, Section 45; the Design Law, Section 56).

#### **6.5 Information Providing System**

### **6.5.1 Pre-grant Information Providing System<sup>50</sup>**

With the adoption of the application disclosure system in 1970, in order to improve the accuracy and promptness of the examination, the information providing system have been regulated in the Regulation under the Patent Law.

Everyone can provide the information. In addition, the provider's filling in of the name etc. in the column can be omitted.

### **6.5.2 Post-grant Information Providing System<sup>51</sup>**

A system allowing a third party to provide extensive information concerning the patentability of an invention, etc. has long been stipulated in the Regulations under the Patent Law (Regulations, Section 13-2), which, however, used to be limited to the pre-grant provision of information.

However, regardless of whether pre-grant or post-grant, the situation in which a patent is (has been) granted to any unpatentable invention is far from what it should be. In this respect, it is significant to allow information to be provided even after a patent is granted, so that more effective means are made available to collect information concerning the validity of a right.

Under the revision of the Law in 2003, the system of opposition to the granting of a patent was abolished and integrated into the system of trial for invalidation of a patent. As a consequence, the revision is effective in the respect that means are available to correct the situation in which a patent has been granted to an unpatentable invention.

In consequence of the revision to the Patent Law, etc. in 2003, a post-grant information providing system was set out in the Regulations under the Patent Law (Regulations, Section 13-3).

The specific advantages of the post-grant information providing system are as follows:

(1) The patentee may study provided information beforehand in making use of a patent and at the same time rectify deficiencies in the patent through a trial for correction, if necessary, so that unnecessary disputes can be proactively avoided.

(2) A person demanding trial for invalidation may refer to information provided up to that time, so that better-prepared grounds for invalidation/evidence can be produced in a way supplementary to the function of reviewing the granting of a patent.

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<sup>50</sup> See: Part of 10-02 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 10-02 of “審判便覧”, <http://www.jpo.go.jp/shiryou/index.htm>

<sup>51</sup> See: Part of 10-04 of Manual of Appeal and Trial Proceedings in JPO (Japanese vision), that is, 10-04 of “審判便覧”, <http://www.jpo.go.jp/shiryou/index.htm>

(3) When a trial for invalidation or for correction is demanded, the appeal examiner has discretion over the ex-officio proceedings, and if the appeal examiner deems it appropriate, the information provided may be subject to ex-officio proceedings, so that a more prompt and precise appeal examination can be expected.

(4) If a trial for correction is demanded in parallel with an infringement suit, the infringing suspect (usually, the defendant in a suit) may produce before the appeal examiners the same evidence used in the argument over the abuse of rights under the relevant system, so that even a trial examination in a trial for correction as a type of appeal in which no defendant exists, can conduct a prompt and precise examination of the requirements for correction such as the requirement for independent patentability and so on.

## **Chapter 7 Brief Introduction of IP Judicial System of Japan<sup>52</sup>**

### **7.1 Judicial System in Japan**

Judicial proceedings in Japan can be broadly classified into civil procedures, criminal procedures and domestic proceedings. Civil procedures deal with disputes related to rights between private individuals. Procedures of administrative cases are intended to examine objections to administrative measures taken by an administrative office, and strictly speaking, they are different from civil procedures. They were examined at administrative courts that were founded aside from general courts in former times. However, under the current Constitution, procedures of administrative cases are dealt with as a kind of civil procedure. Domestic proceedings include procedures to conduct conciliation, appeals and trials, etc., in respect of domestic matters, for example divorce, partition of the estate, etc. Conciliation, and appeals and trials are conducted under an independent procedure instead of civil procedures.

Criminal procedures and civil procedures are conducted at district courts, and domestic proceedings are conducted at family courts.

When a party concerned has an objection to a judgment made by a district court or family court, he/she can appeal the objection to a high court, and when he/she has an objection to a judgment made by the high court, he/she can appeal to the Supreme Court. There is a system in which a trial may be conducted at a summary court concerning an action for a small amount of damages or a criminal case in respect of a relatively light penalty.

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<sup>52</sup> See: the lecture named "IPR Lawsuits in Japan" by Mr. Yuji Koga, Judge, Intellectual Property High Court, JPO/IPR Training Course for Lawyers (FY 2006)

For special cases, exceptionally, the first instance may sometimes start at a high court. One of these cases is a suit for demanding cancellation of an appeal/trial decision made by the Japan Patent Office, in other words, a suit against appeal/trial decision, which is mentioned below.

## **7.2 Courts in Japan**

There is one district court in each prefecture. However, the exception to this general rule has been applied only to Hokkaido, and there are four district courts. There are eight high courts in Japan. They are the Sapporo High Court, which has jurisdiction over the Hokkaido Region, the Sendai High Court, which has jurisdiction over the Tohoku Region, the IP High Court (Tokyo High Court), which has jurisdiction over the Kanto Region, the Nagoya High Court, which has jurisdiction over the Tokai Region, the Osaka High Court, which has jurisdiction over the Kansai Region, the Hiroshima High Court, which has jurisdiction over the Chugoku Region, the Takamatsu High Court, which has jurisdiction over the Shikoku Region, and the Fukuoka High Court, which has jurisdiction over the Kyushu Region. There is one Supreme Court in Japan, which is located in Tokyo and has jurisdiction over the whole country.

## **7.3 Procedures concerning Industrial Property Rights**

Suits concerning industrial property rights are conducted under civil procedures. Suits concerning industrial property rights are broadly divided into suits against infringement and suits against appeal/trial decisions. Suits against infringement are those to demand injunction and compensation for damage against infringement of industrial property rights, while suits against appeal/trial decisions are those to demand cancellation of appeal/trial decisions made by the administrative organization, the Japan Patent Office.

Suits against infringement are examined as general civil cases. Any district court in Japan can examine suits against infringement, if it has jurisdiction. However, taking into consideration that the Tokyo District Court and the Osaka District Court have expert departments specializing in intellectual property rights, the former is recognized to have jurisdiction over suits concerning patent rights, utility model rights, etc., in eastern Japan, and the Osaka District Court has jurisdiction in western Japan, respectively.

Suits against appeal/trial decisions are examined as administrative cases in civil procedures. Since the defendant is an administrative organization, which is the Japan Patent Office, and objections to appeal/trial decisions which are administrative measures taken by the Japan Patent Office are examined in suits against appeal/trial decisions, the procedures are a little different

from general civil procedures. The first trial for these suits is conducted at a high court, and also, the IP High Court (Tokyo High Court) exclusively has jurisdiction over them.

## **7.4 Composition of Expert Departments Specializing in Intellectual Property Rights**

Three (3) of twenty-two (22) departments dealing with civil cases at the IP High Court (Tokyo High Court) specialize in taking charge of intellectual property right cases including industrial property rights. There are three or four judges in each of these three departments. At the High Court, three judges examine and administer justice together concerning all cases.

Three (3) of fifty (50) departments dealing with civil cases at the Tokyo District Court specialize in taking charge of intellectual property right cases. In these departments, three judges examine and administer justice together concerning all cases, in principle. However, one (1) judge may administer justice. There used to be only one expert department at the Tokyo District Court before, however, since the number of intellectual property right cases has been increasing, expert departments have been increased to three (3) in and after 1998, so as to try to upgrade appeal/trial examinations on intellectual property right related suits.

At the Osaka High Court, one (1) of the departments dealing with civil cases specializes in taking charge of intellectual property right cases. The expert department at the Osaka High Court differs from the departments at the IP High Court (Tokyo High Court) in the rule that the former does not deal with suits against appeal/trial decisions.

At the Osaka District Court, one of the departments dealing with civil cases specialize in taking charge of intellectual property right cases.

## **7.5 Judges at the Expert Department**

Suits concerning industrial property rights, genetic engineering, electronic communication technology, computer technology, etc. often become the subjects of appeal/trial examinations. In cases of disputes relating to patent rights for such state-of-the-art matters, judges are not required to understand all of the technologies, but to understand at least specifications which describe contents of patent rights for the state-of-the-art matters, which are the subjects of the disputes.

It is difficult work for judges to understand specifications in which state-of-the-art matters are described. Regardless of whether or not judges have acquired scientific technologies at universities, etc., they have serious difficulty in understanding specifications at a time when scientific technologies are developing remarkably like today.

Some countries make particular judges specialize in taking charge of suits concerning industrial property rights for a long time. However, in Japan, it has not adopted a system in which it makes particular judges take special charge of only suits concerning industrial property rights for a long time. In Japan, even though suits concerning industrial property rights include technological difficulties, they are considered to be nothing more than one of the disputes on rights between private individuals or one of the civil cases in which appeal/trial examinations aim at objections to administrative measures. Therefore, they are not treated specially. Judges shall not settle technological problems but shall settle the legal disputes behind them.

Judges, in charge of suits concerning industrial property rights, are not believed to be able to acquire the wide view of things necessary for settling such legal disputes, if they specialize only in dealing with suits concerning industrial property rights for a long time. Therefore, all judges who are now in charge of suits concerning industrial property rights at the expert departments of high courts and district courts in Tokyo and Osaka have previously experienced general civil suits, criminal procedures or domestic proceedings. And after working for expert departments for three to five years, they move to other courts, and shall take charge of general civil suits, criminal procedures or domestic suits there.

It is difficult to reconcile the general rule under which it do not make judges take charge specializing in suits concerning industrial property rights for a long time with the necessity for judges to understand contents of patent rights for state-of-the-art matters as well as understand specific laws such as the Patent Law, etc.

How to harmonize such requirements that are difficult to reconcile will be an important challenge in industrial property right lawsuits in Japan.

## **7.6 Inquisitor**

Expert members are stationed at the IP High Court (Tokyo High Court), the Tokyo District Court, and the Osaka District Court, which have expert departments, to support judges in the technological fields. As for other courts, inquisitors are dispatched upon their requests. Current inquisitors are veteran appeal examiners or examiners of ex-staff of the Japan Patent Office, who retired from it at one time to become staff members of courts. Nine (11) inquisitors work for the IP High Court (Tokyo High Court), seven (7) for the Tokyo District Court, and three (3) for the Osaka District Court. Inquisitors, whose fields of expertise are classified into mechanical arts, electrical arts and chemicals, take charge of cases fitting each field of expertise.

## **7.7 Procedural Representative**

Concerning a civil suit in Japan, a person in suit can prosecute by him/herself, as well as can entrust a procedural representative for prosecution. When the person in suit entrusts a procedural representative for prosecution, he/she shall designate a lawyer as the procedural representative. Therefore, since in case of a suit against infringement, it does not differ from a general civil suit, only a lawyer can act as a representative for the suit. A patent attorney can act as an assistant to help the representative. In case of a suit against an appeal/trial decision, a patent attorney can also act as a representative for the suit.

## **7.8 Suits against Appeal/Trial Decisions (Suits for Objection to Appeal/Trial Decisions)**

Suits against appeal/trial decisions can be broadly classified into appeals and trials for objections to decision of refusal, in other words, suits for demanding cancellation of appeals and trials concluding that patents shall not be granted, and trials for invalidation, in other words, suits for demanding cancellation of appeals and trials concerning whether or not patents are invalid. The latter can be further classified into suits for demanding cancellation of appeal/trial decisions that invalidate patents, and suits for demanding cancellation of appeal/trial decisions that conclude patents are not invalid.

Under the Japanese Patent Law, a court itself can neither grant a patent nor declare invalidation of a patent, even if it considers that an appeal/trial decision is false, and a patent right shall be granted or that a patent shall possibly become invalid. A court can only order the Japan Patent Office to re-act appeal/trial procedures, by pointing out that there are false reasons in judgments of appeal/trial decisions made by the Japan Patent Office. However, appeal/trial procedures after that shall be placed within certain scope under the judgment of the court to a certain extent.

A suit against an appeal/trial decision is carried out under procedures for an administrative case. In case of a suit for demanding cancellation of an appeal/trial concluding that a patent shall not be granted, the Commissioner of the Japan Patent Office shall act as a defendant. In case of a suit for demanding cancellation of an appeal/trial concerning whether or not a patent is invalid, a loser of the appeal/trial shall act as a plaintiff, and the winner shall act a defendant.

## **7.9 Patent Right Suits against Infringement**

A patent right is the right which a patentee can exclusively and monopolistically work the patented invention. A patentee can demand injunction of infringement act and compensation for



damages by filing a suit, when his/her own right is infringed. This is a patent right suit against infringement and an appeal/trial examination shall be conducted under the Code of Civil Procedure. The plaintiff shall claim the fact that the defendant has been infringing his/her patent right and prove the fact of infringement. The defendant shall claim the fact that infringement against a patent right shall be denied, and shall prove the fact.

An important issue in a patent right suit against infringement is to determine how far the scope of a patent right can reach. A specification indicates the scope of the right of a patent right and contents thereof. On this specification, the scope of the claim(s) and the description of the invention are described. The scope of the right of a patent right shall be decided based on the description of the scope of the claim(s). The plaintiff and the defendant take all possible allegations over interpretation of the scope of the right, and a court shall finally make a judgment. In this point, it can be said that interpretation of the scope of the claim(s) is not the issue in fact but the legal issue.

A patentee demanding compensation for damages shall claim and prove the amount of damages. Since it is difficult to prove the amount of damages caused by patent right infringement in many cases, regulations have been established to facilitate proof.

In many cases, a person who is identified as a defendant in a suit of infringement of patent right, demands a trial for invalidation with the Japan Patent Office, in order to proceed with the appeal/trial examination in his/her favor. The reason is because, under the rule of authority sharing between the Japan Patent Office and the courts traditionally owned in Japan, the Japan Patent Office has been considered to take part in establishment, lapse, etc. of industrial property rights, while the courts have been considered to make judgment on whether or not infringement is constituted on the premise of the established industrial property rights, but are unable to get involved in the issue of effect on whether or not the right is invalid. Therefore, there had often been cases in which a defendant claimed a patent right in question was invalid in a suit of infringement of patent right for a long time, however, courts did not approve the claim. Instead, courts have applied all kinds of devices for an issue of interpretation of the scope of the claim(s) to make a valid settlement. There were opinions among learned men and practitioners that courts could judge invalidation of patents in suits of infringements. Where a person who has been certified as a defendant of a suit of infringement demands a trial for invalidation to invalidate the patent right which is a premise of the plaintiff's claim and receives an appeal/trial decision concluding that the patent is not invalid, he/she can further file a suit against appeal/trial decision with the IP High Court (Tokyo High Court). Then, it means that two suits, a suit of infringement of a patent right and a suit against appeal/trial decision, exist in parallel, concerning the same patent right.

In an appeal/trial and a suit against appeal/trial decision, both the Japan Patent Office and a court had no choice but to decide whether or not a patent right is valid without considering a suit of infringement. In a suit of infringement of a patent right, a court had no choice but to proceed with an appeal/trial examination on the premise that a patent right in question was valid, until the patent right became invalid in the related suit against appeal/trial decision. Where a right was dealt with as valid until it was judged to be invalid even if it was obviously invalid, that resulted in various kinds of confusions and contradictions. Therefore, all kinds of devices were applied to settle these confusions and contradictions.

The Supreme Court settled this problem in April 2000. That is to say, the Supreme Court judged that:

A court examining a suit of infringement of a patent right could judge whether or not it was clear that there were grounds for invalidation of the patent, and where it was found clear that there were grounds for invalidation of the patent as a result of the appeal/trial examination, a demand based on the patent right, in principle, should fall under an abuse of the right and should not be approved.

As a result, where it is clear that there are grounds for invalidation of a patent, a court has come to be able to draw a conclusion on the premise of the grounds.

The situation above is regulated in the Section 104-3 of the Patent Law of Japan.

## **Chapter 8 Conclusion and Recommendations**

### **8.1 Conclusion**

With the study and comparison of the patent appeal/trial system and patent appeal/trial examination proceedings between Japan and China, the conclusion is obtained as follows.

#### 1. Outline

The patent appeal/trial system of Japan includes appeal against the examiner's decision of refusal and trial for invalidation, which is also existent in China. These two kinds of cases are the most important patent appeal/trial in both two countries that constitute the foundation frame of the patent appeal/trial system. Regarding the other form of appeal/trial that is only existent in Japan, for example, such as trial for correction, retrial and Hantei system, they are also the key elements of the patent appeal/trial system. Although there is no relevant above form of appeal/trial in Chinese patent appeal/trial system, the function or purpose of those forms of appeal/trial that are not existent in China can be also obtained in Chinese patent appeal/trial system through the

relevant detailed regulation and practical examination. Anyway, the relatively perfect patent appeal/trial system of Japan is very helpful to and has the inspiration for the revision of the Patent Law of China.

## 2. Regarding the role or position of the Patent Reexamination Board of SIPO

The most important difference of patent appeal/trial system between Japan and China is the difference of the role or position between the Patent Reexamination Board of SIPO and the Appeal department of JPO, although both of which are in charge of the examination of the appeal/trial cases.

According to the Chinese law, where any party is not satisfied with the decision of the Patent Reexamination Board declaring the patent right for invention invalid or valid, it may institute legal proceedings in the court within the time limit and the Patent Reexamination Board is always the defendant even if the invalidation case relates to an infringing lawsuit. In consideration of the situation that majority of the invalidation cases in China are connected to infringement lawsuits through which defendants take as counterattack, in such circumstances, if the appeal to the court makes the Patent Reexamination Board be the defendant, it will ignore the interests of the parties, at least make the disagreement between one party and the Patent Reexamination Board more important than that of the interests of the parties. Supposing an invalidation case on which the requesting party is the defendant in an undergoing infringement lawsuit, the interested parties are the requesting party and the owner of the patent. The judgment of the court, no matter it maintains or annuls the Patent Reexamination Board's decision will directly relate to the interests of the parties, not the interests of the Patent Reexamination Board. However, Chinese Patent Law stipulates that all the lawsuits that are arisen from being not satisfied with the decision made by the Patent Reexamination Board, the defendant will always be the Patent Reexamination Board. This means that at the beginning of the lawsuit mentioned one interested party will be excluded beyond the case. Although he or it may attend the proceedings as the third party, his or its legal rights are limited. Such case in Japan is different, that is, the requesting party or the defendant in the trial shall be the defendant.

This reason of the existence of above phenomenon in China is factually that the Laws of China have not defined the role or position of the Patent Reexamination Board properly. Comparably, according the Patent Law of Japan, the Appeal Department of JPO generally acts as the “quasi-judicial” administrative role, so a trial is equivalent to the first instance in judicial three-instance System of Japan.

Chinese legislative may study the Japanese practice in this aspect.

## 3. Regarding the Hantei System

There is not the Hantei system ( System of Advisory Opinion on the Technical Scope of the Patent Invention ) for patent in China.

So called Hantei is that the Japan Patent Office, having a high degree of expertise regarding technology, design and goods, will render an official *Hantei* in a strictly neutral manner regarding whether the subject article falls under the technical scope of the patented invention in question within as soon as three months from the time of filing of the *Hantei* demand. And no protests against *Hantei* results may be lodged by any party. (According to judicial precedent)

The *Hantei* system, in which the JPO, which granted the original patent right, renders an official opinion regarding the technical scope (including matters concerning equivalents) of the patented invention, has therefore been provided.

The *Hantei* system enables prevention of unnecessary patent disputes and is especially useful for venture businesses and small and medium enterprises for whom legal expenses may be burdensome.

Moreover, the Hantei system has following advantages:

- (a) Results rendered with strict neutrality
- (b) Reasonable fee of 40,000 yen (paid to the JPO)
- (c) Speedy rendering of results (as soon as three months from filing of the demand for *Hantei* )
- (d) Easy procedures (the same as trial examination procedures)

In China, with the development of technology and economy, the quantity of the disputes regarding the intellectual property rights, such as patent right, is also increasing at the same time. So more and more persons or entities related to the IPRs in China will also encounter the following cases:

- i) A patent right holder wishing to know whether the goods of another party (object of working of invention) fall under the technical scope of the right holder's patented invention (infringement of the registered patent right),
- ii) A party other than the patent right holder wishing to know, when investing in research and development (R&D) or actually working an invention, whether the object of investment or working falls under the technical scope of another party's patented invention(The party wishes to work the invention without anxiety).

Although the Patent Reexamination Board of SIPO had ever made some opinions regarding the technical scope of the patent invention which is similar to the Hantei decision of JPO, it is difficult to obtain the effect and purpose of prevention of unnecessary patent disputes because there are no systematic regulations regarding the demand procedures, the examination proceedings, and so on.

#### 4. Regarding the Ex-Officio Principle

From the related regulation, we know that in Appeal Department of JPO, since in appeal/trial examination, the effect of decisions extend to third parties, and may have significant influence on the society, there are many provisions in relevant legislations such as the Patent Law, which do not apply mutatis mutandis provisions of the Code of Civil Proceedings based on the inter-partes principle, but instead state that the appeal/trial examiner should actively involve oneself with the case ex-officio and play a leading role in the examination, independent of the will of the parties concerned, once an appeal/trial examination is requested, unless it is withdrawn, the weight of provisions based on the ex-officio principle being much greater, although the Appeal Department of JPO acts as a “quasi-judicial” role, at least as a “quasi-lawsuit administrative” role. Nevertheless, although the legal nature of the Patent Reexamination Board of SIPO is only the administrative organization, when making examination of cases including Reexamination and Invalidation, the thinking is that provisions based on the so-called inter-partes principle outweigh provisions based on the ex-officio principle.

The Patent Reexamination Board of SIPO is the administrative organization firstly though it is has somewhat “quasi-judicial” nature. In order to deal with the patent appeal/trial cases promptly and with high efficiency, the examiners of The Patent Reexamination Board of SIPO shall be given proper power to utilize the principle of ex-officio.

#### 5. Regarding the Retrial System

A retrial system in JPO is a method to file an urgent objection seeking cancellation of a trial decision which has become irrevocable by a party involved, such as where a serious defect exists in the trial proceedings or an unusual defect in reference materials that constitutes the basis of the judgment has been overlooked. Upon conclusion of a decision it is natural that the resolution by the decision will be respected for the sake of legal stability; however, if no exception is allowed notwithstanding a serious mistake or effect, it will contradict the proper requirement of a trial. So, a retrial can be demanded for the same examination level of 「 the previous 」 trial.

From the standpoint of the appeal/trial parties concerned, the retrial system is reasonable. And if the strict conditions for starting the proceedings of retrial are regulated, the retrial also has its feasibility.

#### 6. Regarding the trial for correction

In Japan, in the course of the development of system of the trial for correction, the regulations regarding it have changed more than once. Pursuant to the revision of the Patent Law in accordance with Law No. 47 of 2003 (came into force on January 1, 2004), the period for demand for a trial for correction to be entered after a suit against the trial decision is filed shall be subject

to restriction under which in principle, a trial for correction may not be demanded after the institution of an action, yet a trial for correction may be demanded exceptionally for a period of 90 days after the action is instituted (to be computed from the date when the action is instituted) (Patent Law, Section 126 (2)). At the same time, the revised Law laid down the provision that in the case that a trial for correction is demanded after the institution of an action against a trial for invalidation demanded after the said Law came into force, if the Court holds it appropriate for the propriety of the correction and the validity of the patent for correction to be examined at a trial for invalidation, the Court may decide to revoke the trial decision by decision and remand the invalidation trial case to the Patent Office (Patent Law, Section 181(2)(3)), and the provision that if remanded, the demand for a trial for correction shall be absorbed into the procedures of a trial for invalidation as a demand for correction (Patent Law, Section 134-3).

Although the relevant regulation regarding the trial for correction of the Patent Law of Japan has been revised in order to prevent the patentee from prolonging the proceedings during the course of invalidation and suit against the invalidation decision, in fact, it can not avoid the phenomenon of delay of proceeding at all because the patentee can continually demand the trial for correction with the changed grounds and facts. And it is thought that giving the too much chance to the patentee for correction means unfair to the other parties, for example, demandant of the trial for invalidation.

Nowadays, in China, the amendment of claim only can be made in the proceedings of trial for invalidation. This can avoid the phenomenon of delay of proceeding effectively. But it is a problem that in practical examination, more and more patentees or the patent representatives of theirs think the PRB of SIPO should give them more opportunity for correction which is difficult to solve up to now.

#### 7. Regarding the Interview

“Interview” refers to face-to-face talks between a collegial body and appellant’s party (appellant, representative, etc.) or an appellee’s party (appellee, representative, etc.), in an attempt to enhance mutual understanding, thereby facilitating procedures.

There is no any detailed regulation regarding interview by collegial body in the Reexamination/Invalidation examination procedures in SIPO. But in practical examination of appeal/trial cases, especially in the examination of reexamination cases, the interview is often utilized by the collegial panel according to the relevant regulations regarding the interview in the procedure of the substantive examination in examination department. So it is necessary to make the relative detailed regulation regarding the interview for the special use of the appeal/trial proceedings.

## 8. Regarding the Information Providing

The main reason to constitute the information providing system in Japan is that regardless of whether pre-grant or post-grant, the situation in which a patent is (has been) granted to any unpatentable invention is far from what it should be. In this respect, it is significant to allow information to be provided even after a patent is granted, so that more effective means are made available to collect information concerning the validity of a right.

It is not so necessary for China to constitute the relevant information system for post-grant in following considerations.

- a. Anyone can demand the request of the trial for invalidation in the any time after the application is granted for a patent.
- b. How to use such information provided post-grant, especially already being several demands for the trial for invalidation, wholly depends on the determination of the collegial panel or the appeal examiners. The color of ex-officio is so intense to determine the utilization of such information provided post-grant that it is unfair for patentee from the standpoint of the so-called inter-partes principle.
- c. In Japan, it is free for anyone to provide the information post-grant in the appeal/trial proceedings for the purpose of a more prompt and precise appeal examination. But in fact, it may result in prolong the period of examination of invalidation case if the quantity of such information provided post-grant increases to the certain extent though quantity of such information provided post-grant is not so many now.

## 8.2 Recommendations

Based on comparison, analysis, and information given above in this research report, some recommendations will be provided below for the purpose of being useful and helpful to the revision of the Patent Law of China.

### 1. Regarding the role or position of the Patent Reexamination Board of SIPO

Through the analysis above, it should be thought that it is reasonable to change the role or position of the Patent Reexamination Board to the “quasi-judicial” administrative organization. At the same time, it should be defined that the trial for invalidation is equivalent to the first instance in the Chinese IP judicial system and is carried out by quasi-judicial proceedings.

Nevertheless, the Chinese judicial system is different from that of Japan, in which only are there two instance judicial levels. So it is necessary to constitute the Intellectual Property Appeal Court of China which will act as the second instance court or similar judicial organization with respect to the IP administrative cases, such as trial for the patent invalidation and so on.

If the Patent Reexamination board of SIPO does act as the quasi-judicial role in the Chinese IP judicial system, it is necessary to constitute the opinion statement system and request for opinion system like Japan, that is, if necessary, the Patent Reexamination board of SIPO may request the Court for permission to state an opinion or the Court may request the opinion from the Patent Reexamination board of SIPO. In the case that the interpretation of the law and/or standard of implementation on the part of the Patent Office is the point at issue in a suit against the trial decision of a trial for invalidation, and if the Court passes judgment to revoke the trial decision on grounds different from the interpretation of law and/or standard of implementation on the part of the Patent Office, the judgment is only binding on the relevant case. However, considering that the Patent Office is called for to apply interpretation of the law and standard of implementation impartially to any case in light of administrative fairness and integrity, it is essential for the Patent Office to discuss whether or not the Patent Office itself needs to change its interpretation of the law and/or standard of implementation in application to other cases as well. In such a case, it is desirable that not only inter-party discussion among private circles but also the opinion of the Patent Office as the competent authority is presented as the basis for the Court to make a determination in a suit against the trial decision.

In order for the above purpose, it may be considered to revise the Patent Law of China with relevant detailed regulation regarding the role or position of the Patent Reexamination Board of SIPO mentioned above drafted into the Law.

## 2. Regarding the Hantei System

As analyzed above, although the Patent Reexamination Board of SIPO had ever made some opinions regarding the technical scope of the patent invention which is similar to the Hantei decision of JPO, it is difficult to obtain the effect and purpose of prevention of unnecessary patent disputes because there are no systematic regulations regarding the demand procedures, the examination proceedings, and so on. And the Hantei System has many advantages such as results rendered with strict neutrality, reasonable fee, speedy rendering of results and easy procedures and so on.

So it is a good choice to constitute the Hantei system in China. It may be considered to revise the Patent Law of China with relevant detailed regulation regarding the Hantei system mentioned above drafted into the Law, or at least into the Implementing Regulations of the Patent Law of China.

## 3. Regarding the Retrial System



Based on the above analysis, from the standpoint of the appeal/trial parties concerned, the retrial system is reasonable. And if the strict conditions for starting the proceedings of retrial are regulated, the retrial also has its feasibility.

So it is also a good choice to constitute the retrial system in China. It may be considered to revise the Patent Law of China with relevant detailed regulation regarding the retrial system mentioned above drafted into the Law, or at least into the Implementing Regulations of the Patent Law of China.

#### 4. Regarding the Interview

As mentioned above, there is no any detailed regulation regarding interview by collegial body in the Reexamination/Invalidation examination procedures in SIPO. But in practical examination of appeal/trial cases, especially in the examination of reexamination cases, the interview is often utilized by the collegial panel according the relevant regulations regarding the interview in the procedure of the substantive examination in examination department. So it is necessary to make the relative detailed regulation regarding the interview for the special use of the appeal/trial proceedings.

It may be considered to revise the Guidelines of Examination of SIPO with relevant detailed regulation regarding the interview in the appeal proceedings mentioned above drafted into the Guidelines of Examination of SIPO.

#### 5. Regarding the Ex-Officio Principle

Based on above analysis, although the legal nature of the Patent Reexamination Board of SIPO is only the administrative organization now, when making examination of cases including Reexamination and Invalidation, the thinking is that provisions based on the so-called inter-partes principle outweigh provisions based on the ex-officio principle. So in order to deal with the patent appeal/trial cases promptly and with high efficiency, the examiners of The Patent Reexamination Board of SIPO shall be given proper power to utilize the principle of ex-officio.

It may be considered that in practical examinations for appeal/trial proceedings, considerations should be balanced between the provisions based on the so-called inter-partes principle and the provisions based on the ex-officio principle.

(ANNEX I)

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(ANNEX II)

## Questionnaires and Corresponding Answers

### 1. Questionnaire for interview with examiners of the Appeal Department of the JPO

1. What is constitution( organization )of the Appeal Department of JPO? ( organization and their functions )

See Attachment 1.

2. Are the examiners of the Appeal Department mainly come from the Examination Department of JPO?

All of the appeal examiners come from the Examination Department of the JPO.

3. Being a qualified ( competent ) examiner of the Appeal Department, what training should he/she go through?

A person who received the training courses provided by law, consisting of lectures and practical business training on the Code of Civil Procedure and appeal examiner's practice, and met the completion standard can qualify as an appeal examiner. Also, it is normally required to have more than 5 years of experience as an examiner of the JPO, before a person becomes qualified as an appeal examiner.

4. When and how to revise the < Manual of Appeal and Trial Proceedings >?

There are examination standards in which the basic ways of thinking concerning application of the related laws such as the Patent Law or the like are consolidated. The examination standards are reviewed in response to systemic revisions, new court decisions, development of new technology and changes in the international situation. Also, there is the Appeal or Trial Examination Manual that provides policies for appeals and trials, related laws and regulations, and agreements within the Appeals Department, etc. for conducting appeal/trial examination procedures. The Appeal or Trial Examination Manual is reviewed regularly, and for example, is revised in response to systemic revisions. When revising the examination standards and the Appeal or Trial Examination Manual, the Patent Office consults extensively with the public by inviting opinions, after creating a draft within the Office.

5. How to understand procedure for extended registration invalidation trial? For example, what is the disposition as provided for in Cabinet Order in Section 67 ( 2 ) according the Section 125<sup>bis</sup> ( 125-2 ) of patent law? In the procedure for extended registration invalidation trial, only examine the form problem? Is it not necessary to examine the substantive problem of patent ( for example, Patentability ) ?

Disposition as provided for in Cabinet Order indicates registration of agricultural chemicals, approval of drugs and such. In demand for trial for invalidation of registration of extension of term, it is absolutely the main purpose of the demand to conflict concerning the invalidation of registration of extension of term. Therefore, other points, for example, the validity or invalidation of the patent per se, cannot be examined in the demand (See Section 153 (3)).

6. Because correction( amendment for claims, descriptions and drawings )is also can be done in the procedure of invalidation trial, why should setting up an independent Correction Trial? It maybe delays the time limit of invalidation trial, so the correction trial maybe damages the interest of demandant. How to understand the correction trial? ( maybe cause the unreasonable delay in the trial )

What are differences of amendments between the correction trial and the invalidation trial?

7. According to Section 126 ( 5 ) , it is regulated that an invention defined by the features stated in the patent claims corrected must be one which could have been patented independently at the time of filling of the patent application. How to understand this sentence?

8. Would you mind if you can introduce the correction trial in detail to me?

First, a correction trial will be explained. A correction trial is a trial in order for a right holder to correct his/her patented invention voluntarily after registration of the right.

Since some partial defects in the contents of rights may possibly cause a demand for trial for invalidation of the patent, a correction trial is provided for a right holder who wants to voluntarily remove defective portions in advance, in order to protect the whole patent right against such an attack . In other cases, since in case that there is an ambiguous description, the scope of right becomes ambiguous and an infringement case may often be caused, a correction trial is also used for clarifying the description and preventing disputes, in advance.

The outline of a correction trial will be shown in Attachment 2. Requirements for the correction to be approved are provided as shown in Attachment 2, so as not to cause unexpected damage to a third party by the shift in the right. Among these, the requirement provided in Section 126 (5) will

be explained here. It is a provision to the effect that since, as long as the scope of claim of an invention to which a patent right has once been granted is corrected, the invention to be specified by the matters described in the scope of claim after correction is free from any defect as a right, the invention should be the one which could have been patented per se in the light of the provisions provided in Section 29, Section 29<sup>bis</sup>, Section 32, Section 36 (4) (i) or (6) and Section 39 (1) to (4).

Before revision of the law of 1993, a correction trial had been used, when a right holder received a demand for trial for invalidation, as a means for avoiding any attack by consolidating the specification or the like. But as is pointed out in Question 6, there was a problem that a period of an appeal/trial examination was prolonged. Therefore, at present, the correction trial cannot be demanded during a procedure of a trial for invalidation, and a procedure to be called a demand for correction within the trial for invalidation is adopted, instead, enabling to perform a trial for invalidation in conjunction with a demand for correction (Section 134 (2)). The correction trial enables a right holder to make voluntary corrections, and from institution of a trial for invalidation to appeal/trial decision, a demand for correction will ensure an expeditious appeal/trial examination.

9. In Section 131(1)(ii), what is the identification of the trial case? In Section 131(1)(iii), what is the relief sought in the demand and grounds therefore?

Indication of an appeal/trial case is for indicating what an appeal/trial case is like, for example, as "Patent No. XXX, invalidation trial case." The relief sought in the demand is a brief description of what an appeal/trial decision is sought against any type of demand. For example, it is described as "Demand for an appeal/trial decision determining "Patent No. XXX is declared invalid. Costs for trials should be borne by a demandee." Also, the grounds for the demand are a concrete description of which ground for invalidation the reason for the demand falls under.

10. In appeal and trial proceedings, what are differences between decision and ruling in effects and functions?

The difference between a decision and a ruling is that an appeal/trial decision is disposition indicating determination on whether a demand is right or wrong concerning an appeal/trial case,

while a ruling is disposition indicating determination on whether a procedure of an appeal/trial case is right or wrong. There are no differences in their effects and functions.

11. How to understand the demand for correction in case where annulling court decision ( regarding Section 134-3 of patent law ) ?

The purpose of the corresponding Section will be explained (take note that this is not a case that a judgment was annulled, but a case that a judgment to annul the appeal/trial decision was made.):

Where a judgment annulling an appeal/trial decision of the validity of a patent has become final and conclusive, the case will be sent back from the court and be reexamined at the JPO, however, in this case, since appeal examiners are bound by the final and conclusive judgment, they are inclined to make an appeal/trial decision of a patent invalidation. However, in spite of the above, since it is too heavy on a right holder not to give any chance to resolve the grounds for invalidation by correction, the relevant provision has been provided.

12. Regarding constitution( organization )of collegial system in trial, how to set up the collegial body? What is division of responsibility of collegial body members?

The Commissioner of the JPO should designate the appeal examiners constituting a collegial body (Section 137). In actual practice, the Directors of the Appeals Division designate the members under the order of the Commissioner of the JPO, based on the selection made by the Directors of the Boards of Appeal. The Directors of the Boards of Appeal make assessments on the technological content of each case and the progress of appeal/trial examination for each appeal examiner, to select the appropriate members constituting a collegial body.

The Chief Appeal Examiner included in the collegial body manages the office duties such as extension of term, interruption of a procedure, transmittal of the duplicate of the written demand and notice of appeal/trial examination ex officio. Also, one of the members of the collegial body shall be assigned as an appeal examiner in charge. The role of the appeal examiner in charge is to prepare so that the other appeal examiners of the collegial body can exactly and easily understand the contents of the case, and to give a quick, accurate and to the point explanation about the contents of the case in the collegial examination, in order to promptly preparing a draft of the appeal/trial decision, in accordance with the result of the collegial examination.

13. How to understand the Section 139 ( iii ) , ( iv ) and ( vi ) ? Can trial examiner become a witness or an expert witness or a representative of a party?

An appeal examiner himself/herself can also become any person stipulated in each paragraph. However, there has been no actual precedent. A strict stipulation for exclusion of an appeal examiner is provided from a standpoint of maintaining fairness of appeals and trials.

14. When the party demands oral trial examination, does it have to be conducted?

The chief appeal examiner may decide whether or not to conduct the trials by oral examination, considering the contents of the case (Section 145 (1)). Therefore, an oral trial examination does not necessarily have to be conducted, although a demand from a party concerned may become one of the requirements for conducting an oral trial examination.

15. How to determine whether using oral trial examination or documentary examination?

It is selected according to the degrees of effectiveness by an oral trial examination and the necessity thereof. For example, in case that grounds for invalidation and evidence, etc. are not complicated and the point of dispute is clear, or in case that multiple demands for trial for invalidation have been filed, and the technological standard and the point of dispute have been well understood, the effect of an oral trial examination is small, and therefore, there is high possibility for selecting a trial examination by a documentary proceeding.

16. How do the trial examiner and the clerk preserve the evidence according the Section 150( 4 ) of patent law?

Preservation of evidence means a procedure for conducting an investigation in advance and preserving its result concerning particular evidence, of which investigation may become impossible or difficult if waiting until the usual examination of evidence at the appeals and trials. After the decision of preserving the evidence has been made, examination of the evidence is promptly performed and the record of investigation is created for preservation.

17. Regarding trial examination ex officio, Section 153( 2 ) of patent law regulate that where in the trial examination grounds that have not been pleaded by a party or an intervener are being examined in accordance with the proceeding subsection, the trial examiner-in-chief shall notify the parties and the interveners of the result of the trial examination and give them an opportunity to state their opinion thereon, designating an adequate time limit. In this situation, the trial examiner substitute ( replace ) the demandant, is it fair to defendant?

If only grounds pleaded in an appeal/trial examination are examined, patents including grounds for invalidation may still be decided as valid. Since this causes unfair damage to the public interest, it is provided to conduct an appeal/trial examination by ex officio in appeals and trials, (Section 153).

Although a proceedings by ex officio may be against the demandee's interest, the provision has been provided as above, in consideration of a balance between the interest of the right holder and the public interest. However, when a trial examination by ex officio was conducted, if the result is not notified to a demandee, matters disadvantageous to the demandee are collected with an appeal examiner and the demandee would not be given any opportunity for explanation, . Therefore, the provision is provided in Section 153 (2) to notify the demandee of the result of a trial examination.

18. Regarding the notification of conclusion of trial examination, when a case is ready for the rendering of a trial decision, the trial examiner-in-chief shall notify the parties and the interveners of the conclusion of the trial examination. Why is it regulated like this? Is it necessary? What purpose or significance does this regulation have?

There is a case that a party concerned is not conscious of the proceeding of the appeals and trials. Since it would be too harsh to the party concerned to make an appeal/trial decision without any notification, the relevant provision has been provided.



19. Regarding special provisions for appeal trials against examiner's refusal, according Section 164 of patent law, Section 164 ( 1 ) when the examiner renders a decision that a patent is to be granted in the examination , he shall cancel his decision of refusal concerned in the demand for the trial; Section 164 ( 3 ) except in the case provided for in subsection ( 1 ) , examiner shall make a report to the commissioner of the Patent Office on the result of the examination without rendering a decision with respect to the demand for a trial. How to understand of above-mentioned two sentences? There are two choice, how to deal with such problem? Sometimes trial examiners may not make a decision regarding the appeal trial against examiner's refusal?

There is a case in which a settlement is reached without any trial decision of an appeal examiner.

When an examiner renders a decision that a patent is to be granted in a reconsideration by examiner before appeal stipulated in Section 162, in which the examiner reexamines the case having been rendered a demand for trial, the examiner cancels his/her decision of rejection concerned, and makes a decision to grant a patent (Section 164 (1)). In this case, there would be no trial examination done by an appeal examiner. Also, in case other than the case stipulated in Section 164 (1), that is to say, in case that an examiner determines not to be able to make a decision to grant a patent, the results of the examination should be reported to the Commissioner of the JPO without making a decision of rejection (Section 164 (3)). In this case, a trial examination and a trial decision are made by an appeal examiner.

20. How to understand Section 168 ( 5 ) of patent law? What meaning is attack or defense?

After the Kilby Judgment (April 11, 1999), the validity or invalidation of a patent in an infringement lawsuit has come to be decided by a court. Information exchange between the JPO and the court is necessary in order to prevent a variance between the judgments declaring invalidation of patent in an infringement lawsuit and judgments made in the trial for invalidation. This provision has been made for this purpose. That is to say, the provision stipulates that when an argument for invalidation of a patent as being stipulated in Section 104 (3) was made in an infringement lawsuit, the JPO should be notified of said effect in order to enable the collegial body to be able to obtain argument proof information on the grounds for invalidation in

infringement lawsuits according to need. A document in which a way of attack or defense is herewith described means a document in which an argument of invalidation of the patent right is described, or a document in which a counterargument of the patentee is described.

21. Regarding the retrial, which organization is responsible for examination of retrial cases?

The Appeals Department is responsible for that.

22. Regarding annulment of the trial decision or ruling, according to Section 181 ( 2 ) , it is regulated that when the right holder has made a demand for a correction trial or intended to do so, it may annul the trial decision by the ruling for remitting the cause to the trial examiner. How to understand this sentence?

The purpose of introducing the relevant provision will be explained: Before the revision in 2002, there was established a judicial practice to cancel the decision of the trial for invalidation firstly at the trial for invalidation if the correction trial was concluded, in case that a correction to restrict the scope of claims of the relevant patent became final and conclusive during the pendency of the suit against appeal/trial decision before the court, in response to a judgment of the supreme court that an appeal/trial examination on the corrected patent should be conducted. As a result, not only the cases in which patentees having received appeal/trial decisions of invalidation of patents demanded trials for correction increased rapidly with the aim of automatic annulment of the trial decisions, but also cases in which patentees demanded trials for correction as late as just before the completion of the suit against appeal/trial decisions increased rapidly.

When the trial decision of the trial for invalidation was automatically annulled by the conclusion of the correction trial, an appeal examiner should conduct the appeal/trial examination again, causing a phenomenon called "play a case game of catch caused by correction" between the High Court and the JPO.

This situation gave rise to the following problems:

1) a problem of trial examinations of the suits against appeal/trial decisions prior to the conclusion of the correction trial becoming totally meaningless, 2) a problem of prolongation of periods of trial examinations of trial for invalidation, 3) a problem of the inefficiency caused by "segmentalization of trial examinations" actualized as a result of conducting trial examinations of trials for correction after an action after decision, and then conducting trial examinations of trials for invalidation returned from the court, and 4) a problem of the another inefficiency to a

demandant of a trial for invalidation who could not state any opinion on the legality of the correction or the effectiveness of the corrected patent in an appeal for correction.

Consequently, in a revision of 2002, there was provided a provision to restrict the term when a correction trial can be demanded after filing of the suit against appeal/trial decision (Section 126 (2)), and also to enable the court to annul the appeal/trial decision according to a decision without going through any substantive examination, and return the case of trial for invalidation to the JPO, when a correction trial has been demanded after an action against decision .

23. Regarding relationship between administrative appeal and litigation, it has been regulated in Section 184-2. But I do not know the meaning of this sentence. Would you mind if you can give me some interpretation in detail about relationship between administrative appeal and litigation.

"An action for measures (with the exception of measures referred to in Section 195<sup>quarter</sup>) taken under this Law or an order hereunder" under this article includes dismissal of procedures, rulings and annulment of rulings.

The term "appeals" here means objections under Administrative Appeal Law and requests for examination, but not the appeal against the examiner's decision of rejection. Also, litigation means action to demand the annulment of an administrative measure (Kokoku appeal) based on the Administrative Case Litigation Law. Section 184<sup>bis</sup> is a regulation by which one must first make objections or requests for examination before appealing against dismissal of procedures and such, and no direct access to the court can be made.

The Administrative Case Litigation Law of Japan adopts the policy of free choice between a request for examination and an appeal as a basic principle, however, the above stated action for measures in Patent Law is an action including specialized expertise or being conducted on a massive scale, requiring unity in administrative action. Therefore, the provision in this article is provided, prescribing that as an exception Kokoku-appeals cannot be filed unless appeals are concluded beforehand.

24. What is the relationship between Examination and Reexamination?

Appeals and trials function as an upper instance of examination, where the collegial body of three or five members reexamines the validity of rejection by an examiner.

25. What are the main principles of Reexamination ( appeal trials against examiner's refusal ) ?

In the Appeals and Trials against a rejection done by an examiner, an appealing system is taken in which a procedure proceeds between the JPO and the applicant, and normally, an appeal examination by documentary proceeding is adopted. On the other hand, in trials for invalidation, it is provided that a demandant and a demandee are placed under an adversarial system and a trial examination is performed based on an oral proceeding.

26. How to conduct reconsideration by an examiner before appeal in Reexamination (appeal trials against examiner's refusal) ?

An applicant can make amendments of a specification or the like within thirty days from when the appeal against the examiner's decision of rejection was made. If there are no amendments, it will be transferred to each Board of Appeals within the Appeals Department, whereas in case that amendment is made, reconsideration by an examiner before appeal will be done. If the reason for rejection is removed, the examiner will annul the original decision and will make a decision to grant a patent. If the reason for rejection is not removed, the examiner will submit a report to the Commissioner. The reconsideration by the examiner before appeal will be canceled, and a trial examination will be done in the Appeals Department.

27. Are there some special regulations about AMENDMENT of patent document in Reexamination (appeal trials against examiner's refusal) ?

Concerning amendments performed at the time of demand for trial, only an amendment based on the purpose provided in Section 17<sup>bit</sup> (iv) is admitted, in order to make effective use of the results of past examinations.

That is to say, amendment intending for the followings are admitted: i) deletion of claim, ii) restriction of the scope of claims (being confined to the restriction limiting matters for specifying the invention, and also confined to the case that the field of industrial application and the problems to be solved of the invention described in the claims before and after amendment are same), iii) correction of errors in the description, and iv) clarification of an ambiguous description.

Among these purposes, a provision of Section 126 (5) explained in the answers for questions 6 to 9 is applied *mutatis mutandis* in case of the purpose ii), and the invention specified by the matter described in the scope of claims after amendment should be the one which could have been patented independently at the time of filing of the patent application.

Also, amendments must be made within the scope of descriptions in the specification or the like originally attached to the request (prohibition to add new matters).

28. What are the main principles of invalidation ( invalidation trial ) ?

See the answer for Question 25.

29. Are there some special regulations about AMENDMENT of patent document in invalidation trial?

In a trial for invalidation, a scope of claims can be corrected by a demand for correction. Since any unexpected damage should not be caused to a third party by correction, requirements for correction are stipulated as follows:

1) Correction is limited to those with the purpose of i) restriction of the scope of claims, ii) correction of errors in the description or translation, and iii) clarification of an ambiguous description.

2) Prohibition to add new matters.

3) No broadening or modification of the scope of claims can be done.

4) In case that claims which no trial for invalidation is demanded for are created with the purpose of i) or ii) of 1), the invention specified by the matter described in the scope of claims after correction should be the one which could have been patented independently at the time of filing of the patent application.

30. How to conduct the proceeding of Hantei ( advisory opinion on the technical scope of patented invention ) ? And what purpose is to set up Hantei proceeding?

Provisions for appeals and trials are applied mutatis mutandis to the procedure for a request for Hantei, in order to secure a just and prompt appeal/trial examination and judgment (Section 71 (3)).

i) One demand for Hantei should be made for each item to be compared with the rights such as the patent right, etc.

ii) When a request for Hantei is made and an opposite party exists, the duplicate of the written demand for Hantei is to be transmitted, and a chance to submit a written reply within the specified term would be given.

iii) The collegial body made of three appeal examiners examines whether the requested items fall under the scope of right such as those of the patent right, creating a written Hantei document describing the judgment of whether it falls within the scope or not, along with the reasons in details.

iv) No appeals can be made to any courts, even though the demandant disagrees with the Hantei results.

The Hantei system, in which any party can request the JPO having granted patent rights, for official opinions on the technical scope of patented inventions (including equivalent relationships), shall be used for the following purposes:

(1) When a patentee wishes to know whether or not other people's products (object of workings) fall under the technical scope of his/her own patented inventions (whether they infringe his/her patent right or not).

(2) When a non-patentee wishes to know whether or not a product for which a development investment or business is being planned or actually is in operation falls under the technical scope of patented inventions (wishes to execute the plan with ease).

This system enables to prevent useless patent disputes.

31. What is the relationship between the trials and litigation ( courts ) ?

Appeal/trial decisions are the final dispositions in the administrative stage, carried out as the exercise of public authority by the JPO. However, those who disagree with the decision can access the court and receive a legal judgment (this is called as a suit against appeal/trial decision).

Since the procedures for appeals and trials provided in the Patent Law and such (including an exclusion of appeal examiner, a refusal, an oral proceeding and an examination of evidence) are strict and just similar to those of civil actions (quasi-judicial procedures), appeals and trials are equated with the first instance of the court, and suits against appeal/trial decision are filed to the IP High Court (Tokyo High Court) directly instead of the district court. In concrete terms, suits become in pendency at the Intellectual Property High Court that is a special branch of the IP High Court (Tokyo High Court).

In suits against appeal/trial decision, it is conflicted whether or not there is a defect in the appeal/trial decision, resulting in making the appeal/trial decision illegal.

If the appeal/trial decision is illegal, the court is not permitted to make ruling pro se, since it means that the court exercises an administrative power. Therefore, the appeal/trial decision is annulled and remanded to the JPO.

The collegial body of appeal examiners should further conduct a trial examination and a trial decision according to the binding force of the annulling decision.

(Attached Document 1)

### **Organizational Diagram of the Appeals Department**

Appeals Department (Main businesses )

└○The 1<sup>st</sup> to 38<sup>th</sup> Boards of Appeal (actually examines appeal/trial cases.)

| Among those, the 1<sup>st</sup> to 32<sup>nd</sup> Boards of Appeal take charge of patents and utility models, while the 33<sup>rd</sup> and 34<sup>th</sup> Boards of Appeal, and the 35<sup>th</sup> to 38<sup>th</sup> Boards of Appeal take charge of designs, and trade marks, respectively.

└○Litigation Affairs Office

(conducts litigation procedures on litigation cases such as suits against appeal/trial decisions or the like.)

└Deputy Director-General of Appeals Department

(takes charge of businesses for enhancing appeal/trial examinations such as analyses of judgments, or the like.)

└○Appeals Division

└The 1<sup>st</sup> to 9<sup>th</sup> Groups

(Formality examination of data on appeals of patents and utility models, or the like.)

└Appeals Planning Office

(Research and planning of basic matters on appeals and trials)

└Office of Infringement and Invalidation Affairs

(Procedures for clerical works and preparation of a record on inter-parties trials.)

└

(Attached Document 2)

### **Outline of the system of correction trial**

A person who is entitled to be a demandant for trial is only a patentee. (Patent Law Section 126(1)) Any person cannot join an appeal/trial examination of others (Patent Law Section 166).

- A correction trial may be demanded even after the extinguishment of the patent right, as long as the patent has not been invalidated on a patent invalidation trial (Patent Law Section 126(6)). However, a correction trial may not be demanded during the period between the time when the patent invalidation trial has come to be pending and the time when the trial decision has become final and conclusive. (However, the correction trial may be demanded during the period of 90 days from the date when an action against the trial decision was instituted with respect to a patent invalidation trial.) (Patent Law Section 126(2))

- Where a trial decision that a patent specification, etc. are to be corrected has become final and conclusive, the patent application, the laying open of the application, the examiner's decision or the trial decision that the patent is to be granted, or the registration of establishment of the patent right shall be deemed to have been made on the basis of the corrected patent specification, etc. (Patent Law Section 128).

- Conditions for a correction to be approved

- (a) Does a correction fall, in particular, under the object of the proviso of Patent Law Section 126 (1)?

1. (i): the restriction of claim(s)
2. (ii): the correction of errors in specification or of incorrect translations
3. (iii): the clarification of an ambiguous description

- (b) Does a correction satisfy other conditions to be permitted?

1. The corrected matters shall remain within the scope of the features described in the specification. (Patent Law Section 126 (3))

2. The correction may not be such as to substantially enlarge or modify the claim(s). (Patent Law Section 126 (4))

3. In case of the restriction of claim(s) and the correction of errors in specification or of incorrect translations, an invention defined by the features described in the patent claim(s) corrected could have been patented independently at the time of filing of the patent application (a requirement for independent claim(s)).

(Patent Law Section 126 (5))

·Kind of appeal/trial decision



(a) A trial decision to dismiss a demand for trial as an irregular demand (Patent Law Section 135).

(b) A trial decision to dismiss a demand. (The main sentence is described, as "The present demand for trial does not come into effect".)

(c) A trial decision to approve a demand. (The main sentence is described, as "It is approved to correct the specification of the invention of the patent No. xxx as the corrected specification attached to a written demand for trial of the present application".)

\* A third party that disagrees with a trial decision to approve a demand for a correction trial may demand an invalidation trial on the ground for invalidation that the correction of the incorrect specification has been made (Patent Law Section 123 (1)(iv)).

## 2. 特許庁審判部審判官との面接のためのアンケート (Mr. Bai Jianfeng)

1. 審判審理マニュアルでは、第 10 章は情報提供に関するものです。情報提供には、権利付与されていない特許出願に関する手続と既に権利付与されている特許に関する手続が含まれます。

- (1) 情報提供の目的は何でしょうか。
- (2) 情報提供の申し立てに関して、審問はどのようにするのですか。
- (3) 審問の担当者は誰ですか。
- (4) 審査官の拒絶査定に対する審判審理又は無効審理において、誰かが情報提供の申し立てを申請した場合、審判官は職務上、これらの情報提供を検討しなければならないということですね。審判官は、当該情報提供を検討しなければならないのでしょうか。

(1)的確、迅速な審理のため、審判官の情報を収集する手段を充実させるため。  
権利付与前においては当然、権利付与後についても、そもそも特許を受けることができない発明に対し権利が付与されている状態を是正するために情報提供制度が設けられる。

(2)(3)(4)情報提供の申立がされた場合、とくにその内容について調査せず、自動的に電子化して審査官、審判官のもとに送っている。審査官・審判官が情報提供の内容を確認し、審判官が適切と認めた場合は職権審理の対象とすることができる。提供された情報について審判官が検討しなければならないとの規定はない。

(参考：審判便覧 10 - 02)

2. 審査官の拒絶査定に対する審判審理においては、早期審理の手続があります。

- (1) 早期審理の目的は、何でしょうか。
- (2) 早期審理は、どのようにするのですか。
- (3) 早期審理の手順をお教えいただけないでしょうか。

(1)拒絶査定不服審判においては、審理順番待ち期間が2年前後あり、通常の順番を待っていたのでは請求人にとって不利なケースとなる場合がある。申請に基づいて早期に審理を行うことで、通常審理の待ち期間では特に不利となると思われる案件について救済する。

(2)早期審理案件に選定されたものは、合議体が通常の審理に優先してすみやかに審理を行う。

(3)特定の要件を満たす案件の請求人は、事情説明書を提出することにより早期審理を申請することができる。事情説明書の提出があった場合、主任審判官が指定され、主任審判官が早期審理の対象とするか否か選定を行い、部門長・審判長が決裁する。対象としない場

合には、その理由を請求人に通知する。対象とする場合は、すみやかに審理を行う。

特定の要件については、早期審査・早期審理ガイドラインを参照。

(参考：審判便覧61 - 12)

3. 無効審理には、計画審理についての手続があります。

- (1) 計画審理の目的は、何でしょうか。
- (2) 計画審理は、どのようにするのですか。
- (3) 計画審理の手順をお教えいただけませんか。

(1) 無効審判は紛争絡みで請求される場合が多く、迅速に権利の有効・無効についての判断を示すことが、紛争の早期解決に必要である。そのため、審理のスケジュールを明確にし、そのスケジュール通りに沿って計画的に進めていく計画審理を行い、無効審判における審理の長期化を防ぐようにしたのが導入の契機である。ただし、近年は無効審判の審理について庁として目標を定め迅速に処理を進めているため、計画審理の必要性は低くなっている。

(2)(3) 審理のスケジュールを記載した「審理計画書」を作成することと、口頭審理の後に今後の審理において両当事者が行う手続とその期限や、それらのスケジュールを踏まえた審理終結予定日、審決謄本発送予定日を記載した「無効審判合意スケジュール」を作成することを骨子とする。

対象案件は、無効理由・証拠や双方当事者間の争点が複雑又は多岐にわたり、その理解や整理等に相当の時間を要することが見込まれる案件等、複雑で審理のスケジュールの見通しが立てにくい案件と合議体が判断したものである。また、審理計画書は主任審判官が作成し、審理計画書の作成時期は、原則として答弁書の副本送付の段階である。(特実意)

(参考：審判便覧51 - 12)

4. 拒絶査定不服審判および無効審判手続において、「請求主義」はありますか。いわゆる「請求主義」とは、再審査手続および無効手続が当事者の請求をもって開始されるべきことをいいます。特許再審査委員会が審決をくだす前に請求人が請求を取り下げた場合には、同委員会または請求人が開始した審査手続は終結されます。

本問でいうところの請求主義(いわゆる処分権主義、当事者主義)は、我が国の民事訴訟法の原則であり、特許法にも適用される。

無効審判においても、当然処分権主義を採るが、被請求人から答弁書の提出があった後は相手方の承諾を得なければ取り下げることができない。(特許法第155条第2項)

5. 「請求主義」が導入されている場合、「職権探知主義」と「請求主義」との関係をいか

に均衡させていますか。

審判においては、その審決の効力が広く第三者に及び、対世的な影響が大きいことから、審判の請求があった後は、取り下げがない限り、当事者の意志とはある程度無関係に、審判官が職権によって積極的に事件に介入し、かつ主導して審理を進めるべき旨を規定した条項が多く設けられており、職権主義の比重がきわめて大きい。

(参考：審判便覧36 - 01)

6. 審判部の審判官は、実際の審査に「職権探知主義」をどのように適用していますか。

査定不服審判においては、原査定の拒絶理由が不適当な場合には、査定の理由と異なる拒絶理由が職権で調査される。また、原査定の拒絶理由が不十分である場合に、原査定に例示されていない周知、慣用技術を調査したり、あるいは、争点となっている原査定の引用刊行物の頒布日を調査したりすることも職権で行われる。

無効審判においては、職権で申立てのない無効理由についても審理することができるが、無効審判が請求されていない請求項に対するの審理は、請求の趣旨の範囲から逸脱するので、行うことができない。

また、訂正請求がなされた場合、訂正要件違反については無効審判請求人が当該訂正請求について不適法である旨争っていないなくても職権で審理し、訂正要件違反を発見した場合は職権の訂正拒絶理由を通知する。

(参考：審判便覧36 - 01)

7. 拒絶査定不服審判および無効審判手続きにおいて、「審理主義」はありますか？「審理主義」とは、審決がくだされる前に、決定が不利にはたらく当事者に対し、審決に採用される理由、証拠および認定事実について検討する機会を与えなければならないこと、すなわち、審決内容が不利となる当事者に対して、通知、書面、または口頭手続きをもって、審決に採用される理由、証拠および認定事実を知らせなければならないことを意味します。

本問でいう審決に採用される理由を通知するものではないが、無効審判の審理を進める前に、権利者には無効審判請求人が申し立てた無効の理由について答弁書を提出する機会が与えられる(特許法第134条)。また、職権により申立てのない理由について審理を行った場合には、職権審理の結果を両当事者に通知して意見を申し立てる機会を与えなければならない(特許法第153条)。

査定不服審判においては、請求人の反論の機会なく審決が下されることもあるが、これ

は、査定不服審判は審査の続審であり、審査段階で反論の機会是与えられているからである。当然、職権によりあらたな理由を発見したときは、拒絶理由を請求人に通知して意見を申し立てる機会を与えなければならない（同前）。

他に、審理の終結を通知しなければならない旨の規定は設けられている（特許法第156条）が、検討の機会を与えるためのものではなく、審判手続打切の宣言であって、これ以降原則審理は行わない。

8. 審決は、どのような構成内容となっていますか。

参考資料を参照。事件の表示、結論、理由（例として、手続の経緯、本願発明の認定、引用刊行物記載の発明の認定、対比、当審の判断、むすび）からなる。

9. 無効審判手続きでは、証拠の提出に関して、時間的または内容的制限がありますか。

証拠は、請求書、答弁書に添付しなければならない（特許法施行規則第50条第1項）。当初の請求理由に記載されていなかった事実について審判請求後に証拠の提示をすることは新たに無効理由を根拠づける事実を追加するに等しいので審判請求書の要旨を変更する補正とされ、原則認められない。しかし、後の証拠調べにおいて証拠を提示することを前提に審判請求当初には証拠を提示しないこと自体は審判請求書の記載要件違反ではなく、請求の理由を具体的に示していれば、証拠を後に追完することは可能である。

証拠の内容については、物的証拠、人的証拠のいずれも認められるが、外国語で作成された文章を書証とする際は翻訳文を提出しなければならない。また、証拠方法が文書のときは、文書の記載から明らかな場合を除き、文書の標目、作成者及び立証趣旨を明らかにした証拠説明書を提出しなければならない。

（参考：審判便覧34 - 01）

10. 毎年、審判部が対応可能な「判定」ケースは何件ですか。また、毎年何件の判定請求がありますか。最近の「判定」にはどのような傾向がみられますか。

ここ数年の判定処理件数、請求件数の推移は参考資料のとおり。

100件前後で推移している。具体的な内容についての傾向は把握していない。

11. 「特許」と「実用新案」との「発明性（進歩性）」における相違をどのように解釈されていますか。「発明性(進歩性)」に関する両者の相違点に関する規定が何かありますか。

進歩性について、特許法は公知、公用、又は、刊行物に記載された発明に基づいて当業者が「容易に」発明をすることができたものは特許を受けることができないと定めるのに対し、実用新案法は、公知、公用、又は、刊行物に記載された考案に基づいて当業者が「きわめて容易に」考案をすることができたものは実用新案登録を受けることができないと定めている。しかしながら、容易ときわめて容易の違いは審査基準上に明文化されておらず、実態上は進歩性判断の水準にほとんど差はなくなっている。

### **3. Additional Questions Asked by Mr. Bai in an Interview at JPO on August 1, 2006**

- Target for an Accelerated Examination Process

Efforts will be made to have the result of every first action sent out within 9 months of the time if necessary documents for the examination are complete.

• Exceptional cases in which a correction to the grounds for the demand for a trial is accepted

The requirements for an acceptance of any correction to the grounds for the demand for trial can be summarized as follows:

Case1

(1) The requested correction does not cause an undue delay in the proceeding.

+

(2) The request for correction of errors involves amendment of the relevant patent claim.

Case2

(1) The requested correction does not cause an undue delay in the proceeding.

+

(2) There is a rational reason for the omission of the grounds at the time such request was made.

+

(3) The request is made with the consent of the patentee.

A concrete example of Case 2 is:

- It is not until an argument of the patent holder takes place that there turns out to be a disputable interpretation of the patent claims that could give rise to another grounds for invalidation in addition to that initially made in the request, and such grounds for invalidation is intended to be added.

To be more specific, in the case wherein invalidation of a patent has been asserted on the grounds that a parameter contained in claim of the patent is not sufficiently clear, the patentee argues against the grounds for invalidation by clarifying the technical meaning of the parameter; and the plaintiff refutes the patentee's argument by asserting that the technical meaning alleged by the patentee would give rise to another grounds for invalidation, a lack of inventive step.

- The number of offers of information that took place, for which no official statistics are available, is roughly estimated at approx.4,000 per annum up to 2003, more than 5,000 in 2004 and more than 6,500 in 2005.

- Re: Consolidation

The only requirement for consolidation is that either or both of the concerned parties should be the same for the trial examination cases to be consolidated, and even cases involving an appeal against an examiner's decision of refusal/rejection could be consolidated. In fact, there are a few past records of consolidation, which involved cases of an appeal against an examiner's decision of rejection with the same plaintiff, in which the same documents were cited. It should be noted, however, that different types of appeals may not be consolidated and that appeals against an examiner's decision or rejection and trials for invalidation of patent may not be consolidated.

In the case wherein two or more cases of trials for invalidation of patent are consolidated, a combination by ex officio of evidence previously submitted or produced for each case could constitute a new grounds for invalidation.