

Opposition systems

Japan

I. Opposition to Grant of Patent¹

(1) Within six months from the date of publication of the Gazette containing the patent, any person may file an opposition to grant of patent (Article 113 of the Patent Act). A person filing the opposition shall submit a written opposition stating the name and the domicile or residence thereof (proceeding by the anonymous is not allowed)

(Article 115(1) of the Patent Act).

(2) The opposition shall be filed on any of the grounds stated in Article 113 of the Patent Act, that is:

(i) where the patent has been granted on a patent application (excluding an application written in a foreign language) with an amendment which does not comply with the requirements provided in Article 17-2(3) of the Patent Act;

(ii) where the patent has been granted in violation of Article 25, 29, 29-2, 32 or 39(1) to (4) of the Patent Act;

(iii) where the patent has been granted in violation of the provisions of a treaty;

(iv) where the patent has been granted on a patent application not complying with the requirements as provided in Article 36(4) or (6)(excluding item (iv)) of the Patent Act;

(v) where matters stated in the description, scope of claims or drawing attached to the application written in a foreign language are not within the scope of matters stated in documents written in a foreign language.

(3) An amendment of the written opposition shall not change the gist thereof.

However, the reason or evidence stated in the written opposition can be changed before the lapse of the opposition period (six months from the date of publication of the Gazette containing the patent) or the receipt of the first notice of reasons for revocation of the patent, whichever is earlier (Article 115(2) of the Patent Act).

(4) A chief administrative judge shall serve a copy of the written opposition to the patentee (Article 115(3) of the Patent Act).

(5) An opposition to grant of patent may be withdrawn before the receipt of the first notice of reasons for revocation. Also, an opposition to grant of patent which has

¹ The information on the history of the opposition system in Japan can be found here.

two or more claims may be withdrawn for any of the claims (Article 120-4(2), 155(3) of the Patent Act). However, an opposition may not be withdrawn after the receipt of the notice of reasons for revocation (Article 120-4(1) of the Patent Act).

II. Non-compliance and amendment of written opposition

(1) Where a written opposition does not comply with the formal requirements, a chief administrative judge shall require an opponent to amend the written opposition. Where the opponent fails to make such amendment within the designated time limit, the chief administrative judge may dismiss the opposition by a ruling (Article 120-8(1), 133 of the Patent Act).

(2) Where an opposition to the grant of a patent is unlawful and not amendable, it shall be dismissed by a judge decision without requiring to amend the written opposition (Article 120-8(1), 135 of the Patent Act).

III. Start of Examination of the Case

(1) The examination of the opposition shall be conducted by documentary examination (Article 118(1) of the Patent Act).

(2) The examinations of two or more oppositions concerning the same patent right shall be jointly conducted, unless the special circumstances exist (Article 120-3(1) of the Patent Act).

IV. Notice of Reasons for Revocation

(1) Where the panel of administrative patent judge intends to render a decision to revoke, the chief administrative patent judge shall notify the patentee and the intervenors of the reasons for revocation and give them an opportunity to submit a statement of their arguments, designating an adequate time limit. The patentee may request a correction only within the time limit (Article 120-5 (1)(2) of the Patent Act).

(2) In an opposition examination, even the grounds that have not been pleaded by the opponent may be examined and the claims not claimed by the opponent cannot be considered in the examination (Article 120-2(2) of the Patent Act).

(3) Where the collegial body finds no reasons for revocation, it shall make a decision that the patent is to be maintained (Article 114(4) of the Patent Act).

V. Written Opinion Submitted by Opponent

Where a request for a correction is made by the patentee, the opponent shall be given an opportunity to submit a written opinion within the designated time limit (except for a case where the opponent does not wish to submit a written opinion or where a special circumstance exists) (Article 120-5(5) of the Patent Act).

VI. Decision

The panel shall make a decision of revocation or a decision of maintenance in response to the opposition (Article 114 of the Patent Act).

VII. Action against Decision

An action against a decision of revocation may be brought by a patentee to the Tokyo High Court (Intellectual Property High Court) (Article 178(1) of the Patent Act). No appeal shall be filed against a decision of maintenance (Article 114(5) of the Patent Act).

VIII. Relationship with Trial for Correction

A trial for correction may not be requested during the period between the time the relevant opposition has become pending and the time the decision has become final and binding (all decisions relevant to claims in the event that the opposition has been filed for each claim) (Article 126 (2) of the Patent Act).