

A new form of attack

Kazuya Sekiguchi of Dennemeyer & Associates examines the new opposition system and how it associates with the Japanese invalidation trial system

A post-grant opposition system previously existed in Japan, but was abolished in 2003 to unify the nullity system into invalidation trials. Recently, it has been decided that a post-grant opposition system reflecting the demands of users be re-introduced and will be put in force in 2015. The exact date of implementation has not yet been fixed. As a result of re-introducing the opposition system, the provisions relating to invalidation trials before the board of appeal of the Japan Patent Office (JPO) will also be revised.

Who can file an opposition?

In the current invalidation trial system, anyone, even a non-interested party, can file an opposition. Therefore, when you do not want to disclose your name as an opponent, you can ask someone else to file an opposition. Substantial anonymous oppositions are possible.

In contrast, after the opposition system is in force, invalidation trials that currently may be filed by anyone, even a non-interested party, will be limited to interested parties only.

When can oppositions be filed?

An opposition can be filed within six months from the date when the patent publication is issued. Even within this six-month period, it is not permissible to change or add grounds for the opposition after the opposition division has issued a notice of the reasons for the revocation of a patent to the proprietor. Therefore, it is advisable to prepare the grounds and/or evidence for the opposition well in advance of filing the opposition.

Invalidation trials can be filed any time after the patent is granted, even after it expires.

What is the cost for filing an opposition?

An opposition can be filed for each claim. The official fee for filing an opposition is JPY 16,500 (\$145) + (JPY 2400 (\$21) x number of claims).

On the other hand, the official fee for filing an invalidation trial in front of the JPO's board of appeal is JPY 49,500 (\$435) + (JPY 5500 (\$48) x number of claims). The fee for the opposition is clearly less than the fee for filing an invalidation trial.

Grounds for filing an opposition

The opposition may be filed on the grounds that:

- The subject matter of the granted patent extends beyond the content of the application as filed;

- The patent is not patentable under Articles 25 (enjoyment of rights by foreign nationals), 29 (industrial applicability, novelty and inventive step), 29(2) (novelty; prior rights), 32 (liable to injure public order, morality or public health) and 39 (prior application);
- The patent has been granted in violation of a treaty;
- The patent does not comply with Article 36(4)(i) (enablement requirements) or Article 36(6) (description requirements); and
- Where matters stated in the specification, which is the translation of a foreign application, are not within the scope of matters stated in original foreign applications.

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The grounds that the patent has been granted for the non-entitled person or granted in non-compliance with the requirements for joint application are not grounds for opposition, though they are grounds for invalidation trials.

Procedure of opposition

In the new opposition system, the procedure is only carried out in writing and no oral proceedings are possible. This will reduce the workload and costs of an opponent. On the other hand, in the proceedings of an invalidation trial, oral proceedings will usually be summoned.

The opposition cases are examined by a collegial body of three or five appeal examiners forming the opposition division, which may, of its own motion, examine grounds for oppositions that are not raised by an opponent. However, the opposition division cannot examine claims that are not opposed by an opponent.

When the opposition division considers that the subject patent cannot be maintained as it

is, it issues a notice of the reasons for the revocation of the patent. In response to the notice, the proprietor can file an argument and/or a request for the correction of claims. If the proprietor files a request for the correction of claims, this is then communicated to the opponent and the opponent can file further arguments against the corrected claims in writing. As the opposition can be filed for each claim, it can also be withdrawn for each claim, provided that a notice of the reasons for the revocation of a patent has not yet been issued.

What can the party do if it cannot agree with the decision of the opposition division?

If the opposition division decides to revoke the patent, the proprietor can file a lawsuit in front of the Intellectual Property High Court within 30 days from the date when the decision is transmitted.

Opponents have no further recourse within the opposition system if they do not agree with the opposition division decisions to maintain the patent. If they still want to nullify the patent, they can file an invalidation trial in front of the JPO's board of appeal. Since the decision by the opposition division has no effect of res judicata, the (former) opponent can file an invalidation trial with the same grounds and same evidences.

On the other hand, the decision by the JPO's board of appeal has an effect of res judicata to the parties, and so the party involved cannot file another invalidation trial with the same grounds and same evidence.

Because of its low cost and possible anonymity it confers to opponents, the opposition tool may be a sharp weapon to attack your competitor's patents. **IPPro**



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