



THINK FORWARD

New Opposition Proceeding in Japan

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Opposition proceedings were first introduced in Japan in 1921, as a pre-grant proceeding. In 1994, the proceeding was changed to a post-grant proceeding. The post-grant opposition proceeding was abolished in 2003 because it failed to demonstrate its utility over the invalidation trial, which is similar to the *inter partes* reexamination in the US.

The pendulum has swung back, however, and opposition proceedings were reintroduced in April this year in Japan. After all, a speedy and low-cost proceeding for solving patent disputes has always been in high demand.

Only patents which issued on or after April 1, 2015 can be the subject of the new opposition proceeding; it is not available for review of patents which issued before that date.

US practitioners may find some similarities between the Japanese opposition proceeding and the US ex parte reexamination. In both, no standing is required to file, and any person can initiate an opposition proceeding. § 113. Even a patentee can initiate a proceeding against his or her own patent. If a panel of Examiners agrees with the opposer that at least one claim should be rejected, the patentee is given an opportunity to amend the claims. Once initiated, the opposition proceeding is conducted mainly between a panel of Examiners and the patentee. Involvement of an opposer is very limited.

However, differences between the US ex parte reexamination and the newly reinstated Japanese opposition proceeding should be kept in mind. In the latter, the time window in which a party may file an opposition is restrictive: It must be filed within six months from the issue date of the patent. § 113. For patents issued longer than six months ago, the invalidity trial is the only proceeding that one can request a review by the JPO. To request a review under the invalidity trial, however, a party must have a standing or must show it has sustained or will sustain harm that needs to be redressed.

In addition to novelty and obviousness issues, an opposer can raise § 112-type issues in the opposition proceeding. § 113. Usually, the panel reviews a patent based on the reasons and evidence provided by an opposer, but the scope of the review is not limited to those. Instead, the panel has the authority to make a search, and may review a patent based on other reasons and evidence not provided in an opposition. § 120-2(1). While the US ex parte reexamination requires a substantial new question of patentability to initiate the reexamination, no threshold question is asked to initiate the opposition proceeding in Japan. It is initiated once the opposition is found to meet all the formality requirements.

Like the ex parte reexamination, settlement does not terminate the opposition proceeding. However, an opposer can withdraw his or her opposition until the panel issues a notice of cancellation. § 120-4(1). Although statistical data is not yet available as to how long the panel takes to issue a notice of cancellation in the new opposition proceeding, the patentee and the opposer may discuss settlement before such notice is issued, and may agree that the latter should withdraw the request for review to

avoid its issuance.

The opposer can also amend a request for review during the opposition period—that is, the six-month period from the issue date of a patent. § 115(2). Moreover, the opposer may file multiple oppositions against a patent during the opposition period. If multiple oppositions are filed against a single patent, these oppositions will be consolidated. § 120-3(1). The opposer's ability to amend the request is limited after the opposition period passes. § 115(2). Only an amendment for supplementing the original argument may be submitted. No new argument or evidence may be submitted after the opposition period ends.

During the opposition proceeding, a notice of cancellation may be issued twice. The first is issued if the panel agrees with the opposer that at least one claim should be rejected. A patentee who receives a first cancellation notice is given 60 days (90 days for parties residing outside Japan) to respond to the notice by filing an answer or a request for correction trial, or both. § 120-5(1) and (2). Only an amendment which narrows the scope of a claim or cancels a claim is allowed in the correction trial.

In a correction trial, an amendment may be filed to correct a claim which is not the subject of an opposition. § 120-5(9). Importantly, an additional patentability requirement is attached to an amendment to a claim which is not the subject of an opposition. If a claim is amended in a correction trial which is not the subject of an opposition, the panel will examine that claim to make sure it meets all of the patentability conditions.

If a correction trial is requested in response to the first cancellation notice, the opposer is given 30 days (50 days for those residing outside Japan) to file a reply. § 120-5(5). Any argument raised in the reply which was not raised in the opposition or is not responsive to the request for a correction trial will not be considered. The opposer may not file a reply if the patentee only files an answer and does not request the correction trial.

A second cancellation notice is issued if at least one claim would still need to be rejected even after the requested correction. § 164-2(1). A patentee who receives a second cancellation notice is given 60 days (90 days for those residing outside Japan) to request a second correction trial. § 120-5(1). The opposer is given an opportunity to file a reply in response to the second request for a correction trial. § 120-5(5).

A cancellation decision is issued if at least one claim would still need to be rejected even after the second correction. §120-6. If the issues raised in the opposition are cured by the first or second correction, the opposition is denied.

A patentee can appeal a cancellation decision to the Intellectual Property High Court within 30 days of the decision. §178(1) and (2). The opposer cannot appeal the decision to deny the opposition. § 114(5).

Lastly, estoppel does not attach to a decision to deny the opposition. Therefore, the opposer whose opposition is denied can request an invalidation trial, presenting the same argument and evidence.

In 2003, when the old opposition proceeding was abolished, 3896 oppositions were filed. In comparison, between 200 to 300 invalidation trials have been requested each year for the past 20 years. We expect that at least the same number of oppositions as were filed in 2003 will be filed each year in the future.

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