

How has Japan's New Patent Opposition System Performed since its Implementation?

In April 2015, the JPO implemented a new opposition system designed to simplify and expedite the process for revoking all or some of the claims of a granted patent. It was anticipated that this new system would make it easier to rapidly remove weak and largely inefficient patents and claims which hinder true technological advances from obtaining IP rights.

Below, we briefly summarize the new Post Grant Opposition System and compare it to the Post Grant Invalidation Trial System also employed in Japan.

A) Post Grant Opposition System

A post-grant opposition may be filed by anyone (including a “straw man” or a “non-interested” third party) within 6 (six) months from date on which the patent was issued. The official cost for filing such an opposition is ¥16,500 (\$153)¹ plus ¥2400 (\$22)¹ per claim to be opposed.

Reasons for which an Opposition may be Undertaken

- 1) The scope of the description, claims, and/or drawings of the amendment exceeds the range of the contents described in the application.
- 2) The patent violates a treaty.
- 3) The translated Japanese document does not remain within the scope of matters described in the original foreign language application.
- 4) The patent violates Article 25 (Enjoyment of Rights by Foreign Nationals), Article 29 (Industrial Applicability, Novelty, and Inventive Step), Article 32 (Inventions Liable to Injure Public Order, Morality or Public Health), Article 36(4)(i) (Enablement Requirements), Article 36(6) (Description Requirements), or Article 39 (Prior Application – First-to-file) of the Patent Law.

The opposition will be examined by a collegial body of three to five Examiners at the JPO and oral proceedings will not be performed. If Reasons for Revocation are issued by the collegial body, the applicant may respond to the Reasons for Revocation and make corrections to the patent. If the Reasons for Revocation are unovercome by the correction, the decision to revoke the patent will be made by the collegial body, and the owner of the patent may appeal the decision to the Intellectual Property High Court.

B) Post Grant Invalidation Trial

An invalidation trial against a patent may only be filed by an interested party, who may not remain anonymous. The official cost for filing an invalidation trial is ¥49,500 (\$458)¹ + ¥5500 (\$51)¹ per claim which is to be invalidated.

¹Based on ¥108 = \$1 (Rate as of January 2020).

In addition to the aforementioned reasons for which an opposition may be undertaken, the case when the patent has been granted for the non-entitled person or granted in noncompliance with the requirements for joint application may also be included as a reason for initiating an invalidation trial against a granted patent.

Invalidation trials may be presented orally or through documentary evidence.

C) Results

In the first year and a half or so since the adoption of the new systems, the number of patent invalidation trials fell by approximately 40% to 140 in 2016. As anticipated, the number of post grant patent oppositions surged to almost 1,200 in 2016 and was 1,250 for 2017. An invalidation trial also tends to take 4-5 months longer to complete than a post grant patent opposition (5.8 months in 2016).

Success rates for oppositions are summarized in the following table*.

	Revocation of all challenged claims	Granted patent maintained after correction	Granted patent maintained as is
2015 (362 cases)	12.6%	45.9%	39.8%
2016 (1135 cases)	9.4%	47.6%	34.3%
2017 (430 cases)**	1.8%	10.7%	21.7%

*The table does not include oppositions that were withdrawn or dismissed (0.2% and 2.6% in 2015 and 2016 respectively)

**As of May 2018, approximately 820 post grant patent opposition cases requested in 2017 were pending at the JPO, and thus, have not been included in the above table.

Data obtained from the JPO.

D) Analysis

As the initial cost for filing a post grant opposition is relatively low compared to a request for an invalidation trial, it is anticipated that the number of requests for post

grant opposition will see further increases in the coming years. In addition, as the time required to complete the post grant opposition is shorter, the new post grant opposition system is seen as a rapid means by which weak patents or claims can be invalidated.

The above results do not seem to suggest a bias towards the patentee or the party requesting a post grant opposition, although the above results only cover a time frame of less than two years since the implementation of the system.

Lastly, as it is theoretically possible for the party requesting a post grant opposition to remain anonymous, it is anticipated that the use of the post grant opposition system will continue to increase in the coming years.