Pitfalls for European Applicants in Japanese Patent Prosecution and How to Avoid Them

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SONODA & KOBAYASHI Intellectual Property Law
Tokyo and Beijing

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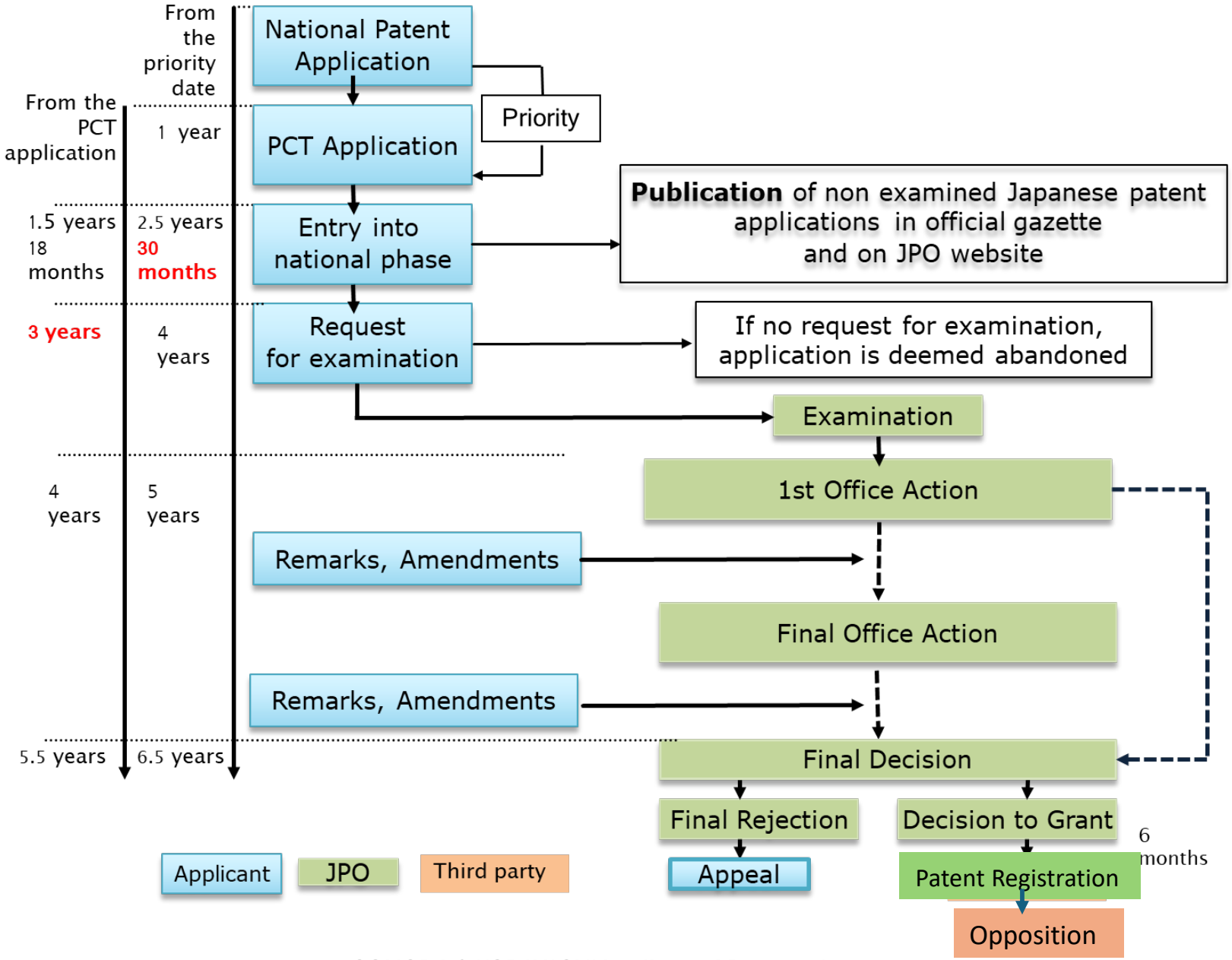


Note*1:

- First OA or Decision to Grant: 9.1 months*2 after Request for Examination
- Average Number of OAs: 1.1
- Examiner's Decision: 13.8 months*2 after Examination is requested.
- Patent Grant Rate: 75.9%
- Number of Registered Patents: 200,284
- Decision to Grant may be issued before 18-month publication
- Opposition Period: 6 months from the publication of granted patents
- Number of Oppositions: 1,264
- Rate of receiving an Opposition when granted: 0.63%
- Opposition Decision: 7.9 months
- Opposition Success Rate: 11.2%

*1: from Annual Report of the Japan Patent Office 2025
*2: the fastest among the IP5 patent examining authorities.

2. Patentable Subject Matter

In order for an invention to be patentable, the invention must be a creation of a technical idea which, as a whole, utilizes a law of nature and has industrial applicability. (Art. 2 and 29 of Japanese Patent Law)

- Computer software–related inventions are patent-eligible subject matter except:
  - Law of nature is not used (programming language, gaming rules);
  - Law of nature *per se* (law of gravity);
  - Mere discovery (substance existing in the nature);
  - Mere presentation (of data or an idea)
- Therapeutic, surgical or diagnostic method is not a patentable subject matter because it is considered to lack industrial applicability.
  - Such claims should be drafted or amended to recite a medicament or a medical device.
  - Voluntary amendments when requesting examination are optional, not always necessary.

A broad range of AI-related inventions are patent-eligible.

- Technical aspects of AI such as
  - neural network configuration, machine learning or deep learning methodology, training data / trained data
- Applications of AI in various technical fields are also eligible for patents provided that the conditions for software inventions' eligibility described above are met.

Examples of patentable claim formats include:

- A computer program for causing a computer to perform operations comprising …
- A method comprising the steps of ……
- Learning data (teaching data, training data) …
- A set of parameters/models established through machine learning
- An application of a set of parameters/models to a particular field
- a system for autonomous driving of a vehicle wherein an AI system is employed …

3. Description Requirements

3.1 Enablement/Support Requirement

Enablement:

Enablement requirements are met when the specification discloses the invention clearly and sufficiently to the extent that those skilled in the art can implement the claimed invention based on the patent application and common technical knowledge at the time of filing.

Support Requirement:

Support requirements are met when the claimed invention is described in the specification to the extent that those skilled in the art would understand that the problem could be solved by the invention, across the entire scope of the invention, including each and every element, based on the specification and the drawings and common knowledge of those skilled in the art.

The enablement and support requirements may not appear materially different from those under the EPC or US Patent Law.

- Nevertheless, the practitioners at SONODA & KOBAYASHI perceive Japanese examination practice as being stricter than that of the EPO and USPTO, with respect to enablement and support requirements.
- However, we see fewer rejections based on enablement or support requirements for patent applications originating from Europe probably because the applications from Europe are adapted to Japanese standards more than before.
- In Japan, particularly in the fields of chemistry and biotechnology, inventions are still often evaluated based on the experimental results disclosed in the specification. Unpredictability of results is the general rule unless rebutted by persuasive argument.
- Unlike in the US or Europe, purely conceptual inventions are rarely granted.
- As a result, providing sufficient experimental support in the specification is crucial to meeting the support and enablement requirements in chemistry and biotechnology.

This difference arises mainly because:

- The underlying assumption in the Guidelines that the effects of chemical compounds are generally unpredictable based on their names or structures;
- the Japanese Examination Guidelines, which explicitly require pharmacological test data for pharmaceutical inventions; and
- The examination practice that broadening or generalization beyond the scope of the submitted test data requires specific basis.

Advice:

- However, examiners tend to be more lenient with respect to enablement and support requirements for novel types of inventions with limited prior art, likely because Examiners view such innovations favorably.
- For chemical or biological inventions, describe narrow (experimented), broader, and broadest ranges with an explanation that the same results are obtainable by broader and broadest ranges.

3.2 Case Study (enablement and support requirement):

"Polymer composite structure reinforced with shape memory alloy and method of manufacturing same"

European Patent No. 1,563,027
US Patent No. 6,989,197
Japanese Patent Application No. 2004-550479 rejected

Granted Claim 1 (US Claim).

A composite structure, comprising:

a first layer of material;

a second layer of material;

a resin layer disposed between said first and second layers of material for bonding said layers together to form a unitary structure;

a plurality of shape memory alloy (SMA) particles dispersed throughout at least a portion of said resin layer for toughening said unitary structure; and

wherein said SMA particles are provided in an austenitic state.

Examination histories in the US, EP and Japan

EPO: Decision to grant a European patent was issued after exchange of opinions and amendments regarding novelty/inventive step; enablement and disclosure requirements were not the issue

USPTO: Notice of allowance was issued after Request for Restriction/Election; enablement and disclosure requirements were not the issue

JPO: Lack of support (and likely lack of enablement as well) was deemed unsolvable

Reasons for Rejection by the Japanese Examiner (June 30, 2009)

Lack of enablement

Generally, it is relatively difficult to predict the effect of an invention in the field of chemistry.

Therefore, in order to describe a detailed description of the invention to enable a person skilled in the art to practice the invention, one or more representative examples are usually required.

However, for the present invention, no examples are provided (although the structure of the molded product is described in the drawings, even the type of polymer used is not described).
Therefore, the detailed description of the invention in this application is not sufficient to enable a person skilled in the art to practice the invention.

Arguments by the applicant

The present invention relates to a resin composition used for an aircraft body, and the problem to be solved is the improvement of certain mechanical properties of the composition (compression strength after impact (CAI) and hot-wet OHC strength).

Therefore, with respect to the present invention, I do not believe it appropriate to conclude that examples are indispensable even if the same might generally be required for the inventions in the field of chemistry. Based on the specification, the structure of the present invention will be clear to those skilled in the art, and the composition described in the claim can be obtained or manufactured without undue trials and errors.

Reasons for Rejection by the Japanese Examiner (November 24, 2009)

Lack of support

With respect to the resin compositions of the present invention, the specification states that composite materials using the resin have increased compression after impact (CAI) strength, etc. without adversely affecting the high temperature-wet compression strength.

However, there is no specific description by way of examples, etc. in the specification, and no specific support is provided as to whether the claimed resin composition achieves the above-mentioned effects. Therefore, the claimed invention is not what is described in the detailed description of the invention. (lack of support: those skilled in the art would understand that the problem could be solved by the invention)

Interview record

The examiner explained that the lack of support rejection will not be solved even if new test data which proves the enhanced properties of the claimed invention is submitted.

Background to the discussion

The support requirements are assessed based on the specification at the time of filing of the application. Therefore, the goal of supplementing test results must be to prove that those skilled in the art could understand by reading the specification and in view of the common knowledge at the filing date that the claimed composite had the technical features alleged in the application.

However, it is logically not possible to prove it by retroactively filing test results in the situation where the original specification does not satisfy this requirement.

The reason why the examination at the JPO ended in a rejection while the examination at the USPTO and EPO did not

- The JPO examination is based on a premise that the results or effects of an invention are not predictable by the structure or composition of the invention and therefore the results or effects must be proved by way of experiments in technical fields such as chemistry, metallurgy, material science, biology and pharmaceutics.
- The examiner does not need affirmative evidence to doubt the results or effects not proved by experiments in those fields.
- The judgment as to whether or not an invention's results or effects must be proved by experiments is within the discretion of the examiner.
- Filing test data proving the results or effects of the invention after the filing date does not cure a lack of enablement or support even if the same test results could have solved the.

Our Recommendations:

- Be aware that evidence is often necessary, especially in chemical or biological fields, to show that the claimed invention solves the problem to be solved by the invention unless it belongs to common knowledge of those skilled in the art.
- When experimental data is necessary but unavailable, the mechanism by which the invention achieves the results must be explained theoretically at least.
- Advantageous results of the invention should be described at least qualitatively even without data to allow later submission of experimental data in support of inventive step (not for enablement or support requirements).

3.3 Clarity

Lack of clarity forms a basis for rejection typically when:

- Claim scope is unclear due to the use of a (an);
  - approximation term (e.g., approximately, nearly, almost, etc.);
  - relative or indefinite adjective or adverb (e.g., high, rapid, substantially, evenly, etc.);
  - optional/qualifying term (e.g., preferably, as necessary, etc.);
  - undefined term (e.g., mixing monomers A and B at 40% and 60%);
- a numerical range includes zero (e.g., 0 to 10% by weight);
- preceding claims are referred to as a whole (e.g., method as claimed in the preceding claims, further comprising);

Our Recommendation:

- Although the JPO Examiners tend to be strict about clarity, we do not recommend automatically amending the claims before the first OA is received because the judgment depends on the Examiner.

3.4 Various Claim Styles

1). Multiple dependent claims

Multiple dependent claims are permitted, but not in a superimposed manner (a multiple dependent claim depending on a multiple dependent claim is not allowed).

Our Recommendation:

- Superposition of multiple dependent claims must be amended when requesting examination or earlier because such claims will not be examined for novelty and inventive step, and subsequent OA will be a Final OA (to which freedom of amendments would be restricted).

2). Functional Expressions

Double Standards at examination and enforcement

During examination, claims defined by function, effect, or purpose are interpreted broadly, covering all means capable of achieving the recited function.

After grant, claim scope is interpreted in light of the specification, based on what a person skilled in the art would understand the invention to be. This interpretation is often narrower than during examination, though broader than the specific examples.

Our Recommendation:

- Enhance examples that possess the claimed function to broaden the claim scope at post-grant claim interpretation.

3). Use Claims

Use claims, including Swiss-type claims, are usually categorized as method claims (not a method of making an object). The Japanese Patent Law recognizes three types of inventions described below and assumes that an invention must fall in one of the three types:

① objects,
②methods of making objects, and
③ methods

"A use of material X in the production of Y" will generally not cover product Y produced by using material X.

Our Recommendation:

- When a use claim is included, consider adding claims addressed to a method and a resultant object whenever possible.
- In patent term extension, note that a Swiss-type claim will likely not be eligible for extension because it is not directed to the approved object (pharmaceuticals).

4). Limitation of Application regarding Substance

When a particular application of a matter or an object is recited in a claim, the claim is interpreted to address the matters or objects suitable for the recited application.

As a result,

- a crane hook having a characteristic shape is patentably distinguishable from a fishing hook having the same shape; and
- an anti-fouling composition for ship hulls having a particular composition is patentably distinguishable from an electrode coating agent having the same composition.

Our Recommendation:

- While a therapeutic (or diagnostic) method using a particular substance is not a patent-eligible subject matter, the claim may be rewritten in the form of a compound (effective ingredient) or a composition for use in a particular therapeutic method.

5). Product-by-Process Claims

When a claim recites a method for making the claimed object (product-by-process claim), the claim scope and gist of the claimed invention are determined and recognized to be the objects identical in the structure and characteristics with those made by the recited method.

Definition of an object by reciting a method for making it (product-by-process claim) satisfies the clarity requirement only if direct definition of the subject by the structure or the property is impossible or impractical at the time the patent application is filed.

Our Recommendation:

- We generally advise to have product claims defined in other ways.
- A product-by-process claims is advisable only when there is a good argument that defining the subject matter by the structure or the property is impractical.

6). Limitation by Parameters

Claims including numerical limitations tend to be scrutinized regarding support requirement, inventive step and the doctrine of equivalents.

- Support Requirement

Support requirement is met if those skilled in the art would understand that a solution would be provided throughout the claimed range (test examples showing the criticality of the range are usually not necessary).

- Inventive Step

Inventive step is often denied if the numerical limitation is the only distinguishing feature of the claimed invention for the reasons that optimizing the numerical range is a common practice of engineers.

Nevertheless, inventive step is affirmed if the qualitatively different results or quantitatively distinctive results exceeding expectation of those skilled in the art are provided for the claimed range.

Doctrine of Equivalents for claims with numerical limitations

In order for an infringement is found under the doctrine of equivalents,

- the feature in question must not be an essential feature of the claimed invention (essential feature: the feature which distinguishes the claimed invention over prior art), and
- the patentee should not have intentionally excluded the product in question from the claim scope during the examination procedure.

In view of the above, there is a higher potential that the doctrine of equivalents may not be applied for the claims with numerical limitations to find infringement.

Our Recommendations:

The examination practice has become less stringent about the criticality in and out of the ranges. However, claiming multiple ranges is advisable to provide stepwise narrowing when necessary.

7). Claims for Computer Software Related Inventions

Broad Eligibility

AI, machine learning, deep learning, and neural network are broadly covered:

- Learning data (teaching data)
- Set of parameters/models established through learning
- Application to a particular field of a set of parameters/models
- A product made by software which applies a set of parameters/models

Our Recommendation:

- Subject matter that is not patentable in Europe or US may be patentable under the Japanese practice.

Regarding computer software related inventions:

Patent-eligible subject matter includes

The software which

- handles hardware, physical substance or information relevant to physical existence; or
- cooperates with hardware in the characterizing part of the invention

Non-patent-eligible subject matter includes:

The software which

- does not handle hardware, physical substance or information relevant to physical existence (but handles manmade agreement, language, mathematics, psychology, data per se), and
- has no cooperation with hardware in its characterizing part of the invention.

8). Omnibus Claims

An omnibus claim such as “the invention disclosed by the specification” is useful in a particular situation although not patentable.

Our Recommendation:

- For a backup Divisional application, an omnibus claim is recommended because:
  - The examination fee is calculated by the number of claims;
  - Even after examination starts, the first OA will simply notify the lack of clarity, providing an opportunity to amend the claims. The OA subsequent to the amendments will be the First OA.
  - By contrast, if the divisional application has the claims identical with its rejected parent application, the first OA will be the Final OA.

4. Novelty

4.1 Exemption from Loss of Novelty

Broad range of disclosure is deemed not novelty destroying

An invention is deemed not to have lost its novelty for one year despite the acts as follows:

- disclosure of the invention against the wish of the applicant; and
- disclosure as a result of the applicant's action (excluding the publication of IP right applications by the JPO or other patent offices),

Our Recommendations:

- Note that novelty may not be lost as far as Japan is concerned despite a disclosure of the invention anywhere in the world.
- However, the provision (exemption from loss of novelty) cannot protect the novelty against a disclosure of an original invention created without borrowing the idea.
- Exemption is applied upon request in patent applications.

4.2 Self Collision of Applications

A patent application filed earlier but yet to be published when a patent application filed later does not constitute a novelty bar or an inventive step bar if:

- either the inventors or the applicants are identical between the two patent applications.
- The same shall apply mutatis mutandis to Utility Model applications.

Our Recommendations:

- Broader relief measures are provided for accidental self collisions of disclosures when patent applications are filed in a series.
- The relief measures are provided without an action of the applicant.
- Publications (early publications by request of unexamined applications and publications of granted patents) before filing of the later application constitute a novelty bar.

4.3 Inherency

Discussion of inherency is not as developed as in the US or EP. Courts have taken different approaches in ruling novelty in view of inherency. However, general understanding would be as follows:

- Inherent attribute of an object or a method is novelty-destroying if an exclusive right of a patent retroactively impedes the right of the public to use the object or the method.
- Novelty is denied if use of the claimed invention
  - substantially overlaps with a use available to the public;
  - necessarily encompasses a use available to the public, or
  - cannot be clearly distinguished from a use available to the public.

Our Recommendation:

- Since the examination standards do not provide detailed guidance on how inherency should be handled in examination, arguments based on court decisions will be necessary to overcome a rejection based on inherency.

4.4 Disclaimers in Claims

The use of disclaimer in claims to eliminate an element/possibility is relatively limited to situations such as:

- Accidental coincidence with prior art;
- Humans should be excluded from mammals to claim patent-eligible subject matter;
- To intentionally exclude implicitly included possibility.

Disclaimer is not allowed if it alters the claimed technical idea by changing the problem to be solved, means of solution or results.

Our Recommendation:

- Although rare, a disclaimer is available when prior art accidentally discloses one or more of the claimed possibilities.

Ex. Claim: A salt of a metal and SO_4
Prior art: A salt of Ca and polyatomic group SO_4, NO_3, ...
Amended claim: A salt of a metal (except for Ca) and SO_4

5. Inventive Step

The examiner evaluates if the examiner can establish a logical structure that the inventor could have made the invention easily based on prior art, common knowledge or a combination thereof. The Examiner might rely on the problem-and-solution approach, but the examiner is not obliged to be based on the approach.

① The Examiner determines whether or not creation of the claimed invention should have been easy based on the differences between the claimed invention and the primary citation in view of supplementary citation or common knowledge. Negative factors for inventive step must be considered.

② If the Examiner cannot establish a logical structure to deny inventive step, the invention is deemed to have inventive step.

③ If the Examiner established a logical structure to deny inventive step, the examiner must consider and evaluate positive factors for inventive step.

Positive and negative factors for inventive step are as follows

Positive Factors

- Advantageous results
- Teach away in prior art or common knowledge
- Technical barrier
- Conflict of purposes

Negative Factors

- Design alternatives, selection, replacement, optimization
- Aggregation
- Close relationship between technologies
- Close relationship between the problems solved by the invention
- Commonality in function or effects

Our Recommendation:

Although results are not the primary factor in the inventive step evaluation, demonstrating advantageous results is often decisive when novelty of the invention is established.

6. Amendments

Scope for allowable amendments narrows gradually as examination proceeds.

- In the amendments in response to the First OA or earlier, claims may be amended in any way within the original disclosure as filed in the JPO in any language;
- In response to the First (non-final) OA, the claims as amended must have unity of invention with the claims examined in the preceding OA in addition to the above-mentioned limitations.
- In response to the Final OA or when filing an appeal, the amendment must have one of the following purposes, in addition to the above-mentioned limitations:
  - Deletion of claims;
  - Further limitation of an already-recited feature maintaining the field of industrial application and the problem to be solved;
  - Correction of typographical errors
  - Clarification of unclear language (as objected by the Examiner)

- Support by the original disclosure is satisfied as long as those skilled in the art would recognize that the invention/feature is disclosed.
  - Direct and unambiguous statement is unnecessary;
  - Selection of a possibility from a Markush claim will be allowable;
  - Selection of an arbitrary numerical range out of a broader range will be not allowed.

Our Recommendations:

- Paris-route applications must be first filed in their original languages and then translations must be filed to enable the amendments based on the original application. Claiming priority does not permit the same.
- PCT applications always allow the amendments based on the original PCT application.
- Divisional applications must also be filed in the original language first.

7. Examiner Interviews

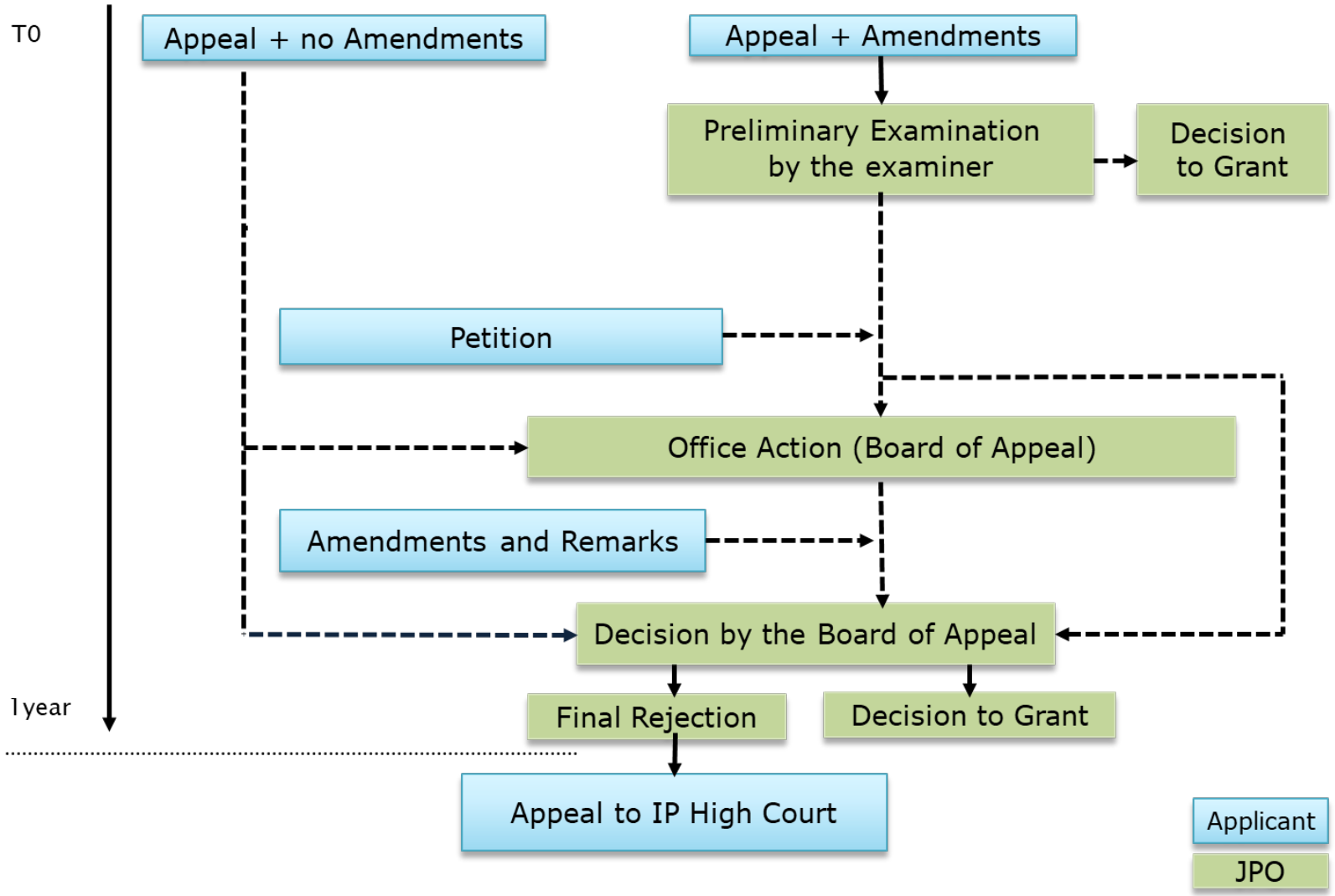
Examiners are generally open to informal telephone or formal face-to-face interviews while applications are pending examination.

- Telephone interviews are more common. Either the Examiner or the applicant can request a telephone interview often to submit proposed amendments and discuss on that basis.
- Face-to-face interviews are used primarily when background information or relevant evidence are to be disclosed and discussions exceeding exchange of amendments and opinions thereon are expected.

Our Recommendation:

- Face-to-face interviews are recommended when information that you need to refer to during the discussion must be kept inaccessible to the public. Such information can be just displayed on a screen. Otherwise, the material used at the interviews will be kept in the file wrapper to be accessible for the public.

8. Appeal against Rejection



Appeals against rejection by the Examiner is relatively inexpensive and attain a high success rate.

- The applicants have only one chance to counterargue the Examiner's reason for rejection (in average 1.1 OAs during examination) before a Decision is issued. An appeal against rejection provides additional opportunities to exchange opinions with the JPO.
- The fees are not prohibitively high (official fee of below €1,000 for up to 25 claims and attorney fees not substantially different from an OA; the success rate is over 80%)

Our Recommendation:

- Filing an Appeal against Rejection by the Examiner is almost always a realistic option when an application is rejected by the Examiner.
- It is not necessary to compromise too much about the claim scope during the examination befor the Examiner.

9. Divisional Applications

Divisional applications may be filed at any moment described below:

- Until the receipt of a First OA;
- Within 3 months (+ 3 months) after the receipt of an OA;
- Within 30 days (+30 days if the deadline for payment of registration fee is extended) after the receipt of a Decision to Grant a Patent;
- Within 4 months after the receipt of a Decision of Rejection by the Examiner.

Our Recommendation:

- When an Appeal is filed against the Decision of Rejection by the Examiner, that might be the last opportunity to file a Divisional application.
- If an Appeal is filed at the same time with a Divisional Application, the examination of the Divisional Application may be stayed upon request until a decision is made on the appeal.
- Refer to Omnibus claims.

10. Accelerated Examination

Various ways to accelerate examination are available, including:

- PPH including PCT-PPH and Mottainai-PPH.
- Accelerated examination for various reasons including that the application has a family member filed outside Japan;
- Accelerated examination when there is a risk of infringement;
- Super accelerated examination when the situation is urgent.

Our Recommendations:

- The examination at the JPO is the fastest among the patent offices performing substantial examination.
- 9.1 month and 13.0 months before the first OA and Decision, respectively.
- An OA will be issued in a few months after acceleration is requested.
- PPH does not guarantee grant of a patent, examination is accelerated though.

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. Patent Infringement Lawsuit

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1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts

	Opposition (JPO)	Nullity Action (JPO)
Requester	Any third party	Interested party (privy)
Time limit	6 months from the publication of patent	Any time after registration of a patent (even if the patent is expired)
Reasons	Lack of novelty, inventive step, enablement, or support by original language document Violation of the provisions regarding the amendments	Lack of novelty, inventive step, enablement, or support by original language document Violation of the provisions regarding the amendments, co-ownership, double patent, or correction after grant, etc.
Board	3 Appeal Examiners	3 Appeal Examiners
Procedure	Simplified inter-part (Fig. 1)	Inter-part (Fig. 2)

Part 2 - Post Grant Procedures

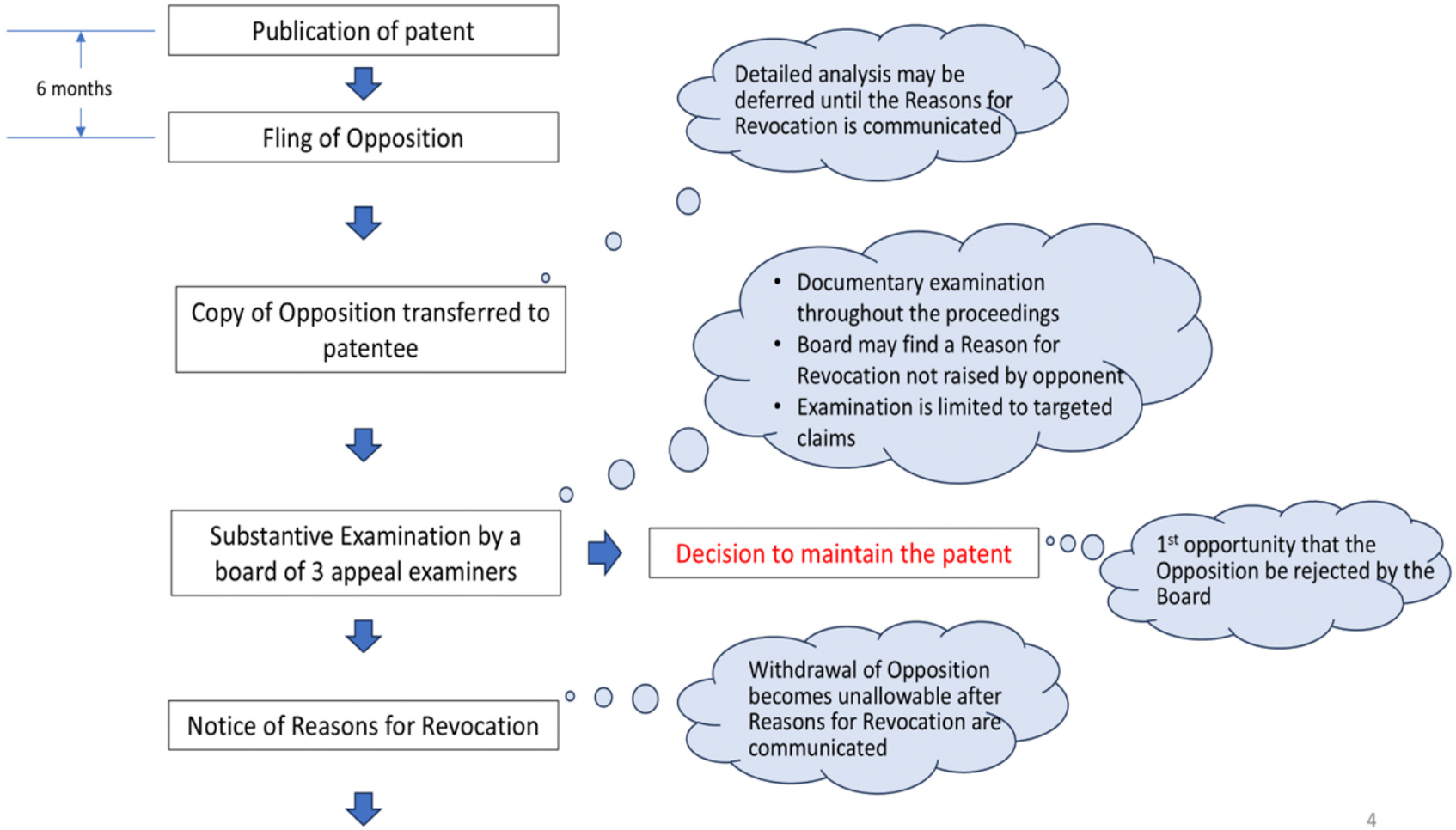
1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. Patent Infringement Lawsuit

	Opposition (JPO)	Nullity Action (JPO)
Particularities	Documentary proceedings	Documentary proceedings + Oral Hearing
	Initiative given to Board of Examiners	Board's initiative is more limited
	• Opposition may be rejected by the Board without hearing the opinion of Opponent	• The same can happen only when the demand for revocation has an uncurable formality error
	• The Board may find a new reason for revocation	• Same initiative is given to the Board
	• Withdrawal is not allowed after the reasons for Revocation are communicated	• Demand for revocation may be withdrawn any time before the finalization of the decision
	In favor of patentee	Parties are provided with equal opportunities
	• patentee is given an opportunities to submit arguments and amendments each time Board's negative opinion is communicated	• Amendments are allowable within the term for filing a reply brief and when a preliminary decision of revocation is communicated
	• After filing an Opposition, Opponent can file its opinion only if patentee requests amendments	• Documents are exchanged at equal number of opportunities, including filing of demandant's opinion at each attempt of amendments
	• Decision to maintain the patent is unappealable while the decision to cancel the patent is appealable	• Decision is appealable to the IP High Court regardless of whether it is favorable to the patentee or not

Part 2 - Post Grant Procedures

1. **Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts**
2. Patent Infringement Lawsuit

Fig. 1 Opposition Proceedings before the JPO (1/3)



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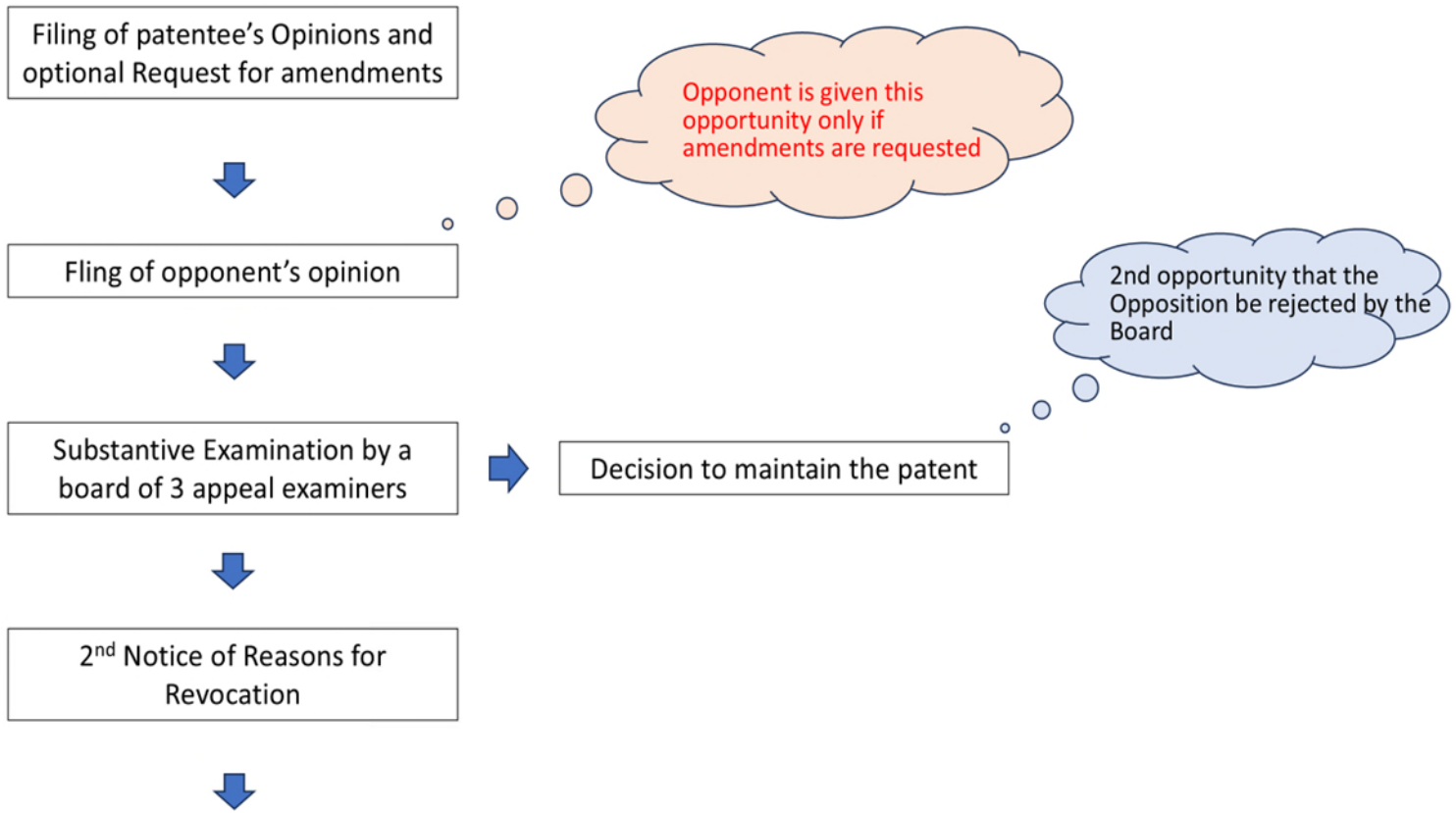
Part 2 - Post Grant Procedures

1. **Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts**
2. Patent Infringement Lawsuit

Fig. 1 Opposition Proceedings before the JPO (2/3)



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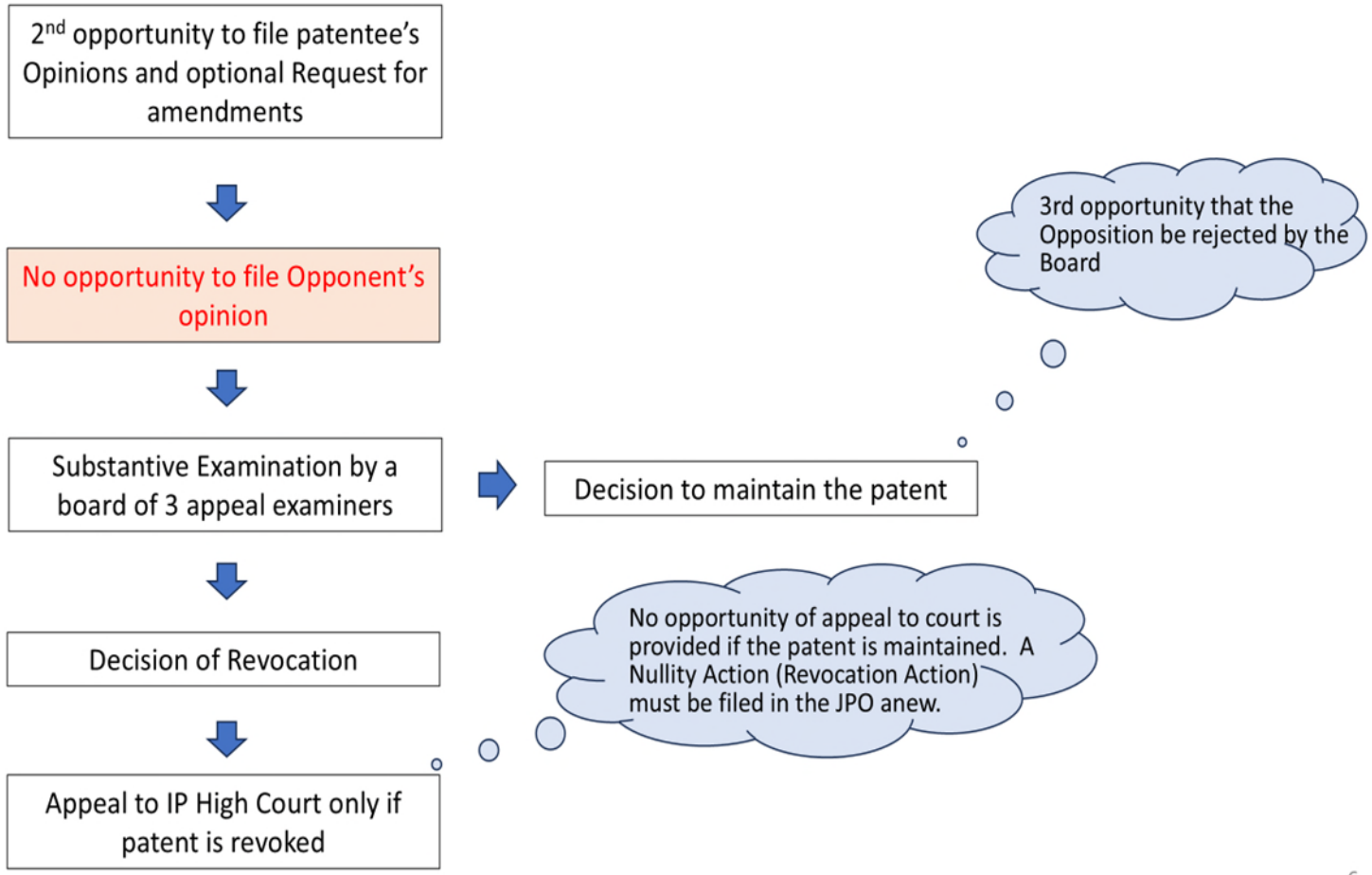
Part 2 - Post Grant Procedures

1. **Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts**
2. Patent Infringement Lawsuit

Fig. 1 Opposition Proceedings before the JPO (3/3)



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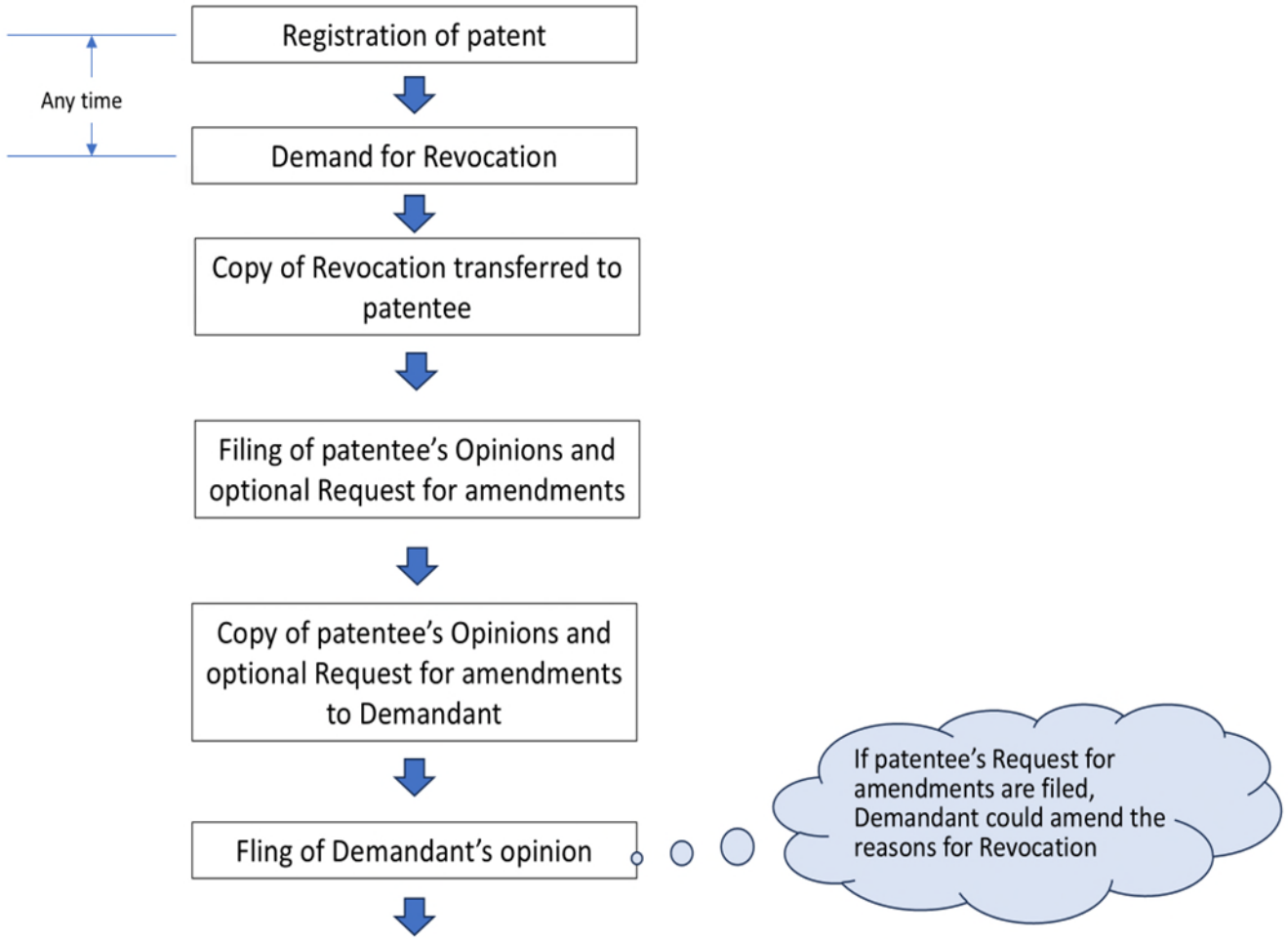
Part 2 - Post Grant Procedures

1. **Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts**
2. Patent Infringement Lawsuit

Fig. 2 Nullity Action Proceedings before the JPO (1/3)



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Part 2 - Post Grant Procedures

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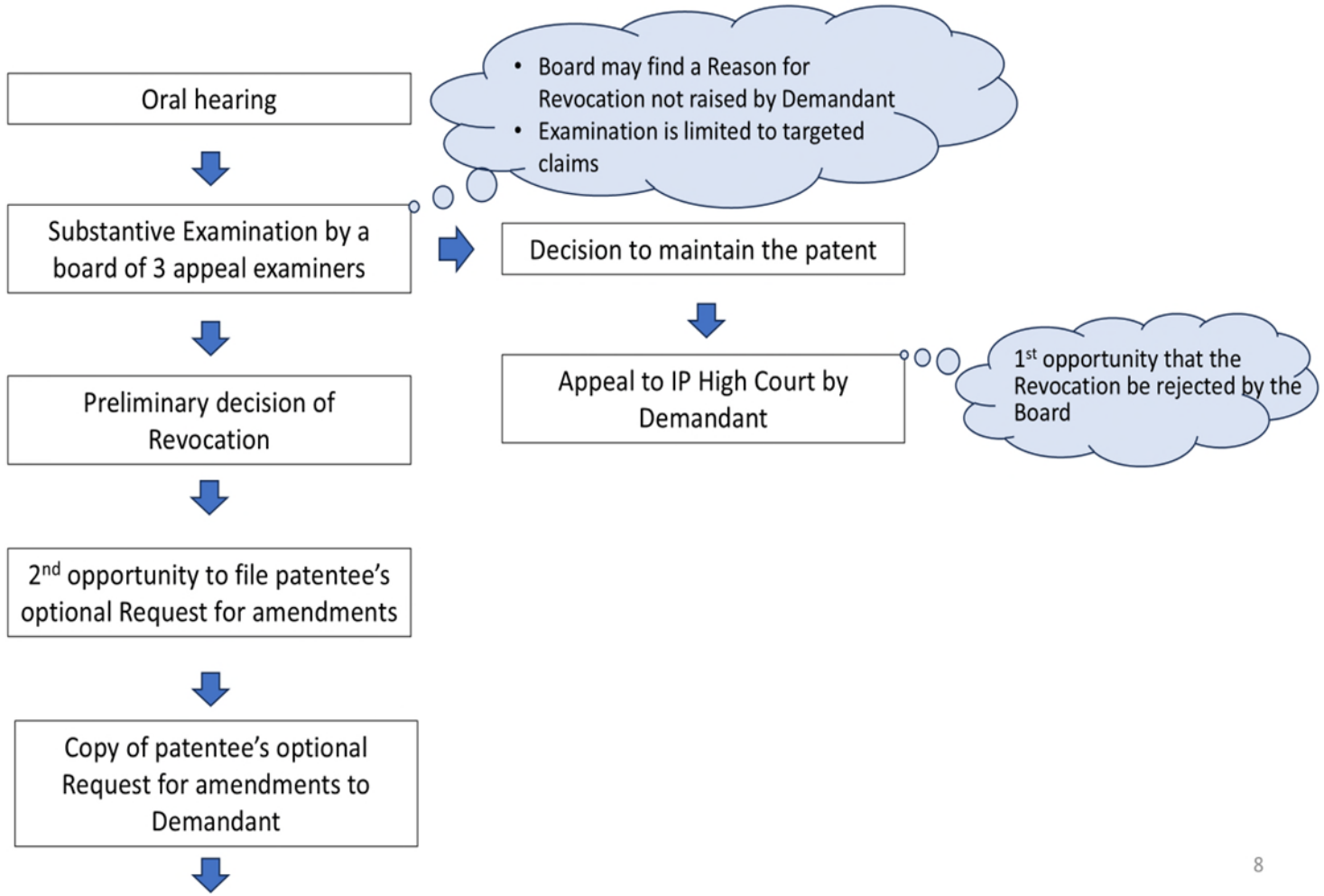
Fig. 2 Nullity Action Proceedings before the JPO (2/3)



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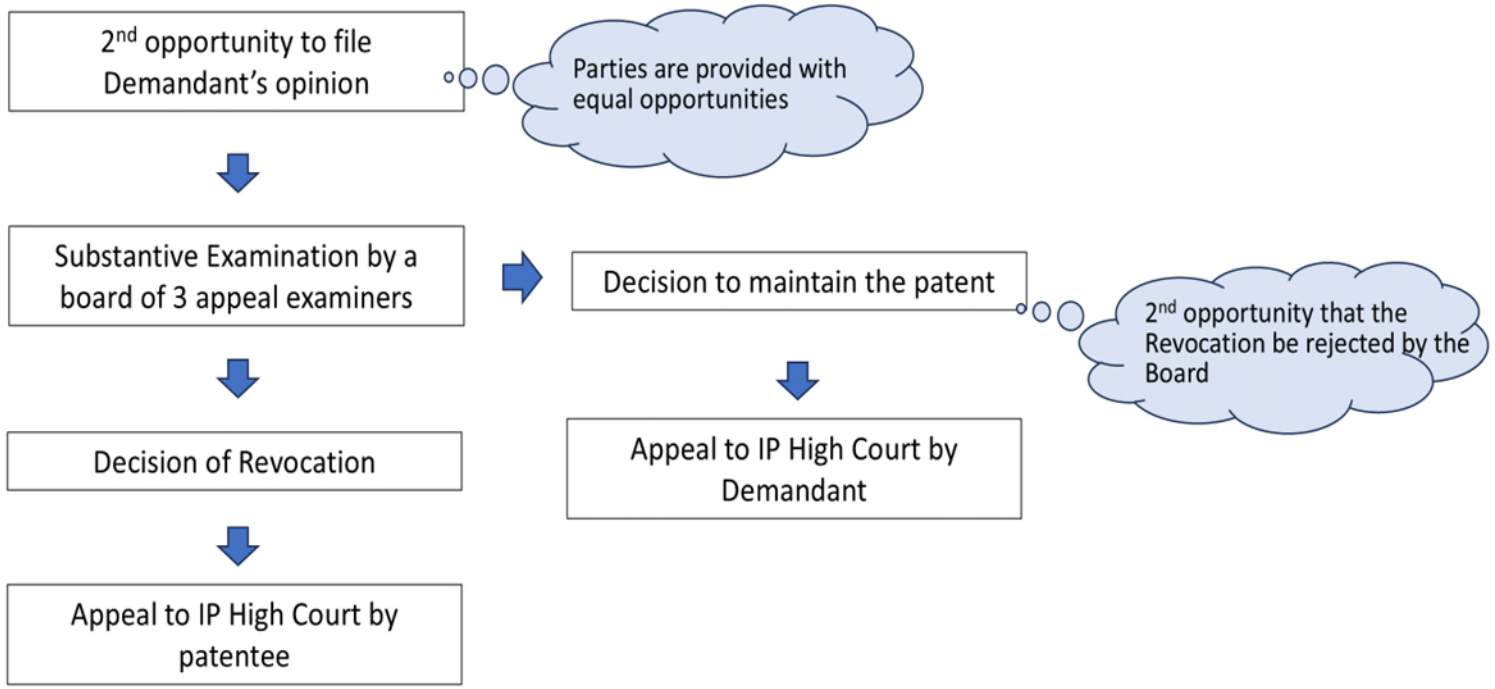
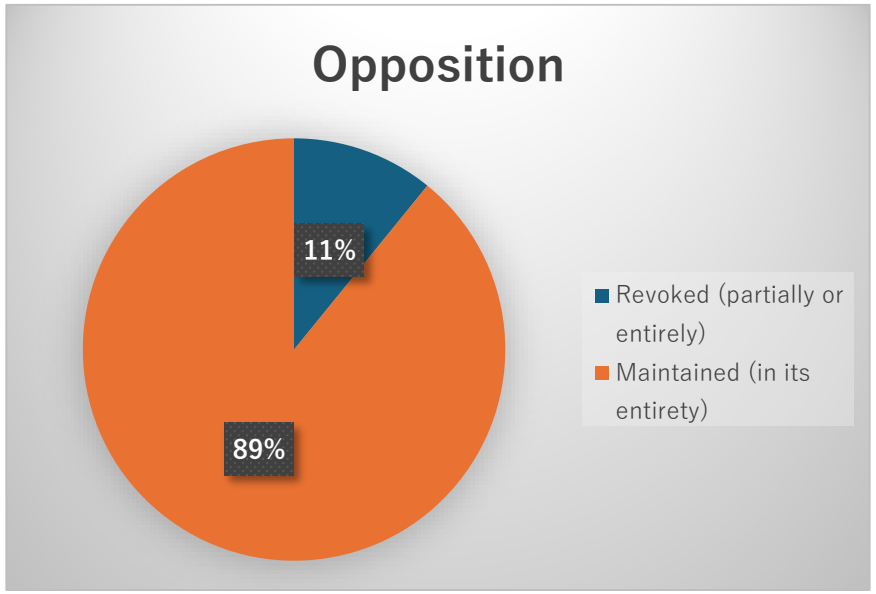
2. Patent Infringement Lawsuit

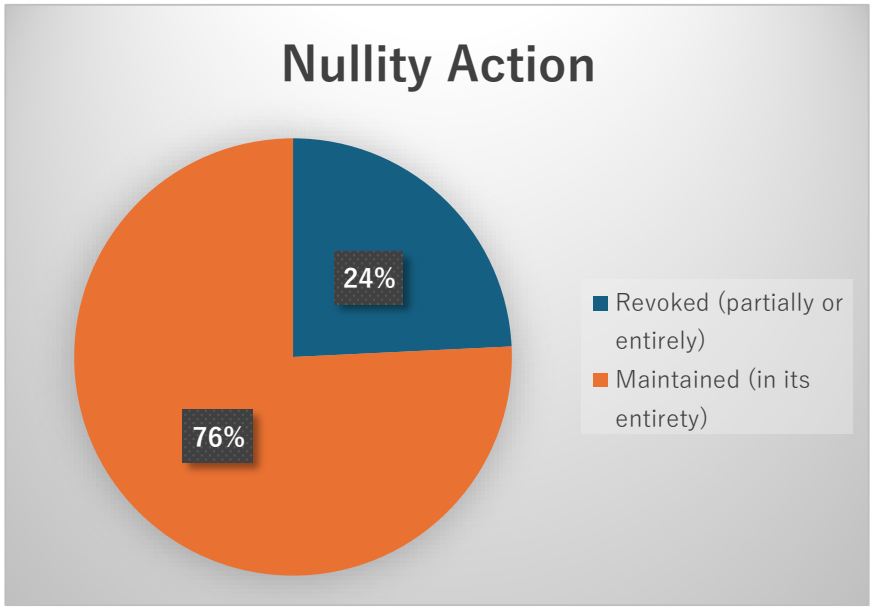
Fig. 2 Nullity Action Proceedings before the JPO (3/3)



Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. Patent Infringement Lawsuit





Part 2 - Post Grant Procedures

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Recent statistics regarding outcomes of revocation actions

Outcome of Oppositions at the JPO

	Opposition Decision		
	Revoke	Maintain	total
2015		5	5
2016	55	645	700
2017	128	1085	1213
2018	150	1006	1156
2019	140	896	1036
2020	139	874	1013
2021	104	961	1065
2022	95	1178	1273
total	811	6650	7461
ratio	10.9%	89.1%	

Outcome of Nullity Actions at the JPO

	Revocation Decision		
	Revoke	Maintain	Total
2015	39	144	183
2016	56	125	181
2017	35	108	143
2018	19	84	103
2019	26	102	128
2020	28	60	88
2021	17	57	74
2022	16	58	74
total	236	738	974
ratio	24.2%	75.8%	

Appeals filed in the IP High Court regarding Nullity Actions and Correction Actions

	IP High Court Decision		
	Revoke	Maintain	Total
2015	30	48	78
2016	23	54	77
2017	36	58	94
2018	14	72	86
2019	19	47	66
2020	13	51	64
2021	24	40	64
2022	10	40	50
total	169	410	579
ratio	29.2%	70.8%	

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
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Under which circumstances is a JPO opposition advisable?

1. The target patent is not crucially important.
   - ➢ The proceedings tend to favor the patentee.
   - ➢ A decision maintaining the patent can make subsequent revocation efforts more difficult.
     - Appeal Board of the JPO tends not to make contradictory decisions within the JPO.
     - New evidence strong enough to lead an opposite decision is necessary.
2. The evidence is strong enough to destroy the patentability
3. Unsuccessful outcome is acceptable
   - ➢ On average, 100 to 140 patents are cancelled annually (10.9% of all Oppositions result in cancellation of patents).
4. When cost minimization is the primary priority

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
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5. When anonymity is important
6. When the demandant is not a concerned party

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
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When are oppositions not advisable?

1. When revocation of the patent is crucially important.
2. When maximum efforts must be made to revoke the patent.
3. When withdrawal of the Opposition must be considered as a tool for negotiation with the patentee

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

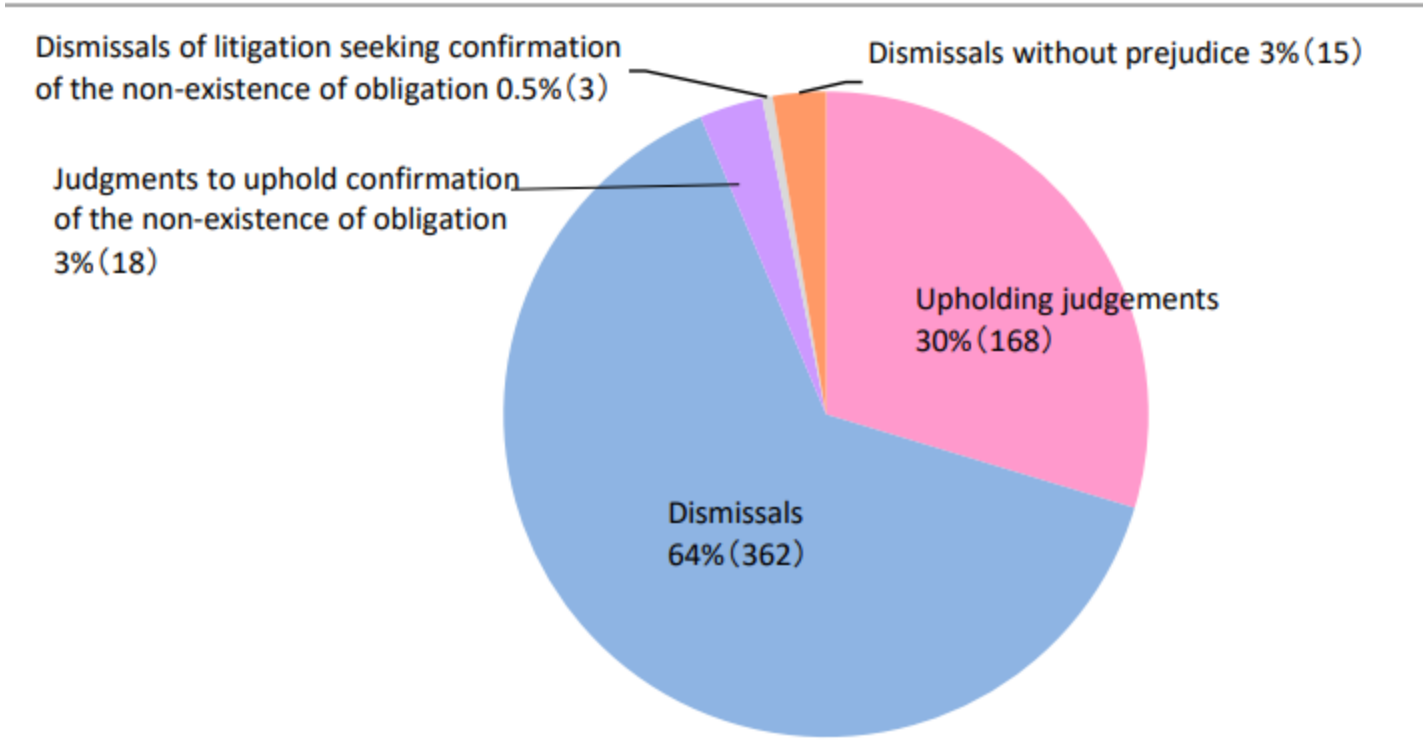
2. Patent Infringement Lawsuits

- Must be filed within 3 years of discovering the alleged infringement and infringer to demand damages.
- Infringement lawsuits are tried before Japanese District Courts (Tokyo or Osaka).
- The invalidity of the patent is a commonly raised defense (～75% of the time)
- Comparatively slow (average 14 months).
- Most expensive (EUR 50 000 – EUR 400 000)

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

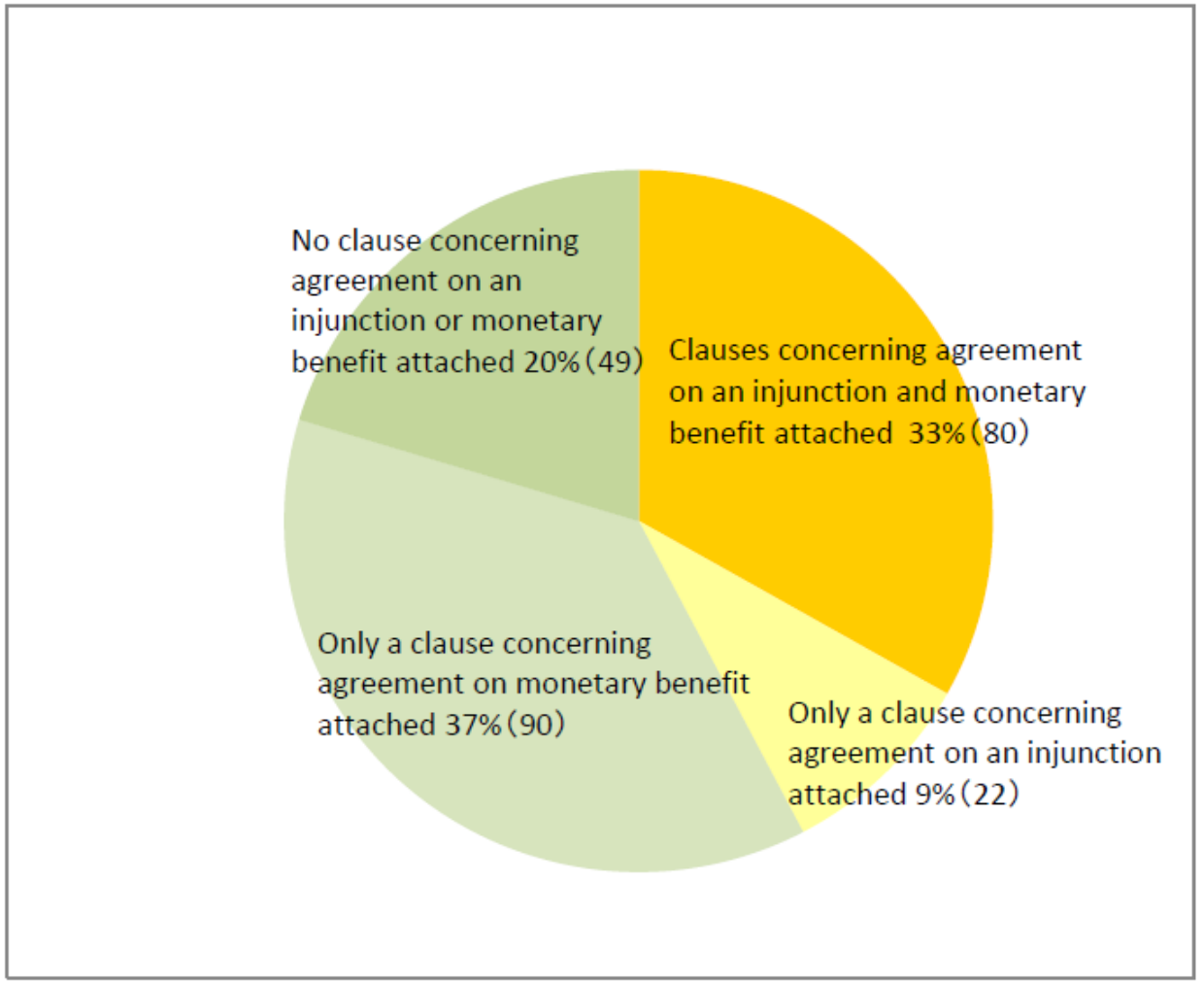
Lawsuits Involving Patent Rights (2014 – 2023): Judgments



Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

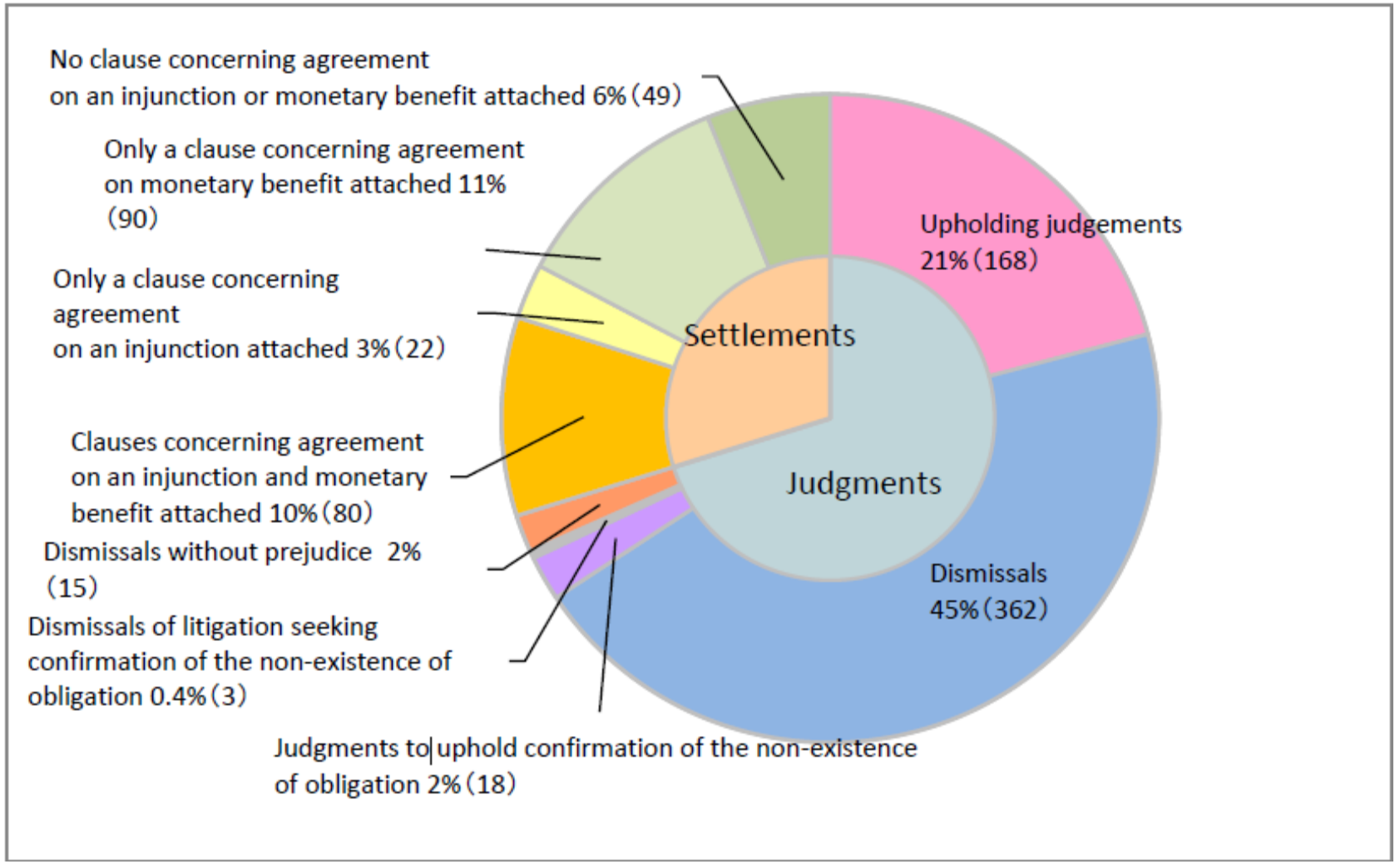
Lawsuits Involving Patent Rights (2014 – 2023): Settlements



Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

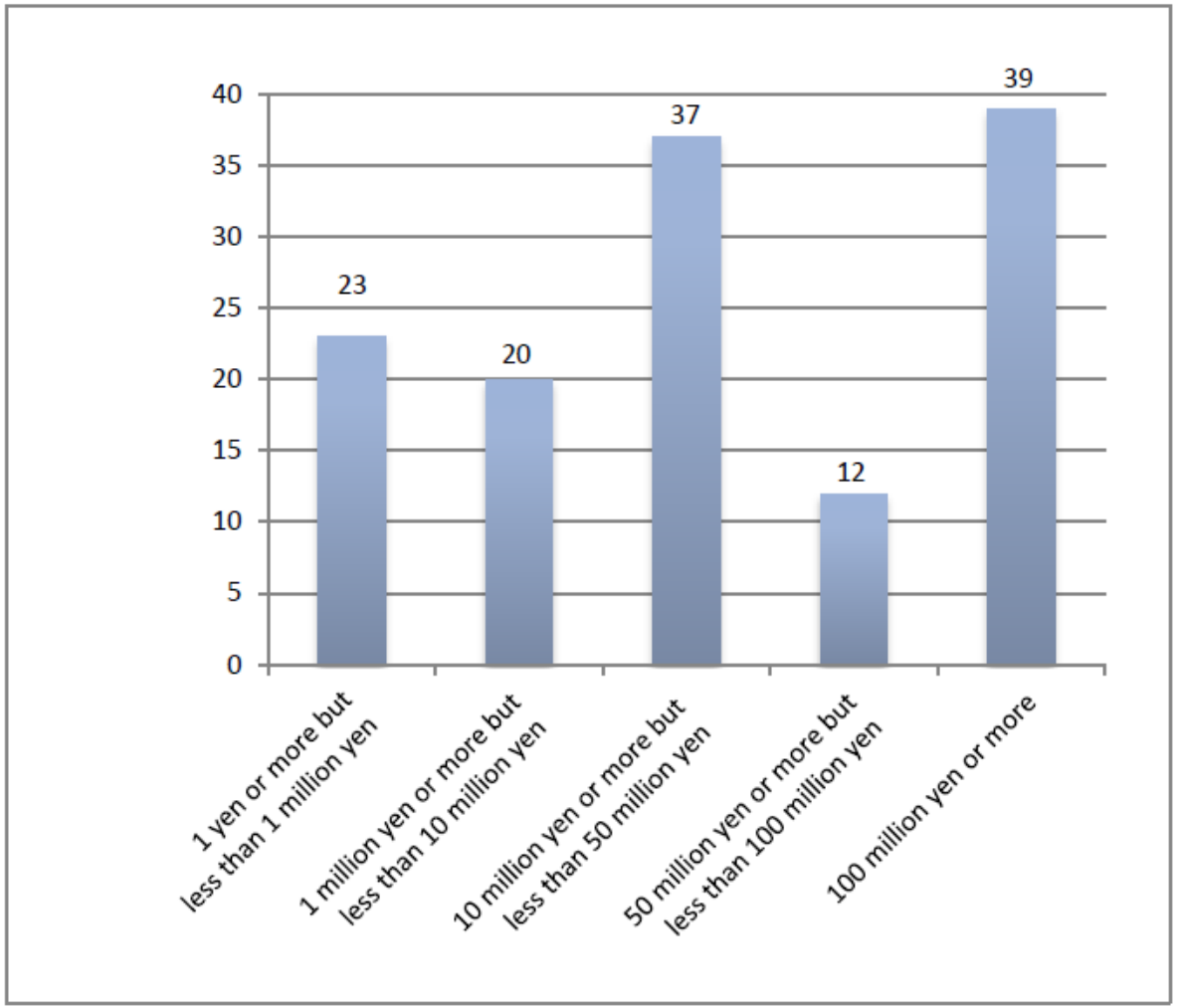
Lawsuits Involving Patent Rights (2014 – 2023)



Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

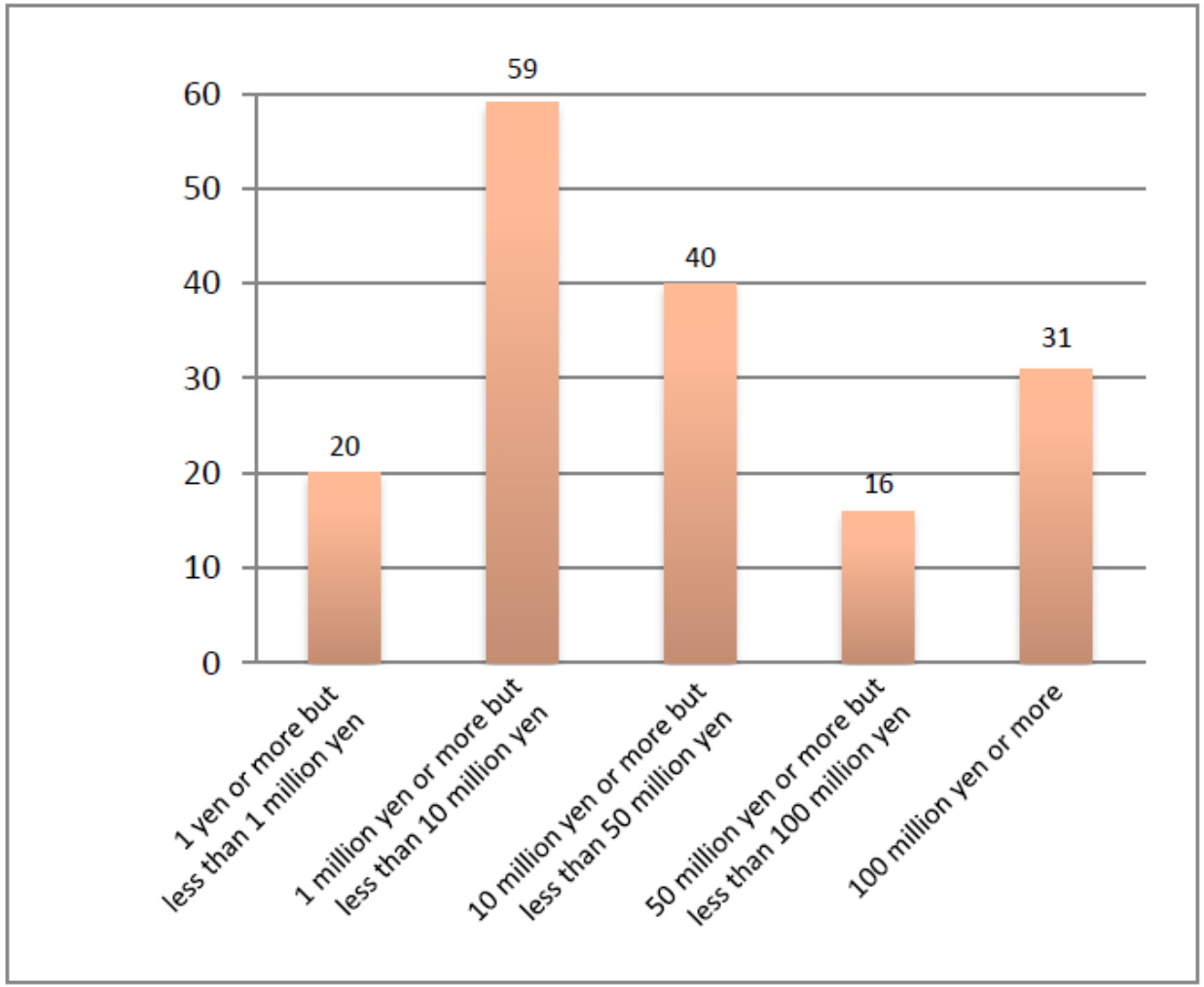
Judgment Damages (2014 – 2023)



Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

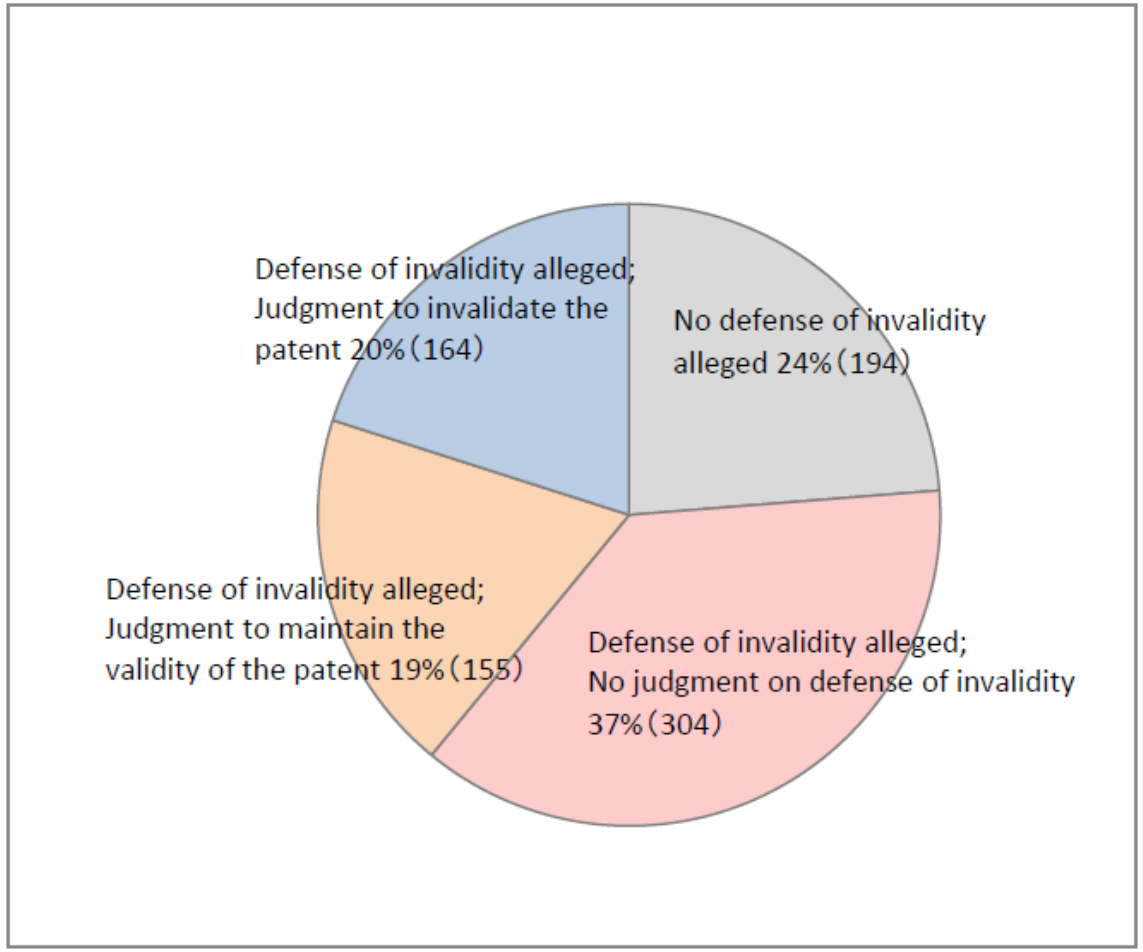
Settlement Amounts (2014 – 2023)



Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

Infringement Lawsuits: the Invalidity Defense (2014 – 2023)



Note: Each patent for which invalidity was raised is counted above. For instance, if a defendant in an infringement lawsuit argued that 3 patents allegedly infringed were invalid, this would be counted as 3 instances above.

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1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
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Infringement Lawsuits: Invalidity Defense Compared to Oppositions/Nullity Actions

How successful is the invalidity defense compared to Oppositions and Nullity Actions?

- Where validity is addressed in the judgment, the defense succeeds approximately 50% of the time.
- It must be kept in mind that most settlements are thought to be plaintiff friendly (i.e., the parties seemingly agree the patent in question is likely valid). Accordingly, it cannot definitively be said that waiting to file an invalidation defense is better or worse than filing a nullity action initially from the perspective of obtaining a favorable outcome.
- In practice, infringement lawsuit defendants who wish to raise an invalidity argument often file a nullity action before the JPO in parallel with raising the invalidity defense in District Court.

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1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

Option for possible infringers: Take No Initial Action?

- Wait and see if patent holder files infringement lawsuit.
- If lawsuit gets filed, assert invalidity of the patent as a defense.
- Successful Defense does not invalidate the patent but precludes patentee from enforcing their patent right against defendant.
- Nullity Action can be filed in parallel with the ongoing lawsuit to invalidate patent.

Part 2 - Post Grant Procedures

1. Invalidation of Patents - Opposition, Nullity Action, and Assertion at Infringement Courts
2. **Patent Infringement Lawsuit**

Option for possible infringers: File a lawsuit for declaratory judgment following a warning letter

- If a possible infringer takes no initial action to invalidate a patent, the patentee may send a warning letter threatening an infringement lawsuit.
- In order to file a lawsuit for declaratory judgment of non-infringement, there must be an actual controversy. A warning letter merely suggesting that a subject product might fall within the scope of a patent, but not demonstrating interest in proceeding with enforcement, is not an existing dispute sufficient to justify the filing of a declaratory judgment action. Takai v. Yanagiya Machinery Co.,Ltd., (October, 2014)
- A declaratory judgment lawsuit is heard before a District Court, and is not mutually exclusive with an infringement lawsuit. If both are filed, both would likely be tried together.

Thank you!

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