

# Overview of Trial for Invalidation and Opposition Systems in Japan

March 2017  
Trial and Appeal Department  
Japan Patent Office

## ◆ Reviewing the examination

- > 1. Resolve the appeal from applicants  
(appeal against an examiner's decision of refusal)
- > 2. Improve the reliability of rights  
(**opposition to grant of patent**)

## ◆ Facilitating the dispute resolution

- > 1. Determine the validity of rights  
(**trial for invalidation**)
- > 2. Correction of patent claims, etc.  
(trial for correction)
- > 3. Expert opinion of scope of rights  
(Hantei)

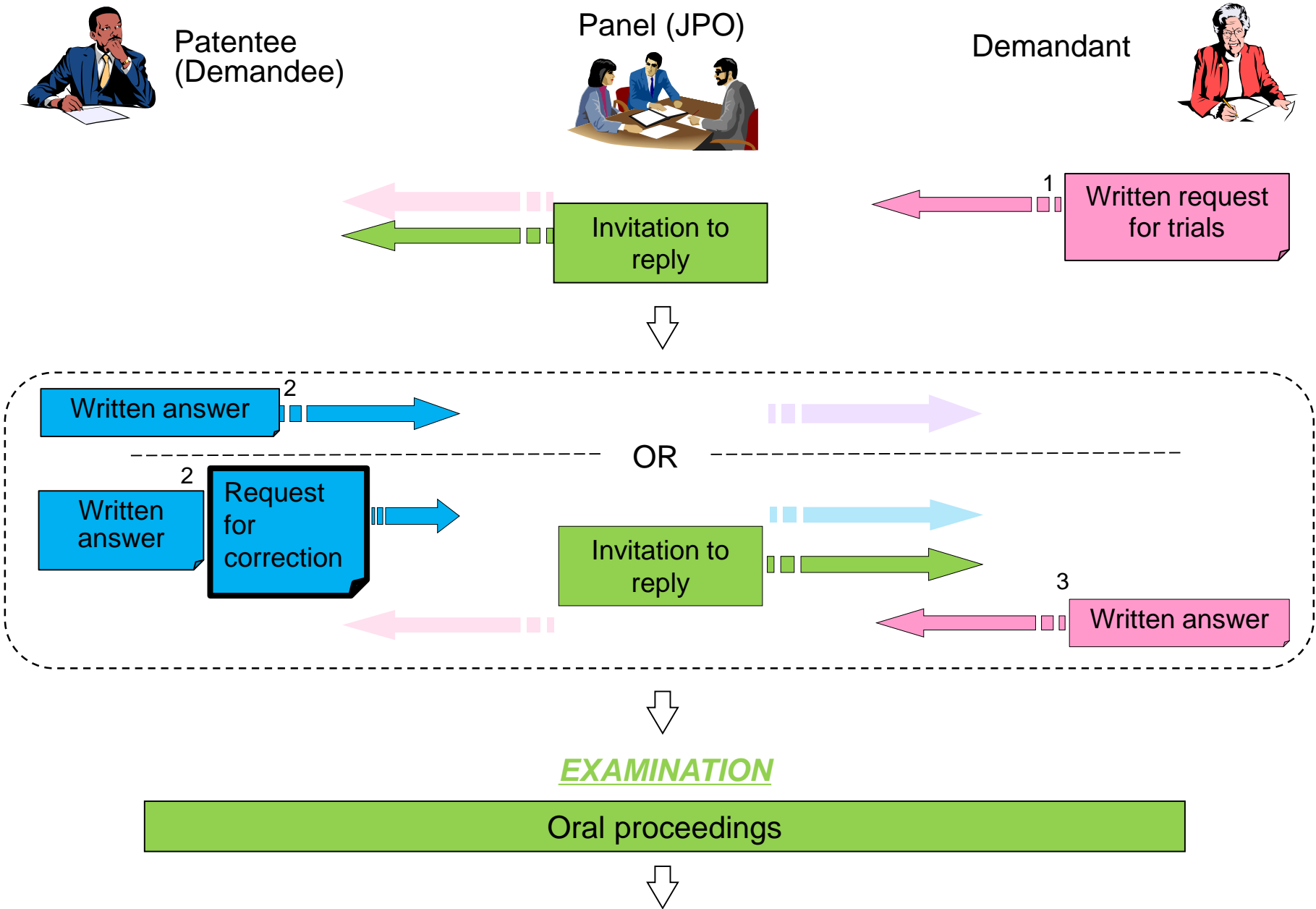
@ Trial and Appeal Department  
of the JPO

- ✓ **Trial for Invalidation**
- ✓ **Opposition to Grant  
of Patent**

@ Patent Trial and Appeal Board  
of the USPTO

- ✓ **Inter Partes Review**
- ✓ **Post-Grant Review**

# A Flow of a Trial for Patent Invalidation



# A Flow of a Trial for Patent Invalidation (cont.)



Patentee  
(Demandee)

Panel (JPO)

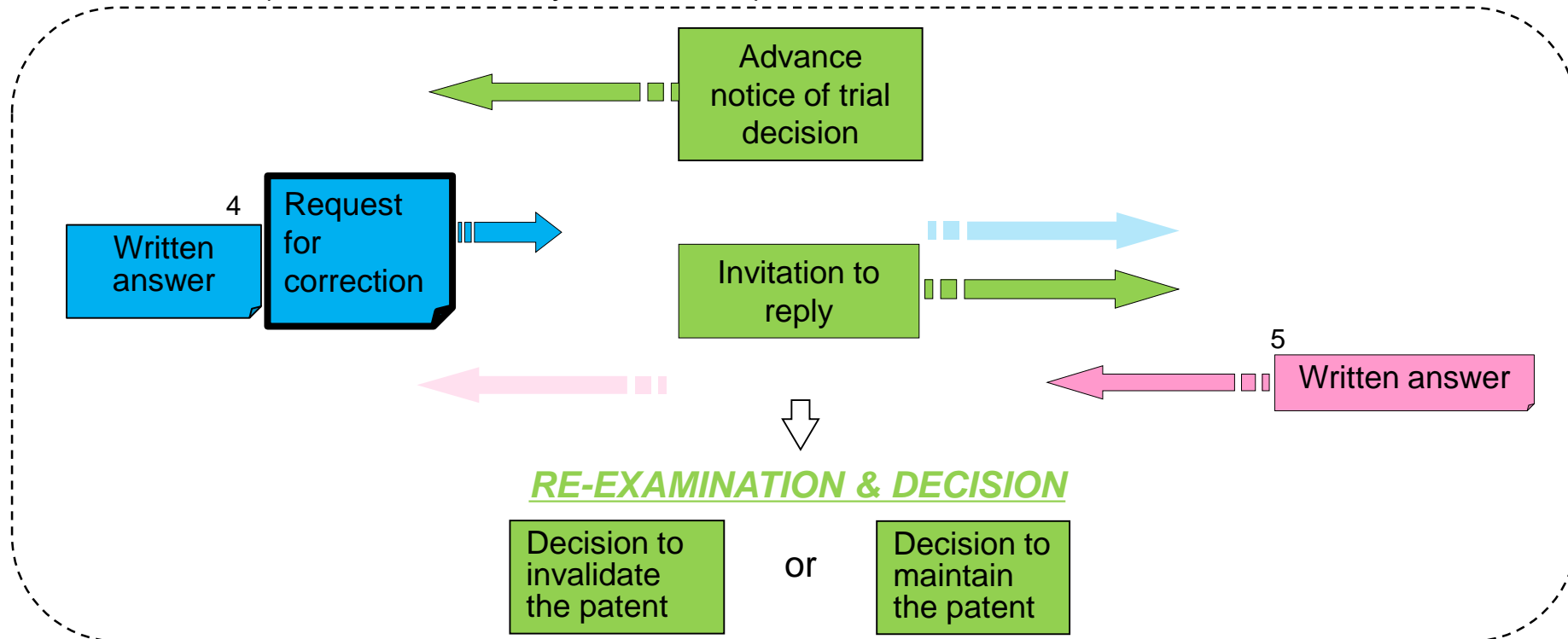


Demandant



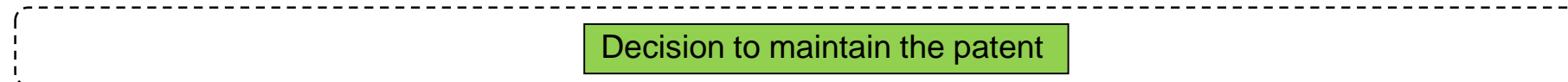
DECISION

OPTION A (in case to be likely invalidated)

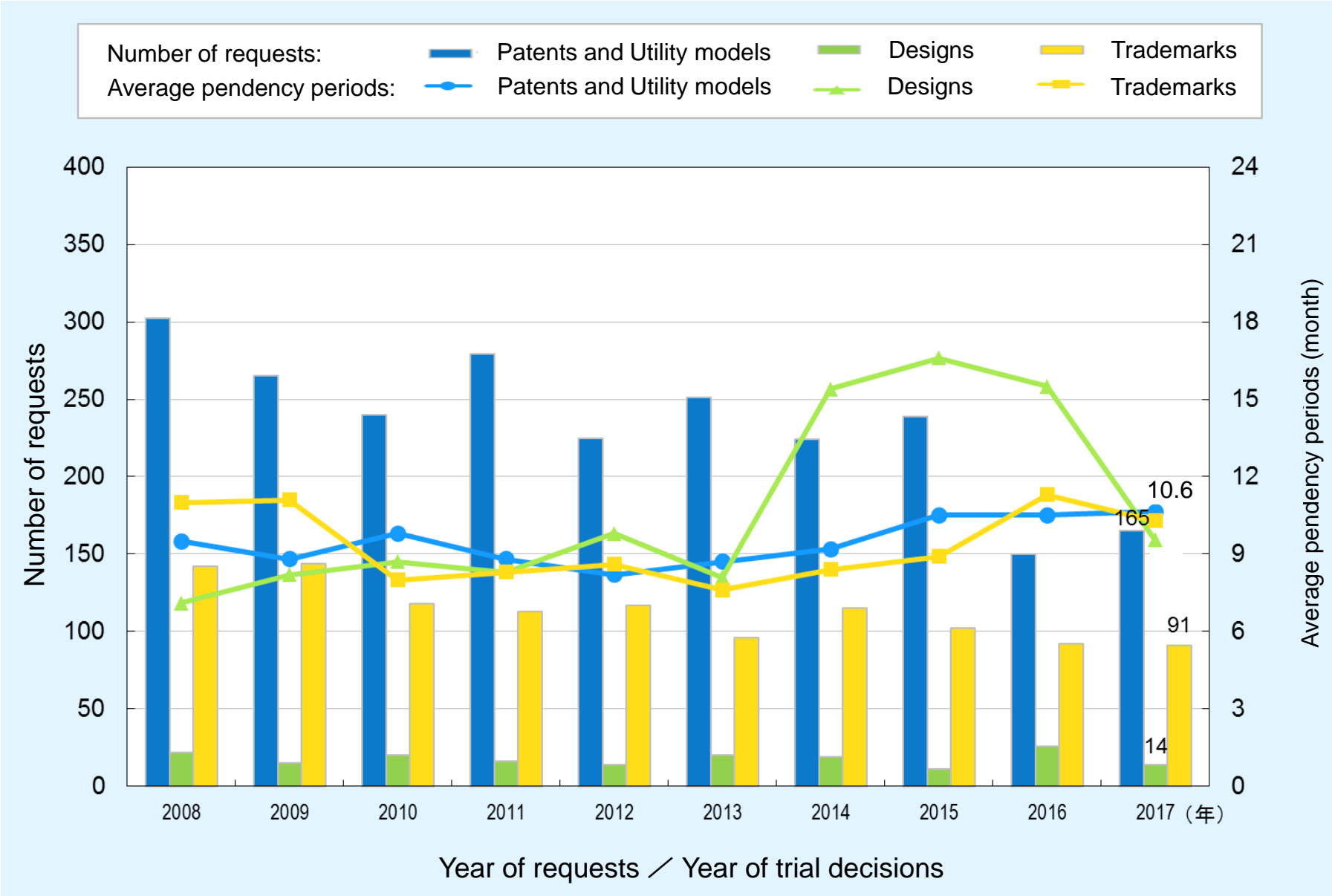


OPTION B (in case to be maintained)

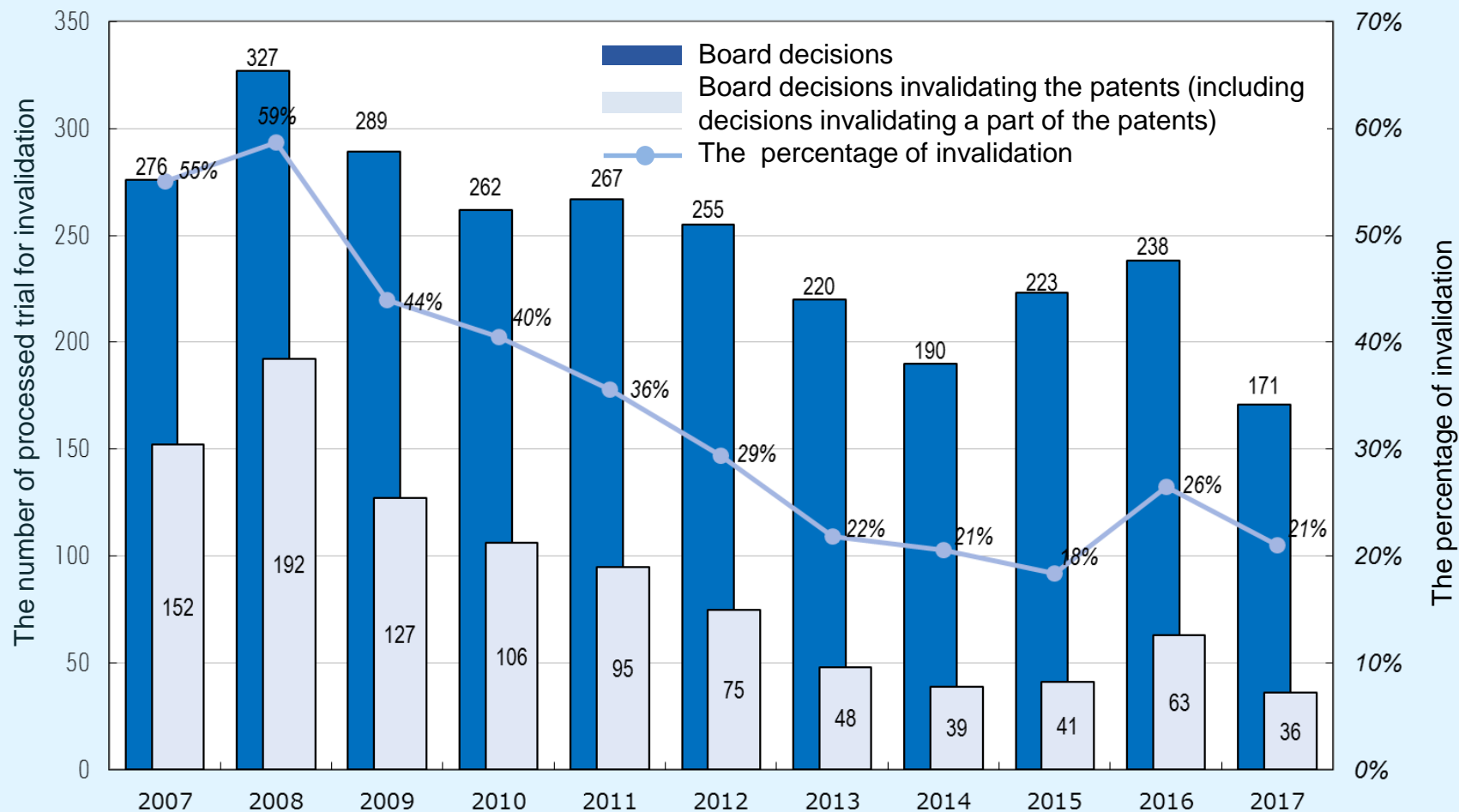
OR



# Trial for Invalidation – the Number of Requests and Pendency Periods



# Figures on results of Trial for Patent Invalidation



Note: the percentage of invalidation = the percentage of board decisions invalidating the patents (including decisions invalidating a part of the patents) / a total number of requests for invalidation trial processed (prepared by the JPO)

# Comparison between Trial for Patent Invalidation and IPR

	Trial for Patent Invalidation	IPR
<b>Person(s) eligible</b>	Interested person	Any persons
<b>Grounds</b>	<ol style="list-style-type: none"> <li>1. Grounds of public interest (novelty, inventive step, new matter, description requirement, etc. )</li> <li>2. Inventorship</li> <li>3. Invalidation Reasons occurring after the grant of patent</li> </ol>	Novelty and non-obviousness on the basis of prior art consisting of patents and printed publications
<b>Period of time to file</b>	Any time after the registration of patent	9 months after the grant of patent or the termination of PGR, whichever later
<b>Examined by</b>	Panel of Administrative Judges (Trial and Appeal Department of JPO)	Panel of Administrative Judges (PTAB of USPTO)
<b>Examination Procedures</b>	Inter Partes Oral proceedings	Inter Partes Oral proceedings
<b>Amendment (correction) of Patent</b>	Twice in principle Not allowed to enlarge/change scope of claims or introduce new matter	Once in principle Not allowed to enlarge scope of claims or introduce new matter
<b>Appeals</b>	Demandant or patentee may appeal to the IP High Court	Petitioner or patentee may appeal to the CAFC

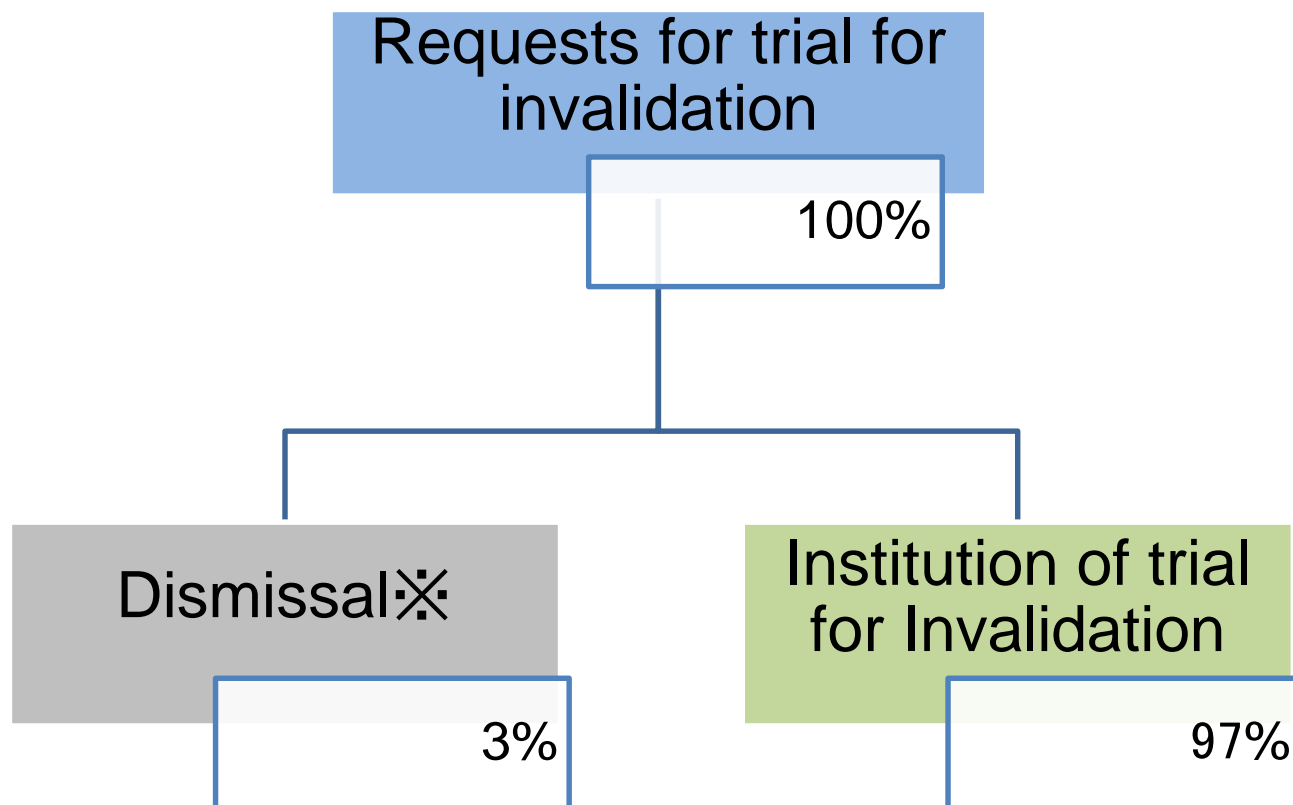


## Distinctive Features of Trial for Patent Invalidation (in contrast with IPR).

- ✓ All cases be subject to substantial examination at the JPO
- ✓ Opportunity to request for correction / amendment
- ✓ Claim construction at the JPO be the same as at the Courts

# Comparison between Trial for Patent Invalidation and IPR

- Proceeding at trial for patent invalidation is instituted without evaluation of the information described in request.



Average pendency period for Trial for Patent Invalidation :  
**10.6 months**

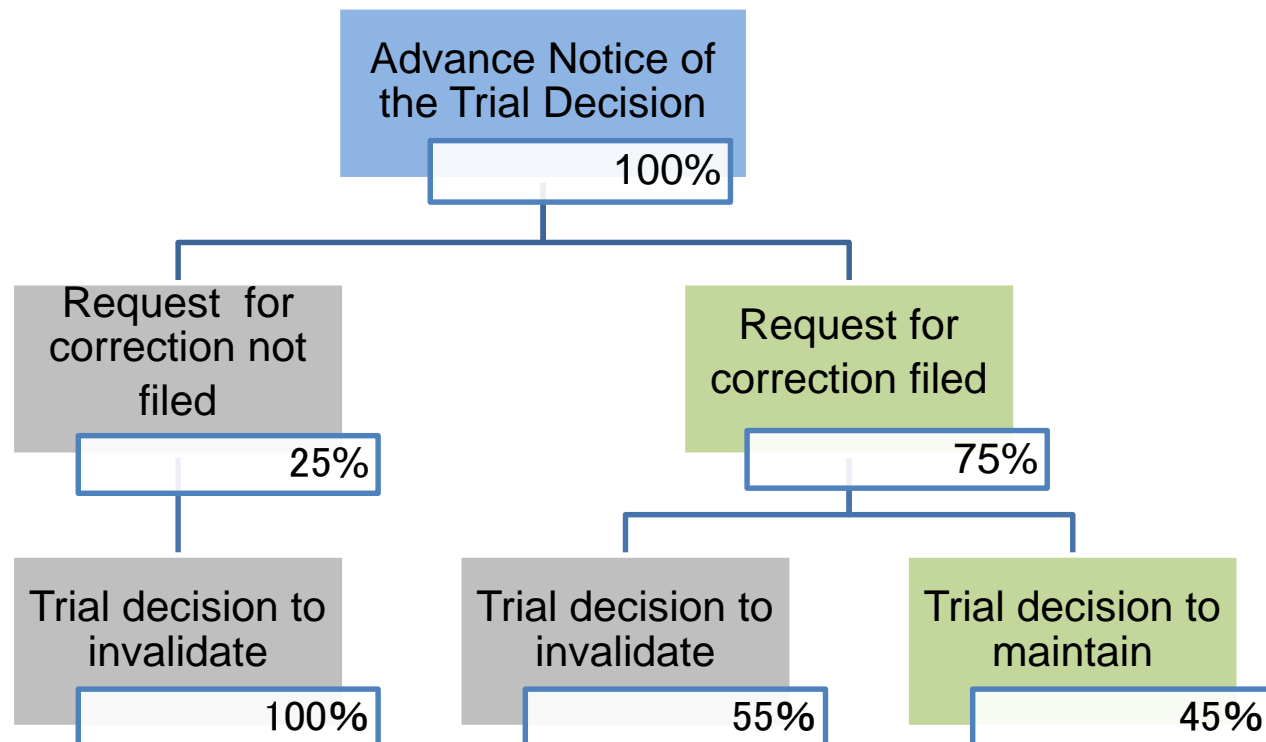
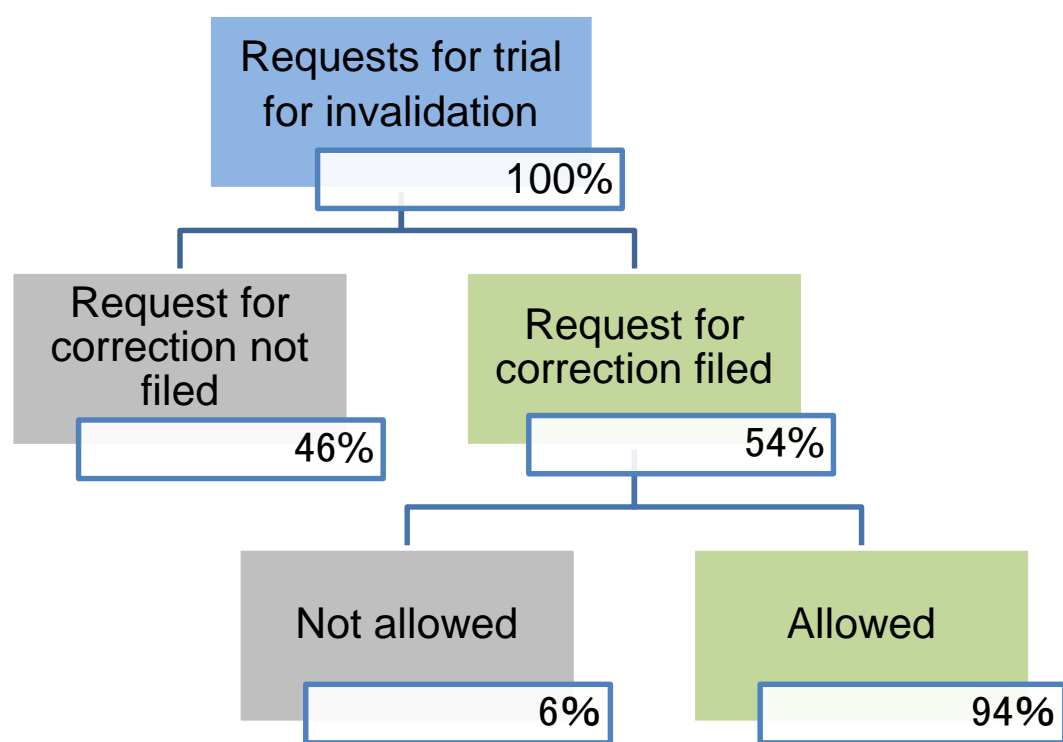
(note) A survey was conducted on cases of which certified copies of the trial decisions were served between January 2015 and December 2017 (excluding the cases of which the requests were filed before April 2012).

※ A request may be dismissed only if there are excessive deficiencies in the written request.

# Comparison between Trial for Patent Invalidation and IPR

- The patentee shall have an opportunity to file a request for correction *twice* during the trial proceedings so as to maintain the patent.

- ✓ When request for trial for invalidation is made
- ✓ When advance notice of trial decision is received



(note) A survey was conducted in the same time period as the survey in the previous page.

## Claim construction by Courts and the Patent Office.

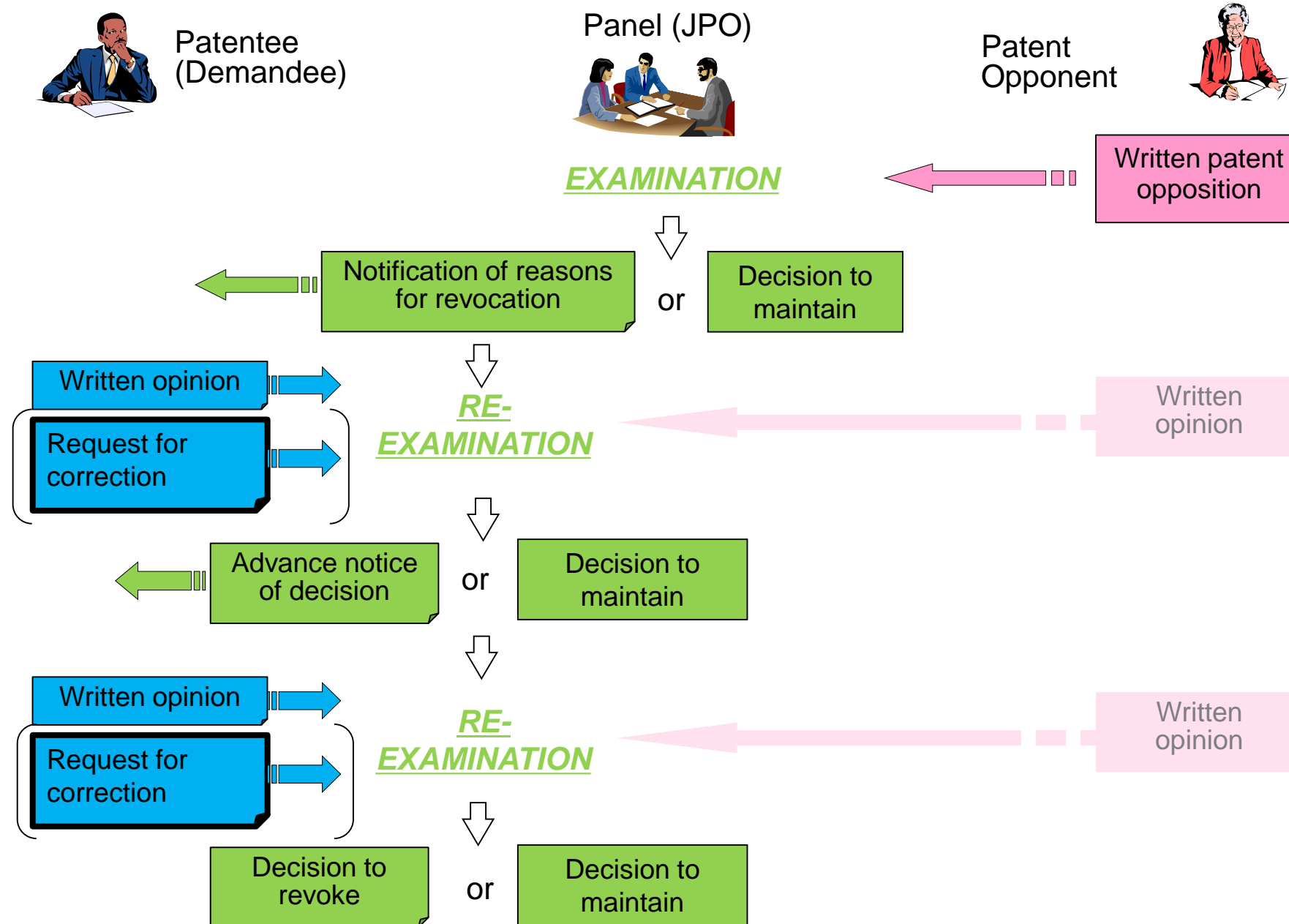
✓ @US “BRI (broadest reasonable interpretation)” standard in IPR  
versus

“The plain meaning” standard in the court proceedings

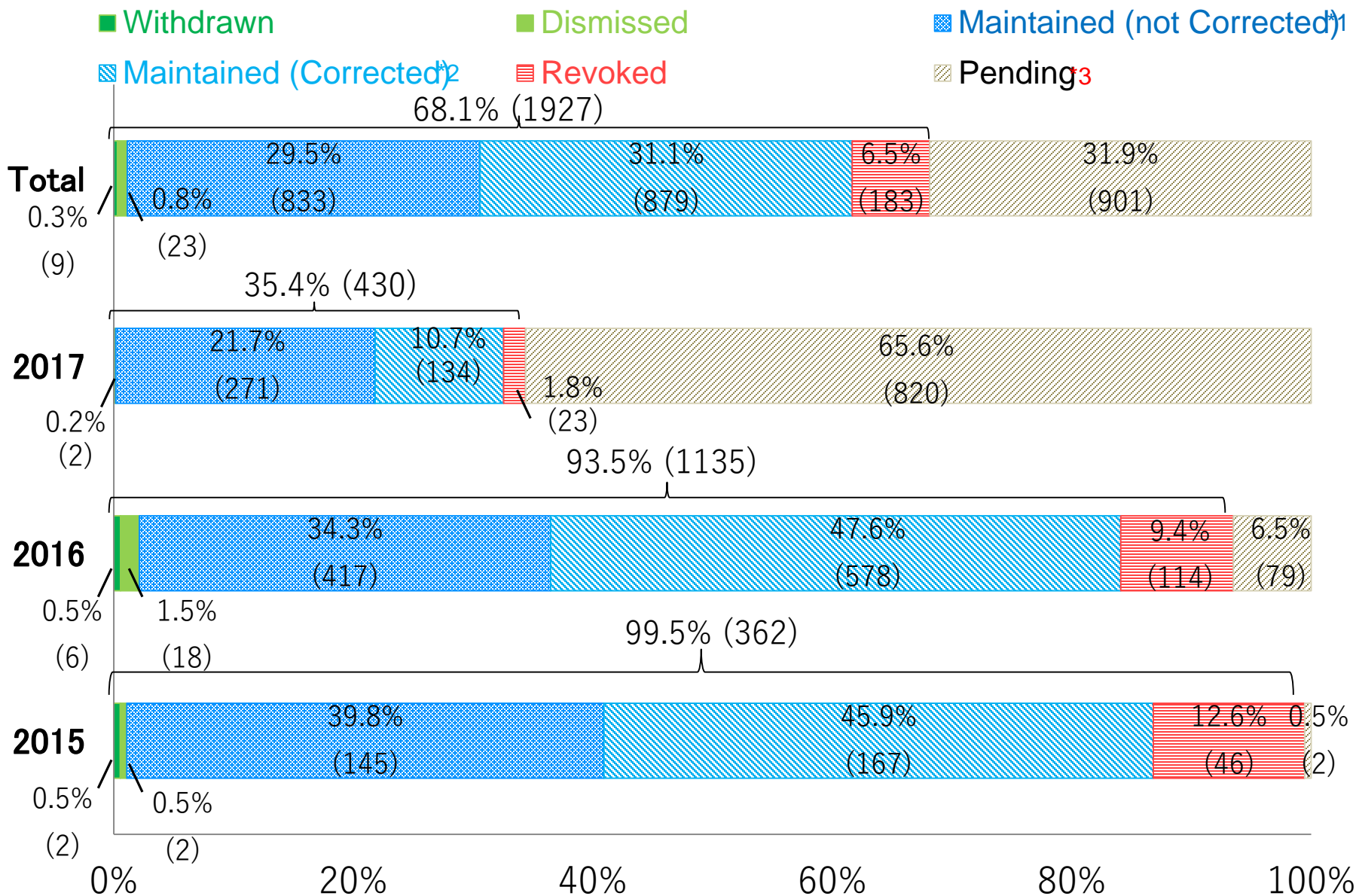
✓ @JP “The examiner takes the description, drawings and the common general knowledge at the time of filing into consideration in interpreting the meanings of words in the claims.”

(Examination Guidelines for Patent and Utility Model in Japan 3-1-1)

# A Flow of Opposition to Grant of Patent



# Number of Decisions for Opposition by Year (as of December, 2017)



\*1 Maintained opposed claims without correction

\*2 Maintained opposed claims with correction

\*3 Revoked all or part of opposed claims

# Comparison between Opposition to Grant of Patent and PGR

	Opposition to Grant of Patent	PGR
<b>Person(s) eligible</b>	Any persons	Any persons
<b>Grounds</b>	Novelty, inventive step, new matter, description requirement, etc. (Grounds of public interest)	Novelty, non-obviousness, description requirement (exclude best mode requirement)
<b>Period of time to file</b>	Within 6 months from the publication of the Gazette of patent	Within 9 months from the grant of patent or the issuance of reissue patent
<b>Examined by</b>	Panel of Administrative Judges (Trial and Appeal Department of JPO)	Panel of Administrative Judges (PTAB of USPTO)
<b>Examination Procedures</b>	Ex Parte Documentary proceedings	Inter Partes Oral proceedings
<b>Amendment (correction) of Patent</b>	Twice in principle Not allowed to enlarge/change scope of claims or introduce new matter	Once in principle Not allowed to enlarge of scope of claims or introduce new matter
<b>Appeals</b>	Patentee may appeal a “Decision to Revoke” to the IP High Court (Opponent may not appeal)	Petitioner or patentee may appeal to the CAFC







Europäisches  
Patentamt  
European  
Patent Office  
Office européen  
des brevets



# EPO appeal proceedings

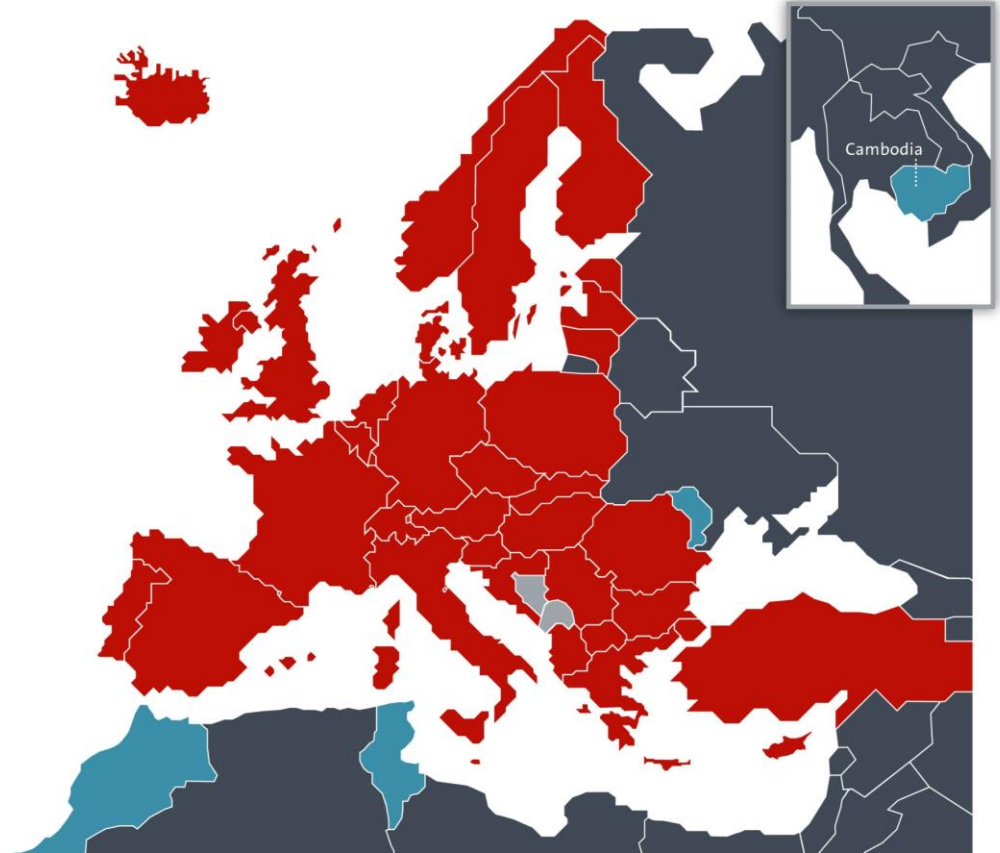
PTAB Bar Association Conference, Washington, 21 – 23 March 2018



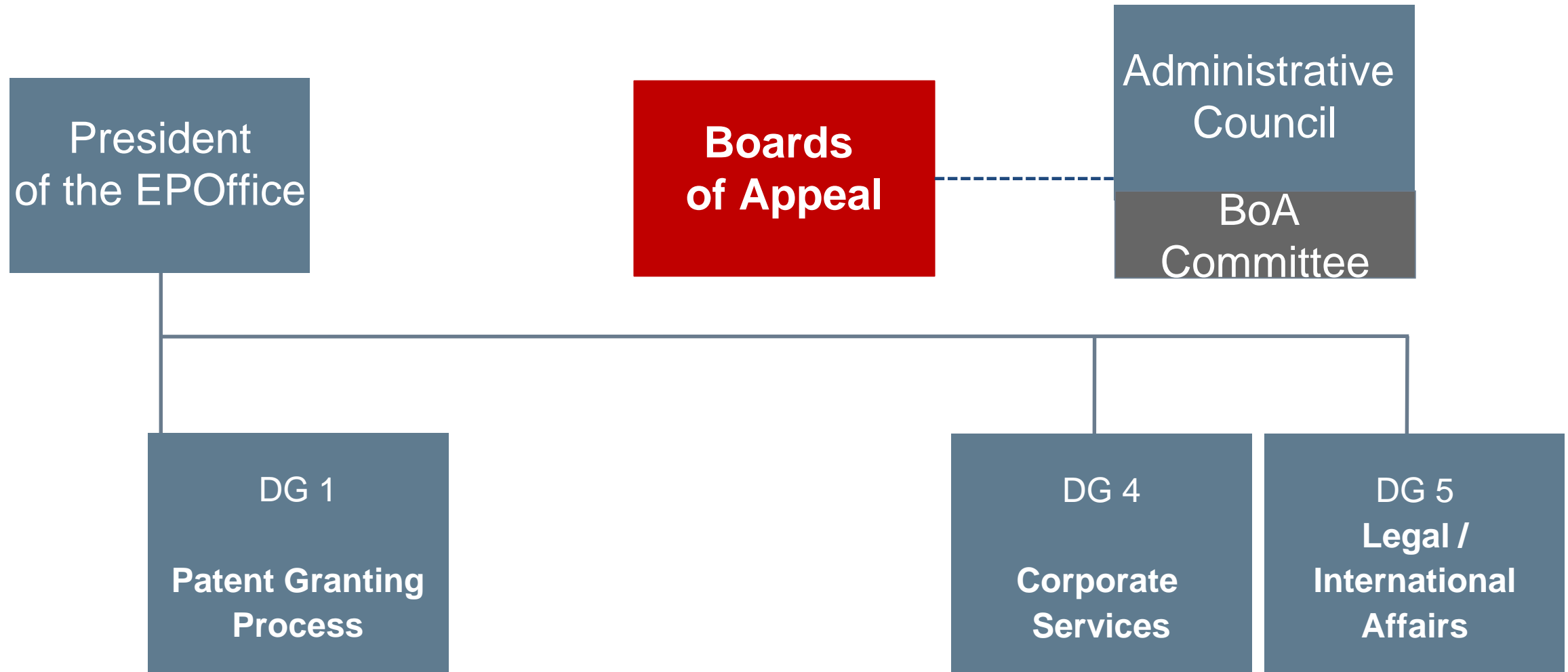
Boards  
of Appeal

## The EPO grants patent protection:

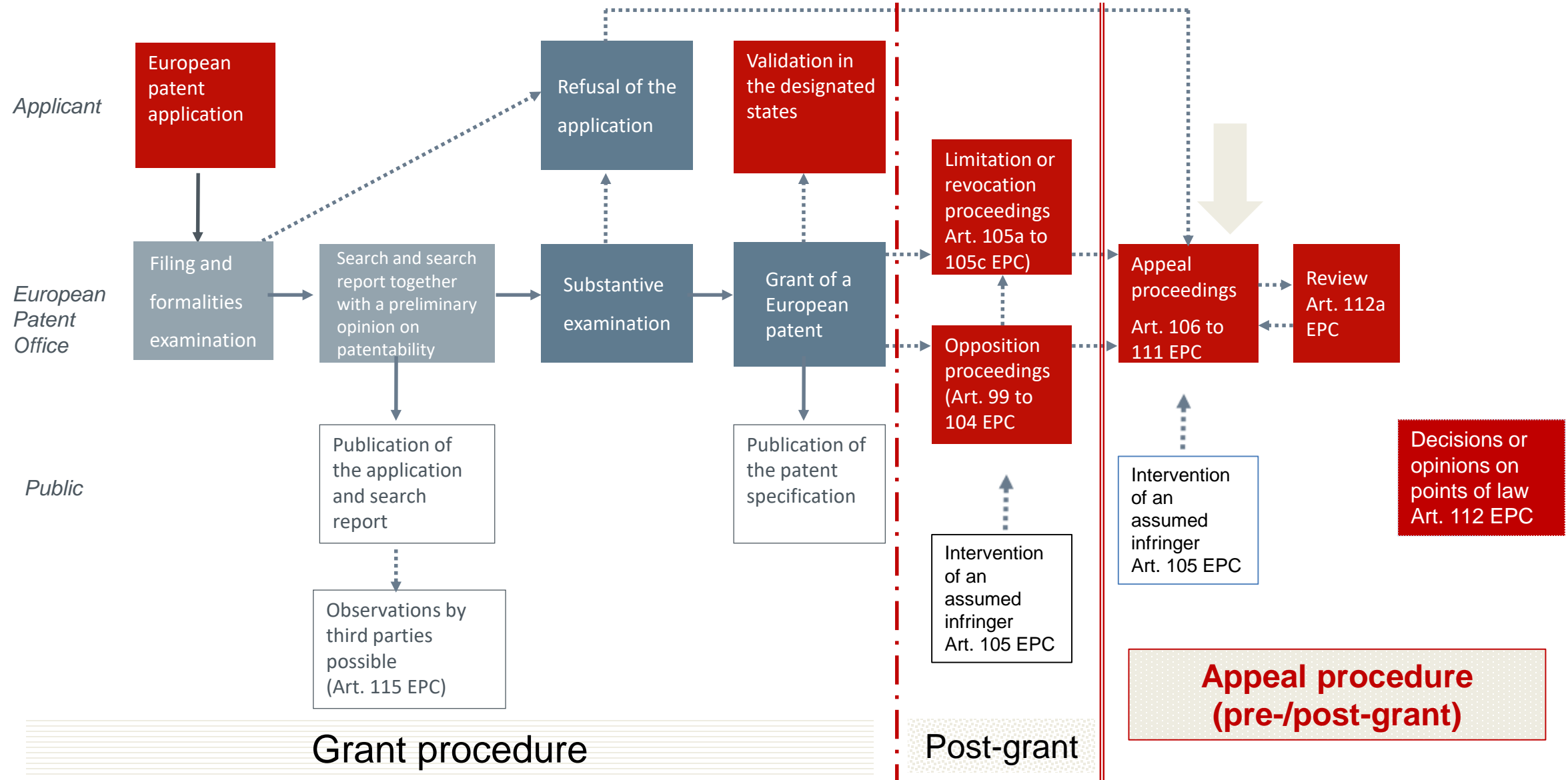
- for up to 38 EPC contracting states  
two extension and four validation  
states (as at 1 Dec 2017)
- based on a single application
- in one of the three official languages  
(English, French, German)

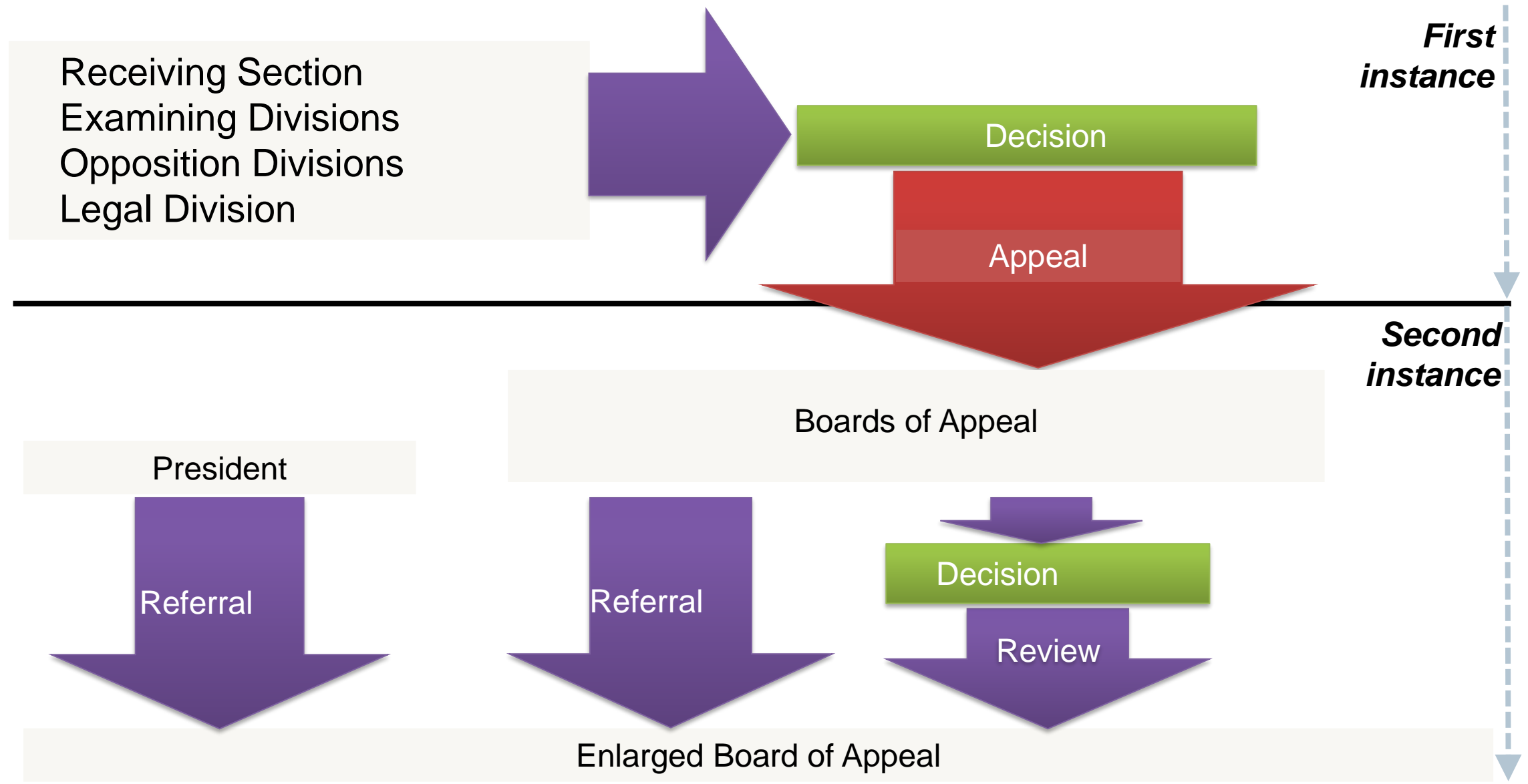


# Boards of Appeal within the EPOrg



# Overview of procedures before the EPO

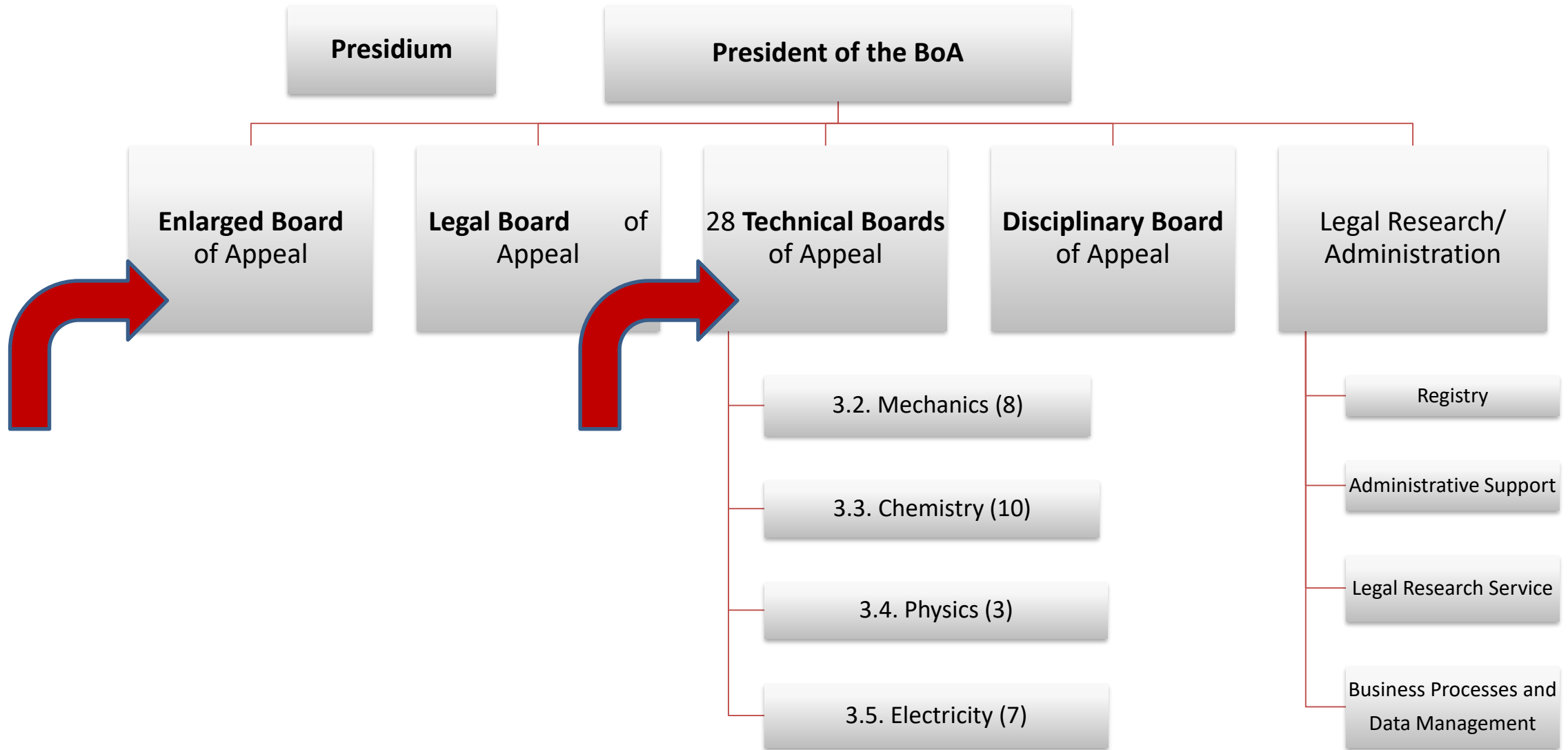




# Judicial function of the Boards of Appeal

- EPO first-instance decisions appealable only before the boards (with suspensive effect)
- Members enjoy judicial independence
  - appointed by **Administrative Council** (Art. 11(3) EPC), for five-year term – re-appointable (Art. 23(1) EPC)
  - "In their decisions the members of the Boards **shall not be bound by any instructions** and shall comply only with the provisions of this Convention." (Art. 23(3) EPC)
- Substantive review of decision based on **request(s)** of appellant(s)
- Boards' decisions are **final**, except that:
  - Very exceptionally (fundamental procedural defect), **review** by Enlarged Board (Art. 112a EPC)
  - Validity of granted/maintained EP patents can be **challenged** before competent **national courts**

# Organisational diagram of the Boards of Appeal



# Technical Boards of Appeal (Art. 21(1), (3)(a), (b), (4) EPC)

- Appeals against decisions of **examining** and **opposition divisions**
- Composition: 2 technically qualified members and 1 legally qualified members
- Board may be enlarged by 1 technically and 1 legally qualified member
- Workload 2017:

per Board (organisational unit): average 83 cases settled (T ../..)



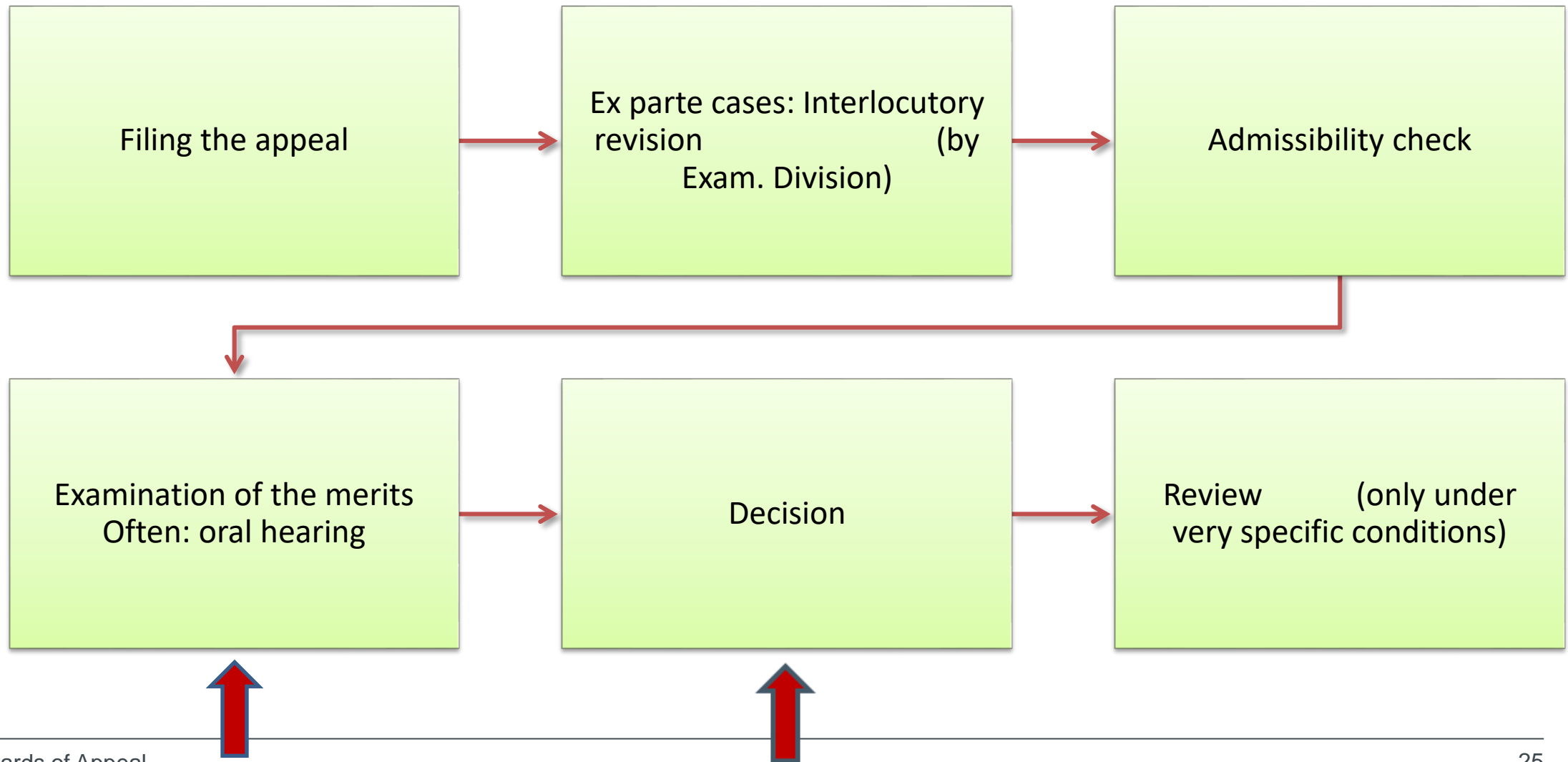
# Enlarged Board of Appeal (Art. 22 EPC)

- **Referral for decision or opinion (Art. 112 EPC)**
  - uniform application of law
  - clarification of point of law of fundamental importance
- **Composition (Art. 5 BDS/EBA):**
  - 5 legally qualified and 2 technically qualified members (optional: 1 or 2 legally qualified external members replacing internal legally qualified members)
- **Mechanism**
  - referral of a point of law by a **board** (→ for decision) of its own motion or following request of a party
  - referral by **EPO President** (→ for opinion) where two boards have given different decisions

2017: two decisions (G 1/15, G/16), no new referrals

(Full list of decisions and opinions <http://www.epo.org/law-practice/case-law-appeals/eba/number.html>)

# Main steps of the appeal proceedings



## Examination of appeal (1)

- Primarily **review of impugned decision**, not re-opening of examination
  - limits imposed by Art. 12(4) RPBA
- Party disposition v. examination of own motion (Art. 114(1) EPC)
- Late submissions
  - at board's **discretion** (Art. 114(2) EPC, Art. 13 RPBA)
  - more discretion than at first instance, but **“convergent”** approach

## Examination of appeal (2)

- **Ex parte proceedings (examination appeals):**
  - board has power to examine whether application meets **EPC requirements** (G 10/93)
  - **new issues** may be examined
  - **withdrawal** of appeal terminates appeal proceedings
- **Inter partes proceedings (opposition appeals):**
  - appellant's **requests** determine board's power to decide (G 9/91 and G 10/91)
  - **new grounds** of opposition only with **patentee's consent**
  - **withdrawal** of **only** appeal/**all** appeals terminates appeal proceedings

# Written proceedings and oral proceedings

- **Role of rapporteur** (Art. 5 RPBA)
- **Written communications to the parties**
  - communications as often as necessary (R. 100(2) EPC)
  - communication helping **concentration on essentials** during oral proceedings (Art. 15(1) RPBA)
- **Oral proceedings** (Art. 116 EPC, Art. 15 RPBA)
  - at **request of party** or at instance of board
  - **public**, provided application has been published

# Decision on the appeal (Art. 111, R. 101-103, 111(1) EPC, Art. 15(6) RPBA)

- Decision usually announced **orally** at end of oral proceedings (exceptionally, proceedings may be continued in writing)
- **Written reasoned decision** issued later, generally within three months
- If **remittal**, first-instance department bound by board decision in so far as facts are the same

## Boards of Appeal – overall figures

- In **2017**
  - 2 851 appeals received
  - 2 324 appeals settled (i.e. decided by the boards or otherwise terminated)
  - 1 168 oral proceedings
- Boards of Appeal **staff** at 01.01.2018:
  - 27 chairmen and 121 members of the boards of appeal, forming 28 technical boards, the Legal Board and the Enlarged Board of Appeal
  - 205 staff in total

# Revision of the Rules of Procedure (1)

## Aims:

- **Harmonisation** of approach of case law and RPBA  
by **codifying and further streamlining** “best practice”,  
in particular by providing for **more consistent exercise of discretion**,  
thus **increasing predictability** for parties.
- **Improved efficiency** of the appeal procedure as a whole  
in particular **for rapporteur and board (active case management)**,  
by tightening up procedure and facilitating exercise of discretion,  
in order to continuously reduce the number of backlog cases so as to bring  
about steady reduction of backlog and pendency times.



## Revision of the Rules of Procedure (2)

- Improved procedural guidance for parties
  - by transparent and predictable structure of proceedings,
  - by increasing parties' responsibility for procedural economy,
- while
  - respecting parties' fundamental right to fair proceedings,
  - recognising parties' general interest in having
  - appeal case dealt with and decided in a timely manner,
  - maintaining quality of boards' decisions.

## Revision of the Rules of Procedure (3)

### User consultation on the revision of the Rules of Procedure of the Boards of Appeal

You are kindly invited to comment on the proposed amendments

**by 30 April 2018 at**

**<http://www.epo.org/law-practice/consultation/ongoing.html>.**

All replies received will be considered in due course, and it is intended that a further draft will be issued in good time before the user conference planned for late autumn 2018.



**Thank you very much for your attention!**

- Internet: <http://www.epo.org/law-practice/case-law-appeals.html>
- Case Law of the Boards of Appeal of the EPO, 8th edition 2016
- OJ EPO Supplementary publications:  
 “Information from the Boards of Appeal”, “Annual Report of the Boards of Appeal”  
 “EPO Board of Appeal Case Law”, “Case Law from the Contracting States to the EPC”