

Revision of Patent Law in 2015

The Patent Law revision in 2015 introduces [1] Enlargement of Remedies, and [2] post-grant opposition system. The Patent Law will be in force on April 1, 2015. The details of the revision are as follows.

[1] Enlargement of Remedies

(1) Remedy for Elapse of Time Limit for Predetermined Procedures

When a time limit for a certain procedure elapses due to an accident (e.g. natural disaster) not attributable to a party in charge, the procedure can still be done within a predetermined period ((i) within fourteen days (two months for residents abroad) from the date when the cause of the accident is eliminated, and (ii) within six months after the time limit elapses).

The procedures to which the remedy is applicable are:

- (a) submission of proof document when requesting exceptions to lack of novelty (§30(4)),
- (b) submission of priority certificate for claiming priority under Paris convention (§43(6)),
- (c) filing a divisional application (§44(7)),
- (d) conversion of utility model/design registration application to patent application (§46(5)),
- (e) patent application based on registered utility model (§46-2(3)),
- (f) submission of documents for extension of registration term of patent right (§67-2-2(4)),
- (g) payment of registration fee (§108(4)),
- (h) request for refund of registration fee having been paid (§111(3)), and
- (i) request for refund of examination fee etc. (§195(13)).

(2) Remedy for Failure in Claiming Priority

When a patent application claiming a domestic priority and/or Paris Convention priority could not be filed within a priority period (one year from the filing date of a prior application) and there is a due reason for not claiming the priority (e.g. "due care has been paid"), the priority can be claimed within a predetermined period (§41(1)(i), 43-2(1) etc.).

The document for claiming a priority can be filed within a predetermined period (i.e. not simultaneously with filing a patent application, as in the previous provision). Claiming of priority can be amended within a predetermined period (§17-4, 41(4), 43(1)).

(3) Remedy for Elapse of Request for Substantive Examination

If there is a reasonable ground for an elapse of a request for substantive examination period, a request for the substantive examination can still be made within a predetermined period ((i) within two months from the date when the cause of the failure is eliminated, and (ii) within one year after the time limit elapses) (§48-3(5)).



[2] Introduction of Post-Grant Opposition System

See the annexed flowchart for the specific procedures in the Post-Grant Opposition System.

Anyone can file a petition for post-grant opposition (referred to simply as "opposition" hereinafter) to a patent within six months from the patent publication date (§113, main paragraph). For your information an anonymous petition is impermissible. It should be noted that the invalidation trial can be filed only by an interested party (i.e. not by anyone as previously stipulated) (§123(2)).

The grounds of opposition are substantially the same as the reasons for rejection during examination procedure, except that formality issues and issues related to attribution of right are not included (§113 (i), (ii), (iii), (iv), (v)).

The opposition can be filed for each of claims (§113, main paragraph). The opposition is examined on a document basis (§118(1)).

When a plurality of oppositions are filed, these oppositions proceedings are, in principle, jointly conducted (§120-3(1)).

The grounds not mentioned by the opponent can be examined in ex officio examination (for only the claim(s) to which the opposition is filed) (§120-2).

If no ground for revocation is found as a result of examination, decision to maintain the patent will be made (§114(4)). Under such a circumstance, no action is necessary for the patentee.

Meanwhile, if a ground for revocation is found, notification of reasons for revocation will be issued. In response, the patentee can file a written opinion and/or demand for correction (§120-5(1), (2)).

If a demand for correction is filed, in principle, an opportunity for filing a written opinion is given to the opponent (§120-5(5)).

As a result of final judgment, if a reason for revocation is found, decision to revoke the patent will be made (§114(2)). On the other hand, if no reason for revocation is found, decision to maintain the patent will be made (§114(4)).



Procedures in Post-Grant Patent Opposition System

