

## **IX. Invalidation Action before Patent Office**

### **1. Invalidation Action before Patent Office**

Before the amendment of Patent Law in 2003, there were two systems to challenge validity of a patent. One is a post-grant opposition which may be filed by anyone within 6 months after publication of the patent and the other is an invalidation action which may be filed only by a person who has an interest in challenging validity at any time even after expiration of the patent. Effective as of January 1, 2004, the post-grant opposition was abolished and consolidated to the invalidation action. The new invalidation action may be filed by anyone even anonymously, except for cases which reason of invalidation is illegal filing of patent application by one who does not have a right to the invention. Such exceptional actions may be filed only by one who has an interest in the case.

In the procedure of invalidation action, after a request of invalidation of patent is filed with Patent Office, it is served upon the patentee and the patentee's response is due in 60 days in case of domestic patentee. The patentee's response may accompany filing of a request of amendment. The invalidation action is handled by Patent Office Appeal Board and the Board considers whether the requested amendment is allowable and, if allowed, the amended claims have reason for invalidation. The Board may allow the requester to file a reply brief. An oral hearing may be had before the panel of Board in some cases and in other cases the proceeding may be concluded without hearing.

An invalidation action is often filed in parallel with a patent infringement action in the court. The defendant may raise a defense of patent invalidity in the court but may also file an invalidation action before Patent Office. When such parallel infringement action is conducted in the court, Patent Office completes the proceeding of invalidation action rather quickly, in about a half year.

### **2. Revocation Action of Patent Office Decision in Intellectual Property High Court**

A party who received an unfavorable decision by Patent Office may appeal to Intellectual Property High Court by filing a revocation action of Patent Office decision. An appeal period is 30 days from the day of receipt of the Patent Office decision. A

foreign patentee may have additional 90 days. A defendant of this proceeding is the party who received the favorable decision from Patent Office. Patent Office is not a party to the revocation action of Patent Office decision in an invalidation action while the director of Patent Office is the defendant in a revocation action of Patent Office decision in an appeal case from Patent Office examiner's rejection of patent application.

After the notice of appeal is served upon the defendant, the High Court sets a date for the first hearing by which time the plaintiff is requested to file its appeal brief. The appeal brief sets forth responses to each statements in Patent Office decision by admission or denial and reasons for revocation of the Patent Office decision, a summary of reasons why the Patent Office decision should be revoked. Filing of such appeal brief is requested in about a month after the service of notice of appeal. After the filing of plaintiff's appeal brief, the defendant is requested to file its counter-brief setting forth its counter-arguments in response to the plaintiff's reason of revocation of the Patent Office decision. Additional exchange of arguments by filing of further briefs may be conducted. Sometimes, the Court requests both parties to present oral explanation of the case. Then the Court renders its decision. The total time for this proceeding would take about a year.

Concerning an appeal to Supreme Court, see VII. Appeals, 2. Supreme Court.

### **3. Amendment Action before Patent Office**

In the revocation action in Intellectual Property High Court, it is not possible to amend the claims. The High Court reviews the Patent Office decision based on the claim which Patent Office considered. Amendment of the claims are possible only by filing an amendment action before Patent Office within the period of 90 days after filing of the notice of appeal with Intellectual Property High Court. In some cases it would be very clear for the High Court that the amendment will be allowed by Patent Office. In such cases Intellectual Property High Court may make a decision to cancel the Patent Office decision and remand the case to Patent Office. If the High Court does not cancel the Patent Office decision, the proceeding before the High Court and the amendment action proceeding before Patent Office are conducted in parallel. The High Court may wait for Patent Office's decision to allow or not allow the amendment. If Patent Office allowed the amendment, IP High Court reverses the original Patent Office decision which invalidated the patent because the claims are no longer the same. If Patent Office did not

allow the amendment, IP High Court makes a decision based on the original claim.