



# **Post-Grant Review in Japan**

**Discover IP JAPAN 2018**

**Houston, January 30, 2018**

**Toshifumi Onuki**

**International Activities Center**

**Japan Patent Attorneys Association**

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**Partner**

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# **Post-Grant Review in Japan**

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**San Diego, February 1, 2018**

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**International Activities Center**

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**Partner**

**Knobbe Martens**

# **Post-Grant Review in Japan**

- **Three Tools for PGR in Japan**

- **Comparison of PGR – JP vs US**

- **How to Use PGR Tools**

- **Summary**

# Three Tools for PGR in Japan

➤ **Type of PGRs**

➤ **History of PGRs**

➤ **Proceedings of PGRs**

➤ **Comparison of Three PGRs**

# Three Tools for PGR in Japan

## ➤ Type of PGRs

➤ History of PGRs

➤ Proceedings of PGRs

➤ Comparison of Three PGRs

# Three Tools for PGR

## - Type of PGRs -

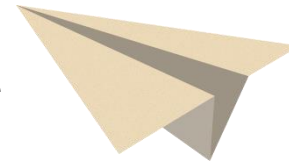
✓ Opposition



✓ Invalidity Trial



✓ Citation of Prior Art



# Three Tools for PGR in Japan

➤ Type of PGR

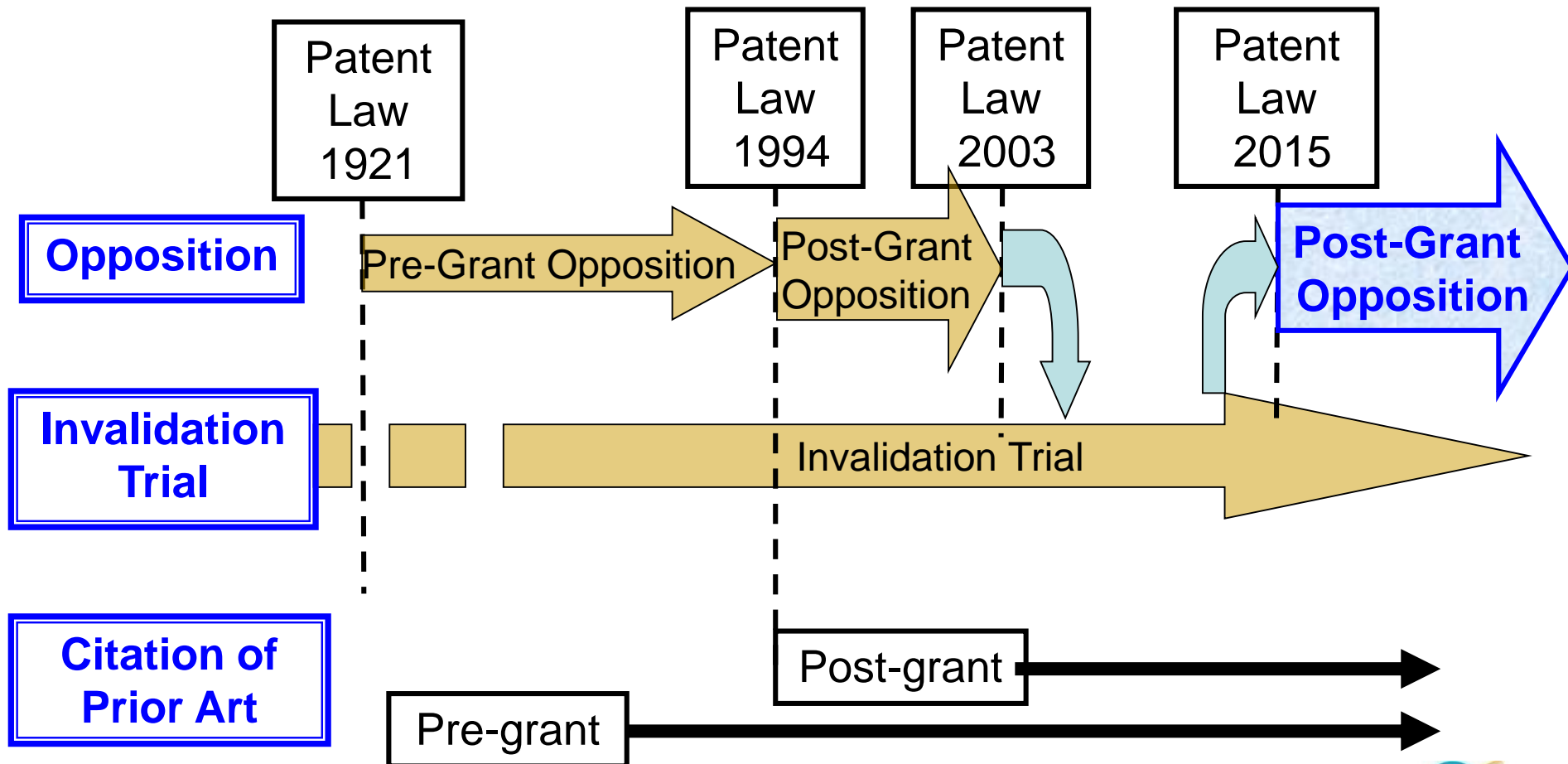
➤ **History of PGRs**

➤ Proceedings

➤ Comparison of Three PGRs

# Three Tools for PGR

## - History of PGRs -





# Three Tools for PGR in Japan

➤ Type of PGR

➤ History

➤ **Proceedings of PGRs**

➤ Comparison of Three PGRs

# Proceedings

## ■ Opposition



# Opposition Proceeding (1)



**Petitioner**



**JPO**

Issuance of Patent



Patent Publication



Forwarding Copy



Starting Trial



**Patentee**

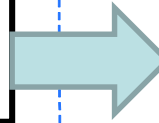
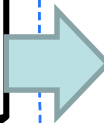


Statutory

Period

**6 Ms**

Petition



Copy of  
Petition

**Trial**

# Opposition Proceeding (2)

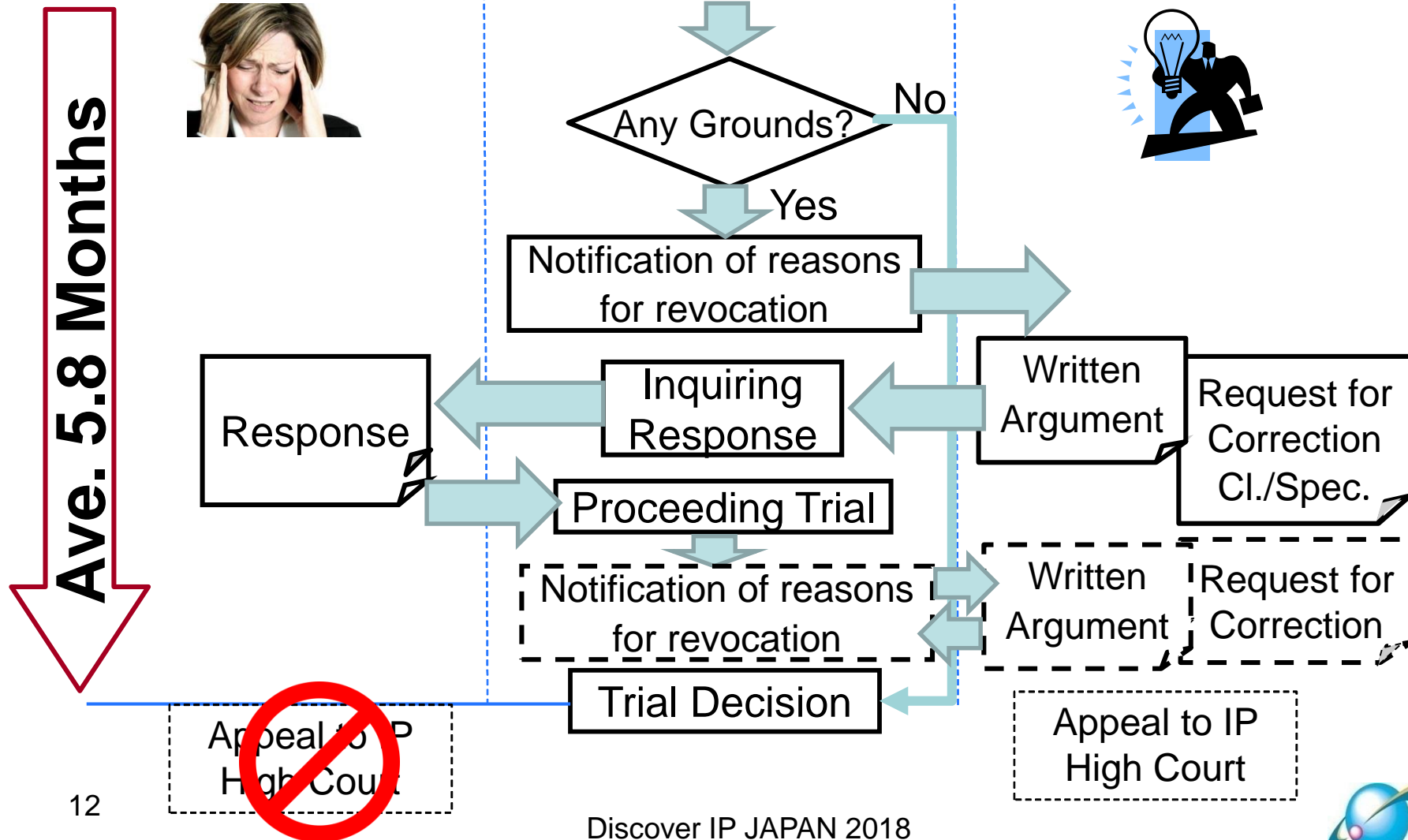


Petitioner



JPO

Patentee

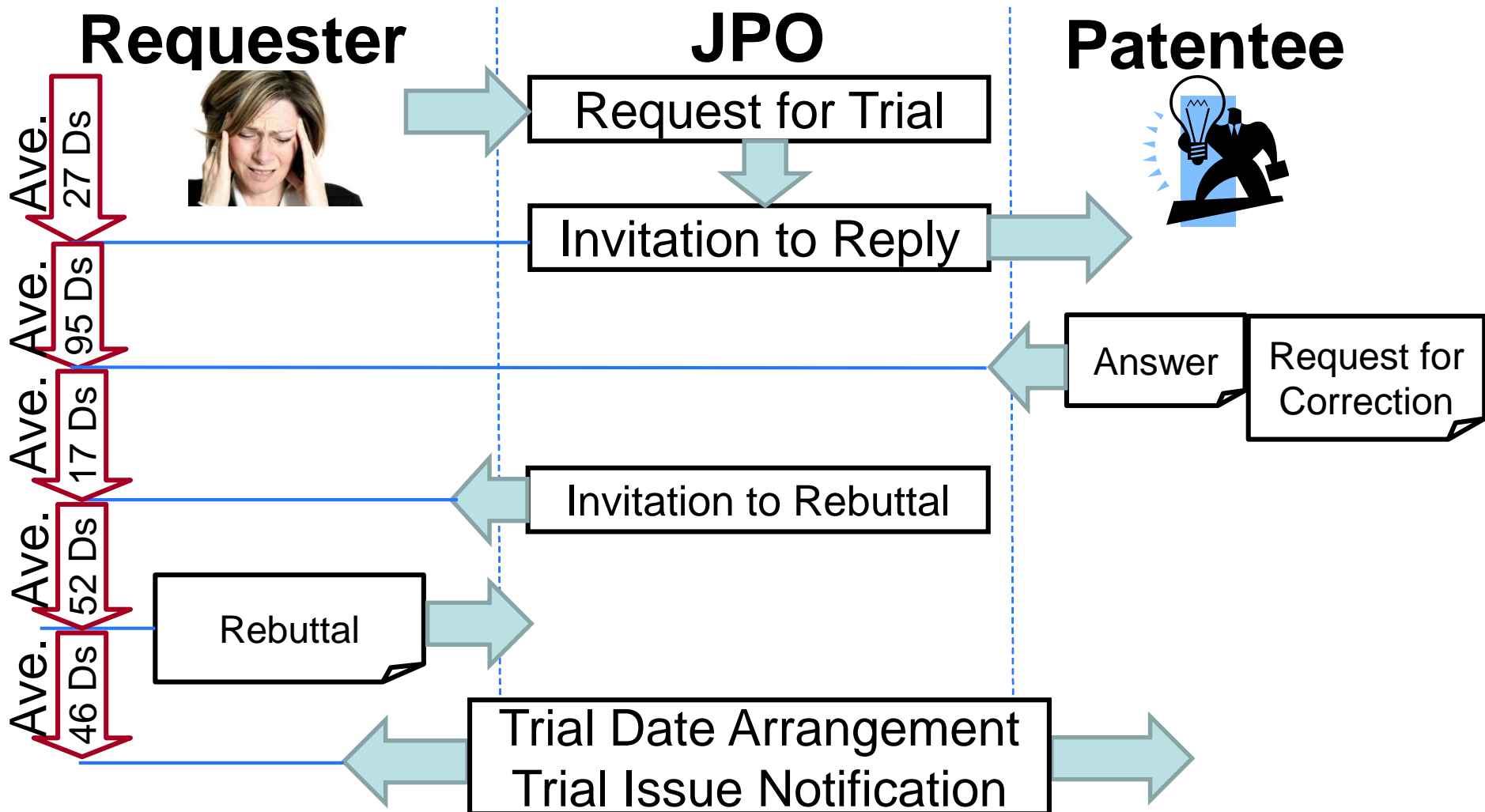


# Proceedings

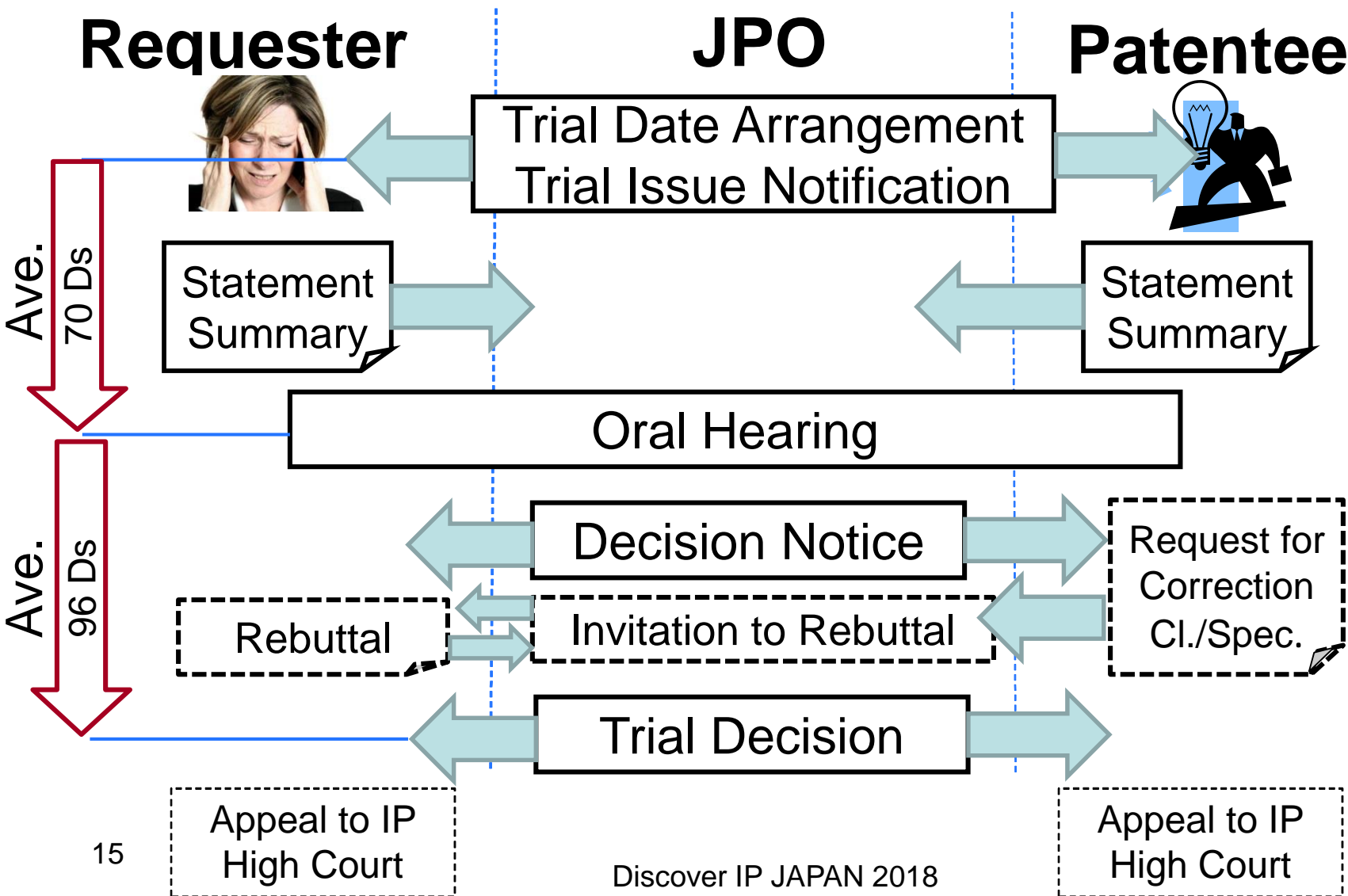
## ■Invalidation Trial



# Invalidation Proceeding (1)

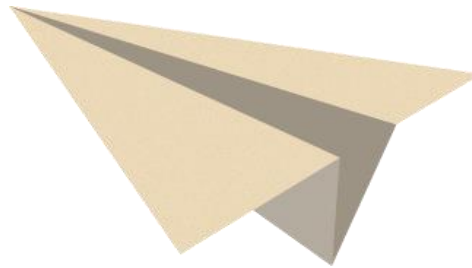


# Invalidation Proceeding (2)



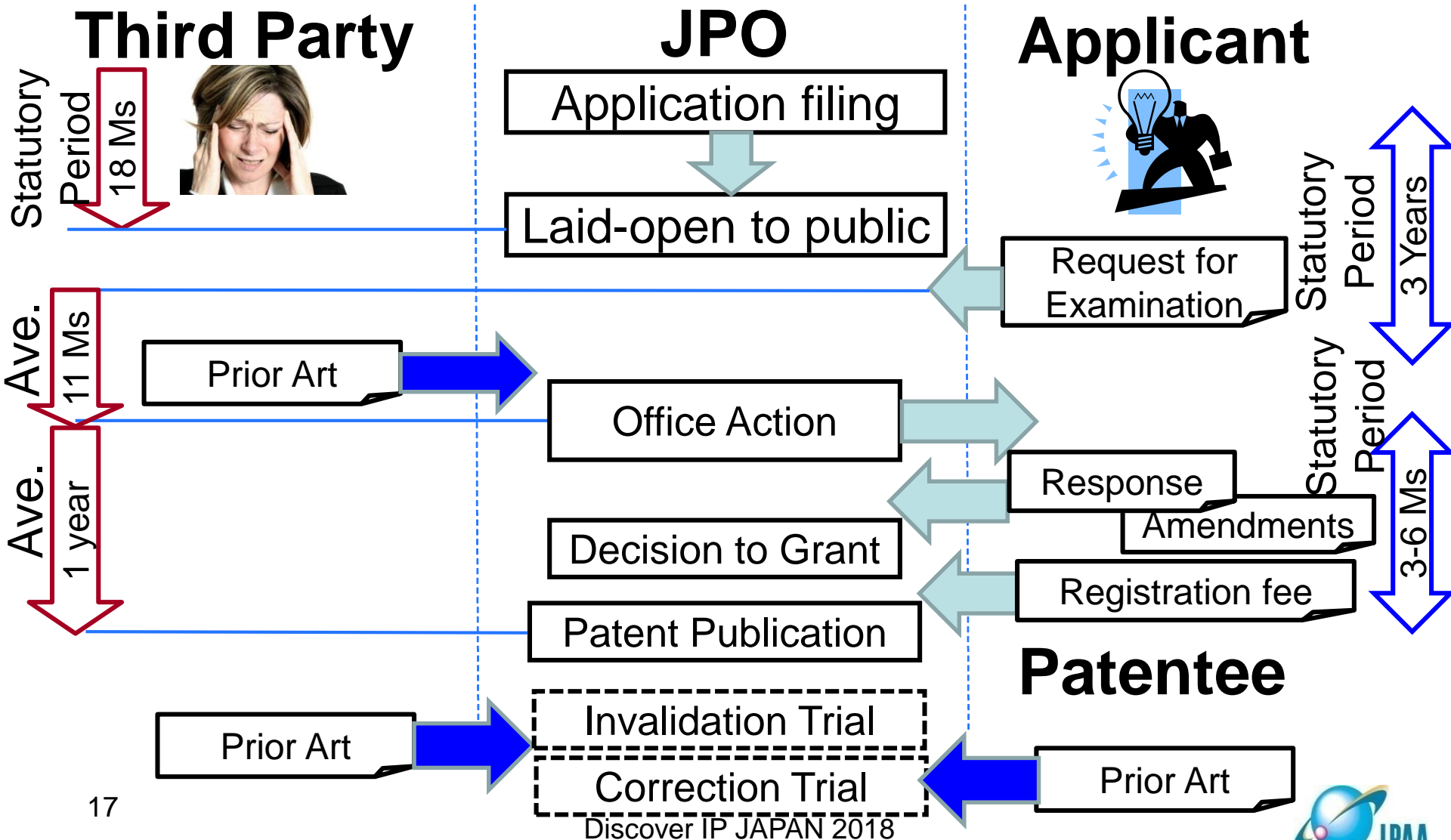
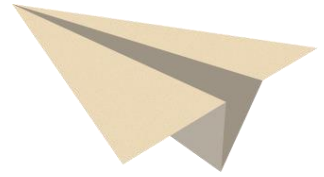
# Proceedings

## ■ Citation of Prior Art





# Citation of Prior Art



# Three Tools for PGR in Japan

➤ Type of PGR

➤ History of PGRs

➤ Proceedings of PGRs

➤ **Comparison of Three PGRs**

# Three Tools for PGR

## - Comparison of Three PGRs -

Item	Opposition	Invalidation Trial	Citation of Prior Art
Character	Ex-parte	Inter-parte	Ex-parte
When	6 months from grant	Anytime after registration	Anytime
Who	Anyone	Interest person	Anyone
Anonymous	Not Allowed	Not Allowed	Allowed
Use of other's name	Possible	Possible	Possible

# Three Tools for PGR

## - Comparison of Three PGRs -

Item	Opposition	Invalidation Trial	Citation of Prior Art
<b>Grounds</b>	<b>Public interest</b> (novelty, inventive step, description, new matter etc.)	<b>Public interest, ownership, ex-post reasons</b>	<b>Public interest, (novelty, inventive step, description, new matter etc.)</b>
<b>Patentee's Arguments/ Correction</b>	<b>Allowed</b>	<b>Allowed</b>	<b>Not Available</b>
<b>Proceeding</b>	<b>Documents only</b>	<b>Oral &amp; Documents</b>	<b>Documents only</b>

# Three Tools for PGR

## - Comparison of Three PGRs -

Item	Opposition	Invalidation Trial	Citation of Prior Art
Opponent's Rebuttal	Possible	Possible	Not Available
Double Jeopardy	<b>Not applicable</b>	Applicable	Not Available
Appeal	Possible	Possible	Not Available
Official Fee	¥16500 +¥2400/claim	¥49500 +¥5500/claim	Free of charge

# Three Tools for PGR

## - Comparison of Three PGRs -

Item	Opposition	Invalidation Trial
Average Period	5.8 months	10.5 months
Likelihood of success	9% revoked (49% narrowed)	18% (including invalidated in part)

# Post-Grant Review in Japan

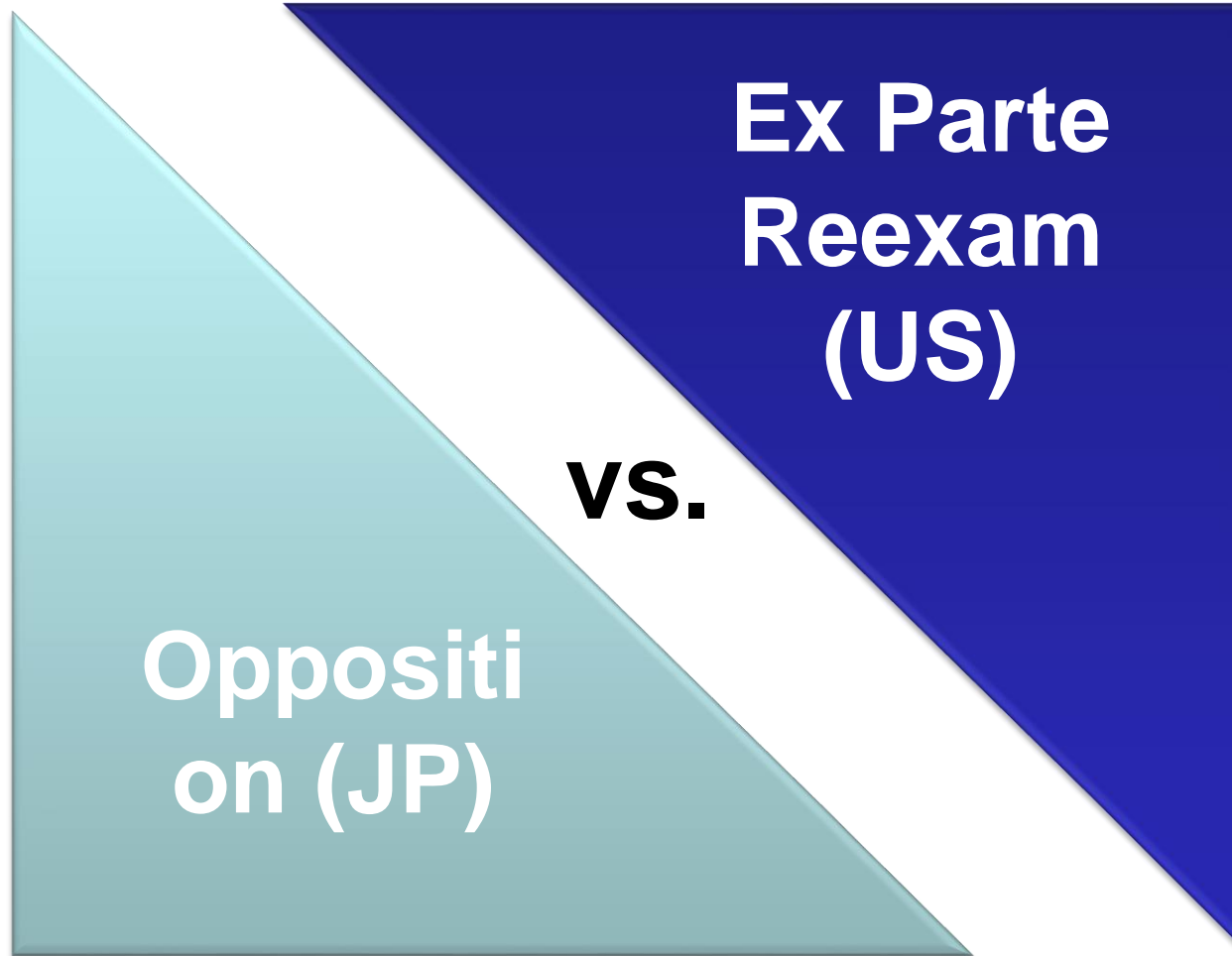
■ Three Tools for PGR in Japan

■ **Comparison of PGR – JP vs US**

■ How to Use PGR Tools

■ Summary

# Comparison





# Comparison

## - Opposition (JP) vs Ex Parte Reexam (US) -

Item	Opposition JP	Ex Parte Reexam US
Character	Ex-parte	Ex-parte
When	6 Ms from patent publication	Anytime after grant
Who	Anyone	Anyone
Anonymous	Not Allowed	Allowed
Use of other's name	Possible	Not Applicable

# Comparison

## - Opposition (JP) vs Ex Parte Reexam (US) -

Item	Opposition JP	Ex Parte Reexam US
<b>Issuance of Preliminary Decision</b>	<b>Not Available</b>	<b>Reexam order</b>
<b>Grounds</b>	<b>Novelty, inventive step, <b>description</b>, etc.</b>	<b>Novelty, obviousness, double patenting only based on publication</b>
<b>Patentee's Arguments/ Correction</b>	<b>Allowed</b>	<b>Allowed</b>

# Comparison

## - Opposition (JP) vs Ex Parte Reexam (US) -

Item	Opposition JP	Ex Parte Reexam US
Discovery	Not Available	Not Available
Oral Hearing	Not Available	Interview
Double Jeopardy	Not Applicable	Not Applicable
Appeal	Possible	Possible, first PTAB
Official Fee	¥16500 +¥2400/claim	\$12000/\$6000/\$3000 Large/Small/Micro

# Comparison

## - Opposition (JP) vs Ex Parte Reexam (US) -

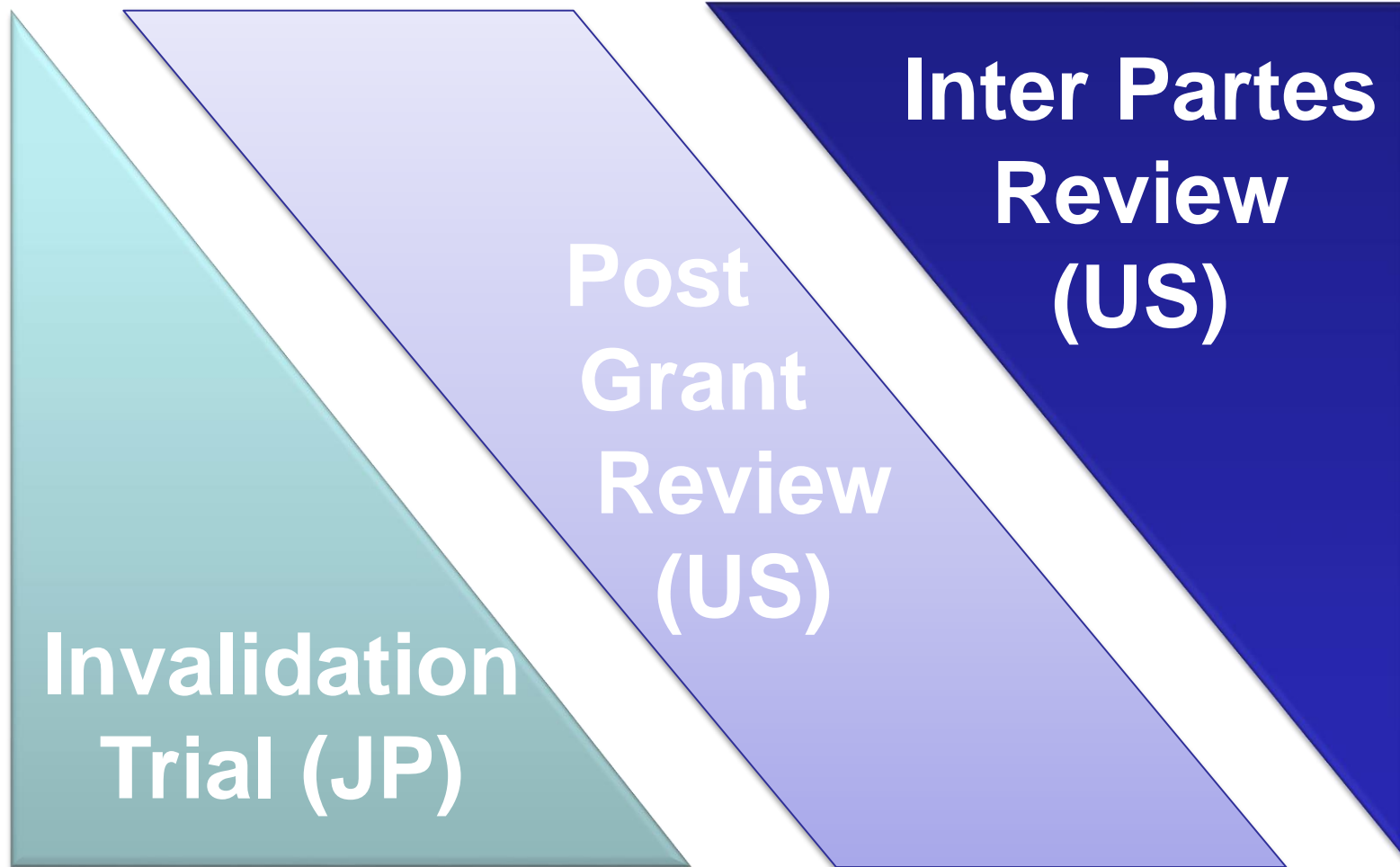
Item	Opposition JP	Ex Parte Reexam US
<b>Ave. Period</b>	<b>5.8 months</b>	<b>~24 months</b>
<b>Likelihood of success</b>	<b>9% revoked, 49% narrowed<sup>*1</sup></b>	<b>12% revoked, 67% narrowed<sup>*2</sup></b>

\*1: JPO statistics as of end of November 2017

\*2: from USPTO statistics fiscal year 2017 at

[https://www.uspto.gov/sites/default/files/documents/ex\\_parte\\_historical\\_stats\\_roll\\_up.pdf](https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_roll_up.pdf)

# Comparison



# Comparison

## - Invalidation Trial (JP) vs Post-Grant Review / Inter Partes Review (US) -

Item	Invalidation Trial (JP)	Post-Grant Review (US)	Inter Partes Review (US)
Character	Inter-partes	Inter-partes	Inter-partes
When	<b>Anytime</b> after registration	<b>9 months</b> from grant	<b>Anytime</b> after grant*
Who	<b>Interest person</b>	<b>Anyone?</b>	<b>Anyone?</b>
Anonymous	Not Allowed	Not Allowed	Not Allowed
Use of other's name	Possible	Impossible (Real interest person)	Impossible (Real interest person)

# Comparison

## - Invalidation Trial (JP) vs Post-Grant Review / Inter Partes Review (US) -

Item	Invalidation Trial (JP)	Post-Grant Review (US)	Inter Partes Review (US)
<b>Grounds</b>	<b>Patentability, Ownership, Ex-post reasons</b>	<b>Any patentability ground</b>	<b>Novelty, obviousness, publications only</b>
<b>Patentee's Arguments/ Correction</b>	<b>Allowed</b>	<b>Allowed but amendments extremely rare</b>	<b>Allowed but amendments extremely rare</b>
<b>Discovery</b>	<b>Not Available</b>	<b>Limited</b>	<b>Limited</b>

# Comparison

## - Invalidation Trial (JP) vs Post-Grant Review / Inter Partes Review (US) -

Item	Invalidation Trial (JP)	Post-Grant Review (US)	Inter Partes Review (US)
Issuance of Preliminary Decision	Not Available	Institution Decision	Institution Decision
Opponent's Rebuttal	Possible	Possible	Possible
Double Jeopardy	Applied	Applied	Applied
Appeal	Possible	Possible	Possible



# Comparison

## - Invalidation Trial (JP) vs Post-Grant Review / Inter Partes Review (US) -

Item	Invalidation Trial (JP)	Post-Grant Review (US)	Inter Partes Review (US)
Official Fee	¥49500 +¥5500/claim	\$38000+\$1200/ excess claim	\$30500+\$900/ excess claim
Ave. Period	10.5 months	<b>Must completed within 12 months</b>	<b>Must completed within 12 months</b>
Likelihood of success	18% (including invalidated in part)	56% <sup>*3</sup> (for all IPR/PGR/CBM )	
Flexibility	Interactive	less interactive	less interactive

\*3: from USPTO statistics as of 09/30/2017 at [https://www.uspto.gov/sites/default/files/documents/Trial\\_Stats\\_2017-09-30.pdf](https://www.uspto.gov/sites/default/files/documents/Trial_Stats_2017-09-30.pdf)

# Post-Grant Review in Japan

■ Three Tools for PGR in Japan

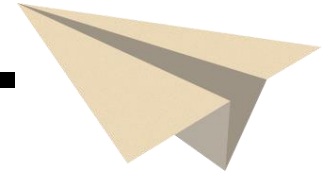
■ Comparison of PGR – JP vs US

■ **How to Use PGR Tools**

■ Summary

# How to Use PGR Tools

## - Citation of Prior Art -



- Use Pre-Grant Citation of Prior Art before first Office Action
- Use Post-Grant Citation of Prior Art when to have correction trial examiners notice documents
- Use Citation of Prior Art when to submit non-patent documents

# How to Use PGR Tools

## - Opposition -



- Use Opposition when offending claims has been finally granted
- Use Opposition if you want to conceal your identification
- Use Opposition if you have documents (including non-patent ones) not used during examination

# How to Use PGR Tools

## - Invalidation Trial -



- Use Invalidation Trial if failed to revoke offending patent in Opposition
- Use Invalidation Trial if you are involved in infringement lawsuit
- If you have an important application, file a divisional just in case

# Post-Grant Review in Japan

■ Three Tools for PGR in Japan

■ Comparison of PGR – JP vs US

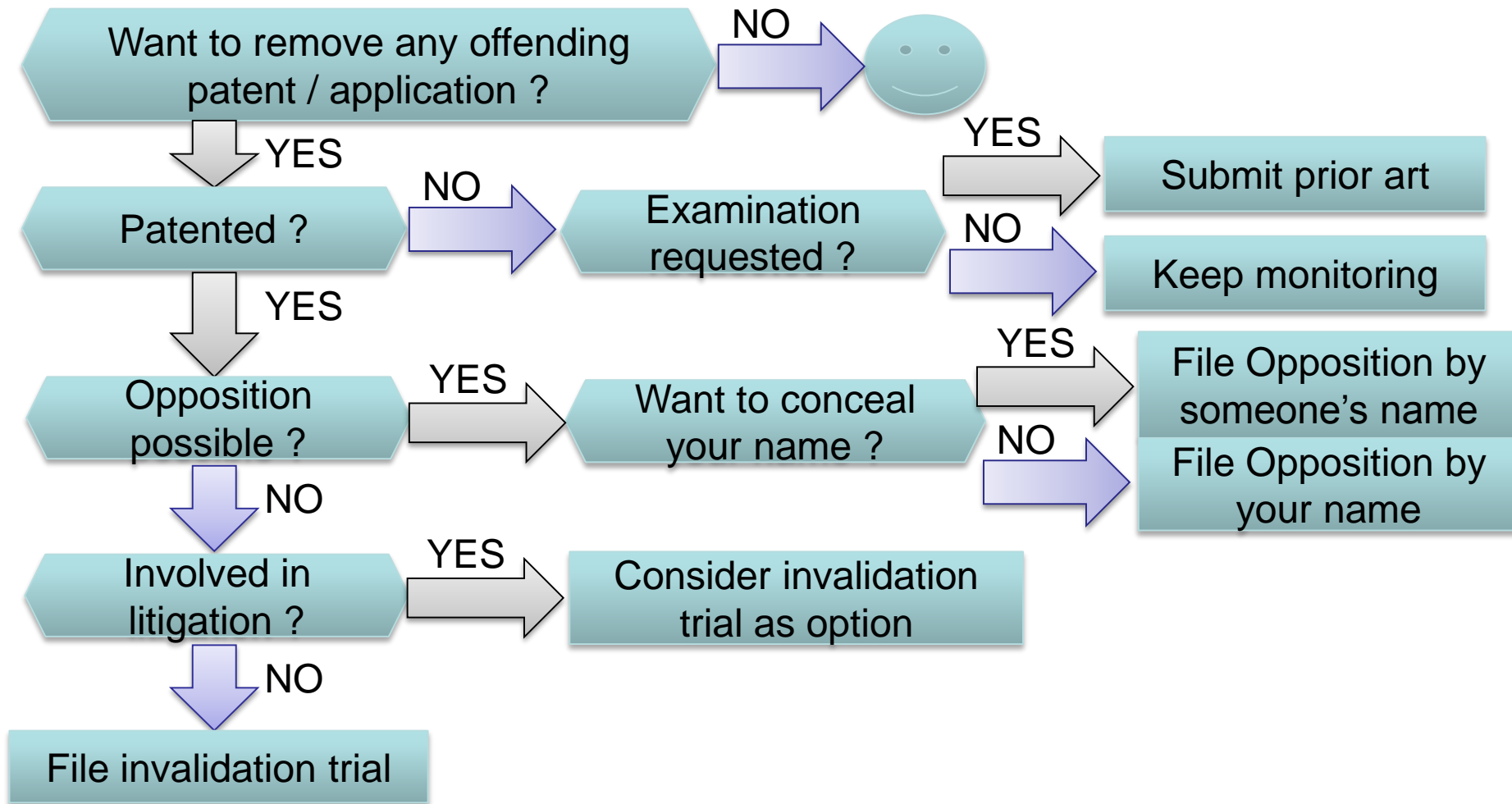
■ How to Use PGR Tools

■ **Summary**

# Summary

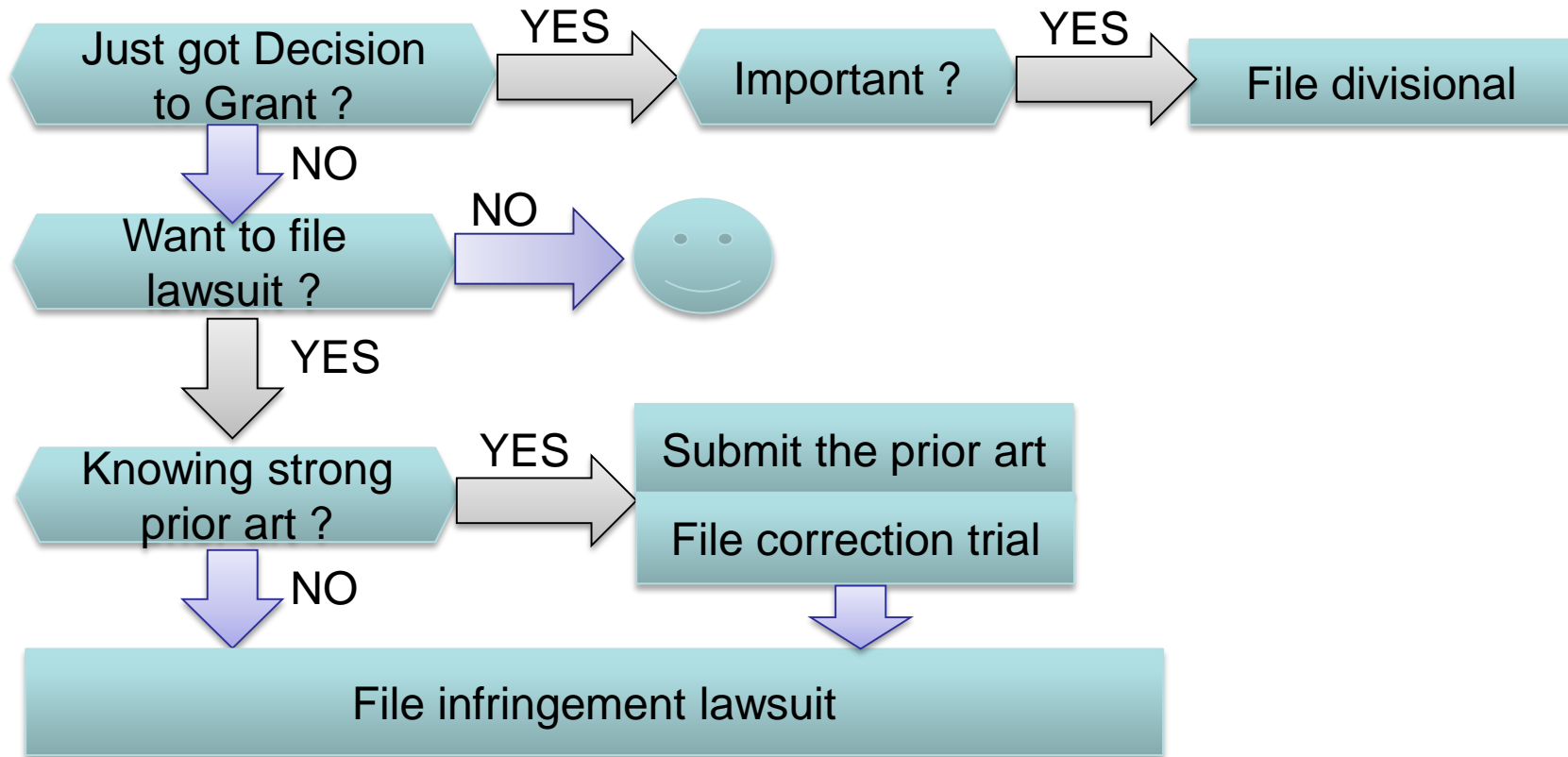
- If you have any offending patent or application to remove
- If you are a patentee

# If you have any offending patent or application to remove





# If you are a patentee





# Thank you for your attention

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TMI Associates