



Post-Grant Review in Japan

Discover IP JAPAN 2018

Houston, January 30, 2018

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Post-Grant Review in Japan

Discover IP JAPAN 2018

San Diego, February 1, 2018

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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 -

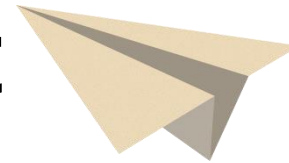
✓ Opposition



✓ Invalidity Trial



✓ Citation of Prior Art



Three Tools for PGR in Japan

➤ Type of PGR

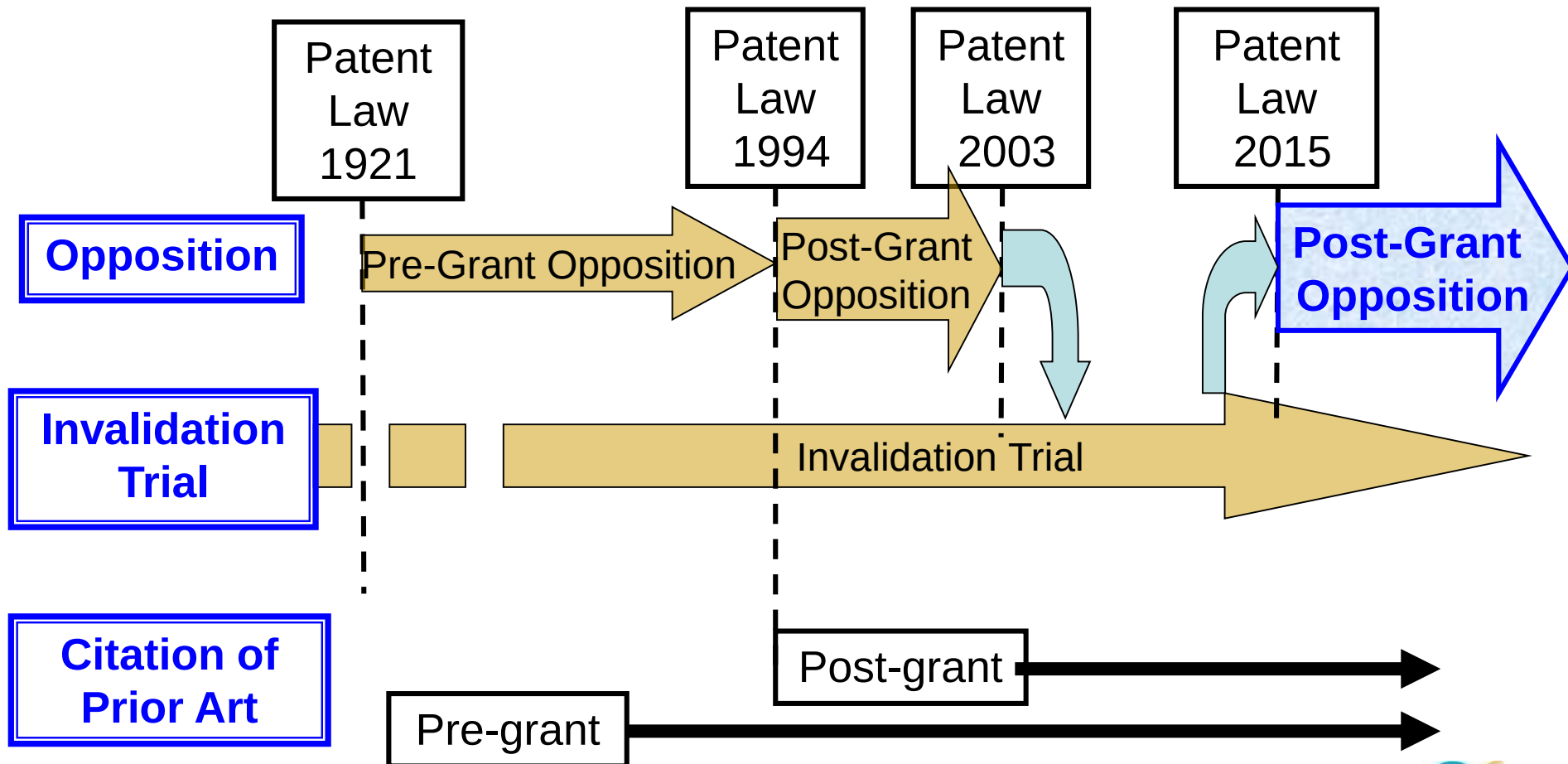
➤ **History of PGRs**

➤ 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



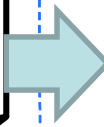
Patentee



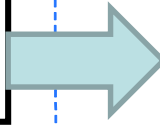
Statutory
Period

6 Ms

Petition

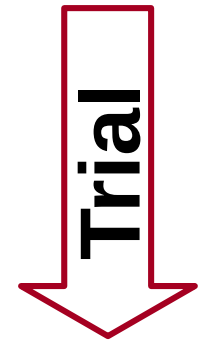


Forwarding Copy



Copy of
Petition

Trial



Opposition Proceeding (2)

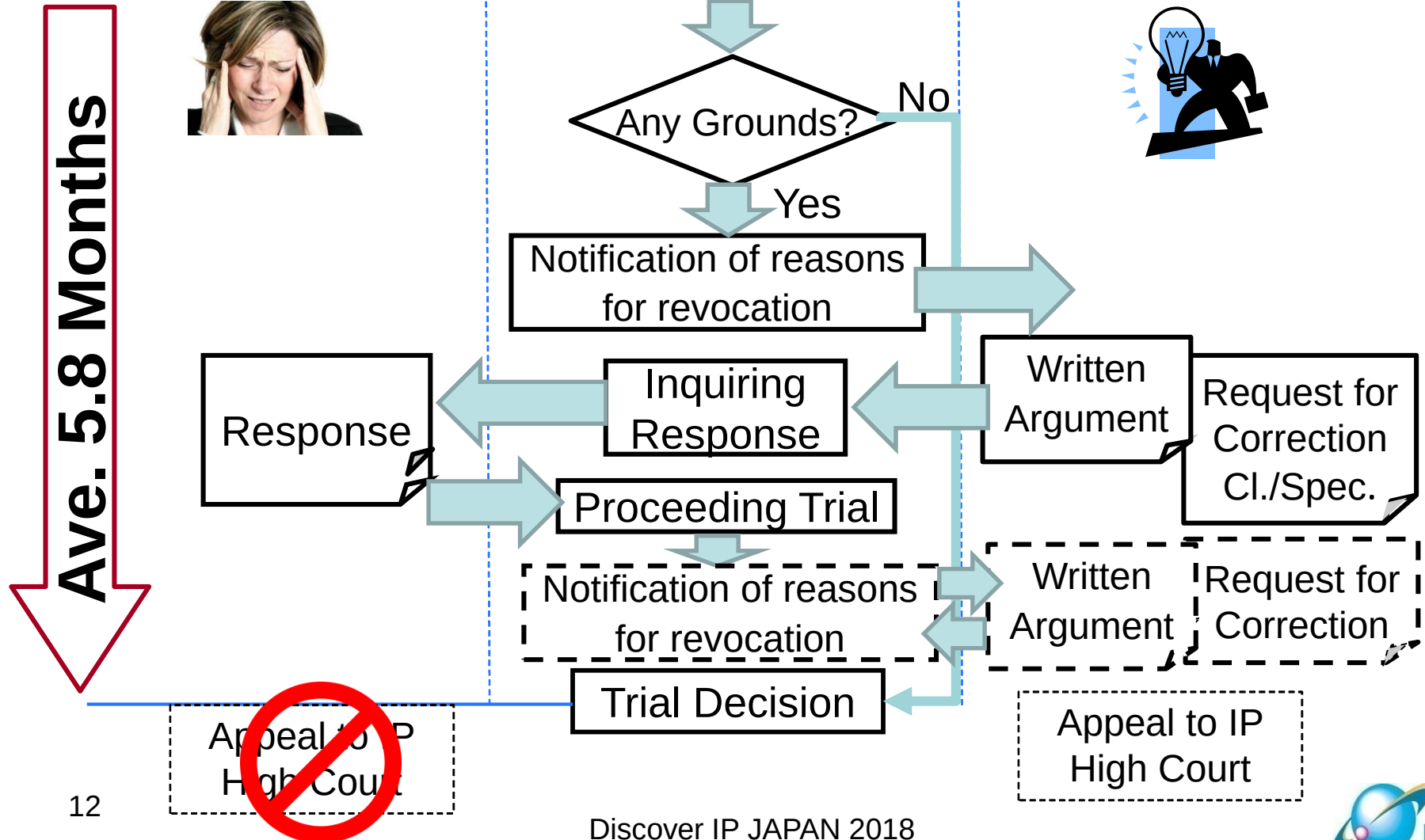


Petitioner



JPO

Patentee

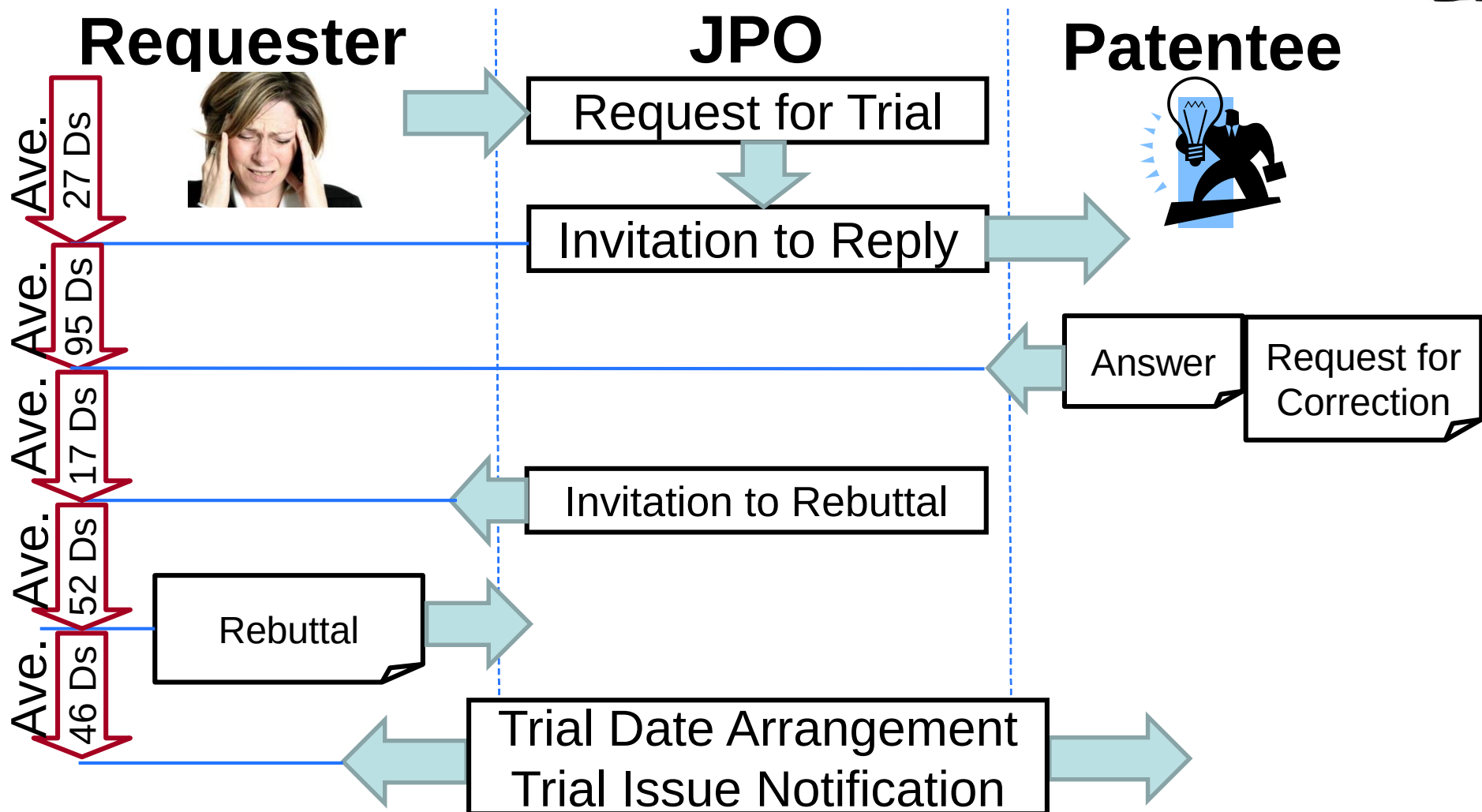


Proceedings

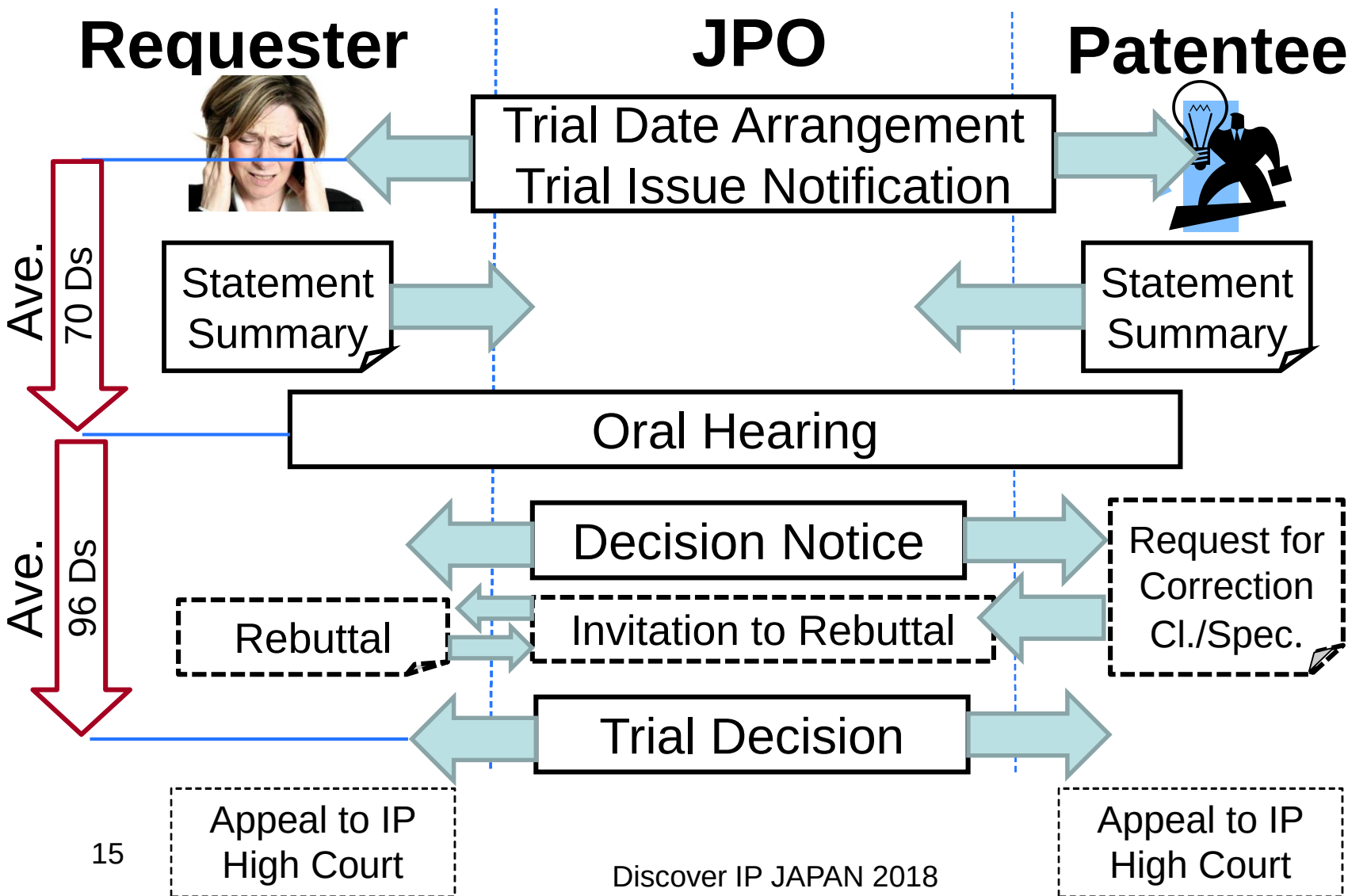
■Invalidation Trial



Invalidation Proceeding (1)

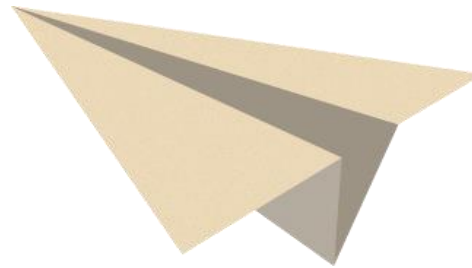


Invalidation Proceeding (2)

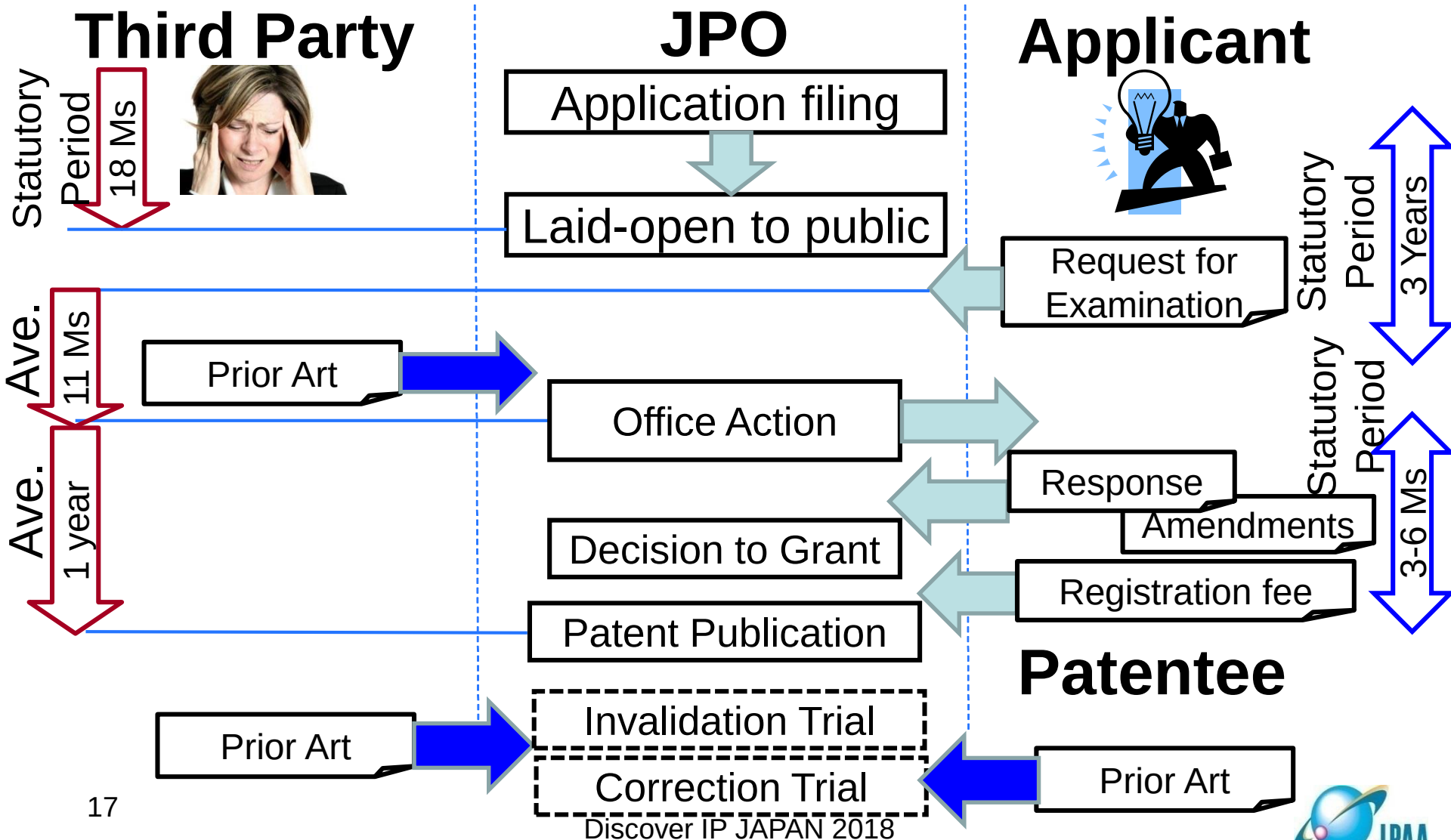
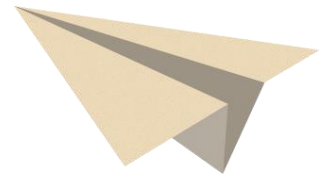


Proceedings

■ 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
Grounds	Public interest (novelty, inventive step, description, new matter etc.)	Public interest, ownership, ex-post reasons	Public interest, (novelty, inventive step, description, new matter etc.)
Patentee's Arguments/ Correction	Allowed	Allowed	Not Available
Proceeding	Documents only	Oral & Documents	Documents only

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	Not applicable	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

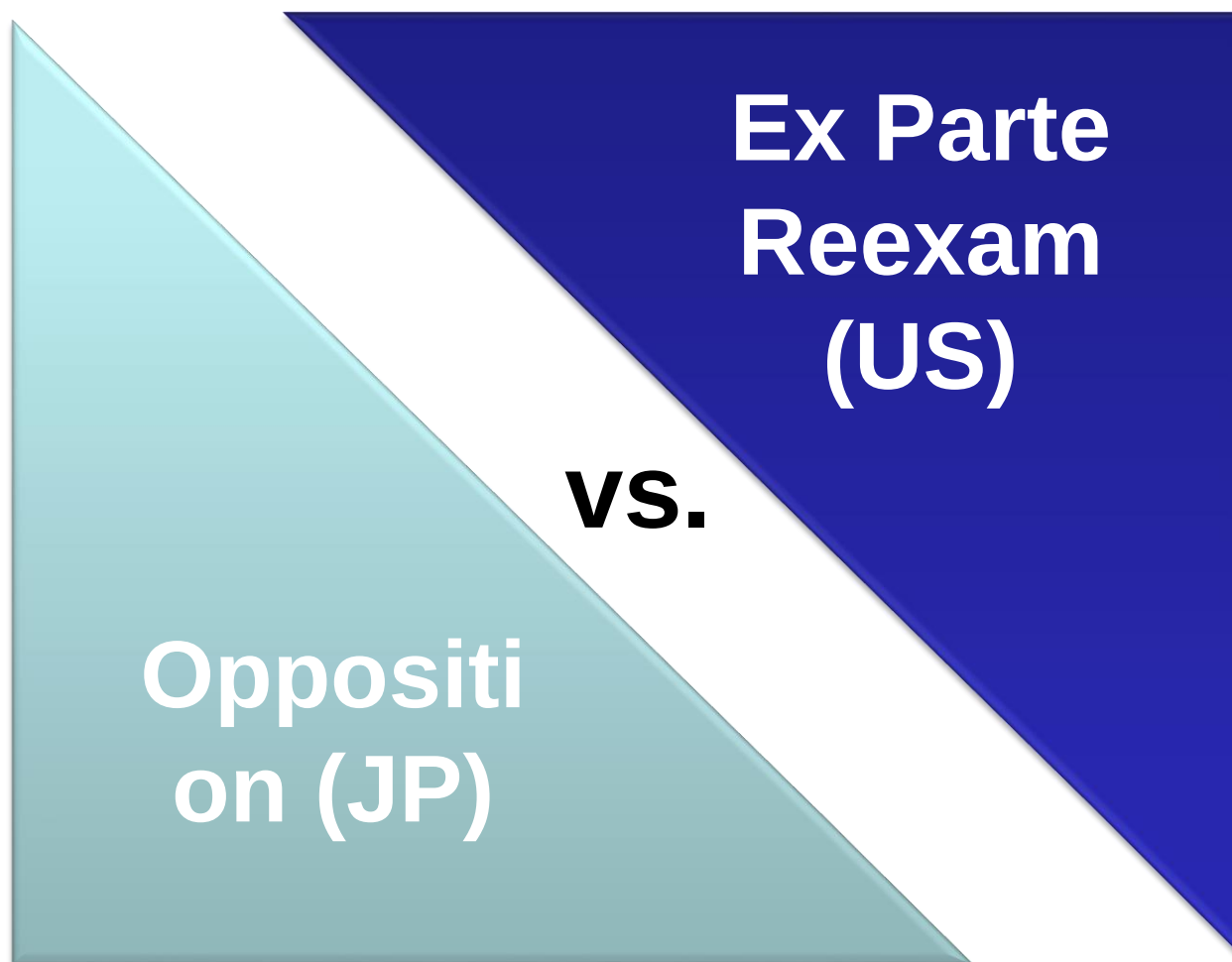
■ Three Tools for PGR in Japan

■ **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
Issuance of Preliminary Decision	Not Available	Reexam order
Grounds	Novelty, inventive step, description , etc.	Novelty, obviousness, double patenting only based on publication
Patentee's Arguments/ Correction	Allowed	Allowed

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) -

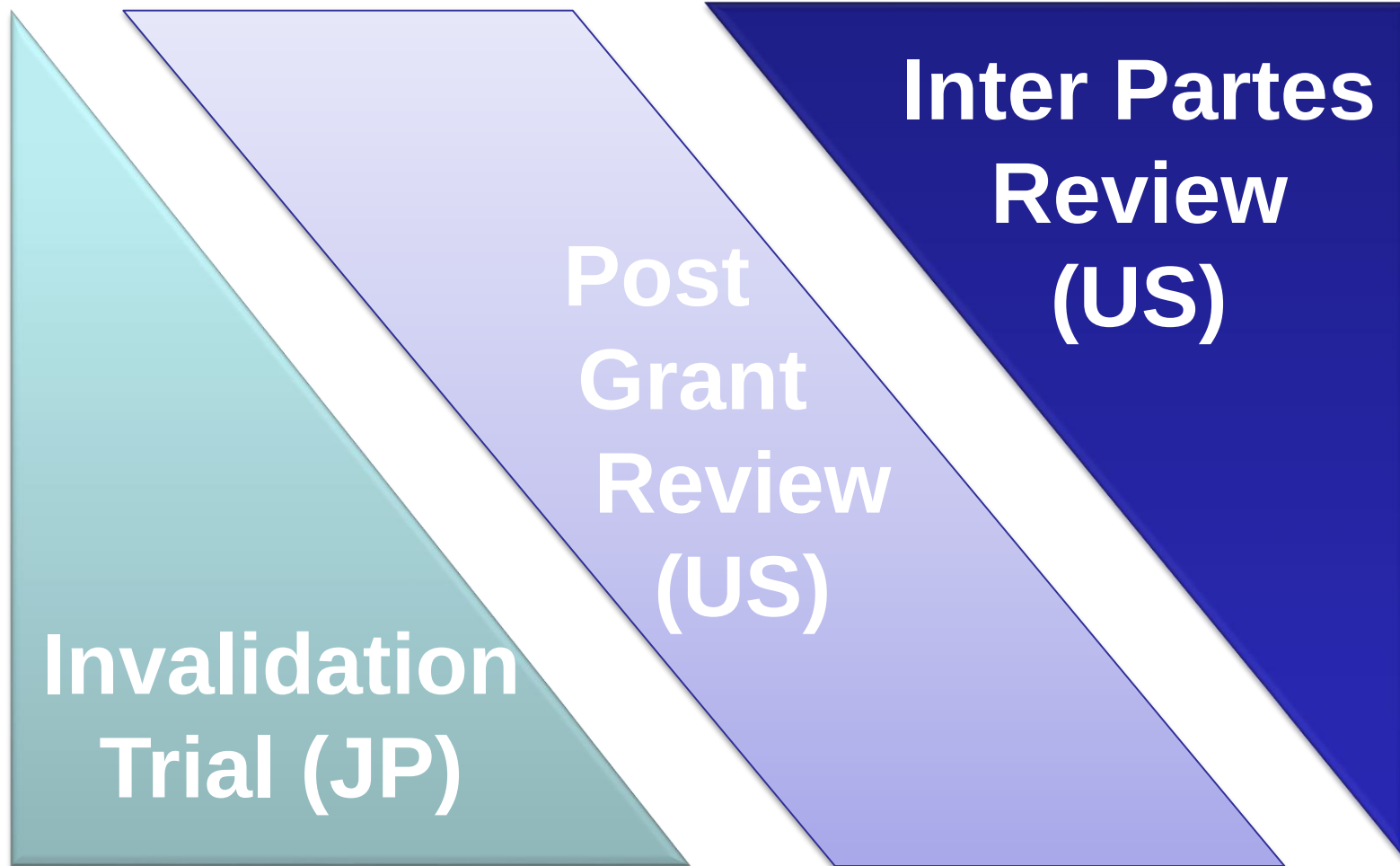
Item	Opposition JP	Ex Parte Reexam US
Ave. Period	5.8 months	~24 months
Likelihood of success	9% revoked, 49% narrowed^{*1}	12% revoked, 67% narrowed^{*2}

*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

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	Anytime after registration	9 months from grant	Anytime after grant*
Who	Interest person	Anyone?	Anyone?
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)
Grounds	Patentability, Ownership, Ex-post reasons	Any patentability ground	Novelty, obviousness, publications only
Patentee's Arguments/ Correction	Allowed	Allowed but amendments extremely rare	Allowed but amendments extremely rare
Discovery	Not Available	Limited	Limited

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	Must completed within 12 months	Must completed within 12 months
Likelihood of success	18% (including invalidated in part)	56%* ³ (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

Post-Grant Review in Japan

■ Three Tools for PGR in Japan

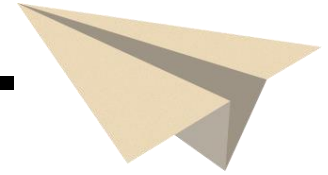
■ Comparison of PGR – JP vs US

■ **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

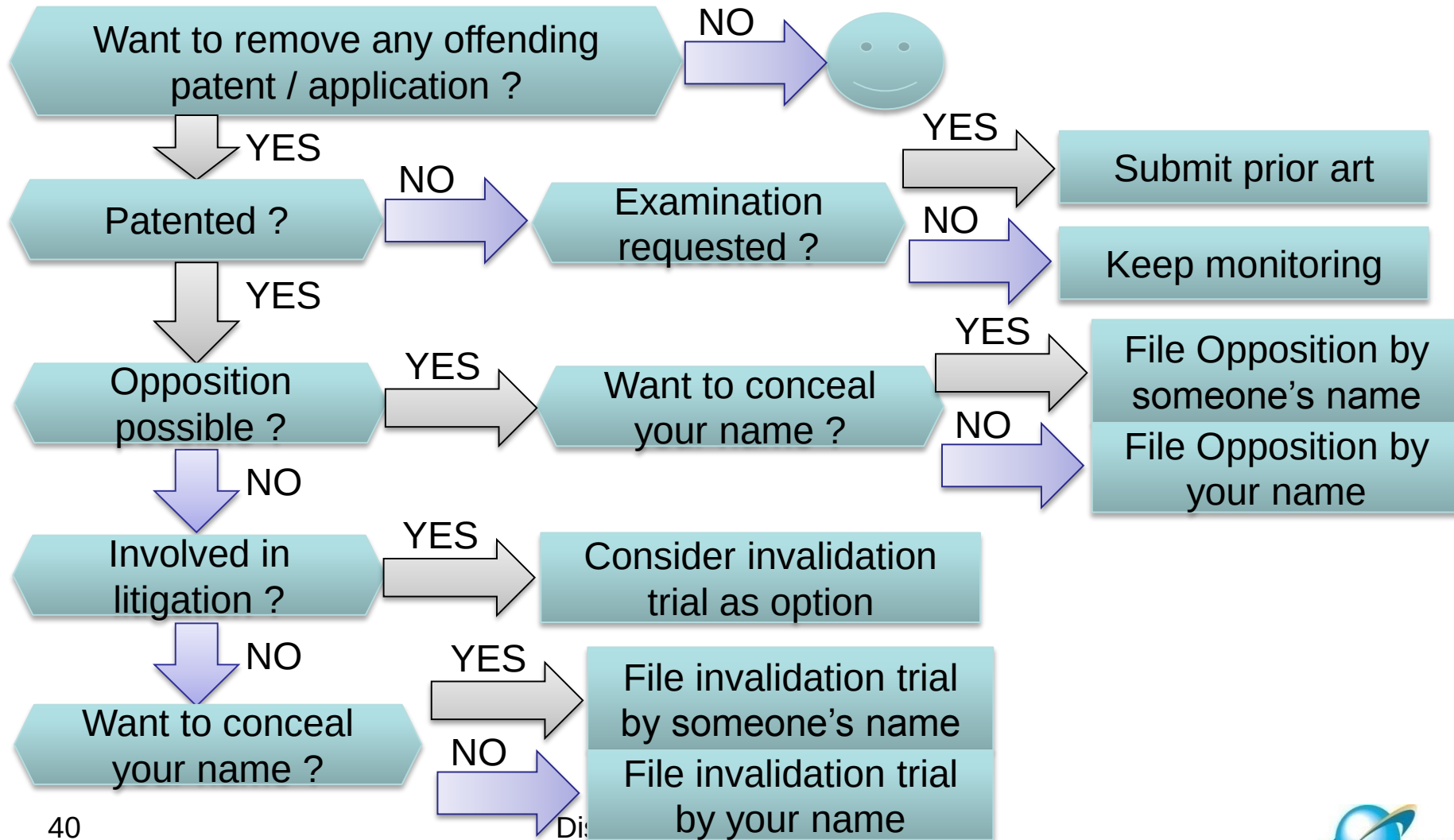
■ How to Use PGR Tools

■ **Summary**

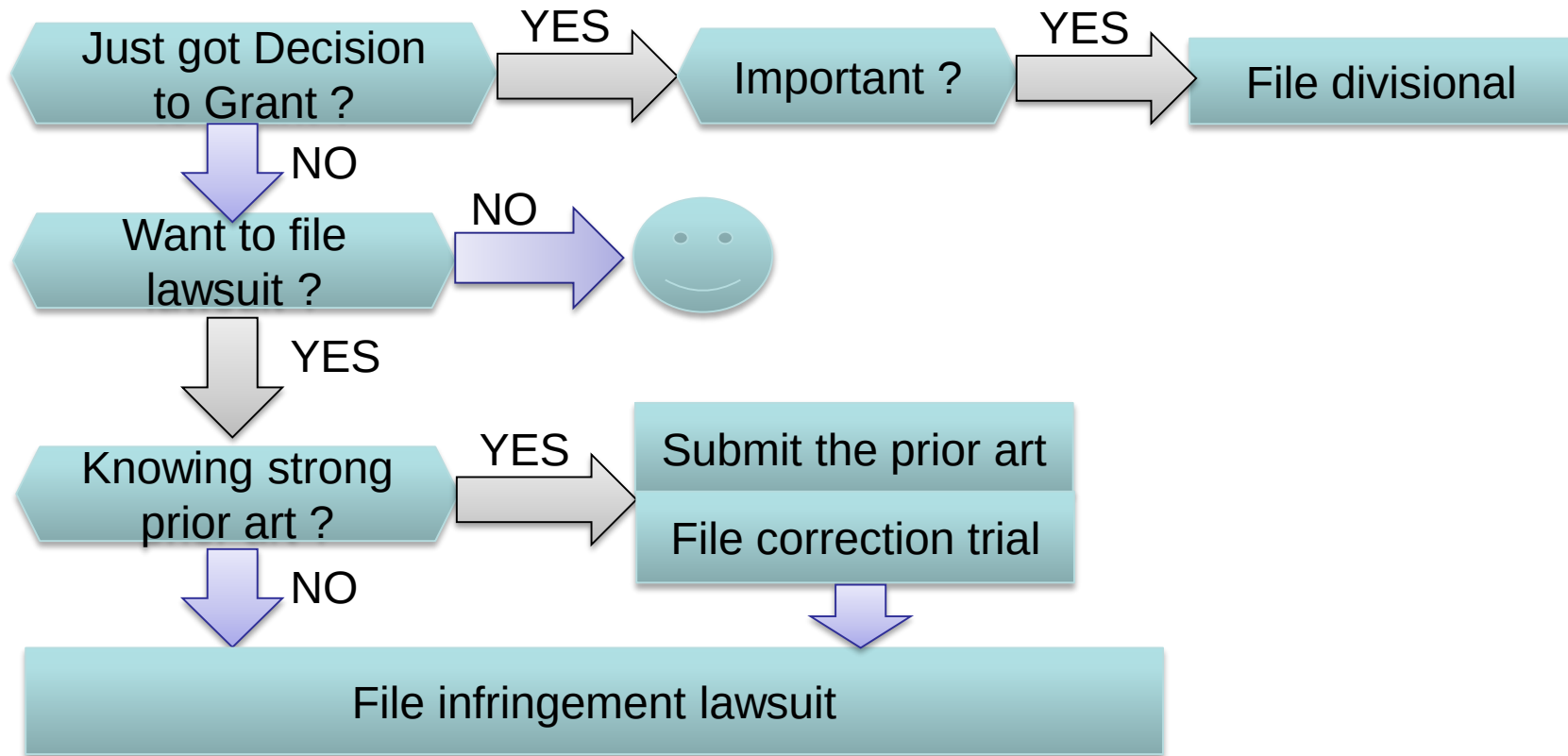
Summary

- 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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