

Administrative Revocation and Invalidation Mechanisms

Japan

Article 123 of the Patent Act provides that a request for a trial for patent invalidation may be filed before the Trial and Appeal Department.¹ Only an interested person may file such a request.² Where a patent contains two or more claims, a request for a trial for patent invalidation may be filed for each claim. A request for a trial for patent invalidation may be filed at any time after the registration of the establishment of the patent right. A request may be filed even after the attacked patent right has been surrendered or has lapsed.³ It may be based on any grounds provided in Article 123(1) of the Patent Act. The demandant shall submit evidence that proves that the patent is invalid. Where a party concerned is dissatisfied with the result of the trial for patent invalidation, he/she may appeal to the Intellectual Property High Court.

A written request for trial shall contain the facts on which the invalidation of the patent is based and they shall be specified in concrete terms, and the relationship of each fact that is required to be proved with the relevant evidence shall be stated in the grounds for the request.⁴ After the request is filed, a chief administrative judge transmits a duplicate of said written request for a trial to the patentee and give him/her an opportunity to reply to said written request for a trial within a specified period. The chief administrative judge may ask the parties concerned questions with regard to the trial.

The trial shall be dealt by a panel consisting of three or five administrative judges, and a decision of the panel shall be made by a majority vote.⁵ Generally, a trial shall be conducted through oral proceedings; provided, however, that the chief administrative judge may decide to conduct the trial through documentary proceedings upon request or *ex officio*.⁶ Evidence may be examined on request or *ex officio*.

Only the claim(s) for which a request for a trial for invalidation has been filed shall be examined. Any grounds not pleaded by a party concerned may be examined in a trial for patent invalidation. Where a trial decision to the effect that a patent is to be invalidated has become final and binding, the patent right shall be deemed never to have existed. Where a trial decision has become final and binding, the parties concerned and the intervenors of the trial may not file a request on the basis of the same facts and the same evidence. Trial proceedings may be suspended, if necessary, until the relevant court proceedings are concluded.⁷ Similarly, court proceedings may be suspended, if necessary, until the relevant trial decision becomes final and binding.⁸

¹ Patent Act (Article 121 of April 13, 1959, as last amended by Article 3 of May 17, 2019).

² Exceptionally, only a person having the right to obtain a patent may file a request for invalidation on some of the grounds relating to the entitlement to a patent.

³ Article 123(3) of the Patent Act.

⁴ Article 131(2) of the Patent Act.

⁵ Article 136(2) of the Patent Act.

⁶ Article 145 of the Patent Act.

⁷ Article 168(1) of the Patent Act.

⁸ Article 168(2) of the Patent Act.