

The Current State of Trials/Appeals

October 25, 2024

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Today's Topics

1

Trends in Trial and Appeal Statistics

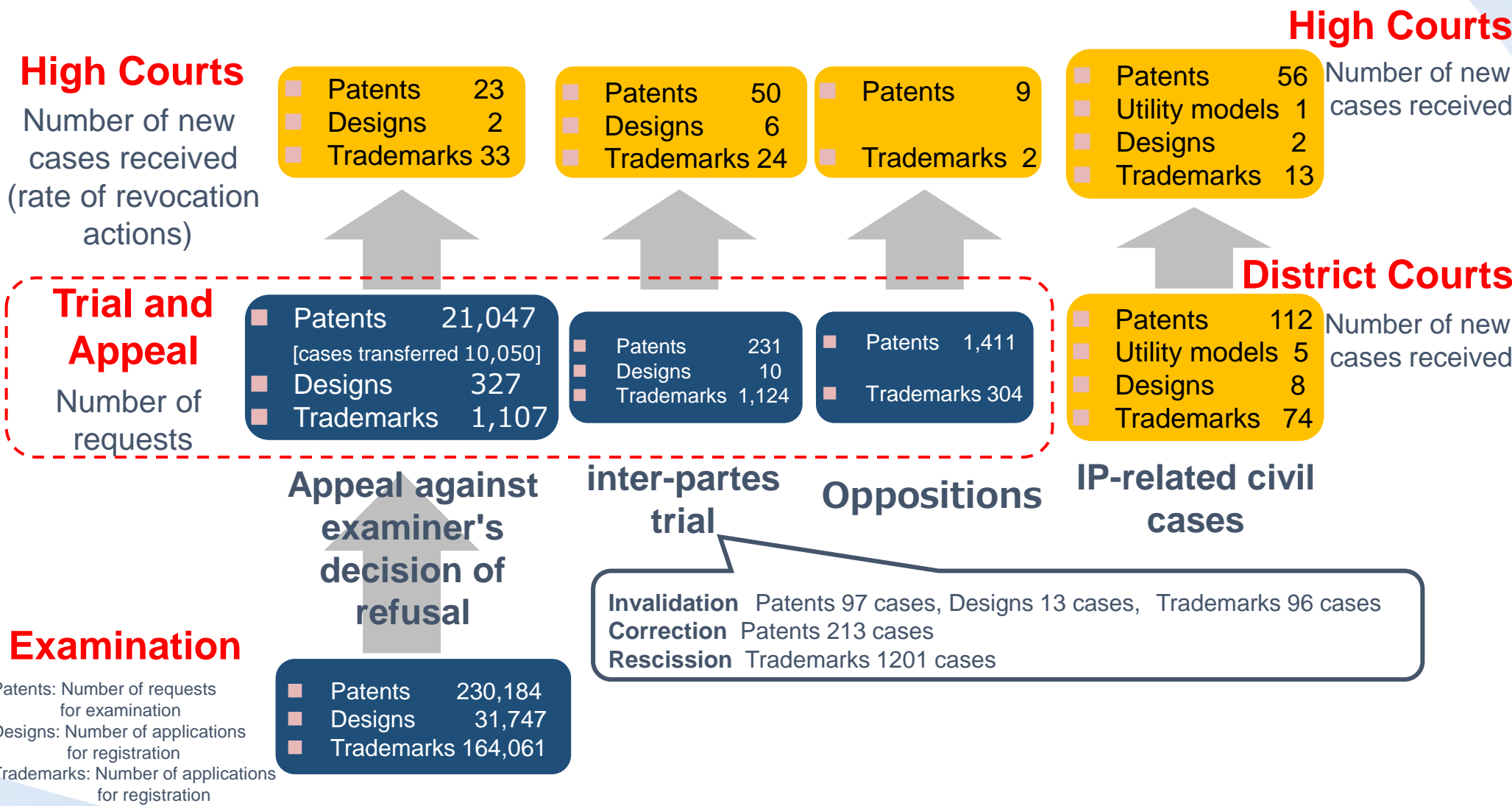
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Initiatives of the JPO

1

Trends in Trial and Appeal Statistics

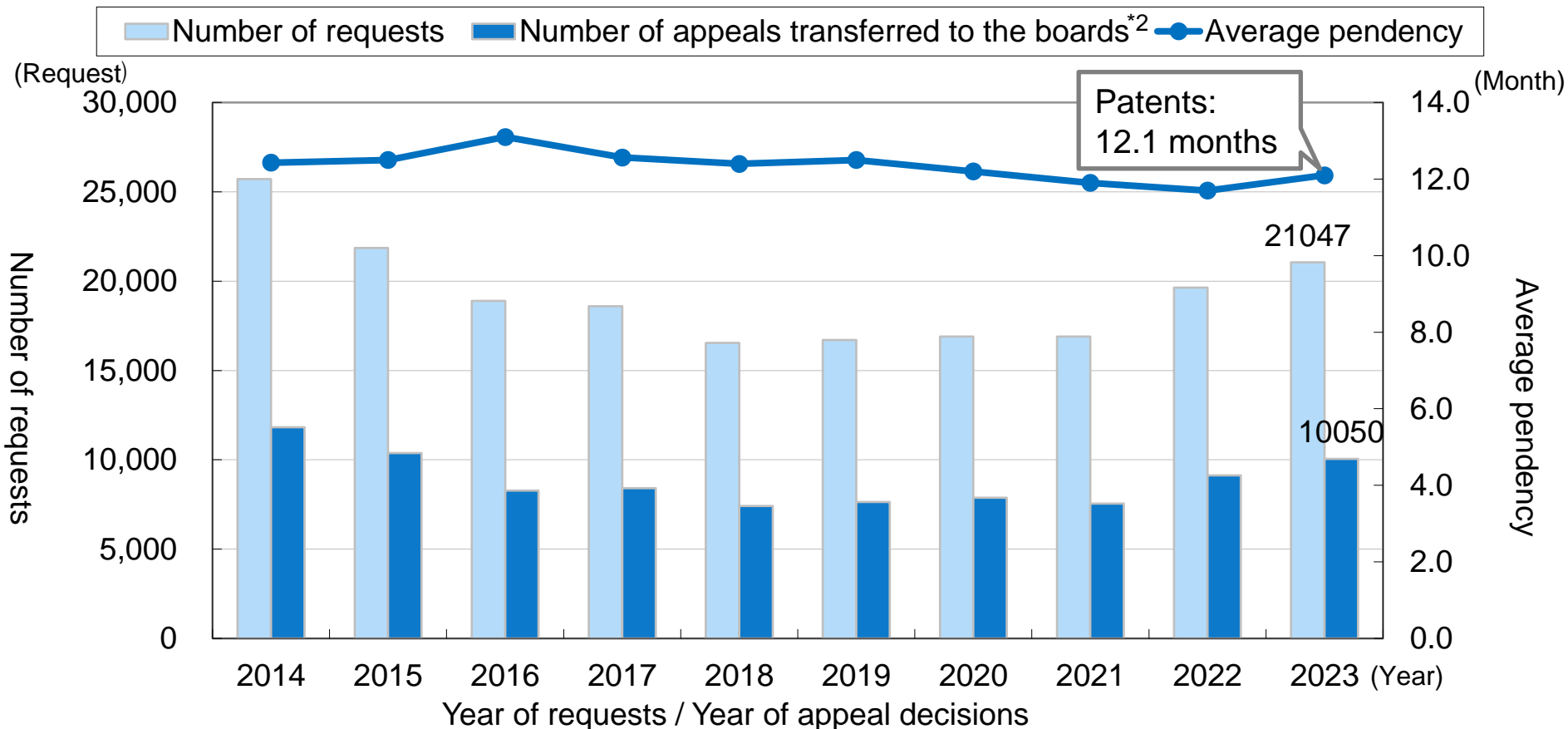
Comparison of Number of Cases



Source: Figures for ex-parte appeal, inter-partes trial and opposition cases are for 2023; Figures for IP-related civil cases are for 2022.

Appeals Against Examiner's Decision of Refusal: Trends in the Number of Requests and Pendency (Patents)

- ✓ The number of requests (for patents) has remained flat in recent years but increased by 7.1% to approximately 21,000 in 2023.
- ✓ Average pendency^{*1} (for patents) is 12.1 months in 2023.



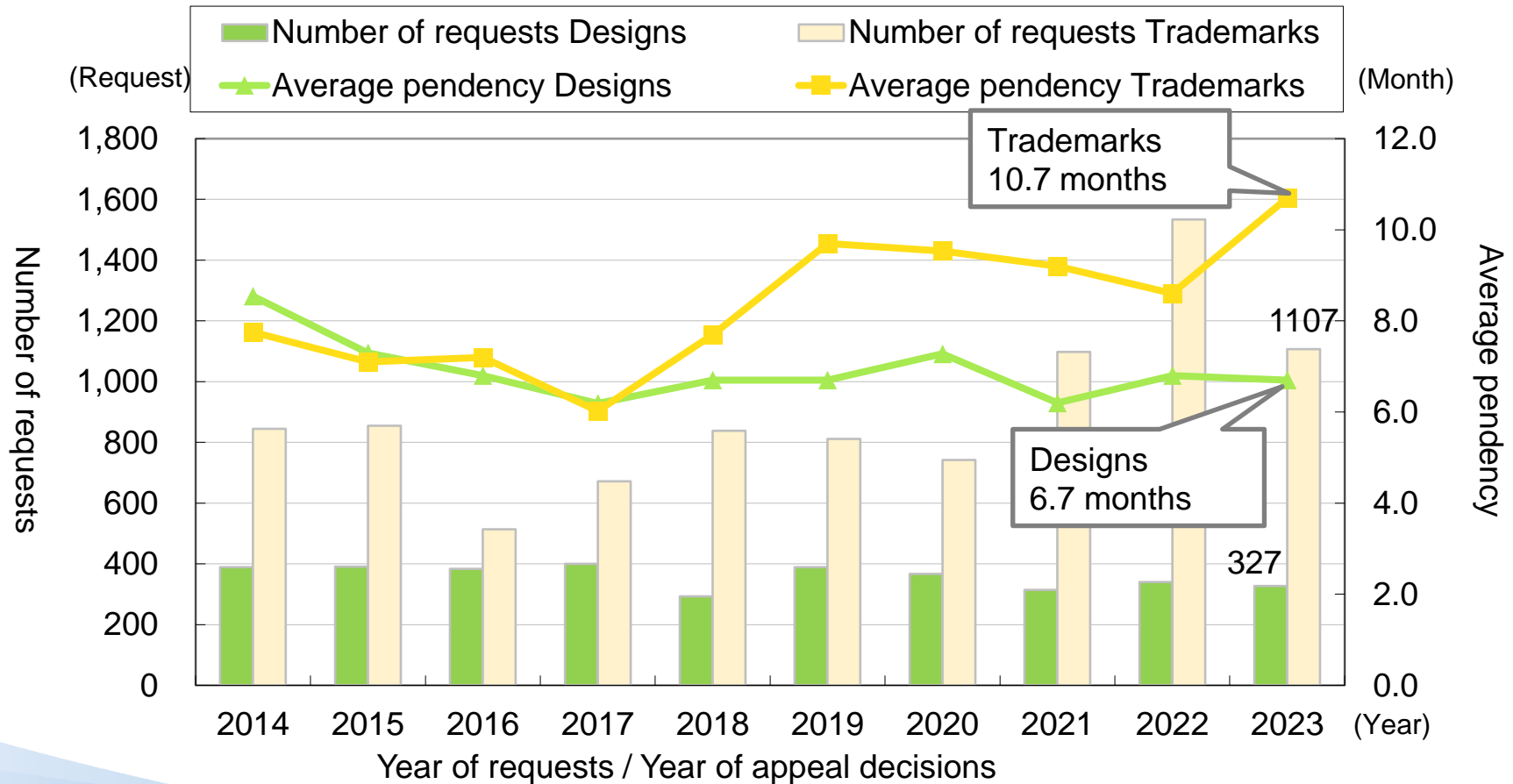
1 Average pendency: Calendar year average from a date of filing a request for appeal^{} to a date of dispatching an appeal decision, a fixed date of withdrawal/abandonment, or a date of dispatching a notice of dismissal.

*2 Number of appeals transferred to the boards: Appeal cases transferred to the boards in charge after a "Reconsideration by examiners before appeal" proceedings.

^{*} Date of filing requests for appeal: (For appeal cases transferred to the boards in charge after a reconsideration by examiners before appeal proceedings) the date on which the case becomes available for appeal proceedings (date of transfer to the board).

Appeals Against Examiner's Decision of Refusal: Trends in the Number of Requests and Pendency (Designs/Trademarks)

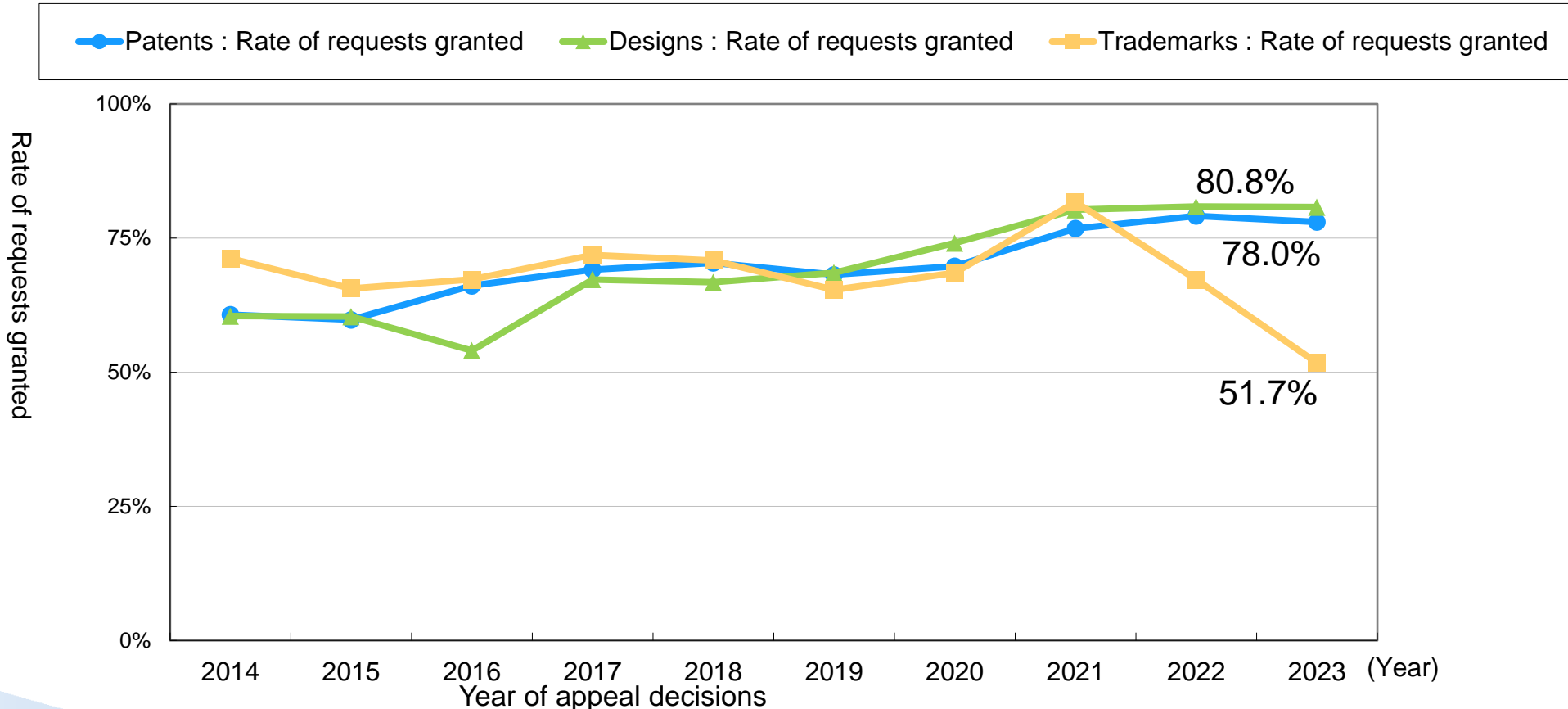
- ✓ Although the number of appeal requests (for designs) has fluctuated, it is approximately 330 requests in 2023.
- ✓ The number of appeal requests (for trademarks) has been increasing in recent years, with approximately 1,100 requests in 2023.
- ✓ Average pendency^{*1} in 2023 is 6.7 months for designs and 10.7 months for trademarks.



*1 Average pendency: Calendar year average from a date of filing a request for appeal to a date of dispatching an appeal decision, a fixed date of withdrawal/abandonment, or a date of dispatching a notice of dismissal.

Appeals Against Examiner's Decision of Refusal: Trend in Rate of Reversing Examiners' Decisions

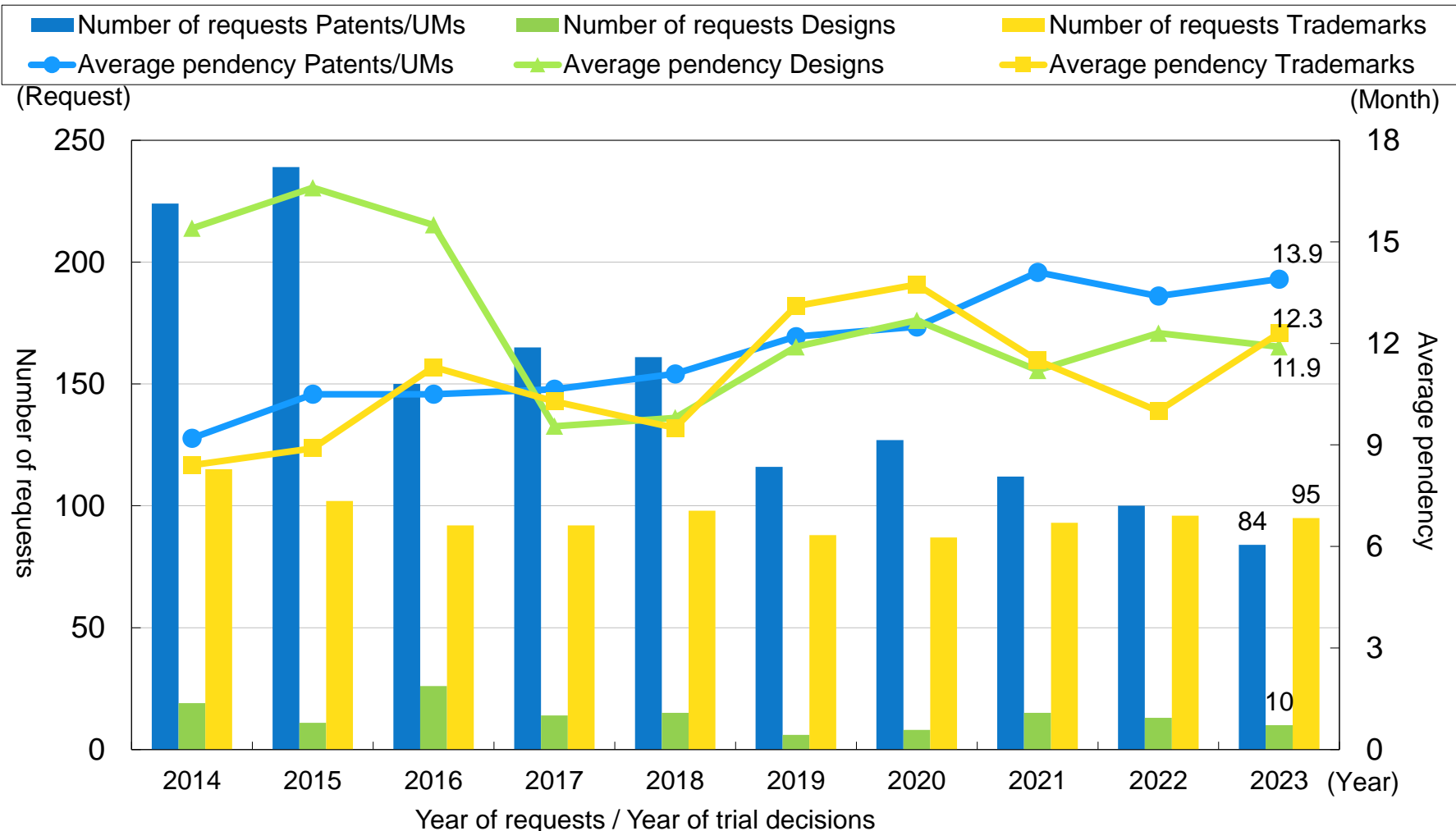
- ✓ Rate of requests granted ^{*1} for patents (rate of reversing examiner's decision of refusal) has been gradually increasing in recent years and reached at 78.0% in 2023.
- ✓ Rate of requests granted for trademarks decreases to 51.7% in 2023.



*1 Rate of requests granted (%) = Number of requests granted / (number of appeal decisions + number of dismissals)
("Rate of requests granted for patents" does not include the number of "examiners' decisions to grant patents upon reconsideration by examiners before appeals.")

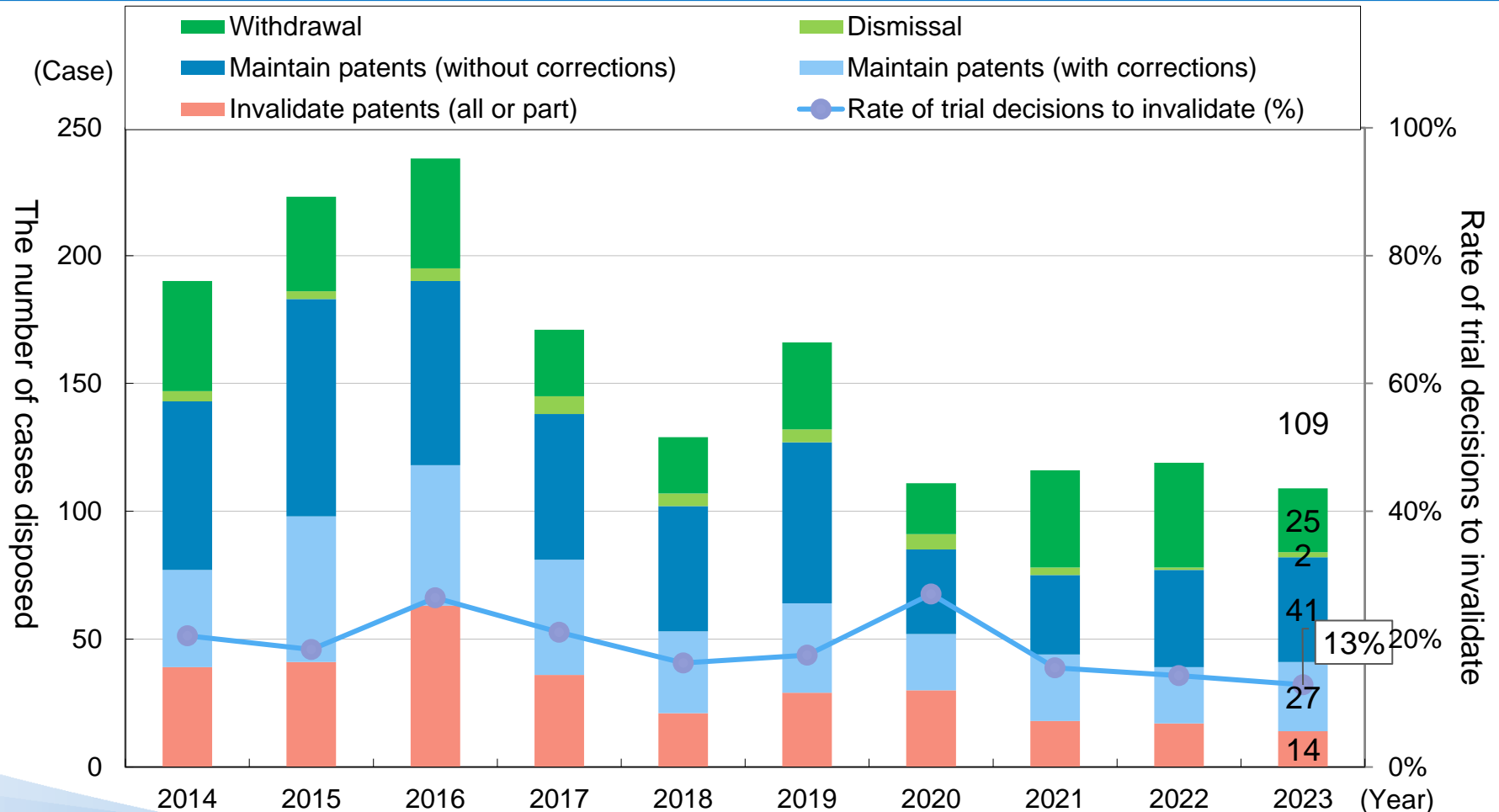
Trials for Invalidation: Trends in the Number of Requests and Pendency

- ✓ The number of requests for trials for invalidation (for Patents / Utility Models (UMs)) has been decreasing since 2016, with 84 in 2023.
- ✓ Average pendency in 2023 is 13.9 months for patents and UMs, 11.9 months for designs and 12.3 months for trademarks.



Trends in the Results of Proceedings (Patents/UMs)

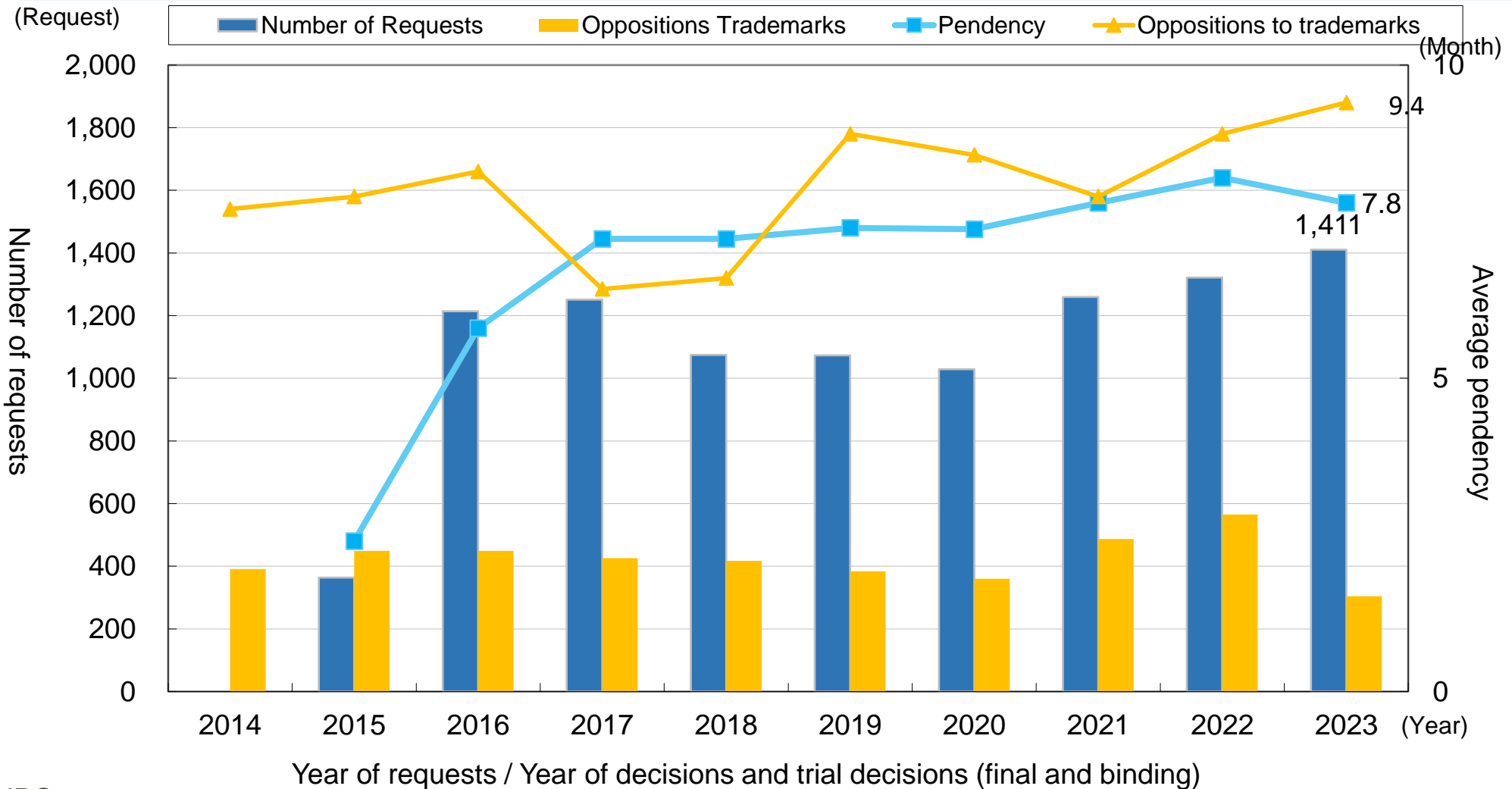
- ✓ The percentage of trial decisions to invalidate in trials for invalidation of the patents / UMs (which means the percentage of requests granted) has generally remained flat in recent years.
- ✓ In 2023, 38% of the trial decisions to maintain the patents were rendered without corrections while 13% of the trial decisions to invalidate the patents were rendered without corrections.



Note: The number of cases disposed = trial decisions to invalidate (dispatched) + trial decisions to maintain (dispatched) + dismissals/withdrawals/ abandonments (final and binding)
 Rate of trial decisions to invalidate = the number of trial decisions to invalidate (dispatched) / the number of cases disposed

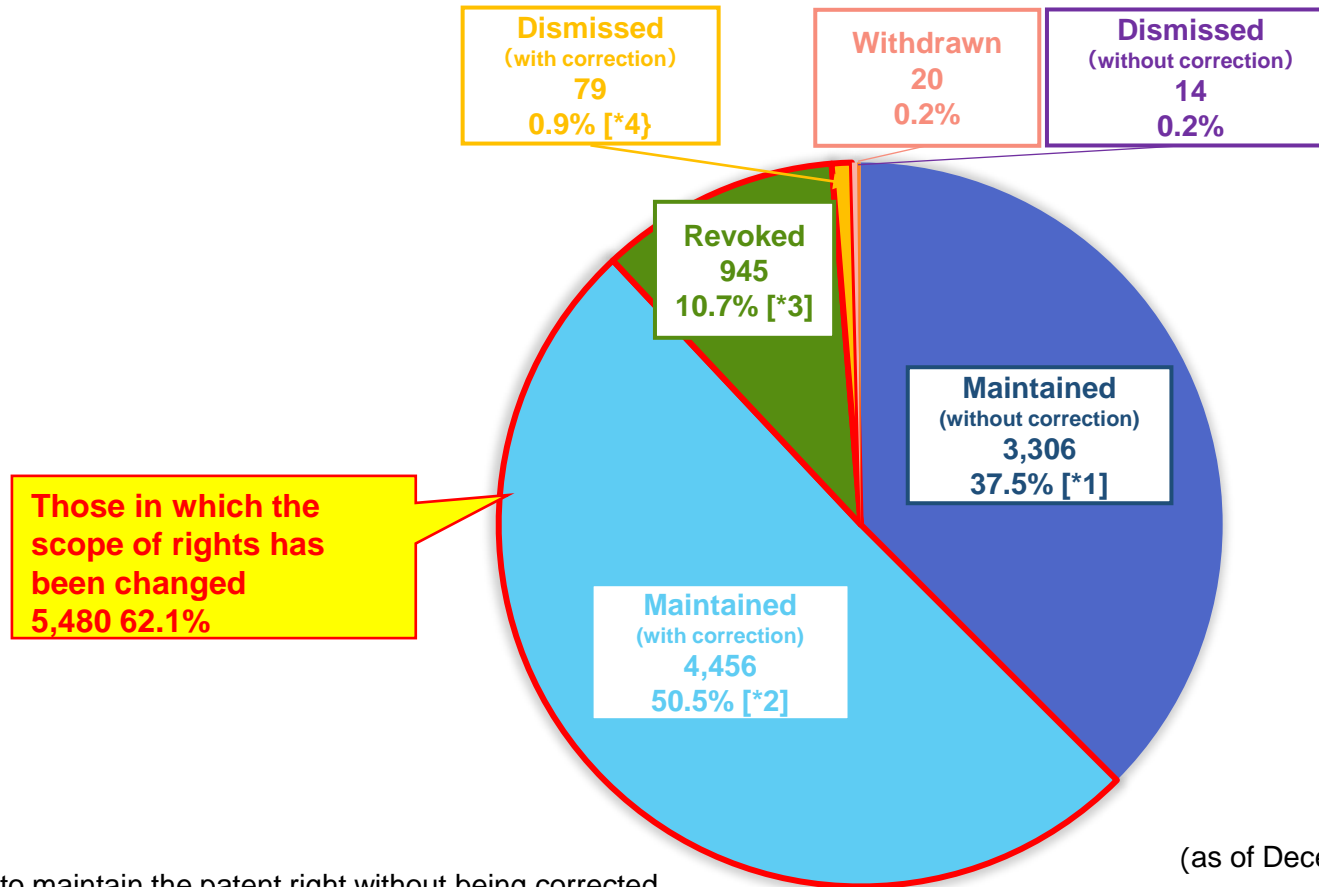
Opposition to Granted Patents: Trends in the Number of Requests and Pendency

- ✓ Number of requests for oppositions to granted patents had been hovering around 1,000 but increased to 1,411 in 2023.
- ✓ Average pendency in 2023: 7.8 months for oppositions to granted patents.



Opposition to Granted Patents: Results of Proceedings

- Among the cases with final dispositions from April 2015 to December 2023, 62.1% resulted in changes to the scope of rights due to opposition.



*1 Decided to maintain the patent right without being corrected.

*2 Decided to maintain the patent right with acceptance of all or part of the corrections.

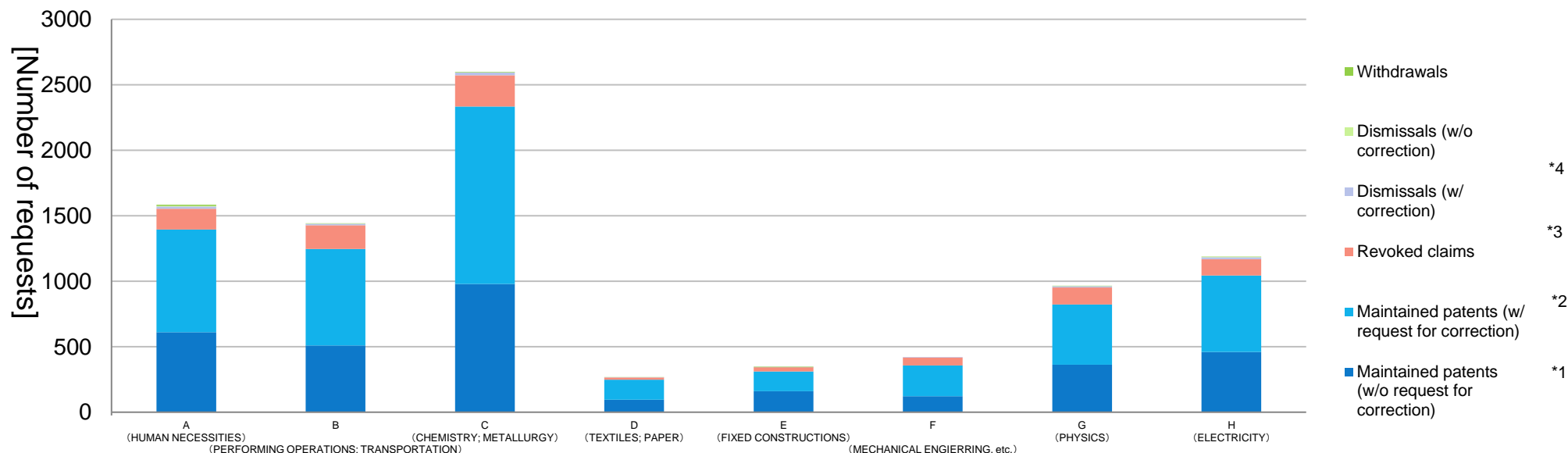
*3 Decided to revoke all or part of the claims that are the subject of opposition.

*4 Dismissed the opposition because of correction that deletes all of the claims that were the subject of the opposition was accepted.

Please note: A ratio between a decision to maintain and a decision to revoke in the certain application year is not finalized until final disposition of all cases in the certain application year has been determined.

Opposition to Granted Patents: Processing Status by Section of IPC Classification (as of December 31, 2023)

- ✓ Many oppositions are filed against the patents in Section C (CHEMISTRY, etc.) of the IPC classification.
- ✓ Number of oppositions filed against patents in Section G (Physics) and Section H (Electricity) is small compared to the number of registration of patents.



Number of requests (ratio) ⁵	1585 (0.6%)	1442 (0.5%)	2600 (1.2%)	269 (1.8%)	347 (0.6%)	422 (0.3%)	965 (0.3%)	1190 (0.3%)
Withdrawals	10	1	3	0	2	0	1	3
Dismissals (w/o correction)	4	1	2	1	0	0	2	4
Dismissals (w/ correction) ⁴	16	11	21	2	1	3	10	15
Revoked claims ³	159	183	240	18	32	61	129	123
Maintained patents (w/ correction) ²	784	736	1354	153	151	235	459	584
Maintained patents (w/o correction) ¹	612	510	980	95	161	123	364	461

*1 Decisions to maintain a patent without any correction or any approval of correction.

*2 Decisions to maintain a patent with approval of correction entirely or partially.

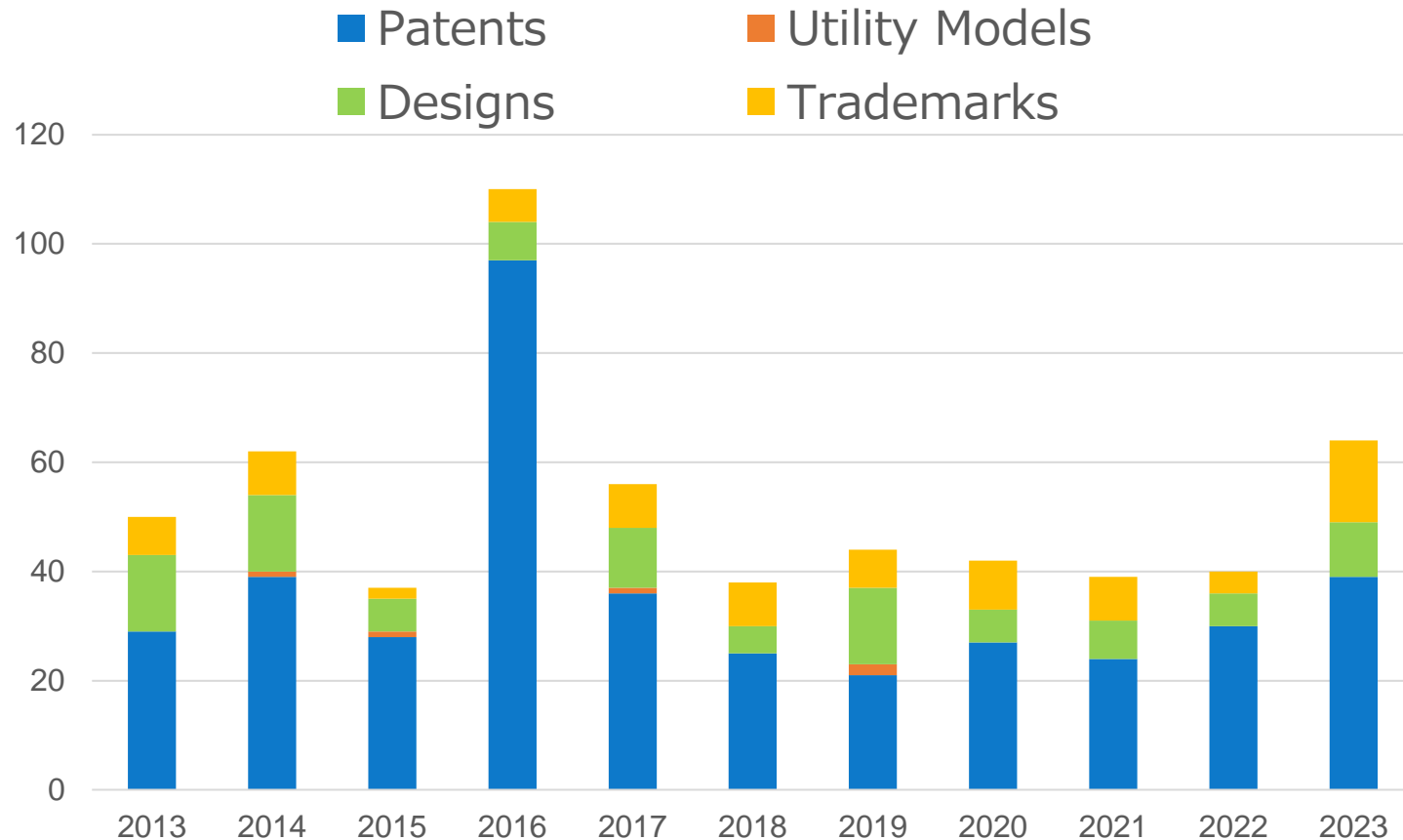
*3 Decisions to revoke the entire claims or partial claims opposed.

*4 Dismissals of the opposition due to approval of correction cancelling the entire claims opposed.

*5 Ratio of the number of patent oppositions to the number of patent registrations.

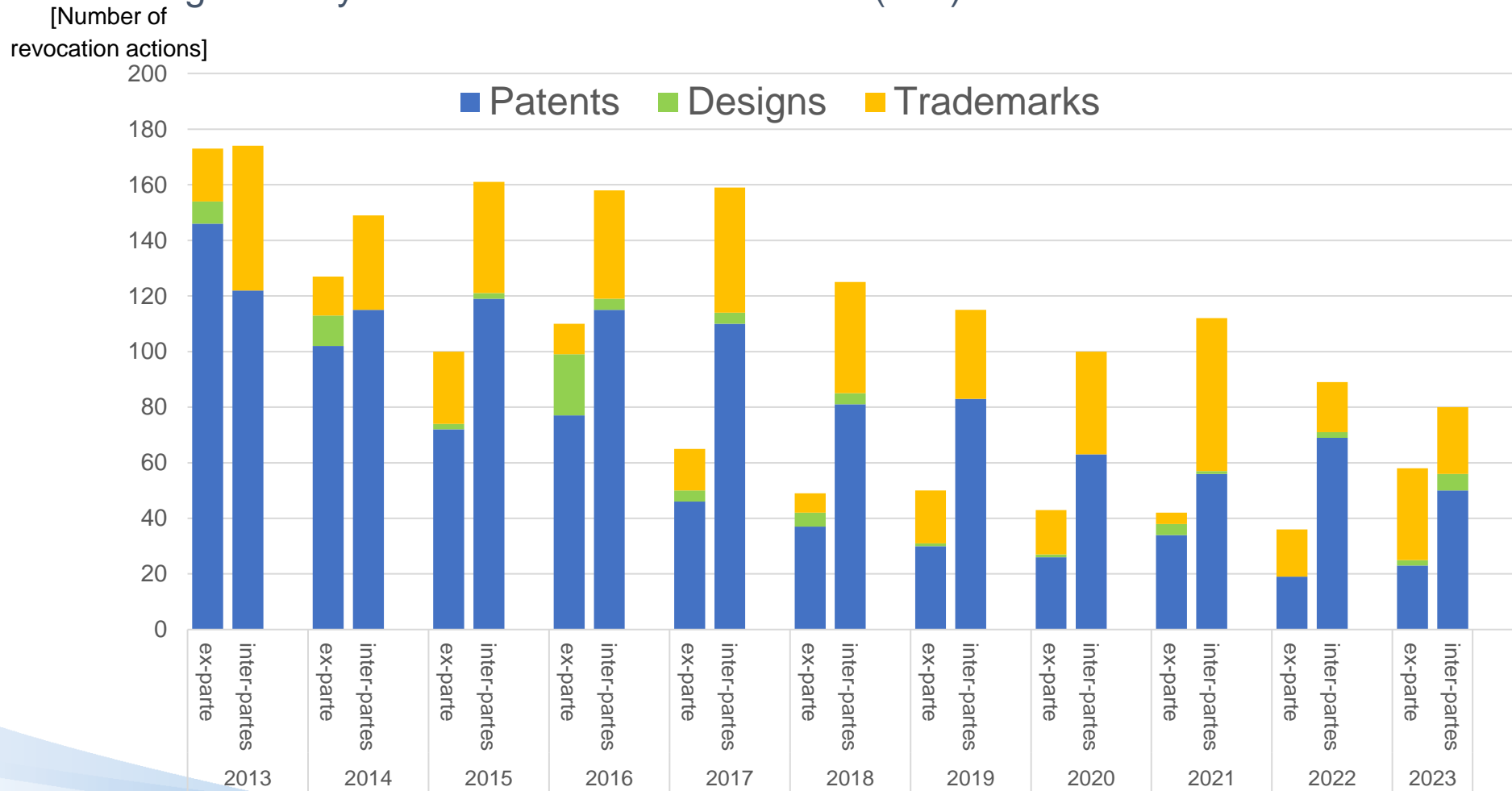
Trends in the Number of Requests for Hantei (Advisory Opinion)

- The number of requests for Hantei for patents has remained at around 30 in recent years.
- Similarly, the number of requests for Hantei for designs and trademarks has remained at less than 10 cases.



Trends in Revocation Actions against Trial/Appeal Decisions (Patents, Designs and Trademarks)

- Compared to the overall number of revocation actions against trial/appeal decisions in 2013 (347), the number of revocation actions in 2022 was significantly decreased to about one-third (124).



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Initiatives of the JPO

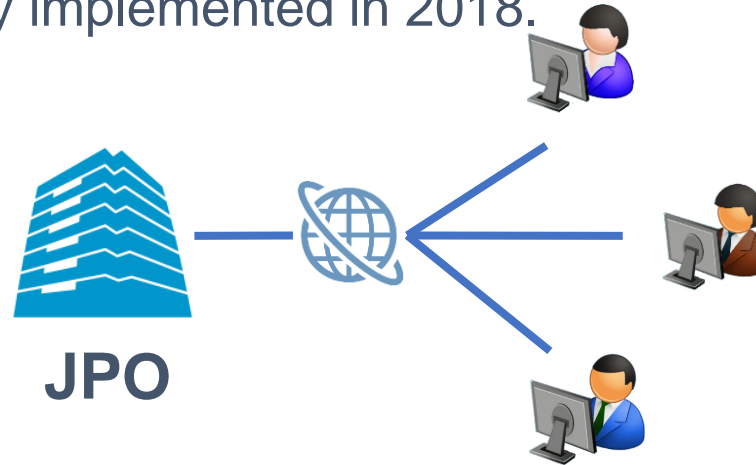
Efforts towards “One JPO”

- ✓ In May 2023, the Trial and Appeal Department, which had been dispersed, was consolidated into the JPO Headquarters. (Designs, trademarks, and some administrative work will be relocated by the middle of FY2025)
- ✓ JPO promotes telework, hot-desking and paperless office.



Promotion of Teleworking

- Based on trial teleworking program that had been in place since 2013, teleworking was fully implemented in 2018.



Teleworking is currently conducted approximately twice a week.



Utilizing Online Meetings.

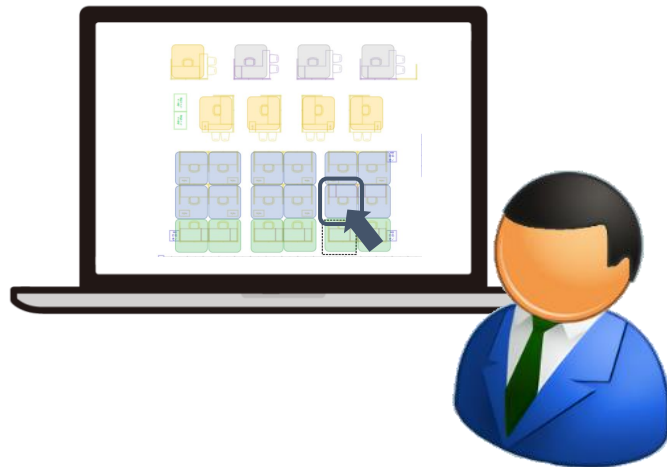


Teleworking support system was introduced to make teleworking environment equivalent to that of the office.

Promotion of Hot-desking System

- Hot-desking system was fully implemented with the relocation of the government office building.

(i) Reserving your own seat in advance. (ii) Performing your duties at reserved seats.



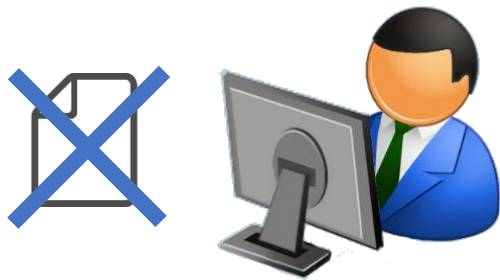
- Advantages of hot-desking system.



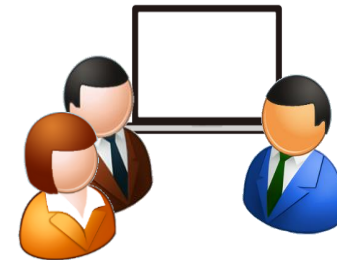
- Can revitalize communication.
- Can effectively use office space.
- Can tidy up desks and office space.

Efforts to Paperless Office

- JPO has been promoting a paperless work environment in conjunction with teleworking, taking into consideration the reduction of information security risks associated with taking paper documents home and the global environment by conserving paper resources.



Paperless proceedings



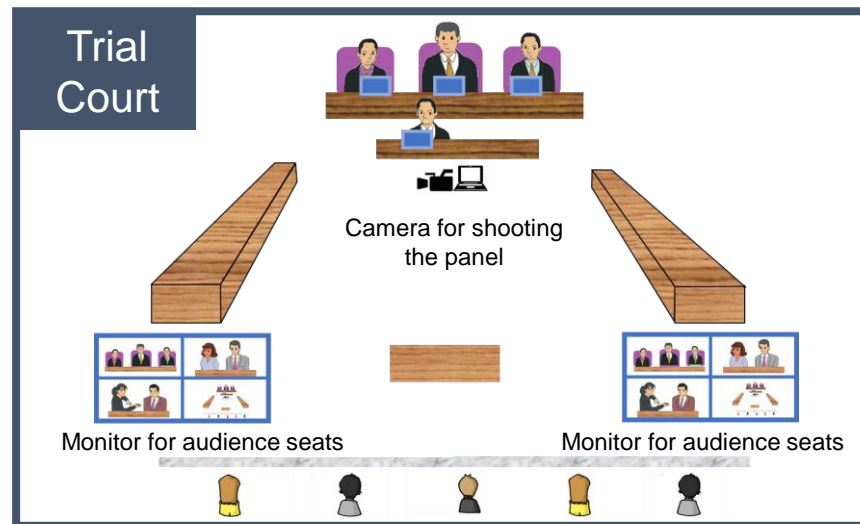
Consultation using displays

Online Oral Proceedings (1)

- The Patent Act, etc. were amended to allow oral proceedings to be conducted without being affected by COVID-19 infection, and to allow parties, etc. residing in a remote area to participate in oral proceedings without having to appear before the trial court (effective October 2021).
- Parties, etc. can now participate in oral proceedings using a web conference system (online oral proceedings). Chief administrative judge may also allow video transmission (online distribution) to the parties and other interested parties, subject to the consent of all parties and other interested parties.



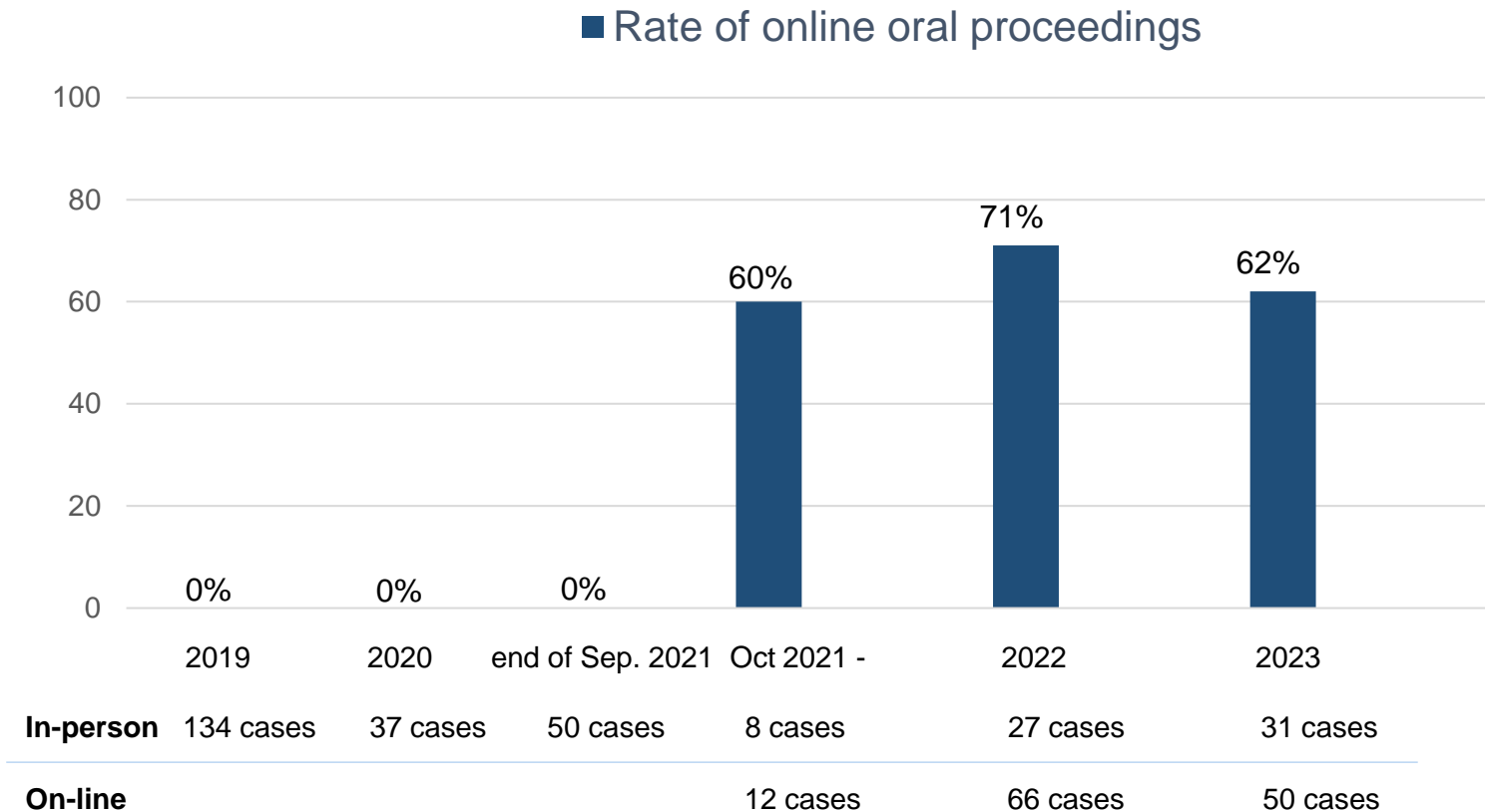
Demandants: remote participation (demandant's corporate meeting room).



Demandees: remote participation (demandee's corporate meeting room).

Online Oral Proceedings (2)

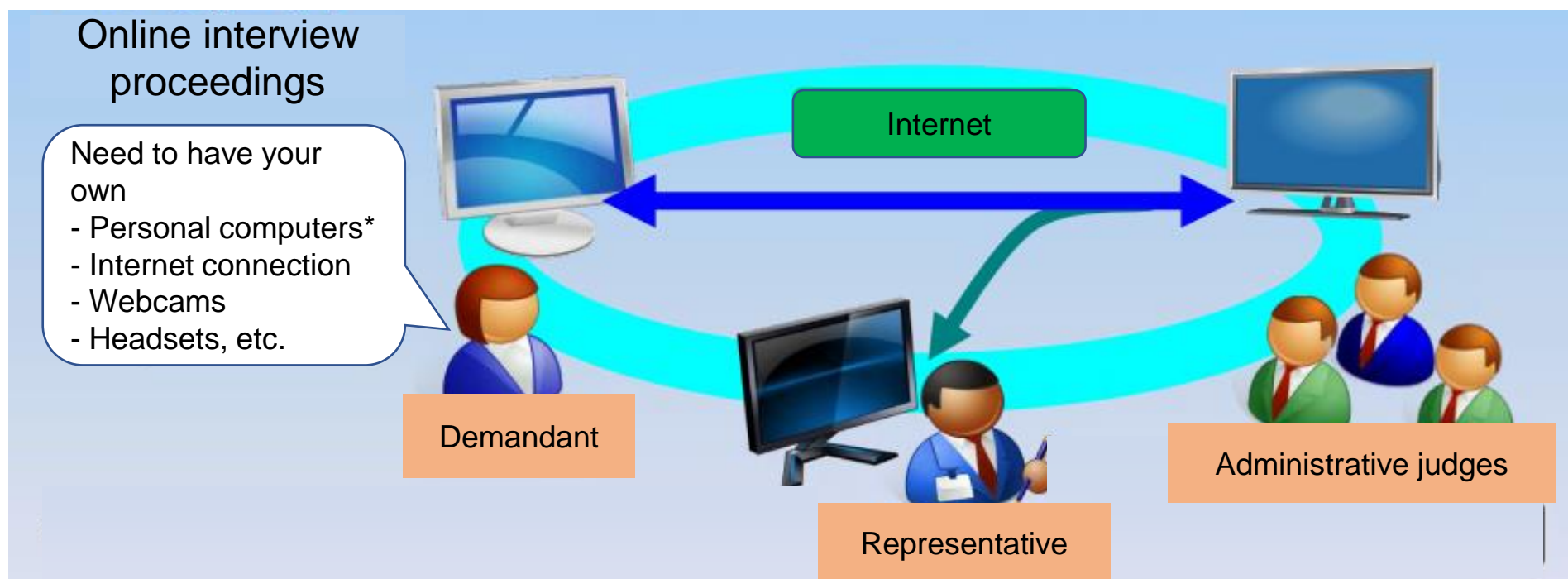
- ✓ The overall number of oral proceedings during the period from the start of operation in October 2021 to the end of December 2023 was 194, of which 128 were conducted online (66% of the total).



Note: 2019 includes patents and utility models (21) in circuit trial examination.

Promotion of Digitization (Online Interview Proceedings)

- ✓ **Online interview proceedings** using a web application are conducted for cases that are open to the public.
- ✓ With the consent of a demandant and a representative, documents may be transmitted via e-mail.



More information on online interview proceedings (Japanese) are available on the website->

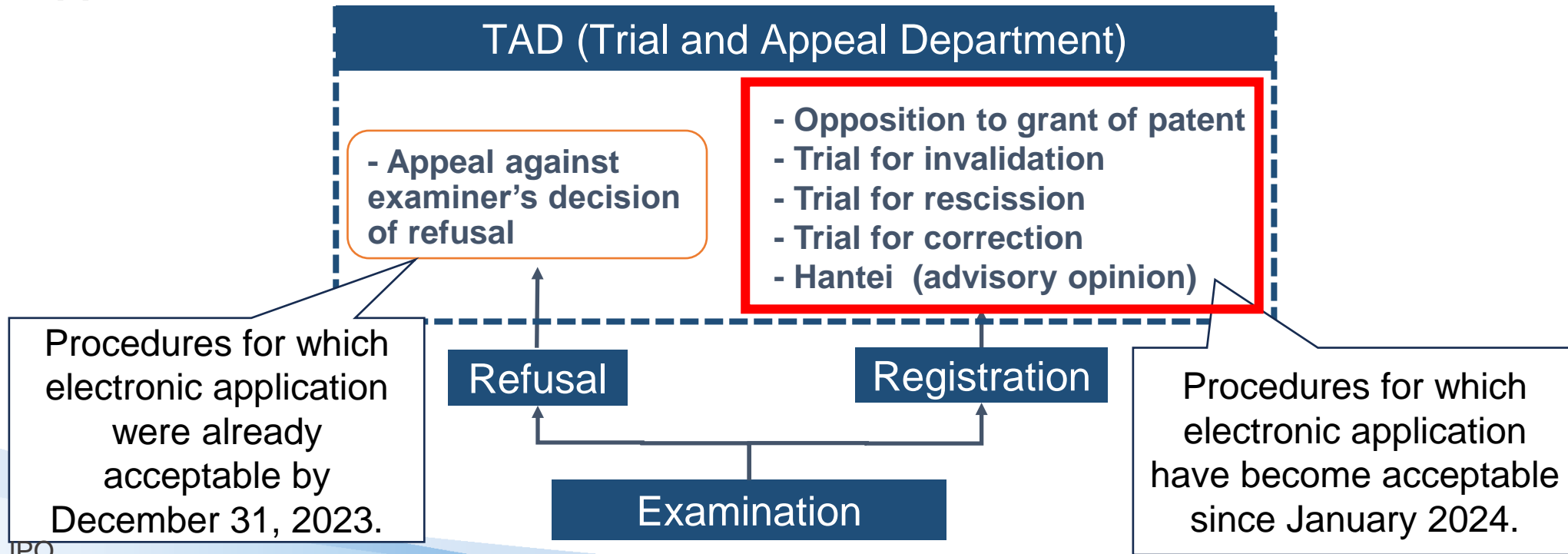
https://www.jpo.go.jp/system/trial_appeal/general-mensetsu/tv-mensetsu.html



Digitization of Trial/Appeal Proceedings

- Up until the end of December 2023, among application documents to be submitted to TAD, only the application documents related to “appeals against examiner’s decision of refusal” were acceptable electronically.
- Electronic filing became, in principle, available for application documents other than “appeals against examiner’s decision of refusal” from January 1, 2024.
- During the period from January to March 2024, 880 of the applications other than “appeals against examiner’s decision of refusal” were submitted electronically (about 26% of the total).

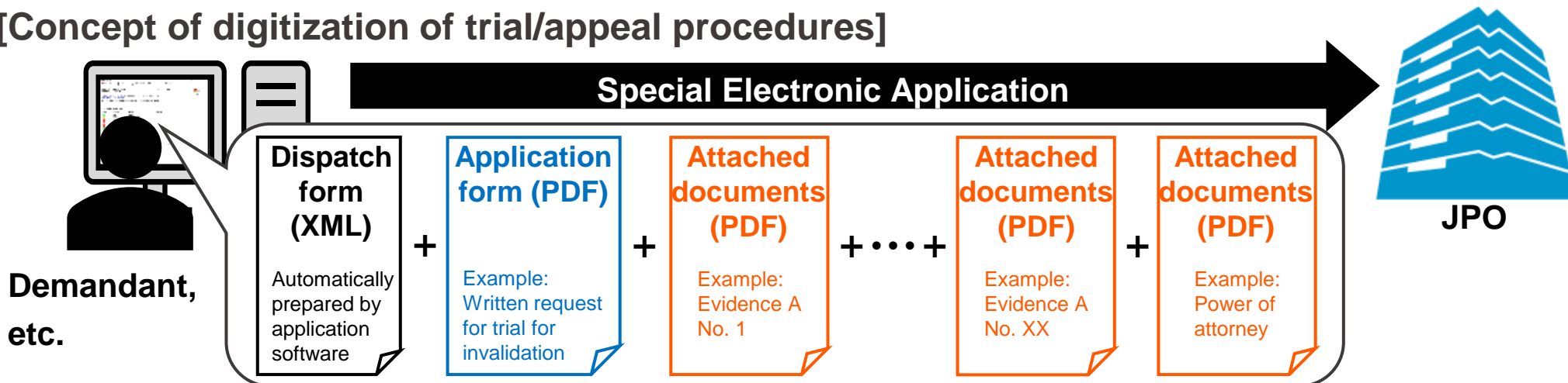
[Application Procedures to TAD]



Promotion of Digitization: Trial/Appeal Proceedings

- ✓ In principle, electronic filing is now available for application documents to be submitted to the JPO for which electronic filing was not previously available.
 - In order to make electronic application filing of new documents available within the system constraints, a function to file an application in an electronic form different from the previous form was added to the application software (called Special Electronic Application).

[Concept of digitization of trial/appeal procedures]



More information on the digitization of trial/appeal procedures are available on the website. ->

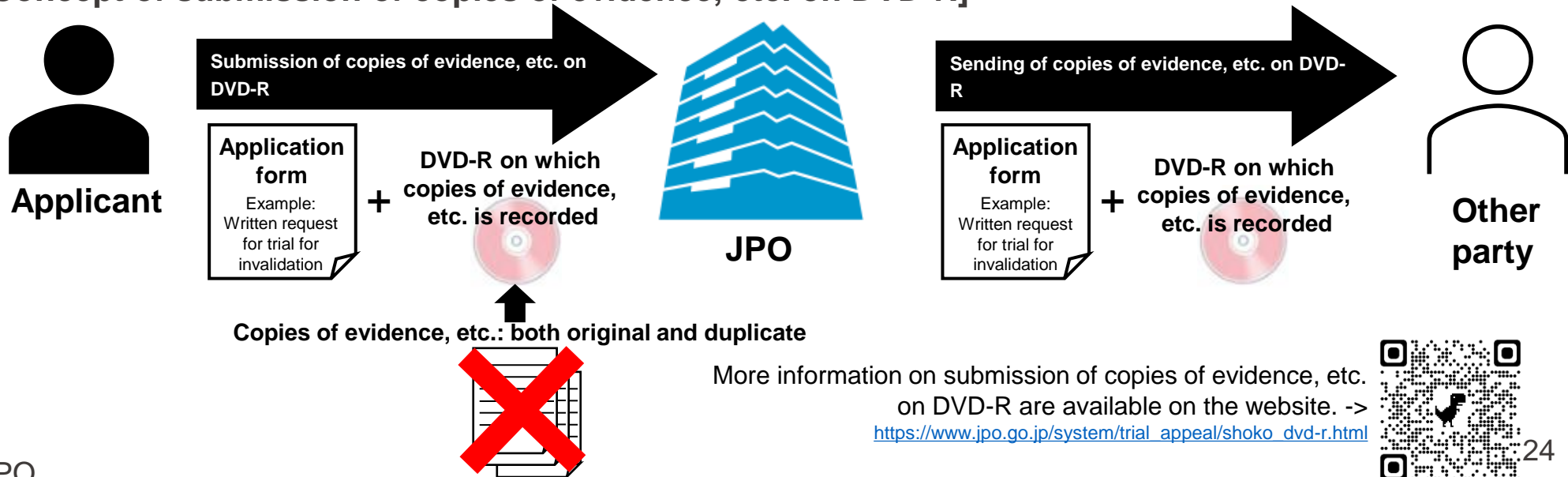
https://www.jpo.go.jp/system/trial_appeal/shinpan_digitalize.html



Submission of Copies of Evidence, etc. on DVD

- ✓ **Digitization of the submission and sending of copies of evidence, etc. was already implemented before Special Electronic Application became available.**
 - Previously, it had been necessary to submit all documents in writing, attaching them to the originals and duplicates of the requests for trials/appeals, etc.
 - Copies of evidence sometimes had exceeded several hundred pages, placing a heavy burden on the demandants, etc.
 - The JPO also had had the burden of checking the identity of the copies of evidence attached to the originals and duplicates.
- ✓ **Submission of copies of evidence, etc. recorded on DVD-R became available instead of in writing**
 - It became possible for the other party to receive copies of evidence, etc. on DVD-R.

[Concept of submission of copies of evidence, etc. on DVD-R]



Trial and Appeal Practitioner Study Group

- The purpose of the Trial and Appeal Practitioner Study Group, which was established in FY2006, is to share the understanding of trial and appeal practice with users of the trial and appeal system by analyzing actual trial and appeal decisions and court decisions, improving future trial and appeal proceedings based on the analysis results, as well as widely disseminating the results of the analyses.
- Corporate IP personnel, patent attorneys, lawyers, and the JPO's administrative judges participate in the group while judges of the Intellectual Property High Court and the Tokyo District Court participate as observers.
- In FY2023, case studies were conducted in a total of six fields: four patent fields, one design field and one trademark field.
- Report summarizing the results of the study is prepared and published (in Japanese and English) on the JPO website.

Topics in the patent/trademark fields and discussion points (FY2023)

Patent: Machinery

- Numerical limitations: Determination of inventive step with respect to different features relating to numerical limitations in the invention.

Patent: Chemistry and Pharmaceuticals

- New matters: To what extent should amendments and corrections that add matters specifying the invention not explicitly stated in the description, etc. be permitted?
- Support requirement: How much statements of embodiments are required in the description?

Patent: Electricity

- Software-related inventions: What should be kept in mind when understanding the functionally expressed features of information and information processing in specifying an invention and identify identical features / different features?

Trademark

- Distinctiveness (Trademark Act Article 3 (1)(iii))

International Cooperation

- Regular meetings and exchanges of opinions with IP Offices and other organizations in each country/region:
 - IP5 Trial and Appeal Boards High-Level Meeting (June 2024).
 - JPO-CNIPA-KIPO Joint Experts Group for Trial and Appeal (December 2023).
 - JPO-CNIPA Trial and Appeal Experts Meeting (December 2023).
 - JPO-KIPO Trial and Appeal Experts Meeting (September 2023).
 - Indo-Pacific Judicial Colloquium on Intellectual Property, Innovation, and Technology: Judicial officials from the Indo-Pacific region meet to discuss IP, innovation and technology (July 2023).



the Indo-Pacific Judicial Colloquium
(July 2023)



IP5 Trial and Appeal Boards High-Level Meeting
(June 2024)

Judicial Symposium on Intellectual Property / TOKYO

- “Judicial Symposium on Intellectual Property / TOKYO (JSIP)” has been co-hosted annually since 2017 by the JPO, the Supreme Court of Japan, the IP High Court, the Ministry of Justice (MOJ), the Japan Federation of Bar Associations (JFBA) and the Intellectual Property Lawyers Network Japan (IPLNET) , inviting IP practitioners.
- 2017, 2019, 2021, 2023: China, Korea, ASEAN and Japan
2018, 2020, 2022, 2024: Europe, United States and Japan



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Director-General, Trial
and Appeal Department,
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Scott R. Boalick, Chief
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Trial and Appeal Board,
the United States Patent
and Trademark Office

Ingo Beckedorf, Chair of
the Technical Board of
Appeal, European
Patent Office

Judicial Symposium on Intellectual
Property / TOKYO 2022



Judicial Symposium on Intellectual
Property / TOKYO 2023

Thank You

