The Actual State of the JPO's Advisory Opinion System and Where it Should Be

The Second Subcommittee,
The Second Patent Committee

In the recent trend of pro-patent, it is anticipated that patent disputes will increase more and more. Solutions to such patent disputes still greatly depend upon the court. On the other hand, however, we can not ignore that not a few of those have come to depend upon alternative dispute resolutions such as the conciliation/arbitration system, etc.

One of the means for solving patent disputes whose exploitation has recently increased is the Advisory Opinion System, under which the Japan Patent Office (JPO) expresses its official opinions on the technical scope of the patented inventions.

This committee implemented a fact-finding survey on the Advisory Opinion System practiced by the JPO, for exploring the way of thinking about a finding of the technical scope of the patented inventions (interpretation of claims) in the JPO, or the differences between the method of finding of the technical scope in the court and in the JPO.

In this article, we have presented the result of the fact-finding survey on the Advisory Opinion System in the JPO and the result of comparison between an advisory opinion of the JPO and a judgment of the court. Specifically, it has been pointed out based on the data of the fact-finding survey that the Advisory Opinion System has been considered through substantially the same process as that of a judgment in the court in the finding of the technical scope of the patented invention and a comparison between patented inventions and the allegedly infringing product/process, and that, the result of an advisory opinion in the JPO and a judgment in the court are substantially not different.

Furthermore, in this article, we have also referred to how the Advisory Opinion System should be, in order to positively exploit it as the alternative means for solving patent disputes, including the way how the Advisory Opinion System and the Conciliation/Arbitration Organization such as the ADR should cooperate together.

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Study of Cases Nullifying/Revoking German/UK Patents Derived from European Patents

The Third Subcommittee,
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Patent rights can be registered in European states through EPC and national routes. The European patent based on the EPC is used mainly to obtain the global Patent right within EPC states and is individually registered in each of the designated states. Under this registered patent, a Patent issue would frequently arise between European firms as well as between a European firm and a non-European firm.

There are cases, however, a European patent could be individually nullified/revoked in an infringement or revocation suit contested within designated states. This is due to the differences in the patentability judgments that possibly exist between the European Patent Office (EPO) and national courts. In fact, in the practices of German/UK courts after the decision of the German Supreme Court in 1995, it is established that the decisions of EPO have no power to bind the decisions made by courts in each state.

This article first explains the patent nullification/revocation process in Germany and UK and matters to be noted. Then this discusses the differences in the criteria of patentability judgments between the EPO and the German/UK courts based on the cases where European patents were nullified/revoked in the latter, in order to explore the stability of European patents. As for the parameters to show the differences in the patentability judgments , there are those relevant to the criteria for novelty/inventive step, interpretation of numerical limitations, requirements of description/disclosure (especially, sufficient description to serve as a ground of the right of priority).

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