An Analysis of the Japanese Patent Information Provision System (Postprint)

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Abstract

[Purpose/Significance] This study analyzes Japan's patent information provision system, aiming to provide valuable insights for constructing a prevention and remedy mechanism for defective patents in China.

[Method/Process] By interpreting the essence of Japan's patent information provision system and its specific implementation rules, this paper examines the effectiveness feedback from years of system implementation.

[Results/Conclusions] Japan's patent information provision system offers the public a zero-cost channel to challenge patent applications and the validity of patent rights. This not only facilitates pre-grant examiners in obtaining beneficial information to achieve more efficient patent examination, but also serves as an important means of widely collecting information on patent validity post-grant. Japan's patent information provision system offers significant reference value for improving the third-party observation system in China's patent examination process, particularly regarding the content, form, and feedback mechanisms for submitting observations.

Full Text

Analysis of Japan's Patent Information Provision System

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Abstract:
[Purpose/Significance] This study examines Japan's patent information provision system to derive valuable insights for constructing an effective remedy mechanism to prevent defective patents in China. [Method/Process] By interpreting

the essential principles and specific implementation rules of Japan's patent information provision system, we investigate the feedback and outcomes from its many years of operation. [Result/Conclusion] Japan's patent information provision system offers the public a zero-cost channel to challenge the validity of patent applications and granted patents. This not only facilitates examiners' access to valuable information before grant, enabling more efficient patent examination, but also serves as a crucial means of broadly collecting validity information after grant. The system provides significant reference value for improving China's public opinion system during patent examination, particularly regarding the content, format, and feedback mechanisms for public submissions.

Keywords: Patent Information Provision System; Defective Patents; Patent Examination
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To ensure patent quality and reduce missed or erroneous examinations due to insufficient time, resources, and capacity, most patent systems worldwide incorporate administrative supervision and remedy mechanisms for defective patents. Japan's explorations and improvements in this area merit particular attention. Through multiple amendments to its Patent Act, Japan has established four distinct systems to prevent and correct defective patents: the information provision system (available to any person before and after grant), the correction trial (available to patentees after grant), the opposition system (available to any person within six months after grant), and the invalidation trial (available to interested parties after grant). Both the correction trial and invalidation trial are administrative procedures under the jurisdiction of the Japan Patent Office (JPO). Among these four systems, the patent information provision system uniquely spans the entire timeline from application to post-grant, providing a zero-cost channel for the public to submit prior art references. This significantly enriches examiners' access to comparative documents and serves a crucial preventive and remedial function: pre-grant information provision helps examiners filter through massive numbers of applications, conserving examination resources while improving efficiency and quality, while post-grant information provision continues to offer a free channel for submitting prior art to patentees, opposition filers, invalidation trial petitioners, and the general public, informing their subsequent strategic decisions and providing reference for JPO proceedings.

Current research in China on Japan's defective patent prevention and remedy mechanisms has focused primarily on the opposition, invalidation trial, and correction trial systems, with scant attention paid to the information provision system. Research on this specific mechanism remains nearly nonexistent. However, both legislatively and practically, the information provision system plays a significant role in Japan's defective patent prevention and remedy framework. It is one of the most frequently utilized systems by the public and has effectively

maintained and promoted the sound development of Japan's patent system. This article provides an in-depth examination of Japan's information provision system from the perspectives of its essential principles, implementation rules, operational effects, and implications for China, aiming to offer empirical reference for China's fourth amendment to its Patent Law.

The Essence of Japan's Patent Information Provision System

Japan's information provision system is stipulated in Articles 13-2 and 13-3 of the Patent Act Enforcement Regulations. The system allows any person to submit to the JPO evidence demonstrating that a patent application or granted patent fails to meet patentability requirements such as novelty and inventive step in its specification or claims. The system operates in two distinct phases—pre-grant and post-grant—with corresponding functional differences.

Pre-Grant Information Provision

Pre-grant information provision (Article 13-2 of the Patent Act Enforcement Regulations) aims to enhance examination accuracy and efficiency while preventing defective patents. Upon receiving a submission, the JPO notifies the patent applicant and makes the submission publicly available. The applicant may then decide whether to proceed with the substantive examination request, while examiners can reference the submission when determining whether to grant the patent. Because patents confer strong exclusive rights that restrict others' use of the technology, particularly for competitors, a rival's patent grant may mean loss of competitive advantage and economic benefits. Although post-grant remedies like opposition and invalidation remain available, they suffer from unavoidable disadvantages: both require real-name filing and payment of fees, and most critically, the patent is presumed valid during proceedings, prohibiting unauthorized implementation. This forces companies to halt production and R&D activities during what can be lengthy proceedings, causing substantial losses. Consequently, many IP-conscious firms, particularly those with dedicated IP departments, actively monitor competitors' patent applications and portfolio strategies. When potentially detrimental applications emerge, they proactively utilize the information provision system to submit evidence of non-patentability, thereby blocking grant. Compared to JPO examiners, these firms possess stronger motivation and greater capacity to locate relevant prior art, making their contributions invaluable for defect prevention.

Post-Grant Information Provision

Post-grant information provision (Article 13-3 of the Patent Act Enforcement Regulations) aims to collect validity information and broaden public channels for challenging patents. Upon receipt, the JPO notifies the patentee and publicly discloses the submission, which is then preserved in the patent dossier. If

the patent later enters invalidation, correction, or opposition proceedings, all information submissions are included in the trial record for the panel's review, which may examine them ex officio to enhance efficiency. Although post-grant submissions do not directly trigger examination proceedings, they serve important remedial functions. First, they help prevent disputes by giving patentees an opportunity to reassess their patents before market deployment. If issues are identified, patentees can proactively file correction trials to eliminate defects, ensuring patent stability and quality while potentially enhancing economic value. Second, they provide reference materials for opposition or invalidation petitioners, who can supplement and strengthen their own arguments by reviewing others' submissions against the same patent. Macroscopically, the information provision system improves examination quality through public participation in prior art submission while providing post-grant challenge channels, thereby increasing the likelihood that defective patents receive remedy and maintaining a sound patent system.

Implementation Details of Japan's Patent Information Provision System

Japan's Patent Act Enforcement Regulations specify detailed implementation rules that help users understand and properly utilize the system while enabling examiners to process submissions efficiently, maximizing systemic benefits.

Filing Party

Any person may file submissions with the JPO, including anonymously. In practice, companies choose anonymous filing for two primary reasons: concealing competitive relationships or preserving cooperative partnerships. When competing, firms prefer not to reveal their research directions or technical interests; when cooperating, they avoid openly challenging partners' patents to maintain established relationships. The anonymity feature accommodates these needs.

Filing Timeframe

Submissions may be filed after patent application submission. Japan's approach is distinctive in extending beyond the application phase to continue after patent registration, thereby enriching public channels for challenging granted patent validity.

Subject of Filing

Pre-grant submissions target applications pending before the JPO, regardless of whether the applicant has requested substantive examination. Applications not under JPO processing (e.g., rejected, abandoned, or withdrawn applications) are excluded. Post-grant submissions target all granted patents.

Types of Submittable Materials

Only documentary evidence is accepted; non-documentary materials (e.g., surveillance footage DVDs) are excluded. Representative "documentary" materials include "publications," "copies of specifications, claims, and drawings attached to patent applications," or "other documents" such as product catalogs and experimental data.

Feedback Mechanism

The system incorporates three feedback channels. First, the JPO notifies patent applicants or patentees upon receiving a submission. Second, real-name filers may request feedback on information utilization, receiving confirmation whether their submission was used in rejection notices issued before or immediately after their filing (but not for subsequent notices or final outcomes). Third, all submissions are publicly disclosed after receipt, enabling public oversight and preventing duplicate submissions.

Information Content

Submissions may address ten categories of patent law violations: (1) new matter added through amendment, violating Article 17-2(3); (2) non-inventions or industrially inapplicable inventions, violating Article 29(1); (3) lack of novelty, violating Article 29(1); (4) lack of inventive step, violating Article 29(2); (5) conflicting applications, violating Article 29-2; (6) later-filed applications, violating Article 39; (7) inadequate description requirements, violating Article 36(4)(i); (8) failure to cite known prior art documents, violating Article 36(4)(ii); (9) defective claim requirements, violating Article 36(6); and (10) failure to submit Japanese translations for foreign-language applications, violating Article 36-2(2).

Implementation Effects of Japan's Patent Information Provision System

Annual filing statistics demonstrate the system's robust operation within Japan's patent framework [FIGURE: 1]. First, the volume is substantial: although recent years have seen decreases from peak levels, the JPO still receives approximately 6,000 submissions annually—far exceeding the number of opposition, invalidation, and correction trials filed. Second, the quality is high: according to a December 2013 survey, examiners incorporated information from submissions into rejection notices at a rate of 73%. Since January 2009, the system has offered online filing in addition to paper submissions, enhancing public accessibility; online filings now account for approximately one-third of total submissions. These data underscore the system's significant contribution to preventing defective patents in Japan.

Implications for Japan's Patent Information Provision System for China

China's current administrative remedy system for defective patents includes pre-grant public opinion procedures and post-grant invalidation declarations. While functionally similar to Japan's information provision system, China's pre-grant public opinion mechanism shows markedly different implementation effectiveness. At the normative level, China's system lacks specificity. The Patent Law Implementation Rules Article 48 and the Patent Examination Guidelines Part II, Chapter 8, Section 4.9 provide only general principles for examiner handling of public opinions, without specifying filing formats, methods, grounds, or feedback mechanisms. In contrast, Japan's detailed regulations offer valuable lessons for improvement.

Standardizing Public Opinion Filing Format and Content

China's current provisions grant the public considerable freedom but make it difficult for filers to identify effective submission methods, forcing them to rely on "subjective initiative." However, since the system's purpose is to enrich examiners' access to prior art for efficient and accurate examination—not to solicit creative submission formats—standardization would better serve systemic functions. Specific improvements could include: (1) standardizing submission forms covering filer information, patent application details, grounds, and feedback preferences, with options for real-name or anonymous filing; (2) specifying submission methods (written or online through dedicated channels); (3) clarifying permissible grounds based on specific Patent Law provisions; and (4) defining acceptable material types, limiting them to documentary evidence.

Establishing Feedback Mechanisms

Feedback should be provided to filers, applicants, and the public. Filers should have the right to know whether their submissions were utilized, contingent on real-name filing and explicit feedback requests. This creates institutional incentives and enhances trust in the system. Patent applicants should receive copies of public opinions, enabling them to abandon unpromising applications (reducing 沉没成本 and examination burden) or proactively amend claims to accelerate grant. Finally, based on the principle of application publication, public opinions should be publicly disclosed to prevent duplicate submissions and conserve social resources.

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Author Contributions:
Xiao Dongmei: Participated in conceptualization and revision of the full manuscript.
Liu Dian: Conceived the study, drafted the initial manuscript, and conducted subsequent revisions.

Abstract: [Purpose/Significance] The study aims to seek inspirations for building up remedy mechanism to prevent patent defects by delving into the patent information system of Japan. [Method/Process] The researcher interprets the content of Japanese Third-party Observation System, assesses its performance, and investigated its functional changes. [Result/Conclusion] The Third-party Observation System of Japan undoubtedly provides the public with a zero-cost channel to check patent defects. It enables examiners to access relevant information before the patent is granted, so that effective and accurate patent examination can be achieved; moreover, it is a critical approach to collect patent information of patent right after the patent is granted. The system can offer some guidance for improving public involvement of Chinese patent examination, especially for the content, the method and the feedback mechanism.

Keywords: Third-party Observation System; defective patents; patent examination

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Figures

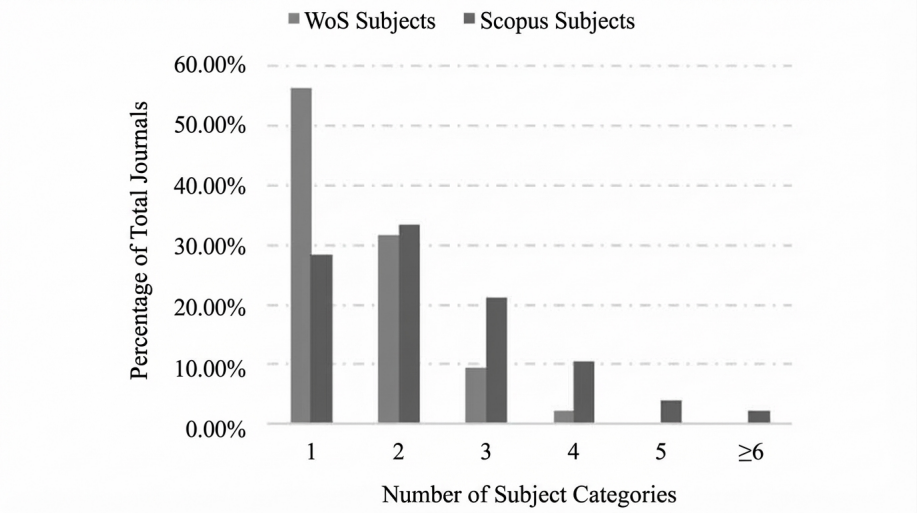

Figure 1: Figure 2