Japan

“Right to Be Heard”

Patent Act, Sec. 153(2) – *X v. Universal Entertainment Co., Ltd.*

Intellectual Property High Court

4 July 2012

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The right of an applicant to be heard prior to a dismissal of the application refers to those grounds the party had no opportunity to comment upon. It is not necessary for the Patent Office to hear the applicant in respect of an assessment of similarities and differences of the invention with a prior art the applicant had an opportunity to comment upon.

Where the plaintiff asserts that the trial decision has an illegal procedural defect, which violates Sec. 153(2) Patent Act, the decision to refuse the application identified other similarities and differences between the patented invention and the prior art than those argued by the applicant, without notifying the latter of it giving him an opportunity to present opinions. Section 153(2) Patent Act requires the Office to hear the applicant for “any grounds not pleaded by a party”. According to the court, this refers to new grounds for invalidation, new facts or new documents, as in such case it would be extremely unfair if the applicant was not heard prior to a decision to dismiss the application. But a decision that identifies other similarities and differences with respect to prior art than those argued by the applicant is not contrary to Sec. 153(2), even if the applicant is not notified thereof prior to a negative decision.

Summarised by Hisayoshi Yokoyama.