

Procedural Rules for Center's Advisory

Opinion Chapter 1: General Provisions

Article 1 (Purpose)

These rules provide for the matters necessary to conduct proceedings in order to issue an advisory opinion (hereinafter, the "Advisory Opinion") by the Japan Intellectual Property Arbitration Center (hereinafter, the "Center").

Article 2 (Types of Opinions)

The Center's Advisory Opinions shall be of two types, depending on the parties' choice: the unilateral opinion which shall be given based on the allegations and evidentiary materials presented by the applicant; and the bilateral opinion which shall be given based on the allegations and evidentiary materials, presented by both the applicant and the respondent as identified in the submitted application.

Article 3 (Matters to be Considered)

The applicant may make an application for an Advisory Opinion with regard to any of the matters as provided in Items (i) through (iv):

- (i) whether or not a specific product or method falls within the technical scope of the patent invention or registered utility model;
- (ii) whether or not a specific design falls within the scope of the registered design and similar design thereto;
- (iii) whether or not a specific mark falls within the scope of the trademark right or effect of the right based on defensive trademark registration; or
- (iv) whether or not there are grounds for invalidation in the patent or registration with regard to a specific patent, utility model registration, design registration, or trademark registration (including defensive trademark registration, hereinafter, the same) provided, however, that this shall be limited to the application for an Advisory Opinion based on the grounds specified by the applicant.

Chapter 2: Procedure

Article 4 (Application)

- (1) The applicant shall submit one original of a written application to the Center which includes the following items, with the number of duplicates equal to the total number of respondents and panelists:
 - (i) the name (or title, hereinafter, the same), domicile (or residence, hereinafter the same), and contact information (telephone number, fax number, e-mail address) of the applicant, and name of the applicant's representative if the applicant is a juridical person;
 - (ii) the name and domicile of the respondent, and name of the respondent's representative if the respondent is a juridical person;
 - (iii) the names, domiciles, and contact information (telephone numbers, fax numbers, e-mail addresses) of agents, if any;
 - (iv) the gist of the application;
 - (v) the grounds for the application; and
 - (vi) identify whether the applicant requests a unilateral opinion or a bilateral opinion.

- (2) The grounds for the application as provided in Item (v) of the preceding Paragraph shall include the following items, depending on the types of matters requested:
 - (i) The Advisory Opinion with regard to the matters as provided in Article 3 Items (i) through (iii) (hereinafter, the "Scope Determination"):
 - (a) the circumstances which have led to the application for an Advisory Opinion,
 - (b) file history of the patent, utility mode registration, design registration, or trademark registration subject to the Advisory Opinion,
 - (c) explanation of the patent invention, registered utility mode, registered design, or registered trademark (hereinafter the "Subject Matter") subject to the Advisory Opinion,
 - (d) explanation of the specific product or method, design or mark (hereinafter, the "Subject Product, etc.") on which the Advisory Opinion is requested,
 - (e) comparison between the Subject Matter and Subject Product, etc.,

- and
- (f) the applicant's allegations with respect to common points and different points, etc.
- (ii) The Advisory Opinion with regard to the matter as provided in Article 3 Item (iv) (hereinafter, the "Invalidation Determination"):
 - (a) the circumstances which have led to the application for an Advisory Opinion,
 - (b) file history of the patent, utility mode registration, design registration, and trademark registration subject to the Advisory Opinion,
 - (c) explanation of the Subject Matter,
 - (d) comparison between the Subject Matter and references, etc., and
 - (e) the applicant's allegations that there are grounds for invalidation in the Patent or Registration.
- (3) The applicant shall attach the following items to the written application:
 - (i) the certificate of qualification for the applicant's representative if the applicant is a juridical person;
 - (ii) the certificate of qualification for the respondent's representative if the respondent is a juridical person;
 - (iii) the document which proves an agent's representative capacity, if an agent has been appointed;
 - (iv) documentary evidence; and
 - (v) duplicates of documentary evidence (the number of duplicates shall be the sum of the number of respondents and panelists).
- (4) An agent shall be a person who is admitted as a representative under the laws and regulations or whom the Center considers proper.

Article 4-2 (Receipt of Application)

- (1) The Center shall receive the application when it finds that the application satisfies the requirements defined in the preceding Article and the application fee defined in Article 17 (1) has been paid; provided, however, that the Center may, in its discretion, reject the receipt of the application in case where the

Center finds that the application is inappropriate for Advisory Opinion. When the Center decides to reject the receipt of the application the Center shall immediately notify the decision to the applicant.

- (2) The procedure of the Advisory Opinion shall commence upon the Center's receipt of the application for Advisory Opinion.

Article 5 (Acceptance Confirmation Procedure in Bilateral Opinion)

- (1) The Center shall, promptly after receipt of an application for a bilateral opinion, notify the respondent that such application for a bilateral opinion has been made, send it duplicates of the written application and documentary evidence, and require that the respondent answer in writing whether or not it intends to be present at the proceedings or not.
- (2) The panelists shall request a submission of a written answer, and shall designate a deadline for submitting such written answer.
- (3) In the case where the respondent does not submit a written acceptance within the reply deadline from the date of its receipt of notice of the application for an Advisory Opinion, the Center may deem this as the respondent's refusal to accept.
- (4) The Center shall request giving a due period for the applicant to answer in writing on its choice to request for a unilateral opinion or to withdraw the application in case where the respondent does not accept to be present at the proceedings (including the case defined in the preceding Provision).
- (5) The application is transitioned into that for a unilateral opinion if the unilateral opinion is chosen in the preceding Provision.
- (6) The Center may, in its discretion, deem that the application is withdrawn in the case where the applicant does not answer within the due period for answer defined in Provision 4.

Article 6 (Written Answer)

- (1) The written answer as provided in the preceding Article, Paragraph (2) shall include an answer to the gist of the application described in the written application, affirmation or denial with regard to the grounds for the application, and the respondent's allegations, and one original copy thereof shall be submitted with the number of duplicates equal to the total number of applicants and panelists.
- (2) Paragraph (1), Items (i) through (iii), Paragraph (3) (excluding Item (iv)) and

Paragraph (4) of Article 4 shall apply mutatis mutandis to submission procedure of the written answer.

Article 7 (Appointment of Panelists)

- (1) The Center shall promptly appoint one attorney-at-law and one patent attorney from a list of panelist candidates which the Center maintains at all times (hereinafter, the “list”) when it receives an application for a unilateral opinion (including the case where an application for a bilateral opinion is transitioned into that for a unilateral opinion) or the respondent accepts to be present at the proceedings in an application for a bilateral opinion. This applies to the case where the number of panelists is lacking for reasons of death or resignation of panelists, and similar scenarios.
- (2) Where the Center has received a motion related to the circumstances in the preceding Paragraph, from any of the panelists, it shall appoint one additional panelist from the list.

Article 8 (Obligation to Disclose Information Regarding other Interests)

- (1) The applicant may, upon written application, and the respondent may, upon written acceptance, designate a person whom they consider to be an interested third party in connection with the case, by making such designation of such interested persons in writing. The Center shall not disclose the written designation of particular interested persons to others including the other party to the relevant case but only to the panelist candidates.
- (2) A panelist shall, upon its appointment, submit to the parties to the Advisory Opinion (hereinafter, the “Parties”) and the Center, a written document with respect to the panelist’s interests and shall without delay, fully disclose any circumstances likely to give rise to justifiable doubts as to its impartiality or independence where such circumstances exist or has occurred.

Article 9 (Challenge of Panelists)

- (1) Where circumstances exist with respect to a panelist that give rise to justifiable doubts as to the panelist’s impartiality or independence, the parties may request to challenge such panelist.
- (2) The Center shall decide that the grounds for a challenge exist when it determines that there are sufficient grounds for the request as provided in the preceding Paragraph.

Article 10 (Cross Application for Invalidation Determination in Bilateral Opinion)

- (1) The respondent may make an application for an invalidation determination (hereinafter, the “Cross Invalidation Determination”) with regard to Subject Matter against the applicant in the proceedings of the Scope Determination.
- (2) The examination of an application for a Cross Invalidation Determination and the examination of an application for an Advisory Opinion, which has been applied for, shall be conducted in consolidation.

Article 11 (Principle of Oral Hearing)

The panelists shall hold oral hearings to give the parties an opportunity to express their opinions on the matters on which the issuance of Advisory Opinion is requested provided, however, that this shall not apply to the case where the applicant has represented that an oral hearing is unnecessary, and the panelists considered it proper, in case of the unilateral opinion.

Article 12 (Duration of Examination)

The Center aims to complete these proceedings within three months from the date of the Center’s receipt of an application for a unilateral opinion, and within four months from the date the Center receives a written answer in case of the bilateral opinion.

Chapter 3: The Center’s Advisory Opinion

Article 13 (Written Advisory Opinion)

- (1) The conclusion of the Center’s Advisory Opinion shall be notified in writing and written Advisory Opinion shall be sent to the applicant in a unilateral opinion and to both parties in a bilateral opinion.
- (2) The reasons for the panelists’ opinion shall be described in the written Advisory Opinion.
- (3) Disclosure of the written Advisory Opinion to any third party shall be done solely at the parties’ discretion, and the Center shall not bear any responsibility for such disclosure by the parties.
- (4) A description of the written method for such Advisory Opinions shall be provided in detailed rules, issued separately.

Article 14 (Nature of Advisory Opinion)

The Advisory Opinion is an opinion of the panelists appointed by the Center, and it shall have no binding force on any person.

Article 15 (Appeal)

No appeal may be entered against an Advisory Opinion.

Article 16 (Withdrawal)

An applicant may withdraw its application for a unilateral opinion at any time, until the written Advisory Opinion has been sent, and an applicant may withdraw its application for a bilateral opinion, at any time before the respondent's acceptance, or with the respondent's consent after its acceptance.

Chapter 4: Fees

Article 17 (Fees)

- (1) The parties shall pay the fees as provided in the appendix.
- (2) Where the respondent, who has received an application for a Scope Determination, gives notice the Center that it will make an application for a Cross Invalidation Determination within two months from the date of receipt of service of a written application, and it submits a written application for an Invalidation Determination before the conclusion of the examination of said Scope Determination, the Cross Invalidation Determination application fee as provided in the appendix shall apply to the application fee.
- (3) The application fee as provided in Paragraph (1) shall be paid promptly after application, and the fee for hearing dates shall be paid promptly after each hearing.
- (4) In the case the fee is not paid, or the fee paid is lacking, the Center may request the parties to pay the shortfall within one week from the date of receipt of notice, and in the case where the applicant does not make such payment within this period, the application may be deemed to be withdrawn.
- (5) The fee paid to the Center shall not be reimbursed, including the case where an application is withdrawn provided, however, that in the application for a bilateral opinion, where the respondent's refusal of acceptance is verified, and where the applicant did not choose to apply for a unilateral opinion, the balance after deducting a reception/acceptance confirmation procedure fee of 31,500 yen from the application fee which the applicant has paid shall be reimbursed to the applicant, and where the applicant chose to apply for a

unilateral opinion, the difference between the paid application fee and the application of a unilateral opinion if it had been made initially, shall be reimbursed to the applicant.

Article 17-2 (Reduction of Fees)

- (1) In the case where either or both the applicant and respondent of the Center's Advisory Opinion (in the case of the bilateral opinion) have difficulty paying the regular fee, a motion for reduction of the fees to be paid by such party may be made by said party's submission of a written motion for reduction.
- (2) Materials, which indicate the circumstances relating to the difficulty in paying the regular fee, shall be attached to the written motion for reduction.
- (3) Where a written motion for reduction has been submitted, the steering committee of the Center shall examine whether or not there are grounds for the motion, and issue a ruling with respect to payment of fee.
- (4) At the examination as provided in the preceding Paragraph, various factors such as monetary capacity, scale of operation, and other financial circumstances of the person who made the motion for reduction, existence or nonexistence of public need, particularity of the case, and economic benefits which lay behind the case, etc. shall be taken into consideration.
- (5) In issuing the ruling as provided for in Paragraph (3), in addition to or in place of granting a reduction ruling, a ruling to allow payment of fees in installments or a ruling to admit rescheduling of due date for payment of fee may be issued.
- (6) The motion for reduction as provided in Paragraph (1) shall, in principle, be made before the submission of a written application for an Advisory Opinion by the applicant, or before the submission of a written acceptance by the respondent of the Center's Advisory Opinion (in the case of the bilateral opinion).
- (7) The applicant, where it submits a written motion for reduction at the same time as a written application for an Advisory Opinion, unavoidably, shall pay half the amount of the regular application fee to the Center as a temporary application fee.
- (8) Where a written motion for reduction has been submitted at the same time as a written application for an Advisory Opinion without temporary payment of application fee, the Center shall receive only the written motion for reduction, and when the fee which has been determined through the examination on the written motion for reduction is paid, it shall receive the written application for an Advisory Opinion.

- (9) Where the respondent has submitted a written motion for reduction at the same time as a written answer, unavoidably, the Center shall receive only the written motion for reduction, and only when the respondent has agreed to the result of the examination on the written motion for reduction, shall it receive the written answer.
- (10) Where the panelists have confirmed from the facts presented that it is not burdensome for the person, who has received a ruling to reduce the fee to be paid, to pay the regular fee, after its payment of the reduced fee, the panelists may order such person to make additional payment(s) of the difference between the regular fee and the fee which has been already paid.
- (11) The panelists may, in the case where additional payment has been ordered pursuant to the provision of the preceding Paragraph, and where such additional payment is not made, suspend or terminate the Advisory Opinion proceedings.

Chapter 5: Management of Case

Article 18 (Management of Case)

- (1) Management of the Advisory Opinion case shall be conducted by a steering committee or a branch steering committee of the Center (hereinafter, the “Steering Committee”) and its office work shall be conducted by a secretariat of the Center.
- (2) The Steering Committee shall, when an application for an Advisory Opinion is made, promptly appoint a case manager to manage the case.
- (3) The case manager may attend hearings as necessary.

Chapter 6: Confidentiality

Article 19 (Confidentiality Obligations)

The Advisory Opinion proceedings and the records thereof shall be maintained behind closed-doors, and panelists, panelist candidates, assistants of panelist, case managers, members of a steering committee, officers and staff of secretariat of the Center, the parties, and agents thereof shall not disclose or use the existence, content, and result of the Advisory Opinion (including the facts relating to the proceedings and the facts which come to be known through the proceedings), without the consent of all parties to disclosure or use. This shall also apply to such persons who have left these services provided, however, that the Center may, in the case where it is necessary for enlightenment and research, etc. of the

resolution of disputes relating to intellectual property, disclose the above without specifying specific content such as the names of parties, the patent, utility mode registration, design registration, or trademark registration (including defensive trademark registration) which are subject to the application, etc.

Supplementary Provisions

These rules shall come into force effective March 1, 2004.

Supplementary Provisions

These amended rules shall come into force effective November 1, 2004.

Supplementary Provisions

These amended rules shall come into force effective January 16, 2006.

Supplementary Provisions

These amended rules shall come into force effective January 9, 2007.

Supplementary Provisions

These amended rules shall come into force effective February 6, 2007.

Appendix Table of Center’s Advisory Opinion Proceedings Fees (Tax Included)

(1) Basic Fee

Table 1: Unilateral Advisory Opinion

Item	Amount
Application Fee	315,000 yen
Fee for Oral Hearing	105,000 yen

Table 2: Bilateral Advisory Opinion

Item	Amount
Application Fee	420,000 yen
(including Reception /Acceptance Confirmation Procedure Fee)	(31,500 yen)
Cross Invalidation Determination Application Fee	210,000 yen
Fee for Oral Hearing	Each party:105,000 yen

(2) Additional Application Fee

One half of the application fee as provided in each table above (with regard to an application for a Cross Invalidation Determination, the same amount as the application fee thereof) shall be added up for each additional matter as provided in Article 3, and for each additional number of Subject Matter or Subject Product, etc. and calculated as follows.

- (i) Number of Subject Matter
 - (a) Patent or utility mode registration: Number of patent claims or utility mode registration on which an Advisory Opinion is requested (Even in the case where one claim refers to one or more other claims, it shall be counted as one.)
 - (b) Registered design: Number of registered designs on which an

Advisory Opinion is requested.

- (c) Registered trademark: Number of categories of designated goods or designated services of the registered trademark on which an Advisory Opinion is requested.
- (ii) Number of Subject Product, etc.
Number of products, methods, designs, or trademarks specified in a written application for an Advisory Opinion.