

# Comparative Study on the Patent Trial for Invalidation among JPO, KIPO and SIPO

(in the 4<sup>th</sup>JEGTA Meeting held in Tokyo, September 5-7, 2016)

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## Introduction

It was proposed at the first JEGTA Meeting held in Japan that comparative studies would be conducted within the JEGTA Meetings from then onwards. Comparative studies have been conducted so far under the themes of “appeal against decision of rejection” as well as “comparative analysis of amendment to patent Documents after granted among SIPO, JPO and KIPO” and “comparative analysis of data” through trilateral cooperation among the Three Offices (JPO, KIPO and SIPO).

“Patent trial for invalidation” was brought up as a theme of the comparative study at the fourth JEGTA Meeting held in Japan in September 2016. A report of the study was completed through trilateral cooperation among the Three Offices. As a host office, JPO set the following agenda for the theme “patent trial for invalidation” and conducted the study.

With the globalization of corporate business activities in recent years, more companies have been involved in lawsuits in various countries. As a countermeasure against such cases, a need to utilize patent trial for invalidation in various countries has been increased for foreign companies. Under such circumstances, the comparative study was conducted for the purpose of not only comparing the invalidation systems in respective countries but also identifying various characteristics with a focus on usability of the invalidation systems and a difference in their operations among the countries from the user’s perspective.

More specifically, purposes of the comparative study of patent trial for invalidation are as follows:

- To understand an outline of the patent trial for invalidation systems of three countries respectively
- To identify various characteristics of the systems in three countries respectively by making a comparison of the systems
- To consider usability of the invalidation systems from the user’s perspective

# Chapter 1: Characteristic and comparison on systems and operations of patent invalidation in China, Korea and Japan from user's viewpoint

## 1. Opportunity for attacks and defenses

Patent invalidation procedure begins with a request from a party who would like to invalidate a patent. Its procedure develops mainly by attacks and defenses based on adversarial system between parties. More concretely, a demandant asserts that the patent should be invalidated and presents evidence for the assertion. On the other hand, a demandee (patent holder) counterclaims and makes correction. A panel consisting of administrative judges hears assertion of both parties well and finally makes a trial judgement which states whether the patent is valid or invalid.

In such a basic process of invalidation trial procedure, a demandant and a demandee need to take the opportunity to make an action and to fully assert and present evidence in the opportunity. In such a viewpoint of attacks and defenses, characteristics of patent invalidation systems of three countries will be described as follows.

### (1) Korea

In Korea, a panel sends a copy of the request for patent invalidation to the patentee and gives him/her an opportunity to defense. In response to this action, patentee can request for correction as well as submit a written answer. When a request for correction is submitted, the panel sends a copy of the request to the demandant and gives him/her an opportunity to submit his/her opinion. When a written opinion is submitted, the panel gives an opportunity to the patentee to respond. Through this procedure, the patentee can request correction again. In this progress, the demandant can add new evidence on reasons for invalidation without limitation whenever the patentee requests correction.

Thus the parties can dispute, in a single invalidation trial, on all evidence which may be presented in the future. This aspect can be viewed to be efficient as a whole in judicial economy because it contributes to the one-time resolution of dispute. It can be also viewed to be well balanced because attacks and defenses can be freely done to an extent. On the other hand, it is concerned to cause not only difficulties on the arrangement of issues but also a long pendency period.

### (2) China

In China, when an invalidation trial is requested, members of patent reexamination board send a copy of the written request to the patentee and request to respond. After that, usually, "written opinion" is communicated once or twice between the demandant

and the patentee. The demandant can add reasons for invalidation and supply evidences within a month from the date of the request for invalidation. On the other hand, although the patentee can request correction, the correction by the patentee is limited to deletion of claims, combination of claims or deletion of technical solutions. Any amendment of a patented invention or utility model shall be limited to the claims.

Thus Chinese invalidation procedure is distinguished by its balance between attacks and defenses because i) it is not allowed to add reasons for invalidation or to supply evidence randomly and ii) the condition for correction is strictly limited compared with Korea and Japan (See Chapter 2). Through this, issues on reasons for validation are easily arranged for parties and the panel, and the pendency period can be shortened.

### (3) Japan

In Japan, when an invalidation trial is requested, a panel sends a copy of the written request to the patentee and gives him/her an opportunity to respond. After this communication, the patentee can submit a written response as well as request correction. These communications are the basic modes of attacks and defenses for both parties.

When a panel decides to invalidate a patent, the panel is supposed to send an "advance notice of trial decision" before trial decision. The patentee who receives this notice can request correction in this occasion, too.

On the other hand, the demandee of the invalidation trial can amend the reasons for invalidation in the written request to change the gist thereof, which means to add new reasons for invalidation or to add evidence, etc., only if the predetermined conditions are met. The predetermined conditions include such a case, for example, that i) an amendment of reasons for request of invalidation trial becomes necessary by correction, and ii) the amendment does not make the period of trial examination unduly longer. At a glance, the recurrence of the request for correction by the patentee and the amendment of reasons for invalidation by the demandee seems to continue without limitation, but practically, this is not a serious issue because the amendment of the reasons for invalidation request is permitted in a very limited case.

Thus, in Japanese invalidation trial, the arrangement of issues is easy for parties because the arrangement of issues is based on i) the reasons for invalidation included in the original written request for invalidation and ii) the written response by the patentee corresponding to the reasons for invalidation. In addition, Japanese system is well balanced in the sense that one-time resolution of dispute is realized to an extent because i) correction of claims by the patentee is permitted in the predetermined condition and

ii) amendment of the reasons for invalidation to change the gist thereof is also permitted in the very limited condition.

## 2. Submission of documents

Generally, in a patent invalidation procedure, it is necessary for the parties concerned to file many documents to the Offices and the other parties concerned. It can be said that this is a considerable burden on both parties concerned even though this is a necessary step towards fully claiming and presenting evidence in the given opportunities. In such a viewpoint, the outline of each country's document filing method will be described as follows.

### (1) Korea

At first, Korean document filing method is distinguished by its characteristics that enable to file all the documents for patent invalidation trials via on-line. Digitization has been progressed for the entire patent invalidation procedure to enable not only the parties concerned to electronically file documents for patent invalidation to the Office, but also the Office to electronically dispatch documents to the parties concerned. Therefore, it is not necessary to prepare a copy of the document.

### (2) China

Chinese document filing method is distinguished by its characteristics that enable the parties concerned to file documents via on-line. In addition, when the parties concerned file documents on paper, it is necessary for them to prepare and file 2 copies of the document in addition to an original document(one copy to the PRB,the other to the opposing party). On the other hand, the Office dispatches documents only on paper, instead of dispatching them via on-line.

### (3) Japan

Japanese document filing method is distinguished by its characteristics that allow only paper filing and paper dispatch by the parties concerned and the Office respectively. Therefore, it is necessary for the parties concerned to prepare and file one copy of the document for examination and the number of copies equal to the number of the other parties, in addition to an original document. Electronic filing will not be accepted by the Office.

### 3. Operation of oral proceedings

Oral proceedings are considered an extremely important process for parties concerned because both parties concerned can meet together at the Trial Court, and directly claim to administrative judges. On the other hand, it is also an important process for administrative judges because they can make inquiries into evidence and issues in dispute with both parties concerned in attendance, and efficiently advance examination. In this section, the outline of each country's oral proceeding operation will be described as follows.

#### (1) Korea

In Korea, when requests are made by the parties concerned, oral proceedings are conducted by a panel. Moreover, it is possible to perform a television conference between the KIPO Seoul Office and the KIPO Daejeon Office. Since the trial and appeal panel also takes an official trip to the KIPO Seoul Office and conducts oral proceedings, it is highly convenient for many parties concerned and patent attorneys that are based in Seoul. Further more, one of the characteristics of the arrangement of issues prior to oral proceedings is that documents describing the claims, etc. are filed with each other between the parties concerned, and thus, it enables the panel to inform a list of questions in those documents to the parties concerned beforehand. Other characteristics of the arrangement of issues is that conviction is not disclosed by the panel at oral proceedings.

#### (2) China

In China, the panel can determine whether oral proceedings shall be conducted, and the panel will conduct oral proceedings upon request by the party concerned. While oral proceedings can be conducted at the Office in Beijing, circuit trial examination can be also held in nine areas upon request by the parties concerned. Prior to oral proceedings, the panel sometimes informs issues in dispute to the parties concerned. If the opinions of both parties are adversarial, even if they have been claimed in the documents, it is usually necessary to claim orally. In addition, one of the characteristics of this is that the number of the parties concerned who can attend oral proceedings is limited to four persons by each party.

#### (3) Japan

In Japan, oral proceedings are conducted in principle. In order for the panel to inform issues in dispute to the parties concerned beforehand, a "notice of proceeding matters" is sent by the panel to both parties concerned. The "notice of proceeding matters" is sent at the time of arranging the date of the oral proceedings. Thereby, issues in dispute can be informed to the parties concerned approximately two months prior to oral proceedings,

and it is possible to fully secure the period of time for both parties concerned to prepare for oral proceedings.

#### 4. Advance notice of trial decision

In Japan, in order to prevent the conversational ball rolling between invalidation trials and lawsuits rescinding trial decisions, the “Advance Notice of a Trial Decision” system was introduced. This is intended to provide patentees with opportunities to make requests for corrections by the panel sending them an advance notice of a trial decision if a trial decision is made to invalidate a patent.

Before the “Advance Notice of a Trial Decision” system was introduced, it was possible for parties concerned to separately institute requests for trial for correction to the Office during the time when lawsuits rescinding trial decisions are instituted. Once requests for trial for correction are instituted, the IP High Court was to remand invalidation trials that were subject to lawsuits rescinding trial decisions (this is so-called “conversational ball rolling”).

With the introduction of the “Advance Notice of a Trial Decision” system, trials for correction are prohibited in order to prevent the conversational ball rolling during the time when lawsuits rescinding trial decisions are instituted to the IP High Court.

After the “Advance Notice of a Trial Decision” system was introduced, it becomes possible for patentees to make corrections based on trial decisions by the panel to invalidate patents.

In addition, there are no such systems to make advance notices of trial decisions in either China or Korea.



## Chapter 2: Comparative Table among Japan, China and Korea

### (1) Trial for Patent Invalidation Systems in 3 Countries

Item	Japan	China	Korea
Name of system	Trial for patent invalidation	Request for declaring a patent right invalid	Trial for patent Invalidation (Patent Invalidation trial)
Competent authority	Appeals Department, JPO	Patent Reexamination Board	Intellectual Property Trial and Appeal Board (IPTAB)
Website	<a href="http://www.jpo.go.jp/seido/shinpan/index.html">http://www.jpo.go.jp/seido/shinpan/index.html</a>	<a href="http://www.sipo-reexam.gov.cn/index.htm">http://www.sipo-reexam.gov.cn/index.htm</a>	<a href="http://www.kipo.go.kr/ipt/index.html">http://www.kipo.go.kr/ipt/index.html</a>
Demandant	An interested person (Art. 123 (2))	A unit or individual, including the patentee and inventor (Art. 45 of Patent Law).	An interested party or an examiner (Art. 133 (1)). Any person may make a request for trial within three months from the publication of the registered patent (Art. 133 (1)).
Object of invalidation	Patent rights	Patent rights	Patent rights
Statutory basis	Art. 123 of the Patent Act	Art. 45 of Patent Law	Art. 133 of the Patent Act.
Requestable unit	A request may be filed for each claim (Art. 123 (1))	A request may be filed for each claim (R65)	A request may be made for each claim (Art. 133 (1)).

Item	Japan	China	Korea
Period for request	Any time (even after the lapse of rights (Art. 123 (3)))	Allowable after the grant of patent is announced (even after expired or renounced) (Pt. IV, Ch. 3, 3.1 of Guideline)	A trial may be requested even after the extinguishment of a patent right (Art. 133 (2)).
Method	Submit a written request to the Office (Art. 131 (1))	Submit a request for invalidation to the Reexamination Board (Rule 65 of the Implementing Regulations).	Submit a written request to the President of the IPTAB (Art. 140 (1)).
Electronic procedure by a party concerned	Not permitted (only paper procedure is permitted)	Permitted (need to submit the online form)	Permitted (need to submit the online form)

Item	Japan	China	Korea
The number of paper copies required	(only by paper) One certified copy, One duplicate for examination and the number of duplicates equal to the number of the other parties (the number of duplicate copies that need to be submitted is the number of patentees plus one)	One certified copy via online or Two paper copies(one to the PRB, the other to the patentee).(R64)	One certified copy via online or by paper (Almost all documents are submitted via online)
Electronic procedure by the Office	Not permitted (notices are issued by only paper)	Not permitted (only paper notice is sent)	Permitted (by Online system)
Production of evidence	Permitted	Permitted	Permitted
Online submission of evidence	Not permitted (only paper submission is permitted)	Permitted (need to submit electronically by PDF files, etc.)	Permitted (need to submit electronically in PDF format, etc.)

Item	Japan	China	Korea
What needs to be stated as grounds for request	...the facts on which the invalidation of the patent is based shall be specified in concrete terms, and the relationship of each fact that is required to be proved with the relevant evidence shall be stated... (Art. 131 (2))	...shall state in detail the grounds for filing the request, making reference to all the evidence as submitted, and indicate the piece of evidence on which each ground is based (Rule 65).	Facts and causes of invalidity
Amendments to written request (grounds for request)	<p>Basically not allowed to amend the gist, except as provided in Paragraphs of Art. 131-2 (2):</p> <ul style="list-style-type: none"> <li>• A request for correction has given rise to the need for amendment;</li> <li>• There exist reasonable grounds for not stating... at the time of request, and the demandee has agreed...</li> </ul> <p>(Only if there is no possibility of unreasonable delay of the proceedings)</p>	<p>The person making the request may add reasons or supplement evidence within one month from the date when the request for invalidation is filed (Rule 67).</p> <p>If the claims amended by way of combination by the patentee, the person making the request may add reasons or supplement evidence within the time limit of respond.</p>	<p>Basically, no amendment to a request for trial submitted shall be made in the intent or purpose,</p> <p>An exception can be made for some amendmentsto be made to correct the grounds for request (Art. 140 (2)).</p>

Item	Japan	China	Korea
How the trial is conducted	Basically, conducted by oral proceedings (Art. 145 (1)) <sup>1</sup>	Examination in written form or oral proceedings (If it is possible that the patent will be invalidated in part, the Board must conclude the case through oral proceedings) (Pt. IV, Ch. 3, 4.4.4)	Conducted by oral hearing or documentary examination (Art. 154).
Grounds for invalidity	See the next table.	See the next table.	See the next table.
Examination of ground for invalidation to be made ex officio	Yes (Patent Act Article 153)	Yes (Pt. IV, Ch. 1, 2.4; Pt. IV, Ch. 3, 4.1)	Yes(Patent Act Article159)
Corrections made during trial	Permitted (Art. 134-2).	Permitted (Pt. IV, Ch. 3, 4.6.2).	Permitted (Art. 133-2).

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<sup>1</sup> For details of oral proceedings, see a separate table below.

Item	Japan	China	Korea
Outline of trial decision structure	1. the conclusion of the trial decision (approval or disapproval of correction, validity or invalidity of each claim, fee payment) 2. history of the case 3. the finding of the patent 4.judgment of propriety of purpose of correction 5. the finding of evidence and cited invention 6. judgment 7. conclusion	1.bibliographic data of the reexamination decision 2.legal bases 3.main points of the decision 4.brief of the case 5.grouds of decision 6.conclusion 7.drawings (when necessary)	1. Conclusion of the trial decision (approval or disapproval of correction, validity or invalidity of each claim, fee payment) 2.Statement of the nature and facts of the case 2-1.history of the case 2-2.the finding of the patent 2-3.the finding of evidence and cited invention 3. Arguments of both parties 4. Judgment of propriety of interest to file the trial 5. Judgment of propriety of correction 6. Judgment 7. Conclusion

Item	Japan	China	Korea
Consequence of final decision to invalidate	The patent shall be deemed never to have existed (in the case of invalidation on grounds arising after the grant, the patent shall be deemed not to have existed from the time when the said grounds became applicable) (Art. 125).	Deemed to be non-existent from the beginning (Art. 47).	The patent right shall be deemed not to have existed (in the case of invalidation on grounds arising after the grant, the patent shall be deemed not to have existed from the time when the patent first became subject to the relevant provision (Art. 133(3)).
Appeals	Appeal may be filed to the Tokyo High Court only by a party in the case, an intervenor, or a person whose application for intervention has been refused (Art. 178 (1), (2)).	The party may take legal action before a people's court (Art. 46 Para. 2).	The action may be brought to the Patent Court of Korea by a party, intervenor or any person whose request for intervention has been rejected (Art. 186 (1)).
Period for appeals	Within 30 days from the date on which a certified copy of the trial decision or the ruling has been served (Art. 178 (3)).	Within 3 months from the date of receipt of the notification (Art. 46 Para. 2).	Within 30 days from the date of receipt of a certified copy of the trial decision or ruling (Art. 186 (3)).

Item	Japan	China	Korea
Submission new evidence to the court in lawsuits rescinding trial decisions	In principle, it is not allowed to assert the grounds for invalidation <u>based on the new evidence</u> . (cf:The Supreme Court Ruling in the Knitting Machine Case(Supreme Court Case S42 (Gyo-Tsu) 28, Judgment on March 10, 1976 (S51)).	In principle, Only facts and evidences appeared in the administrative decision will be reviewed by courts in patent administrative litigation. Those new evidences submitted during litigation will not be accepted and taken into consideration.	It is permissible to freely submit new invalidation evidence to the court.
Allowable types of new evidence in the court	It is allowed to find common general knowledge of a person skilled in the art based on materials that have not appeared in the trial procedures (cf: The Supreme Court Ruling in the Food Packaging Container Structure Case (Supreme Court Case S54 (Gyo-Tsu) 2, Judgment on January 24, 1980 (S55)). .	Exception: 1) Evidences found after the decision has been made. 2) Evidences further explaining of common knowledge in the skilled in the administrative decision. 3) Evidences to prove the ability of the skilled before the filing date.	Any type of new invalidation evidence is allowable.



Item	Japan	China	Korea
Period to submit new evidence to the court	Before the designated date by the court	Before the designated date by the court	Any time within the designated period by presiding judge or before the date for pleading.
<i>Ne bis in idem</i> (effect of decision against 3rd party)	Only applicable to the party in the case and the intervenor (a trial decision is not effective against a third party) (Art. 167).	Applicable (After a decision on any request for invalidation, the Board shall not accept a request for invalidation based on the same facts and evidence) (Rule 66 Para. 2; Pt. IV, Ch. 3, 2.1).	Applicable (No person may demand the trial again on the basis of the same facts and evidence) (Art. 163).

(2) Comparison of grounds for invalidation of patents

<b>Japan (Paragraphs of Art. 123 (1))</b>	<b>China (Art. 45 of Patent Law, Rule 65 (2) of the Implementing Regulations)</b>	<b>Korea (Paragraphs of Art. 133 (1))</b>
Addition of new matter (Art. 17-2 (3)).	Addition of new matter (Art. 33).	Addition of new matter (Art. 47 (2)).
Lack of foreign national's capacity to hold rights (Art. 25).	—	Lack of foreigners' capacity to hold rights (Art. 25).
Non-patentable invention (Art. 29 (1)).	Lack of eligibility for protection (Art. 2), grounds for non-patentability (Art. 25).	Non-patentable invention (Art. 29 (1)).
Lack of industrial applicability (Art. 29 (1)).	Lack of novelty, creativity or practical use (Art. 22).	Lack of industrial applicability (Art. 29 (1)).
Lack of novelty (Art. 29 (1)).		Lack of novelty (Art. 29 (1)).
Lack of inventive step (Art. 29 (2)).		Lack of inventive step (Art. 29 (2)).
—	Lack of novelty or inventive step in appearance design (Art. 23).	—
Enlarged novelty (Art. 29-2).	—	Enlarged novelty (Art. 29 (3), (4)).
Offense against public order and morality (Art. 32).	Violation of social ethics (Art. 5)	Inventions that are likely to contravene public order or morality or to injure public health (Art. 32).
Violation of the joint application provision (Art. 38).	—	Violation of the joint application provision (Art. 44).
Prior art effect (Art. 39 (1) to (4)).	Prior art effect (Art. 9)	Prior art effect (Art. 36 (1) to (3)).
Violation of a treaty (Art. 123 (1) (iii)).	—	Violation of a treaty (Art. 133 (1) 5).

<b>Japan (Paragraphs of Art. 123 (1))</b>	<b>China (Art. 45 of Patent Law, Rule 65 (2) of the Implementing Regulations)</b>	<b>Korea (Paragraphs of Art. 133 (1))</b>
Violation of descriptive requirements for "detailed explanation of the invention" (Art. 36 (4) (i))	Violation of descriptive requirements for "written description" (Art. 26 (3)).	Violation of descriptive requirements for "descriptions" (Art. 42 (3) 1).
Violation of descriptive requirements for "scope of claims" (Art. 36 (6) (i) to (iii))	Violation of descriptive requirements for "written claim" (Art. 26 (4)).	Violation of descriptive requirements for "scope of claims" (Art. 42 (4)).
—	Violation of descriptive requirements for "independent claim" on essential technical features (Rule 20 Para. 2)	—
—	Violation of descriptive requirements for "drawings" (Art. 27)	—
New Matter beyond Original Text (a new matter added to the documents in foreign language) (Art. 123 (1) (v)).	—	—
Usurped application (Art. 123 (1) (vi)).	—	Grant of patent to a person not entitled to obtain patent (Art. 33 (1)).
—	—	Acquisition of patent by an employee of the KIPO or the IPTAB (Art. 33 (1)).

<b>Japan (Paragraphs of Art. 123 (1))</b>	<b>China (Art. 45 of Patent Law, Rule 65 (2) of the Implementing Regulations)</b>	<b>Korea (Paragraphs of Art. 133 (1))</b>
Grounds for invalidation that arise after the grant (lack of foreigners' legal capacity to hold rights, and violation of a treaty) (Art. 123 (1) (vii)).	—	Grounds for invalidation that arise after the grant (lack of foreigners' legal capacity to hold rights, and violation of a treaty) (Art. 133 (1) 4).
Unlawful correction (a correction that does not meet the requirements in Art. 126) (Art. 123 (1) (viii)).	—	—
—	Addition of new matter to divisional application (Rule 43 Para. 1).	Addition of new matter to divisional application (Art. 52 (1)).
—	—	Addition of new matter to converted application (Art. 53 (1)).
—	Violation of provision for confidentiality examination (Art. 20 Para. 1).	—

(3) Comparison of systems for oral proceedings

Item	Japan	China	Korea
Submission of request by party	Not needed <ul style="list-style-type: none"> <li>• Basically, conducted by oral proceedings (Art. 145 (1)).</li> <li>• Documentary proceedings are available upon request (Art. 145 (1)).</li> </ul>	<ul style="list-style-type: none"> <li>• The panel may decide on its own initiative to take oral proceedings (Pt. IV, Ch. 4, 2).</li> <li>• If the party submit a request in written form for oral proceedings (necessary to explain the reason). The panel shall decide to take oral proceedings.</li> </ul>	Needed <ul style="list-style-type: none"> <li>• Submit a "Request regarding Trial" to the President of IPTAB or the presiding administrative patent judge (Art. 65 (1) of the Enforcement Rules).</li> <li>• The presiding administrative judge may decide to hold oral hearing <i>ex officio</i>.</li> </ul>
television conference systems	Not available	• Available	Available (oral proceedings may be conducted by connecting Seoul and Daejeon hearing rooms)
Oral proceeding in any places other than the Office's trial courts	Available ("Circuit Trials " based on request by a party concerned)	Available(at 11 branches or any other places a party concerned)	Available in Seoul for now <ul style="list-style-type: none"> <li>• upon request by both parties concerned</li> <li>• The presiding administrative judge may decide the place of oral hearing</li> </ul>

Item	Japan	China	Korea
How to arrange the date	• A Date Arrangement Request is sent by fax to the party or the representative (33-01 of Appeal/Trial Manual)	Patent Reexamination Board issued to the parties an oral hearing notice informing held oral hearing date and venue	• Date and place are decided by the presiding administrative judge. (upon discussion with parties concerned)
Average period between the start of setting the date and the oral proceeding	Approximately 2 months	normally no less than 37 days	Approximately 1 month
Notice of appearance date	<ul style="list-style-type: none"> <li>• Sent by simple means, such as phone or fax. The party etc. may respond by a written consent of the date.</li> <li>• Alternatively, a writ of summons may be served (by 2 weeks before the date) (33-01 of Appeal/Trial Manual).</li> </ul>	Specified by a Notification (Pt. IV, Ch. 4, 4).	The presiding administrative judge sends a notification on a designated date and place of oral hearing (Art. 154 (4) of the Patent Act).

Item	Japan	China	Korea
Limit on the number of people present	No limit	Up to four (including an agent) (Pt. IV, Ch. 4, 3).	No Limit
Identification of points in dispute carried out in advance?	Yes •Delivery of notification of grounds for proceeding and submission of main points of statements in oral proceedings (when necessary).	Sometimes the panel will also impart dispute points in the notification of oral proceedings.	Yes •Party must submit a Summary of Oral Statement (by a week before the date) •If there seems to be questions that will become points in dispute in the oral proceedings, the presiding judge may send a notice of such questions (Art. 40 (2) of Trial Handling Regulations).(This is practiced for some cases, but not commonly)
Examination of evidence and witnesses in the course of oral proceedings	Examination of evidence and witnesses may be carried out. (33-05 of Appeal/Trial Manual).	Examination of evidence and witnesses may be carried out. As regards to witnesses, only there are statements about the witnesses before the oral proceedings by the party, the said witnesses examination will be carried out.	Examination of evidence and witnesses may be carried out.

Item	Japan	China	Korea
Openness of oral proceedings	• Conducted in public (except in situations where public order and morality can be injured or a trade secret can be made public) (Art 145 (5)).	• Accessible to public audiences (Pt. IV, Ch. 4, 12). Taken in public, unless they need to be kept confidential (Pt. IV, Ch. 4, 5).	Conducted in public (except in situations where public order and morality can be injured) (Art 154 (3)).
Disclosure of 'administrative judge's impression in oral proceedings	Disclosed (depending on the cases)	Usually not disclosed	Not disclosed (Administrative patent judges do not express their impression in oral proceedings.)
Oral statement of what stated in writing	Not needed • Statements in writing are acceptable as evidence without the need to assert them orally (33-00 of Appeal/Trial Manual).	Normally needed, if conflict exist, oral statement will be regarded as formal. If the party state clearly that his opinion is just the same with statement in writing, then he needn't repeat it again.	Not needed • Statements in writing are totally acceptable as valid ones.



Item	Japan	China	Korea
Withdrawal of request for trial during oral proceedings	Permitted (Art. 155).	Permitted (Pt. IV, Ch. 4, 5.3)	Permitted (Withdrawal of all claims should be done in writing; Withdrawal of some claims can be done orally.)
Trial records	Prepared (Art. 147) • Prepared by the trial clerk (Art. 147 (2)).	Prepared. • Minutes are taken by the panel. • After important items of oral proceedings being noted down or the termination of oral proceedings, the minutes must be handed to the parties for reading (Pt. IV, Ch. 4, 11).	Prepared. • Prepared by the trial clerical official (Art. 154 (5) of the Patent Act).

(4) Comparison of corrections during trial for patent invalidation

Item	Japan	China	Korea
Corrections made during trial	Permitted (Art. 134-2)	Permitted (Pt. III, Ch. 3, 4.6.2).	Permitted (Art. 133-2)
Opportunities for correction	(1) Period for submission of written answer; (2) Period for submission of written answer in response to correction of a written request; (3) When a judgement revoking a trial decision becomes final and binding, and a motion is made within a week therefrom; (4) Period for submission of opinions on "grounds not pleaded" when these are examined <i>ex officio</i> ; (5) Period provided when advance notice of a trial decision is issued (Art. 134-2 (1))	Within the time limit for response to: (1) the request for invalidation, (2) causes for invalidation or evidence added by the petitioner, (3) causes for invalidation or evidence not mentioned by the petitioner (Pt. IV, Ch. 3, 4.6.3).	(1) Period for submission of written response (Art. 147 (1)); (2) Period for submission of opinions on "grounds not pleaded" when these are examined <i>ex officio</i> (Art. 159 (1)); (3) When the administrative judge finds it necessary after a lapse of the period for submission of written response (Art. 133-2 (1)).
Procedure	Request for correction (Art. 134-2)	Submit amended patent documents with the time limit for response(Pt. IV, Ch. 3, 4.6.3)	Request for correction (Art. 133-2)
Target of correction	Scope of claims, descriptions, drawings.	Scope of claims only	Descriptions (including the scope of claims), drawings

Item	Japan	China	Korea
Mode(Purpose) of correction	<ul style="list-style-type: none"> <li>• To restrict the scope of claims,</li> <li>• To correct errors in the description or of incorrect translations,</li> <li>• To clarify an ambiguous description,</li> <li>• To dissolve citing relations between claims.</li> </ul> (Art. 134-2 (1) (i) to (iv))	<ul style="list-style-type: none"> <li>• To delete a claim</li> <li>• To combine claims</li> <li>• To delete a technical solution</li> </ul> (Pt. IV, Ch. 3, 4.6.2).	<ul style="list-style-type: none"> <li>• To reduce the scope of claims</li> <li>• To correct clerical errors</li> <li>• To clarify any ambiguous statements</li> </ul> (Art. 136 (2) as applied <i>mutatis mutandis</i> to Art. 133-2 (4))
Requirements for correction	<p>The following matters are not permitted as correction requirement:</p> <ul style="list-style-type: none"> <li>- new matter beyond the original text(Article 126 (5) as applied <i>mutatis mutandis</i> pursuant to Article 134-2 (9));</li> <li>- substantial broadening or modification of the scope of claims (Article 126 (6) as applied <i>mutatis mutandis</i> pursuant to Article 134-2 (9))</li> </ul>	<p>(1)the title of the subject matter of a claim cannot be changed  (2)the extent of protection cannot be extended as compared with that in the granted patent(Rule 69.1)  (3)the amendment shall not go beyond the scope of disclosure contained in the initial description and claims(Art. 33)  (4)addition of technical features not included in the claims as granted is generally not allowed</p>	<p>The requirements of correction are as follows:</p> <ul style="list-style-type: none"> <li>- The correction does not aim to add new matters (Article 136 (2)<sup>2</sup> as applied <i>mutatis mutandis</i> pursuant to Article 133-2 (4));</li> <li>- The correction does not substantially enlarge or alter the scope of claims (Article 136, paragraph (3)<sup>3</sup> as applied <i>mutatis mutandis</i> pursuant to Article 133-2, paragraph (4))</li> </ul>

<sup>2</sup> Article 136, paragraph (3) in the New Patent Act to be enforced in March 2017.

<sup>3</sup> Article 136, paragraph (4) in the New Patent Act to be enforced in March 2017.

Item	Japan	China	Korea
Correctable unit (claim)	·When the request for invalidation was filed for each claim, a request for correction must be filed for each claim (Art. 134-2 (2)).	For each claim.	·Description and drawing should be corrected as a whole.
Ex officio proceedings for correction	Available (Art. 134-2 (5)).	Available (Pt. IV, Ch. 3, 4.6.3)	Available (Art. 159 (1)).
Independent patentability to be met by claims after correction	Required, except those claims of which a request for invalidation has been filed (Art. 126 (7) as applied <i>mutatis mutandis</i> to Art. 134-2 (9)).	No provision	Required, except those claims of which a request for invalidation has been filed (Art. 133-2 (5)).

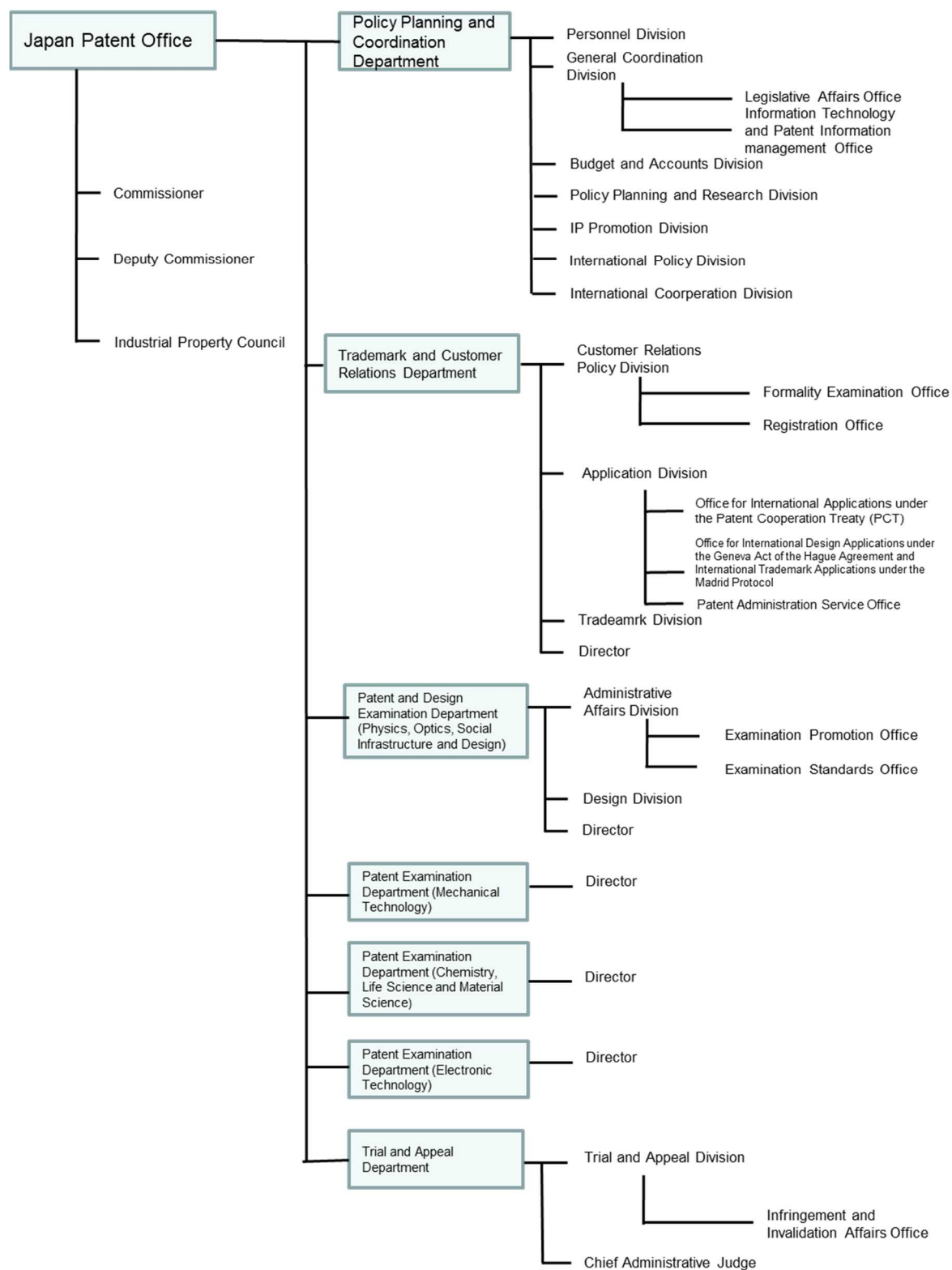
## Chapter 3: Overview of Patent Trial for Invalidation system in Each Country

### 1 Japan

#### 1.1 Structure of the Trial and Appeal Department

The organization of the Japan Patent Office (JPO) is shown in Figure 1 below. The Trial and Appeal Department is established in parallel with the Policy Planning and Coordination Department, Trademark and Customer Relations Department, Patent and Design Examination Departments in charge of the examination of patents and designs.

Figure 1: Organization chart of the JPO<sup>4</sup>



<sup>4</sup> Organization Chart: the JPO's website (<http://www.jpo.go.jp/shoukai/soshiki/sosiki.htm>)

The Trial and Appeal Department has 33 boards in charge of patents divided by technical field. In addition, it has one design board and four trademark boards (See Table 1 below).

Table 1: Structure and the number of officials of each board of the Trial and Appeal Department

Board	Technical field	Board	Technical field
1st	Measurement	20th	Applied Organic Chemicals
2nd	Materials Analysis	21st	Organic Chemistry
3rd	Amusement	22nd	Pharmaceuticals
4th	Natural Resources and Living Environment	23rd	Biopharmaceuticals
5th	Applied Optics	24th	Pharmaceutical Preparations
6th	Business Machinery	25th	Biotechnology
7th	Nano-physics	26th	Electronic Commerce Technology
8th	Optical Devices	27th	Interface and Data Transfer
9th	Automatic Control	28th	Data Processing
10th	Motive Machinery and Logistics	29th	Electronic Device
11th	Transportation and Lighting	30th	Video System
12th	General Machinery and Assembling	31st	Transmission Systems
13th	Production Machinery	32nd	Information Storage
14th	Textile Processing and Packaging Machinery	33rd	Digital Communications and Telephonic Systems
15th	Nursing and Medical Treatment Apparatus and Living Related Machinery	34th	Designs
16th	Heating, Refrigerating and Air-conditioning Engineering	35th	Trademarks: Chemicals and Foodstuffs
17th	Inorganic and Environmental Chemistry	36th	Trademarks: Machinery and Electric Appliances
18th	Materials Processing, Metals and Electrochemistry	37th	Trademarks: Textiles and General Merchandise
19th	Polymers and Plastics Engineering	38th	Trademarks: Industrial Services and General Service

## 1.2 Outline of the Trial for Patent Invalidation System

### (1) Objective

If any defect is found in a patent right, it is prohibited to work or use the invention concerned, etc. even if any person may work or use an invention, in principle. If the right with such a defect continues to exist, adverse effects can occur. For example, an unfair right is granted to the patentee and the industrial development is inhibited. In such a case, it is necessary to invalidate the right so that it is deemed never to have existed or it is deemed not to have existed from the time when any reason occurring after the grant of patent (the Patent Act Article 123(1)-7<sup>5</sup>). The Trial for Patent Invalidation System was introduced with the aim of addressing these cases (Article 123(1)).<sup>6</sup>

### (2) Flow of trial for patent invalidation

A trial for patent invalidation is commenced when the demandant submits a written request for trial to the effect that the patent is to be invalidated and the JPO accepts it (Article 131(1) and Article 123(1)). Once the written request for trial is accepted, an administrative judge is appointed (Article 137(1)), and a duplicate of the said written request for trial is transmitted to the patentee, who is a demandee, after conducting a formality check thereon. Also, an opportunity for submitting a written reply to the said written request for trial is given to the patentee who is a demandee (Article 134(1)). When a written reply is submitted, a duplicate thereof is transmitted to the demandant.

The demandee may file a request for correction within a period for the submission of written reply (Article 134-2(1)). Once the request for correction is accepted, a decision to approve or disapprove the correction is examined. Request for correction will be explained later.

Once the parties concerned submit their allegations by means of a written request for trial and a written reply, a trial examination on the case is conducted to determine the validity of the request for trial of the demandant. Since the examination procedures for trials for patent invalidation are conducted through oral proceedings in principle (Article 145), the procedures for oral proceedings basically start at this point. It should be noted that whether or not an opportunity for refutation (counterargument with the written reply) is given to the demandant is determined before the oral proceedings start (See Figure 2 below). If an opportunity for refutation is required, the chief administrative

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<sup>5</sup> The numbers of Articles in this chapter (Japan) shall refer to those in the “Patent Act” unless otherwise specified.

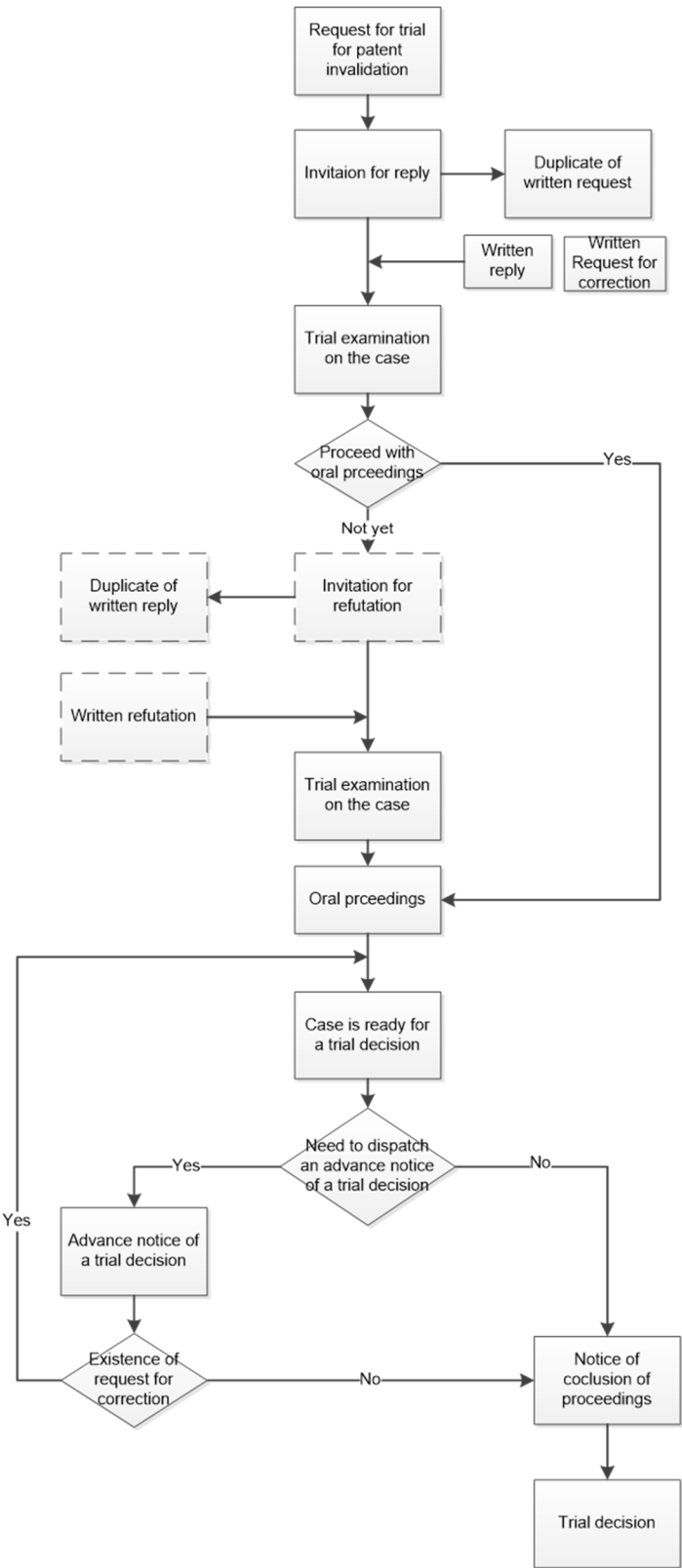
<sup>6</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 51-00 Trial for Patent Invalidation,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm)),



judge transmits a duplicate of the written reply to the demandant and gives him/her an opportunity for the submission of a written refutation, designating a period (Regulations under the Patent Act Article 47-3(1)). In exceptional cases where the case is examined only through documentary proceedings without oral proceedings, whether or not the case is ready for a trial decision is determined. If the case is judged to be ready for a trial decision, an advance notice of a trial decision (Article 164-2(1)) is issued or the examination is concluded to render a trial decision (See Figures 2 below).

Where a trial examination on the case is conducted and the case is judged to be ready for a trial decision, when the request for trial is found to have grounds (if a determination of patent invalidation is made) or in accordance with the other ordinances of the Ministry of Economy, Trade and Industry, the chief administrative judge shall issue an advance notice of the trial decision to the parties concerned and intervenors (Article 164-2(1)). After the advance notice of the trial decision is issued, an opportunity for correction is given to the demandee (Article 164-2(2)), but where no request for correction is filed, the chief administrative judge concludes the trial examination to render a trial decision (Article 157(1)).

Figure 2 Basic flow of trial for patent invalidation



### (3) Requirements, etc. for trial for patent invalidation

#### (i) Demandant

Only interested persons shall have the entitlement of a demandant for trials for patent invalidation (Article 123(2)). Since the opposition system was introduced in response to the revised Patent Act of 2014, a trial for patent invalidation may be filed only by “interested persons” instead of “any person” as provided in the former Act. “The interested persons” shall include, for example, “persons who are actually sued for infringement of patent right,” “persons who own similar patents,” and “persons who produce similar types of products to the patented invention.”<sup>7</sup>

Where a trial for patent invalidation is requested based on the grounds for invalidation relating to attribution of rights (violation of requirements for joint applications (Article 123(1)-2 and Article 38)) or misappropriated applications (Article 123(1) 6), only a person having the right to obtain a patent (genuine right holder) may file such a request (the entry in the parentheses of Article 123(2)).

#### (ii) Objects of trials for patent invalidation

One patent as administrative disposition may be subject to a trial for patent invalidation. Where a patent contains two or more claims, a trial for patent invalidation may be requested for each claim (Article 123(1)). Moreover, a trial for patent invalidation may be requested even after the attacked patent right has been surrendered or has lapsed (Article 123(3)).

#### (iii) Grounds for invalidation

The grounds for invalidation of patent are listed in Article 123(1) in a limited manner. No request for patent invalidation may be filed based on any other grounds. The grounds for invalidation are as follows:<sup>8</sup>

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<sup>7</sup> “Explanation of the Partial Revision of the Patent Act and Other Acts in 2014 and Industrial Property Laws,” p.121, edited by the Legislative Affairs Office, General Coordination Division, Policy Planning and Coordination Department, Japan Patent Office, and issued by the Japan Institute for Promoting Invention and Innovation on December 19, 2014.

<sup>8</sup> Each expression of the grounds for invalidation is based on “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 51-04 Subjects of Trial for invalidations and Grounds for Invalidation,” the JPO website ([http://www.jpo.go.jp/shiryoku/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryoku/kijun/kijun2/sinpan-binran_16.htm))

Table 2: Grounds for invalidation (Japan)

Item <sup>9</sup>	Grounds for invalidation
1	- New matter beyond the original text (Article 17-2(3))
2	<ul style="list-style-type: none"> <li>- Lack of foreign national's capacity to hold rights (Article 25)</li> <li>- Non-patentable invention (Article 29(1))</li> <li>- Lack of industrial applicability (the main paragraph of Article 29(1))</li> <li>- Lack of novelty (Article 29(1))</li> <li>- Lack of inventive step (Article 29(2))</li> <li>- Enlarged earlier application (Article 29-2)</li> <li>- Offense against public order and morality (Article 32)</li> <li>- Violation of requirements for joint applications (Article 38)</li> <li>- Earlier application (Article 39 1 to 4)</li> </ul>
3	- Violation of a treaty (Article 123(1)-3)
4	<ul style="list-style-type: none"> <li>- Description requirement of the detailed explanation (Article 36(4)-1)</li> <li>- Description requirement of the scope of claims (Article 36(6)-1~3)</li> </ul>
5	- New matters beyond original text (Article 123(1)-5)
6	- Usurped application (Article 123(1)-6)
7	- Grounds for invalidation occurring after the grant of patent (lack of foreign national's legal capacity to hold rights, and violation of a treaty that occur subsequently) (Article 123(1)-7)
8	- Inadequate correction (a correction that does not meet the requirements in Article 126) (Article 123(1)-8)

It should be noted that, with regard to the grounds for invalidation relating to attribution of rights (violation of requirements for joint applications (Article 38) and usurped application (Article 123(1)-5), they are excluded from grounds for invalidation when, based on the provisions of Article 74(1), a legitimate person having the right to obtain a patent files a request for transfer to the patentee and the transfer of the patent right has been registered (the entry in the parentheses of Article 123(1)-2 and Article 123(1)-6).

The timing of determining grounds for invalidation is different depending thereon. In the case of a patent, grounds for invalidation are determined usually at the time of the filing of the patent, while, in the case of grounds for invalidation occurring after the grant

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<sup>9</sup> "Items" in the table refer to the item numbers in the Patent Act Article 123(1).

of patent (Article 123(1)-7), a determination timing is the time when the patent comes to fall under the said grounds for invalidation after the grant thereof.<sup>10</sup>

(iv) Timing for request

A trial for patent invalidation may be requested at any time after the registration of the establishment of the patent right. A request may be filed even after the attacked patent right has been surrendered or has lapsed (Article 123-(1) and (3)).

(v) Procedures for filing a trial for patent invalidation

In order to file a trial for patent invalidation, the demandant of a trial shall submit to the Commissioner of the JPO a written request for trial (Article 123(1) and Article 131(1)). The written request for trial shall state “the name, and domicile or residence of the party concerned and the representative thereof (Article 131(1)-1), “the identification of the trial case (Article 131(1)-2) and “the object and statement of the claim (Article 131(1)-3)” (the main paragraph of Article 131, paragraph (1)). “The object of the request” describes what type of trial decision the demandant requires. For example, it is described as “I require a trial decision to the effect that Patent No.\_\_\_\_\_ is to be invalidated. The cost in connection with the trial shall be borne by the demandee.”<sup>11</sup>

Furthermore, where a trial for patent invalidation is requested, Article 131(2) states that “the facts on which the invalidation of the patent is based shall be specified in concrete terms, and the relationship of each fact that is required to be proved with the relevant evidence shall be stated” in the grounds for the request.

It should be noted that an evidence may be submitted, in principle, by the time when the trial examination is concluded. However, it is allowed to file a request for submission of evidences after the trial examination is concluded. In this case, the trial examination is resumed and an opportunity for giving a reply or submitting evidences thereon is given to the other party (Regulations under the Patent Act Article 47-2(1) and Article 47-3(1)).<sup>12</sup>

With regard to an amendment to a written request for trial, the gist thereof may not be changed, in principle (the main paragraph of Article 132-2(1)). However, some

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<sup>10</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 51-04 Subjects of Trial for invalidations and Grounds for invalidation,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))

<sup>11</sup> “Trial and Appeal Manual (16<sup>th</sup> edition) 51-07 Written Request for Trial for Invalidation,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))

<sup>12</sup> “Trial and Appeal Manual (16<sup>th</sup> edition) 34-01 Inspection of Processing on Submission of Evidences and Precautions,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))

exceptions apply in trials for patent invalidation.

Firstly, where a written request for trial does not meet the formality requirements (Article 131(1)) and it is ordered to be amended, amendment for any change of the gist is allowed with regard to the matter for which the amendment was ordered (Article 131-2(1)-3).

Secondly, an amendment to change the gist is permitted where a request for correction has been filed in the trial for patent invalidation and such request for correction has given rise to a need for amendment of the grounds for the request (Article 131-2(2)-1). Thirdly, an amendment to change the gist is permitted where there exist reasonable grounds for not stating the grounds for the request with regard to the amendment of the request at the time the request for trial was filed, and the demandee has agreed to such amendment (Article 131-2(2)-2). In the second or third case, an amendment is allowed only if the chief trial examiner recognizes that there is no possibility of unreasonable delay of the proceedings by such amendment (Article 131-2(2)).

#### **(4) Effect of trial decision**

Where a trial decision to the effect that a patent is to be invalidated has become final and binding, the patent right shall be deemed never to have existed (Article 125). Moreover, where a trial decision to the effect that the patent is to be invalidated has become final and binding pursuant to any grounds for invalidation occurring after the grant of patent (Article 123(1)-7), the patent shall be deemed never to have existed from the time when the said grounds became applicable to the patent (Article 125).

Where a trial decision has become final and binding, the parties concerned and the intervenors of the trial may not file a request on the basis of the same facts and the same evidence (Article 167). It shall be noted that, before the partial revision of the Patent Act in 2011, the effect of a trial decision was understood to extend over third parties concerned who were not involved in the trial. However, the effect of trial decision over third parties concerned was abolished in response to the partial revision.

Moreover, the scope of effect of a trial decision shall be the scope for which a trial for patent invalidation is requested. For example, where a request for a trial for patent invalidation is filed for each claim, the scope of effect extends to each claim. However, where a request for a trial for patent invalidation is filed for each claim and a request for correction is filed for a group of claims (explained later), the trial decision become final and binding for the said group of claims (Article 167-2(1)-1).

### 1.3 Request for correction

#### (1) Subject and timing of request

The system of request for correction allows any part with defect to be removed voluntarily after the patent is granted. The demandee in a trial for patent invalidation (patentee, etc.) may file a request for correction of the description, claims or drawing(s) attached to the application only within the time limit designated (Article 134-2 (1)) during the trial for patent invalidation.

The time limit during which a request for correction may be filed is as follows:

- i) Time limit for submission of a written reply associated with transmittal of duplicate of requests for trial for patent invalidation (Article 134(1))
- ii) Time limit for submission of a written reply after the transmittal of duplicate of written amendment of requests for trial concerned where an amendment to change the gist was permitted with regard to the grounds for the request mentioned in the written request for trial (Article 134(2)).
- (iii) Time limit for filing a request for correction made at the demandee's request within one week from the date trial decisions to uphold the patent was revoked by court decision in lawsuits rescinding trial decisions (Article 134-3).
- (iv) Time limit for submission of written opinion in response to a notice of reasons for invalidation which is made ex officio with regard to any grounds not pleaded by a party concerned or intervenor (Article 153 (2)).
- (v) Designated time limit for request for correction to advance notice of a trial decision (Article 164-2(2)).

#### (2) Subjects of request for correction

The subjects of request for correction are the description, scope of claims or drawing(s) attached to the application (Article 134-2(1)). A request for correction may be filed for the entire patent or for each claim where it is filed for the scope of claims containing two or more claims (Article 134-2(2)). However, where a trial for patent invalidation is requested for each claim, a request for correction shall be filed for each claim (Article 134-2(2)). It should be noted that a request for correction may be filed for claim(s) or the description for which a request is not filed in the trial for patent invalidation.

Moreover, where there are citation relations between the claim for which the correction is sought and other claims, a request for correction shall be filed for each group of those related claims (Article 134-2(3)).

“Group of claims” here shall refer to “a group of claims having citation relations

between one claim and other claims or any other relations in accordance with ordinance of the Ministry of Economy, Trade and Industry” (Article 120-5(4)). Any “relations in accordance with ordinance of the Ministry of Economy, Trade and Industry” are defined as “citation relations between one claim and other claims are related to the formation of the scope of claims, in whole or in part, in an integrated manner with citation relations between another one claim and other claims through the claims included in the said relations” (Regulations under the Patent Act Article 46-2). For example, where a request for correction is filed for dependent claims among multiple claims, those dependent claims constitute a “group of claims” and they form one unit at the time of filing the request for correction. Where the number of claim is one, a request for correction is filed for the entire patent right<sup>13</sup>.

### (3) Purposes of correction

Correction shall be limited to the following purposes:

- (i) Restriction of the scope of claims (Article 134-2(1)-1);
- (ii) Correction of errors or incorrect translations in the description (Article 134-2, (1)-2)
- (iii) Clarification of an ambiguous description (Article 134-2(1)-3)
- (iv) To correct description of the claims that cite description of another claim so that it does not cite the description of the said another claim (Article 134-2(1)-4).

The above-mentioned item (iv) was newly added in response to the partial revision of the Patent Act in 2011. This new Act provides that a request for correction shall be filed for each group of claim. Therefore, where a claim dependent on claims contained in a request for a trial for patent invalidation is not subject to request for correction, it was permitted to make a correction to dissolve the dependent relation.

### (4) Requirements for correction

The requirements for correction are as follows:<sup>14</sup>

- (i) The purpose of correction falls under each item in Article 134-2(1).
- (ii) A correction does not aim to add new matters (Article 126(5) as applied mutatis mutandis pursuant to Article 134-2(9)).
- (iii) A correction does not substantially enlarge or alter the scope of claims (Article 120(6))

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<sup>13</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 38-01 Unit for Request for Correction and Group of Claims,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))

<sup>14</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 38-03 Requirements for Correction,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))



as applied mutatis mutandis pursuant to Article 134-2(9)); and

(iv) The invention stated in the corrected scope of claims shall meet the independent requirements for patentability. However, claims included in a request for a trial for patent invalidation shall be excluded (Article 120(7) as applied mutatis mutandis by the reading of the terms pursuant to Article 134-2(2)).

#### **(5) Procedures for request for correction**

A request for correction is made by submitting a written request for correction (Article 131(1) as applied mutatis mutandis pursuant to Article 134-2 (9)), and formality check is conducted first. Where a request for correction is filed, the object and statement of the claim stated in the written request for correction shall be as specified in accordance with ordinance of the Ministry of Economy, Trade and Industry (Article 131(3)) and the corrected description, scope of claims or drawing(s) shall be attached to the written request (Article 131(4)).

A formality check is conducted once the chief administrative judge accepts a written request for correction. The chief administrative judge shall, where the written request for correction violates formality, order an amendment (Article 133 as applied mutatis mutandis pursuant to Article 134-2(9)).

After the formality check is conducted, whether or not the written request for correction meets the requirements for correction is examined. Where any violation of the requirements for correction is found, a notice of reasons for refusal of correction is transmitted to the demandant and the demandee (patentee) of the trial for patent invalidation (Article 134-2(5)). The patentee may respond by a written opinion or a written amendment, while the demandant of trial may also submit a written opinion (Article 134-2(5), Article 17-5(1), Article 17 (1)). Where there is no defect in the written request for correction or a defect is corrected, the patent shall be examined based on the corrected scope of claims in a trial for patent invalidation. Where the correction is not accepted, the patent before the correction will be examined in a trial for patent invalidation.

It should be noted that, in a request for correction, an amendment may be made to the corrected description, scope of claims or drawing(s) attached to the corrected written request for correction only in any of the following cases (Article 17-5(2)).

(i) First time limit for submission of a written reply after a request for trial has been

filed (Article 134(1));

(ii) Time limit for submission of a written reply where any amendment is made to the written request for trial (Article 134(2));

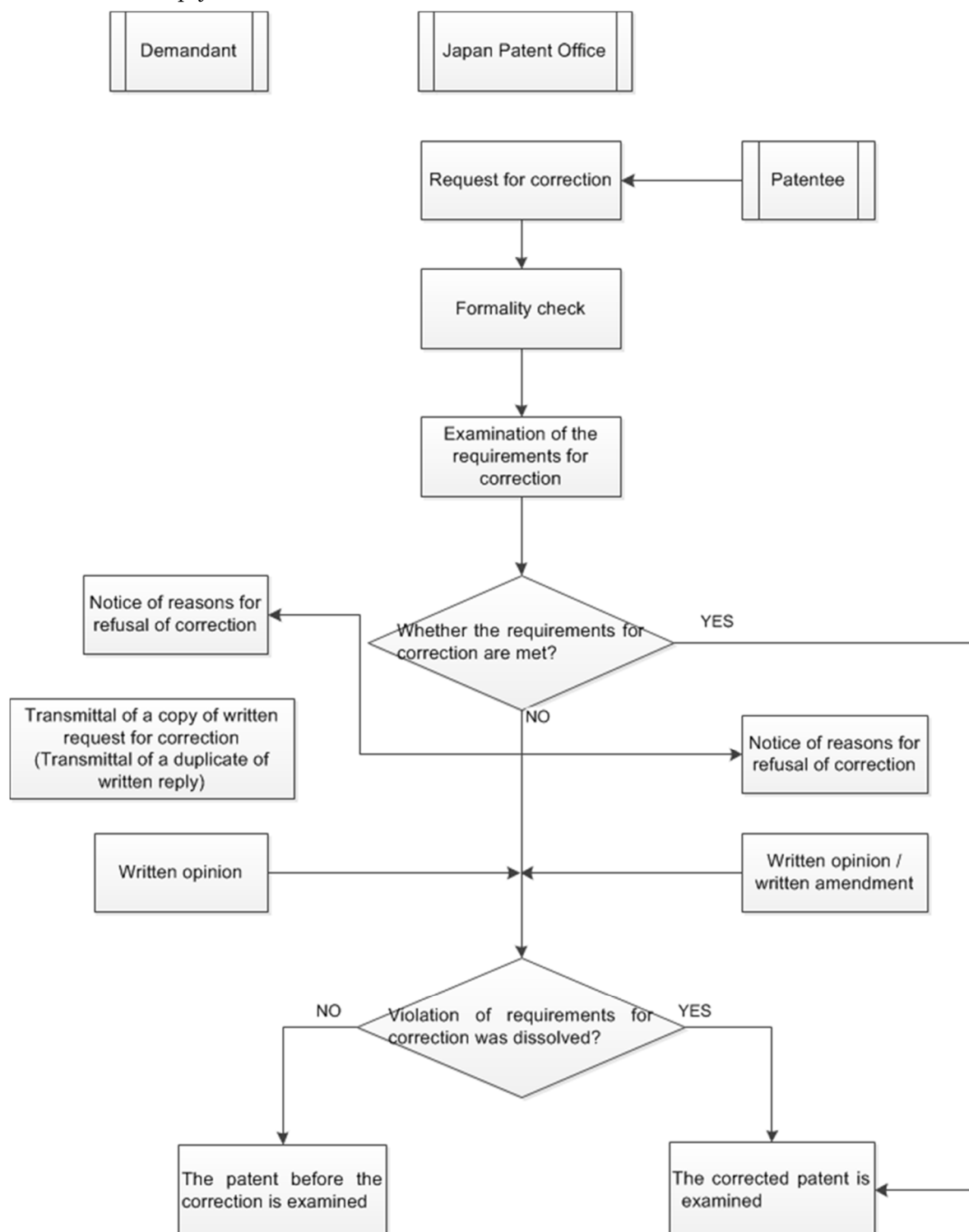
(iii) Time limit for submission of a written opinion when trial examination results on any grounds not pleaded by a party concerned are notified by ex-officio proceedings during the procedures for filing the request for correction (Article 134-2(5));

(iv) Time limit for filing a request for correction granted in response to trial decisions to uphold the patent is revoked by court decision (Article 134-3);

(v) Time limit for submission of a written opinion when trial examination results on any grounds not pleaded by a party concerned are notified by ex-officio proceedings (Article 153(2)); and

(vi) Designated time limit for filing a request for correction in response to an advance notice of a trial decision (Article 164-2(2)).

Figure 3: Flow of request for correction (In the case of the first time limit for submission of a written reply)<sup>15</sup>



<sup>15</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 51-03 Flow of Trial for Invalidations by IP type,” prepared based on Figures 1-1 and 4, the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))

## 1.4 Oral proceedings

The examination procedures for patent invalidation are conducted through oral proceedings in principle (Article 145(1)). Oral proceedings are useful method to supplement allegations of the parties concerned which cannot be expressed sufficiently by written statements and to fully grasp state of the art and accurately understand issues in dispute.<sup>16</sup> Different from civil suits, in a trial for patent invalidation, all matters submitted in writing are treated as having been stated orally and ex-officio proceedings may be held (Article 152). Any grounds not pleaded by a party concerned may be examined in a trial for patent invalidation (Article 153, paragraph (1)).

### (1) Overall flow

Oral proceedings are conducted typically at the stage when all allegations and proofs of the parties concerned are prepared and when a written request for trial, a written reply from the demandee and a written refutation (if necessary) are ready. The date of oral proceedings is set first, and once the date and place are decided, a written notice of proceeding matters (explained later) with the date will be sent to both the demandant and the demandee. At this point, it may be required to submit an oral proceedings statement brief (explained later). Time limit for submission of an oral proceedings statement brief is typically set one week or two weeks before the date of oral proceedings. Once this oral proceedings statement brief is submitted, it will be sent to the other party concerned by fax.

In oral proceedings, the parties concerned make statements, the chief administrative judge make an inquiry and conduct examination of evidence, and in some cases, an advance notice is given. This advance notice includes, for example, the date of the next oral proceedings, a notice of conclusion of trial examination, an invitation to reply or for refutation, a notice of reasons for invalidation and a notice of reasons for refusal of correction.

Where oral proceedings are conducted, a written record of oral proceedings is prepared. A written record of oral proceedings is prepared by the trial clerk for each date and the persons who made statements and the gist thereof are recorded briefly together with formal matters described including the trial case numbers, etc. Where the chief administrative judge mentions matters to be recorded in an oral proceeding, they will be recorded in a written record. After a written record is prepared, a copy thereof will be sent to the parties concerned by fax.

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<sup>16</sup> Operational Guideline for Oral Proceedings,” the Trial and Appeal Department, the JPO, p.1, October 2015, the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/koutou\\_shinri.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/koutou_shinri.htm))

## **(2) Written notice of proceeding matters**

The purpose of a written notice of proceeding matters is to “notify the parties concerned of proceeding matters which the panel plans to examine on the date of oral proceedings before the said date” and, after the date of oral proceedings is set, a written notice of proceeding matters with the decided date will be sent to the parties concerned. By notifying the parties concerned of the contents to be examined in oral proceedings, this written notice aims to encourage the parties concerned to make preparations based thereon, helps the panel smoothly conduct the oral proceedings and collect materials necessary for rendering a trial decision. This written notice of proceeding matters states provisional opinions of the panel consisting of administrative judges at the time of preparing the written notice and, if necessary, requests for opinions or technical explanations for the parties concerned.<sup>17</sup> Moreover, the parties concerned are encouraged to submit an oral proceedings statement brief.

## **(3) Oral proceedings statement brief**

An oral proceedings statement brief (Regulations under the Patent Act Article 51) aims “to ensure collection of statements and hearings of opinions of the parties concerned without missing a word even if the relations of facts complicated and wide-ranging and to conduct oral proceedings efficiently by allowing the parties concerned to construct theories in their statements in a detailed manner.”<sup>18</sup> Typically, the parties concerned are required to submit an oral proceedings statement brief one week or two weeks before the date of oral proceedings. It should be noted that, where a written request for trial is stated appropriately and clearly in submitted documents including a written reply, there is no need to submit an oral proceedings statement brief.

## **(4) Contents of oral proceedings**

In oral proceedings, the chief administrative judge or associate administrative judges ask the parties concerned or intervenors questions on factual or legal matters or encourage the parties concerned or intervenors to prove such matters (of the Regulations under the Patent Act Article 52-2), and if necessary, examination of evidence and an examination of witness will be carried out. Different from civil suits, all matters

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<sup>17</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 33-08 Written Notice of Proceeding Matters,” p.p.1~2, the JPO website ([http://www.jpo.go.jp/shiryoku/kijun/kijun2/sinpan-binran\\_16.htm#15\\_51](http://www.jpo.go.jp/shiryoku/kijun/kijun2/sinpan-binran_16.htm#15_51))

<sup>18</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 33-07 Oral Proceedings Statement Brief,” p.1, the JPO website ([http://www.jpo.go.jp/shiryoku/kijun/kijun2/sinpan-binran\\_16.htm#15\\_51](http://www.jpo.go.jp/shiryoku/kijun/kijun2/sinpan-binran_16.htm#15_51))

submitted in writing including a written request for trial, a written reply, etc. are treated as having been stated effectively in a trial for patent invalidation even if no statement is actually made thereon in oral proceedings.<sup>19</sup>

#### (5) Written record

Where oral proceedings are conducted, a written record thereof is prepared for each date. This written record of oral proceedings states the gist thereof and other necessary matters together with formal matters described including the time and date, persons appeared, the panel, etc.

#### 1.5 Flow from a patent invalidation trial to a suit

Where a party concerned, an intervenor or a person whose application for intervention in the trial has been refused is dissatisfied with the result of the trial for patent invalidation, he/she may institute lawsuits rescinding trial decisions before the Tokyo High Court within 30 days from the date on which a certified copy of the trial decision or the ruling has been served (Article 178(2) and (3)).

Lawsuits rescinding trial decisions are held at a court, because the Japan Patent Office does not have jurisdiction thereover. Therefore, the procedures for instituting lawsuits rescinding trial decisions are undertaken based on the Code of Civil Procedure, the Rules of Civil Procedure, etc.

Where a suit against a trial decision is instituted concerning the result, a court shall rescind the trial decision or the ruling where it finds that the request is found to have grounds (Article 181(1)). On the other hand, where the court finds that the request is found to have no grounds, the court shall dismiss the said suit.

Where a request is found to have grounds in lawsuits rescinding trial decisions (the trial decision is held illegal), a court decision rescinding the trial decision will be made. In this case, since the said trial for patent invalidation becomes pending, it becomes during pendency before the JPO again and will be further examined (Article 181(2)). Where the trial for patent invalidation becomes pending again, the court decision of the prior lawsuits rescinding the trial decisions binds the JPO for the said case. Thus, a trial decision shall be rendered again in accordance with the conclusion of the court decision, fact finding by evidence required to draw the conclusion and matters stated

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<sup>19</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 33-00 Method of Oral Proceedings,” p.1, the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm#15\\_51](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm#15_51))

in the grounds for the court decision as legal judgment.<sup>20</sup>

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<sup>20</sup> “Manual for Appeal and Trial Proceedings (16<sup>th</sup> edition) 51-21 Procedures after the Trial Decision for Invalidation Trial is Rendered,” the JPO website ([http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran\\_16.htm](http://www.jpo.go.jp/shiryou/kijun/kijun2/sinpan-binran_16.htm))

## 2 China

### 2.1 Structure of the Trial and Appeal Department

In China, the Patent Law provides for patents, utility models and designs which are equivalent to patents, utility models and designs in Japan. The State Intellectual Property Office (SIPO<sup>21</sup>) has jurisdiction over applications therefor (patent applications). The Patent Reexamination Board under the SIPO (hereinafter referred to as “the Patent Reexamination Board”) is in charge of reexaminations (appeals against an examiner’s decision of refusal in Japan) and requests for declaring a patent right invalid (trials for invalidation of patent in Japan). The Patent Reexamination Board was established in November 1984 by the SIPO and consists of technical and legal experts appointed by the Patent Administration Department of the State Council of the People’s Republic of China. The chief of the Patent Reexamination Board is a senior member of the Patent Reexamination Board (See Figure 4), and is also in charge of the Patent Administration Department of the State Council (SIPO). The Patent Reexamination Board is composed of 23 divisions. Of them 14 divisions are in charge of patents and utility models, and one division is in charge of designs. The number of members of the Board (including administrative judges and staff) was 305 as of the end of Jun. 2016.<sup>22</sup> The structure of administrative judges of each division is shown in Table 3.

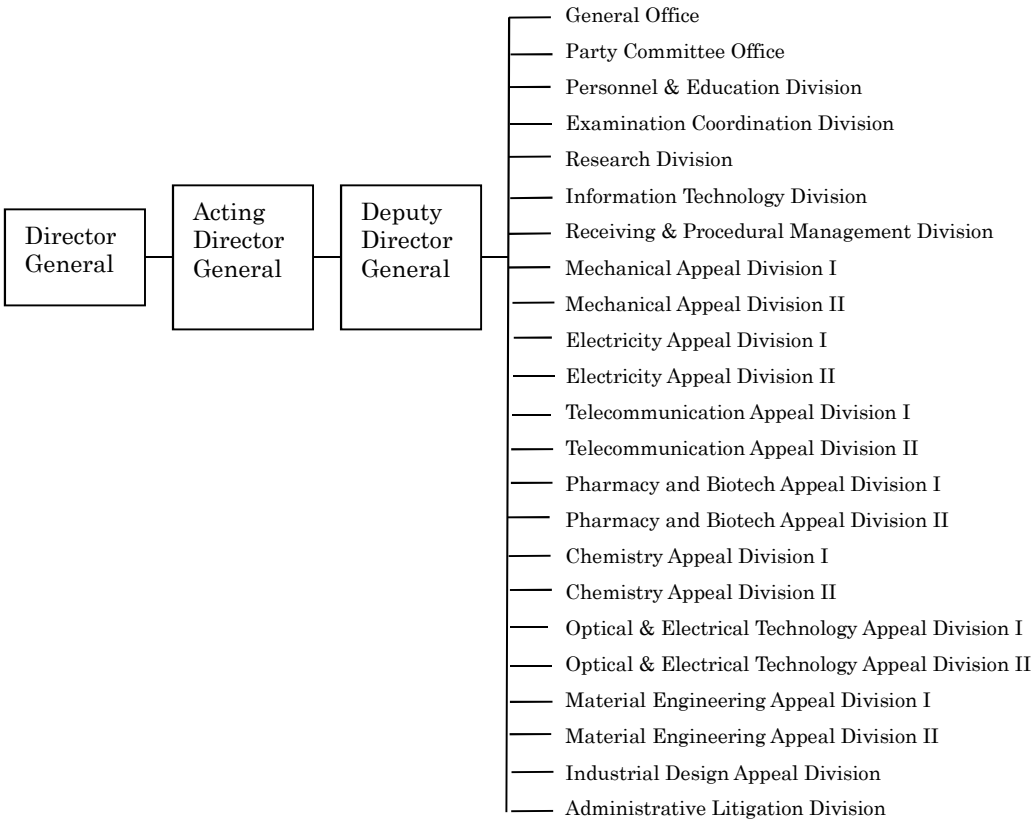
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<sup>21</sup> SIPO: The State Intellectual Property Office of P.R.C.

<sup>22</sup> Status of personnel, the SIPO website (<http://www.sipo-reexam.gov.cn/zwgk/fsgk/ryqk/index.htm>)



Figure 4: Organization of the Patent Reexamination Board<sup>23</sup>



<sup>23</sup>Organization Chart, the Patent Reexamination Board website (<http://www.sipo-reexam.gov.cn/zwgk/fsgk/zzjg/index.htm>)

Table 3: Divisions of the Patent Reexamination Board and the number of staff

Division	Number of staff	Division	Number of staff
General Office	9	Telecommunication Appeal Division II	17
Party Committee Office	2	Pharmacy and Biotech Appeal Division I	12
Personnel & Education Division	6	Pharmacy and Biotech Appeal Division II	15
Examination Coordination Division	5	Chemistry Appeal Division I	11
Research Division	6	Chemistry Appeal Division II	10
Information Technology Division	4	Optical & Electrical Technology Appeal Division I	13
Receiving & Procedural Management Division	8	Optical & Electrical Technology Appeal Division II	14
Mechanical Appeal Division I	19	Material Engineering Appeal Division I	12
Mechanical Appeal Division II	19	Material Engineering Appeal Division II	17
Electricity Appeal Division I	16	Design Appeal Division	28
Electricity Appeal Division II	22	Administrative Litigation Division	22
Telecommunication Appeal Division I	15		

## 2.2 Outline of the system of request for declaring a patent right invalid

### (1) Outline and basis provisions

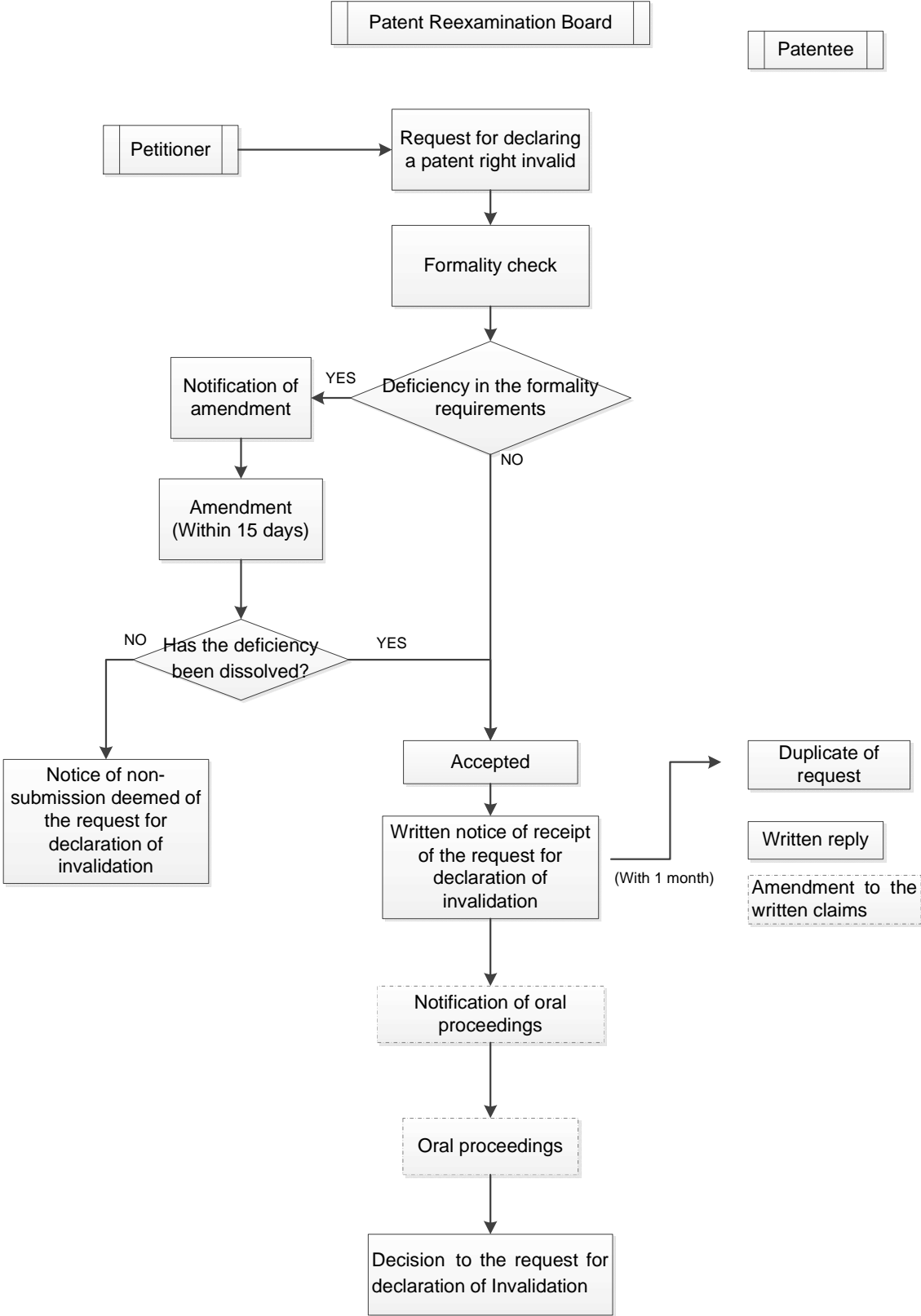
Under the system of request for declaring a patent right invalid, the patent right may be invalidated upon request with regard to a patent for invention (patent) after the said right has been granted. Articles 45 to 47 of the Patent Law provide for this request. Any organizations such as enterprises and individuals may file a request for invalidation from the date on which the patent right is granted and published (Article 45 of the Patent Law). Where the Patent Reexamination Board has rendered a decision of invalidation of the patent right, the said patent right shall be deemed never to have existed (Article 47 of the Patent Law).

## **(2) Flow of the system of request for declaring a patent right invalid**

Any organization or individual may file a request for declaring a patent right invalid after the publication of registration of the patent for invention (Article 45) and even after it has expired or has been abandoned (Part IV, Chapter 3, 3.1 of the Guidelines for Patent Examination). Once a request for invalidation is accepted, the Patent Reexamination Board carries out a formality check to examine whether or not the written request submitted and attachments comply with prescribed formats. Where any of those documents does not comply with prescribed formats, the Patent Reexamination Board informs the petitioner to make an amendment. Where the petitioner does not make an amendment within a designated period or the same defect persists after making amendments twice, the said request for invalidation shall be deemed to have not been submitted (Part IV, Chapter 3, 3.4 of the Guidelines for Patent Examination).

The Patent Reexamination Board examines a request for declaring a patent right invalid at an appropriate time and makes a decision and notifies the petitioner and patentee of the decision. The patentee may make an amendment to the claims (equivalent to a correction of the scope of claims in Japan. This amendment will be explained later) in prescribed cases during the examination proceeding. Where invalidation of a patent right is decided after examination, the Patent Administrative Division of the State Council registers and publishes the decision. Where the petitioner or patentee is dissatisfied with the decision made by the Patent Reexamination Board, he/she may take a legal action before the Beijing IP court within three months from the date of receipt of the notice. The court, in turn, sends a notice informing the other party concerned who undertook the procedures for request for invalidation to intervene in the suit as a third party (Article 46). It should be noted that a patent right which has been declared to be invalid shall be deemed never to have existed (Article 47).

Figure 5: Flow of trial for patent invalidation



### (3) Requirements for filing a request for declaring a patent right invalid

#### (i) Petitioner

“Any unit or individual” may file a request for declaring a patent right invalid (Article 45, paragraph (1) of the Patent Law). “Individuals” shall include the patentees and inventors.<sup>24</sup>

#### (ii) Objects of request for declaring a patent right invalid

The objects of the request for declaring a patent right invalid are “patents for which the right has been granted” and include expired or abandoned patent rights (Article 45, paragraph (1) of the Patent Law and Part IV, Chapter 3, 3.1 of the Guidelines for Patent Examination).

#### (iii) Grounds for invalidity

The Implementing Regulations of the Patent Law provides for grounds for request for declaring a patent right invalid and the grounds are limited to those provided in Rule 65, paragraph (2) of the Implementing Regulations of the Patent Law (Guidelines for Patent Examination Part IV, Chapter 3, 3.3(2)). The grounds for invalidation provided in the Bylaws are shown in Table 4.

Table 4: List of grounds for invalidation

Articles in which grounds for invalidation are provided	Grounds for invalidation
Article 2	Lack of eligibility for protection
Article 20, paragraph (1)	Violation of provision for confidentiality examination (where a patent application is filed in a foreign country for an invention made in China, the patent application has to go through a confidentiality examination before its publication)
Article 22	Lack of novelty, inventive steps or practical applicability of inventions

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<sup>24</sup>何騰雲“Procedures for Prohibiting the Granting of Rights and Procedures for Invalidation of Rights in China (Featured: Opinions of Local Patent Attorney, Inhibition of Granting of Rights and Invalidation,” Patent 2013 Vol.66 No.10, p.p.12~22, Japan Patent Attorneys Association, August 2013.

Article 23	Same as a prior design or a prior Chinese patent application which is filed before and disclosed after the filing date of the discussed design, or not significantly differ from prior design or combination of prior design features, or conflict with prior rights of others
Article 26, paragraph (3)	Violation of descriptive requirements (requirement sufficient for publication) for written description (description in Japan)
Article 26, paragraph (4)	Violation of descriptive requirements (requirements for support and clarity) for written claim (scope of claims in Japan)
Article 27, paragraph (2)	Violation of descriptive requirements for drawings of design
Article 33	Addition of new matters
Implementing Regulations of the Patent Law Rule 20, paragraph(2)	lack of essential technical features for independent claim
Implementing Regulations of the Patent Law Rule43, paragraph(1)	Addition of new matters to divisional application
Article 5	Violation of social ethics
Article 25	Grounds for non-patentability
Article 9	first file application rule

(iv) Timing for request

Where a patent right has already been published, a request for declaring invalidation may be filed, even if the patent right has expired or been abandoned (unless it has been abandoned from the filing date) (Part IV, Chapter 3, 3.1 of the Guidelines for Patent Examination).

(v) Procedures for request for declaring a patent right invalid

A petitioner files a request for declaring a patent right invalid by submitting a written request therefor and evidences required to the Patent Reexamination Board (Rule 65, paragraph (1) of the Implementing Regulations of the Patent Law). A written request for declaration of invalidation shall state the scope of request for which declaration of invalidation is sought and the grounds for the request. First of all, the scope of request

for declaration of invalidation has to be clarified. Where it is not clear, the Patent Reexamination Board requires the petitioner to make an amendment within a prescribed period (Part IV, Chapter 3, 3.3(1) of the Guidelines for Patent Examination). Moreover, in the grounds for the request, “it is required to specifically explain the grounds for filing a request for declaring a patent right invalid by combining all evidences submitted and to point out each evidences on which ground is based” (Rule 65, paragraph (1) of the Implementing Regulations of the Patent Law). Specifically, the grounds provided in Rule 65, paragraph (2) of the Implementing Regulations of the Patent Law “shall be submitted as independent grounds based on related Articles, paragraphs or items in the Patent Law and Implementing Regulations thereof” (Part IV, Chapter 3, 3.3(2) of the Guidelines for Patent Examination). Furthermore, where evidences are submitted, specific explanations for grounds shall be given with regard to all evidences submitted (Part IV, Chapter 3, 3.3(5) of the Guidelines for Patent Examination). The Guidelines for Patent Examination define “specific explanations shall be given” as “it is necessary to specifically describe and perform a comparative analysis on pending patents and related technical solution in cited documents with regard to inventions or utility models whose technical solution need to be compared (Part IV, Chapter 3, 3.3(5) of the Guidelines for Patent Examination).”

It should be noted that, where the grounds for declaration of invalidation are not explained specifically, the said request for declaration of invalidation is not accepted (Rule 66, paragraph (1) of the Implementing Regulations of the Patent Law).

Where a written request for declaring a patent right invalid and attachments do not comply with prescribed formats, the petitioner is required to make an amendment, designating a period (Rule 66, paragraph (4) of the Implementing Regulations of the Patent Law). Where the petitioner does not make an amendment within a designated period or the same defect persists after making amendments twice, the said request for declaration of invalidation shall be deemed to have not been submitted (Rule 66, paragraph (4) of the Implementing Regulations of the Patent Law and Part IV, Chapter 3, 3.4 of the Guidelines for Patent Examination).

Where a request for declaration of invalidation is determined to comply with the Patent Law and other provisions as a result of a formality check, the Patent Reexamination Board issues a notification of acceptance of the request for declaration of invalidation to the petitioner and the patentee and sends duplicates of the said request and related documents to the patentee. Moreover, an opportunity to submit a written

reply is given to the patentee at this moment. The period for submitting a written reply is one month from the date on which the patentee received a notification of acceptance of the request for declaration of invalidation (Part IV, Chapter 3, 3.7(3) of the Guidelines for Patent Examination).

With regard to the grounds for and evidences of the request for declaration of invalidation, grounds may be added or evidences may be supplemented within one month from the date on which the petitioner filed the request of invalidation (Rule 67 of the Implementing Regulations of the Patent Law). Where grounds or evidences added are not explained specifically or grounds have been added or evidences have been supplemented after the lapse of the said period, the Patent Reexamination Board may decide not to take them into consideration (Rule 67 of the Implementing Regulations of the Patent Law and Part IV, Chapter 3, 4.2(1) and 4.3.1(1) of the Guidelines for Patent Examination).

It should be noted that a period designated by the Patent Reexamination Board may not be extended in the procedures of invalidation (Rule 71 of the Implementing Regulations of the Patent Act).

#### **(5) Effect of trial decision**

A patent right for which invalidation has been declared shall be deemed never to have existed. It should be noted that this declaration of invalidation does not apply retroactively to a judgment of infringement of a patent right which has been decided and already executed by a people's court before the said declaration of invalidation, a written arbitration, a ruling processing the infringement dispute which has already been enforced or compulsorily executed or an agreement of an already enforced license or an agreement on transfer of the patent right (Article 47, paragraph (2) of the Patent Law).

Moreover, after the Patent Reexamination Board has made a decision, another request for declaring the patent right invalid based on the same grounds and the same evidences will not be accepted unless such grounds and evidences were not taken into consideration in above decision due to the time limit (ne bis in idem, Rule 66, paragraph(2) of the Implementing Regulations of the Patent Law).(Part IV, Chapter 3, 3.3(3) of the Guidelines for Patent Examination).

#### **2.3 Amendment (correction) of patent documents in the procedures for declaration of**



## **invalidation**

### **(1) Subject of and timing for request**

The patentee may make an amendment to the scope of claims in the process of examination of a request for declaration of invalidation (Rule 69, paragraph (1) of the Implementing Regulations of the Patent Law).

In any of the following circumstances, an amendment may be made to the written claims only within the period for submitting a written reply until the Patent Reexamination Board makes a decision on the request for declaration of invalidation (Part IV, Chapter 3, 4.6.3 of the Guidelines for Patent Examination).

- (i) The amendment is made to the written request for invalidation;
- (ii) The amendment is made to the grounds for invalidation added or evidences supplemented by the petitioner; or
- (iii) The amendment is made to the grounds for invalidation or evidences which are cited by the Patent Reexamination Board but not mentioned by the petitioner.

### **(2) Principles for amendment**

The principles for amendments are as follows (Part IV, Chapter 3, 4.6.1 of the Guidelines for Patent Examination):

- (i) The amendment should not alter the name of the title of the original granted claims;
- (ii) The amendment should not enlarge the scope of protection in comparison with the claims at the time of the granting thereof;
- (iii) The amendment should not exceed the scope stated in the original written description and the scope of claims; and
- (iv) The amendment should not add technical features not included in the claims at the time of the granting thereof.

### **(3) Subject of amendment**

The patentee may make an amendment only to the written claim among patent documents and may not make any amendment to the written description and drawing(s) (Rule 69, paragraphs (1) and (2) of the Implementing Regulations of the Patent Law).

### **(4) Purposes of amendment**

An amendment made to the written claims is limited, in principle, to deletion or combining of claims and deletion of technical solution (Part IV, Chapter 3, 4.6.2 of the

Guidelines for Patent Examination).

Deletion of claim(s) shall refer to deletion of one claim or more claims from the written claims and combining of claims shall refer to combining of two or more dependent claims belonging to the same independent claims where they do not have a dependent relation but have a alternative relation. In this case, the technical features of the above mentioned dependent claims are combined, a new claim is formed. This new claim should include all technical features of the combined dependent claims and a new claim may be formed only when an amendment has been made to the independent claim.

Deletion of technical solution shall refer to deletion of one or more technical solutions from two or more technical solutions that are in parallel alternative in the same claim (Part IV, Chapter 3, 4.6.2 of the Guidelines for Patent Examination).

## 2.4 Oral proceedings

### (1) Outline

In the procedures for declaring a patent right invalid, oral proceedings refer to hearing in administrative procedures which may be conducted upon request from a party concerned or upon a decision by the Patent Reexamination Board in accordance with actual contents (Rule 70 of the Implementing Regulations of the Patent Law and Part IV, Chapter 4, 1 of the Guidelines for Patent Examination). These oral proceedings “aim to investigate facts and provide the parties concerned with an opportunity to make statements in the trial court” (Rule 70 of the Implementing Regulations of the Patent Law and Part IV, Chapter 4, 1 of the Guidelines for Patent Examination).

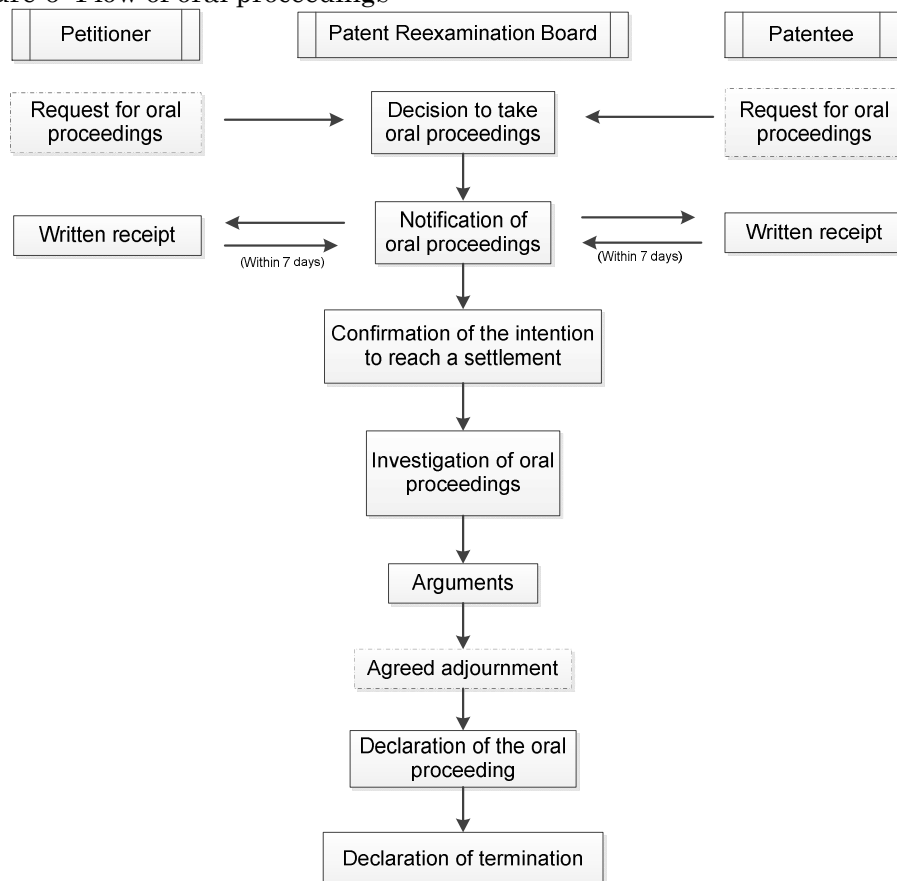
### (2) Flow of oral proceedings

In the procedures for declaration of patent invalidation, oral proceedings are conducted where the panel decides to conduct them in accordance with actual needs of the case or where a party concerned submits a request therefor based on prescribed grounds. Where a party concerned files a request for oral proceedings, he/she shall explain the reasons. Some of these reasons are listed in the Guidelines for Patent Examination (Part IV, Chapter 4, 2).

- (i) One party requests for a face-to-face cross examination or argument with the other party;
- (ii) It is necessary to explain the facts face-to-face to the panel;
- (iii) It is necessary to make a demonstration using an real thing; and
- (iv) It is necessary to have a witness who gave a testimony testify at the court.

Where oral proceedings are conducted, the panel issues a notification of oral proceedings to the parties concerned to notify them of the time and place of the oral proceedings. The parties concerned shall submit to the Patent Reexamination Board a written receipt within seven days from the date of receipt of the notification of oral proceedings. )It should be noted that, where the petitioner does not submit a written receipt and fails to attend the oral proceedings, a request for declaration of invalidation shall be deemed withdrawn. The number of persons of parties concerned including representatives thereof who may intervene in oral proceedings is up to four (Part IV, Chapter 4, 3 of the Guidelines for Patent Examination). Moreover, observers may sit in oral proceedings, but they do not have the right to make any remark (Part IV, Chapter 4, 12 of the Guidelines for Patent Examination).

Figure 6: Flow of oral proceedings



Theoretically the oral proceedings are taken in the order of four stages.

(a) First stage (Part IV, Chapter 4, 5.1 of the Guidelines for Patent Examination)

In the first stage, the members of the panel and the intervenors in the oral

proceedings are introduced. Where both parties concerned are present at the court, they are asked if they have any objection to eligibility of the intervenor(s) of the other party. Then, the intention to reach a settlement is also confirmed. Where a difference in conditions for settlement is so large that it is difficult to hold consultations in a short period of time or any of the parties concerned does not have the intention to reach a settlement, the oral proceedings will continue.

(b) Second stage (Part IV, Chapter 4, 5.2 of the Guidelines for Patent Examination)

In the second stage, after brief explanations on the case are given as needed, an investigation by oral proceedings starts. Firstly, the petitioner of declaration of invalidation makes a brief statement on the scope of request for the declaration of invalidation, grounds therefor, and related facts and evidences. Then, the patentee gives a reply and the scope of request for the declaration of invalidation of the case, the grounds and evidences submitted by each party concerned are cross-checked to determine the scope of examination in the oral proceedings. At this moment, a party concerned may add any ground or evidence. Where any ground is added or any evidence is supplemented, the panel makes a judgment on whether or not the ground or evidence is to be considered. Where the ground or evidence is to be considered, an opportunity to give a reply instantly or to submit a reply in writing afterwards is given to the other party.

(c) Third stage (Part IV, Chapter 4, 5.3 of the Guidelines for Patent Examination)

In the third stage, the arguments of oral proceedings are held in which the parties concerned make a statement of opinion on the facts shown in evidences and on applicable laws and regulations, and then make an argument. Once the arguments of both parties concerned are completed, stop is declared and they will make the final statement. At this point, the petitioner is permitted to withdraw the request for declaration of invalidation, abandon part of the grounds and corresponding evidences or restrict the scope of request for the declaration of invalidation. Moreover, the patentee may declare restriction of the scope of claims or abandon some of the claims of the patent.

(d) Fourth stage (Part IV, Chapter 4, 5.4 of the Guidelines for Patent Examination)

In the fourth stage, the panel may temporarily adjourn the court in accordance with the status of the case in order to hold discussions. Then, the oral proceedings are resumed, and the conclusion of the oral proceedings is declared by the director of the panel to terminate the oral proceedings.

## 2.5 Flow from a Trial for Patent Invalidation to a Suit

A party concerned who is dissatisfied with the result of a judgment made by the Patent Reexamination Board may institute a suit before the Beijing IP court within three months from the date of receipt of a notification of the decision (Article 46, paragraph (2)).

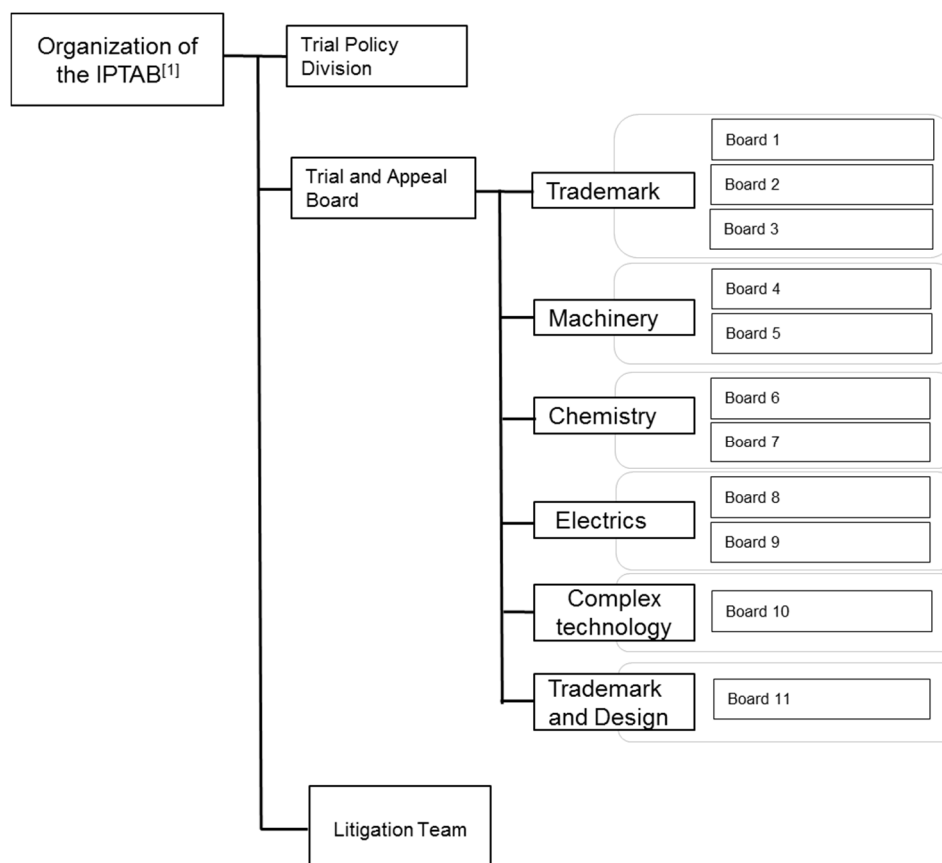
### 3. The Republic of Korea

#### 3.1 Structure of the Trial and Appeal Departments

Article 132-2, paragraph (1)<sup>25</sup> of the Patent Act<sup>26</sup> provides that “the Intellectual Property Trial and Appeal Board (IPTAB) shall be established under the Commissioner of the Korean Intellectual Property Office (KIPO) in order for it to take charge of administrative affairs related to trials, appeals and retrials of patents, utility models, designs and trademarks and researches and studies thereon.”

The IPTAB consists of 11 Trial and Appeal Boards in direct charge of trials and appeals, the Trial Policy Division in charge of trial and appeal-related affairs and the Litigation Team in charge of carrying out lawsuit-related affairs.

Figure 7: Organization of the IPTAB<sup>27</sup>



<sup>25</sup> Hereinafter in this chapter, the Patent Act of the Republic of Korea is described as “the Patent Act.” Moreover, the description is based on the current Act at the time of writing this report in July 2016 (Enforced on June 30, 2016 (Act No.14112)), unless otherwise indicated. It should be noted that the new Act will be enforced from March 1, 2017 and, where the new Act is cited, the effect thereof is stated.

<sup>26</sup> Article 132-16 in new Patent Act to be enforced in March 2017.

<sup>27</sup> Source: <http://www.kipo.go.kr/ipt/intro/intro020.html>

## (1) Structure

Presiding administrative judges: 11

Administrative judges: 95

Table 5: Number of staff of each Trial and Appeal Board of the IPTAB

Name of trial and appeal Board	1	2	3	4	5	6	7	8	9	10	11	Total
Presiding administrative judge	1	1	1	1	1	1	1	1	1	1	1	11
Administrative judges	6	6	6	9	9	13	13	9	9	9	6	95

## (2) Assigned fields for each Trial and Appeal Board

Table 6: Fields taken charge by each Trial and Appeal Board of the IPTAB

Category		Fields	
Trademark	Board 1	Trademark	Cosmetics, detergents, musical instruments, insurance, real estate, food and beverages, furniture, cigarettes, smoking equipment
	Board 2	Trademark	Leather and leather goods, clothes, footwear, hats, beverages, teas, legal services, communications and broadcasting, alcoholic beverages
	Board 3	Trademark	Precious metals, jewelries, watch tools, meats and fishes, poultry, eggs, milk, bedspread
Patent	Board 4	Machinery	Machinery, construction, metals
	Board 5	Machinery	Machinery
	Board 6	Chemistry	Agricultural and fishery food environment, chemical engineering (general), chemical materials
	Board 7	Chemistry	Biotechnology, pharmaceuticals, textiles, medical technology, polymer
	Board 8	Electrics	Electrics and electronics, computers, communication networks
	Board 9	Electrics	Electrics and electronics, computer systems, semiconductors, display
	Board 10	Complex technology	Common technology, complex technology

Trademark and Design	Board 11	Trademark and Design	Office appliances, articles for sales, transportation and carrier machinery, electrics and electronics, communication machinery and equipment, clothes, housewares, sports equipment
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## 3.2 Outline of the System for Patent Invalidation Trial

### (1) Objective

Where a patent right has any ground of invalidation, an unlawful right is granted to specified persons with regard to an invention which may be worked freely by any person and the industrial development is hindered, thereby causing various adverse effects. Therefore, the Patent Act provides for the system for patent invalidation trial in order to prevent adverse effects from occurring caused by the existence of such patent right with defects by allowing it to be invalidated (Article 133).<sup>28</sup>

### (2) Flow of patent invalidation trial

A patent invalidation trial is commenced when the demandant submits a written request to the effect that a patent is to be invalidated and it is accepted by the IPTAB (Article 140, paragraph (1)). Once the written request is accepted, administrative patent judges are appointed (Article 144, paragraph (1), a formality check of the written request is conducted (Article 141, paragraph (1)), and a duplicate of the said written request is sent to the patentee who is a demandee. At the same time, an opportunity to submit a written reply to the said written request is given to the demandee (Article 147, paragraph (1)). Where a written reply is submitted, a duplicate thereof is transmitted to the demandant (Article 147, paragraph (2)).

The demandee may file a request for correction within the period for submission of written reply (Article 133-2, paragraph (1)). Once the request for correction is accepted, a duplicate thereof is transmitted to the demandant (Article 133-2, paragraph (3)) and a decision to approve or disapprove the correction is examined.

After both parties concerned submit allegations in the form of written request and written reply, a trial examination on the case is conducted to see whether or not the request filed by the demandant is valid based on the allegations. Oral hearing or

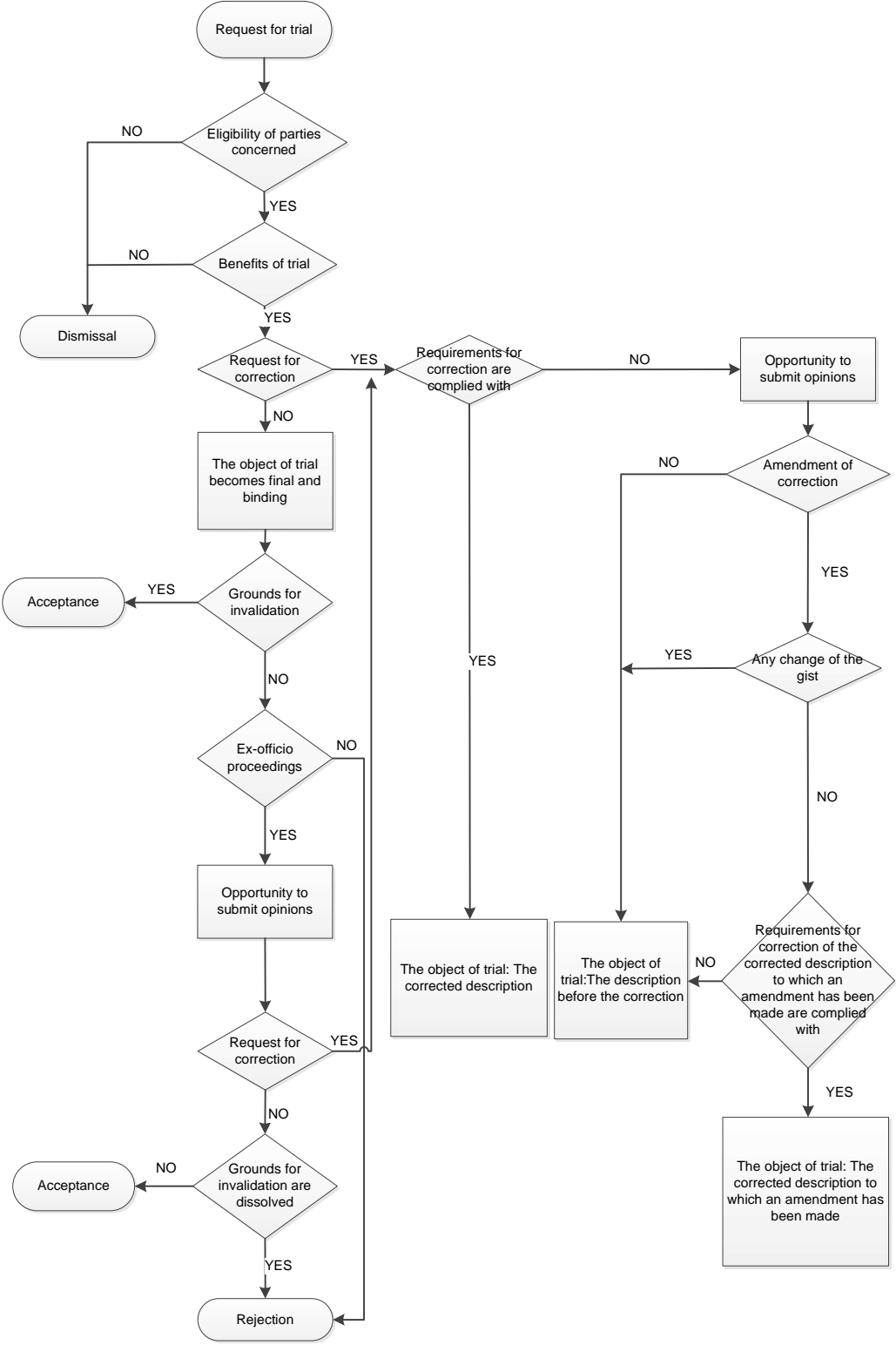
<sup>28</sup> “Trial for Invalidation: Trial and Appeal Guidebook (11<sup>th</sup> edition), Title 16,” the Korean Intellectual Property Office website ([http://www.kipo.go.kr/kpo/user.tdf?a=user.ip\\_info.others.BoardApp&board\\_id=others&cp=9&pg=2&npp=10&catmenu=m04\\_02\\_05&sdate=&edate=&searchKey=&searchVal=&bunryu=&st=&c=1003&seq=14127&gubun=](http://www.kipo.go.kr/kpo/user.tdf?a=user.ip_info.others.BoardApp&board_id=others&cp=9&pg=2&npp=10&catmenu=m04_02_05&sdate=&edate=&searchKey=&searchVal=&bunryu=&st=&c=1003&seq=14127&gubun=))



documentary examination is permitted for trials for patent invalidation (the former clause of Article 154, paragraph (1)); provided, however, that where a party concerned filed a request for oral hearing, the oral hearing shall be conducted except where the IPTAB finds that a decision may be rendered only through documentary proceedings (the latter clause of Article 154, paragraph (1)).

The presiding administrative patent judge shall, where he/she judges that the case is ready for a trial decision, notify the parties concerned and intervenor(s) of the closure of the trial examination (Article 162, paragraph (3)). However, after the closure of the proceedings is notified, the presiding administrative patent judge may resume the proceedings upon a request from any party or intervenor or ex officio (Article 162, paragraph (4)).

Figure 8: Flow of patent invalidation trial



### (3) Requirements for patent invalidation trial

#### (i) Demandant

(a) Patents whose establishment is registered between October 1, 2006 and February 28, 2017

Any person may make a request for a patent invalidation trial from the date on which the establishment of the patent right was registered within 3 months after the publication of the registered patent, except where a ground of invalidation is usurped application or violation of the joint application provision (the proviso to Article 133, paragraph (1)); provided, however, that only interested parties and examiners shall hold the eligibility for demandant when 3 months after the publication of registration lapse (Article 133, paragraph (1)).

On the other hand, where a natural person or juridical person, association or foundation that is not a juridical person but for which a representative or an administrator has been designated, a request for a patent invalidation trial may be filed in the name of the association or foundation (Article 4). Where two or more persons request for a patent invalidation trial with respect to the same patent right, all of them may file a joint request for trial (Article 139).

(b) Patents whose establishment is registered on March 1, 2017 or later or on September 30, 2006 or before

Only interested parties or examiners hold the eligibility for demandant (Article 133, paragraph (1) of the former Patent Act or Article 133, paragraph (1) of the new Patent Act to be enforced on March 1, 2017). A request filed by any person who does not have a special interest is dismissed based on a judgment that it is unlawful. A special interest is determined at the time of rendering a trial decision.

#### (ii) Objects of patent invalidation trial

The objects of request for patent invalidation trial are patents registered by administrative disposition (Article 133). Where there are two or more claims, a patent invalidation trial may be requested for each claim (Article 133, paragraph (1)). Moreover, a patent invalidation trial may be requested even after a patent right has been extinguished (Article 133, paragraph (2)).

#### (iii) Grounds for invalidation

Since the grounds for invalidation are limited to those specified in laws (Article 133, paragraph (1)), a patent invalidation trial may not be requested for any ground other than those grounds.

Table 7: Grounds for invalidation

Items of paragraph (1), Article 133 of the Patent Act	Grounds for invalidation
item (i)	<ul style="list-style-type: none"> <li>- A patent is granted to a foreigner who lacks the capacity to hold right (Article 25)</li> <li>- Any of the requirements for patentability (industrial applicability, novelty, inventive step and the position of enlarged novelty) is violated (Article 29)</li> <li>- A patent is granted to an application for non-patentable invention (Article 32)</li> <li>- The prior application provision is violated (Article 36, paragraphs (1) through (3))</li> <li>- There is a deficiency in the detailed explanation of the description (Article 42, paragraph (3), item (i))</li> <li>- There is a deficiency in the description of the scope of claims (Article 42, paragraph (4))</li> </ul>
item (ii)	A patent is granted to a person who is not entitled to obtain a patent (the text of Article 33, paragraph (1)) or the joint application provision is violated (Article 44)
item (iii)	A patent is granted to a person who is entitled to obtain a patent but cannot obtain a patent (the proviso to Article 33, paragraph (1))
item (iv)	Grounds for invalidation that arise after the grant become applicable
item (v)	A treaty is violated
item (vi)	An amendment is made beyond the scope of amendment (the former clause of Article 47, paragraph (2))
item (vii)	Divisional application that falls under outside the scope provided in Article 52, paragraph (1)
item (viii)	Converted application that falls under outside the scope provided in Article 53, paragraph (1)

As another ground for invalidation of patent rights filed on September 30, 2006 or before, there is the case where a patent is granted to an invention that does not comply with the requirements for patentability of plant patents (Article 31 of the former Patent Act) but the grounds prescribed in Article 133, paragraph (1), items (vii) and (viii) (violation of the provisions for divisional applications and converted applications) are not included.

Where an international patent application filed under the Patent Cooperation Treaty (PCT) includes new matters added to the translation thereof other than i) matters stated in the description, claims or drawing(s) (limited to the descriptive text therein) and a translation of the international patent application filed on the international filing date or ii) matters stated in drawing(s) (excluding the descriptive text therein) of the international patent application submitted on the international filing date, a patent invalidation trial may be requested for the ground for invalidation specific to the international patent application (Article 213); provided, however, that this ground for invalidation specific to international patent applications does not apply to those filed on January 1, 2015 or later, because Article 213 of the Patent Act was deleted due to the revision made on June, 11, 2014.

A judgment on whether there is a ground for invalidation or not in a patent invalidation trial is made at the time when the requirements for registrability of the patent are judged (at the time of the filing thereof). However, in the case of a patent invalidation trial filed based on any ground for invalidation that arose after the patent was granted and registered (Article 133, paragraph (1), item (iv)), a judgment is made at the time when the said ground arose.

(iv) Period for filing a request for patent invalidation trial

After the establishment of a patent right has been registered, a patent invalidation trial may be requested even after the extinguishment thereof (Article 133, paragraph (2)); provided, however, that this is not applicable when the patent has been invalidated by a trial decision. Even in this case, a prior patent invalidation trial may be requested only when the patent right has been invalidated for any ground that arose after its grant (Article 133, paragraph (1), item (iv)) as an exception.

For example, a patent right extinguishes where its duration expires (Article 88), there is no heir (Article 124), it is abandoned (Article 120), patent fees are not paid (Article 81, paragraph (3)), or it is invalidated (Article 133, paragraph (3)).

(v) Procedures for patent invalidation trial

The demandant shall submit a written request stating the requirements of the formality specified in Article 140, paragraph (1) of the Patent Act, that is, “the name and the address of the party (Article 140, paragraph (1), item (i)),” “where any representative has been appointed, his/her name and address or business office (Article 140, paragraph (1), item (ii)),” “the identification of the trial case (Article 140, paragraph (1), item (iii)),” and “the purport of the request and the grounds therefor (Article 140, paragraph (1), item (iv)).” “The purport of the request” explains what kind of trial decision the demandant expects and identifies a patent for which request is sought. Typically, it indicates to the effect that “I request a trial decision to the effect that the registration of paragraph \_\_\_\_ and paragraph \_\_\_\_ of the scope of claim of Patent Registration No.\_\_\_\_ is to be invalidated. The cost in connection with the trial shall be borne by the demandee.”

“The grounds for the request” shall state facts of and causes for invalidity provided in laws in accordance with the purport of the request. Typically, the outline of the case, explanations of the history, statement of an interest, articles and paragraphs which contain the grounds for invalidation are principally stated therein. With regard to an amendment to the grounds for the request, it is allowed to change the gist thereof, different from an amendment to the purport of the request (Article 140, paragraph (2), item (ii)).

Where a written request for a patent invalidation trial violates the provisions of Article 140, paragraph (1), an order to make an amendment is issued (Article 141, paragraph (1)). Where the party does not respond to this order, a decision dismissing the request for a patent invalidation trial is rendered (Article 141, paragraph (2)). The decision of dismissal shall be notified in writing with the grounds therefor (Article 141, paragraph (3)).

Although no violation of formality of written request is found (Article 140, paragraph (1)) as a result of a formality check, a request for patent invalidation trial may be dismissed as a trial decision where an amendment may not be made, because the request is unlawful (Article 142).

(Example) A paragraph of the scope of claim for which invalidation was requested in a patent invalidation trial was deleted by correction.

Even if the number of claims changes due to a request for correction or another reason and the demandant of the patent invalidation trial changes the purport of the request (that is, the claims for which invalidation is sought change), it is not regarded as any change of the gist of the written request; provided, however, that, in this case, the demandant of the patent invalidation trial shall make an amendment to the purport of the request.

#### **(4) Effect of trial decision**

Where a trial decision of invalidation of the patent becomes final and binding, the patent right shall be deemed never to have existed (Article 133, paragraph (3)). Where a trial decision of invalidation of the patent becomes final and binding for any ground for invalidation that arise after the granting thereof (Article 133, paragraph (1), item (iv)), the patent right shall be deemed to have not existed when and after the time when the said item became applicable (the proviso to Article 133, paragraph (3)).

Where a trial decision of partial invalidation of the patent becomes final and binding, only the part of patent relating to the applicable invention shall be invalidated (Article 133, paragraph (1)).

Where a trial decision becomes final and binding in a patent invalidation trial, no person may request a trial for invalidation of the patent based on the same facts and the same evidence (Article 163).

Where a trial decision to the effect that a correction is permitted in response to a request for correction becomes final and binding in a patent invalidation trial, the establishment of the patent application, publication of unexamined application, decision to grant a patent or a trial decision or patent right shall be deemed to have been registered by the corrected description or drawing(s) (Article 136, paragraph (8)<sup>29</sup> as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)). Moreover, a trial decision or a judgment rendered with respect to the description or drawing(s) before the correction shall be subject to retrial.

### **3.3. Request for correction**

#### **(1) Subjects and timing of the request**

In a patent invalidation trial, the patentee who is a demandee may request a correction of the description or drawing(s) of the patented invention during the procedures therefor (Article 133-2, paragraph (1)); provided, however, that, where there

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<sup>29</sup> Article 136, paragraph (10) in the New Patent Act to be enforced in March 2017.

is an exclusive licensee, non-exclusive licensee or pledgee of the patent, a correction may be requested with the consent thereof (Article 136, paragraph (7)<sup>30</sup> as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)).

A request for correction may be filed in any of the following periods (Article 133-2, paragraph (1)).

- (i) Period for submission of a written reply by transmitting a duplicate of the written request for patent invalidation trial (Article 147, paragraph (1));
- (ii) Period for submission of a written opinion in response to a notice of grounds for patent invalidation issued ex-officio (the latter clause of Article 159, paragraph (1));
- (iii) Period specified where the presiding administrative patent judge finds that it is necessary to permit a request for correction by allowing the demandant to submit written evidences<sup>31</sup> even after a period designated based on the provision of Article 147, paragraph (1) (the latter clause of Article 133-2, paragraph (1)). In this case, the said evidences shall include allegations corroborated objectively and logically with respect to the grounds for invalidation such as an allegation of deficiency in the description.

## **(2) Subject of request for correction**

The subject of request for correction is the description or drawing(s) attached to the application (Article 133-2, paragraph (1)).

## **(3) Purposes of correction**

The purposes of correction are limited to the following ones (Article 133-2, paragraph (1)):

- (i) To reduce the scope of claims (Article 136, paragraph (1), item (i));
- (ii) To correct clerical errors (Article 136, paragraph (1), item (ii)); and
- (iii) To clarify any ambiguous descriptions (Article 136, paragraph (1), item (iii)).

## **(4) Requirements of correction**

The requirements of correction are as follows:

- (i) The purpose of correction falls under any of the items of paragraph (1) of Article 136;

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<sup>30</sup> Article 136, paragraph (8) in the New Patent Act to be enforced in March 2017.

<sup>31</sup> In the New Patent Act to be enforced in March 2017, this sentence was revised as follows: “where it is found to be necessary to permit a request for correction, because the demandant submitted evidences or made an allegation of new causes of invalidation.”



- (ii) The correction does not aim to add new matters (Article 136, paragraph (2)<sup>32</sup> as applied mutatis mutandis pursuant to Article 133-2, paragraph (4));
- (iii) The correction does not substantially enlarge or alter the scope of claims (Article 136, paragraph (3)<sup>33</sup> as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)); and
- (iv) The invention stated in the corrected scope of claims complies with the independent requirements for patentability (Article 136, paragraph (4)<sup>34</sup> as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)); provided, however, that a claim or claims for which the patent invalidation trial has been requested are excluded (Article 133-2, paragraph (5)<sup>35</sup>).

#### **(5) Procedures for request for correction**

A correction is requested by submitting a written request therefor (Article 133-2, paragraph (1)). Firstly, a formality check is conducted. A person who files a request for correction shall submit a written request therefor prepared based on a format described in the Attachment No.32 of the Enforcement Rule of the Patent Act (Article 57-2). The corrected description or drawing(s) shall be attached to a written request for correction (Article 140, paragraph (5) as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)). On the other hand, where a correction is made to the description or drawing(s), the full text thereof shall be attached (See Guideline for Description of Format 6 in the Attachment No.32 of the Enforcement Rule of the Patent Act).

Once the presiding administrative patent judge accepts a written request for correction, a formality check is conducted. Where the request for correction violates formality, etc., the presiding administrative patent judge shall issue an order to make amendments to amendable parts (Article 141, paragraph (1)). Where necessary amendments are not made or the said violation may not be amended, the trial is not conducted for the said request for correction and the presiding administrative patent judge mentions to the effect that the written request for correction is not adopted in the grounds for a trial decision.

After the formality check is conducted, whether or not the request complies with requirements for correction is examined. Where a request for correction violates any of

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<sup>32</sup> Article 136, paragraph (3) in the New Patent Act to be enforced in March 2017.

<sup>33</sup> Article 136, paragraph (4) in the New Patent Act to be enforced in March 2017.

<sup>34</sup> Article 136, paragraph (5) in the New Patent Act to be enforced in March 2017.

<sup>35</sup> Article 133-2, paragraph (6) in the New Patent Act to be enforced in March 2017.

the items of paragraph (1) of Article 136 or paragraphs (2) through (4) of the said Article, a notice of reasons for refusal of correction is sent to the demandee (patentee) of the trial for patent invalidation to give him/her an opportunity to submit a written opinion (Article 136, paragraph (5)<sup>36</sup> as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)). At this point, the demandee of the patent invalidation trial may make an amendment to the corrected description or drawing(s) attached to the written request for correction in the request for correction. Where the request for correction is lawful, whether or not there are grounds for invalidation are examined based on the corrected description or drawing(s) attached to the said written request for correction.

Unless there is a clear reason that the request for correction filed by the demandee does not comply with the requirements for correction, a duplicate of the said written request for correction is transmitted to the demandant of the patent invalidation trial to give him/her an opportunity to submit opinions. Where the demandant of the patent invalidation trial makes an allegation that the request for correction is unlawful by means of a written opinion and this allegation is adopted, a notice of reasons for refusal of correction (Article 136, paragraph (5) as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)) is sent to the patentee to give him/her an opportunity to make an amendment to the corrected request. Where the allegation of the said demandant is rejected and the correction is permitted, the matter is stated in the section of grounds in the text of the trial decision.

A written request for correction may be amended to the extent that the gist thereof is not changed. Such amendment may be made during the period for submission of written opinion based on the notice of reasons for refusal of correction (Article 136, paragraph (5) as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)).

Where several requests for correction are made while the same patent invalidation trial is pending, requests for correction made before the last request for correction shall be deemed to be withdrawn (Article 133-2, paragraph (2)).

#### **(6) Effect of correction**

Where a trial decision on the patent invalidation trial to the effect that a correction is permitted as requested becomes final and binding, the establishment of the patent application, publication of unexamined application, decision to grant a patent or trial

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<sup>36</sup> Article 136, paragraph (6) in the New Patent Act to be enforced in March 2017.

decision or patent right shall be deemed to be registered by the corrected description or drawing(s) (Article 136, paragraph (8) as applied mutatis mutandis pursuant to Article 133-2, paragraph (4)). Moreover, ne bis in idem (Article 163) shall apply to a decision to approve or disapprove the said correction.

### 3.4 Oral hearing

A trial is conducted by means of oral hearing or documentary examinations (Article 154). Trial examinations are conducted, in principle, by documentary examinations, because they require procedural simplicity and rapidness as a part of administration and trials are held only at the IPTAB. However, oral hearing is conducted where it is difficult to grasp the allegations of both parties concerned only by means of documentary examinations or a party concerned so requests.

Typically, oral hearing is conducted when the presiding administrative patent judge finds it to be necessary among cases for which the parties concerned made an application therefor. Oral hearing is typically held in inter-partes trial, because they are effective for sorting out issues in dispute through oral offense and defense between the parties concerned. Article 39-2 of the Trial Affairs Handling Regulations provides that oral hearing shall be held, in principle, in (i) a case for which one party concerned or both parties concerned made an application therefor, (ii) a case where both parties concerned do not have representatives, or (iii) a case for which oral hearing is deemed necessary to exercise the elucidation right among cases; provided, however, that, even in any of the aforementioned cases, oral hearing may not be held where the presiding administrative patent judge determines that a decision may be rendered only thorough documentary examinations.

A judgment of a civil suit shall inevitably go through arguments based on the principle of argument (Article 134 of the Code of Civil Procedure). Only oral arguments conducted before judges under the prescribed procedures based on the provisions of laws are used as a basis for rendering a judgment (Article 204 of the Code of Civil Procedure), but not only allegations made in oral hearing but also all allegations submitted in writing are admitted as effective statements in the proceedings before the IPTAB. Therefore, oral hearing of the IPTAB is effective for investigating evidences, questioning and sorting out issues in dispute, and rapidly understanding complicated arts rather than finding arguments.

## **(1) Overall flow**

A party concerned of the trial who intends to apply for oral hearing shall submit to the President of the IPTAB or the presiding administrative patent judge a written request for the trial case (Format 1-1 in the Attachments of the Manual for Oral Hearing) (Article 65, paragraph (1) of the Enforcement Rule of the Patent Act).

The presiding administrative patent judge determines, in response to a request from a party concerned or ex officio, whether or not oral hearing is held. Where a party concerned files an application for oral hearing, the presiding administrative patent judge may decide not to hold oral hearing if he/she finds that a decision may be rendered only through documentary examinations. In this case, the presiding administrative patent judge shall notify the party concerned who filed the application for oral hearing of the effect that a decision is to be rendered only through documentary examinations within fifteen days from the date of receipt of the said written application for the trial case or the date of expiration of the period for submission of written reply, whichever comes later.

Where oral hearing is held, the presiding administrative patent judge shall set the date and place thereof and transmit a written notice designating the date of oral hearing stating such information to the parties concerned and intervenors (Article 154, paragraph (4)). A written notice designating the date of oral hearing is dispatched 3 or 4 weeks before the date of oral hearing except special cases. The presiding administrative patent judge shall make an arrangement so that the parties concerned submit a written summary of statements for oral hearing which sorts out contents to be discussed therein by one week before the date of oral hearing.

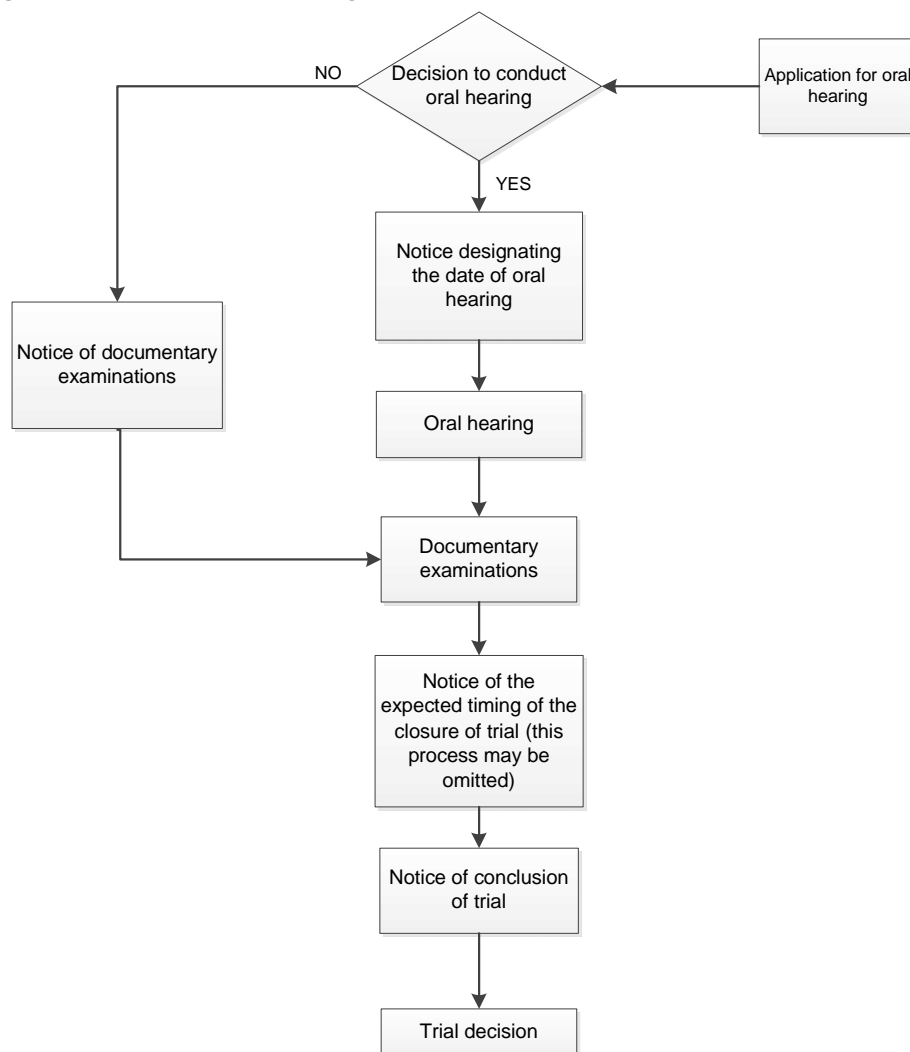
Where it is expected that there is any matter that becomes an issue in dispute in oral hearing, the presiding administrative patent judge may issue the parties concerned of questions about issues in dispute for oral hearing (Format 1-4 in the Attachments of the Manual for Oral Hearing) (Article 40, paragraph (2) of the Trial Affairs Handling Regulations).

In oral hearing, the parties concerned make statements, the presiding administrative patent judge makes questions and witnesses are examined. Then, the date of submission of documents and the timing of the conclusion of trial are notified in advance.

Once the date of oral hearing is concluded, the trial clerical official who intervened therein shall prepare a trial record of oral hearing stating the gist thereof and other

necessary matters (Format 1-9 in the Attachments of the Manual for Oral Hearing) (Article 154, paragraph (5)).

Figure 9: Flow of oral hearing<sup>37</sup>



<sup>37</sup> Manual for Oral Hearing (2015), the Korean Intellectual Property Office website ([http://www.kipo.go.kr/kpo/user.tdf?a=user.ip\\_info.others.BoardApp&board\\_id=others&cp=2&pg=1&npp=10&catmenu=m04\\_02\\_05&sdate=&edate=&searchKey=&searchVal=&bunryu=&st=&c=1003&seq=15771&gubun=](http://www.kipo.go.kr/kpo/user.tdf?a=user.ip_info.others.BoardApp&board_id=others&cp=2&pg=1&npp=10&catmenu=m04_02_05&sdate=&edate=&searchKey=&searchVal=&bunryu=&st=&c=1003&seq=15771&gubun=))

## **(2) Contents of oral hearing**

The principal contents of oral hearing are the statements by the demandant on the purport of the request and the grounds therefor, the statements by the demandee on the purport of the answer and the grounds therefor, offense and defense of both parties concerned, questions by the Trial and Appeal Board and examinations of witnesses.

## **(3) Record**

A trial record of oral hearing is prepared for the purpose of clarifying the process and contents of the examination on the date of oral hearing and making sure to leave attested documents thereon. This record clearly ensures stability and clarity of the progress of the trial and appeal examinations and contributes to a judgment on whether or not the trial decision is accepted in a higher court. Unless a trial record is invalid, whether or not the formality provisions for oral hearing were respected is proved only by the statement of the record (Article 158 of the Code of Civil Procedure). If any fact is stated in the record, it is found that there exists such fact and, if not, the fact is not deemed to exist.

## **3.5 Flow from a patent invalidation trial to a suit**

### **(1) Significance**

Where a party concerned is not satisfied with the trial decision rendered by the IPTAB, the party may institute a suit against the trial decision against the Patent Court of Korea (Article 186, paragraph (1)).

### **(2) Parties concerned**

The plaintiffs are a person who received the trial decision and his/her successor, intervenors or persons whose intervention was rejected (Article 186, paragraph (2)).

The defendant is the demandant or the demandee (Article 187).

### **(3) Period for instituting an action**

An action shall be instituted within thirty days from the date on which a certified copy of the trial decision was transmitted. This period is unchangeable (Article 186, paragraphs (3) and (4)).

Article 161 of the Civil Code shall apply to the calculation of the period for instituting an actions against a trial decision and the period for instituting an appeal. It provides that “where the last day of the period falls under Saturday or a public holiday, the period expires on the following day” (Supreme Court Declaration on February 13, 2014, see the

judgment No.1573 of 2013). In particular, it should be noted that a Labor day does not fall under “Saturday or a public holiday” according to Article 161 of the Civil Code and the period for instituting an action may expire on a labor day.

Where documents are submitted by mail to the IPTAB in relation to the timing of entry into force of the submission of documents, such documents shall be deemed to have arrived on the date indicated in their postmarks (Article 28, paragraph (2)); provided, however, that caution for arrival shall apply without exception to documents submitted to the Patent Court of Korea.

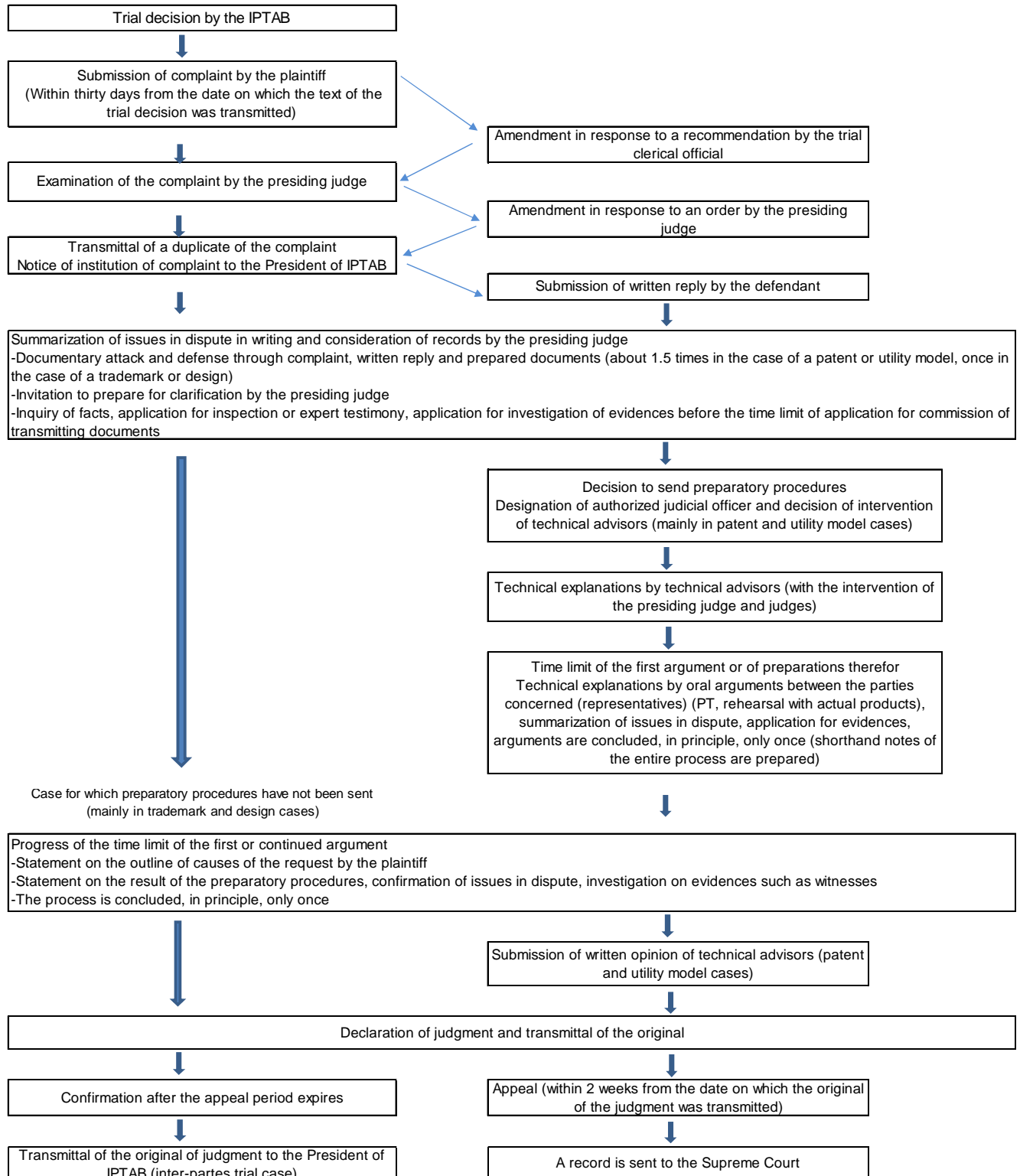
#### **(4) Judgment**

Where a request for patent invalidation trial is found to have grounds as a result of examination, the Patent Court of Korea shall revoke the trial decision as its judgment (Article 189, paragraph (1)).

Moreover, where a request for patent invalidation trial is found to have no grounds, the Patent Court of Korea shall reject the request. Where a judgment of revocation of the trial decision becomes final and binding, the administrative patent judge shall conduct a trial again to render a trial decision or a ruling (Article 189, paragraph (2)).

A ground on which the revocation is based in the judgment shall bind the IPTAB in the relevant case (Article 189, paragraph (3)).

Figure 10: Flow of lawsuit<sup>38</sup>



<sup>38</sup> Source: [http://help.scourt.go.kr/nm/min\\_5/min\\_5\\_2/index.html](http://help.scourt.go.kr/nm/min_5/min_5_2/index.html)