

51-10 PUDT

Initiation of Proceedings of a Trial for Invalidation

1. Procedures at the Initiation of Proceedings of a Trial for Invalidation

(1) Service of a duplicate of a written request

When a trial for invalidation is requested, upon examining whether the request for a trial meets the formal requirements (any deficiency in a request for a trial for invalidation and amendments thereof (→ 51-08), a chief administrative judge shall serve a duplicate of the written request on a demandee and give the demandee an opportunity to submit a written answer within an adequate, specified period of time (→ 25-01.2) (Invitation to submit a written answer) (the Patent Act Article 134(1); the Utility Model Act Article 39; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(2) Notice to an exclusive licensee, etc.

When a trial for invalidation is requested, a notice to that effect is notified to an exclusive licensee under the concerned patent right and any other persons with registered rights under that patent (the Patent Act Article 123(4); the Utility Model Act Article 37(4); the Design Act Article 48(4); the Trademark Act Article 46(4), 68(4) →11-02).

(3) Dispatch of the submitted documents

Duplicates of the submitted documents are served to the counterparty.

(4) When a demandant requests an examination of evidence

When a demandant requests an examination of evidence, such as interrogation of a witness from the outset of the request for a trial, and when it is deemed appropriate to provide the demandee an opportunity to answer or request correction after having a demandant submit evidence that may substantiate the demandant's assertion in the examination of evidence, first serving a duplicate of the request for a trial and then conducting the examination of evidence, thereafter providing an opportunity to answer

or request correction is permissible.

In this case, a notice with which a duplicate of the request for trial is served shall include a notice to the effect that a period of time for answering or requesting correction will be specified after conducting an examination of evidence. Notably, before the said period of time is specified, while the demandee may not be precluded from filing a written answer, the demandee may not request for correction either.

(For reference) When a request for intervene has been made (→57-00 - 09)

2. Written Answer and a Request for Correction

(1) Opportunity to answer

A demandee (right holder) may refute the reasons for invalidation asserted by a demandant by filing a written answer during opportunities to answer, provided as follows:

A. Statutory opportunity to answer

Upon receiving the service of a duplicate of a written request, a demandee may file a written answer within a specified period of time (→ 25-01.2) (the Patent Act Article 134(1); the Utility Model Act Article 39(1); the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Likewise, when a chief administrative judge permits an amendment to change the gist of reasons for request stated in a written request for a trial for invalidation (including an amendment changing the gist of reasons for the request in a written argument or a brief of an oral proceedings statement), in principle, an opportunity is given to file a written answer within a specified period of time (the Patent Act Article 134(2); the Utility Model Act Article 39(2); the Design Act Article 52).

In a trial for patent invalidation, a request may be made to make corrections in a specification, claims, or drawings attached to an application within these specified periods of time (Patent Act Article 134-2(1)) (→ 51-11).

B. Opportunity to answer as provided for in enforcement regulations

In addition to giving said statutory opportunities to answer, when deemed necessary,

a chief administrative judge may request that a demandee file a written answer within an adequate, specified period of time (Enforcement Regulations of the Patent Act Article 47-2(1); Enforcement Regulations of the Utility Model Act Article 23(10); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)).

While a demandee may file a written answer to a chief administrative judge within the specified period of time, the demandee may not request for correction even within the said period of time.

(2) Form of the written answer

A written answer must be prepared in Form 63 pursuant to Enforcement Regulations of the Patent Act (Enforcement Regulations of the Patent Act 47(1); Enforcement Regulations of the Utility Model Act Article 23(13); Enforcement Regulations of the Design Act Article 19(8); Enforcement Regulations of the Trademark Act Article 22(6)).

(Revised June 2019)