

51-16 P U D

Change of the Gist of “Reason for Request”

1. Basic Concepts

The purport of restriction of amendment of a reason for request stated in the request for a trial for invalidation (the Patent Act Article 131- 2; the Utility Model Act Article 38-2; the Design Act Article 52) is to prevent a delay in the proceedings caused by re-proceedings due to the amendment of the reason for request.

Therefore, the scope of proceedings required to determine existence or non-existence of the “facts on which the invalidation of the right is based” described in the original written request for a trial is substantially changed because of the amendment of the reason for request. Thereby, existence of change in the gist of reasons for request can be determined by whether such change will require substantial re-proceedings of the trial or rebuttal by the right holder.

2. Procedure of Judgment

Determination of changing the gist depends on the viewpoint of substantially changing the “facts on which the invalidation of the right is based” (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52) specifically identified in the reason for request in the original request for a trial.

When adding or changing an evidence, change of the gist shall be determined from the viewpoint whether an assertion is made where the “facts on which the invalidation of the right is based” specifically identified as the reason in the original written request can be substantially changed along with the addition or change of the evidence..

3. Examples That Change the Gist of Reasons for Request

(1) Addition or replacement of a new reason for invalidation based on the different

laws and regulations

Any other additional reasons for invalidation based on the laws and regulations that differ from those for the specific reason for invalidation described in the original request for trial, or replacement of the original reason with that based on the different laws and regulations, constitutes an amendment that changes the gist of the reason for the request. Even if an amendment which does not specify the laws and regulations relied on the reason, such amendment is deemed to change the gist if it actually adds or changes the “facts on which the invalidation of the right is based.”

(Examples of changing the gist)

(Example 1) A case that initially claimed the reason for invalidation on the basis of a violation of inventive step (the Patent Act Article 29(2)) and described the facts accordingly, but later claimed the reason for invalidation on the basis of a violation of the requirements of the descriptions (the Patent Act Article 36(4)(i)) and added a statement of facts as the basis for the violation of the stated requirements.

(Example 2) A case that initially claimed the reason for invalidation on the basis of a violation of novelty (the Patent Act Article 29(1)) and described the facts accordingly, but later changed the claim to a reason for invalidation based on inventive step (the Patent Act Article 29(2)) and added a description of the factual relationship that violates the said inventive step.

(2) Replacement or addition of principal facts

Amendments to replace, add or change the “facts on which the invalidation of the right is based” as described in the original written request, generally constitute changing the gist (including an amendment that substantially changes the “facts on which the invalidation of the right is based” by clarifying the statement of the unclear reasons for the request. Meanwhile, if the amendment is minor in the reason for the request and thus does not substantially change the “facts on which the invalidation of the right is based”, this amendment may not be deemed changing the gist.)

(Examples of changing the gist)

(Example 1) Initially, a request was asserted on the fact that the description of the

specific part A in the specification did not satisfy the requirements of the description (the Patent Act Article 36(4)) as the basis for the reason for invalidation of the specification, but the assertion has been changed to the fact that the description in the other specific part B does not satisfy the said description requirements.

(Example 2) Initially, a request was asserted on the fact that the description of the specified part C in the patent specification was a new matter as the basis for the reason for invalidation against the requirement for prohibition of adding a new matter (the Patent Act Article 17-2(3)), but the assertion has been changed to the fact that the description in the different specific part D is a new matter.

(3) Replacement or addition of direct evidence

As a result of replacement or addition of “direct evidence” to prove the “facts on which the proposed invalidation of the right is based” described in the reason for the original request, if the “facts on which the invalidation of the right is based” described in the reason for the original request are changed to different “facts on which the invalidation of the right is based” which are based on said replaced or additional evidence, this case is deemed changing the gist because this case is the same as the above (2).

Additionally, even if only a direct evidence is replaced or added without substantially changing the description of the “facts on which the invalidation of the right is based” described in the original reason for request formally, when claiming a request for new “facts on which the invalidation of the right is based” based on said replaced or added evidence, this case is deemed changing the gist because the case is the same as the above (2).

Moreover, even if an evidence added to, is simply referred to as a “reference material”, and a new “facts on which the invalidation of the right is based” is asserted by using the reference material as an evidence, this case is deemed changing the gist.

(Examples of changing the gist)

(Example 1) Initially, it was claimed that the prior art inventions E and F could be easily invented as evidence of reasons for invalidation based on inventive step (the

Patent Act Article 29(2)) violation, and the evidence concerning the prior art invention G was added later, claiming easily conceivable of the invention. (Example 2) Initially, the secret prior art (the Patent Act Article 29-2) is used as a basis for reasons for invalidation, and the prior application H as proof, it was insisted that the invention was identical to that disclosed in the prior application, but later, the evidence was replaced with another prior application J and the secret prior art was claimed as the reason for invalidation.

4. Examples That Do Not Change the Gist of Reasons for Request

(1) Additional claim and proof of well-known facts

Similar to “well-known facts” that anybody should know, the “well-known art,” “commonly used art,” and “common general technical knowledge” should be known by people skilled in the art and thus do not have to be shown the existence of those known arts one by one. Therefore, additionally claiming the facts that there exists the well-known art, commonly used art, common general technical knowledge, etc. and providing an evidence to prove those facts (for example, the prior art documents, etc. for showing the art is well-known or commonly used) usually do not constitute changing the gist of the reason for request.

However, in a case where the scope of proceedings required to determine the existence or nonexistence of the principal facts is substantially changed as a result of providing an additional claim and proof of the well-known facts, if significant re-proceedings or substantial arguments by the right holder are required, the case is handled as it complies with the changing of the gist of the reason for request. Additionally, if the well-known art, commonly used art, etc., which is claimed by the demandant is not truly well-known facts, but it stays an addition of direct evidence, such assertion and proof also changes the gist.

(2) Addition of indirect facts, supporting facts, and indirect evidence

Adding the “facts that indirectly infer principal facts (indirect facts),” adding the “facts to clarify the proof ability of the evidence that proves the principal facts

(supporting facts),” and adding the “evidence for establishing indirect facts or supporting facts (indirect evidence)” are not deemed addition of principal facts or direct evidence. Therefore, these are not regarded amendments that substantially change “the facts on which the invalidation of the right is based (principal facts)” (See Examples 1–3 below).

(Example 1) In the “facts on which the invalidation of the right is based (principal fact)” of the reason for the original request, it is claimed that the invention is made based on the prior art invention with the catalog as evidence; the right holder responds to the dispute over the date listed in the catalog; while the demandant claims that the issuing date of the catalog is prior to filing the application based on the date of the order form of the printing house as an evidence where the request for printing the catalog was received; it may constitute the submission of an indirect fact and an indirect evidence.

(Example 2) Regarding the prior art documents (direct evidence) that prove the “facts on which the invalidation of the right is based (principal facts)” of the reason for the original request, submitting additional materials to properly understand the technical details described in the documents may constitute the submission of supporting facts and an indirect evidence.

(Example 3) Regarding a witness who proves the fact of “publicly worked” claimed as the “facts on which the invalidation of the right is based (principal fact)” in the reasons of the original request, presenting facts indicating the character of the witness (reliability) and an interest with a demandee (no interest with a demandee) etc., may constitute the submission of supporting facts and an indirect evidence.

However, amendments that actually change principal facts substantially in the name of addition of indirect facts, supporting facts, and an indirect evidence constitute changing the gist of reasons for request. Likewise, if the principal facts are missing in the reasons of the original request (normally a violation of the requirements of the description), claiming that the missing principal facts can be inferred by subsequently adding indirect facts or an indirect evidence also changes the gist of the reasons for

request.

(3) Presentation of evidence in examination of evidence after a request for a trial

In the case that the “facts on which the invalidation of the right is based” are sufficiently specified in the reason of the original request, presenting an evidence to prove the principal facts in the later examination of evidence, refutation, etc. is an action of establishing an evidence, but does not change or add to the “facts on which the invalidation of the right is based”. , described in the reason for the original request. Therefore, this does not constitute changing the gist.

For example, in cases on the reason for the original request, the fact is specifically described to the effect that the patented invention violates novelty based on the invention publicly implemented prior to the filing of the application of the patented invention (for instance, the fact that the product of the invention has been sold), and it is also stated that such fact is to be proven by an interrogation of a witness later, when an interrogation of a witness, etc. is field at a later date, this does not constitute changing the gist of reasons for request even if the evidence is presented, because the principal facts themselves have not been changed and the evidence to prove the principal facts in the later examination of evidence is simply presented.

However, when presentation of an evidence is, in practical, equivalent to claiming a new “facts on which the invalidation of the right is based”, for instance, “facts on which the invalidation of the right is based” is not specifically identified at the beginning and presenting an evidence later, it is deemed the change of the gist of the reason for request.

If “facts on which the invalidation of the right is based” is not specifically identified at the initial reasons for request, it could be violation of the description requirements of the reason for request (→51-08).

(4) Claiming and proving on violation of the requirements for correction (patent)

When claiming and proving that the request for correction should not be admitted because it violates the requirements, and consequently the original patent before correction should be invalidated based on the “facts on which the invalidation of the

patent is based” as described in the original request for a trial, the “facts on which the invalidation of the patent is based” which is described as the reason for the original request have not been changed at all. Therefore, the case does not constitute changing the gist of the reason of request.

Meanwhile, instead of claiming and proving against the violation of the requirement of correction, claiming and proving are made to the effect that the patent corrected by the correction request will have a new reason for invalidation, because the correction is to additionally claim and prove the “facts on which the invalidation of the patent is based” which are not described at the beginning, it constitutes changing the gist. (However, because this case falls under the Patent Act Article 131-2(2)(i), it may be subject to permission for amendment by the chief administrative judge’s n.)

(5) Claiming and proving by objection only against the opposite facts that the right holder asserts and proves

Against the fact that the demandant claimed and proved in the reason for request, while the right holder asserts or disproves the opposite fact for the purpose of denial of said fact in the written answer, etc., the demandant sometimes claims and proves to deny the existence of the opposite fact. In this case, if the demandant’s argument is exclusively made to deny the existence of the opposite fact claimed by the right holder, but it does not change the “facts on which the invalidation of the patent is based” described as the reason for the original request, the gist of the reason for request is not deemed to have changed.

Meanwhile, in the name of opposing against the opposite fact claimed and proved by the right holder, when the demandant claims and proves the fact of a reason for invalidation which is substantially different from the “facts on which the invalidation of the patent is based” as described in the reason for the original request, the gist of the reason for the request is deemed to have changed.

(Example 1) In case the patentee claims and proves the fact (or the opposite fact) that it is possible to work a patented invention under the experimental data as evidence against the reason for request based on violation of enablement requirements when the

demandant submits the opposite experimental data indicating that the patentee's experimental data is inaccurate or incorrect in order to deny the existence of the opposite fact, it is an exclusive objection denying the existence of the opposite fact that the patentee claims and proves, yet does not change the "facts on which the invalidation of the patent is based" described as the reason for the original request.; Thus, such a case is deemed that the gist of the reason for request has been changed. Meanwhile, when submitting the experimental data that is not related to the patentee's experimental data and claiming specific facts of violation of different enablement requirements that differ from the original, because the "facts on which the invalidation of the patent is based" described as reasons for the original request implies claiming facts of reasons for invalidity, which are substantially different, the gist of the reason for the request is deemed to have changed.

(Example 2) In case the patentee claims a fact (or the opposite fact) of existence of an obstructive factor of combination of the prior arts (for example, that the primary cited invention does not function if the secondary cited invention is applied to the primary cited invention) against the reason for request based on violation of inventive step where the invention could be easily invented on the basis of a combination of a plurality of prior art documents, if the demandant asserts to deny the existence of said opposite fact (for example, claiming to the effect that it does not happen the primary cited invention does not function if the secondary cited invention is applied to the primary cited invention),, it is an exclusive objection denying the existence of the opposite fact that the patentee claims and proves, yet does not change the "facts on which the invalidation of the patent is based " described as the reason for the original request. Thus, such a case is deemed the gist of the reason for the request does not change. Meanwhile, when claiming a fact (a fact based on another prior art document) other than the fact of the original inventive step violation regardless of the patentee's claim of the obstructive factor, because the "facts on which the invalidation of the patent is based" described as the reason for the original request implies claiming substantially different facts of reasons for invalidity, the gist of the reason for the

request is deemed to have changed.

(6) A denial of the patentee's defense that does not change the reason for request

In the original request for trial, in contrast to requesting the reason for request based on violation of novelty by using the prior art document as evidence, the patentee made a defense to the effect that the prior art document did not lose novelty under the provision of exception of loss of novelty because it corresponds to "disclosure against the will of a person who has a right to obtain a patent" (the Patent Act Article 30(1)). When the demandant presents facts, evidence, etc. showing that the disclosure is not against the will as a denial of the patentee's defense, because "facts on which the invalidation of the patent is based" described in the reason for the original request have not been changed at all, the gist of the reason for request is not deemed to have changed.

(7) Correction of the applicable provision of law

Maintaining the request concerning the "facts on which the invalidation of the patent is based" as stated in the original request for trial, because amendments or refutation that simply corrects errors of the applicable provision (including errors in the choice of the revised law) do not substantially change the "facts on which the invalidation of the right is based" described in the reason for request, the gist is not deemed to have changed.

However, in the name of correcting an error of the applicable law, adding a new reason for invalidation ("facts on which the invalidation of the right is based") corresponds to changing the gist of the reason for request.

Even if the demandant did not amend or rebut that corrects an error of the provision of the applicable law, because application of the law is a matter of the administrative judge's exclusive authority, the administrative judge, while finding facts claimed by the demandant, may make a trial decision for invalidation applied the article that is bases for the decision and different from the claim.

For instance, from the beginning, in a case where the principal facts that underlie reasons for invalidation based on the violation of novelty (the Patent Act Article 29(1))

are described as the “facts on which the invalidation of the patent is based”, when it is considered substantially equivalent to describing the principal facts underlying reasons for invalidation based on the violation of an inventive step (the Patent Act Article 29(2)), the panel may find the fact and apply the provisions of reasons of invalidation over the inventive step violation (the Patent Act Article 29(2)) to make the trial decision considering the descriptions and evidence of the principal facts comprehensively,

However, if argument from the patentee is necessary, providing an opportunity to answer before the trial decision is appropriate except when a substantial opportunity for argument has already been provided.

(Revised June 2019)