

51-23 U**Trial for Invalidation of Utility Model Registration****1. Applicable Subject**

This applies to the trial for invalidation filed against those registered as utility models on or after January 1, 1994 (Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Articles 4(1), 5).

2. Feature of Trial for Invalidation of Utility Model Registration

The procedure for the trial for invalidation of a utility model registration differs from the trial for patent invalidation in the following respects.

(1) The utility model registration can be corrected and finalized without submission of a correction document and without conducting proceedings on the proposal. (→ 51-23.2)

(2) Anyone may claim the trial for invalidation of a utility model registration.

(3) There is no request for correction in the trial for invalidation of a utility model registration.

(4) There is no advance notice of trial decision in the trial for invalidation of a utility model registration.

(Reference) Proceedings of the trial for invalidation of a utility model registration based on the patent applications for the same invention (→51-23.3)

3. Handling of a Utility Model Registration Filed on or after April 1, 2005

For utility model registrations filed on or after April 1, 2005, the 2004 Act on Partial Revision of the Patent Act, etc. (2004 Act No. 79) is applied (Supplementary Provisions of 2004 Act on Partial Revision of the Patent Act, etc. Article 3, 2004), and it is treated as follows.

(1) Addition of reasons for invalidation due to enlarged allowance of correction

A. In addition to the correction for deleting a claim(s) (the Utility Model Act Article 14-2(7)), corrections (hereinafter, referred to as “correction such as restriction”) for the following purposes may be made : (A) restriction of the scope of claims, (B) correction of errors, (C) clarification of unclear description, and (D) dissolution of citation relation between the claims (rewriting a claim that cites another claim into a claim that does not cite the said other claim). (the Utility Model Act Article 14-2(2)) In addition to the restrictions for correction purpose, there are restrictions of adding new matters and substantial enlargement or change in the scope of the claims for the utility model registration (the Utility Model Act Article 14-2(3)(4)).

(Note) The corrections in (D) above are limited to those after April 1, 2012 (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 3).

B. Timing and limitation of the number of times

By (A) two months after the service of the certified copy of the technical opinion for the first time for the request of the technical opinion of the utility model or (B) the first answer submission period of the trial for invalidation, whichever comes first, correction for restriction, etc. may be done only once (the Utility Model Act Article 14-2(1)).

When a trial for invalidation is pending, a correction by deletion of the claim is possible at any time until the notice of conclusion of the proceedings is issued. There is no limit on the number. (the Utility Model Act Article 14-2(7)).

C. Correction requirements and invalid reasons

In respect of “correction such as restriction”, regardless of whether there is violation of the correction requirements specified in the Utility Model Act Article 14-2(2), (3), (4), if the timing and frequency and other requirements are satisfied, the correction is accepted; the said correction’s effect occurs; and the fact that the correction has been made is published in the “Utility Model Gazette” (the Utility Model Act Article 14-2(11),(12)). The issue of the propriety of the correction requirements in the correction by restriction, etc. is handled as a question of whether a

reason for invalidation in the registration of the utility model exists after the correction (the Utility Model Act Article 37(1)(vii)).

(2) Patent application based on utility model registration and trial for invalidation

If a patent application based on utility model registration is filed after the request for invalidation of utility model registration, the chief administrative judge notifies that effect to the demandant and the intervenor (the Patent Act Article 39(5)). The request for a trial for invalidation can be withdrawn without the counterparty's consent only within 30 days from the date on which the notice was received (the Utility Model Act Article 39-2(3)). If the request for a trial for invalidation or an application for intervention is withdrawn within the 30 days, the fee is refunded upon request (the Utility Model Act Article 54-2(2),(4),(8)).

(Revised June 2019)