A Comparative Study on Administrative Systems Including Consideration about the Scope of Patent Right for Patent Dispute Resolution among Korea, China and Japan

(in the 5th JEGTA Meeting held in Daejeon, September 26, 2017)

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I. Introduction

Background

Three offices, namely, KIPO, SIPO and JPO, have conducted comparative studies on trial systems within Joint Experts Group for Trial and Appeal(JEGTA) meeting; under the themes of ″Appeal against Decision of Rejection″ in 2014, ″Amendment to Patent Documents After Granted″ in 2015, and ″the Patent Trial for Invalidation″ in 2016.

This study is the fourth joint study conducted by the three offices. The subject was selected in 2016, and this study was reported in the 5th trial expert conference held on September, 2017.

Purpose

The purpose of this study is to introduce the administrative systems helpful to resolve patent dispute in Korea, China and Japan, in order to give a help for users and trial examiners in each country to broaden their understanding.

Contents and scope

In all of the three countries, a patent dispute can be solved through a lawsuit of the court; however, separately from the lawsuit of the court, the three countries operate administrative systems to consider the protective scope of the patent right for prompt resolving a patent dispute.

In this study are compared the administrative systems, where in order to resolve patent dispute directly or indirectly, a patentee or interested person requests for considering the scope of the patent right or demands the infringement prohibition. And the subjects of this study are the trial to confirm the scope

of patent right in Korea, the trial of patent infringement dispute in China, and Hantei(Advisory opinion on the technical scope of a patented invention) in Japan.

The trial to confirm the scope of patent right in Korea is the procedure for confirming whether an invention in question, which a third party works, falls within the protective scope of patent right. And a patentee, an exclusive licensee or a third party can file the trial with the Intellectual Property Trial and Appeal Board.

The trial of patent infringement dispute in China is to be filed by a person who has the right of the patent, such as a patentee, an exclusive licensee, etc. with the Local Intellectual Property Office, and this system is distinguished from the systems of the other countries in that the infringement prohibition can be ordered, together with identifying the third party′s infringement act.

Hantei operated by JPO is different from the systems of the other countries in that anyone can file request. And even if no opponent exists, request can be allowed. An appeal against Hantei result of the JPO cannot be filed with the court.

In Section 2 and 3, respectively, a comparative table is prepared and comparisons are made about various characteristics such as the provisions of the system, the parties, the examination procedures, the termination, the legal effect, etc. of each system. And in Section 4, the systems are summarized by country.

It should be noted that since the systems in the three countries are very different from each other, there is a limitation on more detailed comparative study. In addition, although JPO in Japan and PRB in China have systems where upon request of courts or a local intellectual property office of provincial government, an opinion can be presented on whether an invention in question falls within the scope of a patent right, these systems have not been included in the scope of this study.

II. Comparative Table among Korea, China and Japan

ITEM	KOREA	CHINA	JAPAN
Title of System	○ Trial to Confirm the Scope of Patent Right	○ Trial of Patent Infringement Dispute	○ Hantei (Advisory Opinion on the Technical Scope of a Patented Invention)
Authority	○ Intellectual Property Trial and Appeal Board (IPTAB)	○ Local IP Office of Provincial Government	○ Trial and Appeals Department, JPO
1. Relevant Provisions			
1.1. Provisions of Request			
	○ Article 135 (Trials to Confirm Scope of Rights) (1) A patentee or an exclusive licensee may request a trial to confirm the scope of a patent right of his/her own. (2) An interested person may request a trial to confirm the scope of a patent right of others. (3) Where a trial is requested to confirm the scope of a patent right under paragraph (1) or (2), the confirmation may apply to each claim if the patent contains two or more claims. ○ Article 139 (Request for Joint Trial) (1) Where two or more persons request an invalidation trial under Articles 133 (1), 134 (1) and (2) and 137 (1) or a trial to confirm the scope of a patent right under Article135 (1), the request may be made jointly. (2) Where a trial is requested against any of the joint owners of a patent right, all the joint owners shall be	○ Article 60. Where a dispute arises as a result of the exploitation of a patent without the authorization of the patentee, that is, the infringement of the patent right of the patentee, it shall be settled through consultation by the parties. Where the parties are not willing to consult with each other or where the consultation fails, the patentee or any interested party may institute legal proceedings in the people's court, or request the administrative authority for patent affairs to handle the matter. When the administrative authority for patent affairs handling the matter considers that the infringement is established, it may order the infringer to stop the infringing act immediately. If the infringer is not satisfied with the order, he may, within 15 days from the date of receipt of the notification of the order, institutes legal proceedings in the people's court in accordance with the Administrative Procedure Law of the People's Republic of China. If, within the said time limit, such proceedings are not instituted and the order is not complied with, the administrative authority for patent affairs may approach the people's court for compulsory execution. The said authority handling the matter may, upon the request of	○ Article 71 (1) A request may be made to the Patent Office for its advisory opinion on the technical scope of a patented invention. (2) Where a request under the preceding paragraph is made, the Commissioner of the Patent Office shall designate three administrative judges to make an advisory opinion on the requested matter. (3) Articles 131(1), the main clause of 131-2(1), 132(1) and (2), 133, 133-2, 134(1), (3) and (4), 135, 136(1) and (2), 137(2), 138, 139 (excluding (vi)), 140 to 144, 144-2(1) and (3) to (5), 145(2) to (5), 146, 147(1) and (2), 150(1) to (5), 151 to 154, 155(1), 157 and 169(3), (4) and (6) shall apply mutatis mutandis to the advisory opinion under paragraph (1). In this case, the term "trial decision" in Article 135 shall be deemed to be replaced with "ruling", the term "trial other than the trial under the preceding paragraph" in Article 145(2) shall be deemed to be replaced with "proceedings for advisory opinion", the term "where public order or

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	made defendants.	the parties, mediate in the amount of compensation for the damage caused by the infringement of the patent right. If the mediation fails, the parties may institute legal proceedings in the people's court in accordance with the Civil Procedure Law of the People's Republic of China. ○ Article 61. Where any infringement dispute relates to a patent for invention for a process for the manufacture of a new product, any entity or individual manufacturing the identical product shall furnish proof to show that the process used in the manufacture of its or his product is different from the patented process. Where the infringement relates to a patent for utility model, the people's court or the administrative authority for patent affairs may ask the patentee to furnish a search report made by the patent administration department under the State Council.	morality is liable to be injured thereby" in the proviso to Article 145(5) shall be deemed to be replaced with "where the chief administrative judge considers it necessary", the term "Article 147" in Article 151 shall be deemed to be replaced with "Article 147(1) and (2)", the term "before a trial decision becomes final and binding" in Article 155(1) shall be deemed to be replaced with "before the certified copy of the written advisory opinion is served". (4) No appeal shall be available against a ruling under Article 135 to be applied mutatis mutandis in the preceding paragraph. ○ Article 132 (Joint trial) (1) Where two or more persons file a request for a trial for patent invalidation or a trial for invalidation of the registration of extension of duration concerning the same patent right, the request may be filed jointly. (2) Where a request for a trial is filed against patentees jointly owning a patent right, the demandees in the said request shall be all the joint owners of the said patent right.
1.2. Provisions of formality examination			
	○ Article 140 (Formal Requirements of Request for Trial) (1) A person who intends to request a trial shall submit a written request stating the following matters to the President of the Intellectual Property Trial and Appeal Board: 1. Name and domicile of a person (if the person is a juristic person, its title and the location of its place of business);	(Measures for Patent Administrative Law Enforcement) ○ Article 11 To petition the patent administrative department to handle a patent infringement dispute, the petitioner shall submit a petition and the following certification materials: (1)a certificate of the legal status of the petitioner, namely the resident identity certificate or any other valid identity certificate of the petitioner who is an individual, or a duplicate of the valid business license or any other	○ Article 131 (Formal requirements of request for trial) (1) A person filing a request for a trial shall submit a written request stating the following to the Commissioner of the Patent Office: (i) the name, and the domicile or residence of the party and the representative thereof; (ii) the identification of the trial case; and

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	2. The name and domicile, or location of place of business, of the representative, if designated (if the representative is a patent corporation, its title, location of office and designated patent attorney's name); 3. Identification of the trial case; 4. The purport of the request and the grounds therefor. (2) No amendment to a request for trial submitted under paragraph (1) shall be made in the intent or purpose there of: Provided, That this shall not apply when such amendment falls under any of the following subparagraphs: 1. Where an amendment (including an addition) is made to correct a statement of a patentee from among the persons concerned pursuant to paragraph (1) 1; 2. Where a ground for request under paragraph (1) 4 is amended; 3. At a trial requested by a patentee or an exclusive licensee as a petitioner to confirm the scope of a patent right, the specification or drawings of the invention subject to confirmation on the written request for a trial is amended by the petitioner in order to make it identical with the invention which is on the working by the defendant, in cases where the defendant insists that the specification or drawings of the invention subject to confirmation on the written request for a trial (referring to the defendant's invention claimed by the petitioner) are different from the invention which is on the working by himself/herself. (3) When a trial is requested to confirm the scope of a patent right under Article 135 (1) (2), the specification capable to be compared with the patented invention and the relevant drawings shall	certification document which can certify the legal status of the petitioner if it is an entity as well as the identity certificate of the legal representative or major person-in-charge of the petitioner; and (2) a valid certificate of the patent, namely a duplicate of the patent register book, or the patent certificate and the receipt of payment for the annual patent fee for the current year. If the patent infringement dispute involves a patent of utility model or design, the patent administrative department may require the petitioner to present a patent evaluation report issued by the State Intellectual Property Office (Report of Retrieval of Utility Models). The petitioner shall provide as many duplicates of the petition and the relevant evidence as there are the parties against whom the petition is filed. ○ Article 12 A petition shall state: 1.the name and address of the petitioner, and the name and title of the legal representative or major person-in-charge; in the case of an authorized agent, the name of the agent and the name and address of the agency; 2. name and address of the party against whom the petition is filed; and 3. claims, facts and reasons. The relevant evidence and evidential materials may be submitted in the form of attachments to the petition. The petition shall bear the signature or seal of the petitioner.	(iii) purport of and reasons for the demand. ○ Article 131-2 (Amendment of request for trial) (1) An amendment of the written request filed under paragraph (1) of the preceding Article shall not change the gist thereof.

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	be attached to the written request.		
	○ Article 141 (Rejection of Request for Trial) (1) The presiding administrative patent judge shall order an amended submission within a specified period where any of the following subparagraphs applies: 1. Where a request for trial does not comply with Article140 (1) and (3) through (5) or 140-2 (1); 2. Where a procedure relating to a trial falls under any of the following cases: (a) Where the procedure is not in compliance with Article 3 (1) or 6; (b) Where fees required in accordance with Article 82 have not been paid; (c) Where the procedure is not in compliance with the formalities specified in this Act or any order there under. (2) Where a person who has been ordered to make an amended submission under paragraph (1) fails to do so within the specified period, the presiding administrative patent judge shall reject the request for trial by decision. (3) A decision to reject a request for trial under paragraph (2) shall be in writing and shall state the grounds therefor.	(Measures for Patent Administrative Law Enforcement) ○ Article 13 Where a petition meets the requirements as described in Article 10 of these Measures, the patent administrative department shall notify the petitioner about acceptance of the case within 5 working days as of the date of receiving the petition, and in the meantime designate 3 or more (in odd number) persons to deal with the patent infringement dispute. Where a petition meets the requirements as described in Article 10 of these Measures, the patent administrative department shall notify the petitioner about its rejection within 5 working days as of the date of receiving the petition and make an explanation.	○ Article 133 (Dismissal by ruling in the case of non-compliance with formal requirements) (1) Where a written request does not comply with Article 131, the chief administrative judge shall order the demandant to amend the written request, designating an adequate time limit. (2) Excluding the case as provided in the preceding paragraph, the chief administrative judge may order the demandant to amend a procedure pertaining to the trial, designating an adequate time limit, in any of the following cases: (i) where the procedure does not comply with paragraphs (1) to (3) of Article 7 or Article 9; (ii) where the procedure does not comply with formal requirements as provided in this Act or an order thereunder; and (iii) where the fees for a procedure payable under Articles 195(1) or 195(2) have not been paid; (3) The chief administrative judge may dismiss the procedure by a ruling where a person ordered to make an amendment to a procedure pertaining to a trial fails to make such amendment within the time limit designated under the preceding two paragraphs or where such amendment is made in violation of Article 131-2(1). (4) The ruling under the preceding paragraph shall be made in writing and state the grounds thereof.
	○ Article 142 (Dismissal of Request for Trial containing Incurable Defects by Trial Decision)	(Measures for Patent Administrative Law Enforcement) ○ Article 13 Where a petition meets the requirements as	○ Article 135 (Dismissal of inadequate request for trial by trial decision)

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	If a request for a trial contains unlawful defects which cannot be corrected by amendment, such request may be rejected by a ruling without providing the defendant an opportunity to submit a written reply.	described in Article 10 of these Measures, the patent administrative department shall notify the petitioner about its rejection within 5 working days as of the date of receiving the petition and make an explanation.	An unlawful request for a trial, that is not amendable, may be dismissed by a trial decision without giving the demandee an opportunity to submit a written answer.
1.3. Provisions of submission of a written response			
	○ Article 147 (Submission of Written Response, etc.) (1) When a trial has been requested, the presiding administrative patent judge shall serve a copy of the written request on the defendant and shall provide him/her an opportunity to submit a written response within a designated deadline. (2) Upon receipt of a written response under paragraph (1), the presiding administrative patent judge shall serve a copy of the response on the petitioner. (3) The presiding administrative patent judge may directly examine the parties in relation to the trial.	(Measures for Patent Administrative Law Enforcement) ○ Article 14 The patent administrative department shall, within 5 working days as of the date of acceptance, serve the duplicates of the petition and attachments thereof on the party against whom the petition is filed, and require it (him) to submit its (his) defence and provide as many duplicates of its (his) defence as there are petitioners within 15 days as of the date of receiving the petition. That the party against whom the petition is filed fails to submit its (his) defence within the time limit does not affect the patent administrative department's handling of the case. If the party against whom the petition is filed submits its (his) defence, the patent administrative department shall serve a duplicate of the defence on the petitioner within 5 working days as of the date of receiving it.	○ Article 134 (Submission of a written answer, etc.) (1) Where a request for a trial has been filed, the chief administrative judge shall serve a copy of the written request to the demandee and give the demandee an opportunity to submit a written answer, designating an adequate time limit. (3) Upon receipt thereof, the chief administrative judge shall serve to the demandant a copy of the written answer under paragraph (1) or the main clause of the preceding paragraph. (4) The chief administrative judge may question the parties and the intervenors with regard to the trial.
1.4. Provisions of proceeding of examination			
	○ Article 154 (Trial Proceedings, etc.) (1) Trial proceedings shall be conducted by oral hearing or documentary examination: Provided, That where a party requests an oral hearing, trial proceedings shall be conducted by oral hearing except where it is recognized that a decision can be made on the basis of a documentary examination alone. (2) Deleted. (3) Oral hearings shall be conducted in public: Provided that this shall not apply where public	(Measures for Patent Administrative Law Enforcement) ○ Article 15 When a patent administrative department handles a patent infringement dispute, it may mediate the case according to the will of the parties concerned. If both parties concerned reach an agreement, the patent administrative department shall prepare a mediation agreement, affix its official seal to it and have it signed or sealed by all parties concerned. If the mediation fails, it shall timely make a decision of handling. ○ Article 16 When a patent administrative department handles any patent infringement dispute, it may decide whether to try the case orally if the circumstance so requires. If it	○ Article 145 (Procedure of Proceedings) (2) Trials, excluding those as provided in the preceding paragraph, shall be conducted by documentary proceedings; provided, however, that the chief administrative judge may, upon a motion by the party or ex officio, decide to conduct the trial by oral proceedings. (3) Where a trial is conducted by oral proceedings under paragraph (1) or the proviso to the preceding paragraph, the chief administrative judge shall designate the date and place thereof and summon the parties and the intervenor on

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	order or morality is likely to be injured thereby. (4) Where trial proceedings are conducted by oral hearings in accordance with paragraph (1), the presiding administrative patent judge shall designate the date and place thereof and serve a document containing such information on the parties and intervenors: Provided, That this shall not apply where the parties or intervenors to attend the case have already been notified (5) With respect to the trial proceedings by oral hearings under paragraph (1), an official designated by the President of the Intellectual Property Trial and Appeal Board shall, under the direction of the presiding administrative patent judge, prepare a protocol setting forth the gist of the proceedings and other necessary matters for the date of each trial proceeding. (6) The presiding administrative patent judge and the official who has prepared the protocol under paragraph (5) shall sign the protocol and affix their seals thereto. (7) Articles 153, 154, and 156 through 160 of the Civil Procedure Act shall apply mutatis mutandis to protocols under paragraph (5). (8) Articles 143, 259, 299 and 367 of the Civil Procedure Act shall apply mutatis mutandis to trials. ○ Article 158 (Continuation of Trial Proceedings) Notwithstanding the failure of a party or intervenor to take any proceedings within a statutory period or designated deadline, or failure to appear on the designated date in accordance with Article 154 (4), the presiding administrative patent judge may proceed with the trial proceedings. ○ Article 159 (Ex Officio Trial Examination) (1) Grounds which have not been pleaded by a	decides to try the case orally, it shall, not later than at least 3 working days prior to the oral trial, notify the parties concerned about the time and place of the oral trial. Where a party refuses to appear without any justifiable reason or withdraws during the oral trial without permission, the said party who is the petitioner shall be deemed to have withdrawn the petition or the said party against whom the petition is filed shall be deemed to have been absent. ○ Article 17 To try a case orally, the patent administrative department shall include in the transcripts the information of the participants and main points of the oral trial, and shall have them signed or sealed by the law enforcement officials and attendees if no error is found upon verification. ○ Article 21 When handling patent infringement disputes, the patent administrative department shall conclude a case within three months of the date of docketing the case. If it is necessary to extend the time limit for an extremely complicated case, the extension shall be subject to the approval of the person in charge of the patent administrative department. The time limit may be extended for not more than one month with approval. The case handling time limit as mentioned in the preceding paragraph does not include the time for announcement, assessment, suspension, etc. during the process of handling a case. ○ Article 37 During the process of handling a patent infringement dispute, if a party concerned is unable to gather some evidence by itself (himself) for an objective reason, it (he) may request in writing the patent administrative department to conduct an investigation and take evidence. The patent administrative department shall decide whether to conduct an investigation and collect relevant evidence according to the relevant circumstance. During the process of handling a patent infringement dispute or investigating and handling an act of passing off patent, the patent administrative department may, if necessary, conduct investigation and collective relevant	the designated date. (4) Article 94 (Summon on the designated date) of the Code of Civil Procedure shall apply mutatis mutandis to summon on the designated date as provided in the preceding paragraph. (5) The oral proceedings under paragraph (1) or the proviso to paragraph (2) shall be conducted in public; provided, however, that this shall not apply where public order or morality is liable to be injured thereby. ○ Article 146 Article 154 (attendance of interpreter, etc.) of the Code of Civil Procedure shall apply mutatis mutandis to a trial. ○ Article 147 (Trial Records) (1) In oral proceedings under paragraph (1) or the proviso to paragraph (2) of Article 145, the trial clerk shall prepare a trial record stating the gist of the proceedings and all other necessary matters on each trial date. (2) When the trial clerk finds that an order received from the chief administrative judge with regard to the preparation or amendment of the trial record under the preceding paragraph is inappropriate, the trial clerk may add his/her opinion. ○ Article 152 (Ex officio proceedings) The chief administrative judge may proceed with the trial procedures, even if a party or intervenor fails to undertake required procedures within the legal or designated time limit or the said person fails to appear pursuant to the provision of Article 145(3). ○ Article 153 (1) Any grounds not pleaded by a party or

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	party or intervenor in a trial may be examined. In such cases, the parties and intervenors shall be provided with an opportunity to state their opinions regarding such grounds, within a designated deadline. (2) In a trial, no examination may be made on the purpose of a claim not requested by the petitioner. ○ Article 160 (Joint or Separate Conduct of Trial Proceedings or Trial Decisions)An administrative patent judge may jointly or separately conduct trial proceedings or trial decisions with regard to two or more trial proceedings where one or both parties thereto are the same. ○ Article 162 (Trial Decisions) (1) Except as otherwise provided for, a trial shall be closed when a trial decision has been made. (2) The trial decision under paragraph (1) shall be in writing, signed and sealed by the administrative patent judges who have rendered it, and shall state the following: 1. The number of the trial; 2. The name and domicile of the parties and intervenors(if a juristic person, its title and the place of business); 3. The name and domicile or place of business of there presentative, if any (if the representative is a patent corporation, its title, location of office and designated patent attorney's name); 4. The identification of the trial case; 5. The text of the ruling (including the scope, duration and consideration of a non-exclusive license in trial cases under Article 138); 6. The grounds for the decision (including the purport and a summary of the grounds for the	evidence according to its power. When the law enforcers conduct an investigation and collect relevant evidence, they shall show their law enforcement certificates to the party concerned and the relevant persons. The party concerned and the relevant persons shall show assistance and cooperation and faithfully offer relevant information. None of them shall refuse to offer assistance to the law enforcers, or hamper them from conducting the investigation and collecting relevant evidence.	intervenor may be examined in a trial. (2) Where any grounds not pleaded by a party or intervenor has been examined under the preceding paragraph, the chief administrative judge shall notify the parties and the intervenor(s) of the result thereof and give such persons an opportunity to present opinions, designating an adequate time limit. (3) Any purport of the claim not claimed by the demandant may not be examined in a trial. ○ Article 154 (Joint or separate conduct of proceedings) (1) Where one or both parties to two or more trials are identical, the proceedings may be jointly conducted. (2) Proceedings that have been jointly conducted under the preceding paragraph may later be separately conducted. ○ Article 157 (Trial decision) (1) When a trial decision has been rendered, the trial shall be concluded. (2) A trial decision shall be rendered in writing stating the following matters: (i) the trial number; (ii) the name, and domicile or residence of each of the parties, intervenor(s) and their representatives; (iii) the identification of the trial case; (iv) the conclusion of and reasons for the trial decision; and (v) the date of the trial decision. (3) Where a trial decision has been rendered, the

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	request); 7. The date of the ruling. (3) When a case has been thoroughly examined and is ready to be ruled, the presiding administrative patent judge shall notify the parties and intervenors thereof. (4) Even after notification of the closure of the trial examination under paragraph (3), the presiding administrative patent judge may, if necessary, reopen the examination upon the motion of a party or an intervenor or ex officio. (5) The decision shall be rendered within twenty days following the date on which the closure of a trial examination is notified under paragraph (3). (6) When a trial decision or a ruling has been rendered, the presiding administrative patent judge shall serve a certified copy of the trial decision or the ruling on the parties, intervenors, and persons who have requested intervention to the trial, but have been rejected		Commissioner of the Patent Office shall serve a certified copy of the trial decision to the parties, intervenor(s) and person whose application for intervention has been refused.
1.5. Provisions of withdrawal of request			
	○ Article 161 (Withdrawal of Request for Trial) (1) A request for trial may be withdrawn by a petitioner before the trial decision has become final and conclusive: Provided, That the consent of the defendant for the withdrawal shall be obtained where a response has already been submitted. (2) When a request for a trial for invalidating a patent under Article 133 (1) or for confirming the scope of a patent right under Article 135 has been made with regard to two or more claims, the request may be withdrawn for each of the claims. (3) Where a request for a trial or a request for each	○	○ Article 155 (Withdrawal of request for trial) (1) A request for a trial may be withdrawn before a trial decision becomes final and binding.

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	of the claims is withdrawn in accordance with paragraph (1) or (2), the request shall be deemed never to have been made.		
1.6. Provisions of burden of costs of trial			
	○ Article 165 (Costs of Trial) (1) The imposition of costs in connection with a trial under Articles 133 (1), 134 (1) and (2), 135 and 137 (1) shall be decided by a trial decision in the event the trial is terminated by a trial decision, or by a decision in the trial where the trial is terminated in a manner, other than by a trial decision. (2) Articles 98 through 103, 107 (1) and (2), 108, 111,112, and 116 of the Civil Procedure Act shall apply mutatis mutandis to the costs in connection with the trial under paragraph (1).	○ Free.	○ Article 169 (Burden of costs of trial) (3) The costs in connection with an appeal against an examiner's decision of refusal and a trial for correction shall be borne by the demandant. (4) Article 65 (Bearing of litigation costs in joint litigation) of the Code of Civil Procedure shall apply mutatis mutandis to the costs to be borne by the demandant under the preceding paragraph. (6) The scope, the amount and the payment of the costs in connection with a trial, and the payment required for undertaking a procedure for a trial shall be governed by the relevant provisions of the Act on Civil Procedure Costs, etc. (Act No. 40 of 1971) (excluding provisions in Chapter II, Sections 1 and 3 of the said Act) unless such provisions are contrary to the nature of the said matters.
2. Classification			
	< Affirmative trial > ○ A patentee requests for trial against an interested party of the invention in question. < Defensive trial > ○ An interested party of the invention in question requests for trial against the patentee. (Trial and Appeal Guidebook Part 14 Chapter 3(1))	○ No. ○ A patentee requests for trial against an interested party of the invention in question. ○ An interested party of the invention in question requests for trial against the patentee.	○ (A) Example cases of the structure of conflict between the parties in which there is the counterparty (a) With respect to the invention which a third party actually works or worked, the patentee request for Hantei with that third party as the counterparty. (b) With respect to the invention of another patentee, the patentee may take another

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			patentee as the counterparty. (c) Those, other than the patentee, may take the patentee as the counterparty, and request for Hantei about what you are going to work (d) About the invention which a third party actually works or worked, the exclusive licensee may request for Hantei with the third party as the counterparty. (e) Those, other than the exclusive licensee, may request for Hantei about the invention which they work or are going to work with the exclusive licensee as the counterparty. ○ (B) Example cases where there is no counterparty (a) The patentee may request for Hantei about the invention which he/she works or is going to work (b) The patentee may request for Hantei about the invention without knowledge of who works it. (c) Exclusive licensee may request for Hantei about the invention which he/she works or is going to work. (d) The exclusive licensee may request for Hantei about the invention without knowledge of who works it. (Manual for Trial and Appeal Proceedings (hereafter referred to as "Manual") 58-01 2.(2))
3. Parties			
3.1. Petitioner			

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	○ In an affirmative trial, the petitioner is the patentee or exclusive licensee. ○ In a defensive trial, the petitioner is an interested party of the invention in question. - An interested party includes not only those who work the invention in question which can cause dispute on the scope of the patent, but those who intend to do so. (Trial and Appeal Guidebook Part 14 Chapter 4(1))	○ The claimant is the patentee or any interested party(includes the licensee of the patent enforcement license and the legal successor of the patentee) ○ A person who has been warned by the patent holder, may request for trial about the invention which he/she works. (Measures for Patent Administrative Law Enforcement) ○ Article 10 The following requirements shall be met if a petitioner petitions the patent administrative department to handle a patent infringement dispute: (1)The petitioner is the patent holder or an interested party; The term "interested party" as mentioned in subparagraph 1 includes the licensees of patent license contracts and the lawful inheritors of the patent holder. Of the licensees of the patent license contracts, the licensee of a sole license contract may separately file a petition; the licensee of an exclusive license contract may separately file a petition provided that the patent holder does not file any petition; no licensee of an ordinary license contract may separately file a petition unless it is otherwise stipulated in the contract.	○ Anyone can request for Hantei. (Parties requesting for Hantei are not required to have legal interest in the result of Hantei in principle). (Manual 58-01 2.(3))
3.2. Defendant			
	○ (affirmative trial) Person who works a patented invention without permission ○ (defensive trial) Patentee	○ The party against whom the petition(Person who works a patented invention without permission) (Operation Manual for the Administrative Enforcement of Law Concerning Patents) ○ 2.1.2.2 The party against whom the petition shall be a natural person, legal person or other organization.	○ (A) (Right holder is a demandant) Person who actually works or has worked on an invention ○ (B) (Person other than a right holder is a demandant) Right holder (patentee, exclusive licensee)
3.3. Joint trial			

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	○ A. Where multiple parties can request a trial about the same patent, they can do it altogether according to Article 139(1). ○ B. Joint owners of a patent shall become petitioners or defendants altogether.	(Operation Manual for the Administrative Enforcement of Law Concerning Patents) ○ 2.1.2.3 joint petitions or the joint parties against whom the petition ○ Where the Patent infringement disputes are in one of the following circumstances, the relevant units or individuals should jointly participate in the handling of cases: (1) Where two or more patentees involve in the same patent right, all the joint owners are the joint parties against whom the petition, except some of the joint owners expressly waive the rights of the entities concerned; (2) Where the petition is a personal partnership, all the partners are the joint parties against whom the petition ; (3) other circumstances prescribed by laws and regulations.	○ The request for Hantei concerning the same patent right may be filed jointly by two or more persons. Where the request is filed against patentees jointly owning a patent right, the demandees in the said request shall be all the joint owners of the said patent right. (Article 132 (1) and (2) of the Japanese Patent Act (hereafter referred to as "JPA")) ○ It is not necessary that all the joint owners file the request for Hantei concerning their patent right when the said patent right is jointly owned, (Manual 58-03 1.(1)) ○ The proceedings of Hantei may be jointly conducted where one or both parties to two or more trials are identical. (Article 154 (1) and (2) of the JPA) When the panel determines that it is more ex peditious and precise to jointly conduct the pr oceedings for two or more Hantei cases, the panel may jointly conduct the proceedings as long as it is not against the purpose of the Hantei system and there is no special opinion on the matter from the parties (Manual 58-02 2.(4))
3.4. Intervention			
	○ Article 155 (Intervention) (1) Any person having the right to request a trial under Article 139 (1) may intervene in the trial before the conclusion of the trial examination. (2) An intervenor under paragraph (1) may continue a trial even after the request for the trial has been	○ If necessary, an intervenor can be added.	○ Article 148 (Intervention) does not apply mutatis mutandis to the Hantei proceedings Intervention is not approved in the Hantei procedures. However, in consideration of the existence of a person having deep interest, the administrative judge, where deemed necessary, may send a duplicate to the other right holders, and seek opinion ex officio. The same shall apply to the exclusive licensees. (Manual 58-03 1.(1))

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	withdrawn by the original party. (3) Any person having an interest in the result of a trial may intervene in the trial before the conclusion of the trial examination in order to assist one of the parties		
4. Request			
4.1. Subject of the request			
	○ The protected scope of a patented invention - whether the invention in question belongs to the scope of patent ○ A request may apply to each claim if the patent contains two or more claims.	○ Whether the infringement should be established. ○ Should specify the specific claim of infringement. ○ A request may be related to one or more of claims.	○ The technical scope of a patented invention - Whether the invention in question does / does not fall under the technical scope of the Patent no.XXXXXXX. ○ A request may be made for each claim.
4.2. Period for the request			
	○ The request may be filed only during the term of the patent right. Where a patent is extinguished, the courts hold that such request is not allowed because a trial to confirm the scope of a patent right purports to determine the scope of an existing patent.	○ The petitioner can make a request from the date of establishment of the patent right, under the circumstance that the petitioner considers the infringement occurred during the patent right existing. (Patent Law) ○ Article 68. The period of limitation for action against patent right infringement shall be two years, commencing from the date when the patentee or interested party knows or should have known of the infringement.	○ In principle, once the right is established, the time limit for filing a request for Hantei may be extended by a period not exceeding 20 years after the lapse of the right.(Manual 58-01 2.(4))
4.3. Purport and Reasoning			
4.3.1. Purport of the request	○ (Affirmative trial) 'invention in question belongs to the scope of patent #__' ○ (Defensive trial) 'invention in question does not belong to the scope of patent #__'	○ The Objective of the demand is to fall under the scope of patent right or not。	○ Purport of the request shall be stated in a written request (Article 131 (1) of the JPA). The purport of the request shall state certain technical content that falls under the technical

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	○ Invention in question, explanation or drawing (description or drawing which can be compared to the patented invention – Article 140.3) shall be attached (Trial and Appeal Guidebook Part 14 Chapter 4(2)) ○ Invention in question must be just one. If else, the trial shall be dismissed.		scope of a patented invention or does not fall. It is usual that Hantei is requested by stating either one of them. (Manual 58-01 2.(1)) For example, 'To demand a Hantei stating that the invention indicated in the drawing in question and its description does not fall under the technical scope of Patent no.○○○○.' ○ A separate request for Hantei must be filed for each object item in question. (Manual 58-01 2.(1))
4.3.2. Reasoning	○ The description of grounds for a request for trial is mandatory under Article 140(1)3 and 140-2(1)6 of the KPA. ○ Since the grounds for a request for trial are important for understanding the argument of a petitioner in trial proceeding by an administrative patent judge, the substantial reasons should be clearly described in the grounds for a request for appeal when filing a trial. ○ Where no substantial reason is described in "grounds for request," a request for trial shall be ordered to be amended in accordance with Article 141(1)1 of the KPA. ○ Where such amendment is not made within a designated period, the request for trial shall be dismissed by a decision under Article 141(2) of the KPA. (Trial and Appeal Guidebook Part 3 Chapter 4(5))	(Operation Manual for the Administrative Enforcement of Law Concerning Patents) ○ 2.1.3.3 The request shall include the following: (3) Request matters, infringement grounds and infringement facts: Infringement grounds can be technical comparison of the patented invention and the invention in question (Shall specify the specific claim being infringed); Infringement facts, should describe the basic situation of infringement, such as the time and location of infringement, the time, location and procedure of purchasing infringed products, etc.	○ Reason for the request shall be stated in a written request under Article 131 (1) of the JPA. ○ Examples of the description of reason for the request are as follows: 1. A need for a request for Hantei 2. History of the patent 3. Description of the patented invention 4. Description of the invention in question 5. Technical comparison between the patented invention and the invention in question 6. Explanation of why the invention in question does / does not fall under the technical scope of a patented invention 7. Conclusion
4.3.3. Amendment	○ The gist of a request for a trial shall not be amended, but an amendment of 'reasoning' which is necessary to specify purport of the request is not deemed as an amendment of the gist. (Article 140.2) Gist of a request means the parties and object of a trial. Regarding the parties, identification of the case and purport, amendment is allowed within the scope	○ The gist of a request for a trial usually cannot be amended. If necessary, an intervenor can be added.	○ The gist of a request shall not be amended (Article 131-2 (1) of the JPA) Amendment of the purport of and reasons for the request shall not be approved since the said amendment changes the gist thereof (e.g. change of the object item in question under code "A" to a non-identical object). However, if there is

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	of identicalness.		inconsistency between the purport and the reason, the reason shall be amended according to the purport. (Manual 58-03 1.(2))
4.4. Fees			
	○ Where a request for trial is submitted in an electronic format: KRW 150,000 per case plus KRW 15,000 per claim of a patent application or patent right; ○ Where a request for trial is submitted in a written format: KRW 170,000 per case plus KRW 15,000 per claim of a patent application or patent right	○ Free.	○ 40,000 yen per case
5. Invention in question			
5.1. Specifying invention in question			
	○ Invention in question shall be an invention that is currently used or can be used in the future. ○ In order to request this trial, the technical content of the invention in question has to be specifically stated so that it can be compared to that of the patented invention. If not, such request shall be dismissed. Where the specifying is insufficient, an administrative patent judge shall order an amendment of the explanation and drawing. (Trial and Appeal Guidebook Part14 Chapter 5(4))	(Operation Manual for the Administrative Enforcement of Law Concerning Patents) ○ 2.1.3.3 The request shall include the following: (3) Request matters, infringement grounds and infringement facts: Infringement grounds can be technical comparison of the patented invention and the invention in question(Shall specify the specific claim being infringed); Infringement facts, should describe the basic situation of infringement, such as the time and location of infringement, the time, location and procedure of purchasing infringed products, etc. ○ 2.1.3.6 Relevant evidence of patent infringement The relevant evidence of the enforcement of patent infringement refers to the evidence or documentary evidence submitted by the petitioner to prove that the party against whom the petition has committed the infringement. Whether the evidence is sufficient or not is not the requirement for file. During the filing process, the administrative authority for patent affairs only needs to examine the provided evidence or evidence of clues and other forms of review.	○ The purport of the request is to provide certain technical content that falls under the technical scope of a patented invention or does not fall. It is usual that Hantei is requested by describing either one of them. (Manual 58-01 2.(1)) ○ A separate request for Hantei must be filed for each object item in question. (Manual 58-01 2.(1)) ○ Where it is recognized that there are substantially more object items in question than one, the administrative judge shall make an inquiry with the demandant and make the demandant submit a written reply, etc. to specify one. In doing so, the administrative judge recommends the demandant to file a separate request for Hantei on the other object items. (Manual 58-03 1.(2))

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5.2. Amendment of invention in question			
	○ Amendment of the invention in question is only allowed where the invention remains identical (e.g., regarding the description or drawing), corrects an obviously erroneous statement and/or clarifies an unclear statement and/or explaining something in detail. ○ At affirmative trial, amendment of the invention in question is allowed in order to make it identical with the invention which is on the working by the defendant, in cases where the defendant insists that the invention in question on the written request for a trial (referring to the defendant's invention claimed by the petitioner) be different from the invention which is on the working by himself/herself. (Trial and Appeal Guidebook Part 14 Chapter 5(4))	○ Amendment of invention in question(the object item in question) is not allowed.	○ To change the object item in question under code "A" to a non-identical object, is to change the gist of the request. Therefore, it shall not be approved. (58-03 1.(2))
6. Examination of formality			
	○ A request for trial is examined whether or not it meets the formalities prescribed by the law. Thus, where a request violates Articles 140.1,3~5, 140 - 2.1, 3.1 or 6, or fee for the request has not been paid, or formalities of the law have not been obeyed, the presiding administrative patent judge of the division shall order an amendment within a designated period and if not amended, shall issue a written dismissal of the request with reasons called a dismissal order. A party contesting this order can file a lawsuit in the Patent Court. ○ Examination of lawfulness concerns whether or not a request of trial itself is lawful. Where a request for trial contains defects that cannot be corrected by an amendment, the request may be rejected by a ruling without giving the defendant an opportunity to	(Measures for Patent Administrative Law Enforcement) ○ Article 13 Where a petition meets the requirements as described in Article 10 of these Measures, the patent administrative department shall notify the petitioner about acceptance of the case within 5 working days as of the date of receiving the petition, and in the meantime designate 3 or more (in odd number) persons to deal with the patent infringement dispute. Where a petition meets the requirements as described in Article 5 of these Measures, the patent administrative department shall notify the petitioner about its rejection within 5 working days as of the date of receiving the petition and make an explanation.	When a request does not meet the formality requirements prescribed by the law, the chief administrative judge shall order an amendment within an adequate time limit designated, and if the request is not amended, the chief administrative judge may dismiss the procedure by a ruling (Article 133 of the JPA)

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	submit a written answer. (Article 142) This is called dismissal of trial and a dismissed party can file an appeal in the Patent Court. Trial is dismissed when some of the joint owners are missing as a party, when an uninterested party brings an action, etc.		
7. Proceeding of examination			
7.1. Board for examination			
	○ A trial shall be conducted by a board of three or five administrative patent judges.(Article 146)	(Operation Manual for the Administrative Enforcement of Law Concerning Patents) ○ 2.1.4.1 Three or more singular law enforcement officers shall be designated to deal with the patent infringement dispute.	○ A trial shall be conducted by a panel of three or five administrative judges (Article 71 (2), 136 (1) of the JPA).
7.2. Method			
	○ Trial proceedings are conducted by oral hearing or documentary examination. In practice, documentary examinations are the rule. 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.	(Measures for Patent Administrative Law Enforcement) ○ Article 16 When a patent administrative department handles any patent infringement dispute, it may decide whether to try the case orally if the circumstance so requires. If it decides to try the case orally, it shall, not later than at least 3 working days prior to the oral trial, notify the parties concerned about the time and place of the oral trial.	○ In principle, Hantei shall be conducted by documentary proceedings. However, the chief administrative judge may, upon a motion by a party or ex officio, decide to conduct Hantei by oral proceedings. (Manual 58-02 2.)
7.3. Oral hearing			
7.3.1. General	○ Upon a demand from a party or ex officio ○ In the case where a decision can sufficiently be made on the basis of a documentary examination alone, where oral hearing is requested by a party, it can be refused and notified to the requestor in 15 days. (The Trial office Handling Rules 39.2) ○ In holding an oral hearing, the administrative patent judge shall determine the date and location and notify the parties in writing no later than 3 weeks	(Measures for Patent Administrative Law Enforcement) ○ Article 16 When a patent administrative department handles any patent infringement dispute, it may decide whether to try the case orally if the circumstance so requires. If it decides to try the case orally, it shall, not later than at least 3 working days prior to the oral trial, notify the parties concerned about the time and place of the oral trial. Where a party refuses to appear without any justifiable reason or withdraws during the oral trial without permission, the said party who is the petitioner shall be	○ Upon a motion by a party or ex officio Oral proceedings are held when it is more appropriate than documentary proceedings for grasping the truth of the facts in cases of the structure of conflict between the parties. (Manual 58-02. 2.) ○ In principle, a writ of summons about the designated date of oral proceedings shall be serviced to the parties no later than 2 weeks prior

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	prior to the designated date. (Trial and Appeal Guidebook Part 10 Chapter 5(1))	deemed to have withdrawn the petition or the said party against whom the petition is filed shall be deemed to have been absent.	to the designated date. (Manual 33-01 3.)
7.3.2. Location	○ Trial courts of IPTAB ○ The presiding administrative judge may decide the place of oral hearing other than trial courts	○ Trial courts of the administrative authority for patent affairs.	○ Trial court in JPO, if oral hearings are carried out.
7.3.3. Video oral hearing systems	○ Available (oral proceedings may be conducted by connecting Seoul and Daejeon hearing rooms)	○ Available.	○ There is no video oral hearing system in JPO.
7.3.4. Proceeding of oral hearing	○ When both parties are absent, oral hearing shall be cancelled. ○ But, when one of the parties is absent, oral hearing shall be conducted and the party is not deemed to have made a confession unlike a civil action. ○ Korean should be used in oral hearing. (Rule 65(2))	(Measures for Patent Administrative Law Enforcement) ○ Article 16 Where a party refuses to appear without any justifiable reason or withdraws during the oral trial without permission, the said party who is the petitioner shall be deemed to have withdrawn the petition or the said party against whom the petition is filed shall be deemed to have been absent. ○ Chinese should be used in oral hearing. ○ When both parties are absent, oral hearing shall be cancelled.	○ When both parties are absent, oral hearings shall be cancelled. However, when one of the parties is absent, oral hearings shall be carried out and the other party is not deemed to have made a confession unlike a civil action. ○ In oral proceedings, the participants (administrative judges, parties) shall use Japanese.
7.3.5. Records	○ The trial clerk shall prepare a trial record. The trial record shall be written and signed by the presiding administrative judges and the trial clerk.	(Measures for Patent Administrative Law Enforcement) ○ Article 17 To try a case orally, the patent administrative department shall include in the transcripts the information of the participants and main points of the oral trial, and shall have them signed or sealed by the law enforcement officials and attendees if no error is found upon verification. ○ The law enforcement officials shall prepare a trial record. The trial record shall be written and signed by law enforcement officials and attendees	○ The trial clerk shall prepare a trial record stating the gist of the proceedings and all other necessary matters on each trial date (Article 147 of the JPA).
7.4. Suspension of the procedure			

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	○ If necessary, a procedure for the examination might be suspended ex officio or on the request until a procedure for another trial or litigation is completed. (Article 164(1))	○ Where, in the course of handling a patent infringement dispute, the defendant requests invalidation of the patent right and his request is accepted by the Patent Reexamination Board, he may request the administrative authority for patent affairs concerned to suspend the handling of the matter. ○ If the administrative authority for patent affairs considers that the reasons set forth by the defendant for the suspension are obviously untenable, it may not suspend the handling of the matter. (Implementing Regulations of the Patent Law of the People's Republic of China Rule 82)	○ Article 168 of the JPA(suspension in relation to litigation) shall not be applied in Hantei procedure.
7.5. Scope of examination			
7.5.1. Limit of examination	○ For the sake of public interest, grounds that have not been pleaded by a party or intervenor in a trial may be examined; however, in such cases, the parties and intervenors must be given an opportunity within a designated period to state their opinions regarding the grounds. (Article 159.1)An examination may not be made on the purport which is not requested by the petitioner.(Article 159.2) Thus, ex officio trial examination is limited to the reasoning supporting purport. (Trial and Appeal Guidebook Part 14 Chapter 5(8))	(Measures for Patent Administrative Law Enforcement) ○ Article 37 During the process of handling a patent infringement dispute, if a party concerned is unable to gather some evidence by itself (himself) for an objective reason, it (he) may request in writing the patent administrative department to conduct an investigation and take evidence. The patent administrative department shall decide whether to conduct an investigation and collect relevant evidence according to the relevant circumstance. During the process of handling a patent infringement dispute or investigating and handling an act of passing off patent, the patent administrative department may, if necessary, conduct investigation and collect relevant evidence according to its power. When the law enforcers conduct an investigation and collect relevant evidence, they shall show their law enforcement certificates to the party concerned and the relevant persons. The party concerned and the relevant persons shall show assistance and cooperation and faithfully offer relevant information. None of them shall refuse to offer assistance to the law enforcers, or hamper	○ Ex officio proceedings are conducted in the Hantei procedure. The chief administrative judge may examine any grounds not pleaded by a party, and change the proceeding method from documentary to oral proceedings ex officio. (Article 152 and 153 of the JPA) ○ However, the purport of the request, which the demandant did not request, may not be examined in the Hantei procedure. (Manual 58-02 2.(3))

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		them from conducting the investigation and collecting relevant evidence.	
7.5.2. When defendant does not dispute	○ At defensive trial, a request is dismissed where the defendant does not dispute the petitioner's demand obviously. (Trial and Appeal Guidebook Part 14 Chapter 5(9))	(Measures for Patent Administrative Law Enforcement) ○ Article 26 If the parties concerned reach an agreement upon medication, the patent administrative department shall prepare a mediation agreement and affix to it its official seal, and the signature or seal of both parties concerned. If no agreement is reached, the patent administrative department may close the case by revoking the case and notify both parties concerned.	○ Because the conclusion of the Hantei is confirmed not only by the parties' claim but also by the authority (ex officio), it is considered that cognovits (recognition and acceptance) are not allowed.(Manual 58-03 1.(4))
7.5.3. Confession	○ The IPTAB patent trial adopts an inquisitorial system where the administrative patent judge plays an active role because a patent trial needs a solution effective against third parties due to public interest and industrial policy. Even if there is a confession of a party, it is necessary to identify concrete facts and to judge accordingly. (Trial and Appeal Guidebook Part 14 Chapter 5(10))	○ Even if there is a confession of a party, it is necessary to identify concrete facts and to judge accordingly.	○ Because the conclusion of the Hantei is confirmed not only by the parties' claim but also by the authority (ex officio), it is considered that cognovits (recognition and acceptance) are not allowed. (Manual 58-03 1.(4))
7.6. The scope of the patent protection			
	○ As long as invention in question lacks any element of the patented invention, such invention in question is outside the scope of the invention. ○ But, in order for 'infringement by doctrine of equivalent' to be recognized, where invention in question replaces elements of patented invention with others, the new elements performs substantially the same function as the elements of patented invention with substantially same manner and result, a person skilled in the art could easily figure out such replacement at the time of working invention in	(Measures for Patent Administrative Law Enforcement) ○ Article 18 The provision of paragraph 1 of Article 59 of the Patent Law that "The scope of protection of the patent right for an invention or utility model shall be determined by the terms of the claims" means that the scope of protection of a patent shall be determined by the technological features described in the claims, including the scope determined by the features equivalent to the technological features described therein. The equivalent features refer to the features which an ordinary technician in the corresponding field could easily think of without any	○ The principle of confirmation of the technical scope of a patented invention The confirmation of the technical scope of a patented invention is determined based on the scope of the claims. If a part of the scope of the claims is not present in the object item in question under code "A", it does not follow that the object item in question falls under the technical scope of a patented invention usually.

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	question but such invention in question was not publicly known at the time of filling the patent application.	creative work and the use of similar means could bring about similar functions or achieve similar effects as the technological features described in the claims.	○ Requirements for determination of equivalence Even if different part from the product in question exists in the structure described in the scope of the claims, it is appropriate to define the below products in question, etc., as products equivalent to the structure described in the scope of the claims, falling under the technical scope of a patented invention: (1) The different part is not an essential part of the patented invention. (2) The product may achieve the purpose of the patented invention and has identical function and effect even if the different part is replaced. (3) A person skilled in the art could have easily arrived at an idea to replace the above mentioned different part at the time of manufacturing of the product in question, etc. (4) The product in question, etc. is neither identical with publicly known prior art nor one that could have easily conceivable by a person skilled in the art at the time of filing the patent application. (5) There are no special circumstances for the product in question, etc. to be deliberately removed from the scope of the claims in application procedures of the patented invention, etc. Argument of Invalidity or indirect infringement is not accepted in Hantei. (Manual 58-03 1.(5))
7.7. Burden of the cost			

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	○ In Principle, the losing parties pay the trial cost. The decision has to expressly decide *ex officio* which party shall pay for it.	○ Free.	○ The principle that costs of trial shall be borne by the losing party is not usually applied to Hantei system. The fees for a request for Hantei shall be usually paid by the demandant. (Manual 47-01 5.)
8. Termination of Trial			
	○ The IPTAB trial is generally concluded by a decision, however, where a request does not meet legal formality, a trial can end with an order and also with a withdrawal of the request. ○ When a case has been thoroughly examined and is ready to be ruled, the presiding administrative patent judge shall notify the parties and intervenors thereof. The decision shall be rendered within twenty days following the date on which the closure of a trial examination is notified. (Trial and Appeal Guidebook Part 12 Chapter 1)	(Measures for Patent Administrative Law Enforcement) ○ Article 21 When handling patent infringement disputes, the patent administrative department shall conclude a case within three months of the date of docketing the case. If it is necessary to extend the time limit for an extremely complicated case, the extension shall be subject to the approval of the person in charge of the patent administrative department. The time limit may be extended for not more than one month with approval. The case handling time limit as mentioned in the preceding paragraph does not include the time for announcement, assessment, suspension, etc. during the process of handling a case. ○ IF conciliation and mediation are made, the procedure may be terminated only when the petitioner withdraws request. ○ Even if the proceeding is concluded, the notice of the closing of trial shall not be given to the parties.	○ (1) The Hantei procedure is finalized with the service of a certified copy of the Hantei results to each party, withdrawal of the request for Hantei, or the service of a certified copy of the decision to dismiss the request. The same procedure as withdrawal shall be applied mutatis mutandis to the effect of abandonment of the request. ○ (2) Even if the proceedings are concluded, the notice of closing of trial examination shall not be given to the parties. (Manual 58-03 3.)
8.1. Overview of decision			
	○ Where a patent contains multiple claims, the patentee may request a trial for each claim. (Article 135.2) Thus, if a petitioner expressly specifies a claim, whether or not the invention in question belongs to the scope of the relevant claim shall be decided and expressly stated in the conclusion of decision.	○ The petitioner should specify the specific claim being infringed, which may be one or more claims of the patent. (Measures for Patent Administrative Law Enforcement) ○ Article 19 Unless a mediation agreement is reached or the petitioner withdraws the petition, the patent administrative department shall prepare a decision about the handling of	Whether or not the object item in question falls under the technical scope of a patented invention shall be decided and written as the conclusion with the reasons thereof.

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		the patent infringement dispute, which shall state: 3. the reasons and basis for determining whether the infringement is established;	
8.2. Stating matters of decision			
	○ IPTAB decision includes (i) identification of the trial division; (ii) title; (iii) identification of the case; (iv) persons involved in the trial such as the parties and counsels; (v) date of the original decision; (vi) conclusion of decision; (vii) reasoning; (viii) date of the IPTAB decision; and (ix) names of administrative patent judge s making the decision and their signatures. (Trial and Appeal Guidebook Part 12 Chapter 2(1))	(Measures for Patent Administrative Law Enforcement) ○ Article 19 Unless a mediation agreement is reached or the petitioner withdraws the petition, the patent administrative department shall prepare a decision about the handling of the patent infringement dispute, which shall state: 1. the name and address of the parties concerned; 2. the facts and reasons stated by the parties concerned; 3. the reasons and basis for determining whether the infringement is established; 4. express indications of the type, objective and range of infringement which the party, against whom the petition is filed, is ordered to stop promptly if the decision of handling determines that the infringement is established and that it is necessary to order the infringer to stop the infringement promptly; or a rejection of the claims of the petitioner if the decision of handling determines that the infringement is not established; and 5. how to lodge an administrative lawsuit if any party is not satisfied with the decision of handling and the time limit for doing so. The decision of handling shall bear the official seal of the patent. ○ Article 26 If the parties concerned reach an agreement upon medication, the patent administrative department shall prepare a mediation agreement and affix to it its official seal, and the signature or seal of both parties concerned. If no agreement is reached, the patent administrative department may close the case by revoking	○ Hantei results (trial decisions) include (i) trial number, (ii) name of the parties, etc., (iii) identification of the case, (iv) conclusion of and reasons for the decision and (v) the date of the decision. (Article 157 of the JPA) Hantei results bear administrative judges signatures and seals. These may be processed by electrical information processing system. (Manual 58-03 2.(1))

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		the case and notify both parties concerned.	
8.3. Order of decision			
	○ Admission: (1) Defensive trial 'the invention in question does not belong to the scope of patent #__' (2) Affirmative trial 'the invention in question belongs to the scope of patent #__' ○ rejection: 'This request is hereby rejected.' ○ Some admitted and Some rejected. 'the invention in question belongs to the scope of claim # of patent #__' Remainder of the request is rejected.	(Example) [Conclusion] The party against whom the petition made, used, sold, offered to sell, imported the requested infringement products. None of the above shall be deemed an infringement of the patent right. ---------- In accordance with the provisions of Article 60 of the Patent Law, this Council has made the following decisions: Dismissed the petitioner's request of stopping the infringement. And other requests beyond the legal terms of the patent administrative department are dismissed together.	Description examples of the conclusion [Conclusion] A) positive/negative results The "…" indicated in the code "A" drawing and it explanatory document (does not) fall within the technical scope of an invention of the Japanese Patent NO. XXXXXXX B) dismissal of the request The request for Hantei is dismissed (Manual 58-03 2.(2))
8.4. Effect			
	○ When an IPTAB decision becomes final, whether or not the invention in question belongs to the scope of a patent is confirmed. Thus, where the invention is finally decided to belong there, working of invention in question is deemed as a violation of the patent. However, a final decision does not bind the court in specific civil or criminal cases and is simply a technical determination. Where an IPTAB decision has become final under this Act, a person may not demand a new trial on the basis of the same facts and evidence, unless the decision is a rejection. (Article 163)	(Measures for Patent Administrative Law Enforcement) ○ Article 20 After the patent administrative department or the people's court makes a decision of handling or judgment which determines the establishment of infringement and orders the infringer to stop the infringement promptly, the party against whom the petition is filed commits the same type of infringement upon the same patent, if the patent holder or the interested party petitions the case to be handled, the patent administrative department may directly make a decision of handling, which orders prompt stop of the infringement.	○ Since Hantei is an official opinion of the JPO (the panel) regarding the technical scope of a patented invention, it is equivalent to an expert opinion, sufficiently respected in society, and also an authoritative opinion. However, there is no legally binding force (Manual 58-00 2.)

ITEM	KOREA	CHINA	JAPAN
8.5. Appeal to court			
	○ A person contesting a decision of the IPTAB can bring an action to cancel the IPTAB decision before the Patent Court within thirty days after receiving the certified copy of the decision, and with respect to the decision of the Patent Court, an appeal brief can be filed in the Supreme Court within fourteen days after receiving the written decision from the Patent Court. In the case where a request for an additional period is filed regarding the appeal period of the Patent Court, the presiding administrative patent judge can designate an additional period of twenty days for the resident and an additional period of thirty days for the non-resident.	(Patent law) ○ Article 60 When the administrative authority for patent affairs handling the matter considers that the infringement is established, it may order the infringer to stop the infringing act immediately. If the infringer is not satisfied with the order, he may, within 15 days from the date of receipt of the notification of the order, institutes legal proceedings in the people's court in accordance with the Administrative Procedure Law of the People's Republic of China. If, within the said time limit, such proceedings are not instituted and the order is not complied with, the administrative authority for patent affairs may approach the people's court for compulsory execution.	○ Since the Hantei results have no binding legal effects on defendants or third parties, they constitute neither an official procedure of an administrative office nor an exercise of public authority in Administrative Appeal Act. Therefore, appeal to Hantei results under this Act shall not be possible. (Manual 58-00 2.)
8.6. Withdrawal of Request			
	○ Article 161 (Withdrawal of Request for Trial) (1) A request for trial may be withdrawn by a petitioner before the trial decision has become final and conclusive: Provided that the consent of the defendant for the withdrawal shall be obtained where a response has already been submitted. (2) When a request for a trial for invalidating a patent under Article 133 (1) or for confirming the scope of a patent right under Article 135 has been made with regard to two or more claims, the request may be withdrawn for each of the claims. (3) Where a request for a trial or a request for each of the claims is withdrawn in accordance with paragraph (1) or (2), the request shall be deemed never to have been made.	○ A request for trial may be withdrawn by a petitioner before the trial decision has become final and conclusive.	○ A request for Hantei may be withdrawn until the Hantei results are sent to the defendant. (Article 155 (1) of the JPA) ○ Unlike the other type of trial, a request for Hantei may be withdrawn without consent of the counterparty even after the written answer of the counterparty has been submitted..

ITEM	KOREA	CHINA	JAPAN
9. Accelerated procedure			
	○ Trials are, in principle, conducted in sequence of dates requested. However, a trial may be proceeded in preference over others if an accelerated trial is deemed necessary ○ Accelerated trial - A trial to confirm the scope of a patent right or an invalidation trial related to a request for preliminary injunction to prohibit infringement, provided that an accelerated trial is requested ○ Super accelerated trial - A trial case that is related to an infringement suit notified by a court - A trial case that is related to a unfair trade practice investigation case notified the Korea Trade Commission - A trial case that is related to a case pending in court due to a dispute over intellectual property rights or prosecuted by the police or the prosecution after a request for trial is filed, and for which a party-in-interest or an associated authority/organization requests an accelerated trial; - A trial case where a party-in-interest submits, with consent of the other party, a request for a super-accelerated trial	○ No.	○ Trials for Hantei are examined in order of a filing date of a request, in principle. However, since a Hantei case is usually related to a trial for patent invalidation, a trial for correction, a patent infringement litigation, etc., the order of trials for Hantei may be changed, considering the related cases. ○ A request for Hantei is often related to existing dispute about the technical scope of a patented invention or its prevention, carrying out of business, etc., and often needed to be resolved as soon as possible. Therefore, it is desirable to examine it as quickly as possible. (Manual 58-02 2.(5)) However, accelerated trial proceedings shall not be requested for Hantei.

III. Analysis Result

1. Relevant provisions

1.1. Provisions of request

Refer to Article 135 of the (Korean) Patent Law; Articles 60-61 of the (Chinese) Patent Law; Article 71 of the (Japanese) Patent Law

1.2. Provisions of formality examination

Refer to Articles 140, 141 and 142 of the (Korean) Patent Law; Articles 11 and 12 of the (Chinese) Measures for Patent Administrative Law Enforcement; Articles 131, 131-2, 133 and 135 of the (Japanese) Patent Law

1.3. Provisions of written response

Refer to Article 147 of the (Korean) Patent Law; Articles 13 and 14 of the (Chinese) Measures for Patent Administrative Law Enforcement; Article 134 of the (Japanese) Patent Law

1.4. Provisions of proceeding of examination

Refer to Articles 154, 158 to 160 and 162 of the (Korean) Patent Law; Articles 15 to 17, 21 and 37 of the (Chinese) Measures for Patent Administrative Law Enforcement; Articles 145 to 147, 152 to 154 and 157 of the (Japanese) Patent Law

1.5. Provision of withdrawal of request

Refer to Article 161 of the (Korean) Patent Law; Articles 16 and 19 of the (Chinese) Measures for Patent Administrative Law Enforcement; Article 155 of the (Japanese) Patent Law

2. Classification

In Korea, there are an affirmative trial in which the holder of the right argues that ‘a invention in question falls within the scope of the patent right,’ and a defensive trial in which an interested party argues that ‘a invention in question does not fall within the scope of the patent right.’

In China, the cases of trial are divided into: a case where the petitioner argues infringement and a case where the petitioner argues non-infringement. The right holder may request for a trial of patent infringement dispute. And the person who got the notice of infringement may request for a trial in which the purport is ‘the item in question does not infringe on patent right.’

In Japan, the cases of Hantei are divided into: a case where the counterparty exists and a case where no counterparty exists. As the examples of the case where the counterparty exists, there are cases where a patentee files a Hantei against a third party, where a third party files a Hantei against a patentee, etc. As the examples of the case where no counterparties exist, there are a case where a patentee or an exclusive licensee requests for Hantei about the invention which he/she works or is going to work, where a patentee files a Hantei against an invention for which it is unclear who works, etc.

3. Parties

3.1. Petitioner

In Japan, anyone can request for Hantei.

In Korea, in the case of the affirmative trial, a patentee and an exclusive licensee may file a trial; and in the case of the defensive trial, an interested party can file a trial. The interested party covers a person who works and a person who is going to work the invention in question.

In China, a patentee or an interested party may file a trial. The term “interested party” includes the licensees of patent license contracts and the lawful inheritors of the patent holder. Of the licensees of the patent license contracts, the licensee of a sole license contract may separately file a petition; the licensee of an exclusive license contract may separately file a petition provided that the patent holder does not file any petition; no licensee of an ordinary license contract may separately file a petition unless it is otherwise stipulated in the contract.

3.2. Defendant

In Korea and China, a defendant should be clearly indicated; by comparison, in Japan, a defendant is indicated usually as principle, but a request without counterparty is also possible in some cases..

In Korea, in the case of the affirmative trial, a person who has worked the invention in question should be indicated; and in the case of the defensive trial, the right holder should be indicated. In China, a person who has worked a patented invention without authorization should be indicated.

In Japan, if the petitioner is the right holder, the defendant is the person who has worked the invention; and if the petitioner is not the right holder, the defendant is the patentee or exclusive licensee.

3.3. Joint trial

In the three countries, a plurality of petitioner may file a trial jointly. In the case where the patent right is owned jointly, in Korea and China, all of the joint owners must file the trial jointly; by comparison, in Japan, a part of the patentees can request for Hantei.

In the case where a third party files a trial against a jointly owned patent, in Korea, china and Japan , all of the patentees should be indicated as defendants.

3.4. Intervention

In Korea and China, intervention is possible; by comparison, in Japan, participation is not possible, however it is possible to send a copy of petition to the other right holder who is not indicated in the request or the exclusive licensee and ask about his/her opinion.

4. Request for trial

4.1. Subject

In the three countries, the subject of petition is whether a technical item falls within the scope of a patent. The request may apply to each claim in the case where there is a plurality of claims.

4.2. Period for the request

In Korea, the request may be filed only during the term of the patent right, and the request cannot be filed after the patent term has expired.

In China, the request may be filed within 2 years from the date when the patentee or interested party knows or should have known of the infringement.

In Japan, the request may be filed not only during the term of the patent right but also within 20 years after the patent term has expired.

4.3. Petition

4.3.1. Purport of the request

In China, copies of the petition should be submitted according to the number of the defendants; by comparison, in Korea, it is allowed to submit only one copy of the petition, regardless of the number of the defendants. In Japan one authentic copy and other two copy (for proceedings and for the defendants) of the petition should be submitted.

Purport of the request

In Korea, it is described that “the invention described in description and drawings falls(or does not fall) within the scope of Patent No. xxxx.”

In China, it is described that “the item in question infringed(or didn’t infringe) on Patent No. xxxx.”

In Japan, it is described that “the invention in question falls(or does not fall) within the scope of Patent No. xxxx,”.

4.3.2. Reasoning

In the three countries, when filing a trial, reasons of request should be described, and the countries are the same in that if the reasons for request are not lawful, an order for amendment is issued. In Korea and Japan, if substantive reasons are not included in the reasons for request, an order for amendment should be issued, and if an amendment is not made within the designated period, the request is dismissed by ruling. Unlike in Korea and Japan, in China, infringement facts should be indicated, wherein infringement facts include an infringing place and the time, place and procedure of purchasing the infringing product, etc.

4.3.3. Amendment of purport and reasoning

In the three countries, the gist of the petition is not allowed to be changed

In Korea, the purport of request shall not be amended, but amending the reasoning of request is not considered as the change of the gist. In the case of Japan, the amendments of the purport and the reasoning are not allowed; however, in the case where the purport of the request and the reasoning are not consistent with each other, it is allowed to amend the reasoning of the request. In China, the change of the gist is not allowed, but if necessary, the addition of an intervener is allowed.

4.4. Fees for filing the trial

In Korea and Japan, official fees for filing a trial should be paid; by comparison, in China, it is free.

In Korea, in the case of electronic filing, the official fees for filing the trial include basic official fees of KRW 150,000 and an additional official fee of KRW 15,000 for each claim; and in the case of paper-based filing, the basic official fees are KRW 170,000.

In Japan, the official fee is JPY 40,000 per case, and there is no additional fee for each claim.

5. Invention in question

5.1. Specifying invention in question

Invention in question (or item in question), which is to be compared with a patented invention, refers to an invention that has been worked or an invention that will be worked. The invention in question should be specified so that it can be compared with the patented invention.

In the case of Korea and Japan, in the case where invention in question is a plurality of items, the trial should be filed for each item. In the case where it is apparent that the inventions in question are several or where it is contradictory to deem that the invention in question is one, if the deficiency is not overcome after a right for explanation is exerted, the trial shall be dismissed.

In China, an infringement ground (technically comparing a patented invention and the item in question), infringement facts (time, place, etc.), and infringement evidence should be indicated. Whether the evidence is sufficient or not is not a necessary condition for request, and the examination is made based on the indicated evidence.

5.2. Amendment of invention in question

In Korea, an amendment of an invention in question is allowed only when the identity is guaranteed. However, in the affirmative trial, in the case where the

explanation or drawings of the invention in question is amended to be the same as the defendant's invention that has been worked, this is not considered as a change of the gist and thus this amendment is allowed.

In China, the amendment is not allowed.

In Japan, amending the invention in question is considered as the change of the gist and thus this amendment is not allowed.

6. Formality examination

In the three countries, the examination is made on whether the request for trial satisfies the requirements.

In Korea and Japan, in the case the request does not meet the requirement of formality such as official fees, agent, other formality matters, etc., an order shall be issued to amend within a designated period. And if the request is not amended, the request shall be dismissed by ruling. In Korea, Where a request for trial contains defects that cannot be corrected by an amendment, the request may be rejected by a ruling without giving the defendant an opportunity to submit a written answer.

In China, if the request does not comply with the requirements of Article 10 of the measures for Patent Administrative Law Enforcement, the patent administrative department shall notify the petitioner of this fact within 5 working days from the date of receiving the petition, and explain the reason.

7. Proceeding of examination

7.1. Board for examination

In Korea and Japan, a case is examined by 3 administrative judges basically, or 5 administrative judges specially. In China, the examination is performed by the panel of 3 or more singular law enforcement officers.

7.2. Examination method

In the three countries, Trial shall be conducted by a documentary examination or oral hearing, in common. A party concerned can request for an oral hearing, or if it is recognized that an oral hearing is required, an oral hearing can be held.

7.3. Oral hearing

7.3.1. General

Oral hearing will be held ex officio or upon the parties' request. All of the panel members should participate in oral hearing, in principle; and if an oral hearing is decided to be held, it should be notified to the parties of the date and place before 3 weeks in Korea, 3 working days in China, and 2 weeks in Japan, from the date for the oral hearing.

7.3.2. Location

Oral hearing is held at the trial office located in each Patent Office or administrative agency. In Korea and China, a video oral hearing with remote parties is possible.

7.3.3. Proceeding of oral hearing

In Japan and Korea, if the both parties are absent from the oral hearing, the oral hearing is cancelled. However, if one party is absent, the oral hearing is held; however, unlike a civil action, cognovits (recognition and acceptance) are not acknowledged. In China, if the petitioner is not present at the oral hearing without any justifiable reasons or leaves during the oral hearing, the request is considered to be withdrawn, and if the only defendant is absent, the oral hearing shall be held.

In the three countries, if the oral hearing is held, the record of the oral hearing shall be prepared. In Korea and Japan, a trial clerk prepares the record, and in China, one of the panel members prepares it. The record of the oral hearing should include the issues of the oral hearing, and the information on the participants. In Korea and Japan, the record is signed and sealed by the chief administrative judge and the trial clerk, and in China, the report is signed and sealed by the trial examiner and the attendees.

In the three countries, in the oral hearing, its own language should be used.

7.4. Suspension of procedure

In Korea, the procedure may be suspended at its authority or upon parties' request until a relevant trial or suit is completed.

In China, when the defendant requests invalidation of the patent right and his request is accepted by the Patent Reexamination Board, he may request the

administrative authority for patent affairs concerned to suspend the handling of the matter. In addition, in the case where parties claim a request for reconciliation and mediation, the parties can request for the suspension of the relevant procedure of PRB with regard to the patent right.

In the case of Japan, there is no provision for the suspension of Hantei procedure in relation to other trial or litigation.

7.5. Scope of examination

7.5.1. Limit of examination

In Korea and Japan, an ex officio examination can be made for the reasons that the petitioner or participant does not argue. However, an examination may not be made on the purport which is not requested by the petitioner.

In China, an investigation and collection of evidence is possible at its official authority, if necessary; and in this case, parties or relevant persons should faithfully cooperate on the investigation and collection.

7.5.2. In the case where the defendant does not dispute

In the Korean defensive trial, if the defendant does not dispute obviously, the trial shall be dismissed.

In Japan, it is considered that cognovits (recognition and acceptance) are not allowed, and when the defendant does not dispute, Hantei may be proceeded.

In China, there is a system for mediation during the procedure of trial of infringement dispute. In the case where the parties reach an agreement upon medication, the patent administrative department shall prepare a mediation agreement and affix to it its official seal, and the signature or seal of both parties concerned.

7.5.3. Confession

Even if there is confession during the examination process, in consideration of public benefits of a patent, the specific facts are confirmed at its official authority, and confession is not reflected in the confirmation of the facts at it is.

8. Protection scope

8.1. The principle of claim interpretation

In the three countries, it is defined that “the protective scope of a patented invention shall be determined on the basis of the claims,” as the standard for interpreting the claims when determining the protective scope. In general, if an invention in question does not include some of the features of the claims, the invention in question does not fall within the scope of the patent right.

8.2. Doctrine of equivalents

In the three countries, the scope of protection may be extended by the doctrine of equivalents.

In Korea, as for the equivalent scope, the contents made by the precedents (1. the identity of the principle for achieving the task, 2 the possibility of substitution, 3. easiness of substitution, 4 the invention in question is not a known technology, 5. principle of wrapper estoppel) are applied. The invention in question is within the scope of patent provided that: if some elements of patented invention are replaced with new elements, the new elements perform substantially the same function as the elements of patented invention with substantially same manner, a person skilled in the art could easily figure out such replacement at the time of manufacturing invention in question but such invention in question was not publicly known at the time of filing the patent application.

In China, Article 18 of the measures for Patent Administrative Law Enforcement defines the equivalent properties: 1. the same means, 2. the same function, 3. the same effect, 4. a skilled person in the art can make up without creative effort. The equivalent features refer to the features which a person skilled in the art could easily think of without any creative work and the use of similar means could bring about similar functions or achieve similar effects as the technological features described in the claims

In Japan, even if there exists some part in the invention in question that is different from patent claim, the invention in question may be within the scope of patent provided: (1) The different part is not an essential part of the patented invention; (2) The invention in question may achieve the purpose of the patented invention and has identical function and effect even if the different part is replaced; (3) A person skilled in the art could have easily arrived at an idea to replace the above mentioned different part at the time of manufacturing the invention in question; (4) The invention in question, etc. is neither identical with publicly known prior art nor one that could have easily conceivable by a person skilled in the art at the time of filing the patent application; (5) There are no special circumstances for the invention in question, to be deliberately removed from the scope of the claims in examination procedures of the patented invention.

9. Burden of the cost

In Korea, a party who loses the trial bears the trial cost, and the burden of the cost is determined at its official authority. In Japan, the petitioner bears the trial cost(request fee), and in China, there is no official cost.

10. Termination of procedure

10.1. Summary

In the three countries, in general, the procedure is terminated by issuance of a trial decision or by ruling. Or, the procedure is terminated by withdrawal, or dismissal of the request because of the formality deficiency. In China, the procedure may also be terminated by a reconciliation and mediation.

In Korea, if the trial is terminated by issuance of a trial decision, a Notice of Scheduled Closing Date of Trial is issued and then a trial decision is issued within 20 days from the issuance date of the Notice. In Japan and China, a Notice of Scheduled Closing Date of Trial is not separately issued before a decision is rendered.

In China, the infringement dispute procedure should be terminated within three months from the date of filing the trial, and the due date can be extended up to one month upon the approval of the commissioner of the patent administrative management part. The period for publication, analysis, suspension, etc. is not included in the processing period to due date.

10.2. Trial decision

In a Korean trial decision, an indication of the department of the patent tribunal, trial number, case indication, the names and addresses of the party and the agent, decision date, holding, purport of request, and reason should be indicated, and at the end of the trial decision, administrative patent judges who made the decision are indicated with signs and seals.

In a Japanese decision, case number, names or addresses of the party and the agent, decision date, case indication, conclusion and reason should be indicated, and all of administrative patent judges who made the decision are indicated with signs and seals.

In a Chinese decision, the name and address of both parties, the facts and reasons argued by the party, the grounds and evidence for determining the infringement action, whether it constitutes or does not constitute an infringement, types, subject and range of the infringement action for which an order to stop the infringement is required immediately if it is determined that it constitutes an infringement, and guidelines and time limit for filing an appeal against the decision are indicated,

and the end of the decision is executed with the seal of the patent administrative management part.

10.3. Order of the trial decision (decision)

In Korea, the order of decision of the affirmative trial is different from that of the defensive trial. If the request is accepted, in the case of the affirmative trial, it is described that "the invention in question falls within the technical scope of Patent No. 000,'; and in the case of the defensive trial, it is described that "the invention in question does not fall within the technical scope of Patent No. 000." If the request is rejected, it is described that "the request is rejected." If the deficiency in a petition cannot be overcome, it is described that "the request is dismissed." The determination is made for each claim, and it is described in order of partial acceptance, partial rejection, and partial dismissal.

In the Chinese decision, it is described that 'the item in question constitutes an infringement or does not constitute an infringement,' and if the item in question constitutes an infringement, an order to stop the infringement action is issued, and if the item in question does not constitute an infringement, a decision rejecting the request is rendered.

In Japan, it is described in Conclusion that "the invention in question falls(does not fall) within the technical scope of Patent No. 000." If the deficiency in request cannot be overcome, it is described that "the request is dismissed."

10.4. Effect of decision

In Korea, if a trial decision is made final and conclusive, the principle of the prohibition against double jeopardy is applied. By comparison, in Japan, Hantei result is just the Patent Office's advisory opinion, so this does not carry legal binding force. In China, an order to immediately stop the infringement can be exerted, and if the infringement action is not stopped, a compulsory execution can be requested to the People's Court.

10.5. Filing an appeal against the decision

In Korea and China, an appeal against the result of the administrative procedure can be filed with the court. By comparison, in Japan, since Hantei result is just the Patent Office's advisory opinion, an appeal cannot be filed with the court.

In Korea, an appeal against trial decision or dismissal of the request can be filed with the Patent Court within 30 days from the receipt date of the certified copy of the decision, and against a decision of the Patent Court, an appeal can be filed with the Supreme Court within 14 days from the receipt date of the decision. For the time limit for filing an appeal with the Patent Court, if a party request for additional time, the chief trial examiner can give additional 20 days for the residents

of Korea and up to 30 day for the non-residents.

In China, in the case of filing an appeal against the order to stop the infringement, an administrative suit can be filed with the People's court within 15 days from the receipt date of the decision.

10.6. Withdrawal

In the three countries, it is the same in that the petitioner may withdraw the request and then the procedure ends. In Korea and China, the request can be withdrawn until a trial decision or decision is made final and conclusive; by comparison, in Japan, the request may be withdrawn until a decision is transferred to the defendant. Meanwhile, in Korea, after the defendant's written answer is submitted, the request may be withdrawn only with the defendant's consent; by comparison, in Japan, the request may be withdrawn without the defendant's consent.

11. Accelerated procedure

In the three countries, the examination is made in the order of the filing dates of trials, in principle. However, in Korea and Japan, the examination order can be changed in consideration of urgency of the case. In Korea, a 3 track system is operated: general, accelerated, and super accelerated trials. As for cases for which the super accelerated trials is conducted, for example, where the infringement suit is pending at the same time, where it is charged by a police or prosecution, a case for small business, etc., the examination is made fast as compared to general or accelerated cases. In Japan, in consideration of relevant cases such as infringement suits, correction trials, etc., the examination order can be changed in practice.

12. Others(Communication with other organizations)

The Korean trial to confirm the scope of patent is performed by the IPTAB of the Korean Intellectual Property Office; the Japanese Hantei is performed by the Trial and Appeal Department of the Japan Patent Office; and the Chinese trial of patent infringement dispute is performed by a Local IP office, not PRB.

In the case of Korea, once an infringement suit is filed with the Court, the Court notifies the IPTAB of the infringement suit, and when a relevant trial is filed with the IPTAB, it notifies the Court of this fact. There is no procedure that the Court requests the IPTAB for the official opinion.

In the case of Japan, once an infringement suit is filed with the Court, the fact of the infringement suit is notified to the Patent Office, and when a relevant trial is

filed with the Patent Office, it notifies the Court of this fact. In the case where there is an infringement suit, the Court may request the Patent Office for an official opinion (Kantei : Expert testimony for court).

In the case of China, at Local IP Office or Local District Courts' request，PRB can offer advisory opinions about patent infringement disputes as references only.

IV. Overview of the systems in Each Country

1. Trial to Confirm Scope of Patent Right in Korea

1.1. Significance

The protective scope of a patent is determined by the terms of a claim. However, because it is difficult to specify the definite scope of the right, a dispute about it between the patentee and a third party may arise. In such case, the decision by experts is necessary. The Korean Patent Act operates the Trial to Confirm Scope of Patent Right system for confirming the scope of protection of a patented invention.

The purpose of the trial to confirm scope of patent right is to resolve a dispute in early stages before taking a complicated procedure of a lawsuit, by confirming the specific scope of protection of patent, through the government organization with authority.

The trial to confirm scope of patent right is not a trial for the patent right defined only in the Korean Patent Act, and Article 33 of the Utility Model Act, Article 122 of the Design Protection Act and Article 121 of the Trademark Act also provide the trial to confirm scope of patent right.

1.2. Classification

1.2.1. Affirmative trial

The affirmative trial is that a patentee or an exclusive licensee requests a trial decision that an invention in question belongs to the scope of his/her own patent. An invention in question shall be an invention which is currently being worked or had been worked in the past by a third party.

1.2.2. Defensive trial

The defensive trial is that a third party requests a trial decision that an invention in question does not belong to the scope of a patent. An invention in question

includes not only an invention which is currently being worked but also an invention which will be worked in the future. However, the trial is not allowed to confirm scope of patent right which is requested against a method or product which has no possibility of being worked in future by the petitioner.

1.3. Request

1.3.1. Parties

In affirmative trial, a petitioner is the patentee or an exclusive licensee, and a defendant is a person who had worked the invention in question in the past or is currently working the invention.

In defensive trial, and a defendant is the patentee, and a petitioner is a person who had worked or is currently working the invention in question, or an interested person who has a plan to work the invention in question even if he or she is not currently working the invention.

1.3.2. Time period for request

The Korean Patent Act provides no specific provision for the time period for requesting the trial to confirm scope of patent right. However, the Supreme Court′s precedent has held that the trial to confirm scope of right must be requested only during the term of the patent right because there is no merit of trial after the patent right has been expired.

Accordingly, the trial to confirm scope of right cannot be requested after expiration of the patent right. Even if the trial is requested during the term of patent right, where the right is expired while the trial is pending, the request shall be dismissed by a trial decision.

1.3.3. The range of the request

When there are two or more claims, the trial to confirm scope of right can be requested for each of the claims.

1.3.4. Petition for trial

A person who would like to request the trial to confirm scope of patent right should submit a petition for the trial, including the matters prescribed in the subparagraph of Article 140(1) of the Korean Patent Act, to the Intellectual Property Trial and Appeal Board; herein, the explanation and drawings of the invention in question that can be compared with the patented invention should be attached.

When a trial has been requested, the presiding administrative patent judge shall serve a copy of the written request on the defendant and shall provide him/her an opportunity to submit a written response within a designated deadline.

Since the invention in question is a part of the purport of the request, the change of the invention in question is considered as the change of the gist of the purport of the demand and thus is not allowed in principle.

1.4. Examination

1.4.1. Panel of trial judges

Administrative patent judges constituting the panel of judges of a trial case are designated by the president of the Intellectual Property Trial and Appeal Board. The panel of judges consists of three or five administrative patent judges, and majority rule is applied among the panel of judges when rendering a trial decision.

A patent judge who has a personal relationship with the petitioner or a defendant is excluded from examination in order to maintain the fairness of the trial, which. is referred to as exclusion or recusation of trial examiners.

Exclusion means being naturally excluded from examination under the Law due to a certain cause; and recusation means that a patent judge is excluded by a decision of separate trial when the party, etc. requests for exclusion of the patent judge due to the fairness problem. Avoidance is a system where a patent judge requests not to examine a trial case for fairness of the trial..

1.4.2. Examination

The purpose of the examination of the trial to confirm scope of right is to determine whether an invention in question belongs to the protective scope of a patent,

based on the factual issues.

The procedure of the examination of the trial is as follows: ①specifying the patented invention (defining the technical scope), and then ②specifying the invention in question, and ③Comparing the patented invention with the invention in question in consideration of All Elements Rule and Doctrine of Equivalent, and then ④ determining whether the invention in question belongs to the protective scope of the patent.

(1) Specifying the patented invention

The scope of the patent right is determined on the basis of the terms of claims of the patent, and in case where the terms described in the claims are not clear, the description and drawings of the invention can be considered.

Meanwhile, as for an invention which is described only in the description of the invention but is not described in the claims, a third party can freely work this invention because this invention does not belong to the scope of the patent right.

(2) Specifying the invention in question

The invention in question should be interpreted on the basis of the contents of the explanation, and it is not allowed to interpret contents of the explanation in a different manner, based on the drawings. The drawings only serve as supplementary role. Thus, if the contents of the explanation of the invention in question and the drawings are not consistent with each other, the invention in question should be interpreted based on the explanation, not the drawings.

The invention in question should be specified to the extent that it can be compared with the patented invention.

(3) Comparing the patented invention and the invention in question

The scope of protection of the patent right is determined on the basis of the terms of the claims, and the scope of protection may be extended by the doctrine of equivalents.

If the invention in question lacks any element of the patented invention, it is determined that the invention in question does not belong to the scope of the patented invention; however, even if the invention in question formally seems to lack an element of the patented invention, if the invention in question has an element that

performs substantially the same function as the absent element, it should be determined whether the two inventions are equivalent.

1.5. Trial decision

1.5.1. Method for making a trial decision

In a trial decision, it is determined whether the purport of the request is reasonable or not.

In an affirmative trial, in case where the invention in question falls within the protective scope of a patent, a trial decision holding that ″the invention in question belongs to the scope of patent #__″ should be rendered. In the opposite case, a trial decision holding that ″This request is hereby rejected″ should be rendered.

Meanwhile, in a defensive trial, in case where the invention in question does not belong to the scope of a patented invention, a trial decision holding that ″the invention in question does not belong to the scope of patent #__.″ should be rendered. In the opposite case, a trial decision holding that″ This request is hereby rejected.″ should be rendered.

In case where there are a plurality of claims, the specific claims should be indicated.

A trial decision holding that the invention in question does not belong to *all claims* of the patent, despite that the petitioner seeks a decision for *only one of the claims*, is in violation of the doctrine of disposition right and thus this decision is unlawful.

In case where the petition for the trial or the procedure in the trial case does not satisfy the formal requirements, the presiding administrative patent judge shall make a decision dismissing the petition by ruling. Herein, the presiding administrative patent judge should order an amendment, designating the time limit. Article 141(1)(i) of the Korean Patent Act is the provision for the case where the petition for the trial does not satisfy the formal requirements.

In case of an unlawful request for trial which cannot be overcome even by an amendment, the panel of judges can make a decision dismissing the petition by ruling, without giving the defendant an opportunity to submit a written response.

1.5.2. Effect of the decision

If the decision of a trial to confirm scope of patent right is made final and conclusive, the scope of the patented invention is confirmed in connection with the invention in question. However, the decision is just a judge of the Administration, therefore this decision itself cannot be deemed that an infringement by a counterparty has been authoritatively confirmed, and the infringement of the patent right is finally determined in a patent infringement litigation, by a civil court.

Meanwhile, in the trial to confirm scope of patent right, if the claims of the patented invention and the invention in question are the same and relevant evidence are the same, the prohibition against double jeopardy is applied even if the types of the trial to confirm scope of patent right are different such as an affirmative trial and a defensive trial.

As such, the decision rendered in the trial to confirm scope of patent right carries no legal binding force in an infringement litigation, although the effect of the prohibition against double jeopardy is acknowledged in Article 163 of the Korean Patent Act.

2. Trial of Patent Infringement Dispute in China

2.1. The characteristic of the patent protection system in China

Regarding an infringement of the patent right, Article 60 of the Chinese Patent Law provides two relief methods: legal relief and administrative relief. That is, when an infringement of the patent right occurs, a patentee or an interested person may request a lawsuit with the People′s court, or request for the administrative authority for patent affairs to handle the matter. Utilizing the two protection systems, administrative protection and legal protection, together for the patent right is the characteristic of the patent protection system in China.

The administrative management system, trial of the patent infringement dispute, provides an effective solution method on the sharp increase of the number of patent infringement dispute cases in China because the treatment period is short and the cost is inexpensive as compared to the legal relief system. However, in case where the party does not accept the trial result of the State Intellectual Property Office, the party can request an administrative lawsuit with the People′s court.

That is, the trial of the patent infringement dispute is not the final relief method of the patent infringement.

In addition, in case where a party requests for trial of patent infringement dispute, if the party has already requested a lawsuit on the same infringement fact with the People′s court, the request for the trial is not accepted pursuant to Article 13 of the Chinese Patent Administrative Law.

2.2. Legal property

The trial of patent infringement dispute is to resolve a patent infringement dispute case by the administrative organization, and thus is the specific administrative action of the administrative organization. Therefore, according to Article 60 of the Chinese Patent Law, when the administrative authority for patent affairs acknowledges the infringement of the patent right, it may order to stop the infringement act. If the infringer is not satisfied with the order, he may request a lawsuit with the People′s court. Meanwhile, in case where the party does not request a lawsuit within the time limit and does not stop the infringement act, the said authority can request for compulsory execution with the People′s court.

2.3. Jurisdiction

The State Intellectual Property Office(SIPO) is responsible for the management and supervision of the tasks within China according to the Measures for Patent Administrative Law Enforcement, and in the case of a patent case which influences greatly, the Office can organize the relevant patent administrative department to treat the case, if necessary, and for a case involving two or more provinces, autonomous regions and municipalities under the Central government, it can handle the case in cooperation with the Local Intellectual Property Offices.

The Local Intellectual Property Offices of provinces and autonomous regions are responsible for the guidance, management and supervision of the tasks according to the Patent Administrative Law within the administrative districts, and are responsible for the management of a case which is serious, complicated and influences greatly within the administrative districts, and in the case of a serious patent case among cities, it can handle in cooperation with the Local Intellectual Property Office of the cities.

The Local Intellectual Property Office of cities is responsible for patent cases within the administrative district.

2.4. Parties

According to Article 10 of Measures for the Patent Administrative Law Enforcement, in case of requesting for administrative management to handle a patent infringement dispute, the specific interest of the petitioner is required.

That is, the petitioner should be a patent holder or an interested party, and the interested party includes the licensees of patent license contracts, and lawful inheritor of patent holder. Of the licensees of patent license contracts, the licensee of a sole license contract may separately file a petition; the licensee of an exclusive license may separately file a petition provided that the patent holder does not file any petition; no licensee of an ordinary license contract may separately file a petition unless it is otherwise stipulated in the contract. If the petitioner is not a patent holder or an interested person, the Local Intellectual Property Office does not accept the petition according to Article 13 of the same Method.

In case of requesting for a trial, the petitioner should submit a petition, a certificate of the legal status of the petitioner and a certificate of the patent. The certificate of the legal status of the petitioner includes, the resident identity certificate or any other valid identity certificate of the petitioner who is an individual, or a duplicate of the valid business license or any other certification document which can certify the legal status of the petitioner if it is an entity as well as the identity certificate of the legal representative or major person-in-charge of the petitioner; and the certificate of the patent right includes a duplicate of the patent register book, or the patent certificate and the receipt of payment for the annual patent fee for the current year.

Regarding the defendant of a patent infringement dispute, Article 10 of the Measure for Patent Administrative Law Enforcement stipulates that there should be a definite party against the petition. Accordingly, in case where a defendant is not clear or is not indicated, the Local Intellectual Property Office may not accept the demand pursuant to Article 13 of the same measure.

2.5. Requesting

In case of requesting for a trial, the petitioner should submit a petition, a certificate of the legal status of the petitioner and a certificate of the patent. And the petitioner should submit copies of the petition and relevant evidence according to the number of the defendants.

According to Article 12 of Measures for Patent Administrative Law Enforcement, in the petition, the name or title and address of the petitioner, the name and duty of legal representative or major person in charge, and in case where an agent exists, the name of the agent, and the name and address of the agent organization

should be indicated, the name or title and address of the defendant should be indicated, and the matter for which the demand is requested and the fact and reasons should be indicated.

The petition should be signed or sealed by the petitioner. According to Article 14 of the same Measures, the Intellectual Property Office should transfer the petition to the defendant within 5 working days from the date of receipt of the petition, and demand the defendant to submit a written answer within 15 days from the date of receipt of the petition. However, even in case where the defendant does not submit a written answer within the time limit, this gives no influence on the administrative process of the Local Intellectual Property Office.

The Local Intellectual Property Office should transfer the written answer to the petitioner within 5 working days from the date of receipt of the defendant′s written answer.

Article 19 of the same Measures stipulates that the Local Intellectual Property Office shall prepare a decision on the patent infringement dispute, except for cases where the parties make an agreement or the petitioner withdraws the petition. The administrative process is closed by the preparation of the decision by the Intellectual Property Office.

2.6. Examination

2.6.1. Panel of examination

According to Article 13 of the Patent Administrative Law, in case where a petition satisfies the requirements, the Local Intellectual Property Office should notify the petitioner about the acceptance of the case within 5 working days from the date of receipt of the petition, and in the meantime, the Office should organize the panel of examination consisting of 3 or more(odd numbers) persons to handle the patent infringement dispute.

2.6.2. Examination method

Regarding the examination method, a documentary examination is performed, in principle; however, according to Article 16 of the Measures for Patent Administrative Law Enforcement, the Intellectual Property Office may determine whether an oral examination is performed depending on the prosecution history of a case when handling the patent infringement dispute, and in case where the Intellectual Property Office determines to perform an oral examination, the Office

should notify the parties of time and place no later than 3 working days prior to oral trial.

In case where the party refuses to appear without any justifiable reason or leave out during the oral examination without permission, the petitioner is deemed to withdraw the demand, and the defendant is deemed to be absent. Thus, the Intellectual Property Office can perform an oral examination ex officio.

In addition, Section 2.3.1.1 of the Operation Method of the Patent Administration Law provides that ″the patent management division (Intellectual Property Office) can determine whether an oral examination is performed depending on the prosecution history of a case when handling the patent infringement dispute, and shall designate the head and the members of the panel of judges.″ From this, it can be understood that in the case of the oral examination, all of the panels should participate.

2.7. Legal effect

The trial of the patent infringement dispute by the Local Intellectual Property Office is the specific administrative action of the administrative organization. Thus, the decision of trial has a legal binding force. In case where the party is not satisfied with the decision of trial, the party may institute an administrative lawsuit in the people court, and if the party does not follow the decision of trial, the Local Intellectual Property Office may request for compulsory execution with the People′s court.

In addition, Article 20 of the Patent Administration Law stipulates that ″After the patent administrative department or the people's court makes a decision of handling or judgment which determines the establishment of infringement and orders the infringer to stop the infringement promptly, the party against whom the petition is filed commits the same type of infringement upon the same patent, if the patent holder or the interested party petitions the case to be handled, the patent administrative department may directly make a decision of handling, which orders prompt stop of the infringement″ In light of the above, the principle of the prohibition against double jeopardy is applied.

3. Hantei (Advisory Opinion on the Technical Scope of a Patented Invention) in Japan

3.1. Concept and characteristic of the Hantei system

The Hantei system in Japan refers to a system where the Japanese Patent Office (JPO) renders an advisory opinion regarding the technical scope of the patented invention upon a party′s request.

In case where a dispute on the technical scope of the patent right occurs between a patentee and a counterparty, this will be eventually handled through a lawsuit. However, a system, where the organization who has specialized knowledge presents their opinion on whether a product or method falls within the technical scope of a patented invention on a neutral position, could be helpful in resolving the dispute. That is, the Hantei system allows to obtain an advisory opinion on the technical scope of the patented invention from the Japanese Patent Office, who granted the patent rights. This system has been established after the trial to confirm scope of patent right system of the old Japanese Patent Law.

Hantei result is an advisory opinion on factual issues which is the premise of the determination of infringement and does not necessarily lead to the settlement of the dispute. However, the characteristic of this system lies in that the opinion of the administrative office, which provides a clue for resolving the dispute, can be obtained through the inexpensive and simple procedure compared to litigation.

Such Hantei system has the following advantages: By administrative judges of the Trial and Appeal Department of the Japan Patent Office, ① opinion from a neutral and fair position, ② quick conclusion (three months at the shortest), ③ inexpensive cost (official fee of 40,000 Yen per case for requesting), ④ simple procedure, ⑤ a kind of administrative services (no legal binding), and ⑥ opinion which is substantially and sufficiently respectful and authoritative.

3.2. Types of system utilization

When an infringement occurs, the Hantei result can be utilized as ① a material when warning the infringement act to an opponent, ② a material for an argument

when receiving a warning, ③ a material for insisting an infringement or non-infringement in an infringement suit, ④ a material attached to a request for prohibiting import of an infringing product, ⑤ a material based on which a suit is requested with the police, etc.

In actual lawsuits such as infringement suit, the Hantei result can be utilized as ① evidence on infringement, ② evidence on equivalents, ③ evidence in an action for declaratory judgment for the non-applicability of a patent right for requesting the prohibition and for requesting compensation of damages.

Other than the above, ① in the case of applying a provisional disposition, the Hantei result can be a ground for having an opportunity to present an argument to the court; and ② when its own goods are indicated with patent number in order to prevent counterfeit of the goods′ shape, the Hantei result can be utilized for identifying that his/her own goods actually fall within the technical scope of the patent right he/she obtained.

3.3. Parties and the period for requesting

3.3.1. Demandant

Anyone who has a doubt on the scope of a patented invention can request for Hantei with the Japanese Patent Office. Since the general principles, such as the benefit of a petition, of the Civil Act are not applied in the Hantei, a person who requests for Hantei is not required to have legal interests with the result of Hantei, in principle. However, in view of the purpose of the system, it is required to explain the need for Hantei in section ″Reasons for Request of Hantei.″

In case where a patent is jointly owned, it is not necessary that all the joint owners file the request for Hantei concerning their patent right. However, where the request is filed against patentees jointly owning a patent right, the defendants in the said request shall be all the joint owners of the said patent right.

3.3.2. Defendant

The request for Hantei does not essentially need an counterparty; however, in case where the counterparty is hidden even though an counterparty exists, or where a virtual counterparty is indicated to receive the Hantei result, or where the Hantei result is abused, there would be damaging effects which result in

occurring an unnecessary conflict in the business, etc. Furthermore, the Hantei result made based on the demandant′s one-sided arguments and without receiving opponent′s answer should be avoided as much as possible because this result is not made through the fair and proper procedure. Thus, as for the Hantei seeking that a product or method falls within the scope of a patented invention without indication of a defendant, if it is not clear why the defendant is not indicated, an inquiry is issued, and if a person who is the respondent exists, the person is indicated as the defendant. By comparison, in case where a third party requests for Hantei seeking that a product or action ′does not fall′ within the technical scope of a patented invention, if the defendant is not indicated, it is notified that the right holder (patentee, exclusive licensee) should be indicated as the defendant and if no response is made thereto, the holder of the right is regarded as the defendant.

The defendant can reveal in a written answer that he or she has no intention of working. Herein, the time limit for submitting a written answer, etc. is, in principle, 30 days for native residents, and 60 days for foreigners. In case where in the written answer, the defendant reveals that he or she is not working the item in question and has no intention to work it in future, the written answer is transferred to the demandant, and upon the receipt of the refutation of the demandant, the opinion is made.

3.3.3. Time limit for request

The Hantei may be requested after the establishment of the right, and may be requested even after the expiration of the right as well as during the term of the right. That is, even after the expiration of the right, it can be requested because there may be a case where an infringement which occurred during the term of the right could be handled.

However, this does not apply if 20 years have been passed from the expiration of the patent and the right for requesting for compensation of damages and a right of filing a complaint for the patent right, etc. have been expired by extinctive prescription.

3.4. Procedure for requesting

3.4.1. Submission of request and written answer

The Japanese Patent Law provides that when a Hantei is requested, the examination is made pursuant to the trial procedure (Article 71(3) of the Japan Patent Law). In case of requesting a Hantei, first, a request should be prepared and submitted to the Trial and Appeal Department of the Japanese Patent Office.

In the request for Hantei, if the request which does not satisfy the formal requirements, it would not be accepted. A person who requests for Hantei on whether a product or method falls within the technical scope of a patented invention should submit a written document describing ① the case for which the Hantei is requested, where the patent number in question is specified, ② parties, ③ purport and reasons of the demand, etc. to the commissioner of the Japanese Patent Office.

In case where the Hantei is requested, the chief administrative judge should transfer a copy of the request to the defendant and give the defendant an opportunity to submit a written answer, designating a time limit. When the written answer is accepted, the chief trials examiner should transfer a copy of the written answer to the demandant.

3.4.2. Cognovits and withdrawal

There is a case where the defendant acknowledges or admits the purport of the demand. However, the Hantei is made on the technical scope of a patented invention as factual issues based on the terms of the claims of patent, and the conclusion of the Hantei is made final and conclusive in virtue of the Japanese Patent Office, not based only on the parties′ arguments. Thus, it is considered that a cognovits (recognition and acceptance) are not allowed.

A request for Hantei may be withdrawn until the Hantei results are sent to the defendant. Unlike the other type of trial, a request for Hantei may be withdrawn without consent of the counterparty even after the written answer of the counterparty has been submitted.

3.4.3. Cost burden and appeal against the Hantei result

Regarding the procedure of the Hantei, the ′laws regarding cost of civil suit′ are not applied. To be specific, the principle of burden on a person who loses a

lawsuit is not applied, and thus even if the demand for cost burden is requested, it is not necessary to make a determination on this. Generally, the demandant bears the cost for requesting for Hantei, and the defendant bears the cost incurred at the defendant′s side.

Even if the proceedings of Hantei are concluded, the notice of closing is not issued. In addition, since the Hantei result is not an administrative disposition, an appeal against the Hantei result cannot be requested according to the ″Administrative Appeal Act″ in principle. However, if the request for Hantei is dismissed due to the deficiency of the procedure, the application of the ″Administrative Appeal Act″ and ″Administrative Cases Litigation Act″ is acknowledged.

3.5. Classification

Types of Hantei can be divided as follows, depending on whether a counterparty exist or not.

Example cases where an counterparty exists (in parties conflict)	(a) With respect to the invention which a third party actually works or worked, the patentee request for Hantei with that third party as the counterparty. (b) With respect to the invention of another patentee, the patentee may take another patentee as the counterparty. (c) Those, other than the patentee, may take the patentee as the counterparty, and request for Hantei about what you are going to work (d) About the invention which a third party actually works or worked, the exclusive licensee may request for Hantei with the third party as the counterparty. (e) Those, other than the exclusive licensee, may request for Hantei about the invention which they work or are going to work with the exclusive licensee as the counterparty.

Example cases where an counterparty does not exist	(a) The patentee may request for Hantei about the invention which he/she works or is going to work (b) The patentee may request for Hantei about the invention without knowledge of who works it. (c) Exclusive licensee may request for Hantei about the invention which he/she works or is going to work. (d) The exclusive licensee may request for Hantei about the invention without knowledge of who works it.

3.6. Proceeding

3.6.1. Panel for proceeding

The Hantei is conducted by the panel of three trial examiners designated pursuant to the provision of Article 71(2) of the Japanese Patent Law, and determination shall be made by the majority vote.

Administrative judges having a special relationship to a specific Hantei case shall not be appointed to the case for the purpose of fairness. If any impediments arise regarding an administrative judge after their appointment, the administrative judge shall be discharged and replaced by a newly appointed administrative judge, and when the administrative judge is changed, this change should be notified to the parties.

3.6.2. Proceedings method

The proceedings method includes an oral, documentary, ex officio, combination examination, etc., as trial cases. The documentary examination is performed in principle; however, the notification thereof is unnecessary. This is adopted due to the facts that it should be in accordance with written documents (drawings) due to the uniqueness in specifying the object for which the Hantei is requested, that conflicting parties may not exist, that the simplicity and quickness of the procedure are required.

In principle, Hantei shall be conducted by documentary proceedings. However, the chief administrative judge may decide to conduct Hantei by oral proceedings upon a motion by a party or ex officio. In the oral proceedings, administrative judges and the parties are obligated to use Japanese, and the administrative judges can order the parties to submit a summary of statements, and a trial clerk is obligated to prepare a record.

For the Hantei system, the ex officio principle is adopted. The chief administrative judge may examine any grounds not pleaded by a party, and change the proceeding method from documentary to oral proceedings ex officio. However, the purport of the request, which the petitioner did not request, may not be examined in the Hantei procedure

The proceedings of Hantei may be jointly conducted where one or both parties to two or more trials which are identical. When the panel determines that it is more expeditious and precise to conduct the proceedings jointly for two or more Hantei cases, the panel may jointly conduct the proceedings as long as it is not against the purpose of the Hantei system and there is no special opinion on the matter from the parties.

3.6.3. Order of trials

Trials for Hantei are examined in order of a filing date of a request, in principle. However, since a Hantei case is usually related to a trial for patent invalidation, a trial for correction, a patent infringement litigation, etc., the order of trials for Hantei may be changed, considering the related cases. A request for Hantei is often related to existing dispute about the technical scope of a patented invention or its prevention, carrying out of business, etc., and often needed to be resolved as soon as possible.

3.7. Legal effect

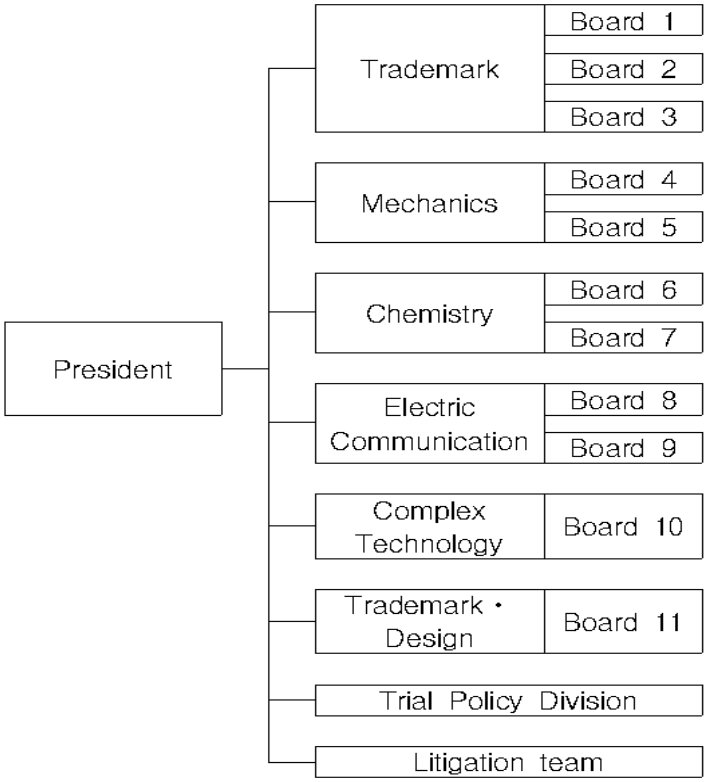
The Hantei procedure is finalized with the service of a certified copy of the Hantei results to each party, withdrawal of the request for Hantei, or the service of a certified copy of the decision to dismiss the request. Since Hantei result is an official opinion of the JPO regarding the technical scope of a patented invention, it is equivalent to an expert advisory opinion. Since the Hantei results have no binding legal effects on defendants or third parties, they constitute neither an official procedure of an administrative office nor an exercise of public authority in Administrative Appeal Act. Therefore, appeal to Hantei results under this Act shall not be possible.

V. Appendices

1. Organization

1.1. Korea

The Intellectual Property Trial and Appeal Board (IPTAB) is an affiliated organization of the Korean Intellectual Property Office (KIPO) and consists of 11 Boards, one division (a Trial Policy Division), and one team (a Litigation Team). The President of the IPTAB is responsible for all operations related to the IPTAB, and commands and supervises affiliated public officials, and each trial board consists of one presiding administrative patent judge and about 10 administrative patent judges.



○ Trial and Appeal Boards

- Board 1~3 (Trademark) Cosmetics, detergents, musical instruments, insurance and real estate businesses, restaurant businesses, furniture, tobaccos, smoking accessories, leather and its products, clothing, shoes, hats, beverages, teas, legal service businesses, communication and broadcasting businesses, alcoholic beverages, precious metals, jewels, and watches, meat, fish, and poultry, eggs, milk, bed covers, etc.
- Board 4~5 (Mechanics) Metals, civil engineering and environment (civil engineering), residential infrastructures (architecture), home appliances (air-conditioning machineries), processing systems (machine tools), automobiles, next generation transportation, etc.
- Board 6~7 (Chemistry) Fine chemistry, polymeric fiber (polymer), pharmaceutical,

biotechnology, etc.

- Board 8~9(Electric) Electronic components, smart grids (electric power), telecommunication networks, computer systems, mobile communications, digital broadcasting, etc.
- Board 10 (Complex Technology) Precision components, residential infrastructures (other than architecture), residential life, office machineries, applied materials, semiconductors, agro-fishery food, polymeric fiber (polymer), home appliances (other than air-conditioning machineries), processing systems (other than machine tools), displays, polymeric fiber (separate operation), civil engineering and environment (environment), robot automations, smart grids (electric devices), energy, automobile convergence, IT convergence, measurement analysis, medical technology, etc.
- Board 11 (Trademark, Design) Office and sales products, transportation and conveyance machineries, electric and electronic and telecommunication mechanisms, clothes, household items, sporting goods, etc.

○ Trial Policy Division

Establishes trial formalities and trial processing plans, evaluating trial qualities, supporting trial works, establishing trial policies, etc.

○ Litigation Team

Conducts litigation over an IPTAB decision on ex parte cases.

1.2. China

○ The Patent Reexamination Board (PRB) is a subordinate unit of the State Intellectual Property Office.

○ The Director-General of the PRB is also the Commissioner of the SIPO. The Deputy Directors shall be appointed by the Commissioner from experienced technical and legal experts in the Office.

○ General Office

To formulate the budget preparation and reporting, planning and execution, making administrative rules and supervising the implementation, asset management,

equipment purchase, financial management, and the other issues assigned by leaders.

○ Party Committee (Discipline Inspection) Office

In charge of party affairs, inspection and supervision work, work of the union, youth and women, and the other issues assigned by leaders.

○ Personnel & Education Division

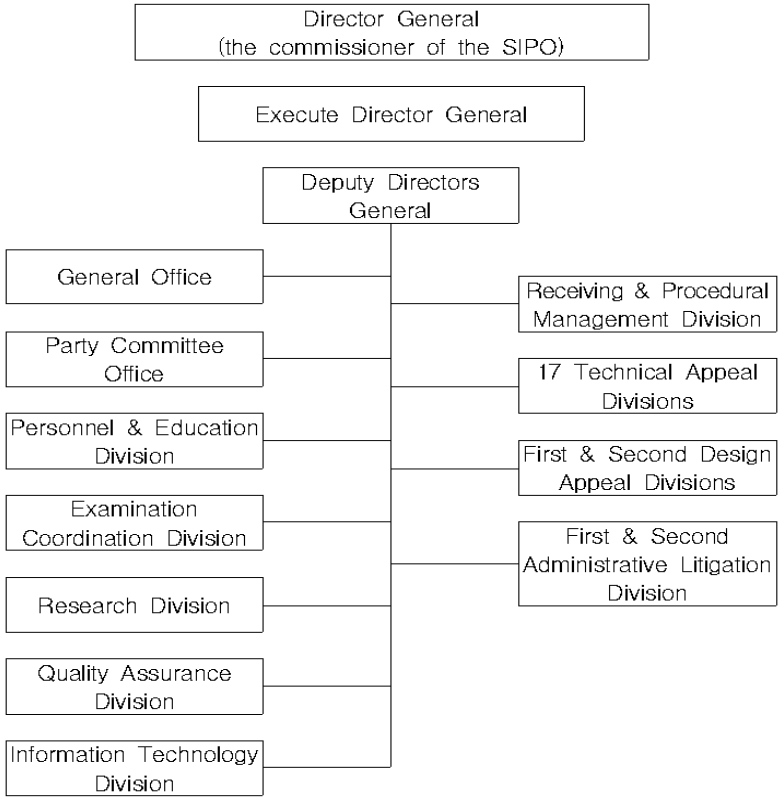
In charge of personnel recruitment, career evaluation and promotion, personnel records management, staff training, international communication, and the other issues assigned by leaders.

○ Examination Coordination Division

In charge of development and research of medium and long-term planning, formulating examination policies, examination coordination, gathering and analyzing data of cases, and the other issues assigned by leaders.

○ Research Division

To formulate examination standards, academic planning, as well as examination quality management, and undertake other work assigned by leaders.



○ Quality Assurance Division

○ Information Technology Division

To be responsible for information technology, information security, and undertake other work assigned by leaders.

○ Receiving & Procedural Management Division

In charge of register of cases of reexamination and invalidation, participating automatic system construction, and the other issues assigned by leaders.

○ 17 Technical Appeal Divisions

In charge of trial cases of request for reexamination and cases of request for invalidation of patent right in the relevant technology fields, and the other issues assigned by leaders.

○ First & Second Design Appeal Divisions

In charge of trial industrial designs cases of request for reexamination and cases of request for invalidation of patent right, and the other issues assigned by leaders.

○ First & Second Administrative Litigation Division

Appearing in court to raise defenses, if plaintiffs are not satisfied with the decisions made by the PRB, participating trial cases of request for reexamination and cases of request for invalidation of patent right in the relevant technology fields, and the other issues assigned by leaders.

1.3. Japan

○ The Trial and Appeal Department is one of the departments of the Japanese Patent Office (JPO), consisting of trial and appeal boards (38 boards), a trial and appeal division (2 offices), and a litigation affairs office (1 office).

○ There are Director-General who is in charge of the Trial and Appeal Department, Executive Chief Administrative Judge, and a number of Directors of Trial and Appeal Board who are appointed from among chief administrative judges in the department. Each board consists of a Director and a number of administrative judges

○ Trial and Appeal Boards

There is a total of 38 trial and appeal boards, which include Boards for Physics, Optics, and Social infrastructures (1st to 8th Boards), Boards for Machinery (9th to 16th Boards), Boards for Chemistry (17th to 25th boards), Boards for Electronics (26th to 33rd Boards), Board for Design (34th Board), and Boards for Trademark (35th to 38th Boards).

○ Trial and Appeal Division

Conducts Communication and arrangement tasks concerning trials oppositions and appeals on an industrial property (rights).

○ Trial and Appeal Policy Planning Office

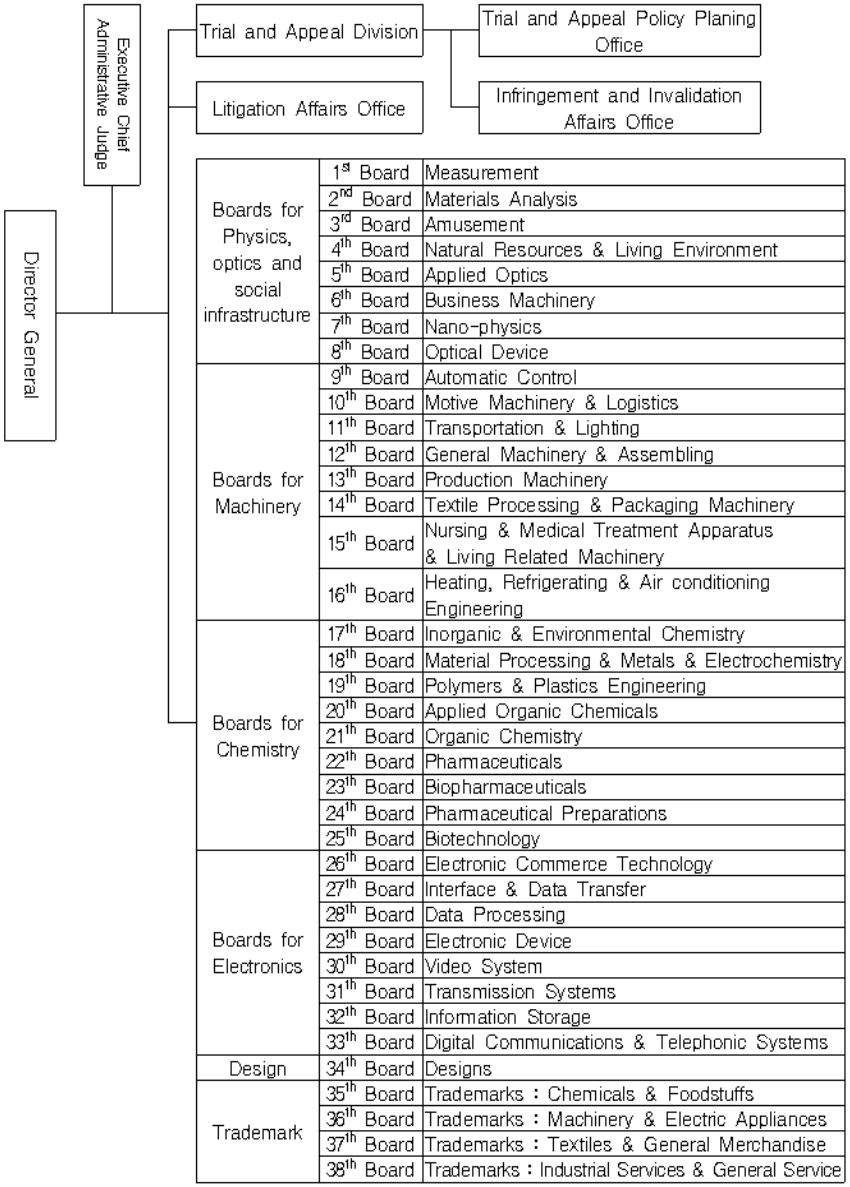
Conducts researches and plans basic matters related to operating a trial and appeal system and processing a trial.

○ Infringement and Invalidation Affairs Office

Conducts proceedings for trials for invalidation against the industrial property (rights), trials for rescission, and trials for correction.

○ Litigation Affairs Office

Conducts proceedings for litigation rescinding the trial decision.



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

2. Manpower

Korea(2016)				China(2016)		Japan(2016)			
Right	**Presiding administrative patent judge**	**Administrative patent judge**	**Total**	**Right**	**Trial examiner**	**Classification**	**Chief administrative judges**	**Administrative judges**	**Total**
Trademark・Design	4	24	26	Patent・Utility Model・Design	266	Trademark Design Patent・Utility Model	129	254	383
Patent・Utility Model	7	71	78						
Total	**11**	**95**	**106**	**Total**	**266**	**Total**	**129**	**254**	**383**

3. Statistics of Administrative systems including consideration about the scope of patent right for patent dispute resolution

3.1. Korea : Trial to Confirm Scope of IP Right

Classification			2014	2015	2016
Patent	Number of requests for trials		385	691	632
	Average length of trials examinations (months)		5.6	5.1	5.9
	Decisions	Acceptances of requests	143	339	234
		Refusals of requests	72	85	57
		Dismissals	46	75	71
		Withdrawals or abandonments	50	96	51
Utility Model	Number of requests for trials		64	53	47
	Average length of trials examinations (months)		5.6	5.6	4.3
	Decisions	Acceptances of requests	26	34	17
		Refusals of requests	15	10	9
		Dismissals	18	10	4
		Withdrawals or abandonments	6	4	15
Design	Number of requests for trials		149	138	149
	Average length of trials examinations (months)		4.1	4.2	5.0
	Decisions	Acceptances of requests	59	66	40
		Refusals of requests	33	40	32
		Dismissals	11	13	4
		Withdrawals or abandonments	28	22	21
Trademark	Number of requests for trials		90	93	101
	Average length of trials examinations (months)		4.6	4.6	4.4
	Decisions	Acceptances of requests	30	57	25
		Refusals of requests	25	24	17
		Dismissals	3	3	12
		Withdrawals or abandonments	8	5	16

3.2. China : Trial of Infringement Dispute

Classification		Local IP office		
		2013	2014	2015
Patent	Number of entertained trials	504	1010	1865
	Number of closed trials	351	988	1836
Utility Model	Number of entertained trials	1589	3461	7836
	Number of closed trials	1093	3404	7711
Design	Number of entertained trials	2591	3200	4501
	Number of closed trials	2092	3248	4493
Decisions	Decisions of requests	241	442	756
	Mediation	1774	5256	11223
	Withdrawals or abandonments	461	1942	2061

3.3. Japan : Hantei (Advisory Opinion on the Technical Scope of Patented Invention)

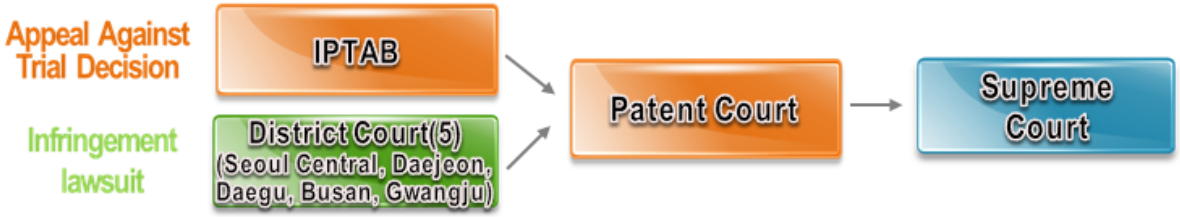
Classification			2014	2015	2016
Patent	Number of requests for trials		39	28	97
	Average length of trials examinations (months)*		4.9	4.9	3.8
	Decisions	Acceptances of requests	8	15	13
		Refusals of requests**	23	18	14
		Dismissals	-	-	-
		Withdrawals or abandonments	1	12	29
Utility Model	Number of requests for trials		1	1	0
	Average length of trials examinations (months)		-	-	-
	Decisions	Acceptances of requests	0	0	1
		Refusals of requests**	0	1	0
		Dismissals	-	-	-
		Withdrawals or abandonments	0	0	0
Design	Number of requests for trials		14	6	7
	Average length of trials examinations (months)		12.1	13.9	9.9
	Decisions	Acceptances of requests	8	4	2
		Refusals of requests**	3	8	3
		Dismissals	-	-	-
		Withdrawals or abandonments	0	3	0
Trademark	Number of requests for trials		8	2	6
	Average length of trials examinations (months)		6.5	8.0	9.0
	Decisions	Acceptances of requests	4	2	2
		Refusals of requests**	1	2	0
		Dismissals	-	-	-
		Withdrawals or abandonments	2	0	0

(* Average length of trial examinations is average length for patent and utility model cases.)

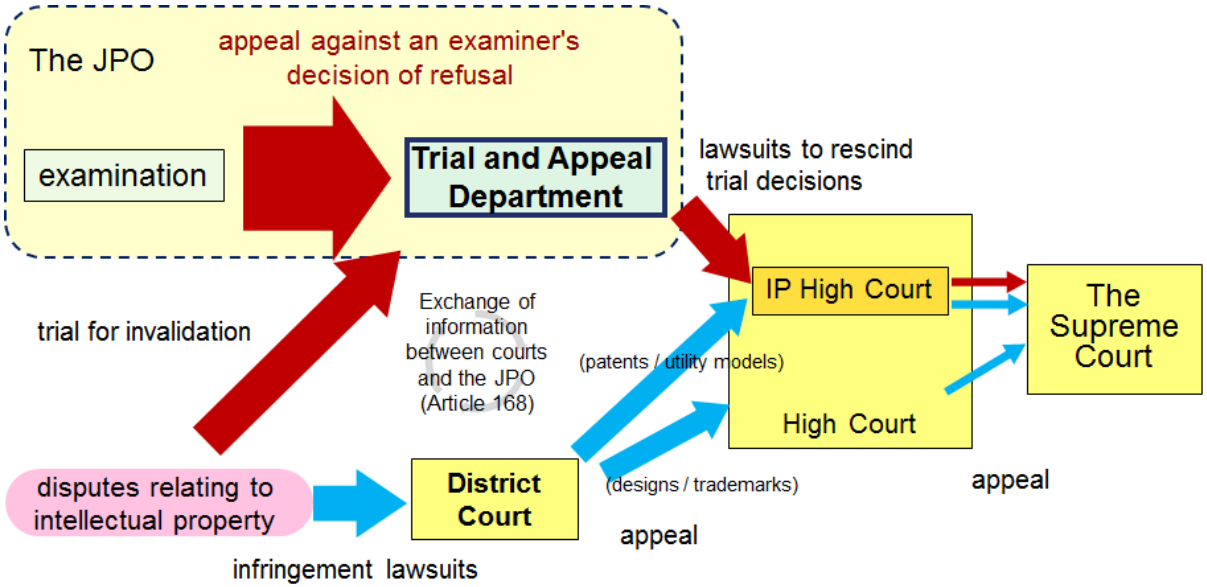
(** Numbers of refusals for patent, utility model, design and trademark include numbers of dismissal.)

4. Patent litigation System

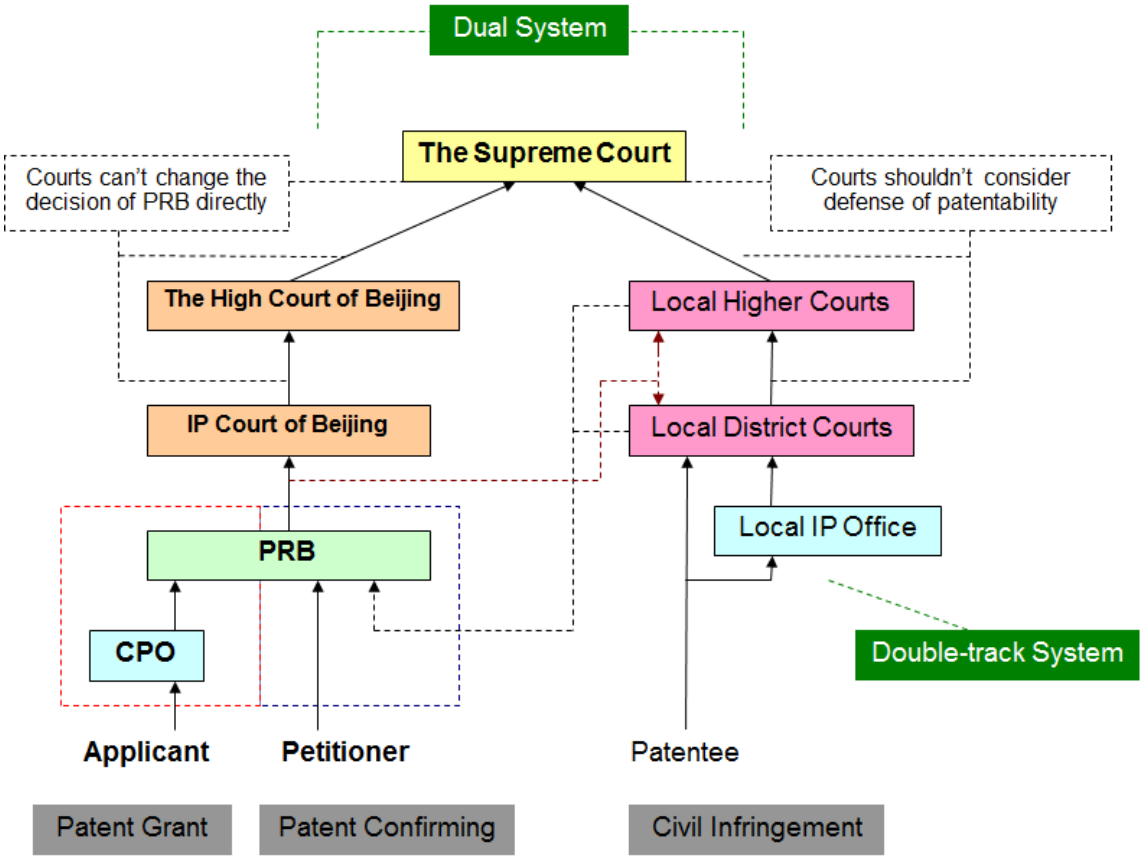
4.1. Korea



4.2. Japan



4.3. China


Dual System
The Supreme Court
Courts can't change the decision of PRB directly
Courts shouldn't consider defense of patentability
The High Court of Beijing
Local Higher Courts
IP Court of Beijing
Local District Courts
Local IP Office
PRB
CPO
Double-track System
Applicant
Petitioner
Patentee
Patent Grant
Patent Confirming
Civil Infringement