

# A Comparative Study on Appeal against Decision of Rejection

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2014



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4. Exclusion, etc. of administrative patent judge

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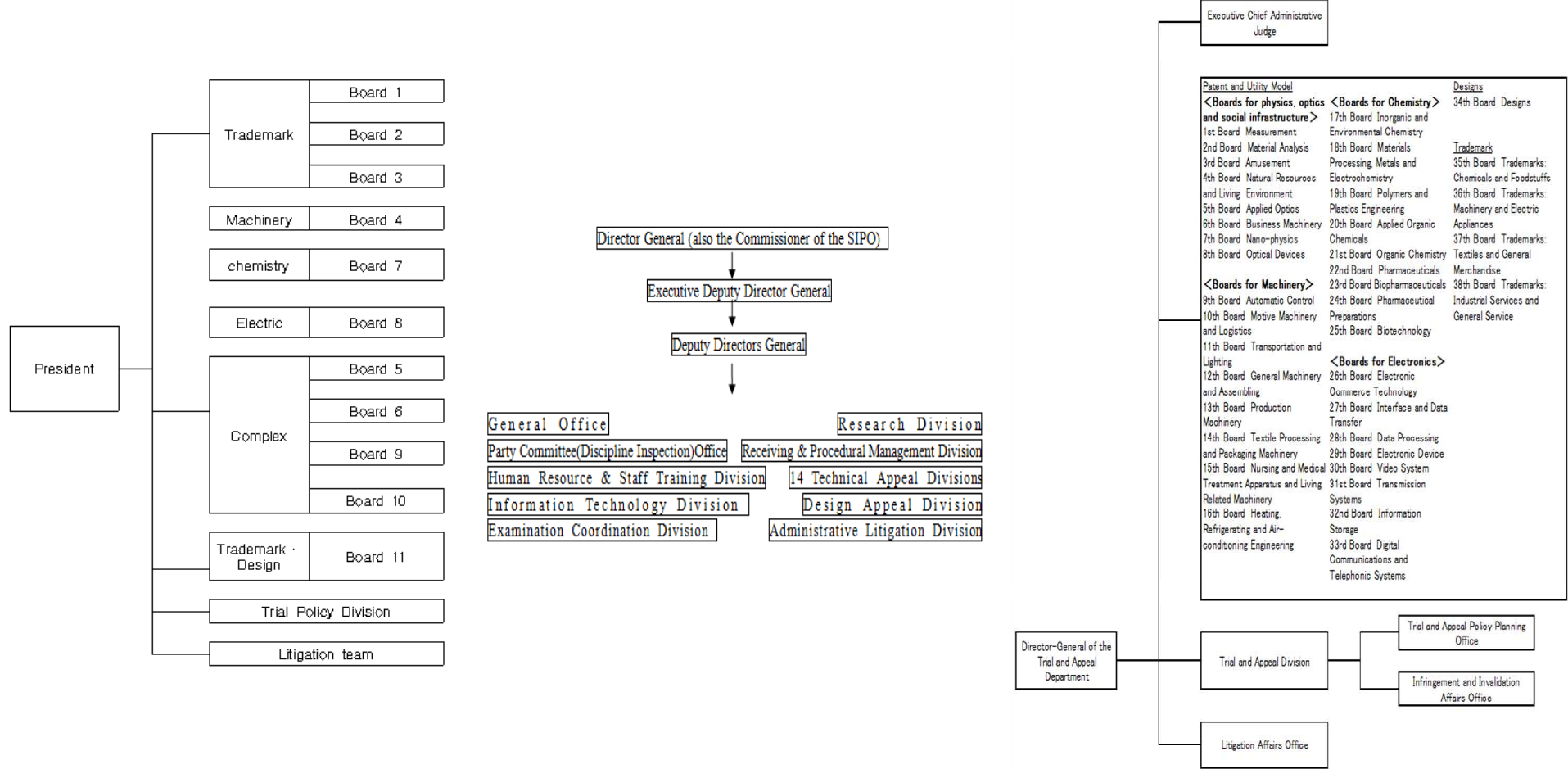
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# **Chapter I Comparison of organizations**

**1. Organization chart**



**2. Overview of organization**

**2.1. Organization**

- The Intellectual Property Trial and Appeal Board (IPTAB) is an affiliated organization of the Korean Intellectual Property Office and consists of 11 Boards, one division (a
- 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
- The Trial and Appeal Department is an affiliated organization of the Japanese Patent Office (JPO) and consists of trial and appeal boards (38 boards), a trial and appeal division (one division), and a litigation affairs

ITEM	KOREA	CHINA	JAPAN
	<p>Trial Policy Division), and one team (a Litigation Team).</p> <ul style="list-style-type: none"> <li>○ 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.</li> <li>○ Trial Boards <ul style="list-style-type: none"> <li>-Board 1(Trademark) Cosmetics, detergents, musical instruments, insurance and real estate businesses, restaurant businesses, furniture, tobaccos, smoking accessories, etc.</li> <li>-Board 2(Trademark) Leather and its products, clothing, shoes, hats, beverages, teas, legal service businesses, communication and broadcasting businesses, alcoholic beverages, etc.</li> <li>-Board 3(Trademark) Precious metals, jewels, and watches, meat, fish, and poultry, eggs, milk, bed covers, etc.</li> <li>-Board 4(Machinery) Civil engineering and environment (civil engineering), residential infrastructures (architecture), home appliances (air-conditioning machineries), processing systems (machine tools), automobiles, next generation transportation, etc.</li> <li>-Board 5(Complex Technology) Metals, precision components, residential infrastructures (other than architecture), residential life, office machineries, applied materials, semiconductors, etc.</li> <li>-Board 6(Complex Technology) Agro-fishery food, polymeric fiber (polymer), home appliances (other than air-conditioning machineries), processing systems (other than machine tools)</li> <li>-Board 7(Chemistry) Fine chemistry, polymeric fiber (polymer), pharmaceutical, biotechnology, etc.</li> <li>-Board 8(Electric) Electronic components, smart grids</li> </ul> </li> </ul>	<p>SIPO. The Deputy Directors shall be appointed by the Commissioner from experienced technical and legal experts in the Office.</p> <ul style="list-style-type: none"> <li>○ General Office <p>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.</p> </li> <li>○ Party Committee (Discipline Inspection) Office <p>In charge of party affairs, inspection and supervision work, work of the union, youth and women, and the other issues assigned by leaders.</p> </li> <li>○ Human Resource &amp; Staff Training Division <p>In charge of personnel recruitment, career evaluation and promotion, personnel records management, staff training, international communication, and the other issues assigned by leaders.</p> </li> <li>○ Examination Coordination Division <p>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.</p> </li> <li>○ Research Division <p>To formulate examination standards, academic planning, as well as examination quality management, and undertake other work assigned by leaders.</p> </li> <li>○ Information Technology Division <p>To be responsible for information technology, information security, and undertake other work assigned by leaders.</p> </li> <li>○ Receiving &amp; Procedural Management Division <p>In charge of register of cases of reexamination and invalidation, participating automatic system construction, and the other issues</p> </li> </ul>	<p>office (one office).</p> <ul style="list-style-type: none"> <li>○ The Director-General is in charge of the Trial and Appeal Department, Director of the Trial and Appeal Board is designated among chief administrative judge, and there is an executive chief administrative judge, and each board consists of one director, and a plurality of administrative judges.</li> <li>○ Trial and appeal boards <p>There are a total of 38 trial and appeal boards, which includes Boards for Physics, Optics, and Social infrastructures (1<sup>st</sup> to 8<sup>th</sup> Boards), Boards for Machinery (9<sup>th</sup> to 16<sup>th</sup> Boards), Boards for Chemistry (17<sup>th</sup> to 25<sup>th</sup> boards), Boards for Electronics (26<sup>th</sup> to 33<sup>rd</sup> Boards), Board for Design (34<sup>th</sup> board), and Boards of Trademark (35<sup>th</sup> to 38<sup>th</sup> boards).</p> </li> <li>○ Trial and Appeal Division - Conducts the following tasks: <ul style="list-style-type: none"> <li>- Communication arrangement of tasks concerning an appeal on an industrial property (rights) and an opposition to registration of a trademark;</li> <li>- Tasks concerning cases of the appeal on the industrial property (rights) and the opposition against the registration of the trademark (including a verdict request case and appraisal; the same as hereinafter);</li> <li>- A designated agent of the Commissioner of JPO on the litigation related with a cancellation of an appeal decision on the industrial property right and a cancellation decision of the trademark registration.</li> </ul> <p>(Article 324(2) of Organization Rule of the Ministry of Economy, Trade and Industry)</p> </li> <li>○ Trial and Appeal Policy Planning Office <p>Conducts researches and plans basic matters related to operating a trial and appeal system and processing an appeal (except those administered by the power of a certain institution by laws).</p> </li> <li>○ Infringement and Invalidation Affairs Office <p>Conducts proceedings for an invalidation appeal against the industrial property (rights), a cancellation appeal, and a correction appeal (including verdict request cases and appraisals) (Article 338(2) of Organization Rule of the Ministry of Economy, Trade and Industry).</p> </li> </ul>



ITEM	KOREA	CHINA	JAPAN
	<p>(electric power), telecommunication networks, computer systems, mobile communications, digital broadcasting</p> <p>-Board 9(Complex Technology) Displays, polymeric fiber (separate operation), civil engineering and environment (environment), robot automations, smart grids (electric devices), etc.</p> <p>-Board 10(Complex Technology) Energy, automobile convergence, IT convergence, measurement analysis, medical technology, etc.</p> <p>-Board 11(Trademark, Design) Office and sales products, transportation and conveyance machineries, electric and electronic and telecommunication mechanisms, clothes, household items, sporting goods, etc.</p> <p>○ Trial Policy Division</p> <p>Establishes trial formalities and trial processing plans, evaluating trial qualities, supporting trial works, establishing trial policies, etc.</p> <p>○ Litigation Team</p> <p>Conducts litigation over an IPTAB decision on ex parte cases.</p>	<p>assigned by leaders.</p> <p>○ 14 Technical Appeal Divisions</p> <p>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.</p> <p>○ Design Appeal Division</p> <p>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.</p> <p>○ Administrative Litigation Division</p> <p>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.</p>	<p>○ Litigation Affairs Office</p> <p>Conducts proceedings for litigation rescinding the appeal decision.</p>

## 2.2. Manpower

\*Based on quota; a trademark administrative judge in China is a administrative judge belonging to the Trademark Appeal Board

Korea(2013)				China(2013) *		Japan(2013)			
Right	Presiding administrative patent judge	Administrative patent judge	Total	Right	Administrative judge	Classification	Chief trial examiner	Administrative judge	Total
Trademark • Design	4	23	27	Trademark	70	Trademark	11	31	42
				Patent • Utility Model • Design	238	Design	4	7	11
Patent • Utility Model	7	65	72			Patent • Utility Model	114	220	334
<b>Total</b>	<b>11</b>	<b>88</b>	<b>99</b>	<b>Total</b>	<b>308</b>	<b>Total</b>	<b>129</b>	<b>258</b>	<b>387</b>

ITEM	KOREA	CHINA	JAPAN
<b>3. Structure of a trial and appeal department</b>			
<b>3.1. Qualification for administrative patent judges</b>			
<p>3.1.1. Presiding administrative patent judge</p>	<ul style="list-style-type: none"> <li>○ <b>Article 145 of the Korean Patent Act (KPA) (Presiding Administrative Patent Judge)</b> (1) The President of the Intellectual Property Trial and Appeal Board shall select one of the administrative patent judges designated under Article 144 (1) as the presiding administrative patent judge.</li> <li>○ <b>Article 8 of the Enforcement Decree to the Patent Act (Qualification for Examiners, etc.)</b> (3) In order to be qualified for a presiding administrative patent judge, a person shall be any of the public officials, among Grade-III or higher-ranking State public officials in general service and public officials in general service as a member of the Senior Civil Service, who work for the Korean Intellectual Property Office or any of its affiliated agencies: Provided, That in order to be qualified for the appointment to a presiding administrative patent judge designated as a position open to the private sector pursuant to Article 28-4 (1) of the State Public Officials Act, a person shall meet the requirements for performing duties under paragraph (2) of the same Article, while in order to be qualified for the appointment to a presiding administrative patent judge designated as a position publicly offered to the private sector pursuant to Article 28-5 (1) of the said Act, a person shall meet the requirements for performing duties under paragraph (2) of the same Article: <ul style="list-style-type: none"> <li>1. A person who has served as an administrative patent judge at the Intellectual Property Trial and Appeal Board for two or more years;</li> <li>2. A person who is qualified as an administrative patent judge under paragraph (2) and has worked for the Korean Intellectual Property Office or any of its affiliated agencies for not less than three years while being engaged in examinations or trials.</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>○ PRB is a subordinate unit of SIPO. The PRB is composed of the Director, Deputy Directors, principal examiners for reexamination, adjunct principal examiners for reexamination, examiners for reexamination, and adjunct examiners for reexamination.</li> <li>○ The Commissioner of the State Intellectual Property Office (SIPO) shall hold the office of the Director of the PRB concurrently.</li> <li>○ The Deputy Directors, principal examiners for reexamination and adjunct principal examiners for reexamination shall be appointed by the Commissioner from experienced technical and legal experts in the Office. The examiners for reexamination and adjunct examiners for reexamination shall be selected by the Commissioner from experienced examiners and legal staff in the Office.</li> </ul> <p>(Guidelines for Examination, Part IV, Chapter I )</p>	<ul style="list-style-type: none"> <li>○ <b>Article 138 of the Japanese Patent Act (JPA) (Chief administrative judge)</b> <ul style="list-style-type: none"> <li>(1) The Commissioner of the Patent Office shall designate one of the administrative judges designated under Article 137(1) as the chief administrative judge.</li> <li>(2) The chief administrative judge shall preside over matters relating to the appeal .</li> </ul> </li> <li>○ <b>Article 324 of Organization Rule of the Ministry of Economy, Trade and Industry</b> <ul style="list-style-type: none"> <li>(1) The Trial and Appeal Department includes appeal boards and 129 chief administrative judges.</li> <li>(3) The chief administrative judge is designated and divides the works relating to appeals on the industrial property right and opposition against the registration of the trademark.</li> </ul> </li> </ul>
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3.1.2. Administ rative patent judge	<p>(4) In order to be qualified for the President of the Intellectual Property Trial and Appeal Board, a person shall be qualified as an administrative patent judge.</p> <p>○ <b>Article 143 of the Korean Patent Act (Administrative Patent Judges)</b> (1) When a trial is requested, the President of the Intellectual Property Trial and Appeal Board shall direct administrative patent judges to hear the case.</p> <p>(2) The qualifications of administrative patent judges shall be prescribed by Presidential Decree.</p> <p>(3) Administrative patent judges shall conduct their official trial duties in an independent manner.</p> <p><b>Article 144 of the Korean Patent Act (Designation of Administrative Patent Judges)</b> (1) For each trial, the President of the Intellectual Property Trial and Appeal Board shall designate administrative patent judges constituting a collegial body for trial under Article 146.</p> <p>(2) When any administrative patent judge designated in accordance with paragraph (1) is unable to participate in the trial, the President of the Intellectual Property Trial and Appeal Board may allow another administrative patent judge to do so.</p> <p>○ <b>Article 8 of the Enforcement Decree to the Patent Act</b></p> <p>(2) In order to be qualified for an administrative patent judge, a person shall be any of the public officials, among Grade-IV or higher-ranking State public officials in general service and public officials in general service as a member of the Senior Civil Service, who work for the Korean Intellectual Property Office or any of its affiliated agencies and who have completed the specified education and training course conducted for administrative patent judges by the International Intellectual Property Training Institute:</p> <p>1. A person who has served as an examiner at the Korean Intellectual Property Office for two or more years;</p>		<p>○ <b>Article 137 of the JPA</b></p> <p>(1) The Commissioner of the Patent Office shall designate the administrative judges constituting a panel under Article 136(1) for each appeal (for an appeal that is to be examined by an examiner under Article 162, limited to the case where a report is submitted under Article 164(3)).</p> <p>(2) Where any of the administrative judges designated under the preceding paragraph is unable to participate in the appeal, the Commissioner of the Patent Office shall terminate the designation and appoint another administrative judges to fill the vacancy.</p> <p>○ <b>Article 136 of the JPA (Panel system for trial)</b></p> <p>(3) Qualifications of administrative judges shall be as provided by Cabinet Order.</p> <p>○ <b>Article 13 of the Enforcement Decree to the Patent Act (Qualification for administrative judge)</b> In order to be qualified for an administrative judge, a person shall be any of the public officials, among who are at the fourth grade or higher in the service of the Administrative Service (I) Salary Schedule or at the third grade or higher in the service of the Professional Administrative Service Salary Schedule, corresponding to any of the following paragraphs and shall have completed the specified education and training course in National Center for Industrial Property Information Center.</p> <p>1 A person who has served as an examiner at the Japanese Patent Office for five or more years;</p> <p>2 A person who has served for not less than ten years in total in affairs such as an industrial administration and has served for not less than three years within said period as an examiner in the Japanese Patent Office;</p> <p>3 A person who has served for not less than twelve years in total in affairs such as an industrial administration and is recognized to have knowledge equivalent to or more than the person prescribed in the previous Paragraph 2.</p>
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	<p>2. Deleted;</p> <p>3. A person whose has served for not less than two years in total as an examiner at the Korean Intellectual Property Office, as a Grade-V or higher-ranking State public official in general service or a public official in general service as a member of the Senior Civil Service, while being engaged directly in trials at the Intellectual Property Trial and Appeal Board, and as a technical examiner in the Patent Court.</p>		<p>○ <b>Article 326 of Organization Rule of the Ministry of Economy, Trade and Industry ( Administrative judge )</b></p> <p>(1) A board of trial has administrative judges.</p> <p>(2) The administrative judge is designated and conducts works on proceedings and decisions relating to the appeal on the industrial property right and the opposition against the registration of the trademark.</p>
	<p><b>3.2. Collegial body for appeal</b></p>		
<p>3.2.1. Composi ng of collegial body for appeal</p>	<p><b>Article 146 of the KPA (Collegial Body For Trial)</b> (1) A trial shall be conducted by a collegial body of three or five administrative patent judges.</p> <p>(2) The collegial body referred to in paragraph (1) shall make its decisions by a majority vote.</p> <p>(3) The consultations of the administrative patent judges shall not be open to the public.</p> <p>○ The President of the IPTAB is a member of the collegial body and designates administrative patent judges and a presiding administrative patent judge, and the designated presiding administrative patent judge presides over all matters relating to a trial. Also, the President of the IPTAB shall designate a chief administrative patent judge, i.e., an administrative patent judge who will review the trial case in advance and explain to the presiding administrative patent judge and all administrative patent judges of the collegial body. (Trial Guidebook Part 4. Chapter 1.)</p> <p>○ In the trial, three or five administrative patent judges in the collegial body may consult each other (Article 146① of the KPA), and this does not simply mean aggregating each trial of the individual administrative patent judges, but that all of the administrative patent judges are united as one and go to the trial as if they are one institution (Article 146 of the KPA). In other words, every matter in the trial is recognized and decided by a majority vote and processed through a procedure similar to a trial proceeding procedure</p>	<p>○ Collegiate Examination</p> <p>Cases that are collegially examined by the PRB shall be examined by a panel consisting of three or five members, including a chairman, a first member, and one or three second members respectively.</p> <p>○ Composition of a Panel</p> <p>The heads of appealing divisions of the PRB and the principal examiners for reexamination are qualified to serve as the chairman of a panel; other members may serve as the chairman subject to the approval of the Director or one of the Deputy Directors of the Board.</p> <p>Principal examiners for reexamination, examiners for reexamination, adjunct principal examiners for reexamination, and adjunct examiners for reexamination may serve as the first or second member of a panel.</p> <p>Examiners invited from the examination departments of the Patent Office for specific cases may serve as the second member of the panel.</p> <p>○ Distribution of Responsibilities among Panel Members</p> <p>The chairman is responsible for comprehensive examination on the reexamination or invalidation procedure, presides over oral proceedings, presides over panel meetings and vote casting, and decides on whether to submit the examination decisions of the panel to the Director or one of the Deputy Directors for approval.</p>	<p>○ <b>Article 136 of the JPA (Panel system for appeal)</b></p> <p>(1) An appeal shall be conducted by a panel consisting of three or five administrative judges.</p> <p>(2) A decision of the panel under the preceding paragraph shall be made by a majority vote</p> <p>(3) Qualifications of administrative judges shall be as provided by Cabinet Order.</p>
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	<p>of a single administrative patent judge so that the trial can be objectively carried excluding subjectivity of individual administrative patent judges.</p> <p>Since the consultation of the administrative patent judges shall not be disclosed to the public, a place where the consultation is conducted is not limited but the consultation confidential shall be kept confidential. (Trial Guidebook Part 11. Chapter 4.)</p> <p>○ Since in order to improve the efficiency of the consultation, it is insufficient that the presiding administrative patent judge presides over the consultation procedure, the President of the IPTAB shall designate an administrative patent judge, i.e., a chief administrative patent judge, who will review matters to be consulted in advance and explain to the presiding administrative patent judge and all administrative patent judges of the collegial body.</p> <p>The chief administrative patent judge shall write in various forms and registers of the IPTAB to conduct a streamlined trial. However, if a chief administrative patent judge is not separately designated, the presiding administrative patent judge will serve as the chief administrative patent judge.</p> <p>The presiding administrative patent judge may serve as the chief administrative patent judge, or any other administrative patent judge in the collegial body may be designated as the chief administrative patent judge, and the chief administrative patent judge conducts substantial matters relating to the trial, such as preparing a trial decision.</p> <p>(Trial Guidebook Part 11. Chapter 4.)</p>	<p>The first member is responsible for comprehensive examination of the case and keeping the file, drafting communications and decisions, managing clerical affairs associated with the parties concerned, and preparing patent document to be published when a partial invalidation decision is made.</p> <p>The second member shall participate in the examination and assist the chairman and the first member.</p> <p>(Guidelines for Examination, Part IV, Chapter I )</p>	
<p>3.2.2. Collegial body of five administrative</p>	<p>○ The collegial body of five administrative patent judges consists of the President of the IPTAB or senior presiding administrative patent judge, and four people of the presiding administrative patent judges or administrative patent judges designated by the President of the IPTAB.</p> <p>The presiding administrative patent judge of the collegial</p>	<p>○ For the following cases, a five-member panel shall be established:</p> <p>(1) cases of great influence in China or abroad;</p> <p>(2) cases involving important difficult legal issues;</p> <p>(3) cases involving great economic interests.</p>	<p>○ Cases subjected to be heard by the panel of five administrative judges are as follows:</p> <p>(1) a case recognized by the chief administrative judge as necessary to be heard by the panel of five administrative judges (an important legal and technical judgment and involving great social influence);</p>

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patent judges	<p>body of five administrative patent judges is the President of the IPTAB or senior presiding administrative patent judge, and the chief administrative patent judge may be separately designated in order to streamline the trial proceeding. In principle, the chief administrative patent judge is a person designated as a chief administrative patent judge of the concerned trial. A trial proceeding and other consultation matters in the collegial body of five administrative patent judges shall follow those of the collegial body of three administrative patent judges.</p> <p>Cases subjected to be heard by the collegial body of five administrative patent judges are as follows:</p> <ol style="list-style-type: none"> <li>① a case which is not suitable to follow the precedent or the previous decision of the case needs to be modified;</li> <li>② a case which includes an important legal and technical judgment, and involves great social influence;</li> <li>③ a case which was reversed by a court and has high importance;</li> <li>④ a case commonly concerned in many trial departments and in which an overall adjustment of opinions is required since opinions of each trial department are inconsistent;</li> <li>⑤ a case which is not determined based on a consultation made by the collegial body of three administrative patent judges;</li> <li>⑥ a case where the trademarks are identical but designated products are different so that the chief administrative patent judges of the trial cases are different, and a prearranged consultation on how to proceed with the concerned trial case has not yet been made;</li> <li>⑦ a case where several trials having different chief administrative patent judges are filed for the same</li> </ol>	<p>Where the circumstance so requires, a five-member panel may be established by a decision of the Director or one of the Deputy Directors, or on a proposal from the head of the relevant appealing division or a member of the relevant panel which shall be submitted in accordance with the prescribed procedure to the Director or one of the Deputy Directors of the Board for approval.</p> <p>For cases examined by a five-member panel, if no oral proceedings have been held before the establishment of such a panel, oral proceedings shall be held.</p> <p>(Guidelines for Examination, Part IV, Chapter I )</p>	<p>(2) a case for which a request for retrial is filed;</p> <p>(3) other cases judged by the Director-General of the Trial and Appeal Department to be necessary.</p>

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	<p>industrial property right(s) and a consultation whether to reassign the case to a single administrative patent judge has not yet been made;</p> <p>⑧ a case having complex issues which may take a long time to decide the trial;</p> <p>⑨ other cases deemed necessary by the President of the IPTAB</p> <p>(Trial Guidebook Part 11. Chapter 4.)</p> <p>○ Procedures to decide whether a case shall be conducted by the collegial body of five administrative patent judges are as follows:</p> <p>① If the presiding administrative patent judge or administrative patent judges of each Trial and Appeal Board has a case, which shall be examined by the collegial body of five administrative patent judges, among cases assigned to their Trial and Appeal Board, they shall select a case to be heard by the collegial body of five administrative patent judges and report the case to the President of the IPTAB by the 15<sup>th</sup> of each month (Article 14① of Provision on establishment and operation of trial and appeal board).</p> <p>② When the President of the IPTAB receives the report, he or she decides whether to have the collegial body of five administrative patent judges hear the case.</p> <p>(Trial Guidebook Part 11. Chapter 4.)</p>		

#### 4. Exclusion, etc. of administrative patent judges

##### 4.1. Related laws

- **Article 148 of the KPA (Exclusion of Administrative Patent judges)** In any of the following cases, an administrative patent judge shall be precluded from exercising his/her functions in a trial:
1. Where the administrative patent judge or his/her spouse

- **Article 37 of the Implementing Regulations of the Patent Law** Where any of the following events occurs, a person who conducts examination or hears a case in the procedures of preliminary examination, examination as to substance, reexamination or invalidation shall, on his own initiative or upon the request of the parties concerned or any other interested person, be excluded from

- **Article 139 of the JPA (Exclusion of administrative judges)**
- An administrative judge shall be excluded from performing his/her duties in any of the following cases:
- (i) where the administrative judge or his/her spouse or former spouse is or was a party in the case or an intervenor in the case;

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	<p>or ex-spouse is a party or intervenor;</p> <p>2. Where the administrative patent judge is or was a relative of a party or intervenor;</p> <p>3. Where the administrative patent judge is or was a legal representative of a party or intervenor;</p> <p>4. Where the administrative patent judge has become a witness or expert witness or was an expert witness;</p> <p>5. Where the administrative patent judge is or was a representative of a party or intervenor;</p> <p>6. Where the administrative patent judge has participated as an examiner or administrative patent judge in a decision to grant a patent or a trial decision relating to the case;</p> <p>7. Where the administrative patent judge has a direct interest.</p> <p>○ <b>Article 149 of the KPA (Request for Exclusion)</b> Where grounds for preclusion under Article 148 exist, a party or intervenor may request the exclusion of an administrative patent judge.</p> <p><b>Article 150 of the KPA (Challenge of Administrative Patent Judges)</b> (1) Where there are circumstances wherein the participation of an administrative patent judge would compromise the fairness of the proceedings in a trial, such administrative patent judge may be challenged by a party or intervenor.</p> <p>(2) After a party or intervenor has made a written or oral statement with regard to the case before an administrative patent judge, he/she may not challenge the administrative patent judge: Provided, That the same shall not apply where the party or intervenor did not know that there was a ground for challenge or where a ground for challenge arose subsequently.</p> <p><b>Article 151 of the KPA (Indication of Grounds for Exclusion or Challenge)</b> (1) a person who presents a motion for exclusion or challenge under Articles 149 and 150 shall submit a document stating the grounds therefor</p>	<p>exercising his function:</p> <p>(1) where he is a near relative of the party concerned or the agent of the party concerned;</p> <p>(2) where he has an interest in the application for patent or the patent right;</p> <p>(3) where he has any other kinds of relations with the party concerned or with the agent of the party concerned that may influence impartial examination and hearing; or</p> <p>(4) where he is a member of the Patent Reexamination Board who has taken part in the examination of the same application.</p>	<p>(ii) where the administrative judge is or was a relative by blood within the fourth degree of kinship, a relative by affinity within the third degree of kinship or a relative living together (as defined in the Civil Code of Japan) of a party in the case or an intervenor in the case;</p> <p>(iii) where the administrative judge is a guardian, a supervisor of a guardian, a curator, a supervisor of the curator, an assistant or a supervisor of the assistant of a party in the case or an intervenor in the case;</p> <p>(iv) where the administrative judge has become a witness or an expert witness in the case;</p> <p>(v) where the administrative judge is or was a representative of a party in the case or an intervenor in the case;</p> <p>(vi) where the administrative judge was involved in the procedures relating to the examiner's decision who is being appealed in the case as the examiner; and</p> <p>(vii) where the administrative judge has a direct interest in the case.</p> <p>○ <b>Article 140 of the JPA</b> Where there exists any ground for exclusion under Article 139, a party or an intervenor may file a motion requesting the exclusion.</p> <p>○ <b>Article 141 of the JPA (Recusation to administrative judge)</b> (1) Where there exists any circumstances of an administrative judge that might hinder fair proceedings of the appeal, a party or an intervenor may recuse the administrative judge.</p> <p>(2) A party or an intervenor may not recuse an administrative judge after making a written or oral statement to the administrative judge with regard to the case; provided, however, that this shall not apply where the party or the intervenor was not aware of the ground of the recusation or the ground of the recusation occurred after making such statement.</p> <p>○ <b>Article 142 of the JPA (Formal requirements for a motion requesting exclusion or recusation)</b></p> <p>(1) A person filing a motion requesting an exclusion or recusation shall submit a document to the Commissioner of the Patent Office stating the grounds therefor; provided, however, that in the case of oral proceedings such request may be made orally.</p>



ITEM	KOREA	CHINA	JAPAN
	<p>to the President of the Intellectual Property Trial and Appeal Board: Provided, That in an oral trial proceeding, an oral challenge may be made.</p> <p>(2) The underlying causes for exclusion or challenge shall be substantiated within three days from the date the motion was presented.</p> <p><b>Article 152 of the KPA (Decision on Petition for Exclusion or Challenge)</b> (1) A decision on a petition for exclusion or challenge shall be made by a trial.</p> <p>(2) No administrative patent judge subject to the exclusion or challenge motion shall participate in the trial of the request: Provided, That he/she may state his/her opinion.</p> <p>(3) A decision made under paragraph (1) shall be in writing and shall state the grounds therefor.</p> <p>(4) No appeal shall be made against a decision made under paragraph (1).</p> <p>○ <b>Article 153 of the KPA (Suspension of Proceedings)</b> When a motion for exclusion or challenge has been presented, the trial proceedings shall be suspended until a decision thereon has been made: Provided, That this shall not apply to the matters requiring urgent attention.</p> <p>○ <b>Article 153-2 of the KPA (Avoidance of Administrative Patent Judges)</b> Where Article 148 or 150 applies to an administrative patent judge, he/she may avoid trial proceedings relating to the case with permission from the President of the Intellectual Property Trial and Appeal Board.</p>		<p>(2) The grounds for the exclusion or recusation shall be showed of a prima facie within three days from the date the motion under the preceding paragraph has been filed. The same shall apply to the facts prescribed in the proviso to Article 141(2).</p> <p>○ <b>Article 143 of the JPA (Ruling on motion requesting exclusion or recusation)</b></p> <p>(1) Where a motion requesting an exclusion or recusation has been filed, administrative judges who are not the administrative judge named in the motion shall render a ruling thereon through an appeal; provided, however, that the administrative judge named in the motion may present his opinion.</p> <p>(2) The ruling under the preceding paragraph shall be made in writing and state the grounds therefor.</p> <p>(3) The ruling under paragraph (1) shall not be subject to appeal.</p> <p>○ <b>Article 144 of the JPA</b> Where a motion requesting an exclusion or recusation has been filed, the appeal procedures shall be suspended until a ruling on the motion is rendered; provided, however, that this shall not apply to the case requiring urgent action.</p>

#### 4.2. Related guidelines

<p>○ In order to maintain fairness of a trial, when an administrative patent judge is in a special personal and material relationship with a specific case of which he or she is in charge, he or she shall be disqualified from participating in a trial; this is referred to as an exclusion, a challenge, and an avoidance of an administrative patent</p>	<p>○ Where a panel member of a reexamination or invalidation case falls into one of the circumstances as prescribed in Rule 37, the panel member shall recuse himself from the examination. Where the panel member fails to recuse, the party concerned may file a motion to recuse him.</p> <p>The close relatives of the Director or Deputy Directors should not</p>	<p>○ It is provided that the Commissioner of the Japanese Patent Office shall designate administrative judges and appeal clerks in each appeal (Article 137 of the JPA), and that where any of the administrative judges or appeal clerks designated under the preceding paragraph is unable to participate in the appeal, the Commissioner of the Patent Office shall terminate the designation and appoint another administrative judge to fill the vacancy (Article 137② of the JPA).</p>
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ITEM	KOREA	CHINA	JAPAN
	<p>judge.</p> <p>It is provided that the President of the Intellectual Property Trial and Appeal Board shall designate administrative patent judges for each trial (Article 144① of the KPA), and that when any administrative patent judge is unable to participate in the trial, the President of the IPTAB may allow another administrative patent judge to do so (Article 144② of the KPA). Thus, for the fairness of a trial, it is necessary to abstain an administrative patent judge from performing his or her duties in a case when the administrative patent judge is in a special relationship with the concerned case (Articles 148 to 153 of the KPA).</p> <p>The exclusion refers to being naturally excluded from legally performing his or her duties on a certain ground, and the challenge refers to being excluded from performing his or her duties when the party files a motion for challenge on the ground that there are circumstances in which the fairness of the trial could be compromised. Other than the exclusion and the challenge, there is a system of avoidance where an administrative patent judge may resign voluntarily.</p> <p>The administrative patent judge may be excluded when he or she falls within the grounds provided by the law, and avoided when a motion for challenge is granted on the ground that there is a circumstance in which the trial proceedings would be compromised.</p> <p>When a request for exclusion or challenge is filed, the President of the IPTAB shall designate an administrative patent judge other than the administrative patent judge related to the request to handle the case.</p> <p>(Trial Guidebook Part 4. Chapter 2. Section 1)</p> <p>○ Grounds for exclusion are provided under Article 148 of the KPA as follows:</p> <p>a. Where the administrative patent judge or his/her spouse or ex-spouse is a party or intervenor;</p>	<p>represent the parties of a reexamination or invalidation case during the tenure of the Director or Deputy Directors.</p> <p>The close relatives of the head of appealing division should not represent the parties of a reexamination or invalidation case that will be examined in the appealing division during the tenure of the head of appealing division.</p> <p>The close relatives referred to above means spouse, parent, child, sibling, grandparent, grandchild and other relatives with maintenance relationship.</p> <p>The Director or Deputy Directors should not represent the parties of a reexamination or invalidation case within three years since his demission, and other members of the PRB should not within two years since their demission.</p> <p>Where the party concerned files a motion to recuse a member of the panel, or he thinks the attorney appointed fall into the circumstances as prescribed above, he shall raise the recusation in written form and explain the causes therein, and attach relevant evidence if necessary.</p> <p>For any recusation raised by a party concerned, the PRB shall make a decision in written form and notify the party who raised it.</p> <p>(Guidelines for Examination, Part IV, Chapter I )</p>	<p>However, in order to secure the fairness of the appeal, when a administrative judge is in a special relationship with a specific case of which he or she is in charge, it is necessary to inhibit the administrative judge from performing his/her duties in the case. This refers to the exclusion and recusation system (Articles 139 ~ 144(2) of the JPA).</p> <p>The exclusion refers to being naturally excluded from performing legal duties on a certain ground, and the recusation refers to being excluded from performing duties when a request for recusation is filed by a party because there exist any circumstances of an administrative judge that might hinder fair proceedings of the appeal.</p> <p>Other than the exclusion and the recusation, in terms of an administrative management rather than a system, a measure of avoidance may be considered through which an administrative judge may voluntarily withdraw himself/herself from performing his/her duties in the appeal (there is a procedure of avoidance in an appeal proceeding; however, it is considered separately here).</p> <p>Grounds, formal requirements and time limits for filing a request for exclusion are as follows:</p> <p>(1) Grounds for exclusion are provided under Article 139(i) to (vii) of the JPA as follows:</p> <p>a. where the administrative judge or trial clerk or his/her spouse or former spouse is or was a party or intervenor in the case (i)</p> <p>b. where the administrative judge or trial clerk is or was a relative of a party or intervenor in the case (ii);</p> <p>c. where the administrative judge or trial clerk is a guardian, a curator, or an assistant a party or intervenor in the case (iii)</p> <p>d. where the administrative judge or trial clerk has become a witness or an expert witness in the case (iv)</p> <p>e. where the administrative judge or trial clerk is or was a representative of a party or intervenor in the case (v)</p> <p>f. where the administrative judge or trial clerk was involved in the previous decision (vi)</p> <p>g. where the administrative judge or trial clerk has a direct interest in</p>

ITEM	KOREA	CHINA	JAPAN
	<p>b. Where the administrative patent judge is or was a relative of a party or intervenor;</p> <p>c. Where the administrative patent judge is or was a legal representative of a party or intervenor;</p> <p>d. Where the administrative patent judge is a witness or expert witness or was an expert witness;</p> <p>e. Where the administrative patent judge is or was a representative of a party or intervenor;</p> <p>f. Where the administrative patent judge has participated as an examiner or administrative patent judge in a decision whether to grant a patent or a decision on the patent opposition or the trial decision relating to the case;</p> <p>g. Where the administrative patent judge has a direct interest with the case. Here, the “direct” interest refers to a legal interest but does not include a financial interest. The legal interest may include the following cases:</p> <p>o where the administrative patent judge is a holder of a priority right of a case in dispute;</p> <p>o where the administrative patent judge is a pledgee of a right of a case in dispute;</p> <p>o where the administrative patent judge is an licensee of a right of a case in dispute;</p> <p>o where the administrative patent judge is a person who has pledged his/her property to secure another's obligation of a right of a case in dispute</p> <p>※ Examples of Item f of the grounds for exclusion may be a case where an examiner granted a patent or issued a notice of decision to reject a patent application, and also participated as an administrative patent judge of an invalidation trial/appeal against the decision to reject the patent application, and a case where an administrative patent judge in an original trial decision participated again in the trial resumed after the original trial decision was reversed.</p>		<p>the case (vii)</p> <p>Here, the direct interest refers to a legal interest but does not include a financial interest. The legal interest may include the following cases.</p> <p>(a) where the administrative judge or trial clerk is a holder of a priority right of a case in dispute;</p> <p>(b) where the administrative judge or trial clerk is a pledgee of a right of a case in dispute;</p> <p>(c) where the administrative judge or trial clerk is a licensee of a right of a case in dispute;</p> <p>(d) where the administrative judge or trial clerk is a person who has pledged his/her property to secure another's obligation of a right of a case in dispute</p> <p>(2) Request for exclusion (Article 140 of The JPA, and Article 48(2) of Enforcement Rule to the Act)</p> <p>Even though there are grounds for exclusion, when the administrative judge or trial clerk has previously participated in the case, a party may request the exclusion.</p> <p>a. A person filing the request for exclusion</p> <p>A person who can file the request for exclusion is a party and an intervenor (Article 140 of The JPA). Further, a person filing an opposition against a trademark registration can file the request for exclusion.</p> <p>Also, other administrative judges may provide a statement on the grounds for exclusion to the Director-General of the Trial and Appeal Department.</p> <p>b. Formal requirements (Article 142 of the JPA)</p> <p>Regardless of whether the request is filed in writing or an oral request (→7), an appeal case, a name of an appeal examiner or trial clerk to be excluded, and a ground for exclusion (a corresponding item of Article 139 of the JPA) shall be indicated clearly. However, an oral request is accepted only in an oral appeal proceeding.</p> <p>c. Time limit for filing the request</p>

ITEM	KOREA	CHINA	JAPAN
	<p>(Trial Guidebook Part 4. Chapter 2. Section 2)</p> <p>○ Even though there are grounds for exclusion, when the administrative patent judge has participated in the case, a party may file the request for exclusion.</p> <p>A person who can file the request for exclusion is a party or intervenor (Article 149 of the KPA).</p> <p>Regardless of whether the request is written or oral, a trial case, a name of an administrative patent judge to be excluded, and a ground for exclusion (indicating the item number of possible grounds provided in Article 148 of the KPA) shall be indicated clearly. However, an oral request is accepted only in an oral hearing (Article 151(1) of the KPA).</p> <p>The request for exclusion may be filed before a decision of the trial is made.</p> <p>Between the time when the trial decision is made and the time when the decision is final and conclusive, the party or intervenor can use the ground for exclusion as a ground for appeal in a higher court or litigation. Also, the exclusion can be a ground for retrial after a trial decision has become final and conclusive (Article 78 of the KPA and Article 451 of the Korean Civil Procedure Act).</p> <p>(Trial Guidebook Part 4. Chapter 2. Section 2)</p> <p>○ The ground for challenge is provided that "where there are circumstances wherein the participation of an administrative patent judge would compromise the fairness of the proceedings in a trial." This ground refers to an objective and reasonable ground that a party concerns the unfairness of the administrative patent judge, and cannot be the ground for exclusion. However, the administrative patent judge may be biased in the following cases:</p> <p>① where the administrative patent judge is an intimate friend of a party;</p> <p>② where the administrative patent judge is in a hatred</p>		<p>The request for exclusion may be filed before a decision of the appeal is made.</p> <p>(Note) 1 It may be a ground for an appeal before a decision of the appeal is made.</p> <p>2 It may be a ground for retrial after a decision of the appeal is made (Article 171 of The JPA, and Articles 328 and 329 of Japanese Civil Procedure Act).</p> <p>(Trial Guidebook Chapter 59-01(1-4))</p> <p>○ Grounds, formal requirements and a time limit for filing a request for recusation are as follows:</p> <p>(1) Grounds for recusation (Article 141 of The JPA)</p> <p>The ground of recusation is provided that "where there exists any circumstances of an administrative judge that might hinder fair proceedings of the appeal." This ground refers to an objective and reasonable ground that a party is concerned about the unfairness of an appeal proceeding of the administrative judge or a work of the trial clerk. The following cases cannot be the ground for exclusion, but may be the issue of recusation:</p> <p>a. where the administrative judge or trial clerk is a friend of a party;</p> <p>b. where the administrative judge or trial clerk is in a hatred relationship;</p> <p>c. where the administrative judge or trial clerk has a special financial interest in a case;</p> <p>d. where the administrative judge or trial clerk has filed a personal statement on a case;</p> <p>e. where the administrative judge or trial clerk is in a marriage of consent or engaged with a party</p> <p>(2) Request for recusation (Article 142 of JPA)</p> <p>a. A person filing a Request for recusation</p> <p>A person who can file the request for recusation is a party and an intervenor (Article 141 of The JPA). Further, a person filing an objection to a trademark registration can file the request for recusation (Item 4(2)a).</p>

ITEM	KOREA	CHINA	JAPAN
	<p>relationship;</p> <p>③ where the administrative patent judge has a special interest in a case financially;</p> <p>④ where the administrative patent judge has filed a personal statement on a case;</p> <p>⑤ where the administrative patent judge is in a marriage of consent or engaged with a party</p> <p>(Trial Guidebook Part 4. Chapter 2. Section 3)</p> <p>○ The avoidance of the administrative patent judge implies that the administrative patent judge admits the grounds for exclusion or challenge by himself/herself to thereby avoid the trial proceedings voluntarily (Article 153-2 of the KPA).</p> <p>The provision on the avoidance was newly established on February 3, 2001.</p> <p>(Trial Guidebook Part 4. Chapter 3.)</p>		<p>b. Formal requirements</p> <p>Regardless of whether the request is filed in writing or an oral request (→8), an appeal case, a name of an appeal examiner or trial clerk to be recused, and a ground of recusation shall be indicated clearly. However, an oral request is accepted only in an oral appeal proceeding.</p> <p>c. Time limit for filing the request</p> <p>A party or an intervenor may not recuse an administrative judge after making a written or oral statement to the administrative judge with regard to the case.</p> <p>However, this shall not apply to a case where the party or the intervenor was not aware of the ground of the recusation or the ground of the recusation occurred after making such statement (Article 141② of JPA).</p> <p>In the case of the statement according to an oral proceeding, when a party or intervenor files a certain request, it could be deemed that there was a statement even without providing any statement on the ground thereof.</p> <p>(Trial Guidebook Chapter 59-01(5))</p> <p>○ Avoidance</p> <p>In order to prevent in advance the request for exclusion or recusation from being filed by a party and to secure the fairness of the appeal, it is considered that the request for avoidance shall voluntarily be filed by an appeal examiner or trial clerk for himself/herself when it is deemed necessary.</p> <p>(Appeal Guidebook Chapter 59-01(6))</p> <p>○ Where a motion requesting an exclusion or recusation has been filed, administrative judges or trial clerk who are not the administrative judge or trial clerk named in the motion are designated to render a ruling thereon through an appeal (Article 143① and 144-2⑤ of The JPA).</p> <p>For a misuse of a right to file the request for exclusion and recusation and countermeasures thereof, if the request for exclusion (recusation) is obviously filed only with the purpose of delaying the appeal proceedings, the administrative judge subjected to the request also can decide to dismiss the request as the misuse of the right to request.</p> <p>(However,) This decision (to dismiss) shall be made carefully in</p>

ITEM	KOREA	CHINA	JAPAN
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particular to avoid losing the security on the fairness of the procedure, which is essential in both systems.

(Appeal Guidebook Chapter 59-01(8-9))

## **Chapter II Comparison chart for appeal against decision of rejection**

ITEM	KOREA	CHINA	JAPAN
<b>1. Related laws</b>			
<b>1.1. Laws related to appeal request</b>			
	<p>○ <b>Article 132-3 of the KPA (Appeal against Decision to Reject Patent Application, etc.)</b> Where a person who has received a decision to reject a patent application or a decision to reject an application to register extension of the term of a patent right has an objection to such decision, such person may request a trial within thirty days from the date of receipt of the certified copy of the decision.</p>	<p>○ <b>Article 41 of the Patent Law of the People’s Republic of China</b> The patent administration department under the State Council shall set up a Patent Reexamination Board. Where an applicant for patent is not satisfied with the decision of the said department rejecting the application, the applicant may, within three months from the date of receipt of the notification, request the Patent Reexamination Board to make a reexamination. The Patent Reexamination Board shall, after reexamination, make a decision and notify the applicant for patent.</p> <p>Where the applicant for patent is not satisfied with the decision of the Patent Reexamination Board, it or he may, within three months from the date of receipt of the notification, institute legal proceedings in the people’s court.</p>	<p>○ <b>Article 121 of the JPA (Appeal against examiner's decision of refusal)</b> A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for an appeal against the examiner's decision of refusal within three months from the date the certified copy of the examiner's decision has been served.</p>
<b>1.2. Laws related to appeal formalities</b>			
	<p>○ <b>Article 140-2 of the KPA (Formal Requirements of Request for Appeal against Decision to Reject Patent Application)</b> (1) Notwithstanding Article 140 (1), a person who intends to request an appeal against a decision to reject a patent application under Article 132-3 shall, submit a written request stating the following matters to the President of the Intellectual Property Trial and Appeal Board:</p> <ol style="list-style-type: none"> <li>1. The name and domicile of a petitioner (if the petitioner is a juristic person, its title and the location of its place of business);</li> <li>1-2. 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);</li> <li>2. The filing date and file number of the application;</li> <li>3. The title of the invention;</li> <li>4. The date of the decision;</li> </ol>	<p>○ <b>Article 60 of the Implementing Regulations of the Patent Law</b> Where the applicant requests the Patent Reexamination Board to make a reexamination in accordance with the provisions of Article 41 of the Patent Law, it or he shall file a request for reexamination, state the reasons and, when necessary, attach the relevant supporting documents.</p> <p>Where the request for reexamination does not comply with the provisions of Article 19, paragraph one or Article 41, Paragraph one of the Patent Law, the Patent Reexamination Board shall refuse to accept it, notify the applicant in written form and state the reasons thereof.</p> <p>Where the request for reexamination does not comply with the prescribed form, the person making the request shall rectify it within the time limit specified by the Patent Reexamination Board. If the requesting person fails to do so, the request for reexamination shall be deemed not to have been filed.</p>	<p>○ <b>Article 131 of the JPA (Formal requirements of request for appeal)</b> A person filing a request for an appeal shall submit a written request stating the following to the Commissioner of the Patent Office:</p> <ol style="list-style-type: none"> <li>(i) the name, and the domicile or residence of the party and the representative thereof;</li> <li>(ii) the identification of the appeal case; and</li> <li>(iii) object and statement of the claim.</li> </ol> <p>○ <b>Article 46 of the Enforcement Rule of the Act (Format of Request for appeal)</b> A request for appeal against the examiner's decision of refusal shall be prepared in Format 61-2 and other requests for appeal shall be prepared in Format 62.</p> <p>○ <b>Article 131-2 of the JPA (Amendment of request for appeal)</b> An amendment of the written request filed under paragraph (1) of the preceding Article shall not change the gist thereof;</p>



ITEM	KOREA	CHINA	JAPAN
	<p>5. The identification of the trial case;</p> <p>6. The purport of the request and the grounds therefor.</p> <p>(2) Where a written request for a trial submitted pursuant to paragraph (1) is amended, the gist thereof shall not be changed: Provided, That this shall not apply where such amendment falls under any of the following subparagraphs:</p> <ol style="list-style-type: none"> <li>1. Where an amendment (including an addition) is made to correct a statement of a petitioner pursuant to paragraph (1) 1;</li> <li>2. Where a ground for request pursuant to paragraph (1) 6 is amended.</li> </ol> <p><b>Article 141 of the KPA (Rejection of Request for Trial) (1)</b> The presiding administrative patent judge shall order an amended submission within a specified period where any of the following subparagraphs applies:</p> <ol style="list-style-type: none"> <li>1. Where a request for trial does not comply with Article 140 (1) and (3) through (5) or 140-2 (1);</li> <li>2. Where a procedure relating to a trial falls under any of the following cases; <ol style="list-style-type: none"> <li>(a) Where the procedure is not in compliance with Article 3 (1) or (6);</li> <li>(b) Where fees required in accordance with Article 82 have not been paid;</li> <li>(c) Where the procedure is not in compliance with the formalities specified in this Act or any order thereunder.</li> </ol> </li> <li>(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.</li> <li>(3) A decision to reject a request for trial under paragraph (2) shall be in writing and shall state the grounds therefor.</li> </ol> <p>○ <b>Article 142 of the KPA (Dismissal of Request for Trial containing Incurable Defects by Trial Decision)</b> If a request for a trial contains unlawful defects which cannot be corrected</p>		<p>provided, however, that this shall not apply</p> <ol style="list-style-type: none"> <li>(1) where the said amendment is made with respect to the grounds for the request as provided in paragraph (1) item (iii) of the preceding Article in the course of filing a request for an appeal other than a patent invalidation appeal, or</li> <li>(2) in the event that approval is granted by the chief administrative judge under the following paragraph.</li> <li>(3) where when an amendment to the written request is ordered under Article 133(1) of the JPA (including mutatis mutandis to Article 134-2(9)), the ordered matter is conducted.</li> </ol> <p>○ <b>Article 133 of the JPA (Dismissal by ruling in the case of non-compliance with formal requirements)</b></p> <ol style="list-style-type: none"> <li>(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.</li> <li>(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 appeal, designating an adequate time limit, in any of the following cases: <ol style="list-style-type: none"> <li>(i) where the procedure does not comply with paragraphs (1) to (3) of Article 7 or Article 9;</li> <li>(ii) where the procedure does not comply with formal requirements as provided in this Act or an order thereunder; and</li> <li>(iii) where the fees for a procedure payable under Articles 195(1) or 195(2) have not been paid;</li> </ol> </li> <li>(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 an appeal 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).</li> <li>(4) The ruling under the preceding paragraph shall be made in</li> </ol>

ITEM	KOREA	CHINA	JAPAN
	<p>by amendment, such request may be rejected by a ruling without providing the appellee an opportunity to submit a written response.</p>		<p>writing and state the grounds thereof.</p> <ul style="list-style-type: none"> <li>○ <b>Article 133-2 of the JPA (Dismissal of unlawful procedures)</b> <ul style="list-style-type: none"> <li>(1) In the procedures pertaining to an appeal case (excluding a request for an appeal), the chief administrative judge may, by a ruling, dismiss procedures that are unlawful and not amendable.</li> <li>(2) Where the chief administrative judge intends to dismiss a procedure under the preceding paragraph, he/she shall notify the person who undertook the procedures of the reasons therefor, and give the said person an opportunity to submit a statement of explanation, designating an adequate time limit.</li> <li>(3) The ruling under this paragraph (1) shall be in writing and state the grounds therefor.</li> </ul> </li> <li>○ <b>Article 135 of the JPA (Dismissal of inadequate request for appeal by appeal decision)</b> An unlawful request for an appeal, that is not amendable, may be dismissed by an appeal decision without giving the demandee an opportunity to submit a written answer.</li> </ul>

### 1.3. Laws related to reconsideration by examiner before an appeal

	<p>※ The following provisions shall apply to the application that was filed before June 30, 2009</p> <ul style="list-style-type: none"> <li>○ <b>Article 173 of the old KPA (Reconsideration by Examiner Before a Trial)</b> (1) Where a person who has received a decision to reject a patent application under Article 62 requests a trial under Article 132-3 and amends the specification or drawing(s) attached to the application that is the subject of the request within thirty days of the request, the President of the Intellectual Property Trial and Appeal Board shall notify the Commissioner of the Korean Intellectual Property Office before proceeding with the trial.</li> <li>(2) Where a notification referred to in paragraph (1) is given, the Commissioner of the Korean Intellectual Property Office shall order the examiner to reexamine the application that is the subject of the request.</li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 62 of the Implementing Regulations of the Patent Law</b> The Patent Reexamination Board shall remit the request for reexamination which the Board has received to the examination department of the patent administration department under the State Council which has made the examination of the application concerned to make an examination. Where that examination department agrees to revoke its former decision upon the request of the person requesting reexamination, the Patent Reexamination Board shall make a decision accordingly and notify the requesting person.</li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 162 of the JPA</b> Where, in the case of a request for an appeal against an examiner's decision of refusal, where an amendment has been made to the description, scope of claims or drawings attached to the application in the patent application pertaining to the request concurrently with the request, the Commissioner of the Patent Office shall direct the examiner to examine the request.</li> <li>○ <b>Article 163 of the JPA</b> <ul style="list-style-type: none"> <li>(1) Articles 48, 53 and 54 shall apply mutatis mutandis to an examination under the preceding Article. In this case, the term "Article 17-2(1)(i) or (iii)" in Article 53(1) shall be deemed to be replaced with "Article 17-2(1)(i), (iii) or (iv)" and the term "an amendment" in Article 53(1) shall be deemed to be replaced with "an amendment (in the case of Article 17-2(1)(i) or (iii), excluding the amendment made prior to the request for an</li> </ul> </li> </ul>
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ITEM	KOREA	CHINA	JAPAN
	<p>○ <b>Article 174 of the old KPA (<i>Mutatis Mutandis</i> Application of Provisions on Examination to the Reconsideration by Examiner Before a Trial)</b> (1) Articles 51 (Dismissal of an Amendment), 57(2)(Examination by Examiner), 78 (Suspension) and 148(i) to (v) and (vii) (Exclusion) apply <i>mutatis mutandis</i> to the reconsideration by examiner under Article 173. In such cases, in Article 51(1), the expression "Article 47(1)(ii)" reads "Article 47(1)(ii) or (iii)", and "an amendment" reads "an amendment (under Article 47(2), excluding an amendment filed before a request for an appeal against a decision to reject a patent application under Article 132-3)".</p> <p>(2) Articles 47(1)(i) and (ii) (Amendment) and 63 (Notification of Grounds for Rejection) apply <i>mutatis mutandis</i> to a reconsideration by examiner before trial under Article 173 if grounds for rejection have been found that differ from those of the examiner's decision to reject a patent application which is related with the request for trial. In such cases, "under 47(1)(ii)" in Article 63 reads "under 47(1)(ii) or (iii) (in cases under 47(2), excluding those submitted before a request for an appeal against the decision to reject a patent application under Article 132-3)".</p> <p>(3) Articles 66 (Decision to Grant a Patent) and 67 (Formalities for a Decision of Patentability) apply <i>mutatis mutandis</i> to the reconsideration by examiner before trial under Article 173 if the request for a trial is considered to have merit.</p> <p>○ <b>Article 175 of the old KPA (Termination of a Reconsideration by Examiner before Trial)</b> (1) If the grounds for rejection are resolved by the reconsideration under Article 173(2), the examiner shall reverse the ruling of refusal to grant a patent, and grant the patent. In such cases, a request for an appeal against a ruling of refusal to grant a patent is deemed to be extinguished.</p> <p>(2) If an examiner cannot decide to grant a patent as a result of the reconsideration under Article 173(2), the examiner shall report the result to the Commissioner of the Korean Intellectual Property Office without issuing another decision to reject a patent application. The Commissioner of the Korean Intellectual</p>		<p>appeal against an examiner's decision of refusal)."</p> <p>(2) Article 50 and Article 50-2 shall apply <i>mutatis mutandis</i> where a reason for refusal which was not contained in the examiner's decision concerned in the request for an appeal is found in the examination under the preceding Article. In this case, the term "in the case of Article 17-2(1)(i) or (iii) (in the case of Article 17-2(1)(i), limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal)" in the proviso to Article 50 shall be deemed to be replaced with "in the case of Article 17-2(1) (limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal, and excluding the case where the applicant has made an amendment prior to the filing of a request for an appeal against an examiner's decision of refusal), (iii) (excluding the case where the applicant has made an amendment prior to the filing of a request for an appeal against an examiner's decision of refusal) or (iv)."</p> <p>(3) Articles 51 and 52 shall apply <i>mutatis mutandis</i> where a request for an appeal is found to have reasonable grounds in the examination under the preceding Article.</p> <p>○ <b>Article 164 of the JPA</b></p> <p>(1) In an examination under Article 162, where the examiner renders a decision to the effect that a patent is to be granted, the examiner shall rescind the examiner's decision of refusal that is the basis of the appeal request.</p> <p>(2) Except in the case of the preceding paragraph, the examiner may not render a ruling dismissing an amendment under Article 53(1) as applied under Article 163(1).</p> <p>(3) Except in the case of paragraph (1), the examiner shall report to the Commissioner of the Patent Office the result of the examination without rendering a decision on the request for the said trial.</p>

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	<p>Property Office shall notify the President of the Intellectual Property Trial and Appeal Board after receiving the report.</p>		
<p><b>1.4 Laws related appeal proceeding on the merits</b></p>			
	<ul style="list-style-type: none"> <li>○ <b>Applications filed before June 30, 2009: Article 170 of the KPA (<i>Mutatis Mutandis</i> Application of Provisions on Examination to Appeal against Decision to Reject Patent Application)</b> (1) Articles 47(1) (i) and (ii) (Amendment), 51 (Dismissal of an Amendment), 63 (Notification of Grounds for Rejection) and 66 (Decision to Grant a Patent) apply <i>mutatis mutandis</i> to an appeal against a decision to reject a patent application. In such cases, in Article 51(1) the expressions "Article 47(1)(ii)" reads "Article 47(1)(ii) or (iii)", and "an amendment" reads "an amendment (under Article 47(2), excluding an amendment filed before a request for an appeal against a decision to reject a patent application under Article 132-3)"; and "under 47(1)(ii)" in Article 63 reads "under 47(1)(ii) or (iii) (under 47(2), excluding that which was submitted before a request for an appeal against a decision to reject a patent application under Article 132-3)."</li> <p>(2) Article 63, which applies <i>mutatis mutandis</i> under paragraph (1), applies only if grounds for rejection have been found to be different from those in the decision to reject a patent application.</p> <li>○ <b>Applications filed on/after July 1, 2009: Article 170 of the KPA (<i>Mutatis Mutandis</i> Application of Provisions on Examination to Appeal against Decision to Reject Patent Application)</b> (1) Article 47 (1) 1 and 2 (Amendment), Articles 51 (Dismissal of Amendment), 63 (Notification of Grounds for Rejection) and 66 (Decision to Grant Patent) shall apply <i>mutatis mutandis</i> to an appeal against a decision to reject a patent application. In such cases, "Article 47 (1) 2 and 3" in the main sentence of Article 51 (1) shall be construed as "Article 47 (1) 2", and "amendment" in the main sentence of Article 51 (1) shall be construed as "amendment (excluding such amendments made before a request for an appeal against a decision to reject a patent application referred to in Article 132-3)."</li> <p>(2) Article 63, which applies <i>mutatis mutandis</i> under paragraph</p> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 63 of the Implementing Regulations of the Patent Law</b> Where, after reexamination, the Patent Reexamination Board finds that the request does not comply with relevant provisions of the Patent Law and these Implementing Regulations, it shall notify the person requesting reexamination to submit his or her observations within a specified time limit. If the time limit for making response is not met, the request for reexamination shall be deemed to have been withdrawn. Where, after the requesting person has made his or her observations or amendments, the Patent Reexamination Board still finds that the request does not comply with relevant provisions of the Patent Law and these Implementing Regulations, it shall make a decision of reexamination to maintain the earlier decision rejecting the application.</li> <p>Where, after reexamination, the Patent Reexamination Board finds that the decision rejecting the application does not comply with relevant provisions of the Patent Law and these Implementing Regulations, or that the amended application has removed the defects as pointed out by the decision rejecting the application, it shall make a decision to revoke the decision rejecting the application, and allow the original examination department to resume the examination procedure.</p> <li>○ <b>Article 64 of the Implementing Regulations of the Patent Law</b> At any time before the Patent Reexamination Board makes its decision on the request for reexamination, the requesting person may withdraw his or her request for reexamination.</li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 158 of the JPA (Special provisions regarding appeals against examiner's decision of refusal)</b> Any procedure taken during the examination procedure shall also be effective in an appeal against an examiner's decision of refusal.</li> <li>○ <b>Article 159 of the JPA (the same as the previous article)</b> <p>(1) Article 53 shall apply <i>mutatis mutandis</i> to an appeal against an examiner's decision of refusal. In this case, the term "Article 17-2(1)(i) or (iii)" in Article 53(1) shall be deemed to be replaced with "Article 17-2(1)(i), (iii) or (iv)", and the term "an amendment" in Article 53(1) shall be deemed to be replaced with "an amendment (in the case of Article 17-2(1)(i) or (iii), excluding the amendment made prior to the request for an appeal against the examiner's decision of refusal)".</p> <p>(2) Article 50 and Article 50-2 shall apply <i>mutatis mutandis</i> where a reason for refusal found in an appeal against an examiner's decision of refusal is different from the reason(s) of the examiner's decision. In this case, the term "in the case of Article 17-2(1)(i) or (iii) (in the case of Article 17-2(1)(i), limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal)" in the proviso to Article 50 shall be deemed to be replaced with "in the case of Article 17-2(1)(i) (limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal, and excluding the case where the applicant has made an amendment prior to the filing of a request for an appeal against an examiner's decision of refusal), (iii) (excluding the case where the applicant has made an amendment prior to the filing of a request for an appeal against an examiner's decision of refusal) or (iv)."</p> <p>(3) Articles 51 and 67-3(2) shall apply <i>mutatis mutandis</i> where a request for an appeal against an examiner's decision of refusal is found to have reasonable grounds.</p> </li> </ul>

ITEM	KOREA	CHINA	JAPAN
	<p>(1), shall apply where the grounds for rejection have been found to be different from those in the decision to reject a patent application.</p> <p>○ <b>Applications filed before June 30, 2009: Article 171 of the KPA (Special Provisions for an appeal against a Decision to Reject a Patent Application)</b> (1) The designation of the administrative patent judge for an appeal against a decision to reject a patent application under Article 173 is made only when a notice has been given under Article 175(2).</p> <p>(2) Articles 147(1) and (2) (Submission of a Written Response), 155 (Intervention) and 156 (Request for an Intervention) shall not apply to an appeal against a decision to reject a patent application, or a decision to reject to register an extension of the term of a patent.</p> <p>○ <b>Applications filed on/after July 1, 2009: Article 170 of the KPA (Special Provisions of Appeal against Decision to Reject Patent Application)</b> Articles 147 (1) and (2) (Submission of Written Response), 155 (Intervention) and 156 (Request for Intervention) shall not apply to an appeal against a decision to reject a patent application or against a decision to reject to register an extension of the term of a patent right.</p> <p>○ <b>Article 172 of the KPA (Effect of Examination Proceedings)</b> Patent-related procedures previously taken during the course of an examination shall also remain effective in an appeal against a decision to reject a patent application or against a decision to reject to register an extension of the term of a patent right.</p> <p>○ <b>Article 176 of the KPA (Cancellation of Decision to Reject Patent Application, etc.)</b> (1) Where an administrative patent judge deems that the request for trial under Articles 132-3 is well-grounded, he/she shall make a trial decision to cancel the decision to reject a patent application or to reject the registration of an extension of term of a patent right.</p> <p>(2) When any decision to reject a patent or to reject the registration of extension of term of a patent right is revoked pursuant to paragraph (1) in a trial, a trial decision may be made to remand the case for examination proceedings.</p>		<p>○ <b>Article 160 of the JPA (the same as the previous article)</b></p> <p>(1) Where an examiner's decision has been rescinded in an appeal against the examiner's decision of refusal, an appeal decision may be made to order a further examination to be carried out.</p> <p>(2) The decision made in the appeal decision under the preceding paragraph shall be binding upon the examiner with respect to the case.</p> <p>(3) Article 159(3) shall not apply where an appeal decision under paragraph (1) is rendered.</p> <p>○ <b>Article 161 of the JPA (the same as the previous article)</b> Articles 134(1) to (3), 134-2, 134-3, 148 and 149 shall not apply to an appeal against the examiner's decision of refusal.</p> <p>○ <b>Article 156 of the JPA (Notice of conclusion of proceedings)</b></p> <p>(1) When the case has reached the point at which an appeal decision may be rendered except for a patent invalidation appeal, the chief trial examiner shall notify the parties and intervenor(s) of the conclusion of the proceedings.</p> <p>(2) For the patent invalidation appeal, when the case has reached the point at which an appeal decision may be rendered and a preliminary notice of an appeal decision under Article 164-2(1) is not rendered, or when a preliminary notice of an appeal decision under the same article is rendered and a request for correction under Article 134-2(1) or an amendment under Article 17-4(1) is not filed within a time period designated under the preceding paragraph, the chief administrative judge shall notify the parties and intervenor(s) of the conclusion of the proceedings.</p> <p>(3) The chief appeal examiner may, upon a motion by a party or intervenor, or ex officio, resume proceedings, where necessary, even after the notice has been given under the preceding paragraph.</p> <p>(4) The appeal decision shall be rendered within 20 days from the date on which the notice under paragraph (1) or (2) has been issued; provided, however, that this shall not apply where the</p>

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	<p>(3) In ruling on a trial under paragraphs (1) and (2), the reasons constituting the basis for the reversal shall bind the examiner with respect to the case.</p> <p>○ <b>Article 162 of the KPA (Trial Decisions)</b> (1) Except as otherwise provided for, a trial shall be closed when a trial decision has been made.</p> <p>(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:</p> <ol style="list-style-type: none"> <li>1. The number of the trial;</li> <li>2. The name and domicile of the parties and intervenors (if a juristic person, its title and the place of business);</li> <li>2-2. The name and domicile or place of business of the representative, if any (if the representative is a patent corporation, its title, location of office and designated patent attorney's name);</li> <li>3. The identification of the trial case;</li> <li>4. The order of the trial decision (including the scope, duration and consideration of a non-exclusive license in trial cases under Article 138);</li> <li>5. The grounds for the trial decision (including the purport and a summary of the grounds for the request);</li> <li>6. The date of the trial decision.</li> </ol> <p>(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.</p> <p>(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.</p> <p>(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).</p>		<p>case is complex or there are unavoidable reasons therefor.</p> <p>○ <b>Article 157 of the JPA (Trial decision)</b></p> <p>(1) When an appeal decision has been rendered, the appeal shall be concluded.</p> <p>(2) An appeal decision shall be rendered in writing stating the following matters:</p> <ol style="list-style-type: none"> <li>(i) the appeal number;</li> <li>(ii) the name, and domicile or residence of each of the parties, intervenor(s) and their representatives;</li> <li>(iii) the identification of the appeal case;</li> <li>(iv) the conclusion of and reasons for the appeal decision; and</li> <li>(v) the date of the appeal decision.</li> </ol> <p>(3) Where an appeal decision has been rendered, the Commissioner of the Patent Office shall serve a certified copy of the appeal decision to the parties, intervenor(s) and person whose application for intervention has been refused.</p>

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	<p>(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.</p>		
<p><b>1.5. Laws related to specification or drawings</b></p>	<p><b>Article 47 of the KPA (Amendment to Patent Application)</b>  (1) A patent applicant may amend the specification or drawings attached to a patent application within the period prescribed by each subparagraph of Article 42 (5) or before delivering a certified copy of a decision to grant a patent pursuant to Article 66: Provided, That after receiving a notice of grounds for rejection pursuant to Article 63 (1) (hereinafter referred to as "notice of grounds for rejection"), a patent applicant may amend the specification or drawings during the period prescribed in the following subparagraphs only (in cases under subparagraph 3, referring to that time):</p> <ol style="list-style-type: none"> <li>1. Where an applicant receives a notice of grounds for rejection (excluding a notice of grounds for rejection with regard to a ground for rejection which has arisen according to the amendment following the notice of grounds for rejection) for the first time or receives a notice of grounds for rejection, other than that referred to in subparagraph 2, the period for presentation of a written opinion following the relevant notice of grounds for rejection;</li> <li>2. Where an applicant receives a notice of grounds for rejection with regard to a ground for rejection which has arisen according to the amendment following the notice of grounds for rejection, the period for presentation of a written opinion following the relevant notice of grounds for rejection;</li> <li>3. When an applicant requests a re-examination pursuant to Article 67-2.</li> </ol> <p>(2) An amendment to the specification or drawings under paragraph (1) shall be made within the scope of the features disclosed in the specification or drawings initially attached to the patent application.</p>	<ul style="list-style-type: none"> <li>○ <b>Article 33 of the Patent Law of the People's Republic of China</b> An applicant may amend his or her application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of disclosure contained in the initial description and claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.</li> <li>○ <b>Article 61 of the Implementing Regulations of the Patent Law</b> The person making the request may amend his or her patent application at the time when he or she requests reexamination or makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination.</li> </ul> <p>The amendments to the application for patent shall be in two copies.</p>	<ul style="list-style-type: none"> <li>○ <b>Article 17-2 of the JPA (Amendment of Specification, Claim or Drawing attached to the application)</b>(1) An applicant for a patent may amend the specification, claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases: <ul style="list-style-type: none"> <li>(i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(1))and Article 163(2), hereinafter the same shall apply in this paragraph) and the said amendment is made within the designated period under Article 50;</li> <li>(ii) where following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48-7 and the said amendment is made within the designated period under the said Article;</li> <li>(iii) where following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and the said amendment is made within the designated period under Article 50 with regard to the latter notice of reasons for refusal; and</li> <li>(iv) where the applicant files a request for an appeal against an examiner's decision of refusal and the said amendment is made concurrently with the filing of the request;</li> </ul> </li> <li>(2) Where an applicant of a foreign language written application as provided in Article 36-2(2) amends the specification, claims,</li> </ul>

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	<p>(3) An amendment to the scope of claims, from among amendments pursuant to paragraph (1) 2 and 3, may be made only where it falls under any of the following subparagraphs:</p> <ol style="list-style-type: none"> <li>1. Where the scope of claims for a patent is reduced by limiting, deleting, adding claims;</li> <li>2. Where wrong description is corrected;</li> <li>3. Where ambiguous description is made clear;</li> <li>4. With regard to an amendment beyond the scope referred to in paragraph (2), where returning to the scope of claims made prior to the amendment, or amending the scope of claims pursuant to subparagraphs 1 through 3 in the course of returning to the said scope of claims.</li> </ol> <p>(4) Where a patent application is amended within the period specified in paragraph (1) 1 or 2, all amendments made before the last amendment in the course of each amendment shall be deemed withdrawn.</p>		<p>or drawings under the preceding paragraph for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.</p> <p>(3) Except in the case where the said amendment is made through the submission of a statement of correction of an incorrect translation, any amendment of the specification, claims or drawings under paragraph (1) shall be made within the scope of the matters described in the specification, claims or drawings originally attached to the application(in the case of a foreign language written application under Article 36-2(2), the translation of the foreign language documents as provided in Article 36-2(2) that is deemed to be the specification, claims and drawings under Article 36-2(6) (in the case where the amendment to the specification, claims or drawings has been made through the submission of the statement of correction of an incorrect translation, the said translation or the amended specification, claims or drawings))</p> <p>(4) In addition to the case provided in the preceding paragraph, where any amendment of the claims is made in the cases listed in the subparagraphs of paragraph (1), the invention for which determination on its patentability is stated in the notice of grounds for rejection received prior to making the amendment and the invention constituted by the matters described in the amended claims shall be of a single group of invention recognized as fulfilling the requirements of unity of invention set forth in Article 37.</p> <p>(5) In addition to the requirements provided in the preceding two paragraphs, in the cases of subparagraphs (i), (iii) and (iv) of paragraph (1) (in the case of subparagraph (i) of the said paragraph, limited to the case where the applicant has received a notice under Article 50-2 along with the notice of reasons for refusal), the amendment of claims shall be limited to those for the following purposes:</p> <ol style="list-style-type: none"> <li>(i) the deletion of claim(s) as provided in Article 36(5);</li> <li>(ii) narrowing the scope of claims (limited to the cases where the restriction is to specify the matters required to identify the</li> </ol>



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			<p>invention stated in the claims under Article 36(5), and the field of industrial applicability and the problem to be solved of the invention stated in the claim(s) prior to the amendment are identical with those after the amendment;</p> <p>(iii) the correction of clerical errors; and</p> <p>(iv) the clarification of an ambiguous statement (limited to the matters stated in the reasons for refusal in the notice of reasons for refusal).</p> <p>(6) Article 126(7) shall apply mutatis mutandis to cases under subparagraph (ii) of the preceding paragraph.</p>
<b>2. Petitioner</b>			
<b>2.1. Petitioner</b>			
	<ul style="list-style-type: none"> <li>○ A petitioner is a person who has received a decision to reject a patent application (including a successor (KPA §132-3).  (Trial Guidebook Part 21. Chapter 2.)</li> </ul>	<ul style="list-style-type: none"> <li>○ The applicant of a rejected application may file a request for reexamination with the PRB. Where the person filing a request for reexamination is not the applicant of the rejected application, the request shall not be accepted.  (Guidelines for Examination, Part IV, ChapterII)</li> </ul>	<ul style="list-style-type: none"> <li>○ A petitioner is a person who has received a decision to the effect that an application is to be refused (including a successor) (JPA §121(1)).  (Appeal Guidebook, Chapter 61-02(1))</li> </ul>
<b>2.2. Joint application</b>			
	<ul style="list-style-type: none"> <li>○ Where joint owners of a patent right make a request for trial concerning the right related with joint ownership (i.e., joint application), the request for trial shall be filed jointly by all of the owners (KPA §139③). A request for trial which was not jointly made is deemed unlawful and may be dismissed by a decision (KPA §142).  (Trial Guidebook. Part 21. Chapter 2(2))</li> <li>○ For the request for trial made after July 1, 2009, where one of the joint patentees is omitted from the list of petitioners or appellees and where one of the joint applicants is omitted from the list of applicants, an amendment can be made to add the omitted one. The violation of joint request for trial shall be notified through written examination, and when the omission is not amended, the trial proceeding may be closed and the request for trial may be dismissed by a trial decision.</li> </ul>	<ul style="list-style-type: none"> <li>○ Where a rejected application has two or more applicants and the petitioner for reexamination does not include all the applicants, the PRB shall notify the petitioner to make rectification within a specified time limit. If the defect is not rectified within the time limit, the request for reexamination shall be deemed not to have been made.  (Guidelines for Examination, Part IV, ChapterII)</li> </ul>	<ul style="list-style-type: none"> <li>○ Where joint owners of a right to receive a patent file the request for appeal concerning the right under joint ownership, the request for appeal shall be made jointly by all of the owners(JPA §132(3))  (Appeal Guidebook, Chapter 61-02(1))</li> <li>○ The request for appeal filed by one of the co-applicants is treated as follows.</li> <li>○ After examining whether the appeal is well indicated as substantially a co-trial based on a collective review of all documents submitted from the date of filing to the date when the period for a request for appeal expires, the request is treated as follows: <ul style="list-style-type: none"> <li>a. where the intent is well indicated</li> </ul> </li> </ul>

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	<p>(Trial Guidebook, Part 5, Chapter 4, Section 2(3))</p>		<p>If it is recognized that the appeal is indicated as substantially a co-appeal by the documents filed until the date when the period for a request for appeal expires (including the filing documents), the presiding administrative judge shall order to amend the procedure (JPA §133(1)) and, when a defect is not cured, shall dismiss the procedure by a decision (JPA §133(3)).</p> <p>Where the procedure needs to include reconsideration by an examiner before the appeal, the Commissioner of the Patent Office orders to amend the procedure (JPA §17(3)) and, when a defect is not cured, may dismiss the procedure by a decision (JPA §18(1)).</p> <p>b. wherein the intent is not well indicated</p> <p>The amendment of the procedure is ordered or the request is dismissed by a decision on grounds that the defect is not curable because the examination cannot be conducted (JPA §134(4), JPA §135)</p> <p>(Appeal Guidebook, Chapter 22-03(3))</p>

### 2.3. Appeal intervention

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| <p>○ <b>Article 63-2 of the KPA (Furnishing of Information concerning Patent Applications)</b> Any person may, at the time a patent application is filed, furnish the Commissioner of the Korean Intellectual Property Office with information with evidence, to the effect that the patent application is unpatentable because it falls under grounds for rejection: Provided That this shall not apply where the requirements prescribed in Article 42(3)2 (Description of information of reference), Article 42(8) (Requirements for Claim Description), and Article 45 (Unity) are not complied therewith.</p> <p>○ Intervention is not allowed in an appeal against the decision to reject the patent application because the provisions related to intervention (KPA §155) and request for intervention (KPA §156) do not apply <i>mutatis mutandis</i> to such an appeal (KPA §171(2)). However, furnishing of information by a third party is allowable.</p> | <p>○ <b>Article 48 of the Implementing Regulations of the Patent Law</b> Any person may, from the date of publication of an application for a patent for invention till the date of announcing the grant of the patent right, submit to the patent administration department under the State Council his observation, with reasons therefore, on the application which is not in conformity with the provisions of the Patent Law.</p> | <p>○ <b>Article 13-2 of Regulations for Enforcement of the Patent Act (Furnishing of Information)</b> (1) Any person may provide the Commissioner of the Patent Office with information to the effect that a patent application corresponds to any of the following paragraphs by submitting publications, copies of the specification, patent claims, utility model claims, or drawings attached to the original patent or utility model application, or other documents. However, this shall not apply when the patent application is no longer pending before the Patent Office.</p> <p>(i) where the amendment to the specification, claims, or drawings attached to the original patent application(excluding a foreign language written application provided for in Article 36-2(2) of the Patent Act, a patent application in foreign language provided for in Article 184-4(1) of the same Act, and an international application in foreign language deemed to be a patent application by Article 184-2(4) of the same Act) does not meet the requirements under Article 17(2) of the Patent</p> |
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	<p>(Trial Guidebook, Part 21, Chapter 2(3))</p>		<p>Act;</p> <p>(ii) Where the invention of the patent application cannot be granted under Articles 29, 29-2 or 39(1) to (4) of the Patent Act;</p> <p>(iii) Where the patent application does not meet the requirements under Article 36(4) or (6) (excluding subparagraph (iv)) of the Patent Act; and</p> <p>(iv) Where when the patent application is a foreign language written application provided for in Article 36-2(2) of the Patent Act, the features described in the specification, claims or drawings attached to the original patent application are not within the scope of the features described in the foreign language documents provided for in Article 36-2(1) of the same Act;</p> <p>(2) The provision of information as prescribed in the previous paragraph shall be made in accordance with the documents prepared in accordance to Format 2.</p> <p>(3) The documents of the previous paragraph, notwithstanding the provision of Article 1(3), do not require the seal of a person who submits the documents.</p> <p>(4) The documents of paragraph (2), notwithstanding the provision of Article 1(3), may omit descriptions of the name, residence, or domicile of a person who submits the documents, or the name of the representative in the case of a corporation.</p> <p>○ The provisions related to intervention (JPA §148) and a request for intervention (JPA §149) shall not apply <i>mutatis mutandis</i> to an appeal against the examiner's decision of refusal (JPA §161).</p> <p>(Appeal Guidebook, Chapter 61-02(2))</p>
<h3>3. Request for Appeal</h3>			
<h4>3.1. Subject matter of request</h4>			
	<p>○ The subject matter of an appeal against a decision to reject a patent application is "a decision to reject a patent application."</p>	<p>○ The applicant who is not satisfied with the decision of rejection by the Patent Office may file a request for reexamination with the PRB. A request for reexamination shall not be accepted if it</p>	<p>○ The subject matter of a request for appeal against an examiner's decision of refusal of a patent application is 「Examiner's</p>
<p style="text-align: center;">-34-</p>			

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	(Trial Guidebook, Part 21, Chapter 2(1))	is not directed to a decision of rejection by the Patent Office.  (Guidelines for Examination, Part IV, ChapterII)	decision of refusal」 (JPA §121).  (Appeal Guidebook Chapter 61-01(1))

### 3.2. Time frame

#### 3.2.1. Period for request

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| <ul style="list-style-type: none"> <li>○ <b>Article 132-3 of the KPA (Appeal against Decision to Reject Patent Application, etc.)</b> Where a person who has received a decision to reject a patent application or a decision to reject an application to register extension of the term of a patent right has an objection to such decision, such person may request a trial within thirty days from the date of receipt of the certified copy of the decision.</li> </ul> | <ul style="list-style-type: none"> <li>○ <b>Article 41 of the Patent Law of the People’s Republic of China</b> The patent administration department under the State Council shall establish a patent review board. If a patent applicant is dissatisfied with the decision made by the Patent Administration Department under the State Council on rejecting of the application, he may, within three months from the date of receipt of the notification, file a request with the patent review board for review. After review, the Patent Review Board shall make a decision and notify the patent applicant of the same.</li> <li>○ The applicant may file a request for reexamination with the PRB within three months from the date of receipt of the decision of rejection by the Patent Office. The request for reexamination shall not be accepted if the time of filing the request does not meet this requirement.</li> </ul> <p style="text-align: center;">(Guidelines for Examination, Part IV, ChapterII)</p> <ul style="list-style-type: none"> <li>○ Where the time of filing the request for reexamination does not meet the above requirement and the petitioner files a request for restoration of right after the PRB has made a decision of non-acceptance, if the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the right shall be restored and the request for reexamination accepted; otherwise, the right cannot be restored.</li> </ul> <p style="text-align: center;">(Guidelines for Examination, Part IV, ChapterII)</p> <ul style="list-style-type: none"> <li>○ Where the time of filing the request for reexamination does not meet the above requirement and the petitioner files a request for restoration of right before the PRB has made a decision of non-acceptance, the PRB may handle the two requests together. If the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99. 1, the request for reexamination shall be accepted;</li> </ul> | <ul style="list-style-type: none"> <li>○ <b>Article 121 of the JPA (Appeal against examiner's decision of refusal)</b> A person who has received an examiner's decision to the effect that an application is to be refused and is dissatisfied may file a request for an appeal against the examiner's decision of refusal within 3 months from the date the certified copy of the examiner's decision has been served.</li> </ul> |
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3.2.2. Extension of periods	<ul style="list-style-type: none"> <li>○ <b>Article 15 of the KPA (Extension, etc. of Periods)</b> The Commissioner of KIPO or the President of the IPTAB may, upon request or ex officio, extend the period of filing trial only once up to thirty days, provided that he/she may additionally extend the times and term of the period for the benefit of a person residing in an area with poor transportation.</li> <li>○ <b>Article 21 of the Trial Practice Rules (Extension of Statutory Periods)</b> The President of the IPTAB may, upon request for extension of a statutory period under Article 15(1) of the Patent Act, extend the period of request only once up to thirty days and shall notify the extension to a person who requested the extension, provided that he/she may approve the extension of the period within two months for the benefit of a person residing in an area with poor transportation.</li> </ul>	<p>otherwise, the request for reexamination shall not be accepted.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p> <ul style="list-style-type: none"> <li>○ n/a</li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 4 of the JPA (Extension of time, etc.)</b> The Commissioner of the Patent Office may, upon request or ex officio, extend the period provided for in Articles 46-2(1)(iii), 108(1), 121(1) or 173(1), for a person in a remote area or an area with transportation difficulty.</li> <li>○ The Commissioner of the Patent Office may, upon request or <i>ex officio</i>, extend the period provided for in §121(1)(Japanese Design Act §68(1), Japanese Trademark Act §77(1)) of the Patent Act for a person in a remote area or an area with a transportation difficulty. However, in principle, the period is not extended, except for a period for an appeal against an examiner's decision of refusal of a patent application (JPA §121).  In practice, the Commissioner of the Patent Office does not extend the period for an appeal against an examiner's decision of refusal of a patent application (JPA §121) for domestic residents and may extend the period within one month only for overseas residents.  (Appeal Guidebook Chapter 61-03(1))</li> <li>○ The Commissioner of the Patent Office may, <i>ex officio</i>, extend the period up to 60 days under the provision of Article 4-of the Patent Act when a person who goes through the procedure is an overseas resident and may extend the period within one month exceptionally when the period is provided for in §121(1) of the Patent Act.  (Appeal Guidebook Chapter 25-01)</li> </ul>
3.2.3. Calculation of periods	<ul style="list-style-type: none"> <li>○ <b>Article 14 of the KPA (Calculation of Periods)</b> The periods provided for in this Act or any orders thereunder shall be calculated as follows: <ul style="list-style-type: none"> <li>1. The first day of the period shall not be counted, provided that this shall not apply to cases where the period starts at midnight.</li> <li>2. When the period is expressed in months or years, it shall be</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 5 of the Implementing Regulations of the Patent Law</b> The first day of any time limit prescribed in the Patent Law and these Implementing Regulations shall not be counted in the time limit. Where the time limit is counted by year or by month, it shall expire on the corresponding day of the last month; if there is no corresponding day in that month, the time limit shall expire on the last day of that month; if a time limit expires on an</li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 3 of the JPA (Calculation of time periods)</b>(1) The calculation of time periods under this Act or any order issued under this Act shall be made in accordance with the following provisions: <ul style="list-style-type: none"> <li>(i) The first day of the period shall not be included in the calculation; provided, however, that this shall not apply where</li> </ul> </li> </ul>

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	<p>counted according to the calendar.</p> <p>3. When the start of the period does not coincide with the beginning of a month or year, the period shall expire on the day preceding the date in the last month or year of the period corresponding to the date on which the period started, provided that where the period is expressed in months or years and there is no corresponding date in the last month, the period shall expire on the last day of that month;</p> <p>4. If the last day of the period for executing a patent-related procedure falls on an official holiday (including Saturdays and the Labor day designated by the Designation of Labor Day Act), the said period shall expire on the working day following such holiday.</p> <p>○ The period of thirty days does not refer to one month. Considering that the first day of the period is not counted (KPA §14), for example, when a document is delivered on May 1, a petition for trial shall be filed between May 2 and May 31. When May 31 is Sunday, the period is extended to the next day, i.e., June 1. Where the period is extended pursuant to Article 15(1) of the Patent Act, a procedure can be taken until the extended date.</p> <p>(Trial Guidebook Part 21. Chapter 3(4))</p>	<p>official holiday, it shall expire on the first working day following that official holiday.</p> <p>○ All of the specified time limits and part of the prescribed time limits are calculated from the date on which a notification or a decision is presumably received. For example, the time limit for the applicant to make observations or amend the application specified by the examiner in accordance with Article 37(specified time limit) of the Patent Law is calculated from the date on which the Office Action is presumably received by the applicant. The time limit for the applicant to go through the formalities of registration as provided for in Article 54.1 of the Implementing Regulations of the Patent Law (prescribed time limit) is calculated from the date on which the Notification to Grant Patent Right is presumably received by the applicant.</p> <p>(Guidelines for Examination, Part V, ChapterVII)</p> <p>○ The date on which a document is presumably received refers to the 16th day from the date of the issuance of the said document by the Patent Office (the date is indicated in the notification or the decision). For example, where a notification is issued on 4 July, 2001 by the Patent Office, the date on which the notification is presumably received shall be 19 July, 2001.</p> <p>(Guidelines for Examination, Part V, ChapterVII)</p> <p>○ The first day (Dies a Quo) of any time limit is not to be calculated in. Where a time limit is calculated by year or by month, it shall expire on the corresponding day (the date corresponding Dies a Quo)of the last month; if there is no corresponding day in that month, the time limit shall expire on the last day of that month. For example, if the filing date of a patent application for invention is 1 June, 1998, the expiration date of the time limit for requesting the substantive examination shall be 1 June, 2001.</p> <p>(Guidelines for Examination, Part V, ChapterVII)</p> <p>○ For another example, if an Office Action is sent by the Patent Office on 6 June, 2008, the date on which it is presumably received is 21 June,2008 (the date cannot be postponed in case of statutory holidays); if the specified time limit for this</p>	<p>the period of time commences at midnight.</p> <p>(ii) Where the period is indicated by months or years, such months or years shall refer to calendar months or calendar years. Where the period is not calculated from the beginning of a month or a year, the period shall expire on the preceding day of the day corresponding to the first day of the calculation in the last month or year; provided, however, that where there is no corresponding day in the last month, the period shall expire on the last day of the last month.</p> <p>(2) Where the last day of the prescribed period for any procedures relating to a patent (hereinafter referred to as "procedures") including filing a patent application and a request, is any of the days provided for in Article 1(1) of the Act on Holidays of Administrative Organs (Act No. 91 of 1988), the day following such day shall be the last day of the period.</p> <p>○ The extension period shall be calculated as follows:</p> <p>The extension period provided for in Articles 4 and 5 of the Patent Act refers to a lawful period that complies with the original period and the extended period. Thus, the "last day of the period" mentioned in Article 3(2) of the Patent Act refers to the last day of a period calculated from the date on which the original period started. Accordingly, even if the last day of the original period corresponds to Saturday, Sunday or an official holiday, the provision of §3(2) of the Patent Act does not apply to such cases.</p> <p>(Appeal Guidebook Chapter 25-02)</p>

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		<p>notification is two months, the expiration date shall be 21 August, 2008. For another example, if a notification is sent by the Patent Office on 16 December, 1999, the date on which it is presumably received is 31 December, 1999. If the specified time limit for this notification is two months, the expiration date shall be 29 February, 2000.</p> <p>(Guidelines for Examination, Part V, ChapterVII)</p> <p>○ If a time limit expires on an official holiday or an adjusted weekly holiday, the time limit shall be extended to expire on the first working day after that official holiday or the adjusted weekly holiday; if the first working day is a weekly holiday, the expiration date shall be postponed to next Monday. Statutory holidays include the holidays enjoyed by all citizens as provided for in Article 2 of the "Measures on Having a Holiday for National Annual Leaves and Memorial Days" promulgated by the State Council and the weekly holidays as provided for in Article 7.1 of the "Provisions of the State Council on Working Hours of Workers and Staff".</p> <p>(Guidelines for Examination, Part V, ChapterVII)</p>	
<p><b>3.3. Written request for appeal</b></p>			
<p>3.3.1. Purport of the request</p>	<p>○ The purport of the request shall describe the content of the decision which the applicant seeks and specify a patent application as a subject matter to be claimed.</p> <p>The section entitled "Purport of Request" is generally described as follows: "The original decision shall be canceled. Korean Patent Application No. 00000 shall be granted."</p> <p>(Trial Guidebook Part 21. Chapter 4(2))</p>		<p>○ The object of request shall describe a decision sought by the applicant and specify a patent application which is a subject matter to be claimed.</p> <p>The section entitled "Object of Request" is generally described as follows: "The decision that Japanese Patent Application No. 20 X X -000000 is rejected shall be canceled. The subject patent shall be granted."</p> <p>(Appeal Guidebook Chapter 61-04(1))</p>
<p>3.3.2. Grounds of the request</p>	<p>○ For grounds of the request, the grounds for cancelling the decision of rejection in accordance with the purport of the request shall be described.</p> <p>(1) In the case of a request for appeal where grounds of the request are not described for the reason that a patent application is subject to reconsideration by an examiner before an appeal, when the original decision is maintained as a result of the</p>	<p>○ <b>Article 60.1 of the Implementing Regulations of the Patent Law</b> The petitioner shall submit request for reexamination and explain the causes therein, and attach the relevant evidence if necessary.</p> <p><b>Article 60.3 of the Implementing Regulations of the Patent Law</b> Request for reexamination shall comply with the prescribed format. Where the request for reexamination is not in</p>	<p>○ a. For grounds of the request, the grounds to cancel the examiner's decision of refusal in accordance with the object of request shall be described.</p> <p>b. In the section entitled "Grounds of Request," the procedural history of the decision of examiner's decision of refusal and the grounds of the examiner's decision of refusal should be summarized first and the grounds to cancel the examiner's</p>

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	<p>reconsideration, it is requested that the grounds of the request be amended within a designated period (KPA §140-2(1) and(3)).</p> <p>(2) In the section entitled "Grounds of Request," the procedural history of the decision to reject a patent application and the grounds of the decision to reject a patent application should be summarized first and the grounds to cancel the decision to reject a patent application should be described specifically and clearly.</p> <p>(3) Where an amendment is made to the specification or drawings while filing a request for appeal, the grounds to cancel the decision to reject a patent application must be described based on the specification or drawings as amended when filing a request for appeal.</p> <p>(4) Where an appeal is filed against a dismissal of an amendment which was made during the examination of a patent application and a request for appeal is filed without an amendment to the specification or drawings, the purport of appeal against a dismissal of an amendment and the grounds to cancel the dismissal of an amendment should be described and the grounds to cancel the decision to reject a patent application based on the specification or drawings before the dismissal of the amendment should be described.</p> <p>(5) Where an appeal is filed against a dismissal of an amendment that was made during the examination of a patent application and also an amendment is made to the specification or drawings upon filing a request for appeal, grounds for cancellation of the decision to reject a patent application based on the specification or drawings amended when filing a request for appeal should be described.</p> <p>(Trial Guidebook Part 21. Chapter 4(3))</p> <p>○ The description of grounds for a request for appeal is mandatory under KPA§140(1)3 and KPA§140-2(1)6.</p> <p>Since the grounds for a request for appeal are important for understanding the argument of a petitioner in a clear and expedited manner in reconsideration by examiner before appeal or in appeal proceeding by an administrative patent judge, the substantial reasons should be clearly described in the grounds</p>	<p>the prescribed format, the Patent Reexamination Board shall notify the petitioner to make rectification within a specified time limit. If, within the time limit, no rectification is made or the defect has not been overcome after two rectifications, the request for reexamination shall be deemed not to have been made.</p>	<p>decision of refusal should be described specifically and clearly.</p> <p>c. Where an amendment is made to the specification, claims or drawings while filing a request for appeal, the grounds to cancel the examiner's decision of refusal must be described based on the specification, claims or drawings as amended when filing a request for appeal.</p> <p>d. Where an appeal is filed against a decision to dismiss an amendment which was made during the examination of a patent application and a request for appeal is filed without an amendment to the specification, claims, or drawings, the object of appeal against a decision to dismiss an amendment and the grounds to cancel the decision to dismiss an amendment should be described and the grounds to cancel the examiner's decision of refusal must be described based on the amended specification, claims and drawings.</p> <p>e. Where an appeal is filed against a decision to dismiss an amendment that was made during the examination of a patent application and also an amendment is made to the specification, claims, or drawings upon filing a request for appeal, grounds for cancellation of the examiner's decision of refusal are based on the specification, claims, and drawings amended upon filing a request for appeal. In addition, since an amendment made upon filing a request for appeal is made on the rejected specification, claims, and drawings, all the subject matters appealed against a decision to dismiss the amendment are required to be included in an amendment made upon filing a request for appeal.</p> <p>(Appeal Guidebook Chapter 61-04(1))</p> <p>○ Since the grounds for a request for appeal are important for understanding the argument of a demandant in a clear and expedited manner in reconsideration or examination in an appeal, the substantial reasons should be clearly described in the grounds for a request for appeal when filing an appeal.</p> <p>Where no substantive reasons are described in "grounds for request" in a request for appeal, since the request does not comply with JPA§131(1)(iii), it shall be ordered to be amended</p>



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	<p>for a request for appeal when filing an appeal.</p> <p>Where no substantial reason is described in "grounds for request," a request for appeal shall be ordered to be amended in accordance with KPA§141(1)1. Where such amendment is not made within a designated period, the request for appeal shall be dismissed by a decision under KPA§141(2).</p> <p>However, in the case of reconsideration by examiner before appeal (an application filed on or before June 30, 2009), an amendment shall be ordered in the name of the presiding administrative patent judge after the reconsideration is closed.</p> <p>The following cases also are regarded as the case where substantial reasons are not described:</p> <p>a. where only an intent for supplementation is described (e.g., "detailed grounds will be supplemented later," and the like);</p> <p>b. where only an intent for appealing the decision to reject a patent application is described (e.g., "The Petitioner protests against Decision to Reject a Patent Application"), but the detailed grounds for the rejection are not described;</p> <p>c. where only a history until reaching the decision to reject a patent application is described;</p> <p>d. where only what corresponds to a combination of cases (a) through (c) is described.</p> <p>Even in the case where the formalities were examined by a formality examiner in Trial Policy Division of IPTAB and then transferred to the administrative patent judges, the grounds of the request may not have been substantively described. Such case should be handled by a written examination by the presiding administrative patent judges of collegial body for appeal.</p> <p>(Trial Guidebook Part 3. Chapter 4(5))</p>		<p>in accordance with JPA§133(i) (or JPA§17(iii)). Where the request for appeal is not amended within a designated period, it shall be dismissed by a decision under JPA §133(3)(or JPA§18(1)).</p> <p>Particularly, the details of handling an appeal against an examiner's decision of refusal of a patent application and the standards thereof are as follows.</p> <p>(1) Details of handling</p> <p>a. When an amendment is made to the specification, claims, or drawings at the same time as filing a request for appeal, an applicant is notified of "a Notice of Requesting an Amendment to a Procedure" issued by the order of the Commissioner under JPA§17(3). Where an amendment is not made within a period of time designated by the order, a requested proceeding shall be dismissed under JPA §18(1).</p> <p>b. In addition to item (a), an applicant is notified of "a Notice of Requesting an Amendment to a Procedure" ordered by the presiding administrative judge under JPA§133(1) (→21-02, Form 2). Where an amendment is not made within a period of time designated by the order, a request for appeal shall be dismissed by decision under JPA§133(3).</p> <p>(2) Standards for handling</p> <p>a. where only an intent for supplementation is described (e.g., "detailed grounds will be supplemented later," and the like);</p> <p>b. where only an intent for appealing the examiner's decision of refusal <i>per se</i> is described (e.g., "protest against examiner's decision of refusal") and the detailed grounds for the rejection are not described;</p> <p>c. where only a history of the examiner's decision of refusal is described; and</p> <p>d. where only what corresponds to a combination of cases (a) through (c) is only described.</p> <p>(Appeal Guidebook Chapter 21-03(1))</p>

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**3.4. Fees**

- **Article 82 of the KPA (Fees)** (1) A person undertaking a patent-related procedure shall pay the official fees.  
  
 (2) Where the number of claims is increased because of amendments to the specification attached to the patent application after a request for examination made by a person other than the applicant, the applicant shall pay the fees for the request for examination corresponding to the increased number of claims.  
  
 (3) The fees under paragraph (1), the method and period for payment and other necessary matters are prescribed by Ordinance of the Ministry of Trade, Industry and Energy.
  
- **Regulation of Collection of Patent Fees, etc., Article 2 (Patent Fees and Patent Related Fees)** (3) Fees relating to a request for trial set forth in Article 82 of the KPA fall in each paragraph below:
  1. Fees for filing a request for appeal against the decision to reject a patent application, Correction Trial, and Correction Invalidation Trial. .
    - a. 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;
    - b. 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

- **Article 93, 94 of the Implementing Regulations of the Patent Law** If the petitioner files the request for reexamination within three months from the date of receipt of the decision of rejection, but has not paid, or not paid in full, the reexamination fee within the time limit, the request for reexamination shall be deemed not to have been made.  
  
 Where a request for restoration of right is filed after the Patent Reexamination Board has made the decision that the request for reexamination is deemed not to have been made, if the request is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the right shall be restored and the request for reexamination accepted; otherwise, the right shall not be restored.  
  
 Where the reexamination fee is paid in full after three months from the date of receipt of the decision of rejection and the request for restoration of right is filed before the decision of deeming the request for reexamination not to have been filed is made, the Patent Reexamination Board may handle the two requests together. If the request for restoration of right is in conformity with the provisions concerning restoration of right as provided in Rules 6 and 99.1, the request for reexamination shall be accepted; otherwise, the request for reexamination shall be deemed not to have been made.
  
- The reexamination fee is 1000 Yuan for an invention, and 300 Yuan for an utility model or a design

- **Article 195 of the JPA and Attached Table, Ordinance on Fees Concerning Patent Acts, etc., Article 1, Paragraph 1** 49,500 yen per case plus 5,500 yen per claim
  
- **Article 195 of the JPA (Fees)**
  - (2) The persons listed in the column of the attached table shall pay fees in the amount as provided by Ordinance within the range of the amounts specified in the corresponding below column of the table.

	A person(s) who shall pay fees	Amounts
11	A person filing a request for a trial or retrial (excluding one in the following item)	49,500 yen per case plus 5,500 yen per claim

- **Ordinance on Fees Concerning Patent Acts, etc., Article 1**
  - (2) Fees that shall be paid under Patent Act 195-2(including the case where an applicant receives a discount on fees under Article 39-3 of Laws on Special Measures Concerning Industrial Property Right Proceedings, etc.) are summarized in the table below. .

	A person(s) who shall pay fees	Amounts
11	A person filing a request for an appeal or retrial (excluding one in the following subparagraph)	49,500 yen per case plus 5,500 yen per claim

**4. Formality examination**

**4.1. General**

- **Article 141 of the KPA (Dismissal of a Request for a Trial)** (1) A presiding administrative patent judge shall order to make
- **Article 60 of the Implementing Regulations of the Patent Law** Where the applicant requests the Patent Reexamination
- **Article 133 of the JPA (Dismissal by decision in the case of non-compliance with formal requirements)** (1) Where a

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	<p>an amendment within a designated period in either case of the following subparagraphs:</p> <ol style="list-style-type: none"> <li>1. where the written request for a trial does not comply with Articles 140(1) and (3) to (5) or 140-2(1);</li> <li>2. where a trial-related procedure falls under any of the following items: <ol style="list-style-type: none"> <li>(a) where the procedure does not comply with Articles 3(1) (Minors) or 6 (Authority of Representation);</li> <li>(b) where the fees under Article 82 have not been paid; or</li> <li>(c) where the procedure does not comply with the formalities prescribed in this Act or Presidential Decree.</li> </ol> </li> <li>(2) Where a person ordered to make an amendment under paragraph (1) fails to do so within the designated period, the presiding administrative patent judge shall dismiss the written request for a trial by a decision.</li> <li>(3) A decision to dismiss a request for a trial under paragraph (2) shall be in writing and shall state the reasons for the ruling.</li> </ol> <ul style="list-style-type: none"> <li>○ <b>Article 142 of the KPA (Dismissal of a Request for a Trial Containing Incurable Defects)</b> Where a request for a trial contains unlawful defects that cannot be corrected by amendment, the request may be dismissed by a decision without giving the appellee an opportunity to submit a written response.</li> <li>○ Where a request for appeal against an examiner's decision to reject a patent application does not comply with KPA§140-2 and falls under KPA§141(1), a presiding administrative patent judge shall order to make an amendment and, where such amendment is not made, shall dismiss the written request by a decision (KPA§141(2)).</li> </ul> <p>Where a request for trial complies with formalities, etc. but contains unlawful defects which cannot be corrected by an amendment, such a request may be dismissed by a trial decision (KPA§142). For example, a request filed after the deadline for filing a request for trial, etc. falls in such case.</p>	<p>Board to make a reexamination in accordance with the provisions of Article 41 of the Patent Law, he or she shall file a request for reexamination, state the reasons and, when necessary, attach the relevant supporting documents.</p> <p>Where the request for reexamination does not comply with the provisions of Article 19, paragraph one or Article 41, Paragraph one of the Patent Law, the Patent Reexamination Board shall refuse to accept it, notify the applicant in written form and state the reasons thereof.</p> <p>Where the request for reexamination does not comply with the prescribed form, the person making the request shall rectify it within the time limit specified by the Patent Reexamination Board. If the requesting person fails to do so, the request for reexamination shall be deemed not to have been filed.</p> <ul style="list-style-type: none"> <li>○ Eligibility as a Petitioner for Reexamination</li> </ul> <p>The applicant of a rejected application may file a request for reexamination with the PRB. Where the person filing a request for reexamination is not the applicant of the rejected application, the request shall not be accepted. Where a rejected application has two or more applicants and the petitioner for reexamination does not include all the applicants, the PRB shall notify the petitioner to make rectification within a specified time limit. If the defect is not rectified within the time limit, the request for reexamination shall be deemed not to have been made.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p> <ul style="list-style-type: none"> <li>○ The Object of a Request for Reexamination</li> </ul> <p>The applicant who is not satisfied with the decision of rejection by the Patent Office may file a request for reexamination with the PRB. A request for reexamination shall not be accepted if it is not directed to a decision of rejection by the Patent Office.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p> <ul style="list-style-type: none"> <li>○ Time Limit</li> </ul> <p>The applicant may file a request for reexamination with the PRB within three months from the date of receipt of the decision of</p>	<p>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.</p> <ol style="list-style-type: none"> <li>(2) Excluding the case as provided in the preceding subparagraph, the chief administrative judge may order the demandant to amend a procedure pertaining to the appeal, designating an adequate time limit, in any of the following cases: <ol style="list-style-type: none"> <li>(i) where the procedure does not comply with paragraphs (1) to (3) of Article 7 or Article 9;</li> <li>(ii) where the procedure does not comply with formal requirements as provided in this Act or an order thereunder; and</li> <li>(iii) where the fees for a procedure payable under Articles 195(1) or 195(2) have not been paid.</li> </ol> </li> <li>(3) The chief administrative judge may dismiss the procedure by a decision where a person ordered to make an amendment to a procedure pertaining to an appeal fails to make such amendment within the time limit designated under the preceding two subparagraphs or where such amendment is made in violation of Article 131-2(1).</li> <li>(4) The decision under the preceding subparagraph shall be made in writing and state the grounds thereof.</li> </ol> <ul style="list-style-type: none"> <li>○ <b>Article 133-2 of the JPA</b> (1) In the procedures pertaining to an appeal case (excluding a request for an appeal), the chief administrative judge may, by a decision, dismiss procedures that are unlawful and not amendable.</li> </ul> <ol style="list-style-type: none"> <li>(2) Where the presiding administrative judge intends to dismiss a procedure under the preceding paragraph, he/she shall notify the person who undertook the procedures of the reasons therefor, and give the said person an opportunity to submit a statement of explanation, designating an adequate time limit.</li> <li>(3) The decision under this paragraph (1) shall be in writing and state the grounds therefor.</li> </ol> <ul style="list-style-type: none"> <li>○ <b>Article 135 of the JPA (Dismissal of inadequate request for</b></li> </ul>

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	<p>(Trial Guidebook Part 21. Chapter 4(5))</p>	<p>rejection by the Patent Office. The request for reexamination shall not be accepted if the time of filing the request does not meet this requirement.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p> <p>○ Fees</p> <p>If the petitioner files the request for reexamination within three months from the date of receipt of the decision of rejection, but has not paid, or not paid in full, the reexamination fee within the time limit, the request for reexamination shall be deemed not to have been made.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p> <p>○ Notification on Formal Examination</p> <p>Where, after formal examination, the request for reexamination is considered not in conformity with the relevant provisions of the Patent Law or its Implementing Regulations or these Guidelines and needs to be rectified, the PRB shall issue notification to make a Rectification, and invite the petitioner to make rectification within fifteen days from the date of receipt of the notification.</p> <p>Where the request for reexamination is deemed not to have been made or is not accepted, the PRB shall respectively issue notification that request for reexamination deemed not to have been made or notification of non-acceptance of request for reexamination to notify the petitioner.</p> <p>Where, after formal examination, the request for reexamination is considered in conformity with the relevant provisions of the Patent Law and its Implementing Regulations and these Guidelines, the PRB shall issue notification of acceptance of request for Reexamination to notify the petitioner.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p><b>appeal by decision</b>) An unlawful request for an appeal, that is not amendable, may be dismissed by an appeal decision without giving the demandee an opportunity to submit a written answer.</p> <p>○ Where a request for an appeal against an examiner's decision of refusal does not comply with JPA§131(1) or falls under JPA§133(2), the chief administrative judge shall order an amendment (JPA§133(1)(2)). Where a person ordered to make an amendment fails to make such amendment, the chief administrative judge may dismiss the procedure by a decision (JPA§133(3)).(Note)</p> <p>(Note) In an appeal against an examiner's decision of refusal, where the specification, claims, or drawings is amended concurrent with filing a request for appeal, the Commissioner of the Patent Office may order an amendment (JPA§17(3)). Where an applicant does not response to this order, the Commissioner of the Patent Office may dismiss the procedures (JPA§18).</p> <p>Even where a request for appeal satisfies the requirements of a request for an appeal, etc. (JPA§131(1), 195(2)), an unlawful request for appeal, that is not amendable, may be dismissed by a decision (JPA§135).</p> <p>As examples of a request for appeal that is not amendable, there are, ① a request for appeal which was filed after the deadline for filing a request expired, ② a request for appeal which was not jointly filed by all persons sharing a right sought to be patented, and ③ a later-filed appeal request where another request for appeal against an examiner's decision of refusal is redundantly filed on one patent application.</p> <p>Appeal Guidebook Chapter 61-04(2))</p>
<p><b>4.2. Change of gist</b></p>	<p>○ A request for trial may be amended while the case is continuing with the IPTAB, and the amendment cannot change the gist of the request. However, this does not apply to the grounds of the</p>	<p>○ n/a</p>	<p>○ A request for appeal may be amended while the case is pending at the Patent Office (JPA§17(1)), and the amendment shall not change the gist of the request. However, this does not apply to</p>

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	<p>request.</p> <p>For a request for appeal against an examiner's decision to reject a patent application filed after July 1, 2009, an amendment (including an addition) correcting a description of a petitioner does not constitute change of gist (KPA§140-2(2)).</p> <p>(Trial Guidebook Part 21. Chapter 4(6))</p>		<p>the grounds for a request for appeal (JPA§131-2(1)).</p> <p>(Appeal Guidebook Chapter 61-04(4))</p> <p>○ Any amendment made by a demandant and a demandee is regarded as a change of the gist of the request, except the case where the subject matter remains the same (e.g., correction of typographical errors, etc.) (Recent Precedents Sho 53. 3.24.).</p> <p>(Appeal Guidebook Chapter 30-01(2))</p>

## 5. Grounds for rejection

<p>○ <b>Article 62 of the KPA (Decision to Reject a Patent Application)</b> An examiner shall make a decision to reject a patent application for any of the following grounds (referred to as "the grounds for rejection," hereinafter):</p> <ol style="list-style-type: none"> <li>1. where the invention is unpatentable under Articles 25(Capacity of Foreigners), 29(Requirements for Patent Registration), 32(Unpatentable Inventions), 36(1) to (3) (First-to-File Rule), or 44(Joint Applications);</li> <li>2. where the application is filed by a person who does not have the right to obtain a patent under the main sentence of Article 33(1)(Persons Entitled to Obtain a Patent)or where the invention is unpatentable under the proviso of Article 33(1);</li> <li>3. where the application violates a treaty;</li> <li>4. where the application does not comply with the requirements of Articles 42(3) (Specification Description Defects), 4(Claim Description Defects), 8(Claim Drafting Requirements), or 45(Untity);</li> <li>5. where the application is amended beyond the scope of Article 47(2)(Prohibition on Addition of New Matters);</li> <li>6. where the application is a divisional application beyond the scope of Article 52(1); or</li> <li>7. where the application is a conversion application beyond the scope of Article 53(1).</li> </ol>	<p>○ <b>Article of the Patent Law of the People's Republic of China</b> Where, after the applicant has made the observations or amendments, the patent administration department under the State Council finds that the application for a patent for invention is still not in conformity with the provisions of this Law, the application shall be rejected.</p> <p>○ <b>Article 53 of the Implementing Regulations of the Patent Law</b> In accordance with the provisions of Article 38 of the Patent Law, the circumstances where an application for a patent for invention shall be rejected by the patent administration department under the State Council after examination as to substance are as follows:</p> <ol style="list-style-type: none"> <li>(1) where the application falls under Article 5 or 25 of the Patent Law, or the applicant is not entitled to a patent right in accordance with the provisions of Article 9 of the Patent Law;</li> <li>(2) where the application does not comply with the provisions of Article 2, paragraph two, Article 20, paragraph one, Article 22,Article 26,paragraph three, four or five, or Article 31, paragraph one of the Patent Law, or of Rule 20,paragraph two of these Implementing Regulations;</li> <li>(3) where the amendment to the application does not comply with the provisions of Article 33 of the Patent Law, or the divisional application does not comply with the provisions of Rule 43, paragraph one of these Implementing Regulations.</li> </ol>	<p>○ <b>Article 49 of the JPA (Examiner's decision of refusal)</b> The examiner shall render an examiner's decision to the effect that a patent application is to be refused, where the patent application falls under any of the following:</p> <ol style="list-style-type: none"> <li>(i) an amendment made to the specification, claims or drawings attached to the application of a patent application does not comply with the requirements as provided in Article 17-2 (3) or (4);</li> <li>(ii) the invention claimed in the patent application is not patentable under Article 25, 29, 29-2, 32, 38 or 39(1) to 39(4);</li> <li>(iii) the invention claimed in the patent application is not patentable under the provisions of any relevant treaty;</li> <li>(iv) the patent application does not comply with the requirements under Article 36(4)(i), 36(6), or 37;</li> <li>(v) where notice under the preceding Article has been given, following the amendment of the description or submission of the written opinion, the patent application does not comply with the requirements under Article 36(4)(ii);</li> <li>(vi) where the patent application is a foreign language written application, matters stated in the specification, claims or drawings attached to the application of the said patent application do not exist within the scope of matters stated in foreign language documents;</li> <li>(vii) where the applicant for the patent does not retain the right to obtain a patent for the said invention.</li> </ol>
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<b>6. Reconsideration by examiner before appeal</b>			
<b>6.1. Specification and drawings for reconsideration by examiner</b>			
	<ul style="list-style-type: none"> <li>○ The subject matters for reconsideration by examiner before appeal are limited to a patent application, a utility model registration application, and a design application where an amendment to the specification or drawings are made within thirty days from the date of filing a request for appeal against an examiner's decision to reject a patent application.</li> </ul> <p>(Trial Guidebook Part 21 Chapter 6(3))</p>	<ul style="list-style-type: none"> <li>○ According to Rule 62, the PRB shall transfer the request for reexamination (including any proof document and the amended application document attached thereto) having passed formal examination to the previous examination department which made the decision of rejection for interlocutory examination, together with the application dossier.</li> </ul> <p>The previous examination department shall provide its opinion on interlocutory examination, and make a Note of Interlocutory Examination Opinion. Except in special situations, interlocutory examination shall be completed within one month after receipt of the dossier.</p>	<ul style="list-style-type: none"> <li>○ In the case of a request for appeal against an examiner's decision of refusal, where an amendment has been made to the specification, claims, or drawings attached to the application in the patent application at the same time of filing the request, the Commissioner of the Patent Office shall direct an examiner to examine the request (Reconsideration) (JPA§162)</li> </ul> <p>(Appeal Guidebook Chapter 61-05(4))</p>
<b>6.2. Scope of an amendment to a specification or drawings</b>			
	<ul style="list-style-type: none"> <li>○ <b>Article 47 of the KPA (Amendment to Patent Application)</b> (1) A patent applicant may amend the specification or drawings attached to a patent application within the period prescribed by each subparagraph of Article 42 (5) or before delivering a certified copy of a decision to grant a patent pursuant to Article 66: Provided, That after receiving a notice of grounds for rejection pursuant to Article 63 (1) (hereinafter referred to as "notice of grounds for rejection"), a patent applicant may amend the specification or drawings during the period prescribed in the following subparagraphs only (in cases under subparagraph 3, referring to that time):</li> </ul> <ol style="list-style-type: none"> <li>1. Where an applicant receives a notice of grounds for rejection (excluding a notice of grounds for rejection with regard to a ground for rejection which has arisen according to the amendment following the notice of grounds for rejection) for the first time or receives a notice of grounds for rejection, other than that referred to in subparagraph 2, the period for presentation of a written opinion following the relevant notice of grounds for rejection;</li> <li>2. Where an applicant receives a notice of grounds for rejection with regard to a ground for rejection which has arisen according to the amendment following the notice of grounds for rejection,</li> </ol>	<ul style="list-style-type: none"> <li>○ <b>Article 33 of the Patent Law of the People's Republic of China</b> An applicant may amend his or its application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of disclosure contained in the initial description and claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.</li> </ul> <p><b>Article 61 of the Implementing Regulations of the Patent Law</b> The person making the request may amend its or his patent application at the time when it or he requests reexamination or makes responses to the notification of reexamination of the Patent Reexamination Board. However, the amendments shall be limited only to remove the defects pointed out in the decision of rejection of the application or in the notification of reexamination.</p> <p>The amendments to the application for patent shall be in two copies.</p> <ul style="list-style-type: none"> <li>○ The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral</li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 17-2 of the JPA (Amendment of Specification, Claims, or Drawings attached to the application) (1)</b> An applicant for a patent may amend the specification, claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:</li> </ul> <ol style="list-style-type: none"> <li>(i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied <i>mutatis mutandis</i> pursuant to Article 159(2) (including the cases where it is applied <i>mutatis mutandis</i> pursuant to Article 174(1)) and Article 163(2), hereinafter the same shall apply in this paragraph) and the said amendment is made within the designated time limit under Article 50;</li> <li>(ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48-7 and said amendment is made within the designated time limit under Article 2;</li> <li>(iii) where, following the receipt of the notice of reasons for</li> </ol>

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	<p>the period for presentation of a written opinion following the relevant notice of grounds for rejection;</p> <p>3. When an applicant requests a re-examination pursuant to Article 67-2.</p> <p>(2) An amendment to the specification or drawings under paragraph (1) shall be made within the scope of the features disclosed in the specification or drawings initially attached to the patent application.</p> <p>(3) An amendment to the scope of claims, from among amendments pursuant to paragraph (1) 2 and 3, may be made only where it falls under any of the following subparagraphs:</p> <p>1. Where the scope of claims for a patent is reduced by limiting, deleting, adding claims;</p> <p>2. Where wrong description is corrected;</p> <p>3. Where ambiguous description is made clear;</p> <p>4. With regard to an amendment beyond the scope referred to in paragraph (2), where returning to the scope of claims made prior to the amendment, or amending the scope of claims pursuant to subparagraphs 1 through 3 in the course of returning to the said scope of claims.</p> <p>(4) Where a patent application is amended within the period specified in paragraph (1) 1 or 2, all amendments made before the last amendment in the course of each amendment shall be deemed withdrawn.</p> <p>○ <b>Article 51 of the KPA (Dismissal of an Amendment)</b></p> <p>(1) Where an examiner deems that an amendment pursuant to Article 47 (1) 2 and 3 has violated paragraphs (2) and</p> <p>(3) of the same Article or that a new ground for rejection has arisen following the amendment (excluding an amendment deleting claims pursuant to paragraph (3)1 and 4 of the same Article), he/she shall dismiss such amendment by decision: Provided, That where a request for re-examination is made pursuant to Article 67-2, this shall not apply to an amendment</p>	<p>Proceedings for Request for Reexamination), or appearing in oral proceedings. Any amendment, however, shall meet the requirements of Article 33 and Rule 61.1.</p> <p>○ According to Rule 61.1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. Generally, the above requirement is not considered to be met in the following cases:</p> <p>(1) where a claim amended extend the extent of protection as compared with the claim rejected in the decision of rejection;</p> <p>(2) where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the decision of rejection;</p> <p>(3) where the type of a claim is altered, or the number of claims is increased; or</p> <p>(4) where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature with that indicated in the decision of rejection.</p>	<p>refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of grounds for rejection; and</p> <p>(iv) where an amendment is made at the same time as filing a request for an appeal against an examiner's decision of refusal.</p> <p>(2) Where an applicant of a foreign language written application as provided in Article 36-2(2) amends the specification, claims or drawings under the preceding paragraph for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.</p> <p>(3) Except in the case where said amendment is made through the submission of a statement of correction of an incorrect translation, any amendment of the specification, claims or drawings under paragraph (1) shall be made within the scope of the matters described in the specification, claims or drawings originally attached to the application (in the case of a foreign language written application under Article 36-2(2), the translation of the foreign language documents as provided in Article 36-2(2) that is deemed to be the specification, claims and drawings under Article 36-2(4) (in the case where the amendment to the specification, claims or drawings has been made through the submission of the statement of correction of an incorrect translation, said translation or the amended specification, claims or drawings), same in the cases of Article 34-2(1) and Article 34-3(1)).</p> <p>(4) In addition to the case provided in the preceding paragraph, where any amendment of the scope of claims is made in the cases listed in the items of paragraph (1), the invention for which determination on its patentability is stated in the notice of reasons for refusal received prior to making the amendment, and the invention constituted by the matters described in the amended scope of claims, shall fall within one group of inventions recognized as fulfilling the requirements of unity of invention set forth in Article 37.</p> <p>(5) In addition to the requirements provided in the preceding</p>



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	<p>made prior to such request.</p> <p>(2) The decision to reject an amendment under paragraph (1) shall be made in writing and shall state the reasons therefor.</p> <p>(3) No appeal shall be made against a ruling of dismissal under paragraph (1): Provided, That this shall not apply to a dispute concerning the ruling of dismissal (where a request for re-examination is filed pursuant to Article 67-2, a ruling of dismissal made before such request is filed shall be excluded) in a trial on the decision of refusal of a patent pursuant to Article 132-3.</p>		<p>two paragraphs, in the cases of subparagraphs (i), (iii) and (iv) of paragraph (1) (in the case of subparagraph (i) of the said paragraph, limited to the case where the applicant has received a notice under Article 50-2 along with the notice of reasons for refusal), the amendment of the scope of claims shall be limited to those for the following purposes:</p> <p>(i) the deletion of a claim or claims as provided in Article 36(6);</p> <p>(ii) the restriction of the claims (limited to the cases where the restriction is to restrict matters required to identify the invention stated in a claim or claims under Article 36(5), and the industrial applicability and the problem to be solved of the invention stated in the said claim or claims prior to the amendment are identical with those after the amendment);</p> <p>(iii) the correction of errors; and</p> <p>(iv) the clarification of an ambiguous statement (limited to the matters stated in the reasons for refusal in the notice of reasons for refusal).</p> <p>(6) Article 126(7) shall apply <i>mutatis mutandis</i> to cases under subparagraph (ii) of the preceding paragraph.</p> <p>○ <b>Article 53 of the JPA (Dismissal of amendment)</b> (1) In the case of Article 17-2(1)(i) or 17-2(1)(iii) (in the case of Article 17-2(1)(i), limited to the case where the examiner has given a notice under Article 50-2 along with the notice of reasons for refusal), where, prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, an amendment made to the specification, claims or drawings attached to the application is found not to comply with paragraphs (3) to (6) of Article 17-2, the examiner shall dismiss the amendment by a decision.</p> <p>(2) The decision dismissing an amendment under the preceding paragraph shall be made in writing and state the reasons therefor.</p> <p>(3) The decision dismissing an amendment under paragraph (1) shall not be subject to appeal; provided, however, that where a request for an appeal against an examiner's decision of refusal</p>



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			has been filed, this shall not apply to the appeal made in the proceeding in the said appeal.
<p><b>6.3. Procedure of reconsideration by examiner before appeal</b></p>			
	<p>○ If a patent application shall be returned to the examiner for reconsideration when appealing the decision to reject the patent application, the written request for appeal may not state the grounds for request. In case the grounds for request are not described, when the decision to reject the patent application is upheld as a result of the reconsideration, the grounds for request shall be amended.</p> <p>(Trial Guidebook Part 21 Chapter 6(3))</p> <p>○ The formality examination of a regular request for appeal shall be conducted by a presiding administrative patent judge designated by the President of the IPTAB. However, in a case where an application shall be returned to the examiner for reconsideration, the formality examination of a request for appeal for such a case shall be conducted by the President of the IPTAB because a presiding administrative patent judge cannot be designated at this stage.</p> <p>Thus, in an appeal where an application shall be returned to the examiner for reconsideration, the President of the IPTAB may issue a notice to resolve lack of any formality requirement in a request for appeal or failure of the payment of official fees, if any. If there is no response to the notice, the President of the IPTAB may dismiss the procedure.</p> <p>If the application shall be returned to the examiner for reconsideration, the President of the IPTAB shall notify the Commissioner of KIPO of the request for appeal before proceeding with the appeal. Upon being notified, the Commissioner of KIPO shall allow the examiner in charge to reconsider the application. In that event, the petitioner or the attorney shall receive a notice stating that the application shall be transferred to the examiner for reconsideration.</p> <p>The reconsideration of the application shall be conducted by the examiner who issued the original decision to reject the patent application. Since the examiner who made the decision to reject</p>	<p>○ Where the petitioner has made amendments to the application, the previous examination department shall examine if the amendments are acceptable or not, if the examination department believes that the amendments conform the provisions, it shall perform interlocutory examination on the basis of the amended document. Otherwise, it shall maintain the decision of rejection and, in addition to the explanation in detail why the amendments are not acceptable, explain the remained defects in the application to which the grounds of rejection are directed.</p> <p>Where the petitioner presents new evidence or raises new causes, the previous examination department shall examine the evidence or causes.</p> <p>The previous examination department shall not raise new grounds or evidence for the rejection, except in the following cases:</p> <p>(i) supplementing the evidence of common knowledge such as those in a technical dictionary, a technical manual, or a text book well known in the skilled art, to support the allegation of common knowledge in the decision of rejection and the interlocutory Examination opinion;</p> <p>(ii) where the previous examination department believes the text of the application being examined has such defects that it is sufficient to reject the application on the basis of the fact, grounds and evidence of which the applicant has been notified, it shall specify the defects in the interlocutory examination opinion; and</p> <p>(iii) where the previous examination department believes the defects indicated in the decision of rejection still exist and finds the text of the application being examined has other defects which are obvious and substantive or of the same nature with that indicated in the decision of rejection, it may specify them as well.</p>	<p>○ Reconsideration</p> <p>If a patent application has been returned to the examiner for reconsideration as a result of an amendment made at the time of filing a request for appeal, the examiner shall reconsider the patent application (Article 162 of the JPA).</p> <p>During the reconsideration, the examiner shall first determine whether the amendment made at the time of filing a request for appeal meets requirements under Article 17bis, Paragraphs 3 to 6 of the JPA and then determine whether the grounds of the decision of refusal have been overcome.</p> <p>If it is found as a result of the reconsideration that the grounds of the decision of refusal have been overcome and there are no new reasons for refusal, the examiner shall withdraw his or her original decision of the decision of refusal and decide to grant a patent to the application.</p> <p>(Examination Guidelines for Patent and Utility Model, Part IX, Section 2, the provisions in 8 entitled "Reconsideration by Examiner before Appeal")</p> <p>○ Order of Reconsideration</p> <p>(1) Review of an amendment made at the time of filing a request for appeal</p> <p>It is first reviewed whether the amendment made at the time of filing the request for appeal meets requirements under Article 17bis, Paragraphs (3) to (6) of the JPA.</p> <p>The amendment made at the time of filing the request for appeal shall be reviewed in accordance with the provisions in 6.2.2 entitled "Examination when Amendment Was Made in Response to The Last Notice of Examiner's Decision of Refusal." In that event, the phrase "Amendment Was Made in Response to The Last Notice of Examiner's Decision of Refusal" shall be changed to read "Amendment Made at the time of Filing the Request for appeal."</p>

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	<p>the patent application is the most appropriate person to compare the grounds in the decision to reject the patent application and the amendment, the examiner shall be vested with the authority to conduct the reconsideration to meet the essential object of the reconsideration proceeding.</p> <p>If the petitioner's amendment is found to be unlawful as a result of the reconsideration, a ruling of dismissal of the amendment shall be made. Although there is no separate legal procedure for appealing the ruling, this ruling may be disputed together with the trial procedure of the appeal against the decision to reject the patent application.</p> <p>(Trial Guidebook Part 21 Chapter 6(5))</p>	<p>For example, the previous examination department once indicated in an office action that claim 1 is not in conformity with Article 22.3, but finally rejected the application on the ground that the amendment of the document is not in conformity with Article original text, and the previous examination department believes the defect of noncompliance with Article 22.3 still exists, which falls into the above circumstance (ii), then the previous examination department shall specify the defect in the interlocutory examination opinion.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>(2) In a case where the amendment made at the time of filing the request for appeal is proper</p> <p>① As a result of the proper amendment made at the time of filing the request for appeal, if the grounds for the examiner's decision of refusal have been overcome and no new reasons for refusal are found, the original decision of examiner's decision of refusal shall be withdrawn and a decision to grant a patent to the application shall be rendered.</p> <p>② If the grounds for the examiner's decision of refusal have been overcome as a result of the amendment made at the time of filing the request for appeal, but new reasons for refusal, which are different from those for the examiner's decision of refusal, have been found after the amendment, a notice of preliminary rejection shall be issued (e.g., if some claims have been deleted as a result of the amendment made at the time of filing the request for appeal and new reasons for refusal have been discovered with respect to the remaining claims).</p> <p>③ If the grounds for the examiner's decision of refusal have not been overcome despite the amendment made at the time of filing the request for appeal, a notice of reconsideration result shall be served to the Commissioner of the JPO. The notice of reconsideration result shall state that all of the grounds for the examiner's decision of refusal are upheld, along with new reasons for refusal, if any.</p> <p>(3) In a case where the amendment made at the time of filing the request for appeal is improper</p> <p>During the reconsideration, even if the amendment is found to be improper, a ruling of dismissal of the amendment shall not be made, except for the case where a decision to grant a patent is rendered [Article 164, Paragraph (2) of the JPA].</p> <p>If the amendment made at the time of filing the request for appeal is improper, it shall be reviewed once again whether the grounds of the examiner's decision of refusal of the application before the amendment made at the time of filing the request for examination are proper.</p> <p>① If the grounds for the examiner's decision of refusal of the</p>

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			<p>application before the amendment made upon filing the request for appeal are proper, a notice of reconsideration result shall be served to the Commissioner of the JPO. The notice of reconsideration result shall state that all of the grounds for the original decision of refusal are upheld, along with new reasons for refusal, if any.</p> <p>② If the grounds for the examiner's decision of refusal of the application before the amendment made at the time of filing the request for appeal are improper and no new reasons for refusal of the application before the amendment made when filing the request for appeal are found, a decision to withdraw the examiner's decision of refusal and grant a patent to the application shall be rendered along with a ruling of a dismissal of the amendment.</p> <p>③ If the grounds for the examiner's decision of refusal of the application before the amendment made when filing the request for appeal are improper while new reasons for refusal of the application before the amendment made when filing the request for appeal are found, a notice of reconsideration result shall be served to the Commissioner of the JPO.</p> <p>The notice of the reconsideration result shall state the grounds for dismissing the amendment made when filing the request for appeal, along with new reasons for refusal of the application before the amendment made when filing the request for appeal.</p> <p>(4) In a case where it is possible to grant a patent by giving the demandant an opportunity to make an amendment</p> <p>If a decision to grant a patent may be rendered by giving an opportunity to amend minor issues with the descriptions and the like, a notice of reasons for refusal may be issued regardless of paragraphs (2) and (3). In that event, the examiner shall make efforts to communicate with the demandant through an interview or the like and shall make himself or herself understood by the demandant as to what amendments to be made.</p> <p>This notice of reasons for refusal shall be the last notice of</p>

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			<p>reasons for refusal, in principle [see the provisions in 4.3.3.1(2) ①]).</p> <p>(Examination Guidelines for Patent and Utility Model, Part IX, Section 2, the provisions in 8 entitled "Reconsideration by Examiner before Appeal")</p>
<p><b>6.4. Termination of reconsideration by examiner before appeal</b></p> <p>○ The examiner shall withdraw the decision to reject a patent application when the grounds for rejection of the patent application have been overcome as a result of reconsideration of the patent application and shall issue a notice of allowance. In that event, the request for appeal filed to appeal the decision to reject a patent application shall be deemed to have lapsed [see Article 175, Paragraph (1) of the KPA].</p> <p>Where new grounds for rejection have been found during reconsideration while the original grounds of the decision to reject a patent application have been overcome based on the amendment, the examiner shall issue a notice of preliminary rejection with designating a time period for submitting a response.</p> <p>The applicant may file an amendment to the specification or drawings once again within the designated time period. If the amendment is unlawful, the examiner may dismiss the amendment. Although there is no separate legal procedure for appealing the dismissal of amendment, this dismissal of amendment may be disputed together with the appeal procedure of the appeal against the decision to reject a patent application.</p> <p>If it is still found that a patent cannot be granted as result of reconsideration, the examiner shall close the reconsideration proceeding by submitting a report on the reconsideration result to the Commissioner of KIPO without rendering a decision to reject the application once again. In that event, the President of the IPTAB shall designate administrative patent judges for the</p>	<p>○ The previous examination department shall provide its opinion on interlocutory examination, and make a Note of Interlocutory Examination Opinion. Except in special situations, interlocutory examination shall be completed within one month after receipt of the dossier.</p> <p>○ There are three types of interlocutory examination opinion:</p> <p>(1) that the request for reexamination is allowable, and the decision of rejection is agreed to be revoked;</p> <p>(2) that the amended text of the application submitted by the petitioner has overcome the previous defects, and the decision of rejection is agreed to be revoked on the basis of the amendments; and</p> <p>(3) that the observations and the amendments submitted by the petitioner are not sufficient to revoke the decision of rejection, and the decision of rejection is maintained.</p> <p>○ The previous examination department shall specify which of the above types its examination opinion is. Where the examination department maintains the decision of rejection, it shall explain in detail the grounds of rejection maintained and the defects concerned; where the grounds are the same as in the decision of rejection, a brief explanation shall suffice, without the need to repeat the same.</p> <p>Where an interlocutory examination opinion falls to be the first or second type as provided before, the PRB needs not to conduct collegiate examination. It shall make a reexamination decision according to the interlocutory examination opinion, and notify the petitioner. The previous examination department shall restore the examination procedure consequently. The previous examination department shall not directly restore the</p>	<p>○ Except for the case of rendering a decision stating to the effect that a patent must be granted during reconsideration, the examiner shall submit a report on the result of reconsideration to the Commissioner of the JPO without rendering a decision on the request for appeal (Article 164, Paragraph (3) of the JPA).</p> <p>In this event, the reconsideration procedure will lapse and the panel of administrative judges shall proceed with the appeal of the subject case.</p> <p>(Manual of Appeal and Trial Proceedings, Chapter 61-05, Section 4)</p> <p>In addition, for the flow of reconsideration, see the Examination Guidelines, Part IX entitled "Procedure of Examination," Fig. 3 showing the "flow chart of reconsideration by examiner before appeal."</p>	

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	<p>appeal and appeal proceedings accordingly, and the administrative patent judges shall proceed with the appeal according to the general appeal and trial procedures.</p> <p>(Trial Guidebook Part 21 Chapter 6(6))</p>	<p>examination procedure without the reexamination decision being made by the PRB.</p>	

## 7. Appeal proceeding on the merits

### 7.1. General

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| <p>○ Regarding an appeal against the examiner's decision to reject a patent application, the proceeding shall be in principle conducted by a documentary proceeding. The trial proceeding shall be initiated in the order of filing a request for appeal.</p> <p>If an appeal against an examiner's decision to reject a patent application is subject to an accelerated appeal or a super-accelerated appeal, the appeal proceeding may be conducted in preference.</p> <p>(Trial Guidebook Part 21. Chapter 7. Section 1)</p> <p>※ In the case of an appeal against the examiner's decision to reject a patent application, an oral hearing is not conducted, and a technical presentation may be instead held upon request or <i>ex officio</i>.</p> <p>○ A technical presentation shall be held in the presence of an involved party and administrative patent judges in order to promptly help them understand the issues disputed in an appeal. The presentation is similar to an oral hearing in that they both are held in order to terminate a case earlier.</p> <p>(Trial Guidebook Part 10. Section 4)</p> <p>○ There are differences between a technical presentation and an oral hearing as follows:</p> <p>a. Scope of participation: while the oral hearing is heard by all of administrative patent judges constituting a collegial body, the presentation may be attended only by chief administrative patent judges.</p> <p>b. Holding place: While the oral hearing is held in a trial court,</p> | <p>○ For a request for reexamination, the panel may conduct examination in written form, by oral proceedings, or in both ways.</p> <p>According to Rule 63.1, in any of the following circumstances, the panel shall issue Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination) or take oral proceedings:</p> <p>(1) where the decision of rejection is intended to be upheld;</p> <p>(2) where the decision of rejection can be revoked on the condition that the petitioner makes amendments to the application document in accordance with the relevant provisions of the Patent Law, its Implementing Regulations and these Guidelines;</p> <p>(3) where further evidence or explanation is required to be submitted by the petitioner; or</p> <p>(4) where new grounds or evidence that have not been provided in the decision of rejection need to be introduced.</p> <p>Where the panel issues Notification of Reexamination, the petitioner shall respond in written form with respect to the defects indicated in the notification within one month from the date of receipt. If the petitioner fails to respond in written form within the time limit, the request for reexamination shall be deemed withdrawn. Any response without concrete contents is regarded as no objections to the examination opinions in Notification of Reexamination.</p> <p>Where the panel issues Notification of Oral Proceedings for Request for Reexamination, the petitioner shall appear in the</p> | <p>○ In an appeal against the examiner's decision of refusal for a patent application, the proceeding is conducted the order of filing a request for appeal.</p> <p>Only in a case where a patent application was filed a long time ago (in view of its filing date and also in view of its priority date), the proceeding is promptly conducted.</p> <p>An accelerated appeal must be initiated, regardless of a filing order, in one of the following cases:</p> <p>a. In a case where a written statement for accelerated appeal is submitted, and predetermined requirements are satisfied</p> <p>b. In a case where there are other particular reasons for which an accelerated appeal is recognized to be necessary</p> <p>○ A proceeding of appeal against the examiner's decision of refusal for a patent application is conducted based on documentary examination. However, a chief appeal examiner may conduct the proceeding based on an oral examination upon request from an involved party or <i>ex officio</i> (Article 145, Paragraph (2) of the JPA).</p> <p>(Appeal Guidebook Chapter 61-06)</p> |
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	<p>the presentation may be held in a trial court, the presiding administrative patent judge's office, an interview room, or in the Seoul office of KIPO, etc.</p> <p>c. Examination of witness and strict formality: An examination of a witness is generally conducted along with the oral hearing, and a witness gives a testimony under a strict formality by swearing in as a witness. In contrast, it is rare to swear in as a witness in the presentation, and even an involved party may make a statement freely without formal procedures under the command of the chief administrative patent judges or another administrative patent judges.</p> <p>d. Report of result: In the case of an oral hearing, a report in a pre-defined form is prepared by an administrative officer after the oral hearing. In contrast, in a presentation, an administrative patent judge prepares a result report on the presentation in a relatively free form.</p> <p>(Trial Guidebook Part 10. Section 4)</p>	<p>oral proceedings or respond in written form with respect to the defects indicated in the notification within one month from the date of receipt. If the notification has indicated the facts that the application fails to conform with the relevant provisions of the Patent Law and its Implementing Regulations and these Guidelines and has provided the grounds and evidence therefor, and the petitioner neither attended oral proceedings nor made response in written form within the time limit, then the request for reexamination is deemed withdrawn.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	

## 7.2. Specification or drawings for appeal proceeding

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| <p>○ An appeal system regarding the examiner's ruling of dismissal of an amendment to a patent application was abolished by the Act revised on February 3, 2001, and the ruling of dismissal of the amendment rendered in the process of examination can be disputed when a request for appeal against the examiner's decision to reject a patent application is filed.</p> <p>Accordingly, in the appeal against the examiner's decision to reject a patent application, the specification or drawings, which are to be examined in the appeal, varies depending on whether an appeal against the examiner's dismissal of the amendment was raised, whether an amendment to the application was made when the request for appeal was filed, and the like.</p> <p>Further, in accordance with the introduction of the re-examination system, an amendment to an application filed on or after July 1, 2009 is not allowed when a request for appeal is filed. Therefore, in such a case, a subject matter in the appeal shall be determined according to whether a ruling of dismissal of an amendment was rendered in the process of re-examination</p> | <p>○ In the reexamination procedure, the panel normally examines only the grounds and evidence on which the decision of rejection is based.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p> | <p>○ The examiner's ruling of dismissal of an amendment to a patent application, which was made during the process of examination, may be appealed when a request for appeal against the examiner's decision of refusal of the application is filed (Article 53, Paragraph (2) of the JPA).</p> <p>In an appeal proceeding against the examiner's decision of refusal for a patent specification, the specification, claims, and drawing, which are to be subject to the appeal proceeding, differ from case to case depending on whether or not an appeal against the examiner's dismissal of amendment was raised, whether or not an amendment to the application was made when the request for appeal was filed, and the like.</p> <p>(1) In a case where an appeal against the examiner's ruling of dismissal (Article 53, Paragraph (1) of the JPA), which was rendered in the previous examination process, was not requested (also in a case where a ruling of dismissal of an amendment was not rendered), at the time of filing a request for appeal against</p> |
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	<p>and whether the petitioner of the appeal will raise an appeal against the ruling of the dismissal of the amendment.</p> <p>○ <b>Applications filed on or before June 30, 2009 (in a case where an amendment is not made after a request for appeal is filed)</b></p> <p>When a ruling of dismissal of an amendment which was made before the filing of the request for appeal is disputed, whether the ruling of dismissal is lawful is determined based on the last amended specification and drawings. When the ruling of dismissal is lawful, whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings before the last amendment. When the ruling of dismissal is unlawful, whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings after the last amendment, which was dismissed, presuming that the ruling of dismissal shall be withdrawn.</p> <p>If the petitioner does not dispute the ruling of dismissal of the last amendment which was made before the filing of the request for appeal, whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings before the last amendment.</p> <p>○ <b>Applications filed on or before June 30, 2009 (in a case where an amendment is made after a request for appeal is filed)</b></p> <p>(1) In a case where an amendment was dismissed in the process of reconsideration by an examiner before an appeal</p> <p>When the ruling of dismissal of an amendment is disputed after the filing of the request for appeal, whether the ruling of dismissal is lawful is determined. When the ruling of dismissal is determined to be lawful, whether the decision of the examiner's decision to reject a patent application is proper is determined based on the specification and drawings before the amendment. If the ruling of dismissal is determined to be unlawful, whether the decision to reject a patent application is proper is determined based on the specification and drawings</p>		<p>the examiner's decision of refusal</p> <p>The specification, claims, and drawings, which were finally rejected, shall be subject to the proceeding. In a case where an amendment is made when the request for appeal is made, the specification, claims, and drawings after the amendment shall be subject to the proceeding.</p> <p>(2) In a case where an appeal against the examiner's ruling of dismissal of amendment, which was rendered in the previous examination process, is requested at the time of filing the request for appeal against the examiner's decision of refusal.</p> <p>A. In a case where an amendment is not made at the time of filing the request for appeal.</p> <p>(a) In this case, the appeal proceeding is conducted with respect to the appeal against the ruling of dismissal of the amendment. When the decision to ruling of dismissal of the amendment is determined to be unlawful, a subsequent proceeding is conducted on the premise that the ruling of dismissal of the amendment is withdrawn. When the ruling of dismissal of the amendment is determined to be lawful, the specification, claims, and drawings, which are pending after the ruling of dismissal of the amendment was rendered (i.e., the finally rejected specification, claims, and drawings) shall be subject to a subsequent proceeding.</p> <p>(b) In the foregoing case, if a notice of rejection for the patent application is notified during the appeal proceeding, the notice shall clearly indicate which part of the specification is relied upon in connection with a determination of whether or not the ruling of dismissal the amendment is lawful.</p> <p>(c) A determination on whether or not the ruling of dismissal of the amendment, which was rendered in the process of the previous examination, is proper shall be described in the section of decision grounds within an appeal decision.</p> <p>B. In a case where an amendment is made at the time of filing the request for appeal</p> <p>(a) In this case, when a request for appeal is filed, an</p>

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	<p>after the amendment, which was dismissed, presuming that the ruling of dismissal is withdrawn.</p> <p>If the petitioner does not dispute the ruling of dismissal, whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings before the amendment.</p> <p>(2) In a case where an amendment is accepted in the process of reconsideration by the examiner before appeal</p> <p>When an amendment is accepted in the process of reconsideration by the examiner before an appeal and the examiner's decision to reject a patent application is maintained, whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings after the amendment.</p> <p>○ <b>Applications filed on or after July 1, 2009</b></p> <p>(1) In a case where a request for re-examination is not filed</p> <p>If a request for re-examination is not filed, the appeal proceeding is conducted according to the regulations applied to a case where an amendment is not made after the filing of the request for appeal, as stated above in the preceding item.</p> <p>(2) In a case where a request for reexamination is filed</p> <p>a. When an amendment for reexamination is accepted</p> <p>Whether the examiner's decision to reject a patent application is proper is determined based on the amended specification.</p> <p>b. When an amendment for reexamination is dismissed</p> <p>If the petitioner of the appeal does not dispute the ruling of dismissal of the amendment, the appeal proceeding is conducted according to preceding item (1). However, if the petitioner disputes the ruling of dismissal, the ruling of dismissal is examined in the appeal proceeding. If the ruling of dismissal is determined to be lawful, whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings that were pending when the decision to reject a patent application was rendered. If the ruling of</p>		<p>amendment shall be made to the specification, claims, and drawings that are pending after the ruling of dismissal of the amendment was rendered (i.e., the specification, claims, and drawings that were rejected in the examiner's decision). The specification, claims, and drawings in accordance with the amendment made at the time of filing the request for appeal shall be subject to the trial proceeding.</p> <p>(b) In the proceeding, grounds for appeal against ruling of dismissal of the amendment are taken into consideration when reviewing the amendment made when the request for appeal is filed.</p> <p>(c) As a result of the proceeding, when the amendment made at the time of filing the request for appeal should be dismissed, the specification, claims, and drawings finally rejected in the previous examination process shall be subject to a subsequent proceeding.</p> <p>(Appeal Guidebook Chapter 61-05(1))</p>



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	<p>dismissal is determined to be unlawful, the subject matter examined in the appeal is the specification and drawings after the dismissed amendment, and whether the examiner's decision to reject a patent application is proper is determined based on the specification and drawings after the amendment, presuming that the ruling of dismissal of the amendment has been withdrawn. If a notice of grounds for rejection must be issued in the appeal, it shall clearly indicate which part of the specification is relied upon in issuing the notice of grounds for rejection in connection with the determination on whether the ruling of dismissal of the amendment is lawful. That is, if the ruling of dismissal of an amendment is unlawful, the specification and drawings after the amendment are examined for grounds for rejection, whereas if the ruling of dismissal of an amendment is lawful, the specification and drawings before the amendment are examined for grounds for rejection. Thus, a notice of grounds for rejection is required to clearly indicate based on what specification the grounds for rejection are notified.</p> <p>The determination on whether the ruling of dismissal of an amendment which is made during the patent examination is proper shall be described in the grounds for appeal decision.</p> <p>※ In a case where a request for re-examination is filed, the petitioner shall not dispute a ruling of dismissal of an amendment, which was rendered before the filing of the request for reexamination (Article 51, paragraph 3 of the KPA and Article 11 of the Korean Utility Model Act).</p> <p>(Trial Guidebook Part 21. Chapter 7. Section 3)</p>		
	<p><b>7.3. Effect of examination procedure</b></p>		
<p>○ <b>Article 172 of the KPA (effect of examination proceedings)</b> Patent-related proceedings previously taken during the course of an examination remain effective in an appeal against an examiner's decision to reject a patent application or against a decision to reject to register a patent term extension of a patent right.</p>	<p>○ The previous examination department shall follow the decision of the PRB, and shall not make a decision contrary to the reexamination decision on the same basis of facts, grounds and evidence.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>○ <b>Article 158 of the JPA (Special Provisions regarding Appeals against Examiner's Decision of Refusal)</b></p> <p>Any procedure taken during the examination procedure shall also be effective in an appeal against the examiner's decision of refusal.</p>	
	<p><b>7.4. Notification of grounds for rejection and an amendment</b></p>		

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<p>7.4.1. Notification of grounds for rejection</p>	<p>○ Article 47, Paragraph (1) 1 and 2, Articles 51, 63, and 66 shall apply <i>mutatis mutandis</i> to an appeal against the examiner's decision to reject a patent application. Thus, in the appeal against the examiner's decision to reject a patent application, when grounds for rejection have been found to be different from those indicated in the examiner's decision to reject a patent application, the administrative patent judges shall issue a notice of grounds for rejection, and shall give the petitioner an opportunity to present his or her written opinion within a reasonably designated time period. Further, in a case where an amendment, which was made in response to the last notice of grounds for rejection issued in the process of examination, has been found to go beyond the allowable scope for amendments during the appeal proceeding, the amendment shall not be dismissed. However, if the amendment adds a new matter, the administrative patent judges shall issue a notice of grounds for rejection (Article 170 of the KPA).</p> <p>In the notice of grounds for rejection issued by the administrative patent judges, the grounds for rejection that have existed from the time of filing of the application and should have been indicated in the first notice of grounds for rejection shall, in principle, be grounds for preliminary rejection provided in Article 47, Paragraph (1)1 of the KPA. A notice of grounds for rejection issued regarding the grounds for rejection that has arisen by an amendment made in response to the first notice of grounds for rejection shall be the last notice of grounds for rejection provided in Article 47, Paragraph (1) 2 of the KPA.</p> <p>The allowable scope of an amendment and the lawfulness of an amendment are handled differently depending on whether the notice relates to the first or last notice of grounds for rejection. Therefore, when a notice of grounds for rejection is issued, the notice shall clearly indicate whether it relates to the first or last notice.</p> <p>If a ruling of dismissal of an amendment, which was made in the process of examination, is appealed and an amendment is not made at the time of the filing of the request for appeal, or if the notice of grounds for rejection is issued in the appeal proceeding, the notice shall clearly indicate what specification is</p>	<p>○ In the reexamination procedure, the panel normally examines only the grounds and evidence on which the decision of rejection is based.</p> <p>In addition to the grounds and evidence on which the decision of rejection is based, where the panel finds the text of the application being examined has one of the following defects, it may examine the grounds and evidence related to the defect, and if the panel confirms the existence of the defect after examination, it shall make a decision of upholding the rejection decision on the basis of said grounds and evidence:</p> <p>(1) The defects for which it is sufficient to reject the application on the basis of other grounds and evidences of which the applicant has been notified before rejection; or</p> <p>(2) The defects which are not indicated in the decision of rejection but are obvious and substantive or of the same nature with those indicated in the decision of rejection.</p> <p>For example, where the decision of rejection indicated that claim 1 did not involve an inventive step, and the panel after examination found that the claimed subject matter was obviously a perpetual motion machine, it shall make a reexamination decision of upholding the decision of rejection on the ground that the claim is not in conformity with Article 22.4.</p> <p>For another example, where the decision of rejection indicated that claim 1 was not clear because of indefinite terms and thus failed to define a clear extent of protection, and the panel found that claim 2 was also not clear for the use of the similar indefinite terms, it shall notify the petitioner of the defect as well in the reexamination procedure; if the response of the petitioner fails to overcome the defect of claim 2, the panel shall make a reexamination decision of upholding the decision of rejection on the ground that claim 2 is not in conformity with Article 26.4.</p> <p>During the collegiate examination, the panel may introduce common knowledge of the skilled art into the examination, or supplement the evidence by providing common knowledge such as those in a technical dictionary, a technical manual, or a text</p>	<p>○ a. When reasons for refusal different from those for the examiner's rejection are found, all of the reasons for refusal are notified, and the demandant for the appeal must be given an opportunity to submit a response within a reasonably designated time period. However, this regulation does not apply when an amendment made at the time of filing the request for appeal or an amendment made in response to a last notice of reasons for refusal that is issued after the filing of the request for appeal( → b) is dismissed (Article 159, Paragraph (2) of the JPA → Article 50 of the JPA).</p> <p>(e.g.) In a case where it is found during the appeal proceeding that the amendment made in the process of examination violates the allowable scope for amendments in response to a last notice of reasons for refusal, the amendment shall not be dismissed (Article 159, Paragraph (2) of the JPA → Article 53 of the JPA). However, in a case where the violation is due to an addition of new matter, a notice of reasons for refusal (Article 49, Paragraph (1)1) shall be issued in the appeal proceeding.</p> <p>b. When a notice of reasons for refusal is issued in the appeal proceeding, the notice shall describe grounds that arise due to lack of novelty/inventiveness on a claim basis, except for the grounds that cannot be described for each claim (indefinite descriptions in a specification in its entirety, an addition of new matter, etc.). Further, the notice shall clearly indicate the status of all of the claims so that rejected claims can be distinguished from those not rejected.</p> <p>(NOTE) Even if the notice of reasons for refusal indicates claims that do not contain any reasons for refusal, this does not mean that such an indication is legally binding.</p> <p>c. Regarding a notice of reasons for refusal that is issued in the appeal proceeding, if the notice includes grounds that has existed at the time of filing the application and should have been indicated in the first notice of grounds for refusal, the notice in principle (Note) corresponds to a first notice of reasons for refusal provided in Article 17, Paragraph 2(1) of the JPA. In a case where the notice of reasons for refusal that is issued in the appeal proceeding includes only the grounds due to the</p>

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	<p>relied upon in issuing the notice of grounds for rejection in connection with a determination whether the ruling of dismissal of the amendment is lawful.</p> <p>(Trial Guidebook Part 21. Chapter 8. Section 1(1))</p>	<p>book.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>amendment made in response to the first notice of reasons for refusal, the notice corresponds to a last notice of reasons for refusal provided in Article 17bis, Paragraph (1)3 of the JPA.</p> <p>d. The allowable scope of an amendment and the lawfulness of an amendment are handled differently depending on whether a notice concerns a first or last notice. Thus, the notice shall indicate whether it concerns a first or last notice.</p> <p>e. In a case where an appeal against the examiner's ruling of dismissal of an amendment to an application was requested and an amendment is not made at the time of filing a request for appeal against the examiner's decision of refusal, when a notice of reasons for refusal is issued in the appeal proceeding, the notice shall clearly indicate which part of the specification is relied upon in notifying the rejection in connection with a determination on whether or not the ruling of dismissal of the amendment is lawful.</p> <p>(Manual of Appeal and Appeal Proceedings, Chapter 61-05, Section 5)</p> <p>※Also, see Chapters 62-02, 62-03, and 62-06 of Appeal Examination Manual.</p>
<p>7.4.2. Scope of an amendment to a specification or drawings</p>	<p>○ In an appeal against the examiner's decision to reject a patent application, when a notice of grounds for rejection is issued for the rejection grounds different from those for the examiner's decision to reject a patent application, the petitioner of the trial may amend the specification or drawings attached to the request for appeal [Article 170 (2) of the KPA].</p> <p>(1) In a case where a notice of grounds for rejection issued during the appeal proceeding corresponds to the first notice of grounds for rejection under Article 47, Paragraph (1)1 of the KPA [Article 170, Paragraph (2) of the KPA → Article 47, Paragraph (1)1 of the KPA], an amendment may be made unless new matter is added to the originally filed specification and drawings (in the case of filing a foreign language application, its translation) [Article 47, Paragraph (2) of the KPA].</p> <p>(2) In a case where a notice of grounds for rejection issued during the appeal process corresponds to the last notice of</p>	<p>○ The petitioner may amend the application at the time of submitting the request for reexamination, responding to Notification of Reexamination (including Notification of Oral Proceedings for Request for Reexamination), or appearing in oral proceedings.</p> <p>Any amendment, however, shall meet the requirements of Article 33 and Rule 61.1.</p> <p>According to Rule 61.1, amendments by the petitioner shall be limited only to overcome the defects indicated in the decision of rejection or by the panel. Generally, the above requirement is not considered to be met in the following cases:</p> <p>(1) Where a claim amended extend the extent of protection as compared with the claim rejected in the decision of rejection;</p> <p>(2) Where a claim in the amendment is derived from the technical solution that lacks unity with the claims rejected in the</p>	<p>○ In an appeal against the examiner's decision of refusal for a patent application, when a notice of reasons for refusal is issued, the demandant for the appeal may amend the specification or drawings attached to the request for appeal (Article 159, Paragraph (2) of the JPA → Article 50 of the JPA → Article 17bis (1)2 of the JPA).</p> <p>a. In a case where the notice of reasons for refusal for a patent application issued during the appeal proceeding corresponds to a "first notice of reasons for refusal" under Article 17bis, Paragraph (1) of the JPA (Article 159, Paragraph (2) of the JPA → Article 17bis, Paragraph (1)1 of the JPA), an amendment may be made unless new matter is added to the originally filed specification, claims, and drawings (in the case of filing a foreign language application, its translation) (Article 17bis, Paragraph (3) of the JPA). However, in a case where the amendment is to correct an error, as long as the amendment is</p>

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	<p>grounds for rejection under Article 47, Paragraph (1)2 of the KPA [Article 170, Paragraph (2) of the KPA → Article 47, Paragraph (1)1 of the KPA], the allowable scope of an amendment is equal to the scope of the amendment made at the filing of the request for appeal. An amendment that violates this requirement shall be dismissed (Article 170, Paragraph (1) of the KPA → Article 53 of the KPA).</p> <p>(Trial Guidebook Part 21. Chapter 8. Section 2(1))</p>	<p>decision of rejection;</p> <p>(3) Where the type of a claim is altered, or the number of claims is increased; or</p> <p>(4) Where the amendments are directed to the claims or the description that were not involved in the decision of rejection, unless they are intended merely to correct obvious clerical errors or to amend the defects of the same nature with that indicated in the decision of rejection.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>made within the matter described in a foreign language text, the amendment beyond the translation thereof may be made (Article 17bis, Paragraph (3) of the JPA). The amendment violating the requirement is subject to reasons for refusal (Article 159, Paragraph (2) of the JPA → Article 50 of the JPA).</p> <p>b. In a case where the notice of reasons for refusal issued in the appeal proceeding corresponds to a "last notice of reasons for refusal" under Article 17bis, Paragraph (1)3 of the JPA (Article 159, Article (2) of the JPA → Article 17bis, Paragraph (1)3 of the JPA), the scope for an amendment is equal to that for amendment that may be made at the time of filing a request for appeal (Article 159, Article (2) of the JPA → Article 17bis, Paragraph (1)3 of the JPA → Article 17bis, Paragraphs (3), (4), (5), and (6) of the JPA). An amendment that violates the requirements shall be dismissed (Article 159, Paragraph (1) of the JPA → Article 53 of the JPA). (→3 (1) a)</p> <p>(Appeal Guidebook Chapter 61-05(6))</p>
<p>7.4.3. Handling of an inappropriate specification or drawings</p>	<p>○ When an amendment made at the time of filing a request for appeal (applicable only to applications filed on or before June 30, 2009) or an amendment made in response to the last notice of grounds for rejection after the filing of the request for appeal, is determined to violate the regulation under Article 47, paragraph (2)3 of the KPA, the amendment shall be dismissed (Article 170, Paragraph (1) of the KPA → Article 51, Paragraph (1) of the KPA).</p> <p>※ NOTE</p> <p>As Article 47, Paragraph (4) of the KPA was deleted by Act No. 9381 as of January 30, 2009, Article 47, Paragraph (4) (requirements for modification and independent patent) do not apply to applications filed on or after July 1, 2009 when the revised Act went into effect.</p> <p>※ Even if it turns out in the appeal that an amendment made in response to the last notice of grounds for rejection in the process of examination clearly violate the allowable scope for amendments, the amendment already made in the examination process shall not be dismissed (Article 170, Paragraph (1) of the</p>	<p>○ In reexamination procedure, if the application document submitted by the petitioner is not in conformity with the provision of Rule 61.1, the panel will generally refuse to accept it; and the panel should explain why the amended document is unacceptable in Notification of Reexamination and examine the previous acceptable document. If part of the content of the amended document is in conformity with the provisions of Rule 61.1, the panel may provide examination opinions on this part, and notify the petitioner that he should amend other part of the text which is not in conformity with the provisions of Rule 61.1 and submit document which is in conformity with the provisions, otherwise the panel will take the previous acceptable text as the basis of examination.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>○ When an amendment made at the time of filing a request for appeal (Note 1) or an amendment made in response to a last notice of reasons for refusal that is issued after a request for appeal is filed (Note 2) is recognized to violate the requirements under Article 17bis, Paragraphs (2), (3), (4), (5), and (6) of the JPA, and such violation is found before a certified copy of a notice to the effect that the patent is to be granted is sent, the amendment shall be dismissed (Article 159, Paragraph (1) of the JPA → Article 53 of the JPA).</p> <p>In a case where it is found during the appeal proceeding that an amendment made in the process of examination violates an allowable scope for an amendment that can be made in response to a last notice of reasons for refusal, the amendment shall not be dismissed.</p> <p>In any of cases (Note 1) and (Note 2), or in a case where the violation is due to an addition of new matter, this shall constitute reasons for refusal (Article, 49, Paragraph (1) of the JPA) and grounds for invalidation (Article 123, Paragraph (1) of the JPA).</p>

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	<p>KPA). However, if the amendment made in the examination process adds new matter, this shall constitute grounds for rejection [Article 62, Paragraph (1)5 of the KPA] and grounds for invalidation [Article 133, Paragraph (1)6 of the KPA].</p> <p>(Trial Guidebook Part 21. Chapter 8. Section 3(1))</p>		<p>An amendment thereto is required to satisfy the requirements for an amendment in response to the last notice of reasons for refusal. Therefore, there may be a case where new matter cannot be deleted by an amendment.</p> <p>(Appeal Guidebook Chapter 61-05(7))</p>

### 7.5. Divisional application in the process of appeal

	<p>○ <b>Article 52 of the KPA (Divisional Patent Application)</b> (1) An applicant who has filed one patent application comprising two or more inventions may divide such application into two or more patent applications within the limit of such matters as stated in the specification or drawings which are initially attached to the patent application, in accordance with a period falling under any of the following subparagraphs:</p> <p>1. A period in which an amendment can be filed pursuant to Article 47, Paragraph (1)</p> <p>2. A period in which a request for trial can be made pursuant to Article 132-3 after the receipt of a certified copy of the ruling of dismissal of a patent.</p>	<p>○ The applicant shall file a divisional application no later than the expiration of two months (i.e., the time limit for going through the formalities of registration) from the date of receiving the Notification to Grant Patent Right to the initial application issued by the Patent Office. After the expiration of the above time limit, or where the initial application has been rejected, or the initial application has been withdrawn, or is deemed to have been withdrawn and the right has not been restored, no divisional application shall be filed in general.</p> <p>With regard to the initial application to which the examiner has issued the decision of rejection, the applicant may file a divisional application within three months from the date that the applicant receives the decision of rejection regardless of whether the applicant requests for reexamination or not. The applicant, after requesting for reexamination or during the initiation of the administrative litigation against the reexamination decision, may also file a divisional application.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>○ <b>Article 44 of the JPA (Division of Patent Applications)</b> An applicant for a patent may extract one or more new patent applications out of a patent application containing two or more inventions only within the following time limits:</p> <p>(i) within the allowable time limit for amendments of the description, scope of claims or drawings attached to the application;</p> <p>(ii) within 30 days from the date on which a certified copy of the examiner's decision to the effect that a patent is to be granted (excluding the examiner's decision to the effect that a patent is to be granted under Article 51 as applied <i>mutatis mutandis</i> under Article 163(3) and the examiner's decision to the effect that a patent is to be granted with regard to a patent application that has been subject to examination as provided in Article 160(1)) has been served; and</p> <p>(iii) within 3 months from the date on which a certified copy of the examiner's initial decision to the effect that the application is to be refused has been served.</p>
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## 8. Termination of appeal

### 8.1. Overview

<p>○ If the appeal against the decision to reject a patent application is found to be baseless, the appeal shall be dismissed.</p> <p>If the appeal is found to have merit, the administrative patent judge may render an appeal decision to vacate the decision to reject a patent application and remand the case to the Examiner [see Article 176, Paragraphs 1 and 2 of the KPA] or may render an appeal decision to vacate the decision to reject a patent application and make its own judgment to grant a patent [see</p>	<p>○ There are three types of examination decisions on requests for reexamination (hereinafter reexamination decisions):</p> <p>(1) a request for reexamination is not allowed, and the decision of rejection is upheld;</p> <p>(2) a request for reexamination is allowed, and the decision of rejection is revoked; and</p> <p>(3) where an application document has been amended and the</p>		<p>○ If the application can be rejected based on the grounds of the original decision, an appeal decision stating to the effect that the request for appeal is baseless shall be rendered.</p> <p>If the application cannot be rejected based on the grounds of the original decision, it is possible to proceed with examination by applying the procedure for examination, <i>mutatis mutandis</i>, in the appeal proceeding.</p> <p>If the original decision is held as a result of examination, an</p>
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	<p>Article 176, Paragraphs 1 and 2 of the KPA]. (Trial Guidebook Part 21. Chapter 9(1))</p>	<p>defects indicated in the decision of rejection has been overcome, the decision of rejection is revoked on the basis of the amended text.</p> <p>The second type as mentioned above includes the following circumstances:</p> <p>(i) where the provisions of laws were misapplied in the decision of rejection;</p> <p>(ii) where the grounds for rejection lacked necessary evidence support;</p> <p>(iii) where the process of examination failed to follow the statutory procedures. For example, the decision of rejection was based on an application document that had been abandoned by the applicant or on a technical solution not claimed; the applicant was not given a chance in the process of examination to make observations on the grounds, evidence or affirmed facts adopted in the decision of rejection; or the decision of rejection failed to comment on the evidence submitted by the applicant concerning the grounds of rejection, and thus might affect the impartiality of the examination; and</p> <p>(iv) any other circumstances where the grounds of rejection are not tenable.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>appeal decision stating to the effect that the request for appeal is baseless shall be rendered. If the original decision is not held, an appeal decision to vacate the original decision and grant the request for appeal shall be rendered (Article 159, Paragraphs (1)-(3) of the JPA).</p> <p>When vacating the original decision upon finding that the application cannot be rejected by the grounds of the original decision, an appeal decision stating to the effect that the application shall be remanded to the Examiner for examination may rendered.</p> <p>If the request for appeal is improper, it shall be dismissed by a ruling or an appeal decision.</p> <p>(Appeal Guidebook Chapter Chapter 61-07)</p>

## 8.2. Appeal decision

<ul style="list-style-type: none"> <li>○ The information, which are necessarily stated in a written appeal decision, is provided in the rules of decision drafting and the like on a computer (Rule No. 55 of the IPTAB Practice Rules), as follows: <ul style="list-style-type: none"> <li>a. Indication of the IPTAB</li> <li>b. Heading (Indication of Trial and Appeal Board and Appeal Decision)</li> <li>c. Indication of Appeal Case Number</li> <li>d. Description of Appeal Case</li> <li>e. Indication of Interested Parties, Intervenors, Representatives</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>○ An examination decision shall include the following parts: <ol style="list-style-type: none"> <li>(1) Bibliographic data of the examination decision</li> <li>(2) Legal bases</li> <li>(3) Main points of decision</li> <li>(4) Brief of the case</li> <li>(5) Grounds of decision</li> <li>(6) Conclusion.</li> </ol> <p>(Guidelines for Examination, Part IV, ChapterII)</p> </li> </ul>	<ul style="list-style-type: none"> <li>○ <b>Article 157 of the JPA (Appeal Decision)</b> <ol style="list-style-type: none"> <li>2 The appeal decision must be rendered in writing stating the following matters: <ol style="list-style-type: none"> <li>1. the appeal number;</li> <li>2. the name, and domicile or residence of each of the parties, intervenor(s) and their representatives;</li> <li>3. the identification of the appeal case;</li> <li>4. the conclusion of and reasons for the appeal decision; and</li> <li>5. the date of the appeal decision</li> </ol> </li> </ol> </li> </ul>
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	<p>and Counsel</p> <p>f. Issue Date of Appeal Decision</p> <p>g. Order of Appeal Decision</p> <p>h. Purport of Request</p> <p>i. Grounds of Appeal Decision</p> <p>j. Indication of Administrative patent judges (including Presiding Administrative patent judge) and Their Signs and Seals</p> <p>(Trial Guidebook Part 12. Chapter 2(1))</p> <p>○ Careful attention is needed to ensure that the appeal decision is announced within twenty days from the date when a notice of closure of the appeal has been issued [see Article 162, Paragraph (5) of the KPA]. In addition, the administrative patent judges constituting a collegial body, including the presiding administrative patent judges, the chief administrative patent judges, and the associate administrative patent judges, etc., shall sign and seal at the end of the decision.</p> <p>(Trial Guidebook Part 12. Chapter 4(7))</p> <p>○ If the administrative patent judges constituting the collegial body for appeal reach an appeal decision and sign and seal the decision, an official of the Trial Policy Division shall compare the decision with the records in the trial management system to check whether there is any error in the information entered in the decision and the issue date of the appeal decision is correct and thereafter serve the appeal decision.</p> <p>(Trial Guidebook Part 12. Chapter 10(1))</p>	<p>○ The whole text of an examination decision made by the PRB on a request for reexamination or invalidation shall be published unless where the patent application involved was not published. Where an examination decision shall be published but an action has been brought by the party concerned before the court and has been accepted, the examination decision will be published along with the judgment of the People's Court after the judgment coming into effect.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>○ <b>Article 50decies of the Implementing Rules of the JPA (Appeal Decision)</b> The written decision must be signed and sealed by the administrative judge who rendered the appeal decision.</p> <p>○ Except for the case where the appeal is closed by a ruling of dismissal, withdrawing a request for appeal, and abandoning, withdrawing, and modifying the application, the appeal decision shall generally be rendered within 20 days from the date when a notice of conclusion of appeal is issued and the appeal case shall be closed (Article 156, Paragraphs (1) and (4) of the JPA)</p> <p>The appeal decision includes a dismissal by an appeal decision on an improper request for appeal (Article 135 of the JPA) and an appeal decision rendered upon an appeal on the merits (Article 156, Paragraphs (1) and (4) of the JPA)</p> <p>(Appeal Guidebook Chapter Chapter 45-01(1))</p>

### 8.3. Order of appeal decision

	<p>○ (1) In a case where the original decision is vacated and the appeal case is remanded to the examiner</p> <p>① When the ruling of dismissal of an amendment is also vacated</p> <p>The Order section of the trial decision shall state: "the original</p>	<p>○ (1) a request for reexamination is not allowed, and the decision of rejection is upheld;</p> <p>(2) a request for reexamination is allowed, and the decision of rejection is revoked; and</p> <p>(3) where an application document has been amended and the</p>	<p>○ (1) In a case where a request for appeal is granted</p> <p>a. When vacating the original decision and deciding the application at hands without remanding the case to the examiner</p> <p>The appeal decision shall state that "the original decision</p>
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	<p>decision and the ruling of dismissal of the amendment, dated on 0000. 00. 00., shall be vacated and the present case shall be remanded to the Examiner."</p> <p>※ Details of whether the ruling of dismissal of the amendment is proper or not shall be included in the "Grounds" section of the appeal decision.</p> <p>※ Although the Order section may not state that the ruling of dismissal of the amendment shall be vacated, the administrative patent judges may vacate the ruling of dismissal of the amendment during the appeal proceeding on behalf of the examiner.</p> <p>② When there is no appeal against the ruling of dismissal of an amendment</p> <p>The Order section of the appeal decision shall state: "the original decision shall be vacated and the present case shall be remanded to the Examiner."</p> <p>(2) When the request for appeal is dismissed</p> <p>The Order section of the appeal decision shall state: "the request for appeal for the present case shall be dismissed."</p> <p>※ Details of whether the ruling of dismissal of the amendment is proper shall be included in the "Grounds" section of the appeal decision.</p> <p>(3) When the administrative patent judges render an appeal decision to vacate the original decision and render a decision to grant a patent without remanding the appeal case to the examiner</p> <p>The Order section of the appeal decision shall state: "the original decision shall be vacated and a patent shall be granted to the present application."</p> <p>(Trial Guidebook Part 21. Chapter 9(5))</p>	<p>defects indicated in the decision of rejection has been overcome, the decision of rejection is revoked on the basis of the amended text.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>shall be vacated" and "the present invention shall be granted a patent".</p> <p>b. When vacating the original decision and remanding the case to the Examiner</p> <p>The appeal decision shall state that "the original decision shall be vacated and the subject case shall be remanded to the examiner for examination"</p> <p>(2) Where the request for appeal is not granted</p> <p>The appeal decision shall state that "the request for appeal in the subject case is baseless"</p> <p>(Appeal Guidebook Chapter 45-04(5))</p>

#### 8.4. Reversing and rendering judgment

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| ○ In a case where it is found that a patent application cannot be rejected based on the grounds of decision to reject a patent application, the administrative patent judges may examine the | ○ (1) If an examination decision on a request for reexamination is overturned by an effective judgment of the People's Court, the | ○ In a case where it is found that the application cannot be rejected by the grounds of the original decision during the appeal on the appeal against the original decision, the appeal |
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	<p>patent application without remanding it to the examiner if, from the perspective of administrative economy, it is undesirable to leave the judgment and procedure to the examiner by remanding the case to the examiner after vacating the original decision although the administrative patent judges can also handle such judgment and procedure at the appeal. A case where the administrative patent judges are allowed to make their own judgment shall be limited to deciding to grant a patent or deciding to grant a request for extension of term of a patent right.</p> <p>(Trial Guidebook Part 21. Chapter 9(2))</p> <p>○ The administrative patent judges shall vacate the original decision and remand the case to the examiner when it is improper or impossible to make their own judgment under any of the following paragraphs:</p> <p>(1) when the substantial importance of the examination system that is divided into the two levels of "examination" and "appeal" will become meaningless if the administrative patent judges make their own judgment in a case where:</p> <p>a. the invention did not undergo substantive examination or was rejected for formality issues during the examination by the examiner</p> <p>b. a cited reference(s) is erroneously identified and a correct cited reference is not clearly identified</p> <p>(2) when the administrative patent judges' own judgment is unlawful in case where:</p> <p>a. the notice of decision to reject a patent application was issued without giving the applicant an opportunity to submit written opinions</p> <p>(Trial Guidebook Part 21. Chapter 9(3))</p>	<p>PRB shall make an examination decision anew.</p> <p>(2) Where the examination decision overturned for reasons if insufficient evidence or misapplication of laws, the Board shall not make a same decision as the previous one on the same grounds.</p> <p>(3) Where the examination decision is overturned for reasons of violation of statutory procedures, the PRB shall make an examination decision anew, with the procedural defects being remedied according to the judgment of the court.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>examiners may examine the application at hands by applying the examination procedures, <i>mutatis mutandis</i>, to the appeal proceeding. Thus, immediately remanding the case to the examiner upon vacating the original decision is undesirable in terms of administrative efficiency because it allows the examiner to proceed with examination and involved procedures, which can also be handled by the administrative judges. Thus, in the case as above, further examination must be conducted by the appeal examiners at the appeal.</p> <p>However, it is improper or impossible for the administrative judges to make their own judgment under any of the following paragraphs. In that event, it is considered to be desirable to vacate the original decision and remand the case to the examiner:</p> <p>(1) when the substantial importance of the examination system that is divided into the two levels of "examination" and "appeal" will become meaningless if the trial examiners make their own judgment on the application without remanding the case to the examiner where:</p> <p>○ the invention did not undergo substantive examination or was rejected for formality issues during the examination by the examiner</p> <p>○ a cited reference(s) is erroneously identified and a correct cited reference is clearly identified</p> <p>(2) when the appeal examinations' own judgment is improper where:</p> <p>○ the decision of refusal is issued without giving the applicant an opportunity to submit opinions</p> <p>(Appeal Guidebook Chapter 61-07)</p>
<p><b>8.5. Effect of appeal decision</b></p>	<p>○ <b>Article 176 of the KPA (Cancellation of Decision to Reject Patent Application, etc.)</b> (1) Where an administrative patent judge deems that the request for a trial under Articles 132-3 is</p>	<p>○ <b>Article 63 of the Implementing Regulations of the Patent Law</b> Where, after reexamination, the Patent Reexamination Board finds that the request does not comply with relevant</p>	<p>○ <b>Article 156 of the JPA (Notice of Conclusion of Appeal)</b> (1) When the case has reached the point at which an appeal decision may be rendered except for a patent invalidation</p>

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	<p>well-grounded, he/she should make a trial decision to cancel the decision to reject a patent application or to reject the registration of an extension of term of a patent right.</p> <p>(2) When any decision to reject a patent or to reject the registration of extension of term of a patent right is revoked pursuant to paragraph ① in a trial, a trial decision may be made to remand the case for examination proceedings.</p> <p>(3) <u>In ruling on a trial under paragraphs (1) and (2), the reasons constituting the basis for the reversal shall bind the examiner with respect to the case.</u></p>	<p>provisions of the Patent Law and these Implementing Regulations, it shall invite the person requesting reexamination to submit its or his observations within a specified time limit. If the time limit for making response is not met, the request for reexamination shall be deemed to have been withdrawn. Where, after the requesting person has made its or his observations or amendments, the Patent Reexamination Board still finds that the request does not comply with relevant provisions of the Patent Law and these Implementing Regulations, it shall make a decision of reexamination to maintain the earlier decision rejecting the application.</p> <p>Where, after reexamination, the Patent Reexamination Board finds that the decision rejecting the application does not comply with relevant provisions of the Patent Law and these Implementing Regulations, or that the amended application has removed the defects as pointed out by the decision rejecting the application, it shall make a decision to revoke the decision rejecting the application, and ask the examination department which has made the examination to continue the examination procedure.</p>	<p>appeal, the chief administrative judge shall notify the parties and intervenor(s) of the conclusion of the proceedings.</p> <p>(omitted)</p> <p>(4) The appeal decision shall be rendered within 20 days from the date on which the notice under paragraph (1) or (2) has been issued; provided, however, that this shall not apply where the case is complex or there are unavoidable reasons therefor.</p> <p>○ <b>Article 160 of the JPA</b></p> <ol style="list-style-type: none"> <li>1. Where an examiner's decision has been rescinded in an appeal against the examiner's decision of refusal, an appeal decision may be made to order a further examination to be carried out.</li> <li>2. <u>The decision made in the appeal decision under the preceding paragraph shall be binding upon the examiner with respect to the case.</u></li> <li>3. Article 159(3) shall not apply where an appeal decision under paragraph (1) is rendered.</li> </ol>

### 8.6. Appeal against appeal decision

<p>○ <b>Article 186 of the KPA (Action on Trial Decision etc.)</b> (1) The Patent Court of Korea shall have an exclusive jurisdiction over any action against a trial decision or dismissal of a request for a trial or retrial.</p> <p>(2) The action prescribed in paragraph (1) may be brought by a person who is a party, intervenor or any person who has requested for intervention in the trial but has been rejected.</p> <p>(3) The action prescribed in paragraph (1) shall be brought within thirty days from the date of receipt of a certified copy of the trial decision or ruling.</p> <p>(4) The period prescribed in paragraph (3) shall be invariable.</p> <p>(5) With respect to an invariable period as referred to in paragraph (4), the presiding administrative patent judge may, <i>ex officio</i>, determine any additional period for the benefit of a</p>	<p>○ If a petitioner is not satisfied with the reexamination decision, he may institute legal proceedings before the People's Court according to Article 41.2 within three months from the date of receipt of the reexamination decision; where no legal proceedings are instituted within the specified time limit, or the reexamination decision is upheld by an effective judgment of the People's Court, the reexamination procedure is terminated.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>○ <b>Article 178 of the JPA (Action on Appeal Decision etc.)</b> The Tokyo High Court shall have exclusive jurisdiction over any action raised against an appeal decision or a ruling to decline to grant a notice of appeal or retrial, or a request for correction provided for under Article 134<i>bis</i>, Paragraph (1) of the JPA.</p> <ol style="list-style-type: none"> <li>2. An action under paragraph (1) may be instituted only by a party in the case, an intervenor, or a person whose application for intervention in the appeal or in the retrial has been refused.</li> <li>3. An action under paragraph (1) may not be instituted after the expiration of thirty days from the date on which a certified copy of the appeal decision or the ruling has been served.</li> <li>4. The time limit as provided in the preceding paragraph shall be invariable.</li> <li>5. The chief administrative judge may <i>ex officio</i> designate an</li> </ol>
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ITEM	KOREA	CHINA	JAPAN
	<p>person residing in a remote area or area with poor transportation</p> <p>(6) No action may be brought unless it relates to matters for which a trial may be requested</p> <p>(7) No action under paragraph (1) on a trial decision on consideration under Article 162 (2) 4 and a trial decision or ruling on trial costs under Article 165 (1) may be brought independently</p> <p>(8) Any person who has received a ruling from the Patent Court may appeal to the Supreme Court</p>		<p>additional period extending the invariable time limit under the preceding paragraph for a person in a remote area or an area with transportation difficulty.</p> <p>6. An action with regard to a matter for which a request for an appeal may be made may be instituted only against an appeal decision.</p> <p>○ <b>Article 2 of the Act for Establishment of the Intellectual Property High Court (Establishment of the Intellectual Property High Court)</b> Notwithstanding the provisions of Article 22, Paragraph 1 of the Court Act (Act No. 59 of 1947), the Intellectual Property High Court shall be established within the Tokyo High Court as a special branch that shall handle the following intellectual property cases over which the Tokyo High Court has jurisdiction:</p> <ol style="list-style-type: none"> <li>1. (omitted)</li> <li>2. Lawsuits pertaining to actions set forth in Article 178, Paragraph 1 of the Patent Act (Act No. 121 of 1959) ...</li> <li>3. (omitted)</li> <li>4. (omitted)</li> </ol>

### 8.7. Withdrawal of appeal

<p>○ In general, the appeal proceedings are closed by an appeal decision, a ruling, or a <u>withdrawal of a request for appeal</u> by petitioner.</p>	<p>○ The reexamination procedure is terminated where the request for reexamination is deemed withdrawn for lack of response within the time limit.</p> <p>The reexamination procedure is terminated where the petitioner has withdrawn the request for reexamination before a reexamination decision is made.</p> <p>The reexamination procedure is terminated where the request for reexamination that has been accepted is rejected for inconformity with the requirements of acceptance.</p> <p>(Guidelines for Examination, Part IV, ChapterII)</p>	<p>○ Except for the case where the appeal is closed by a ruling of dismissal, withdrawing a request for appeal, and abandoning, withdrawing, and modifying the application, the appeal decision shall generally be rendered within 20 days from the date when a notice of conclusion of appeal is issued and the appeal case shall be closed (Article 156 of the JPA)</p> <p>(Appeal Guidebook Chapter 45-01(1))</p>
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## 9. Accelerated appeal

### 9.1. Case for the accelerated appeal

ITEM	KOREA	CHINA	JAPAN
	<p>○ <b>Article 31 of the Trial Practice Rules (Priority of Trials) (1)</b> Trials are, in principle, conducted in sequence of dates requested. However, a trial may be examined in preference over others if the former falls under any of the following items for which an accelerated trial is deemed necessary:</p> <ol style="list-style-type: none"> <li>1. An appeal case against a ruling of dismissal of an amendment;</li> <li>2. A trial case that is revoked in an action to revoke a trial decision by the IPTAB;</li> <li>3. A trial case where an examiner requests an invalidation trial <i>ex officio</i>;</li> <li>4. A trial case that is related to an infringement suit notified by a court under Article 164, Paragraph (3) of the KPA after a request for trial is filed, but not concluded yet;</li> <li>4-2. A trial case that is related to a unfair trade practice investigation case notified the Korea Trade Commission after a request for trial is filed, but not concluded yet;</li> <li>5. 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;</li> <li>6. A trial case that evokes social criticism against a dispute over intellectual property rights, and for which a party-in-interest or an associated authority/organization requests an accelerated trial;</li> <li>7. A trial case that ensues from an international dispute over intellectual property rights, and for which a party-in-interest or an associated authority/organization requests an accelerated trial;</li> <li>8. A trial case that is required to be processed urgently for the national economy and brought to trial under the necessity of conducting war, including, with limitation, munitions, and for which a party-in-interest or an associated authority/organization requests an accelerated trial;</li> <li>9. A trial case to confirm the scope of a patent right. In this case, if an administrative patent judge deems an accelerated trial</li> </ol>	<p>○ n/a</p>	<p>○ A trial on appeal against the examiner's decision of refusal for a patent application is subject to accelerated appeal if the patent application falls under any of the following requirements:</p> <ol style="list-style-type: none"> <li>(1) An appeal is requested by a demandant for a patent application for an invention which the demandant itself or a licensee, who is granted therefrom a license to practice the invention, is practicing the invention (where the patent application includes an application for an invention that is to be practiced within two 2 years from the filing date of an "written explanation of circumstances concerning an accelerated appeal"; and an application for an invention for which conducted are procedures (including but not limited to submitting a test request for consigned packaging and a declaration of treatment plans) that are required for rendering a disposition (a registration under the Agrochemicals Control Act and an approval under the Pharmaceutical Affairs Act), as defined in Article 3 of the Enforcement Decree of the JPA (hereinafter, such a patent application will be referred to as a "practice-related application").</li> <li>(2) An appeal is requested by a demandant for the invention for which the demandant files: a patent application(s) before a foreign IP office(s) other than the JPO or an inter-government office(s); or a PCT international patent application(s) (including a domestic national application(s) filed in Japan based on a priority claim(s) from the PCT international application(s), a PCT international application(s) at a national phase in Japan, etc.) (hereinafter, such patent applications will be referred to as the "foreign-related applications").</li> <li>(3) The demandant for the invention is, in whole or in part, a university/college, a public research institute, or an approved or authorized technology transfer agency (approved or authorized TLO).</li> <li>(4) The demandant for the invention is, in whole or in part, a small or medium-sized enterprise, or an individual.</li> <li>(5) A party (third party) which is not the demandant for the invention practices the invention as its business after the disclosure of the patent application to the public before an</li> </ol>

ITEM	KOREA	CHINA	JAPAN
	<p>necessary for an invalidation trial/correction trial that is pending along with the trial to confirm the scope of a patent right, the administrative patent judge may institute the accelerated trial in conjunction therewith; and</p> <p>10. An appeal case on appeal against the decision to reject the application for the patent application that has been subject to the accelerated examination, unless otherwise appealing a decision to reject the patent application for any of the following: a utility model application which is filed concurrently with a request for examination thereof, followed by a request for accelerated examination within two months from the filing thereof; an application for an invention an applicant itself is practicing or preparing for practicing; and an application for which an approved agency is requested to conduct a prior art/design search and then notify a report thereon to the Commissioner of the KIPO.</p> <p>○ <b>Article 31bis of the Trial Practice Rules (Super-accelerated Trial)</b> (1) Notwithstanding Article 31, Paragraph (1), a request for trial may be examined in preference over the others described in each item of Article 31, Paragraph (1), if the former falls under the following items for which a super-accelerated trial is deemed necessary; provided, however, that the case where procedures for an accelerated trial already proceeded under Article 31 shall be governed by Article 31:</p> <p>1. A trial to confirm the scope of a patent right or an invalidation trial among those related to an infringement suit notified by a court under Article 164, Paragraph (3) of the KPA (where the trial to confirm the scope of a patent right or the invalidation trial is limited to a case notified before a request for trial is filed);</p> <p><i>1bis.</i> a trial to confirm the scope of a patent right or an invalidation trial among those related to an unfair trade practice investigation case notified by the Korea Trade Commission conducts (where the trial to confirm the scope of a patent right or the invalidation trial is limited to a case notified before a request for trial is filed);</p> <p><i>1ter.</i> A trial to confirm the scope of a patent right or an invalidation trial related to a request for preliminary injunction to</p>		<p>appeal decision is rendered.</p> <p>(6) An appeal is requested by a demandant for a patent application sought to be patented for a green invention (that provides the effects of energy saving, CO<sub>2</sub> emission reduction, etc.)</p> <p>(7) An appeal is requested by a demandant for a patent application that falls under any of the following: (i) the demandant is, in whole or in part, a person who has an address or a place of residence at a region (excluding Tokyo; hereinafter, the "specific disaster region") governed by the Disaster Recovery Act (Act No. 118 as legislated Showa 22), and suffers from earthquake-caused damage; or (ii) the demandant is an incorporated entity whose place of business, etc. (*9) is damaged by an earthquake as being located at the specific disaster region; and the appeal concerns a patent application related to an invention that is made or practiced at the place of business, etc. (temporally from August 1, Hei 23)</p> <p>(8) An appeal is requested by a demandant for a patent application that falls under the following: (i) the demandant is, in whole or in part, a national affiliated established by a specific multinational company to conduct research and development business according to an approved research and development project (hereinafter, the "approved R&amp;D project") based on the Act on Special Measures to Promote Research and Development Business by Specific Multinational Company (Act No. 55 as legislated Heisei 24; hereinafter, the "Asian Business Location Act"); and (ii) the appeal concerns a patent application for an invention that is related to the outcome of the research and development business (where the patent application is limited to being filed within 2 years commencing from the expiration date of a period during which the research and development business has been conducted in the approved R&amp;D project) (hereinafter, such a patent application will be referred to as a "Asian Business Location Act-related application".</p> <p>("Guidelines for Accelerated Examination/Accelerated Appeal Trial of Patent Application," the JPO, July Heisei 25)</p>

ITEM	KOREA	CHINA	JAPAN
	<p>prohibit infringement, provided that a super-accelerated trial is requested (Annexed Form No. 24) within seven days after a request for trial is filed (where the trial to confirm the scope of a patent right or the invalidation trial is limited to a case where preliminary injunction is requested before a request for trial is filed, but is not concluded yet);</p> <p>2. A trial case where a party-in-interest submits, with consent of the other party, a request for a super-accelerated trial (Annexed Form No. 24) within the due date for submitting a response;</p> <p>3. <u>A trial case on appeal to a decision to reject the patent application rendered under super-accelerated examination for a patent application among those directly related to green technology as described in Article 9, Paragraph (2) of the Enforcement Decree of the KPA;</u></p> <p>4. A trial case that is a first correction trial which is requested by a patent holder for a granted right before the Patent Court closes all hearings for an action to revoke a decision on an invalidation trial for the same right, and in which a request for a super-accelerated trial (Annexed Form No. 24) is made;</p> <p>5. A trial case that is an invalidation trial requested solely on the grounds that the patent owner is not legally entitled own the patent, as described in Article 33, Paragraph (1) of the KPA, and in which a party-in-interest requests a super-accelerated trial; and</p> <p>6. A trial case that is related to a case prosecuted by the police or the prosecution before a request for trial is filed, and in which a party-in-interest or an associated authority/organization requests a super-accelerated trial.</p>		

## 9.2. Procedure of appeal proceedings

<p>○ <b>Procedure for Accelerated Appeal</b></p> <p>(1) Upon receipt of a request for an accelerated trial, the Trial Policy Division of IPTAB shall immediately enter it into the designated trial administration processing system and transfer to a chief administrative patent judge.</p> <p>(2) If an accelerated trial is requested, the presiding administrative patent judge shall discuss with the chief</p>	<p>○ n/a</p>	<p>○ <b>Procedure for Accelerated Appeal</b></p> <p>In the case of requesting an accelerated appeal, a copy of a "written explanation of circumstances concerning an accelerated appeal" shall be submitted for each appeal eligible for an accelerated appeal. (For an appeal staying at a reconsideration stage, it may be permissible to submit the "written explanation of circumstances concerning an accelerated</p>
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ITEM	KOREA	CHINA	JAPAN
	<p>administrative patent judge and decides on whether the request for the accelerated trial meets the requirements therefor within fifteen days from the date when the request for the accelerated trial is transferred from the Trial Policy Division, and then immediately notify a party-in-interest of the decision. However, in a case where an amendment is ordered for violation of the formality requirements, among trials to confirm the scope of a patent right (including invalidation trials/correction trials pending therewith), a decision on whether to institute an accelerated trial may be notified after the amendment is remediated.</p> <p>(3) For a trial case decided to proceed with an accelerated trial, the presiding administrative patent judge (or another administrative patent judge) shall lead it to mature fast based on oral hearings, evidence investigation/verification, or interviews, etc., and in principle, process within four months from the date when the accelerated trial is decided. However, if the accelerated trial is not mature fully enough to be processed within the above-identified time period, it shall be processed within two and a half months from the date when a final response is received.</p> <p>(4) For an accelerated trial by request, the Trial Policy Division should record the dates of the request received and transferred to the Trial and appeal Board of IPTAB, the date when the accelerated trial is decided, details of such decision, the date of a decision thereon made, etc. in the designated trial administration processing system.</p> <p>(Trial Guidebook Part 7. Chapter 4)</p> <p>○ <b>Procedure for Super-accelerated Appeal</b></p> <p>(1) Upon receipt of a request for a super-accelerated trial, the Trial Policy Division of IPTAB shall immediately enter it into the designated trial administration processing system and transfer to a chief administrative patent judge.</p> <p>(2) For a case eligible for a super-accelerated trial, the presiding administrative patent judge shall discuss with the chief administrative patent judge and decide whether this case meets</p>		<p>appeal.")</p> <p>NOTE) Since an "accelerated appeal" is different from "accelerated examination," even if the procedure for "accelerated examination" has been conducted, the procedure for "accelerated appeal" is required to be conducted again if the "accelerated appeal" is desired in trial proceedings.</p> <p>(1) Submitter</p> <p>The submitter shall be a demandant for appeal.</p> <p>(2) How to Submit</p> <p>A request for an accelerated appeal may be submitted online or directly to the designated reception desk (of the Patent Filing Support Division of the JPO located at 3-4-3 Kasumigaseki, Chiyoda-ku, Tokyo) or via mail, directed to the Commissioner of the JPO (3-4-3 Kasumigaseki, Chiyoda-ku, Tokyo, postal code: 100-8915) with the following statement indicated on an envelope: "Written Explanation of Circumstances Concerning Accelerated Appeal Enclosed."</p> <p>(3) Fees</p> <p>No fees are incurred for the submission of a "written explanation of circumstances concerning an accelerated appeal." Further, even if the same is submitted in writing, no fees are charged for data entry.</p> <p>(4) Supplement to the Written Explanation of Circumstances</p> <p>In the case of supplementing the submitted "written explanation of circumstances concerning an accelerated appeal," it proceeds with a "supplement to the written explanation of circumstances concerning an accelerated appeal." This will not incur any fees as well.</p> <p>("Guidelines for Accelerated Examination/Accelerated Appeal Trial of Patent Application," the JPO, July Heisei 25)</p> <p>○ <b>Appeal Proceedings, etc.</b></p> <p>(1) Procedure for determination</p>

ITEM	KOREA	CHINA	JAPAN
	<p>the requirements for a super-accelerated trial within fifteen days from the date when a request for super-accelerated trial is transferred from the Trial Policy Division, and then immediately notify a party-in-interest of the decision. However, in a case where an amendment is ordered for violation of the formality requirements provided for under the KPA/Utility Model Act/Trademark Act/Design Act, a decision of whether to institute a super-accelerated trial may be notified after the amendment is remediated.</p> <p>(3) For a case related to an infringement suit and a case where a request for a super-accelerated trial is submitted, among inter parties cases, an oral hearing shall be held within one month from the expiration date of the deadline for submitting a response, and come to a decision within two months from the date when the oral hearing is held (in the case of continuing oral hearing, the date when a final oral hearing is held). However, an oral hearing may not be held for the case where a trial decision is made within one month from the due date for submitting a response.</p> <p>(4) The process initiation date and the process termination date of an accelerated trial shall apply <i>mutatis mutandis</i> to ex parte cases. However, if a notice to submit a response in a correction trial is sent out within three months from the initiation date, the termination date shall be set to a date when two months lapse from the due date for submitting the response.</p> <p>(5) The Trial Policy Division should record the dates of a request for a super-accelerated trial received and transferred to the Trial and Appeal Board of IPTAB, the date of a decision thereon made, etc.</p> <p>(Trial Guidebook Part 7. Chapter 4)</p>		<p>① Procedure for determination</p> <p>For a trial under which a "written explanation of circumstances concerning an accelerated appeal" is submitted, Director of the Board of Trial and Appeal or chief administrative judge designates a deputy administrative judge who will then determine whether the appeal is eligible for an accelerated appeal and get an approval therefor from the Director of the Board of Trial and Appeal or chief administrative judge.</p> <p>② If it is decided to notify the determination result that "the appeal requested is ineligible for an accelerated appeal," the determination result and accompanying grounds therefor are notified to the demandant (or its counsel/agent).</p> <p>③ Regarding confirmation, etc. when making a determination</p> <p>In regard to explanations on the circumstances concerning an accelerated appeal among those set forth in the "written explanation of circumstances concerning an accelerated appeal," the grounds for such explanations, etc. may occasionally be confirmed by holding a hearing(s), requesting the submission of any relevant material(s), etc.</p> <p>(2) Accelerated trial by a collegial panel</p> <p>For an appeal that is determined to be eligible for an accelerated appeal, a responsible collegial panel for the appeal expeditiously initiates the appeal trial in preference over other general appeals, and conducts appeal proceedings to dispose without delay.</p> <p>Further, for an appeal entering into a reconsideration stage, reconsideration proceedings are conducted expeditiously.</p> <p>(3) Cooperation of the demandant (counsel/agent)</p> <p>① Despite that the collegial panel accelerates an appeal, if the specification fails to meet the statutory description requirements, it is required to undergo procedures of notifying reasons for refusal and awaiting a response thereto, thereby resulting in a prolonged time for appeal in some cases. When requesting an appeal, it is required to attentively check whether the request for appeal, or the specification or a</p>



ITEM	KOREA	CHINA	JAPAN
			<p>drawing(s) fully comply with the statutory description requirements.</p> <p>② In a case where an order regarding formalities, a notice of reasons for refusal, and examination take place, a response shall be made expeditiously, based on the object of an accelerated appeal. Further, if a request for extension of the deadline for submitting a response is made at the time of issuing a notice of reasons for refusal, conducting examination, etc. in an appeal requested, it should be careful that, even if the appeal is determined to be eligible for an accelerated appeal, based on the object of the accelerated appeal, the appeal is, in principle, handled identically to general appeals after such time extension.</p> <p>③ A written explanation of circumstances concerning an accelerated appeal, an amendment to a procedure(s), a response, etc. may be submitted online, if possible.</p> <p>④ In order to accelerate an appeal, an interview would be more effective. Upon request from the collegial panel of the appeal, cooperation is required.</p> <p>(4) Perusal of documents submitted</p> <p>As with the perusal of appeal records, a "written explanation of circumstances concerning an accelerated appeal" is also subject to perusal, regardless of the determination result.</p> <p>("Guidelines for Accelerated Examination/Accelerated Appeal Trial of Patent Application," the JPO, July Heisei 25)</p>

## **Chapter III Analysis Results**

# **I. Comparison of Organization**

## **1. Organization chart**

Please refer to 1. Organization chart of chapter I.

## **2. Overview of organization**

### **2.1. Organization**

The Intellectual Property Trial and Appeal Board (IPTAB) of Korea is an organization affiliated with the Korean Intellectual Property Office (KIPO) and consists of 11 trial and appeal boards, one division (trial policy division), and one team (litigation team). 11 trial and appeal boards include trademark boards (trial and appeal board 1, 2, and 3), a machinery-specialized board (trial and appeal board 4), a chemistry-specialized board (trial and appeal board 7), an electricity-specialized board (trial and appeal board 8), a complex technology board (trial and appeal board 5, 6, 9, and 10), and a trademark design board (trial and appeal board 11). The trial policy division oversees trial formality examination, trial quality evaluations, and trial policy establishment, and the litigation team conducts defense decisions by the IPTAB on an appeal against a decision of rejection and a correction trial before the Patent Court. The President of the IPTAB handles all office operations relating to the management of the IPTAB, directs and supervises assigned public officials, and each trial boards consists of one presiding administrative patent judge and ten administrative patent judges or less.

The Chinese Patent Reexamination Board (PRB) belongs to the State Intellectual Property Office (SIPO) and consists of two offices (general office, party committee office) and 21 divisions. The appeal division consists of mechanical fields (2 divisions), electronic fields (2 divisions), communication fields (2 divisions), photo electricity fields (2 divisions), medical and biological fields (2 divisions), chemical fields (2 divisions), material fields (2 divisions), and design lawsuit department (1 division). The administrative litigation division conducts operations relating to cancellation litigation against the appeal decision of rejection. The members of the PRB include the Director, Deputy Directors, principal examiners for reexamination and adjunct principal examiners for reexamination examiners for reexamination, adjunct examiners for reexamination.

The Japanese Trial and Appeal Department is a subsidiary organization of the Japan Patent Office (JPO), and consists of 38 trial and appeal boards, one division (a trial and appeal division), and one office (a litigation affairs office). The trial and appeal boards are divided into a total of 38 fields, i.e., physics·optics·infrastructure fields (boards 1 to 8), machinery fields (boards 9 to 18), chemistry fields (boards 17 to 25), electricity fields (boards 26 to 33), design fields (board 34), and trademark fields (boards

36 to 38).

## **2.2. Manpower**

The IPTAB of Korea has a total of 100 persons based on the quota in 2013, i.e., one President, 11 presiding administrative patent judges, and 88 administrative patent judges. In addition, an appeal policy division (25 persons) and a litigation team (15 persons) are newly assigned.

In China, there are 238 trial examiners (administrative patent judges) in the PRB and 70 trial examiners (administrative patent judges) in the trademark review and adjudication board.

The Japan Trial and Appeal Department has 334 trial examiners for patent and utility model, 11 trial examiners for design, and 42 trial examiners for trademark based on the quota in 2013.

## **3. Structure of a trial and appeal department**

### **3.1. Qualification for administrative patent judges**

#### **3.1.1. Presiding Administrative patent judge**

In Korea, a person who can be a presiding administrative patent judge is a public official of Grade III in general service or a public official in general service as a member of the Senior Civil Service who works for KIPO or any of its affiliated agencies.

#### **3.1.2. Administrative patent judge**

In Korea, a person who can be an administrative patent judge is a public official of Grade IV or higher in general service or a public official in general service as a member of the Senior Civil Service who works for KIPO or any of its affiliated agents, has an experience as an examiner, and has completed the specified education and training course conducted for administrative patent judges by the International Intellectual Property Training Institute (IIPTI).

In Japan, a person who is qualified as a trial examiner (administrative patent judge) is a person of Grade IV or higher or Grade III or higher who has experience as an examiner and has completed a specific training course conducted by the National Center for Industrial Property Information and Training.

## **3.2. Collegial body for appeal**

### **3.2.1. Composing of collegial body for appeal**

The three countries are identical in that a collegial body for appeal is formed as a collegial body of three administrative patent judges or five administrative patent judges.

In Korea, a collegial body of three administrative patent judges consisting of one presiding administrative patent judge, one chief administrative patent judge, and one associate administrative patent judge or a collegial body of five administrative patent judges consisting of one presiding administrative patent judge, one chief administrative patent judge, and three associate administrative patent judges can be formed. The consultation is decided by a majority vote and its result is not open to the public. A chief administrative patent judge conducts substantive works, such as drafting the written consultation and the appeal decision, etc., and an associate administrative patent judge assists the chief administrative patent judge's works.

In China, a panel of three members, which consists of one chairman (a head of the appeal divisions or the principal examiners for reexamination), one first member, and one second member, or a panel of five members, which consists of one chairman, one first member and three second members, can be formed. The first member of the panel conducts substantive works, such as comprehensively examining an assigned case and drafting a written decision, and the second member assists the chairman and the first member's work. Principal examiners for reexamination, examiners for reexamination, adjunct principal examiners for reexamination, and adjunct examiners for reexamination can serve as the first or second member of the panel. An examiner invited from the examination division can serve as a second member depending on a case.

### **3.2.2. Collegial body of five administrative patent judges**

The three countries are identical in that a collegial body of five administrative patent judges can be formed in an appeal.

In Korea, a collegial body of five administrative patent judges consists of the President of the IPTAB or the senior presiding administrative patent judge and four presiding administrative patent judges or administrative patent judges designated by the President of the IPTAB. Whether a collegial body of five administrative patent judges is carried out is determined by the President of the IPTAB. A collegial body of five administrative patent judges is carried out for a case where the former decision or appeal decision should be changed, a case where it is important in legal or technical judgment, a case where many appeal boards are mutually involved, etc. However, a collegial body of five administrative patent judges is rarely carried out. (Three cases in 2012 and none in 2013)

In China, in case where it is necessary to form a panel of five members, a Director or a Deputy Director may independently decide to do so, or a person in charge in the relevant department or a member of the panel may receive an approval for forming the panel of five members by submitting a report to the Director or Deputy Director in

accordance with the prescribed procedure.

In Japan, a panel of five patent administrative judges is operated according to the internal regulations for an important case in legal or technical judgment or a case which gives a great effect on society, a case for which a request for retrial is filed, and a case judges by the Director-General of the Trial and Appeal Department to be necessary.

#### **4. Exclusion of administrative patent judges and the like**

##### **4.1. Related laws**

The three countries are identical in that in order to secure fairness in an appeal, the Patent Act provides an exclusion of administrative patent judges in the case where an administrative patent judge is a close relative of a concerned party or an administrative patent judge was involved in examination. There is a difference in that in Korea, the exclusion is divided into three cases, i.e., exclusion, challenge, and avoidance, whereas China adopts a single system of avoidance and Japan prescribes exclusion and recusation (challenge) under the Patent Act.

In Korea, exclusion means that an administrative patent judge is excluded from performing his/her natural legal duties due to a specific cause, and challenge (recusation) means that where there are circumstances where it is difficult to anticipate fairness in an appeal proceeding and thus a request for excluding an administrative patent judge from performing his/her natural legal duties is filed by a concerned party, etc., an administrative patent judge is excluded from performing his/her natural legal duties, and avoidance is a system where an administrative patent judge voluntarily resigns from performing his/her natural legal duties.

In China, a system of avoidance is prescribed under Article 37 of the Implementing Regulations of the Patent Law of People's Republic of China, but exclusion and challenge are not provided.

In Japan, a system of exclusion and recusation (challenge) is prescribed under the Patent Act, but the regulations of avoidance are only provided in the appeal handbook.

##### **4.2. Related guidelines**

The three countries are identical in that when a concerned party files a request for exclusion or challenge of an administrative patent judge, a decision is made in writing and a notification is sent to the petitioner.

In Korea, a request for exclusion can be filed until a decision is rendered. However, a request for challenge cannot be filed after a written or oral statement is made before an administrative patent judge. If a request for exclusion or challenge is filed, a decision is made based on an appeal. Avoidance can be filed at any time by reporting to the President of the IPTAB. If a decision of exclusion or challenge is made, an administrative patent judge is excluded from an appeal case.

In China, a trial examiner may avoid an appeal case with the request from a concerned party or by voluntarily resigning from the appeal case. Contrary to Korean and Japan, in China, the Director or the Deputy Director of the PRB is prohibited from representing a concerned party in the reexamination or invalidation appeal case within three years after leaving his or her position, and other people working at SIPO are prohibited from representing a concerned party in the reexamination or invalidation appeal case within two years after leaving his or her position.

Like Korea, Japan has a system of exclusion and challenge under the Patent Act and an operation method is similar to Korea.

## **II. Comparison of appeal against decision of rejection**

### **1. Relevant laws**

#### **1.1. Laws related to appeal request**

Please refer to (Korea) Article 132 of the Patent Act; (China) Article 41 of the Patent Law; (Japan) Article 121 of the Patent Act

#### **1.2. Laws related to appeal formalities**

Please refer to (Korea) Articles 140*bis*, 141, and 142 of the Patent Act; (China) Article 60 of the Implementing Regulations of the Patent Law; (Japan) Articles 131, 131*bis*, 133, 133*bis*, and 135 of the Patent Act

#### **1.3. Laws related to reconsideration by examiner before an appeal**

Please refer to (Korea) Articles 173-175 of the old Patent Act; (China) Article 62 of the Implementing Regulations of the Patent Law; (Japan) Articles 162-164 of the Patent Act

#### **1.4. Laws related to appeal proceeding on the merits**

Please refer to (Korea) Article 162, 170-172 and 176 of the Patent Act; (China) Article 63 of the Patent Law; (Japan) Articles 156-161 of the Patent Act

#### **1.5. Laws related to specification or drawings**

Please refer to (Korea) Article 47 of the Patent Act; (China) Article 33 of the Patent Law and Article 61 of the Implementing Regulations; (Japan) Article 17*bis* of the Patent Act



## **2. Petitioner**

### **2.1. Petitioner**

The three countries are identical in that a patent applicant or a successor can file a request for appeal against the decision to reject the application.

In Korea, in the case of a request for appeal filed after January 30, 2009, even if an appeal request deadline has elapsed, an amendment to correct a description of petitioner is not recognized as a change of subject matters.

### **2.2. Joint application**

In the three countries, joint applicants should jointly file a request for appeal against a decision to reject the application. In the case where there is a defect in the joint appeal request requirements, it can be cured by the amendment if the deadline for filing the request for appeal has not yet elapsed.

However, in Korea, for a request for appeal filed after January 30, 2009, even if a deadline for filing an appeal has elapsed, the case of adding an omitted co-applicant(s) is not recognized as a change of subject matters.

### **2.3. Whether appeal intervention is possible**

The three countries are identical in that appeal intervention is not allowed in an appeal against a decision to reject the application. However, if a third party has an argument, a written statement for provision of information can be filed with the tribunal.

## **3. Request for appeal**

### **3.1. Subject matter of request**

The three countries are identical in that the subject matter of the appeal against a decision to reject the application is a decision to reject the application.

## **3.2. Time frame**

### **3.2.1. Period for request**

There is a difference in that in Korea, a request for appeal against a decision to reject the application can be filed within thirty days after receipt of the notice of the decision to reject the application, whereas in China and Japan, a request for appeal against the decision of rejection can be filed within three months from the receipt of the notice.

### **3.2.2. Extension of periods**

In Korea, the period to file a request for appeal can be extended upon request or *ex officio*. In practice, in the case of residents, the deadline can only be extended once up to thirty days. In the case of non-residents, the deadline can be extended up to two months.

In China, the period to file a request for appeal cannot be extended.

In Japan, in the case of residents, the deadline cannot be extended. In the case of non-residents, the deadline can be extended for one month *ex officio*.

### **3.2.3. Calculation of periods**

In the three countries, the first day of the period is not counted for calculating the period, and if the last day of the period falls on an official holiday, the period expires on the next business day (Monday).

When the start of the period does not coincide with the beginning of a month or year, the period expires on the day preceding the date in the last month or year of the period corresponding to the date on which the period started. However, where a month or year is used and there is no corresponding day in the last month, the period expires on the last day of that month.

China adopts an estimated served date system when calculating the period. All specified periods and some statutory periods are calculated based on the estimated served date of the notice and decision. The estimated served date is set to be 15 days after the date at which SIPO issues a document (the date will be indicated in the notice and decision). For example, if the notice was issued from SIPO to the applicant on July 4, 2001, then its estimated served date is July 19, 2001.

### **3.3. Written request for appeal**

#### **3.3.1. Purport of the request**

In Korea and Japan, the purport of the request is described: "The original decision should be revoked. Patent Application No. xxxx should be granted."

In China, the purport of the request is described: "I (We) file a request for reexamination against the final rejection rendered on the patent application by the State Intellectual Property Office on [year, month, day]."

#### **3.3.2. Grounds for the request**

The three countries are identical in that when filing a request for appeal, the grounds for the request should be described. In this case, if the grounds for the request are illegitimate, an order of amendment is issued.

In Korea and Japan, if substantial reasons are not described in the grounds for the request, an order of amendment should be issued. If an amendment is not made within a designated period, the written request for appeal is dismissed by a decision. Meanwhile, in Korea, as for the reconsideration by examiner before the appeal (applications filled before June 30, 2009), it is possible to omit the grounds for the request when filing a request for appeal and later describe the grounds for the request after the reconsideration by examiner is finished. In the case where the grounds for the request are substantially not described, e.g., only the intention to later supplement the grounds for the request is indicated by describing 「detailed grounds will be supplemented at a later time」, etc., an order of amendment is issued. If no amendment is made in response to the order, the written request for appeal is dismissed.

In China, a person who files a request for reexamination should submit a written request for reexamination and explain the grounds, and also, if necessary, attach its relevant evidences. If the written request for reexamination does not comply with the prescribed formalities, the person who filed a request for reexamination is notified of non-compliance so that he/she can cure the defect of the written request within a designated period. If no amendment is made or the request is not cured after two amendments within the designated period, the request for reexamination is deemed to have not been submitted.

### **3.4. Fees**

The three countries are identical in that fees for filing a request for appeal should be paid.

In Korea, in the case of electronic filing, fees for filing a request for appeal are a basic fee of 150,000 KRW plus an additional fee of 15,000 KRW per claim. In the case of paper filing, a basic fee is 170,000 KRW.

In China, fees for filing a request for appeal are a basic fee of 1,000 yuan for patent cases and a basic fee of 300 yuan for utility model and design cases.

In Japan, fees for filing a request for appeal are a basic fee of 49,500 JPY plus an additional fee of 5,500 JPY per claim.

#### **4. Formality Examination**

##### **4.1. General examination of appeal formalities**

The three countries are identical in that in the case where the written request for appeal is illegitimately described, an order of amendment is issued with respect to an error that can be solved. Meanwhile, there is a difference in that when the formality examination is passed, Korea and Japan do not issue a notification to the petitioner (demandant), but China issues a notification of acceptance of reexamination request to the petitioner. Further, in Korea and Japan, as for a matter which can be amended, an order of amendment is issued and if an error is not cured, the request for appeal is dismissed by a decision. As for a defect which cannot be solved, the request for appeal is dismissed by an appeal decision. However, China issues a notification that a reexamination request is deemed not to be submitted or a notification that a reexamination request is not accepted.

In Korea, once a request for appeal is filed, "a notification of appeal number and designation of administrative patent judge" is issued to the petitioner. However, if the grounds for request are not described in case of the reconsideration by examiner before the appeal, an order of amendment is issued under the name of the President of the IPTAB without designating administrative patent judges, and if no amendment is filed, the request for appeal is invalidated. If the written request for appeal violates formalities (violation of legal capacity, a defect in the right of representation, a case where the written request violates the formalities prescribed under the laws, fees are not paid, etc.), an order of amendment is issued while generally giving a period of four weeks (extendible). If no amendment is filed within a designated deadline or a defect cannot be cured by an amendment, the written request for appeal is dismissed by a decision. If a request for appeal is illegitimate and a defect cannot be amended (an appeal request period has elapsed, an application is withdrawn while an appeal is pending, etc.), the request for appeal can be dismissed by an appeal decision without giving the respondent an opportunity to submit a response.

In China, if the request for reexamination needs to be amended upon the formality examination because it does not comply with the patent law, the implementing regulations, and the examination guidelines, the PRB issues an order of amendment to the petitioner. The order of amendment requires the petitioner to amend the request

for reexamination within fifteen days from the date when the notice is received by the petitioner. If the request for reexamination is deemed to have not been submitted or is not accepted, the PRB notifies the petitioner by issuing a notice indicating that the request for reexamination is deemed to have not been submitted or a notification indicating that the request for reexamination is not accepted. If the request for reexamination is found to be in compliance with the patent act, the implementing regulations of the patent law, and the relevant regulations of the examination guidelines, the PRB should notify the petitioner by issuing a notice indicating that the request for reexamination is accepted.

In Japan, if the written request for appeal violates formalities, an order of amendment is issued and if no amendment is filed within a designated deadline or a defect cannot be cured by an amendment, the written request for appeal is dismissed by a decision. Meanwhile, if a request for appeal is illegitimate and a defect cannot be amended, the request for appeal can be dismissed by an appeal decision without giving the respondent an opportunity to submit a response.

#### **4.2. Change of gist**

Korea and Japan are identical in that the gist of an appeal cannot be changed while an appeal is pending, and if the gist of an appeal is changed (change of the purport of the request, change of the indication of case, etc.), the request for appeal is dismissed by an appeal decision.

In Korea, for an appeal against a decision of rejection filed after July 1, 2009, an amendment to correct a description of petitioner (applicant) (including addition) is not recognized as a change of gist.

China has no relevant regulation.

### **5. Grounds for rejection**

The three countries are identical in that the grounds for rejection (reasons for refusal) deal with patentability requirements, such as novelty, inventiveness, first-to-file rule, etc. however, they are slightly different with respect to the detailed rejection grounds.

In Korea, a violation of divisional application requirements or a violation of conversion application requirements is included in the grounds for rejection. A conversion application is a system where an application can be filed by changing the right between a patent application and a utility model application with the same contents. For an application filed after July 1, 2011, background arts must be described in the application and a violation of such description requirement for the background arts can be one of the grounds for rejection. However, a violation of the description requirements for the background arts cannot be the grounds for a

provision of information or an invalidation action.

In China, the applications that passed initial examination go through substantive examination. During the initial examination, clear and material defects are examined. Contrary to Korea and Japan, in China, the grounds for rejection do not include a case in which a person who does not have a patent right to an invention files the application or a case in which rules regarding filing a joint application is not complied. Rather, the grounds for rejection include a case in which an invention is completed by acquiring and using a genetic resource in violation of the rules under the legal or administrative regulations (Article 5(2) of the patent law) and a case in which the confidential status examination (Article 20(1) of the patent law) is violated.

Japan is different in that a violation of divisional application requirements is not included in the grounds for rejection, and if a patent application is an application written in foreign language and the matter described in the specification, claims, or drawings originally attached to the corresponding patent application is not within the scope of the matter described in the application written in foreign language, such case is included in the grounds for rejection.

## **6. Reconsideration by examiner before appeal**

### **6.1. Target of reconsideration by examiner before appeal**

Three countries are identical in that they have a system of reconsideration by an examiner before an appeal. However, in Korea, as for the applications filed before June 30, 2009, only the reconsideration before appeal was allowed, and as for the applications filed after July 1, 2009, the re-examination system can be proceeded in a case where the specification or drawings are amended without filing a request for appeal, such that the application can be re-examined by the Examiner who issued the original decision to reject the application. Under the system of reconsideration by an examiner before an appeal, the request for appeal should be necessarily filed against the decision to reject the application and in case where the specification of drawings are amended, the application should be re-examined by the original examiner (the examiner at the time of the decision to reject the application), which causes inconvenience, such as the increase in the number of appeals and complexity of the appeal target. Accordingly, it is converted to a re-examination system.

In Korea, an amendment to the specification or drawings may be filed within thirty days from the filing date of a request for appeal. However, in China and Japan, the amendment should be filed at the time of filing a request for appeal. Therefore, there countries are different with respect to when the amendments to the specification or drawings should be filed.

In Korea and Japan, if an amendment to the specification or drawings is filed together with a request for appeal, the application is forwarded to the examiner for reconsideration before the appeal. If no amendment is made when filing the request for appeal, the application is directly transferred to the IPTAB (Trial and Appeal

Board). However, in China, the examiner should reconsider the application before the beginning of the appeal, regardless of whether the amendment is filed.

## **6.2. The scope of amendment to the specification or drawings at the time of reconsideration by examiner before appeal**

Three countries are identical in that the specification or drawings can be amended at the time of reconsideration by the examiner before the appeal, but three countries are different in terms of the scope of the amendment.

In Korea, the amendment after filing an appeal can be allowed as long as the amendment does not add new matter, merely deletes and further restricts the claims, corrects an error, or clarifies the descriptions. If new matter is added, the amendment to claims will be allowed only when the claims are restored to those before the amendment. Accordingly, broadening the scope of the claims is impossible. If the claims are further restricted by adding features in series which are not described in the claims but described only in the specification or adding the features enumerated in other claims in series, as long as the previous ground for rejection (lack of inventiveness and the like) is overcome and no new ground for rejection is generated, the amendment is recognized.

In China, the amendment at the time of filing a request for appeal should not go beyond the scope of the original specification and claims. The amendment is allowed only for resolving the defects indicated in the rejection. Therefore, in principle, the amendment is not allowed (i) when the scope of protection for the claims is broadened after the amendment, (ii) when the unity of the invention is not satisfied after the amendment, (iii) when the subject matter of the claims is modified or the number of claims is increased, or (iv) when the portion of the claims or the specification which is not relevant to the defect indicated in the final rejection is amended.

In Japan, as long as the amendment after filing a request for appeal does not introduce new matter, merely satisfies the unity of the invention requirement with the amendment, deletes the claims, restricts the specified features of the invention, corrects an error/mistranslation, and resolves the unclear description (limited to the features corresponding to the rejection grounds of the final rejection), such amendments are allowed.

## **6.3. Procedure of reconsideration by examiner before appeal**

Three countries are identical in that if the amendment on or after the filing of the request for appeal does not satisfy a predetermined amendment requirement, the amendment is not recognized, and the examination proceeds with the specification or drawings before the amendment.

In Korea, if a request for appeal that is subject to reconsideration by the examiner before an appeal is filed, the President of the IPTAB notifies the filing for a request

for appeal to the Commissioner of KIPO, and the Commissioner of KIPO instructs the examiner who issued the original decision to reject the patent application to re-examine the patent application. As a result of the re-examination, if the petitioner's amendment is recognized as an inappropriate amendment, the amendment is dismissed and a notice of "dismissal of amendment" is issued to the petitioner, and the examination proceeds based on the specification or drawings filed at the time of the decision to reject the application. The appeal against the dismissal of amendment cannot independently be filed and it should be filed with the request for appeal against the decision to reject the application. If the grounds of the decision to reject the application is resolved by the amendment, but another ground is found as a result of the re-examination, the examiner issues a notice of grounds for rejection and gives an opportunity to file a response within a prescribed period. Within this period, the petitioner may file an amendment to the specification or drawings again. To be specific, if the examiner finds the ground for rejection which existed before the issuance of the first notice of grounds for rejection prior to the reconsideration by the examiner before the appeal, a first notice of grounds for rejection is issued while if a new ground for rejection is found based on the amendment after the issuance of the first notice of grounds for rejection, a last notice of grounds for rejection is issued.

In China, the PRB initiates the reconsideration examination by transferring the written request for reexamination which was accepted in the formality examination (including the attached evidences and the filing documents after the amendment) together with the file wrapper to the original examination division which rendered the decision to reject the application. If the petitioner files an amendment together with the request for reexamination and the original examination division determines that the amendment satisfies the regulations, the original examination division will proceed with the reconsideration examination based on the amendment. If it is determined that the amendment is inappropriate, the decision to reject the application is maintained. In this case, the original examination division should explain the reasons for deciding that the amendment is inappropriate and the defects regarding each ground for rejection that is not resolved in the application.

In Japan, even when the amendment is illegitimate, a dismissal of amendment is not issued in reconsideration by the examiner before the appeal, except for granting a patent. The other procedures are identical to Korea.

#### **6.4. Termination of reconsideration by examiner before appeal**

Three countries are identical in that they write a result of the reconsideration when maintaining the decision to reject the application. However, three countries are different when vacating the decision to reject the application. In other words, in Korea and Japan, the original examiner grants the patent application when the decision to rejection ground is vacated, while in China, after the re-examination decision of the PRB, the original examination division proceeds with the examination procedure again.

In Korea and Japan, when the grounds for rejection in the patent application are resolved as a result of reconsideration, the examiner should vacate the decision to reject the application and grant the patent application as a patent. In this case, the request for appeal against the decision to reject the application is deemed to have been



lapsed. If the patent application cannot be granted as a result of reconsideration, the examiner does not reject the patent application, but terminate the reconsideration by reporting the examination result to the Commissioner of KIPO (in Japan, minister of JPO). Then, the President of the IPTAB designates an administrative patent judge who will examine the subject appeal and handle the subject case according to the appeal procedures.

In China, a written opinion of the reconsideration examination is issued when the reconsideration examination is terminated. The written opinion of the reconsideration may decide whether to withdraw or maintain the decision to reject the application. If the written opinion agrees to withdraw the decision to reject the application, the PRB no longer proceeds with the examination, renders the reexamination decision according to the written opinion, and notifies the reexamination decision to the petitioner. Then, the original examination division should proceed with the examination procedure again. The original examination division cannot directly proceed with the examination procedure without going through the reexamination of the PRB.

## **7. Appeal proceeding on the merits**

### **7.1. General of appeal proceeding**

Three countries are identical in that an appeal against a decision to reject the application is based on documentary proceedings. In order to highlight the issue, Korea holds technical presentations or interviews, Japan holds interviews, and China holds oral hearings.

In Korea, an appeal is based on documentary proceedings in principle and proceeds in the order of filing the request for appeal. The appeal can be prioritized or expedited and proceed prior to other appeal cases. As for an appeal against a decision to reject the application, a technical presentation may be held upon ex officio or request. Compared to the oral hearing where a collegial body of three administrative patent judges participates, in general, only a chief administrative patent judge may participate in the technical presentation. The technical presentation is held in a meeting room, not in an appeal court under a relatively free atmosphere. However, when a technical presentation is held, a result report indicating a summary of the technical presentation is produced, rather than a protocol of oral hearing.

In China, with respect to the reexamination, the examination can be based on documentary proceedings, oral hearings or a combination of the documentary proceedings and the oral hearings. A reexamination notice should be issued or the oral hearing should be held (1) when the reexamination decision maintains the decision to reject the application, (2) when the decision to reject the application can be withdrawn only by amending the application according to the patent law, the implementing regulations, and regulations of examination guidelines, (3) when the petitioner should submit further evidence or explain the related issues in detail, or (4) when a reason or evidence which was not discussed in the decision to reject the application should be introduced. The request for appeal is deemed to be withdrawn if no response to the reexamination notice is filed or the petitioner fails to attend the oral hearing. Contrary to Korea and Japan, China issues a reexamination notice or an oral hearing notice and allows the amendment to be filed during the designated period even when the reexamination decision maintains the decision to reject the application.

In Japan, an appeal is based on the documentary proceedings in principle and proceeds in the order of filing the request for appeal. In Japan, a request for accelerated examination including an explanation for circumstances can be filed. If predetermined requirements for accelerated examination are satisfied, the appeal on such case may proceed before other appeal cases. In no case, was an oral hearing carried out in an appeal against a decision of rejection.

## 7.2. Specification and drawings which are subject to the appeal proceeding

Due to the difference in systems, the specification or drawings which are subject to the appeal proceeding in the appeal are different in three countries.

In Korea, as for the applications filed before June 30, 2009, the system of reconsideration by the examiner before the appeal is applied; but as for the applications filed on or after July 1, 2009, the re-examination system is introduced. As such, the subject matter of the appeal proceeding may differ depending on the filing date (*see* Table below).

In China, even if an amendment is made to the specification, as long as the request for reexamination is accepted in the formality examination (including the attached evidences and the amended application), the request together with the file wrapper is transferred to the original examination division which decided to reject the application and the reconsideration examination is initiated. The reexamination is made based on the amendment the petitioner had finally filed.

Japan has a reconsideration system similar to Korea. However, as for the amendment filed at the time of filing an appeal, even when the amendment at the time of filing an appeal is illegitimate, the dismissal of amendment is not issued, except for granting a patent. Accordingly, there is no dispute for the dismissal of the amendment after filing a request for appeal and if the amendment at the time of filing a request for appeal should be dismissed as a result of an appeal proceeding, a further appeal proceeding is carried out based on the specification and drawings at the time of the decision to reject the application.

<Specification and drawings which are subject to the appeal proceedings in Korea>

Classification		Applications before June 30, 2009	Applications on or after July 1, 2009
The case where no amendment is filed when filing a	The case where the dismissal of amendment is made before filing a	If there is a dispute regarding the dismissal of amendment of before filing a request for appeal, the legality of the dismissal of amendment is examined based on the dismissed specification	If there is no re-examination, the procedure is identical to the column on the left and if there is a re-examination, the appeal proceeding is carried out based on the specification or drawings dismissed in the re-

request for appeal	request for appeal	and drawings. If the dismissal of amendment is appropriate, the appropriateness of the decision to reject the application is determined based on the specification and drawings before the amendment.	examination.
	The case where there is no dismissal of amendment is made before filing a request for appeal	Specification or drawings at the time of the decision to reject the application	If there is no re-examination, the procedure is identical to the column on the left, and if there is a re-examination, the appeal proceeding is carried out based on the specification or drawings approved in the re-examination.
The case where an amendment is filed when filing a request for appeal	The case where the amendment is dismissed at the time of reconsideration	If there is a dispute regarding the dismissal of amendment after filing a request for appeal, the legality of the dismissal of amendment is examined based on the dismissed specification and drawings. If the dismissal of amendment is appropriate, the appropriateness of the decision to reject the application is determined based on the specification and drawings before the final amendment.	Do not apply (amendment cannot be made when filing a request for appeal)
	The case where the amendment is accepted at the time of reconsideration	Specification or drawings amended after filing a request for appeal	

### 7.3. Effect of examination procedure

In Korean and Japan, the Patent Act stipulates that the proceedings which were gone through for a patent application during examination also have an effect on the appeal against a decision of rejection.

China has no particular regulation.

## **7.4. Notification of grounds for rejection and amendment in an appeal procedure**

### **7.4.1. Notification of grounds for rejection**

In three countries, the grounds of the decision to reject the application are examined in principle and when the administrative patent judge discovers grounds for rejection different from the grounds of the decision to reject the application, the administrative patent judge may issue the notice of grounds for rejection.

In Korea and Japan, when the administrative patent judge finds grounds for rejection different from the grounds of the examiner's decision to reject the application, the administrative patent judge may issue a notice of grounds for rejection and should give the applicant an opportunity to file a response within a prescribed period. Among the grounds for rejection issued by the administrative patent judge, the grounds for rejection which originally existed at the time of filing the application corresponds to first grounds for rejection and the new grounds for rejection caused by the amendment filed in response to the first notice of grounds for rejection corresponds to the last grounds for rejection.

In China, the panel may examine the reasons and grounds for the decision to reject the application. In addition, when a clear and material defect is found upon examination, the panel may also examine the related reasons and grounds for the defect. If the defect is recognized to be a new ground for rejection, the decision to reject the application should be maintained based on the new ground of rejection.

### **7.4.2. Scope of an amendment to a specification or drawings**

Three countries are identical in that the specification or drawings may be amended at the stage of an appeal, but different in terms of the scope of amendment.

In Korea, as for the amendment filed in response to the first notice of grounds for rejection, an addition of new matter is only prohibited. However, as for the amendment filed in response to the last notice of grounds for rejection, only followings are allowed: (i) deleting and restricting the claims, (ii) correcting an error, (iii) clarifying unclear descriptions, (iv) amending the claims to be restored before the amendment in case the new matter was added.

In Japan, the amendment after the first notice of grounds for rejection should not introduce new matter, and the amendment allows for satisfying the unity of the invention requirements between the claims before and after the amendment. However, as for the amendment after the last notice of grounds for rejection, not only said stipulation but also amendments for deleting the claims, restricting limitations on the specified invention, correcting an error, and clarifying unclear descriptions indicated in the Notice of Preliminary Rejection are allowed.

In China, an amendment cannot be accepted if (i) the amendment broadens the scope of protection scope, (ii) the amendment does not satisfy the unity of the invention requirements after the amendment, (iii) the amendment modifies the subject matter of the claims or increases the number of the claims, and (iv) the amendment amends the claims or the specification which are not related with the defects indicated in the rejection.

#### **7.4.3. Handling of an inappropriate amendment to specification or drawings**

Three countries are identical in that an inappropriate amendment to specification or drawings is not recognized. However, they are different in terms of the procedure of non-recognition.

In Korea, if the amendment at the time of filing a request for appeal (limited to the applications before June 30, 2009, the applications after July 1, 2009 cannot be amended at the time of filing a request for appeal) or the amendment with respect to the last notice of grounds for rejection after filing a request for appeal does not comply with the amendment requirements, the amendment is dismissed by a decision.

In Japan, if the amendment at the time of filing a request for appeal or the amendment with respect to the last notice of grounds for rejection after filing a request for appeal is recognized as violating the amendment requirements, the amendment is dismissed by a decision.

In China, if the application which the applicant filed is not acceptable to Article 61, Paragraph 1 of the implementing regulations, the panel does not generally accept it. Also, the panel should explain the reason why they cannot accept the amendment in the notice of reexamination, and proceed the examination based on the application before the amendment.

#### **7.5. Whether a divisional application can be filed during the proceedings of appeal**

Three countries are identical in that a divisional application can be filed during the appeal proceedings, but the timing for filing a divisional application is different.

In Korea, a divisional application can be filed at any time when the amendment to the specification can be made and when a request for appeal can be filed after receiving a certified copy of a decision to reject the application. Thus, during the appeal against the decision to reject the application, if a notice of grounds for rejection is issued by the administrative patent judge, a divisional application can be filed in theory.

In Japan, a divisional application can be filed within a period in which the amendment to the specification can be made, i.e., within 3 months after receiving a certified copy of the decision to reject the application (decision of refusal), or within thirty days after receiving a notice of allowance.

In China, a divisional application can be filed at any time before two months from the date of receiving a notice of patent right registration. Thus, a divisional application can be filed within three month from the date when the applicant receives the decision to reject the application, after filing a request for reexamination, and during the period of filing administrative litigation for appealing the reexamination decision.

## **8. Termination of appeal**

### **8.1. Summary**

Three countries are identical in that the administrative patent judge may terminate an appeal by a decision or determination. Meanwhile, in Korea and Japan, the examiner may directly issue a grant decision when the grounds for rejection are resolved in the reconsideration stage, while in China, after the re-examination by the PRB is carried out, the original examination division re-examines the application.

In Korea, when the request for appeal against the decision to reject the application is without merit, the administrative patent judge dismisses the appeal. When the request for appeal against the decision to reject the application has merits, the administrative patent judge may cancel the decision to reject the application by issuing an appeal decision and remand the application to the examination bureau of KIPO, or the administrative patent judge may cancel the decision to reject the application by issuing an appeal decision and render a judgment of granting a patent.

In China, even if the decision to reject the application is maintained, the reexamination notice is issued before the decision. In response to the reexamination notice, the petitioner may file an amendment to the specification. If the written opinion of the reconsideration examination withdraws the rejection, the PRB terminates the reexamination, renders the reexamination decision according to the written opinion, notify the reexamination decision to the petitioner, and the original examination division proceeds with the examination procedure.

### **8.2. Appeal decision**

Three countries are identical in that the appeal is terminated by the appeal decision. However, there is a difference in that Korea and Japan issues a preliminary notice of closure of proceeding before issuing the appeal decision, while China does not issue such a notice. Further, Korea and Japan serves the petitioner with a certified copy of the appeal decision, while China publishes a certified copy of the appeal decision except for the non-published patent.

In Korea, if the appeal is terminated by the appeal decision, a notice of closure of proceeding is issued and the appeal decision is issued within twenty days from the date of issuance of the notice of closure of proceeding. The appeal decision includes an appeal board, an appeal number, a case number, information of the petitioner and its representative, an appeal decision date, an order, a purport of the claim, and reasons for the appeal decision. At the end of the appeal decision, the presiding administrative patent judge and administrative patent judges who decided the appeal signs and seals the appeal decision. The document of appeal decision is delivered as a special delivery to the petitioner via a courier (electronic delivery is possible upon the petitioner's request).

In China, the full text of the original decision is published except for the unpublished patents. After the petitioner appeals the decision of the published decision to the court and once the court's decision is made final and conclusive, the decision and the Court's decision are published at the same time.

In Japan, except for the dismissal decision, a withdrawal of the appeal, the termination of the appeal by the abandonment, a withdrawal, and a change of the petitioner, the appeal decision is generally made within twenty days from the date of issuance of the notice of closure of proceeding (JPA §156(1)) and the appeal case is terminated. The appeal decision includes an appeal number, the name or title and address or residence of the petitioner (demandant) and the representative, the case number, the conclusion and reasons of the appeal decision.

### **8.3. Order of appeal decision**

Three countries are identical in that they can dismiss or cancel and remand the case. However, there is a difference in that when dismissing the appeal, China describes the order of the appeal decision: "The decision to reject the application is maintained," while Japan describes the order of the appeal decision: "the present appeal is not established".

In Korea, the order is described in case of cancelling and remanding: "The original decision is cancelled and this case is remanded to the examination bureau of KIPO," in case of a dismissal: "The present appeal is dismissed," and in case of granting a patent: "The original decision is cancelled and the present application is granted as a patent." In case where the examiner's dismissal decision of amendment is illegal, the order indicates that the dismissal decision of amendment is cancelled.

In China, when the case is remanded, the order is described: "SIPO revokes the final rejection against the present application on [year, month, date]. The original examination division shall continue to proceed with the examination with respect to patent filing based on xxxx the applicant filed on January 9, 2007." In contrast, in case of maintain the decision, the order is described: "SIPO maintains the decision to reject the application on [year, month, date]."

In Japan, the order is described, in case of cancelling and remanding: "The original decision is cancelled and the present application shall be remanded to the

examination," in case of a dismissal: "The present appeal is not established," and in case of granting the registration: "the present invention should be allowed."

#### **8.4. Rendering judgment**

In Korea, in case where the application is not considered to be rejected by the grounds of decision to reject the application, if cancelling the original decision and remanding the case to the examination bureau of KIPO is considered as undesirable in view of administration economy because it makes the examination bureau handle the judgement and the procedure which the IPTAB can also handle, the case is not remanded and a judgment is rendered by administrative patent judge. Practically, rendering a judgment is rarely conducted in Korea.

In Japan, the administrative patent judge can directly decide to grant a patent, and such a practice is more common than in Korean.

China has no regulations regarding reversing and rendering a judgement.

#### **8.5. Effect of appeal decision**

In Korean and Japan, when cancelling and remanding the case, reasons constituting the basis for the cancellation in the appeal decision are binding on the examiner in that specific case. The original examiner grants the patent application when the grounds for rejection are not found as a result of examining the patent application remanded to the examination bureau.

In China, the PRB withdraws the original decision to reject the application in case where it was not rendered in compliance with the patent law, the implementing regulations after proceeding the reexamination, or the amended application resolves the defect indicated in the original decision to reject the application. Then, the original examination division will proceed with the examination.

#### **8.6. Appeal against appeal decision**

Three countries are identical in that the appeal decision on the decision to reject the application is appealable.

In Korea, with respect to the appeal decision or dismissal decision, an appeal can be filed in the Patent Court within thirty days after receiving the certified copy of



the appeal decision or dismissal decision, and with respect to the decision of the Patent Court, an appeal can be filed in the Supreme Court within fourteen days after receiving the written decision from the Patent Court. In 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 20 days for the resident and an additional period of thirty days for the non-resident.

In Japan, with respect to the appeal decision or dismissal decision, an appeal can be filed in Tokyo High Court within thirty days after receiving the certified copy of the appeal decision or dismissal decision.

In China, an appeal against the reexamination decision can be filed in Beijing No. 1 Intermediate People's Court within three months after receiving the certified copy of the decision. In case of appealing the decision of Beijing No. 1 Intermediate People's Court, the appeal can be filed in Beijing High People's Court within fifteen days of receiving the decision. The decision of Beijing High People's Court is the final decision.

## **8.7. Withdrawal of appeal**

Three countries are identical in that the appeal procedure is terminated when the petitioner withdraws the request for appeal.

In Korea, when the petitioner submits a withdrawal during the appeal proceeding and the withdrawal is legally accepted, a "notice of withdrawal of a request for an appeal" is issued to the petitioner and the appeal is terminated.

## **9. Accelerated appeal**

### **9.1. Target case**

Three countries are identical in that they have a system of an accelerated appeal but the cases that fall within predetermined requirements of the accelerated appeal or the operation manners are different. In other words, in Korea, if predetermined requirements are satisfied in an appeal against a decision to reject the application, an invalidation appeal, a correction appeal, an appeal to confirm the scope of a patent, etc., an accelerated appeal is conducted upon ex officio or request of concerned parties. In Japan, the accelerated appeal is available only in an appeal against a decision to reject the application. In China, there is no accelerated appeal in an appeal against a decision to reject the application, and an accelerated appeal is only available in an invalidation case.

In Korea, an appeal against a decision to reject the application regarding the application of an accelerated examination in the examination stage is treated by the

accelerated appeal. However, the accelerated appeal is not available to an appeal against a decision to reject the application regarding (i) utility model patents in which a request for examination is filed at the time of filing the application and the request for acceleration examination was filed within two months after the filing of the application, (ii) an application where the applicant of a patent application is practicing or preparing to practice the invention, and (iii) an application where the prior art search is requested in a specialized institution. Also, among the patent applications directly related with the green technology, the appeal case against a decision to reject the application regarding the decision of the super-accelerated examination is dealt with a super-accelerated appeal, which is faster than the accelerated appeal.

In Japan, for the appeal case against decision to reject the application, two tracks are available including an accelerated appeal proceeding and a general appeal proceeding. The accelerated appeal is available to an invention where (i) the invention of the patent application is being practiced, (ii) where the application is a foreign-country-related application, (iii) where all or a part of the petitioner (demandant) is a university, public research institute, technology transfer institution, small and medium-sized businesses, or individual, and (iv) where the third party is practicing the invention.

## **9.2. Procedure of appeal proceedings**

In Korea, no special request is required for the accelerated appeal for the appeal against a decision to reject the application and in case where a predetermined requirement is satisfied, the case is automatically designated as a case for the accelerated appeal. No fee is required for filing an accelerated appeal. The case meeting the requirements for the accelerated appeal is examined within four months from the first designation date of the administrative patent judge or within two and half months from the date of filing a written opinion. Where the case is designated as a super-acceleration appeal, the case is examined within three months from the first designation date of the administrative patent judge or within two months from the date of filing a written opinion.

In Japan, for the accelerated appeal, the petitioner (demandant) should submit a written explanation of circumstances regarding the accelerated appeal. Where an administrative patent judge considers as inappropriate, the petitioner is informed accordingly. No particular fee regarding the accelerated appeal is required.

**Appendix** Assignment of Appeal Cases of JPO's Trial and Appeal Department

as of April 1st, 2014

Section	Name of Section	Outline of the Section	IPC
1	Measurement	General measurement, Distance and Electrical measurement, display device	G01B-G, G01K-L, G01P, G01R-S, G04B-G, G04R, G06M, G08C, G09G, G12B
2	Material Analysis	Machinery-Chemical analysis, Physical/diagnostic analysis	A61B, C40B20/00-30/00, C40B30/04-30/10, C40B60/04, C40B60/10-60/12, G01H-J, G01M-N, G01Q, G01T, G01V-W, H05G
3	Amusement	Amusement, Electric game	A63F
4	Natural Resources and Living Environment	Bio Resources, City and Regional Engineering, Construction, House equipment	A01B-G, A01K-M, A23K, A45F, A47B, A47H, A47K, B02B, B27D, B27H-N, B68B-C, C10B, C10J, E01B-E21F, F16S, H02S
5	Applied Optics	photographic material, Optical Apparatus, Optical element, EL device	B41M, B44C, G02B-G03C, G03F-H, H05B
6	Business Machinery	Digital photography, Press and Printer, liquid crystal element	A01N, A47C-F, A63B-K, B41B-B43M, B60N, B65H, B68G, G02F, G03G, G09B, G09D-F
7	Nano-physics	Nano-physics	B82B-Y, G01T, G03B, G03D-F, G09F, G21B-K, H01J-L, H02S, H05H
8	Optical Devices	Photonic device, light control	G02B, G02F, H01L, H01S
9	Automatic Control	traffic control, Motor control, fluid control	B06B, B60L-M, B61L, B67D, F03B-D, F04B-F15D, F16K, F16T, G01C, G05F, G08G, H01M, H02H-P, H05K
10	Motive Machinery and Logistics	Engine control, Motor-fluid machinery, Transfer disposition	A62B-C, B02C, B05B-C, B07C, B60K, B60W, B65G, B66B-F, F01B-F02P, F03G, F23B-R
11	Transportation and Lighting	transportation equipment, vehicle control, lighting	B29C-D, B60B-G, B60J-K, B60P-S, B60V, B61B-G, B61J-K, B62B-K, B62M-B64G, F03H, F16L-M, F17D-F21V, F41A-F42D, H05B
12	General Machinery and Assembling	mechanism of transmission, terminal device, Braking-machine element, Assembling/Manufacturing	B60K, B60R, B60T, B61H, B62L, F16B-J, F16N-P, G05G, G08B, H01H, H01R, H01T-H02G, H05F, H05K
13	Production machinery	machine tool, non-conventional machining, Robotics	B21C-L, B23B-B27C, B27F-G, B28D, B30B, B44B-F, B65G, B81B-C, G05B-D, H01L
14	Textile Processing and Packaging Machinery	Fiber sheet working, packaging container	A41B-F, A41H-A42C, A44B, A61F, A61L, B01D-F, B01L, B03B-B04C, B05D, B07B, B29D, B31B-B32B, B65B-D, B67B-C, B68F, C14B-C, D01B-D06C, D06G-N, D06Q-D21J, F17B-C

15	Nursing and Medical Treatment Apparatus and Living Related Machinery	Health/ Nursing, therapeutic apparatus, Home appliance, Service device	A41G, A43B-D, A44C-A45D, A46B-D, A47G, A61B-J, A61M-N, B65D, G07B-G
16	Heating, Refrigerating and Air-conditioning Engineering	Heating equipment, Cooling equipment, food	A01J, A21B-A23J, A23L-A24F, A45D, A47J, A47L, B08B, B60H, B65F, C12C-C12L, C13B-C13K, D06F, F22B-G, F24B-F25D, F26B, F28B-G, H05B-C
17	Inorganic and Environmental Chemistry	inorganic compound, ceramics, vapor deposition, single crystal growth, environmental clean-up, Separative treatment	A61L, B01B-D, B01J, B09B, B28B-C, B29B, C01B-C04B, C08J, C23C, C30B, C40B40/18, F25J
18	Materials Processing, Metals and Electrochemistry	Metal material working, Metallic material, Electrochemistry, Battery	B21B-C, B22C-F, B23K, C21B-C25F, F27B-D, H01B, H01G, H01M
19	Polymers and Plastics Engineering	High molecular compound, High molecular composition High molecular processing Resin finishing	B29B-D, C08C-L, C09H-J, C40B40/14
20	semiconductor equipment	Applied organic material Paint/Adhesive	A62D, B01F-J, C05B-C06F, C09C-G, C09K-C11D
21	Organic Chemistry	Organic compound, Heterocyclic compound Pesticide/Dye Protein engineering	A01N-P, C07B-C08B, C09B, C40B40/00, C40B40/04, C40B40/12, C40B40/16, C40B50/00, C40B50/04, C40B50/08- 60/02, C40B60/06- 60/08, C40B60/14, D06P
22	Pharmaceuticals	Medicine	A61K, A61P
23	Biopharmaceuticals	Biomedicine	A61K
24	Pharmaceuticals Preparations	Pharmaceutical tablet Cosmetics	A61K-L, A61Q
25	Biotechnology	Genetic engineering Microorganism	A01H, A01K, C12M-C12Q, C40B10/00, C40B40/02, C40B40/06- 40/10, C40B50/06
26	Electronic Commerce Technology	Business related technology, Database /Language processing Memory management	C40B30/02, C40B50/02, G06F, G06K, G06Q
27	Interface and Data Transfer	Man-Machine interface, Memory control Power transmission and distribution/ Data transfer	G06C-J
28	Data Processing	Program management, Information security	G06F, G06N, G09C, H04K-L
29	Electronic Devices	Discrete devices Applied devices Device process	G11C, H01B, H01L, H02G

30	Video System	Video signal processing Television Still picture, Image processing system	G06F, G06K, G06T, H04N
31	Transmission Systems	Transmission scheme Transmission circuit Mobile communication system	H03B-D, H03H-J, H03L, H04B-H, H04L, H04Q, H04W
32	Information Storage	Record reproduction Sound system	G10B-G11B, H01C-G, H01L, H03F-G, H04R-S
33	Digital Communications and Telephonic Systems	Data transmission Data network Phone system	H01P-Q, H03J-K, H03M, H04B, H04J, H04L-M, H04Q
34	Designs	household appliance/supply, processed food and luxury goods, garments and personal belongings, Life related products, Hobby/leisure equipment, and <y, Ñsport gear, stationeries, Sales material, Transportation-transporting machine, Electrical and electric equipment and Communication instrument/tool, General machinery and appliances, industrial machinery and appliances, Civil work/Construction supplies	A0-N0
35	Trademarks: Chemicals and Foodstuffs	Chemical and food, as well as what extended to multiple categories primarily consisting with Chemical or Food	1-5, 29-33
36	Trademarks: Machinery and Electric Appliances	Machinery and what extended to multiple categories primarily consisting with machinery	6-13, 19
37	Trademarks: Textiles and General Merchandise	Fiber and miscellaneous goods, as well as what expanded to multiple categories primarily consisting with fiber or miscellaneous goods	14-18, 20-28, 34
38	Trademarks: Industrial Services and General Services	Service and what extended to multiple categories mainly consisting with Service	35-45