

Comparative Study on the Legal Effect  
of the Decision by the Invalidation  
Department  
among JPO, CNIPA and KIPO

(in the 8th JEGTA Meeting, November 18, 2021

at Video Conference)

Published in November, 2022

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## **Introduction**

Since 2013, relying on the annual JEGTA meeting, the comparative studies among CNIPA, JPO and KIPO have been continuously conducted. The three Patent Offices have conducted comparative studies on topics such as "appeals against rejection decisions", "comparative analysis of post-grant amendments to patent documents" and "comparative data analysis". Among them, after the fourth JEGTA meeting in 2016, the three Patent Offices also cooperated to complete a report of comparative study on the topic of "Patent Invalidation Trial" and made it available to users so that they can better understand and use the invalidation trial system of each country.

In recent years, the Cov-19 Pandemic has brought shocks to the global and regional economies, but there is still a relatively strong demand from users to utilize the patent invalidation system in various countries. The legal effect of the decision by the invalidation department, which are the conclusions of patent invalidation proceedings, directly affects the enforcement of patent rights, such as patent infringement litigation, and is of substantial importance to users. At the 8th JEGTA meeting in China in 2021, the three Patent Offices conducted a comparative study on the topic of "Legal Effect of the Decision by the Invalidation Department" and collaborated on the report of the study. The purpose of the comparative study is not only to improve the

understanding and knowledge of the subject among the three Patent Offices, but also to make better use of the patent invalidation system of each country for the users.

More specifically, the main elements of the report include:

- Matters such as the making, service and disclosure of the decision by the invalidation department.
- How to coordinate the related invalidation cases.
- The legal effects of the decision by the invalidation department and how the decision enters into force.

# **Chapter 1: Characteristics and Comparison on the Legal Effect of the Decision by the Invalidation Department in China, Korea and Japan**

## **1. Decisions making, Decisions service and Decisions publication**

The three Patent Offices are basically similar in the means of service and publication of the decision by the invalidation department. In the process of making decisions, the JPO's "advance notice of the trial decision" is its distinctive feature.

### **(1) The timing for making the decision**

The three Patent Offices have in common that the decision can be made when the panel reaches the state that they can draw the conclusion after considering all necessary facts and examining all evidence necessary to be examined. In addition, the JPO's invalidation procedure is characterized by the "advance notice of the trial decision". When a chief administrative judge gives advance notice of a trial decision, the judge must specify an adequate period of time for respondent to file a request for correction of the description, claims or drawings attached to the written application. In CNIPA and KIPO's invalidation proceedings, there are no such advance notice.

### **(2) Service and publication of decisions.**

The three Patent Offices have a high degree of consistency in the service and publication of decisions. In means of service, all three Patent Offices use postal service and public notice service, and the postal service is in the form of special postal delivery which is traceable. CNIPA and KIPO also use electronic service. The public can access the decisions from the official websites of the three Patent Offices. In China, the decisions are available online on the day they are issued. In Korea, the decisions are available within one month or two months after they are made. In Japan, a trial decision can be seen on the internet generally in one or two months from the date on which the decision is made.

## **2. Legal effect of the decisions**

What the three countries have in common is that if the party concerned does not institute judicial litigation within the prescribed time limit, or if the decision is upheld by the effective judicial decision, the decision by the invalidation department has final and binding legal effect. The patent right which has been declared invalid shall be deemed to be non-existent from the date of filing. In China's practice, the decision also has a phased legal effect after it has been made.

### **(1) Time limits of filing a litigation**

In Japan, an action may be filed within 30 days from the date on which a certified copy of the trial decision is served. JPO's chief

administrative judge may, upon ex officio, provides an additional time period, which is 15 days for domestic residents and 90 days for overseas residents. The time limit is also 30 days in Korea. China's Patent Law provides that the party can file a lawsuit within 3 months from the date of receiving the decision by the invalidation department, which is significantly longer.

## (2) Legal effects of the final and binding decisions

The patent right which has been declared invalid shall be deemed to be non-existent from the date of filing.

Where a patent right is declared invalid in part, the part of the patent right so invalidated shall be deemed non-existent from the date of filing, and the part of the patent right (including the amended claims) that are maintained valid shall be deemed existent from the date of filing at the same time.

## (3) Temporary legal effect of the decision by the invalidation department in China

In China, the decision by the invalidation department has a temporary legal effect after it is made and before it becomes into final and binding. According to the relevant judicial interpretations and administrative enforcement documents, if a patent right is declared invalid, the court or the patent administrative authority may reject the

lawsuit or request temporarily. If there is evidence that the decision to invalidate the said claim has been revoked by an administrative judgment in force, the right holder may sue separately. If the decision to invalidate the said claim has been revoked by a final administrative judgment, the patent holder may file a lawsuit newly.

### **3. Effect of the previous decisions on other cases**

The three Patent Offices focus on comparing the effect of the previous decision on the subsequent invalidation cases, as well as the association of invalidation cases and patent infringement cases.

#### **(1) Principal of "prohibition of double jeopardy"**

In Japan, if the final and binding decision was registered on or before March 31, 2012, no one may request a trial based on the same facts and evidence, while if the decision was registered on or after April 1, 2012, neither the parties nor intervenors of said trial may request a trial based on the same facts and the same evidence. In China and Korean, the principal of "prohibition of double jeopardy" applies not only to the relevant parties of said trial, but also to everyone.

#### **(2) Effect of the previous decision on a later case in trial**

JPO and KIPO are more consistent on this issue. Regardless of whether the previous decision is pending in the court of first instance or



second instance, the subsequent invalidation case will be handled differently depending on the conclusion of the previous decision. In the case of invalidation of patent rights, in principle, the subsequent invalidation case is stopped before the court decision becomes final and binding. In the case of maintaining the validity of the patent right, in principle, the later invalidation cases will be started directly.

### (3) Association of invalidation cases and infringement cases

The Japan's Patent Law specifically provides for an information notification mechanism when the two proceedings are parallel. If deemed necessary, both the Office and the court may first suspend their own proceedings and wait for the other proceeding to become final. The Office and the court notify each other of the commencement and progress of the proceeding and make mutual delivery of the relevant necessary evidence and documents. There is no such provision in China's and Korea's patent laws. In CNIPA's practice, the Reexamination and Invalidation Department has established information communication mechanism with the Beijing Intellectual Property Court and the Supreme People's Court.

## Chapter 2: Comparative Table of the Legal Effect of the Decision by the Invalidation Department in China, Japan and Korea

No.	Item	China	Japan	Korea
1	The department that makes the decision	Reexamination and Invalidation Department of the Patent Office	Trial and Appeal Department (TAD), JPO	33 Boards makes decisions on invalidation trials.
2	Time for making the decision	<p>After performing the examination in written form (by means of issuing notification of transfer of document or notification of examination) , and making the decision shall satisfy the principle of hearing;</p> <p>After oral proceedings;</p> <p>The conclusion of the decision is pronounced by the chairman in oral proceedings. According to Article 9 of the "Implementation Measures of Reexamination and Invalidation</p>	<p><b>1. Conclusion of the proceedings (Conclusion of the trial)</b></p> <p>(1) In a patent trial for invalidation, if the case is considered ripe for trial decision and an advance notice of trial decision is not given (→Manual for Trial and Appeal Proceedings 51-17), or if an advance notice is given but the demandee does not request the correction or does not make any amendment, conclusion of the proceedings shall be notified to the</p>	<p><b>Patent Act Article 162 (Trial Rulings)</b></p> <p>(1) Except as otherwise expressly provided for in any Act, a patent trial shall be closed by a trial ruling.</p> <p>(3) When a case has been thoroughly reviewed and is ready to be ruled, the presiding judge shall notify the parties and intervenors of the closing of the trial review.</p> <p>(5) The trial ruling shall be rendered</p>

Department of the Patent Office to Promote Pronouncement of the conclusion of the decision in oral proceedings", the date when the conclusion of the decision is pronounced by the chairman in oral proceedings is the date of the decision.

party concerned (P. Art. 156(2)). For inter partes trials, in case where a trial decision is dismissed, conclusion of the proceedings shall be notified to both parties concerned (including a duplicate of requests which has not yet been served to the demandee).

(2) A notice of conclusion of the proceedings informs that a trial decision will be made in the near future. In case where the party concerned submits the allegations and evidence after the notice is made, they may not be the subject of the proceedings (1964 (Gyo-Ke) 17, Judgment of the Tokyo High Court, July 29, 1965). When further proceedings are required after the notice of conclusion of the proceedings is made, the proceedings shall be conducted after the party concerned is notified to resume the proceedings. After the proceedings has become concluded, no one may

within 20 days from the date notice of the closing of trial review is given under paragraph (3).

participate in the trial (→Manual for Trial and Appeal Proceedings 57-01) (P. Art. 148(1), (3), U. Art. 41, D. Art. 52, T. Art. 56(1), 68(4)).

(3) Even after conclusion of the proceedings is notified, a trial may be withdrawn until a trial decision has become final and binding (→Manual for Trial and Appeal Proceedings 43-02).

(4) A phrase "when (the case is considered) ripe for trial decision" represents the state of drawing the conclusion after considering all necessary facts for the proceedings and examining all evidence to be examined.

Therefore, any further proceedings are conducted in principle after conclusion of the proceedings is notified.

(6) It is regulated under any of the

			<p>following acts that a trial decision shall be made within 20 days on which a notice of conclusion of the proceedings is dispatched (P. Art. 156(4), U. Art. 41, D. Art. 52, T. Art. 56(1), 68(4)). However, this is an advisory provision and even if a trial decision is not made in this time limit, it does not occur a problem that the procedure is illegal (Refer to (1925(O) 165, Judgment of the Supreme Court of Japan, April, 17, 1925).</p> <p>&lt;Reference&gt; Manual for Trial and Appeal for Proceedings 42-00 "Conclusion and Resumption of the Proceedings"</p>	
3	Types of the decision by the invalidation	<p>Maintaining the validity of a patent right;</p> <p>Declaring a patent right invalid on part;</p>	There are different types of trial decisions for an invalidation trial by each IP right as described below.	<p>Rejected (patent right maintained);</p> <p>Invalid in part;</p>

department	Declaring a patent right invalid in wholes.	<p>(1) Patent, Utility Model, and Trademark</p> <p>There are 4 types of trial decisions for an invalidation trial.</p> <p>A. Uphold the all requests of the demandant (All claimed patents (or utility model registrations) requesting invalidity are invalid. For trademarks, all designated goods or services requesting invalidity are invalid.)</p> <p>B. Uphold the partial requests of the demandant (Claimed patents (or utility model registrations) requesting invalidity are partially invalid and other claims are not invalid. For trademarks, designated goods and services requesting invalidity are partially invalid and other designated goods or services are not invalid.) (P. Art. 125, 185, T. Art. 46-2(1), 69)</p> <p>C. Do not uphold the request of the demandant (All claimed patents (or</p>	<p>Invalid as a whole</p> <p>(Manual for Trial and Appeal Proceedings, p. 664)</p>
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utility model registrations) requesting invalidity are not invalid. For trademarks, all designated goods or services requesting invalidity are not invalid.)

D. Dismiss the requests for a trial  
(→Manual for Trial and Appeal Proceedings 51-08, 45-04 5.)

## (2) Design

There are 3 types of trial decisions for an invalidation trial.

A. Uphold the request of the demandant

B. Do not uphold the request of the demandant

C. Dismiss the request for a trial  
(→Manual for Trial and Appeal Proceedings 51-08, 45-04 5.)

			<Reference> Manual for Trial and Appeal Proceedings 51-19 "Trial Decision of a Trial for Invalidation, Registration in a Register of the Trial Decision, etc."	
4	Legal consequences of the decision by the invalidation department	A patent right declared invalid is deemed to have not existed from the beginning. However, there is no retrospective effect in the following situations: (1) Judgments and rulings on patent infringement that the court has made and executed before the invalidation of the patent right. (2) Decisions on the settlement of patent infringement disputes that have been executed or enforced. (3) Implement licensing contracts or patent rights assignment contracts for patents that have already been performed.	<p>Legal effects of a trial decision for an invalidation trial as shown below.</p> <p><b>(1) Effect of an invalidation trial decision</b></p> <p>A. When the invalidation trial decision has become final and binding, the right shall be deemed never to have existed (P. Art. 125, U. Art. 41, D. Art. 49, T. Art. 46-2(1), 68(4)).</p> <p>B. Based on the subsequent reasons for invalidation (P. Art. 123(1)(vii), U. Art. 37(1)(vi), D. Art. 48(1)(iv), T. Art. 46(1) (v)~(vii)), when a trial decision that the right should be invalidated has become final and binding, the right shall be deemed</p>	<p>If a trial decision invalidating a patent becomes final and conclusive, the patent right shall be deemed never to have existed (Patent Act Article 133(3)).</p> <p>When a partial invalidation of patent decision becomes final and conclusive, its invalidation is affected by simply excluding the concerned claims.</p> <p>When a trial decision invalidating a patent becomes final and conclusive, no person may request re-trial, based on the same facts and evidence</p>



			<p>never to have existed since it comes to fall under any of the followings (P. the proviso to Art. 125, U. Art. 41, D. the proviso to Art. 49, T. the proviso to Art. 46-2(1)).</p> <p>C. It may become reasons for re-trial under the Code of Civil Procedure, the Code of Criminal Procedure (Code of Civil Procedure Art. 338(1)(viii), Code of Criminal Procedure Art. 435(v)). However, when a trial decision that the right should be invalidated is final and binding after a court decision of the infringement lawsuit, etc. (when P. Act Art. 104-3(1) is applied) is final and binding under the Code of Civil Procedure, a re-trial of the final and binding court decision is restricted for the reason that said trial decision is final and binding (P. Art. 104-4(1), Supplementary Provisions of the 2011 Act on Partial Provision of the P. Art.</p>	<p>(Patent Act Article 163).</p> <p>When a trial decision to correct the specification or drawings of a patented invention becomes final and conclusive, it shall be deemed that filing and laying open the relevant patent application, a decision to grant a patent or trial decision, and the registration of the grant of the patent have been made according to the corrected specification or drawings (Patent Act Article 136(10)).</p>
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2(15)).

D. When a partial invalidation trial of the patent and utility model is final and binding, only the patents of the corresponding claims become invalid (P. Art. 123(1), 185). Regarding the design, only designs subject to invalidation become invalid even if the design includes the principal design and the related designs. The trademark becomes invalid for each designated goods and service.

**(2) Effect of a trial decision to approve the correction in a patent invalidation trial**

A. When a trial decision of an invalidation trial that correction by a request for correction is approved, it is deemed that a patent application, a publication before examination, a decision of patent or a trial decision and a registration of establishment of the patent right are made under the

corrected specification, claims or drawings (P. Art. 134-2(9)).

B. When a trial decision (only those specified by Cabinet Order) to the effect that correction should be made becomes final and binding after the conclusion of a court decision for an infringement case, etc. becomes final and binding, a re-trial of the final court decision is restricted for the reason that said correction is final and binding (P. Art. 104-4(iii), Enforcement Order of the P. Art. 8).

**(3) Prohibition of double jeopardy on a trial decision for invalidation trial**

A. When a final and binding trial decision for an invalidation trial is registered on or after April 1, 2012

When a trial decision for invalidation trial is final and binding, neither the parties concerned nor

interveners of said trial may request a trial based on the same facts and the same evidence. (P. Art. 167, U. Art. 41, D. Art. 52, T. Art. 56(1), 68(4)) (→Manual for Trial and Appeal Proceedings 30-02).

B. When a final and binding trial decision for an invalidation trial is registered on or before March 31, 2012

When a final and binding trial decision for invalidation trial is registered, no one may request a trial based on the same facts and the same evidence.

**(4) Effect of a final and binding trial decision that a registered trademark should be invalid based on subsequent reasons for invalidation**

When a trademark registration falls

under the Trademark Act Article 46(1)(v)~(vii), if a trial decision that the trademark registration should be invalid becomes final and binding, the trademark right shall be deemed never to have existed since the trademark registration comes to fall under said reasons for invalidation (T. the proviso to Art. 46-2(1)).

If it may not be specified when a trademark registration falls under the Trademark Act Article 46(1)(v)~(vii), the trademark right shall be deemed never to have existed from the registration date (the date of advance notice of registration) of the request for a trial for invalidation of the trademark registration (T. Art. 46-2(2)).

<Reference> Manual for Trial and Appeal Proceedings 51-19 "Trial Decision of a Trial for Invalidation, Registration in a Register of the Trial

			Decision, etc."	
5	Delivery of the decision by the invalidation department	Delivery by Post; Delivery by Electronic Means; Delivery by Public Notice	<p>A certified copy of a trial decision is served by special delivery (P. Art. 190, U. Art. 55(2), D. Art. 68(5), T. Art. 77(5), Code of Civil Procedure Art. 99, Postal Act Art. 49).</p> <p>Special delivery is a postal delivery by postal official having the approval authority to serve a document such as complaint from the court to parties concerned and to prove the fact of the delivery, (Postal Act Art. 49)</p> <p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 17-01 "Service of Documents"</p>	<p>Delivered by post;</p> <p>Delivered by electronic document;</p> <p>Delivered by public notice in lieu of service</p> <p><b>Patent Act Article 218 (Service of Documents)</b></p> <p>Matters necessary for the procedure for service of documents, etc. specified in this Act shall be prescribed by Presidential Decree.</p> <p><b>Patent Act Article 219 (Public Notice in Lieu of Service)</b></p> <p>(1) If it is impossible to serve a document on a person because his/her address or place of business of the person is unknown, public notice shall</p>

			<p>be given in lieu of service.</p> <p>(2) Public notice in lieu of service shall be given by publishing the statement that the relevant document is available at any time for delivery to the person on whom it is to be served, in the Patent Gazette.</p> <p>(3) Initial public notice in lieu of service shall take effect two weeks after the date of publication in the Patent Gazette: <i>Provided</i>, That subsequent public notice in lieu of service to the same party shall take effect on the day immediately after the date of publication in the Patent Gazette.</p> <p><b>Patent Act Article 220 (Service on Overseas Residents)</b></p> <p>(1) Documents to be served on an overseas resident shall be served on his/her patent administrator, if the</p>
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				<p>overseas resident has appointed a patent administrator.</p> <p>(2) Documents to be served on an overseas resident may be posted to the overseas resident by registered airmail, if the overseas resident has not appointed a patent administrator.</p> <p>(3) Documents posted by registered airmail under paragraph (2) shall be deemed served on the mailing date of the documents.</p>
6	Date of Delivery	The date of expiration of one month from the date of publication of the decision shall be taken as the date on which the decision is received; Where the decision is delivered by post, the 16th day from the date of mailing shall be the date on which the party concerned presumably receives the decision.	<p>In principle, a date of delivery shall be the date of a document to be served to a person that is to be served (Code of Civil Procedure Art. 101).</p> <p>However, if a person that is to be served a document refuses the service of the document or it is not possible to serve a document to a person that is to be served, a document shall be served by registered mail. In this case, the dispatching date shall be deemed as a</p>	<p>The certified copy of trial decision shall be delivered by a special service method as prescribed by the Postal Service Act and its Enforcement or delivered via information and communications networks for those who has reported on the use of electronic documents. The date when the written trial decision is delivered shall be the date of delivery.</p>



			<p>date of service (Code of Civil Procedure Art. 107(3)).</p> <p>If the domicile or residence of the person to be served or any other place where the person is to be served is unknown, the service may be delivered by publication. The service by publication shall be effected after 20 days from the date published in the official bulletin (P. Art. 191, U. Art. 55(2), D. Art. 68(5), T. Art. 77(5)).</p>	
7	To whom the decision by the invalidation department shall be delivered	<p>Petitioner for Invalidation; Patentee;</p> <p>For a request for invalidation that involves an infringement dispute, Reexamination and Invalidation Department of the Patent Office shall deliver the decision to the court or local intellectual property administrative authority.</p>	<p>A trial decision shall be delivered to the parties concerned, intervenors and persons whose application for intervention has been refused (P. Art. 157(3) U. Art. 41, D. Art. 52, T. Art. 56(1)).</p>	<p>A certified copy of the decision shall be delivered to the relevant parties, intervenors, and persons who filed an application for intervening in hearings but had the application rejected (Patent Act Article 162(6)).</p>

8	Judicial Remedies for both parties after receiving the decision by the invalidation department	The party who is not satisfied with the decision may institute legal proceedings in Beijing Intellectual Property Court.	<p>Those who are dissatisfied with the trial decision for an invalidation trial may file a revocation action rescinding the trial decision (P. Art. 178(2), U. Art. 47(1), D. Art. 59(1), T. Art. 63(1)).</p> <p><b>(Time limits of filing an action)</b></p> <p>An action may be filed within 30 days from the date on which a certified copy of the trial decision for was served. This period shall be invariable (P. Art. 178(3), U. Art. 47(2), D. Art. 59(2), T. Art. 63(2)).</p> <p>A chief administrative judge may ex officio provides an additional time period (15 days for domestic residents and 90 days for overseas residents) for a person in a remote area or an area with transportation difficulty, and the additional time period shall be notified with the service of the trial</p>	<p><b>Patent Act Article 186 (Legal Proceedings against Trial Rulings, etc.)</b></p> <p>(1) The Patent Court of Korea shall have exclusive jurisdiction over lawsuits filed against a decision to revoke a patent or a trial ruling and lawsuits filed against a decision to dismiss an application for revoking a patent, a petition for trial, or a petition for retrial.</p> <p>(3) Legal proceedings referred to in paragraph (1) shall be filed within 30 days from the date when a certified copy of the relevant trial ruling or decision is served.</p> <p>(8) A ruling rendered by the Patent Court of Korea under paragraph (1) may be appealed to the Supreme Court of the Republic of Korea.</p>
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			<p>decision (→Manual for Trial and Appeal Proceedings 25-04 4.).</p> <p><b>(Jurisdiction)</b></p> <p>The Tokyo High Court has exclusive jurisdiction over any action against a trial decision for invalidation trial, and the Intellectual Property High Court, a special branch of the Tokyo High Court, is to handle those cases (P. Art. 178(1), U. Art. 47(1), D. Art. 59(1), T. Art. 63(1), Act for Establishment of the Intellectual Property High Court Art. 2).</p> <p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 51-21 "Procedures After a Trial Decision on a Trial for Invalidation is Rendered"</p>	
9	The time when the	(I) Once the decision is delivered to both parties, the decision will come	<p>Legal effect is occurred</p> <p>When a trial decision becomes final</p>	The trial decision shall become final and conclusive when those who are

<p>decision by the invalidation department come into effect</p>	<p>into effect, but it is not the final verdict according to the administrative procedure.</p> <p>Legal basis:</p> <p>1. Article 46 of the Patent Law: "The patent administrative department of the State Council shall timely examine the request for invalidating a patent, make a decision and notify the petitioner and the patentee. The decision on invalidating the patent shall be registered and announced by the patent administrative department of the State Council."</p> <p>2. Article 56 of the Administrative Litigation Law of the People's Republic of China (2017 Revision): "During litigation, the execution of the alleged administrative action shall not be suspended; "</p> <p>3. "Guidelines for Handling Administrative Adjudication of Patent</p>	<p>and binding and when a trial decision becomes partially final and binding, the decisions come into legal effect in the following time.</p> <p><b>1. Final and binding trial decision for an invalidation trial</b></p> <p>A trial decision for an invalidation trial has become final and binding when a person who is dissatisfied with the decision does not file a revocation action within the legal time period (P. Art. 178(3), U. Art. 47(2), D. Art. 59(2), T. Art. 63(2)), or when a person who is dissatisfied with the decision is filed a revocation action but the action is not succeeded and may not overturn the decision by the ordinary petition of objection and thus the decision is finally maintained</p> <p><b>2. Partially final and binding trial</b></p>	<p>not satisfied with the trial ruling or decision within 30 days from the date when a certified copy of the decision is served (within the additional period when the period is extended legitimately, Patent Act Article 186(3)) do not file a petition to the Patent Court or when there is no appeal filed against a revocation action. Even when appeal is filed, the trial decision shall become final and conclusive when the trial decision is supported and cannot be canceled by the usual method of filing an appeal even when it is appealed (Trial Practice Regulations p. 1015).</p>
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Infringement Disputes" (4)  
Suspension and Resumption of the procedure: "If the State Intellectual Property Office declares the patent rights invalid, the administrative authority for patent affairs may notify the requester to withdraw the request; If the requester does not withdraw the request, the administrative authority for patent affairs shall make a decision to reject the request and deliver it to both parties."

(II) If the party concerned does not institute legal proceedings before the court within legal term, or the decision is upheld by an effective judgment of the court, the decision shall be the final verdict legally.

If the final judgment revokes the decision, the decision shall lose its legal effect.

#### **decision for an invalidation trial**

Trial decisions, etc. for a patent (registration) invalidation trial (P. Art. 123, U. Art. 37), a trademark registration invalidation trial (T. Art. 46) and an invalidation trial for classification conversion registration of registered trademark (Supplementary Provisions of the T. Art. 14) may be partially final and binding as shown below.

#### **(1) Partial final and binding trial decision (P. Art. 167-2, U. Art. 41) for a patent (registration) invalidation trial (P. Art. 123, U. Art. 37) (→Manual for Trial and Appeal Proceedings 51-19 4.)**

Regarding a patent (registration) with more than two or more claims, a trial for invalidation of patent (registration) may be requested for each claim. When a trial for invalidation of patent (registration)

with two or more claims is requested, in principle, it is understood that the proceedings of each claim are conducted simultaneously. Then, a trial decision for an invalidation trial (whether the right is invalid or maintained) is a separable administrative disposition for each determination on each claim. When a trial decision is partially maintained or a revocation action rescinding a trial decision is not filed for some of the claims in an action of rescission, a part related to the relevant claims in a trial decision is concluded separately.

In a case where a request for correction is filed for each "group of claims" (P. Art. 134-2(3)), a patent trial decision shall be final and binding for the each group of claims when all claims in a group become final and binding.

A "group of claims" shall be

examined one before correction. However, correction to eliminate the citation relationship or correction to delete a claim is approved for the specific claim consisting of a "group of claims", and when a "request that a claim be a different unit of correction" (→Manual for Trial and Appeal Proceedings 38-01) is applied to the correction of said specific claim, said specific claim is handled as a different correction unit, and a decision of said specific claim is concluded separately from other claims consisting of the same group of claims.

**(2) Partial final and binding trial decision (T. Art. 43-14, 55-3. Supplementary Provisions of T. Art. 16-2) for a trademark registration invalidation trial (T. Art. 46) and an invalidation trial**

			<p><b>for classification conversion registration of registered trademark (Supplementary Provisions of T. Art. 14)</b></p> <p>Regarding a trademark registration with two or more designated goods or services, a trial for invalidation may be requested for each designated goods or service, and such a trial decision has become partially final and binding for each designated goods or service, similar to a patent (registration) invalidation trial.</p> <p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 46-00 "Becoming Final and Binding"</p>	
10	The decision whether to be published, whether to be published in	All of the decisions by the Reexamination and Invalidation Department of the Patent Office will be announced on the website of CNIPA, and the decision will be	<p>• <b>A trial decision to be published</b></p> <p>A trial decision for an invalidation trial is to be published in the gazette (Decision on Trial and Appeal Gazette) when all the requests related</p>	All trial decisions will be open to public via KIPRIS website ( <a href="http://www.kipris.or.kr">www.kipris.or.kr</a> ), once all personal information is sealed.



<p>whole text; the way and the time of publishing the decision</p>	<p>published online on the date of the issuance of the decision. The general public can search the decisions.</p>	<p>to the case have become final and binding (P. Art. 193(2)(vii), U. Art. 53, D. Art. 66(2)(ii), T. Art. 75(2)(vi)). If it is partially finalized, the partial final trial decision gazette is issued and the partial decision information is published.</p> <p><b>• Whether the whole text is to be published</b></p> <p>The whole text is to be published.</p> <p><b>• How and when a trial decision is published</b></p> <p>As described, a trial decision for an invalidation trial is published in the gazette (Decision on Trial and Appeal Gazette). It is also possible to browse via the internet (<a href="https://www.publication.jpo.go.jp/">https://www.publication.jpo.go.jp/</a>) .</p> <p>The decision on trial and appeal</p>	<p>General public can also search decisions at KIPRIS website.</p>
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11	<p>After the decision is made, whether to update its legal status, when to update, and how to update</p>	<p>After the Reexamination and Invalidation Department of the Patent Office has made the decision of declaring the patent right invalid (in whole or in part), if the party concerned does not institute legal proceedings before the court within three months from receipt of the decision, or the decision is upheld by an effective judgment of the court, the decision shall be registered and announced by the Patent Office.</p> <p>The legal status of patents can be inquired on the official website of the CNIPA. The legal status is automatically updated by the system, and the update conditions are as follows:</p>	<p>The same as the reply of Question 9. It is described again below.</p> <p><b>1. Final and binding trial decision for an invalidation trial</b></p> <p>A trial decision for an invalidation trial has become final and binding when a person who is dissatisfied with the decision does not file a revocation action within the legal time period (P. Art. 178(3), U. Art. 47(2), D. Art. 59(2), T. Art. 63(2)), or when a person who is dissatisfied with the decision is filed a revocation action but the action is not succeeded and may not overturn the decision by the ordinary petition of objection and</p>	<p>After the trial decision is made, the trial decision that finished the screening of personal information and such trail status information shall be made public within one month or two months from the date of decision.</p> <p>When the parties are not satisfied with the trial decision and file a petition before the Court, the Court hearing the case shall notify the IPTAB of the details and judgement without delay at the time when the petition and appeal is filed and completed. In that sense, the legal status will be available upon notification. General public may check the legal status of patents at KIPRIS website (<a href="http://www.kipris.or.kr">www.kipris.or.kr</a>).</p>

Should the Reexamination and Invalidation Department of the Patent Office do not receive the complaint 7.5 months after the decision is made;

Should the Reexamination and Invalidation Department of the Patent Office do not receive an appeal petition 3 months after winning a suit in the first-instance;

Winning a suit in the second-instance.

thus the decision is finally maintained

## **2. Partially final and binding trial decision for an invalidation trial**

Trial decisions, etc. for a patent (registration) invalidation trial (P. Art. 123, U. Art. 37), a trademark registration invalidation trial (T. Art. 46) and an invalidation trial for classification conversion registration of registered trademark (Supplementary Provisions of the T. Art. 14) may be partially final and binding as shown below.

**(1) Partial final and binding trial decision (P. Art. 167-2, U. Art. 41) for a patent (registration) invalidation trial (P. Art. 123, U. Art. 37) (→Manual for Trial and Appeal Proceedings 51-19 4.)**

Regarding a patent (registration) with more than two or more claims, a

trial for invalidation of patent (registration) may be requested for each claim. When a trial for invalidation of patent (registration) with two or more claims is requested, in principle, it is understood that the proceedings of each claim are conducted simultaneously. Then, a trial decision for an invalidation trial (whether the right is invalid or maintained) is a separable administrative disposition for each determination on each claim. When a trial decision is partially maintained or a revocation action rescinding a trial decision is not filed for some of the claims in an action of rescission, a part related to the relevant claims in a trial decision is concluded separately.

In a case where a request for correction is filed for each "group of claims" (P. Art. 134-2(3)), a patent trial decision shall be final and binding for the each group of claims

when all claims in a group become final and binding.

A "group of claims" shall be examined one before correction. However, correction to eliminate the citation relationship or correction to delete a claim is approved for the specific claim consisting of a "group of claims", and when a "request that a claim be a different unit of correction" (→Manual for Trial and Appeal Proceedings 38-01) is applied to the correction of said specific claim, said specific claim is handled as a different correction unit, and a decision of said specific claim is concluded separately from other claims consisting of the same group of claims.

**(2) Partial final and binding trial decision (T. Art. 43-14, 55-3. Supplementary Provisions of T.**

**Art. 16-2) for a trademark registration invalidation trial (T. Art. 46) and an invalidation trial for classification conversion registration of registered trademark (Supplementary Provisions of T. Art. 14)**

Regarding a trademark registration with two or more designated goods or services, a trial for invalidation may be requested for each designated goods or service, and such a trial decision has become partially final and binding for each designated goods or service, similar to a patent (registration) invalidation trial.

<Reference> Manual for Trial and Appeal Proceedings 46-00 "Becoming Final and Binding"

12	<p>After the decision declaring a patent right invalid in part is made, whether, when and how to announce the valid claims</p>	<p>After the legal status is updated, announcement of validation of part of the patent right will be available on the Patent Gazette. The items to be published for the announcement of invalidation of part of the patent right shall include: the main classification symbol, patent number, date of announcement of grant of patent right, the number of decisions, date of decision of invalidation of patent, and claims maintaining validity.</p>	<p>The valid claims are published in the decision on trial and appeal gazette and the patent gazette.</p> <p>Namely, when the specification, claims or drawings are corrected in a trial for invalidation of patent, a final and binding trial decision as well as the matters described in the corrected specification and claims and the contents of the drawings are published in the patent gazette (the corrected patent specification) (P. Art. 193(2) (vii)(viii)).</p> <p>The patent gazette is published when the case becomes final and binding, and the decision on trial and appeal gazette is published when all the requests related to the case have become final and binding, the decision on the trial and appeal gazette is issued in the form of continuously binding the full text of corrected specification (or</p>	<p>When the trial decision becomes final and conclusive, the gist of final decision (invalid as a whole, invalid in part, whether to accept the correction, etc.), claims to be invalidated, claims to be deleted after correction, the date of decision to become final and conclusive shall be recorded in the Patent Register. The Patent Register is open to anyone and is available at e-filing website (<a href="http://www.patent.go.kr">www.patent.go.kr</a>) or KIPRIS website (<a href="http://www.kipris.or.kr">www.kipris.or.kr</a>).</p>
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			<p>specifications, if there are multiple corrected specifications). If it is partially finalized, the partial final trial decision gazette is issued and the partial decision information is published.</p> <p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 51-19 "Trial Decision of a Trial for Invalidation, Registration in a Register of the Trial Decision, etc."</p>	
13	The time limits of requests for invalidation of the patent right	There is no limit to the number of requests for invalidation before the patent right gets invalid in whole. In theory, the request for invalidation can be filed without limit [unless the principle of <i>Res Judicata</i> is met].	<p>The time limits of filing a request for an invalidation trial of the patent right are as follows.</p> <p>(1) A request for a trial for invalidation can be filed any time after establishing the registration of the right, even after the right has been extinguished (P. Art. 123(1)(3)).</p> <p>(2) A request for a trial for invalidation may be filed even after</p>	<p><b>Patent Act Article 133</b></p> <p>(1) If two or more claims are in the scope of claims, a petition for trial for invalidation may be filed for each claim.</p> <p>(2) A petition for trial referred to in paragraph (1) may be filed even after the relevant patent is extinguished.</p>



		<p>the right has been extinguished. For instance, when a claim of damage due to actions of infringement of a right is filed after the right is extinguished because of the expiration of its duration, the counter party can still request a trial to invalidate the said right</p> <p>(3) A request for a trial for invalidation may be dismissed when any right to seek claims of damage and to file any complaint has extinguished because the right had expired 20 or more years ago, or when no case for trial is pending, based on the reason that the request for the trial does not provide any benefit (Enforcement Regulations under the Patent Registration Order Art. 5→ Manual for Trial and Appeal Proceedings 51-19 6.(4))</p> <p>&lt;Reference&gt; Manual for Trial and</p>	<p>There is no limit to the number of requests for invalidation unless the patent right is invalid as a whole.</p>
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			Appeal Proceedings 51-06 "Restrictions on a Request for a Trial for Invalidation"	
14	After the previous decision is made, whether the subsequent request for invalidation will be directly on trial	<p>Should the previous decision is to maintain the validity of the patent right, the subsequent request for invalidation will directly be on trial in general;</p> <p>Should the previous decision is to declare the patent right invalid in part, there are different ways to deal with it depending on the situation, usually waiting for the final judicial result;</p> <p>Should the previous decision is to declare the patent right invalid in whole, Reexamination and Invalidation Department of the Patent Office will issue Notification of Nonacceptance of Request for Invalidation. The accepted request for invalidation has to wait for the previous decision to come into effect, or Reexamination and Invalidation</p>	The subsequent request for an invalidation trial is not brought before the court directly, but the trial proceedings will be conducted.	<p>When the previous decision has been made to maintain the validity of the patent right, the subsequent request for invalidation will directly be on trial in general.</p> <p>When the previous decision has been made to partially invalidate a patent right and relevant legal proceeding is filed in the Court, parties shall wait for the Court judgement.</p> <p>When the previous decision declares the invalidation of a patent right as a whole and the relevant legal proceeding is filed, the invalidation trial requested afterwards shall be suspended until the Court makes a</p>

		Department of the Patent Office issue Notification of Examination Status of Request for Invalidation to notify the petitioner.		judgement.
15	If the previous decision is overturned by the court of first instance but is pending in the second instance, how to deal with the subsequent request for invalidation	Waiting for the final judicial result of the second-instance in general.	<p>Regardless of whether the previous trial decision is pending on the court of first instance or the court of the second instance, the subsequent request for invalidation trial is differently handled depending on whether a trial decision for an invalidation trial is a trial decision to invalidate the right or to maintain the right.</p> <ul style="list-style-type: none"> <li>• In case of a trial decision to invalidate the right ⇒ In principle, the proceedings are suspended until the court decision rescinding the trial decision becomes final and binding, and the suspension will be notified.</li> <li>• In case of a trial decision to</li> </ul>	<p><b>Patent Act Article 164</b></p> <p>(1) If the presiding judge deems it necessary for trial, he/she may, <i>ex officio</i> or at the request of a party, suspend a trial proceeding until a decision on an application for revoking the patent related to the case on trial or a trial ruling rendered in another trial related to the case on trial becomes final and conclusive or until the related legal proceedings are completed.</p> <p>(2) If a court finds it necessary to suspend legal proceedings, it may, <i>ex officio</i> or at the request of a party, suspend legal proceedings until a decision on an application for revoking a patent or a trial ruling on a</p>

		<p>maintain the right ⇒ In principle, the proceedings of a newly filed invalidation trial will be started promptly.</p> <p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 51-22.2</p> <p>(1) When an action rescinding the trial decision is filed against the decision to invalidate the right</p> <p>In principle, the proceedings of the newly filed invalidation trial are suspended until the court decision rescinding the trial decision has become final and binding, and the suspension are notified under the Patent Act Article 168(1) (U. Art. 40(1), D. Art. 52, T. Art. 56(1), 68(4)).</p> <p>(2) When an action rescinding the trial decision is filed against the</p>	<p>patent becomes final and conclusive.</p> <p>The subsequent requests for invalidation shall be suspended until Supreme Court decision is made.</p>
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			<p>decision to maintain the right</p> <p>In principle, the proceedings of the newly filed invalidation trial are started promptly, and the examination on the previous trial decision to maintain the right are considered whether newly submitted reasons and evidence, etc are sufficient to overturn the previous trial decision to maintain the right.</p>	
16	The previous decision has finished the final judicial review, how to proceed the subsequent request for invalidation	Should the previous decision is to declare the patent right invalid in whole and the decision has been upheld by the effective judgment of the court, the invalidation procedures in all other cases concerning the same patent right shall terminate. Should the previous decision is to maintain the validity of the patent right, or to declare the patent right invalid in part, and the decision has been upheld by the effective judgment of the court, the invalidation procedures in all	<p>Assuming that "the final judicial review has finished" means a court decision is final and binding, the handling of the subsequent request for an invalidation trial is different depending on a conclusion of the court decision as below.</p> <ul style="list-style-type: none"> <li>● Rescission of the trial decision is concluded: the case of the previous trial decision is remanded to the JPO, and the subsequent request for an</li> </ul>	<p>When the previous trial decision has been made to invalidate a patent right as a whole and upheld by the valid judgment of the Court, all invalidation trials based on the same patent right shall be dismissed.</p> <p>When the previous trial decision has been made to maintain a patent right or partially invalidate a patent right and upheld by the valid judgement of the Court, all invalidation proceedings</p>

other cases concerning the same patent right shall be confirmed the scope of collegiate examination and directed to the claims maintained in the previous decision. Should the previous decision is overturned by an effective judgment of the court, the previous request for invalidation shall be reviewed again, or Reexamination and Invalidation Department of the Patent Office may hear the previous and the subsequent requests in combination.

invalidation trial becomes co-pending. It is considered whether the proceedings may conduct jointly in fact.

- Dismissal of the request is concluded: when the previous trial decision is to maintain the right, prohibition of double jeopardy comes into effect for the subsequent request for invalidation trial. Namely, the subsequent request for a trial filed by the parties concerned and intervenors of said trial is rejected if the subsequent request for invalidation trial is filed based on the same facts and the same evidence of the previous request for invalidation trial. When the previous trial decision is to invalidate the right, the subsequent request for a trial is rejected due to the non-existence of the right to be an object.

based on the same patent right shall continue only with respect to the remaining valid claims.

When the previous trial decision has been overturned by the valid judgement of the Court, the previous decision shall generally become final and conclusive after the revocation of decision.

17	Whether to limit the cause for invalidating the patent right in the subsequent request	After the decision has been made, any new request for invalidation of the same patent based on the same causes and evidence shall not be accepted or examined. Where the causes of request for invalidation or evidence thereof for the new request have not been considered in the decision of the previous request for invalidation due to the reason of time limit etc., the new request shall not be regarded as inadmissible under the above-mentioned circumstance.	<p>A. Registration of the final and binding trial decision for invalidation is on or after April 1, 2012</p> <p>When a trial decision for an invalidation trial has become final and binding, neither the parties concerned nor intervenors of said trial may request the trial based on the same facts and the same evidence (P. Art. 167, U. Art. 41, D. Art. 52, T. Art. 56(1), 68(4)) (→Manual for Trial and Appeal Proceedings 30-02).</p> <p>B. Registration of the final and binding trial decision for invalidation is on or before March 31, 2012</p> <p>When the final and binding trial decision for an invalidation trial has been registered, no one may file the trial based on the same facts and the same evidence.</p>	<p><b>Patent Act Article 163</b></p> <p>If a trial ruling rendered under this Act becomes final and conclusive, no person may demand re-trial, based on the same facts and evidence.</p>
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			<p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 51-19 "Trial Decision of a Trial for Invalidation, Registration in a Patent Register of the Trial Decision, etc."</p> <p>However, the provisions of the Patent Act Article 167 does not apply to a request for invalidation trial which has already been pending at the time of the registration of the final and binding trial decision to dismiss the request (if a registration is on or after April 1, 2012, at the time of the trial decision to be final and binding).</p> <p>(Reference: Manual for Trial and Appeal Proceedings 30-02 "Prohibition of Double Jeopardy")</p>	
18	For the same patent right, there are		Claims forming basis for examination are determined for each	When there are one or more invalidation requests for the same patent right at the same time, their



<p>more than one request for invalidation at the same time, and the patentee makes different amendments to the claims in response to different invalidation requests. How to determine the text forming basis for examination?</p>	<p>case.</p> <p>Therefore, when a patentee requests correction that is different from the correction accepted in the previous case, the examination proceeds with said (newly) correction, however, the following points should be remarked:</p> <ul style="list-style-type: none"> <li>- when the correction of the previous case is finalized earlier, a specification reference to correction for the subsequent invalidation trial has been changed; and</li> <li>- when the correction of the subsequent invalidation trial is approved and finalized earlier, the trial decision to maintain the right in the previous case is almost automatically cancelled.</li> </ul> <p>Therefore, it is preferable to make the content and timing of attacks</p>	<p>prior arts shall be reviewed. If their prior arts and arguments have much in common, the cases shall be consolidated for rendering a decision.</p> <p>If the prior art and arguments are different, they will be reviewed as a separate case.</p> <p>If possible, corrections will be consolidated for review.</p> <p><b>Patent Act Article 160</b></p> <p>Administrative patent judges may conduct hearings or render trial rulings jointly or separately for at least two trials in which both parties or either party is the same one.</p>	
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against a right holder as similar as possible and make the right holder's defense methods common in multiple cases, and for that reason, it should be considered the proceedings are jointly conducted (P. Art. 154(1)) or jointly conducted in fact.

When prioritizing a particular case can contribute to a prompt resolution of the dispute, decide the proceedings' priority, select the most appropriately prioritized trial(s) for invalidation case(s) to be examined, and examine the trials for invalidation earlier than the remaining trials for invalidation. In conducting the prioritized trial, the following should be considered.

A. Consider reasons, evidence, etc. asserted in the trial for invalidation case that is not preferentially examined as a subject of ex officio proceedings in the trial for

invalidation case that is preferentially examined.

B. In a trial for invalidation case that is not preferentially examined, in principle, a notice of suspension is issued according to the Patent Act Article 168(1) (U. Art. 40(1); D. Art. 52; T. Art. 56(1), 68(4)). If a party concerned submits a written request to cancel the suspension, considering that the presented reasons and evidence have already been taken into account in the priority proceedings, canceling the suspension is allowed only if it is considered useful for prompt resolution of the dispute.

C. Handling of the case in subsequent proceedings is decided according to the conclusion (whether the right is invalid or maintained) of the case that has been preferentially examined as below.

(A) If the conclusion of the

			<p>preferentially examined case is invalid, in principle, proceedings of the subsequent case are suspended until the trial decision is finalized.</p> <p>(B) If the conclusion of the preferentially examined case is to maintain the right, in principle, proceedings of the subsequent case are started promptly thereafter.</p> <p>&lt;Reference&gt; Manual for Trial and Appeal Proceedings 51-22.1 Multiple Co-Pending Trials for Invalidation</p> <p>51-22.2 Trial for Invalidation Requested During a Revocation Action Against a Trial Decision Is Pending</p>	
19	The legal effect of the patentee's self-confessio	The interpretation of technical solution, self-admission, and abandonment by the patentee will be considered in the invalidation	A trial for invalidation adopts ex-officio proceedings and it does not accept the effect of self-confession of the patentee, which differs to a civil action (Refer to the provision of Code	Patentee's self-confession shall be taken into account in the course of review of invalidation trial.

	n	procedures of the subsequent request.	of Civil Procedure Art. 179 which applies by replacing its terms to the provision of P. Art. 151). The patentee must prove a fact in issue even if it is not a point of dispute and all the facts in issue are factum probandum (except the fact obvious to the panel).	
20	Examination procedures after the decision being overturned by an effective judgment of the court	<p>Where the decision is overturned for the reasons of insufficient evidence or misapplication of laws, Reexamination and Invalidation Department of the Patent Office shall make a decision anew. The department shall not make a same decision as the previous one on the same grounds.</p> <p>Where the decision is overturned for the reasons of violation of statutory procedures, Reexamination and Invalidation Department of the Patent Office shall make a decision anew, with the procedural defects being</p>	<p>When a court decision rescinding a trial decision has become final and binding, the case of a trial for invalidation is in a state where it has not yet received an administrative disposition (a trial decision), and therefore the case of a trial for invalidation is remanded to the JPO for re-pending and the panel further proceeds the case (P. Art. 181(2), U. Art. 47(2), D. Art. 59(2), T. Art. 63(2)).</p> <p>The final and binding court decision binds the JPO about the case</p>	<p>Administrative patent judges shall review the case and render another decision</p> <p>The grounds for revoking a trial decision shall have the binding effect on the IPTAB (Patent Act Article 189(3)).</p>

		remedied.	(Administrative Case Litigation Act Art. 33), and thus the panel makes a trial decision again along to the conclusion (main text) indicated in the final court decision and matters described in the reasons for decision as factual finding and legal judgment necessary for leading the conclusion. However, it cannot prevent from making a trial decision with the same conclusion under the different reasons.	
21	Composition of the panel in the case where the decision is overturned by an effective judgment of the court	Generally, a new panel should be established.	Regarding the trial case remanded to the JPO by the court due to rescission of the trial decision, it is not prohibited by the law that the proceedings are conducted by the same panel, but considering fairness and neutrality, in principle, change the panel.  <Reference> Manual for Trial and Appeal Proceedings 83-02.2 "Form a	In general, a new panel shall be composed.

			Panel to Handle Trial/Appeal Cases That Have Been Remanded by Courts"	
22	The Influence of Invalidation Procedure on civil infringement cases concerning the same patent right	<p>Several Provisions of the Supreme People's Court on Issues concerning the Application of Law in the Trial of Cases on Patent Disputes (2020 Amendment)</p> <p><b>Article 5</b> Where, in a case involving a dispute over infringement upon a utility model or design patent, the defendant files a request for declaring invalidation of the patent during the period of submitting a statement of defense, the court shall suspend the action. However, under any of the following circumstances, the court may rule not to suspend the action:</p> <p>(1) The retrieval report or patent assessment report provided by the plaintiff does not contain any cause that leads to the invalidation of the patent for utility model</p>	<p>The influence of invalidation procedures is defined in Patent Act Article 168 as below:</p> <p><b>Patent Act Article 168</b></p> <p>(1) Where deemed necessary during a trial, the trial proceedings may be suspended until the decision on an opposition to grant of patent and the decision in another trial has become final and binding, or court proceedings have been concluded.</p> <p>(2) Where an action is instituted . . . . ., <b>the court may, if it considers it necessary, suspend the court proceedings until the trial decision becomes final and binding.</b></p> <p>(3) <b>Where an action with respect to</b></p>	<p>In general, when an invalidation trial and a civil infringement case are pending concurrently, infringement case shall consider the Patent Court decision: Provided that the foregoing shall not apply to the decision on provisional disposition concerning patent infringement.</p> <p><b>Patent Act Article 164 (Relationship to Litigation)</b></p> <p>(1) If the presiding judge deems it necessary for a trial, he/she may, ex officio or at the request of a party, suspend a trial proceeding until a decision on an application for revoking the patent related to the case on trial or a trial ruling rendered in</p>

	<p>or design.</p> <p>(2) Evidence provided by the defendant is sufficient to prove that the technology used by the defendant is in the public domain.</p> <p>(3) The defendant's evidence or reason for a request for declaring invalidation of the patent is apparently insufficient.</p> <p>(4) The court otherwise deems that the action shall not be suspended.</p> <p><b>Article 6</b> Where, in a case involving a dispute over infringement upon a utility model or design patent, the defendant files a request for declaring invalidation of the patent after the period of submitting a statement of defense ends, the court trying the case shall not suspend the action, unless it deems the suspension necessary after review.</p> <p><b>Article 7</b> Where, in a case involving a dispute over infringement upon an invention patent or over infringement upon a utility model or design patent which has</p>	<p><b>infringement of a patent right or an exclusive license is instituted, the court shall notify the Commissioner of the Patent Office thereof.</b> The same shall apply when the said court proceedings have been concluded.</p> <p>(4) Where the Commissioner of the Patent Office receives the notice as provided in the preceding paragraph, <b>the Commissioner of the Patent Office shall notify the court of whether a request for a trial with regard to the said patent right has been filed. The same shall apply when, with regard to the said trial, a decision dismissing the written request or a trial decision has been rendered or the request has been withdrawn.</b></p> <p>(5) Where the court receives the notice to the effect that a request for a trial with regard to the said patent right has been filed under the</p>	<p>another trial related to the case on trial becomes final and conclusive or until the related legal proceedings are completed.</p> <p>(2) If a court finds it necessary to suspend legal proceedings, it may, ex officio or at the request of a party, suspend legal proceedings until a decision on an application for revoking a patent or a trial ruling on a patent becomes final and conclusive.</p> <p>(3) Where legal proceedings are filed regarding an infringement of a patent or an exclusive license, the court shall notify the President of the Korean Intellectual Property Trial and Appeal Board of the claims asserted in the legal proceedings. The same shall also apply when the legal proceedings are completed.</p> <p>(4) Where a petition is filed for trial seeking invalidation of a patent in response to legal proceedings filed</p>
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		<p>been sustained by the patent administrative department of the State Council, the defendant files a request for declaring invalidation of the patent during the period of submitting a statement of defense, the court trying the case may rule not to suspend the action.</p>	<p>preceding paragraph, if a document stating a method of allegations or evidence as provided in Article 104-3(1) has already been submitted in the action prior to the said notice or if the said document is submitted for the first time after the said notice, the court shall notify the Commissioner of the Patent Office thereof.</p> <p>(6) Where the Commissioner of the Patent Office receives the notice as provided in the preceding paragraph, the Commissioner of the Patent Office may request the court to deliver copies of any record of the said action which the trial examiner considers necessary for the trial.</p>	<p>regarding an infringement of a patent or an exclusive license under paragraph (3), the President of the Korean Intellectual Property Trial and Appeal Board shall notify the competent court referred to in paragraph (3) of the claims thereof. The same shall also apply when a decision or trial ruling dismissing the petition for trial is rendered or when the petition for trial is voluntarily withdrawn.</p>
23	The impact of the decisions on request for invalidation on civil	After the decision is confirmed by the effective judgment, an infringement judgment is made based on the valid claims of patent right maintained by the decision. When the decision has not been confirmed by the effective	There is no legal influence until a trial decision has become final and binding. However, when a trial decision becomes final and binding after the final court decision of infringement litigation is conclusive	When the trial decision on the request for invalidation becomes final and conclusive based on the valid judgement, the judgement on infringement shall be made based on the same grounds.

<p>infringement cases concerning the same patent right</p>	<p>judgment, the court generally will deny the plaintiff's claims in civil infringement case after the decision to declare the patent right invalid in wholes or on part. If the decision is finally overturned by an effective judgment, the right-holder should file a petition again based on the valid claims of patent right. "Interpretation (II) of the Supreme People's Court on Several Issues concerning the Application of Law in the Trial of Patent Infringement Dispute Cases"  <b>Article 2</b> Where the claims of a patentee in a patent infringement action is declared invalid by the patent administrative department of the State Council, the court that tries the patent infringement dispute case may rule to dismiss the action which is initiated based on such invalid claims.</p> <p>Where there is evidence proving that the decision of declaring the</p>	<p>and said trial decision falls under any of the followings, the party concerned in said litigation may not allege that the trial decision becomes final and binding in the action for retrial against the final court decision (P. Art. 104-4).</p> <p>A court decision that the patent is to be rescinded or a trial decision that the patent is to be invalidated;</p> <p>A trial decision that the registration of extension of the term of the patent right is to be invalidated; and</p> <p>A court decision or a trial decision to the effect that the specification, claims or drawings attached to the patent application are to be corrected, which is prescribed by Cabinet Order.</p> <p>Regarding a trial for invalidation of patent filed during the pendency of</p>
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		invalidation of the aforesaid claims is set aside by an effective administrative judgment, the patentee may initiate a separate action.	the infringement litigation, from the view point of effective solution of the dispute and prevention of discrepancies of the judgment, such a trial is a subject to preferential examination. The litigation procedures may be suspended by the court until the trial decision becomes final and binding (P. Art. 168(2)).	
24	Application of Estoppels Principle	For the interpretation adopted by the decision, Estoppel Principle will be taken to civil infringement cases. The patentee's interpretation in civil infringement cases will also be considered in the invalidation procedure.	<p>We will answer on the assumption that the inquiry is intended to be presence or absence of double jeopardy. When a trial decision for an invalidation trial is final and binding, neither the parties concerned nor intervenors of said trial may request a new trial based on the same facts and the same evidence.</p> <p>If it means "estoppels" or "wrapper estoppels", matters asserted in the examination process by the patentee may become the wrapper estoppels</p>	<p><b>Manual for Trial and Appeal Proceedings, p. 651</b></p> <p>If the contents stated in the reply brief is not consistent with the claims of the same patentee in other cases related to the same patent right (trial for invalidation, infringement lawsuits, etc.), such claims may not be adopted (estoppel).</p> <p>Estoppel Principle shall be applied to the argument of parties in the</p>

			during infringement cases, deriving from good faith (Civil Code Art. 1(2)).	invalidation trial.  Arguments made by a patentee in the infringement lawsuit will be also considered in the invalidation trial.
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## **Chapter 3: Overview of Legal Effect of the Decision by the Invalidation Department in Each Country**

### **China**

#### **1. The department that makes the decision**

The department that makes the decision is Reexamination and Invalidation Department of the Patent Office of CNIPA.

#### **2. The timing for making the decision**

After performing the examination in written form or oral proceedings, the panel shall cast votes on issues including whether the evidence involved in the invalidation case can be taken, whether an allegation of facts can be testified, and whether a ground of action can be accepted, and make the decision according to majority rule.

Before making the decision, the party adversely affected by the decision shall be given an opportunity to make observation on the grounds, evidence, and the ascertained facts on which the decision is based, that is to say, the party adversely affected by the decision shall have been informed by means of communication, document exchange, or oral proceeding, of the grounds, evidence, and the ascertained facts on which the decision is based, and given the opportunity to make observations.

In some cases, the panel will announce the result of the decision in oral proceedings.

### **3. Types of the decision by the invalidation department**

There are three types of the decision, which are:

- (1) declaring a patent right invalid in whole;
- (2) declaring a patent right invalid in part; and
- (3) maintaining the validity of a patent right.

### **4. Legal effects of the decision by the invalidation department**

The patent right which has been declared invalid shall be deemed to be non-existent from the date of filing.

Where a patent right is declared invalid in part, the part of the patent right so invalidated shall be deemed non-existent from the date of filing, and the part of the patent right (including the amended claims) that are maintained valid shall be deemed existent from the date of filing at the same time.

### **5. Service of the decision by the invalidation department**

#### **5.1 Addressee**

Reexamination and Invalidation Department of the Patent Office shall serve the decision to the both parties, namely the petitioner and the patentee.

For a request for invalidation involving an infringement case, where the relevant court or the local intellectual property administrative authority had been notified before the initiation of examination on the

request for invalidation, the Reexamination and Invalidation Department of Patent Office shall serve the decision and *the Notification of Termination of Examination on the request for invalidation* to the court or the administrative authority for patent affairs.

## **5.2 Means of Service**

The decision can be served in three manners, including Service by Post, Service by Electronic Means, and Service by Public Notice.

Service by Post refers to sending the decision through the post office, and the relevant documents shall be sent by registered mail. Service by Electronic Means refers to sending the decision through the "Electronic Patent Application System" of CNIPA.

If the service address is unclear and the documents cannot be sent by post, it may be served to the party concerned by Public Notice.

## **5.3 Date of Service**

Where the decision is served by post or by electronic means, the 16<sup>th</sup> day from the date of mailing shall be the date on which the party concerned presumably receives the documents.

Where the decision is served by Public Notice, it shall be deemed to have been served at the expiration of one month from the date of publication of the notice.

## **6. Litigious Rights**

Where the patentee or petitioner is not satisfied with the decision

declaring the patent right invalid or maintaining the validity of a patent right, such part may institute legal proceedings in Beijing Intellectual Property Court within three months from receipt of the decision.

#### **7. The time when the decision by the invalidation department comes into effect**

(1) Once the decision is served to both parties, the decision will have a certain legal effect. For details, please refer to the "Effect of the result of the decision on the civil infringement cases" below.

(2) If the party concerned does not institute legal proceedings before the court within three months from the date of receipt of the decision, or the court makes an effective judgment to uphold the decision, the decision shall have final and binding legal effect.

#### **8. Publication means and the time of publishing the decision by the invalidation department**

The text of the decision made by Reexamination and Invalidation Department of the Patent Office shall be published in full, except when the target patent application has not been published.

In specific practice, all decisions will be published in the form of electronic documents on the website of the CNIPA. On the day when the decision is served to parties, the decision will be published online, and the public can check it.

[http://36.112.95.124/reexam\\_out2020New/wuxiao/wuxiaolb.jsp](http://36.112.95.124/reexam_out2020New/wuxiao/wuxiaolb.jsp)



## **9. Updated legal status after the decision is made**

After a decision is made to declare the patent right invalid (including declaring a patent right invalid in whole and declaring a patent right invalid in part), if the party concerned does not institute legal proceedings before the court within three months from the date of receipt of the decision, or the court makes an effective judgment to uphold the decision, the decision shall be registered and announced by CNIPA.

The legal status of patents can be checked on the official website of CNIPA.

<http://epub.cnipa.gov.cn/SW>

After the legal status is updated, matters relating to invalidation of part of the patent right shall be announced in the Patent Gazette. The items to be published for announcement of invalidation of part of the patent right shall include the main classification symbol, patent number, date of announcement of grant of patent right, the number of the decision, date of the decision, and the claims maintaining the validity.

## **10. Number of requests for invalidation of the same patent right**

Before the relevant patent right gets invalid in whole, there is no limit to the number of request for invalidation. In theory, the request for invalidation can be filed for unlimited amount of times.

## **11. Effect of the previous decisions involving the same patent right on subsequent invalidation case**

(1) If the result of the previous decision is to maintain the validity of a patent right, the subsequent request for invalidation will directly be on trial in general.

(2) If the result of the previous decision is to declare a patent right invalid in part, there are different ways to deal with the subsequent request for invalidation depending on the situation, usually waiting for the final judicial result on the previous decision;

(3) If the previous decision is to declare the patent right invalid in whole, the subsequent request for invalidation will not be accepted. If the subsequent request for invalidation has been accepted, *Notification of Termination of Examination on Request for Invalidation* will be issued to notify the termination of the invalidation procedure; the previous decision is overturned by an effective judgment, and the patent right is maintained, the petitioner may file a request for invalidation again.

## **12. Examination procedures after the decision being overturned by an effective judgement**

(1) After the decision is overturned by the effective judgment of the court, Reexamination and Invalidation Department of the Patent Office shall make a decision anew.

(2) Where the decision is overturned for reasons of insufficient evidence or misapplication of laws, the department shall not make a same decision as the previous one on the same grounds.

(3) Where the decision is overturned for reasons of violation of

statutory procedures, the department shall make a decision anew, with the procedural defects being remedied according to the judgement of the court.

(4) Where the decision is overturned by an effective judgement of the court, for examination of the case anew, generally a new panel shall be established.

(5) The patentee's interpretation of the technical solution, self-confession, abandonment, etc. in the original invalidation procedure will be considered when the panel makes the decision anew.

### **13. Effect of the verdict of judicial proceedings related to previous decision involving the same patent right on later invalidation case**

(1) If the previous decision is overturned by the first-instance court but is pending in the procedure of second instance, the subsequent invalidation case will wait for the final judicial result of the second-instance in general.

(2) After the previous decision has been reviewed by the final judgement, there are different approaches to deal with the subsequent request for invalidation:

① If the previous decision is to declare the patent right invalid in whole and the decision has been upheld by the effective final judgement, the invalidation procedures in all other cases concerning the same patent right shall terminate.

② If the previous decision is to maintain the validity of the patent right, or to declare the patent right invalid in part, and the decision has been upheld by the effective final judgement, the scope of examination on the subsequent request shall be re-determined on the basis of the previous decision.

③ If the previous decision is overturned by an effective final judgement, the previous request for invalidation shall be examined again, or Reexamination and Invalidation Department of the Patent Office may hear the previous and the subsequent requests in combination.

#### **14. Restrictions on grounds for subsequent invalidation requests**

After the decision by the invalidation department has been made, any new request for invalidation of the same patent right based on the same causes and evidence shall not be accepted or examined.

Where the causes of the request for invalidation or evidence thereof for the new request have not been considered in the previous decision due to the reason of time limit etc., the new request shall not be regarded as inadmissible under the above-mentioned circumstance.

#### **15. Handling of multiple invalidation requests for the same patent right at the same time**

In order to increase the efficiency of examination and lighten the burden of the parties concerned, Reexamination and Invalidation Department of the Patent Office may hear cases in combination. For multiple invalidation cases of a patent right, oral hearings shall be

combined as much as possible.

Where more than one case of request for invalidation is directed to the same patent, Reexamination and Invalidation Department of the Patent Office shall as far as possible take the oral proceedings in combination.

During the combined examination, if the patentee has submitted multiple amendments to the claims successively, the examination shall be conducted on the basis of the last submitted amendment which meets the requirement in regard to time limit for amendment. Whether amendment meets the requirements of time limit shall be judged based on the invalidation request to which the amendment is directed.

#### **16. Effect of the invalidation procedure on the civil infringement cases**

(1) Where, in a case involving a dispute over infringement upon a utility model or design patent, the defendant files a request for declaring invalidation of the patent during the period of submitting a statement of defense, the court shall suspend the action. However, under any of the following circumstances, the court may not suspend the action:

① The Search Report or Evaluation Report of Patent submitted by the plaintiff does not contain any cause that leads to the invalidation of the patent for utility model or design;

② Evidence provided by the defendant is sufficient to prove that the technology used by the defendant is in the common knowledge;

③ The defendant's evidence or causes for a request for declaring invalidation of the patent is apparently insufficient.

④ The court otherwise deems that the action shall not be suspended.

(2) Where, in a case involving a dispute over infringement upon a utility model or design patent, the defendant files a request for declaring invalidation of the patent after the period of submitting a statement of defense ends, the court shall not suspend the action, unless it deems the suspension necessary after review.

(3) Where, in a case involving a dispute over infringement upon an invention patent or over infringement upon a utility model or design patent which has been maintained by Reexamination and Invalidation Department of the Patent Office, the defendant files a request for declaring invalidation of the patent during the period of submitting a statement of defense, the court may not suspend the action.

#### **17. Effect of the result of the decision by the invalidation department on infringement cases**

(1) After the decision is served to the parties

Administrative adjudication on patent infringement disputes: If CNIPA declares the patent right invalid, the local intellectual property administrative authority may notify the petitioner to withdraw the request to handle a patent infringement dispute; if the petitioner does not withdraw, the administrative authority for patent affairs shall make a decision to reject the request, and served the decision to both parties.

Judicial litigation on patent infringement disputes: Where the claims involved in the patent infringement litigation are declared invalid by Reexamination and Invalidation Department of the Patent Office, the court may dismiss lawsuit based on such invalid claims. Patentee may file a separate action lawsuit if there is evidence proving that the decision to declare invalidation of the aforesaid claims is overturned by an effective administrative judgment. Where the patentee files a separate action lawsuit, the prescriptive period for filing a action lawsuit shall be calculated from the date when the written administrative judgment is served.

(3) The decision's final and binding legal effect

Any patent right which has been declared invalid shall be deemed to be non-existed from the beginning.

The decision declaring the patent right invalid shall have no retroactive effect on any judgment or mediation decision of patent infringement which has been pronounced and enforced by the court, on any decision concerning the handling of a dispute over patent infringement which has been complied with or compulsorily executed, or on any contract of patent license or of assignment of patent right which has been performed prior to the declaration of the patent right invalid; however, the damage caused to others in bad faith on the part of the patentee shall be compensated.

If, pursuant to the provisions of the preceding paragraph, the

monetary damage for patent infringement, the fees for exploitation of the patent or fees for the assignment of the patent right is not returned, but such non-return is obviously contrary to the principle of equity, all or part of the preceding payments shall be returned.

### **18. Application of Estoppel Principle.**

In the procedure of patent right granting or the invalidation procedure, the patent applicant or patentee renounced the technical solution through amendments to the claims, description or opinion statements. If the patentee asserts the scope of patent protection covers such technical solution in the civil infringement case, the court will not support patentee's assertion.

The court may, when defining terms in the claims in an administrative case involving the confirmation of a patent, refer to the patentee's relevant statements that have been adopted by an effective judgment of a civil infringement case.



## Japan

### **1. The department that makes the decision**

The department that makes the invalidation department's decision is Trial and Appeal Department (TAD), JPO.

### **2. The timing for making the decision**

When a case reaches the point at which a decision on the trial can be rendered, a chief administrative judge must notify the parties and intervenors of the conclusion of the proceedings (P. Art. 156(1)).

"When a case reaches the point at which a decision on the trial can be rendered" is a situation where the panel reaches the state that they can draw the conclusion after considering all necessary facts and examining all evidence necessary to be examined (→Manual for Trial and Appeal Proceedings 42-00 1.(4)). Specifically, the panel decides by comprehensively considering the following points in general (→Manual for Trial and Appeal Proceedings 51-19).

(1) Whether approve or disapprove of the facts are acknowledged by or exchanged between the parties, and what the disputed facts are is clear to

the parties and to the panel (normally completed by the first reply stage).

(2) Whether the point of dispute was subject to proof by the party responsible for proof, and whether the opposing party had an opportunity to counter or rebut (usually completed by oral proceedings, in the first reply stage or the first refutation stage. Additionally, when making a trial decision as "purport of the request" or "purport of the reply" by the opposing party, providing an opportunity for refusal or rebuttal is not necessary).

(3) Whether there is a need to give the counterparty an opportunity to dispute further by requesting a correction (the Patent Act), correction (the Utility Model Act), or presenting a new reason for invalidation (usually considered at the first reply or the first refutation stage).

(4) Whether further listening to the counterparty's argument against one party's allegation and proof to form the panel's conviction is necessary.

In principle, a trial decision must be rendered within 20 days from the date on which the notification is issued (P. Art. 156(4)), however, this article is an advisory provision, and even if a trial decision is failed within this time period, the procedures does not become illegal. See (1925 (O) 165) Judgment of Supreme Court, April 17, 1925).

In a trial for patent invalidation, when a case reaches the point at which a decision on the trial can be rendered, if a chief administrative judge finds there to be reasonable grounds for the request for the trial and disapproves the request for correction, etc. the chief administrative judge must give the parties and intervenors advance notice of the trial decision (P. Art. 164-2(1)). When a chief administrative judge gives advance notice of a trial decision, the judge must specify an adequate period of time for respondent to file a request for correction of the description, claims or drawings attached to the written application (P. Art. 164-2(2)).

*[Ref] Manual for Trial and Appeal Proceedings 42-00*

### **3. Types of the decision by the invalidation department**

There are four types of the decision, which are:

A. Uphold all requests of the demandant

B. Uphold the partial requests of the demandant (P. Arts. 125, 185, U. Art. 41 , 50-2)

C. Do not uphold the request of the demandant

D. Dismiss the requests for a trial (P. Arts. 133, 135, U. Art. 41)

(→Manual for Trial and Appeal Proceedings 51-08, 45-04 5.)

#### **4. Legal effects of the decision by the invalidation department**

Legal effects of a trial decision for an invalidation trial as shown below.

##### (1) Effect of an invalidation trial decision

A. When the invalidation trial decision has become final and binding, the right shall be deemed never to have existed from the beginning (P. Art. 125, U. Art. 41)

B. Based on the reasons for invalidation occurring after the grant of patent (P. Art. 123(1)(vii), U. Art. 37(1)(vi)), when a trial decision that the right should be invalidated has become final and binding, the right shall be deemed not to have existed since it comes to fall under the reasons for invalidation (P. the proviso to Art. 125, U. Art. 41).

C. When a trial decision of the patent and utility model that a part of the claims should be invalidated has become final and binding, only the said claims shall become invalid (P. Arts. 123(1), 185).

(2) Prohibition of double jeopardy on a trial decision for an invalidation trial

When a trial decision for an invalidation trial has become final and binding, neither the parties nor intervenors of said trial may request a trial based on the same facts and the same evidence. (P. Art. 167, U. Art. 41) (→Manual for Trial and Appeal Proceedings 30-02).

*[Ref] Manual for Trial and Appeal Proceedings 51-19*

## **5. Service of the decision by the invalidation department**

### **5.1 Addressee**

A trial decision shall be delivered to the parties concerned (that is, the petitioner and the patentee), intervenors and persons whose application for intervention has been refused (P. Art. 157(3), U. Art. 41).

For an infringement case co-pending with infringement case, the Commissioner of the Patent Office shall notify the court to the effect that a trial decision with regard to the said patent right has been rendered. ( P. Art. 168(4), U. Art. 40(4))

### **5.2 Means of Service**

A certified copy of a trial decision is served by special delivery (P. Art. 190, U. Art. 55(2), Code of Civil Procedure Art. 99, Postal Act Art. 49). Special delivery is a postal delivery by postal official having the approval authority to serve a document such as complaint from the court to parties concerned and to prove the fact of the delivery. (Postal Act Art. 49)

However, if a person that is to be served a document refuses the service of the document or it is not possible to serve a document to a person that is to be served, a document shall be served by registered mail.

If the domicile or residence of the person to be served or any other place where the person is to be served is unknown, the service may be delivered by publication. Service by publication is effected by indication being published in the official gazette and the patent gazette that documents to be served can be served on the person to be served at any time, and by this posted on the noticeboard of the Japan Patent Office (P. Art. 191(2)) .

*[Ref] Manual for Trial and Appeal Proceedings 17-01*

### **5.3 Date of Service**

In principle, a date of delivery shall be the date of a document to be served to a person that is to be served (Code of Civil Procedure Art. 101).

However, in Service by Registered Mail, the dispatching date shall be deemed as a date of service (Code of Civil Procedure Art. 107(3)).

Also, the service by publication shall be effected after 20 days from the date published in the official bulletin (P. Art. 191, U. Art. 55(2)).

## **6. Litigious Rights**

The parties (that is, the petitioner and the patentee,), intervenors and persons whose application for intervention has been rejected may file a revocation action against the trial decision (P. Art. 178(2), U. Art. 47(1)).

### **(Time limits of filing an action)**

An action may be filed within 30 days from the date on which a certified copy of the trial decision is served. This period is invariable (P. Art. 178(3), U. Art. 47(2)).

A chief administrative judge may, upon ex officio, provides an additional time period (15 days for domestic residents and 90 days for overseas residents) for a person in a remote area or an area with transportation difficulty, and the additional time period shall be notified

with the service of the trial decision (→Manual for Trial and Appeal Proceedings 25-04 4.).

### **(Jurisdiction)**

The Tokyo High Court has exclusive jurisdiction over any revocation action against a trial decision for an invalidation trial, and the Intellectual Property High Court, a special branch of the Tokyo High Court, is to handle those cases (P. Art. 178(1), U. Art. 47(1), Act for Establishment of the Intellectual Property High Court Art. 2).

*[Ref] Manual for Trial and Appeal Proceedings 51-21*

### **7. The time when the decision by the invalidation department comes into effect**

Trial decisions will be final and binding and have a legal effect at either of the following timing: when a trial decision becomes final and binding or when a part of the trial decision becomes final and binding

1)When a trial decision becomes final and binding in an invalidation trial

A trial decision for an invalidation trial becomes final and binding if a revocation action against the trial decision has not been filed within the



legal time period from the party(that is, the petitioner and the patentee), intervenor, persons whose application for intervention has been rejected (P. Art. 178(3), U. Art. 47(2)), or even if a revocation action is filed but the decision, etc. is finally upheld and cannot be revoked by the ordinary appeal against the decision.

2)When a part of the trial decision becomes final and binding in an invalidation trial

Trial decisions, etc. for a patent (registration) invalidation trial (P. Art. 123, U. Art. 37) may be partially final and binding as shown below.

(1) Partial final and binding trial decision (P. Art. 167-2, U. Art. 41) for a patent (registration) invalidation trial (P. Art. 123, U. Art. 37) (→Manual for Trial and Appeal Proceedings 51-19 4.)

Regarding a patent (registration) with two or more claims, a trial for invalidation of patent (registration) may be requested for each claim. When a trial for invalidation of patent (registration) is requested for two or more claims, it is understood that the trial proceedings of each claim are conducted simultaneously, in principle. Then, a trial decision for an invalidation trial (request granted or not granted) is a separable administrative disposition for each determination on each claim. When a trial decision is partially maintained in a revocation action, or a

revocation action against a trial decision is not filed for some of the claims, a part related to the relevant claims in a trial decision becomes final and binding separately.

In a case where a request for correction is filed for each "group of claims" (P. Art. 134-2(3)), a patent trial decision shall become final and binding for the each group of claims when all claims in a group become final and binding.

*[Ref] Manual for Trial and Appeal Proceedings 46-00*

## **8. Publication means and the time of publishing the decision by the invalidation department**

### **• A trial decision to be published**

A final and binding trial decision for an invalidation trial is to be published in the gazette (Decision on Trial and Appeal Gazette) (P. Art. 193(2)(vii), U. Art. 53). A trial decision can be seen on the internet generally in one or two months from the date on which the decision is made.

### **• Whether the whole text is to be published**

The whole text is to be published.

- **How and when a trial decision is published**

As described, a trial decision for an invalidation trial is published in the gazette (Decision on Appeal/Trial Gazette). It can be also browsed via the internet (<https://www.publication.jpo.go.jp/>).

Decision on Appeal/Trial Gazette is, in principle, issued on the last Friday of every month. Generally, a trial decision is published after 1-2 months from the date on which the decision becomes final and binding as described above.

## **9. Updated legal status after the decision is made**

The final and binding trial decision of the trial for invalidation is registered ex officio by the Commissioner of the Japan Patent Office (the Patent Registration Order, Article 16-10; the Utility Model Registration Order, Article 6-5).

The registration shall be achieved by recording a reference number of the trial, the fact that the trial decision has become final and binding, the date (y/m/d) thereof, and an outline of the final and binding trial decision on the display section (Enforcement Regulations of the Patent

Registration Order, Article 37; Enforcement Regulations of the Utility Model Registration Order, Article 3(4)). Furthermore, if the trial decision becomes final and binding partially, it is registered as a "registration of a partial final and binding trial decision."

The means to check the Register include requests for inspection and requests for issuance.

In addition, rights information can be also checked on J-Platpat (<https://www.j-platpat.inpit.go.jp/>). (When the Patent Gazette page is displayed, click "Prosecution History Information" in the upper right corner of the page, and then click "Registration Information" to check the information.) However, it should be noted that the information on J-Platpat may not be the most up-to-date information.

*[Ref] Manual for Trial and Appeal Proceedings 46-00,51-19*

## **10. Number of requests for invalidation of the same patent right**

There is no limits on number of times to request for an invalidation trial.

However, when an invalidation trial is requested and once the

decision of the trial to maintain the right has become final and binding, neither the parties nor intervenors may file a request for either such kind of trial on the basis of the same facts or evidence (P. Art. 167).

The court does not interpret "the same facts or evidence" exactly. There may be cases where only a small addition of evidence is presented, a request for an invalidation trial may be rejected under the provision of Patent Act Article 167.

#### **11. Effect of previous decisions involving the same patent right on subsequent invalidation case**

If the earlier decision is a decision to invalidate the right, the subsequent proceedings for an invalidation trial shall be suspended until the earlier trial decision becomes final and binding, and the suspension will be notified. Once the earlier trial decision (decision to invalidate the right) becomes final and binding, the subsequent request for a invalidation trial is dismissed due to the non-existence of the right as an object (except a trial decision to invalidate the right by the reasons for invalidation occurring after the grant of patent).

If the earlier trial decision is to maintain the right, the proceedings for a newly filed invalidation trial shall be initiated promptly, in principle, regardless of whether the earlier trial decision becomes final and binding.

## **12. Examination procedures after the decision being overturned by an effective judgement**

When a court decision rescinding a trial decision has become final and binding, the case of a trial for invalidation is in a state where it has not yet received an administrative disposition (a trial decision), and therefore the case of a trial for invalidation is remanded to the JPO for re-pending and the panel will further examine the case (P. Art. 181(2), U. Art. 47(2)).

The final and binding court decision binds the JPO about the case (Administrative Case Litigation Act Art. 33), and thus the panel makes a trial decision again in accordance with the conclusion indicated in the final and binding court decision (main text of the court decision) and the matters described in the reasons for the court decision as fact-finding and legal determination necessary for the derivation of such conclusion. However, it cannot prevent from making a trial decision with the same conclusion under the different reasons.

With regard to the members of an administrative judge panel, although the law does not prohibit the same panel to hear a trial case in which the trial decision has been rescinded and remanded by the court, the members of the panel shall be changed in principle in consideration of fairness, neutrality, etc. trial case remanded to the JPO by the court due to rescission of the trial decision, it is not prohibited by the law that the proceedings are conducted by the same panel, but considering fairness and neutrality, in principle, change the panel.

*[Ref] Manual for Trial and Appeal Proceedings 80-00,83-02.2*

**13. Effect of the verdict of judicial proceedings related to previous decision involving the same patent right on later invalidation case**

When a court decision has not been conclusive, that is a trial decision is not final and binding, therefore, the answer is similar to the answer of item 11.

Namely, when the earlier trial decision is a decision to invalidate the right, the subsequent proceedings for an invalidation trial shall be suspended until the earlier trial decision becomes final and binding, and

the suspension will be notified.

If the earlier trial decision is to maintain the right, the proceedings for a newly filed invalidation trial shall be initiated promptly, in principle.

And if the court decision becomes final and binding, the handling of the subsequent request for an invalidation trial will be different depending on a conclusion of the court decision as below.

- Court decision reversing a trial decision becomes final and binding: the case of the earlier trial decision is remanded to the JPO (P. Art. 181(2), U. Art. 47(2)), and co-pending with the subsequent request for an invalidation trial. Whether the proceedings may be consolidated.
- Court decision dismissing the request becomes final and binding (i.e., the trial decision is maintained and becomes final and binding): when the earlier trial decision is to maintain the right, prohibition of double jeopardy comes into effect for the subsequent request for an invalidation trial. Namely, if the subsequent request for an invalidation trial is filed by the parties or intervenors of the earlier request based on the same facts and the same evidence as that of the earlier request for an invalidation trial, the subsequent request will be dismissed. When the earlier trial decision is to invalidate the right, the subsequent request for a trial will be dismissed due to the non-existence of the right as an object (except a trial



decision to invalidate the right by the reasons for invalidation).

*[Ref] Manual for Trial and Appeal Proceedings 51-22.2*

#### **14. Restrictions on grounds for subsequent invalidation requests**

When a trial decision for an invalidation trial has become final and binding, neither the parties concerned nor intervenors of said trial may request the trial based on the same facts and the same evidence (P. Art. 167, U. Art. 41) (→Manual for Trial and Appeal Proceedings 30-02).

*[Ref] Manual for Trial and Appeal Proceedings 51-19*

#### **15. Handling of multiple invalidation requests for the same patent right at the same time**

In order to achieve effective proceedings by making the content and timing of attacks against the right holder as similar as possible and making the right holder's defense method common to multiple cases, the proceedings will be conducted as follows.

(1) Consolidated proceedings (→51—09 5.)

When multiple trials for invalidation are "pending simultaneously", consider the possibility of consolidated proceedings. For cases that can be efficiently examined in such a manner, consolidate the proceedings (P. Art. 154(1)).

(2) Factual consolidated proceedings

If conducting consolidated proceedings for multiple trials for invalidation are inappropriate and if multiple, simultaneous proceedings of trials for invalidation do not preclude the smooth progress of the procedure, simultaneously examine multiple cases without conducting consolidated proceedings and make the trial decisions at the same time if possible.

(3) Prioritized Proceedings

When prioritizing a particular case can contribute to a prompt resolution of the dispute, decide the proceedings' priority, select the most appropriately prioritized trial(s) for invalidation case(s) to be examined, and examine the trials for invalidation earlier than the remaining trials for invalidation.

A. Consider reasons, evidence, etc. asserted in the trial for invalidation case that is not preferentially examined as a subject of ex officio proceedings in the trial for invalidation case that is preferentially examined.

B. In a trial for invalidation case that is not preferentially examined, in principle, a notice of suspension is prepared according to the Patent Act Article 168(1) (U. Art. 40(1)). If a party concerned submits a written statement, etc. requesting cancellation of the suspension, considering that the presented reasons and evidence have already been taken into account in the priority proceedings, cancelling the suspension is allowed only if it is considered useful for prompt resolution of the dispute.

C. Handling of the case in subsequent proceedings is decided according to the conclusion (whether the right is invalid or maintained) of the case that has been preferentially examined. (A) If the conclusion of the preferentially examined case is invalid, in principle, proceedings of the subsequent case are suspended until the trial decision becomes final and binding. (B) If the conclusion of the preferentially examined case is to maintain the right, in principle, proceedings of the subsequent case are initiated promptly thereafter. In the patent, if a preferentially examined case of trial for invalidation is filed and if the correction in the said preferentially examined case of trial for invalidation has not been fixed, then set proceedings in consideration of consistency with the correction in

the trial for invalidation which is subsequently examined (→ 51-22.2 2. (2)).

*[Ref] Manual for Trial and Appeal Proceedings 51-22.1*

## **16. Effect of the invalidation procedure on the civil infringement cases**

Effect of invalidation procedures on infringement litigation is regulated under the provision of the Patent Act Article 168 as shown below.

### Patent Act Article 168

(2) If an action has been instituted and the court finds it to be necessary, the court may suspend litigation proceedings until the decision on the trial becomes final and binding.

(3) If an action is instituted with respect to infringement of a patent right or violation of an exclusive license, the court is to notify Commissioner of the Japan Patent Office of this. The same applies once the litigation proceedings conclude.

(4) If Commissioner of the Japan Patent Office is notified as provided in the preceding paragraph, the commissioner is to notify the

court of whether a request for a trial has been filed with the Japan Patent Office with regard to that patent right. The same applies if the Japan Patent Office issues a decision dismissing the written request for the trial, if it renders a decision on the trial in such a trial, or if the request for such a trial is withdrawn.

(5) If the court is notified pursuant to the preceding paragraph that a request for a trial with regard to the relevant patent right, and if a document stating a method of allegation or evidence under the Patent Act Article 104-3 (1) has already been submitted in the litigation prior to the notice or the document is submitted for the first time after the notice, the court must notify Commissioner of the Japan Patent Office of that fact.

(6) If Commissioner of the Japan Patent Office is notified as provided in the preceding paragraph, the commissioner may request the court to deliver copies of any record of the litigation which the administrative judges consider necessary for the trial.

### **17. Effect of the result of the decision by the invalidation department on infringement cases**

There is no legal influence until a trial decision has become final and binding, and civil infringement case has been dismissed after the trial decision to invalidate the right has become final and binding. A party

concerned of infringement litigation may allege and prove on the validity of the patent and the scope thereof in the litigation (P. Art. 104-3), thus even if an invalidation trial decision becomes final and binding after the final court decision, said party concerned of the litigation may not allege that the trial decision has become final and binding in an action for retrial against said final court decision (P. Art. 104-4).

Regarding a trial for invalidation of patent filed during the pendency of infringement litigation, from the view point of effective solution of the dispute and prevention of discrepancies of the judgment, such a trial is a subject to preferential examination. If the court finds it to be necessary, the court may suspend litigation proceedings until the trial decision becomes final and binding (P. Art. 168(2)).

### **18. Application of Estoppel Principle.**

The legal basis of estoppels is not stipulated in the Patent Act, but it can be found in the principle of good faith and fair dealing (Code of Civil Procedure Art. 2) in the general civil proceedings.

It is not permitted a patentee to allege the subject products implemented by the defendant are included in the claims at the stage of patent infringement litigation procedure if the patentee alleged something

opposite during the process of examination or trial in order to avoid reasons for refusal (reasons for invalidation) such as lack of novelty, inventive step, or inappropriate description, etc.

## **Korea**

### **1. The department that makes the decision**

IPTAB consists of 33 Boards, and the Boards make decisions on trials and appeals, including a trial for invalidation.

### **2. The timing for making the decision**

Except as otherwise expressly provided in any Act, a patent trial shall be closed by a trial ruling.

When a case has been thoroughly reviewed and is ready to be ruled, the presiding judge shall notify the parties and intervenors of the closing of the trial review.

The trial ruling shall be rendered within 20 days from the date notice of the closing of trial review is given.

### **3. Types of the decision by the invalidation department**

There are three types of the decision, which are:

- (1) a patent right shall be maintained
- (2) a patent right shall be invalidated in part
- (3) a patent right shall be invalidated as a whole



#### **4. Legal effects of the decision by the invalidation department**

If a trial decision invalidating a patent becomes final and conclusive, the patent right shall be deemed never to have existed.

When a trial decision invalidating a patent in part becomes final and conclusive, only the patents of the corresponding claims become invalid.

When a trial decision invalidating a patent becomes final and conclusive, no person may request a re-trial, based on the same facts and evidence.

When a trial decision to correct the specification or drawings of a patented invention becomes final and conclusive, it shall be deemed that filing and laying open the relevant patent application, a decision to grant a patent or trial decision, and the registration of the grant of the patent have been made according to the corrected specification or drawings.

#### **5. Service of the decision by the invalidation department**

##### **5.1 Addressee**

A certified copy of the decision shall be delivered to the relevant parties, intervenors, and persons who filed an application for intervening in hearings but had the application rejected.

## **5.2 Means of Service**

The decisions can be served in three ways: Service by Post, by Electronic Means, and by Public Notice.

Service by Post refers to delivering the decision by postal service, and the relevant documents shall be delivered by registered mail. Service by Electronic Means refers to delivering the decision via the online KIPO patent application system ([www.patent.go.kr](http://www.patent.go.kr)).

If the service address is unclear and the documents cannot be delivered by post, it may be served to the party concerned by Public Notice.

## **5.3 Date of Service**

The certified copy of trial decision shall be delivered by a special service as prescribed by the Postal Service Act and its Enforcement, or shall be delivered via information and communications network for those who has reported on the use of electronic documents. The date when the written trial decision is delivered shall be the date of delivery. However, when the trial decision is delivered by Public Notice, the initial public

notice in lieu of service shall take effect two weeks after the date of publication in the Patent Gazette. *Provided*, that the subsequent public notice in lieu of service to the same parties shall take effect on the day immediately after the date of publication in the Patent Gazette. For overseas resident (non-residents of Korea) who has not appointed a patent administrator, the documents can be delivered by registered airmail. Documents posted by registered airmail shall be deemed to be served on the mailing date of the documents.

## **6. Litigious Rights**

A party who is dissatisfied with the trial decision rendered by the IPTAB may appeal the Board's decision to the Patent Court. If they are not satisfied with the Patent Court decision, it can be appealed to the Supreme Court.

## **7. The time when the decision by the invalidation department comes into effect**

The trial decision shall become final and conclusive when those who are not satisfied with the trial ruling or decision do not file a petition to the Patent Court within 30 days from the date when a certified copy of the decision is served (within the additional period when the period is extended legitimately, Patent Act Article 186(3)) or when there is no

appeal filed against a revocation action. Even when appeal is filed, the trial decision shall become final and conclusive when the trial decision is supported and cannot be canceled by the usual method of filing an appeal even when it is appealed (Trial Practice Regulations p. 1015).

#### **8. Publication means and the time of publishing the decision by the invalidation department**

All trial decisions will be open to public via KIPRISS website ([www.kipriss.or.kr](http://www.kipriss.or.kr)), once all personal information is sealed.

#### **9. Updated legal status after the decision is made**

After the trial decision is rendered, a decision and trial status information may be made open to public within one month or two months from the date of decision, once all personal information is screened and sealed.

When the parties are not satisfied with the trial decision and file a petition before the Court, the Court hearing the case shall notify the IPTAB of the details and judgement without delay at the time when the petition and appeal is filed and completed. In that sense, the legal status will be made available upon notification. General public may check the legal status of patents at KIPRISS website ([www.kipriss.or.kr](http://www.kipriss.or.kr)).

## **10. Number of requests for invalidation of the same patent right**

There is no limit to the number of requests for invalidation before the patent right becomes invalid as a whole.

## **11. Effect of previous decisions involving the same patent right on subsequent invalidation case**

In general, when the previous decision declares to maintain the patent right, the subsequent request for invalidation will be directly on trial.

When the previous decision declares to invalidate a patent right in part and relevant legal proceeding is filed before the Court, parties shall wait for the Court decision.

When the previous decision declares the invalidation of a patent right as a whole and the relevant legal proceeding is filed before the Court, the subsequent invalidation trial (invalidation trial requested afterwards) shall be suspended until they have the Court decision.

## **12. Examination procedures after the decision being overturned by an effective judgement**

The subsequent requests for invalidation shall be suspended until the Supreme Court decision is made.

Administrative patent judges shall review the case and render another decision

The grounds for revoking a trial decision shall have the binding effect on the IPTAB.

**13. Effect of the verdict of judicial proceedings related to previous decision involving the same patent right on later invalidation case**

When the previous trial decision which declares the invalidation of a patent right as a whole is made and the decision is upheld by the valid judgement of the Court, all invalidation proceedings based on the same patent right shall be dismissed.

When the previous trial decision which declares to maintain a patent right or to invalidate a patent right in part is made and the decision is upheld by the valid judgement of the Court, all invalidation proceedings based on the same patent right shall continue only with respect to the remaining valid claims.

When the previous trial decision is overturned by the valid judgement of the Court, the previous decision shall generally become final and conclusive after the court decision.

#### **14. Restrictions on grounds for subsequent invalidation requests**

##### **Patent Act Article 163**

If a trial ruling rendered under the Patent Act becomes final and conclusive, no person may request re-trial, based on the same facts and evidence.

#### **15. Handling of multiple invalidation requests for the same patent right at the same time**

When one or more invalidation requests for the same patent right are filed at the same time, the prior arts shall be reviewed. If the prior arts and the petitioner's arguments have much in common, the cases shall be consolidated for rendering a decision.

If the prior art and arguments are different, they will be reviewed as a separate case.

If possible, corrections will be consolidated for review.

#### **16. Effect of the invalidation procedure on the civil infringement cases**

In general, when an invalidation trial and a civil infringement case are pending concurrently, infringement case shall consider the Patent

Court decision: *Provided that* the foregoing shall not apply to the decision on provisional disposition concerning patent infringement.

### **17. Effect of the result of the decision by the invalidation department on infringement cases**

(1) In general, when an invalidation trial and a civil infringement case are pending concurrently, infringement case shall consider the Patent Court decision: *Provided that* the foregoing shall not apply to the decision on provisional disposition concerning patent infringement.

(2) When the trial decision on the request for invalidation becomes final and conclusive based on the valid Court decision, the judgement on infringement shall be made based on the same grounds.

### **18. Application of Estoppel Principle.**

Estoppel Principle shall be applied to the argument of parties in the invalidation trial.

Arguments made by a patentee in the infringement lawsuit will be also considered in the invalidation trial.