



Boards
of Appeal



User Guide of IP5 Trial and Appeal Procedures



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INTRODUCTION

Trial and appeal procedures are critical components of patent systems worldwide and are of universal interest to global users. This guide compiles the basic procedures and practice for trial and appeal procedures across IP5, based on information and materials provided by IP5 trial and appeal boards. It aims to assist global users in systematically understanding and using the relevant procedures of the IP5 offices, enhance their ability to respond to and handle patent disputes, facilitate international economic and trade exchange and cooperation, and promote global scientific innovation and economic growth.

The use guide specifically covers information such as the institutional information of the IP5 trial and appeal boards, request submission process, rules for patent document amendments, user-friendly policies, and commonly used information and resources. It should be noted the purposes of User Guide per se is to provide users with more clear introductions. It doesn't seek synergy on the legal provisions and practical experiences. The final ruling of the specific application depends on legal provisions of each partner.

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CONTENTS

Appeal Procedures of BoA	1
1. Institutional Information	1
1.1 Name of Trial and Appeal Authorities.....	1
1.2 Website links and public contact details.....	1
2. Introduction of Appeal Procedure of Boards of Appeal	1
2.1 Key Process Elements	1
2.1.1 Minimum Request Unit.....	1
2.1.2 Applicant Eligibility	2
2.1.3 Time Limits	2
2.1.4 Official Fees	2
2.1.5 Examination Scope.....	3
2.2 Amendment Rules	3
2.3 Hearing Formats.....	5
2.4 Termination or withdrawal of appeal and re-establishment of rights	6
2.4.1 Termination	6
2.4.2 Withdrawal of Appeal.....	6
2.4.3 Re-establishment of Rights	6
2.5 Outcome Types: Possible conclusions	6
2.6 Legal Effects of Invalidation.....	7
2.7 Foreign applicant: Eligibility and special requirements.....	7
3. Request Submission Process	7
3.1 Submission Channels	7
3.2 Online Portals.....	7
3.3 Required Documents	7
4. Additional Resources	8

Patent Trial and Appeal Procedures of JPO	9
1. Institutional Information	9
1.1 Name of Trial and Appeal Authorities.....	9
1.2 Website links and public contact details.....	9
2. Basic Procedures	9
2.1 Appeal against examiner's decision of refusal.....	9
2.1.1 Key Process Elements	9
2.1.2 Amendment Rules	11
2.1.3 Hearing Formats.....	13
2.1.4 Procedure Status.....	13
2.1.5 Outcome Types: Possible conclusions.....	13
2.1.6 Foreign applicant: Eligibility and special requirements	14
2.2 Trial for invalidation	14
2.2.1 Key Process Elements	14
2.2.2 Amendment Rules	17
2.2.3 Hearing Formats.....	18
2.2.4 Procedure Status.....	19
2.2.5 Outcome Types: Possible conclusions.....	19
2.2.6 Legal Effects of Invalidation.....	20
2.2.7 Foreign applicant: Eligibility and special requirements	20
2.3 Opposition to grant of patent.....	20
2.3.1 Key Process Elements	20
2.3.2 Amendment Rules	22
2.3.3 Hearing Formats.....	23
2.3.4 Procedure Status.....	23
2.3.5 Outcome Types: Possible conclusions.....	24
2.3.6 Foreign applicant: Eligibility and special requirements	24
2.4 Trial for correction	25
2.4.1 Key Process Elements	25
2.4.2 Amendment Rules	26

2.4.3 Hearing Formats.....	27
2.4.4 Procedure Status.....	27
2.4.5 Outcome Types: Possible conclusions.....	28
2.4.6 Foreign applicant: Eligibility and special requirements.....	28
3. Subsequent Judicial Procedures	28
4. Request Submission Process	28
4.1 Submission Channels	28
4.2 Online Portals: Links to e-filing platforms	29
4.3 Required Documents: Standard materials	29
4.3.1 Appeal against examiner's decision of refusal.....	29
4.3.2 Trial for invalidation	31
4.3.3 Opposition to grant of patent.....	32
4.3.4 Trial for correction	32
5. Additional Resources	33
Korea Trial and Appeal Procedures	35
1. Institutional Information	35
1.1 Name of Trial and Appeal Authorities.....	35
1.2 Website links and public contact details.....	35
1.3 Group Tour and Observation of Oral Hearings	35
1.4 Overview of Trial and Appeal System	36
1.5 Organization of the IPTAB.....	36
2. General Information on Trials and Appeals	37
2.1 Types of Trials and Appeals	37
2.2 Trial and Appeal Proceedings.....	51
2.3 Administrators for Foreign-domiciled Applicants.....	52
2.3.1 Patent Administrators for Foreign-domiciled Applicants.....	52
2.3.2 Trademark/Design Administrators for Foreign-domiciled Applicants.....	53
2.4 Key Figures for 2024	53
2.5 Trial and Appeal Fees.....	54
3. User-friendly IPTAB Proceedings	56
3.1 Remote Oral Hearing	56

3.2 Three-track Trial System	57
3.3 IPTAB-appointed Attorney	59
4. Litigation Process of Appealing IPTAB Decisions	61
5. Additional Resources	62
Patent Reexamination and Invalidation Procedure in China	63
1. Institutional Information	63
1.1 Name of Trial and Appeal Authorities.....	63
1.2 Website links and public contact details.....	63
2. Basic Procedures	63
2.1 The following aspects of Reexamination procedure	63
2.1.1 Key Process Elements.....	64
2.1.2 Amendment Rules	65
2.1.3 Examination Scope.....	66
2.1.4 Hearing Formats.....	67
2.1.5 Procedure Status.....	67
2.1.6 Outcome Types: Possible conclusions.....	68
2.2 The following aspects of Invalidation procedure	69
2.2.1 Key Process Elements.....	70
2.2.2 Amendment Rules	71
2.2.3 Examination Scope.....	72
2.2.4 Hearing Formats.....	74
2.2.5 Procedure Status.....	75
2.2.6 Outcome Types.....	76
3. Subsequent Judicial Procedures	76
3.1 Whether judicial appeal is permitted against decisions.....	76
3.2 Competent courts	76
4. User-friendly measures	77
4.1 Diversified document submission procedures.....	77
4.1.1 Submission Channels: Electronic vs. paper-based systems	77
4.1.2 Online Portals: Links to e-filing platforms.....	77
4.1.3 Required Documents.....	77

4.2 Fast-track procedures	77
4.3 Multi-modal Review Mechanisms	79
4.4 External Training and Services	80
4.5 Notice to foreign parties.....	80
4.6 Information disclosure and Resource Links.....	80
Brief introduction to Procedures of PTAB, USPTO.....	82
1. Introduction to Patent Trial and Appeal Board (PTAB) of USPTO	82
1.1 Website	82
1.2 Members.....	82
1.2.1 Statutory Members	82
1.2.2 APJs.....	82
1.3 3-member panels issue final decisions	82
2. Ex Parte Appeals	82
2.1 Website.....	82
2.2 Overview	82
2.3 Request Submission Process	83
2.4 Manuals & Resource Links	83
2.5 Request Submission Process	83
3. Subsequent Judicial Procedures	83
3.1 Request rehearing by the panel	83
3.2 Request judicial review	83
4. Additional Resources	83
4.1 PTAB Precedential and Informative Decisions.....	83
4.2 Legal Experience and Advancement Program (LEAP).....	83
4.3 PTAB Inventor Hour Series	83

Appeal Procedures of BoA

1. Institutional Information

1.1 Name of Trial and Appeal Authorities

Boards of Appeal of the European Patent Office (EPO)

1.2 Website links and public contact details

<https://www.epo.org/appeals>

2. Introduction of Appeal Procedure of Boards of Appeal (see Articles 21 and 106 of the European Patent Convention (EPC))

Reference is made to the EPO webpage "Frequently Asked Questions regarding the appeal procedure".

Appeals may be filed against decisions of the Receiving Section, Examining Divisions, Opposition Divisions and Legal Division. Appeals can be filed against final decision which terminate the proceedings or intermediate decisions only if the decision allows a separate appeal.

The function of the appeal procedure is to provide a judicial review on the correctness of an administrative decision (separation of powers, the Boards of Appeal (BoA) function as the first and final judicial instance in the proceedings under the European Patent Convention). Appeal proceedings are wholly separate and independent from the administrative (first) instance proceedings. The decisions of the Boards of Appeal are final.

2.1 Key Process Elements

2.1.1 Minimum Request Unit: Single claim vs. entire patent

For your reference:

“Case Law of the Boards of Appeal of the European Patent Office/

V. Proceedings before the Boards of Appeal/

A. Appeal procedure/

2. Filing and admissibility of the appeal/

2.2. Appealable decisions”

https://www.epo.org/en/legal/case-law/2025/clr_v_a_2_2.html

2.1.2 Applicant Eligibility: Qualifications for filing requests

Under Article 107 EPC, any party who is adversely affected by the decision may appeal. Other parties to the first-instance proceedings become parties to the appeal proceedings as of right.

2.1.3 Time Limits: Deadlines for submission (and extension possibilities)

Under Article 108 EPC and Article 12(1)(a) and (b) Rules of Procedure of the Boards of Appeal (RPBA), the notice of appeal must be filed within two months of notification of the decision of the department of first instance. Notice of appeal shall not be deemed to have been filed until the appeal fee has been paid. Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations.

In opposition-appeal cases with more than one party to the appeal proceedings, any written reply of the other party or parties need to be filed within four months of notification of the grounds for appeal (Article 12(1)(c) RPBA).

2.1.4 Official Fees

The amount of the appeal fee is laid down in the Rules relating to Fees.

2.1.5 Examination Scope: What will be reviewed and Common Grounds for Request

In view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based (see Article 12(2) RPBA).

2.2 Amendment Rules

Three levels of the convergent approach, as set out in Articles 12(4) and (6) RPBA, Article 13(1) RPBA and Article 13(2) RPBA, apply.

Article 12(4) RPBA:

Any part of a party's appeal case which does not meet the requirements in Article 12 paragraph 2 is to be regarded as an amendment, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendment may be admitted only at the discretion of the Board.

The party shall clearly identify each amendment and provide reasons for submitting it in the appeal proceedings. In the case of an amendment to a patent application or patent, the party shall also indicate the basis for the amendment in the application as filed and provide reasons why the amendment overcomes the objections raised.

The Board shall exercise its discretion in view of, inter alia, the complexity of the amendment, the suitability of the amendment to address the issues which led to the decision under appeal, and the need for procedural economy.

Article 12(6) RPBA:

The Board shall not admit requests, facts, objections or evidence which were not admitted in the proceedings leading to the decision under appeal, unless the decision not to admit them suffered from an error in the use of discretion or unless the circumstances of the appeal case justify their admittance.

The Board shall not admit requests, facts, objections or evidence which should have been submitted, or which were no longer maintained, in the proceedings leading to the decision under appeal, unless the circumstances of the appeal case justify their admittance.

Article 13(1) RPBA:

Any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to the party's justification for its amendment and may be admitted only at the discretion of the Board.

Article 12, paragraphs 4 to 6, shall apply *mutatis mutandis*.

The party shall provide reasons for submitting the amendment at this stage of the appeal proceedings.

The Board shall exercise its discretion in view of, *inter alia*, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, *prima facie*, overcomes the issues raised by another party in the appeal proceedings or by the Board and does not give rise to new

objections.

Article 13(2) RPBA:

Any amendment to a party's appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, after notification of a communication under Article 15, paragraph 1, shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

2.3 Hearing Formats

Written or oral hearings:

In application of Article 116 EPC and Rule 115 EPC, oral proceedings shall take place if the Boards of Appeal consider this to be expedient or at the request of any party to the proceedings.

Under Article 15(1) RPBA, the Board shall, if oral proceedings are to take place, endeavour to give at least four months' notice of the summons.

Under Article 15a(1) RPBA, the Board may decide to hold oral proceedings pursuant to Article 116 EPC by videoconference if the Board considers it appropriate to do so, either upon request by a party or of its own motion.

Further information with regard to oral proceedings before the BoA may be found on the Boards of Appeal's website.

<https://www.epo.org/en/case-law-appeals/oral-proceedings>

1) Information of oral proceedings

Oral proceedings are listed in the oral proceedings calendar.

2) Availability of remote participation

Available.

2.4 Termination or withdrawal of appeal and re-establishment of rights

2.4.1 Termination

Reference is made to the case law on the termination of appeal proceedings (Case Law Book, V.A.7.)

https://www.epo.org/en/legal/case-law/2025/clr_v_a_7.html

2.4.2 Withdrawal of Appeal

Under the EPC it is possible to withdraw a patent application, opposition or appeal. Reference is made to J 19/82 with regard to partial withdrawal.

2.4.3 Re-establishment of Rights

The re-establishment of rights is set out under Article 122 EPC.

2.5 Outcome Types: Possible conclusions (e.g., Maintain the rejection decision, suspension, or Deemed to be withdrawn, Declare the patent invalid)

Ex parte cases settled by a decision on the merits can have the following outcome:

- 1) Appeal dismissed;
- 2) Remittal of the case to the Examining Division for further prosecution and decision;
- 3) Patent granted.

Inter partes cases settled by a decision on the merits can have the following outcome:

- 1) Appeal dismissed;
- 2) Remittal of the case to the Opposition Division for further prosecution

and decision;

- 3) Patent maintained in amended form;
- 4) Patent maintained as granted;
- 5) Patent revoked.

Detailed statistical information can be found in the annual reports of the Boards of Appeal.

2.6 Legal Effects of Invalidation: Retroactive ("ab initio") or prospective

Article 68 EPC

Effect of revocation or limitation of the European patent

The European patent application and the resulting European patent shall be deemed not to have had, from the outset, the effects specified in Articles 64 and 67 EPC, to the extent that the patent has been revoked or limited in opposition, limitation or revocation proceedings.

2.7 Foreign applicant: Eligibility and special requirements

No restrictions for foreign applicants; must be represented by an EPO-accredited professional if not EU-resident.

Art. 133(2) EPC

3. Request Submission Process

3.1 Submission Channels: Electronic vs. paper-based systems

Electronic (EPO Online Filing) or paper (via mail).

3.2 Online Portals: Links to e-filing platforms

EPO Online Filing

<https://www.epo.org/applying/online-services.html>

3.3 Required Documents: Standard materials

Under Article 108 EPC, the notice of appeal shall be filed, in accordance with the Implementing Regulations, at the European Patent Office within two months of notification of the decision. Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid. Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations.

Furthermore, each office is welcome to provide any additional information they wish to include or consider important for applicants to be aware of.

4. Additional Resources

Reference is made to the latest, 11th edition of the Case Law of the Boards of Appeal.

<https://www.epo.org/en/legal/case-law>

The annual reports of the Boards of Appeal are available on the Boards of Appeal's website.

<https://www.epo.org/en/case-law-appeals/annual-reports>

Patent Trial and Appeal Procedures of JPO

1. Institutional Information

1.1 Name of Trial and Appeal Authorities

Trial and Appeal Department, JPO

1.2 Website links and public contact details

Phone: +81-3-3581-1101 Ext.3613

E-mail: PA6B00@jpo.go.jp

2. Basic Procedures

2.1 Appeal against examiner's decision of refusal

2.1.1 Key Process Elements

(1) Applicant Eligibility

An appellant is a person who has received a decision of refusal (including a successor) . When a co-owner of the right to obtain a patent requests an appeal for the right jointly owned, all co-owners should jointly file the request.

(2) Time Limits: Deadlines for submission (and extension possibilities)

Patent Act Article 121(1): A person that has been issued an examiner's decision rejecting an application and that is dissatisfied with this decision may file an appeal against the rejection within three months after the date that the certified copy of the examiner's decision is served.

Patent Act Article121 (2) : If a person filing an appeal against a rejection has been unable to file this within the period prescribed in the preceding

paragraph due to reasons beyond the person's control, the person may file an appeal within 14 days (or within two months, if the person is an overseas resident) after the date on which those reasons cease to exist, but no later than six months after the end of the aforementioned period, notwithstanding the preceding paragraph.

The Commissioner of the JPO may extend the term provided in Patent Act Article 4 for a person in a remote area or an area with transportation difficulties by request or ex officio. However, the term except for an appeal against examiner's decision of refusal of a patent application (Patent Act Article 121) will not be extended in principle.

※Q&A

Q: Is it possible to receive an extension of the period for filing a request for an appeal examination?

A: A request for the extension of the period will not be approved. However, in a case where an applicant is an overseas resident, the period for requesting an appeal against an examiner's decision of refusal (with the exception of an appeal against an examiner's decision of refusal of an application for the registration of extension of the duration of a patent right) is extended ex officio by 1 month, and therefore the period for requesting an appeal against an examiner's decision of refusal is within 4 months from the date of delivery of a certified copy of the examiner's decision of refusal. As this is an ex officio extension, you do not have to submit a written request, etc. for the extension of the period.

(3) Official Fees: ¥49,500 + ¥5,500 per claim

(4) Examination Scope: What will be reviewed and Common Grounds for

Requests

A panel consisting of administrative judges examines whether the decision of refusal is appropriate. If it is determined inappropriate, the Trial and Appeal Department (TAD) conducts an ex officio investigation with regard to presence or absence of other reasons for refusal, and determines whether a right can be granted.

2.1.2 Amendment Rules

Allowable claim amendments (types and timing)

○Amendment in Filing a Request for Appeal

When a request for appeal against examiner's decision of refusal of patent application is filed, the following items may be amended for the specification, claims, or drawings attached to the application only if the amendment is made at the same time of filing an appeal.

A. Allowable scope of amendment of the claims

- (a) Deletion of claim(s)
- (b) Restriction by limitation of claim(s)
- (c) Correction of clerical error
- (d) Clarification of ambiguous descriptions about matters pointed out in the reasons for refusal

Regarding (b), restriction by limitation of claim(s), the amended claim(s) should be patented independently upon the filing of the patent application.

B. An amendment may not be made to the specification, claims or drawings by adding new matters which are beyond the scope of the specification, claims or drawings (or in case of a foreign language application, a translation) originally attached to the application.

However, when an amendment is made by a correction for an incorrect translation, the amendment beyond the scope of the matters described in the translation is permitted if the amendment falls within the scope of the matters described in a foreign language application.

C. An invention for which a determination has been made as to whether it may not be patented in a notice of reasons for refusal received before the amendment at the time of request for appeal may not be amended to change into another invention with a different technical feature of the invention.

D. An amendment not satisfied with the requirements of A., B., C. shall be dismissed.

○ Amendment in this Appeal (Except When Filing a Request for Appeal)

In an appeal against examiner's decision of refusal of a patent application, if a notice of reasons for refusal is notified, an appellant may amend the specification, claims or drawings.

A. When a notice of reasons for refusal notified in this appeal case corresponds to a "non-final notice of reasons for refusal" under Patent Act Article 17-2(1)(i), the specification, claims or drawings (or in case of a foreign language application, a translation) attached to the application may be amended without adding a new matter. However, when an amendment is made by a written correction for an incorrect translation, the amendment beyond the scope of the matters described in the translation is possible if the amendment falls within the scope of the matters described in a foreign language application. An amendment that violates the requirements of amendment is subject to a reason for refusal.

B. When a notice of reasons for refusal notified in this appeal corresponds to a “final notice of reasons for refusal” under Patent Act Article 17-2(1)(iii), a scope of amendment is the same as the scope at the time of filing a request for appeal. An amendment that violates the requirement of amendment shall be dismissed.

2.1.3 Hearing Formats

An appeal against examiner’s decision of refusal is documentary proceedings.

2.1.4 Procedure Status: Termination, suspension, or resumption conditions

Patent Act Article 168 (extract): (1) If it is found to be necessary during a trial or appeal, the trial or appeal proceedings may be suspended until the ruling on an opposition to a granted patent or the decision from another trial or appeal becomes final and binding or until litigation proceedings conclude.

2.1.5 Outcome Types: Possible conclusions

(1) When an appeal should be refused based on reasons for refusal of the original decision, an appeal decision to the effect that a request for appeal is groundless is rendered.

(2) When it is determined that an appeal should not be refused based on reasons for refusal of the original decision, the appeal examination may be proceeded by applying the procedures of a notice of reasons for refusal, etc., to an appeal. As a result, when an appeal should be refused, an appeal decision is made to the effect that a request for appeal is groundless, whereas when reasons for refusal are not found, the original decision is

revoked and an appeal decision is made to the effect that a request for appeal is approved.

(3) When it is determined that the original decision is revoked since an appeal should not be refused by reasons for refusal of the original decision, an appeal decision that further examination should be conducted may be also made.

(4) When a request for appeal is unlawful and may not be amended, an appeal is dismissed by appeal decision.

2.1.6 Foreign applicant: Eligibility and special requirements

Need an agent. When an overseas resident performs procedures without a patent administrator, said procedures are deemed inappropriate and dismissed (Patent Act Articles 18-2, 133-2, 135, Utility Model Act Article 41).

2.2 Trial for invalidation

2.2.1 Key Process Elements

(1) Minimum Request Unit: Single Claim

(2) Applicant Eligibility: Interested persons

(3) Time Limits: Deadlines for submission (and extension possibilities)

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.

(4) Official Fees: ¥49,500 + ¥5,500 per claim

(5) Examination Scope: What will be reviewed and Common Grounds for Requests

Reasons of public interest (lack of novelty, lack of inventive step, violation of description requirements, etc.)

Reasons related to attribution of rights (usurped application, violation of joint application)

Reasons occurring after the grant of patent (violation of enjoyment of rights, violation of treaties)

Reasons for invalidation are defined as any reason or fact invalidating a right. The reasons are limited to the statutory reasons for invalidation (the Patent Act Article 123(1); the Utility Model Act Article 37(1)). No other reasons outside the statutory provisions constitute a reason for the request of a trial for invalidation, which is in accordance with the limitative listing of the reasons for invalidation.

Patent Act Article 123(1) (extract)

If a patent falls under any of the following items, a request for a patent invalidation trial may be filed. If the request involves two or more claims, it may be filed on a claim-by-claim basis:

- (i) the patent has been granted on a patent application (excluding a foreign-language application) with an amendment that does not comply with the requirements stipulated in Article 17-2, paragraph (3);
- (ii) the patent has been granted in violation of Article 25, 29, 29-2, 32, or 38, or Article 39, paragraphs (1) through (4) (if the patent has been obtained in violation of Article 38, excluding if the transfer of a patent right under that patent has been registered based on a request under Article 74, paragraph (1));
- (iii) the patent has been granted in violation of a treaty;
- (iv) the patent has been granted on a patent application not complying with the requirements stipulated in Article 36, paragraph (4), item (i) or

paragraph (6) (excluding item (iv) of that paragraph);

(v)the matters stated in the description, claims, or drawings attached to the foreign-language application are not within the scope of matters stated in foreign-language documents;

(vi)the patent has been granted on a patent application filed by a person that does not have the right to the grant of a patent for the invention (excluding when the transfer of a patent right under the patent has been registered based on a request under Article 74, paragraph (1));

(vii)after being granted a patent, the patentee comes to fall under a category of person that is not permitted the enjoyment of a patent right pursuant to Article 25, or the patent comes to violate a treaty after being granted; or

(viii)the correction of the description, claims or drawings attached to the written application for the patent have been obtained in violation of the proviso to Article 126, paragraph (1), and paragraphs (5) through (7) (including as applied mutatis mutandis pursuant to Article 120-5, paragraph (9) or Article 134-2, paragraph (9)), the proviso to Article 120-5, paragraph (2) or the proviso to Article 134-2, paragraph (1).

In a trial, because the proceedings may include reasons that were not requested by the parties or intervenors (for example, different provisions), in the case of a trial for invalidation, detecting ex-officio a reason for invalidation that the demandant has not asserted is also possible. However, because the purport of the request that is not claimed by the demandant cannot be examined, as for the claims for which no trial for invalidation has been requested, reasons for the invalidation of those cannot be

conducted ex-officio detection.

If reasons that parties or intervenors did not request are examined, the chief administrative judge must notify the demande (right holder) of the proceedings' result as the reason for invalidation, the demandant and intervenors as the result of ex-officio proceedings and give an opportunity to file opinions, with a reasonable period of time specified. Correspondingly, both parties and intervenors may state opinions on the notified reason for invalidation.

2.2.2 Amendment Rules

(1) Whether request arguments can be modified (and timing)

※Q&A

Q: In a trial for invalidation, is it possible to add evidence to the grounds for invalidation at a later date?

A: As the addition of evidence of grounds for invalidation essentially changes “the facts on which the invalidation of the patent is based” (i.e., the principal facts), this in principle corresponds to an amendment to change the gist of the grounds for the request, and thus is not allowed. However, as stipulated in the proviso of Paragraph 1 of Patent Act Article 131-2 and in Paragraph 2, when it is clear that there is no possibility of unreasonable delay of the proceedings by such amendment and circumstances exist that apply to the items of Paragraph 2 of the same Article, such amendment may be allowed as an exception at the discretion of the chief administrative judge, even when this corresponds to an amendment to change the gist of the grounds for the request.

(2) Allowable claim amendments (types and timing)

Patent Act Article 134-2 (extract): (1) The respondent in a patent invalidation trial may file a request for a correction of the description, claims or drawings attached to the written application only within a period of time that is specified pursuant to paragraph (1) or (2) of the preceding Article, the following Article, Article 153, paragraph (2), or Article 164-2, paragraph (2); provided, however, that the correction is limited to one with the following purposes:

- (i) restriction of the claims;
- (ii) correction of errors or mistranslations;
- (iii) clarification of an ambiguous statement; and
- (iv) rewriting a claim that cites another claim into a claim that does not cite that other claim.

2.2.3 Hearing Formats

(1) Written or oral hearings

Oral proceedings in principle (documentary proceedings are also possible). A trial for invalidation is conducted by oral proceedings. However, the chief administrative judge may change the oral proceedings to documentary proceedings upon a request from concerned parties, intervenors, or ex officio. Nevertheless, after changing the oral proceedings to documentary proceedings, changing it back to oral proceedings is possible. In such a case, a notice of oral proceedings is issued.

A trial for invalidation is basically conducted through oral proceedings, but in the following exceptional cases, documentary proceedings may be allowed.

If a request for a trial or its procedures (a written request for trial) should

be dismissed.

If concerned parties evidently have no intention of arguing with each other.

All the concerned parties (including intervenors) are requesting the documentary proceedings.

Any other cases wherein oral proceedings will not be required.

(2) Availability of remote participation

In accordance with the 2021 amendments to the Patent Law, etc., from October 2021, at the discretion of a chief administrative judge, it has been possible to carry out procedures on the date of the oral proceedings by "a method that enables the parties concerned to communicate while mutually recognizing the status of the other party by sending and receiving images and sounds" (hereinafter referred to as "online") without appearing before the Trial Court (hereinafter referred to as "online appearance").

In the oral proceedings for invalidation trials, etc., parties concerned, etc. can appear online (online appearance) at the discretion of a chief administrative judge.

2.2.4 Procedure Status: Termination, suspension, or resumption conditions

Patent Act Article 168 (extract): (1) If it is found to be necessary during a trial or appeal, the trial or appeal proceedings may be suspended until the ruling on an opposition to a granted patent or the decision from another trial or appeal becomes final and binding or until litigation proceedings conclude.

2.2.5 Outcome Types: Possible conclusions

(1) All requests of the demandant are permitted (with regard to patents and

utility models, the patent (or utility model registration) relating to all claims for which the demandant requested are invalidated).

(2) Part of the requests of the demandant are permitted (with regard to patents and utility models, the patent (or utility model registration) relating to a part of the claims for which the demandant requested are invalidated, but other claims are not subject to invalidation).

(3) None of the requests of the demandant is permitted (with regard to patents and utility models, the patent (or utility model registration) relating to all the claims for which the demandant requested are not invalidated).

(4) The request for a trial is dismissed.

2.2.6 Legal Effects of Invalidation

When the trial decision for invalidation is final and binding, the right is considered not to have existed from the beginning (the Patent Act Article 125; the Utility Model Act Article 41).

2.2.7 Foreign applicant: Eligibility and special requirements

Need an agent. When an overseas resident performs procedures without a patent administrator, said procedures are deemed inappropriate and dismissed (Patent Act Articles 18-2, 133-2, 135, Utility Model Act Article 41).

2.3 Opposition to grant of patent

2.3.1 Key Process Elements

(1) Minimum Request Unit: Single claim

(2) Applicant Eligibility: Any persons (no anonymous person)

(3) Time Limits: Deadlines for submission (and extension possibilities)

Any person may file to the Commissioner of the Patent Office an

opposition to grant of patent within six months from the publication date of the patent gazette containing the patent. An opposition to grant of patent that has been filed during the period other than the said period, or an opposition to grant of patent that has been filed within said period but after the lapse of the patent right is deemed to be an unlawful opposition which may not be corrected by an amendment, and therefore shall be dismissed by a decision by a panel.

(4) Official Fees: ¥16,500 + ¥2,400 per claim

(5) Examination Scope: What will be reviewed and Common Grounds for Requests

Reasons of public interest (lack of novelty, lack of inventive step, violation of description requirements, etc.)

Patent Act Article 113

Any person may file with the Commissioner of the Japan Patent Office an opposition to a granted patent on the grounds that a patent falls under any of the following items, no later than six months from the publication of a gazette containing the patent, and if a patent has two or more claims, an opposition to a granted patent may be filed for each claim:

- (i) the patent has been granted on a patent application (excluding a foreign-language application) with an amendment that does not comply with the requirements provided in Article 17-2, paragraph (3);
- (ii) the patent has been granted in violation of Articles 25, 29, 29-2, or 32, or Article 39, paragraphs (1) through (4);
- (iii) the patent has been granted in violation of a treaty;
- (iv) the patent has been granted on a patent application not complying with

the requirements provided in Article 36, paragraph (4), item (i) or Article 36, paragraph (6) (excluding item (iv) of that paragraph); or (v) matters stated in the description, claims or drawings attached to the foreign-language application are not within the scope of matters stated in foreign-language documents.

Reasons that have not been pleaded by an opponent may also be examined ex officio (Patent Act Article 120-2 (1)) and evidence that has not been pleaded by an opponent may also be adopted by a panel.

2.3.2 Amendment Rules

(1) Whether request arguments can be modified (and timing)

Amendment in Opposition to Grant of Patent (Written Opposition)

○ Amendment in General

A written opposition shall contain the subject of the opposition (an opponent), the object (indication of a patent, i.e. patent number and claims, relating to the opposition), reasons for the opposition, and supporting evidence. The written opposition may be amended at any time but shall not change its gist.

○ Concrete Approach

A. Amendment of the subject (opponent)

An amendment of the subject (opponent) of an opposition to grant of patent is deemed to be a change of the gist if the identity of the opponent is lost. An amendment of errors of description in such a way that its subject remains identical is not deemed to be a change of the gist.

B. Amendment of the object (patent number and claims)

An amendment of the object (patent number and claims) of an opposition

to grant of patent is deemed to be a change of the gist if the identity of the patent number and claims is lost. However, even though deletion of claims as the subject of an opposition is deemed to be a change of the gist per se, it can be handled in the same manner as withdrawal of claims covered by an opposition and therefore it is not deemed to be a change of the gist until notice of reasons for revocation is issued, on an exceptional basis.

C. Amendment of reasons and evidences

Concerning an amendment of reasons for opposition to grant of patent and evidence, even if the gist thereof is changed, addition or change of reasons or evidence shall be possible on an exceptional basis until the earlier of the expiration of an opposition period or the time of notice of reasons for revocation (provision to Patent Act Article 115 (2)) .

After that, an amendment shall be possible only within the scope without changing the gist of a written opposition.

(2) Allowable claim amendments (types and timing)

A patentee may file a request for correction of the description, scope of claims, or drawings attached to the application. A time limit in which a request for correction may be filed is a time limit for submitting a written opinion as designated in a notice of reasons for revocation (normally 60 days, or 90 days for overseas residents) (Patent Act Article 120-5 (1)).

2.3.3 Hearing Formats

Documentary proceedings (no oral proceedings).

2.3.4 Procedure Status: Termination, suspension, or resumption conditions

Patent Act Article 168 (extract): (1) If it is found to be necessary during a

trial or appeal, the trial or appeal proceedings may be suspended until the ruling on an opposition to a granted patent or the decision from another trial or appeal becomes final and binding or until litigation proceedings conclude.

2.3.5 Outcome Types: Possible conclusions

(1) Decision to Revoke

(2) Decision to Maintain

(3) The Case Where a Request for Correction Has Been Filed

When a request for correction has been filed for the description, scope of claims or drawings attached to the application and said correction is approved, said grant shall be indicated in the conclusion of the decision on an opposition to the grant of a patent and reasons for said grant shall be described in the reasons for the decision.

When said request for correction is rejected, said rejection and reasons for said rejection shall be described in the “reasons for a decision” without stating said rejection in the “conclusion of the decision.”

When a request for correction for deletion of a part of the claims has been filed, and said request is approved and there is no subject to the opposition, it shall be described that the request for opposition to deleted claims shall be dismissed.

When all of the claims covered by an opposition to grant of patent have been deleted by a request for correction, there is no subject of the opposition so that said request for correction shall be approved and the opposition shall be dismissed.

2.3.6 Foreign applicant: Eligibility and special requirements

Need an agent. When an overseas resident performs procedures without a patent administrator, said procedures are deemed inappropriate and dismissed (Patent Act Articles 18-2, 133-2, 135, Utility Model Act Article 41).

2.4 Trial for correction

2.4.1 Key Process Elements:

(1) Applicant Eligibility

The requester shall be a patentee (the Patent Act Article 126 (1)).

When a request is filed by joint owners of a patent right for the right under joint ownership, all said joint owners shall jointly file the request (the Patent Act Article 132 (3)).

(2) Time Limits: Deadlines for submission (and extension possibilities)

A patentee may file a request for a trial for correction after the registration of the patent right's establishment. However, such request may not be filed from the time when an opposition to grant of patent or a trial for invalidation has become pending before the Japan Patent Office to the time a decision on the opposition or a trial decision has become final and binding. Similarly, when an opposition to grant of patent or a trial for invalidation has been filed only with regard to part of claims, a request for a trial for correction may not be filed.

(3) Official Fees: ¥49,500 + ¥5,500 per claim

(4) Examination Scope: What will be reviewed and Common Grounds for Requests

The panel shall determine whether a request of a trial for correction meets the requirements stipulated under the Patent Act Article 126 on the basis of

a written request for trial and the statement in the description, claims, or drawings attached thereto. Where a request for a trial for correction is filed for each claim (or each group of claims), the correction is judged for each claim (or each group of claims).

2.4.2 Amendment Rules

(1) Whether request arguments can be modified (and timing)

A. In a trial for correction, amendment to a written request may be made (the Patent Act Article 17 (1)) until a notice of the proceedings' conclusion is issued (the Patent Act Article 156 (1)), or until further notice of the proceedings' conclusion is issued in the case of the resumption of the proceedings (the Patent Act Article 156 (3)).

B. Where the gist of the request is changed as per the said amendment; for example, a correction item has been added by the amendment, such an amendment may not be adopted.

Any amendment to a written request for a trial shall not change the gist thereof (the Patent Act Article 131-2 (1)). A change in the gist refers to a case wherein the identity or scope of the “statement for a trial” on which the request is based, is changed by amending the description of the purport of the request (the correction item) among items described in the written request for the trial.

(2) Allowable claim amendments (types and timing)

Requirements for correction in relation to the description, claims or drawings attached by the patentee to an application is provided in Patent Act Article 126.

Purpose of a correction is to defend against a possible attack in a trial for

invalidation, etc. by eliminating defect(s) from a part of the patent in advance. In order to accomplish such purpose, correction of minimum scope of claims is enough. Therefore, a correction shall be limited to those intended for the following purposes(Patent Act Article 126 (1), 1993 Supplementary Provisions Article 4 (2), Former Utility Model Act Article 39 (1)):

- ① restriction of the scope of claims (proviso (i)) ;
- ② correction of an error or mistranslation (proviso (ii)) ;
- ③ clarification of an ambiguous statement (proviso (iii)) ; and
- ④ dissolution of the citation relation between claims (rewriting a claim that cites another claim to a claim that does not cite the said other claim) (proviso (iv)).

In addition, a correction must be made within the scope of the matters stated in the description, etc. attached to an application , and must not substantially enlarge or alter the scope of claims. The invention defined by what is stated in the scope of claims after the correction must be one that is independently patentable upon the filing of the patent application.

2.4.3 Hearing Formats

A trial for correction shall be conducted by documentary proceedings. However, the chief administrative judge may—upon a motion by a party concerned or ex officio—decide to conduct a trial by oral proceedings (the Patent Act Article 145 (2)).

2.4.4 Procedure Status: Termination, suspension, or resumption conditions

Patent Act Article 168 (extract)

(1) If it is found to be necessary during a trial or appeal, the trial or appeal proceedings may be suspended until the ruling on an opposition to a granted patent or the decision from another trial or appeal becomes final and binding or until litigation proceedings conclude.

2.4.5 Outcome Types: Possible conclusions

- (1) Approval of the request (The correction is allowed);
- (2) Partial approval of the request (Part of the correction is allowed);
- (3) Disapproval of the request (The correction is not allowed);
- (4) Dismissal of the request.

2.4.6 Foreign applicant: Eligibility and special requirements

Need an agent. When an overseas resident performs procedures without a patent administrator, said procedures are deemed inappropriate and dismissed (Patent Act Articles 18-2, 133-2, 135, Utility Model Act Article 41).

3. Subsequent Judicial Procedures

In the case where the party is not satisfied with the decision of the Trial and Appeal Department (TAD), the party may make a revocation action against the decision with the IP High Court.

4. Request Submission Process

4.1 Submission Channels

From January 2024, procedures for a written demand for invalidation trial or a petition for opposition may also be submitted by means of electronic data processing systems (Enforcement Regulations of the Act on Special

Provisions for Procedures Related to Industrial Property Right Article 13(2)(3)). These procedures are called “special electronic applications”. For details, refer to the JPO’ website: “Digitalization of application procedures

(https://www.jpo.go.jp/system/laws/sesaku/shinsei_digitalize.html)” and “Special electronic applications in trial/appeal proceedings (https://www.jpo.go.jp/system/trial_appeal/shinpan_digitalize.html)”.

In principle, the procedures for an appeal against an examiner's decision of refusal and an appeal against the examiner's decision to dismiss amendment are carried out by means of electronic data processing systems. As stated in the above, the procedures for a demand for invalidation trial and a petition for opposition may be carried out by means of electronic data processing systems (special electronic applications) in addition to a written or documentary procedures. Each section of this Manual for Trial and Appeal Proceedings shows submission of a duplicate, etc. in writing, however, there is no need to provide a duplicate to the other party and for the proceedings when electronic data processing systems are used for the procedures (Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 10-3).

4.2 Online Portals: Links to e-filing platforms

<https://www.pcinfo.jpo.go.jp/site/index.html>

4.3 Required Documents: Standard materials (e.g., request forms, evidence)

4.3.1 Appeal against examiner's decision of refusal

(1) General

A. A person who files a request for appeal against examiner's decision of refusal should submit a written request for appeal satisfied with the formal requirements under Patent Act Article 131 (Enforcement Regulations Under the Patent Act Article 46 (Form 62)).

B. Required items and formality of a written request

(2) Purport of the request (Patent Act Article 131(1)(iii))

A. A purport of the request indicates what kind of appeal decision an appellant seeks for and should specify a patent application subject to the request.

B. An item "Purport of Request" generally describes "The original decision shall be revoked. An appellant seeks the appeal decision that the present invention of the case should be patented."

(3) Grounds for the request (Patent Act Article 131(1)(iii))

A. Grounds for the request describe the grounds for revocation of the decision of refusal corresponding to the purport of the request.

B. An item "Grounds for Request" describes a history and points of the grounds for the decision of refusal, and grounds for revocation of the decision of refusal concretely and clearly.

C. When the specification, claims or drawings are amended with submission of a request for appeal, describe the grounds for revocation of the decision of refusal based on the amended specification, claims and drawings.

D. An appeal against examiner's decision to dismiss amendment of the patent application made at the examination stage may be instituted together at filing an appeal against examiner's decision of refusal (Patent Act

Article 121) (Patent Act Article 53 (3)).

An appeal against examiner's decision to dismiss amendment made at the appeal stage may be instituted at a suit rescinding the appeal decision of the appeal against examiner's decision of refusal (Patent Act Article 178) (Patent Act Article 159(1)).

E. When an appeal against examiner's decision to dismiss amendment made in the examination is filed and no amendment is made for the specification, claims, or drawings at requesting an appeal, describe a dissatisfaction of an appellant with the decision, and grounds for revocation of the decision to dismiss the amendment, and then describe grounds for revocation of the decision of refusal based on the amended specification, claims and drawings.

F. When an appeal against examiner's decision to dismiss amendment made in the examination is filed and an amendment is made for the specification, claims, or drawings, describe the grounds for revocation of the decision of refusal based on the amended specification, drawings and drawings made at the requesting an appeal. An amendment at filing a request for appeal is made for the specification, claims, or drawings which are subject to the decision of refusal. Matters dissatisfied with the decision to dismiss amendment are required to include in the amendment at filing a request for appeal. Namely, when the amendment same as one dismissed is made, a written amendment with the same content shall be submitted.

4.3.2 Trial for invalidation

Patent Act Article 131 (extract)

(1) A person filing a request for trial or appeal must submit a written

request stating the following to the Commissioner of the Japan Patent Office:

- (i) the name, and the domicile or residence of the party and the agent thereof;
- (ii) an indication of the trial or appeal case; and
- (iii) the object and grounds of the claim.

(2) When a request for a patent invalidation trial is filed, the grounds for the request that are set forth in item (iii) of the preceding paragraph must concretely identify the facts that are the basis invalidating the patent and must state the relationship of each fact that needs to be proved to the evidence.

4.3.3 Opposition to grant of patent

Patent Act Article 115(1) (extract)

A person that files an opposition to a granted patent must submit to the Commissioner of the Japan Patent Office a written opposition to grant of patent stating the following matters:

- (i) the name, and domicile or residence of the person filing an opposition and the patent opponent's representative;
- (ii) an indication of the patent related to the opposition to a granted patent; and
- (iii) an indication of the grounds and the necessary evidence for the opposition to a granted patent.

4.3.4 Trial for correction

(1) General matters

A. A person filing a request for a trial for correction shall submit a written

request complying with formal requirements (the Patent Act Article 131(1),(3)); Enforcement Regulations under the Patent Act Article 46, Form 62).

B. The duplicates of a written request, attached documents, and an evidence (drawing, sample, and model in the case of an object to be inspected) shall be submitted for proceedings (Enforcement Regulations under the Patent Act Article 50-4; Enforcement Regulations under the Patent Act Article 50(2), (3)).

(2) Purport of a request (the Patent Act Article 131 (1)(iii))

(3) Reasons for a request (the Patent Act Article 131 (1)(iii); the Patent Act Article 131(3); Enforcement Regulations under the Patent Act Article 46-3)

(4) Documents attached to a written request

Where there is an exclusive licensee, a pledgee, or a specific non-exclusive licensee (i.e., a person has the right to a non-exclusive license on an invention in service), the patentee shall submit a document proving the consent of said person(s) for the correction (the Patent Act Article 127; Enforcement Regulations under the Patent Act Article 6). In the absence of the submission, the written request for a trial shall be dismissed (the Patent Act Article 133 (3)).

(5) Fees

5. Additional Resources

Manual for Trial and Appeal Proceedings

https://www.jpo.go.jp/e/system/trial_appeal/sinpan-binran.html

Questions and Answers about Trial and Appeal System

https://www.jpo.go.jp/e/system/trial_appeal/faq.html

Laws

<https://www.jpo.go.jp/e/system/laws/rule/index.html>

Handbook for Trial and Appeal System in Japan

[https://www.jpo.go.jp/e/resources/report/sonota-info/document/pamphlet/s
hinpan_gaiyo_e.pdf](https://www.jpo.go.jp/e/resources/report/sonota-info/document/pamphlet/s
hinpan_gaiyo_e.pdf)

Korea Trial and Appeal Procedures

1. Institutional Information

1.1 Name of Trial and Appeal Authorities

The Korean Intellectual Property Trial and Appeal Board (IPTAB)

1.2 Website links and public contact details

Website: <https://www.kipo.go.kr/>, <https://www.kipo.go.kr/iptab/>

Tel: +82-42-481-8207

Fax: +82-42-472-3474

Address: Daejeon Government Complex, Civil Service Building, 189
Cheongsu-ro, Seo-gu, Daejeon, Republic of Korea

1.3 Group Tour and Observation of Oral Hearings



IPTAB welcomes a group tour to encourage people to learn more about IPTAB and to have more interest in patent trials and appeals. Almost all oral hearings at the IPTAB are open to public for observation and anyone can attend the public hearings upon prior request. Please visit the IPTAB website at <https://www.kipo.go.kr/ipt/> to request a group tour and observation of oral hearings.

1.4 Overview of Trial and Appeal System

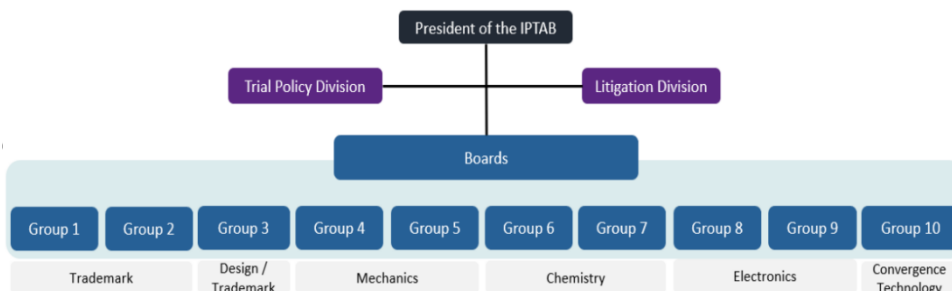
The IPTAB is a quasi-judicial body which has independently operated within the Korean Intellectual Property Office (KIPO) since 1 March, 1998. The Board reviews adverse decisions made by examiners called *ex parte* appeals and also adjudicates disputes over the validity of issued IP rights called *inter partes* trials.

Since its operation, the Board has strived to expand its pool of qualified administrative judges and help them to develop their capabilities and competencies. Furthermore, it also aims to provide transparent, effective and streamlined proceedings.

1.5 Organization of the IPTAB

As shown in the organizational chart below, the IPTAB consists of Boards (36), a trial policy division and a litigation division under the leadership of the President of the IPTAB. Each Board is managed by a chief presiding administrative judge and hears and decides trial and appeal cases in different technical fields. Trial policy division is a Board operations division which supports and administers proceedings and hearings and also conducts formality examination, trial quality evaluation, etc. Litigation Division defends The IPTAB decisions before the Court for cases in which

the Commissioner of the KIPO is the defendant.



In the majority of cases, a case is reviewed in a composition of 3 administrative judges, consisting of the chairperson, rapporteur and an additional member. A panel of judges shall deliberate regarding the decision to be taken. An expanded panel of 5 judges, may hear and decide the case where appropriate, including cases involving issues that span a number of technical fields, cases with legal/technical difficulty and/or importance.

2. General Information on Trials and Appeals

2.1 Types of Trials and Appeals

A. *Ex Parte* Proceedings

<Patent>

Appeal against examiners' decision to reject patent/utility model application, etc. (Article 132-17 of the Patent Act, Utility Model Act 33)

If a person has an objection to an examiner's decision to reject a patent application or to a decision to reject an application to register an extended term of a patent, he/she may file an appeal within three months from the

date when he/she is served with a certified copy of the examiner's decision. An exception may apply in cases where a person resides in an area that is remote or difficult to access. In such cases, the Commissioner of KIPO may extend the period to two months.

Re-examination (Patent Act Article 67-2, Utility Model Act 15)

With respect to a patent application filed on or after July 1, 2009, an applicant may request re-examination or file an appeal, following an adverse decision made by an examiner. A patent applicant may file a request to re-examine his/her patent application after amending the specification or drawings of the patent application within three months after receipt of a certified copy of the decision to reject the patent application; however, an applicant is not allowed to request a re-examination once a petition for trial is filed.

Trial for Correction (Patent Act Article 136, Utility Model Act 33)

A patent holder may file a petition for trial to correct specifications or drawings in any of the following cases:

- to narrow a claim;
- to correct a clerical error; or
- to clarify an ambiguous description.

However, this shall not apply when a patent opposition is pending before the IPTAB.

Trial for correction is intended to protect a patent invention by providing an opportunity for a patentee to make corrections under the condition that there are no unexpected losses or damages caused to any third parties.

When a trial decision to correct specifications 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 or trial ruling to grant a patent, and the registration of the grant of the patent have been made according to the corrected specification or drawings.

<Trademark>

Appeal against Examiners' Decision to Reject Trademark Application (Trademark Act Article 116)

Where a person receives a decision to reject trademark registration, decision to reject registration of additional designated goods, or decision to reject registration of the conversion of the classification of goods, he/she may request an appeal within three months from the date he/she is served with a certified copy of such decision to reject.

<Design>

Appeal against Examiners' Decision to Reject Applications for Design Registration or to Cancel Design Registration (Design Protection Act Article 120)

A person who is dissatisfied with any decision to reject an application for design registration or a decision to cancel the registration of a design may file a petition within three months from the date the person is served with a certified copy of such decision.

Re-examination (Design Protection Act Article 64)

With respect to a design application filed on or after July 1, 2009, an applicant may make a request for re-examination or trial, selectively, following a decision of rejection.

An applicant may file a request to re-examine his/her application after

amending the specification or drawings of the application within three months from receipt of a certified copy of the decision to reject the application; however, an applicant is not allowed to request a re-examination once a petition for trial is filed.

Appeal against Examiners' Decision to Dismiss Amendment (Design Protection Act Article 119)

A person who is dissatisfied with a decision to dismiss an amendment under Article 49 (1) may file an appeal within three months from the date he/she is served with a certified copy of such decision.

B. *Inter Partes* Proceedings

<Patent>

Trial for Invalidation (Patent Act Article 133, Utility Model Act 31)

There may be some patents which should not have been granted. In such cases, an interested party or an examiner may request a trial to review the validity of an issued patent. For a patent containing two or more claims, a request for trial for invalidation may be made for each claim.

Grounds for invalidation are generally the same as the grounds for rejection of a patent application.

A trial for invalidation may be requested even after the expiration of the patent right. Where a trial decision to invalidate a patent becomes final and conclusive, the patent right shall be deemed never to have existed; however, where a patent is invalidated by any reason that arose after the granting of a patent, the patent right is deemed not to have existed from the time when such reason originated.

Trial to Invalidate Registration for Extension of Patent (Patent Act Article

134)

An interested party or examiner may request a trial to invalidate the registration of an extension of a patent right.

Trial to Confirm the Scope of Rights (Patent Act Article 135, Utility Model Act 33)

A patentee or an interested person may request a trial to confirm the scope of a patent right. When filing a petition to confirm the scope of at least two claims in a patent, a petition may be filed for each claim.

Trial to Invalidate Corrections (Patent Act Article 137, Utility Model Act 33)

An interested party or examiner may request a trial to invalidate corrections, where the specifications or drawings of a patented invention have been corrected in violation of Article 136.

When a decision to invalidate corrections of specifications or drawings becomes final and conclusive, the correction shall be deemed never to have been made.

Trial for Grant of Non-exclusive Licenses (Patent Act Article 138, Utility Model Act 32)

When a patentee requires the use of the patent right of a prior patentee to operate his/her patented invention, or when a prior patentee refuses to grant permission to use the patent right without justifiable reasons, he/she may request a trial for grant of a non-exclusive license. To make a such request, it is required that the patented invention of the later patentee should constitute a substantial technical advance in comparison with the patented invention or registered utility model of the prior patentee.

<Trademark>

Trial to Invalidate Trademark Registration (Trademark Act Article 117)

There may be some trademarks which should not have been granted. In such cases, an interested party or an examiner may request a trial to invalidate such trademark registrations. Where at least two designated goods bearing the registered trademark exist, he/she may request a trial to invalidate the relevant trademark registration for each designated goods.

Grounds for invalidation are generally the same as the grounds for rejection of a trademark application.

A trial to invalidate a trademark may be requested even after the trademark rights are extinguished. Where a trial decision to invalidate a trademark registration becomes final and conclusive, trademark rights shall be deemed never to have existed; however, where a trademark registration is invalidated by any reason that arose after the granting of a trademark, the trademark right is deemed not to have existed from the time when such reason originated.

Trial to Invalidate Registration to Renew Duration of Trademark Rights (Trademark Act Article 118)

Where registration to renew the duration of trademark rights falls under any of the following, an interested party or an examiner may request a trial to invalidate such renewal registration. In such cases, where at least two designated goods bearing a registered trademark renewed exist, he/she may request a trial to invalidate such renewal registration for each of the designated goods:

1. Where registration to renew the duration of trademark rights violates

Article 84(2);

Article 84(2): An application to register the renewal of the duration of trademark rights shall be filed within one year prior to the expiry of the duration of trademark rights: Provided, That any person who fails to apply for registering the renewal of the duration of trademark rights within this period may apply for registering the renewal of the duration of trademark rights within six months after the duration of trademark rights expires.

2. Where a person who is not the relevant trademark right holder files an application to register the renewal of the duration of the trademark rights.

A trial to invalidate registration to renew the duration of trademark rights may be requested even after the trademark rights are extinguished.

Where a trial decision to invalidate registration to renew the duration of trademark rights becomes final and conclusive, such renewal registration shall be deemed never to have existed.

Trial to Revoke Registration of Exclusive License or Non-Exclusive License (Trademark Act Article 120)

Where an exclusive licensee or a non-exclusive licensee commits an act falling under Article 119(1)2, the trademark right holder may request a trial to revoke registration of such exclusive or non-exclusive license.

Article 119(1)2: Where an exclusive licensee or a non-exclusive licensee causes the misunderstanding of the quality of goods or confusion with goods related to another person's business by using a registered trademark or a trademark similar to the registered trademark on the designated goods, or goods similar to the designated goods: Provided, That the foregoing shall not apply where the trademark right holder pays considerable

attention.

Even if a fact that constitutes grounds for requesting a trial to revoke registration of an exclusive license or a non-exclusive license ceases to exist after the trademark right holder files such trial, the absence thereof shall not affect the grounds for cancellation.

Trial to Invalidate Registration of Conversion of Classification of Goods (Trademark Act Article 214)

Where registration of the conversion of the classification of goods falls under any of the following, an interested party or an examiner may request a trial to invalidate registration thereof. In such cases, where at least two designated goods relating to registration of the conversion of the classification of goods exist, a trial may be requested for each of the designated goods:

1. Where non-designated goods bearing the relevant trademark are registered for the conversion of the classification of goods, or the scope of designated goods has been substantially extended;
2. Where registration of the conversion of the classification of goods is obtained through an application filed by a person who is not the holder of the relevant registered trademark;
3. Where registration of the conversion of the classification of goods violates Article 209 (3).

Article 209(3): An application for registration of the conversion of the classification of goods shall be filed from one year before the duration of trademark rights expires for a period not exceeding six months after the duration of trademark rights expires.

Where the trial decision to the effect that registration of the conversion of the classification of goods is invalidated becomes final and conclusive, the relevant registration of the conversion of the classification of goods shall be deemed never to have existed.

Trial to Confirm the Scope of Trademark Rights (Trademark Act Article 121)

A trademark right holder, an exclusive licensee, or an interested party may request a trial to confirm the scope of trademark rights. In such cases, where at least two designated goods bearing the registered trademark exist, any of the aforesaid persons may request a trial to confirm the scope of rights for each of the designated goods.

Trial to Cancel Trademark Registration (Trademark Act Article 119)

Where a registered trademark falls under any of the following, a trial to cancel the trademark registration may be requested:

1. Where a trademark right holder causes the misunderstanding of the quality of goods or confusion with goods related to another person's business among consumers by willfully using a trademark similar to the registered trademark on the designated goods, or using the registered trademark or a similar trademark on goods similar to the designated goods;
2. Where an exclusive licensee or a non-exclusive licensee causes the misunderstanding of the quality of goods or confusion with goods related to another person's business by using a registered trademark or a trademark similar to the registered trademark on the designated goods, or goods similar to the designated goods: Provided, That the foregoing shall not apply where the trademark right holder pays considerable attention;

3. Where none of a trademark right holder, an exclusive licensee or a non-exclusive licensee has used the registered trademark on the designated goods in the Republic of Korea for at least three consecutive years without justifiable grounds before a trial to cancel the registered trademark is requested;
4. Where the registered trademark violates Article 93(1), (2), and (4) through (7) (transfer and joint ownership of trademark rights);
5. Where similar registered trademarks belong to different respective trademark right holders due to the transfer of the trademark rights, and one of them causes the misunderstanding of the quality of goods or confusion with goods related to another person's business among consumers by using his/her trademark on goods identical or similar to the designated goods bearing his/her trademark for the purpose of unfair competition;
6. Where a person who has the right to the registered trademark which constitutes an act of unfair competition requests a trial to revoke the trademark registration within five years from the date the relevant trademark is registered; Where the use of the registered trademark;
7. Where a collective mark falls under any of the following:
 - (a) Where a member of the organization allows another person to use its collective mark in violation of its articles of incorporation, or causes the misunderstanding of the quality of goods or the source of a geographical indication, or confusion with goods related to another person's business among consumers by using its collective mark in violation of its articles of incorporation: Provided, That the foregoing shall not apply where the holder of the collective mark right pays due attention to supervising its

members;

(b) Where the organization is likely to cause misunderstanding of the quality of goods or confusion with goods related to another person's business among consumers by amending its articles of incorporation under Article 36 (3) after it registers its collective mark and establishes its collective mark right;

(c) Even where a third party causes the misunderstanding of the quality of goods or the source of a geographical indication, or confusion with goods related to another person's business among consumers by using its collective mark, the holder of the collective mark right willfully fails to take appropriate measures;

8. Where a collective mark with geographical indication falls under any of the following:

(a) In cases of an application for registration of a collective mark with geographical indication, where the articles of incorporation of the organization actually prevents its members from joining the organization, such as prohibiting them from joining the organization or stipulating impracticable conditions for joining the organization, or allow a person ineligible to use such geographical indication to join the organization;

(b) Where the holder of a collective mark right with geographical indication or a member of the organization causes the misunderstanding of the quality of goods or confusion on the source of the geographical indication by using the collective mark in violation of Article 223;

9. Where a certification mark falls under any of the following:

(a) Where the holder of the certification mark right permits the use of the

certification mark, in violation of the articles of incorporation or the rules submitted pursuant to Article 36 (4);

(b) Where the holder of the certification mark right uses the certification mark on his/her own goods, in violation of the proviso to Article 3(3);

(c) Where a person permitted to use the certification mark right allows another person to use such mark, in violation of the articles of incorporation or the rules, or causes confusion concerning the quality of goods, the place of origin, methods of production or other characteristics among consumers by using the certification mark in violation of the articles of incorporation or the rules: Provided, That the foregoing shall not apply where the holder of the certification mark right pays due attention to supervise any person permitted to use the certification mark;

(d) Where the holder of the certification mark right fails to take appropriate measures even though he/she is aware that a third party who fails to obtain permission to use the certification mark causes confusion concerning the quality of goods, the place of origin, methods of production or other characteristics among consumers by using the certification mark;

(e) Where the holder of the certification mark right actually prevents a person eligible to use the certification mark right from using the certification mark right without justifiable grounds in accordance with the articles of incorporation or the rules, or stipulates impracticable conditions for using the certification mark right in the articles of incorporation or the rules.

Any person may request a trial to cancel trademark registration: Provided, That a trial to cancel trademark registration on the grounds that the

registered trademark falls under paragraph (1) 4 and 6 may be requested by an interested person only.

Where a trial decision to cancel trademark registration becomes final and conclusive, such trademark rights shall be extinguished henceforth: Provided, That where the trial decision to cancel the trademark registration on the grounds that the registered trademark falls under paragraph (1) 3 becomes final and conclusive, the trademark rights shall be deemed extinguished on the date the trial is requested.

<Design>

Trial to Invalidate Design Registration (Design Protection Act Article 121)

There may be some design rights which should not have been granted. In such cases, an interested party or an examiner may file a petition for a trial to invalidate the registration of a design. For a design registration containing multiple designs, such petition shall be filed separately for each design.

Grounds for invalidation are generally the same as the grounds for rejection of a design application.

A trial for invalidation may be requested even after the relevant design right is extinguished. Where a trial decision to invalidate a design registration becomes final and conclusive, the design right shall be deemed never to have existed; however, where a design registration is invalidated by any reason that arose after the granting of a design registration, the design right is deemed not to have existed from the time when such reason is originated.

Trial to Confirm the Scope of Design Rights (Design Protection Act

Article 122)

A design right-holder, an exclusive licensee, or any interested party may file a petition a trial to have the scope of the design right confirmed in order to ascertain the extent of protection of the registered design. If a case involves the registration of designs claimed in an application for registration of multiple designs, such petition shall be filed separately for each design.

Trial for Granting Non-Exclusive Licenses (Design Protection Act Article 123)

If a design right-holder, or an exclusive or non-exclusive licensee intends to obtain a license to work a third person's registered design that falls under Article 95 (1) or (2) or a design similar thereto but if the person refuses to grant a license without valid cause or if it is impracticable to obtain such license from the person, the design right-holder or the exclusive or non-exclusive licensee may file a petition for a trial, seeking the grant of a non-exclusive license to the extent necessary to work the registered design or a design similar thereto.

Article 95: (1) If a registered design is a product made by applying another person's registered design or a design similar thereto, patented invention, registered utility model or registered trademark claimed in an application filed earlier than the filing date of the application for registration of the relevant design, or if a design right conflicts with another person's patent right, utility model right, or trademark right claimed in an application filed prior to the filing date of the application for registration of the relevant design, the design right-holder to the relevant registered design, the

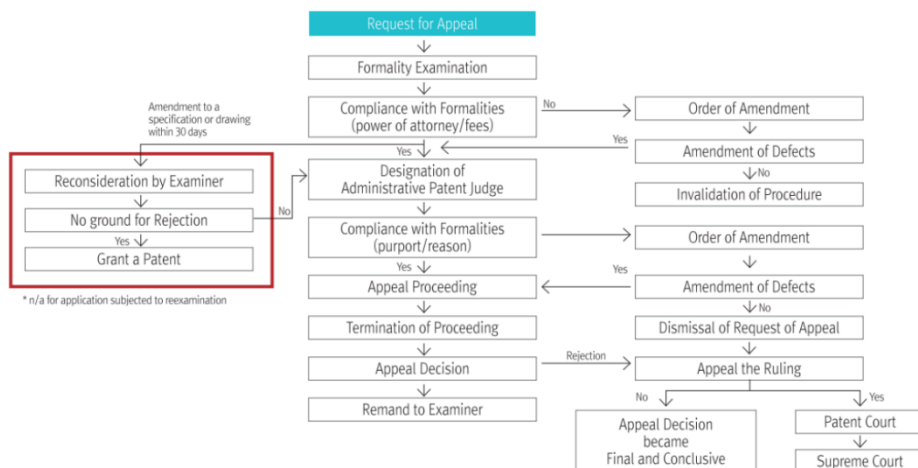
exclusive or non-exclusive licensee for the relevant registered design shall not work the registered design, commercially, without permission from the owner of the relevant design right, patent right, utility model right or trademark right or in breach of Article 123.

(2) If a design similar to a registered design is of a product made by applying another person's registered design or a design similar thereto, patented invention, registered utility model or registered trademark claimed in an application filed earlier than the filing date of the application for registration of the relevant design, or if a design similar to a registered design subject to such design right conflicts with another person's patent right, utility model right, or trademark right under an application filed prior to the filing date of the application for registration of the relevant design, the design right-holder to the registered design, the exclusive or non-exclusive licensee for the registered design shall not work the registered design, commercially, for business without permission from the owner of the relevant design right, patent right, utility model right or trademark right or in breach of Article 123.

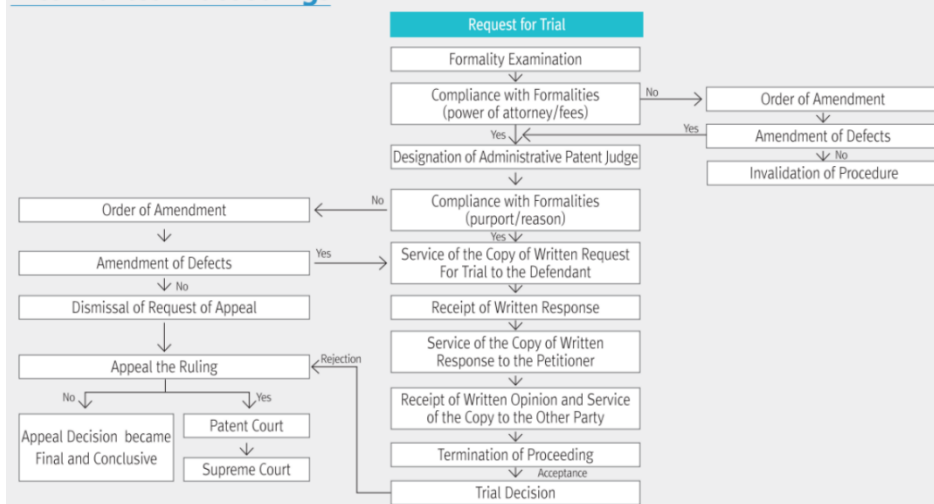
(3) If a registered design or a design similar thereto is of a product made by applying, or conflicting with, another person's copyright that arose earlier than the filing date of the application for registration of the relevant design, the design right-holder to the registered design or a design similar thereto or the exclusive or non-exclusive licensee for the registered design or a design similar thereto shall not work the registered design or design similar thereto, commercially, without permission from the copyright owner.

2.2 Trial and Appeal Proceedings

Ex Parte Proceedings



Inter Partes Proceedings



2.3. Administrators for Foreign-domiciled Applicants

2.3.1. Patent Administrators for Foreign-domiciled Applicants (Patent Act Article 5, Utility Model Act 3)

When a request for a trial is made against a foreign-domiciled applicant (a

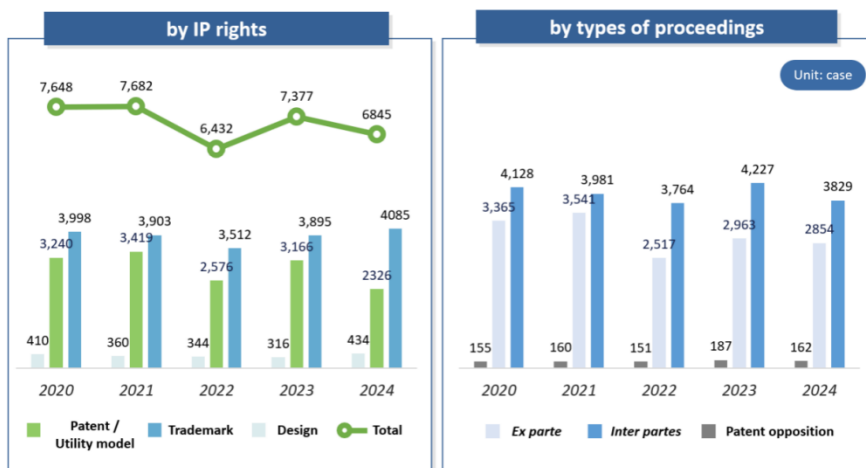
person who has neither a domicile nor a place of business in the Republic of Korea), there may be problems in receiving the copy of the written request for trial and other documents without a patent administrator, and this often causes difficulties, such as the lapse of a right. Therefore, in accordance with the Patent Act Article 5, a foreign-domiciled applicant shall not initiate any patent-related procedure or file legal proceedings, such as application, trial/appeal proceedings, etc., unless he/she is represented by a patent administrator (an agent with respect to his/her patent, who has a domicile or a place of business in the Republic of Korea).

2.3.2 Trademark/Design Administrators for Foreign-domiciled Applicants (Trademark Act Article 6, Design Protection Act Article 6)

When a request for a trial is made against a foreign-domiciled applicant (a person who has neither a domicile nor a place of business in the Republic of Korea), there may be problems in receiving the copy of the written request for trial and other documents without a patent administrator, and this often causes difficulties, such as the lapse of a right. Therefore, a foreign-domiciled applicant, shall not initiate any trademark/design-related procedure or file legal proceedings, such as application, trial/appeal proceedings, etc., unless he/she is represented by a patent administrator (an agent with respect to his/her patent, who has a domicile or a place of business in the Republic of Korea).

2.4 Key Figures for 2024

Filing Trends at the IPTAB in Recent 5 Years



2.5 Trial and Appeal Fees

Appeal fees vary depending on the method of submission of the petition

Submission Type	Patent/Utility Model	Design	Trademark
Electronic documents/written documents	KRW 150,000 /KRW 170,000 per case	KRW 240,000 / KRW 260,000 per design	KRW 240,000 / KRW 250,000 for each class of goods directly related to the grounds for appeal
Additional fee	15,000 KRW per claim	None	If the number of designated goods in one class exceeds 10, an additional fee of KRW 2,000 shall be charged for each excess designated good

However, in the following types of trials proceedings, the fee shall be calculated only with respect to the claims, designs, or class of goods product categories for which the grounds for appeal exist:

Appeal against a decision of refusal of a patent/utility model application;

Appeal against a decision of revocation;

Trial for invalidation;

Trial for confirmation of the scope of rights;

Trial for granting of a non-exclusive license;

Trial for invalidation of an extension of patent right term;

Trial for cancellation of trademark registration;

Trial for invalidation of renewal of trademark right term;

Trial for cancellation of registered trademark license;

Trial for invalidation of product classification registration.

Reduction of Petition Fees:

Individuals (only if the inventor, designer, or creator is the same as the applicant), small or medium-sized enterprises (SMEs) requesting a trial for confirmation of the scope of their own patent rights, etc., shall receive a 70% reduction of the petition fee.

Dedicated organizations shall receive a 50% reduction of the petition fee.

Extension of “Statutory / Designated Period” Fee:

KRW 20,000 for the first extension;

KRW 30,000 for the second extension;

KRW 60,000 for the third extension;

KRW 120,000 for the fourth extension;

KRW 240,000 for the fifth and subsequent extensions.

3. User-friendly IPTAB Proceedings

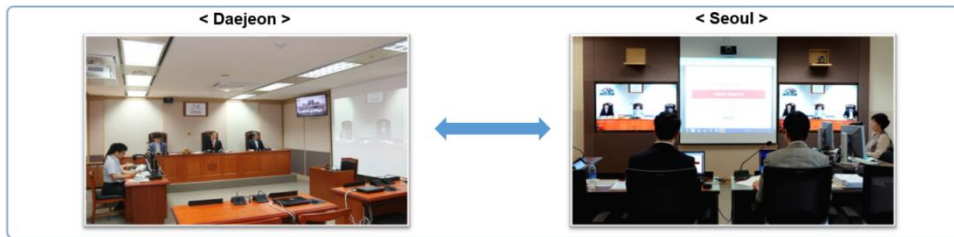
3.1 Remote Oral Hearing

As part of an effort to make the IPTAB's trial services more convenient and accessible, a video-conferencing system was set up for oral hearings in April 2014. The system allows trial parties and patent attorneys to take part in oral hearings remotely at KIPO's Seoul regional office, without having to make a trip to IPTAB Headquarters in Daejeon.

The video-conferencing system connects the IPTAB Headquarters in Daejeon and hearing rooms in Seoul regional office via dedicated network, allowing users to remotely participate in oral hearings. As a result, IPTAB has received a number of positive reviews from the users and patent practitioners in that it helps them to save time and money.

In particular, in response to an increasing demand for remote oral hearings, IPTAB has expanded its hearing facilities by having 2 additional video oral hearing rooms to KIPO's Seoul regional office.

Furthermore, since May 2020, telephonic and video conferences have also been made available for explanatory sessions and interviews with administrative patent judges (APJs) for users' time efficiency and economic considerations.



3.2 Three-track Trial System

To enhance timeliness and efficiency of IPTAB proceedings, the IPTAB has been running three-track proceedings since July 2009.

Under prioritized and accelerated proceedings, IPTAB handles cases which require expedited decisions advanced out of turn.

1. Prioritized proceedings include cases pending before the Court for infringement, cases on investigation of unfair trade practices, cases booked by the police or the prosecution, etc.

- In principle, oral hearings shall be held no later than one month from the date on which the deadline for submitting written reply and a decision shall be rendered no later than two weeks from the oral hearing date.

- In general, when an opportunity to present opinions is not provided for new arguments and evidence, IPTAB has set a target of issuing a decision within three months.

2. Accelerated proceedings include cases revoked by the Court, a trial for invalidation filed by an examiner, etc.

- The IPTAB has set a target of issuing a decision within four months from the case is granted fast-track status, but in practice, final written opinions are filed and a decision is issued within six months in general.

3. Lastly, under a regular track, cases are reviewed and heard in order of

related cases in Court, etc.

A trial for correction initially filed by a right holder for a registered right before the Patent Court closes arguments in a revocation action of invalidation trial or as a trial for correction filed in response to the submission of new evidence of invalidation (including grounds for invalidation); an appeal against a rejection decision for which the later date of three years and six months from the filing date of the patent application (filing date of registration of utility model) and 2 years and six months from the date of requesting examination (excluding a period delayed by applicant under the Article 7-2 of the Enforcement Decree of the Patent Act and Article 54-5 of the Enforcement Rules of the same Act);

< Accelerated proceedings >

Cases concerning a decision to dismiss amendment;

Cases revoked in court revocation action;

Cases in which an examiner files a petition for a trial for invalidation;

An appeal against an examiner's decision to reject application that is filed after a decision to revoke an application for which an appeal against rejection decision was filed in the past;

A trial for correction to only correct the title of the invention (design);

Cases required to be reviewed urgently for the national economy or to prosecute a war, such as providing military supplies, etc.

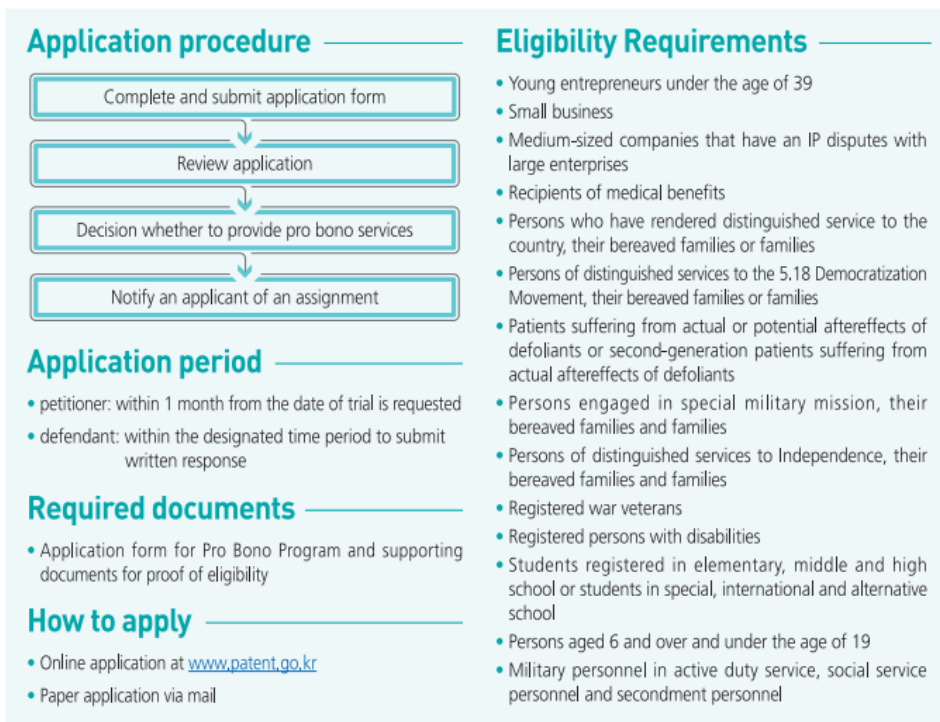
3.3 IPTAB-appointed Attorney

IPTAB strives to ensure fair and impartial trials and appeals by establishing an institutional framework to provide legal assistance for the public good.

The IPTAB launched the IPTAB-appointed attorney program as of July 2019 for trial parties who may not be able to respond properly due to limited financial or human resources. Under this program, IPTAB aims to provide legal assistance free of charge by matching the IPTAB-appointed attorneys with the socially under-represented and financially under-resourced individuals who meet the certain criteria.

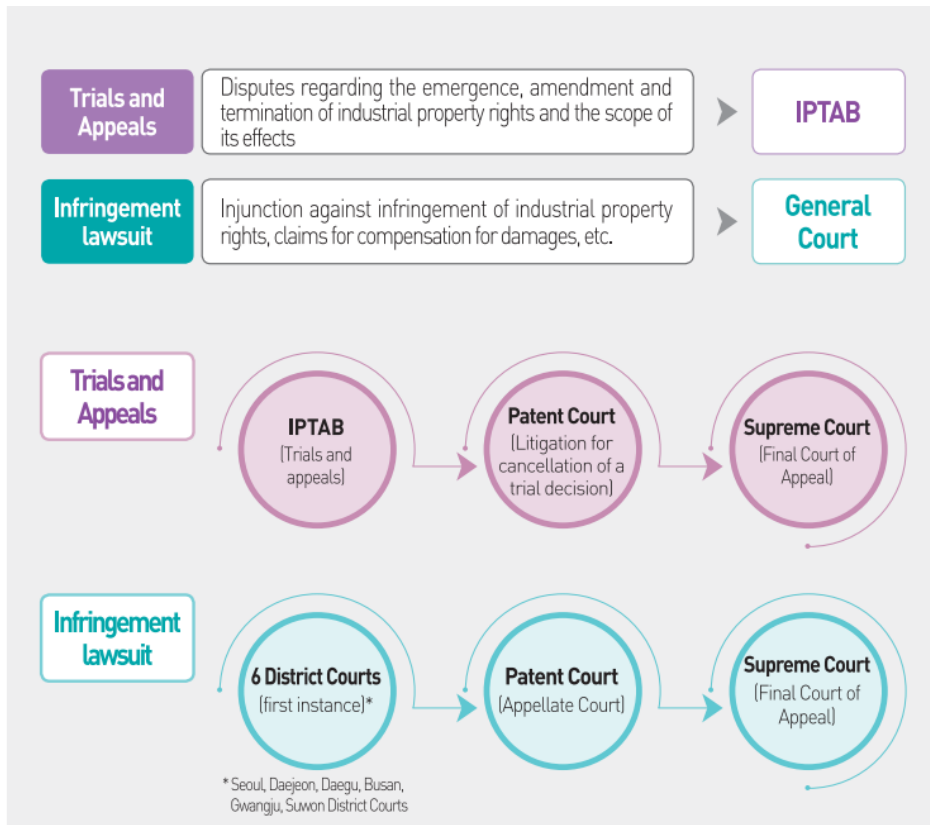
Upon request, IPTAB provides free IP-related legal representation services for groups that meet certain financial thresholds and other qualification criteria listed below, including the recipients of medical benefits, persons with disabilities, financially under-resourced small businesses, etc. In addition, the IPTAB also grants further relief in the form of waiver or reduction of trial fees for those who IPTAB-appointed attorneys are assigned, so that financial support can be further expanded.

To date, more than 20 applicants have received legal assistance every year. It is expected to help facilitate access to patent system and allow socially and financially disadvantaged groups to compete and respond to IP disputes in a fair and equitable manner.



4. Litigation Process of Appealing IPTAB Decisions

An applicant who is dissatisfied with the final decision of the IPTAB may appeal the Board's decision to the Patent Court, which is an IP specialized high court in Korea. An appeal against a decision of the Patent Court shall then be made to the Supreme Court. It therefore can be construed that, in practice, the IPTAB acts as the court of first instance for IP cases.



5. Additional Resources

https://www.kipo.go.kr/en/HtmlApp?c=30300&catmenu=ek03_07_01

Brochure

https://www.kipo.go.kr/en/HtmlApp?c=30300&catmenu=ek03_07_01

Patent Examination Guidelines (2023 EN)

Patent Reexamination and Invalidation Procedure in China

1. Institutional Information

1.1 Name of Trial and Appeal Authorities

Reexamination and Invalidation Department of the Patent Office, CNIPA

1.2 Website links and public contact details

<https://www.cnipa.gov.cn/col/col2632/index.html>

Tel: +86-10-62356655

Postal Address:

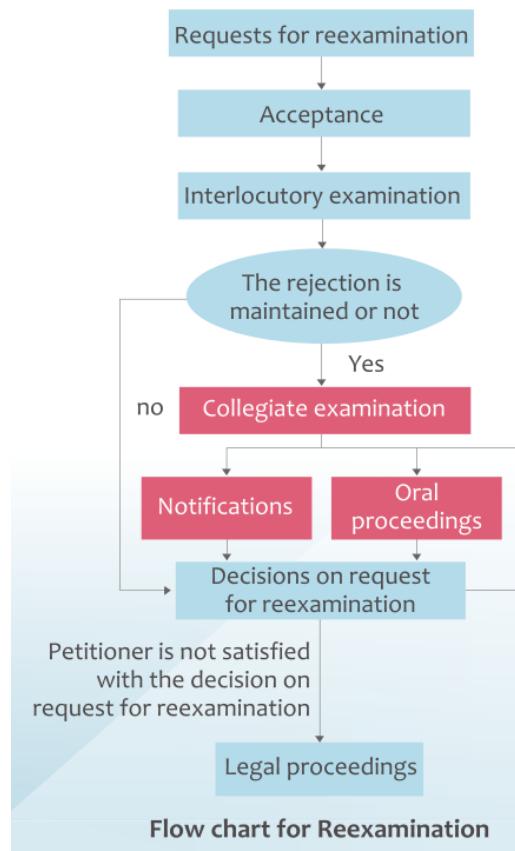
Patent Reexamination and Invalidation Department,
China National Intellectual Property Administration,
No.6, Xitucheng Road, Haidian District, Beijing, P.R.China

Address:

Patent Reexamination and Invalidation Department,
Building 2,
China National Intellectual Property Administration,
Zhuxinzhuang Middle Road, Changping District, Beijing, P.R.China

2. Basic Procedures

2.1 The following aspects of Reexamination procedure



2.1.1 Key Process Elements

(1) Object

A request for reexamination may be filed against a decision rejecting an application in both the preliminary examination and substantive examination proceedings.

(2) Applicant Eligibility: Qualifications for filing requests

The applicant whose application is rejected.

If there is a co-applicant, all applicants need to submit the request for

reexamination.

(3) Time Limits: Deadlines for submission and extension possibilities

Within three months from the date of receipt of the decision on rejecting the application.

The time limit cannot be extended, however, if the time limit is delayed due to force majeure, a request for restoration may be requested.

(4) Official Fees

The official fee for filing an examination request is charged on a per-case basis: ¥1,000 RMB for invention; ¥300 RMB for utility model and ¥300 RMB for design.

The reexamination fee may be reduced by 85% if the petitioner is an individual or unit, where two or more individuals or units are joint petitioners, the fee is reduced by 70%.

2.1.2 Amendment Rules

(1) Allowable amendments (types and timing)

The petitioner may amend the application, including claims and description, at the time of submitting the request for reexamination, responding to Notification of Reexamination or Notification of Oral Proceedings, or appearing in oral proceedings.

(2) Special Requirements: Unique office-specific rules

Any amendment, however, shall meet the requirements of Article 33 of the Patent Law (hereinafter referred to as "Article 33") and Rule 66 of the Rules for the Implementation of the Patent Law (hereinafter referred to as "Rule 66").

In accordance with the provisions of Article 33, an applicant may amend

the application documents, however, the amendment to the patent application documents for an invention or utility model may not go beyond the scope of disclosure contained in the original description and claims, and the amendment to the patent application documents for a design may not go beyond the scope of the disclosure as shown in the original drawings or photographs.

In accordance with the provisions of Rule 66, the amendment of the application documents by the request for reexamination shall be limited to eliminating the defects pointed out by the rejection decision or the panel.

2.1.3 Examination Scope

In the reexamination procedure, the panel normally examines only the grounds and evidence on which the decision of rejection is based.

In addition to the grounds and evidence on which the decision of rejection is based, where the panel finds the text of the application being examined has one of the following defects, it may examine the grounds and evidence related to the defect:

- 1) it does not comply with the provisions of Rule 11 of the Rules for the Implementation of the Patent Law (hereinafter referred to as "Rule 11")(the principle of good faith);
- 2) the defects for which it is sufficient to reject the application on the basis of other grounds and evidences of which the applicant has been notified before rejection;
- 3) the defects which are not indicated in the decision of rejection but are of the same nature with those indicated in the decision of rejection;
- 4) other obvious and substantive defects.

In addition to the above-mentioned cases (1) to (4), the defects are pointed out in relation to the decision of rejection, the panel may appropriately adjust the manner in which it is used, for example, change the closest prior art or default evidence on the basis of the evidence on which the decision is based.

During the collegial examination, the panel may introduce common knowledge of the skilled art into the examination, or supplement the evidence by providing common knowledge such as those in a technical dictionary, a technical manual, or a text book.

2.1.4 Hearing Formats

(1) Written or oral hearings

The panel may conduct examination in written form, by oral proceedings, or in both ways.

(2) Frequency of oral proceedings

Seldom.

(3) Availability of remote participation

The panel will determine whether to conduct an oral proceeding online or in person based on the specifics of the case. The notice of oral hearing in invalidation procedures received by the petitioner will indicate the mode of hearing. If an online oral hearing is designated, the petitioner may either access the Web-based Hearing System of the Patent Reexamination and Invalidation Department, or participate in the online hearing at a local IP protection center.

2.1.5 Procedure Status

Termination

The reexamination procedure is terminated where the request is deemed withdrawn for lack of response within the time limit, where the petitioner has withdrawn the request for reexamination before a reexamination decision is made, or where the request for reexamination that has been accepted is rejected for inconformity with the requirements of acceptance.

Suspension

Suspension of reexamination procedures refers to an action of CNIPA to suspend the relevant procedures upon the request of a party concerned in a dispute over the right to apply for a patent or under the request of the people's court when a dispute over the right to apply for a patent is accepted by the local IP administrative authority or the people's court, or when the people's court has ordered the adoption of measures of property preservation for the right to apply for a patent.

Resumption

After the time limit for suspension expires, CNIPA shall resume the relevant procedures on its own initiative.

2.1.6 Outcome Types: Possible conclusions

There are three types of examination decisions on requests for reexamination:

- (1) a request for reexamination is not allowed, and the decision of rejection is upheld;
- (2) a request for reexamination is allowed, and the decision of rejection is revoked;

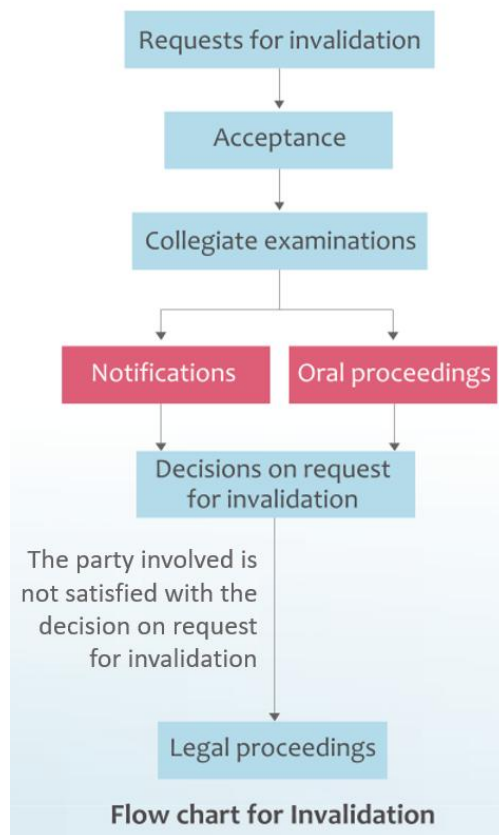
The second type as mentioned above includes the following circumstances:

- (i) where the provisions of laws were misapplied in the decision of

rejection;

- (ii) where the grounds for rejection lacked necessary evidence support;
 - (iii) where the process of examination failed to follow the statutory procedures; and
 - (iv) any other circumstances where the grounds of rejection are not tenable.
- (3) where an application document has been amended and the defects indicated in the decision of rejection has been overcome, the decision of rejection is revoked on the basis of the amended text.

2.2 The following aspects of Invalidation procedure



2.2.1 Key Process Elements

(1) Minimum Request Unit: Single claim vs. entire patent

Single claim. The patent can be declared invalid in part or in whole.

(2) Applicant Eligibility: Qualifications for filing requests

Any entity or individual considers that the grant of the patent right is not in conformity with the relevant provisions of the Patent Law.

But where the petitioner falls into one of the following cases, the request for invalidation shall not be accepted:

- 1) the petitioner is not eligible to institute a civil action;
- 2) where a request for invalidating a design patent is submitted on the ground that the design patent is in conflict with a legitimate right of another individual which was acquired prior to the filing date of the patent, the petitioner fails to prove himself the prior right holder or the interested party.

wherein, the interested party refers to the person who is entitled to file a lawsuit before the people's court or request the competent administrative authority to handle the matter regarding the dispute over infringement of the prior right in accordance with the relevant legal provisions;

- 3) where the patentee files a request for invalidation of his own patent right and requests to invalidate the whole of the patent, the evidence submitted is not a publication, or not all the patentees of the patent have joined in filing the request for invalidation;

- 4) several petitioners jointly submit a request for invalidation, unless all the patentees request to invalidate their common patent right.

(3) Time Limits

Beginning from the date of the announcement of the grant of a patent right by CNIPA.

(4) Official Fees

The official fee for filing an invalidation request is charged on a per-case basis: ¥3,000 RMB for invention; ¥1,500 RMB for utility model and ¥1,500 RMB for design.

(5) Grounds for invalidation requests

The reasons for the request for invalidation refers to when the patent is not conformity with Article 2, Article 19.1, Article 22, Article 23, Article 26.3, Article 26.4, Article 27.2, Article 33 of the Patent Law or Rule 11, Rule 23.2, Rule 49.1 of the Rules for the Implementation of the Patent Law, or falls under Article 5, Article 25 of the Patent Law, or the applicant is not entitled to a patent right in accordance with Article 9 of the Patent Law.

2.2.2 Amendment Rules

(1) Whether request arguments can be increased (and timing)

The grounds and evidences for invalidation may be increased within one month of submission of the request.

(2) Allowable claim amendments

Any amendment to the patent documents of a patent for invention or utility model shall be limited to the claims only, and shall follow the following principles:

- 1) the title of the subject matter of a claim can not be changed;
- 2) the extent of protection can not be extended as compared with that in the granted patent;

3) the amendment shall not go beyond the scope of disclosure contained in the initial description and claims;

4) addition of technical features not included in the claims as granted is generally not allowed.

The specific manners of amendment are generally limited to deletion of a claim, deletion of technical solution, further limitation of a claim, and correction of obvious mistakes.

The patent document of a design cannot be amended.

(3) Special Requirements

Before the panel makes a decision on the request for invalidation, the patentee may either delete a claim or delete a technical solution contained in a claim.

The patentee may amend the claims by means other than deletion within the time limit for response only in one of the following circumstances:

- 1) in response to the request for invalidation;
- 2) in response to grounds for invalidation or evidence added by the petitioner;
- 3) in response to grounds for invalidation or evidence not mentioned by the petitioner but introduced by the panel.

2.2.3 Examination Scope

In the invalidation procedure, the panel usually performs examination pursuant to the scope requested by the petitioner and only on the grounds and evidence submitted by the parties concerned, and bears no obligation of a comprehensive examination on the validity of the patent.

The panel may conduct examination ex officio in the following

circumstances:

- 1) the panel may introduce the invalidation ground under Rule 11 where the acquisition of patent rights is manifestly contrary to the principle of good faith;
- 2) where the grounds raised by the petitioner are obviously inappropriate to the evidence submitted, the panel may inform the petitioner of the meanings of the relevant provisions, and allow him to change or change ex officio the grounds to suitable ones;
- 3) where a patent is found to have the defect that obviously falls within the subject matters excluded from patent protection and the defect is not indicated by the petitioner, the panel may introduce a corresponding ground into the invalidation, and perform examination in that regard;
- 4) where a patent is found to have such a defect not indicated by the petitioner as to inhibit further examination on the grounds raised by the petitioner, the panel may introduce ex officio a corresponding ground to the defect into the grounds for invalidation, and perform examination on the ground;
- 5) where the petitioner requests for invalidating some of the claims which have reference relationship among them, does not request for invalidating the other claims on the same ground, and the examination conclusion will be unreasonable if the panel dose not introduce such cause, the panel may ex officio introduce such ground and perform examination on the other claims in that regard;
- 6) where the petitioner requests for invalidating some of the claims which have reference relationship among them on the panel that they have some

defect, and does not indicate that the other claims have defect of the same nature, the panel may introduce a corresponding ground to the defect into the invalidation and examine the other claims in that regard;

7) where the petitioner requests for invalidating a patent on the ground that it is not in conformity with Article 33 or Rule 49.1 and makes a specific analysis and description of the fact that the amendment goes beyond the scope of the original disclosure, but fails to submit the original application document, the panel may introduce the original application document of the patent as the evidence;

the panel may determine ex officio whether a technical means belongs to common knowledge of the art, and may introduce such common knowledge evidence as those in a technical dictionary, technical manual, or textbook into the examination ex officio.

2.2.4 Hearing Formats

(1) Written or oral hearings

The panel may conduct examination in written form, by oral proceedings, or in both ways.

(2) Frequency of oral proceedings

Oral proceedings are held in the substantial majority of invalidation cases.

(3) Availability of remote participation

The panel will determine whether to conduct an oral proceedings online or in person based on the specifics of the case. The notice of oral hearing in invalidation procedures received by the parties will indicate the mode of hearing. If an online oral hearing is designated, parties may either access the Web-based Hearing System of the Patent Reexamination and

Invalidation Department, or participate in the online hearing at a local Intellectual Property Protection Center.

2.2.5 Procedure Status: Termination, suspension, or resumption conditions

Termination

The invalidation procedure terminates:

- (1) where the petitioner withdraws the request for invalidation before the panel makes an examination decision on it;
- (2) where the petitioner fails to make a response to notification of oral proceedings within the specified time limit and fails to appear in the oral proceedings so that the request for invalidation is deemed withdrawn; and
- (3) where a request for invalidation, which has been accepted is found to be inconformity with the requirements for acceptance and is thus rejected.

However, except where in cases (1) through (2), the panel determines that a decision declaring the patent invalid or partially invalid can be rendered based on completed examination work.

Suspension

Suspension of invalidation procedures refers to an action of CNIPA to suspend the relevant procedures upon the request of a party concerned in a dispute over the ownership of right or under the request of the people's court when a dispute over the ownership of the patent right is accepted by the local IP administrative authority or the people's court, or when the people's court has ordered the adoption of measures of property preservation for the patent right.

Resumption

After the time limit for suspension expires, CNIPA shall resume the relevant procedures on its own initiative.

2.2.5 Outcome Types

There are three types of examination decisions for a request for invalidation, which are:

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

2.2.6 Legal Effects of Invalidation: Retroactive ("ab initio") or prospective

Retroactive. Any patent right that has been declared invalid is deemed never to have existed.

3. Subsequent Judicial Procedures

3.1 Whether judicial appeal is permitted against decisions

Yes.

According to Article 41, where the patent applicant refuses to accept the decision of the reexamination of CNIPA, it or he may, within three months from the date of receipt of the notification, file a lawsuit in the people's court.

According to Article 46, where the party concerned refuses to accept the decision of CNIPA on declaring the patent right invalid or on upholding the patent right, he or it may file a lawsuit in the people's court within three months from the date of receipt of the notification of the decision.

3.2 Competent courts

The first instance is heard by the Beijing IP Court, and the second instance is heard by the IP Tribunal of the Supreme People's Court.

4. User-friendly measures

4.1 Diversified document submission procedures

4.1.1 Submission Channels: Electronic vs. paper-based systems

Both reexamination requests and invalidation requests may be submitted either in electronic or paper-based system.

4.1.2 Online Portals: Links to e-filing platforms

<https://cponline.cnipa.gov.cn>

The petitioner and patentee may log in to the Patent Service System and use the Reexamination and Invalidation E-Request Module to submit documents.

4.1.3 Required Documents

A reexamination request requires submission of the "Request for Reexamination".

An invalidation request requires submission of the "Request for Invalidation". If the invalidation requester appoints a patent agency during the invalidation procedure, the original "Power of Attorney for Invalidation Procedures" shall be submitted.

4.2 Fast-track procedures

Provisions related to reexamination and invalidation in Measures for the Administration of Priority Examination of Patents (2017 CNIPA Order No.76, https://www.cnipa.gov.cn/art/2017/7/11/art_99_28206.html).

For reexamination cases falling under any of the following circumstances,

priority examination may be requested:

- (1) Involving national key development industries such as energy conservation and environmental protection, new-generation information technology, biology, high-end equipment manufacturing, new energy, new materials, new energy vehicles, and intelligent manufacturing;
- (2) Involving industries that are strongly encouraged by provincial and municipal people's governments at the district level;
- (3) Involving fields such as the internet, big data, and cloud computing, where technology or product updates are rapid;
- (4) The petitioner for reexamination has made preparations for implementation or has already begun implementing the invention-creation, or there is evidence proving that others are implementing the invention-creation;
- (5) The initial Chinese application for a patent on the same subject matter, which is subsequently filed in other countries or regions;
- (6) Other cases that are of great significance to national interests or public interests and require priority examination.

In cases of invalidation where one of the following circumstances applies, a request for priority examination may be made:

- (1) In cases of infringement disputes arising from patents involved in invalidation cases, the parties have requested the local IP office to handle the matter, filed a lawsuit with the people's court, or requested arbitration and mediation from an arbitration and mediation organization;
- (2) The patent involved in the invalidation case is of great significance to national interests or public interests.

The request for priority examination of patent reexamination cases shall be approved by all petitioners. The request for priority examination in cases of invalidation shall be approved by the person requesting invalidation or all patent owners.

The local IP office, people's court, or arbitration mediation organization that handles and hears patent infringement disputes may request priority examination for invalidation cases.

The number of priority examinations for reexamination and invalidation cases shall be determined by CNIPA according to the examination capacity of different professional and technical fields, the number of patent authorizations in the previous year, and the number of pending cases in this year.

If CNIPA agrees to give priority to the examination, it shall close the case within the following time limit from the date of consent:

- (1) Patent reexamination cases will be concluded within seven months;
- (2) Cases of invalidation of invention and utility model shall be concluded within five months, and cases of invalidation of design shall be concluded within four months.

4.3 Multi-modal Review Mechanisms

To facilitate the parties involved, the Reexamination and Invalidation Department has established multiple trial modes such as on-site hearings, circuit hearings, remote hearings, and infringement-confirmation cases combined hearings to provide more convenient and efficient services for parties. The Reexamination and Invalidation Department has established 20 standard trial courts and 5 remote courts that meet the requirements of

face-to-face trial and remote trial and set up 11 circuit courts in China.

4.4 External Training and Services

The Reexamination and Invalidation Department publishes the Annual Top 10 Reexamination and Invalidation Cases and hold the Innovation Entity Exchange Conference annually, to interpret the application of law and transmit the examination standards and concepts. The Reexamination and Invalidation Department serves the IP protection of relevant exhibitions, such as the China Import and Export Fair (Canton Fair), China International Supply Chain Expo (CISCE), and China International Fair for Trade in Services (CIFTIS), to deal with patent infringement disputes and provide IP consulting services.

4.5 Notice to foreign parties

Foreign enterprises or other foreign organizations that do not have a habitual residence or business office in China shall entrust a patent agency established in accordance with the law to handle the matter of reexamination and invalidation cases.

4.6 Information disclosure and Resource Links

The Reexamination and Invalidation Department regularly publishes examination decisions, oral hearing announcements and typical cases on its official website to facilitate users' access to relevant information in a timely manner.

<https://www.cnipa.gov.cn/col/col2632/index.html>

Guide to Handling Intellectual Property Government Services (Second Edition)

https://www.cnipa.gov.cn/art/2024/6/3/art_2644_193601.html

Instructions for the Parties

https://www.cnipa.gov.cn/art/2023/6/14/art_2644_176537.html

Brief introduction to Procedures of PTAB, USPTO

1. Introduction to Patent Trial and Appeal Board (PTAB) of USPTO

1.1 Website

<https://www.uspto.gov/patents/ptab>

1.2 Members (35 U.S.C. § 6)

1.2.1 Statutory Members

Director, Deputy Director, Commissioner for Patents, Commissioner for Trademarks, Administrative Patent Judges (APJs)

1.2.2 APJs

- (1) Appointed by the Secretary of Commerce
- (2) Required to have both legal and technical training, i.e., must be an attorney, but experience as an examiner not required

1.3 3-member panels issue final decisions

- (1) Members are usually, but not always, assigned cases in their technical field.
- (2) Each panel member's opinion is given the same weight.

2. Ex Parte Appeals

2.1 Website

<https://www.uspto.gov/patents/ptab/appeals>

2.2 Overview

- (1) An applicant for a patent and patent owner in a reexamination may seek appeal.

- (2) An appellant may request oral argument.
- (3) An appellant may not seek an amendment during appeal.
- (4) PTAB reviews an examiner' s determination for error. *Ex parte Frye*, 2009-006013 (Feb. 26, 2010). A decision on appeal is not a determination of patentability, and, after appeal, the matter returns to the examiner..

2.3 Request Submission Process

Patent Center

2.4 Manuals & Resource Links

- (1) 35 U.S.C. § 134
- (2) 37 C.F.R. §§ 41.1–41.208
- (3) MPEP Chapter 1200
- (4) *Ex parte* appeal brief template

2.5 Request Submission Process

P-TACTS

3. Subsequent Judicial Procedures

3.1 Request rehearing by the panel

3.2 Request judicial review

4. Additional Resources

4.1 PTAB Precedential and Informative Decisions

4.2 Legal Experience and Advancement Program (LEAP)

4.3 PTAB Inventor Hour Series



Boards
of Appeal

