

## CHAPTER VII

### TRIAL

#### **Article 67bis Trial against a Decision to Reject an Amendment**

Where a person who receives a decision to reject an amendment under Article 18*bis*(1) is dissatisfied with the decision, the person may request a trial within thirty days of receiving a certified copy of the decision.

#### **Article 67ter Trial against a Decision to Refuse or Revoke Design Registration**

A person who has received a decision to refuse or revoke design registration may request a trial within thirty days of receiving a certified copy of the ruling.

#### **Article 68 Trial to Invalidate a Design Registration**

(1) In the following cases, an interested person or an examiner may request a trial to invalidate a design registration; a request may be made for each design for which an application for the registration of multiple designs is made under Article 11*bis*:

- (i) the registration violates Articles 5, 6, 7(1), 10, 16(1) and (2) of this Act or Article 25 of the Patent Act as applied under Article 4 of this Act;
- (ii) where the registration is filed by a person not entitled to a patent or it is unpatentable under the proviso of Article 3(1);
- (iii) the registration violates a treaty; or
- (iv) after registration, the owner of the design right is no longer capable of enjoying the design right under Article 25 of the Patent Act as

applied under Article 4 of this Act, or the registration no longer complies with a treaty.

(2) A trial under paragraph (1) may be requested even after the extinguishment of a design right.

(3) Where a trial decision invalidating a design registration has become final (except for the design registration of a similar design), the design right is deemed never to have existed; however, where the design registration falls under paragraph(1)(iv) and a trial decision invalidating the design registration has become final, the design right is deemed not to have existed from the time the design registration first fell under paragraph (1)(iv).

(4) Where a trial decision invalidating the design registration of a principal design has become final, the design registration of a similar design also becomes invalid.

(5) Where a trial decision invalidating a design registration of a similar design has become final or where the design registration of a similar design becomes invalid under paragraph(4), the design right of the similar design is deemed not to have existed from the beginning. However, where a trial decision invalidating the design registration of a similar design under paragraph(1)(iv) has become final, the design right of the similar design is deemed not to have existed from the time the design registration of the similar design first fell under paragraph (1)(iv).

(6) Where a trial for invalidation under paragraph(1) has been requested, the presiding trial examiner shall notify the exclusive licensee of the design right and any other persons who have registered rights related to the design registration.

### **Article 69 Trial to Confirm the Scope of a Design Right**

The owner of a design right or an interested person may request a trial to confirm the scope of a design right protected by the design registration.

### **Article 70 Trial for Granting a Nonexclusive License**

(1) Where the owner of a design right or exclusive or nonexclusive licensee seeks permission to exercise the right under Article 45(1) or (2) and the other party refuses permission without justifiable reasons or permission is impossible to obtain, the owner or exclusive or nonexclusive licensee may request a trial for the grant of a nonexclusive license to the extent necessary to work the registered design.

(2) Where a person who has granted a nonexclusive license under paragraph (1) seeks to work the registered design of the person who has been granted the nonexclusive license and the latter refuses permission or permission is impossible to obtain, the former may request a trial for the grant of a nonexclusive license for the registered design or within the scope of a design similar to the registered design.

(3) A nonexclusive licensee granted a nonexclusive license under paragraphs (1) or (2) shall remunerate the patentee, the owner of the utility model right, the owner of the design right or the exclusive licensee; if payment is not possible for unavoidable reasons, the remuneration must be deposited.

(4) A nonexclusive licensee under paragraph (3) may not work a patented invention, registered utility model or design right or similar design without paying or depositing the remuneration.

### **Article 71 *Mutatis Mutandis* Application of the Provisions of Examination to Trial against the Decision to Refuse Design Registration**

(1) The main stipulation of Articles 18(1), 18*bis*, 27 and 28 applies *mutatis mutandis* to a trial against the decision to refuse design registration. In such cases, "before transmittal of the examiner's first decision to either grant or refuse design registration under Article 28 (referred to as 'decision to grant or refuse design registration')" in Article 18(1) reads "within the designated period for submitting arguments by notification of reasons for refusal", "where an applicant has requested a trial under Article 67*bis*" in Article 18*bis*(3) reads "where an action has been brought under Article 186(1) of the Patent Act

applying *mutatis mutandis* under Article 75 of this Act", and "until the trial decision has become final" reads "until the ruling has become final".

(2) Article 18*bis*(1), (4) and 27 that apply *mutatis mutandis* under paragraph(1) apply only where the reasons for refusal differ from the grounds of the examiner's original decision to refuse design registration.

### **Article 72 *Mutatis Mutandis* Application of the Patent Act**

Articles 139 to 166 and 171 to 176 of the Patent Act apply *mutatis mutandis* to trials concerning designs. In such cases, "A person who requests a trial against a decision to refuse or revoke a patent under Article 132*ter*" in Article 140*bis*(1), excluding the subparagraphs, reads "a person who requests a trial under Article 67*bis* or 67*ter*", "date of decision" in Article 140*bis*(1)(iv) reads "date of decision to refuse design registration, date of decision to revoke design registration, or date of decision to reject an amendment", "the costs of a trial under Article 132*ter* and 136 or 138" in Article 165(3) of the Patent Act reads "the costs of the trial under Article 67*bis*, 67*ter* or 70", "a decision of refusal to grant a patent, a decision of refusal to extend the term of a registered patent or a trial against a decision to revoke a patent" in Article 171(2) of the Patent Act reads "a trial under Articles 67*bis* or 67*ter*", "Article 51" in Article 174(1) of the Patent Act reads "Article 18*bis*", "Article 47(1)(i) and (ii)" in Article 174(2) of the Patent Act reads "Article 18(1)", "Article 132*ter*" in Article 176(1) of the Patent Act reads "Articles 67*bis* or 67*ter*", and "a decision of refusal to grant a patent, a decision of refusal to extend the term of a registered patent or a decision to revoke a patent" in Article 176(1) of the Patent Act reads "a decision to reject an amendment, refuse design registration or revoke design registration".