

Administrative Revocation and Invalidation Mechanisms

The Republic of Chile

The invalidation procedure in Chile is regulated by Title I “Preliminary provisions”, paragraph 5 “Procedure for invalidation of a registration”, articles 18bis G to 18bis O of Law No. 19.039 on Industrial Property (LPI).

1. Claim for invalidity

Any interested party may file a claim to invalidate the registration of an industrial property right and must be duly represented by a lawyer with standing under Law No.18.120 on appearance in court (LPI, article 18bis G).

2. Deadline for filing claims for invalidity

A claim for invalidity may be filed against a patent during a period of five years from the date on which it was registered (LPI, article 50).

3. Claim requirements

Claims for invalidity shall contain at least the following information (LPI, article 18bis G):

- a) name, address and occupation of the claimant;
- b) name, address and occupation of the respondent;
- c) number and date of the registration for which invalidity is sought and indication of proof of payment of the required fee;
- d) factual and legal reasons on which the claim is founded, and a clear and precise statement of the invoked grounds for invalidity.

In the case of patents for inventions and utility models, invalidation may be requested of the registration in its entirety or of one or more claims made therein (LPI, article 18bis H).

4. Grounds for invalidation

A patent may be invalidated on the following grounds (LPI, article 50):

- a) the patent grantee is neither the inventor nor the inventor’s licensee;
- b) the patent has been granted on the basis of erroneous or manifestly deficient examiners’ reports;
- c) title has been granted in breach of patentability rules and related requirements set out in the LPI.

5. Court

Cases concerning invalidation shall be heard by the Director of the Institute in accordance procedures contained in the LPI (LPI, article 17).

6. Notification of claims for invalidity

Invalidity claims shall be notified in accordance with articles 40 *et seq.* of the Code of Civil Procedure (LPI, article 13).

7. Response to claims for invalidity

The registration holder and respondent shall respond to the invalidity claim within 60 days following the notification of the claim (LPI, article 18bis I).

8. Evidence

Once the deadline for responding to the claim has passed, on the basis of the merits of the claim, if any relevant substantive matters are in issue, evidence shall be heard within 45 days (LPI, article 18bis K).

The evidence-gathering stage may, in qualified cases, be extended once by 45 days at the request of either party.

Documentary evidence for that stage shall be submitted in Spanish or be duly translated, should INAPI so require (LPI, article 18bis M and article 10bis).

During invalidation proceedings, the parties may use all means of adducing evidence and those set out in the Code of Civil Procedure, with the exception oral evidence (LPI, article 18bis M and article 12).

9. Patentability examination

The patentability examination shall be based on the facts contained in the claim and in the response thereto, in particular the grounds for invalidation set out in article 50 b) and c) of the LPI.

The report shall be sent to the claimant and the respondent (registration holder) for comment within 60 days (LPI, article 18bis K).

10. Ruling

The ruling shall be substantiated by reasons and must comply with the provisions of Article 170 of the Code of Civil Procedure, as appropriate. Rulings shall basically contain a clear and precise designation of the parties, a statement of the claimant's petitions or actions, the exceptions alleged by the respondent, the considerations of fact and law on which the ruling is based and the decision on the disputed matter (LPI, article 18bis K and article 17).

If the claim for invalidity succeeds, the registration that had been declared invalid, in whole or in part, shall be deemed null and void from the date on which the patent entered into force (LPI, article 18bis N).

The decision declaring the registration null and void shall be recorded in the margin of the respective registration for publicity purposes (LPI, article 18bis N).

11. Appeal procedure – second instance

Appeals against the decision of the National Director's ruling on the claim for invalidity shall be lodged within 15 days from the date of notification of the decision and shall be heard at second instance by the Industrial Property Tribunal with jurisdiction over such matters (LPI, article 17bis B).

12. Supreme Court

Action against a judgment at second instance by the Industrial Property Tribunal shall consist of an appeal to the Supreme Court in cassation as to the merits (LPI, article 17bis B).