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).

The LPI provides that any interested person may request the invalidation (nullity) of an industrial property right registration (Art. 18 *bis* G LPI).

As with the opposition proceeding, the nullity application shall be filed by a qualified attorney in accordance with the provisions of Law No. 18.120.

Time limit for the application for invalidation: The application to invalidate an invention patent or utility model shall be filed within five years, with effect from the date of grant of the registration (Art. 50 LPI).

Application requirements: The invalidity application shall contain, at a minimum, the following information (Art. 18 *bis* G LPI):

- Name, domicile, and profession of the applicant;
- Name, domicile, and profession of the respondent; and
- Number and date of the registration for which invalidation is sought, and identification of the relevant right.
- The factual and legal grounds on which the application is based, with a precise and clear indication of the grounds for invalidation invoked.

For patents and utility models, invalidation may be sought with respect to the entire registration or to one or more of its claims (Art. 18 *bis* H LPI).

Grounds for invalidation A declaration of invalidity of an invention patent shall proceed on one of the following grounds (Art. 50 LPI):

- The grant was based on expert reports that were erroneous or manifestly deficient.
- The registration was granted in contravention of the rules on patentability and their requirements, in accordance with the provisions of the LPI.

Steps in the proceedings

a. Filing and service of the invalidity application:

Service of the invalidity application shall be carried out in accordance with Articles 40 *et seq.* of the Code of Civil Procedure. For these purposes, foreign applicants shall establish a domicile in Chile. Where a party has no domicile or residence in Chile, the application shall be served on the attorney-in-fact or representative referred to in Article 2 LPI (Art. 13, paragraph 3, LPI).

b. Challenge to the request for invalidity:

From the date of service of the request for invalidity, the patent applicant or respondent has a period of 60 days to answer the opposition (Art. 18 *bis* LPI).

c. Payment of the expert fee

The expert fee, which is payable by the complainant in the invalidity application, shall be paid within 60 days of the date of service – as reflected by the court record – of the order referring the invalidity application. Failure to do so shall result in the application being declared abandoned. (Art. 8 LPI).

Pursuant to Article 4(h) of Law No. 20.254 establishing the National Institute of Industrial Property, the National Director is empowered, among other matters, to periodically set the fee established in Article 8 of Law No. 19.039 with respect to invalidity proceedings.

Accordingly, the fees at set forth in National Directorate Decision No. 441 of 2024. In proceedings for the invalidation of patent registrations, utility models, and layout-design(s) of integrated circuits, the amount of the fee is equal to twice the examination fee for an application for registration. The aforementioned decision determines the expert fees using an adjustable unit known as the Annual Tax Unit, which takes account of inflation, thereby avoiding the need for INAPI to issue a new decision every year.

d. Evidence:

Once the period to answer the claim has expired, and depending on its merits, if there are substantial, relevant, and disputed facts, the case shall be opened to evidence for a period of 45 days (Art. 18 *bis* K LPI).

The evidentiary period may be extended once and in cases where justification is valid, by 45 days at the request of either party to the proceedings.

Documentation submitted during the evidentiary stage shall be presented in Spanish or duly translated, if required by INAPI (Arts. 18 *bis* M and 10 *bis* LPI).

In the invalidation proceedings, the parties may use all the customary means of evidence for such matters, as well as those laid down in the Code of Civil Procedure, excluding witness testimony (Arts. 18 *bis* M and 12 LPI).

In the proceedings, the evidence shall be assessed according to the rules of sound judgment (18 *bis* M and 16 LPI).

e. Appointment of the expert:

Once the evidentiary period has elapsed, INAPI shall appoint an expert to examine the grounds for invalidity; such expert shall be different from the expert who took part in the examination of the application. The expert shall be appointed by mutual agreement of the parties at a hearing convened for that purpose. Failing agreement, the expert shall be appointed by INAPI, which shall seek to avoid appointing the same expert who took part in the original expert examination. The foregoing is without prejudice to the National Director's ability, at any time, with a view to reaching a more informed decision, to hear the expert(s) who issued the report at the time the registration was applied for. (Art. 18 *bis* J LPI).

In accordance with the final paragraph of Article 75 of the RLPI, non-acceptance of the expert appointment shall be substantiated.

f. Challenge of the expert:

The parties may challenge the expert within five days of service of the order appointing them, exclusively on one or more of the following grounds (Art. 18 *bis* K LPI):

- having publicly expressed an opinion on the matter;
- Having a relationship of kinship, friendship, or manifest enmity with one of the parties;

- lack of suitability or competence with respect to the matter under consideration; and

- having provided professional services, whether as an employee or independently, to either of the parties, or for having had an economic or business relationship with either of them, within the preceding five years.

The challenge shall be resolved through an incidental proceeding, whereby the other party is given 20 days to respond; upon receipt of that response, or in its absence, the incidental matter shall be resolved without further proceedings.

g. Expert report:

- Time limit for issuing the expert report: The expert report shall be issued within 60 days, with effect from acceptance of the appointment. The expert may request a single extension of up to 60 days, provided that such request is substantiated and INAPI grants it on reasoned grounds (Art. 7 LPI).

- Content: The expert report constitutes a technical opinion that shall be confined to the matter in dispute, that is, to the facts contested by the parties and the points of evidence set out in the relevant order. In other words, this report is not intended to assess the patentability requirements in the context of the registration application. Accordingly, the expert shall issue an opinion on the matter discussed in the case file within the context of the invalidity application.

- Comments on the expert report: Once the expert report has been served, the parties shall have 60 days to submit their comments (Art. 18 *bis* K LPI).

- If either party feels unfairly treated in the report issued by the expert, it may request a second report, in which case the same procedure described above shall apply with respect to payment and appointment of the expert.

h. Judgment (ruling)

Based on the parties' submissions and the expert report, INAPI shall determine the requested invalidity by way of a ruling issued by the National Director. The ruling shall be reasoned and be formally consistent with Article 170 of the Code of Civil Procedure, insofar as it is applicable (Arts. 18 *bis* K and 17 LPI).

If the invalidity application is upheld, the registration declared invalid, in whole or in part, shall be deemed to have had no effect from the date the patent entered into force (Art. 18 *bis* N LPI).

A judgment upholding the invalidity of the registration shall be recorded in the margin of the corresponding entry for publicity purposes (Art. 18 *bis* N LPI).

An appeal may be filed with the Industrial Property Court against the ruling within 15 days of its service (Art. 17 *bis* B LPI).