

### 3. Trials for Correction

#### <<Request for trials for correction>>

**Q1:** A request for a trial for correction may be filed by claim in a case where two or more claims need to be corrected. Are there any points that should be heeded in filing a request for each claim?

**A1:** When filing a request for a trial for correction by claim, if the claims you need to correct include those which are in a relationship, for example, where one claim is cited in one or more other claims (these are referred to as a "group of claims"), then you must file the request by group of claims (Patent Act §126 (3)).

In addition, when the correction of the description or drawings is related to a statement of a claim or claims, you must file a request for all the claims that are related to the correction of the description or drawings (Patent Act §126 (4)) (Chapter 54-01 of the Manual for Appeal and Trial Proceedings).

#### <<Group of claims>>

**Q2:** What is a "group of claims," and what points should I heed concerning a group of claims?

**A2:** In order to prevent a "lack of overviewability," which means the scope of invention cannot be identified by a single document since there has become multiple versions of Description or Claims through the claim-based correction procedures to be looked at in order to identify the scope of invention, if the claims you need to correct include those which are in a relationship, for example, where one claim is cited in one or more other claims, these related claims should be handled as a whole as a "group of claims."

Accordingly, the multiple claims that compose a "group of claims" should be subject to the condition not only that the multiple claims are in a relationship where one claim is cited in one or more other claims but also that the cited claim is corrected (Chapter 54-01 of the Manual for Appeal and Trial Proceedings).

#### <<Correction that eliminates citation / deletion of claims>>

**Q3:** In what cases is a group of claims not handled as a whole?

**A3:** If you do not wish for a group of claims to be handled as a whole, you may correct the statement of the claim(s) citing a claim so that it does not cite the claim (elimination of the citing and cited relationship among the claims), and the claims are no longer handled as a whole as a group of claims.

Also, when a claim is deleted through correction, the deleted claim is no longer handled as a whole as a group of claims.

Note that judgment concerning whether or not multiple claims constitute a group of claims is conducted on the basis of the post-correction statement of claims.

<<Amendment in response to a notice of reasons for refusal of correction>>

**Q4:** Is it possible to amend the corrected description, etc. in response to a notice of reasons for refusal of correction? If so, what is the scope of amendment that is possible?

A4: Where a request for a trial for correction does not comply with the Patent Act Article 126, the chief administrative judge shall notify the demandant of the reasons for refusal of correction, and the demandant may submit a Written Opinion in response. The demandant may also make an amendment to the Written Request for a Trial (Patent Act §17 (1)) or to the corrected description, etc. (Patent Act §17-4), within a scope that does not change the gist of the Written Request.

However, the scope of the correction that can be made to description, etc. is limited to minor modifications such as deletion of corrections, amendment of minor flaws, etc. (Chapter 54-05.1 of the Manual for Trial and Appeal Proceedings).

**Q5:** Regarding the fact that an amendment shall not change the gist of a Written Request for a Trial for Correction, should I understand that an amendment to a description, etc. attached to a Written Request for a Trial for Correction also shall not change its gist?

A5: When the corrections that are the object of a request change due to changes in the content of descriptions, etc. attached to the Written Request for a Trial for Correction, and when the scope and the content of the items for which a trial is requested also change, this generally equates to a change of the gist of the Written Request.

<<Amendment of corrections>>

**Q6:** When a notice of reasons for refusal of correction has been sent in a trial for correction, is it possible to make an amendment that deletes or adds corrections?

A6: In accordance with the stipulations of the Patent Act Article 165 and Article 17-4, Written Opinions and Written Amendments may be submitted. However, when a notice of reasons for refusal of correction has been sent, these amendments are rarely approved and are nearly always dismissed.

The "object of the request" for a trial for correction is based on "the corrections that has been made to description, the scope of claims or the drawings." As such, making amendments to the corrected description, the scope of claims, or the drawings equates to changing the object of the request for a trial for correction. Amendments that delete corrections, amendments of errors, etc. may be approved, but amendments that add new corrections equate to amendments that change the object, and thus are usually not approved.

However, if the period in which a request for a trial for correction can be filed has not expired, you may withdraw the request for the trial at the time that a notice of reasons for refusal of correction has been sent, and file a request for a new trial for correction, as a way to make an amendment to add corrections (Chapter 54-05.1 of the Manual for Trial and Appeal Proceedings).

<<Addition of new items>>

**Q7:** In a trial for correction of a patent right based on a patent application filed prior to the 1993 Act on Partial Revision of the Patent Act, etc., is it possible to add new items, the banning of which was not clearly stipulated in the Patent Act Article 126 prior to the 1993 Revision?

A7: In trials for correction requested on or after January 1, 1994, corrections that add new items will not be approved, regardless of application date.

<<Correction that increases the number of claims>>

**Q8:** Is it possible to make corrections that increase the number of claims, if these corrections do not correspond to those that substantially enlarge or alter the scope of claims?

A8: In accordance with the stipulations of Patent Act Article 126, corrections to the description, the scope of claims, or the drawings are allowed in a trial for correction only for specified purposes.

The purpose of corrections that simply increase the number of claims do not correspond to any of them stipulated in the proviso to Paragraph 1 of the Patent Act Article 126, i.e., (i) "restriction of the scope of claims," (ii) "correction of errors or incorrect translations," (iii) "clarification of an ambiguous statement," and (iv) "elimination of the citing and cited relationship among claims." As such, corrections that increase the number of claims are in principle not allowed.

However, in cases where, for example, a multiple dependent claim is made into the one with the reduced number of claims cited, it is possible to submit a correction that increases the number of claims.

**Q9:** In a request for corrections for the purpose of restriction of the scope of claims, if there are two Claims A and B, for example, is it possible to make corrections to delete Claim A and to divide Claim B into two claims, Claim B' and Claim B" (with the total number of claims before and after the corrections unchanged)?

A9: The question of whether the purpose of a correction corresponds to restriction of the scope of claims is generally determined on a claim basis. The deletion of Claim A corresponds to restriction of the scope of claims. However, as the correction of Claim B is a correction that increases the number of claims, it is not recognized as a restriction of the scope of claims for patents.

Accordingly, even though the total number of claims before and after the corrections is unchanged, the correction in question violates the requirements for corrections and will not be allowed.

<<Corrections with regard to product-by-process claims>>

**Q10:** With regard to product-by-process claims (i.e., claims concerning inventions of products reciting manufacturing processes of the products), in response to the judgments by the Supreme Court in June 2015, the JPO posted “Interim Handling Procedures for Examinations and Appeals/Trials involving Product-by-process Claims” on its website on July 6, 2015.

According to this, “After a final notice of reasons for refusal is issued, when making an amendment to a claim where the manufacturing process of a product is recited together with the product itself, if an applicant wishes to change it into simply reciting the product in terms of structure or characteristics, or, into simply reciting the manufacturing process of the product, at the time of requesting an appeal against an examiner’s decision of refusal, or after receiving a notice as per the Patent Act Article 50-2, such amendments shall be normally recognized as an amendment that corresponds to a clarification of an ambiguous statement (Patent Act 17-2, Paragraph 5 (iv)).”

In a trial for correction, when requesting a correction to specify the invention only by the structure or characteristics of a product, or a correction to change the reciting of the claim into that of the manufacturing process of the product alone, does this correspond to clarification of an ambiguous statement in the same manner as in the handling of examinations?

**A10:** With regard to the “clarification of an ambiguous statement” stipulated in Patent Act Article 126, Paragraph 1, proviso (iii) in a request for a trial for correction, the requirement of “limited to the matters stated in the reasons for refusal in the Notice of Reasons for Refusal” that is taken into account when applying Patent Act Article 17-2, Paragraph 5 to amendment does not apply here. Therefore, when the manufacturing process of a product is recited in a claim concerning an invention of the product, a correction that specifies the invention only by the structure or characteristics of the product, or a correction that changes the reciting of a claim into that of the manufacturing process of the product is recognized as a correction made for the purpose of clarifying an ambiguous statement.

However, it must be noted that, unlike the requirements for amendments, the requirements for corrections include that the correction “shall not substantially enlarge or alter the scope of claims” (Patent Act Article 126, Paragraph 6 ).

With regard to the handling of a product-by-process claim in a request for a trial for correction, the JPO, while analyzing case studies, will indicate the decisions of the panel in accordance with a case, based upon laws and regulations.

<<Trials concerning violation of requirements for correction>>

**Q11:** When a correction has been approved in a trial for correction but a third party has an objection to the approval of the correction, can the third party file a request for a trial for invalidation against the correction?

A11: When an unlawful correction has been made, which corresponds to the stipulations of the Patent Act Article 123, Paragraph 1, Item (viii), the third party may request a trial for invalidation with this fact as the grounds for invalidation.

<<Request for a trial for correction filed without the consent of the non-exclusive licensees>>

**Q12:** When filing a request for a trial for correction, the patentee must obtain consent even from non-exclusive licensees. If it is found that a request for a trial for correction does not have the consent of the non-exclusive licensees, what action does the JPO take?

A12: When filing a request for a trial for correction, you must submit documents verifying the consent of the non-exclusive licensees as an attached document. If it is recognized, during the proceedings, that there is a non-exclusive licensee whose Written Consent was not submitted, it will be considered non-compliance with formal requirements, and an order to amend procedures will be issued by the chief administrative judge in accordance with the stipulations of the Patent Act Article 133, Paragraph 2, Item (ii). If the Written Consent is still not submitted in response to this order to amend, the Written Request will be dismissed by a ruling according to the stipulations of the Patent Act Article 133, Paragraph 3.