

38-00 P

Corrections in General

1. Outline

A trial for correction is a system for a patentee to voluntarily correct the description, claims or drawings after the registration of establishment of a patent right. A request for correction in a trial for invalidation or opposition to grant of patent is a system to correct the description, etc. as the patentee's means of defense against a trial for invalidation, etc.

The "description, claims or drawings attached to an application" shall be subject to correction. In a trial for correction, a patentee may file a request for a trial for correction (Patent Act Article 126 (1)). In addition, a patentee may file a request for correction in a trial for invalidation or opposition to grant of patent (Patent Act Article 134-2 (1), Article 120-5 (2)). However, where a previous request for correction exists and a second request for correction is filed, the previous request shall be deemed to have been withdrawn (Patent Act Article 134-2 (6), Article 120-5 (7)).

Where a trial decision on a trial for correction, trial for invalidation, or decision on opposition to grant of patent that allows a correction becomes final and binding, it shall be deemed that the patent application, publication of an application, examiner's decision to grant a patent, etc. have been done based on the description, etc. after the correction (Patent Act Article 128, Patent Act Article 120-5 (9) → Patent Act Article 128, Patent Act Article 134-2 (9) → Patent Act Article 128).

2. Unit of Request for Correction

(1) Filing a "Request for Correction for the Whole Patent Right" or "Request for Correction on a Claim-by-Claim Basis"

A. Choice between filing a "request for correction for the whole patent right" or filing a "request for correction on a claim-by-claim basis"

A correction shall be made by filing a "request for correction for the whole patent right" (the unit of request for correction shall be the whole patent right) or filing a "request for correction on a claim-by-claim basis" (the unit of request for correction shall be each

claim) (Patent Act Article 120-5 (3), (4), Article 126 (3), Article 134-2 (2), (3)).

In terms of a correction, whether the correction is allowed shall be determined for each unit of request for correction, and a trial decision, etc. shall become final and binding for each unit of request (Patent Act Article 120-7, Article 167-2).

Where the number of claims before a correction is one, the requester must file a "request for correction for the whole patent right." Where the number of claims before a correction is two or more, the patentee may choose between filing a "request for correction for the whole patent right" and filing a "request for correction on a claim-by-claim basis." However, regarding a request for correction in a trial for invalidation or opposition to grant of patent, where a request for the trial for invalidation, etc. was filed on a claim-by-claim basis, it is also necessary to file a "request for correction on a claim-by-claim basis" (Patent Act Article 134-2 (2), Article 120-5 (3)). It shall be understood that "a request for correction was filed on a claim-by-claim basis" unless any intention of either filing a "request for correction for the whole patent right" or filing a "request for correction on a claim-by-claim basis" is manifested by who requests correction (see Table 1). This is because although a request for a trial for invalidation and an opposition to grant of patent may be filed for the whole patent right, they are filed on a claim-by-claim basis in general. There will not be any advantage for a demandant or opponent if a request for correction is filed for the whole patent right because the whole patent right could be invalidated even if only a part of the patent right is subject to invalidation.

Table 1 Choice of the unit of request for correction

	Trial for correction	Request for correction
The number of claims before the correction is one	"Whole patent right"	"Whole patent right"
The number of claims before the correction is two or more	The requester may choose the unit	"on a claim-by-claim basis" in general

B. Regarding filing a "request for correction for the whole patent right"

Filing a "request for correction for the whole patent right" is to request making corrections for all the correction items collectively as stated in the attached corrected

description, claims or drawings.

Therefore, if some of the corrections do not fulfill the requirements, all the corrections will not be allowed in an integrated manner. Because of this, in a correction relating to multiple claims, the correction only relating to some of the claims shall never be allowed. Consequently, when confirming statements in the present patent description, etc., it is always necessary to only confirm one set of description, claims, or drawings for one patent right, which will make management of rights easy.

However, filing a "request for correction for the whole patent right" leads to making corrections as stated in the attached corrected claims, etc., that is, filing a request for correction for all the claims before the correction. Therefore, even in the case of correcting only the stated matter relating to one claim, fees for the number of claims stated in the patent register shall be necessary (→ 38-06).

C. Regarding a "request for correction on a claim-by-claim basis"

Filing a "request for correction on a claim-by-claim basis" is to request that a correction be made in units of each claim before the correction. As whether a correction is accepted is determined on a claim-by-claim basis, correction of a claim may be allowed even if correction of another claim is not allowed.

However, as whether a correction is allowed is determined on a claim-by-claim basis, where there are multiple correction items relating to one claim and any one of those correction items does not fulfill the requirements for correction, all the correction items concerning the said claim shall not be allowed in an integrated manner.

Incidentally, where claims to be corrected include groups of claims (groups of claims having the prescribed citation relation), a request for correction must be filed on the basis of each "group of claims" in relation to those claims (Patent Act Article 120-5 (3), (4), Article 126 (3), Article 134-2 (2), (3)), and whether the correction is allowed shall also be determined based on the unit of request, that is each "group of claims" (→ 38-01).

In the case of filing a "request for correction on a claim-by-claim basis," a request for correction may be filed only for some of the claims. Therefore, fees may be lower than those in the case of filing a "request for correction for the whole patent right" (→ 38-06).

(Revised Sep. 2018)