

## 38-03 P

### Requirements for Correction

1. Requirements for Correction (Regarding a Trial for Correction: Patent Act Article 126 (1), (5), (6), (7), 1993 Supplementary Provisions Article 4 (2), the Former Utility Model Act Article 39 (1), (2), (3), Regarding a Trial for Invalidation: Patent Act Article 134-2 (1), Article 134-2 (9) → Article 126 (5), (6), (7), 2011 Supplementary Provisions Article 19 (2), the Former Utility Model Act Article 40-2 (1), Article 40-2 (9) → Utility Model Act Article 39 (5), (6), (7); Regarding an Opposition to Grant of Patent: Patent Act Article 120-5 (2), Article 120-5 (9) → Article 126 (5), (6), (7))

Requirements for correction in relation to the description, claims or drawings attached by the patentee to an application is provided in Patent Act Article 126, Article 134-2, and Article 120-5.

Purpose of a correction is to defend against a possible attack in a trial for invalidation, etc. by eliminating defect(s) from a part of the patent in advance. In order to accomplish such purpose, correction of minimum scope of claims is enough. Therefore, a correction shall be limited to those intended for the following purposes (Patent Act Article 126 (1), 1993 Supplementary Provisions Article 4 (2), Former Utility Model Act Article 39 (1), Patent Act Article 134-2 (1), Article 120-5 (2)):

- (1) restriction of the scope of claims (proviso (i)) (→ 2.);
- (2) correction of an error or mistranslation (proviso (ii)) (→ 3. 4.);
- (3) clarification of an ambiguous statement (proviso (iii)) (→ 5.); and
- (4) dissolution of the citation relation between claims (rewriting a claim that cites another claim to a claim that does not cite the said other claim) (proviso (iv)) (→ 6.).

In addition, a correction must be made within the scope of the matters stated in the description, etc. attached to an application (→ 7.), and must not substantially enlarge or alter the scope of claims (→ 8.). The invention defined by what is stated in the scope of claims after the correction must be one that is independently patentable upon the filing of the patent application (→ 9.).

## 2. Restriction of the Scope of Claims (Patent Act Article 126 (1) (i), Former Utility Model Act Article 39 (1) (i), Patent Act Article 134-2 (1) (i), Article 120-5 (2) (i))

(1) The "restriction of the scope of claims" refers to restricting the matters stated in the claims, etc. in the case where the statement of the scope of claims as it is has a defect of containing publicly known art or is likely to be understood as having a reason for the invalidation or revocation of a patent, etc. to the effect that the patent right is identical with another invention of the same person. Deletion of a claim (including deletion of all claims) shall also fall under this.

(2) All matters found to be necessary for defining the invention for which a patent is sought must be stated in the scope of claims by segmenting them into claims. Therefore, a determination concerning "restriction of the scope of claims" shall be basically made with respect to each claim (including dependent form claims (dependent claims) whose statement itself is not corrected).

(3) Specific examples that do not fall under the "restriction of the scope of claims"

A. Deletion of a part of matters to specify the invention stated in series

B. Addition of elements in an alternative form

C. Correction that increases the number of claims (excluding the cases that fall under (4) F. G. or 6.)

(4) Specific examples that fall under the "restriction of the scope of claims"

A. Deletion of elements in an alternative form

B. Serial addition of matters to specify the invention

C. Change from a generic concept to a more specific concept

D. Deletion of a claim

E. Reduction of the number of claims cited in multiple dependent form claims

Example: Correction that rewrites the statement of the scope of claims "Air-conditioner device stated in any of Claims 1 to 3 containing Mechanism A" to "Air-conditioner device stated in Claim 1 or 2 containing Mechanism A"

#### F. Change of a claim that cites n claims to a claim that is n-1 or fewer claims

Example: Correction that changes the statement of one claim in the scope of claims "Air-conditioner device stated in any of Claims 1 to 3 containing Mechanism A" to two claims, "Air-conditioner device stated in Claim 1 containing Mechanism A" and "Air-conditioner device stated in Claim 2 containing Mechanism A." This case includes rewriting the relevant claim without citing these claims.

### 3. Correction of an Error (Patent Act Article 126 (1) (ii), Former Utility Model Act Article 39 (1) (ii), Patent Act Article 134-2 (1) (ii), Article 120-5 (2) (ii))

(1) "Correction of an error" refers to correcting an error to a word or phrase, in a case where it is clear from the statements in the description, scope of claims or drawings that the word or phrase implies original meaning, and refers to one for which the statement before the correction is objectively recognized as naturally indicating the same meaning as the statement after the correction (Notes 1 and 2).

(Note 1) Where a drawing attached to the registered utility model application contains an error, it shall be allowed to interpret the scope of rights of the utility model right by correcting the error even without rendering of a trial decision to correct (court decision of the Hirosaki Branch of the Aomori District Court, May 22, 1972 (1971 (Yo) No. 2, Mutaishu, Vol. 4, No. 1, page 313).

(Note 2) As far as the statement of the scope of claims is concerned, correction of an error shall be allowed only where a person ordinarily skilled in the art or other third parties understand that the statement before the correction naturally indicates the same meaning as the statement after the correction, and the statement of the detailed explanation of the invention must be taken into consideration only to the extent that it serves as material for making a determination in this regard (court decision of the First Petty Bench of the Supreme Court, December 14, 1972 (1966 (Gyo-Tsu) No. 1), Minshu, Vol. 26, No. 10, page 1888, Hanji, No. 692, page 18, Hanta, No. 297, page 220; court decision of the Tokyo High Court, December 25, 1973 (1969 (Gyo-Ke) No. 10), Mutaishu, Vol. 5, No. 2, page 530; court decision of the Intellectual Property High Court, 2006 (Gyo-Ke) No. 10204).

(2) In order that correction of an error is allowed, the error must exist in the statements in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any).

(3) Where it is clear that a statement in a claim is an error per se or in relation to the statements in the description at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any) and the correct statement is determined as an obvious matter from the whole statements in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any), the correction to change the error to the correct statement neither substantially enlarges nor alters the scope of claims.

On the other hand, where a correct statement is determined only by taking into consideration the description originally attached to the application or foreign-language documents, it is necessary to examine whether the correction substantially enlarges or alters the scope of claims through a new comparison of the scopes of claims before and after the correction (→ 8.).

(4) Regarding correction of Japanese particles "te, ni, wo, ha," the purpose of a correction must also be made clear as correction of an error if the correction is intended for correction of an error.

However, where correction is to rewrite "および (*oyobi* in Hiragana characters)" into "及び (*oyobi* in Hiragana and Kanji characters)" and it is incidental to another correction, the purpose of correction shall not have to be indicated.

#### 4. Correction of a Mistranslation (Patent Act Article 126 (1) (ii), Article 134-2 (1) (ii), Article 120-5 (2) (ii))

"Correction of a mistranslation" refers to correcting a statement that has come to have a meaning that differs from its meaning in a foreign-language document due to translation (mistranslation) to a statement that indicates the same meaning as that in the foreign-language document.

In order that correction of a misinterpretation is allowed, the meaning of a statement

in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any) must differ from the meaning thereof in the foreign-language document.

#### 5. Clarification of an Ambiguous Statement (Patent Act Article 126 (1) (iii), Former Utility Model Act Article 39 (1) (iii), Patent Act Article 134-2 (1) (iii), Article 120-5 (2) (iii))

(1) "Clarification of an ambiguous statement" refers to making clear the original meaning of the statement by correcting a deficiency in a statement arising in the description, claims or drawings, such as (1) a statement whose meaning itself is unclear in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any), (2) a statement that is unclear because it causes irrationality in relation to another statement in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any).

(2) In order that clarification of an ambiguous statement is allowed, an unclear statement must exist in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any).

(3) Types of the cases where the purpose of a correction falls under "clarification of an ambiguous statement"

A. When correcting a statement whose content itself is not clear

B. When correcting a statement whose content itself causes irrationality in relation to another statement

C. When making the content of the statement clear by correcting a statement in which the purpose, structure or effect of the invention is technically unclear, etc.

D. Addition of function and effect

E. Addition of a naturally required condition to the scope of claims

Correction of a description that is made to make the description be consistent with the scope of claims along with correction of the scope of claims falls under Type B above. Regarding Type D, a correction is allowed if the structure and function and effect of the invention is explicitly stated in the description, etc. at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any) and the said function and effect is obvious from the statement.

Addition of a new working example or embodiment shall not be generally recognized as being within the scope of the matters stated in the description, scope of claims or drawings at the time of the registration of the establishment of the patent right (or, at the time of becoming final and binding of a trial decision to correct if there is any).

#### 6. Dissolution of the Citation Relation between Claims (Rewriting a Claim that Cites Another Claim into a Claim that Does Not Cite The Said Other Claim) (Patent Act Article 126 (1) (iv), the 2012 Supplementary Provisions Article 19, Former Utility Model Act Article 39 (1) (iv), Patent Act Article 134-2 (1) (iv), Article 120-5 (2) (iv))

In relation to correction of the scope of claims, "dissolution of the citation relation between claims (rewriting a claim that cites another claim into a claim that does not cite the said other claim) refers to rewriting a statement of a claim, among multiple claims that are not subject to a correction, that has the citation relation in such manner that a claim cites a statement of another claim into a statement that does not cite the statement of the said other claim without changing the content of the statement.

This correction shall be made for the purpose of dissolving the citation relation between claims so as to prevent a claim from being handled as one comprising a "group of claims" (→ 38-01).

Where dissolution of the citation relation between claims and restriction of the scope of claims are conducted in the same correction unit (one single claim), it shall be noted that there is a case where the invention defined by what is stated in the scope of claims after the correction must be one that is independently patentable upon the filing of the patent application (Patent Act Article 126 (7), Patent Act Article 134-2(9)→Patent Act Article 126 (7), Patent Act Article 120-5(9)→Patent Act Article 126 (7)).

(Example of correction that is allowed: dissolution of the citation relation between claims along with deletion of a superordinate claim)

\*Original claims

[Claim 1] Air-conditioner device containing Mechanism A and Mechanism B.

[Claim 2] Air-conditioner device stated in Claim 1 also containing Mechanism C.

[Claim 3] Air-conditioner device stated in Claim 1 or 2 also containing Mechanism D.

[Claim 4] Air-conditioner device stated in Claim 1, 2 or 3 also containing Mechanism E.

\*Claims after the correction (deletion of the original Claim 1)

[Claim 1] (Deleted)

← Correction for restrict the scope of claims

[Claim 2] Air-conditioner device containing Mechanism A, Mechanism B, and Mechanism C.

[Claim 3] Air-conditioner device containing Mechanism A, Mechanism B, and Mechanism D.

[Claim 4] Air-conditioner device containing Mechanism A, Mechanism B, and Mechanism E.

[Claim 5] Air-conditioner device containing Mechanism A, Mechanism B, Mechanism C, and Mechanism D.

[Claim 6] Air-conditioner device containing Mechanism A, Mechanism B, Mechanism C, and Mechanism E.

[Claim 7] Air-conditioner device containing Mechanism A, Mechanism B, Mechanism D, and Mechanism E.

[Claim 8] Air-conditioner device containing Mechanism A, Mechanism B, Mechanism C, Mechanism D, and Mechanism E.

← Correction for dissolution of the citation relation between claims

7. Prohibition of Correction that Adds a New Matter (Patent Act Article 126 (5), Article 134-2 (9) → Article 126 (5), Article 120-5 (9) → Article 126 (5))

When making a correction, the correction must be made within the scope stated in the description, scope of claims or drawings for which a patent was granted, and a correction that adds a new matter shall not be allowed.

The description, etc. that serve as a standard for determining whether a correction adds a new matter is the description, scope of claims or drawings as of the registration of establishment of the patent right (where a correction by another trial for correction or request for correction in a trial for invalidation has already become final and binding, the description, scope of claims or drawings that has already become final and binding). Therefore, for example, if a patent was granted based on the description whose statement as of the filing of the patent application was partially deleted, a correction that restores the deleted part shall not be allowed.

However, a correction for correction of an error or mistranslation may be allowed within the scope of the matters stated not in the description, scope of claims or drawings at the time of the registration of establishment of a patent right but in the description, scope of claims or drawings (foreign-language documents for a patent relating to an application written in a foreign language) originally attached to the application (→ 3., 4.).

## 8. Correction Neither Substantially Enlarges Nor Alters the Scope of Claims (Patent Act Article 126 (6), Former Utility Model Act Article 39 (2), Patent Act Article 134-2 (9) → Patent Act Article 126 (6), Patent Act Article 120-5 (9) → Patent Act Article 126 (6))

(1) Correction that "substantially enlarges the scope of claims" refers to a correction that enlarges the scope of claims by merely correcting the statement of the detailed explanation of the invention or drawings without correcting the scope of claims, in addition to a correction that enlarges the scope of claims by correcting the statement of the scope of claims itself (for example, correction that replaces a matter stated in a claim with an expression indicating a broader meaning).

Correction that "substantially alters the scope of claims" refers to a correction that alters the scope of claims by merely correcting the statement of the detailed explanation of the invention or drawings without correcting the scope of claims, in addition to a correction that alters the scope of claims by correcting the statement of the scope of claims itself (for example, correction that displaces the scope of claims by replacing a matter



stated in a claim with an expression indicating a different meaning) and a correction that alters the subject of the invention.

Examples of corrections that substantially enlarge or alter the scope of claims

A. Correction that partially deletes serial elements in the matters required to define the invention stated in a claim

B. Correction that adds elements in an alternative form in the matters required to define the invention stated in a claim

C. Alteration of a matter required to define the invention stated in a claim to a generic concept

D. Replacement of a matter required to define the invention stated in a claim

E. Correction that broadens or displaces a numerical limitation stated in a claim

F. Correction that changes the category of the invention, specifically, from an "invention of a process" or "invention of a process for producing a product" to an "invention of a product"

G. Correction of a statement in the detailed explanation of the invention that affects the interpretation of a matter stated in a claim and thereby results in substantially falling under any of A to F mentioned above

(2) Addition of an embodiment or working example, addition of an explanation, theory, or experimental data showing the effect achieved by a product or process subject to a patent shall generally not be recognized as being within the scope of the matters stated in the description, scope of claims or drawings attached to an application even if it does not substantially alter the scope of claims.

9. Invention That Is Independently Patentable Upon the Filing of a Patent Application (Requirements for Independent Patentability: Patent Act Article 126 (7), Former Utility Model Act Article 39 (3), Patent Act Article 134-2 (9) → Article 126 (7), Article 120-5 (9) → Article 126 (7))

(1) Where a correction is made for restriction of the scope of claims (Patent Act Article 126 (1) (i), Article 134-2 (1) (i), Article 120-5 (2) (i)) and correction of an error or mistranslation (Patent Act Article 126 (1) (ii), Article 134-2 (1) (ii), Article 120-5 (2) (ii)),

the invention defined by what is stated in the scope of claims after the correction must be independently patentable upon the filing of the patent application. However, this requirement shall not be imposed on claims for which a request for a trial for invalidation has been filed and claims for which an opposition to grant of patent has been filed.

Moreover, this requirement shall not be imposed either on corrections by deletion of a claim, claims for which a correction is not requested (Note 1), and claims for which only the correction for clarification of an ambiguous statement or dissolution of the citation relation between claims was made.

(Note 1) Whether a correction is requested is determined based on whether a correction is substantially requested. For example, dependent form claims shall be considered as being indirectly corrected if the cited claim is corrected even if the claim itself is not directly corrected.

(2) Where the invention specified by what is stated in the scope of claims after the correction is not patentable under the provisions of Patent Act Article 49, the correction shall, in principle, violate the requirements for independent patentability.

However, Patent Act Article 36 (4) (ii), Article 36 (6) (iv), and Article 37 shall not be applicable by considering that the invention does not violate the provision of Patent Act Article 126 (7) "... allow the invention ... to be patented independently upon the filing of the patent application," taking into consideration the fact that these provisions are not considered as constituting reasons for invalidation (Patent Act Article 123 (1)) or reasons for revocation (Patent Act Article 113(1)).

(3) Example case subject to a determination concerning the requirements for independent patentability (trial for correction)

In the following example, Claims 1 to 3 are subject to a determination concerning the requirements for independent patentability.

In light of the purpose of the correction, Claims 1 and 3 are subject to a determination concerning the requirements for independent patentability, and Claims 4 and 5 are not subject thereto. Although there is no explicit correction item in relation to Claim 2, Claim 2 after the correction cites the restricted Claim 1 after the correction. Therefore, Claim 2 after the correction is substantially restricted compared to Claim 2 before the correction. Consequently, Claim 2 is subject to a determination.

(Example)

Before the correction	After the correction	(Purpose of the correction)
Claim 1 Device containing A	→ Device containing a	(Restriction of the scope of claims)
Claim 2 Device stated in Claim 1 also containing B		
Claim 3 Device containing C	→ Device containing C'	(Correction of an error)
Claim 4 Device containing D	→ Device containing D'	(Clarification of an ambiguous statement)
Claim 5 Device containing E		

## 10. Determination Procedure

When determining whether a correction fulfills the requirements provided in Patent Act Article 126, Article 134-2, and Article 120-5, a determination shall be made on whether the correction fulfills the requirements for purpose provided in Patent Act Article 126 (1) in advance of making a determination concerning the requirements provided in Patent Act Article 126 (5) to (7) (Article 134-2 (9) → Article 126 (5) to (7), Article 120-5 (9) → Article 126 (5) to (7)).

## 11. Effect of Prohibition of Double Jeopardy

Although the provisions of Patent Act Article 167 [the Effect of Prohibition of Double Jeopardy] are not applicable, if requests for correction with the completely same content are repeatedly filed, they are highly likely to reach the same conclusion.

(Revised Sep. 2018)