

## **38-04 P**

### **Purport of the Request for Correction and the Reasons for Correction in a Written Request for (Trial for) Correction**

#### **1. How to State "Purport of the Request"**

In the "Purport of the request" column in a written request for a trial for correction or written request for correction, the patentee shall indicate the patent right subject to the correction and specify the content and scope of the correction in relation to the patent right, and also state a trial decision, etc. (correction) for which the patentee requests.

This " Purport of the request" column explicitly indicates whether the request is filed " for the whole patent right" or "on a claim-by-claim basis." In the case of filing a "request for correction on a claim-by-claim basis," the patentee shall state this column in such manner that the unit of request (on a claim-by-claim basis or on the basis of each group of claims) is clear (→ 38-00).

Specifically, the purport of the request shall be stated as indicated in Tables 1 and 2 below (Regulations under the Patent Act Article 46-2 (1), Form No. 61-4 Remark 1, Form No. 62 Remark 5, Form No. 63-2 Remark 2).

The "Purport of the request" column shall be stated according to the content of the requested correction. For example, where the content of the requested correction is only correction of the scope of claims, the patentee shall state "Attached corrected scope of claims" in the "Purport of the request" column (see 38-05 regarding preparation of the corrected description and scope of claims).

In the case of filing a "request for correction on a claim-by-claim basis," the claim subject to the correction shall be identified by the number assigned to the claim after the correction. At this moment, in the case of deleting Claim A, Claim A shall be also stated in the column.

Incidentally, regarding a group of claims, whether claims subject to a request constitute a group of claims is determined based on the statement of the scope of claims before the correction. However, when dissolving the citation relation, a request for correction may be filed based on a unit of request that does not include the citing claim before the correction by filing "a request that a claim be a different unit of correction."

However, if a correction of a claim for which a correction that dissolves the citation relation was made is not allowed, the request that the claim be a different unit of correction will not be also allowed. In a statement that the correction is allowed in the conclusion of a trial decision or decision, claims shall be indicated separately on the basis of each unit of correction for which correction is allowed. For example, a group of claims shall be indicated by brackets, like Claims [3 to 5].

Table 1 Example: How to state the "Purport of the request" column in a written request for a trial for correction

Unit of request	"Purport of the request" column
In the case of filing a "request for a trial for correction for the whole patent right"	The patentee requests that the JPO renders a trial decision that allows the correction of the description and scope of claims (and drawings) of Patent No. XXXXXXXX as described in the corrected description and scope of claims (and drawings) attached to the written request for a trial for correction.
In the case of filing a "request for a trial for correction on a claim-by-claim basis)	The patentee requests that the JPO renders a trial decision that allows the correction of the description and scope of claims (and drawings) of Patent No. XXXXXXXX as described in the corrected description and scope of claims (and drawings) attached to the written request for a trial for correction <u>in relation to Claims X, X, X to X after the correction.</u>

Table 2 Example: How to state the "Purport of the request" column in a written request for correction

Unit of request	"Purport of the request" column
In the case of filing a "request for correction for the whole patent right"	The patentee requests correction of the description and scope of claims (and drawings) of Patent No. XXXXXXXX as described in the corrected description and scope of claims (and drawings) attached to the written request for correction.
In the case of filing a	The patentee requests correction of the description and scope

"request for correction on a claim-by-claim basis"	of claims (and drawings) of Patent No. XXXXXXXX as described in the corrected description and scope of claims (and drawings) attached to the written request for correction <u>in relation to Claims X, X, X to X after the correction.</u>
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## 2. How to State "Reasons for the Request"

The "Reasons for the request" column shall be stated in separate sections, like the "Background of the registration of establishment," "Correction items," and "Reasons for the correction" sections. In the case of filing a request for correction on a claim-by-claim basis, the patentee shall separate the "Reasons for the request" column into sections based on each unit of request for correction (on a claim-by-claim basis or on the basis of each group of claims) and then state the reasons in separate sections, like the "Background of the registration of establishment," "Correction items," and "Reasons for the correction" sections (Regulations under the Patent Act Article 46-2 (2), Form No. 61-4 Remark 2, Form No. 62 Remark 7 C, Form No. 63-2 Remark 3).

### (1) "Background of the Registration of Establishment"

The patentee shall state the background from the filing of the application to the registration of establishment of the patent right (including the filing date, registration date, etc.) regarding the patent for which a request for a trial for correction or request for correction is filed (or a claim, etc. of the patent right subject to the request) in the "Background of the registration of establishment" column.

In addition, where a correction has already been allowed for the said patent by an earlier request for a trial for correction or request for correction, the patentee shall also state the background in relation to the procedure for the correction.

### (2) "Correction Items"

Where a correction includes wide-ranging correction items, the patentee shall state the content of the correction in a specific and clear manner by separating the "Correction Items" column into sections on the basis of each correction item in order to make it possible to accurately specify each correction item.

Incidentally, in the case where the number of claims is increased or reduced, it is desirable that the patentee prepares a correspondence table of claims before and after the

correction in this column.

(3) "Reasons for the Correction"

The patentee shall state explanations about the following items.

A. Explanation about a group of claims

Where there is a correction relating to a group of claims, the patentee shall explain what claims constitute the "group of claims" based on the statement of the scope of claims corrected by the corrected description, etc. (Patent Act Article 120-5 (4), Article 126 (3), Article 134-2 (3), Regulations under the Patent Act Article 46-2).

B. Explanation about the fact that a correction item complies with all the requirements for correction

The patentee shall state the "Reasons for the correction" column in separate sections so that each section corresponds to a correction item. Specifically, the patentee shall explain the fact that a correction item complies with all the requirements for correction with respect to each correction item stated as described in (2) above (Patent Act Article 126, including the case where said Article is applied mutatis mutandis pursuant to Article 120-5 and Article 134-2). For example, the patentee shall explain the purpose of the correction, the fact that the correction is not one that substantially enlarges or alters the scope of claims, the fact that the correction is one within the scope of the matters stated in the description, scope of claims, or drawings attached to the written application, and the fact that the corrected invention is independently patentable upon the filing of the patent application.

C. Request that a claim be a different unit of correction

In the case of making a correction that dissolves the citation relation or correction that deletes a claim, where the patentee requests that the claim is handled separately from the unit of request to which the cited claim belongs, the patentee shall also state a "request that a claim be a different unit of correction " here (→ 38-01).

D. Explanation about claims relating to the correction of the description or drawings

In the case of filing a "request for correction on a claim-by-claim basis," where the correction of the description or drawings relates to multiple claims, it is necessary to file a request that "all claims" relating to the correction of the description or drawings be

subject to the request (Patent Act Article 126 (4)).

Then, in the case of filing a "request for correction on a claim-by-claim basis," the patentee shall clearly state the correspondence relation with all claims (or a group of claims) that have a relationship with the correction of the description or drawings, and explain that the correction of the "description or drawings" are made to all claims (or a group of claims) relating to the correction (Patent Act Article 131 (3), Regulation for Enforcement of the Patent Act Article 46-2 (2)).

Incidentally, it is also believed that correction of the "description or drawings" will not be taken into account in interpreting a claim about which relation with the correction of the "description or drawings" was not clearly stated. Therefore, it is important to carefully consider the said correspondence relation.

(Revised Sep. 2018)