

51-11 P**Patentee's Request for Correction**

1. Request for Correction

In a trial for invalidation of a patent, the right holder may request correction in a specification, claims, or drawings attached to an application during the procedure for a trial for invalidation (the Patent Act Article 134-2(1)).

(1) Time period within which a request for correction may be made

A request for correction may only be made within one of the periods of time specified below (the Patent Act Article 134-2(1)). A written request for any correction filed other than the specified time period is dismissed as noncompliant with the time requirement upon notification of the reasons for dismissal.

A. A time period for filing a written answer after service of a duplicate of the request for a trial for invalidation (the Patent Act Article 134(1));

B. When a chief administrative judge has permitted amendment to change the gist of the "Reasons for Request" in a written request for trial, a time period for filing a written answer after service of a duplicate of the written amendment of the procedure of the said written request for trial (the Patent Act Article 134(2));

C. A time period for requesting correction in response to a right holder's motion for correction when a trial decision to maintain the right has been rescinded in litigation rescinding a trial decision on a trial (the Patent Act Article 134-3);

D. A time period for filing a written opinion in response to an ex-officio notice of reasons for invalidation (the Patent Act Article 153(2));

E. A time period for requesting correction in response to an advance notice of trial decision (the Patent Act Article 164-2(2)).

(2) Subject for which correction may be requested (→ 38-00)

Since an opportunity for requesting a trial for correction is restricted when a trial for invalidation is pending, a request for correction may also be made for a claim for

which a trial for invalidation is not requested (the Patent Act Articles 134-2(9), 126(7)).

A. Unit of request for correction and a group of claims (→ 38-00 - 01)

B. Correction of specification or drawing (→ 38-02)

(3) Requirements for correction (→ 38-03)

The requirements for correction in a request for correction are the same as those for a trial for correction, except that a requirement that corrections be such as would allow an invention as corrected to be patented independently upon filing a patent application (requirements for independent patentability; corrections are limited to those for restriction of the claims and correction of errors or mistranslations) applies only to claims for which a trial for invalidation has not been requested (the Patent Act Articles 134-2(9), 126(7)).

2. Formal Requirements for a Request for Correction

(1) Written request for correction

A request for correction shall be made by filing a specified written request for correction (Enforcement Regulations of the Patent Act Article 47(2), Form 63-2). A purport of and reasons for the request to be stated in a written request for correction must be described to meet the requirements of description of a written request for correction (the Patent Act Articles 134-2(9), 131(3); Enforcement Regulations of the Patent Act Article 46-2).

To a request for correction, provisions for consent of an exclusive licensee (the Patent Act Article 127), formal requirements for a request for trial (the Patent Act Article 131), and a joint trial (the Patent Act Article 132(3)) are applied mutatis mutandis (the Patent Act Article 134-2(9)) as in a trial for correction.

(2) Purport and reasons for request (→ 38-04)

(3) Corrected specification, etc. (→ 38-05)

(4) Fees (→ 38-06)

(5) Submission of duplicates of the request for correction, etc.

When filing a written request for correction, a corrected specification, etc., a demandee (patentee) shall submit a required number of duplicates thereof (the number of demandants + the number of intervenors + 1 (for the proceedings)) (Enforcement Regulations of the Patent Act Articles 4, 50-4)

3. Handling the Case When Multiple Requests for Correction Are Made

When multiple requests for correction are made in one case of a trial for invalidation, the preceding requests for correction are deemed to be withdrawn (the Patent Act Article 134-2(6)).

However, when corrections made in relating to the preceding requests for correction become final and binding, the request for correction concerning those corrections (wherein a part thereof has become final and binding) is not deemed to be withdrawn.

Accordingly, from the second request for correction onward, a specification, claims, and drawings of a patent based on which the corrections are to be made are the specification, claims, and drawings as registered (or as corrected where corrections already made final and binding exist) and not the corrected specification, corrected claims, or corrected drawings attached to the immediately preceding request for correction.

The provision for “deemed withdrawn” is applied when a request for correction is made multiple times in one case of trial for invalidation but not applied when separate requests for corrections are made in multiple cases of trials for invalidation of the same right.

Even when one request for correction is made in one case of a trial for invalidation of a right and another request for correction is made in another case of a trial for invalidation of the said right, before or after the one said request, the said request for correction in the said case of a trial for invalidation is not deemed to be withdrawn because of such circumstances. As a result, requests for correction in respective cases exist as respective procedures for a trial for invalidation and remain to be subject for proceedings.

(For reference) When multiple trials are pending on one patent right, the following is to be noted:

When a trial decision to allow corrections becomes final and binding, the effects of the corrections are retroactive to the date on which the patent application was filed pursuant to the provisions of the Patent Act Article 128 (effects of corrections → 46-00 3.). Therefore, when multiple trials for invalidation (a trial for invalidation, a trial for correction, an opposition to grant of patent, etc.) are pending on the same patent right and when a trial decision to allow the corrections becomes final and binding in one of the cases, the effects of corrections of the patent right made final and binding extend to all the other cases.

For example, when a request for correction has been made in another case, the subject of correction is changed as a result of the corrections made final and binding, and the judgment as to whether the said request for correction is proper may change, or other effects might be caused.

To prevent such a situation, a chief administrative judge needs to see that proceedings advance properly by, for instance, suspending (→ 26-01 6.) or consolidating (→ 30-03 1.) the proceedings with those of other cases of trial for invalidation.

4. Withdrawal of a Request for Correction

Request for correction may be withdrawn only within the period of time in which an amendment referred to in the Patent Act Article 17-5(2) may be made (the Patent Act Article 134-2(7)). When the request for correction has been withdrawn, the counterparty is notified thereof (Enforcement Regulations of the Patent Act Article 50-5-2).

When a request for correction is withdrawn, the entire request must be withdrawn (the Patent Act Article 134-2(7)).

Accordingly, when only a part of a request for correction is to be cancelled, a procedure for deleting the part of the matters to be corrected must be followed by

amending a written request for correction (the Patent Act Article 17(1)) and amending the specification, claims, and drawings concerning the corrections (the Patent Act Article 17-5(1)) in lieu of withdrawing said part of the request for correction.

Since a request for correction presupposes a trial for invalidation, when a trial for invalidation is withdrawn, the request for correction is also deemed to be withdrawn. Likewise, when a request for a trial for invalidation is withdrawn for each claim, the request for correction is deemed to be withdrawn on a claim-by-claim basis (the Patent Act Article 134-2(8)). (In this case, even when claims constitute “a group of claims” (→ 38-01), only the request for correction relating to the applicable claims on a claim-by-claim basis is deemed to be withdrawn.)

5. Effects of Correction (→ 46-00 3.)

When a trial decision to allow the correction in a trial for invalidation becomes final and binding, a patent application, a publication of the unexamined of a patent application, an examiner’s decision or a trial decision to the effect that the patent is to be granted, and a registration of the establishment of a patent right are all deemed to have been conducted based on the corrected application, etc. (the Patent Act Articles 134-2(9), 128).

A request for correction, unlike a trial for correction, is never made only by concluding that “the correction is allowed” but includes a judgment allowing the correction in the conclusion of a trial decision on a trial for invalidation; thus, the correction becomes effective only at the time when a trial decision to allow the correction becomes final and binding, i.e., at the time when a trial decision on a trial for invalidation becomes final and binding. Accordingly, when litigation rescinding a decision on a trial is instituted over a trial decision on a trial for invalidation where a request for correction is submitted, the trial decision on the trial for invalidation does not become final and binding until litigation is concluded, and the correction takes effect thereafter.

6. Preliminary Registration of a Request for Correction

Because a third party may predict the possibility that a request for correction of a specification, etc. may be filed from a preliminary registration of a trial for invalidation (the Patent Registration Order, Article 3), no preliminary registration to the effect that a request for correction is filed, unlike in a trial for correction.

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