

**51-14 P****Proceedings Following the Submission of a Written Request for Correction**

## 1. Formalities of a Written Request for Correction and the Amendment Thereof

## (1) Matters of proceedings of the formalities of a request for correction

A chief administrative judge and the associated panel conduct proceedings of formalities to determine whether a written request for correction, its appendices, or other similar documents comply with the provisions of the Patent Act Article 131 (the Patent Act Article 131(1)(3)(4)), which are applied mutatis mutandis to the Patent Act Article 134-2(9); whether such documents fall under one of the items of the provisions of the Patent Act Article 133(2); or whether such documents comply with other matters (the Patent Act Article 134-2(9)→the Patent Act Article 127; the Patent Act Article 132(3), etc.). (Procedures for Request for a Trial for Correction → 54-04)

## (2) Amendable noncompliance with formal requirements (the Patent Act Article 133)

When a written request for correction has amendable instances of noncompliance with formal requirements, such as insufficient payment of fees, formal deficiency of the power of attorney, or formal deficiency of a written consent in a case wherein an exclusive licensee exists, but no voluntary amendments have been made, a chief administrative judge orders the patentee to make the amendment within an adequate, specified period of time (normally 10–30 days, depending on the content of the formal deficiency; → 25-01.2) (the Patent Act Article 134-2(9) → the Patent Act Article 133(1); the Patent Act Article 133(2)).

When a purport of and reasons for a request stated in a written request for correction do not comply with the description requirements (the Patent Act Article 131(3); Enforcement Regulations of the Patent Act Article 46-2) (e.g., when a request for correction is not made on a claim-by-claim basis, although a request for a trial for invalidation is made on a claim-by-claim basis; when a group of claims is not

accurately specified; or when not all the claims related to corrections of a specification or drawings are designated as subjects for correction), a chief administrative judge orders the patentee to make amendments within an adequate, specified period of time (normally 30 days (50 days for overseas residents → 25-01.2)).

When the patentee does not correct matters for which correction is ordered, the chief administrative judge dismisses the written request for correction by a decision (the Patent Act Article 134-2(9) → the Patent Act Article 133(3)).

The patentee may institute an action objecting to the decision of the dismissal of the written request for correction in the Tokyo High Court (the Intellectual Property High Court) (the Patent Act Article 178(1)).

(3) Non-amendable noncompliant request for correction (the Patent Act Article 133-2)

When the noncompliance is such that no amendment thereof is permissible (e.g., when a request is made after a specified period of time, or when not all joint owners have jointly undertaken the necessary procedures), the patentee is notified of reasons for dismissal and given an opportunity to file a written explanation, after which a chief administrative judge dismisses the request for correction by a decision (the Patent Act Article 133-2(1)).

The patentee may file a complaint with regard to the decision of dismissal of a request for correction pursuant to the Administrative Complaint Review Act.

When making a trial decision on a case wherein the decision to dismiss a request for correction has been made, the panel adds a statement in the reasons for the said decision to the effect that the request for correction has been dismissed.

(4) Amendment of a written request for correction in response to an order

While an amendment of a written request for correction should not modify the gist thereof, correction of a matter that has been ordered is permitted even when the gist of the written request for correction is thereby modified, provided that such an amendment complies with the said order for correction (the Patent Act Article 131-2(1)(iii)).

(5) Inquiry (the Patent Act Article 134(4))

When examining a request for correction for compliance with the requirements, a chief administrative judge may conduct the required inquiry; for example, when necessarily seeking clarification from a demandant for correction, to clarify the facts, the content of the request, etc.

## 2. Proceedings of the Content of Correction

### (1) Requirements for correction (→38-03)

#### A. Purposes of correction (the Patent Act Article 134-2(1), provisos)

(A) Restriction of the scope of claims (the Patent Act Article 134-2(1), Proviso 1);

(B) Correction of errors or mistranslations (the Patent Act Article 134-2(1), Proviso 2);

(C) Clarification of an ambiguous statement (the Patent Act Article 134-2(1), Proviso 3); and

(D) Removal of dependency between the claims (rewriting a claim that cites another claim into a claim that does not cite the said other claim) (the Patent Act Article 134-2(1), Proviso 4).

#### B. Prohibition of addition of new matter (the Patent Act Article 134-2(9) → the Patent Act Article 126(5))

#### C. Prohibition of substantial expansion and change of claims (the Patent Act Article 134-2(9) → the Patent Act Article 126(6))

#### D. Requirements for independent patentability (claim for which no trial for invalidation has been requested and purposes falling under A (A) or (B) above) (the Patent Act Article 134-2(9) → the Patent Act Article 126(7))

### (2) Examination of corrections and notice of reasons for rejecting a request for correction

The panel conducts a proceeding to identify whether a request for correction meets the requirements for correction based on a written request for correction and descriptions attached thereto, such as an entire specification with corrections.

When conducting an examination to identify whether the requirements for

corrections are met, a judgment is made on each corrected matter's compliance with the requirements for correction.

Prior to judging compliance with the requirements B–D, judgment is made as to whether the requirements regarding the purposes of correction stated in A above are met. For any corrected matter found not to be meeting the requirements regarding the purposes of correction apparently, no further judgment on compliance with other requirements for correction need to be made.

Furthermore, regarding a correction concerning a claim for which no request for a trial for invalidation has been made, when such correction fails to comply with any of the requirements B–C even the correction is requested with regard to the purposes stated in A (A) or (B) above, no judgment on compliance with the requirements for independent patentability stated in D need to be made.

Final judgment on compliance of a requested correction with the requirements for correction is made on the basis of unit of request for correction. More specifically, judgment on compliance of a requested correction is made on the basis of each claim when a request for correction is made on a claim-by-claim basis; judgment is made on the basis of a group of claims when a request is made on a group-by-group basis; and judgment is made on the whole specification when a request for correction is made for the whole specification (a group of claims → 38-01; a correction of the specification or drawings → 38-02). As for a group of claims, for example, even when only a part thereof is found not to comply with requirements for correction, the correction is not admitted as a whole.

When a request for correction clearly does not comply with the requirements for correction and when ex-officio notification of reasons for rejecting a request for correction without awaiting the demandant's assertion help conduct prompt and accurate proceedings, a chief administrative judge notifies both parties and intervenors of the reasons for rejecting a request for correction on the reason of noncompliance with the requirements for correction (results of ex-officio proceedings), giving an opportunity to file an opinion within an adequate, specified period of time (normally

30 days (50 days for overseas residents → 25-01.2) (the Patent Act Article 134-2(5)). A notice of the reasons for rejecting a request for correction may be given in parallel with an opportunity to file arguments as described in (3) below.

When a demandant asserts the illegitimacy of corrections, a notice of reasons for rejecting a request for correction need not necessarily be made, as specified in (3) below.

### (3) Opportunity for a demandant to submit an opinion

When correction is requested, a duplicate of the written request is sent to a demandant to give the demandant an opportunity to state an opinion about the request for correction by submitting a written argument, an oral proceedings statement brief, etc. (opportunity for refutation).

However, a demandant need not be given an opportunity to state an opinion in the following cases:

A. When the request for correction is deemed not to overcome the reasons for invalidation asserted and proved in a written request for trial;

B. When reasons for request for trial for invalidation do not constitute proper reasons for invalidation of a patent that is yet to be corrected:

Example 1: When the reasons asserted by a demandant do not constitute proper reasons for invalidation, regardless of whether a request for correction has been made;

Example 2: When correction is requested only to a part for which no reasons for invalidation have been asserted and to a part for which no correction is requested, no proper reasons for invalidation are constituted.

C. When it cannot be said the necessity for amending a reason for request has arisen due to a request for correction and when it cannot be said there is no rational reason for not having stated such reason for invalidation in the written request at the time of requesting a trial even if a new reason for invalidation has been added by giving a demandant an opportunity to state an opinion (the Patent Act Article 131-2(2)).

Example 1: When corrections in response to a request are minor;

Example 2: When corrections in response to a request involves only deletion of

alternative matters specifying the invention or deletion of the claim(s).

### 3. Patentee's Response to the Notice of Reasons for Rejecting a Request for Correction

(1) A demandee (patentee) who has received a notice of reasons for rejecting a request for correction may file a written opinion and amend a corrected specification, etc. attached to a written request for correction (and also amend the written request for correction for consistency) within a specified period of time. When an exclusive licensee, etc. on a patent right exists, consent to the amendment must be given (the Patent Act Article 127).

A second amendment in a specified period of time is not permitted.

(2) Amendment of a corrected specification, etc. attached to a written request for correction may be amended only within one of the following periods of time (the Patent Act Article 17-5(2)):

A. A time period for filing a written answer (the Patent Act Article 134(1) and (2));

B. A time period for filing a written opinion about an ex-officio notice of reasons for patent invalidation (the Patent Act Article 153(2));

C. A time period for filing a written opinion against a notice of reasons for rejecting a request for correction (the Patent Act Article 134-2(5); the Patent Act Article 134-2(3), 2003);

D. A time period for requesting corrections when a rescission judgment, etc. has been given (the Patent Act Article 134-3, 2011; the Patent Act Article 134-3(1) and (2), 2003); and

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

A written request for correction may be amended before the service of a notice of the conclusion of proceedings (the Patent Act Articles 156(2), 17(1)). However, since the purport of the request in a written request for correction and a corrected specification, etc. should be essentially inseparable and consequently must be amended at the same time, in most cases, a written request for correction maybe amended, in effect, only when amendment of a corrected specification, etc. is permitted.

(3) In response to a notice of reasons for rejecting a request for correction, an amendment is permitted, provided that it does not change the gist of a written request for correction, such as deletion of a matter to be corrected, amendment of a minor defect, etc.

As in amendment of a written request for a trial for correction, adding a new matter to be corrected or changing a matter to be corrected is treated as changing the gist of a written request for correction (the Patent Act Article 134-2(9) → the Patent Act Article 131-2(1)).

However, (1) an amendment in which a matter of correction concerning a claim is changed to a matter of deletion of the said claim and an amendment of a matter of correction concerning a corrected specification, etc. for consistency therewith, and (2) an amendment in which a matter of correction being a matter of deletion of a claim is added and an amendment of a matter of correction concerning a corrected specification, etc. for consistency therewith are not treated as changing the gist of a written request for correction (→ 54-05.1).

(4) After examining a written opinion and an amendment in response to a notice of reasons for rejecting a request for correction, when it is determined that the request for correction still does not comply with the requirements for correction, judgment is made on the reasons for invalidation on the supposition that the correction was not made. When it is determined that a request for correction complies with the requirements for correction, judgment is made on the reasons for invalidation on the premise that the correction should be allowed.

(Revised June 2019)