

**51-22 P****Handling of a Trial  
for Patent Invalidation related to a Trial for Correction****1. Handling of a Trial for Patent Invalidation related to a Trial for Correction**

During a trial for invalidation becomes pending at the Patent Office until a trial decision is made, a trial for correction concerning the same right cannot be requested (the Patent Act Article 126(2)).

However, “When the trial for invalidation becomes pending at the Patent Office” refers to the time when a duplicate of the request for trial is served to the demandee (→54-03). If a trial for correction is requested before serving the duplicate of the filed request for invalidation to the demandee, the Patent Office will hold the trials for invalidation and correction simultaneously.

To promptly and accurately conduct the proceedings both of the trial for invalidation and the trial for correction, understanding the relevance of the both trials is necessary for examination.

**2. Proceedings by the Same Panel**

Because the trials for correction and invalidation are not related to the upper and lower courts, and they are different cases, thus, involvement in the prior trial (→12-04) does not matter. Therefore, in principle, the same panel takes both the trials for invalidation and correction.

**3. Handling When the Trials for Invalidation and Correction Are Simultaneously Pending**

(1) As a rule, prioritize a trial for invalidation.

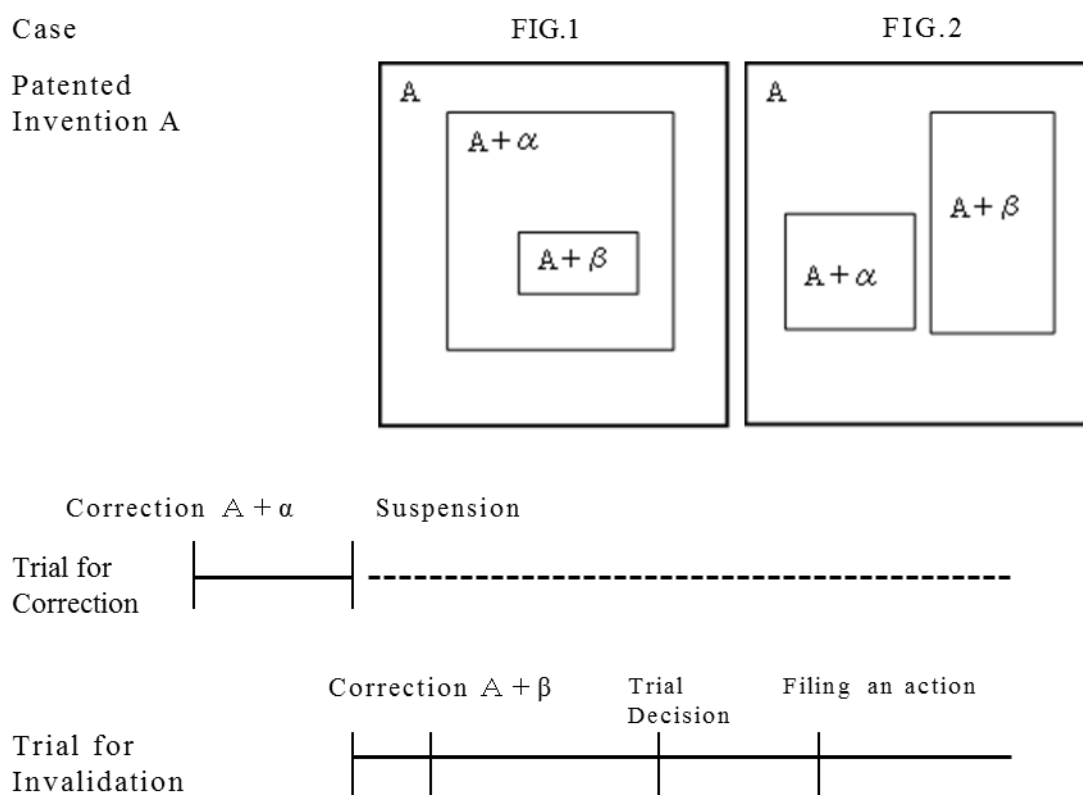
If a trial for correction (the Patent Act Article 126) and a trial for invalidation (the Patent Act Article 123) are co-pending at the Patent Office, in principle, the trial for

invalidation is preferentially examined.

When priority is given to the proceedings of one of the trials, the proceedings of the other trial is suspended as necessary (the Patent Act Article 168(1)), and the party is notified of the suspension.

This is done because (A) while the trial for invalidation is pending, requesting correction can be filed in consideration of all previous circumstances in the trial for invalidation, and examining the request for correction meets the right holder's intention; and (B) in the trial for invalidation which takes an adversarial system, the demandant can make an argument to the request for correction, which contributes to a more accurate trial. This can prevent occurrence of the following cases.

In Figure 1, because the correction  $A + \alpha$  by the trial for correction is restricted by the correction  $A + \beta$  necessary for the trial for invalidation, it is scarcely necessary to perform the trial for correction. Furthermore, in Figure 2, when the correction  $A + \alpha$  is determined, the correction  $A + \beta$  cannot be performed.



## (2) When a trial for correction is preferentially examined

In contrast to the aforementioned situation, if the right holder asserts in the answer that the trial for correction should be examined first because its correction content can sufficiently counter the reason for invalidation, and the panel determines that prioritizing the trial for correction is more appropriate, give priority to the proceedings for the trial for correction. (However, even if the right holder claims that proceedings for the trial for correction should be conducted first, if the content of the correction for the trial for correction is clearly unacceptable, or if it is recognized that the request for the trial for invalidation does not stand regardless of the result of the trial for correction; the trial for invalidation is preferentially examined.)

Additionally, when the trial for invalidation is requested just before the end of the proceedings for the trial for correction and accordingly the proceedings have progressed to a considerable extent, the said proceedings may be prioritized.

## 4. Proceedings of the Subsequent Trial

In principle, the other trial's proceedings are continued immediately after making the trial decision of the trial preferentially examined. At that time, pay attention to the following points.

(1) If a trial for invalidation is preferentially examined and a trial decision to invalidate the right is finalized, the request for the trial for correction shall be dismissed by a trial decision as an unlawful request (the Patent Act Article 135)(Reference: Court Decision of Supreme Court of Japan, the 3rd Petty Bench, April 24, 1984, (1982 (Gyo-Tsu) No. 27)).

Moreover, if a trial decision to accept the request for correction during the trial for invalidation and to maintain the right is finalized, notably, the content of the request for the trial for correction on the premise of the original patent may not be consistent with the patent after the correction is finalized, and thus may not satisfy the correction requirement.

(2) When the proceedings for a trial for correction are prioritized, if the trial decision

to allow correction is finalized and the result of the correction, the subject of the trial for invalidation is changed, the demandant of the trial for invalidation is notified of the contents of the trial for correction (→ Form 1), and is given an opportunity of refutation for filing an opinion on the corrected patent subject to a trial within a specified period of time (Enforcement Regulations under the Patent Act Article 47-3).

If the patentee has not requested correction under the trial for invalidation by the time of the opportunity to refute, and if the demandant of the trial for invalidation has amended to change the gist of the reason for the request at the opportunity to refute, a decision will be made on whether to permit an amendment to change the gist based on the provisions of the Patent Act Article 131-2(2)(ii) (rational reasons not initially stated / consent of demandee (patentee)), but not based on the provisions of the Patent Act Article 131-2(2)(i) (amendments required by the request for correction) . (Because no request for correction exists, and because the trial for correction was requested before the request for the trial for invalidation, it cannot be assumed that the demandee naturally agrees with the demandant to present a new reason for invalidation in response to the request for correction; therefore, the case is handled in this manner.)

(3) When the trial for correction is preferentially examined, a trial decision is made stating that the correction is not permitted, and litigation rescinding a trial decision is filed, proceedings of a trial for invalidation are conducted without waiting for the final trial decision of the trial for correction from the viewpoint of making prompt and accurate determination on the proprieties of the correction and the validity of the patent in the invalidation trial under the adversarial system.

(Revised June 2019)

Form 1

## Notice of the final trial decision to allow a correction to the demandant

## Notice of Final Trial Decision to Allow Correction

Date  
Chief Administrative Judge of the Patent Office

Trial Number: Muko (invalidation) xxxx-xxxx  
 (Patent No.(s)) (Patent XXXX)  
 Demandant  
 Patent Attorney

We hereby notify you of this patent as follows: If you have any opinion, etc. regarding this trial for invalidation case of the patent, please submit it in writing within 30 days on which this notice was dispatched.

## Description

Regarding the specification, etc. of the invention pertaining to the Patent No. XX, a request for a trial for correction was filed (Correction No. XX). A trial decision was made on XX,YY, that was fixed on XX,YY.