

51-23.2 U**Correction in a Trial for Invalidation
of Utility Model Registration**

1. Correction

(1) Correctable range

In the registration of a utility model, a correction may be made to delete the claim (the Utility Model Act Article 14-2(7)).

Regarding any such registration filed on or after April 1, 2005, in addition to the correction aiming to delete a claim(s), correction (A) to restrict the scope of the claims of a utility model registration, (B) to errors, (C) to clarify unclear description, if any, and (D) to dissolve the citation relationship between claims (the statement of the claim that refers to the statement of another claim shall not be cited in the statement of the said other claim) (hereinafter, referred to as “correction such as restriction”) can be done only once (the Utility Model Act Article 14-2(1),(2)). (Note) The correction in (D) above is limited to those on or after March 1, 2012 (Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 3).

Addition of new matter or substantial enlargement or change in the scope of claims in the utility model registration is limited (the Utility Model Act Article 2(2),(3), (4)). If a correction is made that does not meet these requirements, it becomes an invalid reason (the Utility Model Act Article 37(1)(vii) in 2004).

(2) Period till when a correction can be made

A. In principle, a correction to delete a claim is possible at any time without any limitation on the number of times.

However, if a trial for invalidation of the registration of a utility model is pending at the Patent Office, no correction can be made (the Utility Model Act Article 14-2(7)) after the notice of conclusion of the proceedings (the Utility Model Act Article 41 → the Patent Act Article 156(1)) has been received (if proceedings are resumed (the

Utility Model Act Article 41 → the Patent Act Article 156(3)) after the further notice of conclusion of the proceedings has been received). Additionally, the end time of the period that the correction cannot be made after the notice of conclusion of the proceedings shall be until the service of the trial decision of the trial for invalidation of the registration of a utility model. (Note 1)

B. A correction intended to delete a claim can be made even after the extinction of the utility model right, but it cannot be made (the Utility Model Act Article 2(8)) after being invalidated by the trial for invalidation of registration of a utility model (the Utility Model Act Article 37(1)) (Note 2), (Note 3).

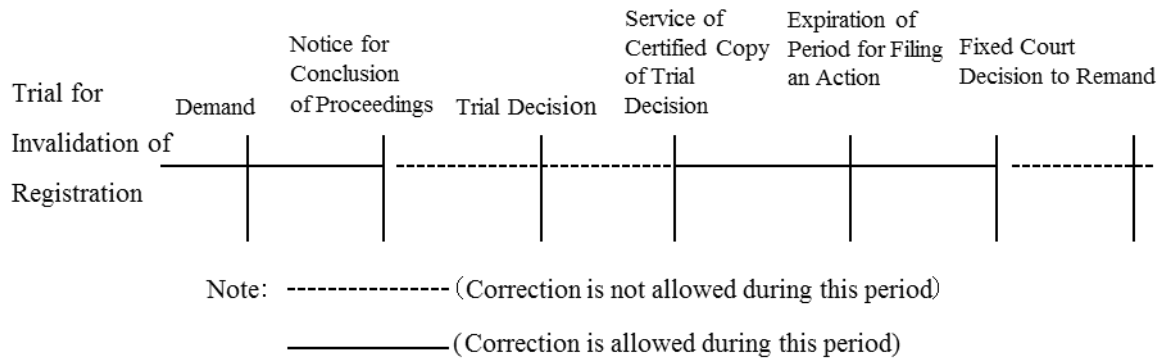
C. By the deadline of two months the date on which a certified copy of the first technical opinion is dispatched for the request of the technical opinion of the first utility model or the submission period of the first answer about the trial for invalidation, whichever is earlier, correction such as restriction can be done only once (the Utility Model Act Article 14-2(1)).

(Note 1) The intent of the law that while the trial for invalidation of the utility model registration is pending, it cannot be corrected after the notice of conclusion of the proceedings is for prompt and accurate proceedings for the validity of the registration of a utility model by preventing the object of the proceedings from being changed by the correction after the proceedings of the trial for invalidation of the registration of a utility model is concluded, and by preventing the proceedings and trial decision drafting done so far from being wasted and having to resume the proceedings. Therefore, after the trial decision of the trial for invalidation of the registration of a utility model is served, making corrections is acceptable.

Additionally, if the decision to remand the trial for invalidation of the registration of a utility model case is fixed by the litigation rescinding the trial decision, it again becomes “pending in the Patent Office” in relation to corrections.

Furthermore, correction of the utility model is a procedure for the Commissioner of the Patent Office, and a correction submitted at a time when it cannot be made is treated as dismissal of procedures. (→21-08)

Here, at the end of the period when the trial for invalidation of the registration of a utility model is “pending at the Patent Office” in relation to submission procedure of the correction, it is handled as shown in the following figure.



(Note 2) When there is a correspondence to the following prescribed in the Utility Model Act Article 37(1)(vi): “After the utility model registration is made, when the utility model right holder becomes a person who cannot hold the utility model right according to the provision of the Patent Act Article 25 (enjoyment of rights by foreign nationals) as applied mutatis mutandis pursuant to the Utility Model Act Article 2-5(3) or when the utility model registration has become in violation of a treaty,” even when the trial decision to invalidate the utility model registration is finalized as per the provision of the proviso of the Patent Act Article 125 to be applied mutatis mutandis to the Utility Model Act Article 41, the utility model right is valid until it becomes to fall under the same item, so corrections can be made (the Utility Model Act Article 41→the Patent Act Article 125).

(Note 3) For a utility model registration claimed two or more claims described in the scope of the claims for the utility model registration, when those for which some claims have become invalid (the latter part of the Utility Model Act Article 37-1), corrections can be made to the remaining claims (the Utility Model Act Article 14-2(8)).

(3) Effect of correction

The correction is effective when appropriate corrections are received and it is considered that the application and establishment of registration have been made according to the corrected description, the claims or the drawings for a utility model registration (the Utility Model Act Article 14-2(11)).

(4) Correction form, etc.

A person who intends to correct a utility model registration must submit a written correction of the registration of a utility model prepared by Form 8, Form 8-2 according to Enforcement Regulations under the Utility Model Act, with a prescribed fee (see the attached table of the Utility Model Act Article 54(2)) (Enforcement Regulations under the Utility Model Act Article 10).

For example, the claim to be deleted is displayed by the claim number.

(5) Handling of formal deficiency or unlawful corrections

A. If there is a deficiency in the form, an amendment (the Utility Model Act Article 2-2(4)) is ordered in the name of Commissioner of the Patent Office. In cases where the deficiency is not resolved, the procedure is dismissed in the name of Commissioner of the Patent Office (the Utility Model Act Article 2-3(1)).

B. If corrections cannot be amended due to unlawful procedures, notify of the reasons for rejection and provide an opportunity to submit a written explanation; then, dismiss the procedures (the Utility Model Act Article 2-5 → the Patent Act Article 18-2(1)).

C. If basic requirements, such as a corrected specification, is deficient, an amendment is ordered (the Utility Model Act Article 14-3) in the name of Commissioner of the Patent Office. Dismiss the procedure in the name of Commissioner of the Patent Office if the deficiency is not resolved (the Utility Model Act Article 2-3(1)).

(Note) Dismissal of procedures other than a written request for trial (→21-08)

2. Related Handling of the Trial for Invalidation of the Registration of a Utility Model and Correction

(1) If the correction is made during the pendency of the trial for invalidation of the registration of a utility model, the duplicate of the written correction must be served to

the demandant (the Utility Model Act Article 39(3)). In the case of a trial for invalidation, because making corrections such as restriction, etc is also possible, a refutation shall be invited as required. (→ 51-13)

Additionally, when a correction of the utility model registration aims only to delete the claim (claims subject to a trial for invalidation may be deleted, but their contents may not be changed), generally, there is no need to provide the demandant an opportunity to file another opinion.

(2) Handling of the trial for invalidation of the registration of a utility model according to corrections

If the correction effects a change in the number of claims and if the purport of the request for a trial for invalidation of the utility model registration is changed accordingly, it is not handled as a change in the gist of the written request. (→51-07 2.)

(3) Permission for amendment to change the gist of reasons for request due to correction

If the demandant corrects the reason for request in response to the correction such as restriction, etc. and if the correction changes the gist of the reason for request (as in the trial for patent invalidation), examine whether the amendment to change in the gist due to the correction is permitted, and determine permission or rejection for the amendment (the Utility Model Act Article 38-2(2)).

(Revised June 2019)