

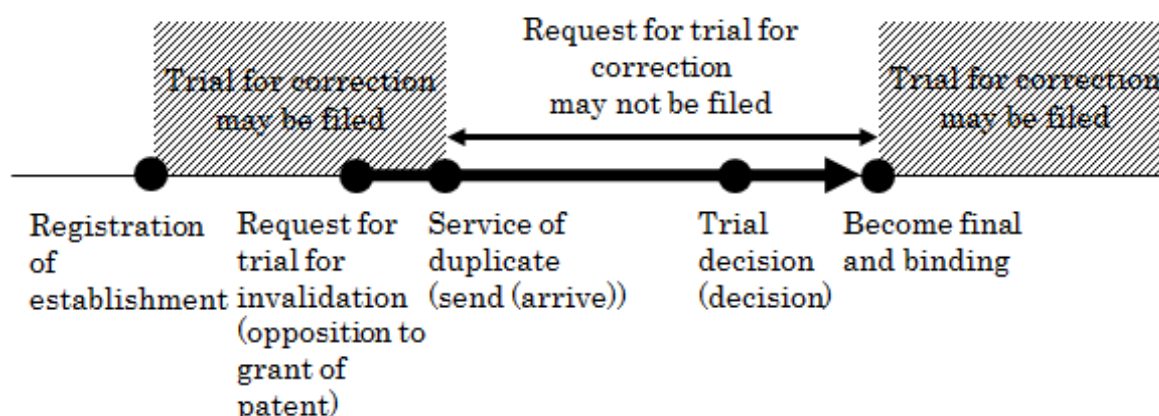
54-03 P

Time Requirements for submission of a Request for a Trial for Correction

1. Time requirements for submission of a Request for a Trial for Correction

A patentee may file a request for a trial for correction after the registration of the patent right's establishment. However, such request may not be filed from the time an opposition to grant of patent or a trial for invalidation has become pending before the Japan Patent Office to the time a decision on the opposition or a trial decision has become final and binding (the Patent Act Article 126 (1) (2)). Similarly, when an opposition to grant of patent or a trial for invalidation has been filed only with regard to part of claims, a request for a trial for correction may not be filed.

Reference Figure: Time Requirements to Request a Trial for Correction



2. Purport of Rejecting a Request during the Pendency of an Opposition to Grant of Patent or a Trial for Patent Invalidation

During the pendency of an opposition to grant of patent or a trial for patent invalidation, if the subject matter of the patented invention—to which an opposition to grant of patent or a trial for invalidation has been filed—is changed by a trial for correction, there is a risk of causing inconvenience in those proceedings. Hence, a correction with the same content as a trial for correction in the form of a request for correction may be filed during the proceedings of an opposition to grant of patent or a trial for invalidation procedures, and thus a request for a trial for correction may not be filed.

3. “Time when an Opposition to Grant of Patent or a Trial for Patent Invalidation Becomes Pending before the Japan Patent Office”

In determining the time during which a request may be made in a trial for correction, the “time when an opposition to grant of patent or a trial for patent invalidation becomes pending before the Japan Patent Office” is the time a duplicate of a written opposition is sent to (or received by) a patentee, or a duplicate of a written request for the trial has been served to a demandee because of the following reasons (1)–(3):

(1) The purport of the provision providing that a request for a trial for correction may not be filed from the time an opposition to grant of patent or a trial for patent invalidation becomes pending before the Japan Patent Office (the Patent Act Article 126 (2)) is to expect an expeditious and precise attack or defense in the examination of the opposition to grant of patent or trial for invalidation by allowing a request for correction of the description, claims, or drawings attached to the application only in the procedure of the opposition to grant of patent or the trial for patent invalidation. Thereby, the purport is also to expect expeditious and precise proceedings.

(2) Meanwhile, the patentee has the right to correct the description, claims, or drawings; hence, such restriction imposed on the right of correction is to be kept to the minimum

for realizing the aforementioned (1) purport.

(3) Points (1) and (2) clarify that an appropriate timing to begin imposing the restriction is when both an opponent or demandant as well as a patentee or demandee participate in the attack or defense, in particular, when a duplicate of the written opposition has been sent to (or received by) the patentee, or a duplicate of the written request has been served to the demandee.

4. Handling of Patent Rights after the Lapse of Patent Rights

(1) A request for a trial for correction may be filed even after the lapse (see Note below) of a patent right. However, such a request may not be filed in case where a patent covering all claims has been revoked by a decision to revoke or has been invalidated by a trial decision to invalidate, resulting from a request for opposition to grant of patent (the Patent Act Article 113) or a trial for invalidation (the Patent Act Article 123 (1); the Patent Act Article 126(8)). In addition, the following points (2)–(4) should be noted.

(Note) Examples of lapse:

- Expiration of the duration of a patent rights (the Patent Act Article 67)
- Absence of a successor (the Patent Act Article 76)
- Waiver (the Patent Act Article 97)
- Unpaid Fees (the Patent Act Article 112 (4))
- Revocation by the Antimonopoly Act (the Antimonopoly Act Article 100)

(2) After a grant of a patent, in a case where the patentee has become unable to hold a patent right under the Patent Act Article 25 (enjoyment of rights by foreign nationals) or the patent has violated a treaty (the Patent Act Article 123 (1) (vii)), even if a trial decision to the effect that the patent is to be invalidated has become final and binding, the patent is deemed valid until invalidated under the same Articles (proviso of the

Patent Act Article 125); therefore, a request for a trial for correction may be filed for the patent before it falls under the same Articles.

(3) In the scope of claims, wherein a patent covering two or more claims is partially invalidated (second half of proviso of the Patent Act Article 123 (1)), a request for a trial for correction may be filed for remaining claims (the Patent Act Article 185).

(4) A request for a trial for correction may be filed for any number of times unless the patent right has been invalidated under a trial for invalidation or the patent right has been cancelled under an opposition to grant of patent.

(Revised Jun.2019)