

54 - 04 P

Procedure for a Trial for Correction

1. Written Request for a Trial (See also the Description Example below)

(1) General matters

A. A person filing a request for a trial for correction shall submit a written request complying with formal requirements (the Patent Act Article 131(1),(3)); Enforcement Regulations under the Patent Act Article 46, Form 62).

B. The duplicates of a written request, attached documents, and an evidence (drawing, sample, and model in the case of an object to be inspected) shall be submitted for proceedings (Enforcement Regulations under the Patent Act Article 50-4; Enforcement Regulations under the Patent Act Article 50(2), (3)).

(2) Purport of a request (the Patent Act Article 131 (1)(iii)) (→ 38-04-1.)

(3) Reasons for a request (the Patent Act Article 131 (1)(iii); the Patent Act Article 131 (3); Enforcement Regulations under the Patent Act Article 46-3) (→ 38-04-2.)

(4) Documents attached to a written request (→ 38-05)

Where there is an exclusive licensee, a pledgee, or a specific non-exclusive licensee (i.e., a person has the right to a non-exclusive license on an invention in service), the patentee shall submit a document proving the consent of said person(s) for the correction (the Patent Act Article 127; Enforcement Regulations under the Patent Act Article 6). In the absence of the submission, the written request for a trial shall be dismissed (the Patent Act Article 133 (3)).

(5) Fees (→ 38-06)

2 Non-compliance with Formal Requirements and Dismissal of a Written Request by Decision

When a request for a trial does not comply with the provisions of the Patent Act Article 131 (1), (3), and (4) or falls under any items of the Patent Act Article 133 (2) (see Examples A–C), the chief administrative judge may order a requester to amend it (the Patent Act Article 133 (1), (2)) and if the requester does not submit such amendment, the chief administrative judge may dismiss the written request by a decision (the Patent Act Article 133 (3)) (→ 21-02, 21-03, 44-00).

(Examples of dismissal by a decision after an order of amendment)

A. A corrected description, claims (full text), or drawings are not attached (→38-05-1.).

It is imperative to prepare the corrected description, claims, or drawings according to the Form 29, 29-2, or 30 stipulated in Enforcement Regulations under the Patent Act Articles 24, 24-4, and 25.

Where a request for a trial for correction in relation to one case has been filed with selectable multiple corrected descriptions, claims, or drawings attached thereto, an amendment shall be ordered to change to the request for a trial concerning only one of the corrected descriptions, claims, or drawings to conduct the proceedings.

B. The purport of the request and the reason therefor are absent or do not meet the description requirements (→38-04.).

For instance, when “a group of claims” is not precisely identified or all the claims related to the correction of description or drawings are not the subject of the request, the said description requirements are not met, and consequently, the chief administrative judge shall order the requester to make amendment of the purport of the request (with the reasons therefor).

C. Consent of an exclusive licensee, a pledgee, or a specific non-exclusive licensee is absent (the Patent Act Article 127) (→ 1. (4)).

3. Other Non-compliance with Formal Requirements and Dismissal of Request by a Trial Decision

Even if a written request for a trial complies with formal requirements, etc. (the Patent Act Article 131 (1), (3), and (4); Article 133 (2)), the request may be dismissed by a trial decision wherein the request is essentially unlawful and not amendable (the Patent Act Article 135).

(Examples of dismissal by a trial decision)

- A. The requester is not a patentee and has no subrogated right of demand (the Patent Act Article 126 (1)).
- B. A request for a trial is not jointly filed by all the joint owners of a patent right at the time of filing the request in relation to the patent right under joint ownership (except where affirmative inference of the compliance is possible) (the Patent Act Article 132 (3)) (→ 22-03-3. (2)).
- C. A request for a trial for correction is filed at the time when such a request may not be filed (the Patent Act Article 126 (2)) (→ 54-03-1.).
- D. The patent is invalidated (the Patent Act Article 126 (8)) (→ 54-03-4.).

4. Amendment to a Written Request for a Trial

(1) In a trial for correction, amendment to a written request may be made (the Patent Act Article 17 (1)) until a notice of the proceedings' conclusion is issued (the Patent Act Article 156 (1)), or until further notice of the proceedings' conclusion is issued in the case of the resumption of the proceedings (the Patent Act Article 156 (3)).

(2) Where the gist of the request is changed as per the said amendment; for example, a correction item has been added by the amendment, such an amendment may not be adopted.

However, this shall not apply to the amendment to reasons for the request (the Patent

Act Article 131-2(1)(i)) and to a matter that is specifically ordered to be amended by the chief administrative judge (the Patent Act Article 131-2(1)(iii)) (→30-01, 54-05.1).

5. Abandonment or Withdrawal of Request for a Trial (→43-01~ 05)

Form: Example of correction to restrict the scope of claims and to dissolve the citation relationship between claims in “a group of claims”

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(60,500 yen)

Written Request for a Trial

YY/MM/DD

To: The Commissioner of the Japan Patent Office

1. Indication of Trial Case Trial case for correction of Patent No. xxxxxxxx
2. The Number of Claims Concerning the Request for the Trial 2
3. Requester

Address (Domicile): 2-2-1 Toranomom, Minato-ku, Tokyo

Telephone No.: 03-xxxx-xxxx

Facsimile No.: 03-xxxx-xxxx

Name: Tokyo Corporation

Representative: Taro SHINPAN

4. Agent

(Identification No.: 100XXXXXX)

Address (Domicile): 3-4-2 Kasumigaseki, Chiyoda-ku, Tokyo

Telephone No.: 03-xxxx-xxxx

Facsimile No.: 03-xxxx-xxxx

Name: Patent Professional Corporation, xxxx Office

Representative: Hanako DAIRI

Contact: Jiro DAIRI, Patent Attorney in charge

5. Purport of the Request

The requester requests that a trial decision to correct Claims 1 and 2 of Patent No. xxxxxxxx—as shown in corrected claims attached to the present written request for the trial—be granted.

6. Reasons for the Request

(1) History of the Registration of Establishment

Application	YY/MM/DD
(Claim of priority	YY/MM/DD)
Publication of unexamined application	YY/MM/DD
...
Decision to grant a patent	YY/MM/DD
Registration	YY/MM/DD
Publication of Gazette containing the patent	YY/MM/DD
	(Patent Publication No. xxxxxxx)

(2) Correction Items

A. Correction Item 1

In the scope of claims, correction is made in Claim 1 to replace “an anti-slip member composed of a tube having air permeability” with “an anti-slip member composed of a tube having air permeability provided with a large number of mesh-like openings.”

B. Correction Item 2

In the scope of claims, correction is made in Claim 2 to replace “A ballpoint pen described in Claim 1, wherein the tube having air permeability has a large number of small projections on an outer surface thereof” with “A multi-core ballpoint pen configured to accommodate a plurality of ink cores within a shaft tube and project a pen point of each of the ink cores from a tip end hole of the shaft tube by selectively moving an operation part forward, wherein an anti-slip member made of a different material from that of the shaft tube and composed of a tube having air permeability with a large number of small projections on an outer surface is fitted to a grip portion at the tip end side of the shaft tube.”

(3) Reason for the Correction

A. Explanation of a Group of Claims

With regard to Claims 1 and 2 before correction, Claim 2 cites Claims 1 and Claim 2 is corrected together with Claim 1 as corrected by correction item 1. Therefore, Claims 1 and 2 after correction corresponding to Claims 1 and 2 before correction are claims in a group, as defined under the Patent Act Article 126 (3).

B. Explanation regarding all Correction Items Comply with Correction Requirements

(A) Correction Item 1

a. Purpose of the Correction:

The correction item 1 relates to the correction of Claim 1, involving the replacement of “an anti-slip member composed of a tube having air permeability” with “an anti-slip member composed of a tube having air permeability provided with a large number of mesh-like openings.”

In the patented invention described in the uncorrected Claim 1, a tube composed of an anti-slip member is identified only by having air permeability as “an anti-slip member composed of a tube having air permeability.” However, nothing is identified with regard to how air permeability is composed.

Meanwhile, the patented invention described in the corrected Claim 1 restricts the scope of claims by clarifying a concrete feature of air permeability realized by a tube provided with a large number of mesh-like openings. Thus, the said correction item 1 aims at restricting the scope of claims under proviso 1 to the Patent Act Article 126(1).

b. Correction Does Not Substantially Enlarge or Alter the Scope of Claims:

As evident from the aforementioned reason (A), the correction to item 1 adds the matters specifying the invention in series without altering the category, subject, or objective of the invention; therefore, it does not fall under substantial enlargement or alteration of the scope of claims, thereby complying with the Patent Act Article 126 (6).

c. Correction Falls within the Scope of Matters Described in the Description, Claims, or Drawings Attached to the Application:

The aforementioned correction in item 1 is a feature derived from the first example in the description found in the gazette that contains the patent. To explain the first example, paragraph [0018] describes "...the tube in the grip portion is structured to have a large number of mesh-like openings and therefore can be configured to have air permeability in the gap between mesh-like openings inside the grip portion of a writing tool, thus realizing a tube with excellent air permeability. Such a tube is fitted to a grip portion at the tip end of the shaft tube so that a comfortable sense of grip can be maintained with suppression of stickiness caused by sweat while sustaining an anti-slip function." From such a description, the said correction to item 1 is made within the scope of matters in the description, claims, or drawings attached to the application; thus, it complies with the Patent Act Article 126 (5).

d. Patent Would Have Been Granted Independently at the Time of Filing the Patent Application:

Owing to the following reasons, the invention described in corrected Claim 1 (hereafter, the “present corrected invention 1”) would not have been easily achieved by a person ordinarily skilled in the art of invention from the invention described in Evidence A, No. 1 (Japanese Unexamined Patent Application Publication No. Hxxxxxxx) or that described in Evidence A, No. 2 (Japanese Unexamined Patent Application Publication No. Hxx-xxxxx), which were submitted in the previous ..., and the well-known art, and would have been granted a patent independently at the time of filing the patent application without falling under the Patent Act Article 29 (2).

... [omitted] ...

Thus, it is evident that the present corrected invention 1 would not have been easily achieved from the inventions described in Evidence A, No. 1, Evidence A, No. 2, and the well-known art and that it does not fall under the Patent Act Article 29 (2). As such, it could have been patented independently at the time of filing the patent application and complies with the Patent Act Article 126 (7).

(B) Correction Item 2

a. Purpose of the Correction:

In the scope of claims, correction item 2 is made in Claim 2 to replace “A ballpoint pen described in Claim 1, wherein the tube having air permeability has a large number of small projections on an outer surface thereof” with “A multi-core ballpoint pen configured to accommodate a plurality of ink cores within a shaft tube and project a pen point of each of the ink cores from a tip end hole of the shaft tube by selectively moving an operation part forward, wherein an anti-slip member made of a different material from that of the shaft tube and composed of a tube having air permeability with a large number of small projections on an outer surface is fitted to a grip portion at the tip end side of the shaft tube.”

This correction dissolves citation relation between the claims so that Claim 2 citing Claim 1 will no longer cite it and will be changed to an independent claim with the aim of “dissolving

the description of a claim citing the description of other claims so as not to cite the said other claims” under proviso 4 to the Patent Act Article 126 (1).

b. The Correction Does Not Substantially Enlarge or Alter the Scope of Claims

This correction does not involve substantial alteration to the content and hence complies with the Patent Act Article 126 (5) and (6).

c. Patent Would Have Been Granted Independently at the Time of Filing the Patent Application

Correction item 2 aims at “dissolving the description of a claim citing the description of other claims so as not to cite the said other claims” under proviso 4 to the Patent Act Article 126 (1) and does not aim at the item under requirements of the Patent Act 126 (1) or (2). Therefore, requirements of independent patentability under the Patent Act 126 (7) are not imposed on correction item 2 according to Claim 2.

C. Different Unit of Correction Is Required:

With regard to Claim 2 after correction, where the correction is accepted in said claim, filing a correction separate from the correction of other claims that comprise a group of claims is required.

7. List of Documents or Evidence Attached

(A) Corrected Claims	1 Original, 1 Duplicate
(B) Written Consent	1
(C) Duplicate of a Written Request for a Trial	1

(Revised December 2020)