

54-07 P

Trial Decisions in a Trial for Correction and Registration of a Trial Decision

1. Trial Decision in a Trial for Correction

A Trial decision in relation to a trial for correction is divided into the following four types:

- (1) Approval of the request (The correction is allowed.)
- (2) Partial approval of the request (Part of the correction is allowed.)
- (3) Disapproval of the request (The correction is not allowed.)
- (4) Dismissal of the request (the Patent Act Article 135)

2. Description in a Trial Decision (→45-01-20)

3. Final and Binding a Trial Decision (→46-00)

4. Effects of a Trial Decision

(1) Where a trial decision, which allows a correction of the description, claims, or drawings attached to the application, has become final and binding, the filing of the patent application, publication of the patent application, the examiner's decision or the trial decision to the effect that the patent is to be granted, and the registration of the establishment of the patent right shall be deemed to have been made on the basis of the corrected description, claims, or drawings (the Patent Act Article 128).

(2) Where a trial decision (limited to the trial decision provided by the Cabinet Order), to the effect that a correction is to be made, has become final and binding after a final and binding ruling in an infringement case, etc., a request for a retrial of

the final and binding ruling, based on reasons that the correction has become final and binding, shall be restricted (the Patent Act Article 104-4 (iii); the Order for Enforcement of the Patent Act Article 8).

5. Registration, etc.

(1) Preliminary registration of a request for a trial

A request for a trial for correction that has been filed shall be preliminarily registered in the patent registry (the Patent Registration Order Article 3 (iv)).

The preliminary registration shall be made by recording, in the indication part, the date on which the request for trial was filed, the trial number, and the purport of the request (the Regulations under Patent Registration Order Article 38).

(2) Registration of a final and binding trial decision

The Commissioner of the Patent Office may register, ex officio, a final and binding trial decision on a trial for correction (the Patent Registration Order Article 16 (x)), and the said registration shall be made by recording, in the indication part, the trial number, the effect that the trial decision has become final and binding, the date thereof, and the outline of the final and binding trial decision (the Regulations under Patent Registration Order Article 37(1)). Additionally, where a request for correction has become final and binding because of a partially final and binding trial decision (→46-00), the Commissioner shall recognize the final and binding part and register the fact that the trial decision has become partially final and binding as “registration of the partially final and binding trial decision.”

The origin of the trial decision is deemed part of the patent registry (the Patent Registration Order Article 9 (3)).

(3) Registration of correction in the description, claims, or drawings

The Commissioner of the Japan Patent Office may register, ex officio, a correction of the description, claims, or drawings attributed to a trial for correction (the Patent Registration Order Article 16 (ii)). Where the patented invention's title has been changed, the changed title shall be registered (the Regulations under Patent Registration Order Article 31 (1)).

Where a request for a correction decision has become final and binding because of a partially final and binding trial decision (→46-00), the correction shall be registered as “registration of the partially final and binding trial decision” in the patent registry.

The description, claims, and drawings of the invention to which a patent is granted are deemed part of the patent registry (the Patent Registration Order Article 9 (2)).

6. Others

(1) Patent Certificate

Where a trial decision, to the effect that a correction of the description, claims, or drawings attached to the application is to be allowed, has become final and binding, and the trial decision has been registered, the Commissioner of the Japan Patent Office shall issue a patent certificate to the patentee (the Patent Act Article 28 [1]; the Patent Registration Order Article 1 [ii]; the Regulations under the Patent Act Article 66).

(2) Trial Decision Gazette

Where a correction of the description, claims, or drawings has been made in a trial for correction, the patent gazette (i.e., corrected description of the patent) shall contain a final and binding trial decision, a corrected description, matters described in claims, and contents of drawings (the Patent Act Article 193(2) (vii) (viii)).

The above patent gazette shall be issued when the case has become final and binding. The Trial Decision Gazette, to be issued when all requests in the case have become final and binding, shall contain the full text of the corrected description (or multiple

corrected descriptions, if any) in an attached form to the trial decision. Where the case has become partially final and binding, the gazette containing the partially final and binding trial decision shall be published containing the partially final and binding information.

(Revised Jun.2019)