

54-00 P

Trial for Correction

1. Purport of the System

A trial for correction ensures a patentee's right to voluntarily correct the description, claims, or drawings attached to an application, to take preventive measures against a request for a trial for invalidation when a patent is partially defective, or to preclude a dispute by clarifying an ambiguous part in a patented invention (the Patent Act Article 126).

A trial for correction is often associated with other cases, including a trial for invalidation, an opposition to grant of patent, a request for advisory opinion (*Hantei*), and an infringement, and might affect the conclusion of a trial and appeal decision, a decision, and/or a court decision. Therefore, conducting the proceedings as early as possible is desirable. When a request for a trial for invalidation or for an opposition to grant of patent has been filed after a request for a trial for correction, request for correction may be filed during the trial for invalidation or the opposition to grant of patent proceedings. Therefore, the request for a trial for correction shall be carefully considered in the proceedings in relation to the request of correction (→51-22, 67-10).

2. History of Law Amendment

(1) Act Amended by Act No. 63 of 2011 (Entered into force on April 1, 2012)

With the amendment, the concept “a group of claims” was introduced, and a prohibition was defined against filing a request for a trial for correction after instituting a suit for canceling a trial decision of a patent trial for invalidation. The Act shall be applicable to a request for a trial for correction filed on or after April 1, 2012 (2011 Revised Act Supplementary Provision 2 (18)).

(2) Act Amended by Act No. 36 of 2014 (Entered into Force on April 1, 2015)

Owing to the introduction of an opposition to grant of patent, the Act was amended defining that a request for a trial for correction cannot be filed from an opposition to grant of patent becomes pending before the Japan Patent Office until a decision of the opposition becomes final. No transitional measure is taken.

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Request for a Trial for Correction

1. Outline

A Request for a trial for correction may be filed with regard to “the description, claims, or drawings attached to the application” (Note: the Patent Act Article 126(1); the Patent Registration Order Article 16 (ii)).

For instance, an application, an abstract, a patent gazette, etc. may not be corrected. (Note) With regard to an application filed on or before June 30, 2003, an amendment or a correction for the description was filed in the previous format (the Supplementary Provision of Ministerial Ordinances Article 2 (1)); therefore, the subject of the request for a trial for correction is “the description or drawings attached to the application.”

“The description, claims, or drawings attached to the application” imply the one(s) at the time of registration of the patent right’s establishment. However, if other trial decisions become final and binding in a trial for correction, a trial for invalidation wherein a request for correction is granted, or a request for opposition to grant of patent wherein a request for correction is granted, before the request of the said trial for correction, the subject of the request is the description, claims or drawings corrected at that time (the Patent Act Article 134-2 (9); the Patent Act Article 128; the 1994 Patent Act Article 120-4 (3); the 1994 Patent Act Article 128).

2. Correction in General (→38-00)

3. Group of Claims (→38-01)

4. Correction of Description or Drawings (→38-02)

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Parties in a Trial for Correction

1. Requester

The requester shall be a patentee (the Patent Act Article 126 (1)).

Where there is an exclusive licensee, a pledgee, or a non-exclusive licensee under provisions of the Patent Act Article 35 (1), the Patent Act Article 77 (4), or the Patent Act Article 78 (1), the patentee may file a request for a trial for correction only with the said person's consent (the Patent Act Article 127). Additionally, submission of a written agreement is required (Enforcement Regulations under the Patent Act Article 6).

When a request is filed by joint owners of a patent right for the right under joint ownership, all said joint owners shall jointly file the request (the Patent Act Article 132 (3)).

When it is recognized that a way of thinking of subrogation right of oblige (the Civil Law Article 423 (1)) can be transferred to the request, for example, when a patentee does not file a request for a trial for correction but an act of filing a request for a trial for correction corresponds to that of preserving self-exclusive license for an exclusive licensee, the exclusive licensee may file the request in place of the patentee.

2. Intervention

Provisions of intervention (the Patent Act Article 148) and application for intervention (the Patent Act Article 149) shall not be applicable to a trial for correction; thereby, intervention is not permitted (the Patent Act Article 166).

(Revised Jun.2019)

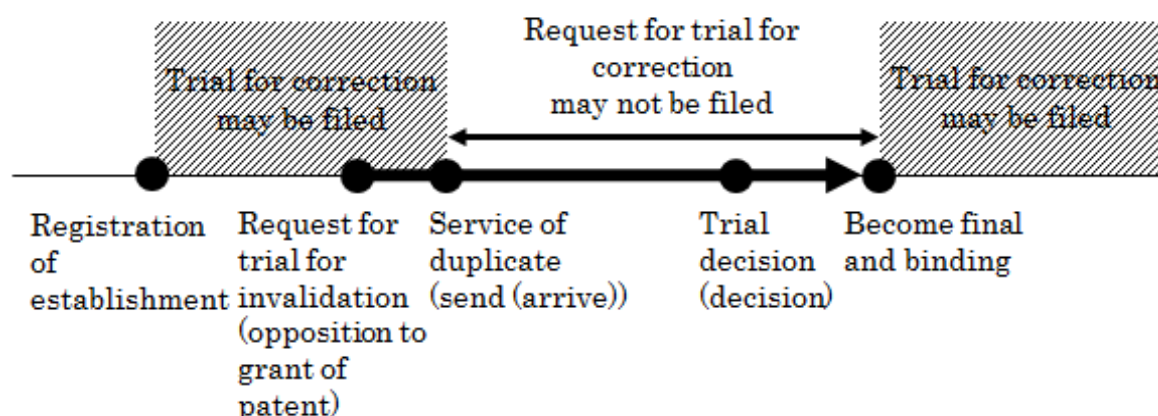
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Time Requirements for submission of a Request for a Trial for Correction

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.

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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”

Patent revenue stamp 50,000	Patent revenue stamp 10,000	Patent revenue stamp 500
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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)

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Proceedings of a Trial for Correction

1. Proceedings of a Trial for Correction

The panel shall determine whether a request of a trial for correction meets the requirements stipulated under the Patent Act Article 126 on the basis of a written request for trial and the statement in the description, claims, or drawings attached thereto (→38-02-03.). Where a request for a trial for correction is filed for each claim (or each group of claims) (→38-00-2.), the correction is judged for each claim (or each group of claims).

2. Notice of Reasons for Rejecting a Request for Correction

(1) Where a request for a trial for correction does not correspond to one of the purposes in the proviso to the Patent Act Article 126 (1) or does not comply with provisions of the Patent Act Article 126 (5), (6), or (7), the chief administrative judge shall notify the requester of reasons therefor and shall provide the requester an opportunity to submit a written opinion by designating an adequate time limit (the Patent Act Article 165).

(2) Examples of reasons for rejecting a request for correction are as follows.

(Example 1) ... Thus, the present request for a trial for correction does not correspond to one of the purposes in the proviso to the Patent Act Article 126 (1).

(Example 2) ... Thus, the present request for a trial for correction does not comply with provisions of the Patent Act Article 126 (5), (6), or (7).

(3) Where a written opinion has not been submitted within a designated time limit, or a written opinion has been submitted, but an opinion has not been adopted, a notice of the conclusion of proceedings shall be issued, and a trial decision of disapproval (in some cases, partial approval) of the request shall be rendered.

(4) Where the purport of the request (such as a correction item) described in a written request for trial has been amended in response to the notice of reasons for rejecting a request for correction, and the gist of the written request has not been changed by the amendment, the amended purport of the request (such as a correction item) shall be further examined. Where the gist of the written request has been changed by the amendment, the said amendment shall not be adopted, and a trial decision shall be rendered with issuance of notice of the conclusion of proceedings. In this case, reasons for the trial decision shall contain refusal of the amendment and reasons therefor (→54-04-4 (2) 54-05.1).

3. Handling Associated with a Trial for Patent Invalidation or an Opposition to Grant of Patent

(1) Handling associated with a trial for invalidation (→51-22)

(2) Handling associated with an opposition to grant of patent (→67-10)

(Revised Jun.2019)

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Amendment Changing the Gist of Written Request for the Trial for Correction

1. Outline

Any amendment to a written request for a trial shall not change the gist thereof (the Patent Act Article 131-2 (1)). A change in the gist refers to a case wherein the identity or scope of the “statement for a trial” on which the request is based, is changed by amending the description of the purport of the request (the correction item) among items described in the written request for the trial (→30-01).

2. Types of Amendment and the Method of Determining Change in the Gist

The purport of the Patent Act Article 131-2 defining change in the gist of a written request for a trial is to prevent a delay in proceedings due to expansion or change of subject of proceedings.

(1) Change by addition

If a change by addition (addition of a correction item) is made in the purport of the request, for example, correction items A (restriction) and B (clarification of an ambiguous description) with item A, item B, and item C (correction of errors), the change by addition is deemed to change the gist of the written request for the trial.

On the contrary, an amendment to add a correction item of deleting a claim, which is to understand that such an amendment deletes the subject of proceedings, or an amendment to add only a correction item of dissolving a citation relation between claims, is not deemed to change the gist of the written request for the trial because no expansion or change of subject of proceedings is caused.

(2) Change by replacement

A reciprocal change in the purport of the request, for instance, replacing correction item A with correction item B, shall fall under a new request in place of the original request; therefore, it is deemed to change the gist thereof.

However, an amendment to change a correction item concerning a claim into the correction item that would delete the claim, and the correction item that the description, claims, or drawings ensures to be consistent with the amendment of deleting the claim, are not deemed to change the gist of the written request for the trial because no expansion or change of the subject of proceedings is caused.

(3) Change by restriction

If a restriction change is made in the purport of the request, for example, replacing correction items A (restriction) and B (errors), only with correction item A (restriction), this action is not deemed to change the gist thereof, in general.

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Remarks in Proceedings of a Trial for Correction

1. Designation of Administrative Judges

Where there are cases of a trial for invalidation and an opposition to grant of patent with regard to the same patent, the same administrative judges shall be designated to constitute a panel in both—trial for invalidation and opposition to grant of patent—with regard to the same patent in principle (→12-04).

2. Procedures of Proceedings

(1) A trial for correction shall be conducted by documentary proceedings.

(2) However, the chief administrative judge may—upon a motion by a party concerned or ex officio—decide to conduct a trial by oral proceedings (the Patent Act Article 145 (2)).

3. Ex Officio Proceedings (→36-01)

Any purport of the request not claimed by the demandant may not be examined in a trial (the Patent Act Article 153(3)).

4. Consolidated Proceedings (→30-03)

Proceedings of trials for correction may also be jointly conducted (the Patent Act Article 154).

5. Inquiry (→37-00)

The chief administrative judge may question concerned parties (the Patent Act Article 134 (4)).

6. Suspension (→26-01)

When deemed necessary during a trial, procedures may be suspended until a decision in another trial has become final and binding or court procedures have been concluded (the Patent Act Article 168).

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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)