

67-05.2 P

Submission of Written Opinion or Written Request for Correction by Patentee

1. Response to a Notice of Reasons for Revocation by a Patentee

(1) Submission of Written Opinion

When reasons for revocation have been notified, a patentee may submit a written opinion within a designated time limit (normally 60 days, or 90 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (1)).

Where a patentee does not wish to receive a notice of reasons for revocation (advance notice of decision) (→ 67-05.5) for the purpose of obtaining an early decision, a patentee shall state a note to that effect in a written opinion (→ 67-05.5-2.).

(2) Request for Correction

A patentee may file a request for correction of the description, scope of claims, or drawings attached to the application (referred to as the "description, etc." in this Chapter 67-05.2) (Patent Act Article 120-5 (2)). A patentee has to obtain consent of an exclusive licensee, etc. if there is any such person (Patent Act Article 120-5 (9) → Patent Act Article 127).

A. Time Limit Allowed for Filing a Request for Correction

A time limit in which a request for correction may be filed is a time limit for submitting a written opinion as designated in a notice of reasons for revocation (normally 60 days, or 90 days for overseas residents, → 25-01.4) (Patent Act Article 120-5 (1)).

B. Object of the Request for Correction (→ 38-00)

Claims of which an opposition to grant of patent has not been filed may be also corrected (Patent Act Article 120-5 (9) → Patent Act Article 126 (7)).

(a) A group of claims and a request for correction (→ 38-01)

(b) Correction of the description or drawings (→ 38-02)

C. Correction Requirements (→ 38-03)

Claims of which an opposition to grant of patent has been filed shall be examined by allowing a correction thereof as long as the correction complies with other correction requirements, without applying a correction requirement that a corrected invention must be one which could have been patented independently at the time of filing of the patent application (requirements for independent patentability).

In contrast, a correction of claims of which an opposition to grant of patent has not been filed, or a correction of a part of claims becomes final and binding upon request for correction that was previously made shall be decided based on requirements for independent patentability in addition to other correction requirements (Patent Act Article 120-5 (9) → Patent Act Article 126 (7)) (→ 51-11-1. (3)).

D. Method of Filing a Request for Correction, etc.

(A) Written Request for Correction

A request for correction shall be filed according to a prescribed written request for correction (Regulations under the Patent act Article 45-3 (2), Form 61-4 in the Regulations under the Patent Act). The object and statement therefor in a written request for correction have to comply with the description requirements of the written request for correction (Patent Act Article 120-5 (9) → Patent Act Article 131 (3), Regulations under the Patent Act Article 46-2).

Provisions concerning the consent of the exclusive licensee, etc. (Patent Act Article 127), formality of request for trial (Patent Act Article 131 (1), (3) and (4)), and joint trial (Patent Act Article 132 (3), (4)) shall apply mutatis mutandis to a request for correction in the same manner as a trial for correction (Patent Act Article 120-5 (9)).

(B) Object of and Reasons for the Request (→ 38-04)

(C) Corrected Description, etc. (→ 38-05)

(D) Fees (→ 38-06)

(E) Submission of Duplicates of Written Opinion, and Written Request for Correction, etc.

To submit a written opinion, a written request for correction, a corrected description, etc., a patentee shall submit a required number of copies (the number of opponents + the number of intervenors + 1 for proceedings) (Regulations under the Patent

Act Article 4, Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-4).

A required number of duplicates shall be described in a notice of reasons for revocation.

(3) Multiple Requests for Correction

When a request for correction has been filed more than once in specific case of an opposition to grant of patent, previous requests for correction shall be deemed to have been withdrawn (Patent Act Article 120-5 (7)).

Therefore, scope of claims, description and drawings at the time of registration of the establishment of the patent right (or, at the time of correction if there is any correction that has already become final and binding) shall become a basis for correction of scope of claims, description and drawings in the second or later request for correction. Corrected scope of claims, description and drawings that are attached to the last written request for correction shall not become a basis.

Furthermore, a final and binding correction shall not be deemed to have been withdrawn by a subsequent request for correction (→ 51-11-3.).

(4) Withdrawal of Request for Correction

A “request for correction” in an “opposition to grant of patent” may be withdrawn only within a time limit for submission of a written opinion as specified in a “notice of reasons for revocation” (including a “notice of reasons for revocation” issued as an “advance notice of decision”) (normally 60 days, or 90 days for overseas residents → 25-01.4) or within a time limit for submission of a written opinion as specified in a “notice of reasons for rejecting a request for correction” (normally 30 days, or 50 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (8), Patent Act Article 17-5 (1)). In this case, when a request for correction has been filed on a claim-by-claim basis or for a group of claims, all of the requests for correction have to be withdrawn (Patent Act Article 120-5 (8), Regulations under the Patent Act Article 45-6 → Regulations under the Patent Act Article 50-2-2). If a person wishes to cancel a part of a request for correction, a portion of correction items may be cancelled through amendment to a request for correction (Patent Act Article 17(1)) as well as

amendment to the description, scope of claims, or drawings concerning the correction (Patent Act Article 17-5(1)).

2. Effects of Correction

Where a decision to grant a correction in an opposition to grant of patent has become final and binding, the filing of the patent application, the publication of patent application, the examiner's decision or the appeal decision to grant the patent, or the registration of the establishment of the patent right shall be deemed to have been made based on the corrected description, etc. (Patent Act Article 120-5 (9) → Patent Act Article 128).

3. Preliminary Registration of Request for Correction

Since it is possible for a third party to predict the possibility of a request for correction of the description, etc. by preliminary registration of an opposition to grant of patent (Patent Registration Order Article 3 iii), preliminary registration of a request for correction shall not be made.

(Revised Sep. 2018)