

67-05.3 P

Proceedings after Submission of Written Opinion or Written Request for Correction

1. Proceedings after Submission of a Written Opinion or a Written Request for Correction, etc.

When a written opinion or a written request for correction has been submitted by a patentee in response to a notice of reasons for revocation, proceedings shall be conducted as follows according to the submitted document.

2. Proceedings in the Case Where Only a Written Opinion Has Been Submitted

When only a written opinion has been submitted in response to notified reasons for revocation without submission of a written request for correction, proceedings shall be conducted without giving an opportunity to submit a written opinion to an opponent (opportunity to submit a written opinion must be given to an opponent when a legitimate request for correction has been filed: Patent Act Article 120-5 (5)) in principle. However, when any question arises within the reasons for revocation determined by the panel upon patentee's allegation, inquiry may be made to the demandant (Patent Act Article 120-8 (1) → Patent Act Article 134(4)).

Based on the above, the panel shall handle the case as follows.

(1) When it is determined that a patent should be revoked, an opportunity to make a correction shall be given to a patentee in principle by a notice of reasons for revocation (advance notice of decision) (→ 67-05.5).

(2) Where it is determined that it is not possible to revoke a patent, a decision to maintain shall be rendered.

3. Proceedings in the Case Where neither a Written Opinion nor a Written Request for Correction Has Been Submitted

Where neither a written opinion nor a written request for correction has been submitted, even if a notice of reasons for revocation (advance notice of trial decision) is further issued, submission of a written request for correction shall not be expected even if a notice of reasons for revocation (advance notice of trial decision) is further issued (→ 67-05.5). Therefore, a decision to revoke a patent (referred to as the "decision to revoke" in this Chapter 67) may be issued without issuing a notice of reasons for revocation (advance notice of trial decision).

4. Proceedings in the Case Where a Written Request for Correction Has Been Submitted

(1) Violation of Formality Requirements and Amendment of Written Request for Correction

A. Handling of the Case of Violation of Formality Requirements of Written Request for Correction which is Amendable

When a written request for correction does not comply with formality requirements due to insufficiency of fees, deficiencies of power of attorney, or deficiencies of written consent of exclusive licensee if there is any exclusive licensee (Patent Act Article 120-5(9) → Patent Act Article 127) while it is amendable, if it has not been amended voluntarily, the chief administrative judge shall order a patentee to amend the written request by designating an adequate time limit (normally 10 to 30 days depending on the contents of deficiencies → 25-01.5) (Patent Act Article 120-5 (9) → Patent Act Article 133 (1), Patent Act Article 120-8 (1) → Patent Act Article 133 (2)).

When the purport of and reasons for filing a written request for correction do not comply with description requirements (Patent Act Article 120-5 (9) → Patent Act Article 131 (3), Regulations under the Patent Act Article 46-3) (e.g., cases where a written correction has not been made on a claim-by-claim basis even though an opposition to grant of patent has been filed on a claim-by-claim basis, where a group of claims has not been specified correctly (including a case where there is a deficiency in a request that a claim be

a different unit of correction), where all the claims relating to a correction of the description or drawings are not the subject to the request, etc.), the chief administrative judge shall order a patentee to amend the written request by designating an adequate time limit (normally 30 days → 25-01.5).

When a patentee, who has been ordered to make an amendment to an item, fails to make such necessary amendment, the chief administrative judge shall dismiss the written request for correction by a decision (Patent Act Article 120-5 (9) → Patent Act Article 133 (3)).

A patentee may file an action before the Tokyo High Court (Intellectual Property High Court) against a decision of dismissal of written request for correction (Patent Act Article 178 (1)).

B. Handling of an Unlawful Request for Correction Which Is Not Amendable

Where a matter which violates formality requirements is not amendable (such as a request filed after the expiry of a time period), the chief administrative judge shall notify a patentee of reasons for dismissal, give the patentee an opportunity to submit a written explanation (Patent Act Article 120-8 (1) → Patent Act Article 133-2 (2)), and then dismiss the request for correction by a decision (Patent Act Article 120-8 (1) → Patent Act Article 133-2(1)).

Appeal may be entered pursuant to the “Administrative Appeal Act” or an action may be made at a district court pursuant to the “Administrative Case Litigation Act” against a decision to dismiss a written request for correction (Patent Act Article 120-8 → Patent Act Article 133-2(1)).

To make a decision on an “opposition to grant of patent” concerning a case in which a decision of dismissal of a “request for correction” has been rendered, a panel shall state a note in its reasoning to the effect that the request for correction has been dismissed.

C. Handling of an Amendment of a Written Request for Correction in Response to the Order

An amendment of a written request for correction shall not change the gist thereof except the reasons for making a request. However, an amendment of an item ordered to amend shall be granted only when it complies with the said order to amend, even if the

amendment changes the gist of the “written request for correction” (Patent Act Article 120-5(9) → Patent Act Article 131-2 (1) iii).

(2) Proceedings of Request for Correction

A. Determination of Whether or Not the Correction is Appropriate

(A) Consideration of Correction Concerning the Scope of Claims

To determine whether a request for correction fulfills with correction requirements, suitability of each correction item with correction requirements shall be determined first.

[Correction Requirements]

- a. Patent Act Article 120-5 (2): Purpose of the correction (any one of restriction of the scope of claims, correction of errors or incorrect translations, clarification of ambiguous description, or elimination of citation of statement of a claim that cites statement of another claim, i.e. elimination of citation)
- b. Patent Act Article 120-5 (9) → Patent Act Article 126 (5): Correction within the scope of the patent description, etc. (or the original description, etc. in the case of correction of errors or incorrect translations) (prohibition of addition of new matter beyond the original text,)
- c. Patent Act Article 120-5 (9) → Patent Act Article 126 (6): Prohibition of enlargement or alteration of the scope of claims
- d. Patent Act Article 120-5 (9) → Patent Act Article 126 (7): Requirements for independent patentability (concerning claims of which no opposition to grant of patent has been filed, and restricted to those which purpose is restriction of the scope of claims, or correction of errors or incorrect translations)

A final determination of suitability of correction shall be rendered according to the unit of the request for correction. For example, suitability of correction shall be determined on a claim-by-claim basis in the case of a request filed on a claim-by-claim basis, based on each group of claims in the case of a request filed for each group of claims, or based on an entire patent in the case of a request filed for the entire patent.

(B) Consideration of Correction Concerning the Description or Drawings

Suitability of correction items in the description or drawings relating to multiple claims shall be determined for each request concerning claims containing the said correction items (or a group of claims).

B. Handling of the Case Where a Request for Correction Does Not Comply with Correction Requirements

When a request for correction does not comply with correction requirements (any of the items in the proviso to Patent Act Article 120-5 (2), Patent Act Article 120-5 (9) → Patent Act Article 126 (5) (6) (7)), a notice of reasons for rejecting a request for correction shall be issued (Patent Act Article 120-5 (6)).

It should be noted in particular that a notice of reasons for rejecting a request for correction shall be issued even if a request for correction of claims of which no opposition to grant of patent has been filed does not comply with requirements for independent patentability (Patent Act Article 120-5 (9) → Patent Act Article 126 (7)), (→ 67-05.2-1. (2) C).

(3) Patentee's Response to Notice of Reasons for Rejecting a Request for Correction

A. In response to a notice of reasons for rejecting a request for correction, a written opinion may be submitted or the corrected description, scope of claims, or drawings (referred to as the "corrected description, etc." in this Chapter 67-05.3) attached to a "written request for correction" may be amended (Patent Act Article 120-5 (6), Article 17-5 (1)). The consent of an exclusive licensee, etc., if any, is required for amendment (Patent Act Article 120-5 (9) → Patent Act Article 127).

B. In response to a notice of reasons for rejecting a request for correction, an amendment such as deletion of correction items, an amendment of minor defects, etc. that do not change the gist of a "written request for correction" may be made.

As is the case with the amendment of a written request for trial for correction, addition of a correction item or change a correction item shall be regarded as change of the gist of a "written request for correction."

However, (i) an amendment to change from “a correction item in a certain claim” to “a correction item to delete the said claim,” and an amendment of a correction item concerning the corrected description, etc. for consistency thereto, and (ii) an amendment to add “a correction item to delete a claim,” and an amendment of a correction item concerning the corrected description, etc. for consistency thereto shall not be regarded as change of the gist of the purport of a request in a “written request for correction” (→ 54-05.1-2.).

C. If it is determined that a request for correction still does not comply with correction requirements after consideration of a written opinion or a written amendment in response to a notice of reasons for rejecting a request for correction, proceedings shall be conducted without allowing the said correction. In contrast, if it is determined that a request for correction complies with correction requirements, proceedings shall be conducted while allowing the said correction.

(4) Time Limit During Which a “Written Request for Correction” or “Corrected Description,” etc. May Be Amended

A “written request for correction” may be amended only when the case is pending before the Patent Office (Patent Act Article 17 (1)). However, the corrected description, scope of claims, or drawings attached to a “written request for correction” may be amended only within the following time limit (Patent Act Article 17-5 (1)).

A. A time limit for submission of written opinion in response to a “notice of reasons for revocation” (including a “notice of reasons for revocation” issued as an advance notice of trial decision) (normally 60 days, or 90 days for overseas residents → 25-01.4) (Patent Act Article 120-5 (1))

B. Period of submission of written opinion in response to 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 (6))

Since the corrected description, etc. is integral with the purport of filing a “written request for correction,” both must be amended at the same time. Therefore, the time limit during which a “written request for correction” may be amended is substantially restricted to a designated time limit for a “notice of reasons for rejecting a request for correction,” which is the same as the time limit during which the corrected description, etc. may be amended.

(Revised Sep. 2018)