

67-10 P

Relationship between Opposition to Grant of Patent and Trial for Correction

1. Handling of a Trial for Correction in the Case Where an Opposition to Grant of Patent is Pending

A request for a trial for correction may not be filed between the time a relevant opposition to grant of patent has become pending before the Patent Office and the time a decision thereof (decision on all the claims when an opposition has been filed on a claim-by-claim basis) has become final and binding (Patent Act Article 126 (2)). When an action seeking revocation of a decision of revocation has been filed before the court, a request for a trial for correction may not be filed until said decision of revocation becomes final and binding.

2. Time Limit to Request a Trial for Correction (→ 54-03)

- (1) A trial for correction requested between the time a relevant opposition to grant of patent has been filed and the time a duplicate of a written opposition has been sent (received) shall be handled as a lawful trial for correction.
- (2) A trial for correction requested after a certified copy of a decision to maintain has been served shall be handled as a lawful trial for correction.
- (3) A trial for correction that has been requested for claims that are not revoked after the time limit for action against opposition decision (30 days from the day of service of a certified copy of a decision, or 90 days shall be added for overseas residents → 25-01.5) (→ 67-06-7.(3)) (Patent Act Article 178 (3) (5)) has expired and a decision to revoke has become final and binding or after the said decision of an filed action (decision on all the claims when an opposition has been filed on a claim-by-claim basis) has become final and binding shall be handled as a lawful trial for correction.

3. Proceedings When an Opposition to Grant of Patent and a Trial for Correction Are Pending Concurrently on a Patent

(1) An opposition to grant of patent and a trial for correction are cases under different categories, therefore proceedings thereof may not be consolidated.

(2) Parallel proceedings of the two cases are possible when the two cases are pending concurrently. However, the following problems arise with parallel proceedings and therefore one of the proceedings shall be prioritized.

A. Since the two cases are different in types of procedures and parties concerned, parallel proceedings may give rise to inconsistency in the timing and contents of procedures, complication of procedures, or inconsistent results therebetween.

B. Where a correction has become final and binding in one of the two cases, the subject of proceedings is changed in the other case and therefore repeated proceedings will be required. Consequently, procedures that have been presented by the Patent Office and the parties will be wasted.

C. Where a patent is to be revoked in an opposition to grant of patent case, it will not be necessary to conduct proceedings in a trial for correction case. Despite this, if parallel proceedings of the two cases are conducted, it may impose an unnecessary burden on the Patent Office and the parties.

(3) When an opposition to grant of patent and a trial for correction are pending concurrently, an opposition to grant of patent shall be prioritized in principle because a request for correction may be filed again in proceedings of the opposition in response to a notice of reasons for revocation in the opposition even if a request for a trial for correction has been filed already.

Where it is evident that a correction submitted in a trial for correction does not comply with the correction requirements, a supplementary note stating that the correction submitted in the trial for correction does not comply with the correction requirements may be added in the reason of a notice of reasons for revocation in proceedings of an opposition to grant of patent.

However, where proceedings of a trial for correction have already progressed to a considerable extent and it is possible to render a trial decision at an early stage, proceedings of the trial for correction shall be prioritized as an exceptional case.

4. Suspension of Procedures

When proceedings of either one of the opposition to grant of patent and the trial for correction are prioritized, proceedings of the other one shall be suspended (Patent Act Article 168 (1)) and a notice of suspension of procedure shall be notified to a patentee, an opponent, requester for trial for correction and an intervenor (→ 51-09-1.).

5. Points to Note When Proceedings Are Prioritized

(1) The Case Where Proceedings of an Opposition to Grant of Patent Has Been Prioritized

Where all the claims have been revoked by an opposition to grant of patent of which proceedings were prioritized and have become final and binding, a trial for correction, which is the other case, has become an unlawful request and therefore the request shall be dismissed by a trial decision (Patent Act Article 126 (8), Patent Act Article 135) (→ 54-04-3.).

Furthermore, where a request for correction has been approved and a decision to maintain has become final and binding in an opposition to grant of patent of which proceedings were prioritized, it should be noted that contents of a request for a trial for correction based on a patent before correction may not be consistent with a patent after a final and binding correction and may not comply with the correction requirements.

(2) The Case Where Proceedings of a Trial for Correction Has Been Prioritized

Where a correction has been granted in a trial for correction of which proceedings were prioritized, an opportunity to submit a written opinion shall be given to an opponent according to the case where a request for correction has been filed in proceedings of an opposition to grant of patent after cancellation of suspension thereof (→ 67-09-4. (2)). Specifically, contents of the said correction (a final and binding written trial decision of a trial for correction) shall be notified to an opponent and an opportunity to submit a written opinion on a patent after

correction shall be given to the opponent by designating an adequate time limit (normally 30 days, or 50 days for overseas residents → 25-01.4).

(Revised Sep. 2018)