

**Comparative Study  
on “Requirements for Post Patent Grant  
Corrections (Amendments)” and Purpose  
of the Requirements  
in Japan, China and Korea**

(in the 10<sup>th</sup> JEGTA Meeting, 12 December, 2023 in Tokyo)

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## **Introduction:**

Since the 1st JPO-CNIPA-KIPO Joint Experts Group for Trial and Appeal (JEGTA) meeting was held in 2013 in Japan, Japan Patent Office (JPO), China National Intellectual Property Administration (CNIPA) and the Korean Intellectual Property Office (KIPO) have continued to conduct comparative studies in the field of patent trials and appeals in order to better understand respective practices.

The topic of the present comparative study, “Requirements for Post Patent Grant Corrections (Amendments),” was proposed during the 10th JEGTA meeting (December 2023). This study mainly focuses on the requirements for corrections (amendments) made by the patentee in the trial proceedings requesting invalidation of the said patent right after the grant of the patent right. We hope that this comparative study will contribute to further improvement in the trial and appeal systems in all three Offices and promote users' understanding of the correction (amendment) requirements and use of the system. The purpose of this comparative study is to compare and identify the various requirements for post-grant corrections (amendments) in each country. This study is based on information provided by each Office as of November 2023.

## **Chapter 1: Characteristics and comparison of post patent grant corrections (amendments) in Japan, China and Korea.**

In this study, we focus on corrections in a trial for invalidation to grant of patent in Japan and Korea, and amendments (corrections) in a trial for invalidation to grant of patent in China. The term “correction(s)” will be used for in this study.

### **1.1 General matters of corrections**

#### **1.1.1 Target of Corrections**

In the JPO and KIPO, the scope of claims, descriptions and drawings are all subject to amendment. In contrast, CNIPA covers only the scope of claims.

#### **1.1.2 Opportunities (Time Limitation) for Corrections**

All three Offices have in common that an opportunity for corrections is given during the period for submitting a written reply, written opinion, etc. in response to a request for invalidation or reasons for invalidation. In addition to this, at the JPO, a designated period for a request for correction to be made at the request of the right holder when a decision to maintain the patent is revoked by a court decision in a revocation action against a trial decision, and a designated period for a request for correction in response to an advance notice of a trial decision. In addition, the CNIPA allows the deletion of a claim or a technical solution included in a claim<sup>1</sup> at any time as long as it is made before the decision on the request for invalidation is made.

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<sup>1</sup> Deletion of a technical solution means the deletion of one or more technical solutions from two or more parallel technical solutions in the same claim.

### **1.1.3 Effect of Corrections**

All three Offices have in common that the effect of the correction is retroactive to the time of filing.

### **1.2 Requirements for Corrections (Substantive Limitation)**

All three Offices have in common that “deletion of claims”<sup>2</sup> and “correction of errors” are allowed. It is also common that so-called “addition of new matter” is prohibited. Although all three Offices allow corrections to restrict/limit/reduce the scope of claims, there are differences in the requirements for such correction to restrict/limit/reduce.

Moreover, the JPO and the KIPO are substantially common in allowing restriction or reduction of the scope of claims and clarification of unambiguous descriptions. They also substantially share the “no substantial enlargement or alteration of the scope of claims.”

The details of the requirements of the three Offices are shown below for each Office.

#### **(1) Japan**

Since corrections are intended to prepare for attacks such as trials for invalidation by remedying the deficiencies in part of the patent in advance, it is sufficient to accept corrections to the minimum extent to achieve such a purpose. Therefore, corrections are limited to those aimed at the matters listed in the following:

- To restrict the scope of claims.
- To correct errors in the description or of incorrect translations.

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<sup>2</sup> “Restriction or reduction of the scope of claims” in the JPO and the KIPO includes deletion of claims.

- To clarify an ambiguous description
- To dissolve citing relations between claims

In addition, the following requirements are imposed:

- Prohibition of addition of new matters.
- No substantial enlargement or alteration of the scope of claims.
- Requirements for independent patentability.

However, the requirements for independent patentability do not apply to claims for which a request for a trial for invalidation has been filed.

## (2) China

Corrections must be made to the causes for invalidation or to the defects identified by the collegial panel. Allowing the patentee to narrow the scope of protection by adding one or several technical features, it is more accurate and flexible for the patentee to overcome the grounds for invalidation raised in the invalidation request or the defects identified by the collegial panel. The principles of corrections are as follows:

- The title of the subject matter of a claim cannot be changed.
- The extent of protection cannot be extended as compared with that in the granted patent.
- The correction shall not go beyond the scope of disclosure contained in the initial description and claims.
- Addition of technical features not included in the claims as granted is generally not allowed.

And corrections are generally limited to the following matters:

- To further limit the scope of claims.

- To correct obvious errors.
- To delete a claim.
- To delete a technical solution.

### (3) Korea

Corrections for the following matters are allowed:

- To reduce the scope of claims.
- To rectify a clerical error.
- To clarify any ambiguous descriptions.

In addition, the following requirements are imposed:

- The correction does not aim to add new matters.
- The correction shall not substantially extend or alter the scope of claims.

And the requirements for independent patentability are not imposed on corrections in a trial for invalidation.

## Chapter 2: Comparative Table of post-grant corrections in Japan, China and Korea

“Post Patent Grant Corrections (Amendments)” in General			
Item	Japan	China	Korea
Type of Corrections (Amendment)	<p>A trial for correction</p> <p>A request for correction in a trial for opposition to grant of patent</p> <p>A request for correction in a trial for invalidation to grant of patent (main target of this Comparative study)</p>	<p>Amendment (corrections) in a trial for invalidation to grant of patent</p>	<p>A trial for correction</p> <p>A request for correction in patent opposition</p> <p>A request for correction in a trial for invalidation</p>
Target of Corrections (Amendment)	Scope of claims, descriptions, drawings.	Scope of claims only	Descriptions (including the scope of claims), drawings
Opportunities (Time Limitation) for Corrections (Amendment)	<p>A request for correction may be filed only within the following designated time limit (Patent Act Article 134-2 (1)).</p> <p>A request for correction not submitted during the designated time limit will be dismissed as it is non-</p>	<p>I. Before a decision on the request for invalidation is made, the patentee may either delete a claim or delete a technical solution contained in a claim.</p> <p>II. The patentee may amend the claims by other ways besides deleting within the time limit for</p>	<p>Within the period specified below:</p> <p>(1) Period for submission of written response (Art. 147 (1));</p> <p>(2) Period for submission of opinions on “grounds not pleaded” when examined <i>ex officio</i> (Art. 159 (1));</p> <p>(3) If the administrative judge deems it necessary to permit a request for</p>



	<p>compliant after a notice of the reason for dismissal is given (the main paragraph of Article 133-2 (1)).</p> <p>(1) Time limit for submitting a written reply upon service of a duplicate of a written request for trial for invalidation (Article 134 (1));</p> <p>(2) Time limit for submitting a written reply after service of a duplicate of the written amendment to the request for trial or appeal where a chief administrative judge allows an amendment to change the gist of the “grounds for the request” in the request for trial or appeal (Article 134 (2));</p> <p>(3) Designated time limit for filing a request for correction at the request of a right holder when a court decision revoking a trial decision to maintain a patent right becomes final and binding in a revocation action</p>	<p>response to:</p> <p>(1) the request for invalidation,</p> <p>(2) causes for invalidation or evidence added by the petitioner,</p> <p>(3) causes for invalidation or evidence not mentioned by the petitioner but introduced by the Patent Reexamination Board (Guidelines for Patent Examination Pt. IV, Ch. 3, Section 4.6.3 ).</p>	<p>correction even after the expiration of the designated period because the petitioner submits any evidence or asserts new grounds for invalidation, he/she may permit the defendant to request a correction within a specified period (Art. 133-2 (1)).</p> <p>(Opportunities for correction (time period) listed above are limited to trials for invalidation)</p>
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	<p>against a trial decision (Article 134-3);</p> <p>(4) Time limit for submitting a written opinion in response to a notice of reasons for invalidation when the case is examined ex officio (Article 153 (2));</p> <p>(5) Time limit for submitting a request for correction in response to an advance notice of a trial decision (Patent Act Article 164-2 (2))</p>		
Effect of Corrections (Amendment)	<p>It shall be deemed that the filing of the patent application, the publication of the patent application, the examiner's decision to grant a patent, etc. have been made based on the corrected description, etc. (Patent Act Article 128, Patent Act Article 128 as applied <i>mutatis mutandis</i> pursuant to Articles 120-5(9) and 134-2(9)).</p>	<p>Any patent right which has been declared invalid shall be deemed to be non-existent from the beginning. (Patent Law Article 47)</p> <p>Where a patent right is declared invalid in part, the part of the patent right so invalidated shall be deemed non-existent from the date of filing, and the part of the patent right that are maintained valid (including the amended claims) shall be deemed existent from the date of filing at the same time. (Guidelines for Patent</p>	<p>When a trial decision to grant the request for corrections in a trial for invalidation becomes final and conclusive, it shall be deemed that filing and laying open the relevant patent application, a decision or trial ruling to grant a patent, and the registration of the grant of the patent have been made according to the corrected specification or drawings (Patent Act Article 136(10)).</p>

		Examination Pt. IV, Ch. 3, Section 5)	
Partially Final and Binding Trial Decisions	<p>A trial decision on a request for trial for correction (correction accepted or not accepted) is an administrative disposition that is separable by determination on each claim or each group of claims. If only a part of the trial decision is maintained in a revocation action against a trial decision on the trial for correction, or if no action against a trial decision is instituted with respect to a part of the trial decision, the portion of the said part that relates to the claim shall become final and binding on a claim-by-claim or group-of-claim basis.</p> <p>[Manual for Trial and Appeal Proceedings 46-00]</p>	Amendments need to be confirmed through an examination decision.	For a patent with two or more claims, if only a part of them becomes invalid, a request for trial for correction can be filed for the remaining parts.

Requirements for Correction (Substantive Limitation)				
Requirements for Correction (Amendment) (Substantial Limitation)	Requirement 1 (Substantial Limitation)	To restrict the scope of claims (Article 134-2 (1) (I))	To further limit the scope of claims (Pt. IV, Ch. 3, Section 4.6.2, 2017 amended)	To reduce the scope of claims (Patent Act Article 136(1)1 as applied <i>mutatis mutandis</i> in Article 133-2(1)).
	Purpose of the Requirement 1	Since corrections (amendments) are intended to prepare for attacks such as trials for invalidation by remedying the deficiencies in part of the patent in advance, it is sufficient to accept corrections to the minimum extent to achieve such a purpose. Therefore, corrections (amendments) are limited to those aimed at the matters listed in requirements 1 - 4.	Allowing the patentee to narrow the scope of protection by adding one or several technical features, it is more accurate and flexible for the patentee to overcome the grounds for invalidation raised in the invalidation request or the defects identified by the collegial panel. Manners of amendments in the invalidation procedure are listed in requirements 1-4.	It aims to reduce the scope of claims by limiting the descriptions in the claim in case when there are possibilities for a patent to be invalidated or revoked because the descriptions that are interpreted to be within the scope of claims include well-known technology.
	Requirement 2	To correct errors in the description or of incorrect translations (Patent Act Article	To correct obvious errors (Pt. IV, Ch. 3, Section 4.6.2)	To rectify a clerical error (Patent Act Article 136(1)2 as applied <i>mutatis mutandis</i> in Article

		134-2 (1) (ii))		133-2(1)).
	Purpose of the Requirement 2	Requirement 2 was added in the Act on the Partial Revision of the Patent Act, etc. of 1994 because there may be cases where a mistranslation of an application written in a foreign language is discovered after the patent is granted.		Rectifying a clerical error is to correct descriptions that fail to express original meanings due to a mistake so that they can deliver originally intended meanings. It should be objectively understood that the descriptions before and after the correction indicate the same meaning.
	Requirement 3	To clarify an ambiguous description (Patent Act Article 134-2 (1) (iii))	To delete a claim (Pt. IV, Ch. 3, Section 4.6.2)	To clarify any ambiguous descriptions (Patent Act article 136(1)3 as applied <i>mutatis mutandis</i> in Article 133-2(1))
	Purpose of the Requirement 3	See the Purpose of Requirement 1.		To clarify an ambiguous description is to clarify its original meaning by correcting insufficient descriptions, including when the description in the specification or drawings itself is not clear or when the description is not clear due to inconsistencies with other descriptions in the specification or drawings, etc.
	Requirement 4	To dissolve citing relations between claims (Patent Act Article 134-2 (1) (iv))	To delete a technical solution (Pt. IV, Ch. 3, Section 4.6.2)	No relevant requirements

	Purpose of the Requirement 4	See the Purpose of Requirement 1.		
	Requirement 5	Prohibition of addition of new matters. (Article 126 (5) as applied <i>mutatis mutandis</i> pursuant to Article 134-2 (9))	<p>(1) the title of the subject matter of a claim cannot be changed;</p> <p>(2) the extent of protection cannot be extended as compared with that in the granted patent (Implementing Regulations of the Patent Law Rule 69);</p> <p>(3) the amendment shall not go beyond the scope of disclosure contained in the initial description and claims (Art 33);</p> <p>(4) addition of technical features not included in the claims as granted is generally not allowed.</p> <p>(Pt. IV, Ch. 3, Section 4.6.1)</p>	The correction does not aim to add new matters (Patent Act Article 136(3) as applied <i>mutatis mutandis</i> in Article 133-2(4))
	Purpose of the Requirement 5	This indicates the scope of within which corrections may be made. Post-grant corrections must be made within the scope of the description, claims or drawings in which a patent was granted. Therefore, corrections that add so-called new matters are not		In order to prevent unexpected damages to the third persons, the corrections of specification or drawings shall be made within the scope of descriptions in the specification or drawings of the patented invention. However, when rectifying clerical errors, corrections can be made

		allowed.		within the scope of descriptions in the original specification or drawings in the initially attached to the application.
	Requirement 6	No substantial enlargement or alteration of the scope of claims (Patent Act Article 126 (6) as applied <i>mutatis mutandis</i> pursuant to Patent Act Article 134-2 (9))		The correction shall not substantially extend or alter the scope of claims (Patent Act Article 135(4) as applied <i>mutatis mutandis</i> in Article 133-2(4))
	Purpose of the Requirement 6	<p>It provides that corrections of the description, claims or drawings must not in any case substantially enlarge or alter the scope of claims.</p> <p>If an invention that was not included in the claims before the correction is included in the corrected claims, there is a risk of unexpected disadvantages to third parties. Therefore, this requirement ensures that such a situation will not occur.</p>		<p>In order to prevent unexpected damages to the third persons, when reducing the scope of claims, if the correction is deemed to be made within the scope of specific purpose of the invention described in the claims, it shall not be deemed to be an alteration of the scope of claims.</p> <p>In other words, if the purpose and/or effect of the invention described in the claims after the reduction is inherent in the invention described in the claims before the reduction, included as a premise thereof, or is an extension within the scope of the</p>

				specific purpose, it shall not be deemed to be an alteration of the scope of claims. When determining whether the correction falls under the substantial alteration, it shall be determined based on claims as a whole, not claim-by-claim.
	Requirement 7	Requirements for independent patentability (Patent Act Article 126 (7) as applied <i>mutatis mutandis</i> pursuant to Article 134-2 (9)). However, the requirements for independent patentability do not apply to claims for which a request for a trial for invalidation has been made (Article 134-2 (9)).		<ul style="list-style-type: none"> <li>- This does not include corrections made in the trials for invalidation (Patent Act Article 133-2(6))</li> <li>- This does not include corrections made in patent opposition (Patent Act Article 132-3(3))</li> <li>- This shall apply only for trials for correction (Patent Act Article 136(5)). This is to ensure expedited proceedings in the request for corrections during the trial for invalidation.</li> </ul>
	Purpose of the Requirement 7	It provides that an invention in which the scope of claims has been restricted or an invention in which clerical errors or incorrect translations have		



		<p>been corrected must be independently patentable at the time of filing the patent application.</p> <p>Even if only the parts that are not independently patentable remain after the correction, the patent application is deemed to have been filed based on the corrected description or drawings under the Patent Act Article 128, and a request for a trial for invalidation will be filed on the grounds that the patent application is defective.</p>		
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