

WINDS FROM JAPAN

The Licensing Executives Society Japan

Correction on each of multiple Claims can be Individually requested – 2011 Patent Act Revision

By Mitsuo KARIYA*



Correction of patented claims is one of the most effective ways to protect a patent from validity challenges by potential licensees or accused infringers. Prior to a 2008 Supreme Court decision (July 10, 2008) the Japanese Patent Office maintained a

principle of denying allowability of multiple corrected claims as a whole if at least one unallowable claim was included. This practice was partially modified by the court decision and totally changed by the patent act revision made in 2011, which became effective on April 1, 2012.

Pre-2011 Patent Act Revision - Different Treatments between two types of Correction procedures

There are two types of procedures for correcting patented claims. Patentees can request a Trial for Correction to voluntarily resolve validity questions or strengthen an assertion of validity against an invalidity argument by the defendant in an infringement litigation procedure. On the other hand, if a Trial for Nullification is requested, the patentee is not allowed to request a Trial for Correction, and instead is required to file a Petition for Correction.

Based on precedents, e.g., a 1980 Supreme Court Decision (May 1, 1980), the 2008 Supreme Court Decision (July 10, 2008) and a 2009 IP High Court Decision (November 19, 2009), it has been understood that whereas allowability of correction of multiple patented claims should be indivisibly

examined in a Trial for Correction, allowability of correction for narrowing multiple patented claims that are individually challenged in a Trial for Nullification should be examined for individual claims.

Prior to the 2011 revision, it was still not clear whether all questions relating to correction of multiple patented claims were resolved by the court decisions. Additionally, there were criticisms of the inconsistent treatments between the two procedures, which commonly relate to correction of patented claims.

Unified Treatment - 2011 Patent Act Revision

According to the revised patent act, correction of each of multiple patented claims can be individually requested in a Trial for Correction as well as in a Petition for Correction (Articles 126 and 134-2). However a group of an independent claim and its dependent claims is treated indivisibly, and if allowability of correction of at least one claim in the group is denied, allowability of correction of all claims in the group is denied. This treatment is intended to prevent a complicated situation where a reference to originally patented claims becomes necessary when correction of some claims is allowable and correction of others is unallowable. Supposing that a patent includes two patented claims, e.g., Claim 1 (configuration “A”) and Claim 2 which was dependent on Claim 1 (further comprising configuration “B”), and it is requested that corrections be made to amend them to Claim 1’ (configuration “a”) and Claim 2’, which is dependent on Claim 1’ (further comprising configuration “b”), if the correction of Claim 1 to Claim 1’ is allowed and the correction of Claim 2 to Claim 2’ is rejected, the claims subsequent to the proceeding for correction will result in Claim 1’ (configuration “a”) and Claim 2 dependent on the uncorrected Claim 1. Thus, a

reference to Claim 1' in the corrected patent publication and a reference to Claim 2 in the original patent publication become necessary.

When a patentee requests corrections on multiple patented claims including dependent claims either in a Trial for Correction or in a Petition for Correction, it is permitted to rewrite the dependent claims to independent form so that the patentee can request individual examination of corrections of multiple patented claims.

Correction of Patented Claims became more user-friendly

According to this revision, it became clear that patentees can protect their patents from validity challenges by avoiding the disadvantageous situation where multiple claims were indivisibly treated under the previous practice.

When corrections of patented claims are allowed either in a Trial for Correction or in a Petition for Correction, the corrected claims become effective retroactive to the filing date. Potential licensees or accused infringers are liable for past damages as long as they infringed the corrected claims regardless of existence of patent marking or receipt of a cease-and-desist notice.

It is recommended that dependent claims be rewritten to independent form when a request for a Trial for Correction or a Petition for Correction is filed, to avoid rejection as a whole if the patentee is not confident on allowability of all the requested

corrections for a group of claims including dependent claims. It is allowable to include multiple independent claims for one category. The official fee for a Trial for Correction, the official fee for a Petition for Correction and the annual fees are determined simply by the number of claims.

There are other revised provisions relating to Correction. Prior to the 2011 patent act revision, patentees had an opportunity to correct claims even after issuance of a trial decision to nullify the patent, by requesting a Trial for Correction within 90 days from filing of a suit to rescind the trial decision. This opportunity is no longer available, as a result of the 2011 patent act revision; however, instead, the Board of Appeal issues advance notice of a decision and a final opportunity to correct claims will be given to the patentee (Article 164-2).

It should be noted that there are transitional measures relating to the 2011 patent act revision, which for the sake of simplicity are not discussed here.

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*\*Editor, WINDS from Japan*

*Licensing Director and Executive Counselor at GE Japan Corporation, Patent Attorney*

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## **35<sup>th</sup> LES Japan Group Summer Symposium in Nagano**

### **By Kazuaki OKIMOTO\***

The LES Japan Group held their 35<sup>th</sup> Summer Symposium on July 6 and 7, 2012, at the Shinshu Matsushiro Royal Hotel in Nagano City, Nagano Prefecture and celebrated the 40<sup>th</sup> anniversary of the foundation of the LES Japan Group. About 190 members attended the meeting.

On July 6, 2012, guest speakers were: Mr. Hiroshi Tsukagoshi, president of Ina Food Industry, Co., Ltd.; Ms. Makiko Takabe, a judge of the Intellectual Property High Court (IPHC); and Mr. Tomoyoshi Wada, the vice governor of Nagano Prefecture. Mr. Tsukagoshi made a speech on his policy to make Ina Food Industry a "good company." Judge Takabe lectured on recent trends in judging patent cases at the IPHC.

Five workshops were held concurrently, coordinated by the US Issues Working Group, the Trade Secret Working Group, the Healthcare Working Group, the Corporate Law and Intellectual Property Management Working Group, and the Asia Issues Working Group, followed by a cocktail party and dinner party. At the dinner party, Mr. Wada made a statement of congratulations on the 35<sup>th</sup> symposium and 40<sup>th</sup> anniversary of the LES Japan Group. The party was a great success, and all attendees seemed to enjoy the combination of conversation and the local food and wines.

In the morning on July 7, 2012, we had a panel discussion on the Intellectual Property Promotion Plan provided by a Cabinet committee, with Mr. Shigeo Takakura, a professor of the law school of Meiji University, as a coordinator, and Mr. Takashi Sakurai, Deputy Commissioner of the Japanese Patent Office, Mr. Itaru Kato, Director of Intellectual

Property of Mitsubishi Electric Co., Ltd., and Mr. Kazunari Sugimitsu, a professor of the Graduate School of Kanazawa Institute of Technology, as panelists. Subsequently, the panelists fielded a number of substantial questions from the floor.

The 36<sup>th</sup> LES Japan Group Summer Symposium will take place in July 2013, in Matsue City, Shimane Prefecture. Please mark it in your schedule book.

We look forward to receiving you next July, at the 36<sup>th</sup> Summer Symposium in Matsue.

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* Editor, WINDS from Japan
Patent Attorney at YUASA and HARA





Editors' Note

This issue includes an article relating to correction of patent under the Japanese patent law revised in 2011 and the 35th LESJ Japan Group Summer Symposium in Nagano, which we trust will provide you with useful facts on activities of the LESJ and up-to-date information on a variety of IP issues in Japan.

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