

The Japanese Supreme Court's Decision Concerning Whether the Permissibility of Correction of a Patent Should be Determined on a Claim by Claim Basis

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Decision of Supreme Court (First Petty Bench), July 10, 2008 ((2007 (Gyo-Hi), No. 318, Application to Reverse Trial Decision to Revoke Patent entitled "Light Emitting Diode Module and Light Emitting Light Source"), (Minshu, Vol. 62, No. 7, p 1905; Hanji, No. 2019, p. 88; Hanta, No. 1279, p. 110)

Abstract

It was appropriate that the court determined that where "a request for correction" regarding multiple claims is filed, the permissibility of the correction should be determined individually for each claim subject to the request for correction. However, the Supreme Court's finding that "a request for trial for correction" regarding multiple claims should be treated as one request (and reviewed as a whole, rather than on a claim by claim basis) is problematic, even though it was *obiter dictum*.

Facts

This case was raised to reverse a trial decision to revoke a patent by the Japan Patent Office pursuant to a patent opposition request, by X (the plaintiff, appellant) who was the patentee of Patent No. 3441182 (Number of claims: 4. hereafter "the patent") having a name of the invention of "Light Emitting Diode Module and Light Emitting Light Source."

The patent was registered on June 20, 2003, however an opposition was made on December 26, 2003 (with respect to all claims, Opposition No. 2003-73487). X made a request for correction on December 7, 2005 (hereafter "the request for correction"). However a notification of rejection regarding the correction was received on December 20, 2005 and the decision of the opposition was made on February 22, 2006. The conclusion was that "the patent as stated in claims from 1 to 4 of Patent No. 3441182 is revoked" and the decision noted in the reasons that the correction was not allowed.

The request for correction included a correction item a for the correction of claim 1, a correction item b for the correction of claim 2, a correction item c for the correction of claim 3, a correction item d for the correction of claim 4. The correction of claims 3 and 4 was asserted by X to be a correction of a simple formalities mistake and that its

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Note:

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permissibility had no effect on the consequence on the determination of the patent revocation.

The determination of the opposition was, in short, that the correction item b for the correction of claim 2 did not satisfy the conditions for correction and without determining the remainder of the correction items, it was concluded that the entire request for correction was not allowed.

The decision of the Intellectual Property High Court at first instance which was handed down June 29, 2007 (2006 (Gyo-Ke) No. 10314, available at homepage of the Supreme Court) supported the determination in the above decision and dismissed the request of X.

The Intellectual Property High Court reasoned that “In a request for correction or a request for trial for correction in which request is made to correct a plurality of positions in the disclosure of the drawings or the specification attached to the patent application, when the correction has a substantial effect on the scope of the patent claims, (that is to say, when the correction is not merely a formalities correction for the purposes of correcting a simple clerical error), to the extent that the applicant has not clearly specified an intent to request correction of one part of a plurality of corrections by the amendment of the items for correction in the correction (trial) request documents, then the trial decision or ruling must decide whether to allow or not allow the entirety of the plurality of positions for correction as a whole. Even if one part of a plurality of positions for correction does not have an indivisible technical relationship with another part objectively, and that even when the allowance of a partial correction would be of benefit to the applicant, it is reasonable to understand that the trial decision or ruling may not allow only correction of that position. (See above mentioned decision by Intellectual Property High Court of 1980). This reason would also be the case under the improved multiple claim system mentioned by the plaintiff.” Consequently X filed an appeal in the present case.

Conclusion

Decision at First Instance Partially Reversed and Judged by the Supreme Court and Appeal Partially Reversed

That is to say, the Supreme Court dismissed a part of the judgment at first instance in relation to the revocation determination of the patent with respect to claim 1 and substituted its own judgment by reversing that part which revoked the patent in relation to claim 1 in the opposition proceedings. Thereafter the remainder of the appeal was dismissed.

Holding

1. Basic Structure of Patent Law

“Patent Law has a basic structure that a single patent is granted and a single patent right is generated based on the decision of allowance after patent examination or patent trial as a form of administrative procedure with respect to a single patent application. Thus it is premised on the basic structure that the patent is not granted individually with respect to each claim. In view of that structure, even a patent application having a plurality of claims, to the degree to which the application is not divided, the whole patent application is indivisible and is either granted or subject to final refusal. There is no provision for partial handling in which the patent is granted in relation to the patent application as defined in some claims and is rejected in relation to the patent application as defined in other claims. In addition to the wording of Art. 49 and Art. 51 of the Patent Law, this is clear from the presence of a system for the division of the patent application itself. On the other hand, the Patent Law includes express provisions of exceptions enabling the partial

handling on a claim by claim basis in defined circumstances in which indivisible handling of the patent right or the patent as defined in a plurality of claims is considered unsuitable. In addition to provisions provided presumption such as Art. 185 of the Patent Law, an exception is defined by the latter paragraph of the body of the former Art. 113 of the Patent Law and provides that “a patent as defined in two or more claims may be subject to opposition on a claim by claim basis”. (The latter paragraph of the body of the former Art. 123 (1) of the Patent Law which prescribed the request for trial for patent invalidation has the same intent). (hereafter “ruling “a””).

2. Request for Trial for Correction

“When the provisions related to correction are viewed with respect to the premise of the basic structure of the Patent Law as described above, since there is no express provision determining a partial handling on a claim by claim basis corresponding to the latter paragraph of the body of the former Art. 113 of the Patent Law or the latter paragraph of the body of the former Art. 123 (1) of the Patent Law, when it is considered that a request for trial for correction has a substance as a new application (See Art. 126(5) and Art. 128 of the Patent Law), it is envisaged that a request for trial for correction seeking correction of a plurality of claims handles a whole application as an indivisible one in the same manner as a procedure for a patent application in relation to a plurality of claims.” (hereafter “ruling “b””).

3. Request for Correction

“In contrast, a request for correction as provided for in the former Art. 120 *quarter* (2) of the Patent Law (hereafter “request for correction”) is an ancillary procedure in a patent opposition application and has a different position within the Patent Law from a request for trial for correction which is an independent trial procedure. As for the request for the purpose of a reduction of claims subject to a patent opposition such as the correction in the present case, the independent patentability requirements (Art. 120 *quarter* (3) and Art. 126(4) of the old Patent Law) are not required. Such requests are envisaged to be handled in a different manner from the correction trial procedures and they cannot have the substance of a new application as in the request for trial for correction. A request for correction for the purpose of a reduction of claims subject to a patent opposition has the substance of a defensive means against patent oppositions enabling filing an opposition on a claim by claim basis. Thus the patentee in this type of request for correction is understood to request corrections on a claim by claim basis. Furthermore, when separate corrections on a claim by claim basis are not allowed, there is a conspicuous lack of balance in the offense and defense in the patent opposition case. When the above points are considered, corresponding to allowing a patent opposition on a claim by claim basis and determining the merits of patent revocation separately on a claim by claim basis, it is rational to think that a request for correction is allowed on a claim by claim basis and the permissibility of that request is determined individually on a claim by claim basis also with respect to request for correction for the purpose of a reduction of claims subject to a patent opposition.

The appellee insisted that the whole of the specification expressing the invention should be understood to be indivisible. However the amendment of the Patent Law pursuant to Law No. 27 of 1987 abolished provisions related to the principle of “one invention – one application” and moreover enabled the provision of multiple claims for a single invention. When these developments are considered, there remains no basis for the understanding as described above in the Patent Law as amended. Although the decision of the he Supreme Court (First Petty Bench) handed down May 1,

1980 denied in principle so-called partial correction, it is a decision related to request for trial for correction in which a plurality correction items are included within the scope of utility model claims which does not allow for a plurality of claims. The main thrust of the decision relates to a request for correction including a plurality of items for correction in a specified claim. The main thrust of the decision does not extend to the situation in the present case of whether or not to make a separate determination regarding the permissibility of a correction on a claim by claim basis in a request for correction in which there are items for correction in each of a plurality of claims. (hereafter “ruling “c””).”

“In view of the above points, when a request for correction is made in relation to a plurality of claims associated with a pending patent opposition case, the permissibility of a correction for the purpose of a reduction of claims subject to a patent opposition should be determined separately on a claim by claim basis for each claim to be corrected. The whole of the correction including items for correction with respect to the other claims should not be refused only due to the fact that the request for correction in relation to a part of the claims does not comply with the conditions for correction. (hereafter “ruling “d””).”

4. Conclusion

“The trial decision in the present matter determined to not allow the whole of the correction including correction item a without any examination of correction of item a in relation to claim 1 only for the reason that the correction item b in relation to claim 2 did not comply with the conditions for correction. ... (abbreviated)... Thus the decision contains an error which should be removed and the decision at first instance which pretermitted the error is clearly an infringement of law and regulation which clearly affects the decision.”

Explanatory Comments

1. Legislative History of System

The Japanese Patent Law adopted a unique single claim system after 1921 and this system was continued into the current Patent Law of 1959 (Law No. 121 of 1959).

When Japan ratified the Patent Cooperation Treaty (PCT), there was a shift in the law towards a multiple claim system pursuant to the Law No. 46 of 1975. However, this system was a partial multiple claim system.

Law No. 27 of 1987 introduced an improved multiple claim system resulting in a full multiple claim system which enabled flexible disclosure of a single invention in the form of multiple claims. At the same time, trials for patent invalidation provided for requests by claim.

Law No. 26 of 1993 disallowed separate request for trial for corrections while a trial for patent invalidation was before the Patent Office, and rather enabled request for correction under fixed conditions during trials for patent invalidation.¹ Thereafter Law No. 41 of 1999 prescribed that no determination regarding independent patentability requirements would be made with respect to a correction related to a claim which was subject to an allegation of invalidity.

The present case is related to a request for correction during an opposition procedure in a post-grant opposition case. The post-grant opposition system was introduced by Law No. 116 of 1994 and although it was abolished by Law

No. 47 of 2003, the provisions related to correction have the same intent as those related to trials for patent invalidation.

2. Practice and Procedure before the Japan Patent Office (Prior to the Decision)

When a request for correction or a request for trial for correction is made with respect to a plurality of claims, the Japan Patent Office has treated the requests as indivisible. In other words, if it is determined that a correction related to one claim does not satisfy requirements, the Japan Patent Office has taken the position that the entire request for correction or request for trial for correction is without merit without determining a correction in relation to other claims.

3. Overview of Judicial Precedent

3.1 Decision of the Supreme Court (First Petty Bench), May 1, 1980 (*Minshu*, Vol. 34, No. 3, p. 431)

Although this case is related to a utility model, the Supreme Court stated that “Even when the corrected specification happens to represent the correction of the original specification over a plurality of positions, the request for trial for correction should be understood to be a correction of a single indivisible matter, . . . for that reason, the sole consideration is a determination whether or not to allow the correction as a whole of all the plurality of correction points.”

Although at the time of the decision, the Japan Patent Office drew a critical view of a practice of indivisibility, this 1980 decision was received to provide a final interpretation to this problem and thereafter, the practice of the Japan Patent Office and the practice of the courts used this decision as a precedent and an approach of indivisibility has been regarded as a matter of course for not only a request for trial for correction in relation to patent rights but also a request for corrections introduced thereafter.

3.2 Decision of Tokyo High Court, October 31, 2002²

This decision created a stir in the practice and procedure which had been used for more than 20 years in the wake of the Supreme Court decision of 1980.³

In this decision, the Court noted⁴ that “the patent in question relates to a request made pursuant to the so-called improved multiple claim system. The correction in the present case is a request for correction in relation of the trial for patent invalidation and is a request for correction in which when the correction does not comply with legal requirements the correction constitutes grounds for invalidation of the patent and, including that point, is a request under a system which enables determination of invalidity for each of the claims by trial. . . . The determination of the permissibility of the present request for correction should be reasonably understood as a request by claim.”⁵

3.3 Series of Determinations and Rulings by Intellectual Property High Court (Third Division)

In 2007, the Intellectual Property High Court (Third Division) handed down a series of rulings and decisions.⁶

Among them, the decision handed down by the Intellectual Property High Court on June 20, 2007⁷ stated that “The Patent Law, pursuant to the amendment of Law No. 27 of 1987, introduced the so-called improved multiple claim system and enabled the request for a trial for patent invalidation with respect to each claim of a patent in relation to two or more claims (See, the body of Art. 123(1) of the Patent Law). Thereafter the amendment of Law No. 26 of 1993 enabled the request for correction during procedures related to a trial for patent invalidation and furthermore the amendment of Law No. 41 of 1999 (hereafter the “1999 amendments”) provided that, in relation to the allowance or

disallowance of a request for correction, a determination on the basis of the so-called independent patentability requirements is not performed with respect to an invention in relation to claims after correction (however, this excludes invention in relation to claims not subject to a request for a trial for patent invalidation). . . . In this manner, in a request for a trial for patent invalidation in relation to two or more claims, the presence or otherwise of reasons for invalidation is determined independently with respect to each claim and it accords with the intent of the trial system for patent invalidation to think that the trial in relation to each individual claim proceeds at the same time. When considered in these terms, the effect of a correction in a decision in relation to a trial for patent invalidation should be reasonably understood to apply to each individual claim.”

In addition to making comments in accordance with the judgment discussed above in relation to requests for correction, in a decision handed down February 12, 2008⁸, the Intellectual Property High Court stated that “in the Patent Law after the introduction of the improved multiple claim system, during litigation to reverse a judgment in which a request for trial for correction in relation to two or more claims was disallowed, when the details of the request for trial for correction are such that the permissibility of the correction can be determined independently for each claim, the section of the judgment corresponding to those concerns for each claim should be understood to be determined whether or not to be reverse. Perhaps as stated above, if it is considered that a request may be made for a trial for patent invalidation in respect of each claim for a patent in relation to two or more claims (See the body of Art. 123(1) of the Patent Law), in a request for correction during a trial for patent invalidation in relation to two or more claims, the patentee may request correction by claim as a defensive means in the invalidation trial with respect to each claim. The collegial body of the relevant tribunal should determine the permissibility of a correction to each claim. And this reason can be applied to a request for a trial for correction in relation to two or more claims, as long as the request for a trial for correction by the appellant enables the judgment on the permissibility of the correction by claim independently.”

3.4 Decision of Intellectual Property High Court (Second Division) (the Original Judgment)

The original judgment⁹ in the present case was handed down by the Intellectual Property High Court on June 29, 2007. The details are as described above. In addition, the judgment was handed down immediately after the decision of the Intellectual Property High Court (Third Division), No. 3 on June 20, 2007.

4. Study of the Judgment of the Supreme Court in the Present Case

4.1 Determination in relation to “Request for correction”

The conclusion of the ruling “d” of the judgment stated that “The permissibility of a correction for the purpose of reducing the claim should be determined separately with respect to each claim being the subject of the correction”. This is the first decision by the Supreme Court and is appropriate. Even when making this type of determination, there is no inconsistency with the 1980 judgment and the fact that there is no change in precedent is explained in the second half of the ruling “c”. (This point has already been explained by the decision of the Tokyo High Court in 2002).

In addition, the Supreme Court explained the reason for arriving at the conclusion in ruling “c” with reference to ruling “a” and “b”. As will be examined in the section below, there is room for problems in the manner in which the conclusion was formulated.

4.2 Determination in relation to “Request for Trial for Correction”

4.2.1 The Supreme Court in ruling “b” above noted that “a request for a correction trial for correction of a plurality of claims is envisaged to handle the whole of the claims as indivisible in the same manner as a procedure for a patent application in relation to a plurality of claims.” Although the part of the ruling in relation to “request for trial for correction” should strictly be understood to be an *obiter dictum*, such a clear statement by the Supreme Court has a significant actual influence.

However the part of the ruling in relation to “request for trial for correction” has been criticized as incomprehensible by many practitioners and there are published critical explanatory materials and articles.¹⁰ The present author also believes that there are problems arising in the section of the ruling in relation to “request for trial for correction.”

4.2.2 Interpretation of the Theory put forth by the Supreme Court

The ruling “a” with respect to the basic structure of the Patent Law in relation to the present judgment is convincing.¹¹

At any rate, of the foundations for the conclusion divided between request for correction and request for trial for correction based on the ruling “b” and “c”, those worth examination may be reduced to the following three points.¹²

- (1) In a request for correction, patent claims which are the subject of a patent opposition (request for trial for patent invalidation) are not required to have independent patentability requirements for the purpose of reducing claims. However in a request for trial for correction, independent patentability requirements are required (See Art. 126(5) of the Patent Law) and have the substance corresponding to a new application.
- (2) Although a request for correction is an incidental procedure, a trial for correction is an independent trial procedure.
- (3) A request for correction has the substance of a defensive means and requires consideration of a balance between offense and defense. However this is not the case with respect to request for trial for correction.

4.2.3 Study of the Merits of the Theory of the Supreme Court in the Present Decision

Of the three points above, there remain doubts whether the point regarding the independent patentability requirements in (1) above serves as a foundation. Independent patentability requirements are required for a request for correction in the same manner as a trial for correction in the period from the introduction of the request for correction system by Law No. 26 of 1993 to the amendment of Law No. 41 of 1999. Moreover in accordance with Law No. 41 of 1999, the amendment has the effect that independent patentability requirements are not required in a determination of the permissibility of a correction for a claim which is the subject of a trial for patent invalidation (subject of a patent opposition) in a request for correction. Therefore since the same determination as for independent patentability requirements is performed as a condition for a trial for patent invalidation (post-grant opposition), it is merely an attempt to improve efficiency by avoiding duplication at the stage of determining permissibility of the correction. Finally if

independent patentability requirements are not satisfied, the patentee will not achieve the purpose and as a result there is no change to the substance of the request for correction and the request for trial for patent invalidation.¹³

Next, there also remain doubts whether the ancillary procedures in (2) above serves as a foundation. Developments in introducing a request for correction system and the intent of the system have been discussed above. Prior to the amendment pursuant to Law No. 26 of 1993, a request for correction system did not exist in the first place and was provided for exclusively by trial for correction. The effect of the amendment was the introduction of correction amendment system as a convenient procedural means for examining corrections during trial procedures for patent invalidation to accelerate and streamline examination including trials for invalidation.¹⁴ Thus, the question of whether both are an ancillary procedure or an independent procedure is merely a technical problem with respect to procedural and examination issues and do not produce any difference in substance.

It is submitted that the defensive means in (3) above is also difficult to serve as a foundation. As mentioned above, prior to the amendment of 1993, a request for correction system did not exist and only a trial for correction system existed. It is clear that, prior to the amendment of 1993, a “request for trial for correction” was provided for as a defensive means for a patentee with respect to a trial for patent invalidation. Thus, it is not the case that a “request for trial for correction” does not substantially have the substance of a defensive means. Certainly, from the introduction of the “request for correction” system in the 1993 amendments, a “request for correction” was often used as a defense to a trial for patent invalidation (the same comments would apply to defense to a patent opposition after introduction of the post-grant opposition system in 1994). However, until the amendment of Law No. 47 of 2003, if a trial for patent invalidation was not pending with the Japan Patent Office, for example, after a litigation to revoke the trial decision for patent invalidation was raised, a correction was enabled pursuant to a “request for trial for correction” and a “request for trial for correction” was actively used as a means for eliminating reasons for invalidity after a trial for patent invalidation.¹⁵ Thus, even the introduction of a “request for correction” system did not necessarily result in the loss of a defensive function for “request for trial for corrections.” Furthermore, even in a situation in which a trial for a patent validation (patent opposition) is not requested, correction has also been performed as a prior preparation as a defense to a future attack such as invalidity. In this case, a “request for trial for correction” must be used, and it seems reasonable to comment that the “request for correction” has the function of a prior defensive mechanism with respect to an invalidity attack. Furthermore, after the decision of the Supreme Court (Third Petty Bench), April 11, 2000 (*Minshu*, Vol. 54, No. 4, 1368, Kirby case), a defense of a restriction on the exercise of patent rights or invalidation of patent rights has been available in patent infringement litigation and a corresponding defense has become important for a patentee. In this instance, although a “request for correction” provides a defense in the event a trial for patent invalidation is requested, a trial for patent invalidation is not necessarily requested. When a trial for patent invalidation is not requested, the patentee may attempt for protection by use of a “request for trial for correction.” In this manner, the “request for trial for correction” plays an important role as a defensive mechanism. Incidentally, the present decision mentioned this to be a “defensive mechanism with respect to patent oppositions”. It is considered that this statement results from the fact that the present case was a patent opposition. However, for the sake of certainty, when the post-grant opposition system is considered, the post-grant opposition system was introduced by the Law No. 116 of 1994 and was abolished by the Law No. 47 of 2003. During the intervening period, it is submitted that the above comments apply to the function of the “request for trial for correction.”

As discussed above, the present decision entails considerable uncertainty as to the appropriateness of that section of the decision noting that a “request for trial for correction” should be treated in an indivisible manner in contrast to a “request for correction.” In view of the above results of the studies, it is submitted that a “request for trial for correction” should be handled in the same manner as a “request for correction.”¹⁶

5. Outstanding Issues and Prospects for the Supreme Court’s Decision

The Japan Patent Office has stuck to a policy of indivisibility up to this point. A considerable change was imposed on the practice of the Japan Patent Office as a result of the present decision which noted that the permissibility of a correction should be determined on a claim by claim basis in a “request for correction.” In addition, the present decision in relation to the differing treatment for “request for trial for correction” and “request for correction” is very inconsistent with actual practice and is increasing confusion.

As the practice of the Patent Office, in light of the clear decision, though in an *obiter dictum* from the Supreme Court, permissibility of a correction will only be determined on a claim by claim basis when “request for correction” satisfied the limited conditions as indicated by the Supreme Court.

Talking a litigation practice in accordance with the present decision, when acting defensively in the face of an assertion of patent invalidity from the other party to patent infringement litigation a patentee will be required to either perform corrections by a request for correction during a trial for patent invalidation or to perform corrections by a request for trial for correction, where permissibility of the correction is determined either on a claim by claim basis or on the basis of indivisibility. Consequently a considerable effect will result on correction strategies.

However, as already examined, it is difficult to see a rational reason for a differing conclusion with respect to “request for correction” and “request for trial for correction” and in the event that both procedures were to be handled in the same manner, a solution would necessitate a legislative process.

When it is assumed that the permissibility of a correction is determined on a claim by claim basis, there exist a number of small, actual problems. For example, although a request for trial for patent invalidation may be made with respect to only part of the claims of a plurality of claims, problems arise with respect to how to handle a situation in which the request for correction also includes claims which are not the subject of a request for trial for patent invalidation. Furthermore, although a request for correction may be made with respect to a plurality of claims, when a correction is allowed only with respect to a part of those claims, there would be problems in practice regarding the form of any public notice.

The Japan Patent Office is subjecting these matters to detailed consideration and, going forward, the Intellectual Property High Court will also make decisions in this area. Furthermore, in the event of a legislative solution as discussed above, a solution including these problems would be desirable.

As a related problem, issues remain regarding partial conclusion determined of trial decisions. Since the Supreme Court has not determined such issues in the present decision, they will remain outstanding.¹⁷

Notes

- ¹ Up to that time, a trial for correction was conducted separately to a trial for patent invalidation and based on that result, a trial for correction for patent invalidation provided a framework for the conflict which prolonged the trial for patent.
- ² 2000 (Gyo-Ke) Case No. 170, *Hanji*, No. 1821, p. 117. There is an explanatory note by Hiroshi Furusawa, *Hanpyo*, No. 540, p. 15.
- ³ This case related to a request for correction for a plurality of claims in a patent invalidation proceeding. The Japan Patent Office determined that the correction was allowable and dismissed the request for trial for patent invalidation. However the Tokyo High Court reversed the trial decision in finding that the determination of the Japan Patent Office in allowing the correction was in error. However at that time, the Court noted in the course of its decision that an examination of all the claims which were the subject of the request for correction showed that all claims were not compliant and therefore reversed the whole decision.
- ⁴ In relation to the decision of Supreme Court of 1980, “When the Supreme Court ((First Petty Bench), May 1, 1980 (*Minshu*, Vol. 34, No. 3, p. 431)) decided this case, the Court noted that the system in question was different to the present case, and under a system as used in the present case, even if a consideration of whether to determine the permissibility as a whole of the correction require for a plurality of position in relation to a specific claim holds true, that consideration does to extend to the permissibility of a separate and independent request for correction related to separate claims.”
- ⁵ In the decision of the Intellectual Property High Court handed down January 30, 2006 (2005 (Gyo-Ke) No. 10842 and No. 10847), available at homepage of the Supreme Court), the Court allowed a request for correction with respect to a plurality of claims and made the following comments when rescinding a case pursuant Art. 181(2) of the Patent Law newly provided for by the Law No. 47 of 2003 regarding the trial decision of partial invalidity and partial failure to make out a case of invalidity. “At the Japan Patent Office, after the introduction of the so-called improved multiple claim system and the variation to the system of determining invalidity on a claim by claim basis, there is the possibility of an effect on the transitional provisions in Art. 134(2)(4) as a result of the deeply entrenched indivisible approach to procedures such as procedures in relation to corrections, procedures in relation to the confirmation of a trial decision during litigation for patent invalidation regarding of a part of a trial decision in a trial for patent invalidation in relation to a plurality of claims and procedures in relation to confirmation of a trial decision when some of the parties in a decision with the participation of a plurality of parties commence an action to reverse. On the other hand, an action to reverse a trial decision is prescribed by the court procedure laws and the mechanism by which the court sets aside a part of a decision is thought to be naturally allowed, but there is a risk that it does not complement the indivisible integrated approach of the Japan Patent Office. Hereafter, it is considered that there will be questions regarding the coherence of the administrative procedures of the Japan Patent Office and the legal procedures of the courts.”
- ⁶ The series of decisions is (1) Intellectual Property High Court, June 20, 2007 (2007 (Gyo-Ke) No. 10081, *Hanji*, No. 1997, p. 199; *Hanta*, No. 1263, p. 327), (2) Intellectual Property High Court, July 23, 2007 (2007 (Gyo-Ke) No. 10099), *Hanji*, No. 1998, p. 110; *Hanta*, No. 1266, p. 320), (3) Intellectual Property High Court, September 12, 2007 (2006 (Gyo-Ke) No. 10421, available at homepage of the Supreme Court), (4-1) Intellectual Property High Court December 28, 2007 (2006 (Gyo-Ke) No. 10426), *Hanji*, No. 1999, p. 102; *Hanta*, No. 1265, p. 326), (4-2) Intellectual Property High Court, December 28, 2007 (2006 (Gyo-Ke) No. 10425), available at homepage of the Supreme Court), (4-3) Intellectual Property High Court, December 28, 2007 (2006 (Gyo-Ke) No. 10517), available at homepage of the Supreme Court), (5) Intellectual Property High Court, February 12, 2008 (2006 (Gyo-Ke) No. 10455, *Hanji*, No. 1999, p. 115; *Hanta*, No. 1265, p. 311). (1) to (3) above decided that in a decision in which the permissibility of a correction or patent validity in relation to a plurality of claims was in suit, such permissibility was allowed for each part of the decision in relation to each claim (the court explained that the effect of the effective rescinding provision in Art. 134(2)(4) of the Patent Law was produced on a claim by claim basis). The decisions in (4) and (5) determined whether or not the determination of permissibility of a correction should be made in a claim by claim basis. (5) was decided in relation to a request for trial for correction.
- ⁷ 2007 (Gyo-Ke) No. 10081, *Hanji*, 1997, No. 119; *Hanta*, No. 1263, p. 327.
- ⁸ 2006 (Gyo-Ke) No. 10455, *Hanji*, 1999 No. 115; *Hanta*, No. 1265, p. 311.
- ⁹ 2006 (Gyo-Ke) No. 10314, available at homepage of the Supreme Court.
- ¹⁰ See, Ryuichi Murabayashi, “21st Century Intellectual Property Research, (No. 93), Research into New Decisions, *ChizaiPrism*, Vol. 6, No. 71, p. 131; Ryoichi Mimura, “Claim Correction under the Improved Multiple Claim System”, *ChitekizaisanSeisakugakuKenkyu*, No. 22, p. 1. Kenichi Kumagai, “Allowance of a Partial Correction for an Invention having a Plurality of Claims” *AIPPI*, Vol. 54, No. 3, p. 114; Kenichi Kumagai, “Partial Correction of Patent Rights”, *Juri*, No. 1376 “2008 Digest”, p. 305.
- ¹¹ However there is scope for doubt as to whether it can be said that the Patent Law has been amended appropriately.
- ¹² Although the present decision gives an example that there is not express provision determining a divisible treatment on a claim by claim basis (ruling “b”), this point is the same for requests for correction. Furthermore the present decision also gives Art. 128 of the Patent Law as an example on the basis that a request for trial for correction has a substance of a type of new application (ruling “b”), the retroactive action of the provision also applies to a request for correction (Art. 134 *bis* (5)). It is submitted not to be reason for having different conclusions regarding a “request for trial for correction” and a “request for

correction.”

¹³ The present decision does not refer to a manner of evaluating a request for correction prior to the 1999 amendments.

¹⁴ At the time when the post-grant opposition system was introduced, a request for correction system was already in operation and consequently those facts have no effect on the above comments.

¹⁵ After the 2003 amendment the period for requesting a trial for correction was limited to 90 days after the commencement of litigation to reverse a decision. However during that period, the same defensive function is performed.

¹⁶ See, Murabayashi, *supra* note 10; Mimura, *supra* note 10; Kumagai, *supra* note 10. There is an Explanatory Note of the Decision by the former Supreme Court Research Official, Akitoshi Miyasaka, “Explanatory Note of Important Decisions”, *L&T*, No. 42, p. 96; “Tokinohanrei,” *Juri*, No. 1375, p. 117. However it is submitted that there is not a convincing explanation of the above point.

¹⁷ It is noted that this problem has been examined in the course of the decision by the Intellectual Property High Court (Fourth Division), *supra* note 5, and was directly taken up in the series of decisions by the Intellectual Property High Court (Third Division), *supra* note 6.