Amendment of patent claims after grant (in court and administrative proceedings, including re-examination proceedings requested by third parties)

Questions

1) Does your national law permit post-grant amendment of patent claims? Are utility models – if available – treated the same way as patents or differently? If so, what are the differences?

In Japan, a patentee may demand a trial for correction of a claim/claims, provided that such correction is limited to the restriction of a claim or claims or to the correction for other statutory specified purpose (Article 126(1), Japanese Patent Law). In addition, it is provided that such correction may not introduce any new matter (Article 126(3)) and may not substantially enlarge or modify the claim or claims (Article 126(4)). In principle, a trial for correction cannot be requested when a trial for invalidation is pending against the patent (Article 126(2)); in a trial for invalidation, however, the patentee may request correction of the claim/claims for purpose of the restriction of the claim/claims. Utility models are not treated in the same way as patents. As for utility models, correction may, in principle, not be requested more than once for purpose of the restriction of a claim/claims or for other statutory specified purpose, except for correction requested in order to delete a claim/claims (Article 14bis, Japanese Utility Model Law).

Note: In Japan, post-grand amendment is referred to as “correction (‘teisei’ in Japanese)” in order to distinguish it from amendment during the prosecution process (“hosei” in Japanese). Hereinafter, the same applies.

2) Who is entitled to request post-grant amendment of patent claims under your national law?

Only patentees may request it (Article 126(1), Japanese Patent Law).

A third party may, however, prompt the patentee to make correction by initiating a trial for invalidation against the patent.

3) What is the procedural framework for requesting post-grant amendment of patent claims under your national law, in particular:

- What procedures (judicial, administrative or other) are available for dealing with requests for post-grant amendment of patent claims under your national law?

As described above, trial for correction and trial for invalidation are available for requesting post-grant amendment (correction). Both are administrative proceedings before the JPO.
- Are all of these procedures freely available under your national law to those wishing to request post–grant amendment of patent claims, or does the law give priority to certain procedural measures in certain situations?

In principle, a patentee can freely initiate a trial for correction. It may be initiated even during the period of an infringement suit pending at court.

- Is it possible under your national law for patentees to make multiple subsequent amendments of patent claims directed towards individual alleged infringers?

Correction may be made any number of times. The Japanese Patent Law does not impose any restriction in this regard.

- Who is entitled to amend claims? Is this limited to courts or do also the patent offices have the competence to amend claims?

Please limit the answer to a general description of the proceedings avoiding discussion of procedural details and peculiarities.

The Japan Patent Office (JPO) has competence to decide whether a requested correction of a patent claim/claims may be allowed. In Japan, correction of a claim/claims can not be requested to a court. However, a patentee who dissatisfies the decision for a trial for correction made by JPO is allowed to file an appeal to the Intellectual Property High Court (Article 178(1), Japanese patent Law).

4) What are the substantive conditions for allowing post–grant amendment of patent claims under your national law, in particular:

- Is there a distinction in your national law between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post–grant amendment?

In Japan, only a patentee may request correction of a patent claim/claims. A party other than patentee is not allowed to request it. However, a third party may initiate a trial for invalidation against a patent to prompt the patentee to make correction. A third party may also request a trial for invalidation of a patent on ground that a correction made by the patentee is in breach of statutory conditions for correction (Article 123(1)(viii), Japanese patent Law).

- In what ways may patent claims be amended post grant under your national law?

Correction (post–grant amendment) will be allowed only when its purpose is:

i) the restriction of a claim or claims;

ii) the correction of errors in the description or of incorrect translations; or

iii) the clarification of an ambiguous description.

In addition, correction may not introduce any matter that was not disclosed in the specification or drawing as filed, and may not substantially enlarge or modify the claim or claims. Furthermore, the claimed invention after correction should be patentable independently even at the time of filing.

- Is it a requirement (or a possibility) under your national law that the description/specification be amended to correspond with amendments of the claims?

It is not required, but possible, to do so.

- Is it possible to make amendments for the purposes of clarification and/or correction of errors?

It is possible, provided that the correction satisfies all the substantial conditions described above.
5) What are the consequences for third parties of post–grant amendments of patent claims under your national law, in particular:

- What are the consequences for third parties’ liability for patent infringement where patent claims are amended post grant?

   Correction shall be regarded as having retroactive effect from the time of filing (Article 128, Japanese Patent Law), and the technical scope of a patented invention shall be determined on the basis of the statements of the patent claim(s) (Article 70(1)). Therefore, there may be cases where a possible infringer could escape from liability of patent infringement as a result of correction of a claim of the possibly infringed patent, when such a correction brings the infringer’s invention out of the technical scope of that patent.

- Are amendments effective only inter partes or, conversely, erga omnes, including in relation to previously decided cases?

   Correction of a patent claim(s) will be made through administrative proceedings, and therefore, will have an erga omnes effect.

- Are amendments effective only ex nunc or also ex tunc? Does that depend on the context in which the amendment is made?

   Correction will have an ex tunc (retroactive) effect, regardless of the context in which it is made.

II) Proposals for substantive harmonisation

The Groups are invited to put forward their proposals for adoption of uniform rules, and in particular to consider the following questions:

6) Should post–grant amendment of patent claims be permitted?

   In our opinion, post–grant amendment (correction) of patent claims should be permitted. When an invalidation proceeding is initiated against a patent and when the patent claim in question is defective but has some patentable part in it, if the patentee is not allowed to defend him/herself by amending the patent claim, it would be too severe consequence for the patentee and appropriate balance of interests between patentees and third parties (the public) would be lost. In addition, it would ultimately lead to insufficient protection for patents.

7) Who should be entitled to request post–grant amendment of patent claims and who should have the competence to amend?

   It seems sufficient to only allow patentees to request such amendment (correction). This is because third parties may prompt patentees to make correction by initiating a trial for invalidation against their patent.

   Regarding competence to amend (correct) claims, Patent Offices should be granted it. We consider that it is not necessary to grant the first instance competence to courts, since it is sufficient to allow patentees to appeal the office’s decision in court if they dissatisfy the office’s decision.

8) What should be the substantial conditions for allowing post–grant amendment of patent claims?

   Post–grant amendment (correction) should be limited to ones that would not give third parties unforeseen disadvantages (for example, it should be limited to a correction made in order to restrict patent claims or to correct clerical error).
9) **Should there be a distinction between the remedies available to patentees/third parties and/or the substantive conditions applicable to patentees/third parties for allowing post-grant amendment?**

In our opinion, it is not necessary to make the same remedies available to patentees and third parties. Since third parties may demand a trial for invalidation against a patent, it is not necessary to allow third parties to request correction of patent claims.

10) **What should be the consequences for third parties' liability for patent infringement where patent claims are amended post grant?**

If post-grant amendment (correction) of a patent claim/claims does not have retroactive effect from the time of filing, it cannot play a role of means for defense that is available to a patentee in invalidation proceedings because the patent before correction would be invalid. Therefore, post-grant amendment (correction) of a patent claim/claims should have retroactive effect from the time of filing.

When we give post-grant amendment (correction) with such retroactive effect, a party who initiates an invalidation proceeding may also benefit from it, since such a party can achieve his/her ultimate purpose by prompting a patentee to amend (correct) his/her patented claim(s) and thereby escape from the technical scope of the patent and therefore from liability of infringement.

However, post-grant amendment (correction) should not be allowed when, as a result of it, an otherwise legal activity would become a patent infringing activity.

11) **Does your Group have any other views or proposals for harmonisation in this area?**

I) In every jurisdiction, opportunity to amend a patent claim/claims after grant of the patent should be given to patentees, because:

1) In case invalidation proceedings are initiated against a patent that is somewhat defective but has some patentable part in it, it seems appropriate to allow the patentee of such a patent to amend his/her patent claim as a means for defending him/herself against the request for invalidation, from the viewpoint of ensuring sufficient protection of new inventions.

Allowing post-grant amendment will not decrease legal certainty, if it is made within the scope of matters already patented. Such amendment may lead to a narrowing down of patent claims to ones really deserving patent protection and/or may result in a clearer scope of patent rights, which will also benefit third parties.

2) If post-grant amendment is not allowed, a patentee might attempt to increase the number of claims in a patent with a view to securing future enforceability of his/her patent. This may cause more burdens on patent offices, which, in turn, may result in more prolonged prosecution periods.

II) Only patentees should be granted the right to amend patent claims. Only opportunities to prompt patentees to amend their claims should be granted to a third party.

A patent claim determines the scope of patent right and is an intangible property owned by the patentee. Therefore, only patentee should have the right to decide how it should be amended.

On the other hand, it cannot be denied that since even a defective patent will extend its effect to third parties, such a patent may impair third parties' legal activities.

In order to exclude such defective patents, third parties should be granted opportunities to prompt patentees to restrict the scope of their patent to an appropriate one.
III) Only patent offices should be granted competence to allow post–grant amendment, because:

1) Patent Offices are administrative agencies whose duty is to examine patent applications and to grant patents by using their expertise in the field of technologies. Therefore, they can examine whether a requested correction is acceptable or not in the most suitable and prompt manner.

2) On the other hand, courts are entities one of whose duty is, upon appeal by dissatisfying parties, to review decisions of administrative agencies. Therefore, it seems more appropriate that, only after a patent office, an administrative agency specialized in patent related matters, decides the appropriateness of a requested amendment, and only upon such decision is appealed by the dissatisfying party, a court will examine the appealed decision.

Summary

Regarding post–grant amendment of patent claims, in Japan, only patentees may demand a trial for correction (Article 126(1), Japanese Patent Law).

On the other hand, a third party who desires a post–grant amendment of patent claims may request a trial for invalidation of a patent (Article 123(1) and (2), Japanese Patent Law).

A patentee may demand a trial for correction to restrict patent claims to ones patentable, as a means for defending him/herself against a trial for invalidation of a patent.

The above–mentioned mechanism entrusts patentees to decide how to amend patent claims while granting third parties, desiring an amendment of patent claims involving reasons for invalidation or patent claims including an obscure part, the opportunity to prompt patentees to appropriately amend the scope of their patented inventions through the filing of a request for a trial for invalidation.

Regarding the harmonization of post–grant amendments of patent claims, only patentees should have the right to decide how a patent claim should be amended, since a patent claim determines the scope of the patent right. On the other hand, if there is a defective patent, third parties should be granted an opportunity to prompt patentees to appropriately restrict the scope of their patent.

Résumé

Concernant la modification des revendications d’un brevet après délivrance de celui–ci, au Japon seul le détenteur du brevet peut demander un jugement correctif après délivrance du brevet (Loi sur les brevets, article 126–1).

D’un autre côté, un tiers souhaitant la modification des revendications d’un brevet après la délivrance de celui–ci peut demander un jugement d’annulation de brevet (Loi sur les brevets, articles 123–1 et 123–2).

En présence d’un jugement d’annulation d’un brevet, en tant que moyen d’opposition, le détenteur du brevet peut demander un jugement en correction du brevet, et restreindre l’invention brevetable aux parties de celles–ci qui ont le caractère de brevetabilité.

Grâce aux mécanismes précités, le détenteur du brevet se voit confier la manière dont les revendications des brevets seront modifiées, et d’un autre côté, le tiers qui souhaite la modification d’une invention brevetée contenant des motifs de nullité, ou d’une invention brevetée contenant des parties imprécises, parce qu’il peut demander un jugement en annulation, se voit attribuer le moyen d’inciter le détenteur du brevet à modifier l’invention brevetée dans une étendue appropriée.
Concernant l’harmonisation des modifications de revendications de brevet après la délivrance de celui-ci, le droit de décider du type de modification devrait être attribué seulement au détenteur du brevet, parce que ce sont les revendications du brevet qui délimitent les droits du détenteur. D’autre part, dans le cas de brevets renfermant des vices, le moyen d’inciter le détenteur à limiter l’étendue des droits de manière appropriée devrait être reconnu aux tiers.

Zusammenfassung

Eine Änderung bereits erteilter Patentansprüche ist in Japan nur dann möglich, wenn der Patentinhaber nach erfolgter Erteilung eine Änderungsprüfung beantragt (Japanisches Patentgesetz, Art. 126, Abs. 1).

Dagegen können Dritte, die eine Änderung erteilter Ansprüche wünschen, einen Einspruch auf Widerruf einlegen (Japanisches Patentgesetz, Art. 123, Abs. 1 und 2).

Wird auf Ungültigkeit entschieden, kann der Patentinhaber im Gegenzug eine Beschwerde einreichen und kann die Erfindung auf ihren patentfähigen Teil einschränken.

Auf diese Weise bleibt dem Patentinhaber eine etwaige Änderung der Ansprüche überlassen, während Dritten, die eine Änderung einer zum Einspruch Anlass gebenden patentierten Erfindung oder einer undeutlich offenbarten patentierten Erfindung wünschen, geeignete Mittel zur Verfügung stehen, einen entsprechenden Einspruch einzulegen bzw. den Patentinhaber dazu zu veranlassen, eine angemessene Änderung des Umfangs der beanspruchten Erfindung vorzunehmen.