

## **Extension of the Time Limit for and Change of the Date of Submission**

### **1. Extension of the Time Limit for Submission in General**

The Commissioner of the Patent Office or a chief administrative judge may, upon request or ex officio, extend a legal period and a designated time limit.

A request for the extension of the time limit shall be made before the expiration of an original legal period or a designated time limit. Where the original expiration date falls on a Saturday, Sunday, or national holiday of Japan, the original expiration date shall become the next working day that the JPO is open and the request for the extension of the time limit may be made on that date.

### **2. Extension of a Legal Period**

(1) The Commissioner of the Patent Office or a chief administrative judge may, ex officio, extend the period provided for only in the following for a person who undertakes a procedure or a representative in a remote area or an area with transportation difficulty (see the attached table 25-01).

The period for filing a new application after an amendment is dismissed during trial and appeal procedures (Design Act Article 50(1), Trademark Act 55-2(1)) 15 days

(2) Where a person who undertakes a procedure is an overseas resident, an appeal or a new application may be approved only during the following period.

A. The time limit for filing a request for an appeal against the examiner's decision of refusal (Patent Act Article 121(1)) 1 month

B. The period for filing a new application only after an amendment, that is in the process of examination, is dismissed (Design Act Article 17-3(1), Trademark Act 17-2(1)) 60 days

### 3. Extension of a Designated Time Limit

The Commissioner of the Patent Office or a chief administrative judge may, upon request or ex officio, extend a designated time limit (Patent Act Article 5, Utility Model Act Article 2-5(1), Design Act Article 68(1), Trademark Act 77(1)).

(1) Extension of the time limit upon request by a person who undertakes a procedure

A. Extension of the time limit upon request in general (except the following B and C)

The extension of the time limit by request may be only approved where the time limit is designated for the purpose of enabling overseas residents to file certified experiment results or models/samples, etc. through a written opinion (excluding what is specified in the Patent Act Article 48-7), a written reply (limited to the case where an award is rendered) or inquiry.

In addition, where it is approved that it is due to grounds not attributable to a person who undertakes a procedure or a representative in a specific procedure (see 25-01-I-1.(1) and (2)), the extension of the necessary time limit may be approved irrespective of whether the person is a domestic resident or an overseas resident (see 25-01-I-1.(6)).

B. Trial for invalidation, trial for correction, trial for rescission of trademark registration and opposition to grant of patent

In consideration of the following requirements (A) and (B), the extension of the designated time limit upon request shall be exercised while the extension of the designated time limit upon request by a person who undertakes a procedure during the processes of trial for invalidation, trial for correction, trial for rescission of trademark registration and opposition to grant of patent shall not be exercised in principle. It is not necessary to extend the time limit as requested as long as the time limit to be extended shall be the standard time limit and additional 20 days at the maximum.

(A) After the designated time limit is passed, a request for the extension of the time limit shall be such that it is prohibited by law to undertake a procedure concerning important allegations or evidence during the designated time limit.

Specifically, a request for the extension of the time limit shall be approved only for the designated time limit only within which "a request for correction" (Patent Act Article 134-2(1), 120-5(2)) and "amendment of the corrected description, etc. attached to a written request for correction" (Patent Act Article 17-5(1)&(2)) may be approved,

namely; the time limit for the submission of a written reply, in trial for invalidation under the Patent Act and the old Utility Model Act, designated by law; the designated time limit for a request for correction to the Advance Notice of a Trial Decision; the time limit for responding to an office action for notice of reasons for invalidation; the time limit for responding to an office action for notice of reasons for revocation in the process of opposition to grant of patent; the time limit for responding to an office action for notice of reasons for rejecting a request for correction in the process of a request for correction; and the designated time limit for requesting for correction in the process of the second action pendency.

(B) A person who undertakes a procedure have paid the required fees (Patent Act Article 195(1)1) and submitted a written request for the extension of the period (format 3, Regulations under the Patent Act Article 4-2), sufficiently before the expiration of the designated time limit, while having described the following items in the column "contents of the claim" of the said written request.

a. Rational and concrete reasons that necessitate the extension of the time limit (the reason that cannot be attributed to a responsibility of a person who undertakes a procedure or a representative, or the reason that can be objectively examined)

b. Specifying the extended time limit that will be requested

c. Concrete reasons that rationalize the extended time limit that will be requested

C. Appeal against examiner's decision of refusal

The extension of the designated time limit of notice of reasons for refusal and inquiries in the appeal against examiner's decision of refusal procedure upon request shall not be approved in principle except in the following (A) and (B) cases.

(A) Patent applications

An extension of the designated time limit shall be limited to those for either of the following purposes a or b.

a. Acquisition of the experimental data to compare the claimed invention with a cited invention indicated in the notice of reasons for refusal, etc.

b. Translation of trial and appeal procedure document

An extension of the designated time limit that can be granted shall be up to one month per request. A one-month extension can be granted only once for domestic

residents for the purpose a. Additional one-month extension can be granted for overseas residents by filing the second request and the third request respectively. However, the extension based on the purpose a shall be made only once irrespective of whether the person is a domestic resident or an overseas resident.

However, a person who undertakes a procedure should keep filing deadlines in mind and give herself/himself plenty of time in advance to submit a written request for the extension of the time limit, sufficiently prior to the expiry of the designated time limit (prior to the expiry of the extended designated time limit if overseas residents file the second and/or third request(s)).

(B) Design and trademark applications

Up to one-month extension of the designated time limit can be granted only to overseas residents by filing a request for extension.

D. Cases subject to accelerated appeal examinations

Where a request for an extension of the specified time limit for response is filed for a patent case that has been selected as a case subject to accelerated appeal examination, the case shall be treated in the same manner as it is treated as a regular case rather than being treated as an accelerated appeal examination.

(2) Extension of the time limit ex officio

A. Extension of the time limit ex officio in general (except for the extension for patent applications) (except for the following B)

Where a request for the issuance of a certified copy of documents or an extract of documents required to prepare a written opinion is filed within an original designated time limit, the extension of the time limit ex officio shall be exercised over the time limit for the submission of the written opinion irrespective of whether the person is a domestic resident or an overseas resident.

The extension shall be exercised by expressing the 23<sup>rd</sup> day as the 1<sup>st</sup> day that is the next day following the shipping date of a certified copy of documents. However, where 23 days or longer are left in the original designated time limit, the extension shall not be exercised.

B. Trial for invalidation, trial for correction and trial for rescission of trademark registration, and opposition to grant of patent

The extension of the designated time limit ex officio during the processes of trial for invalidation, trial for correction and trial for rescission of trademark

registration, and opposition to grant of patent shall not be exercised in principle. However, the extension of the designated time limit may be exercised ex officio only where either of the following requirements (A) or (B) is fulfilled.

(A) Where the length of the designated time limit is shorter than the standard designated time limit

Where either of the following a or b is fulfilled, the extension of the designated time limit may be exercised within a standard designated time limit at the maximum even after the designated time limit is extended.

a. A person who undertakes a procedure has submitted a written statement that states rational and concrete reasons that necessitate the extension of the designated time limit as long as the standard designated time limit, sufficiently before the expiration of the designated time limit.

b. Considering the contents of the written statement, etc. it is recognized that the extension of the time limit as long as the standard designated time limit shall be adequate.

(B) Where the longer length of the designated time limit for response is necessary arising from the quantity and quality of evidence, etc.

Where the following requirements a to c are met, the extension of the designated time limit upon request shall be exercised. Basically, a maximum of 30 days may be added to the standard designated time limit. (However, in a trial for rescission of trademark registration, where a demandee is an overseas resident and where there are rational reasons requiring the reasonable time limit of time compared to a period of time limit taken by a domestic resident to contact licensees, etc. in Japan, collect evidences disclosing a relationship between the said licensee and the demandee (right holder), etc., the extension may be permitted as an exception. Basically, a maximum of 50 days may be added to the first action period that is a legal standard designated time limit to submit a written reply.)

a. Where "evidence submitted by the parties is to be collected by themselves," both the need for presenting a certified experiment results and other evidence in a designated time limit, and the fact that it would take an extremely long period of time to collect evidence shall be recognized. Where "evidence submitted by the other parties or the opponent is to be analyzed," there is the fact that it would take an extremely long period of time to analyze and prepare the evidence because the quantity of the evidence submitted by the other parties or the opponent is enormous (hundreds of pages), or the nature of the evidence is extremely complicated and sophisticated.

b. An extension of the specified time limit for response (the opportunity of rebuttal, etc.) that is to be made by the demandant in a trial for invalidation where "evidence submitted by the parties is to be collected by themselves" is not aimed at submitting evidence that violates the limitation of correction of the grounds for the request for trial.

c. A person who undertakes a procedure has submitted a written statement that describes the following items, sufficiently before the expiration of the designated time limit.

- Rational and concrete reasons that necessitate the extension of the time limit

- Specifying the extended time limit that is required

- Concrete reasons that rationalize the extended time limit that is required

(3) Extension upon request and extension ex officio shall not be exercised concurrently. Extension upon request or extension ex officio, whichever its expiration date is later, shall be exercised.

(4) Procedures made with the JPO that is necessary to exercise extension of a designated time limit and related administrative work at the JPO

A. Both a written request for the extension of the time limit described in the above-mentioned (1)B and a written statement for the purpose of the above-mentioned (2)B shall be addressed to the "chief administrative judge of the JPO," and submitted to the JPO by either mail or in person sufficiently before the expiration of the designated time limit.

B. Where a written statement concerning extension of time limit or a written request for the extension of the time limit is submitted, a trial clerk immediately sends the said written statement or the said written request for the extension of the time limit to a chief administrative judge, and seeks the judgment of propriety of the extension of the time limit from the chief administrative judge.

C. Where extension of the time limit is approved, a person who undertakes a procedure will be notified of that and the time limit shall be managed henceforth based on the extended time limit. In addition, where there is no relation between the extension of the said time limit and the extension of the time limit that enables to request correction of a description, etc., communication may be made by either phone or facsimile even if the communication is made to notify that the extension of the time limit has been approved.

D. Where extension of the time limit is not approved, a trial clerk sends a person who undertakes a procedure a document by facsimile which describes that the specified time limit for response shall not be extended after making a telephone call to notify the person of that.

#### **4. An Additional Time Limit**

A chief administrative judge may ex officio designate an additional time limit for actions against trial decisions, etc. extending the invariable time limit for a person in a remote area or an area with transportation difficulty (Patent Act Article 178(5), Design Act Article 59(2), Trademark Act Articles 63(2) and 68(5)) (-> For a person who lives in the area indicated in the Appendix of 25-1 PUDT, an additional time limit shall be 15 days, and for an overseas resident, 90 days). The additional time limit shall be integrated into the original time limit in the same manner as prescribed for the extended time limit.

#### **5. Change of a Date**

A chief administrative judge may, upon request or ex officio, change a date where the date is designated by the chief administrative judge in accordance with the provisions of the Patent Act.

For a request to change the above-mentioned date, the reason to require a change of the date shall be clarified (Regulations under the Patent Act Article 4-2(3), Regulations under the Utility Model Act Article 23(1), Regulations under the Design Act Article 19(1), Regulations under the Trademark Act Article 22(1)).

A request to change the above-mentioned date shall not be permitted in the following cases (1) or (2), except for where there are unavoidable reasons therefor (Regulations under the Patent Act Article 4-2(4), Regulations under the Utility Model Act Article 23(1), Regulations under the Design Act Article 19(1), Regulations under the Trademark Act Article 22(1)).

(1) Where several representatives have been appointed on either side of the party concerned and there is a reason to change representative(s).

(2) Where the same date is designated as a date for another case after the date has been designated.

## **6. Extension Based on the Act on Special Measures Concerning Preservation of Rights and Interests of Victims of Specified Disasters (Act No. 85 of 1996)**

By prescribing various special measures concerning administrative extension, etc. of the expiration date of rights and interests by Cabinet Order, the Act on Special Measures concerning Preservation of Rights and Interests of Victims of Specified Disasters (Act No. 85 of 1996) enables to issue these measures in a prompt manner at the time of disaster, and is applied to large-scale extraordinary disasters (specified extraordinary disasters).

When the Great East Japan Earthquake of 2011 (Heisei 23) was designated as a specified extraordinary disaster, measures were taken to extend a legal period and a designated time limit for applicants who were not able to follow the necessary procedures with the JPO within the original time limit due to the enormous damages incurred by the earthquake disaster.

A request for the extension of a designated time limit was accepted as a valid procedure if an applicant filed the request attaching a document, explaining the situation where the applicant was not able to follow the necessary procedures within the original time limit, as soon as it became possible for the applicant to follow the necessary procedures.

Measures were taken to extend a legal period so that the expiration date of a procedural time limit would be extended as late as March 31, 2012 (H24).

Procedures for trials and appeals that were subject to the extension are as follows.

(1) A request for an appeal against examiner's decision of refusal

(Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Articles 44(1), 68(4), Supplementary Provision 13)

(2) A request for a trial for correction

(Patent Act Article 126(2))

(3) Filing a request for correction

(Patent Act Article 134-3(1))

(4) A request for a retrial against a final and binding decision

(Patent Act Articles 171(1), 172(1), Utility Model Act Articles 42(1), 43(1), Design Act Articles 53(1), 54(1), Trademark Act Articles 57(1), 58(1), 68(5), Supplementary Provision 18)

(5) A request for a trial against the examiner's decision dismissing an amendment

(Design Act Article 47(1), Trademark Act Articles 45(1), 68(4))

(6) An amendment of the Written Opposition to Registration of Trademark

(Trademark Act Articles 43-4(2), 68(4))

Where a large-scale disaster occurs and is designated as a specified extraordinary disaster in the future, it is considered that similar measures shall be taken.

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