

Chapter I Amendment

1. Outline

Amendment refers to a procedural act which an applicant performs voluntarily or based on an order issued by the Commissioner of the Patent Office or the chief administrative judge to correct or supplement the filing documents, etc. after the filing so as to remedy improper descriptions, where documents, etc. relating to the filing contain any improper descriptions, such as an error or ambiguous statement, in light of law or the prescribed forms.

In order for procedures to progress smoothly and promptly, it is ideal that the applicant submits a perfectly complete set of documents from the beginning. However, due in part to the need for haste in filing an application under the first-to-file system, in reality, such perfect documents may not always be possible. For this reason, Article 60-24 of the Design Act allows the amendment of procedures.

However, given an amendment has the effect of the documents, etc. being treated as having been submitted in the amended state when originally filed, if the contents that were described when originally filed could be freely amended, it would run contrary to the purport of the first-to-file system and would give unexpected disadvantage to third parties. For this reason, limitations are imposed on the contents of and period for amendment.

If an applicant submits a legitimate written amendment of proceedings (Article 17, paragraph (4) of the Patent Act as applied mutatis mutandis pursuant to Article 68, paragraph (2) of the Design Act), the documents, etc. shall be treated as having been submitted in the amended state when originally filed.

2. Limitations of amendment

2.1 Limitation on the contents of amendment

Since amendment should only be made to correct or supplement any error or ambiguous statement in the documents, etc. as originally filed, amendment made to the statement in the application or any drawings, etc. attached to the application must not change the gist thereof. Where an amendment does change the gist thereof, the examiner should dismiss the amendment by a ruling (Article 17-2, paragraph (1) of the Design Act) (see Part VI, Chapter II “Dismissal of Amendments”).

2.2 Limitation on the period for amendment

A person undertaking a procedure with regard to an application for design registration, a request, or any other procedures relating to design registration may make amendments only while the case is pending in examination, trial or retrial (Article 60-24 of the Design Act).