

## Q&A: Appeal and Trial Procedures

\*The content is the same as the “Q&A on Overview of Appeals and Trials (Procedures Chapter).”

[1. Appeal Against an Examiner’s Decision of Refusal](#)

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[7. Post-Grant Submission of Information by Third Parties](#)

## 1. Appeal Against an Examiner's Decision of Refusal

### (i) Written Request for Appeal

#### <Submission deadline>

**Q1-1:** I received a certified copy of the examiner's decision of Refusal. What is the deadline for submitting a Written Request for Appeal? (Common to the 4 Acts)

**A1-1:** The period for filing is 3 months (4 months if you are an overseas resident limited to appeals against an examiner's decision of refusal in regard to patent) from the day immediately following the date when you received the certified copy of the Examiner's Decision of Refusal (i.e. date of deliver) (Patent Act §121 (1)). However, if the last day of the three-month or four-month period falls on days when the JPO is closed, such as Saturdays, Sundays and national holidays, the submission deadline is the next day when the JPO is open. This three-month or four-month period is calculated by calendar days, not the number of days (Patent Act §3 (1) (ii)). Accordingly, i) when counting from the beginning of the month, the period terminates on the last day of the final month; ii) when counting not from the beginning of the month, and there is an applicable date in the final month, the period terminates on the day immediately preceding that date; iii) when counting not from the beginning of the month, and there is no applicable date in the final month, the period terminates on the last day of that final month.

For example, when the certified copy of the Decision of Refusal is delivered on April 1, the base date is April 2, and therefore, the submission deadline is July 1, which is the day immediately preceding the applicable date three months later (\*if the JPO is open). When the applicable date is the 30th or 31st in months, like February, that have less than 30 or 31 days, the period terminates on the last day of that month (\*if the JPO is open).

However, please note that the date sent is the date delivered if the certified copy of the Decision of Refusal is sent online.

**Q1-2:** Is it possible to receive an extension of the period for filing the Written Request for Appeal? (Common to the 4 Acts)

**A1-2:** No, all requests for the extension of the period are dismissed. However, in cases where the applicant is an overseas resident, the period for requesting an appeal against an examiner's decision of refusal (with the exception of an appeal against an examiner's decision of refusal concerning a request for the registration of extension of the duration of a patent right) is extended ex officio by 1 month, and therefore the period for requesting an appeal against an examiner's decision of refusal is within 4 months from the date of deliver of a certified copy of the Examiner's Decision of Refusal. Since this is an ex officio extension, you do not have to submit a Written Request, etc. for the extension of the deadline.

#### <Address>

**Q1-3:** Where should I address the Written Request for Appeal, etc.? (Common to the 4 Acts)

**A1-3:** The Written Request for Appeal as well as the Written Amendment, for amending Description, Claims or Drawing filed at the same time as the request for appeal, should be addressed to the JPO Commissioner.

In other cases, amendments responding to notification of invitation for amendment, etc. by the JPO Commissioner or voluntary amendments should be addressed to the JPO Commissioner, and amendments responding to notification of invitation for amendment from the JPO Chief

Administrative Judge, notice of reasons for refusal, etc. should be addressed to the JPO Chief Administrative Judge.

**<Application number>**

**Q1-4:** When requesting for appeal by online filing, entering the application number required for the [Indication of the Appeal Case] field using Western calendar years returned an error. What is the correct way of entering the application number? (Common to the 4 Acts)

A1-4: When the year of your application number is 2000 or later, you need to enter the year using Western calendar years, such as “Japanese Patent Application No. 2000-123456,” but if the year of your application number is earlier than 2000, you need to enter the year in Japanese era years, such as “Japanese Patent Application No. 10-123456.”

**<Appeal fee>**

**Q1-5:** How much do I need to pay for the appeal fee? At which point in time do I count the number of claims, which corresponds to the amount to be paid? (Patent Act)

A1-5: The appeal fee you need to pay is the amount corresponding to the number of claims described in the Claims when requesting for appeal. Accordingly, when amending the Claims at the same time as requesting for appeal, please make payment in the amount corresponding to the number of claims after amendment.

**Q1-6:** I plan to submit a Written Amendment to amend the Claims at the same time as requesting for appeal, and the number of claims will increase from the time of the examiner’s decision of refusal. What should I do for the fees? (Patent Act)

A1-6: When filing a Written Request for Appeal, you need to pay the appeal fee corresponding to the number of claims described in the Claims at the time of requesting for appeal. If the number of claims will increase from the number of claims for which you have already paid the fees for requesting the examination of patent application in the examination phase, you need to pay additional fees for requesting the examination of patent application corresponding to the difference in the number of claims together with the Written Amendment.

**<Number of classes of trademarks>**

**Q1-7:** When the decision of refusal was made, the number of classes of goods and services (hereinafter referred to as “classes”) was “2.” But, the number of classes of goods and services is “1” at the time of requesting for appeal. How should I request for appeal with the number of classes “1”? (Trademark Act)

A-7: Please submit a Written Amendment to reduce the number of classes on the same day as requesting for appeal. When doing so, you need to pay an appeal fee in the amount corresponding to the number of classes after amendment (1 class in the case of the question).

**<If an appeal fee is not required>**

**Q1-8:** If payment of an appeal fee is not required (e.g. in the case of a government organization), what should be written in the [Indication of the Fee] field? (Common to the 4 Acts)

A1-8: You are not required to fill in the [Indication of the Fee] field. When filing online, a warning message will be displayed at the time of sending the request, but continue with the procedures and send the request.

**Q1-9:** When requesting for appeal regarding an application on which an organization such as a government organization that is not required to pay an appeal fee is named as a co-applicant, I believe only the appeal fee corresponding to the non-government ownership ratio needs to be paid. In such case, how should I indicate this in the Written Request for Appeal? (Common to the 4 Acts)

A1-9: Please indicate the ownership of all non-government parties in relation to total ownership, in the format of XX/XX, by inserting the [Ownership Ratio] field following the [Appellant] field (or the [Agent] field if an agent files the request). In such case, you will need to present written proof of the ownership ratios. Or, when omitting the submission of the written proof by referring to a document submitted at the time of filing the application that proves the ownership ratios, please indicate it as shown below.

[Title of Document] Written Request for Appeal

:

[Agent]

:

[Ownership Ratio] XX/XX

[List of Documents to be Submitted]

[Name of Documents] Written Proof of Ownership Ratio 1

[Indication of Reference] Referred to the document attached to XX concerning  
Japanese Patent Application No. XXXX-XXXXXX  
submitted on Month Day, Year

**<Request for appeal concerning joint application>**

**Q1-10:** I received a certified copy of the Examiner's Decision of Refusal for an application jointly filed by two or more people. What should I keep in mind when appealing against the examiner's decision of refusal? (Common to the 4 Acts)

A1-10: Since all applicants need to jointly request for appeal (Patent Act §132 (3)), you need to insert the [Appellant] field in the Written Request for Appeal to include all members of the joint applicants (Regulations under the Patent Act, Form No. 61-2, Note 7). However, when requesting for appeal by online filing, not through an agent, parties other than the online performer of the request for appeal must conduct procedures (filing a Written Supplement), within 3 days from the date of requesting for appeal, for statement to the effect that they have completed specified procedures (Regulations under the Act on Special Provisions §21). (Please refer to Q1-36 regarding the statement to the effect of having completed specified procedures)

**<Agent>**

**Q1-11:** If there are multiple agents, how should I indicate persons other than the online performer of the request when filing online? (Common to the 4 Acts)

A1-11: You can indicate them by inserting the [Agent] or [Appointed Agent] fields repeatedly until all agents are included. In the [Agent] field, you need to describe the agent that files a Written Request for Appeal. In the [Appointed Agent] field, you need to describe the agents for which appointment is being notified at the same time as filing the Written Request for Appeal. Both parties do not differ in their status as the applicant's agent.

If there are multiple [Agent] fields, this means that procedures are conducted by those multiple agents. Accordingly, when conducting procedures by submitting documents on paper, each agent must affix their seal or identification label. When conducting procedures by online filing, agents other than the performer of procedures must submit a Written Supplement for confirmation of their intent (Please refer to Q1-36 regarding the statement to the effect of having completed specified procedures).

**Q1-12:** When requesting for appeal, do I need to attach a document on paper proving authority of representation? (Common to the 4 Acts)

A1-12: When filing appeals against an examiner's decision of refusal, you must attach a Power of Attorney, since it is necessary to confirm if the agent is "expressly so empowered" as stipulated in the provisions in Article 9 of the Patent Act when the appellant is a domestic resident (Regulations under the Patent Act §4-3 (1)), and to confirm if there is "limitation on the scope of authority of representation" as stipulated in the Proviso to Article 8, Paragraph 2 of the Act when the appellant is an overseas resident (Regulations under the Patent Act §4-3 (4)). However, if the agent at the time of filing the application files a request for appeal against an examiner's decision of refusal, and if the "request for appeal against an examiner's decision of refusal" is clearly stated as matters delegated in the Power of Attorney submitted prior to request for appeal, you do not need to submit another Power of Attorney. In such case, please describe the statement to the effect of referring to the Power of Attorney in the Written Request for Appeal .

**Q1-13:** I plan to request for appeal through an agent different from the one at the time of filing the application. Do I need to submit a notification of change of agent, etc. when filing a request for appeal? (Common to the 4 Acts)

A1-13: You do not need to submit a Written Notification of Acceptance of Power of Attorney or Written Notification of Resignation of Power of Attorney. However, please be aware that you need to submit a written proof of authority of representation when requesting for appeal.

**Q1-14:** If a patent business legal entity is the agent, or if multiple agents are appointed, do I always need to indicate the patent attorney in charge? (Common to the 4 Acts)

A1-14: Yes, please indicate your patent attorney in charge to the best extent possible. Specifically, in the [Contact] field under the [Agent] or [Appointed Agent] field of the patent attorney in charge, please describe “Representative of the applicant” (if the agent is a patent business legal entity, describe “The representative of the applicant is XXXX (Name).”), and also insert the [Phone Number] field and describe the representative’s phone number.

- (1) If the agent is a patent attorney

[Title of Document] Written Request for Appeal

:

[Agent]

:

[Agent] (or [Appointed Agent])

[Identification Number] XXXXXXXXXX

[Patent Attorney]

[Name] XXXX

[Phone Number] XX-XXXX-XXXX

[Contact] Representative of the applicant

- (2) If the agent is a patent business legal entity

[Title of Document] Written Request for Appeal

:

[Agent]

[Identification Number] XXXXXXXXXX

[Name] Patent business legal entity XXXX

[Representative of the Entity] XXXX

[Phone Number] XX-XXXX-XXXX

[Contact] The representative of the applicant is XXXX

#### <Written proof of authority of representation>

**Q1-15:** I want to refer to the Power of Attorney that I submitted at the time of filing an application. How should I indicate this? (Common to the 4 Acts)

A1-15: When referring to the Power of Attorney at the time of filing an application, please insert the [List of Documents to be Submitted] field and describe as shown below.

[List of Documents to be Submitted]

[Name of Documents] Power of Attorney 1

[Indication of Reference] Referred to the document attached to XX submitted  
on Month Day, Year

**Q1-16:** I want to submit a Power of Attorney at the same time as requesting for appeal by online filing. What is the procedure for this? (Common to the 4 Acts)

A1-16: You need to submit a Power of Attorney by filing a Written Supplement. (Regulations under the Act on Special Provisions §19, §20)

You are not required to fill in the [List of Documents to be Submitted] field in the Written Request for Appeal.

However, if three days have elapsed since the date of requesting for appeal, you need to submit a Power of Attorney by filing a Written Amendment (Formality) (Please refer to Q1-35)).

**Q1-17:** I want to refer to the General Power of Attorney that I submitted before requesting for appeal in a Written Request for Appeal. In such case, how should I indicate this in the Written Request for Appeal? (Common to the 4 Acts)

A1-17: If a General Power of Attorney's number is already assigned, please describe it in the [List of Documents to be Submitted] field of the Written Request for Appeal as shown below.

[List of Documents to be Submitted]

[General Power of Attorney's Number] XXXXXXXX

If a General Power of Attorney's number is not assigned, please describe as shown below.

[List of Documents to be Submitted]

[Name of Document] Power of Attorney 1

[Indication of Reference] Referred to the General Power of Attorney submitted on Month Day, Year

#### <Grounds for the request/means of evidence>

**Q1-18:** If I submit a Written Request for Appeal describing in the [Grounds for the Request] field that "This will be supplemented later" due to being unable to prepare it in time, how will it be handled? (Common to the 4 Acts)

A1-18: If you submit a Written Request for Appeal describing in the [Grounds for the Request] field that "This will be supplemented later," please submit a Written Amendment (Formality) to supplement the description of the [Grounds for the Request] field as soon as possible. If you do not submit a Written Amendment (Formality), an invitation for amendment is issued, and if you do not respond to this, your Written Request for Appeal is dismissed.

**Q1-19:** When requesting for appeal online, entering half-width katakana characters in the [Grounds for the Request] field of the Written Request returned an error. Are there restrictions to the characters that can be used? (Common to all 4 Acts)

A1-19: Yes, there are restrictions to the characters that can be used in online filing. You must use the JIS codes conforming to JIS-X0208-1997 “Code of Japanese Graphic Character Set for Information Interchange,” consisting of the JIS Level 1 kanji set and the JIS Level 2 kanji set. Therefore, for example, you cannot use half-width katakana or numbers enclosed within a circle.

**Q1-20:** I want to submit documentary evidence when requesting for appeal by online filing. How should I conduct the necessary procedures? (Common to the 4 Acts)

A1-20: Please describe as shown below in the [Means of Evidence] field of the Written Request for Appeal, and submit your documentary evidence in writing by attaching it to the Written Supplement. (Please refer to Q1-33 regarding how to describe a Written Supplement)

[Means of Evidence] As evidence, Appellant’s Exhibit No. 1 (name of documentary proof) and Appellant’s Exhibit No. 2 (name of documentary proof) are submitted with a Written Supplement

#### <Other>

**Q1-21:** What kind of appeal can be filed online? (Common to the 4 Acts)

A1-21: Online filing is allowed for appeals against an examiner’s decision of refusal for patents, designs, and trademarks; appeals against examiner’s decision of dismissing an amendment of designs and trademarks; and intermediate procedures to such appeals. Please note that when conducting these procedures in writing you must pay for a digitizing fee.

**Q1-22:** When requesting an appeal against an examiner’s decision of refusal in writing, should I include the dispatch number of the Decision of Refusal? In addition, do I need to submit a duplicate? (Common to the 4 Acts)

A1-22: You do not need to include the dispatch number of the Decision of Refusal since a new procedure starts when an appeal is filed. You also do not need to submit a duplicate.

#### (ii) Intermediate Documents

##### <Written Amendment at the same time as requesting for appeal>

**Q1-23:** I want to send a Written Amendment that amends Description, Claims, or Drawings (hereinafter referred to as “Description, etc.”) at the same time as filing a Written Request for Appeal by online filing. What should I do? Also, how should I fill in the field of the appeal number on the Written Amendment? (Patent Act)

A1-23: By putting the documents that you want to send at the same time, such as a Written Request for Appeal and a Written Amendment, in the Outgoing File Folder of the e-Filing software, selecting all of these documents, and then clicking the “Apply Online” button once, you can send the documents (Regulations under the Act on Special Provisions §14 (1)).

Since you cannot fill in the [Appeal Number] field of the Written Amendment if an appeal number has not been assigned yet, in such case, please change the [Appeal Number] field to the



[Date of Request for Appeal] field, and then enter the request date. You can send a request without the [Date of Request for Appeal] field, but if it is a PCT application number assigned prior to 2009, you need to always insert the [Date of Request for Appeal] field, because otherwise you cannot complete the online filing.

Not following the instruction described above, if you send documents with the assigned appeal number in the [Appeal Number] field, such Written Amendment will be dismissed since the amendment procedures are not being conducted at the same time as the request for appeal.

**Q1-24:** If the Written Amendment that amends Description, etc. submitted at the time of requesting for appeal is dismissed due to not having been submitted “at the same time” as the request for appeal, what should I do? (Patent Act)

**A1-24:** If amendment of Description, etc. is not conducted at the same time as the request for appeal, the Written Amendment will be dismissed. Accordingly, such appeal case will undergo proceedings by the panel without undergoing reconsideration by examiners before appeal proceedings.

If you desire reconsideration by examiners before appeal proceedings and appeal examination by the panel based on the content after amendment, and if it is within the designated period of requesting for appeal, you must file a request for appeal one more time before the expiration of the designated period of requesting for appeal and, when doing so, you must conduct the amendment at the same time as requesting for appeal. You will also need to withdraw the previous request for appeal. In this case, the appeal fee will not be returned.

**Q1-25:** When filing online, what happens if I cannot send the Written Request for Appeal and Written Amendment “at the same time” due to communication problems, etc.? For example, if an outgoing transmission is interrupted and one document is sent before the interruption and another is sent after the interruption, will both be deemed as having been submitted “at the same time”? (Patent Act)

**A1-25:** If some of the outgoing files that you tried to send at the same time remain in the [Outgoing File Folder] as a result of the process (communication) being interrupted and being later resumed due to the occurrence of an error during online procedures, etc., they will be handled as having been submitted at the same time as the request for appeal as long as the outgoing files are re-sent on the same day, without having undergone another operations (e.g. operations of inserting the appeal number you received in the Written Amendment and converting it to the re-sent files, or sending other documents such as a Written Request for Examination of the divisional application), and they are received by the JPO.

#### **<Written Amendment>**

**Q1-26:** Is it possible to conduct necessary procedures for amendment of grounds for the request and amendment of Description, etc. by filing one Written Amendment? (Patent Act)

**A1-26:** An amendment of grounds for the request is the amendment to the Written Request for Appeal, while an amendment to Descriptions, etc. is the amendment to a different document from the Written Request for Appeal. You are not allowed to perform amendment to different documents by filing one Written Amendment, so please conduct necessary procedures by filing separate Written Amendments. As for amendment of grounds for the request, please submit a Written Amendment (Formality). In addition, please note that amendment of Description, etc. must be made at the same time as the request for appeal or within the designated period

regarding notification of reasons for refusal.

**Q1-27:** Are there any points to keep in mind when amending only part of the multiple claims indicated in the Claims at the same time as the request for appeal, or within the response duration regarding the notice of reasons for refusal after the request for appeal? (Patent Act)

A1-27: When amending the Claims after service of the certified copy of the examiner's decision of refusal to the effect that the request is to be refused, you need to file an amendment for the full text of the Claims, even if you amend only part of the Claims (Regulations under the Patent Act, Form No. 13, Note 7). Please refer to the sample form below to create a Written Amendment.

(1) New Form (Applications filed on or after July 1, 2003)

[Amendment 1]

[Title of Document to be Amended]	Claims
[Name of Item to be Amended]	Full text
[Method of Amendment]	Change
[Content of Amendment]	
[Title of Document]	Claims
[Claim 1]	
:	
[Claim X]	
:	

(\*Please include the full text.)

(2) Old Form (Applications filed on or before June 30, 2003)

[Amendment 1]

[Title of Document to be Amended]	Description
[Name of Item to be Amended]	Claims
[Method of Amendment]	Change
[Content of Amendment]	
[Claims]	
[Claim 1]	
:	
[Claim X]	
:	

(\*Please include the full text.)

**<Amendment of description in PCT application (with application numbers assigned on or before 1999)>**

**Q1-28:** Even for a translation in documentary proceedings of a PCT application, an amendment to Written Request for Appeal or Written Amendment concerning the translated PCT application shall be dealt as specified procedures. In such case, how should I amend the Description, etc.? (Patent Act)

A1-28: Please conduct (1) full text amendment or (2) partial amendment, as shown below.

(1) Full text amendment

[Amendment 1]

[Title of Document to be Amended]	Description
[Name of Item to be Amended]	Full text
[Method of Amendment]	Change
[Content of Amendment]	
[Title of Document]	Description
[Title of Invention]	
[Claims]	
[Detailed Description of Invention]	
([Brief Description of Drawings])	

(2) Partial amendment

[Amendment 1]

[Title of Document to be Amended]	Description
[Name of Item to be Amended]	Detailed description of invention
[Method of Amendment]	Change
[Content of Amendment]	
[Detailed Description of Invention]	
(1) Amended “XX” in Page X, Line X of the Description as “XX”.	
(2) Amended “XX” in Page X, Line X of the Description as “XX”.	

**<Amendment of application for the registration of extension of the duration of patent right>**

**Q1-29:** I received an error when trying to conduct procedures online for amendment of my application for the registration of extension of the duration of patent right (e.g. content of disposition designated by Cabinet Order or materials indicating the grounds for extension, which are stated in the application) after requesting an appeal against an examiner's decision of refusal of the application. How should I conduct the necessary procedures? (Patent Act)

**A1-29:** When amending a Written Amendment online (the same as filing it on paper) regarding (1) content of disposition designated by Cabinet order or (2) materials indicating the grounds for extension, etc., which are stated in the application, please conduct the necessary procedures by describing "[Title of Document to be Amended] Patent Application" and "[Name of Item to be Amended] Other" as shown below.

You can also conduct the necessary procedures for the amendment matters of (1) or (2) by filing a single Written Amendment.

(1) Content of disposition set forth by government ordinances

[Amendment 1]

[Title of Document to be Amended]	Patent Application
[Name of Item to be Amended]	Other
[Method of Amendment]	Change
[Content of Amendment]	

[Other]

1. Amended "(3) XXXXXXXX" of "6. Content of disposition designated by Cabinet Order in Article 67, Paragraph 2 of the Patent Act" in this application as "(3) XXXXXXXX."

(2) Materials indicating the grounds for extension

[Amendment 1]

[Title of Document to be Amended]	Patent Application
[Name of Item to be Amended]	Other
[Method of Amendment]	Change
[Content of Amendment]	

[Other]

Amended "1. XXXXXXXX" in the materials describing the grounds for extension attached to the application as "1. XXXXXXXX."

**<Rank of agents and patent attorney in charge>**

**Q1-30:** The person who will be appointed as one of the agents mid-way through the procedures will be the patent attorney in charge for this case. However, if I do not want to change the head agent, what procedures do I need to conduct? (Common to the 4 Acts)

A1-30: You need to describe the attorney's name in the [Appointed Agent] field of the Written Notification of Acceptance of Power of Attorney to indicate that the person is the patent attorney in charge, and to insert the [Other] field at the end of the Written Notification to indicate that you will not change the head agent as shown below.

[Title of Document] Written Notification of Appointment of Attorney

:

[Appointed Agent]

[Identification Number] XXXXXXXXXX

[Patent Attorney]

[Name] XX XX

[Phone Number] XX-XXXX-XXXX

[Contact] Representative of the applicant

[List of Documents to be Submitted]

:

[Other] No change to the rank of head agent

**<Warning error>**

**Q1-31:** When making an amendment without an invitation to do so, I sent a request online without inserting the [Dispatch Number] field in the Written Amendment (Formality), and then a warning message appeared in the [Dispatch Number] field. What should I do? (Common to the 4 Acts)

A1-31: When making amendments voluntarily, please continue with the procedures without change and send the request. However, when amending as a response to an invitation for amendment, you need to include the dispatch number (6 digits) in the [Dispatch Number] field.

**<Sending error>**

**Q1-32:** When I sent a Written Amendment online, the receipt indicated that there were inaccuracies in the documents. What should I do? (Common to the 4 Acts)

A1-32: If the receipt indicates that there are inaccuracies in the documents, the Written Amendment was not received by the JPO. So, you need to check the content of the Written Amendment again and re-send it.

If you are unclear about the place of inaccuracies, please contact the Electronic Filing Support Center (03-5744-8534) during service hours between 9:00 a.m. and 8:00 p.m. on weekdays.

## &lt;Written Supplement&gt;

**Q1-33:** I would like to submit evidence by attaching it to a Written Supplement. Would you tell me how to prepare it? Also, when doing so, is it necessary to indicate each of the document names from Appellant's Exhibit No. 1 to Appellant's Exhibit No. 30? (Common to the 4 Acts)

**A1-33:** Please prepare a Written Supplement in writing, indicating the details as shown below, and file it by attaching the documentary evidence to it.

[Title of Document] Written Supplement

:

[Title of Document to be Supplemented] Written Request for Appeal

[Content of Supplement] Documentary evidence

[List of Documents to be Submitted]

[Name of Documents] One copy each of Appellant's Exhibit No. 1 to Appellant's Exhibit No. 30

You do not need to pay a digitizing fee for this.

**Q1-34:** I would like to submit the actual article of a color photo when requesting for appeal by online filing. What are the proper procedures for this? (Patent Act)

**A1-34:** Please file a request in writing, indicating to the effect that you will submit a color photo in the [Grounds for the Request] field, etc. in the Written Request for Appeal, and indicating the details as shown below in the Written Supplement. In the [Content of Supplement] field, please describe the article(s) you are submitting as specifically as possible.

[Title of Document] Written Supplement

:

[Title of Document to be Supplemented] Written Request for Appeal

[Content of Supplement] Appendices (color photo)

[List of Documents to be Submitted]

[Name of Documents] Appendices (color photo) 1

You do not need to pay a digitizing fee for this.

**Q1-35:** Would you please tell me how to prepare a Written Supplement when supplementing a Power of Attorney? (Common to the 4 Acts)

A1-35: Please prepare a Written Supplement in writing, indicating the details as shown below, and file it by attaching a Power of Attorney to it.

[Title of Document] Written Supplement

:

[Title of Document to be Supplemented]

Written Request for Appeal

[Content of Supplement]

Written Proof of Authority of  
Representation

[List of Documents to be Submitted]

[Name of Documents]

Power of Attorney 1

However, if three days have elapsed from the date of requesting for appeal, please prepare a Written Amendment (Formality) in writing, indicating the details as shown below, and filing it by attaching the Power of Attorney to it.

[Title of Document] Written Amendment (Formality)

:

[Amendment 1]

[Title of Document to be Amended]

Written Request for Appeal

[Name of Item to be Amended]

List of Documents to be Submitted

[Method of Amendment]

Addition

[Content of Amendment]

[List of Documents to be Submitted]

[Name of Documents]

Power of Attorney 1

You do not need to pay a digitizing fee for this.

**Q1-36:** How should I indicate when stating to the effect that I have completed the specified procedures within three days from the date of requesting for appeal? (Common to the 4 Acts)

A1-36: Please prepare a Written Supplement, indicating the details as shown below, and file it either online or in writing.

[Title of Document] Written Supplement

:

[Title of Document to be Supplemented]

Written Request for Appeal

[Content of Supplement]

I affirm that I have conducted the procedures  
of this case.

When conducting the necessary procedures for this case in writing, you need to pay a digitizing fee.

**<Notification of Change of Name>**

**Q1-37:** I have succeeded a right to obtain a patent after a decision of refusal was made, and I plan to request an appeal against the examiner's decision of refusal. In this case, when should I conduct the necessary procedures for notifying the change of applicant's name?

**A1-37:** When a party, which becomes the successor of right to obtain a patent after the decision of refusal was made, requests for an appeal against the examiner's decision of refusal, the said party must submit a Notification of Change of Applicant's Name by the time of requesting for appeal against the examiner's decision of refusal.

When the necessary procedures are conducted by an agent, if the agent requests for appeal in the name of prior applicant without submitting a Notification of Change of Applicant's Name, even though there was a succession of right by assignment, the agent must receive from the right holder prior to assignment a proof of authority of representation concerning the request for an appeal against the examiner's decision of refusal.

Please note that, when the agent cannot prove authority of representation, that request for appeal is dismissed.

**<Other>**

**Q1-38:** Should I file a divisional application at the same time as a request for appeal? (Patent Act)

**A1-38:** As for divisional applications filed prior to April 1, 2007, you need to file a divisional application at the same time as the request for appeal.

However, as for the divisional application filed on or after April 1, 2007, regardless of whether the request for appeal is filed or not, you can file a divisional application within three months (four months if you are an overseas resident) from the date on which a certified copy of the decision of refusal has been served (Patent Act Article 44, Paragraph 1 (iii)).

**Q1-39:** For which documents do I need to pay a digitizing fee? (Common to the 4 Acts)

**A1-39:** You need to pay a digitizing fee for the specified procedures prescribed in Article 10 of the Regulations under the Act on Special Provisions. Specifically, you need to pay a digitizing fee for a Written Request for Appeal against an Examiner's Decision of Refusal, Written Amendment, Written Opinion, etc.

The JPO website publishes a list of documents related to specified procedures for which you need to pay a digitizing fee. To go to the page where the list is published, click the URL below.

<http://www.jpo.go.jp/uketuke/pdf/denshika/denshika.pdf> (英語版にリンク)

**Q1-40:** How should I make amendment when amending the fee? (Common to the 4 Acts)

**A1-40:** There are several methods. Please indicate the details as shown below, and conduct the necessary procedures with a Written Amendment (Formality).

(1) By pre-paid account

[Title of Document] Written Amendment (Formality)

:

[Amendment of Fee]

[Title of Document to be Amended]

Written Request for Appeal

[Pre-Paid Account Register Number]

XXXXXX



- [Payment Amount] 55,000 yen
- (2) By patent revenue stamp  
 [Title of Document] Written Amendment (Formality)  
 :  
 [Amendment of Fee]  
     [Title of Document to be Amended] Written Request for Appeal  
     [Payment Amount] 55,000 yen  
 \* Please prepare a Written Amendment (Formality) in writing, affixing the patent revenue stamps in the upper left margin and indicating the amount within parentheses below the stamps.
- (3) By cash payment  
 [Title of Document] Written Amendment (Formality)  
 :  
 [Amendment of Fee]  
     [Title of Document to be Amended] Written Request for Appeal  
     [Payment Statement Number] XXXXXXXXXXXXX  
 [List of Documents to be Submitted]  
     [Name of Documents] Proof of completing payment (for submission to the JPO) 1  
 \* Please attach the proof of completing payment (for submission to the JPO) to a Written Amendment by affixing it to a mount.
- (4) By electronic payment (payment information)  
 [Title of Document] Written Amendment (Formality)  
 :  
 [Amendment of Fee]  
     [Title of Document to be Amended] Written Request for Appeal  
     [Payment Number] XXXX-XXXX-XXXX-XXXX
- (5) By bank transfer (only for online filing)  
 [Title of Document] Written Amendment (Formality)  
 :  
 [Amendment of Fee]  
     [Title of Document to be Amended] Written Request for Appeal  
     [Transfer Number] XXXXXXXXX  
     [Payment Amount] 55,000 yen

**Q1-41:** What procedures do I need to conduct when I want to know the scheduled period of initiating appeal or the status after the appeal has been initiated? (Common to the 4 Acts)

A1-41: Please submit a Written Inquiry of Proceedings Status by postcard or A4 size paper. Please refer to the format provided in the Overview of Appeals and Trials (Chapter for Procedures) (Reference 11).

Also note that only the following parties are allowed to inquire: appellant (agent), interested person (demandee, intervenor, exclusive licensee, non-exclusive licensee, provisional exclusive licensee, provisional non-exclusive licensee, etc.) or information provider.

**Q1-42:** What is the correct format of the Written Response to a hearing? (Patent Act)

A1-42: The format of the Written Response is not defined by the Regulations under the Patent Act, etc. Therefore, please prepare the Written Response by following Format 64 explained in 124.01 of the Formality Examination Manual. You can find the format of the Written Response from the downloadable templates in the support site of the electronic application software (available only in Japanese).

[Title of Document] Written Response

[Addressed to] Chief Administrative Judge of the Japan Patent Office

[Indication of the Appeal Case]

[Appeal Number] Appeal XXXX-XXXXXX

[Application Number] Japanese Patent Application No. XXXX-XXXXXX

[Appellant]

:

[Dispatch Number] XXXXXX

[Content of Response]

**Q1-43:** How should I conduct the necessary procedures to extend the response duration for the Written Notice of Reasons for Refusal and hearing in an appeal against an examiner's decision of refusal? (Common to the 4 Acts)

A1-43: When there are reasonable grounds (the two grounds listed below) for being unable to respond during the response duration, an extension of the refusal response duration is approved.

Ground (1): By grounds of conducting a comparison experiment with the invention indicated in the documents cited in the Written Notice of Reasons for Refusal

Ground (2): By grounds of conducting a translation of documents for procedures, such as the Written Notice of Reasons for Refusal, the Written Opinion, the Written Amendment, etc.

<If the applicant is a domestic resident>

An extension of response duration is only approved in the case of Ground (1).

When requesting for an extension of response duration by Ground (1), a one-month extension of response duration is approved. The applicant may submit only one set of Written Request for Extension of Duration.

<If the applicant is an overseas resident>

An extension of response duration is approved in the case of either Grounds (1) or (2). The applicant may submit up to three sets of Written Request for Extension of Duration (i.e. three-

month extension).

The applicant may submit only one set of Written Request for Extension of Duration by Ground (1).

The applicant may submit up to three sets of Written Request for Extension of Duration by Ground (2).

One set of Written Request for Extension of Duration allows one month extension. Therefore, when requesting for an extension of duration of two or three months, you must submit two or three sets of Written Request for Extension of Duration, respectively.

Also note that you may submit multiple sets of Written Request for Extension of Duration at the same time.

The fee to be paid when submitting the Written Request for Extension of Duration is 2,100 yen per request.

- \* When the applicant is an overseas resident and tries to submit multiple sets of Written Request for Extension of Duration on the same day using the electronic application software, if all the Requests have identical content, they cannot be submitted on the same day due to system restrictions. In order to pass this restriction, please indicate the details in the [Content of Request] field, for example, as shown below.

“I request for a one-month extension of duration for the purpose of the translation of documents for procedures concerning the above-mentioned case. (Request X)”

(Insert 1, 2, or 3 in the X of “Request X.”)

## 2. Trial for Correction

### <Deficient description in Written Request for Trial for Correction>

**Q2-1:** The 2011 Amendment to Patent Act has made it possible to request a trial for correction on a claim-by-claim basis. As a consequence, how to prepare a Written Request for Trial has been changed, and because of this I made an error in description. What should I do in this case?

**A2-1:** When the “object of the request” or “grounds for the request” in the Written Request for Trial for Correction does not meet the description requirements (Patent Act §131 (3)), if it is possible to amend that deficiency, the chief administrative judge orders amendment of that description in the Written Request for Trial to meet the description requirements.

Among them, amendments to the “object of the request” will seek changes to the subject of correction, so in theory they require a change of the gist of the Written Request. However, such amendments are allowed only if they are in response to the order to amend (Patent Act §131-2 (1) (iii)). Please make sure to resolve deficient descriptions according to the order to amend.

However, when it is not possible to amend deficient descriptions, a decision of dismissal is made, so please request for a new trial for correction.

### <Withdrawal of request for trial for correction>

**Q2-2:** Article 155, Paragraph 4 of the Patent Act states that when we wish to withdraw a request for trial for correction, we need to withdraw all requests for trial. Isn't it possible to withdraw requests on a claim-by-claim basis?

**A2-2:** No, it is not possible to withdraw requests on a claim-by-claim basis when filing a withdrawal of requests for trials for correction after 2011 Amendment to Patent Act. Therefore, you need to withdraw all the requests for trial for correction that have been filed (Patent Act §155 (4)).

However, when you want to revoke a part of the request for trial for correction, you can delete corrections related to concerning that part of the request by filing amendment with a corrected Description, etc. (Patent Act §17-4).

### 3. Trial for Invalidation

#### <Grounds for the request>

**Q3-1:** When the amendment of the “grounds for the request” in the Written Request for Trial for Invalidation will change the gist of the Written Request, if the demandee submits a Written Reply for Consent stating approval of the amendment in question (Patent Act §131-2 (2) (ii)), does the demandee need to indicate the grounds for approval or disapproval in the Consent Form? Or, is it sufficient to simply indicate approval or disapproval? (Patent Act, Utility Model Act, Design Act)

**A3-1:** In the Written Reply for Consent (specifically, in the “Object of Reply” field therein), it is sufficient to indicate “Approval” or “Disapproval” so that the intent of the demandee may be clear. Also, when there are items that do not meet the requirement for approval of amendment in the corrections, the demandee may also indicate his/her opinion, etc. for such items, in addition to indicating his/her approval or disapproval in the Written Reply for Consent.

**Q3-2:** When requesting a trial for invalidation for a patent right granted according to the Patent Act prior to 1987 Amendment, do I need to describe the grounds for invalidation not only for essential claims (independent claims) but also for embodiment claims (dependent claims)? (Patent Act)

**A3-2:** You can request for trial with the description of the grounds for invalidation only for essential claims (since embodiment claims will be automatically invalidated when essential claims become invalid before 1987 Amendment to Patent Act). However, in cases where the patentee has changed embodiment claims to essential claims through a request for correction, if you did not describe the grounds for invalidation for the then embodiment claims, the request may be dismissed since the object and grounds of the request for trial for invalidation cannot be amended.

#### <Extended registration invalidation trial>

**Q3-3:** I want to request for an extended registration invalidation trial, but there are multiple extended registrations for the patent in question, and I want to invalidate all of such extended registrations. Is it possible to do this by filing one Written Request for Trial for Invalidation? In addition, is the fee calculated based on the number of claims to be invalidated? (Patent Act)

**A3-3:** Multiple extended registrations may arise in cases where, for example, as for the patent right of a certain pharmaceutical product, etc., approval and authorization may have to pass through multiple administrative agencies (e.g. Ministry of Agriculture, Forestry and Fisheries, Ministry of Health, Labor and Welfare) depending on the embodiment (e.g. pest control, prevention of suppuration), and as a consequence, the period of extended duration varies.

In such case, you need to request a trial for invalidation for each of those extended registrations. Unlike regular trial for invalidation, it is an invalidation of extension for that patent right, so the trial fee is based on the number of all claims indicated in the Claims.

**<Oral proceedings>**

**Q3-4:** When the demandant is summoned on a designated date in the proceedings of a trial for invalidation (Patent Act §145 (3)), can the demandant be represented by a new agent? (Common to the 4 Acts)

A3-4: Both parties concerned may be represented by a new agent at any time during a pending trial. The same applies when being summoned on a designated date. Also, when the agent is appearing as agent only for oral proceedings, you need to submit on the date of oral proceedings a Power of Attorney stating to that effect.

**Q3-5:** Trials for invalidation are, in principle, conducted by oral proceedings, but wouldn't it be highly disadvantageous for people living far away in terms of cost, because they must appear before the JPO? (Common to the 4 Acts)

A3-5: Upon request by parties concerned, a panel (administrative judge) may be able to hold the oral proceedings by visiting a location other than the JPO (circuit trial).

**Q3-6:** Does an agent (patent attorney) always need to be in attendance when conducting oral proceedings? (Common to the 4 Acts)

A3-6: It is acceptable for only the parties concerned to appear in the oral proceedings. However, when the concerned party is not versed in the procedures, etc. of trial for invalidation, it is desirable to have someone who can sufficiently handle the questions and answers in the oral proceedings (agent such as a patent attorney) to appear.

**<Written Request for Examination of Witness(es)>**

**Q3-7:** How should I describe the witness in the Written Request for Examination of Witness(es) to be submitted when requesting for examination of witness(es)? (Common to the 4 Acts)

A3-7: You need to always indicate the address (domicile), name, and occupation of the witness for the description of witness so that the witness can be specified. Additionally, in the Written Statement of Matters for Examination to be submitted at the same time as the Written Request for Examination of Witness(es), please list the matters to be examined and indicate the time required for examination.

**Q3-8:** Article 148, Paragraph 4 of the Patent Act states that "the intervenor may undertake all trial procedures." Is it possible for the intervenor to withdraw the request for the trial in question? (Common to the 4 Acts)

A3-8: No, it is not possible for the intervenor to withdraw a request initiated by the demandant. When wishing to withdraw from an intervened trial case, the intervenor shall withdraw the intervention. When the demandant withdraws the request for trial (does not require consent of intervenor), the intervenor shall continue the trial, and therefore, in such case, the intervenor may withdraw the request for trial that has been continued.

**<Lapse of the patent right>**

**Q3-9:** I plan to request a trial for invalidation for a patent right which has already lapsed, but the patentee (company) has changed due to undergoing a merger. Who should I indicate as demandee when requesting for trial? (Common to the 4 Acts)

A3-9: When the party that used to be the right holder has changed due to succession or merger, the party that succeeded the right becomes the demandee, but when requesting for trial, you simply need to indicate the party that is recorded as the right holder in the registry. However, when the successor in question is known at the time of requesting for trial, you need to indicate the successor next to the demandee in the [Demandee] field.

**<Submission of evidence in a request for trial for invalidation>**

**Q3-10:** When submitting a publicly known publication as the principal evidence to be used as grounds for invalidation to request for trial for invalidation, do I need to submit a document that proves the period of distribution of publication at the time of requesting for trial? (Patent Act)

A3-10: Facts that are used as grounds for invalidation (i.e. the principal facts) are the required description for the grounds for requesting trial for invalidation, so you need to concretely specify the facts, including the period of distribution of publication, when requesting for trial. Later on, when the credibility of the distribution period becomes a point of conflict between the parties concerned, and you wish to submit documents that prove that period, it shall be deemed as addition of indirect fact or indirect evidence, which does not fall under an amendment that essentially changes the principal facts. However, it is recommended that you submit documentary evidence at an early stage in order to conduct proceedings promptly and accurately.

**<Withdrawal of request for correction in a trial for invalidation>**

**Q3-11:** Is it possible to withdraw a request for correction in a trial for invalidation? (Patent Act)

A3-11: It is possible to withdraw a request for correction only within the period in which amendment is allowed, but it is not possible to withdraw the requests for any of the claims or any of the groups of claims, so you need to withdraw all the requests that have been made (Patent Act §134-2 (7)). When you want to withdraw requests for corrections for any of the claims or for any of the groups of claims, you may do so by amendment with a corrected Description, etc. (Patent Act §17-4).

**<Motion for request for correction when a judgment on revocation of a trial decision has been finalized>**

**Q3-12:** When is the base date of the period in which a motion for request for correction can be made after a judgment on revocation of a trial decision to maintain a patent has been finalized? (Patent Act)

A3-12: The base date is the day immediately following the date when the judgment on revocation of a trial decision has been finalized (Patent Act §134-3, §3 (1) (i)). If a motion for final appeal or acceptance of final appeal is not made, the judgment is finalized on the expiry of two weeks (appeal period) from the date on which the date of service of the Written Judgment in question (Code of Civil Procedure §313, §318 (5), §285). Please check with the court clerk for the specific date of finalization of judgment.

**<Withdrawal of request for trial for invalidation>**

**Q3-13:** I submitted a request for trial for invalidation, but I would like to withdraw the request partially. Is this possible? (Common to the 4 Acts)

A3-13: As for trials for invalidation concerning patent right and utility model right, when a trial for invalidation is requested for two or more claims, you can withdraw trial on a claim-by-claim basis (Patent Act §155 (3), Utility Model Act §39-2 (6)). Also, as for trial for invalidation concerning trademark right, when a trial for invalidation is requested for two or more designated goods (or services), you can withdraw trial for any of the designated goods (or designated services) (Patent Act §155 (3) applied mutatis mutandis pursuant to Trademark Act §56 (2) ).

Meanwhile, as for requests for trial for invalidation concerning design right, you can withdraw trial only on a case-by-case basis (since Patent Act §155 (3) is not applied mutatis mutandis).



## 4. Trial for Rescission of Trademark Registration

**Q4-1:** When requesting a trial for rescission of a multi-class registered trademark in connection with some designated goods and designated services, how should the “object of the request” be described, and what is the fee for requesting trial? (Trademark Act)

**A4-1:** In the [object of the request] field, please describe as follows: “I would like to request that out of the goods and services designated for Japanese Trademark Registration No. XXXXXXXX, the registrations for “Class nn xxx, xxx” and “Class nn xxx, xxx” shall be rescinded pursuant to Article 50, Paragraph 1 of the Trademark Act., and that demandee will bear the cost in connection to the trial.”

The fee for requesting the trial for rescission is 15,000 yen + (the number of classes x 40,000 yen).

**Q4-2:** In a sample of the Written Request for Trial for Rescission, the [Grounds for Request] field contains (1) “Composition of Trademark” as well as “Designated Goods or Designated Services.” If the mark is a figure and a vast number of goods or services are designated for the mark, how should I describe the grounds for request? (Trademark Act)

**A4-2:** Since a Written Request for Trial for Rescission should be submitted in writing, you can indicate, for example, by cutting and pasting from a trademark bulletin, etc. for marks, and from the registry for designated goods and designated services. However, these are not required description in the Written Request for Trial, so an invitation for amendment will not be issued for them even if they are not included.

**Q4-3:** I requested a trial for rescission of trademark registration due to nonuse, but I accidentally included designated goods and designated services that are in use. As such, I would like to withdraw a part of the request concerning such designated goods, etc.. Is this possible? (Trademark Act)

**A4-3:** No, you can withdraw trial only on a case-by-case basis in requests for trial for rescission (since Patent Act §155 (3) is not applied mutatis mutandis).

## 5. Opposition to Trademark Registration (Trademark)

**Q5-1:** What is the deadline for filing a Written Opposition? (Trademark Act)

A5-1: The submission deadline is two months after the base date, calculated from the day immediately following the date of issuance of the trademark bulletin (Trademark Act §43-2 (1)). However, if the last day of the two-month period falls on days when the JPO is closed, such as Saturdays, Sundays, and national holidays, the submission deadline is the next day when the JPO is open (Patent Act §3 applied mutatis mutandis pursuant to Trademark Act §77 (1)). This two-month period is calculated by calendar days, not the number of days.

**Q5-2:** Is it possible to receive an extension of the period for filing a Written Opposition? (Trademark Act)

A5-2: No, all requests for extension of the period are dismissed. However, certain amendments, such as supplementing the [Grounds for Opposition] field in the Written Opposition (Proviso to Trademark Act §43-4 (2)) may be filed within thirty days if the opponent is a resident of Japan, and within ninety days (thirty days + sixty days extended ex officio) if the opponent is an overseas resident.

**Q5-3:** When is a duplicate of a Written Opposition sent to the right holder? (Trademark Act)

A5-3: If the opponent is a resident of Japan, the duplicate is sent approximately two months after the expiry of the period for filing an opposition. If the opponent is a resident of a foreign country, the duplicate is sent approximately four months after the expiry of that period.

**Q5-4:** Can the right holder state an opinion on the duplicate of a Written Opposition that has been sent? (Trademark Act)

A5-4: The right holder can state an opinion by means of a Written Statement. Also, when the trial examination has proceeded and a Notice of Reasons for Revocation has been issued, the right holder is granted an opportunity to submit a Written Opinion in response.

**Q5-5:** How can I learn that an opposition has been filed? (Trademark Act)

A5-5: A Notice of Opposition Number is sent by postcard to the opponent and to the right holder approximately three to four weeks after an opposition is filed. In addition, a registration of the request for a trial for opposition is entered into the registry.

**Q5-6:** What is a registration of a request for a trial? (Trademark Act)

A5-6: When an opposition has been filed, that effect is registered in the registry. This is done for the purpose of providing a warning to persons engaging in transactions concerning the trademark rights so that they may not face the risk of suffering unforeseen damage at a later date. The request for a trial is recorded in the registry approximately four weeks after the opposition is filed. It is also recorded on the Japan Platform for Patent Information (J-PlatPat) database approximately one month after the request for trial is recorded in the registry.

**Q5-7:** Is there a way for the opponent to learn of the progress of a trial examination? (Common to the 4 Acts)

A5-7: The opponent can learn of the progress by filing an application for viewing, or by referring to the Japan Platform for Patent Information (J-PlatPat) to see whether Written Oppositions or other documents have been submitted for certain cases.

**Q5-8:** Is it possible to make additional amendments when new grounds have been discovered after the expiry of the period for submission of supplementary grounds? (Trademark Act)

A5-8: You cannot make additional amendments as grounds for opposition, but you can submit them in a Written Statement. However, whether the Written Statement that you submitted will be subject to ex officio proceedings is left to the decision of the panel.

**Q5-9:** Is it possible to restrict viewing by third parties when trade secrets are included in the documents concerning the filed opposition? (Trademark Act)

A5-9: No, it is not possible to restrict viewing even when expressing the reason to the effect that trade secrets are included in the documents concerning the filed opposition (since Trademark Act §72 (1) (i) is not applied mutatis mutandis).

**Q5-10:** Can I withdraw an opposition to registration? (Trademark Act)

A5-10: You may withdraw an opposition to registration until a notice of grounds for revocation of trademark registration is issued by the JPO (Trademark Act §43-11 (1)) (Trademark Act §43-12). In addition, if the objection is for two or more designated goods (designated services), you may withdraw registration for any of the designated goods (or designated services) (Trademark Act §43-11 (2)).

## 6. Hantei (Advisory Opinions on the Scope of a Right)

### <The number of items in question (article A) in one request>

**Q6-1:** When seeking, for instance, the Hantei of the JPO regarding whether a certain patent right falls under the technical scope of the patented invention in terms of multiple items in question (customarily termed “article A (article in dispute)”), is it possible to do so with one request for Hantei? (Common to the 4 Acts)

**A6-1:** You can have only one item in question (article A) per request for Hantei. Even if the subject of Hantei is an identical patent right, if there are multiple items in question (articles A) for which Hantei should be requested, you need to separately file a request for Hantei for each item in question (article A).

### <Joint request>

**Q6-2:** When the demandants of the request for Hantei are joint right holders, do the joint right holders need to file a request jointly? (Common to the 4 Acts)

**A6-2:** No, joint right holders do not necessarily need to file a request jointly. Insofar as the Hantei does not have binding force, it is not always necessary for them to request jointly. Therefore, even if it is not requested jointly, the request is processed as being lawful without being invited for amendment.

### <How to request for Hantei>

**Q6-3:** When the patentee seeks a Hantei that the licensed items of another party fall under the technical scope of his/her patent, if there are multiple parties that are implementing the licensed items, is it possible to request for Hantei collectively of all such cases by filing a request for Hantei one time? (Common to the 4 Acts)

**A6-3:** Since it is necessary to make judgement on each item in question (article A) for each case based on the content of the demandee’s answers in the proceedings of the Hantei, you are not allowed to enter multiple demandees in one request from the perspective of avoiding complexity in the proceedings.

## 7. Post-Grant Submission of Information by Third Parties

**Q7-1:** Will the notice to the effect that there was post-grant submission of information by third parties be served only to the patentee? Are there cases where the agent at the time of filing the application will be also served? (Patent Act, Utility Model Act)

**A7-1:** Regardless of whether the patentee is an overseas resident or not, if an agent was appointed at the time of filing the application, notice is served only to that agent. If an agent was not appointed at the time of filing the application, the patentee is notified.

**Q7-2:** Is it possible to view the content of the post-grant submission of information by third parties via the Internet? (Patent Act, Utility Model Act)

**A7-2:** In order to view the information via the Internet, you need the electronic filing software. However, in the cases indicated below, you will not be able to view it online:

- (1) Patent and Utility Model: Applications filed on or before November 30, 1990 and procedures thereof
- (2) PCT (Designated Office): Procedures of PCT international applications as well as international utility model registration applications for which the domestic documents or translations were submitted on or before December 31, 1999
- (3) Appeal (ex-parte appeal): Procedures of appeal cases for which a request was filed on or before December 31, 1999

\* Please note that it is not possible to view content of submission of information by third parties on the Japan Platform for Patent Information (J-PlatPat).

### <Other>

**Q7-3:** Is it possible for third parties to submit information online after the grant of patent? (Patent Act, Utility Model Act)

**A7-3:** Yes, it is possible for third parties to submit information (Written Submission of Publications and Others) after the grant of patent by online filing. Please use the electronic filing software provided on the support site of the electronic application software, which you can find on the National Center for Industrial Property Information and Training website. Please note that you cannot mix PDF and image data (e.g. JPEG, GIF, BMP). Also note that you can only attach up to 10 PDF files.