

21—02 PUDT

Order for Amendment and Inquiry

1 . As a result of examination of formality requirements of a written demand/request for trial/appeal, etc. according to 21-00, when a deficiency on formalities has been found, an order for amendment or an inquiry is issued in principle.

(1) Order for amendment (Patent Act Articles 17(3) and 133(1)(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

An order for amendment is issued by the Commissioner of the Japan Patent Office or a chief administrative judge. This order is issued when an amendment is ordered for a deficiency on formalities (lack of descriptions, unclearness, outstanding (shortage) of payment of fees, etc.) of a demand/request for trial/appeal, or a petition of an opposition to grant of patent (an opposition to registration of trademark).

Regarding an order for amendment for an appeal against examiner's decision of refusal for a patent application, when the appeal case that a specification, claims or drawings are amended with a request for the appeal, the order is issued by the Commissioner of the Japan Patent Office before releasing a reexamination by the examiner before trial, and the order is issued by a chief administrative judge after releasing a reexamination by the examiner before trial and for other cases.

(2) Inquiry (Patent Act Articles 134(4), Utility Model Act Article 39(4), Design Act Articles 52, 68(2), Trademark Act Articles 56(1), 68(4), 77(2))

An inquiry is issued by a chief administrative judge: it is issued for clarifying the facts on legal requirements of the demand, for ensuring

accurate indication of the demand although the facts are clear, or for arising necessity to clarify the facts after the trial proceedings begin on the merits (→ 37-02). When an amendment, etc. has not been made and a deficiency is not resolved even after an inquiry was issued, an order for amendment of (1) will be issued.

2. When a person taking procedures has received a contact from a trial clerk or an administrative judge prior to the issuance of an order for amendment or an inquiry against a deficiency of formalities, and the deficiency is resolved by the person making voluntary amendment, the written amendment is accepted and neither an order for amendment nor an inquiry is issued.

3. When it is apparent that a deficiency of formalities is an error in writing or a minor mistake and ex officio correction does not change a purport of the documents, a trial clerk may correct the documents ex officio without issuing an order for amendment or an inquiry. When making corrections ex officio, a trial clerk needs to obtain a consent of a person taking procedures by telephone, e-mail, etc. prior to the correction.

4. When an order for amendment or an inquiry is issued for trials such as a trial for invalidation, a trial for rescission, etc. and an opposition to grant of patent (an opposition to registration of trademark), a duplicate of a written demand (an opposition) is suspended from serving (dispatching) to a counterparty, and the duplicate shall be served (dispatched) after a deficiency is lawfully amended by a written amendment.

5. When a panel determines a demand for trial is unlawful and it is not possible to make an amendment thereof, said demand for trial is immediately dismissed by trial decision without issuing an order for amendment or an inquiry (Patent Act Article 135, → 22-01 8.(2), → 61-04 3., etc.).

(Revised December 2023)