

## **21—03.1 PUDT**

### **Description in the Column "Reasons for Demand (Request)" in Written Demand/Request for Trial/Appeal**

It is required to state reasons for demand/request for trial/appeal stipulated under the provisions of the Patent Act Article 131(1)(iii), the Utility Model Act Article 38(1)(iii), the Design Act Article 52, the Trademark Act Article 56(1).

1. Trial/appeal for patents, designs, or trademarks excluding a trial for invalidation

Reasons for demand/request for a trial/appeal are important in the proceedings of reexamination by examiner before trial and the proceedings of trial/appeal, for an examiner and an administrative judge to understand argument of a demandant/appellant promptly and appropriately. Therefore, it is necessary to clearly explain reasons with substantive contents of demand/request for trial/appeal when filing a written demand/request for trial/appeal ((1986 (Gyo-Ke) 96) Judgement of the Tokyo High Court, Oct.11, 1988, (1989 (Gyo-Tsu) 7) Judgement of the Supreme Court, 2<sup>nd</sup> Petty Bench, April 14, 1989, (1998 (Gyo-Ke) 312) Judgement of the Tokyo High Court, Nov 9, 1999).

When substantive reasons are not stated in a column of “reasons for demand/request” in a written demand/request for trial/appeal, an amendment shall be ordered stipulated under the provisions of the Patent Act Article 133(1), the Design Act Article 52, the Trademark Act Article 56(1) (or the Patent Act Article 17(3), the Design Act Article 68, the Trademark Act Article 77(2)) since the demand/request is considered to be in violation of the Patent Act Article 131(1)(iii), the Design Act Article 52 or the Trademark

Act Article 56(1). If an amendment is not made in the designated period of time, the written demand/request for trial/appeal (or the procedures for the demand/request) will be dismissed by decision stipulated under the provisions of the Patent Act Article 133(3), the Design Act Article 52, the Trademark Act Article 56(1) (or the Patent Act Article 18(1), the Design Act Article 68(2), the Trademark Act Article 77(2)). (→ 61-04).

Even when the statement in the column “reasons for demand” in a written demand for trial for correction does not satisfy the description requirements (Patent Act Article 131(3), Enforcement Regulations of the Patent Act Article 46-2 (2)), a chief administrative judge shall order an amendment stipulated under the provisions of the Patent Act Article 133(1). If an amendment is not made in the designated period of time, the written demand for trial (or the procedures for the demand/trial) will be dismissed by decision stipulated under the provision of the Patent Act Article 133(3).

In particular, cases concerning an appeal against examiner’s decision of refusal for a patent application are as specified below.

(1) Contents of the procedures

- A. When an amendment of a specification, claims or drawings is made at the same time as filing a request for appeal, an “Invitation for Amendment (Formality)” is notified by the name of Commissioner of Japan Patent Office stipulated under the provision of the Patent Act Article 17(3). If an amendment of said invitation is not made in the designated period of time, the procedures for the request will be dismissed stipulated under the provisions of the Patent Act Article 18(1).
- B. Regarding other than item A, an “Invitation for Amendment (Formality)” is notified by the name of a chief administrative judge under the provision of the Patent Act Article 133(1). If an amendment of said invitation is not made in the designated period of time, the written request for appeal will be dismissed by decision stipulated under the provisions of the

Patent Act Article 133(3).

(2) Criteria for issuance of order for amendment

- A. Applies to the statement that only states the intention to supplement reasons later, such as “the detailed reasons will be supplemented later”.
- B. Applies to the statement that only states the intention not to accept the conclusion of the original decision, such as “not satisfied with the original decision”, but there is no specific statement of what is not acceptable.
- C. Applies to the statement that only states the process that led to the original decision.
- D. Applies to the statement that only states something equivalent to combinations of A ~ C.

2. Trial for Invalidation ( $\rightarrow$  51-04)

(Revised December 2023)