

21—03.1 PUDT

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

It is required to describe 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. A trial for patents, designs, or trademarks excluding a trial for invalidation

Reasons for demand for trial/appeal are important in the proceedings of reexamination by the examiner before trial and of a trial, for an examiner and an administrative judge to understand allegation of a demandant promptly and properly. Therefore, it is necessary to clearly describe substantial contents of reasons for demand for trial when filing a written demand for trial (Judgement of the Tokyo High Court, Oct.11, 1988 (1986 (Gyo-ke) 96), Judgement of the Supreme Court, 2nd Petty Bench, April 14, 1989 (1989 (Gyo-tsu) 7), Judgement of the Tokyo High Court, Nov 9, 1999 (1998 (Gyo-ke) 312)).

When substantial reasons are not described in a column of “reasons for demand” in a written demand for trial, 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)). If an amendment is failed in the designated period of time, a written demand for trial (or a demand procedure) 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).

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

Regarding an appeal against the examiner’s decision of refusal for a patent application, it specifies as follows.

(1) Contents of the procedures

A. When an amendment is made for a specification, claims or drawings at the same time as filing a demand for trial, “Invitation for amendment (formality)” is notified in the name of Commissioner of Japan Patent Office stipulated under the provisions of the Patent Act Article 17(3). If an amendment of said invitation is failed in the designated period of time, a procedure for the demand will be dismissed stipulated under the provisions of the Patent Act Article 18(1).

B. Regarding other than item A, “Invitation for amendment (formality)” is notified in the name of a chief administrative judge under the provisions of the Patent Act Article 133(1). If an amendment of said invitation is failed in the designated period of time, a written demand for a trial will be dismissed by decision stipulated under the provisions of the Patent Act Article 133(3).

(2) Criteria for order for amendment

A. Only description of the intention of replenishing later such as “the detailed reasons will be replenished later”.

B. Only description of the invention of not accepting the conclusion of the original decision such as “the original decision is not satisfied”, but it does

not state any point of not accepting the conclusion specifically.

C. Only description of a process leading to the original decision.

D. Only description equivalent to combination of A ~ C.

2. Trial for Invalidation (→ 51-04)

(Revised Feb 2015)