

**21—03 PUDT**  
**Types of Ordering for Amendment**

1. A chief administrative judge shall order a demandant/appellant (an opponent) to amend a written demand/request (an opposition) by specifying a considerable period of time if it falls under the following items.

(1) When there is a deficiency in the following matters to be described in a written demand/request (the Patent Act Article 133(1), the Utility Model Act Article 41, the Design Act Articles 52,68(2), the Trademark Act Articles 56(1), 77(2))

A. A name or an appellation and an address or a domicile of a party concerned and an attorney

B. Indication of a trial/appeal case

C. Purport of the demand/request and the reasons therefor

(2) When there is a deficiency in the following matters to be described in an opposition to grant of patent (an opposition to registration of trademark) (the Patent Act Article 120-8(1), the Trademark Act Article 43-15(1))

A. A name or an appellation and an address or a domicile of an opponent of an opposition to grant of patent (an opposition to registration of trademark) and an attorney

B. Indication of a patent (a trademark registration) pertaining to an opposition to grant of patent (an opposition to registration of trademark)

C. Purport of an opposition to grant of patent (an opposition to registration of trademark) and indication of necessary evidences

(3) When demanding a trial for correction (the Patent Act Article 126(1), the former Utility Model Act Article 39(1)) or a correction in a trial for invalidation or in an opposition to grant of patent (the Patent Act Article

134-2(1), the Patent Act Article 120-5(2)), a case falls under the following matters.

- A. When a purport of the demand and its reasons do not satisfy the description requirements (the Patent Act Article 131(3))
- B. When a corrected specification, claims or drawings are not attached.

2. A chief administrative judge shall order an amendment to a person who performs procedures by specifying a considerable period of time if a trial procedure falls under the following items (the Patent Act Article 133(2), the Patent Act Article 120-8(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Article 56(1), the Trademark Act Article 43-15(1)).

- (1) When a procedure is in violation of the Patent Act Article 7(1)~(3) (for instance, a minor performs procedures without a legal agent)
- (2) When a procedure is in violation of the Patent Act Article 9 (for instance, a request for an appeal against examiner's decision of refusal is filed by an attorney who has not been yet authorized about such request)
- (3) When a procedure is in violation of a formality regulated in the law
- (4) When fees remain payable

(Note) Regarding an appeal against examiner's decision of refusal for a patent application, if there is a violation of a formality in amendment of the specification, claims or drawings made with a request for an appeal, and also if a request for appeal does not satisfy the description requirement, Commissioner of the Japan Patent Office shall order an amendment under the Patent Act Article 17(3).

3. Specific examples of order for amendment

- (1) Amendments which may be a subject to order for amendment are shown below: they are within the range that can be understood from the descriptions in a written demand/request for trial/appeal or an opposition to grant of

patent (an opposition to registration of trademark).

(2) Inter partes trial

A. A party concern (a demandant, a demandee)

(A) When there is no description of address (domicile)

(B) When there is no description of name (appellation), but it can be identified from the entire document

(C) When there is no description of a representative of a corporation or an association that is not a juridical person (only a demandant, and except when a procedure is taken by an attorney)

(D) When there is no description of nationality/region if a party concern is a foreigner (only a demandant. In case a nationality/region is the same as one described in the address, this description can be omitted.)

B. Agent (Attorney)

(A) When there is no description of address (domicile)

(B) When there is no description of name (appellation), but it can be identified from the entire document

(C) When there is no description of a representative of a patent professional corporation

C. Indication of the case

(A) When there is no description of a patent (registration) number, but it can be identified from the entire document

(B) When there is a description of a patent (registration) number, but it cannot be identified

D. Purport of demand

(A) When there is no description

(B) When there is a description, but it is not accurate

E. Reasons for demand (excluding a trial for invalidation)

When there is no description

F. Fees (patent revenue stamps affixed)

(A) When statutory fees are not paid

(B) When the paid fees are less than statutory fees

G. A trial for correction, a request for correction

(A) When purport of demand and its reasons do not satisfy the description requirement (the Patent Act Article 131(3))

(B) When the corrected specification and claims are not attached

(C) When the corrected drawings are not attached

(3) Appeal trial

A. Appellant

(A) When there is neither description of address nor domicile (except when an identification number is described)

(B) When there is neither description of identification number, name nor appellation, but it can be identified from the entire document

(C) When there is no description of a representative of a corporation (except when a procedure is taken by an attorney)

(D) When there is no description of nationality/region if an appellant is a foreigner (If a nationality/region is the same as one described in the address, or the address is omitted with an identification number, this description is optional.)

B. Agent (Attorney)

(A) When there is neither description of address nor domicile (excluding when an identification number is described)

(B) When there is neither description of identification number, name, nor appellation, but it can be identified from the entire document

(C) When there is no description of a representative of a patent professional corporation

C. Indication of the case

(A) When there is no description of an application number, but it can be identified from the entire document

(B) When there is a description of an application number, but it cannot be identified

## D. Purport of request

(A) When there is no description

(B) When there is a description, but it is not accurate

## E. Reasons for request

(A) When there is no description

(B) When there is a description, but not specified

## F. Fees (patent revenue stamps affixed)

(A) When statutory fees are not paid

(B) When the paid fees are less than statutory fees

## G. A written amendment

When a written amendment is submitted as an evidence (2014 (Gyoke)10158)

## (4) Opposition to grant of patent (Opposition to registration of trademark)

## A. Opponent

(A) When there is no description of address (domicile)

(B) When there is no description of name (appellation), but it can be identified from the entire document

(C) When there is no description of a representative of a corporation or an association that is not a juridical person (except when a procedure is taken by an attorney)

(D) When there is no description of nationality/region if an opponent is a foreigner (In case a nationality/region is the same as one described in the address, this description can be omitted.)

## B. Agent (Attorney)

(A) When there is no description of address (domicile)

(B) When there is no description of name (appellation), but it can be identified from the entire document

(C) When there is no description of a representative of a patent professional corporation

C. Indication of patent (trademark registration) for the opposition

(A) When there is no description of a registration (patent) number, but it can be identified from the entire document

(B) When there is a description of a registration (patent) number, but it cannot be identified

F. Fees (patent revenue stamps affixed)

(A) When statutory fees are not paid

(B) When the paid fees are less than statutory fees

A Table for Regulations of Dismissal, etc., and a Statement of  
Dissatisfaction in Trial/Appeal Procedures

Order	Contents of Order		Grounds	Statement of Dissatisfaction
Commissi oner of Japan Patent Office	Procedu res of re- examina tion by the examine r before trial	Deficiency of formality	the Patent Act Article 17(3) → the Patent Act article 18(1) (Dismissal of procedures)	Administrative appeal
			the Patent Act Article 17(3) → the Patent Act Article 18(2) (Dismissal of application)	
		Unlawful procedures Not allowable of amendment	the Patent Act Article 18-2(2) → the Patent Act article 18(1) (Dismissal of procedures)	
	Other procedu res	Deficiency of formality	the Patent Act Article 133(2) → the Patent Act article 133(3) (Dismissal of procedures)	
		Unlawful procedures Not allowable of amendment	the Patent Act Article 133-2(2) → the Patent Act article 133-2(1) (Dismissal of procedures)	

A chief administrative judge	Procedure of demand/request for trial	Deficiency (the Patent Act Article 131) in a written demand/request	the Patent Act Article 133(1) → the Patent Act Article 133 (3) (Dismissal of demand/request for trial)(Note 1)	the Tokyo High Court  the IP High Court
		Deficiency of fees for a written demand/request or attached document, etc.	the Patent Act Article 133(2) → the Patent Act Article 133 (3) (Dismissal of demand/request for trial)(Note 1)	
		Unlawful demand/request for trial Not allowable of amendment	the Patent Act Article 135 (Dismissal of demand/request for trial)(Note 2)	

Note 1:

An action against a decision of dismissal of a demand for correction filed after Apr. 1, 2012 (the Patent Act Article 134-2(1), the Patent Act Article 120-5(2)) shall be under the exclusive jurisdiction of the Tokyo High Court.

Note 2:

Statement of dissatisfaction against a decision of dismissal of an opposition to grant of patent (an opposition to registration of trademark) is not allowable (the Patent Act Article 120-8(2) → the Patent Act Article 114(5), the Trademark Act Article 43-15(2) → the Trademark Act Article 43-3(5)).

(Revised December 2020)