

21—03 PUDT

Types of Order for Amendment

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

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

- A. A name or trade name and a domicile or residence of a party concerned and an attorney
- B. Identification of a trial/appeal case
- C. Purport of a demand/request and reasons therefor

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

- A. A name or trade name and an address or residence 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. Reasons for filing an opposition to grant of patent (an opposition to registration of trademark) and indication of necessary evidence

(3) When a trial for correction (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 is filed (Patent Act Article 134-2(1), Patent

Act Article 120-5(2)), in the following cases.

- A. When a purport of the demand/request and reasons therefor do not meet the description requirements (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 undertaking a trial/appeal procedure by specifying a considerable period of time if the procedure falls under the following items except the cases stated in the above item 1. (Patent Act Article 133(2), Patent Act Article 120-8(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Article 56(1), Trademark Act Article 43-15(1)).

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

(Note) Regarding an appeal against examiner's decision of refusal for a patent application, when there is a violation of formalities in amendment of the specification, claims or drawings filed with the request for an appeal, including a case where the request for appeal does not meet the description requirements, the 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) Amendment matters which may be subject to an order for amendment are shown below: they are within the range that can be understood by looking at 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 concerned (a demandant, a demandee)

(A) When there is no description of a domicile (residence)

(B) When there is no description of a name (trade name), but it can be identified from the entire documents

(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 the procedures are performed by an attorney)

(D) When there is no description of a nationality/region if a party concerned is a foreigner (only a demandant. When a nationality/region is the same as one stated in the address, this is optional.)

B. Agent (Attorney)

(A) When there is no description of a domicile (residence)

(B) When there is no description of a name (trade name), but it can be identified from the entire documents

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

C. Identification of the case

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

(B) When there is a description of a patent (registration) number, but it is unreadable

D. Purport of demand

(A) When there is no description of purport

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

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

When there is no description of reasons

F. Fees

(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 the reasons therefor do not meet the description requirements (Patent Act Article 131(3))

(B) When the corrected specification, claims or drawings are not attached

(3) Ex parte trial (Appeal trial)

A. Appellant

(A) When there is no description of a domicile or residence (except when there is an identification number)

(B) When there is no description of an identification number, name nor trade name, but it can be identified from the entire documents

(C) When there is no description of a representative of a corporation (except when procedures are performed by an attorney)

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

B. Agent (Attorney)

(A) When there is no description of a domicile or residence (except when an identification number is listed)

(B) When there is no description of an identification number, name, nor trade name, but it can be identified from the entire documents

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

C. Identification of the case

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

(B) When there is a description of an application number, but it is unreadable

D. Purport of the request

(A) When there is no description of purport

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

E. Reasons for request

(A) When there is no description of reasons

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

F. Fees

(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 evidence (2014 (Gyo-Ke) 10158)

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

A. Opponent

(A) When there is no description of a domicile (residence)

(B) When there is no description of a name (trade name), but it can be identified from the entire documents

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

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

B. Agent (Attorney)

(A) When there is no description of a domicile (residence)

(B) When there is no description of a name (trade name), but it can be identified from the entire documents

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

C. Identification of patent (trademark registration) for the opposition to grant of patent (registration of trademark)

(A) When there is no description of a registration (patent) number, but it

can be identified from the entire documents

(B) When there is a description of a registration (patent) number, but it is unreadable

D. Fees

(A) When statutory fees are not paid

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

Table for Regulations of Dismissal, etc., and Appeals
in Trial/Appeal Procedures

Order	Contents of Order		Grounds	Appeals
Commissioner of Japan Patent Office	Procedures of re-examination by the examiner before trial	Formal deficiency	Patent Act Article 17(3) ⇒ Patent Act Article 18(1) (Dismissal of procedures)	Administrative appeal
			Patent Act Article 17(3) ⇒ Patent Act Article 18(2) (Dismissal of application)	
		Unlawful procedures No amendment allowed	Patent Act Article 18-2(2) ⇒ Patent Act Article 18-2(1) (Dismissal of procedures)	
A chief administrative judge	Other procedures	Formal deficiency	Patent Act Article 133(2) ⇒ Patent Act Article 133(3) (Dismissal of procedures)	
		Unlawful procedures No amendment allowed	Patent Act Article 133-2(2) ⇒ Patent Act Article 133-2(1) (Dismissal of procedures)	

	Procedures of demand/request for trial/appeal	Deficiency in a written demand/request under the Patent Act Article 131	Patent Act Article 133(1) ⇒ Patent Act Article 133 (3) (Dismissal of demand/request for trial/appeal) (Note 1)	The Tokyo High Court The Intellectual Property High Court
		Deficiency in fees or attached documents, etc. in a written demand/request	Patent Act Article 133(2) ⇒ Patent Act Article 133 (3) (Dismissal of demand/request for trial/appeal) (Note 1)	
		Unlawful demand/request for trial/appeal No amendment allowed	Patent Act Article 135 (Dismissal of demand/request for trial/appeal) (Note 2)	

Note 1:

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

Note 2:

An appeal against a decision to dismiss an opposition to grant of patent (registration of trademark) is not allowed (Patent Act Article 120-8(2) → Patent Act Article 114(5), Trademark Act Article 43-15(2) → Trademark Act Article 43-3(5)).

(Revised December 2023)