

21—06 PUDT

Handling of Supplement of Reasons

1. It is required for a party concerned to clarify a reason for allegation in a demand/request for trial/appeal, retrial or Hantei (advisory opinion) (Patent Act Articles 17(1), 71(3), 131(1)(2), Enforcement Regulations of the Patent Act Articles 46, 46-2, Utility Model Act Article 38(1)(2), Design Act Articles 25(3), 52, 60-24, Enforcement Regulations of the Design Act Articles 14, 19(8), Trademark Act Articles 28(3), 56(1), 68(4), 68-40(1), Enforcement Regulations of the Trademark Act Articles 14, 22(6)) (→ 51-07, 58-01, 70-00).

It is required to describe a reason for opposition when filing an opposition to grant of patent (an opposition to registration of trademark) (Patent Act Article 115(1), Enforcement of Regulations of the Patent Act Article 45-2, Trademark Act Articles 43-4(1), 68(4), Enforcement Regulations of the Trademark Act Article 12) (→ 66-03, 67-03).

2. There is a restriction on amendment of a reason for demand/request depending on the types of trial/appeal, etc.

(1) A trial/appeal for patent, design, trademark excluding a trial for invalidation

Regarding a demand for trial/appeal for patent, design or trademark except a trial for invalidation, a reason firstly made may be amended partially or entirely and a new reason may be further added to the amendment until the conclusion of the proceedings unless it changes a purport of the demand/request (However, late supplement of reasons is not preferable from the perspective of acceleration of the proceedings.) (Patent Act the proviso to Article 131-2(1)(i), Design Act Article 52, Trademark Act Articles 56(1),

68(4)) (→ 61-04 4.).

(2) Trial for invalidation

Regarding a trial for invalidation, in principle, an amendment to change the gist of a reason for demand cannot be made (Patent Act Article 131-2(1), Utility Model Act Article 38-2, Design Act Article 52, Trademark Act Articles 56(1), 68(4)), but such amendment to change the gist of a reason for demand is sometimes permitted by a chief administrative judge (Patent Act the proviso to Article 131-2(1)(ii), Utility Model Act Article 38-2, Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2) Former Utility Model Act Article 41, Design Act Article 52) (→ 30-01 1., 51-08, 51-15).

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

It is possible to amend (change, add, etc.) a reason for opposition, etc. within the allowable period for amendments of an opposition to grant of patent (an opposition to registration of trademark) (Patent Act Article 115(2), Trademark Act Articles 43-4(2)(3), 68(4)) (→ 66-03, 67-04).

Patent: Until six (6) months have passed from the publication date of a patent gazette, or until a notice of decision to revoke is notified under the Patent Act Article 120-5(1), whichever is earlier.

Trademark: Within thirty (30) days (extension of the term: for domestic residents 15 days (standard), for overseas residents 60 days) after two (2) months have passed from the publication date of a trademark gazette.

3. When a written amendment for supplement of reasons is submitted after notifying a notice of conclusion of the proceedings, it is considered whether the proceedings need to be reopened based on the contents of the amendment. The proceedings are reopened when necessary (→ 42-00), but when it is found to be unnecessary, the submitted amendment is continuously bound in the record.

4. Any written amendment submitted after service of the trial decision, the decision, etc. will result in dismissal of the proceedings (Patent Act Article 18-2, Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(Revised December 2023)