

21—00 PUDT

Examination Procedures of Formality Requirements

1. Basic Concept

A formality of a demand/request for trial/appeal should be examined whether it satisfies with the requirements of the law before proceedings of the merits.

A chief administrative judge has an authority over formalities of cases of a trial (excluding a reexamination by the examiner before trial for patent), an opposition to grant of patent (an opposition to registration of trademark), or an advisory opinion (the Patent Act Article 133), and a trial clerk and a panel conduct formality examinations and proceedings respectively under the authority.

Commissioner of the Japan Patent Office has an authority over formalities for a trial case for a reexamination by the examiner before trial for patent.

In the proceedings of formalities, it is examined whether a written demand/request for trial/appeal, an opposition to grant of patent (an opposition to registration of trademark), or a demand for an advisory opinion satisfies formal description requirements regulated under the Patent Act Article 131(1), the Patent Act Article 115(1), the Utility Model Act Article 38(1), the Design Act Article 52, the Trademark Act Articles 43-4(1), 56(1) and 68(4). The examination items are as below and ex officio examination (→ 36-01 3.) items such as requirements of demand/request, etc. are also examined.

“Purport of the demand and the reasons therefor” is also a formality requirement item (the Patent Act Article 131(1)(iii)). It should be confirmed carefully whether this requirement is satisfied, otherwise it could interfere

with the proceedings of the merits.

2. Inter-partes Trial

(1) A formality of a demand for trial (the Patent Act Article 131(1), the Utility Model Act Article 38(1), the Design Act Article 52, the Trademark Act Articles 56(1), 68(4))

Whether the written demand includes the descriptions such as a demandant, a demandee, a representative of a corporation or an association that is not a juridical person (only a demandant. If procedures are taken by an agent, no entry required), a legal agent (→ 23-01), an authorized agent (→ 23-02), indication of the trial case, purport of the demand and the reasons therefor, and also includes determination of the subject matter (the industrial property rights) of the demand (a patent number, a registration number) and payment of fees (such as attachment of patent revenue stamps), etc.

(2) Relationship between reasons and evidences

Whether a relationship between reasons and relevant evidences (the Patent Act Article 131(2)) are described properly.

(3) Confirmation of a party concerned

Whether a party concerned is an actual person, whether he/she corresponds to a true party concerned by checking against a power of attorney and a registration register

(4) Whether a party concerned has ability to conduct the procedures (→ 22-01 6.) (the Patent Act Articles 6 ~ 8)

(5) Whether there is a power of attorney and its scope (the Patent Act Articles 7 ~ 14 excluding Article 10, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(6) Whether a party concerned is eligible for being a party (→ 22-01 7.), whether it is a compulsory joint trial (→ 22-03) (the Patent Act Article 132(2)(3)(4), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

(7) Whether a demand is filed in a statutory period (the Patent Act Articles 126, 173(1)(2)(4), the Utility Model Act Article 45, the Design Act Article 58(1), the Trademark Act Articles 47, 52, 53(3), 53-3, 61).

(8) Whether required documents are attached (→ 21-01), whether the required number (the number of demandees and an additional one for the proceedings) of duplicates are prepared, specifically, whether there are duplicates of a full text of the corrected specification and claims (an entirely corrected specification, etc.) or drawings in a trial for correction or a trial for invalidation (the Patent Act Article 131(4)).

(9) Whether there is an indication of a case number of preservation of evidences when the evidences are examined for preservation of evidences before a trial is demanded (Enforcement Regulations of the Patent Act Article 46(2), Rules of Civil Procedure Article 54).

3. Appeal Trial

(1) A formality of a request for appeal (the Patent Act Article 131(1), the Design Act Article 52, the Trademark Act Article 56(1))

Similar to the above 2. (1), except for the following points: the subject matter of the request is an application; there is no demandee; and an association that is not a juridical person cannot be an appellant.

(2) Comparison the descriptions of an appellant with a power of attorney, application documents, application registration information, etc.

(3) Whether there is a power of attorney and its scope (the Patent Act Articles 7 ~ 14 excluding Article 10, the Design Act Article 68(2), the Trademark Act Article 77(2)).

(4) Whether a party concerned is eligible for being a party, whether all applicants (or the successors) who “received the final refusal” jointly request an appeal (the Patent Act Articles 121(1), 132(3), the Design Act Articles 46(1), 47(1), 52, the Trademark Act Articles 44(1), 45(1), 56(1)).

(5) Whether a request is filed in a statutory period (the Patent Act Articles

121, 173(1)(2)(4), the Design Act Articles 46, 47, 58, the Trademark Act Articles 44, 45, 61).

(6) Whether required documents are attached (→ 21-01).

4. Opposition to Grant of Patent (Opposition to Registration of Trademark)

(1) A formality of an opposition (the Patent Act Article 115(1), the Trademark Act Articles 43-4(1), 68(4))

Similar to the above 2. (1).

(2) Whether there is a power of attorney and its scope (the Patent Act Articles 7 ~ 14 (excluding Article 10)).

(3) Whether an opposition is filed in a statutory period (the Patent Act Article 113(1), the Trademark Act Article 43-2).

(4) Whether required documents are attached (→ 21-01), whether the required number (the number of right holders and an additional one for the proceedings) of duplicates are prepared, etc.

5. Advisory Opinion

Similar to the above 2. The Patent Act Article 131, etc. applies *mutatis mutandis* to the Patent Act Article 71(3).

(Revised December 2020)

21—01 PUDT

Required Documents That Need to be Attached to Written Demand/Request for Trial/Appeal, etc. (including Power of Attorney)

1. A Written Demand/Request for Trial

Documents that need to be attached to a written demand/request for trial are shown below (order of articles of the law).

(1) When an association or a foundation that is not a juridical person and a person designated as a representative or an administrator thereof performs procedures (the Patent Act Article 6, the Utility Model Act Article 2-4, the Design Act Article 68(2), the Trademark Act Article 77(2))

A name of representative or administrator needs to be written in a demand/request for trial, but in principle any document for proof of their qualification is not required any more with simplification of the procedures.

(2) When a minor, an adult ward, a person under curatorship, etc. performs procedures

Documents for proof of a statutory power of attorney, a letter of consent of a supervisor of guardian, a letter of consent of a curator (the Patent Act Article 7, Enforcement Regulations of the Patent Act Article 6, Utility Model Act Article 2-5(2), Enforcement Regulations of the Utility Model Act Article 23(1), the Design Act Article 68(2), Enforcement Regulations of the Design Act Article 19(1), the Trademark Act Article 77(2), Enforcement Regulations of the Trademark Act Article 22(1))

(3) When an authorized agent performs procedures

A document for proof of power of attorney (the Patent Act Articles 8 and 9, Enforcement Regulations of the Patent Act Article 4-3(1), the Utility Model Act Article 2-5(2), Enforcement Regulations of the Utility Model Act

Article 23(1), the Design Act Article 68(2), Enforcement Regulations of the Design Act Article 19(1), the Trademark Act Article 77(2), Enforcement Regulations of the Trademark Act Article 22(1)).

(4) When two or more people jointly perform procedures and a representative is selected from them, a document for proof of said selection (the Patent Act Article 14, Enforcement Regulations of the Patent Act Article 8, the Utility Model Act Article 2-5(2), Enforcement Regulations of the Utility Model Act Article 23(1), the Design Act Article 68(2), Enforcement Regulations of the Design Act Article 19(1), the Trademark Act Article 77(2), Enforcement Regulations of the Trademark Act Article 22(1)).

(5) When a successor of the patent right performs procedures

A notice of change of applicant and a document for proof of transfer the right, and a letter of consent of other right holders if the right is jointly owned (the Patent Act Articles 33 and 34(4)(5), Enforcement Regulations of the Patent Act Articles 5 and 12, the Design Act Article 15(2), Enforcement Regulations of the Design Act Article 19(1), the Trademark Act Article 13(2), Enforcement Regulations of the Trademark Act Article 22(1)).

(6) When demanding a trial for correction (Note)

A. When there is an exclusive licensee, a pledgee, a non-exclusive licensee on an invention in service, or a non-exclusive licensee with permission, a letter of consent of those people (the Patent Act Article 127, Enforcement Regulations of the Patent Act Article 6).

B. Corrected specification, claims or drawings (the Patent Act Article 131(4))

(Note) Similarly, a demand for correction filed in the procedure of a trial for invalidation and an opposition to grant of patent, also needs those documents to be attached.

(7) When a power of attorney, a certificate of nationality, or other document is written in a foreign language, a translation thereof (Enforcement Regulations of the Patent Act Article 2, Enforcement Regulations of the

Utility Model Act Article 23(1), Enforcement Regulations of the Design Act Article 19(1), Enforcement Regulations of the Trademark Act Article 22(1)).

(8) Necessary number of duplicates of written demand/request for sending to a counterparty and for the proceedings (Enforcement Regulations of the Patent Act Articles 4 and 50-4, Enforcement Regulations of the Utility Model Act Article 23(1)(10), Enforcement Regulations of the Design Act Article 19(1)(8), Enforcement Regulations of the Trademark Act Article 22(1)(6))

(9) Explanation of evidence (Enforcement Regulations of the Patent Act Articles 50(3), Enforcement Regulations of the Utility Model Act Article 23(10), Enforcement Regulations of the Design Act Article 19(8), Enforcement Regulations of the Trademark Act Article 22(6))

(Excluding the case when a document heading, a person prepared the document and a purport of proof are clear from descriptions of the document.)

2. Opposition to grant of patent (Opposition to registration of trademark)

An opposition to grant of patent (an opposition to registration of trademark) also applies to a written demand/request for trial/appeal (→ 66-03, 67-03).

(Revised Feb 2015)

21—02 PUDT
Order for Amendment and Inquiry

1. As a result of examination of formalities of a written demand/request for trial/appeal, etc. according to 21-00, when a deficiency on formalities has been found, an order for amendment or an inquiry is issued in principle.

(1) Order for amendment (the Patent Act Articles 17(3) and 133(1)(2), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4))

An order for amendment is issued by Commissioner of the Japan Patent Office or a chief administrative judge. This order is issued when an amendment is ordered for a deficiency on formalities (lack of descriptions, unclearness, outstanding (shortage) of payment of fees, etc.) of a demand/request for trial/appeal, an opposition to grant of patent (an opposition to registration of trademark).

Regarding an order for amendment for an appeal against examiner's decision of refusal for a patent application, when the appeal case that a specification, claims or drawings are amended with a request for the appeal, the order is issued by Commissioner of the Japan Patent Office before releasing a reexamination by the examiner before trial, and the order is issued by a chief administrative judge after releasing a reexamination by the examiner before trial and for other cases.

(2) Inquiry (the Patent Act Articles 134(4), the Utility Model Act Article 39(4), the Design Act Articles 52, 68(2), the Trademark Act Articles 56(1), 68(4), 77(2))

An inquiry is issued by a chief administrative judge: it is issued for clarifying the facts on legal requirements of the demand, for indicating

accurately in the demand although the facts are clear, or for arising necessity to clear the facts after entering the proceedings of the merits (→ 37-02). When a deficiency is not resolved even by an inquiry, an order for amendment of (1) will be issued.

2. When a deficiency of formalities is resolved by voluntary amendment by those who perform the procedures by receiving contact from a trial clerk or an administrative judge, prior to the issue of an order for amendment or an inquiry against a deficiency of formalities, the written amendment is received and an order for amendment or an inquiry is not issued.

3. When a deficiency of formalities is apparently an error in writing or a minor mistake and ex officio correction does not change a purport of document, a trial clerk may correct the documents ex officio. In that case, a trial clerk needs to obtain a consent of those who perform the procedures in advance by telephone, facsimile, etc.

4. When an order for amendment or an inquiry is issued for a trial for invalidation, a trial for rescission, etc. and an opposition to grant of patent (an opposition to registration of trademark), a duplicate of a written demand (an opposition) is suspended from serving (dispatching) to a counterparty, and a duplicate shall be served (dispatched) after a deficiency is lawfully amended by a written amendment.

5. A panel judges a demand for trial is unlawful and an amendment thereof may not be made, said demand for trial is immediately dismissed by trial decision without an order for amendment or an inquiry (the Patent Act Article 135, →22-01 8.(2), →61-04 3., etc.).

(Revised Feb. 2015)

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)

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)

21—03.3 T

Handling of a Case When Description in the Column "Purport of Demand" is "Similar Goods", etc. in Trial for Invalidation/Rescission for Trademark

1. Basic concept

In demanding a trial for rescission or a trial for invalidation for trademark registration, there is a case that "similar goods" etc., is described (Note) in a column "Purport of demand" of a written demand for trial when a trial is demanded for a part of the designated goods/services.

"Purport of demand" in a written demand for trial is described by a demandant. The scope of the subject of proceedings for a demand for trial is determined based on said description. It is not permitted in principle the indication of "similar goods", etc. because the scope of designated goods/services to which the registered trademark is effective becomes ambiguous.

Therefore, a written demand for trial having a description of "similar goods" in a column "Purport of demand" needs to handle as follows.

(Note) A description "similar goods", etc. includes, for example, "similar services", "goods of similarity" or "services of similarity".

2. Countermeasures

(1) Order for written amendment

A. When there is an indication of "similar goods", etc. in "Purport of demand" in a written demand for trial, an order for amendment shall be issued against the provision of the Patent Act Article 131(1) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1) during a

formality examination.

B. Said order for amendment requires either to clarify an indication “similar goods” etc. in a range without change of the gist, or to delete said indication if not necessary, or to explain about objective clarity of said “Purport of demand”.

C. When a demandant does not respond at all against an order for amendment, a chief administrative judge may dismiss a written demand for trial by decision under provisions of the Patent Act Article 133(3) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1).

(2) Inquiry

A. When there is any response such as amendment or explanation of “Purport of demand” to the order for written amendment in (1), a panel shall judge substantially on clarity of “Purport of demand”.

B. A panel requires a demandant to explain clarity of “Purport of demand” under the inquiry of a chief administrative judge, based on the Patent Act Article 134(4) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1), if necessary.

C. When a panel recognizes “Purport of demand” becomes clear by amendment or explanation, the panel corrects a preliminary registration of a register of the trademark registration, and serves a duplicate of a written demand for trial to a counterparty.

D. When there is no response to the inquiry from a demandant and a panel still recognizes the description of “Purport of demand” is unclear, said written demand for trial shall be dismissed by decision under the Patent Act Article 133(3) as applied mutatis mutandis pursuant to the Trademark Act Article 56(1).

(Reference court cases)

1. Judgement of the IP High Court, June 27, 2007 (2007 (Gyo-ke) 10084)
2. Judgement of the IP High Court, Oct. 31, 2007 (2007 (Gyo-ke) 10158)

3. Judgement of the IP High Court, Nov. 28, 2007 (2007 (Gyo-ke) 10172)

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21—05 PUDT**Handling of Errors in Indication of Either Application Number
or Registration Number**

1. When an application number or a registration number (a patent number, etc.) has an error in its indication, a chief administrative judge shall confirm, in principle, an intention of a demandant by an inquiry, etc. and take any one of the following measures.

A chief administrative judge shall order amendment when he/she comprehensively considers entire documents and presumes a clerical error (the Patent Act Article 133(1), the Patent Act Article 120-8(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 43-15(1), 56(1), 68(4)).

1. When a written amendment is submitted

(1) When an amendment is not approved

When an amendment of an application number or a registration number indicated in a written demand for trial/an opposition to grant of patent (an opposition to registration of trademark) changes the gist of the written demand/an opposition to grant of patent (an opposition to registration of trademark) (→ 30-01), such demand or request shall be dismissed by trial decision/decision (the Patent Act Article 135, the Patent Act Article 120-8(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 43-15(1), 56(1), 68(4)).

(2) When an amendment is approved

When an amendment of an error of an application number or a registration number indicated in a written demand for trial/an opposition to grant of patent (an opposition to registration of trademark) does not change the gist of the written demand/an opposition to grant of patent (an opposition to registration of trademark) in such cases where the error is merely a clerical error, such amendment is approved.

2. When there is no response

When there is no response or no submission of a written amendment from a demandant, etc. to the inquiry, etc., such demand/request shall be dismissed by trial decision/decision (the Patent Act Article 135, the Patent Act Article 120-8(1), the Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 43-15(1), 56(1), 68(4)).

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21—06 PUDT
Handling of Supplement of Reasons

1. It is required for a party concern to clarify the reason for allegation in a demand for trial, retrial or advisory opinion (the Patent Act Articles 17(1), 71(3), 131(1)(2), Enforcement Regulations of the Patent Act Articles 46, 46-3, the Utility Model Act Article 38(1)(2), the Design Act Articles 25(3), 52, 60-3, Enforcement Regulations of the Design Act Articles 14, 19(8), the 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 request for an opposition to grant of patent (an opposition to registration of trademark) (the Patent Act Article 115(1), Enforcement of Regulations of the Patent Act Article 45-2, the 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 according the types of trial, etc.

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

Regarding a demand for trial/appeal for patent, design or trademark, an amendment firstly requested may be amended partially or entirely and further added a new reason to the amendment until the end of the proceedings unless it changes a purport of demand (However, it is not preferable late supplement of reasons from the perspective of acceleration of the proceedings.) (the proviso to the Patent Act Article 131-2(1)(i), the Design Act Article 52, the 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 (the Patent Act Article 131-2(1), the Utility Model Act Article 38-2, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)), but such amendment to change the gist of a reason for demand is sometimes approved by a chief administrative judge (the proviso to the Patent Act Article 131-2(1)(ii), the 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, the Design Act Article 52) (→ 30-01 1., 51-08, 51-15).

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

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

Patent: until 6 months have been passed on which a patent gazette is issued, or a notice is notified under the Patent Act Article 120-5(1), whichever comes first

Trademark: until 30 days have been passed (extension of the term: for domestic residents (standards) 15 days, for overseas residents 60 days) after 2 months have been passed on which a trademark gazette is issued

3. When a written amendment is submitted for supplement of reasons after the end of the proceedings, it is considered whether the proceedings should be reopened under 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. A written amendment submitted after a certified copy of a trial decision is served and a written amendment submitted after the proceedings of advisory opinion is ended shall be both dismissed (the Patent Act Article 18-2, the Utility Model Act Article 2-5(2), the Design Act Article 68(2), the Trademark Act Article 77(2)).

(Revised Feb 2015)

21—08 PUDT
Dismissal of Unlawful Procedures

1. When intermediate documents other than documents of a written demand for trial/appeal and opposition to grant of patent (opposition to registration of trademark) fall under the following items, a reason for dismissal shall be notified, and dismiss the procedures upon giving an opportunity to submit a written explanation (the Patent Act Articles 18-2, 133-2, the Utility Model Act Articles 2-5(2), 41, the Design Act Articles 52, 68(2), the Trademark Act Articles 56(1), 68(4), 77(2)).

(1) When a procedure is performed with a document or other articles which do not clarify a purport of submission

(2) When a procedure is performed with a document (excluding an information statement) which has neither identification number nor a name (appellation) of a person performing procedures (except when the name (appellation) can be specified from the entire procedural documents).

(3) When a document such as a written opinion or a written reply is submitted after a certified copy of a trial decision or a dismissal of a written demand is served

(4) When an extension of term for a statutory period or a designated period is requested and such extension is not legally permitted, or an extension of term is requested after the period is expired (the Patent Act Articles 4, 5, the Utility Model Act Article 2-5(1), the Design Act Article 68(1), the Trademark Act Article 77(1)).

(5) When a procedure falls under any of the followings:

A. A content of amendment is not described in a written amendment (except when a method of amendment is “deletion”). Or a document (an article) to be attached is not attached therewith.

B. An article (an evidence) is not attached to a written submission of article

(evidence)

- C. No description about who becomes a representative in a notification of appointment of representative
- D. No description of an identification number or a name (appellation) of a successor in a notification of change of applicant
- E. No description of an identification number or a name (appellation) of an agent in a notification of acceptance of appointment of agent
- F. No description of an identification number or a name (appellation) of an appointed agent in a notification of appointment of agent (a notification of change of agent, a notification of change of power of attorney, a notification of extinction of power of attorney)

A procedure is not dismissed if a content of notification can be specified from the attached certificate, etc. for the notification of C~F.

- G. No supplementary description or attachment which should be enclosed in a written supplement
- H. No description of agent who is restricted to use the comprehensive power of attorney
- I. No description of a design feature in a feature statement for a design application
- J. No description of a new deposit number in a notification of change of deposit number on deposition of microorganism and a certificate to certify a new deposit number is not attached.

(6) When non-Japanese documents are used for the procedures (Enforcement Regulations of the Patent Act Article 2(1))

(7) When an overseas resident performs a procedure without an agent who has an address (domicile) in Japan.

(8) When a person who performs a procedure is different from one who is described in a written demand, an opposition to grant of patent (an opposition to registration of trademark) (except when a procedure is performed by an agent and it is clear a clerical error is made in preparing a procedural

document).

(9) When an amendment of fees is necessary and such amendment falls under any of the followings:

A. Using a deposit system

(A) There is no deposit account number

(B) A person who performs a procedure (an agent if appointed) is not a depositor of a deposit account described in a deposit account number of a written amendment (including a person who is appointed by notification of appointment of power of attorney pursuant to Enforcement Regulations on Special Exceptions for Procedures Related to Industrial Property Article 41)

(C) Payment of expected fees cannot be applied due to insufficient balance in a deposit account

B. Using patent revenue stamps

A procedure is performed without any patent revenue stamp

C. Using cash (electronic cash)

There is no fact of payment, or it is already used (returned)

D. Using account transfer

(A) A person paying fees requests payment by account transfer in a written amendment

(B) A person who performs a procedure (an agent if appointed) is not a person who is given a transfer number described in a written amendment (including a person who is appointed by notification of appointment of power of attorney pursuant to Enforcement Regulations on Special Exceptions for Procedures Related to Industrial Property Article 41).

(C) Fees cannot be transferred due to no deposit account or insufficient balance in a deposit account, etc.

E. Using a person designated for replacement payment

(A) A person paying fees requests payment by a person designated for

replacement payment in a written amendment

(B) Fees cannot be paid due to such circumstances that a credit card is expired, etc.

(10) When the time or the time period for a procedure is designated under the Patent Act, the Utility Model Act, the Design Act or the Trademark Act, and the procedure is taken outside such the time or the time period

(11) When an application for intervention is submitted in an ex parte case (including a trial for correction)

(12) When a person who is not a representative performs a procedure even a notification for appointment of representative is filed (excluding a procedure the effect of which extends only to the person him/herself)

(13) A procedure is taken after a written demand or an opposition to grant of patent (an opposition to registration of trademark) is withdrawn or dismissed, or a procedure is taken after a trial decision or a decision is finalized (excluding an amendment that reduces the number of classes for the trademark registration application made at the same time of payment of registration of the establishment under the Trademark Act Article 68-40(2) after a trial decision).

(14) When a procedure which should be jointly done is performed by not all demandants (excluding when an agent performs a procedure and omitted apparently in preparing procedural documents)

(15) A written amendment (limited to those for amending a specification, claims or drawings attached to the application, including correction of an incorrect translation) submitted with a written request for appeal against examiner's decision of refusal of patent, and such demand is withdrawn or dismissed by appeal decision (however, when there is other pending request for appeal against examiner's decision to the same application) (the Patent Act Article 17-2(1)(iv)).

(Revised June 2019)

21—09 P**Fees for Demand/Request for Patent Trial and Appeal**

1. Fees for a demand/request for patent trial/appeal shall be collected based on the number of claims shown below:

- (1) For an appeal against examiner's decision of refusal (the Patent Act Article 121(1)), the number of claims described in the claims (including the claims after amendment made with a demand for appeal) at the time of a demand for appeal;
- (2) For a trial for invalidation (the Patent Act Article 123(1)), the number of claims relating to a demand for trial; and
- (3) For a trial for correction (the Patent Act Article 126(1)), the number of claims relating to a demand for trial. In other words, when the entire patent right is corrected, the number of claims recorded in a patent register in demanding a trial. When a correction is made for each claim, the number of claims subject to correction (→ 38-06).

2. When the number of claims at the time of requesting an appeal increases because of the amendment made at the same time of requesting an appeal against examiner's decision of refusal, compared to the number of claims providing a basis for fees for a request for examination already paid, and thus the fees for a request for examination becomes insufficient, the shortage shall be collected.

Please note it is often unlawful to increase the number of claims by amendment in the proceedings on the merit.

3. When the number of claims increases by amendment after requesting an appeal against examiner's decision of refusal, fees for a request for appeal

and a request for examination shall be collected.

However, when the number of claims increases or decreases several times and such increase or decrease is within the fees already paid, the additional fee is not collected.

4. When fees are insufficient corresponding to the above 1.~3., an amendment of fees shall be ordered and asked additional payment.

	A person who issues an order	A person who should pay a fee	Disposal when a payment is not made
Falling under 1.(1), an amendment is made at the time of request for appeal	Commissioner of the Japan Patent Office (the Patent Act Article 17(3))	An appellant (An applicant)	Dismissal of a procedure of a request for appeal (the Patent Act Article 18(1))
Falling under 1.(1), no amendment is made at the time of request for appeal	A chief administrative judge (the Patent Act Article 133(2))	An appellant (An applicant)	Dismissal of a written request for appeal (the Patent Act Article 133(3))
Falling under 1.(2)(3)	A chief administrative judge (the Patent Act Article 133(2))	A demandant	Dismissal of a written demand for trial (the Patent Act Article 133(3))
Falling under 2.	Commissioner of	An appellant	Dismissal of a

(an order for amendment to a written amendment)	the Japan Patent Office (the Patent Act Article 17(3))	(An applicant)	written amendment (the Patent Act Article 18(1))
Falling under 3. (under a reexamination by the examiner before trial)	Commissioner of the Japan Patent Office (the Patent Act Article 17(3))	An appellant (An applicant)	Dismissal of a procedure of a request for appeal (the Patent Act Article 18(1))*
Falling under 3. (under proceedings)	A chief administrative judge (the Patent Act Article 133(2))	An appellant (An applicant)	Dismissal of a written request for appeal (the Patent Act Article 133(3))

(Note) In case of 3. in the table, an amendment of an insufficient fee shall be ordered by one notice combined with a request for examination fee and a request for appeal fee.

*A request for examination filed by the third party (the Patent Act Article 195(3)) becomes a dismissal of the application (the Patent Act Article 18(2)).

5. Notes

For an appeal against examiner's decision of refusal, when the number of claims increases compared to those at the final refusal because of an amendment filed with a request for appeal and there is no shortage of the fees for a request for appeal but there is shortage of the fees for a request for examination, an amendment of the fees shall be ordered for the written amendment. If there is no additional payment, the written amendment shall be dismissed.

6. Over or error payment for fees shall be returned by a request from a person made the payment (the Patent Act Article 195(11)).

Return of over or error payment cannot be requested after one year has been passed from the date of payment (the Patent Act Article 195(12)). A request for return of fees shall be asked by submission of a written request for return of fees already paid (Enforcement Regulations of the Patent Act Article 77, Form 75).

(Revised Oct 2015)