

## 21—00 PUDT

### Examination Procedures of Formality Requirements

#### 1. Basic Concept

Formalities of a demand/request for trial/appeal should be examined to determine whether it complies with the requirements of the law before the proceedings on the merits.

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

The Commissioner of the Japan Patent Office has the authority over formalities of a trial case related to 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 Hantei (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 of formalities are as listed below, and ex officio examination (→ 36-01 3.) items such as requirements of demand/request, etc. are also examined simultaneously.

“Purport of the demand and the reasons therefor” are also a formality requirement item (Patent Act Article 131(1)(iii)). It should be carefully

confirmed whether this requirement is satisfied, otherwise it could interfere with the proceedings on the merits.

## 2. Inter Partes Trial

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

Whether a written demand includes a description of a demandant, a demandee, a representative of a corporation or an association which 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), identification of the trial case, and purport of the demand and the reasons therefor; determination of the subject matter (the industrial property right) (a patent number, a registration number); and payment of fees (such as attachment of patent revenue stamps), etc.

(2) Relationship between reasons and evidence

Whether a relationship between reasons and relevant evidence (Patent Act Article 131(2)) is properly described.

(3) Confirmation of a party concerned

Whether a party concerned is an actual person, whether he/she corresponds to a true party concerned by comparing with the description in a power of attorney, a registration ledger, etc.

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

(5) Whether there is authority of representation and the scope of the authority (Patent Act Articles 7 ~ 14 (except Article 10), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

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

Act Articles 56(1), 68(4)).

(7) Whether a demand is filed in a statutory period (Patent Act Articles 126, 173(1)(2)(4), Utility Model Act Article 45, Design Act Article 58(1), 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, and especially in a trial for correction or a trial for invalidation whether there is a full text of both the corrected specification and claims (an entirely corrected specification, etc.) or corrected drawings (Patent Act Article 131(4)).

(9) Whether there is an identification number of the case for preservation of evidence only when the examination of evidence was carried out for preservation of evidence before a trial is demanded (Enforcement Regulations of the Patent Act Article 46(2), Rules of Civil Procedure Article 54).

### 3. Appeal (Ex Parte) Trial

(1) Formality requirements of a request for appeal (Patent Act Article 131(1), Design Act Article 52, Trademark Act Article 56(1))

Same as the above item 2. (1), except that the subject matter of the request is an application, that there is no demandee, and that an association that is not a juridical person cannot be an appellant.

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

(3) Whether there is authority of representation and the scope of the authority (Patent Act Articles 7 ~ 14 (except Article 10), Design Act Article 68(2), 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 (Patent Act Articles 121(1), 132(3), Design Act Articles 46(1), 47(1), 52, Trademark Act Articles 44(1), 45(1), 56(1)).

(5) Whether a request is filed in a statutory period (Patent Act Articles 121, 173(1)(2)(4), Design Act Articles 46, 47, 58, 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) Formality requirements of a petition of opposition (Patent Act Article 115(1), Trademark Act Articles 43-4(1), 68(4))

Same as the above item 2. (1).

(2) Whether there is authority of representation and the scope of the authority (Patent Act Articles 7 ~ 14 (except Article 10)).

(3) Whether an opposition is filed in a statutory period (Patent Act Article 113(1), 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. Hantei (Advisory Opinion)

Same as the above item 2. The Patent Act Article 131, etc. applies mutatis mutandis to the Patent Act Article 71(3).

(Revised December 2023)

## 21—01 PUDT

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

#### 1. A Written Demand/Request for Trial

Documents that need to be attached to a written demand/request for trial/appeal are shown below (in the order of the legal provisions).

(1) When procedures are carried out by an association or a foundation that is not a juridical person that has a person designated as a representative or an administrator (Patent Act Article 6, Utility Model Act Article 2-4, Design Act Article 68(2), Trademark Act Article 77(2))

A name of representative or administrator needs to be written in a demand/request for trial/appeal, but in principle any documents for proof of their qualification are not required due to simplification of the procedures.

(2) When procedures are carried out by a minor, an adult ward, a person under curatorship, etc.

A document proving authority of statutory representation, a letter of consent of a supervisor of guardian, a letter of consent of a curator (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), Design Act Article 68(2), Enforcement Regulations of the Design Act Article 19(1), Trademark Act Article 77(2), Enforcement Regulations of the Trademark Act Article 22(1))

(3) When procedures are carried out by an authorized agent

A document certifying authority of representation (not only the original (document) but also its copy is acceptable) (Patent Act Articles 8 and 9, Enforcement Regulations of the Patent Act Article 4-3(1), Utility Model Act

Article 2-5(2), Enforcement Regulations of the Utility Model Act Article 23(1), Design Act Article 68(2), Enforcement Regulations of the Design Act Article 19(1), Trademark Act Article 77(2), Enforcement Regulations of the Trademark Act Article 22(1)).

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

(5) When procedures are carried out by a successor of the patent right

A notice of change of applicant and a document for proof of transfer of the right, and a letter of consent of other right holders if the right is jointly owned (Patent Act Articles 33 and 34(4)(5), Enforcement Regulations of the Patent Act Articles 5 and 12, Design Act Article 15(2), Enforcement Regulations of the Design Act Article 19(1), 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 or a pledgee, a letter of consent of those people (Patent Act Article 127, Enforcement Regulations of the Patent Act Article 6).

B. Corrected specification, claims or drawings (Patent Act Article 131(4)) (Note) Similarly, a request for correction filed in the procedure of a trial for invalidation and an opposition to grant of patent also requires these documents to be attached.

(7) When a power of attorney, a certificate of nationality, or other documents are 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 a written demand 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) Written 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 name of person who prepared the document and a purport of proof are obvious from the descriptions of the document.)

## 2. Opposition to Grant of Patent (Opposition to Registration of Trademark)

A petition of an opposition to grant of patent (an opposition to registration of trademark) is also handled in the same manner as a written demand/request for trial/appeal (→ 66-03, 67-03).

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## 21—02 PUDT

### Order for Amendment and Inquiry

1 . As a result of examination of formality requirements 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 (Patent Act Articles 17(3) and 133(1)(2), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 56(1), 68(4))

An order for amendment is issued by the 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, or a petition of 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 the 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 (Patent Act Articles 134(4), Utility Model Act Article 39(4), Design Act Articles 52, 68(2), 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 ensuring



accurate indication of the demand although the facts are clear, or for arising necessity to clarify the facts after the trial proceedings begin on the merits (→ 37-02). When an amendment, etc. has not been made and a deficiency is not resolved even after an inquiry was issued, an order for amendment of (1) will be issued.

2. When a person taking procedures has received a contact from a trial clerk or an administrative judge prior to the issuance of an order for amendment or an inquiry against a deficiency of formalities, and the deficiency is resolved by the person making voluntary amendment, the written amendment is accepted and neither an order for amendment nor an inquiry is issued.

3. When it is apparent that a deficiency of formalities is an error in writing or a minor mistake and ex officio correction does not change a purport of the documents, a trial clerk may correct the documents ex officio without issuing an order for amendment or an inquiry. When making corrections ex officio, a trial clerk needs to obtain a consent of a person taking procedures by telephone, e-mail, etc. prior to the correction.

4. When an order for amendment or an inquiry is issued for trials such as 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 the duplicate shall be served (dispatched) after a deficiency is lawfully amended by a written amendment.

5. When a panel determines a demand for trial is unlawful and it is not possible to make an amendment thereof, said demand for trial is immediately dismissed by trial decision without issuing an order for amendment or an inquiry (Patent Act Article 135, → 22-01 8.(2), → 61-04 3., etc.).

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## 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
Commissi oner of Japan Patent Office	Procedu res of re- examina tion by the examine r 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 administra tive judge	Other procedu res	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)).

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## **21—03.1 PUDT**

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

It is required to state 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. Trial/appeal for patents, designs, or trademarks excluding a trial for invalidation

Reasons for demand/request for a trial/appeal are important in the proceedings of reexamination by examiner before trial and the proceedings of trial/appeal, for an examiner and an administrative judge to understand argument of a demandant/appellant promptly and appropriately. Therefore, it is necessary to clearly explain reasons with substantive contents of demand/request for trial/appeal when filing a written demand/request for trial/appeal ((1986 (Gyo-Ke) 96) Judgement of the Tokyo High Court, Oct.11, 1988, (1989 (Gyo-Tsu) 7) Judgement of the Supreme Court, 2<sup>nd</sup> Petty Bench, April 14, 1989, (1998 (Gyo-Ke) 312) Judgement of the Tokyo High Court, Nov 9, 1999).

When substantive reasons are not stated in a column of “reasons for demand/request” in a written demand/request for trial/appeal, 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)) since the demand/request is considered to be in violation of the Patent Act Article 131(1)(iii), the Design Act Article 52 or the Trademark

Act Article 56(1). If an amendment is not made in the designated period of time, the written demand/request for trial/appeal (or the procedures for the demand/request) 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).

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

In particular, cases concerning an appeal against examiner’s decision of refusal for a patent application are as specified below.

(1) Contents of the procedures

- A. When an amendment of a specification, claims or drawings is made at the same time as filing a request for appeal, an “Invitation for Amendment (Formality)” is notified by the name of Commissioner of Japan Patent Office stipulated under the provision of the Patent Act Article 17(3). If an amendment of said invitation is not made in the designated period of time, the procedures for the request will be dismissed stipulated under the provisions of the Patent Act Article 18(1).
- B. Regarding other than item A, an “Invitation for Amendment (Formality)” is notified by the name of a chief administrative judge under the provision of the Patent Act Article 133(1). If an amendment of said invitation is not made in the designated period of time, the written request for appeal will be dismissed by decision stipulated under the provisions of the

Patent Act Article 133(3).

(2) Criteria for issuance of order for amendment

- A. Applies to the statement that only states the intention to supplement reasons later, such as “the detailed reasons will be supplemented later”.
- B. Applies to the statement that only states the intention not to accept the conclusion of the original decision, such as “not satisfied with the original decision”, but there is no specific statement of what is not acceptable.
- C. Applies to the statement that only states the process that led to the original decision.
- D. Applies to the statement that only states something equivalent to combinations of A ~ C.

2. Trial for Invalidation ( $\rightarrow$  51-04)

(Revised December 2023)

## 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. The indication of "similar goods", etc. is not permitted in principle, because the scope of designated goods/services covered by the registered trademark becomes ambiguous when the case becomes final and binding with a partial rescission or a partial invalidation.

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

(Note) A description "similar goods", etc. includes "similar services". The same applies hereinafter.

#### 2. Handling of the Case

##### (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 in violation of 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. within the range that does not change 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 give any response to an order for amendment, a chief administrative judge may dismiss a written demand for trial by decision under the provision 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 make substantive determination on clarity of “Purport of demand”.

B. A panel asks a demandant for an explanation on 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. (2007 (Gyo-Ke) 10084) Judgement of the IP High Court, June 27, 2007
2. (2007 (Gyo-Ke) 10158) Judgement of the IP High Court, October 31,

2007

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

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## 21—05 PUDT

### Handling of Errors in Indication of Either Application Number or Registration Number

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 inquiry, etc. and take any one of the following measures.

A chief administrative judge shall order amendment when he/she considers the entire documents comprehensively and infers a clerical error from them (Patent Act Articles 133(1), 120-8(1), Utility Model Act Article 41, Design Act Article 52, 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 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) changes the gist of the written demand/an opposition to grant of patent (an opposition to registration of trademark) (→ 30-01), such demand or petition shall be dismissed by trial decision/decision (Patent Act Article 135, Patent Act Article 120-8(1), Utility Model Act Article 41, Design Act Article 52, 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 an inquiry, etc., such demand/petition shall be dismissed by trial decision/decision (Patent Act Article 135, Patent Act Article 120-8(1), Utility Model Act Article 41, Design Act Article 52, Trademark Act Articles 43-15(1), 56(1), 68(4)).

(Revised February 2015)

## 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)

## 21—08 PUDT

### Dismissal of Unlawful Procedures

1. When intermediate documents other than documents of a written demand for trial/appeal and an opposition to grant of patent (an 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 (Patent Act Articles 18-2, 133-2, Utility Model Act Articles 2-5(2), 41, Design Act Articles 52, 68(2), Trademark Act Articles 56(1), 68(4), 77(2)).

(1) When procedures are performed with documents or other articles whose purport of submission are not clear

(2) When procedures are performed with documents (excluding an information statement) which have neither identification number nor a name (trade name) of a person performing the procedures (except when the name (trade name) can be identified 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 has expired (Patent Act Articles 4, 5, Utility Model Act Article 2-5(1), Design Act Article 68(1), 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 to be submitted is not attached to a written submission of

articles

- 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 (trade name) of a successor in a notification of change of applicant
- E. No description of an identification number or a name (trade name) of an agent in a notification of acceptance of appointment of agent
- F. No description of an identification number or a name (trade name) 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)

The 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 description of supplementary content 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 in a notification of restriction on use of 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 a domicile (residence) in Japan (Patent Act Article 8(1), Utility Model Act Article 2-5(2), Design Act Article 68(2), Trademark Act Article 77(2)).

(8) When a person who performs a procedure is different from one who is described such as 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 obvious a clerical error is made in preparing a procedural document).

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

A. Using a deposit system

- (A) There is no deposit account number
- (B) A person (an agent if appointed) who performs a procedure is not a depositor (including a person who been notified as an agent pursuant to Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 41) of a deposit account number in a written amendment
- (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 affixing 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 has been notified as an agent pursuant to Enforcement Regulations of the Act on Special Provisions for Procedures Related to Industrial Property Right Article 41).
- (C) Fees cannot be transferred due to no deposit account or insufficient balance in a deposit account, etc.

E. Using a designated advance payer



(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 although a notification for appointment of representative is filed (excluding a procedure the effect of which extends only to the person him/herself)

(13) When 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 when a procedure is taken after a trial decision or a decision becomes final and binding (excluding an amendment to reduce 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 becomes final and binding).

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

(15) In a written amendment (only limited to those for amending the 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, when the request for appeal is withdrawn or dismissed by appeal decision (however, this applies only when another request for appeal against examiner's decision of refusal is pending to the same patent application) (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 (Patent Act Article 121(1)), the number of claims described in the claims (including the claims after amendment made with a request for appeal) at the time of filing a request for appeal;
- (2) For a trial for invalidation (Patent Act Article 123(1)), the number of claims related to a demand for trial; and
- (3) For a trial for correction (Patent Act Article 126(1)), the number of claims related to a demand for trial. In other words, when correcting the entire patent right, the number of claims recorded in a patent register at the time of demanding a trial. When a correction is made per claim, the number of claims subject to correction (→ 38-06).

2. When the number of claims at the time of requesting an appeal increases by amendment 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 has already been 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 (Patent Act Article 17(3))	An appellant (An applicant)	Dismissal of a procedure of a request for appeal (Patent Act Article 18(1))
Falling under 1. (1), no amendment is made at the time of request for appeal	A chief administrative judge (Patent Act Article 133(2))	An appellant (An applicant)	Dismissal of a written request for appeal (Patent Act Article 133(3))
Falling under 1. (2)(3)	A chief administrative judge (Patent Act Article 133(2))	A demandant	Dismissal of a written demand for trial (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 (Patent Act Article 17(3))	(An applicant)	written amendment (Patent Act Article 18(1))
Falling under 3. (under a reexamination by the examiner before trial)	Commissioner of the Japan Patent Office (Patent Act Article 17(3))	An appellant (An applicant)	Dismissal of a procedure of a request for appeal (Patent Act Article 18(1))*
Falling under 3. (under proceedings)	A chief administrative judge (Patent Act Article 133(2))	An appellant (An applicant)	Dismissal of a written request for appeal (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 (Patent Act Article 195(3)) becomes a dismissal of the application (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 in the written amendment. If no additional payment is made, the written amendment shall be dismissed.

6. Fees paid in excess or in error shall be refunded upon a request from the person who made the payment (Patent Act Article 195(11)).

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

(Revised October 2015)