

25—04 PUDT

Extension of the Time Limit for Submission and Change of the Date of Submission

1. Extension of the Time Limit for Submission in General

The Commissioner of the Patent Office or a chief administrative judge may, upon request or ex officio, extend a statutory period and a designated time limit.

A request for extension of the time limit should be made before expiration of the original statutory period or designated time limit. If an expiration date falls on a holiday, the request for extension may be made on the following day.

2. Extension of a Statutory Period for Submission

(1) When persons undertaking procedures or their representatives reside in remote areas or areas with transportation difficulties (see the attached table 25-01), the Commissioner of the Patent Office or a chief administrative judge may extend a statutory period ex officio for the following period.

A. A period for filing a demand for retrial (Patent Act Article 173(1), Design Act Article 58(1), Trademark Act Articles 61, 68(5)) 15 days

B. A period for filing a new application after dismissal of amendment in trial and appeal (Design Act Article 50(1), Trademark Act Article 55-2(1)) 15 days

An extension of the period for filing an appeal against examiner's decision of refusal (Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Article 44(1)) or an appeal against examiner's decision to dismiss amendment (Design Act Article 47(1), Trademark Act Article 45(1)) will not be granted ex officio, however there are provisions for relief after expiration of the period for reasons not attributable to the appellant (Patent Act Article 121(2), Design Act Article 46(2), Design Act Article 47(2)→Article 46(2), Trademark Act Article 44(2), Trademark Act Article 45(2)→Article 44(2))). The period

for filing a new application after dismissal of amendment in examination (Design Act Article 17-3(1), Trademark Act Article 17-2(1)) may not be extended, but it may be extended in appeal (Design Act Article 50(1), Trademark Act Article 55-2(3)) (Design Act Article 17-4(2), Trademark Act Article 17-2(2)).

(2) When persons undertaking procedures are overseas residents, the statutory period may be extended for the following periods.

A. A period for filing an appeal against examiner's decision of refusal for a patent application (Patent Act Article 121(1))(except the period for filing an appeal against examiner's decision of refusal for an application for registration of an extension of the term) 1 month

B. A period for filing a retrial (Patent Act Article 173(1), Design Act Article 58(1), Trademark Act Articles 61, 68(5)) 60 days

C. A period for filing a new application after dismissal of amendment in trial/appeal (Design Act Article 50(1), Trademark Act Article 55-2(3)) 60 days

D. A period for filing an amendment to change of the gist for an opposition to registration of trademark (Trademark Act the proviso to Article 43-4(2)) 60 days

An extension of the period for filing an appeal against examiner's decision of refusal for a design application and a trademark application (Design Act Article 46(1), Trademark Act Article 44(1)) and an appeal against examiner's decision to dismiss amendment for a design application and a trademark application (Design Act Article 47(1), Trademark Act Article 45(1)) will not be granted ex officio, however there are provisions for relief after expiration of the period for reasons not attributable to the appellant (Patent Act Article 121(2), design Act Article 46(2), Design Act Article 47(2) → Article 46(2), Trademark Act Article 44(2), Trademark Act Article 45(2) → Article 44(2)). The period for filing a new application after dismissal of amendment in examination (Design Act Article 17-3(1), Trademark Act Article 17-2(1)) may not be extended, but it may be extended in appeal (Design Act Article 50(1), Trademark Act Article 55-2(3)) (Design Act Article 17-4(2), Trademark Act Article 17-2(2)).

3. Extension of a Designated Time Limit for Submission

The Commissioner of the Patent Office or a chief administrative judge may, upon request or ex officio, extend a designated time limit (Patent Act Article 5(1), Utility Model Act Article 2-5(1), Design Act Article 68(1), Trademark Act Article 77(1)).

(1) Extension of a designated time limit upon request by persons undertaking procedures

A. Extension of the time limit upon request in general (except for the following items B and C)

The extension of the time limit by request may only be approved for the time limit designated for the purpose of enabling overseas residents to file certified experimental results or models/samples, etc. through a written opinion (excluding those specified in the Patent Act Article 48-7) or an inquiry. In addition, if it is deemed that there are grounds not attributable to persons undertaking procedures or their representatives in specific procedures (see 25-01-I-1.(1) and (2)), the necessary extensions of time may be approved regardless of whether domestic or overseas residents (see 25-01-I-1.(5)).

B. Trial for invalidation, trial for correction, trial for rescission of trademark registration and opposition to grant of patent

In principle, no extension of the designated time limit in an invalidation trial, a trial for correction, a trial for rescission of trademark registration and an opposition to grant of patent will be approved upon request of persons undertaking procedures, but it is possible to extend the designated time limit if any of the following requirement (A) or (B) is satisfied. It is not necessary to extend the time limit exactly as requested as long as the time limit to be extended will be generally an additional 20 days on top of the standard time limit.

(A) After the designated time limit has passed, a request for extension of a designated time limit shall be such that it is prohibited by law to undertake procedures concerning important allegations or evidence.

Specifically, a request for the extension of the time limit shall be approved only for the designated time limit only within which "a request for correction" (Patent Act Articles 134-2(1), 120-5(2)) and "amendment of the corrected description, etc. attached to a written request for correction" (Patent Act Article 17-5(1)&(2)) may be approved,

namely; the time limit for the submission of a written reply, in trial for invalidation under the Patent Act and the old Utility Model Act, designated by law; the designated time limit for a request for correction to the Advance Notice of a Trial Decision; the time limit for responding to an office action for notice of reasons for invalidation; the time limit for responding to an office action for notice of reasons for revocation in the process of opposition to grant of patent; the time limit for responding to an office action for notice of reasons for rejecting a request for correction in the process of a request for correction; and the designated time limit for requesting for correction in the process of the second action pendency.

(B) Persons undertaking procedures have paid the specified fees (Patent Act Article 195(1)(i), Utility Model Act Article 54(1)(i), Design Act Article 67(1)(iii), Trademark Act Article 76(1)(ii)) and submitted a written request for extension of the period (Enforcement Regulations under the Patent Act Article 4-2(2) (Form 3), Enforcement Regulations under the Utility Model Act 23(1), Enforcement Regulations under the Design Act Article 19(1), Enforcement Regulations under the Trademark Act Article 22(1)) sufficiently before the expiration of the designated time limit as well as the persons have stated the following matters in the column "contents of the request" of the said written request.

a. Rational and specific reasons for requesting an extension of the time limit (reasons that are not attributable to persons undertaking procedures or their representatives, or reasons that can be objectively examined)

b. Identifying the extension period to request

c. Specific reasons why the extension period to request is reasonable

C. Appeal against examiner's decision of refusal

In principle, no extension of the designated time limit for responding a notice of reasons for refusal and an inquiry in appeal proceedings will not be granted upon request, but it is possible to extend the designated time limit in the following cases (A) and (B).

(A) Patent applications

An extension of the designated time limit is granted if any of the following requirement a. or b. is satisfied.

a. Obtaining experimental data for comparison with cited inventions described in a notice of reasons for refusal, etc.

b. Translation of trial and appeal procedural documents

The maximum extension period per request is one month. Domestic residents may submit a request once for the item a. Overseas residents may submit a request up to three times for the item b, but may submit only once for the item a.

Persons undertaking procedures should submit a request for extension of time sufficiently before the designated time limit has passed (before the extended designated time limit has passed if overseas residents file a second or subsequent request).

(B) Design and trademark applications

The maximum extension period is one month only for overseas residents.

D. Cases subject to accelerated appeal examinations

If a request for extension of period of response is filed for a patent case that has been selected as the case subject to an accelerated appeal examination, the case will not be handled as a subject to an accelerated appeal examination but be handled as a normal case.

(2) Extension of a designated time limit ex officio

Trial for invalidation, trial for correction and trial for rescission of trademark registration, and opposition to grant of patent

In principle, no ex officio extension of the designated time limit ex officio in an invalidation trial, a trial for correction, a trial for rescission of trademark registration and an opposition to grant of patent will be granted, but it is possible to extend the designated time limit ex officio in any of the following case (A) or (B) as long as the case satisfies the specified requirements.

(A) In a case where a designated time limit is shorter than the standard designated time limit

If the following a. or b. is both satisfied, the extension of a designated time limit is granted up to the standard designated time limit after extension.

a. A petition with rational and specific reasons why the standard designated time limit is required has been submitted sufficiently before the designated time limit has passed.

b. Considering the submitted petition, etc., it is deemed to have been appropriate to determine the designated time limit equivalent to the standard designated time limit.

(B) In a case where a long period is required for response due to the amount and nature of the evidence, etc.

When the following requirements items a. to c. are satisfied, an extension of a designated time limit is possible with additional 30 days to the standard designated time limit roughly as a maximum (However, regarding a trial for rescission of trademark registration, if a demandee is an overseas resident and there are rational reasons to require a reasonable time period compared to a domestic resident, such as contact with domestic licensee, etc., collect evidence disclosing a relationship between the said licensee and the demandee (right holder), etc., an extension of a designated time limit for submission of the first statutory reply is possible with additional 50 days to the standard designated time limit roughly as a maximum.).

a. In a case of "collection of self-presented evidence," both the necessity of submitting a certification of experimental results and other evidence in a designated time limit and the need for an appreciable period of time to collect evidence are recognized. In a case of "analysis of evidence presented by the other parties or an opponent of patent opposition," it necessarily requires a long period of time to analyze and prepare evidence because the amount of the evidence submitted by the other parties or the opponent is enormous (hundreds of pages), or the nature of the evidence is highly complex.

b. Regarding an extension of the time limit for response (an opportunity of refutation, etc.) requested by the demandant of a trial for invalidation in a case of "collection of self-presented evidence", it is not intended to provide the evidence that violate restrictions on amendment of grounds for the demand for trial.

c. Persons undertaking procedures have submitted a petition including the following items sufficiently before a designated time limit has passed.

- Rational and specific reasons that the extension period is necessary
- Identifying the required extension period

- Specific reasons that the required extension period is rational

(3) Extension upon request and by discretion will not be granted in duplicate, and only the expiry date is later will be granted.

(4) Procedures before the JPO and the administrative work at the JPO for extension of a designated time limit

A. A written request for extension of time limit in the above item (1) B. and a petition for the purpose of the above item (2). will be addressed to the "chief administrative judge of the JPO," and submitted to the JPO either by mail or in person sufficiently before the designated time limit has passed.

B. When a petition or a written request for extension of time limit is submitted, a trial clerk immediately provides a chief administrative judge with the petition or written request to ask for a decision on whether to extend the time limit.

C. When extension of time limit is granted, a person undertaking procedures will be notified to that effect and will manage the time limit based on the time limit after extension. In addition, if there is no relation between the extension of said time limit and extension of time limit for requesting correction of the specification, etc., it is possible to contact by phone, e-mail, etc. even if the extension of the time limit is granted.

D. Where extension of time limit is not granted, a trial clerk notifies a person undertaking procedures that the extension of the time limit for response is not granted after making a phone call to that effect.

4. Additional Time Limit

A chief administrative judge may ex officio determine an additional period to the indefinite period for actions against trial decisions, etc. for persons in remote areas or areas with transportation difficulties (Patent Act Article 178(5), Utility Model Act Article 47(2), Design Act Article 59(2), Trademark Act Articles 63(2) and 68(5)) (→For persons in areas listed in Appendix of 25-1, an additional period is 15 days, and for overseas resident, 90 days). The additional period will be integrated into the original time limit in the same manner as specified for the extended time limit.

5. Change of Date

A chief administrative judge may, upon request or ex officio, change a date where the date was designated by the chief administrative judge in accordance with the provisions of the Patent Act (Patent Act Article 5(2), Utility Model Act Article 2-5(1), Design Act Article 68(1), Trademark Act Article 77(1)).

For a request to change the date, the reason why the change of the date is needed should be clarified (Enforcement Regulations under the Patent Act Article 4-2(3), Enforcement Regulations under the Utility Model Act Article 23(1), Enforcement Regulations under the Design Act Article 19(1), Enforcement Regulations under the Trademark Act Article 22(1)).

A request to change the date should not be permitted in the following cases (1) or (2), unless there are unavoidable reasons (Enforcement Regulations under the Patent Act Article 4-2(4), Enforcement Regulations under the Utility Model Act Article 23(1), Enforcement Regulations under the Design Act Article 19(1), Enforcement Regulations under the Trademark Act Article 22(1)).

(1) Where multiple representatives have been appointed on either side of the party concerned and some of the representatives have reasons to change.

(2) Where the same date is designated as a date for another case after the date has been designated.

6. Extension Based on the Act on Special Measures Concerning Preservation of Rights and Interests of Victims of Specified Disasters

By prescribing various special measures concerning administrative extensions, etc. of expiration dates of rights and interests by the Cabinet Order, the Act on Special Measures concerning Preservation of Rights and Interests of Victims of Specified Disasters enables to issue these measures in a prompt manner at the time of disasters and is applied to large-scale extraordinary disasters (specified extraordinary disasters).

When the Pacific coast of Tohoku Earthquake of 2011 (Heisei 23) was designated as a specified extraordinary disaster, the measures were taken to extend a statutory period and a designated time limit for applicants who were not able to follow the necessary

procedures before the JPO within the original time limit due to the particularly severe damages.

A request for extension of a designated time limit was accepted as a valid procedure if an applicant filed the request with documents explaining the situations where the applicant was not able to follow the necessary procedures within the original time limit, and followed the procedures promptly as soon as it became possible.

Measures were taken to extend a statutory period so that the expiration date of a procedural time limit would be extended as late as March 31, 2012 (H24).

Procedures for trials and appeals that were subject to the extension are as follows.

(1) A request for an appeal against examiner's decision of refusal

(Patent Act Article 121(1), Design Act Article 46(1), Trademark Act Articles 44(1), 68(4), Supplementary Provisions of the Trademark Act Article 13)

(2) A demand for a trial for correction

(Patent Act Article 126(2))

(3) A request for correction

(Patent Act Article 134-3)

(4) A demand for a retrial against a final and binding decision

(Patent Act Articles 171(1), 172(1), Utility Model Act Articles 42(1), 43(1), Design Act Articles 53(1), 54(1), Trademark Act Articles 57(1), 58(1), 68(5), Supplementary Provisions of the Trademark Act Article 18)

(5) A request for an appeal against examiner's decision to dismiss amendment

(Design Act Article 47(1), Trademark Act Articles 45(1), 68(4))

(6) An amendment of an opposition to registration of trademark

(Trademark Act Articles 43-4(2), 68(4))

If a large-scale disaster occurs and is designated as a specified extraordinary disaster in the future, it is understood that similar measures will be taken.

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