

30-01 P U D T

Amendment and Change of Gist of a Written Demand/Request for Trial and Appeal

1. Amendment of Written Demand/Request for Trial and Appeal

(1) A person who demands/requests for a trial/appeal shall file a written demand/request with Commissioner of the Japan Patent Office and an amendment of the filed written demand/request must not change a gist of the filed written demand/request.

Therefore, regarding amendments of the following items A to C, an amendment which changes the gist of the filed written demand/request shall not be permitted in a trial and appeal of patent, utility model (including old utility models before the revision of law in 1993), design, or trademark:

A. a party concerned, etc.;

B. an identification of the trial/appeal case; and

C. a purport of the demand/request and its reason.

(2) However, the above does not apply to an amendment of a reason for demand/request of a trial and appeal other than a trial for invalidation for patent, old utility model, design or trademark (the Patent Act the proviso (i) of Article 131-2(1), Supplementary Provisions of the 1993 Act on Partial Revision of the Patent Act, etc. Article 4 the Old Utility Model Act Article 41, the Design Act Article 52, the Trademark Act Articles 56(1), 68(4)).

(3) An amendment of a reason for demand for an invalidation trial is as follows (→51-04)

A. Even if an amendment is made for a reason for demand, it shall not change the gist of written demand for an invalidation trial of patent, old utility model, design or trademark, with except following C (the Patent Act Article 131-2, etc.);

B. An amendment of a reason for demand shall not change the gist of the written demand for a trial for invalidation of new utility model registration registered after January 1, 1994 (the Utility Model Act Article 38-2(i)).

C. A chief administrative judge may permit an amendment to change the gist of a reason for demand for a trial for invalidation of a patent, new utility model, old utility model, design, or trademark (the Patent Act the proviso (i) of Article 131-2(1), the Utility Model Act the proviso of Article 38-2, Supplementary Provisions of the 2011 Act on Partial Revision of the Patent Act, etc. Article 19(2) the Old Utility Model Act Article 41, the Design Act Article 52).

(4) When the descriptions in a written request for a trial for correction do not satisfy the requirements of descriptions (the Patent Act Article 131(3)), a chief administrative judge shall require a party concerned to amendment under the provision of the Patent Act Article 133(1). Only amendment to be required shall be permitted to change the gist (the Patent Act Article 131 the proviso (iii) of Article 131-2(1)).

2. Amendment of Party Concerned, etc.

(1) Demandant/Appellant

Excluding the case where the identity of demandant/appellant may be maintained (for example, correction of errors), an amendment of demandant/appellant shall change the gist (→22-01 9.).

(2) Demandee/Appellee

Excluding the case where the identity of demandee/appellee may be maintained, an amendment of demandee/appellee shall change the gist (→22-01 9.).

When a written demand for invalidation trial states a part of the joint owners as a demandee, it shall in principal change the gist by adding the remaining joint owners as a demandee by an amendment (→22-03, 51-05 2.).

(3) Representative of corporation

In a case where a party concerned is a corporation, when there is no agent, an amendment to fill in a missing representative's name of a demandant/appellant in a written demand/request or to change the representative's name stated in the demand/request shall not change the gist.

(4) Agent

It shall not change the gist to amend errors of the agent's name. In case of a lawyer/a patent attorney, amendment of his/her address shall not change the gist. When an agent is a patent attorney corporation, etc., an amendment to fill in a missing representative's name of the agent in a written demand/request, or to change the representative's name stated in the demand/request shall not change the gist.

3. Amendment of Identification of Trial/Appeal Case and Purport of Demand/Request

(1) Amendment of the application number or registration number

In a case where an application number or a registration number has an error and the error is amended, only if the amendment does not lose the identity of the subject to the demand/request for a trial/appeal, such as merely an error in writing, the amendment shall not change the gist (\rightarrow 21-05).

(2) Amendment of purport of the demand/request and a reason thereof

A. Amendment of a registration number subject to the demand/request for a trial/appeal (\rightarrow (1)).

B. Amendment to change a subject to a patent (utility model) invalidation trial from a certain claimed invention (device) to another claimed invention (device) described in the claims.

C. In a case where a subject to a patent (utility model) invalidation trial is a certain claimed invention (device), the claimed invention has become another claimed invention (device) as a result of a trial for correction (a request for correction). In that case, an amendment subject to a claimed invention (device) after correction shall not change the gist.

D. Amendment to change a trial for invalidation of trademark registration into a trial for rescission of trademark registration shall change the gist.

E. Amendment of the attached specification, claims or drawings in a trial for correction (\rightarrow 54-05.1).

F. Amendment of the attached specification, claims or drawings in a request for correction (\rightarrow 51-14 3.).

G. In an appeal against examiner's decision to dismiss

amendment of a design or trademark application for registration, an amendment to change the date of the decision to dismiss the amendment shall change the gist (except an obvious error in writing).

4. Amendment of Reasons for Demand/Request (→1. (2)(3))

5. Change of Gist in Opposition to Registration of Trademark
(→66-03 3.)

6. Change of Gist in Opposition to Grant of Patent (→67-04
2.)

(Revised December 2023)