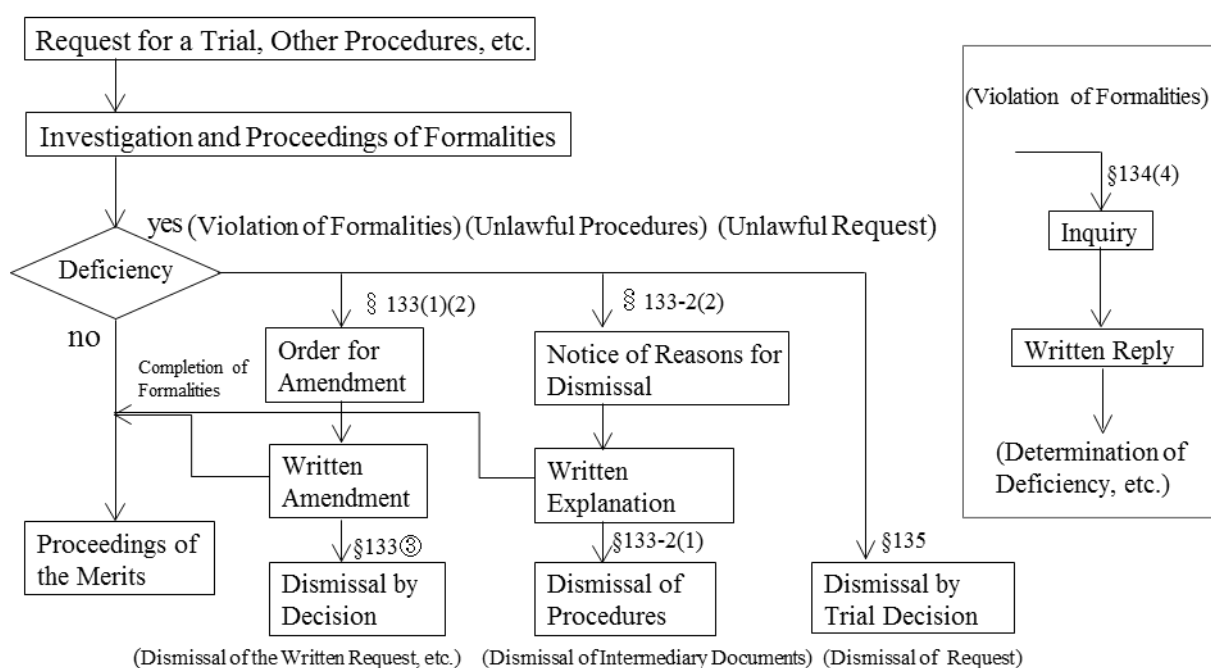


51-08 P U D T

Deficiency and Amendment of a Request for a Trial for Invalidation

1. Deficiency of a Request (in writing) and Disposition

A chief administrative judge has an authority regarding formalities (the Patent Act Article 133). Under this authority, in the process of a request for trial, examinations of the formalities by a trial clerk and proceedings of the formalities by a panel are conducted prior to the proceedings of the merits (→21-00).



A demandant may make amendments in the written request for a trial when the case is in pending before the Japan Patent Office (the Patent Act Article 17(1); the Utility Model Act Article 2-2; the Design Act Article 60-3; the Trademark Act Article 68-40(1)).

If any violation of the requirements of descriptions is found in the written request for trial and a demandant does not make any voluntary amendments, the JPO can take one of the following actions:

(1) If the violation of the requirements of descriptions has not been resolved after the chief administrative judge has provided an opportunity to amend with an order for amendments, the chief administrative judge will dismiss the written request for trial by

decision (the Patent Act Article 133(1) (3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(2) The panel dismisses the request for trial by a trial decision without providing an opportunity to amend (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(3) Conducting an inquiry to clarify facts and findings (the Patent Act Article 134(4); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4))

The action to be taken will be determined by the degree of possibility of resolving the violation of the description requirements in the written request for a trial through lawful amendments.

(Notes) Amendment by the concerned party: (→ 22-01 9.(2))

a. Should be a change in the gist except where both a demandant and a demandee remain the same

b. Should be a change in the gist, in principle, where only some co-patentees are listed as demandees and to supplement the rest of the co-patentees (to be comprehensively determined by reviewing the whole purport)

c. Should not be a change in the gist for an amendment of supplementing the missing name of a representative of a corporation and changing the name of the representative that is already shown

d. Should not be a change in the gist for the amendment of correcting the representative's incorrect name and the patent attorney's address

2. Order for Amendment and Dismissal of a Written Request for a Trial by Decision

(1) Descriptions other than “Reasons for request” in the written request for a trial

When the violation of the requirements of descriptions other than “reasons for request” in the written request for trial is minor and may be resolved, amendments will be ordered (the Patent Act Article 133(1); the Utility Model Act Article 4; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

Examples of the order for amendments are as follows:

- A. A request filed by any person (minors, adult wards, etc.) who does not have sufficient capacity of implementing the procedures;
- B. A request filed in violation of the provisions of the scope of authority of representation;
- C. A request made in violation of the laws in the Patent Act, etc. or formalities pursuant to the governmental or ministerial ordinances;
- D. A request with unpaid predetermined fees; and
- E. Evidence in a foreign language without translated descriptions.

(2) About “Reasons for request”

The requirements of descriptions of the “reasons for request” (the Patent Act Article 131(2); the Utility Model Act Article 38(2); the Design Act Article 52) serve to reduce the demandee’s unnecessary task of addressing matters owing to insufficient descriptions of original reasons for request in writing and to prevent any delay in the proceedings resulting from any violation of the requirements of descriptions.

Accordingly, determining whether the “reasons for request” satisfy the requirements of descriptions may be, for instance, based on the following:

- (1) Whether the descriptions of reasons for the request allow the demandee to identify a subject for counterargument;
- (2) Even if the demandee can identify a subject for counterargument, whether the descriptions of reasons for the request may create any unreasonable burden on the demandee; and
- (3) Whether any deficiency of the descriptions of reasons for the request may cause the demandee to provide any irrelevant response to the subject and thus any substantial counterargument cannot be expected.

Determining whether the reasons for request satisfy the description requirements has a nature to be made by each case based on, for example, the nature or content of the requirements according to acts and provisions in line with reasons for invalidation and the content and complexity in the case’s relations of facts and findings. Therefore, the

determination should be reasonable and suitable according to the circumstances of the individual case.

The requirements of descriptions of the “reasons for request” are requirements of formalities; hence, they are not related to whether the request is accepted based on the descriptions of principal facts or not. In the same manner, the descriptions of the relations between facts and evidence may be satisfactory so long as corresponding relations are defined between the facts that require proof and evidence for proof; however, this has nothing to do with whether the evidence successfully prove the facts that require proof.

Examples of the order for amendments are as follows:

- A. When the volume or length of prior art publications, etc. is too extensive to identify the descriptions that indicate the existence of a prior art invention in evidence;
- B. When facts requiring proof and their evidence are listed to the extent that the descriptions fail to precisely identify each of those relations; and
- C. When relations between facts requiring proof and their evidence are described to a certain extent but fail to precisely identify what part of the evidence is attempting to prove the facts, and when such points are still missing even after an examination of the written request for a trial and other attached documents

(3) Decision to dismiss a written request for trial

In response to an order for amendments set forth in the aforementioned (1) and (2), when a demandant fails to follow the order, when any violation of the requirements of descriptions still remains unresolved even after the amendment, or when the amendment violates the Patent Act Article 131-2(1) (for example, when the amendment changes the gist of the reasons for the request or the gist of the purport of the request), the written request for trial for invalidation may be dismissed by a decision (the Patent Act Article 133(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

3. Dismissal by Trial Decision

If there is any substantial violation of the requirements of descriptions in the written request for a trial and if the amendment is made to resolve the violation, it may evidently require, without intention, a change in the gist of the written request for a trial or it may miss the essential requirements in the written request for trial. On such occasions, the said request will be dismissed by a trial decision as “unlawful request for a trial but unamendable,” without providing any order for amendments as well as any opportunity for submitting a written reply to the right holder (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)).

(Explanation)

Any amendment in the written request for a trial shall not change the gist of the written request. Therefore, if the amendment needs to change the gist of the written request to resolve a violation of the requirements of descriptions in a written request for a trial, such an amendment is not allowed and results into the inability to resolve the violation.

However, some amendments changing the gist of the reasons for request may be permitted in exceptional cases by a chief administrative judge (the Patent Act Article 131-2(2); the Utility Model Act Article 38-2(2); the Design Act Article 52). Even if an amendment changing the gist is made to resolve the violation of the requirements of descriptions of the reasons for request before servicing a duplicate of the written request to the demandee, the chief administrative judge still cannot permit the amendment. Consequently, violation of the requirements of descriptions will never be resolved.

Thus, the case should be handled as mentioned above (The Patent Act Article 131-2(3), the Utility Model Act Article 38-2(3), the Design Act Article 52).

The following cases is applicable to any substantial violation of the requirements of descriptions in the written request for trial, or to any essential requirements that are missing in the request. Therefore, the request shall be dismissed by a trial decision.

A. No descriptions about the reasons for request

(Example 1) Either when nothing is described about the reasons for request in writing or when the description simply says, “To be supplemented.”

(Example 2) When asserting the reasons for invalidation that do not fall under any statutory reasons for invalidation.

B. Substantially, nothing is described about the reasons for request

(Example 1) Even though the reasons for invalidation are described abstractly, the absence of specific facts and evidence indicating the reason for invalidation.

(Example 2) Even though specific facts are described to a certain extent and evidence is presented, it is impossible to identify which reasons for invalidation is applicable to the subject patent (registration) in the argument from the facts and the evidence presented in the request.

C. No descriptions about the principal facts on critical requirements

(Example 1) In the reasons for invalidation in violation of inventive step (the Patent Act Article 29(2)), nothing is described about the fact of existence of “inventions (prior art inventions) listed in the respective items of the preceding paragraph.”

(Example 2) Failure to describe a comparison between the subject patented invention and a prior art invention, thereby resulting into the inability to understand specific reasons for the request.

(Example 3) Failure to describe the reasons for having easily arrived at the patented invention on the basis of the prior art invention (including its logical structure for the arrival), thereby resulting into the inability to understand specific reasons for the request.

D. Failure to precisely describe principal facts and to include appropriate evidence

(Example) When any evidence is not attached to the written request for a trial, the descriptions of the reasons for request are not specific enough to understand the principal facts without evidence.

(Even though failure to attach any evidence in the initial request for a trial does not constitute violation of the description requirements on the assumption that any evidence

be presented in the subsequent examination of evidence, it should be noted that such a case necessitates the descriptions of reasons for request to be more specific to understand the principal facts without presenting any evidence unlike any other cases that have evidence attached.)

E. Others

(Example 1) Failure to identify all co-owners of right as demandees (the Patent Act Article 132(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→ 22-03 2.; 51-05 2.; an example of a trial decision 45-20)

(Example 2) A person who is not a right holder is identified as a demandee (the Patent Act Article 132(2); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Articles 56(1), 68(4)). (→ 22-01; 51-05 2.; an example of a trial decision 45-20). (Example 3) In a trial for invalidation of a patent, or a trial for invalidation of a trademark registration, a demandant is not a party concerned (the Patent Act Article 123(2), the Trademark Act Article 46(2)) (→ 31-01).

(Example 4) In a trial for invalidation of a patent, the claims requested for invalidation are all deleted as a result of correction (→ 51-19 3.).

(Example 5) In a trial for invalidation of a patent, some of the claims requested for invalidation are deleted as a result of correction (Dismissal of the trial decision on the deleted claims → 51-19 3.).

(Example 6) Invalidation or rescission of the right has become final and binding as a result of another case of a trial for invalidation or any other case of opposition to grant of patent.

(Example 7) Any request for trial is filed after the lapse of the period of statute of limitations (Trademarks).

4. Dismissal of Other Unlawful Procedures

Any deficiency in the formalities other than the written request in procedures relating to any case of trials shall be ordered for amendments. Failure to amend the deficiency

within a designated period shall cause the procedures to be dismissed by a decision of the chief administrative judge (the Patent Act Article 133; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1)). In addition, other than the written request for trial, any unlawful and unamendable procedures shall be dismissed by a decision after an opportunity is provided for submitting a statement of explanation by notifying reasons for dismissal (the Patent Act Article 133-2(1); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1)).

5. The Chief Administrative Judge's and Panel's Discretion

(1) Order for Amendments and Dismissal

Formal proceedings of the requirements of descriptions of the reasons for request are a matter to be examined *ex officio*. Accordingly, if any violation of the requirements of descriptions is found in the written request for trial, the chief administrative judge shall order amendments to those written request for a trial. An order for amendments serves to ensure an opportunity to resolve any violation of the description requirements. Therefore, as for any request for a trial that will not be dismissed definitively by a decision, an order for amendments may not be required. The chief administrative judge has the discretion to determine whether issuing an order for amendments is required.

If an amendment by order is found unable to resolve the violation of the requirements of descriptions, "the procedures may be dismissed by a decision" (the Patent Act Article 133(3); the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)). Accordingly, the chief administrative judge has the discretion to determine whether a case should be dismissed by a decision.

If existing substantial violation of the requirements of descriptions in a written request for trial cannot be resolved through amendments, the request can be dismissed by a trial decision (the Patent Act Article 135; the Utility Model Act Article 41; the Design Act Article 52; the Trademark Act Article 56(1), 68(4)). However, the panel has the discretion to determine whether to dismiss the request by a trial decision or to order

an amendment.

Therefore, if violation of the requirements of descriptions is minor, causing no substantial problem, it does not matter even if the chief administrative judge, or the panel does not order amendments and dismiss the procedures by a decision, or does not dismiss the procedures by a trial decision. Similarly, when the matter to be amended by an order still retains an unresolved part even after the amendment, whether to dismiss the case by a decision will be determined by considering significance of the violation.

(2) Handling when an Amendment Changes the Gist

Some amendments that might change the gist of reasons for request prior to the service of a duplicate of a written request for a trial to a patentee are in the stage before proceedings of the merits and hence might not cause any significant delay in the proceedings. Thus, if an order is issued for amendments of any deficiency in the requirements of descriptions prior to the service of a duplicate of a written request for trial to a patentee, if amendments corresponding to the order may resolve the violation of requirements of descriptions in the reasons for request, and if such amendments do not significantly change the gist, such amendments might be acceptable (→ 51-16 1.).

Meanwhile, given the purport that maintains the principle of prohibiting any amendment that may change the gist of reasons for request, amendments of reasons for request after conducting the proceedings of the merits should be stricter to be determined under the provisions of the prohibition of change of the gist than those before conducting the proceedings of the merits.

6. Filing an Appeal

Actions of an appeal against a trial decision to dismiss a request for a trial according to the Patent Act Article 135, or an appeal against a decision to dismiss the written request for a trial according to the Patent Act Article 133(3) may be filed at the Tokyo High Court (the intellectual Property High Court) (the Patent Act Article 178(1); the Utility Model Act Article 47(1); the Design Act Article 59(1); the Trademark Act Article 63(1)).

Meanwhile, actions of appeals against any dismissal of other procedures may be requested according to the Administrative Appeal Act Article 2, or may be filed at a district court.

(Revised June 2019)