

Note: When any ambiguity of interpretation is found in this provisional translation, the Japanese text shall prevail.

(Remarks)

In applying the Examination Guidelines ("Part VIII: Foreign Language Application") to applications filed on or before March 31, 2007, explanations regarding the "amendment that changes a special technical feature of an invention" (Article 17bis (4)) and "notice under Article 50bis" (Article 50bis) in 5.3.2(2), 6.4.3(4), 7.3, 7.3.1(ii) and 7.3.6 shall not be applicable.

1. Application under Foreign Language Patent Application System

1.1 Relevant Provisions

[Provisions applicable to applications filed on or before March 31, 2007]

Patent Act Article 36bis

- (1) A person requesting the grant of a patent may, in lieu of the description, scope of claims, drawings (where required) and abstract as provided in paragraph (2) of the preceding Article, attach to the application a document in a foreign language as provided by a relevant Ordinance of the Ministry of Economy, Trade and Industry, stating matters required to be stated in the description or the scope claims under paragraphs (3) to (6) of the said Article, and drawing(s) (where required) which contain any descriptive text in the said foreign language (hereinafter referred to as "document in foreign language"), and a document in the said foreign language stating matters required to be stated in the abstract under paragraph (7) of the said Article (hereinafter referred to as "abstract in foreign language").
- (2) The applicant for a patent application in which a document and an abstract in foreign language are attached to the application under the preceding paragraph (hereinafter referred to as "written application in foreign language") shall submit to the Commissioner of the Patent Office Japanese translations of the document and the abstract in foreign language within two months from the date of filing of the patent application.
- (3) Where the translation of the document in foreign language excluding drawings as provided in the preceding paragraph is not submitted within the time limit as provided in the preceding paragraph, the patent application shall be deemed to have been withdrawn.
- (4) The translation of the document in foreign language as provided in paragraph (2) shall be deemed to be the description, scope of claims and drawings submitted with the application under paragraph (2) of the preceding Article and the translation of the abstract in foreign language as provided in paragraph (2) shall be deemed to be the abstract submitted with the application under paragraph (2) of the preceding Article.

[Provisions applicable to applications filed on or after April 1, 2007]

Patent Act Article 36bis

- (1) A person requesting the grant of a patent may, in lieu of the description, scope of claims, drawings (where required) and abstract as provided in paragraph (2) of the preceding Article, attach to the application a document in a foreign language as provided by a relevant Ordinance of the Ministry of Economy, Trade and Industry, stating matters required to be stated in the description or the scope claims under paragraphs (3) to (6) of the said Article, and drawing(s) (where required) which contain any descriptive text in the

said foreign language (hereinafter referred to as "document in foreign language"), and a document in the said foreign language stating matters required to be stated in the abstract under paragraph (7) of the said Article (hereinafter referred to as "abstract in foreign language").

- (2) The applicant for a patent application in which a document and an abstract in foreign language are attached to the application under the preceding paragraph (hereinafter referred to as "written application in foreign language") shall submit to the Commissioner of the Patent Office Japanese translations of the document and the abstract in foreign language within one year and two months from the date of filing of the patent application; provided, however, that where the foreign language application is a new patent application divided from a patent application under Article 44(1), a patent application pertaining to conversion of application under Article 46(1) or (2), or a patent application based on a utility model registration under Article 46bis(1), the applicant may submit Japanese translations of the foreign language document and foreign language abstract only within two months from the date of division of the patent application, conversion of the application or filing of the patent application based on the utility model registration.
- (3) Where the translation of the document in foreign language excluding drawings as provided in the preceding paragraph is not submitted within the time limit as provided in the preceding paragraph, the patent application shall be deemed to have been withdrawn.
- (4) The translation of the document in foreign language as provided in paragraph (2) shall be deemed to be the description, scope of claims and drawings submitted with the application under paragraph (2) of the preceding Article and the translation of the abstract in foreign language as provided in paragraph (2) shall be deemed to be the abstract submitted with the application under paragraph (2) of the preceding Article.

Hereinafter in Part VIII, the provisions of Article 36bis, 17bis and 49 shall be represented by provisions applicable to applications filed on or after April 1, 2007.

1.2 Request

Even in the case of a foreign language application, a request shall be written in Japanese just as in the case of a regular Japanese language application. It shall be stated in the column of "[Special Remarks]" in the request that it is a "patent application in accordance with the provision of Patent Act Article 36bis (1)."

1.3 Foreign Language Document and Foreign Language Abstract (Article 36bis)

- (1) Instead of the description, necessary drawings and an abstract to be attached to the request, a foreign language document and a foreign language abstract written in a foreign language specified in the Ordinance of the Ministry of Economy, Trade and Industry may be attached to the request (English is the only foreign language which is specified in Regulations under the Patent Act Article 25quater).
- (2) A foreign language document is not the description, claims and drawings under Article 36(2) but consists of a document stating matters to be described in the description and claims (Article 36(3) to (6)) in the foreign language and the necessary drawings in which any text matter is stated in the foreign language.

The foreign language abstract is not the abstract under Article 36(2), but a document stating the matters to be described in the abstract (Article 36(7)) in the foreign language.

- (3) When the request, the foreign language document and the foreign language abstract are filed, they will be accepted as a regular patent application and the filing date of application will be accorded.

1.4 Translation

- (1) The applicant with a foreign language application shall submit Japanese translations of the foreign language document and of the foreign language abstract within one year and two months after the filing date of the application (Article 36bis(2)).

(Note) For applications filed on or before March 31, 2007, the period is within two months after such a date.

- (2) The translation shall be submitted by means of a written submission of translation. It shall be stated in the column of "[Confirmation]" in the written submission of translation that the matters described in the foreign language document, etc. are translated into proper Japanese without excess nor shortage.

- (3) The applicant shall submit, as a translation under Article 36bis(2), a literal translation in proper Japanese (a word-by-word translation into proper Japanese in accordance with the context of the foreign language document).

- (4) Examiner's Approach to Application Lacking Submission of Translation

- (i) Translation of "Foreign Language Document (Excluding Drawings)"

A foreign language document, excluding drawings, contains a main portion of description of the contents of the invention for which a patent is sought. A translation thereof is legally regarded as the description (Article 36bis(4)) and later becomes a subject of the examination and patent granting. Because of these, lack of a translation is equal to lack of the description attached to the request under Article 36(2). Therefore such foreign language application is regarded as withdrawn (Article 36bis(3)).

- (ii) Translation of "Drawings in which Any Text Matter is stated in the Foreign Language"

In the foreign language application system, it is required to submit entire drawings as the translation even if no foreign language text matter is included in the drawings as of the filing date. If any of the drawings are not submitted as the translation, the missing drawings are deemed not to have been attached to the application although such application is not regarded withdrawn.

It should be noted that no submission of a translation of drawings may result in failure to satisfy the description requirements for the description, claims or drawings, or the requirements for patentability and, therefore, the correction of mistranslation may become necessary.

- (iii) Translation of Foreign Language Abstract

Since an abstract has no influence on any matter related to patent rights, an application will not be deemed to have been withdrawn even if a translation of the foreign language

abstract is not submitted within one year and two months after the filing date of the application. However, the abstract is indispensable for publication of an unexamined application. Therefore, if a translation of the foreign language abstract is not submitted, such an application may be subject to an invitation to correct or the dismissal of procedure (Article 17(3)(ii) and Article 18(1)).

(Note) For applications filed on or before March 31, 2007, the period is within two months of such a date.

1.5 Description, Claims, Drawings and Abstract

A translation of the foreign language document and of the foreign language abstract shall be respectively deemed as the description, claims and drawings attached to the request and the abstract attached to the request (Article 36bis(4)).

(Explanation)

- (1) Where a translation under Article 36bis(2) has been filed, the translation is legally regarded as the description, claims and drawings by the Patent Act. Therefore, it is not the translation but the description, claims or drawings that is the subject of subsequent amendments. Through such amendments, the contents of the document which has been regarded as the description, etc. will be changed.
- (2) As a general rule in this Part VIII, a term "translation" used in relation to the foreign language application only means a "translation filed within one year and two months after the filing date of a patent application." "Description, claims and drawings," "description, claims or drawings," and "description, etc." mean documents which have been regarded as description, etc. (or description, etc. as amended if such documents are later amended).
- (3) However, it should be noted that the word "translation" used in "new matter beyond the translation" means not only a "translation filed within one year and two months after the filing date of a patent application," but also the description, etc. after correction of a mistranslation if a written correction of mistranslation is submitted (Refer to 5.3.1 "Relevant Provisions Concerning New Matters beyond the Translation" and 5.3.3 "Specific Practices regarding New Matters beyond the Translation").

2. Subject for Examination of Foreign Language Application

In a foreign language application, a translation is deemed as the description, claims and drawings attached to the request (Article 36bis(4)). The patent right and the right to demand compensation will come into existence on the basis of the description, claims and drawings written in Japanese.

Accordingly, the subject for substantive examination as to the description requirements and other requirements for patentability shall be the description, claims and drawings. (Refer to the sections starting from the next page with regard to examination concerning reasons for refusal, etc. which are inherent to foreign language applications.)

3. Foreign Language Document

Though a foreign language document submitted for a foreign language application is not the description, claims or drawings under Article 36(2), it describes the contents of the invention at the time of filing. Therefore, the foreign language document has the following legal status.

3.1 Criterion for Determination of New Matter beyond Original Text

(1) In the case of a foreign language application, if any matter which is not disclosed in the foreign language document has been introduced into the translation or into the subsequent amended description etc., it constitutes a reason for refusal or invalidation of patent (Articles 49(vi), 123(1)(v)).

(2) It is foreign language document, which describes the contents of the invention at the time of filing, which always serves as a criterion for determining new matter beyond the foreign language text.

(Note) Refer to "5.1 New Matter beyond Original Text" with regard to the practice for the examination of new matter beyond the original text.

3.2 Prior Art Effect

3.2.1 Relevant Provisions Concerning Prior Art Effect

Patent Act Article 29bis

Where an invention claimed in a patent application is identical with an invention or device (excluding an invention or device made by the inventor of the invention claimed in the said patent application) disclosed in the description, scope of claims or drawings (in the case of the written application in foreign language under Article 36bis (2) , the document in foreign language as provided in Article 36bis (1)) originally attached to the written application of another application for a patent or for a registration of a utility model which has been filed prior to the date of filing of the said patent application and published after the filing of the said patent application in the patent bulletin under Article 66(3) of the patent Act (hereinafter referred to as "patent bulletin" or in the utility model bulletin under Article 14 (3) of the utility model Act (Act No. 123 of 1959) (hereinafter referred to as "utility model bulletin") describing matters provided for in each of the paragraphs of the respective Article or for which the publication of the patent application has been effected, a patent shall not be granted for such an invention notwithstanding Article 29 (1) ; provided, however, that this shall not apply where, at the time of the filing of the said patent application, the applicant of the said patent application and the applicant of the other application for a patent or for registration of a utility model are the same person.

Utility Model Act Article 3bis

Where a device claimed in an application for a utility model registration is identical with a device or invention (excluding a device created or an invention made by the creator of the device claimed in the said application for a utility model registration) disclosed in the description, scope of claims or drawings in the case of the written application in foreign

language under Article 36bis (2) of the Patent Act, the document in foreign language as provided in Article 36bis (1) originally attached to the written application of another application for a utility model registration or for a patent which has been filed prior to the date of filing of the said application for a utility model registration and published after the filing of the said application for a utility model registration in the utility model bulletin under Article 14(3)(hereinafter the "Utility Model Bulletin" or in the patent bulletin under Article 66 (3) of the Patent Act describing matters provided for in each of the paragraphs of the respective Article or for which the publication of the patent application has been effected, a utility model registration shall not be granted for such a device notwithstanding paragraph (1) of the preceding Article; provided, however, that this shall not apply where, at the time of the filing of the said application for a utility model registration, the applicant of the said application and the applicant of the other application for a utility model registration or for a patent are the same person.

(Explanation)

- (1) When a foreign language application is filed prior to the application concerned, the foreign language document filed on its filing date of application will be laid open subsequent to the filing of the later application. Therefore, if the invention of the later application is identical with the invention described in the foreign language document, the later application does not disclose any new invention to the public.
- (2) Accordingly, if a foreign language application falls under "another application for a patent" under Article 29bis of the Patent Act or Article 3bis of the Utility Model Act, the "description, claims, or drawings originally attached to the request" in the case of a regular application written in Japanese shall be replaced with the "foreign language document," and the prior art effect shall be generated on the basis of the foreign language document which is a document submitted describing the contents of the invention as of the filing date (Note).

(Note) Concerning the prior art effect of foreign language PCT application, refer to "10.3 Relevant Provisions Concerning Special Cases of Prior Art Effect."

3.3 Basis of Special Application (Divisional Application, Converted Application or Internal Priority Application)

- (1) Since a foreign language application is accepted as a regular application, a divisional application, a converted application and an internal priority application based on the foreign language application are also permissible.
- (2) A divisional or converted application is deemed to have been filed on the filing date of the original application. Therefore, whether the divisional or converted application based on the foreign language application is appropriate or not is judged on the basis of the foreign language document, which describes the contents of the invention as of the filing. Similarly, the effect of the internal priority comes into existence on the basis of the foreign language document because it is the foreign language document that describes the content of the invention as of the filing (Articles 41(1) and (2)).

(Note) Concerning the practice for the examination of the special application, refer to "9. Examiner's Approach to Special Application, etc."

4. Period during which Amendments to Description, Claims and Drawings are Available

4.1 Relevant Provisions Concerning the Period during which Amendments are Available before Transmittal of Certified Copy of Decision to Grant a Patent

Patent Act Article 17bis (see, Note)

(1) An applicant for a patent may amend the description, scope of claims, or drawings attached to the application, before the service of the certified copy of the examiner's decision notifying that a patent is to be granted; provided, however, that following the receipt of a notice provided under Article 50, an amendment may only be made in the following cases:

(i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal" under Article 50 [including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(1)) and Article 163(2), hereinafter the same shall apply in this paragraph] and said amendment is made within the designated time limit under Article 50;]

(ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48septies and the said amendment is made within the designated time limit under the said Article;

(iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and the said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and

(iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made simultaneously with said request for said trial.

(Paragraph (2) and the rest of the provisions omitted)

(Explanation)

The periods during which an amendment to description, claims or drawings are permitted before transmittal of a certified copy of a decision to grant a patent are as described below, regardless of whether an amendment is made to a foreign language application or a regular Japanese application:

(i) Period from the filing date to the date on which a certified copy of a decision to grant a patent is transmitted (excluding the period after the receipt of the first notice of reasons for refusal) (text of Article 17bis(1))

(ii) Within the designated period for responding to the first notice of reasons for refusal (Article 17bis(1)(i))

(iii) Within the designated period for responding to a notice under Article 48septies after the receipt of a notice of reasons for refusal (Article 17bis(1)(ii))

(iv) Within the designated period for responding to the final notice of reasons for refusal (Article 17bis(1)(iii))

(v) Simultaneous with a request for an appeal against an examiner's decision of refusal is filed (see, Note) (Article 17bis(1)(iv))

(Note) For applications whose date of transmittal of a copy of decision of refusal is on or before 31 March, 2009, the above-mentioned explanation may be replaced by "Within 30 days

after the date on which a request for an appeal against an examiner's decision of refusal is filed".

5. New Matters beyond Original Text or beyond Translation

5.1 New Matters beyond Original Text

5.1.1 Relevant Provisions Concerning New Matters beyond Original Text

Patent Act Article 49

The examiner shall render an examiner's decision to the effect that a patent application is to be refused where the patent application falls under any of the following:

(Paragraphs (i) to (v) and (vii) omitted)

(vi) where the patent application is a written application in foreign language, matters stated in the description, scope of claims or drawings attached to the application of the said patent application do not remain within the scope of matters stated in the document in foreign language; and

Patent Act Article 123(1)

Where a patent falls under any of the following, a request for a trial for patent invalidation may be filed. In the event of two or more claims, a request for a trial for patent invalidation may be filed for each claim.

(Items (i)-(iv) omitted)

(v) where matters stated in the description, scope of claims or drawings attached to the application in a written application in foreign language are not within the scope of matters stated in the document in foreign language;

Patent Act Article 184duodevicies

For the purpose of an examiner's decision of refusal and a trial for patent invalidation, with respect to a patent application in foreign language, the term "written application in foreign language" in Articles 49(vi) , and 123(1)(i) and (v) shall be deemed to be replaced with "patent application in foreign language referred to in Article 184quater (1) ," and the term "document in foreign language" in Article 49(vi) and 123(1)(v) shall be deemed to be replaced with "the description, scope of claims or drawing s of the international application as of the international application date referred to in Article 184quater(1)."

Utility Model Act Article 48quaterdecies

For the purpose of a trial for invalidation of utility model registration with regard to a Utility Model Registration Application in Foreign Language, "where the utility model registration has been granted on an application for a utility model registration with an amendment that does not comply with the requirements as provided in Article 2bis (2)" in Article 37(1)(i) shall be deemed to be replaced with "where with regard to a utility model registration granted based on a Utility Model Registration Application in Foreign Language under Article 48quater(1), matters stated in the description, scope of claims or drawing attached to the application do not remain within the scope of matters stated in the description, scope of claims or drawing of the international application as of the International Application Date referred to in Article 48quater (1)."

(Explanation)

- (1) In the case of a regular application written in Japanese, amendments to the description, claims and drawings shall be made within the matters described in the original description, etc. (Patent Act Article 17bis(3) and Utility Model Act Article 2bis(2)) (Refer to the "Part III Section I New Matter").
- (2) Similarly, for a foreign language application, a foreign language PCT patent application and a foreign language PCT utility model application, it is prohibited to submit a translation which includes a matter beyond the foreign language document or beyond the description, etc. as of the international filing date, or to add new matter beyond the original text to the description, claims or drawings through subsequent amendments. In the cases of (3) to (5) described below, as in the case where new matter is added to a regular Japanese application, the existence of "new matter beyond the original text" shall be deemed as a reason for refusal or invalidation with regard to the foreign language application and the foreign language PCT patent application, and as a ground for a patent invalidation with regard to the foreign language PCT utility model application.
- (3) If the matters disclosed in the description, claims or drawings of the foreign language application are not within the matters described in the foreign language document, such fact will be considered as the reason for refusal (Article 49(v)) and invalidation (Article 123(1)(v)).
- (4) If the matters disclosed in the description, claims or drawings of the foreign language PCT patent application do not fall within the matters disclosed in the description, claims or drawings of the international application as of the filing date of the international application, such a fact will be considered as a reason for refusal (Article 49(vi)), or a ground for invalidation (Article 123(1)(v)) (Article 184duodevices).
- (5) If the matters disclosed in the description, claims or drawings of the foreign language PCT utility model application do not fall within the matters disclosed in the description, claims or drawings of the international application as of the filing date of the international application, such a fact will be considered as a ground for invalidation (Utility Model Act Article 37(1)(i)) (Utility Model Act Article 48quaterdecies).
- (6) Accordingly, "the original text" referred to in "new matter beyond the original text" in this Part VIII means "foreign language document" in the case of a foreign language application, or "description, claims and drawings of an international application as of the filing date of the international application" in the case of a foreign language PCT application.

(Note) Concerning the examination of new matter beyond the original text, the discussion hereinafter will mainly focus on the foreign language application. However, the same approach may be applied to foreign language PCT patent applications, and "foreign language document" referred to in the following explanation may be replaced by "description, claims or drawings of an international application as of the filing date of the international application referred to in Article 184quater(1)."

5.1.2 Concrete Standards for Judgment of New Matter beyond Original Text

- (1) The examiner first assumes a translation which is translated word-by-word from the foreign language document into proper Japanese in accordance with the context (hereinafter referred to as "assumed translation"). Being within the scope of the matters described in the assumed translation is treated as being within the matters disclosed in the foreign language document. The standard for judging whether the matters described in the description, etc. is within the scope of the matters described in the assumed translation shall be identical with the standard for judging whether it is within the matters described in the original description, etc. in "Part III Section I. New Matter."
- (2) The description, etc. may be described in a manner other than that stated in 1.4(3) (literal translation) only in cases where the relations between the foreign language document and the description, etc. do not become unclear and the technological content can be more accurately understood by such a manner of translation. However, even in this case, the description, etc. needs to fall within the matters disclosed in the foreign language document, or in other words, needs to satisfy the requirements mentioned in (1).
- (3) Also, when the foreign language document is translated in such a way that the order of sentences, etc. is changed, the change of the order shall not be deemed to introduce new matters beyond the original text unless it makes a matter not disclosed in the foreign language document disclosed in the description, etc.
Accordingly, if a matter is described somewhere in the foreign language document, it shall not be deemed as a new matter beyond the original text.
- (4) When a part of the foreign language document is not translated into Japanese, it would often not be deemed as a new matter beyond the original text, just as an amendment to a regular Japanese application which deletes a part of the description would often not constitute the addition of a new matter. However, one shall note that a portion which has not been translated may be deemed as a new matter beyond the original text, depending on the content thereof.

Example 1: Case where a portion which has not been translated is not deemed as a new matter

Although a foreign language document discloses a generic concept A in a claim and more specific concepts a1, a2, a3 and a4 as working examples, the a4 is not translated.

(Explanation)

In this case, since any matter beyond the foreign language document is not described in the description, etc., the portion which has not been translated will not be deemed as a new matter beyond the original text.

Example 2: Case where a portion which has not been translated is deemed as a new matter

There is a specific description, "rubber treated to be heat resistant," in a foreign language document, but no description which can be understood as meaning general "rubber" can be found anywhere in the foreign language document, even considering the description, etc. In such a case, the original description is mistranslated into "rubber" in the usual meaning.

(Explanation)

In this case, the foreign language document discloses only the rubber treated to be heat-resistant, and general rubber cannot be recognized as a matter within the disclosure of the foreign language document. On the other hand, the description etc. describes general rubber. Therefore, such mistranslation constitutes new matter beyond the original text.

5.2 Method of Examination of New Matter beyond Original Text

In the foreign language application, it is the description, claims and drawings that are, in principle, subject for the substantive examination on the premise that the contents of the foreign language document coincides with the content of the description, claims and drawings. The foreign language document and the description, etc. are checked with each other only in cases where doubt arises concerning the consistency between the foreign language document and the description, etc., specifically in the cases shown in 5.2.1. If such a check reveals any new matter beyond the original text, it constitutes a reason for refusal.

(Explanation)

If the description, etc. of the foreign language application contains new matters beyond the original text, such an application is subject to refusal or invalidation. However, in light of the following, it is unnecessary for the examiner to compare the description, etc. with the foreign language document in every case:

- i) it is highly probable that the contents of the foreign language document coincide with the contents of the description, etc.; and
- ii) the inconsistency between the foreign language document and the description, etc. can be found by solely examining the description, etc. in light of the conformity among descriptions and common general knowledge.

Therefore, the above-mentioned handling shall be conducted.

5.2.1 Typical Examples in which Comparison with a Foreign Language Document Is Necessary

(1) Where unnatural or unreasonable descriptions in the description, claims or drawings raise a suspicion that the description, claims or drawings may contain new matters beyond the original text

(i) Among typical examples of mistranslation are oversight of words or phrases to be translated (see, Examples 3 and 4), and errors in interpretation of words, context or grammar (see, Example 5).

Such mistranslation brings in the description, etc. text which does not make sense as a whole, or which is contrary to the common general knowledge. The examiner will notice such deficient descriptions in the course of reading and understanding the description, etc. In such a case, the examiner is to suspect that matters beyond the foreign language document may be described in the description, etc. as there have been mistranslations.

Example 3:

A foreign language document contains the sentence, "A is disconnected with B." The letters "dis" were overlooked during the translation, which resulted in a mistranslation into

"A is connected with B," despite the fact that it should have been translated as "A is disconnected with B."

(Explanation)

If elements which should be disconnected are translated as being connected, the relevant description in the translation usually does not make sense in terms of technology. In this case, there is a reason to suspect the new matter beyond the original text resulting from the mistranslation.

Example 4:

A term "beam" in the foreign language document is translated into "*hari* (girder)" despite that it should have been translated into "*kosen* (ray)."

(Explanation)

It is very unnatural to find the term "*hari* (girder)" being used in a completely different technical field where the correct translation "*kosen* (ray)" is usually used. Therefore, there is a reason to suspect the existence of new matter beyond the original text resulting from the mistranslation.

Example 5:

The foreign language document includes a statement, "first circle is drilled through the substrate at 20% of the desired diameter for the hole, and another circle is then drilled at 30% of the full diameter. "A person skilled in the art would be able to recognize that the "first circle" and "another circle" are drilled with the same center in succession in order to form a single hole of accurate size, in view of the context of the descriptions in the foreign language document and the disclosed technological details. Accordingly, the above sentence should be translated as "first circle is drilled through the substrate at 20% of the desired diameter for the hole, and in succession, the circle is additionally drilled up to 30% of the full diameter" (in Japanese). However, a translator misunderstood that the 20%-diameter hole and the 30%-diameter hole were to be separately formed at different positions, and mistranslated the sentence as "first circle at 20% of the desired diameter is drilled through the substrate, and a different circle at 30% of the desired diameter is drilled" (in Japanese).

(Explanation)

It is unnatural and unreasonable that the translation states that two different holes are formed in the context where only one hole is to be formed. Therefore, there is a reason to suspect the existence of new matter beyond the original text resulting from the mistranslation.

(2) Where there is a suspicion that new matter beyond the original text may exist in the corrected description, claims or drawings because it is not objectively clear that the aim of the correction is to correct the mistranslation even by referring to the reason for correction of the written correction of mistranslation.

(i) When an applicant submits a written correction of mistranslation, (s)he must state a reason for correction etc., in addition to the details of the correction so as to make clear that the correction aims at correcting a mistranslation.

(ii) On the contrary, in the cases of Examples 6 and 7 below, it is unclear that the aim of correction is to correct a mistranslation. In such cases, the examiner has a reason to suspect that new matter beyond the original text may exist in the description, etc. corrected by the written correction of mistranslation.

(Note) Refer to "6. Written Correction of Mistranslation" with regard to the examination of written correction of mistranslation.

Example 6:

There is no objective explanation about the reasons why the translation before the correction is improper and why the translation after the correction is proper, although it is insisted that there are some mistranslations in words. (An example is the case where an objective documentary evidence such as a copy of a dictionary is not attached to the written correction despite that it is necessary as a material for explanation of the reasons.)

Example 7:

Although it is insisted that the incorrect translation is due to misinterpretation of the common general knowledge or the context, there is no sufficient explanation or there is a doubt about explanation with respect to the common general knowledge or the comprehension of the context.

(3) A case where there is an offer of information to the effect that new matter beyond the original text exists in the description, claims or drawings, and the result of the examination provides a suspicion that new matter beyond the original text may exist in the description, etc.

As shown in Examples 8, 9 and 10, information concerning new matter beyond the original text may be gathered through the offer of information under Article 13bis of Regulations under the Patent Act or through the submission of a written argument, etc. by an applicant to whom the foreign language application is cited as a prior application of Article 29bis, Article 39, etc. In such cases, the examiner checks the information or the argument and may have a suspicion that matters beyond the foreign language document are described in the description, etc.

Example 8:

If the examiner is informed by a third party that matters beyond the foreign language document have been added to the description, etc., and if such information is deemed reasonable, the examiner is to be suspicious that matters beyond the foreign language document are described in the description, etc.

Example 9:

When a foreign language application is cited as a ground for refusal of another application (Article 29bis or Article 39), and when the applicant of the latter makes an assertion that the foreign language document of the cited application contains new matter beyond the original text. (An example is the case where the examiner has issued a notice of reasons for refusal under Article 29bis after referring only to the translation of the cited application, and the applicant makes an objection to the notice by asserting that the foreign language document does not disclose the cited invention.)

Example 10:

When an opinion about new matter is shown in an international preliminary examination report concerning a PCT application.

5.3 New Matter beyond Translation

5.3.1 Relevant Provisions Concerning New Matter beyond Translation

Patent Act Article 17bis(3)

Except in the case where the said amendment is made through the submission of a statement of correction of an incorrect translation, any amendment of the description, scope of claims or drawings under paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawings originally attached to the application [in the case of a written application in foreign language under Article 36bis (2) , the translation of the document in foreign language as provided in Article 36bis (2) that is deemed to be the description, scope of claims and drawings under Article 36bis (4) (in the case where the amendment to the description, scope of claims or drawings has been made through the submission of the statement of correction of an incorrect translation, the said translation or the amended description, scope of claims or drawings)].

Patent Act Article 49

The examiner shall render an examiner's decision to the effect that a patent application is to be refused where the patent application falls under any of the following:
an amendment made to the description, scope of claims or drawings attached to the application of a patent application does not comply with the requirements as provided in Article 17bis 3 ;
(Paragraphs (ii) through (vii) omitted)

Patent Act Article 123(1)

Where a patent falls under any of the following, a request for a trial for patent invalidation may be filed. In the event of two or more claims, a request for a trial for patent invalidation may be filed for each claim.

(i) where the patent has been granted on a patent application (excluding a written application in foreign language) with an amendment that does not comply with the requirements as provided in Article 17bis (3);
(Items (ii) through (viii) omitted)

Patent Act Article 184duodecies (Paragraph (1) omitted)

(2) For the purpose of the allowable scope of amendment to the description, scope of claims or drawings with regard to a Patent Application in Foreign Language, the term "a written application in foreign language as provided in Article 36bis (2)" in Article 17bis (2) shall be deemed to be replaced with "a Patent Application in foreign Language as provided in Article 184quater(1)"; the term "the description, scope of claims or drawings originally attached to the application [in the case of a written application in foreign language under Article 36bis (2) , the translation of the documents in foreign language as provided in Article 36bis (2) that is deemed to be the description, scope of claims and drawings under Article 36bis (4) (in the case where the amendment to the description, scope of claims or drawing has been made

through the submission of the statement of correction of incorrect translation, the said translations or the amended description, scope of claim or drawings]" in Article 17bis (3) shall be deemed to be replaced with "a translation as provided in Article 184quater (1) of the description or drawings (limited to the descriptive text in the drawings) of an International Patent Application as provided in Article 184ter (2) (hereinafter referred to as an "International Patent Application" in this paragraph) as of the international application date as provided in Article 184quater (1) (hereinafter referred to as the "International Application Date" in this paragraph , a translation as provided in Article 184quater (1) of scope of the claims of an International Patent Application as of the International Application Date (in the case where a translation of the scope of claim(s) amended under Article 19(1) of the Patent Cooperation Treaty signed in Washington on June 19, 1970 has been submitted under Article 184quater (2) or (4), the said translation) or drawings(excluding the descriptive text in the drawings) of an International Patent Application as of the International Application Date (hereinafter referred to as the "Translations, etc." in this paragraph) (in the case where an amendment to the description, scope of claim(s) or drawing(s) has been made through the submission of the statement of correction of incorrect translation, the Translations, etc. or the said amended description, scope of claims or drawings)".

(Explanation)

(1) In cases where a regular amendment does not satisfy the requirements under Article 17bis(3), as in the following cases (i) or (ii), such an amendment is deemed to add new matter beyond translation:

(i) Cases where any written correction of mistranslation has not been submitted, and where a regular amendment to the description, claims or drawings introduces a matter which is not disclosed in the translation considered to be the description, claims and drawings by virtue of Article 36bis(2); or

(ii) Cases where a written correction of mistranslation has been submitted, and where a later regular amendment to the description, claims or drawings introduces a matter which is neither disclosed in the translation considered to be the description, claims and drawings by virtue of Article 36bis(2) nor is disclosed in the description, claims or drawings as corrected by the said written correction of mistranslation.

(2) When a regular amendment is made to add a new matter beyond the translation, such an amendment constitutes a reason for refusal (Article 17bis(3) and Article 49(i)). Moreover, when such a regular amendment is submitted during the time for response to the final notice of reasons for refusal or a notice of reasons for refusal given together with a notice under Article 50bis (hereinafter referred to as the "final notice of reasons for refusal, etc." in Part VIII), or at the time of making a request for an appeal against the examiner's decision of refusal, such an amendment will be dismissed (Article 53, Article 159(1) and Article 163(1))

(3) When a regular amendment includes new matter beyond translation, such an amendment constitutes a reason for refusal or becomes to be dismissed. One can say, however, that it is a mere formality error in selecting a form to be used in the procedure. It is harsh to the applicant to invalidate a patent on the ground of such a minor error, through the invalidation procedure, when the amendment does not introduce any new matter beyond the foreign

language document. Therefore, introduction of new matter beyond translation is not treated as the ground for invalidation.

- (4) The provisions concerning new matter beyond translation do not apply to the amendment made by a written correction of mistranslation.

5.3.2 New Matter beyond Translation

- (1) Significance of Regular Amendment and Prohibition of New Matter beyond Translation

With respect to a foreign language application, an amendment to the description, claims and drawings (a "regular amendment") may be made.

However, it is set forth that such a regular amendment should be made within the matters disclosed in the translation (including the description, etc. as corrected by written correction of mistranslation, if any) (prohibition of new matter beyond translation, Article 17bis(3)). Any regular amendment which infringes the above provisions constitutes a reason for refusal.

Namely, the examination of new matter is carried out on the basis of the translation because it is highly likely that the contents of a foreign language document coincide with the contents of a translation. If any amendment is made beyond the matters disclosed in translation (including the description, etc. as corrected by, if any, a written correction of mistranslation), such an amendment is treated as the reason for refusal just as in the case of the amendment adding new matter beyond the original text.

- (2) Significance of Written Correction of Mistranslation

If the translation does not coincide with the foreign language document due to a mistranslation, and an amendment is made to correct the mistranslation into a proper translation, such an amendment is necessarily within the matters disclosed in the foreign language document. Namely, such an amendment does not infringe the restriction for the new matter beyond the original text. Even in this case, however, if the amendment is made beyond translation, the applicant must submit a "written correction of mistranslation" of which formality is different from the formality of a regular amendment in order to specify the details of mistranslation, the reasons for correction, etc., and thereby, must explain that it is a proper amendment which is made within the matters disclosed in the foreign language document.

This procedure aims at lightening the burden of monitoring by the third party and the workload of examination with regard to the foreign language document.

5.3.3 Practices for Determination of New Matter beyond Translation

- (1) In the examination under Article 17bis(3), the criteria for determining whether or not an amendment is "within the matters disclosed" are the same as those for determination mentioned in "Part III: Section I. New Matter."
- (2) If a written correction of mistranslation is submitted, a matter described at least either in the translation or in the description, claims or drawings immediately after being corrected by the written correction of mistranslation will not constitute new matter beyond the translation.

5.3.4 Applicant's Response to Examiner's Indication for New Matter beyond Translation

If the examiner indicates, in a notice of reasons for refusal, that the description, claims or drawings describes a new matter beyond the translation, the applicant may take, for example, the following actions:

- (1) Make an assertion by submitting a written argument, etc. that the indicated matter does not fall under new matters beyond the translation. In this case, the reason for refusal will be overcome if the applicant succeeds in convincing the examiner that the indicated matter does not fall under new matters beyond the translation through submission of a written argument, etc.;
- (2) Delete the description concerning the indicated new matter beyond the translation, just as in the case of new matter in a regular Japanese application; or
- (3) Submit a written correction of mistranslation to clarify that the description concerning the indicated new matter beyond the translation has been introduced for the purpose of correcting a mistranslation. (Through this procedure, the indicated new matter beyond the translation is deemed to have been added to the description, etc. through a lawful procedure.) In this case, in preparing the written correction of mistranslation, the applicant shall state, in the column of "[Unit to be Corrected]," the portion including the description of the new matter beyond the translation, and shall state "Change" in the column of "[Method of Correction]." In the column of "[Reasons for Correction, etc.]," reasons for correction, etc. shall be stated on the premise of the description, etc. prior to the addition of the indicated new matter beyond the translation. (Refer to "6.2.1 Reasons for Correction" and "6.4.5' Cases where a Written Correction of Mistranslation Overcoming the Reason for Refusal against New Matters beyond the Translation Added by a Regular Amendment is Submitted.")

6. Written Correction of Mistranslation

6.1 Relevant Provisions Concerning Written Correction of Mistranslation

Patent Act Article 17(4)

For any amendment of procedures (except in the case of the payment of fees), written amendment shall be submitted in writing, except for cases provided by Article 17bis (2).

Patent Act Article 17bis(2)

Where an applicant of a written application in foreign language as provided in Article 36bis (2) amends the description, scope of claims or drawings under the preceding paragraph for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.

Patent Act Article 193(2)

In addition to the matters provided for in this Act, the Patent Bulletin shall contain:

(Items (i) and (ii) omitted)

(iii) amendments of the description, scope of claims or drawings attached to an application under Article 17bis (1) after the laying open of a patent application (in the case of an

amendment under any of the items in the proviso to the said paragraph, limited to an amendment made through the submission of a statement of correction of an incorrect translation);

(Items (iv) through (ix) omitted)

(Explanation)

- (1) When an amendment is made to a foreign language application for the purpose of correction of mistranslation, a written correction of mistranslation which states reasons for the correction must be submitted instead of a written amendment under Article 17(4).
- (2) When an amendment is made in order to correct a mistranslation, the applicant is liable for submitting a written correction of mistranslation in which the reasons for correction of mistranslation must be stated. The purposes of this procedure are (i) to clarify that the correction of mistranslation is conducted on the basis of the description of the foreign language document, and (ii) to lighten third parties' or the examiners' burden of checking whether the correction of mistranslation is appropriate or not in the light of the foreign language document.

6.2 Requirements for Written Correction of Mistranslation

The procedure for amendment to the description, claims or drawings by a written correction of mistranslation is different from the procedure for regular amendment by a written amendment. The former procedure has been established in order to make clear to third parties or the examiner, by specifying the details of mistranslation and reasons for correction, etc., that the correction is within the matters disclosed in the foreign language document.

Accordingly, the written correction of mistranslation must satisfy the requirements described below as well as the formality requirements under the Regulation under the Patent Act.

6.2.1 Reasons for Correction

- (1) Reasons for correction shall be described in a written correction of mistranslation in order to clarify that the correction is conducted within the matters disclosed in the foreign language document. Accordingly, the following items (hereinafter referred to as "reasons for correction, etc.") shall be stated enough in the column of "[Reasons for Correction, etc.]" of the written correction of mistranslation so that reasons why the mistranslation occurred become clear and the person skilled in the art would be able to confirm that the content of the correction of mistranslation is within the matters described in the foreign language document:
 - (i) descriptions of the foreign language document corresponding to the descriptions to be amended, and positions thereof;
 - (ii) reasons why the translation, which constitutes the basis of the description, claims or drawings before amendment, is inappropriate; and
 - (iii) reasons why the translation, which constitutes the basis of the description, claims or drawings after amendment, is appropriate.
- (2) When amending two or more portions which belong to different amendment units, reasons for correction shall be stated with respect to each portion with such titles as "(Reason for

Correction 1),” “(Reason for Correction 2)” and so on. When amending two or more portions which belong to a single unit, the reasons for correction shall be stated with respect to each portion (words, phrases, or sentences) with such titles as “(Reason for Correction 1-1),” “(Reason for Correction 1-2)” and so on. (Refer to the Regulation under the Patent Act, Form 15bis, Notes 4 and 5, etc.)

6.2.2 Materials Necessary for Explanation of Reasons for Correction

- (1) If documentary materials are necessary to help a person skilled in the art to easily confirm that the content of correction of mistranslation or the reasons for correction are reasonable, the “materials necessary for explanation of reasons for correction” shall be attached. In this case, the “materials necessary for explanation of reasons for correction” shall be stated as “[Title of Documents]” in the column of “[List of Documents Submitted]” of the written correction of mistranslation, and the necessary materials shall be attached.
- (2) The cases “where it is necessary to show using documents that the content of the correction and the reasons for correction are reasonable” include the cases where a dictionary or other materials are necessary to show that the content of the correction is reasonable, for example, in the case of correction of mistranslation of a technical term. In such a case, copies of relevant pages of the dictionary or other materials shall be attached to the written correction of mistranslation as the materials necessary for explanation of reasons for correction.
- (3) In the materials submitted, such titles as “(Material Necessary for Explanation of Reasons for Correction 1),” “(Material Necessary for Explanation of Reasons for Correction 2),” “(Material Necessary for Explanation of Reasons for Correction 1-1),” and “(Material Necessary for Explanation of Reasons for Correction 1-2)” shall be written in order to clearly show the correspondence relationship between the materials and the reasons for correction stated in the column of “[Reasons for Correction, etc.]”
- (4) When material necessary for explanation of reasons for correction for a portion to be amended is the same as the material necessary for explanation of reasons for correction for another portion to be amended, the attachment of the material may be omitted for the other portion with a statement to that effect in the column of “[Reasons for Correction, etc.]”

6.3 Examples of Written Correction of Mistranslation

(See Appendix 1 and 2, "Written Correction of Mistranslation (Sample)".)

6.4 Examination of Written Correction of Mistranslation

6.4.1 "Aiming at Correction of Mistranslation"

When an amendment is made by submitting a written correction of mistranslation, the fact whether or not said amendment aims at correction of mistranslation does not constitute a reason for refusal. Therefore, the purpose itself should not be examined for a written

correction of mistranslation.

(Explanation)

A written correction of mistranslation is to be submitted instead of a written amendment in order to lighten third parties' or the examiners' burden when an amendment is made for the purpose of correction of mistranslation. The provision of Article 17bis only sets forth a mere formality requirement as to what document should be submitted. Therefore, violation of such provision is not deemed to be a reason for refusal.

6.4.2 Insufficient Description of "Reasons for Correction, etc."

- (1) If the examiner is not convinced that the content of correction of mistranslation is proper (i.e., no new matter beyond the original text exists in the description, etc. as amended by the correction of mistranslation), due to insufficient description of the reasons for correction and insufficiency of the materials necessary for explanation of reasons for correction, the examiner may ask the applicant for an explanation by sending a notice according to Article 194(1) or by making a telephone call, etc.
- (2) If the examiner is not convinced in spite of the action (1) above, this is the case where the examiner should suspect that new matter beyond the original text exists. Therefore, the comparison with the foreign language document should be conducted.
- (3) The examination procedure with respect to the notice of reasons for refusal on the grounds of new matters beyond the original text shall be as described in "7.1 Examination Procedure for New Matters beyond the Original Text."

6.4.3 Including Matters which can be Amended by Regular Amendment in Written Correction of Mistranslation

- (1) A written correction of mistranslation is, in its nature, a document to be filed when making an amendment with the aim of correction of mistranslation. In actual practice, however, an amendment not aiming at the correction of mistranslation may also be necessary at the same time of making a correction of mistranslation. In such a case, if matters which can be amended in the regular amendment procedure are amended in addition to the correction of mistranslation, it is rather desirable to include such matters to be amended in the written correction of mistranslation so as to consolidate the amendments into a single procedure without separately filing a written amendment.
On the other hand, it is impermissible to include an amendment for correction of mistranslation in a written amendment without submitting a written correction of mistranslation.

(Explanation)

(i) Even if a written correction of mistranslation includes a regular amendment, it is possible for third parties or the examiner to clarify the content of mistranslation or the reasons for correction as far as the mistranslation is concerned.

(ii) Even though both amendments corresponding to the regular amendments and other amendments corresponding to the correction of mistranslation are mixed with each other in

a single written correction of mistranslation, appropriateness of amendments is judged for each matter to be amended and, therefore, such mixing of conditions is not regarded as troublesome in the practical work of the examination.

(iii) On the other hand, by handling the matter as described in (1) above, one can avoid such duplicated procedures filing of both a written amendment and a written correction of mistranslation, thereby simplifying a response by the applicant, etc.

(iv) To the contrary, it is impermissible to make a correction of mistranslation by means of the regular written amendment. The purpose of the written correction of mistranslation is to clarify the content of mistranslation and the reasons for correction to third parties or the examiner when there are mistranslations. Therefore, it is not proper to make an amendment through the regular amendment procedure, if it should be amended by the written correction of mistranslation. Moreover, where the amendment which should be amended by the written correction of mistranslation is made by the regular amendment procedure, one should be careful that such amendment would in many cases constitute violation of the restriction of new matter beyond translation and, therefore, constitute the reason for refusal or the reason for dismissing the amendment.

(2) Matters to Be Described in a Written Correction of Mistranslation Including Matters which can Be Amended by Regular Amendment

(i) Where matters which can be amended by regular amendment (i.e., matters to be amended within the scope of the matters described in the description, etc. before amendment) are included in a written correction of mistranslation, it is unnecessary to indicate the reasons for correction, etc. (Refer to 6.2.1(1)) in the column of “[Reasons for Correction, etc.]”

(ii) However, in this case, the applicant shall explain in the column of “[Reasons for Correction, etc.]” by indicating the corresponding portions of the description, etc. before amendment where the matters to be amended are described, that the amendment is within the scope of the matters described in the description, etc.

(3) Examiner’s Approach in Cases Where the Allegedly Regular Amendment Included in Written Correction of Mistranslation Turns out to Be New Matter beyond Translation

(i) Where an amendment is included in the written correction of mistranslation as matters which is to be made as a regular amendment, and it is found that the amendment violates the restriction of new matter beyond translation (i.e., amendment which cannot be done by the regular amendment), the examiner cannot refuse the application nor dismiss the amendment for that reason. However, this makes the reason for correction insufficient with regard to the particular amendment. Thus, the examiner can request the applicant to explain such insufficiency by sending a notice under Article 194(1) or by making a telephone call, etc.

(ii) In response to the above-mentioned demand from the examiner, the applicant may assert or produce counterevidence by filing a written statement, etc. to the effect that the contents of amendment do not correspond to new matter beyond the original text. (For

example, matters to be described as the reasons for correction may be submitted in the written statement in order to show that the amendment does not introduce new matter beyond the original text.)

(iii) If the examiner is not convinced yet that any new matter beyond the original text does not exist in the description, etc. after the correction of mistranslation in spite of the above-mentioned actions, he/she shall compare the description, etc. with the foreign language document.

(iv) If the above-mentioned comparison reveals that a new matter beyond the original text exists in the description, etc., the examiner shall notify reasons for refusal (Article 49(vi)).

(4) **Examiner's Approach in Cases Where a Written Correction of Mistranslation Including a Matter which can Be Amended by Regular Amendment Is Filed after Final Notice of Reasons for Refusal**

If a written correction of mistranslation submitted in response to the final notice of reasons for refusal does not satisfy the requirements under Articles 17bis(4) to (6), such an amendment is to be dismissed. It must be noted that if a written correction of mistranslation contains any matter to be amended which does not satisfy the requirements under Articles 17bis(4) to (6), the entire written correction of mistranslation will be subject to a dismissing of amendment, including matters to be amended which can be amended by regular amendment, in the same manner as in a regular Japanese application, where if a certain matter to be amended does not satisfy the requirements for amendment, the entire written amendment including the said matter will be dismissed.

6.4.4 Notes when Written Amendment and Written Correction of Mistranslation both Dated the Same Date are Filed Separately

Where a written amendment and a written correction of mistranslation are separately filed in response to a certain notice of reasons for refusal, attention shall be paid so as to prevent substantial duplications in amendment units (amendment units indicated in "[Unit to be Amended]" in the written amendment and those indicated in "[Unit to be Corrected]" in the written correction of mistranslation).

6.4.5 Cases where a Written Correction of Mistranslation Overcoming the Reason for Refusal against New Matters beyond the Translation Added by a Regular Amendment is Substantially Submitted

(1) Where the later-submitted written correction of mistranslation makes clear to the examiner and third parties that the earlier-submitted written amendment has not introduced the new matter beyond translation, the reason for refusal against the new matter beyond translation should be deemed overcome by the written correction of mistranslation.

For example, if the description including new matter beyond translation which were added through the regular amendment is included in the amendment unit indicated in "[Unit to be Corrected]" of the written correction of mistranslation, and if the written correction of mistranslation shows sufficient reasons for correction regarding the new matter, the reason for refusal against the new matter beyond translation which were added through the

regular amendment should be considered to be overcome. Moreover, the examiner may not refuse the application nor dismiss the amendment by the reason that the new matter beyond translation exists in the description, etc. amended by such correction of mistranslation.

(Explanation)

Such a written correction of mistranslation should be deemed submitted in order to overcome the reason for refusal based on the new matter beyond translation (See 5.3.4(3)).

As Article 17bis(3) stipulates "Except in the case where the said amendment is made through the submission of a statement of correction of an incorrect translation," the restriction concerning the new matter beyond translation shall not be violated when the new matter beyond translation is added by the written correction of mistranslation. The notion behind this provision is that correction of mistranslation is regularly conducted by necessarily adding new matter beyond translation. Also, the procedure of submitting the written correction of mistranslation makes clear the content of correction of mistranslation and the fact that such correction does not include new matter beyond the original text, thereby, lightens third parties' burden to check foreign language documents and the examiner's burden of examination.

Accordingly, if the later-submitted written correction of mistranslation clearly states that the new matter beyond translation caused by the earlier submitted regular amendment were for the purpose of correcting mistranslation, the reason for refusal due to the new matter beyond translation should be deemed overcome.

Thus, it is appropriate that the examiner cannot refuse the application nor dismiss the amendment merely because the new matter beyond translation is included in the description after the correction of mistranslation.

- (2) If the later-submitted written correction of mistranslation does not make apparent to third party or the examiner the reason why new matter beyond translation has been added, it should not be deemed that the reason for refusal due to the new matter beyond translation is resolved.

For example, if the portion of the description including new matter beyond translation which was added by the prior regular amendment is not indicated in the amendment unit of "[Unit to be Corrected]" of the written correction of mistranslation, and if the written correction does not show sufficient reason for correction regarding the new matter, the reason for refusal based on the new matter beyond translation which was added by the prior amendment should not be canceled.

Accordingly, in the above-mentioned situation, the examiner may send a notice of reasons for refusal on the ground of the new matter beyond translation. If such notice of reasons for refusal has already been sent to the applicant, the examiner may make a decision of refusal on the basis of such reason. However, the examiner may not dismiss the amendment made by the written correction of mistranslation.

(Explanation)

It is not appropriate to regard, in such a case, the reason for refusal due to the new matter beyond the translation as being overcome by considering that the new matter beyond the translation has been amended by the written correction of mistranslation,

because it is against the purpose of establishing the system of written correction of mistranslation. In addition, since, as a result, the new matter beyond the translation is still maintained, the reason for refusal due to the new matter beyond the translation still exists even after the correction of mistranslation.

Therefore, if such a written correction of mistranslation is filed, the examiner may send a notice of reasons for refusal on the grounds of the new matter beyond the translation. If such a notice of reasons for refusal has been already sent, the examiner may make a decision of refusal based thereon.

However, it must be noted that the amendment made by the written correction of mistranslation may not be dismissed.

- (3) Even if the description in the written correction of mistranslation is not completely sufficient, the reason for refusal based on the new matter beyond translation should be deemed overcome by the written correction of mistranslation, if it makes apparent that the new matter beyond the translation has been added for correcting mistranslation.

7. Examination Procedure for Foreign Language Application

7.1 Examination Procedure for New Matter beyond Original Text

- (1) If the examiner has a suspicion that new matter beyond the original text exists in the description, claims or drawings, the examiner compares them with the foreign language document. If the examiner becomes provisionally convinced through the comparison that new matter beyond the original text does exist, the examiner indicates such effect as a reason for refusal and invites the applicant's assertion or counterevidence that new matter beyond the original text does not exist.
- (2) If the applicant, in response to the notice of reasons for refusal, succeeds in denying such reason for refusal by submitting a written argument, etc. to the extent to bewilder the examiner's conviction, the above-mentioned reason for refusal should be deemed overcome. If the examiner's conviction does not change, a decision of refusal can be rendered on the basis of the reason for refusal due to the new matter beyond the original text.
- (3) In a notice of reasons for refusal based on new matter beyond the original text, all of the new matters beyond the original text which have been found in a manner described in above-mentioned (1) should be pointed out in the notice of reasons for refusal.
- (4) Where a notice of reasons for refusal is sent with regard to unnatural or unreasonable descriptions on the grounds of violation of Article 36 as the descriptions of the description etc. are unnatural or unreasonable to the extent that they do not satisfy the requirements for description under Article 36, it may be issued without comparison with the relevant foreign language document, regardless of whether or not the examiner has had a suspicion that there is a reason for refusal based on the new matter beyond the original text.

However, it must be noted that the existence of any unnatural or unreasonable description in a part of the description, claims and drawings does not necessarily mean failure in satisfying the requirements under Article 36.

7.2 Notice of Reasons for Refusal Concerning New Matter beyond Original Text

If new matter beyond the original text is found at the first step of substantive examination, the existence of such new matter should be indicated in a first notice of reasons for refusal. If the new matter beyond the original text still exists after the response made to the first notice of reasons for refusal, or if new matter beyond the original text comes to exist due to amendments made in the response to the first notice of reasons for refusal, the following procedure should be taken:

- (1) In the event that the new matter beyond the original text which has been indicated in the first notice of reasons for refusal still remains, a decision of refusal may be rendered.
- (2) In the case where the new matter beyond the original text which have not been indicated in the first notice of reasons for refusal:
 - (i) the new matter beyond the original text should be notified as a first notice of reasons for refusal, if the new matter had existed before the first notice of reasons for refusal was served, and
 - (ii) the new matter beyond the original text should be notified as a final notice of reasons for refusal, if the new matter came to exist through the amendments made in the response to the first notice of reasons for refusal. However, if there is another reason for refusal which should be notified as a first notice of reasons for refusal, the new matter should be notified as a first notice of reasons for refusal.
 - (iii) In the above-mentioned cases of (i) and (ii) when a reason for refusal having been already notified still remains other than that of new matter beyond the original text, a decision of refusal may be rendered. In this case, the existence of the new matter beyond the original text should be additionally mentioned in the decision of refusal.

7.3 Amendment after Final Notice of Reasons for Refusal, etc.

When an amendment is made in response to the final notice of reasons for refusal, etc., the examiner shall determine whether or not the amendment should be dismissed after confirming that it has been appropriate to make the notice the final notice of reasons for refusal or to give a notice under Article 50bis, following "Part IX: Procedure of Examination, 6.1" or "Part V: Chapter 1. Section 2. Notice under Article 50bis, 4.2."

7.3.1 Amendment to be Dismissed

- (i) A regular amendment to the description, claims or drawings to add a new matter beyond the translation (Article 17bis(3)).
 - (a) Where a new matter beyond the translation which was indicated in the final notice of reasons for refusal, etc. still remains
 - (b) Where a new matter beyond the original text is added through a regular amendment made in response to the final notice of reasons for refusal, etc. and the new matter beyond the original text involves a new matter beyond the translation at the same time

(ii) A regular amendment or a correction of mistranslation for the claims, which changes a special technical feature of an invention (Article 17bis(4))

A regular amendment or a correction of mistranslation made in response to the final notice of reasons for refusal, etc.

- (a) which newly adds an “invention whose special technical feature was changed”; or
- (b) which includes the “invention whose special technical feature was changed” which was indicated in the final notice of reasons for refusal, etc.

(iii) A regular amendment or a correction of mistranslation made for the claims, which is not for any of the following purposes (Article 17bis(5)):

- (a) the deletion of the claim or claims (Article 17bis(5)(i));
- (b) the restriction of the claim or claims with limitation (Article 17bis (5)(ii));
- (c) the correction of errors (Article 17bis (5)(iii)); or
- (d) the clarification of ambiguous description (only with respect to the matters mentioned in the reasons for refusal concerned) (Article 17bis(5)(iv)).

(Explanation)

If an amendment to the claims is not regarded as an amendment made for any of the purposes mentioned in the paragraphs of Article 17bis(5), it will be subject to being dismissed regardless of whether or not it includes new matters beyond the original text.

(iv) A regular amendment or a correction of mistranslation which is made for the purpose of the restriction of claims with limitation, which does not make the invention after the amendment patentable (Article 17bis(6)).

7.3.2 Procedure for Considering Dismissal of Amendment

The procedure for considering a dismissing of amendment shall follow “6.2.2 Examination on whether Amendment was made legally” in “Part IX: Procedure of Examination,” with “new matter” being replaced by “new matter beyond the translation.”

7.3.3 Cases where Amendments (Correction of Mistranslation and Regular Amendment) are Made more than Once in Response to Final Notice of Reasons for Refusal, etc.

- (1) If a correction of mistranslation and a regular amendment are made on different dates, judgment on whether or not the regular amendment violates Article 17bis(3) shall be made based on the translation where the correction of mistranslation was not made prior to the regular amendment or based on the description, claims or drawings immediately after the amendment by the written correction of mistranslation where the correction of mistranslation was made prior to the regular amendment.
- (2) If more than one amendment (including a correction of mistranslation and a regular amendment) is made on the same date and it is apparent according to the content which of the amendments was made prior to others, then whether or not the amendments are accepted shall be judged on a first-come-first-served basis. If the order of amendments

made on the same date is unknown and the decision to dismiss or the subject of the dismissal depends on the order of the amendments, the examiner shall confirm a chronological order of the amendments by sending a notice under Article 194(1) to the applicant and then determine the order of judgments on the acceptability of the amendments.

7.3.4 Application of Article 17bis (6) and Article 53

- (1) Provisions to be considered when applying the requirement for independent patentability shall be as follows: Articles 29, 29bis and 32, Article 36(4)(i) or (6) (excluding paragraph (iv)), and Article 39(1) to (4).
- (2) Article 49(vi) (new matter beyond the original text) shall not be included in the provisions applicable to the judgment on whether or not a claimed invention to which an amendment was made for the purpose of restriction of the claim with limitation is independently patentable at the time of filing of the patent application.

7.3.5 Application whose Amendment is Dismissed

The approach to an application when an amendment thereto is dismissed shall follow “Part IX: Procedure of Examination, 6.3” or “Part V: Chapter 1. Section 2. Notice under Article 50bis, 4.2.”

7.3.6 Application whose Amendment is Accepted without being Dismissed

- (1) The approach to an application when an amendment thereto is accepted without being dismissed shall follow “Part IX: Procedure of Examination, 6.4” or “Part V: Chapter 1. Article 2. Notice under Article 50bis, 4.2.”
- (2) If a new matter beyond the original text is added by an amendment made in response to the final notice of reasons for refusal, etc., another notice of reasons for refusal shall be sent since an amendment shall not be dismissed on the grounds of introducing a new matter beyond the original text. However, if reasons for refusal mentioned in the final notice of reasons for refusal or in a notice of reasons for refusal given with a notice under Article 50bis have not been overcome, the examiner may render a decision of refusal without giving a notice of reasons for refusal to such effect. In this case, the existence of the new matter beyond the original text shall be additionally mentioned in the written decision of refusal.

8. Foreign Language Application as Prior Art

8.1 Practice when Foreign Language Documents are Searched

- (1) When foreign language applications or official gazettes thereof are searched as prior art for the examination under Articles 29, 29bis or 39, etc., it is highly probable that the contents of the foreign language document coincide with the contents of the translation. Therefore, it

is usually considered to be sufficient to search only the portion translated into Japanese.

- (2) However, if any doubt arises that some differences exist between the translated portion and the description of the foreign language document, it is necessary to expand the search range to the foreign language document of the foreign language application.

8.2 Notes to Prior Application Search under Article 29bis, etc.

8.2.1 Notes to Scope of Search

- (1) When a foreign language application or a foreign language PCT application becomes "another application (prior application)" referred to in Article 29bis or 184terdecies of the Patent Act, or Article 3bis or 48novies of the Utility Model Act, the prior art effect of such prior application is produced on the basis of the foreign language document. Therefore, the relevant description in the foreign language document of the cited prior application must be eventually indicated.
- (2) As mentioned in 8.1 above, however, it is highly probable that the content of the foreign language document coincides with the content of the translation. Therefore, it is usually considered to be sufficient to search only the portion translated into Japanese.

8.2.2 Notes when Foreign Language Application or Foreign Language PCT Application is Cited as Another Application referred to in Article 29bis or 184terdecies of Patent Act, or Article 3bis or 48novies of Utility Model Act

It is usually sufficient to indicate only the relevant description in the translation and to mention that the corresponding description of the foreign language document, etc. is the ground of the notice of reasons for refusal. However, if the corresponding description in the foreign language document, etc. has been identified, the descriptions of both the translation and the foreign language document should respectively be indicated.

8.2.3 How to Deal with Applicant's Argument

- (1) Where a reason for refusal according to Article 29bis etc. is notified by citing the foreign language application as "another application," and where the applicant asserts through an argument, etc. that the relevant description indicated by the examiner is not described in the foreign language document of the relevant application and thereby succeeds in denying the examiner's conviction that the indicated description is in the foreign language document to the extent that truth or falsity becomes unclear, the reason for refusal should be deemed overcome. If the applicant's argument does not change the examiner's conviction, a decision of refusal may be rendered.
- (2) When new matter beyond the original text is discovered in "another application" for which the examination has not been completed, a notice of reasons for refusal on the basis of the new matter beyond the original text will be sent to such "another application."

8.3 Prior Application Right under Article 39 of Foreign Language Application

When an invention defined in a claim of a prior application or of another application filed on the same date includes new matter beyond the original text, the provisions of Article 39(1)-(4) shall not apply to such an invention.

(Explanation)

If the invention defined in a claim containing new matter beyond the original text has the effect to defeat later applications, it is against the principle of first-to-file as in the case of a regular application with a claim containing new matter. Therefore, if a claimed invention of a prior application or of another application filed on the same date contains new matter beyond the original text, the provisions of Article 39(1)-(4) should not apply to such an invention.

9. Examiner's Approach to Special Application, etc.

9.1 Basic Concept

- (1) As foreign language applications are accepted as regular domestic applications, divisional applications, converted applications and internal priority applications filed on the basis of a foreign language application shall be accepted.
- (2) Since divisional applications, converted applications, patent applications based on a utility model registration and internal priority applications are not different from regular applications in that they are patent applications, filing these applications as a foreign language application shall be allowed as in the case of regular patent applications.
- (3) Since a divisional application and a converted application have the effect that these applications are deemed to be filed on the filing date of their original applications, if the original application is a foreign language application, appropriateness of the division or conversion is judged on the basis of the foreign language document, but not of the translation.

If a divisional or converted application contains new matter beyond the foreign language document of the original (foreign language) application, it does not satisfy the requirements for a divisional or converted application and an earlier filing date therefore cannot be entitled for such an application.

In the case of an internal priority based on a foreign language application, the internal priority takes effect based on the foreign language document, since the foreign language document is the one describing the details of the invention as of the filing date of the prior application (Article 41).

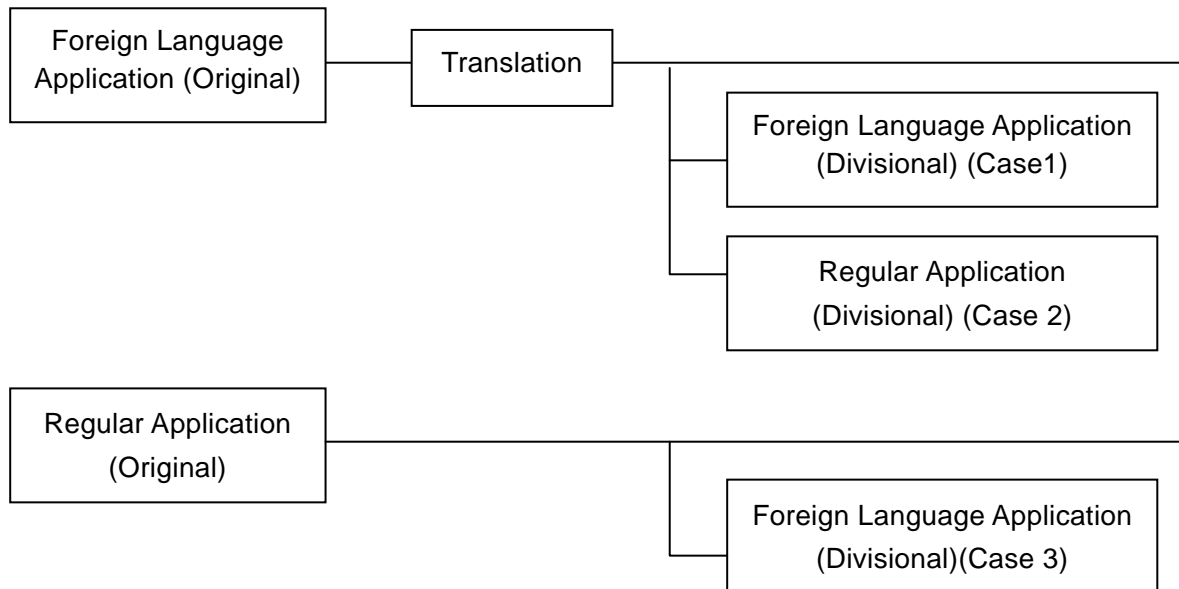
- (4) Notwithstanding (3) above, since it is highly probable that the content of a foreign language document coincides with the content of the translation thereof, it is usually only necessary to examine the translation of the original application (or the prior application) in order to judge the propriety of retroactive effects in respect of the filing date.
- (5) When a foreign language application is a divisional application, a converted application, an application based on a utility model registration, or an application claiming a priority, the

fulfillment of the requirements for division, conversion, etc. and the occurrence of effect of priority shall be examined not on the basis of the foreign language document but on the basis of the description, etc..

9.2 Divisional Application

9.2.1 Cases of Divisional Application

Possible cases of a divisional application related to a foreign language application are as follows:



9.2.2 Examination Practice

(1) Where the original application is a foreign language application (Cases 1 and 2)

Regarding the requirement that the divisional application “shall not exceed the scope of matters described in the description, claims or drawings of the original application as of the filing” (Part V: Chapter 1. Section 1. Division of Application, 2.2 Substantive Requirements, (1)(ii) or (2)(ii)), which is a part of the substantive requirements for division, such matters should be replaced with the matters described in the foreign language document of the original application. However, since it is highly probable that the content of the foreign language document of the original application coincides with the content of the translation thereof, it is usually sufficient to compare the translation of the original application with the matters described in the description, etc. of a divisional application to determine whether the said requirement is satisfied.

(2) Where a divisional application is a foreign language application (Cases 1 and 3)

Not the foreign language document but the translation thereof and the description, etc. amended thereafter shall be examined in terms of the fulfillment of the substantive requirements for division.

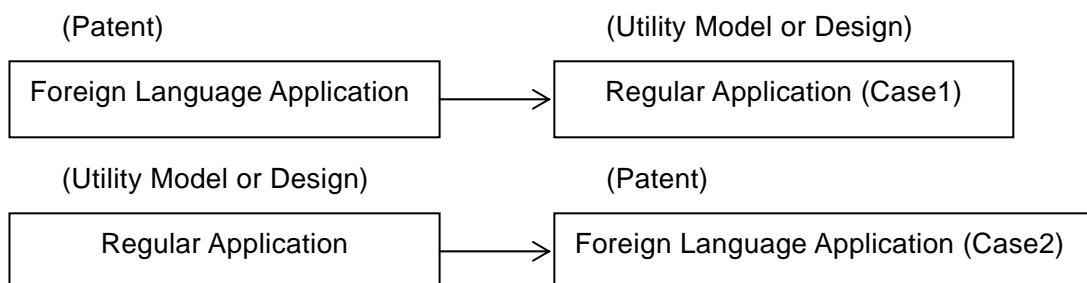
9.2.3 Period during which Divisional Application can be Filed

The period during which a divisional application can be filed for a foreign language application is basically the same as such a period for regular Japanese applications. However, where a divisional application is filed by referring to a foreign language application as the original application, the description, etc. of the original application which is subject to the division does not exist before a translation of the original application is filed. Therefore, a divisional application cannot be filed during such a period.

9.3 Converted Application

9.3.1 Cases of Converted Application

Since a foreign language application is not admitted for utility model application, possible cases of a converted application related to the foreign language application are the following:



9.3.2 Examination Practice

(1) Case 1

(i) The basis of a converted application is the matters described in a foreign language document of the original application. If a translation is filed, it is highly probable that the content of the foreign language document of the original application coincides with the content of the translation. Therefore, it is usually sufficient to compare the translation of the original application with the matters described in the description, etc. of the converted application to determine whether the substantive requirements for conversion are satisfied or not.

(ii) When a converted application is filed before a translation is submitted for the original application, the foreign language document of the original application is compared with the matters described in the description, etc. of the converted application to determine whether the substantive requirements for converted application are satisfied.

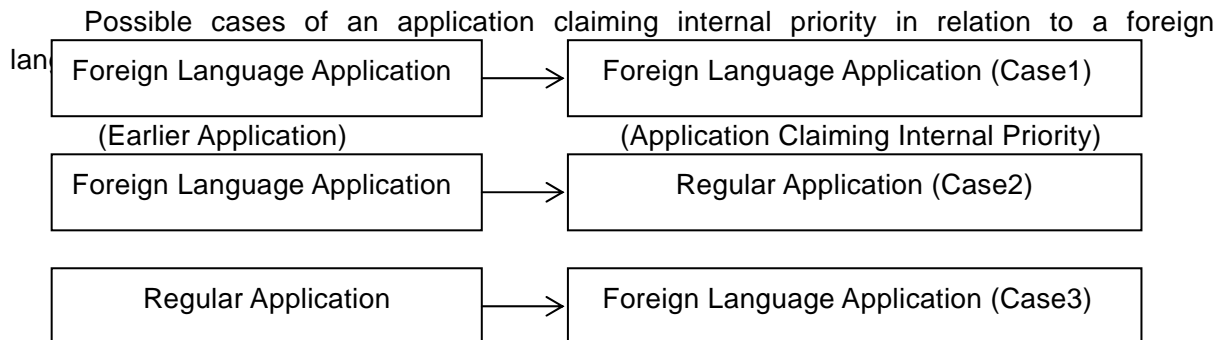
(2) Case 2

(i) The original description, etc. of the original application (regular application) and the description, etc. of the converted application are compared to determine whether the requirements for conversion are satisfied. Regarding the other requirements, the same examination procedure will be conducted as in the case of other foreign language applications.

(ii) Even if the foreign language document of the converted application does not satisfy the requirements for conversion, such converted application will be lawful if defects are remedied in the translation or later amended description, etc.

9.4 Internal Priority

9.4.1 Cases of Application



9.4.2 Examination Practice

(1) Cases 1 and 2

(i) The basis of internal priority is the matters described in a foreign language document of the earlier application. If a translation is filed, it is highly probable that the content of the foreign language document of the earlier application coincides with the content of the translation. Therefore, it is usually sufficient to compare the translation of the earlier application with the matters described in the description, etc. of the application claiming internal priority to determine whether the internal priority comes into effect or not.

(ii) However, if an internal priority application is filed before filing of a translation, and if the translation of the earlier application is not filed afterward, the foreign language document of the earlier application must be compared with the matters described in the description, etc. of the application claiming internal priority to determine whether the internal priority comes into effect or not.

(iii) As in the case of a regular application claiming internal priority, the existence of the effect of priority is judged only when the examiner has discovered a prior art which can be the ground for the reason for refusal and which was published after the filing date of the earlier application and before the filing date of the application claiming internal priority.

(2) Case 3

The prior application (regular application) is compared with the matters described in the description, etc. of the foreign language application claiming priority to judge whether the effect of priority exist or not. Regarding the other requirements, the same examination procedure will be conducted as in the case of other foreign language applications.

10. Foreign Language PCT Application

A foreign language PCT patent application is treated as in the same manner with the foreign language applications. It is possible to correct mistranslation in a foreign language PCT utility model application on the basis of the description, etc. as of the filing date of international application.

However, a translation of the foreign language PCT application must be filed during the period for submission of the national form paper.

10.1 New Matter beyond Original Text and Description as Criterion for Judgement thereof

As stated in "5.1.1 Relevant Provisions Concerning New Matter beyond Original Text", new matter beyond the original text constitutes a reason for refusal or invalidation in the foreign language PCT patent application, and further, it constitutes a reason for invalidation in the foreign language PCT application for utility model registration, and the criteria for new matter in these applications is the description, claims and drawings of international application as of the international filing date.

10.2 Correction of Mistranslation and Regular Amendment

10.2.1 Correction of Mistranslation in Foreign Language PCT Application

- (1) As in the case of the foreign language application, a mistranslation in the foreign language PCT patent application may be corrected by submitting a written correction of mistranslation (Article 184duodecies(2)).
- (2) When mistranslations are corrected, the translation as well as the description or drawings as amended by the correction of mistranslations serve as the criteria for judging new matter beyond translation in a later regular amendment.
- (3) In the case of the foreign language PCT utility model application, it is possible to correct mistranslation on the basis of the description, etc. as of the international filing date which is prepared in a foreign language, within a period of time during which amendments are allowed to make to the description, claims or drawings (Articles 2bis(1), 6bis and 48octies(2) of the Utility Model Act). In this case, amendments should be made by means of a written amendment under Article 2bis(4) of the Utility Model Act (Article 48octies(3) of the Utility Model Act).

10.2.2 Regular Amendment in Foreign Language PCT Patent Application

The criterion for regular amendment to the foreign language PCT patent application is a "translation or drawings of an international patent application (if a written correction of mistranslation is filed, a translation, or the description, claims or drawings as amended by the correction of mistranslation is considered the criterion for regular amendment)" (Article 184duodecies(2)). Violation of such provisions constitutes a reason for refusal as in the case of the foreign language application. (Concerning the foreign language PCT utility model

application, no provision is set forth with regard to the addition of new matter on the basis of the translation.)

10.2.3 Amendment under PCT Article 34

(1) Concerning foreign language PCT patent applications, where an amendment is made at the international phase in accordance with the provisions of Article 34(2)(b) of the PCT and the translation of the written amendment is submitted to the Commissioner of the Japan Patent Office by the date on which the relevant time for the national processing occurs, the amendment shall be deemed to have been made by means of submitting a written correction of mistranslation (Article 184octies(1) to (4)).

Therefore, in that case, as a result of the amendment under Article 34(2)(b) of the PCT, the criteria for judging the new matter beyond the translation shall be the translation or drawings of the international patent application, or the translation of the description or drawings as amended under Article 34(2)(b) of the PCT.

(2) When an amendment under Article 34(2)(b) of the PCT as mentioned above is made to a foreign language PCT utility model application, it shall be deemed to have been made in accordance with the provision of Article 2bis (Utility Model Act Article 48quindecies(1)).

10.3 Relevant Provisions Concerning Special Cases of Prior Art Effect

Patent Act Article 184terdecies

For the purpose of the application of Article 29bis, in the case where another patent application or a utility model registration application as provided in Article 29bis is an International Patent Application or an International utility model registration application under Article 48ter (2) of the Utility Model Act, the term "another patent application or a utility model registration application" under Article 29bis of this Act shall be deemed to be replaced with "another patent application or utility model registration application (excluding a patent application in Foreign Language under Article 184quater (1) or a utility model registration application in foreign language under Article 48quater (1) of the Utility Model Act which has been deemed to have been withdrawn in accordance with Article 184quater (3) of this Act or Article 48quater (3) of the Utility Model Act)," the term "the laying open of the patent application or" shall be deemed to be replaced with "laying open of the patent application," the term "published" shall be deemed to be replaced with "published or where international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970 has been effected," and the term "the description, scope of claims or drawings originally attached to the application" shall be deemed to be replaced with "the description, scope of claims, or drawings of an international application as of the International Application Date under Article 184quater (1) of this Act or Article 48quater (1) of the Utility Model Act."

Utility Model Act Article 48novies

For the purpose of the application of Article 3bis, in the case where another application for a utility model registration or patent application as provided in Article 3bis is an International Utility Model Registration Application or an International Patent Application under Article 184ter (2) of the Patent Act, the term "another application for a utility model registration or for a patent" under Article 3bis shall be deemed to be replaced with "another application for a utility model registration or for a patent (excluding a Utility Model Registration Application

in Foreign Language under Article 48quater (1) of this Act or a Patent Application in Foreign Language under Article 184quater (1) of the Patent Act which has been deemed to have been withdrawn in accordance with Article 48quater (3) of this Act or Article 184quater (3) of the Patent Act," the term "the respective Article or for which" shall be deemed to be replaced with "the respective Article, for which," the term "the publication of the patent application has been effected" shall be deemed to be replaced with "the publication of the patent application has been effected, or international publication under Article 21 of the Patent Cooperation Treaty signed in Washington on June 19, 1970 has been effected," and the term "the description, scope of claims or drawings originally attached to the written application" shall be deemed to be replaced with "the description, scope of claims, or drawings of an international application as of the International Application Date under Article 48quater (1) of this Act or Article 184quater (1) of the Patent Act."

(Explanation)

- (1) Concerning a foreign language PCT application, the prior art effect is produced on the basis of the description, claims or drawings of the international application as of the international filing date, except the foreign language patent application referred to in Article 184quater(1) and the foreign language utility model application referred to in Article 48quater(1) of the Utility Model Act which are considered to have been withdrawn in accordance with the provisions of Article 184quater(3) of the Patent Act or Article 48quater(3) of the Utility Model Act (Patent Act Article 184terdecies and Utility Model Act Article 48novies).
- (2) However, where the foreign language PCT application is an earlier application on which internal priority is based, even if a translation of the earlier application has not been filed, the earlier application shall be considered to have been published with regard to the inventions described in the description, claims or drawings as of the international filing date of the earlier application, among the inventions described in the original description of the later application for which priority is claimed, provided that the later application claiming priority has been laid open or published in the gazette containing the patent. As a result, the earlier application has the prior art effect. (Articles 41(3) and 184quindecies(4))
- (3) If a patent application claiming internal priority is the foreign language PCT patent application, the prior art effect is produced with regard to the inventions described in the description, claims or drawings originally attached to the request for application of the earlier application among the inventions described in the description, claims or drawings of the foreign language PCT patent application as of the international filing date (Articles 41(3) and 184quindecies(3)).

Written Correction of Mistranslation (Sample)

[Document Name] Written Correction of Mistranslation

[Submission Date] September 1, 1995

[Address] To: The Commissioner of the Japan Patent Office

[Indication of the Case]

[Application Number] HEISEI 7 (1995) Patent Application No. 100321

[Applicant]

[Identification Number] 090004324

[Name] Tokkyo Kabusiki Kaisha

[Administrator]

[Identification Number] 190001231

[Patent Attorney]

[Name] Tokkyo Taro

[Correction of Mistranslation 1]

[Title of Document to be Corrected] Description

[Unit to be Corrected] 0003

[Method of Correction] Change

[Content of Correction]

[0003]

An apparatus for charging a cannon, which speedily charges a barrel with powder (hohshin ni kayaku wo sohtensuru) by lightening the weight (keiryoka) of the charging apparatus and by making the rotational response of the charging apparatus capable of following the elevation of the barrel.

[Reasons for Correction, etc.]

(Reason for Correction 1-1)

Concerning the phrase "hohshin ni kayaku wo sohtensuru (charges a barrel with powder)" in Paragraph [0003]:

The phrase of the foreign language document which corresponds to the above-mentioned phrase in the translation is "charge a barrel with powder" in line 3 on page 2 of the foreign language document, and such phrase was translated as "taru ni kona wo sohtensuru (charge a cask with flour)" before the correction of mistranslation. The translation before the correction of mistranslation is a general translation of the above-mentioned English phrase. However, this application relates to the apparatus for charging a cannon, and the word "barrel" means "hohshin (gun barrel)" rather than "taru(barrel/cask)" and the word "powder" means "kayaku (powder/gunpowder)" rather than "kona (powder/flour). Accordingly, taking into consideration the technical meaning of this application, the mistranslation are hereby corrected to translate the above-mentioned phrase as "hohshin ni kayaku wo sohtensuru."

(Material necessary for the explanation of the reason for correction 1-1: "SHOGAKU-KAN RANDOM HOUSE ENGLISH-JAPANESE DICTIONARY," pages 213 and 2020, published on January 20, 1988)

(Reason for Correction 1-2)

Concerning the word "keiryō (lightening the weight)" in Paragraph 0003:

It was translated as "keiryō (measuring)" before the correction of mistranslation. As it is apparent from other descriptions in the description (such as "to lighten the weight" in Paragraph [0002]) that such word "keiryō (measuring)" is an error of "keiryō (lightening the weight)." Therefore, it is a matter to be amended which can also be handled by regular

amendment.

[Indication of Fee]

[Advance Payment Book Number] 012345

[Amount Paid] ¥19000

[List of Documents Filed]

[Title] Material necessary for the explanation of the reason for correction: 1

[Material Necessary for Explanation of the Reason for Correction 1-1]

bar·rel【baerel】n.,v.(-reled.-rel·ing or(特に英)
-relled,-rel·ing)—n. 1(胴のふくれた)たる,ビヤ
だる.2 バレル:1 たるの量;米国で液体は 31 1/2 ガロン,果
実や野菜は 105 乾量クォート,英国では 36 英ガロン.3(話)
多量,たくさん,どっさり(large quantity): —a barrel of
monkeys たくさんのサル.—have a barrel of fun とても
おもしろく過ごす.4 たるに似た形の容器(ケース),円筒[形
のもの]の胴部].5【兵器類】砲身,銃身: —the disman-
tled barrel of the machine pistol 自動ピストルの分解し
た銃身.6【機械】ポンプの筒.7 シャフトの上で動く円筒.8
〔時計〕香箱():時計のゼンマイを入れる歯車つきの箱.9
〔鳥類〕(廢)羽柄(calamus,quill).10(牛・馬などの)
胴体(trunk).11〔海事〕車地(capstan)の胴部.→
capstan(図).12 バレル:回転しながら製品をめっきまた
は研磨する水平のシリンダー.13(一般に)筒形構造の丸
天井,かまぼこ屋根,半円筒ボルト.
over a barrel(俗)窮地に陥って,お手上げで(in an
embarrassing or uncomfortable position);身動きで
きない,にっちもさっちもいかない(unable to act): —They
really had us over a barrel when they foreclosed the
mortgage. 抵当を流されたときは,全く困り果ててしまった.
—v.t.1 たるに入れる,たるに詰める.2(金属部品を)バ
レルで仕上げる,バレル研磨(めっき)する.
—v.i.(俗)高速度で進む(運転する),疾走する(travel
or drive very fast): —barrel along the speedway
高速道路をぶっ飛ばす.
[ME barell <OF baril,?=barre stave(→BAR1)+
-il<L-ile,neut.of -ilis -ILE]

pow·der[paud r]-d]n.1 粉,粉末:—be reduced
to powder 粉末になる,粉々になる.—grind...into(or
to)powder...をひいて粉にする.2 粉末剤;火薬,爆薬
(gunpowder),粉おしろい(face powder),歯みがき粉
(tooth powder)など:—black powder 黒色火薬.—
smokeless powder 無煙火薬.—food for powder 弾丸
のえじき.—powder and shot 弾薬、軍需品.—the smell
of powder 硝煙のにおい,実戦の経験.—smell powder
実戦の経験をする.—digestive powder 粉末消化剤.—
curry powder カレー粉.—a lady in powder and patch
おしろいをしてつけぼくろをした婦人.—with powder and
paint 厚化粧をして.3(また powder snow)【スキー】
粉雪:通例ざらめ雪でない,さらさらした新雪.
Keep one's powder dry (俗)万ーに備える,用意を怠
らない:—Put your trust in God, and keep your pow-
der dry. 神を信頼し,万ーに備えなさい.
not worth powder and shot 骨折りがいがない.

—v.t.1 粉にする,製粉する,粉末にする,粉状にする
(reduce to powder, pulverize):—be powdered
to dust 粉末にされる,粉々になる.

2 粉をふりかける,粉でおおう(Sprinkle or cover with
powder):—She powdered the cookies with confec-
tioners' sugar. クッキーに精製糖をまぶした.—Her face
was powdered with flour.彼女の顔は小麦粉にまみれて
いた.

Origin: "SHOGAKUKAN RANDOM HOUSE ENGLISH-JAPANESE DICTIONARY,"
SHOGAKUKAN INC., pages 213 and 2020, published on January 20, 1988.

Written Correction of Mistranslation (Sample)

[Document Name] Written Correction of Mistranslation
[Submission Date] September 1, 1995
[Address] To: The Commissioner of the Japan Patent Office
[Indication of the Case]
[Application Number] HEISEI 7 (1995) Patent Application No. 100322
[Applicant]

[Identification Number] 090004324

[Name] Tokkyo Kabushiki Kaisha

[Administrator]

[Identification Number] 190001231

[Patent Attorney]

[Name] Tokkyo Taro

[Correction of Mistranslation 1]

[Title of Document to be Corrected] Description

[Unit to be Corrected] 0003

[Method of Correction] Change

[Content of Correction]

[0003]

As has often been the case, oars break due to a collision, etc. during boating practices. Oars are usually purchased in a set for a boat (for examples, eight oars for an "eight" boat). Accordingly, if only one oar breaks, it is necessary to purchase extra oars. As a means for preventing the breakage of oars, it is possible to manufacture oars by using flexible materials. However, it costs too much if all oars are manufactured by using flexible materials. This invention is characterized in that an oar nearest the front (saizenbu no o-ru) which tends to easily break is made resistant to breakage upon collision by adopting flexible materials for the oar nearest the front (saizenbu no o-ru) used for a boat (such as an "eight" boat) rowed by several people.

[Correction of Mistranslation 2]

[Title of Document to be Corrected] Description

[Unit to be Corrected] 0004

[Method of Correction] Change

[Content of Correction]

[0004]

Only a steersman watches ahead of a boat while rowing the boat (sohte). Therefore, in many cases, one person's carelessness has lead to a collision.

[Reasons for Correction, etc.]

(Reason for Correction 1)

Concerning the phrase "saizenbu no o-ru (the oar nearest the front)" in Paragraph

[0003]:

The word of the foreign language document which corresponds to the above-mentioned phrase in the translation is "bow" in line 3 on page 2 of the foreign language document, and such word was translated as "senshu (bow/stem/prow)" before correction of mistranslation. Although it is true that the word "bow" has the meaning of "senshu

(bow/stem/prow)," it also has the meaning of "saizenbu no o-ru (an oar nearest the front)." Taking into consideration that this invention relates to oars of a boat, the above-mentioned word should be translated as "saizenbu no o-ru (front side of an oar). "Therefore, the word "bow" which was mistranslated as "senshu (bow/stem/prow)" is hereby corrected to "saizenbu no o-ru (front side of an oar)."

(Material necessary for the explanation of the reason for correction 1: "SHOGAKUKAN RANDOM HOUSE ENGLISH-JAPANESE DICTIONARY" page 31, published on January 20, 1988)

(Reason for Correction 2)

Concerning the word "sohte (rowing the boat)" in Paragraph [0004]:

The above-mentioned portion was written as "sohte (hypothesis)" before the correction of mistranslation. However, as it is apparent from other descriptions in the description (such as the description of "sohte renshu chu (during boating practices)" in Paragraph [0003]) that the word "sohte (hypothesis)" is an error and should be written as "sohte (rowing the boat)." Therefore, it is a matter to be amended which can also be handled by regular amendment.

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[Material Necessary for Explanation of the Reason for Correction 1]

bow³【bau】n.1[海事][航空](1)(船の)船首,へさ
き;(飛行船の)船首.cf.stern. (2)船首方向:特に遠
い目標物を示すとき船首を基準にその左右 45°以内の方向.
—a mooring two points off the port (starboard)bow
左(右)側船首から 2 ポイントの方向(角度 22°30′)にある係
船柱.2(pl.)[海事]船の最前端の外側;特に船首材か
ら船体の両側に向かってなだらかに広がっていく部分.3 漕
艇最前部のオール.4(また bowman, bow oar)バ
ウ,パウマン:艇首でこぐ人.
bows on (船かある物に)船首を向けて(with the bow
foremost)—The vessel approached us bows on. 船は船首をまっ
すぐに我々に向けて近づいてきた.
bows under(船が)船首に水をかぶって(shipping
water at the bow):—The ship was bows under
during most of the storm.船はほとんど暴風雨の間じ
ゆう船首に水をかぶっていた.
on the bow[海事]船首の方に(左右前方 45°内に).
—adj.船首の,船首にある.
[<LG boog(n.) or D boeg or Dan bov; →BOUGH

Origin: "SHOGAKUKAN RANDOM HOUSE ENGLISH-JAPANESE DICTIONARY,"
SHOGAKUKAN 1NC., page 310, published on January 20, 1988.