

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

(Points to consider)

With regard to applications filed on or before March 31, 2007, among the provisions of this Examination Guidelines (Part IX Procedure of Examination), the provisions in 2(6) of "Section 1 Introduction" and the provisions in 4.2(3), 4.3.3.1(1)e, 6.2.1(2), 6.2.2(2) and (3) of "Section 2 Details," which relate to "Amendment that changes a Special Technical Feature of an Invention" (Article 17bis (4)) shall not apply.

The procedure of examination involving a "notice under Article 50bis" given with regard to applications filed on or after April 1, 2007, shall be as provided in the provisions of "Part V Chapter 1 Section 2 Notice under Article 50bis."

In Part IX, the provisions of Article 17bis (5) and Article 17bis (6) are indicated as those applicable to applications filed on or after April 1, 2007.

## **Section 1 Introduction**

Main Articles related to the examination procedures

Patent Act Article 47 : Examination by examiner

Patent Act Article 49 : Examiner's decision of refusal

Patent Act Article 50 : Notice of reasons for refusal

Patent Act Article 51 : Examiner's decision to the effect that a patent is to be granted

Patent Act Article 52 : Formal requirements for decision

Patent Act Article 53 : Dismissal of amendments

Patent Act Article 162 and 164: Reconsideration by examiner before appeal

### **1. Principle of Examination**

An examiner should conduct a substantive examination on whether an application for a patent should be granted or not. The examiner, therefore, is required to make a fair judgment based on high-level expertise.

Especially, the followings are to be taken note:

- (1) To conduct examination as uniformly as possible in line with guidelines related to the examination, such as "Examination Guidelines", etc., paying due consideration to the promptness, accuracy, fairness and transparency.
- (2) To make an effort to ensure and improve the quality of examination with respect to prior art search and judgment on the requirements for patentability. The prior art search and the judgment on patentability should be made taking into consideration of complexity and advancement of the technology by fully utilizing expertise accumulated in each examiner.
- (3) To perform efficient examination in sufficiently communicating with an applicant or the attorney (hereinafter, simply referred to as "an applicant").

## 2. Outline of Examination Procedures

The examination procedures are summarized as follows. For the detailed procedures, “see Section 2 Details.” Figure 1 shows the flow chart of the substantive examination of a patent.

(1) Understanding and finding of the invention (→Section 2, 1)

The examination starts by finding a claimed invention of an application concerned. After reading the description carefully and understanding the content of an invention sufficiently, the examiner should find the claimed invention based on the writing of the claims.

(2) Selection of the Subject of Search (→Section 2, 2.1)

Following the recognition of the invention claimed in the application concerned, the examiner shall consider the requirements of unity of invention (Article 37). At the same time, the examiner shall consider the requirements for the description and claims (Article 36), thereby selecting inventions as the subject of a prior art search.

(3) Prior art search (search concerning novelty, inventive step and senior or junior of applications) (→Section 2, 2.2 to 2.3)

The examiner shall conduct a prior art search targeting the claimed inventions selected as the subject of the search, in terms of novelty, inventive step and seniority of applications (Articles 29, 29bis and 39). Where the applicant discloses the information on relevant prior art documents in the description attached to the application concerned or the search report prepared by a search agency (including a foreign patent office) indicates relevant prior art documents, the examiner shall first examine these documents.

(4) Examination of requirements for patentability in terms of novelty, inventive step, etc. (→Section 2, 3.)

Novelty, inventive step, etc. of the claimed invention that was decided as the subject of the search in (2) should be examined, based on the search results.

(5) Notice of reasons for refusal (→Section 2, 4.)

The examiner should notify an applicant of a notice of reasons for refusal when finding reasons for refusal as the results of examination (Patent Act 50). Reasons for refusal should be stated as clearly and simply as possible so as to make it easy for an applicant to understand it. Judgment should be clearly stated by every claim.

(6) Where a written opinion and a written amendment are submitted (→Section 2, 4.)

Upon receiving a written amendment, the examiner shall check the legality of the amendment made by means of the written amendment. (Whether, in comparison with the description, claims or drawings attached to the application initially filed, the amendment adds any new matters or contains an invention that change a special technical feature.) (See “Part III Amendment of Specification, Claims and Drawings”). Then, by fully examining the contents of the written opinion and the written amendment, the examiner shall determine whether the reason for refusal stated in the notice has been overcome.

Where the reasons for refusal were resolved but other new reasons for refusal were found, the examiner should notify the applicant of reasons for refusal after judging whether it should be set to “the final notice of reasons for refusal” or not.

(7) Final decision (→Section 2, 7.)

Where no reasons for refusal are found, decision to grant a patent should be made (Patent Act Article 51).

Where the notified reasons for refusal were deemed not to be resolved in consideration of the written opinion and amendment, an examiner should decide on refusal, as well as dismissal of the amendment if required (Patent Act Article 49). In decision of refusal, all unresolved reasons for refusal should be indicated, and the examiner should describe them clearly and simply so that the applicant can easily understand the claims for which the notified reasons for refusal were still unresolved.

(8) Reconsideration by examiner before appeal (→Section 2, 8.)

Where an amendment is made in the demand for appeal and reconsideration by an examiner before the appeal is referred, the examiner should reconsider the application before the appeal (Patent Act Article 162).

In reconsideration by an examiner before the appeal, after judging whether the amendment made in the demand for appeal contravenes the provisions of Patent Act Article 17bis (3) to (6) or not, the examiner should examine whether the reasons for refusal of the original decision were resolved or not.

Where the reasons of refusal of the original decision were resolved and other reasons for refusal are not found as results of the examination, the examiner should annul the original decision and make a decision to grant a patent. When the examiner cannot decide to grant a patent, the results of examination should be reported to the Commissioner of the Patent Office.

## **Section 2: Details**

### **1. Understanding of Invention**

As the premises for examining presence/absence of the patentability in terms of novelty, inventive step etc., the technical content of a claimed invention should be understood and established. This work is called finding of a claimed invention. Finding of a claimed invention should be performed, based on the description of claims. In interpreting the meaning of the terms described in claims, descriptions and drawings should be considered.

Reference:

In the process of finding the gist of an invention, it is necessary to look through the detailed description of the invention and drawings in order to clarify the technical content related to the invention. However, at the stage where finding the technical matters, which are the gist of invention, after understanding of the technical content, any constituent elements described only in the detailed description of the invention or drawings should not be added beyond the description of claims." ("Finding of the gist of an invention related to an application of a patent", High Court Reporter, Civil Affairs, 1991, p.35)

### **2. Prior Art Search**

An examiner should search prior art, paying attention to the provisions of the Examination Guidelines on novelty, inventive step and senior and junior applications (Patent Act Article 29, 29bis, 39) (see "Part II Chapter 2-4"), and thoroughly find relevant prior art.

#### **2.1 Subject of Search**

##### **(1) Selection of the subject of search**

Among all inventions set forth in the claims, the invention first mentioned in the claims and any other inventions that meet the requirements of unity with that invention shall be selected as the subject of search. Where the invention first mentioned in the claims lacks a special technical feature, the subject of the examination will be selected as the subject of the search in accordance with the provisions of "4.2 Subject of Examination Where the Invention First Mentioned in the Claims Does Not Have Any Special Technical Feature" ("Part I Chapter 2 Requirements of Unity of Invention"), without considering whether the requirements of unity of invention are met.

##### **(2) Items to be considered when deciding subject of search**

- ① Embodiments of the claimed invention should be taken into consideration in deciding a subject of prior art search.
- ② When considered to contribute to a prompt and precise examination, matters reasonably expected to be added to claims after an amendment, unless the burden is extremely increased, may be set to a subject of prior art search.

(3) Invention that may be excluded from a subject of search

The following inventions may be excluded from a subject of prior art search:

- ① Invention to which new matters have been clearly added (violation of the requirements of Patent Act Article 17bis (3))
- ② Invention directed to a category of unpatentable invention (violation of the requirements of Patent Act Article 32)
- ③ Invention clearly not falling under the invention defined in Patent Act Article 2 or invention clearly not industrially applicable (violation of the requirements of Patent Act Article 29(1) main paragraph)
- ④ In case where the description of claims are so ambiguous that the invention cannot be conceived even by taking into consideration of the detailed description of the invention and drawings (violation of the requirements of Patent Act Article 36 (6)(ii))
- ⑤ In case where the claimed invention of which detailed description is too unclear or insufficient for a person skilled in the art to carry out, the parts where description is too unclear or insufficient for a person skilled in the art to carry out (violation of the requirements of Patent Act Article 36 (4)(i))
- ⑥ In case where the claimed invention is beyond the scope of description in the detailed description of the invention within which a person skilled in the art can recognize that the problem of the invention can be solved, the parts that is “beyond the scope of description” (violation of Patent Act Article 36(6)(i))

## 2.2 Search Strategy

(1) Remarks before search

- ① Where information on prior art documents related to the detailed description of the invention was disclosed, the content of prior art documents should be examined prior to search.  
With regard to the requirements for disclosure of information on prior art documents (Patent Act Article 36 (4) (ii)), please see “Part I Chapter 3 Requirements for disclosure of information on prior art document”.
- ② Where prior art search relating to the application was conducted in advance by search agencies (including foreign patent offices), the content of search results should be considered and utilized for an examination.

(2) Methods of search

- ① Among all documents falling in the technical fields to which the claimed inventions pertain, the examiner shall, because of reasons of economy, search a certain range of documents in which the examiner, based on his knowledge and experience, considers it highly probable to find relevant prior art documents.
- ② Where the examiner uses the search results provided by a search agency (including a foreign patent office), and, based on his knowledge and experience, considers it possible to conduct an examination precisely and efficiently by using such search

results, the examiner is not required to conduct a prior art search himself. Where the examiner conducts an additional prior art search, the scope already searched by the search agency shall be excluded from the scope of the additional search unless it is considered highly probable to find more significant prior art documents in the scope already searched by the search agency. (For the use of prior art search results and examination results provided by foreign patent offices in the procedure for examination of overseas-related applications, see “(Attachment) Guidelines for the Use of Prior Art Search Results and Examination Results Provided by Foreign Patent Offices.”)

- ③ The examiner shall first search the technical fields in which it is most probable to find relevant prior art documents. In general, it is appropriate for a examiner to start the prior art search from the most closely relevant technical fields to the embodiments disclosed in the detailed description of the invention, and gradually extends to less relevant fields.
- ④ Whether to extend the search from highly relevant technical fields to less relevant fields should be determined by considering the obtained search results. That is to say, where adequate prior art for reasonably denying novelty or inventive step could not be found as the results of the search of the highly relevant fields, the scope of search should be extended if probability of finding prior art documents denying novelty or inventive step is high by search of less relevant fields.
- ⑤ Search results should be evaluated as needed, and the subjects of search are reviewed if required. In particular, it may be clarified during the prior art search that what was considered to be a “special technical feature” at the beginning of search does not indicate contribution to the prior art, which may not meet the requirements for unity of invention a posteriori. In this case, in accordance with the provisions of “Part I Chapter 2 Requirements of Unity of Invention; 4. Procedure of Examination,” any inventions excluded from the subject of the examination shall be excluded from the subject of the search.

(3) Completion of search

- ① When a document denying by itself novelty of the claimed invention and the embodiment of the invention disclosed in the detailed description of the invention is found, the prior art search for the claim may be completed.  
However, in cases where other embodiments can be searched without any excessive burden, it is desirable to continue a further search.
- ② When highly relevant prior art documents have been sufficiently obtained, or when the possibility of discovering further relevant prior art becomes very low, the prior art search may also be stopped (see Note).

**(Note)** Where the claim of a chemical substance expressed by Markush form is unduly wide and has various embodiments, and the searching all of the subjects of search is extremely difficult without accompanying excessive search burden, the search can be ended without further searching, only if it falls under the following (i) or (ii) on assumption that all search of the scope which do not require the excessive

search burden have been completed.

In this case, the report of finishing the search without searching all of the subjects of the search and the searched scope should be indicated in a “record of the result of prior art search”.

(i) As to at least one of the chemical substance groups expressed by alternatives disclosed in claims including the chemical substances disclosed as embodiments (a group of chemical substances expressed by specified alternatives corresponding to embodiments), at least one prior art document denying its novelty etc. has been found.

(ii) All chemical substance groups expressed by specified alternatives corresponding to the aforementioned embodiments have already been searched, and at least one prior art denying novelty etc. of the claimed invention has been found by the search of the chemical substance groups expressed by those other than the aforementioned alternatives.

### **2.3 Record of Search Results**

When notifying a notice of reasons for refusal after the first prior art search, the searched field (expressed by the IPC etc.) should be entered in the “record of the result of prior art search”.

In addition, where there is prior art that does not constitute the reasons for refusal but is considered to be useful for an applicant in amending, information on the documents can be recorded together.

### **3. Examination of Prior Art Documents etc.**

Whether the content of prior art documents constitutes the reasons for refusal on novelty, inventive step etc. of the claimed invention should be examined as follows:

(1) Confirmation of bibliographic items of prior art documents etc.

The dates of publication of prior art documents etc. are very important to constitute the reasons for refusal. The relationship between the date of publication and the filing date (or the priority date) should be certainly confirmed for each prior art document. (see Novelty and Inventive Step in Chap. 2, Part II).

In addition, when considering application of Patent Act Article 29bis or 39, a filing date, an inventor and an applicant should be confirmed.

(2) Understanding of content of prior art documents etc.

The examiner should read carefully prior art documents and understand the prior art sufficiently. In this case, the examiner;

- ① should not understand the content of prior art documents with unreasonable interpretation obsessed by the claimed invention to bring them to the claimed invention;
- ② should not judge the whole content of the prior art document from its partial description and should not assume and determine the content of the prior art document without rational evidence;

- ③ should judge the content of the invention described in the prior art document not only by their structure but also from the viewpoints of problems to be solved, technical fields etc.

(3) Selection of cited invention, comparison with claimed invention and judgment

In considering the reasons for refusal regarding novelty, inventive step etc, comparison between the cited invention and the claimed invention should be conducted as follows:

- ① In choosing the relevant prior art to be cited in a notice of reasons for refusal among the prior art described in the prior art documents already found, the optimum relevant prior art (a principle cited invention) should be selected with due consideration of embodiments.

As the principle cited invention, an invention of which technical field or problem to be solved is the same as or close to that of the claimed invention, should be selected. Where their technical field or problems to be solved are different, the reason why the relevant invention is used as a principle cited invention should be taken into consideration.

- ② Identical features and differences should be clarified by comparison of the claimed invention with the principle cited invention. Where there are no differences, the novelty of the claimed invention should be denied, but where there are differences, the inventive step of the claimed invention should be examined (see Novelty and Inventive Step, Chap. 2, Part II).

- ③ The examiner should examine inventive step of the claimed invention by determining whether a person skilled in the art would have been able to easily make the invention, based on the content of the principle cited invention and other cited inventions (including well-known art and commonly used art), and common general technical knowledge (see Novelty and Inventive Step, Chap.2, Part II).

#### **4. Notice of Reasons for Refusal**

The Patent Act stipulates that the examiner, before the decision of refusal, should notify an applicant of the reasons for refusal and give him/her an opportunity for submission of a written opinion, with specifying a reasonable period (Patent Act Article 50).

It is unfair for an applicant that an examiner decides to refuse without giving him/her any opportunities for defense even when the examiner is convinced of reasons for refusal. Moreover, it's not beyond the realm of possibility that an examiner makes a mistake. Under these circumstances, this provision aims at the fair and appropriate operation of the procedures of an application for a patent, giving the applicant an opportunity for offering an opinion, as well as resolving the reasons for refusal by amendment of a description etc., and also giving the examiner an opportunity for reconsidering with a written opinion. (Please refer to Precedent of Tokyo High Court, Mar. 30, 1993, Hei3 (Gyo Ke) No.199).

#### **4.1 Types of Notice of Reasons for Refusal**

Notices of reasons for refusal fall into two types in view of procedure. One is a notice of reasons for refusal to be notified to an applicant for the first time (hereinafter, referred to as “the first notice of the reasons for refusal,” Patent Act Article 17bis (1)(i)), and the other is the last notice of reasons for refusal received in a case where another notice of reasons for refusal was received after receiving the previous notice of reasons for refusal (hereinafter, referred to as “the final notice of reasons for refusal,” Patent Act Article 17bis (1)(iii)).

After “the final notice of reasons for refusal” was served, amendable scope of the claims shall be subjected to the restriction (Patent Act Article 17bis (5)(6)). Where a notice under Article 50bis is given along with a notice of reason for refusal, the same restriction shall be applied to the amendments to be made to the claims (see Part V Chapter 1 “Section2 Notice under Article 50bis”).

(Explanation: The purport of the system of “the final notice of reasons for refusal” and the restriction of amendments against it)

If claims can be freely changed whenever a notice of reasons for refusal is received, the examination can be restarted on each occasion, not only causing a delay of the examination but also giving difficulty to secure duly fairness between applications with appropriate amendment and those without it.

Therefore, where another notice of reasons for refusal was received after having already received a notice of reasons for refusal, the content of amendments in response to “the final notice of reasons for refusal” should be limited to the scope in which the results of the examination that has been already completed can be effectively used in order to carry out a prompt examination, securing the fairness among applications.

(1) “The first notice of the reasons for refusal”

The first-time notice of the reasons for refusal is “the first notice of the reasons for refusal.” Even when an examiner notifies the reasons for refusal on the second time or more, if the reasons for refusal are not necessitated by amendments made in response to the previous notice of reasons for refusal, “the first notice of the reasons for refusal” shall be notified.

(2) “The final notice of reasons for refusal”

“The final notice of reasons for refusal” notifies only the reasons for refusal necessitated by an amendment made in response to “the first notice of reasons for refusal” in principle.

Whether the second or later notice of reasons for refusal should be “the final notice of reasons for refusal” or not should be substantively judged, not by the ritual number of notifications.

In addition, whether a notice should be set to “the first notice of reasons for refusal” or “the final notice of reasons for refusal” is decided by the following 4.3.3.

#### **4.2 Remarks When Notifying Notice of Reasons for Refusal**

Reasons for refusal should concretely be described in a notice of reasons for refusal so that an applicant can understand clearly its purport. In addition, the reasons for refusal should be clear for a third party because the reasons for refusal and the response of the

applicant will be important data not only in procedures at the Patent Office but also in determination of the technical scope of a patented invention.

Practically, the reasons for refusal should be notified, considering the following points;

(1) Reasons for refusal should be stated clearly and simply with points so as to make it easy for an applicant to understand.

(2) Reasons for refusal of lack of novelty, inventive step, etc. should be indicated on a claim by claim basis excluding reasons for refusal that cannot be judged by each claim (deficiency of the whole description, addition of new matters etc.), and distinction between claims which have reasons for refusal and the claims which do not have reasons for refusal should be clearly made. In this case, with regard to claims on which explanations of comparison, judgment, etc. in the reasons for refusal are common, they can be stated together.

(3) With regard to the inventions excluded from the subject of the examination in accordance with the provisions in "Part I Chapter 2 Requirements of Unity of Invention" (violation of Article 37) and the amended inventions excluded from the subject of the examination in accordance with the provisions in "Part III Section II Amendment that Changes a Special Technical Feature of an Invention" (violation of Article 17bis(4)), the examiner shall give a notice to indicate only the relevant reason for refusal, while clearly stating that no examination has been conducted with regard to the requirements other than those concerning Article 37 or Article 17bis(4).

(4) In the following cases, the examiner may also give a notice to indicate only the relevant reason for refusal, while clearly stating that no examination has been conducted with regard to other patentability requirements such as novelty or inventive step.

- ① Invention to which new matters have been clearly added (violation of the requirements of Patent Act Article 17bis (3))
- ② Invention directed to a category of unpatentable invention (violation of the requirements of Patent Act Article 32)
- ③ Invention clearly not falling under the invention defined in Patent Act Article 2 or invention clearly not industrially applicable (violation of the requirements of Patent Act Article 29(1) main paragraph)
- ④ In case where the description of claims are so ambiguous that the invention cannot be conceived even by taking into consideration of the detailed description of the invention and drawings (violation of the requirements of Patent Act Article 36 (6)(ii))
- ⑤ In case where the claimed invention of which detailed description is too unclear or insufficient for a person skilled in the art to carry out, the parts where description is too unclear or insufficient for a person skilled in the art to carry out (violation of the requirements of Patent Act Article 36 (4)(i))
- ⑥ In case where the claimed invention is beyond the scope of description in the detailed description of the invention within which a person skilled in the art can recognize that the problem of the invention can be solved, the parts that "beyond the scope of description" (violation of Patent Act Article 36(6)(i))

(5) Where a description, claims and drawings are violating the provisions of Patent Act Article 36(4)(i) or (6), the deficient parts and the reasons for deficiency should be concretely indicated.

- (6) For citation of prior art documents, the following matters should be noted;
- ① Cited documents should be specified and the cited parts required for comparison with the claimed invention and judgment should be specified.
  - ② The technical contents found in the cited documents etc. should be clarified.
  - ③ Necessary and sufficient documents for constituting the reasons for refusal should be cited and too many documents should not be cited unnecessarily.

#### **4.3 Detailed Practices**

In principle, examination should be made as to all of the reasons for refusal on the occasion of notifying the first notice of reasons for refusal. Reasons for refusal should not be notified more than two times, and the examination should be carried out, with effectiveness of the whole procedure considered.

##### **4.3.1 First Notice of Reasons for Refusal**

(1) The first-time notice of the reasons for refusal is set to “the first notice of reasons for refusal.”

(2) In principle, all of the reasons for refusal which have been found should be notified on the occasion of notifying the notice of reasons for refusal for the first time.

However, where it is clear that other reasons for refusal will be resolved if one reason for refusal is resolved, multiple reasons for refusal should not be always notified redundantly.

(3) In drafting the first notice of reasons for refusal, the examiner should make an effort to notify the reasons for refusal required for the applicant to amend for obtaining the patent, without sticking to trivial matters.

(4) The reasons for refusal should be notified, considering the items shown in 4.2.

##### **4.3.2 Examination of Written Opinion or Amendment in Response to the First Notice of Reasons for Refusal**

When written opinion or amendment is submitted in response to the first notice of reasons for refusal, the examiner should examine as follows:

(1) Examination of the content of a written opinion, amendment etc.

The examiner should examine the content of a written opinion, amendment, etc. and judge whether the previous reasons for refusal was resolved or not.

In particular, where only a written opinion was submitted without amendment in response to the notice of refusal, the examiner should consider sufficiently the content of the written opinion and examine whether the reasons for refusal indicated in the notice of reasons for refusal can be resolved or not.

(2) Handling of amendment

Where an amendment was submitted in response to the first notice of reasons for refusal, the examiner should accept and examine it based on the description, claims, drawings etc. as amended.

(3) Handling of written opinions, reports of experiment results, etc.

Written opinions and reports of experiment results submitted in response to the notice of reasons for refusal can not substitute for the detailed description of the invention in the description, but if the applicant argue and prove thereby that the matters disclosed in the description or drawings as originally filed are correct and proper, the examiner should take into consideration of these particulars.

### **4.3.3 Second or Later Notice of Reasons for Refusal**

For the second or later notice of reasons for refusal, the examiner should notify the applicant of the reasons for refusal after judging whether it should be set to “the final notice of reasons for refusal” or “the first notice of reasons for refusal.”

#### **4.3.3.1 Cases where “The Final Notice of Reasons for Refusal” should be notified**

Notice of reasons for refusal notifying only the reasons for refusal necessitated by amendments made in response to the first notice of reasons for refusal is set to “the final notice of reasons for refusal”.

(1) A type of the notice of reasons for refusal necessitated by amendments

- ① Reasons for refusal necessitated by amendments as to the description, claims or drawings made by an applicant in response to “the first notice of reasons for refusal.”

(Practical examples)

- a. Where the detailed description of the invention becomes obscure or new matters were added to the detailed description of the invention by amendments.
  - b. Where new reasons for refusal in terms of lack of novelty, inventive step, etc. were notified as to the examined claims to which other technical matters were added by amendments or of which technical matters were deleted or limited by amendments.
  - c. Where new reasons for refusal in terms of lack of novelty, inventive step, etc. were notified by amendment adding new claims
  - d. Where the amendment adds a new matter to the claims or causes deficiency in descriptions
  - e. Where the amendment changes a special technical feature of the invention
  - f. Where the amendment results in the failure to meet the requirements of unity (applicable only to the applications filed on or before March 31, 2007)
- ② Reasons for refusal related to the claims requiring examination of the requirements for patentability in terms of novelty, inventive step, etc. as a result of amendment in response to “the first notice of reasons for refusal”

(Explanation)

Where the claims that had not been examined on the requirements for patentability in terms of novelty, inventive step, etc. (limited to the case where it is clearly expressed in the notice that the requirements for patentability in terms of novelty, inventive step, etc. have not been examined) were amended and the reasons for refusal related to the requirements for patentability in terms of novelty, inventive step, etc. is notified to the amended claims, the notice should be notified as “the final notice of reasons for refusal” because this case is substantially the same as newly starting examination on added claims by amendments.

(Practical examples)

- a. Where reasons for refusal in terms of lack of novelty, inventive step, etc. are found as to the amended claim which was not examined on the requirements for patentability such as novelty, inventive step, etc. because the writing of the claim was too obscure to understand even if the description and the drawings were taken into account.
- b. Where reasons for refusal in terms of lack of novelty, inventive step, etc. are found as to the amended claim for which only the reason for refusal of adding new matters was notified without examining on the requirements for patentability in terms of novelty and inventive step because the claim before amendment was clearly added new matter.

(2) Special cases where “the final notice of reasons for refusal” should be notified

- ① Where there was a very minor deficiency in the description (e.g., the deficiency in the description deemed to fall under the correction of error or clarification of an ambiguous description under 17bis (5)(iii) and (iv)) along with the reasons for refusal not meeting the requirements of patentability in terms of novelty, inventive step, etc. but only the reasons for refusal related to novelty or inventive step of the claims were notified and reasons for refusal related to the requirements for the description were not notified, if there still exists a very minor deficiency in the description, the reasons for refusal on the deficiency in the description should be notified as “the final notice of reasons for refusal”.

(Explanation)

Minor deficiency in the description is, in general, expected to be amended together with the amendment in response to the reasons for refusal related to novelty, inventive step, etc.. In addition, since the amendments of the description deemed to fall under “correction of error” or “clarification of an ambiguous description” in Patent Act Article 17bis (5)(iii) and (iv) can be accepted as amendments after “the final notice of reasons for refusal,” even though the deficiency in the description was not amended, that would be indicated in “the final notice of reasons for refusal”.

- ② Where new reasons for refusal is found based on a new prior art document as to the claims for which the prior art search was finished according to the 2.2(3)② (see, Note) after the reason for refusal was negated by amendments, “the final notice of reasons for refusal” should be notified in principle.

#### **4.3.3.2 Cases where “The First Notice of Reasons for Refusal” should be notified even though it is the Second or Later One**

Where the second or later notice of reasons for refusal notifies the reasons that should have been indicated by the examiner when the first notice of reasons for refusal was made, it should be notified as “the first notice of reasons for refusal” because reexamination was not necessitated by amendment.

Therefore, in the event of either of the following (1) or (2), “the first notice of reasons for refusal” should be notified.

(1) The reasons for refusal which could not be found when the first notice of reasons for refusal was made though they should have been indicated by the examiner at that time

(Practical examples)

- a. Where the examiner overlooked reasons for refusal, such as deficiency in the description of the description or lack of the unity of invention when notifying the reasons for refusal in terms of novelty and inventive step in the first notice of reasons for refusal, and the reasons for refusal are found after that.
- b. Where reasons for refusal are found as to the claims for which it was clearly indicated that reasons for refusal were not found in the first notice of reasons for refusal, in spite of being not amended or being restricted by amendment.
- c. Where an examination on the requirements for patentability in terms of novelty, inventive step, etc. was not made in the first notice of reasons for refusal even though there is no reasonable reason not to perform the examination on the requirements(see, 4.2(4) ①to⑦), and reasons for refusal related to the requirements are notified in the second notice of reasons for refusal.

(2) Where an appropriate reasons for refusal are notified again because the reasons for refusal indicated in the first notice of reasons for refusal were inappropriate.

(Practical examples)

- a. Where reasons for refusal are notified again after no amendment was made in response to the first notice of reasons and only a written opinion was submitted.
- b. The reasons for refusal in terms of novelty and inventive step, etc. were notified by referring to a prior art document in the first notice of reasons for refusal and an amendment against it was made. In this case, the reasons for refusal should be notified using other new prior art document on a claim which was not amended, where it is discovered that the previous reason for refusal on the claim was not appropriate after taking the written opinion into account.
- c. When reasons for refusal related to lack of novelty and inventive step were notified to the invention consisting of A and B, an amendment was made for A but not for B. In this case, where examiner notify the reasons for refusal again changing the prior art documents cited for B (however, except for the cases in which the content of B was substantially changed by the amendment of A).

#### **4.3.3.3. Remarks Related to “The Final Notice of Reasons for Refusal”**

(1) Where the reasons for refusal necessitated by the amendment in response to the notice of reasons for refusal and other reasons for refusal are simultaneously notified, this should be “the first notice of reasons for refusal.”

(2) Where the case is not fallen into practical examples shown in 4.3.3.1, 4.3.3.2 and whether the notice should be “the final notice of reasons for refusal” or “the first notice of reasons for refusal” is not clear, returning the purport of the system and judge so that the applicant’s opportunity of amendment may not be unreasonably limited.

(3) Indication of “the final” and the reasons for setting it to be “the final notice of reasons for refusal” should be described in the notice of reasons for refusal. Where the examiner did not describe the indication of “the final,” it should not be regarded as “the final notice of reasons for refusal” even if it could have been “the final.”

#### **4.4 Securing of Communication with Applicant**

(1) In a notice of reasons for refusal, the examiner can suggest amendment or division, etc. if it enables applicants to easily respond to the reasons for refusal and thus contributes prompt and precise examination. However, this suggestion makes no legal effects. Amendment, division, etc. should be made by the intention and responsibility of the applicant.

(2) Technical explanation or interview is the supplementary means for securing communication with the applicant. Where it is considered to contribute to the prompt and precise examination, communication with the applicant through an interview, telephone or facsimile should be used. An interview etc. should be performed based on the “Interview Guideline,” and in order to secure transparency in an interview procedure, the examiner should keep a interview record or a response record and contribute to benefit for the access of the public.

(3) The continuity of examination should be ensured after the examiner in charge was changed. If the new examiner intends to determine differently from the previous examiner, the new examiner should communicate with the applicant so that the applicant may not be blindsided.

### **5. Requirement of Submission of Documents and Other Articles Required for Examination**

Based on the provision in Patent Act Article 194 (1), the examiner can request the applicant for submission of documents and other articles (hereinafter referred to documents etc.) required for the examination.

#### **5.1 Documents of which Submission can be Requested**

Under Article 194(1), the examiner may request that the applicant submit the following documents for instance.

(1) Where, in the process of recognizing the claimed invention, it is difficult to understand the invention because the technical contents of the invention are difficult, the quantity of the specification is enormous or the number of claims is too high: documents that explain which matters defining the invention stated in a claim (respective parts of constituents of the invention) correspond to which parts of the working example or documents that explain concisely the purport of the invention, or drawings that show the relevance between the claims

(2) Where it is difficult to understand the applicant's assertion stated in the written opinion submitted after the notice of reason for refusal, and that assertion seems to have material impact on the examination results: documents that clearly explain the applicant's assertion stated in the written opinion

(3) Where it is impossible to verify the operation or effect of the invention in the description without using models, samples or experiment reports (hereinafter referred to as "samples, etc."), and it is possible to use such samples, etc. to confirm that the descriptions or drawings as originally filed are clear and sufficient: such samples, etc.

(4) Where it is not easy to determine whether the divisional application meets the substantial requirements for division of application, or where it takes a considerable amount of time to determine whether or not the invention claimed in the divisional application is identical to the invention claimed in the original application or to the invention claimed in another divisional application: documents that indicate which part of the descriptions, etc. attached to the original application has been altered or which matters described in the description, claims or drawings as originally filed provide the basis for the invention claimed in the divisional application, or documents that explain that the invention claimed in the divisional application is not identical to the invention claimed in the original application or to the invention claimed in another divisional application

## **5.2 Remarks**

(1) When demanding submission of documents etc. based on Patent Act Article 194(1), the examiner should notify the applicant, showing concretely the type of documents to be submitted, after setting the submission period.

However, the examiner can also demand submission of documents etc., in the form of a supplementary note to the notice of reasons for refusal (For example, reasons for refusal to the effect that "since the actions, effects, etc. described in the description cannot be confirmed, the detailed description of the invention is not clear and sufficient enough for a person skilled in the art to carry out the claimed invention" can be notified with a note to the effect that "if the actions and effects can be confirmed by submission of models etc., it negates the reason for refusal").

(2) It should be noted that the submitted documents are only references for examination and cannot replace descriptions or drawings.

## **6. Examination when Amendment was made in Response to “The Final Notice of Reasons for Refusal”**

Where amendment was made in response to “the final notice of reasons for refusal”, after confirming appropriateness of setting the notice to “the final notice of reasons for refusal”, the examiner judges whether the amendment is made legally based on the provisions of Patent Act Article 17bis (3) to (6). Amendments that are not made legally should be subjects to dismissal (Patent Act Article 53).

Figure 2 shows the procedures of examination when amendment was made in response to “the final notice of reasons for refusal”.

### **6.1 Examination of Appropriateness of Decision of “The Final Notice of Reasons for Refusal”**

At first, the examiner should review whether it was appropriate to set it to “the final notice of reasons for refusal”, considering the assertion of the applicant in the written opinion etc.

(1) Where it was appropriate to set it to “the final notice of reasons for refusal”

Where it was appropriate to set it to “the final notice of reasons for refusal”, the examiner should judge whether the amendment is made legally or not (see, 6.2).

(2) Where it was inappropriate to set it to “the final notice of reasons for refusal”

Where it was inappropriate to notify “the final notice of reasons for refusal”, the examiner cannot apply Patent Act Article 53. Therefore the examiner can not dismiss the amendment and accept it. And even if the reasons for refusal were not resolved by the amendment, “the first notice of reasons for refusal,” not prompt decision of refusal, should be notified again. In addition, even where only reasons for refusal necessitated by the amendment are notified, the examiner should set it to “the first notice of reasons for refusal”, not to “the final notice of reasons for refusal”.

(Points of consider)

However, where the applicant asserts that it should have been “the first notice of reasons for refusal” and has made amendment on the basis of that assertion, the relevant reasons for refusal should be regarded as “the first notice of reasons for refusal.” Therefore, where the reasons for refusal were not resolved, decision of refusal should be made, and where only the reasons for refusal necessitated by amendment are to be notified, the notice should be set to “the final notice of reasons for refusal”.

### **6.2 Examination of Amendment**

Where it was appropriate to set it to “the final notice of reasons for refusal”, the examiner should examine whether the amendment in response to the notice contravenes Patent Act Article 17bis (3) to (6) or not. And where it contravenes these provisions, the relevant amendment should be dismissed by decision (Patent Act Article 53).

### 6.2.1 Amendment to be dismissed

(1) Amendment that adds new matters (violation of the requirements of Patent Act Article 17bis (3))

Amendment in response to “the final notice of reasons for refusal”, and

- ① amendment adding new matters
- ② amendment including new matters indicated in “the final notice of reasons for refusal”.

(Points of consider)

Where new matters which existed when notifying “the final notice of reasons for refusal”, but no reasons for refusal were indicated thereto, are maintained without being deleted as amended, the examiner should accept the amendment without dismissal and notify the reasons for refusal on the ground of adding the new matters.

(2) Amendment that changes a special technical feature of an invention (violation of Article 17bis (4))

An amendment made in response to “the final notice of reason for refusal,” which:

- ① adds an “invention that changes a special technical feature” (excluding the inventions subject to the examination as to the patentability requirements (novelty, inventive step) in accordance with the provisions in 4.3 of “Part III Section II Amendment that Changes a Special Technical Feature of an Invention” (the same shall apply hereinafter); or
- ② contains an “invention that changes a special technical feature,” which is pointed out in “the final notice of reason for refusal.”

(Points to consider)

Consider an example where an amendment made in response to the first notice of reason for refusal contained an “invention that changes a special technical feature” but the examiner failed to give a notice of reason for refusal with regard to such invention. Even if the claims amended in response to “the final notice of reason for refusal” includes the “invention that changes a special technical feature,” the examiner will not dismiss the amendment but accept it, and shall give a notice of reason for refusal to indicate that the amendment is made to change a special technical feature of the invention.

(3) Amendment other than the purpose (violation of the requirements of Patent Act Article 17bis (5))

Amendment of claims that does not intend the followings (Patent Act Article 17bis (5) each item)

- a. Deletion of the claim (Patent Act Article 17bis (5)(i))
- b. Restriction of the claims (only the restriction of all or some of the matters necessary to define the claimed invention and the industrial applicability and the problem to be solved of the claimed invention after amendment are the same as those of the claimed invention prior to the amendment. Hereinafter simply referred to as

- “restriction of claims” (Article 17bis (5)(ii))
- c. Correction of errors in the description (Article 17bis (5)(iii))
  - d. Clarification of an ambiguous description (only the amendment with respect to the matters mentioned in the reasons for refusal (Article 17bis (5)(iv))

(Points of consider)

Since the provisions of Patent Act Article 17bis (5) are provided, from the viewpoints of realization of the prompt grant of a right and fairness among applications, so that the examination results already obtained can be effectively used for the purpose of establishing the examination procedures, the amendment contravening the provision do not bring substantial deficiency that may invalidate the patent. Therefore, this provision is not provided as the ground invalidation.

Therefore, in applying the provision of 17bis (5), the examiner should not implement it more strictly than necessary to such an invention as is deemed worth a protection in a case where an examination can be promptly performed by effectively using the examination results already obtained.

- (4) Amendment that does not satisfy requirements for independent patentability (violation of the requirements of Patent Act Article 17bis (6))

The amendment falls under this category is the amendment for the restriction of claims after which the invention cannot be patented independently.

Provisions applied to judging whether the claimed invention which was amended to restrict the claim can be independently patented at the time of filing should be limited to the followings.

Article 29, Article 29bis, Article 32, Article 36(4)(i) or (6) (excluding (iv)), Article 39(1) to (4)

(Points of concern)

Where the requirements of independent patentability is not satisfied;

- (i) Where the reasons for refusal based on the above provisions indicated in “the final notice of reasons for refusal” are still unresolved even by the amendment of the restriction of claims;
- (ii) Where the reasons for refusal indicated with respect to the claims prior to the amendment were resolved by the amendment of the restriction of claims, however, new reasons for refusal under the above provisions with respect to the invention as amended were found.

### **6.2.2 Examination on whether Amendment was made legally**

(1) The examiner should determine whether new matters are added to the description, claims or drawings by the amendment in response to “the final notice of reasons for refusal”. The examiner should determine whether the claims include new matters on a claim-by-claim basis. With regard to the claims to which new matters have been added, the examiner shall not judge whether these claims fall under the cases prescribed in Article 17bis (5) or (6).

(2) Then, the examiner shall determine whether the inventions in other claims to which no new matter has been added are “inventions that change a special technical feature.” With

regard to “inventions that change a special technical feature,” the examiner shall not judge whether these claims fall under the cases prescribed in Article 17bis (5) or (6).

(3) With regard to the claims to which no new matter has been added and which are not “inventions that change a special technical feature,” the examiner shall further determine whether the amendment to each of these claims has been made for any of the purposes prescribed in Article 17bis (5)(i) to (iv).

(4) After the determination with respect to Patent Act Article 17bis (5)(i) to (iv) in the aforementioned (3), where there are amended claims falling under Patent Act Article 17bis (5)(ii) (restriction of claims), the examiner should determine whether it should meet requirements of Article 17bis (6).

(5) Where there are amendments which are determined to be illegal by following aforementioned (1) to (4), the examiner should indicate reasons to all such amendments and decide the dismissal of the amendment.

(Explanation)

All the reasons should be indicated in dismissal so that the applicant can make an appropriate amendment when demanding an appeal.

### **6.2.3 Remarks when Dismissing Amendment Due to Violation of Requirements of Independent Patentability**

(1) Where the claimed invention amended for the purpose of restriction of claims cannot be patented according to the provisions of Patent Act Article 29, 29bis or 39.

① In dismissal of the amendment, the prior art cited in “the final notice of reasons for refusal” should be referred in principle. However, where the claims are restricted by the amendment, new prior art may be cited.

② Where the amendment was dismissed by indicating reasons for not granting a patent by referring only the prior art that was not cited in “the final notice of reasons for refusal,” since there may be cases where the prior art cited in “the final notice of reasons for refusal” was improper, it should be reconsidered whether “the final notice of reasons for refusal” was proper and maintainable.

③ In deciding whether to dismiss the amendment, reasons for the dismissal should be indicated for each claim which was amended for restriction and determined not to meet the requirements of independent patentability.

(2) Where the invention amended for the purpose of restriction of claims does not meet the requirements prescribed in Patent Act Article 36

Regarding the invention amended for the purpose of restriction of claims, where there is still a deficiency in the description, claims or drawings, or where a new deficiency was generated by the amendment, the examiner should dismissed the amendment for the reason of the contravention of the provision of Article 36, with applying Patent Act Article 17bis (6)

and 53 applied. (However, if the reason for refusal of violation of Article 36 which had been existed before the amendment was not notified, the amendment shall not be dismissed based on the violation of Article 36.)

However, if the deficiency is very minor so that the deficiency in the description can be corrected by the simple amendment, and is deemed worth granting a patent, the examiner should accept the amendment and give the applicant an opportunity of re-amendment, by notifying a notice of reasons for refusal related to the deficiency in the description as “the final notice of reasons for refusal”.

(3) On application of Patent Act Article 17bis (6)

Patent Act Article 17bis (6) is the provision applying Patent Act Article 126(5) (prescribing that the invention described in the corrected claims must be one which could have been patented independently at the time of filing of the patent application) mutatis mutandis thereto and applied only where the amendment (amendment corresponding to restriction of claims) falling under Patent Act Article 17bis (5)(ii) was made.

Therefore, Article 17bis (6) should not be applied to claimed inventions as not amended and those as amended just for correction of errors (Article 17bis (5)(iii)) or for clarification of an ambiguous description (Article 17bis (5)(iv)).

### **6.3 Approach to the Application in dismissing the amendments**

Where an amendment is dismissed, since the application is returned to the state before the amendment, a review should be made on whether the reasons for refusal indicated in “the final notice of reasons for refusal” before the amendment are proper.

In review of the fairness of the reasons for refusal indicated in “the final notice of reasons for refusal,” the examiner should consider the particulars of the written opinion submitted by the applicant.

(1) Where the reasons for refusal indicated in “the final notice of reasons for refusal” is judged to be proper so that the reasons for refusal were not resolved, the examiner should make the decision of refusal simultaneously with the dismissal of the amendment.

(2) Where the reasons for refusal indicated in “the final notice of reasons for refusal” were inappropriate and any other reasons for refusal were not found, the examiner should decide to grant a patent simultaneously with the dismissal of the amendment.

(3) Where the reasons for refusal indicated in “the final notice of reasons for refusal” were inappropriate, but other reasons for refusal are found, the examiner should notify the applicant of the reasons for refusal with respect to the application prior to the amendment again simultaneously with the dismissal of the amendment.

In this case, the examiner should decide whether it should be set to “the final notice of reasons for refusal” or “the first notice of reasons for refusal”, according to the paragraphs of 4.3.3, including whether a notice of the new reasons for refusal were necessitated by the amendment made in response to “the first notice of reasons for refusal” or not.

In addition, because the reasons for refusal should be notified along with the decision of the dismissal of the amendment, the examiner should make it clear that it is the

reasons for refusal for the application before the amendment in the notice of reasons for refusal,.

#### **6.4 Approach to the Application when Amendments are not Dismissed but Accepted**

(1) Where the reasons for refusal related to the application prior to the amendment were not resolved, the examiner should make decision of refusal.

(2) Where the reasons for refusal related to the application prior to the amendment were resolved and any other reasons for refusal are not found, the examiner should decide to grant a patent.

(3) Where the reasons for refusal were resolved by the amendment but other new reasons for refusal were found, the examiner should notify the applicant of new reasons for refusal.

① Whether a notice should be set to “the final notice of reasons for refusal” or “the first notice of reasons for refusal” should be judged, according to the guidelines in 4.3.3.

② Where an amendment made in response to “the final notice of reasons for refusal” was once accepted and new reasons for refusal were notified, even if the amendment made in response to the earlier “final notice of reasons for refusal” is found to be illegal afterward, the amendment should not be dismissed retroactively. In addition, where new matters are found to be added afterward, the reasons for refusal should be notified again.

(Explanation)

Under the provisions of Patent Act Article 159 (1), and Article 163 (1), where the amendment made in response to “the final notice of reasons for refusal” was found to be illegal after the decision of refusal, the examiner should not dismiss the amendment retroactively from the viewpoint of facilitation of procedure. In compliance with this purport, where new reasons for refusal were notified after accepting the amendment made in response to “the final notice of reasons for refusal” and the amendment made for the earlier “final notice of reasons for refusal” was found to be illegal, it should be handled in the same manner.

### **7. Final Decision**

#### **7.1 Decision to Grant a Patent**

Where no reasons for refusal related to the application for patent are found or the reasons for refusal were resolved in response to the notice of reasons for refusal, the examiner should promptly make decision to grant a patent.

#### **7.2 Decision of Refusal**

Where the notified reasons for refusal are still unsolved even in response to the notice of reasons for refusal, decision of refusal should be made regardless of whether the notice is “the first” or “the final” one (Patent Act Article 49).

Where the amendment should be dismissed, decision of refusal should be made

simultaneously with the decision of dismissal.

Practically, the following points should be remarked.

(1) The examiner should indicate all the claims in which the notified reasons for refusal were still unsolved. In this case, the examiner should clearly and simply state them so that the applicant can understand the claims to which the reasons for refusal are unresolved. However, the claims in which explanation of comparison, determination etc. is the same can be described together.

(2) For the issuable items in the written opinion, determination of the examiner on them should be clarified.

(3) Obsessed by the notified reasons for refusal, the examiner should not make an unreasonable decision such as additionally referring to new prior art documents. In deciding on refusal, the examiner should not refer to the new prior art except for the well-known art or the commonly used art.

## **8. Reconsideration by Examiner before Appeal**

As to the the appeals against examiner's decision of refusal, those in which descriptions, claims or drawings were amended simultaneously with the day of request of appeal (see, Note) should be reconsidered (Patent Act Article 162). This is called "reconsideration by examiner before appeal". Reconsideration by examiner before appeal, in principle, is performed by the examiner who made decision of refusal.

(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".

Considering the fact that many cases of which original decision was cancelled at the appeal against the decision of refusal are those of which claims etc. were amended after decision of refusal, the system of "reconsideration by examiner before appeal" was introduced for the purport of reducing the number of the cases to be dealt by an appeal examiner and facilitating the appeal by letting the examiner who made decision of refusal examine the relevant case again (Reference: "Article by Article Description of the Industrial Property Act").

The cases can be more easily and promptly examined by reconsideration by the examiner who has made decision of refusal, with full knowledge on the application, than by a newly designated appeal examiner from the start.

Figure 3 shows the flow chart of reconsideration by examiner before appeal.

### **8.1 Procedure of Reconsideration by Examiner before Appeal**

(1) Examination of amendment made in the demand for the appeal

At first, the examiner should judge whether the amendment made in the demand for the appeal contravenes the provisions of Patent Act Article 17bis (3) or (6) or not.

As to the amendment made in the demand for the appeal, the examination should apply mutates mutandis the paragraph of the aforementioned 6.2.2 in "6. Examination when amendment was made in response to the final notice of reasons for refusal". In this case, "the

final notice of reasons for refusal” in this paragraph should be replaced with “the decision of refusal,” and “amendment made in response to the final notice of reasons for refusal” into “the amendment made in the demand for the appeal”

(2) Where the amendment made in the appeal is legal

- ① Where the reasons for refusal were resolved by the legal amendment made in the demand for the appeal and no new reason for refusal is found, the examiner should negate the original decision and decide to grant a patent.
- ② Where the reasons for refusal were resolved by legal amendment made in the demand for the appeal, but new reasons for refusal that can be the reasons for refusal related to the application after amendment were found, the examiner should notify the reasons for refusal.  
(e.g. where a part of claims were deleted by the amendment and other new reasons for refusal were founded as to the remaining claims )
- ③ Where the reasons for refusal were not negated even by the legal amendment made in the demand for the appeal, the examiner should report the results of the examination to the Commissioner of the Patent Office. All the reasons to maintain the original decision should be stated in the reconsideration report. In addition, where other new reasons for refusal are found, the examiner should also state them.

(3) Where the amendment made in demand for the appeal is illegal

In reconsideration by the examiner before an appeal, even for cases that were not legally amended, the examiner should not decide the dismissal of the amendment except in cases of a decision to grant a patent (Patent Act Article 164).

Where the amendment made in the demand for the appeal was illegal, the examiner should reconsider whether the reasons for decision of refusal to the application prior to the amendment made in the demand for the appeal were appropriate or not.

- ① When the reasons for decision of refusal to the application prior to the amendment made in the demand for the appeal were appropriate, the examiner should report the results of the examination to the Commissioner of the Patent Office. In the reconsideration report, the examiner should state all the reasons to maintain the original decision along with the reasons to dismiss the amendment made in the demand for the appeal. When other new reasons for refusal are found, he/she should also state them.
- ② Where the reasons for decision of refusal to the application prior to the amendment made in the demand for the appeal were not appropriate, and no other reasons for refusal were found in the application prior to the amendment made in the demand for the appeal, the examiner should cancel the decision of refusal and make decision to grant a patent simultaneously with the decision of dismissal of the amendment.
- ③ Where the reasons for decision of refusal to the application prior to the amendment made in the demand for the appeal were not appropriate, but other new reasons for

refusal were found in the application prior to the amendment made in the demand for the appeal, the examiner should report the results of the examination to the Commissioner of the Patent Office. In the reconsideration report, the examiner should state, as well as the reasons for dismissal of the amendment made in the demand for the appeal, the new reasons for refusal to the application prior to the amendment.

- (4) Where decision to grant a patent can be made by giving an opportunity of amendment

Where decision to grant a patent can be made by giving an opportunity of amendment (for example, where there is only minor deficiency in the description), reasons for refusal can be notified regardless of (2) or (3).. In this case, the examiner should make an effort to make the requester understand how to amend, by communicating with the requester using an interview etc..

These reasons for refusal, in principle, should be “the final notice of reasons for refusal” (refer to 4.3.3.1 (2)①))

## **8.2 Remarks**

(1) In judging whether the reasons for decision of refusal were resolved or not, the examiner should consider the reasons for an appeal sufficiently.

(2) Where the examiner judges that the reasons for refusal were resolved, he/she should reconfirm before decision to grant a patent whether other reasons for refusal do not exist.

(3) In the reconsideration report, the examiner should state the issuable items and his/her judgment on them.

## **(Attachment) Guidelines for the Use of Prior Art Search Results and Examination Results Provided by Foreign Patent Offices**

### **1. Basic policy**

In the examination of overseas-related applications\*1, in order to reduce the examination workload and to improve the quality of the examination, it is important to effectively use prior art search results and examination results provided by foreign patent offices.

In particular, with regard to the applications for which an accelerated examination has been requested under the Patent Prosecution Highway (PPH)\*2, one must make best use of the prior art search results and examination results provided by foreign patent offices while in the process of conducting an examination, because the PPH program aims to make it easier for applicants to obtain patent rights overseas quickly, and also aims to enable the patent offices to reduce the examination workload by using prior art search results and examination results provided by the patent office of first filing, while improving the quality of the examination.

Therefore, in the examination of overseas-related applications, the JPO shall use prior art search results and examination results provided by foreign patent offices in the following procedure.

\*1: An “overseas-related application” means a patent application of which the applicant has also filed applications with patent offices or intergovernmental organization other than the JPO or filed international applications with regard to the same invention (e.g., domestic applications based on which priority is claimed for international applications; international applications that have entered into the national phase).

\*2: Under the Patent Prosecution Highway (PPH), an application for which the office of first filing (OFF) has decided to grant a patent is eligible for an accelerated examination through the simple procedure at the office of second filing (OSF). Where the applicant desires a normal accelerated examination through the ordinary procedure at the JPO or the USPTO, he is required to carry out a prior art search and describe the comparison between the prior art and the claimed invention, thereby explaining the patentability of the claimed invention to the OSF. Under the PPH, the applicant can omit to these requirements by submitting to the OSF the claims to which the OFF has granted a patent and the office actions that have been given by the OFF (see “Patent Prosecution Highway Pilot Program between the JPO and the USPTO”).

### **2. Procedure of Examination**

#### **(1) Prior art search**

Where search results provided by a registered search agency are unavailable in the examination of an overseas-related application, the examiner shall carry out a prior art search through the following procedure.

- i) The examiner shall refer to the prior art search results and examination results concerning the corresponding foreign application that have been provided by the foreign patent office. The examiner is not required to carry out an additional prior art search

himself/herself if he/she considers it possible, based on his/her knowledge and experience, to conduct an examination precisely and efficiently by using such search results.

- ii) The examiner shall carry out an additional prior art search himself/herself where he/she considers it impossible, based on his/her knowledge and experience, to conduct an examination precisely and efficiently by using only prior art search results or examination results concerning the corresponding foreign application, which have been provided by the foreign patent office\*3. In this case, unless the examiner considers it highly probable, based on his/her knowledge and experience, to find more significant prior art documents in the scope already searched by the examiner of the foreign patent office, the scope already searched by the foreign patent office shall be excluded from the scope of the additional search.

(For instance, where the JPO examiner uses prior art document search results provided by the USPTO, the US patent bulletins or publications of US patent applications shall be excluded from the scope of the additional search unless it is considered highly probable to find more significant prior art documents from among these US documents.)

\*3: With regard to the applications for which an accelerated examination has been requested under the PPH, the JPO can use the examination results indicating that patents have been granted to the corresponding foreign applications.

- iii) Where the examiner considers it possible, based on his/her knowledge and experience, to find relevant prior art documents more efficiently by carrying out a prior art search himself/herself rather than referring to the prior art search results provided by the foreign patent office, he may carry out an additional prior art search before referring to the prior art search results concerning the corresponding foreign application, which have been provided by the foreign patent office.

Where search results provided by a registered search agency are available in the examination of an overseas-related application, the examiner shall carry out an additional prior art search through the procedure described in above i) to iii) if, having referred to the search results provided by the registered search agency, he/she considers it impossible, based on his knowledge and experience, to conduct an examination by using only such search results.

- (2) Examination of prior art documents, etc.

Where the highly relevant prior art documents obtained through the above-mentioned procedure are included in the scope of the prior art search results provided by the foreign patent office, the examiner shall take into account the prosecution history and examination results (finding of cited invention, rationale of the reason for refusal, final result of examination, description of the claim granted a patent) at the foreign patent office to judge whether any of the contents of the prior art documents gives a reason for refusal of the claimed invention in terms of novelty or inventive step. In this case, the examiner should take notice of the difference between the Japanese examination system and practice and those of the foreign country.

- (3) Examination on other reason for refusal

When considering the existence of a reason for refusal in terms of the deficiency in descriptions or claims, the examiner shall also take into account the prosecution history and examination results (content of the notice of reasons for refusal, final result of examination, description of the claim granted a patent) at the foreign patent office, while taking notice of the differences between the Japanese examination system and practice and those of the foreign country.

Figure 1 Flow of Examination Procedure

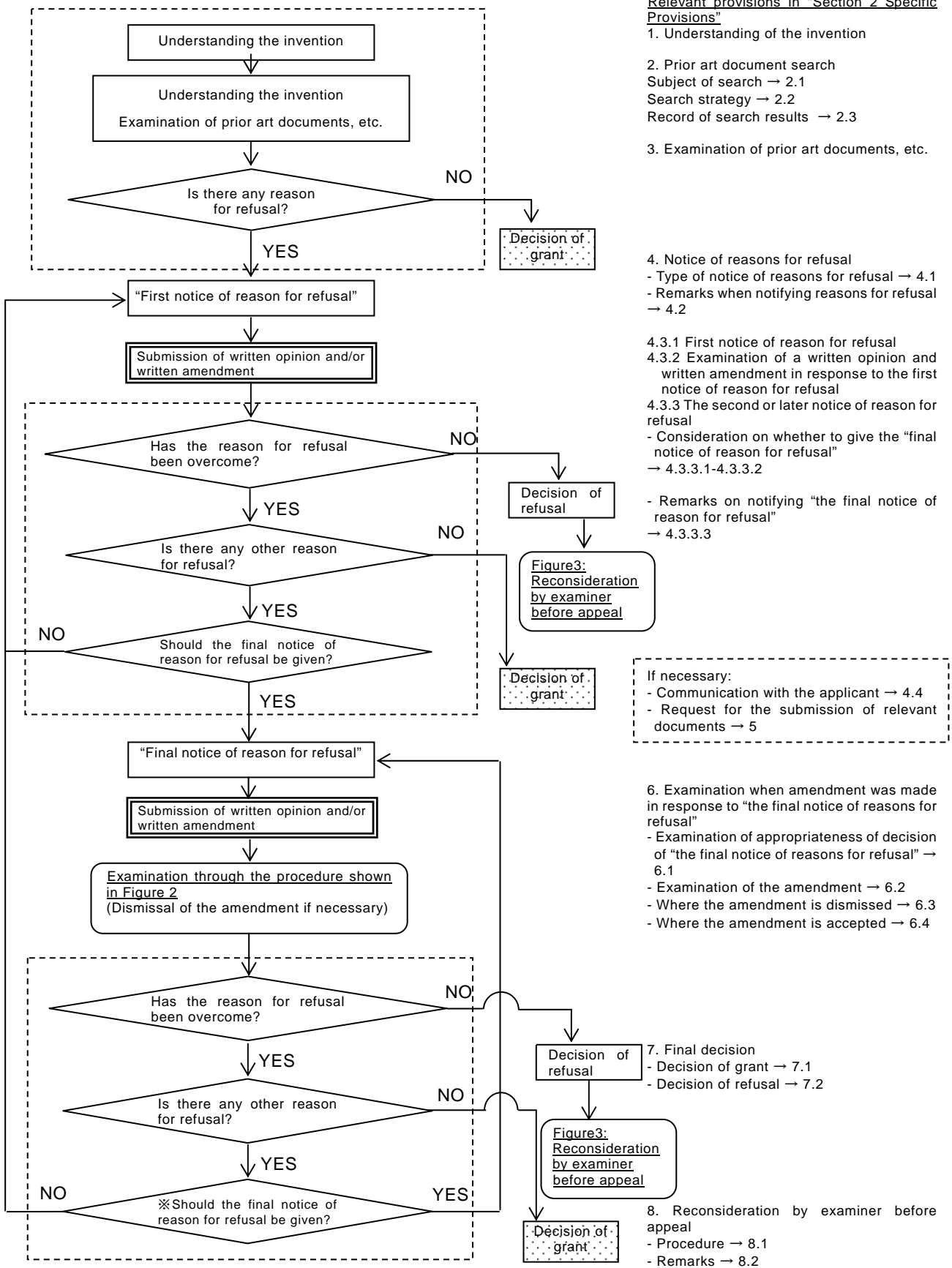
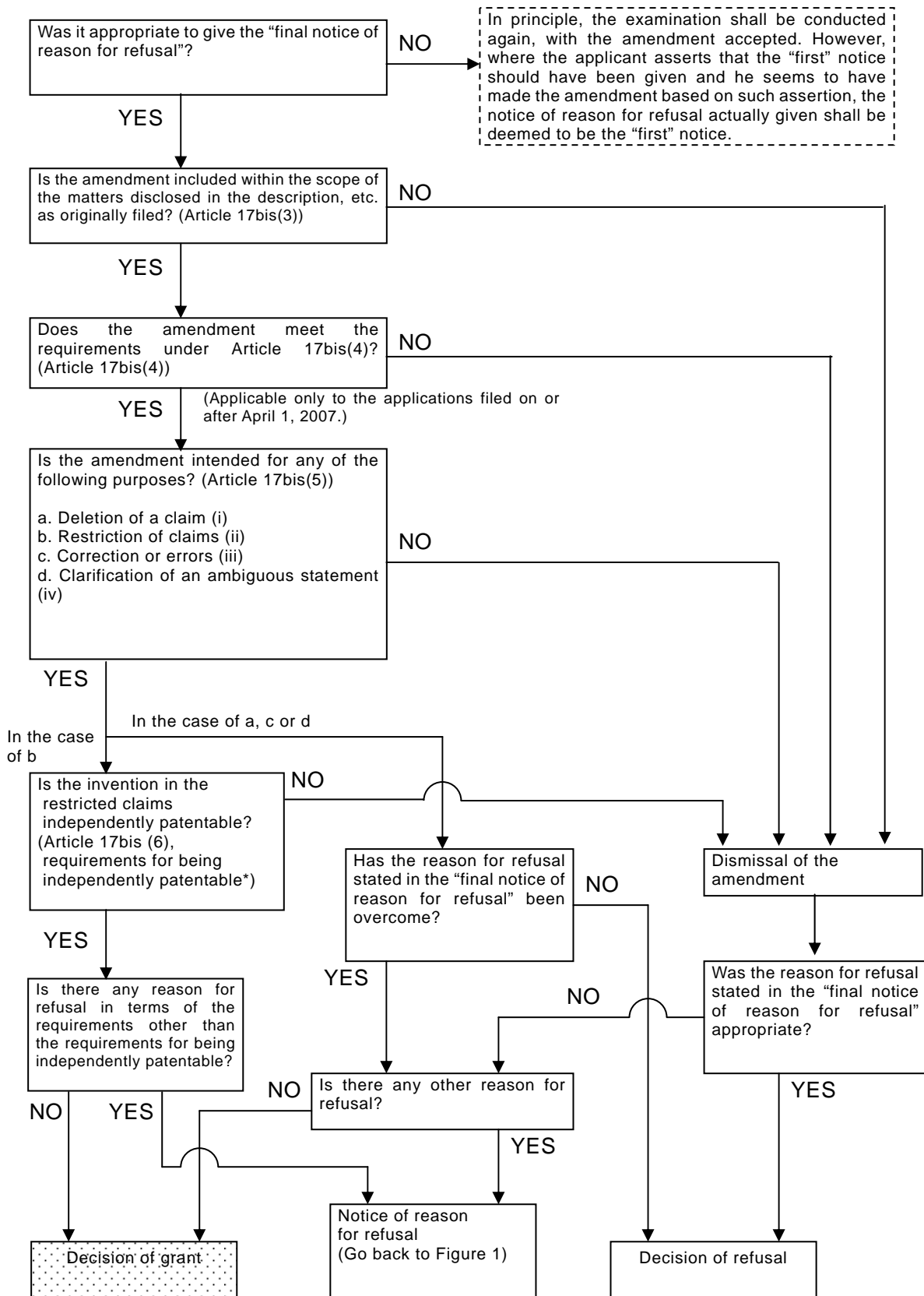


Figure 2 Examination after the amendment was made in response to the “final notice of reason for refusal”



\* Requirements for being independently patentable: the requirements under Article 29, Article 29bis, Article 32, Article 36(4)(i) and (6) (excluding (iv)), Article 39(1) to (4)

Figure 3 Reconsideration by examiner before appeal

