

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

Section 6 Decision of Dismissal of Amendment

1. Overview

1.1 Patent Act Article 53

When amendment made as a response to the final notice of reasons for refusal (Article 17bis(1)(iii)) does not fulfill any of the requirements stipulated in Articles 17bis(3) to (6), the examiner shall decide to decline the amendment (Article 53(1)).

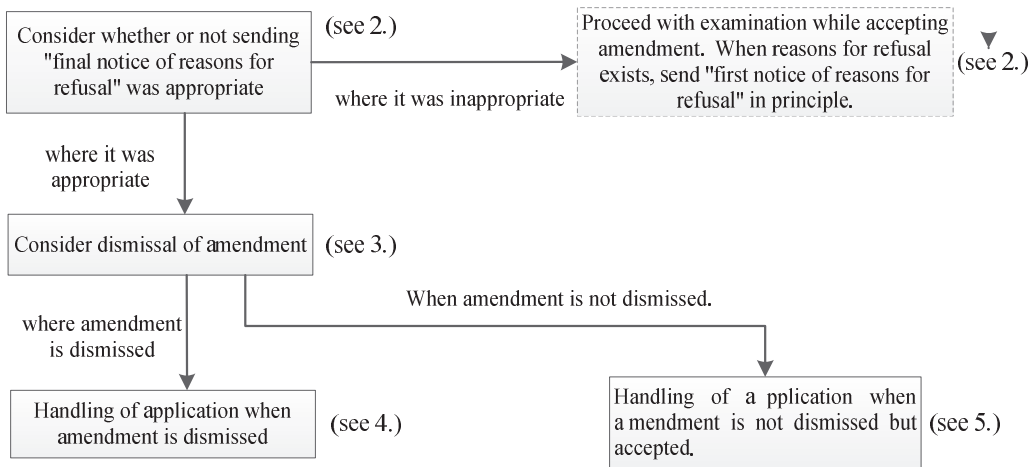
If even a case where amendment made as a response to a second and subsequent notice of reasons for refusal is illegitimate is taken as reasons for refusal of the patent application, reasons for refusal to the effect that the amendment is illegitimate are again notified. Since amendment can be made in response to the notice of reasons for refusal, the amended patent application must be examined again. To avoid such a situation, when amendment made as a response to the "final notice of reasons for refusal" notified after the second examination is illegitimate, the provisions of Article 53 are provided to dismiss the amendment.

1.2 Overview of examination procedures concerning decision of dismissal of amendment

When amendment is made as a response to the "final notice of reasons for refusal," the examiner shall examine whether or not it was appropriate to take the reasons for refusal notified immediately before as the "final notice of reasons for refusal." When determining that sending the "final notice of reasons for refusal" was appropriate, the examiner shall examine whether or not the amendment fulfills the requirements set forth in Article 17bis(3) to (6) (whether or not the amendment is made legitimately). When amendment is illegitimate, the examiner shall dismiss the amendment (see also Figure 2 as to examination procedures employed when amendment is made as a response to the final notice of reasons for refusal).

Meanwhile, from the viewpoint of inhibition of misuse of a divisional application system, where a notice under Article 50bis is issued along with a notice of reasons for refusal and when amendment made as a response to the notice does not fulfill any of the requirements set forth in Articles 17bis(3) to (6), the examiner shall dismiss the amendment (Article 53(1) parentheses. see "Part VI Chapter 1 Section 2

Notice under Article 50bis).



2. Consider Whether or not Sending the Final Notice of Reasons for Refusal was Appropriate

The examiner shall first reconsider whether or not sending the "final notice of reasons for refusal" was appropriate by taking the applicant's argument in the written opinion, etc., into account.

2.1 Where taking the notice as "final notice of reasons for refusal" was appropriate

When taking the notice as the "final notice of reasons for refusal" was appropriate, the examiner shall review whether or not amendment is made legitimately (see 3.)

2.2 Where sending "final notice of reasons for refusal" was inappropriate

When sending the "final notice of reasons for refusal" was inappropriate, Article 53 is not applicable. Therefore, in this case, the examiner shall proceed with the examination based on the description and etc. after amendment, which was made as a response to the "final notice of reasons for refusal," without deciding to decline it. Even when the previously-notified reasons for refusal are unresolved, the examiner shall again notify "non-final notice of reasons for refusal" instead of immediately deciding to reject the patent application. Further, even when only the reasons for refusal which

become necessary to be notified as a result of amendment is notified, the examiner shall again issue a "non-final notice of reasons for refusal" instead of the "final notice of reasons for refusal."

(Points to Note)

When the applicant alleges that the notice should have been the "non-final notice of reasons for refusal" and makes an amendment on the premise that the notice is the non-final notice of reasons for refusal, the examiner shall handle the notice as the "non-final notice of reasons for refusal." In other words, when the reasons for refusal are unresolved, the examiner shall make a decision of refusal. Where only reasons for refusal which become necessary to be notified by amendment are notified, the examiner may handle the notice as the "final notice of reasons for refusal. "

3. Consider of Dismissal of Amendment

3.1 Amendment to be dismissed

Amendment to be dismissed is one corresponding to any of (1) to (4) provided below.

- (1) Amendment adding new matters (non-compliance with Article 17bis(3))
- (2) Amendment changing special technical feature of the invention (non-compliance with of Article 17bis(4))
- (3) Amendment for other than the prescribed purposes (violation of Article 17bis(5))
- (4) Amendment not fulfilling requirements for independent patentability (non-compliance with of Article 17bis(6))

3.1.1 Amendment adding new matters (non-compliance with Article 17bis(3))

Amendment, which is made as a response to the "final notice of reasons for refusal" and which corresponds to any either (i) or (ii), corresponds to "amendment adding a new matter" and hence becomes an amendment to be dismissed.

- (i) amendment adding a new matter, and
- (ii) amendment including a new matter pointed out in a "final notice of reasons for refusal"

(Points to Note)

Where a new matter is present at the time of "final notice of reasons for refusal" and where reasons for refusal were not notified on the basis of the new matter, the examination will be carried out based on the description, etc after amendment without dismissal of the amendment even if the amendment serving as a response to the "final notice of reasons for refusal" includes the new matter. In addition, reasons for refusal to the effect that amendment entails addition of a new matter are notified.

3.1.2 Amendment changing special technical features of the invention (non-compliance with of Article 17bis(4))

Amendment, which serves as a response to the "final notice of reasons for refusal" and which corresponds to (i) or (ii) provided below, corresponds to "amendment changing the special technical features of the invention" and hence become an amendment to be dismissed.

- (i) Amendment adding an invention whose special technical features are newly changed (an invention which does not become a target of examination in connection with requirements other than Article 17bis(4) in accordance with "Part IV Chapter 3 Amendment Changing Special Technical Feature of the Invention")
- (ii) Amendment including an invention which is pointed out in the "final notice of reasons for refusal" and whose special technical feature is changed

(Points to Note)

(1) Where amendment to the "non-final notice of reasons for refusal" includes an invention whose special technical feature is modified and where reasons for refusal were not notified for the amendment, the examination will be carried out based on the description, etc after amendment without dismissal of the amendment even when the claims amended in response to the "final notice of reasons for refusal" includes the invention whose special technical features are modified. Reasons for refusal to the effect that the amendment changes the special technical feature of the invention are notified.

(2) Even if an amendment which changes a special technical feature of an invention is made, as long as there is no substantive deficiency in the invention, there is a mere formal deficiency that

the applicant should have divided the application into two or more patent applications in order for it to be examined. Accordingly, it does not directly inflict serious damages on the interests of third parties, even if the patent application to which the amendment which changes the special technical feature of the invention is made is patented. Therefore, failure to fulfill the requirements of Article 17bis(4) constitutes a reason for refusal, but does not constitute a reason for invalidation.

Considering these circumstances, the examiner shall not make an unnecessarily strict determination on whether an amendment is an amendment which changes a special technical feature of an invention.

3.1.3 Amendment for other than the prescribed purposes (non-compliance with Article 17bis(5))

Amendment which is to be made to the claims and which is not made for any of the following purposes (i) to (iv) shall be an amendment to be dismissed.

- (i) Removal of a claim (item (i))
- (ii) Restriction of claims (limited to restriction of matters required to specify a claimed invention such that the invention becomes identical with the invention claimed before amendment in terms of the technical field and the problem to be solved) (referred to in the following as "restriction in a limited way of claims," item(ii))
- (iii) Correction of errors (item(iii))
- (iv) Clarification of an ambiguous statement (limited to the clarification of the matter shown in reasons for refusal, Paragraph 4)

(Points to Note)

Provisions of Article 17bis(5) are provided to enable the examiner to proceed with examination by effectively utilizing existing examination results from the viewpoint of realization of quick granting of right and assurance of equity among applications. Even when the requirements are later found not to have been fulfilled, the amendment is not rendered as ground for invalidation because the amendment has substantive defects, which would invalidate the patent.

Therefore, the examiner shall not apply strictly more than necessary the provision of Paragraph 5, to the invention that is to be essentially protected when an examination can be quickly performed by effective utilization of the existing examination results.

3.1.4 Amendment not fulfilling requirements for independent patentability (non-compliance with the requirements of Article 17bis(6))

Where a claimed invention that has been amended for "restriction in a limited way of claims" cannot be patented independently, the amendment shall be dismissed because the amendment does not satisfy the requirements for independent patentability.

Examples of amended inventions which cannot be patented independently include the following case (i) and (ii).

- (i) An amended claim in which a new reason for refusal under the following provisions is found although the reasons for refusal notified with respect to the claim before the amendment were resolved.
- (ii) An amended claim for which the reasons for refusal under the following provisions indicated in the "final notice of reasons for refusal" are still unresolved.

Whether or not a claimed invention can be patented independently shall be determined based on the following provisions.

- (i) Eligibility for Patent and Industrial Applicability (The main paragraph of Article 29(1))
- (ii) Novelty (Article 29(1))
- (iii) Inventive step (Article 29(2))
- (iv) Secret prior art (Article 29bis)
- (v) Category of unpatentable invention (Article 32)
- (vi) Description requirements (Articles 36(4)(i), (6)(i) to (iii))
- (vii) Prior application (Articles 39(1) to (4))

Where a claimed invention that has been amended for "restriction in a limited way of claims" fails to involve inventive step (Article 29(2)), for example, the amendment shall be normally dismissed (for exceptions, see (2) of (Points to note) below).

Where a claimed invention that has been amended for "restriction in a limited way of claims" includes improper descriptions (Article 36), the amendment shall be normally dismissed (for exceptions, see (3) of (Points to note) below).

(Points to note)

(1) Patent Act Article 17bis(6) shall be applied only where an amendment for the purpose of restriction in a limited way of claims(Patent Act Article 17bis(5)(ii)) is made.

Therefore, an examiner shall not apply Patent Act Article 17bis(6) to an amendment of claims for deletion of a claim (Article 17bis(5)(i)), correction of errors (Article 17bis(5)(iii)) or clarification of an ambiguous description (Article 17bis(5)(iv)).

(2) Where a claimed invention that has been amended for "restriction in a limited way of claims" has a reason for refusal related to novelty, inventive step, etc., but the reason for refusal related to snovelty, inventive step, etc.for the claimed invention before the amendment had not been notified in the final notice of reasons for refusal (except for the case where it is explicitly stated that the invention is deemed as the subject of exclusion from prior art document search because it may be the subject of exclusion from prior art document search), the amendment shall not be dismissed based on that reason. The examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment.

For example, where a claimed invention that has been amended for "restriction in a limited way of claims" has a reason for refusal due to novelty, inventive step, etc. but the claimed invention had not been excluded from the subject of search and the reason for refusal related to novelty, inventive step, etc. had not been notified in the final notice of reasons for refusal, the amendment shall not be dismissed based on that reason. The examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment..

However, where a claimed invention that has been amended for "restriction in a limited way of claims" fails to comply with the requirements of Articles 39(2) and (4), the claimed invention before the amendment comply with the requirements of Article 39(2) or (4), and the amendment renders the claimed invention not complying with the requirements of Article 39(2) or (4), the amendment shall be dismissed (for determination whether a claimed invention complies with the requirements of Article 39(2) or (4) are violated and the procedure of the examination, see 3. and 4. of "Part III, Chapter 4, Prior Application").

(3) Regarding a claimed invention that has been amended for "restriction in a limited way of claims," where a reason for refusal due to deficiency in the description etc. exists in the description, etc., and the reason was not notified in the final notice of reasons for refusal although the reason for refusal due to the deficiency had existed before the amendment, the amendment shall not be dismissed based on that reason. The examiner shall notify the applicant of the reasons for refusalbased on the description, etc after amendment.

Even if the deficiency in the description is very minor, and is deemed worth granting a patent

by correcting the deficiency in the description by a simple amendment, the examiner shall notify the applicant of the reasons for refusal based on the description, etc after amendment without dismissal of the amendment related to the deficiency in the description in "the final notice of reasons for refusal" to give the applicant an opportunity of re-amendment.

3.2 Procedure for determining whether an amendment was made legally

When determining that an amendment made in response to "the final notice of reasons for refusal" does not satisfy any of the requirements of Article 17bis(3) to (6), an examiner shall dismiss the amendment.

However, all reasons shall be indicated in dismissal of the amendment to allow the applicant to make an appropriate amendment in the request for appeal against the examiner's decision of refusal. An examiner shall determine whether an amendment was made legally in accordance with the following procedure.

- (1) Whether a new matter has been added to the description, the claims or the drawings by the amendment in response to "the final notice of reasons for refusal" (Article 17bis(3), see 3.1.1) shall be determined. Whether the claims to which the amendment has been made for adding a new matter shall be determined on a claim-by-claim basis. With regard to the claim to which the amendment has been made for adding a new matter, the examiner shall not determine whether the amendment falls under the cases prescribed in Article 17bis(4) to (6).
- (2) Whether the amendment falls under "amendments that change a special technical feature of the invention" shall be determined based on the inventions in other claims to which no amendment has been made for adding a new matter (Article 17bis(4), see 3.1.2). With regard to an invention serving as the ground for the determination that the amendment falls under "amendments that change a special technical feature of the invention", the examiner shall not make determination for the respective paragraphs in Article 17bis(5) and Article 17bis(6).
- (3) Based on the inventions in other claims which no new matter has been added to and are not a basis for determination of "amendments that change a special technical feature of the invention", whether the amendment has been made for any of the purposes prescribed in Article 17bis(5)(i) to (iv) shall be determined (Article 17bis(5), see 3.1.3).

(4) After the determination with respect to Article 17bis(5)(v) in the above (3), where a claim to which the amendment falling under Article 17bis(5)(ii) (restriction in a limited way of claims) has been made is included, whether the amendment of the claim satisfies the requirements of Article 17bis(6) shall be determined (Article 17bis(6). see 3.1.4).

(5) Where an amended matter determined to fail to satisfy the amendment requirements is found as a result of the determination in accordance with the above (1) to (4), reasons for all such amendments shall be indicated in dismissal of the amendments.

For example, where all claimed inventions have been amended for "restriction in a limited way of claims" and all the amended claims are determined to be unpatentable independently, reasons for invention in all the claims shall be indicated.

3.3 Points to note in dismissal of the amendment due to non-compliance with of requirements for independent patentability

When determining that a claimed invention that has been amended for "restriction in a limited way of claims" cannot be patented due to lack of novelty or inventive step, etc., an examiner shall consider the following points.

(1) In dismissal of the amendment, the prior art cited in "the final notice of reasons for refusal" shall be, in principle, referred. However, since the claims have been restricted by the amendment, new prior art may be cited.

(2) Where the amendment is dismissed by referring only the prior art that was not cited in "the final notice of reasons for refusal" and indicating reasons for not granting a patent, there may be cases where the prior art cited in "the final notice of reasons for refusal" was improper. Therefore, it shall be reconsidered whether the contents of "the final notice of reasons for refusal" are proper and maintainable. If an examiner determines that the contents of "the final notice of reasons for refusal" are improper, the examiner shall dismiss the amendment and issue a notice of reasons for refusal again without making the decision of refusal.

4. Handling of the Application When the Amendment is Dismissed

Where an amendment is dismissed, the application is returned to the state before the amendment. Thus, an examiner shall confirm whether the reasons for refusal indicated in the final notice of reasons for refusal made for application before the amendment are proper.

In confirming whether the reasons for refusal indicated in the final notice of reasons for refusal are proper, the contents of the written opinion submitted by the applicant shall be considered.

- (1) Where reasons for refusal indicated in "the final notice of reasons for refusal" are determined to be proper and the reasons for refusal are unresolved, the examiner shall render a decision to dismiss the amendment and render a decision to refusal simultaneously.
- (2) Where reasons for refusal indicated in "the final notice of reasons for refusal" are determined to be improper and any other reason for refusal is not found, the examiner shall render a decision to dismiss the amendment and render a decision to grant a patent simultaneously.
- (3) Where reasons for refusal indicated in "the final notice of reasons for refusal" are improper, but a new reason for refusal is found, the examiner shall render a decision to dismiss the amendment and notify the applicant of the new reasons for refusal with respect to the application prior to the amendment again simultaneously. In such a case, the examiner shall decide whether it should be set to "the final notice of reasons for refusal" or "the non-final notice of reasons for refusal", according to 3. of "Section 3 Notice of Reasons for Refusal", including whether the new reason for refusal was necessitated to be notified by the amendment made in response to "the non-final notice of reasons for refusal".

In addition, because the reasons for refusal shall be notified along with the decision of the dismissal of the amendment, the examiner shall make it clear that it is the reason for refusal for the application before the amendment in the notice of reasons for refusal.

5. Handling of the Application When the Amendment is not Dismissed

- (1) When determining that an application after an amendment resolves a reason for refusal and finding no other reason, an examiner shall decide to grant a patent.
- (2) When determining that an application after an amendment fails to resolve a reason for refusal, an examiner shall make a decision of refusal.
- (3) When determining that an amendment resolves a reason for refusal but finding other new reason for refusal, an examiner shall notify the applicant of the new reason for refusal.
 - (i) Whether a notice should be set to "the final notice of reasons for refusal" or "the non-final notice of reasons for refusal" shall be determined, according to 3. in "Section 3 Notice of Reasons for Refusal".
 - (ii) Where an amendment made in response to "the final notice of reasons for refusal" was not dismissed and a new reason for refusal was notified based on the description, etc after amendment, even if the amendment made in response to the earlier "final notice of reasons for refusal" is found to be illegal afterward, the amendment shall not be dismissed retroactively. In addition, where a new matter are found to be added in the amendment afterward, a reason for refusal shall 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, an examiner shall not dismiss the amendment retroactively from the viewpoint of facilitation of the proceeding or reconsideration by examiners before appeal proceedings (for the reconsideration by examiners before appeal proceedings, see "Section 7 Reconsideration by Examiners before Appeal Proceedings"). In compliance with this purport, where a new reason for reason was notified based on the description, etc after amendment without dismissal of the amendment after once 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" is found to be illegal, it shall be handled in the same manner.