

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

Part I Chapter 2 Section 7 Reconsideration by Examiners before Appeal Proceedings

## Section 7 Reconsideration by Examiners before Appeal Proceedings

### 1. Overview

As to appeals against the examiner's decision of refusal, those in which the descriptions, etc. were amended in the request for appeal shall be reconsidered before appeal examination by a collegial body of appeal examiners (Patent Act Article 162). This is called "reconsideration by examiners before appeal proceedings".

Many cases of which an original decision of refusal was cancelled at the appeal against the decision of refusal are those of which the description etc. was amended after the decision of refusal. Considering the above fact, in case that amendments were made in a request for appeal, the system of reconsideration by examiners before appeal proceedings was introduced for the purport of reducing the number of 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.

Where decision to grant a patent can be made by the amendment particularly, by letting an examiner who made decision of refusal examine an application again, the examiner can take advantage of his/her knowledge on the application and conduct examination more easily and promptly than a designated appeal examiner begins appeal examination from scratch.

Therefore, reconsideration by examiners before appeal proceedings shall be conducted, in principle, by the examiner who made the decision of refusal.

### 2. Basic Rules for Reconsideration by Examiners before Appeal Proceedings

In reconsideration by examiners before appeal proceedings, when determining that reasons for refusal in the original decision (decision of refusal) was resolved and any other reason for refusal is not found, an examiner shall cancel the original decision and make a decision to grant a patent.

Where an examiner cannot cancel the original decision and make a decision to grant a patent, the examiner, in principle, shall make a reconsideration report to the JPO Commissioner in the procedure of reconsideration by examiners before appeal proceedings.

However, an examiner shall issue a notice of reasons for refusal in the following case (1) or (2).

- (1) Where an amendment made in the request for appeal is legal and reasons for refusal are resolved by the amendment, but new reasons for refusal are found, and the found new reasons for refusal are only those necessitated to be newly notified by the amendment (Note) (See 3.2.1(2) and 3.2.2(2))
- (2) Where an examiner can indicate a response the requester can take to resolve the unresolved reasons in the original decision, and determines that such a response can make an agreement on the response with the requester, and the agreement is made by communicating with the requester.

(Note)

Reconsideration by examiners before an appeal proceedings is not conducted for reexamining an application to which refusal has been decided. Thus, where only new reasons for refusal necessitated to be newly notified by the amendment are found, an examiner shall issue a notice of reasons for refusal.

### 3. Flow of Reconsideration by Examiners before Appeal Proceedings

In reconsideration by examiners before appeal proceedings, an examiner shall determine whether the amendment made in the request for appeal is legal (see 3.1), and then continue the reconsideration by examiners before appeal proceedings (see 3.2 and 3.3).

According to the results of the reconsideration by examiners before appeal proceedings, the examiner shall make a decision to grant a patent(cancel the original decision), issue a notice of reasons for refusal or make a reconsideration report.

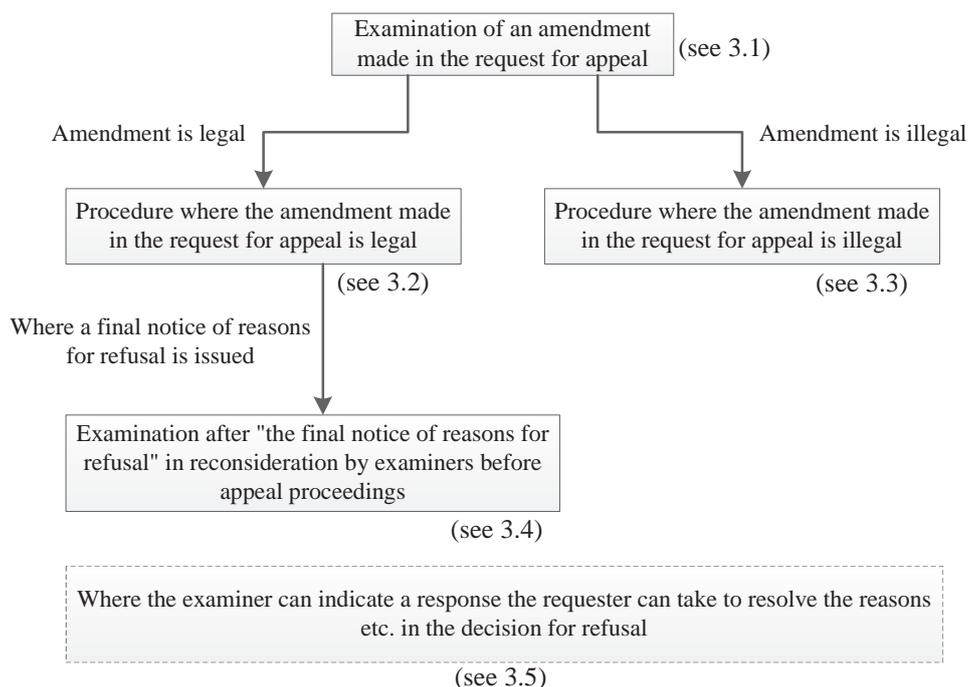
Where a notice of reasons for refusal is issued, an examiner shall continue the reconsideration by examiners before appeal proceedings in accordance with 3.4. According to the result of the reconsideration, the examiner shall make a decision to grant a patent (cancel the original decision) or make a reconsideration report.

Where it is possible to indicate a response the requester can take to resolve the reasons in the decision of refusal, an examiner shall continue the reconsideration by examiners before appeal proceedings in accordance with 3.5.

In making a reconsideration report of reconsideration, an examiner shall indicate any of (i) to (v) applied as the results of reconsideration in the reconsideration

report. For which items should be indicated, see 3.2 and 3.3.

- (i) All reasons to maintain the original decision
- (ii) Determination of dismissal of the amendment and reasons for the dismissal
- (iii) Unresolved reasons for refusal of the reasons for refusal notified in the reconsideration by examiners before appeal proceedings
- (iv) Issuable items in the written request for appeal and the examiner's determination on the items
- (v) Newly found reasons for refusal



### 3.1 Examination of an amendment made in the request for appeal

At first, an examiner shall determine whether the amendment made in the request for appeal is legal (whether the amendment complies with the requirements of Article 17bis(3) to (6)) (Note).

The examiner shall carry out such determination in accordance with "Section 6 Decision of Dismissal of Amendment". In this case, "amendment made in response to 'the final notice of reasons for refusal'" in this paragraph shall be replaced with "amendment made in the request for appeal".

(Note) Only where the claim has been amended for the purpose of Article 17bis(5)(ii) (restriction of the claims), an examiner shall determine whether the amendment complies with

violate the requirements of Article 17bis(6) (independent patentability).

### 3.2 Procedure where the amendment made in request for appeal is legal

Where an amendment made in the request for appeal is legal, specifically, the amendment satisfies the requirements of Article 17bis(3) to (6), an examiner shall continue the reconsideration by examiners before appeal proceedings in the following procedures, depending on whether the subject of the amendment is only the description or the drawings, or on which paragraph in Article 17bis(5) the purpose of the amendment falls under based on the description, the claims and the drawings after the amendment.

#### 3.2.1 Where only the description or the drawings are amended, or where the amendment is made for the deletion of a claim or claims, the correction of errors, or the clarification of an ambiguous statement (Article 17bis(5)(i), (iii) or (iv))

After confirming that the reasons in the decision of refusal are proper, the examiner shall determine whether the legal amendment in the request for appeal resolves the reasons in the decision of refusal.

When determining that the reasons in the decision of refusal are resolved, the examiner shall further determine whether any other new reason for refusal is found.

In accordance with the results of the determination, the examiner shall make a decision to grant a patent (cancel the original decision), issue a notice of reasons for refusal or make a reconsideration report, as in the following (1) to (3).

(1) When determining that the reasons in the decision for refusal are resolved and finding no other reason for refusal in the amended description etc., the examiner shall cancel the original decision and make a decision to grant a patent.

(2) When determining that the reasons in the decision for refusal are resolved and finding another reason for refusal in the amended description etc., the examiner shall issue a notice of reasons for refusal or make a reconsideration report, as in the following a or b.

a Where the found reasons for refusal include only reasons for refusal necessitated to be newly found by the amendment (Note), a notice of reasons for refusal shall be, in principle,

issued. In this case, the examiner shall issue "the final notice of reasons for refusal".

- b Where the found reasons for refusal include a reason other than a reason for refusal necessitated to be newly notified by the amendment, the examiner shall make a reconsideration report to indicate the found reason for refusal (a matter of (v) shown in 3.) as the result of the reconsideration.

(Note) The "reasons for refusal necessitated to be newly notified by the amendment" here mean those corresponding to the following (i) or (ii).

(i) A new reason for refusal arising by the amendment made in the request for appeal (for illegal amendments, see 3.3)

(ii) A reason for refusal that had arisen before the decision for refusal but had not need to be determined before the decision for refusal, and as the result that determination of the reason is necessitated by the amendment in the request for appeal a new reason for refusal has been found (Example 1 and Example 2)

Example 1:

Addition of a claim in the amendment in response to the first notice of reasons for refusal had failed to resolve the reasons for refusal indicated in the notice of reasons for refusal. Consequently, the decision for refusal was made without examination on the added claim. This caused the necessity of examination on the added claim in reconsideration by examiners before appeal proceedings. As a result of the reconsideration, a new reason for refusal has been found.

Example 2:

A claimed invention had not been examined for novelty, inventive step, etc. before the decision of refusal because it had been the subject of exclusion from the search. The claimed invention was amended in the request for appeal, and thus, it was not the subject of exclusion from search any more. This caused the necessity of examination of the claimed invention for novelty, inventive step, etc. Consequently, a new reason for refusal based on novelty, inventive step, etc. has been found.

- (3) Where determining that the reasons in the decision for refusal are unresolved, the examiner shall make reconsideration report to indicate matters of (i), (iv) and (v) shown in 3. as the result of the reconsideration.

3.2.2 Where the amendment of the claims is made for restriction of the claims and the amendment satisfies the requirements for independent patentability (Article 17bis(5)(ii), (vi))

An examiner shall determine whether the amended claimed invention has a reason for refusal due to requirements other than the requirements for determination on whether the claimed invention can be patented independently (for example, new matter beyond the original text, (Article 49(6)) (Note)).

The examiner shall make a decision to grant a patent (cancel the original decision), issue a notice of reasons for refusal or make a reconsideration report, in accordance with the determination results, as in the following (1) or (2).

For cases where a claimed invention to which the amendment has been made for restriction of the claims is unpatentable independently, see 3.3.

(Note) Only in cases where doubt arises concerning the consistency between the foreign language document and the description, etc., the examiner shall check the foreign language document and the description, etc. to determine whether a new matter beyond the original text exists. (see "Part VIII, Chapter 2 Examination of Foreign Language Written Application", 2.2).

(1) Where no reason for refusal under requirements other than the requirements for determination on whether the claimed invention can be patented independently is found, the examiner shall cancel the original decision and make a decision to grant a patent.

(2) Where a reason for refusal non-compliance with of requirements other than the requirements for determination on whether the claimed invention can be patented independently is found, the examiner shall issue a notice of reasons for refusal or make a reconsideration report, in accordance with the following (i) or (ii).

(i) Where the found reasons for refusal include only reasons for refusal necessitated to be newly notified by the amendment (see (Note) in 3.2.1(2)), the examiner shall, in principle, issue a notice of reasons for refusal. In this case, the examiner shall issue "the final notice of reasons for refusal".

(ii) Where the found reasons for refusal include a reason other than new reasons for refusal necessitated to be newly notified by the amendment, the examiner shall make a reconsideration report to indicate the found reasons for refusal (a matter of

(v) shown in 3.) as the result of the reconsideration.

### 3.3 Procedure where the amendment made in the request for appeal is illegal

Where the amendment in the request for appeal is illegal, more specifically, the amendment fails to comply with any of the requirements under the provisions of Articles 17bis(3) to (6) is violated, the examiner shall determine again whether the reasons in the decision for refusal are proper and determine where the description, the claims and the drawings as of the decision of refusal has any other reason for refusal.

The examiner shall make a reconsideration report or make a decision to grant a patent in accordance with the determination results, as in the following (1) to (3).

(1) When determining that the reasons in the decision for refusal are proper, the examiner shall make a reconsideration report to indicate matters of (i), (ii), (iv) and (v) shown in 3. as the result of the reconsideration.

(2) When determining that the reasons in the decision for refusal were not proper and finding no other reason for refusal in the description, the claims and the drawings as of the decision of refusal, the examiner shall decide dismissal of the amendment, cancel the decision of refusal and make a decision to grant a patent.

(3) When determining that the reasons in the decision for refusal are not proper but finding other reason for refusal in the description, the claims and the drawings as of the original decision, the examiner shall make a reconsideration report to indicate matters of (ii), (iv) and (v) shown in 3. as the result of the reconsideration.

(Points to note)

Where the amendment in the request for appeal is illegal, the examiner shall consider the following points.

(1) In reconsideration by examiners before appeal proceedings, even where the amendment is not made legally illegal, the examiner shall not decide dismissal of the amendment except for cases of deciding to make a decision to grant a patent (Article 164(2)).

(2) Where the amendment in the request for appeal is illegal, a notice of reasons for refusal shall not be issued, except for cases of 3.5.

### 3.4 Examination in a case where after "final notice of reasons for refusal" is notified

in reconsideration by examiners before appeal proceedings

#### 3.4.1 Examination where a response is made to the notice of reasons for refusal

##### (1) Where the written amendment is submitted

In this case, the examiner shall, in principle, conduct the examination in accordance with the above 3.1 to 3.3. In the examination, "in the request for appeal" and "reasons in the decision of refusal" in 3.1 to 3.3 are replaced with "in response to the final notice of reasons for refusal in reconsideration by examiners before appeal proceedings" and "reasons for refusal indicated in the final notice of reasons for refusal in reconsideration by examiners before appeal proceedings", respectively. In making a reconsideration report, the examiner shall indicate matters of (iii) shown in 3. in addition to the matters described in the above 3.2 or 3.3, in the reconsideration report.

Regarding 3.2.1(2) and 3.2.2(2), the examiner shall not issue a notice of reasons for refusal but make a reconsideration report to indicate a matter of (v) shown in 3., except for cases of 3.5.

##### (2) Where the written amendment is not submitted

In this case, the examiner shall determine whether the reasons for refusal indicated in the notice are resolved by considering the allegations in the written opinion etc.

When determining that the reasons for refusal indicated in the notice is resolved and finding no other reasons for refusal, the examiner shall cancel the original decision and make a decision to grant a patent.

When determining that the reasons for refusal indicated in the notice are unresolved, the examiner shall make a reconsideration report to indicate items (iii) to (v) shown in 3. as the result of the reconsideration.

#### 3.4.2 Examination where no response is made to the notice of reasons for refusal

Where no response is made to the notice of reasons for refusal, the examiner shall make a reconsideration report to indicate items (iii) and (v) shown in 3. as the result of the reconsideration.

### 3.5 Where the examiner can indicate a response the requester can take to resolve the reasons in the decision for refusal

Where a reconsideration report is to be made but the examiner can indicate a response the requester can take to resolve the unresolved reasons in the decision for refusal or the newly found reasons for refusal and there is a possibility to establish the agreement on the response with the requester, the examiner shall try to communicate with the requester. Where the agreement is established, the examiner shall issue a notice of reasons for refusal.

The notice of reasons for refusal in this case shall be, in principle, "the final notice of reasons for refusal" (see "Section 3 Notice of Reasons for Refusal", 3.2.1(2)c).

### 3.6 Points to note

(1) Where a basis of determination on the illegality of the amendment or the found reasons for refusal are concerned with requirements that are not regarded as reasons for invalidation (for example, Article 37, Article 17bis(4) and 17bis(5)) and reconsideration by examiners before appeal proceedings can be promptly performed by effectively making use of the examination results already obtained, the examiner shall not formally apply the requirements more strictly than necessary to such an invention as is deemed worth a protection.

(2) When determining that there is no possibility to make a decision to grant a patent, the examiner shall consider to make a reconsideration report, except for cases of 3.2.1(2) and 3.2.2(2).