

<Relevant Provisions>

Patent Act

(Amendment of Description, Claim or Drawings attached to the application)

Article 17bis

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

- (i) where the applicant has received the first notice (hereinafter referred to in this Article as the "notice of reasons for refusal") under Article 50 (including the cases where it is applied mutatis mutandis pursuant to Article 159(2) (including the cases where it is applied mutatis mutandis pursuant to Article 174(2)) and Article 163(2), hereinafter the same shall apply in this paragraph) and said amendment is made within the designated time limit under Article 50;
- (ii) where, following the receipt of the notice of reasons for refusal, the applicant has received a notice under Article 48septies and said amendment is made within the designated time limit under said Article;
- (iii) where, following the receipt of the notice of reasons for refusal, the applicant has received a further notice of reasons for refusal and said amendment is made within the designated time limit under Article 50 with regard to the final notice of reasons for refusal; and
- (iv) where the applicant files a request for a trial against an examiner's decision of refusal and said amendment is made at the same time as said request for said trial.

(2) to (6) (Omitted)

(Examiner's decision of refusal)

Article 49

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

- (i) an amendment made to the description, scope of claims or drawings attached to the application of a patent application does not comply with the requirements as provided in Article 17bis(3) or (4);
- (ii) the invention claimed in the patent application is not patentable under Article 25, 29, 29bis, 32, 38 or 39(1) to 39(4);
- (iii) the invention claimed in the patent application is not patentable under the provisions of any relevant treaty;
- (iv) the patent application does not comply with the requirements under Article

36(4)(i), 36(6), or 37;

- (v) where notice under the preceding Article has been given, following the amendment of the description or submission of the written opinion, the patent application does not comply with the requirements under Article 36(4)(ii);
- (vi) where the patent application is a foreign language written application, matters stated in the description, scope of claims or drawings attached to the application of said patent application do not remain within the scope of matters stated in foreign language documents; and :
- (vii) when the patent applicant does not hold the right to receive a patent concerning the invention.

(Notice of reasons for refusal)

Article 50

Where the examiner intends to render an examiner's decision to the effect that an application is to be refused, the examiner shall notify the application for the patent of the reasons therefor and give said applicant an opportunity to submit a written opinion, designating an adequate time limit for such purpose; provided, however, that in cases referred to in Article 17bis(1)(i) or (iii) (in the case of Article 17bis(1)(i), limited to the case where the examiner has given a notice set under the next Article along with the notice of reasons for refusal), this shall not apply where a ruling dismissing an amendment under Article 53(1) is rendered.

(Decision to grant a patent)

Article 51

Where the examiner's decision is rendered, the Commissioner of the Patent Office shall serve to the applicant of a Patent a certified copy of the examiner's decision.

(Dismissal of amendments)

Article 53

In the case of Article 17bis(1)(i) or 17bis(1)(iii) (in the case of Article 17bis(1)(i), limited to the case where the examiner has given a notice under Article 50-2 along with the notice of reasons for refusal), where, prior to the service of the certified copy of the examiner's decision notifying to the effect that a patent is to be granted, an amendment made to the description, scope of claims or drawings attached to the application is found not to comply with paragraphs (3) to (6) of Article 17bis, the examiner shall dismiss the

amendment by a ruling.

(2), (3) (omitted)

Article 162

In the case of a request for a trial against an examiner's decision of refusal, where an amendment has been made to the description, scope of claims or drawings attached to the application in the patent application pertaining to the request simultaneously with the request, the Commissioner of the Patent Office shall direct the examiner to examine the request.

Article 163

(1) Provisions of Articles 48, 53 and 54 shall apply mutatis mutandis to an examination under the provision of the preceding Article. In this case, the term "Article 17bis(1)(i) or (iii)" in Article 53(1) shall be deemed to be replaced with "Article 17bis(1)(i), (iii) or (iv)" and the term "an amendment" in Article 53(1) shall be deemed to be replaced with "an amendment (in the case of Article 17bis(1)(i) or (iii), excluding the amendment made prior to the request for a trial against an examiner's decision of refusal)."

(2) Provisions of Article 50 and Article 50bis shall apply mutatis mutandis where a reason for refusal which was not contained in the examiner's decision concerned in the request for a trial is found in the examination under the provision of the preceding Article. In this case, the term "in the case of Article 17bis(1)(i) or (iii) (in the case of Article 17bis(1)(i), limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal)" in the proviso to Article 50 shall be deemed to be replaced with "in the case of Article 17bis(1) (limited to the case where the examiner has given a notice under the next Article along with the notice of reasons for refusal, and excluding the case where the applicant has made an amendment prior to the filing of a request for a trial against an examiner's decision of refusal), (iii) (excluding the case where the applicant has made an amendment prior to the filing of a request for a trial against an examiner's decision of refusal) or (iv)."

(3) Provisions of Articles 51 and 52 shall apply mutatis mutandis where a request for a trial is found to have reasonable grounds in the examination under the provision of the preceding Article.

Article 164

(1) In an examination under the provision of Article 162, where the examiner renders a decision to the effect that a patent is to be granted, the examiner shall rescind the examiner's decision of refusal that is the basis of the trial request.

(2) Except in the case provided in the preceding paragraph, the examiner may not render a ruling dismissing an amendment under Article 53(1) as applied under Article 163(1).

(3) Except in the case provided in paragraph (1), the examiner shall report to the Commissioner of the Patent Office the result of the examination without rendering a decision on the request for said trial.

(Submission of documents, etc.)

Article 194

(1) The commissioner of the Patent Office or the examiner may request a party in a case to submit documents or other materials required for a procedure other than one relating to opposition, a trial, or a retrial.

(2) (Omitted)