

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

<Relevant Provisions>

Patent Act

(Amendment of proceedings)

Article 17(1)

(Omitted)

(2) Notwithstanding the main clause of the preceding paragraph, an applicant of a foreign language written application as provided in Article 36bis(2) may not amend foreign language documents and as provided in Article 36bis(1).

(3) to (4) (omitted)

(Amendment of Description, Claim or Drawing 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 of filing said request for said trial.
- (2) Where an applicant of a foreign language written application as provided in Article 36bis(2) amends the description, scope of claims or drawings under the

preceding paragraph for the purpose of correcting an incorrect translation, the applicant shall submit the statement of correction of the incorrect translation, stating the grounds thereof.

(3) Except in the case where said amendment is made through the submission of a statement of correction of an incorrect translation, any amendment of the description, scope of claims or drawings under paragraph (1) shall be made within the scope of the matters described in the description, scope of claims or drawings originally attached to the application (in the case of a foreign language written application under Article 36bis(2), the translation of the foreign language documents as provided in Article 36bis(2) that is deemed to be the description, scope of claims and drawings under Article 36bis(6) (in the case where the amendment to the description, scope of claims or drawings has been made through the submission of the statement of correction of an incorrect translation, said translation or the amended description, scope of claims or drawings), the same shall apply in Articles 34bis(1) and 34ter(1)).

(4) to (6) (Omitted)

#### Article 36bis(1)

A person requesting the grant of a patent may, in lieu of the description, scope of claims, drawings (where required) and abstract as provided in paragraph (2) of the preceding Article, attach to the application a document in foreign language as provided by Ordinance of the Ministry of Economy, Trade and Industry, stating matters required to be stated in the description or the scope of claims under paragraphs (3) to (6) of said Article, and drawing(s) (where required) which contain any descriptive text in said foreign language (hereinafter referred to as "foreign language documents"), and a document in said foreign language stating matters required to be stated in the abstract under paragraph (7) of said Article (hereinafter referred to as "foreign language abstract").

(2) The applicant for a patent application in which the document and abstract in foreign language are attached to the application under the preceding paragraph (hereinafter referred to as "foreign language written application") shall submit to the Commissioner of the Patent Office Japanese translations of the document and the abstract in foreign language within one year and four months from the date of filing of the patent application (or in the case of a patent application containing a priority claim under Article 41(1), the filing date of the earlier application provided for in the said paragraph, in the

case of a patent application containing a priority claim under Article 43(1), 43-2(1) or 43-2(2), the filing date of the earliest application, a patent application that is deemed to be the earliest application under Article 4.C(4) of the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, the same shall apply hereinafter) or a patent application that is recognized as the earliest application under Article 4.A(2) of the Paris Convention, and in the case of a patent application containing two or more priority claims under Article 41(1), 43(1), 43-2(1) or 43-2(2), the earliest day of the filing dates on which the said priority claims are based, the same shall apply to the main clause of Article 36-2(2) and Article 64(1)); provided, however, that where the written application in foreign language is a new patent application arising from the division of a patent application under Article 44(1), or a patent application arising from the conversion of an application under Article 46(1) or (2), or a patent application based on a utility model registration under Article 46bis(1), the applicant may submit Japanese translations of the document and the abstract in foreign language even after the lapse of the time limit prescribed in the main clause, but not later than two months following the division of a patent application, conversion of application or filing of patent application based on a utility model registration.

(3) Where the translation of foreign-language-documents and the foreign-language abstract as provided in the preceding paragraph have not been submitted within the time limit prescribed in the main clause of the said paragraph (the time limit prescribed in the proviso to the said paragraph where the translation of foreign-language-documents and the foreign-language abstract may be submitted under the proviso to the said paragraph; hereinafter the same shall apply in this Article), the Commissioner of the Patent Office shall notify the applicant of the foreign-language-written-application thereof.

(4) A person who has received the notice as provided in the preceding paragraph may submit the translation of foreign-languagedocuments and the foreign-language abstract as provided in paragraph (2) to the Commissioner of the Patent Office only within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(5) Where the translation of foreign-language-documents (excluding drawings) as provided in paragraph (2) has not been submitted within the time limit as provided in paragraph (4), the patent application shall be deemed to have been withdrawn upon

expiration of the time limit prescribed in the main clause of the said paragraph.

(6) An applicant of a patent application that was deemed to have been withdrawn pursuant to the provision of the preceding paragraph, where there are justifiable reasons for having not been able to submit the said translation within the time limit under paragraph(4), may submit to the Commissioner of the Patent Office translations of the foreign-language-documents and the foreign-language-abstract under paragraph (2), only within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(7) The translation submitted under paragraph (4) or the preceding paragraph shall be deemed to have been submitted to the Commissioner of the Patent Office at the time of expiration of the time limit under the main clause of paragraph (2).

(8) The translation of foreign language documents as provided in paragraph (2) shall be deemed to be the description, scope of claims and drawings submitted with the application under paragraph (2) of the preceding Article and the translation of foreign language abstract as provided in paragraph (2) shall be deemed to be the abstract submitted with the application under paragraph (2) of the preceding Article.

(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) to (v) (Omitted)

(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) (Omitted)

Regulations under the Patent Act

(Language of the foreign language written application)

Article 25quarter

The foreign language as provided by Ordinance of the Ministry of Economy, Trade and Industry under Article 36bis(1) of the Patent Act shall be English and other foreign language.

(Format, etc., of the Translation)

Article 25septies

(Omitted)

(2), (3) (Omitted)

(4) The period prescribed by the Ordinance of the Ministry of Economy, Trade and Industry under Article 36bis (4) of the Patent Act shall be two months from the day on which notification under Article 36bis (3) was notified.

(5) to (8) (Omitted)